The Contribution of Cultural Studies to Right of Publicity Laws: Evocative Identification, Associative Appropriation and Political Recoding

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ABSTRACT

Celebrity sells. The right of publicity, broadly defined as the inherent right of every individual to control the commercial use of his or her identity, has been well-established in the United States (US) for over fifty years. It protects the associative value that one brings to products and services, and is invoked mainly by celebrities to prevent unauthorised commercial uses of their persona.

There is a wealth of legal literature in the US that discusses a broad range of issues from justifications for the right of publicity to its interaction with freedom of speech under the First Amendment. However, very few contributions have studied the connections between cultural practices and the right of publicity in depth. This dissertation draws on insights pertinent to aspects of right of publicity laws in its evaluation of how the cultural studies literature may contribute to doctrinal development. The usefulness of cultural studies in this inquiry rests in its examination of the roles and meanings of celebrities in contemporary society.

This thesis demonstrates how an appreciation of the production, circulation and consumption of the celebrity personality can be incorporated into an analytical framework. It argues that what we generally call ‘celebrity’ is a collective product of the celebrity individual, the audience and the cultural producers. Two exemplary insights are explored. The first insight on the definition of the contemporary celebrity based on well-knownness provides the impetus for the legal protection of the commercial value of identity. The second insight about the celebrity’s function as a cultural sign representing majoritarian ideals has important implications both for contemporary consumption and identity politics. It will be shown how these insights support the concepts of evocative identification, associative appropriation and political reencoding, all contributing to a more nuanced understanding of three key elements of a typical publicity claim. As celebrities in other common law jurisdictions like the United Kingdom and Australia rely on the passing off action to seek redress for unauthorised commercial uses of their identity, the relevance of these concepts to passing off is also examined.
The findings indicate that insights from cultural studies on the celebrity phenomenon can support both an expansive interpretation of identification in a publicity claim and, at the same time, a more restrictive application of the requirement of commercial appropriation. The dissertation also demonstrates how treating ideological codings of the celebrity persona as political speech can influence the articulation of the First Amendment defence. In addition, these cultural insights have similar relevance to passing off laws, supporting a broad interpretation of goodwill and damage, and a standard of impressionistic association based on the notion of affective transfer as sufficient to constitute misleading conduct.

In conclusion, this dissertation establishes that, far from being merely a theoretical discipline concerned with semiotic codings and the politics of power and identity, cultural studies provides a pragmatic framework for judges, scholars and lawyers to further their understanding of the extra-legal issues relating to the laws protecting the commercial value of the celebrity personality.
CHAPTER 1 INTRODUCTION

I OVERVIEW

The fact is – celebrity sells. Famous faces greet us at every turn – on billboards, on television, on public transport, in the newspapers and magazines, and even on cereal boxes. As cultural studies scholar Graeme Turner suggests,

it is the pervasiveness of celebrity across the modern mass media that encourages us to think of it as a new development . . . . The exorbitance of celebrity’s contemporary cultural visibility is certainly unprecedented, and the role that the celebrity plays across many aspects of the cultural field has certainly expanded and multiplied in recent years.¹

Bolstered by their ubiquitous presence in the mass media and the internet, the commercially valuable reputations of celebrities are often widely exploited. The right of publicity, broadly defined as the ‘inherent right of every human being to control the commercial use of his or her identity’,² has been well-established in the United States for over fifty years.³ It protects the burgeoning ‘associative value’ that celebrities bring to products and services.⁴ Generally perceived to be a property right akin to an intellectual property right,⁵ the right of publicity has been invoked mainly by celebrities to prevent unauthorised commercial uses of various aspects of their persona.

There is a wealth of legal literature in the United States – both cases and academic commentaries – that discusses a broad range of issues from the doctrinal justifications for the right of publicity to its interaction with free speech values protected by the First Amendment. However, very few contributions to this field of law have studied the connections between cultural practices and the right of publicity in depth, and these

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³ It was first recognised by the Second Circuit in 1953 that baseball players had a ‘right of publicity’ in their images. Haflan Laboratories Inc v Topps Chewing Gum Inc, 202 F 2d 866, 868 (2nd Cir, 1953). In the only right of publicity case ever to reach the US Supreme Court, the court affirmed the recognition of such an actionable right. Zacchini v Scripps-Howard Broadcasting Company, 433 US 562 (1977).
writings tend to use cultural studies in a postmodern tradition to challenge the legal recognition of the right of publicity. This thesis offers a different contribution by using relevant insights from cultural studies in a pragmatic manner to evaluate how an understanding of contemporary production, circulation and consumption of the celebrity personality could assist a doctrinally-focused understanding of the right of publicity.

Contemporary culture in industrialised nations is characterised by a vibrant kaleidoscope of images and spectacles that permeate the fabric of everyday life, influencing consumption choices and political views, and providing meaningful materials out of which people may shape their own identities. It is in ‘hybrid mode’ as ‘consumer-citizens’ that ‘individuals participate to express freedom, choice and identity’.

The conceptual framework of cultural studies can help one better understand why certain cultural artifacts are popular and their impact within the environment they inhabit, and more importantly, can provide insights into how the law may respond in the context of this cultural milieu. This dissertation argues that the celebrity personality – or the commercially valuable public persona of what we generally call ‘celebrity’ – is a collective product of the celebrity individual, the audience and the cultural producers.

The *celebrity individual* is the physical human person as distinct from the public image of the famous personality that the audience perceives and with whom it identifies. The *audience* encompasses anyone who consumes or uses the celebrity commodity or any product associated with a celebrity; this includes consumers and users of the mass media and purchasers of goods and services. The *cultural producers* include the mass media and other cultural intermediaries, like advertising agencies, transnational corporations, local businesses, brand consultants, talent management and public relations firms, that contribute to the creation, development and propagation of the celebrity personality.

However, in adjudicating right of publicity claims, the courts rarely consider how the relationships and interactions between the constituents of this ‘celebrity trinity’ may influence, if at all, the doctrinal development of publicity laws. Too often, the law focuses only on the celebrity individual as the equivalent of the celebrity personality, ignoring the quintessential roles of the audience and the producers. In sum, this thesis seeks to (i) demonstrate that an important value that cultural studies can bring to right of

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publicity doctrine lies in its investigation of the celebrity trinity, in particular, through its understanding and critique of ideological codings and its examination of identity formation practices; and (ii) uncover a pragmatic framework for the application of cultural studies to key elements of a right of publicity claim.

II OUTLINE OF A RIGHT OF PUBLICITY CLAIM

The right of publicity is articulated in the Restatement (Third) of Unfair Competition as follows: ‘[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’. It explains the meaning of ‘purposes of trade’ as being ‘used in advertising the user’s goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user’; however, exempted uses include ‘news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.’ Injunctive and monetary relief may be granted for an appropriation of the ‘commercial value’ of a person’s identity.

For celebrities who actively seek fame through the attention of the media, it was an unconvincing argument to extend the traditional right of privacy to prevent the unauthorised commercial uses of their identities. The Restatement (Third) makes a distinction between the right of privacy and right of publicity, explaining that while privacy relates to an ‘injury to solitude or personal feelings’, the right of publicity provides a redress for ‘commercial harm’ and is widely seen to be ‘a purely economic

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7 Restatement (Third) of Unfair Competition § 46 (1995). The right of publicity action is available to all claimants – celebrities and non-celebrities. However, due to the highly lucrative commercial value associated with the celebrity identity, most claims are brought by celebrities like Tiger Woods, Dustin Hoffman, Johnny Carson, Bette Midler and professional sporting league athletes for unauthorised uses of their identity. Eg ETW Corp v Jireh Publishing, 332 F 3d 915 (6th Cir, 2003) (‘ETW Corp’); Hoffman v Capital Cities/ABC Inc, 255 F 3d 1180 (9th Cir, 2001); Midler v Ford Motor Co, 849 F 2d 460 (9th Cir, 1988); Carson v Here’s Johnny Portable Toilets Inc, 698 F 2d 831 (6th Cir, 1983); Doe v TCI Cablevision, 110 SW 3d 363 (Mo banc, 2003); Wendt v Host International, Inc, 125 F 3d 806 (9th Cir, 1997); Cardtoons LC v Major League Baseball Players Association, 95 F 3d 959 (10th Cir, 1996).


10 See, eg, United States cases from the early twentieth century, where the courts protected individuals from unauthorised commercial uses of name and likeness by enforcing a right of privacy: Pavesich v New England Insurance Co, 50 SE 68 (Ga, 1905); Edison v Edison Polyform Manufacturing Co, 67 A 392 (NJ, 1907); Kunz v Allen, 172 P 532 (Kan, 1918).

11 Restatement (Third) of Unfair Competition § 46 cmt b (1995); McCarthy, above n 2, § 1:35.
The complementary tort of appropriation of personality under the rubric of invasion of privacy was primarily designed to compensate for the hurt feelings of private individuals who find their identities usurped for another’s commercial gain; and it is articulated in the *Restatement (Second) of Torts* that ‘[o]ne who appropriates to his own use or benefit the name and likeness of another is subject to liability to the other for the invasion of his privacy.’ Since it is widely accepted that the right of publicity originated from the privacy tort of misappropriation of identity, some courts, when adjudicating a common law claim for an unauthorised commercial use of identity, may refer to the *Restatement (Second)* instead. The *Restatement (Third)* also indicates that similar substantive rules may govern the determination of liability. As Steven Hoffman noted, it is ‘more accurate to think of [the right of publicity] as a *sui generis* mixture of personal rights, property rights, and rights under the law of unfair competition then to attempt, Procrustean-like, to fit it precisely into one of those categories.’

Although the right of publicity may have been accepted as an emerging area of intellectual property law in the US, its conceptual basis is still not entirely clear. Legal scholars Stacey Dogan and Mark Lemley have identified ‘the usual explanations’ as belonging to three categories: ‘the moral or natural rights story; the exhaustion or

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13 *Restatement (Second) of Torts* § 652C (1977).

14 The right of publicity and the right of privacy are not mutually exclusive and they originate from the same wrong. See William L Prosser, ‘Privacy’ (1960) 48 California Law Review 383, 389. See also *Restatement (Third) of Unfair Competition* § 46 cmt b (1995). Following the decision in *Haelan Laboratories*, Melville Nimmer explained that the right to privacy provided insufficient protection for the commercial value of one’s identity because it focused on prevention of feelings of indignity and embarrassment that are often not present in cases involving celebrities and that this new publicity right should more appropriately be an assignable property right. This seems to be the view adopted in over half of the US states. Melville Nimmer, ‘The Right of Publicity’ (1954) 19 Law & Contemporary Problems 203. Despite the differences in the types of damages that may be recovered, the key elements of the publicity tort and the identity misappropriation tort are essentially similar. *Doe*, 110 SW 3d 363, 368-69 (Mo banc, 2003). See also comments by Howard I Berkman, ‘The Right of Publicity-Protection for Public Figures and Celebrities’ (1976) 42 Brooklyn Law Review 527, 534-41.


allocative-efficiency account; and the incentive-based rationale.' These theoretical justifications have all been subject to numerous criticisms, but there is no doubt that the right of publicity is firmly entrenched in American jurisprudence and provides the fundamental protection for the commercial value of the celebrity identity. Commentator Sheldon Halpern cogently argues that the ‘right of publicity in recognizing exclusive rights to “fame” is not predicated on a moral judgment of transcendent “entitlement” … [it] is predicated on a societal reaction to the phenomenon of celebrity.’ Indeed the Restatement (Third) observes that overriding rationale appears to be grounded in unjust enrichment, with the result that, unlike in Lanham Act § 43(a) and passing off claims, there is no need to prove likelihood of confusion or misleading conduct. Furthermore, the law is more concerned with an unauthorised commercial advantage gained by the defendant than with any actual damage or loss suffered by the plaintiff.

In practice, infringement of the right of publicity is found when the plaintiff is ‘identified’ from the defendant’s unauthorised commercial use. If a defendant seeks to draw attention to his or her own product, the defendant will inevitably make the plaintiff as identifiable as possible, since there is little point in resorting to subtle references which few consumers will perceive. This seemingly easy requirement to fulfill however does not mean the right of publicity is a ‘pure misappropriation’ tort. The misappropriation doctrine, as recognised in US law, is a separate concept based on unfair competition and provides redress for an unauthorised taking of property in the context of commercial competition. The right of publicity tort differs not only conceptually, but also in the

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21 Halpern, above n 4, 866.
22 Restatement (Third) of Unfair Competition § 46 (1995) cmt c. However, the award of compensatory damages is ‘measured [either] by the loss to the plaintiff or … by the unjust gain to the defendant’. Restatement (Third) of Unfair Competition § 49 (1995) cmt a. While damage is often presumed, the court may award nominal damages if the plaintiff fails to establish on the evidence pecuniary gain to the defendant or pecuniary loss to the plaintiff. Restatement (Third) of Unfair Competition § 49 (1995) cmt c.
23 Eg Restatement (Third) of Unfair Competition § 46 (1995) cmt d; McCarthy, above n 2, § 3:7.
24 Eg International News Service v Associated Press, 248 US 215 (1918); Goldstein v California, 412 US 546 (1973); National Basketball Association v Motorola Inc, 105 F 3d 841 (2nd Cir, 1997); Michael Ahrens, ‘The Misappropriation Doctrine After Sears-Compco’ (1968) 2 University of San Francisco
elements of the claim. Mere unauthorised taking should not result in liability. Bird CJ’s detailed explanation of the right of publicity is instructive in determining when actionable appropriation has occurred:

When a product’s promoter determines that the commercial use of a particular person will be advantageous, the promoter is often willing to pay handsomely for the privilege … Such commercial use of an individual’s identity is intended to increase the value or sales of the product by fusing the celebrity’s identity with the product and thereby siphoning some of the publicity value or good will in the celebrity’s persona into the product … [T]he marketable product . . . is the ability of a person’s name or likeness to attract the attention and evoke a desired response in a particular consumer audience.  

From Bird CJ’s analysis, it is clear that both the recognition value (well-known to large segments of consumers) and the affective value that elicits a favourable response (well-liked by large segments of consumers) underscore the commercial attractiveness of the celebrity persona – the ‘marketable product’. While recognition value has been thoroughly examined by courts regarding evocative uses of identity, judges have mostly ignored any discussion of affective value. This notion of affective transfer – the siphoning of publicity value – ought to be more explicitly examined in right of publicity cases. As the Restatement (Third) points out, the right of publicity ‘protect[s] the value associated with the identity of a celebrity’ and that it is ‘fundamentally constrained by the public and constitutional interest in freedom of expression.’ The fact that the defendant seeks or is successful in obtaining a commercial advantage from an otherwise permitted expressive use of another’s identity does not render the appropriation actionable. This dissertation therefore takes the view that the expansive reach of the right of publicity, as a result of an increasing recognition of numerous protectable indicia
of identity attributable to the contemporary celebrity, should be properly limited by considerations of affective transfer and recoding/free speech interests.

III  SCOPE OF THIS DISSERTATION

This dissertation does not seek to interrogate the doctrinal foundations of the right of publicity. Instead it will concentrate on examining key elements of the claim to determine if they are consonant with – or can be informed by – cultural practices and consumption behaviour. As J Thomas McCarthy, one of the foremost authorities on the right of publicity remarks, ‘the initial phase of questioning what the right of publicity is, and whether it should exist at all, has passed into history.’

What is in dispute today is not whether the right of publicity should exist, but rather what it protects and the extent of the protection.

The right of publicity exhibits significant variations due to its recognition in both common law and statutory regimes at the state level in United States; there is no overarching federal right of publicity. To bring focus to the law for the purposes of this thesis, common themes will be identified from the cornucopia of common law and statutory publicity right regimes in almost thirty states. The Restatement (Third) of Unfair Competition § 46 is taken also as a starting point. As a highly regarded distillation of the law prepared by the American Law Institute, the Restatement (Third) clarifies both the common-law principles and the related statutory rules.

A state-by-state analysis of the laws here is not of primary importance as the aim of this research project is to investigate how relevant perspectives in cultural studies can contribute to understanding key elements of a typical claim. As the thesis is concerned

30 McCarthy, above n 2, § 1:34. See also Halpern, above n 4, 869 (‘very few voices have been raised questioning the legitimacy of the right’).
31 In 2009, 28 states had provided their citizens with a remedy for infringement of the right of publicity. Eighteen states recognise publicity rights by way of common law, and of those, eight also have statutory provisions. Ten states provide only a statutory remedy. McCarthy, above n 2, § 6:3.
32 ‘Restatements are … prepared by the American Law Institute (ALI), a prestigious organization comprising judges, professors, and lawyers. The ALI’s aim is to distill the “black letter law” from cases, to indicate a trend in common law, and, occasionally, to recommend what a rule of law should be. In essence, they restate existing common law into a series of principles or rules.’ Restatements of the Law (2009) Harvard Law Library <http://www.law.harvard.edu/library/research/guides/united_states/restatements-of-the-law.html> at 30 June 2009.
with discovering – and evaluating – the common principles that resonate through the right of publicity claims as defined in the different state jurisdictions, this necessitates certain assumptions to be made. From the definition of the right of publicity adopted by the *Restatement (Third)*, it appears that generally the right of publicity is infringed when the following conditions are all satisfied:

(i) the plaintiff’s identity was used ‘without consent’;

(ii) the plaintiff’s identity – ‘name, likeness or other indicia’ – has been used in a manner that identifies the plaintiff;

(iii) there must be an appropriation of the ‘commercial value of a person’s identity’ and mere use of the identity without consent for the purposes of trade is insufficient; and

(iv) the use of identity does not fall within an exempted category like ‘news reporting, commentary, entertainment, works of fiction or non-fiction, or in advertising that is incidental to such uses’; the defendant may also argue that a particular unauthorised use is nevertheless justified and protected as a form of speech under the First Amendment – more frequently known as the First Amendment defence.

As consent is rarely a contentious doctrinal issue in a right of publicity claim and is largely governed by contract law, the focus therefore will be on the three key elements of a right of publicity claim that have either elicited the greatest disagreement amongst courts and commentators or have been largely ignored in legal analysis: the interpretation of the actionable indicia of identity in the ‘use of identity’ requirement, the commercial advantage gained in ‘appropriation of commercial value of identity’, and the First Amendment defence.

In addition, the jurisdictions of the state of New York and California, as well as their respective appellate Second and Ninth Circuit courts, have been chosen as the focus

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34 In a common law claim, the courts usually require the defendant to show that there was express written or oral consent by the celebrity plaintiff if there was a complementary applicable statute stipulating express consent. In the absence of such a statute, consent may also be ‘implied from conduct or inaction reasonably interpreted as manifesting consent.’ See *Restatement (Third) of Unfair Competition* § 46 cmt f (1995).
of this research. However, references to other state and Circuit court decisions will be made where appropriate to illustrate a similar viewpoint or to discuss significant doctrinal differences. Of all the US states, New York and California boast a disproportionately high concentration of celebrities in the film, television and entertainment industries. There are far more reported cases on celebrity claims under the New York Civil Rights Law than under equivalent common law or statutory claims in any other state. The prominence of the Hollywood industry has also resulted in expansive protection being accorded to the right of publicity in California, and other jurisdictions often look to the Ninth Circuit and the California state courts for guidance in right of publicity cases.

Although this dissertation focuses on the right of publicity, observations and conclusions on the production, circulation and consumption of the celebrity may also be relevant to another area of law outside of the United States that regulate the commercial exploitation of the celebrity personality. In particular, the common law passing off action in the United Kingdom and Australia will be considered. There are a number of academic commentaries suggesting that, unlike the right of publicity, the passing off action does not adequately protect the commercial value of the contemporary celebrity persona. However, there is limited literature attempting a cultural studies analysis of passing off, and this dissertation argues that the legal recognition of impressionistic association as capable of satisfying the requirement of misrepresentation is consonant with contemporary consumption behaviour.

**IV METHODOLOGY AND STRUCTURE**

This project starts with the premise that legal analysis and doctrinal development may benefit from observations and empirical research conducted in cultural studies, particularly on consumption behaviour and identity politics relating to uses of the

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35 Although New York protects the commercial value of persona under its statutory privacy tort, the New York courts and the Second Circuit have handed down numerous significant decisions over the last half century involving claims by celebrities to prevent unauthorised commercial uses of their identity. See New York Civil Rights Law §§ 50-51 (McKinney 2007); McCarthy, above n 2, §§ 6:74-6:98.
celebrity personality. Cultural studies has considered these issues at length and it appears likely to be a useful exercise to consider what that literature could add to legal approaches.

As cultural studies is a diverse discipline that incorporates perspectives from other areas like anthropology, gender studies, media studies, semiotics and sociology, this dissertation will adopt a combination of resources based on revised, updated, and reconstructed readings of the Frankfurt School, of British cultural studies, and of some positions of postmodern theories. As cultural scholar Douglas Kellner notes, instead of selecting a particular theory of cultural studies, this ‘multiperspectival approach’ is not only ‘pragmatic contextualist’ in its orientation, but can also yield ‘more insightful and useful analyses than those produced by one perspective alone’. Such an approach is evident in the celebrity studies of contemporary cultural scholars like Richard Dyer, David Marshall and Graeme Turner, and of Stuart Hall, whose writings constitute an invaluable resource for this research. Dyer’s groundbreaking work Stars in 1979 provided the first seminal analysis of Hollywood stars as a social phenomenon, and their semiotic significance in the areas of consumption and social identity construction. His ideas have influenced the development of subsequent cultural studies writings that investigate the celebrity phenomenon, some of the more significant ones being Marshall’s Celebrity and Power (which analysed the ideological power of celebrity signs and their principal functions in capitalist democracies) and Turner’s Understanding Celebrity (which studied the contemporary cultural processes involved in the production and consumption of the celebrity). At the same time, the scholarship of Stuart Hall, often seen to be highly influential in the British cultural studies movement, has also made significant contributions to the study of the semiotic connotations of the celebrity sign. Over the last two decades, the research of Grant McCracken on the celebrity endorsement effect in economic consumption, drawing on semiotics and other cultural writings, has also influenced other scholars exploring the connection between the star aura and consumer

behaviour. These works will form the foundation of the cultural studies approach undertaken in this dissertation.

The usefulness of cultural studies to the right of publicity doctrine rests in its examination of the roles and meanings of celebrities in contemporary society, and how people consume them and incorporate them into their daily lives. This dissertation aims to draw certain insights from cultural studies that resonate with aspects of right of publicity laws in its investigation of how the literature may contribute to doctrinal development. Some of these ideas are evident in the writings of legal scholars like Rosemary Coombe and Michael Madow who have drawn from cultural studies to criticise the right of publicity and other intellectual property regimes for their restrictive impact on the public domain. For example, Madow argues that ‘no such [justification] has yet been made with respect to star images’ that celebrities should be granted ‘property rights in our culture’s basic linguistic, symbolic, and discursive raw materials’. Even courts have sometimes attempted to import cultural studies considerations into their evaluation of right of publicity claims. However, the perfunctory application of these cultural insights by the Sixth Circuit has met with a number of criticisms. This thesis will use cultural studies in a manner different from the postmodern agenda of these legal scholars and will engage with it more closely than the existing case law has done. It will instead employ cultural studies with a pragmatic orientation to discover what it has to offer to the advancement of right of publicity doctrine.

42 Madow, ibid 239.
43 Eg ETW Corp., 3d 915, 933 (6th Cir, 2003).
This dissertation has seven Chapters.

Chapter 2 highlights key aspects in cultural studies writings about the contemporary celebrity phenomenon to indicate how some of these may be relevant to the analysis of the elements of a right of publicity claim. It explains how cultural studies has been used by legal scholars writing in a postmodern tradition to criticise the legal recognition of the right of publicity and the impact that the commodification of identity has on the public domain. It will outline how this dissertation aims to use cultural studies in a different manner. With a pragmatic orientation, the final part of this chapter will engage in an analysis of key cultural studies texts which are relevant to an understanding of the cultural, political and economic significance of contemporary celebrity and its relationship with the audience. It derives two broad insights which will be further explored in subsequent chapters: (i) that the contemporary celebrity personality is defined in cultural studies by the notion of ‘well-knownness’; and (ii) that the majoritarian values or ideals which the celebrity personality may exemplify as a cultural sign can have significant impact on the consumption of commodities and identity politics which utilise the celebrity symbolically in speech that contributes to a participatory democracy.

Chapter 3 contends that insights from cultural studies support the expansive interpretation of the first element of a right of publicity claim – the ‘indicia of identity’ requirement. It analyses this requirement in purely doctrinal terms before moving to evaluate how cultural studies perspectives on the symbolic meanings that audiences accord to the celebrity personality when making their consumption decisions can support the judicial recognition of other aspects of identity that extend beyond name and likeness. By examining the influential works of cultural scholars who discuss the contemporary celebrity phenomenon, like Dyer, Marshall and Turner, this chapter argues that all forms of evocative identification of the celebrity ought to be accepted as being sufficient to satisfy the threshold requirement of identifiability in a right of publicity claim.

Chapter 4 discusses why the second element of commercial appropriation – widely accepted in legal literature as the crux of a publicity claim – is often glossed over by the courts, and suggests that only uses of the associative value of the celebrity identity should be actionable. As pointed out in Part II, the right of publicity is not a pure
misappropriation tort, and this Chapter argues that a narrower interpretation of appropriation should be embraced: only such unauthorised uses of associative value that result in commercial harm should be found to satisfy the element of commercial appropriation. It also contends that perspectives in cultural studies, particularly the findings of McCracken who studied the associative impact of celebrities on the consumption decisions of audiences, support the conclusion that the law ought to focus on associative appropriation. Although right of publicity doctrine does not require the showing of misrepresentation, the judicial presumption that identification is tantamount to misappropriation\(^45\) overly favours the celebrity individual, and merits a degree of circumspection. It further recommends the adoption of a direct and substantial connection standard which would better direct judicial attention to the determination of whether the associative value of the celebrity’s identity has in fact been appropriated by the defendant; this inquiry ensures that liability is imposed only in the circumstances where the defendant has sought or has realised the transfer of affective values from the celebrity persona to the defendant’s product.

Chapter 5 argues that cultural studies supports the protection of certain uses of the celebrity identity as political speech within First Amendment doctrine. It examines how courts have devised various tests to resolve the conflict between the proprietary right of publicity and free speech values protected by the First Amendment. Its doctrinal analysis is premised on a participatory theory of the First Amendment which finds support in Supreme Court decisions and analyses of other legal commentators. Drawing on the cultural writings of scholars like Dyer and Turner, as well as Michael Warner and Rosemary Coombe, this Chapter explains why particular uses of celebrity identity, in addition to their economic significance in consumption, may be categorised as ‘political speech’. It further suggests how present judicial tests can take into account such political recodings of the celebrity sign so as to give greater protection to speech that contributes to democracy.

Chapter 6 considers what lessons, if any, the findings from this research project suggest for another area of law which regulates the commercial exploitation of the

\(^{45}\) Eg Restatement (Third) of Unfair Competition § 46 (1995) cmt a; McCarthy, above n 2, § 1:35; Eastwood v Superior Court for Los Angeles County, 149 Cal App 3d 409, 420 (1983); Wendt v Host International, Inc, 125 F 3d 806, 811-2 (9th Cir, 1997).
celebrity personality. The common law passing off action – the claim relied upon by celebrities in common law jurisdictions, like the UK and Australia, which do not recognise a right of publicity – is examined. The conclusions are that the insights from cultural studies support the justification for a passing off action that determines liability based on consumers’ impression of whether the affective values have been transferred from the celebrity persona to the defendant’s product, and that free speech interests, especially political recodings, may be accommodated within the element of misrepresentation. If one accepts the notion of affective transfer as the basis for liability as argued in Chapter 4, then the element of damage should also be evaluated against this understanding. Finally, the analysis suggests that the extended passing off action not only appears to be adequate in protecting against unauthorised exploitation of the associative value of a celebrity’s persona, but is also able to consider, in a more holistic manner than the right of publicity, the interests of the constituents of the celebrity trinity.

Chapter 7 summarises the findings emerging from the doctrinal analysis and relevant writings in cultural studies that are pertinent to right of publicity and passing off laws. This dissertation demonstrates that, far from being just a theoretical discipline concerned with the politics of power and identity, cultural studies can provide a useful analytical framework for judges, scholars and lawyers to further their understanding of the extra-legal issues relating to the laws protecting the commercial value of the celebrity personality.
CHAPTER 2  RELEVANT INSIGHTS FROM CULTURAL STUDIES FOR RIGHT OF PUBLICITY LAWS

This Chapter establishes a set of relevant insights from cultural studies that will be further investigated in Chapters 3, 4 and 5. It will advance the argument that in contemporary highly industrialised societies like the United States, which are characterised by consumer capitalism and the ubiquity of mediated communications, the celebrity personality may be regarded generally as a semiotic text possessing both significant cultural and economic values pertinent to right of publicity doctrine.

Part I provides a brief overview of the historical origins of cultural studies, its interdisciplinary nature and the development of cultural writings on the contemporary celebrity phenomenon.

Part II will discuss how cultural studies has been mostly used by legal scholars who write in a postmodern or poststructural tradition to criticise the legal recognition of the right of publicity as having a detrimental effect on the use of communicative symbols in the public domain. It will highlight how this dissertation aims to make a different contribution to legal doctrine by investigating how insights from cultural studies could develop the law’s understanding of contemporary cultural and consumption practices, and consequently reshape the elements of a right of publicity claim.

Part III engages in an examination of key cultural studies texts which are relevant to an understanding of the cultural, economic and political significance of contemporary celebrity and its relationship with the audience. It derives two broad insights which will be further explored and applied to three elements of a typical common law right of publicity claim. These insights are: (i) that the contemporary celebrity is defined, not by significant individual achievements, but by its widespread public recognition; and (ii) that the celebrity as a cultural sign embodies specific meanings which are relevant to both the consumption process and in identity politics. The specific contributions of these insights to each of the three elements will be addressed over the next three chapters.
I OVERVIEW OF CULTURAL STUDIES

How might cultural studies be useful to law? One often equates cultural studies with the theory and politics of ideology, identity and difference, but as Lawrence Grossberg points out, new discursive opportunities present themselves when cultural studies moves ‘towards a model of articulation as “transformative practice”’. While some may regard this broader use as ‘cultural analysis’, this dissertation will adhere to the more familiar term ‘cultural studies’ as it seeks to draw out prominent features of cultural studies relevant to aspects of right of publicity laws. Much of cultural studies research concentrates on how a particular phenomenon relates to matters of ideology, race, social class and gender; it departs from the text (which can be seen as the law’s main concern) to undertake a discursive analysis of the context to consider how power in society is distributed and contested through processes of production, circulation and consumption. Its ‘study of the quotidian world’ often employs a combination of ideological and empirical approaches, such as audience survey, content analysis, narrative analysis, semiotics and star studies. This thesis will focus on key contemporary cultural scholars who examine the function of the celebrity in society, the extent to which the audience help determine cultural meanings and messages, and their interactions with the cultural producers. This approach can offer robust analyses of the celebrity trinity that contribute to the law’s understanding of the celebrity phenomenon.

The origins of cultural studies may be traced back to the Frankfurt School, whose most ardent proponents Max Horkheimer and Theodor Adorno postulated a neo-Marxian passive and resigned audience in a society where certain cultural products and practices

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1 Chris Rojek, Cultural Studies (2007) 28. Rojek also observes that cultural studies is characterised by the 3D’s of deconstruction, demythologization and demystification. Ibid 27-8.
4 Eg Douglas Kellner, ‘The Frankfurt School and British Cultural Studies: The Missed Articulation’ in Jeffrey T Nealon and Caren Irr (eds), Rethinking the Frankfurt School: Alternative Legacies of Cultural Critique (2002) 31. Kellner points out that cultural studies ‘operates with a transdisciplinary conception’ in understanding how texts are ‘articulating discourses in a given sociohistorical conjuncture’ and one ‘should move from text to context, to the culture and society that constitutes the text and in which it should be read and interpreted.’ Ibid 43.
in the culture industry reproduce ideological domination. Despite some stark differences in their focus, the Frankfurt School and much of contemporary cultural studies share ‘at least a family of resemblances as practices that attempt to understand … commodity culture’. Frankfurt School theorists generally view mass-mediated popular culture as a field in which autocratic and dominant meanings are systematically reproduced and reinforced by the culture industries. Extending this Frankfurt view to the contemporary celebrity personality, it appears that the cultural producers are creating and perpetuating a product – the celebrity – that induces the audience to live in ‘a world of hypnotic definitions and automatic ideological equations’; and as later writings of the star phenomenon would reveal, the celebrity is seen to be an embodiment of particular majoritarian values/ideals. The celebrity personality, in the eyes of the Frankfurt School, is little more than a cultural artifact – a ‘commodity’ – that is produced in order to be exchanged for money. This view finds parallels in contemporary empirical research on consumption behaviour where econometric models have been constructed to analyse the

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10 Bennett, above n 8, 44.

11 See below Part IIIIB.

12 This view, however, is not universally held by members of the Frankfurt School. For example, Benjamin thought the technological reproduction of important works of art could democratise art’s critical insights: Walter Benjamin, *Illuminations* (1969).
value of the celebrity identity and the impact of celebrity associations on consumer choice.\textsuperscript{13}

In contrast to the Frankfurt School, the highly influential Birmingham Centre for Contemporary Cultural Studies (‘Birmingham School’), established in 1964 by Richard Hoggart, and later headed by Stuart Hall, tends to see popular culture as a contested terrain in which individuals make and establish their own cultural meanings, and in the process, resist and even subvert the preferred meanings that are generated and circulated by the culture industries.\textsuperscript{14} The Birmingham School has been regarded as producing some of the foundational texts of cultural studies. Their signature approach assigns a less important role to cultural producers, and is focused on how culture is made and practised by different groups and classes in society struggling for cultural domination.\textsuperscript{15} In demonstrating ‘how culture came to constitute distinct forms of identity and group membership’, these writings focused on ‘how subcultural groups resist dominant forms of culture and identity … [and] create oppositional identities, defining themselves against standard models.’\textsuperscript{16} Although many of Hall’s works relate to televiusal media, his key thesis may be extended to an understanding of the mediated celebrity personality as a ‘naturalistic illusion’, constituted by ‘the combination of verbal and visual discourse … [requiring] the most skilful and elaborate procedures of coding’.\textsuperscript{17}

Seen as a corrective to the Frankfurt School,\textsuperscript{18} the Birmingham view on encoding and decoding in culture suggests a distinction between cultural texts and subtexts: culture conveys meanings and values explicitly through the text, and it also conveys them

\textsuperscript{14} Eg Stuart Hall, ‘Encoding/Decoding’ in Stuart Hall, Dorothy Hobson, Andrew Lowe and Paul Willis (eds), Culture, Media, Language (1980) 128; Iain Chambers, Popular Culture: The Metropolitan Experience (1986); John Fiske, Reading the Popular (1989).
\textsuperscript{15} For Hall, popular culture is one of the sites where the ‘struggle for and against a culture of the powerful is engaged … It is the arena of consent and resistance.’ Stuart Hall, ‘Notes on Deconstructing the “Popular”’ in Raphael Samuel (ed), People’s History and Socialist Theory (1981) 228, 239. See also Jane Woollacott, ‘Messages and Meanings’ in Michael Gurevitch, Tony Bennett, James Curran & Janet Woollacott (eds), Culture, Society and the Media (1982) 91.
\textsuperscript{16} Kellner, above n 4, 35.
\textsuperscript{18} Douglas Kellner, Media Culture: Cultural Studies, Identity and Politics Between the Modern and the Postmodern (1995) 8.
implicitly via the subtext, in which obscured messages and values are encoded in cultural gestures – eg the association of glamorous movie stars or high-performing athletes with a product – and these are decoded by the audience to yield specific meanings. These concepts have established important foundations for the development of contemporary celebrity studies.

Contemporary cultural studies are concerned with the practices of popular culture, the relationships between audiences and producers, the formation of identity and the nature of consumption. Scholars often adopt a multiperspectival approach that blends together ideas from this history of cultural studies, as well as from discourses and theories like gender and race studies, psychoanalysis and postmodernism. Since the late 20th century, as new media appear, the human image that is conveyed is intensified and the number of individuals celebrated grows. Concomitantly, there has been a flourishing of academic writing in cultural studies concentrating on the meaning of celebrity and fame in contemporary culture. The celebrity can be a ‘commodity’, ‘sign’, ‘text’, ‘ideology’ and ‘ideal’ as much as he or she is a human individual. Contemporary cultural studies emphasises ‘the democratic and participatory rather than the authoritarian and repressive potential of contemporary popular culture.’ It also draws on scholars who adopt a postmodern or poststructural approach in their semiotic study of culture where the products or ‘texts’ of the culture industries (film, music, sport, fashion, celebrities etc) are deconstructed and particular attention is paid to the process in which audiences – whether as individuals or groups – compete to establish their presence, identities and meanings.

A multiperspectival approach involves properly contextualising, analysing and redefining the nature and effects of right of publicity laws against these findings. It has

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been argued that when ‘utilized in a proficient and revelatory fashion’, the limitations of a particular theoretical approach may be offset by the strengths of another; thus the more interpretive perspectives one can bring to a cultural artifact, the more comprehensive and stronger one’s reading may be. In their critique of the celebrity phenomenon in contemporary culture, the star studies of scholars like Richard Dyer, David Marshall, Chris Rojek and Graeme Turner have employed a combination of deconstructive techniques, empirical research and ideological arguments. In this interdisciplinary endeavour, celebrity is conceptualised ‘as something to be professionally managed, rather than discursively deconstructed’; the doctrinal challenge is then how best to understand and manage this cultural phenomenon in the formulation of right of publicity laws. In summary, the celebrity trinity of the celebrity individual, the audience and the producers work in concert, although not necessarily in a coordinated conscious fashion, to create what is known as the ‘celebrity’. The central argument begins with the assertion that there exist certain personalities called ‘celebrities’ who command widespread recognition from a diverse population. Drawing from a series of performances (eg from the movies and sporting arena) or media representations, the audience will ‘abstract and reapply to the [celebrity individual] a particular, defined personality … that takes on iconic significance.’ The next Part will discuss how existing legal literature have addressed these themes.

II EXISTING LEGAL LITERATURE AND CULTURAL STUDIES

The focus here is on eliciting salient themes from the cultural writings on the contemporary celebrity. A number of scholars have propounded the value of engagement between cultural studies and law. Although cultural studies has achieved autonomy as a discipline in its own right, ‘cultural studies’ as a label can have its limitations in legal scholarship. First, it has ‘its roots planted firmly in the Marxist struggle over commodity fetishism and [in the] working class culture’ which tends to treat private property in

22 Kellner, above n 18, 98-9.
23 Turner, above n 19, 136.
25 Almost three decades ago, Hall has contended that cultural studies had ‘a direction, an object of study, a set of themes and issues, a distinctive problematic of its own’. Stuart Hall, ‘Cultural Studies and the Centre: Some Problems and Problems’ in Stuart Hall, Dorothy Hobson, Andrew Lowe and Paul Willis (eds), Culture, Media, Language (1980) 15, 26. See also Francis Mulhern, Culture/Metaculture (2000) 101-4.
intangibles ‘with not only zealous suspicion but outright contempt’. Second, it is a particularly diverse discipline in which a constellation of interpretive practices is used to study the production, dissemination and consumption of culture and the meanings of cultural forms.

Scholars like Austin Sarat and Jonathan Simon have been prominently involved in the ‘cultural analysis’ of law, focusing on the cultural lives of law and how the law is ‘a part of the cultural processes that actively contribute in the composition of social relations.’ Cultural perspectives on law are a growing part of contemporary legal scholarship, paralleling the emergence of cultural studies as an academic discipline. Of legal works that use cultural studies as an interpretive background and consider issues of publicity and intellectual property, there has been an overwhelming criticism that the right of publicity, like other intellectual property rights, goes too far in protecting the commercial value of identity, and significant rejection of the legal recognition of publicity rights as being harmful to the cultural domain. Legal scholars like Keith Aoki, David Lange, Jane Gaines, Rosemary Coombe and Michael Madow have drawn on cultural studies in their critique of intellectual property laws that restrict the terms and conditions of cultural production. For much of this writing, a key point is that ‘the power to license is the power to suppress’.

27 Eg Kellner, above n 4, 42-3.
28 Sarat and Simon, above n 3; See also Austin Sarat and Thomas R Kearns (eds), Law in Everyday Life (1993); Susan Silbey, ‘Making a Place for a Cultural Analysis of Law’ (1992) 17 Law and Social Inquiry 39.
34 Ibid 145.
challenge or subvert the meaning he or she prefers. Sometimes known as ‘critical cultural legal studies’, these attacks on the right of publicity doctrine often focus on how the enforcement of such rights would close off the ‘public domain … [resulting in the loss of] the rich heritage of its culture, the rich presence of new works derived from that culture and the rich promise of works to come.’ For example, although Madow accepts that the ‘“associative” or “publicity” value [of celebrities] derives from their semiotic power’, he concludes that no compelling justification has yet been made for celebrities to be granted ‘property rights in our culture’s basic linguistic, symbolic, and discursive raw materials’.

Some legal work has questioned the more absolute aspects of these approaches. Justin Hughes has pointed out that

the argument for more recoding freedom probably overstates the negative impact of existing intellectual property laws on the self-expression of non-owners … [and] understates the positive utility non-owners derive from stability in the meaning of propertized intellectual property.

Hughes argues that the critics who draw from cultural studies rarely acknowledge that non-owners commonly benefit from cultural objects having at least relatively ‘stable meanings’ and has illustrated how consumers of the celebrity persona often ‘rely on a stable image for self-definition or expression.’ Hughes explains that

recoding must be using the cultural object or recognizable elements of the object in a forum for third persons to achieve different effects than those generally achieved already by the object; the different results must affect the meaning of the original object in the social discourse.

36 Lange, above n 30, 163. See also Madow, above n 33, 142.
37 Madow, above n 33, 142-3.
38 Ibid 239.
40 Ibid 926, 952-63.
41 Ibid 957.
42 Ibid 947. Popular examples often cited include greeting cards depicting well-known heterosexual male icons John Wayne and Clark Gable with gay themes. Ibid 931.
However, for recoding to occur, it ‘depends on the image itself retaining background stability.’\(^{43}\) Similarly, legal commentator Jason Bosland agreed that trademark rights are not ‘culturally oppressive and dialogically restrictive’, and has relied on writings in cultural studies to show that ‘trademark ownership might, in fact, serve culturally beneficially interests’.\(^{44}\) Bosland contends that ‘the \textit{per se} ownership of intellectual property should not have the effect of restricting the production or use of cultural resources if intellectual property rights are tempered by appropriate limitations.’\(^{45}\)

This dissertation expands on such work, and investigates what contribution cultural studies can make to right of publicity doctrine, and whether it could facilitate such ‘appropriate limitations’ to be found. As pointed out in Chapter 1, this dissertation aims to use cultural studies to assist in the doctrinal development of right of publicity laws, and represents an effort to create a new interdisciplinary synthesis that investigates what cultural pragmatism can contribute to the law. When one moves beyond the usual agenda of cultural studies of deconstructing ‘the complex interpenetrations of power and subjectivity’\(^{46}\) one may ultimately uncover the richness that cultural studies offers to the advancement of legal doctrine.\(^{47}\) Thus this dissertation eschews the ‘law-and-’ approaches which tend to present a grand theory to understanding the legal system,\(^{48}\) and employs cultural studies in a multiperspectival manner to help construct ‘a model of law that is more rule-like, coherent, and functional’.\(^{49}\) Using key texts in cultural studies, it

\(^{43}\) Ibid 947.


\(^{47}\) The skepticism of the contribution of cultural studies to legal orthodoxy is aptly captured by Sarat and Simon: ‘[B]ecause cultural analysis and cultural studies often are identified with a particularly intense form of boundary breaking – a challenge to givens which regularly invoke the transgressive – one might rightly be skeptical about whether a legal studies field that experiences itself as vulnerable in a highly competitive academic universe would welcome the destabilizing agendas and strategies associated with either cultural analysis or cultural studies.’ Ibid 13.


\(^{49}\) Sarat and Simon, above n 46, 8.
adopts a pragmatic orientation toward inquiry that is both contextualist and instrumental. As Thomas Grey points out,

[I]aw is contextual: it is rooted in practice and custom, and takes its substance from existing patterns of human conduct and interaction. To an equal degree, law is instrumental, meant to advance the human good of those it serves, hence subject to alteration toward this end.

Cultural studies perspectives have already found some support in legal scholarship about publicity on the issue of identification. For example, legal commentator Steven Clay acknowledges that ‘the evocation of identity does not rely upon a realistic rendering of the plaintiff’ and that a use of the ‘trappings’ or ‘surroundings’ of a celebrity identity can ‘reinforce the celebrity’s semiotic message, thus reinforcing who the celebrity is to the audience.’ What is relevant then to the issue of identifiability in a right of publicity claim is why, and how, the concept of ‘well-knownness’ may influence the development of legal doctrine. This thesis, in Chapter 3, will advance the argument that because a celebrity is characterised by an individual’s well-knownness in society, its commercial value may be easily captured without an obvious reference to name or likeness as the celebrity can be evoked by many other publicly identifiable means. Furthermore, as Chapters 4 and 5 will show, the widespread recognition of the contemporary celebrity reinforces its semiotic power in the areas of consumption and political communication.

Thus this dissertation is focused on analysing the context of cultural practices in the consumption of the celebrity personality and uses of the celebrity sign in identity politics. It will concentrate on examining primarily cultural studies literature on the contemporary formation and cultural meanings of movie and sport celebrities, and secondarily on writings regarding postmodern identities in a consumerist society. The next Part will provide an overview of the nature of the celebrity personality as understood in cultural studies in order to identify relevant insights that may help to refine the elements of a right of publicity claim.

50 Ibid 22.
51 Ibid 41-2.
III RELEVANT INSIGHTS FROM CULTURAL STUDIES

The three sections below explore two exemplary insights derived from the corpus of cultural studies writings that are relevant to right of publicity doctrine. Section A contends that the definition of the contemporary celebrity personality in cultural studies as characterised by its ‘well-knownness’ is particularly pertinent to the first element of a right of publicity claim that any attribute that is publicly identified with a celebrity may be legally protected as an actionable aspect of identity. Section B highlights what majoritarian values or ideals the celebrity personality may exemplify as a cultural sign and discusses how this insight gives rise to two implications. First, that the commercial value of the celebrity personality is derived as a result of its affective relationship with the audience, and that this understanding may contribute to reshaping the element of commercial appropriation in right of publicity doctrine. Second, that the celebrity sign as a product of the dominant culture presents a rich symbol of expression for political speech, and may be significant in the articulation of the First Amendment defence in a publicity claim.

A The Celebrity as defined by Widespread Public Identification

Daniel Boorstin’s influential reading of the superficiality of the celebrity in 196153 paved the way for future works on the nature of the contemporary celebrity personality. His elegant and oft-quoted phrase – ‘A celebrity is a person who is known for his well-knownness’54 – is an important starting point for a broad definition of a contemporary celebrity based on a ubiquitous media presence and public recognition. Boorstin’s reading of fame that explains the rapid proliferation of celebrities55 has been adopted by influential contemporary cultural studies scholars who investigate the

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53 Boorstin, above n 19.
54 Ibid 57.
55 For example, in his study of celebrities and popular culture, Australian media scholar McKenzie Wark remarks apropos that celebrity is after all ‘an index of media productivity’ and ‘the human face of the media vector.’ McKenzie Wark, Celebrities, Culture and Cyberspace: The Light on the Hill in a Postmodern World (1999) 82. In another important study of how the media selects and emphasises aspects of news, Todd Gitlin charges that the media creates celebrities ‘where there were none.’ Todd Gitlin, The Whole World is Watching: Mass Media in the Making and Unmaking of the New Left (1980) 154.
celebrity phenomenon like Richard Dyer,\textsuperscript{56} David Marshall,\textsuperscript{57} Chris Rojek,\textsuperscript{58} Graeme Turner\textsuperscript{59} and Garry Whannel.\textsuperscript{60}

Cultural studies writings are notable in their overwhelming acceptance that the contemporary celebrity is ‘characterized by an individual distinction, mass appeal, ubiquity and popular authorship.’\textsuperscript{61} Although criticisms have been rife on the increasing ease of becoming a celebrity based on widespread media circulation instead of acquiring fame based on acting, sporting, artistic, literary or intellectual abilities,\textsuperscript{62} what cultural studies scholars do agree on is the heightened visibility in the media that is characteristic of the contemporary celebrity. A celebrity is not created in a vacuum, but very much a product of the cultural producers. In the 21st century, the escalating growth in the range of media outlets and the vastly increased speed of circulation of information can combine to create the phenomenon of a vortex effect.\textsuperscript{63} In the midst of a vortexual moment, the public persona of a celebrity can be born almost instantaneously, when the newspapers, television, radio, tabloids, columnists, internet chatrooms and blogs are all drawn into the same topic. Individuals from almost any field, be it film, sport, music, television, business or even cookery, can be elevated to the status of celebrity.\textsuperscript{64} It is this widespread public identification – both of the visual image and the embodied values/ideals – that defines a celebrity, and consequently imparts to it a commercial value in the context of consumption.\textsuperscript{65}

In addition to their widespread recognition, celebrities ‘succeed by skillfully distinguishing themselves from others essentially like them’,\textsuperscript{66} through acquiring and

\begin{itemize}
\item \textsuperscript{56} Dyer, above n 19.
\item \textsuperscript{57} Marshall, above n 19, 11.
\item \textsuperscript{58} Rojek, above n 9, 18, 76-7. In particular, Rojek comments that ‘[c]elebrity power depends on immediate public recognition.’ Ibid 76.
\item \textsuperscript{59} Graeme Turner, \textit{Film as Social Practice} (4\textsuperscript{th} ed, 2006) 144; Turner, above n 19, 5.
\item \textsuperscript{60} Whannel, above n 9, 42-3.
\item \textsuperscript{63} Whannel, above n 9, 206.
\item \textsuperscript{64} Eg Irving Rein, Philip Kotler and Martin Stoller, \textit{High Visibility: The Making and Marketing of Professionals into Celebrities} (1997).
\item \textsuperscript{65} Eg Coombe, \textit{Cultural Life}, above n 32, 96.
\item \textsuperscript{66} Boorstin, above n 19, 65.
\end{itemize}
honoring a particular appearance, gesture, voice or other attributes. In writing on why celebrities enhance brand familiarity and favourability, it was observed that celebrities ‘have very high public awareness and people are able to visualize them very easily as they are so familiar with them.’\(^6^7\) This evocative aspect of celebrity – through the ‘marginal differentiation of their personalities’\(^6^8\) that leads to easy audience recall – provides the impetus for the legal recognition and protection of the commercial value of the celebrity identity. The emotional affinity the audience may have with a particular celebrity often translates to some form of imitation,\(^6^9\) where the consumer would purchase products associated with their favourite celebrities to become more like them. In the context of emulating movie stars, Jackie Stacey refers to this behaviour as ‘extra-cinematic identificatory practices’.\(^7^0\)

Chapter 3 will be examining the significance of the observations by cultural scholars that the contemporary celebrity is one defined not by its heroic qualities, but by its public visibility and mass appeal. In practice, as Turner points out, the individual celebrity has ‘a highly identifiable, even iconic, physical image, a specific history for the circulation of this image, and accrues psychological and semiotic depth over time’.\(^7^1\) The next section will explore the semiotic significance of the celebrity sign.

**B The Celebrity as a Cultural Sign**

According to Dyer, Marshall and many other cultural studies scholars, the celebrity is a sign that embodies particular meanings for the majoritarian public.\(^7^2\) Dyer’s

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68 Boorstin, above n 19, 65.  
72 Eg Dyer, *Stars*, above n 19, 2-3, 53-61, 99-181, 183-4; Marshall, above n 19, 57. The ‘celebrity-function’ is as important as Michel Foucault’s ‘author function’ in its power to organise the domains of the personal and individual within the social. The origin of the sign may be attributed to the influential Swiss linguist de Saussure, who perceived linguistics as a branch of a general science of signs he called semiology (now known as semiotics). Ferdinand de Saussure, *Course in General Linguistics* (Roy Harris trans, 1986 ed) [trans of: *Cours de linguistique générale*]. See also Michel Foucault, ‘What is an Author?’ in *Language, Counter-Memory, Practice: Selected Essays and Interviews* (1977); Jean Baudrillard, *The Mirror of Production* (Mark Poster trans, 1975 ed) [trans of: *Le Miroir de la Production*].
extensive work on the movie star has been consistently hailed as being highly influential in the contemporary study of the meaning of celebrities in society. Celebrities can ‘represent typical ways of behaving, feeling and thinking in contemporary society, ways that have been socially, culturally, historically constructed’. In building on Dyer’s arguments in examining the celebrity as a form of cultural power and its significance in identity formation, Marshall observes that celebrities function as stable configurations of collective identity formations and act as ‘icons of democracy and democratic will’. Celebrities have become ‘common points of reference for millions of individuals who may never interact with one another, but who share, by virtue of their participation in a mediated culture [as the audience], a common experience and a collective memory.’

In considering this iconic status, one can draw from Stuart Hall’s *Encoding/Decoding* essay which itself has achieved ‘canonic status’ in relation to audience study. Hall suggests that

we must recognize that the symbolic form of the message has a privileged position in the communication exchange: and that moments of ‘encoding’ and ‘decoding’, though only ‘relatively autonomous’ in relation to the communication process as a whole, are *determinate moments*.

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73 Eg Marshall, above n 19, 17-9; Turner, above n 19, 7.
79 Hall, above n 14, 129.
Referring to Barthes’ work on modern myths, as well as to Antonio Gramsci and Claude Lévi-Strauss, Hall later discusses the politics of signification and how ideological discourses of a particular society are classified and framed through semiotic signs within a ‘pragmatic circle of knowledge’. In Barthesian terms, the celebrity image is seen to be a ‘cultural narrative’ or signifier that is synonymous with the dominant culture. Due to the meticulously constructed public personae of many celebrities particularly the movie stars and sport icons – the semiotic sign of these well-known individuals is usually ‘decoded’ by the audience to represent a defined cluster of meanings. A celebrity persona is like a well-known brand; each advertisement featuring a celebrity can be viewed as ‘a contributory iteration of the brand’ and its function is to attach the ‘brand idea to advertised product or service in appropriate style’. While movie stars are often represented as objects of aspiration, glamour and desire, the celebrity athlete signifies heroism, human transcendence and a love for the pure authentic game.

Hall, ibid n 17, 70-4.
Ibid 74.
Eg Dyer, above n 19; DeCordova, above n 71; Christine Gledhill (ed), *Stardom: Industry of Desire* (1991); Whannel, above n 9; Barry Smart, *The Sport Star: Modern Sport and the Cultural Economy of Sporting Celebrity* (2005).
Eg Dyer, *Stars*, above n 19, 33-85; Marshall, above n 19, 56-71, 185-99, 244-7; Turner, above n 19, 14-5, 23-6, 89-108; Rojek, above n 9, 51-63, 74-8, 91-9, 186-99.
Eg Dyer, above n 19, 99 (‘stars are supremely figures of identification … and this identification is achieved principally through the star’s relation to social types’); McDonald, above n 70, 191 (‘American films offered a greater degree of “glamour”, and American film stars acted as the special representatives of that glamour’); Stacey, above n 70, 138-45 (discussing a survey where respondents described how they admired and worshipped the movie star as someone whose life was different and unattainable); Carmel Giarratana, ‘The Keanu Effect – Stardom and the Landscape of the Acting Body: Los Angeles/Hollywood as Sight/Site’ in Angela Ndalianis and Charlotte Henry (eds), *Stars in Our Eyes: The Star Phenomenon in the Contemporary Era* (2002) 61 (analysing the stardom of movie celebrities especially the global popularity of Keanu Reeves).
Eg Whannel, above n 9, 46 (‘The cultures of sport still depend in part upon a constant re-enacting of the heroic … Footballers Paul Gascoigne and Ryan Giggs have had to carry the burden of figures expected to provide the heroic’); C L Cole and David L Andrews, ‘America’s New Son: Tiger Woods and America’s multiculturalism’ in David L Andrews and Steven J Jackson (eds), *Sport Stars: The Cultural Politics of Sporting Celebrity* (2001) 70, 81 (‘Woods signifies a post-national order, suggests a transnational coalition of sorts, and is imagined as a global-national antidote … Woods is coded as a multicultural sign of color-blindness’); Kyle W Kusz, ‘Andre Agassi and Generation X: Reading white masculinity in 1990s’ America’ in *Sport Stars*, ibid 51, 64 (‘the rearticulation of Agassi’s white masculinity in the mid-1990s exemplifies the process in which he was constructed and valorized for exemplifying a reformed Generation X slacker’).
The concept of celebrity – with its attendant notions of well-knownness, adulation and popularity – is signified through, for example, an entertainer or athlete, and the resulting product is a semiotic sign replete with meaning in everyday culture. As illustrated in Barthes’ work, *Mythologies*, a particular well-known individual, like David Beckham (the signifier), may be viewed as a sign that denotes ‘celebrity’ (the signified). The widespread media narratives and other forms of commercial and non-commercial circulation of the celebrity sign also result in a particular celebrity sign garnering certain connotations which make it distinctive vis-à-vis other signs. Thus a celebrity sign like David Beckham is able to differentiate itself from other celebrity signs with an ascribed set of connotations; for example, the Beckham sign can connote attributes of sexual desirability and over time, the Beckham sign ‘develops into a *metalanguage* and becomes a significant resource for cultural expression and critique.’

In the context of the celebrity, ideology may be viewed as an artifact which ‘mobilizes sentiment, affection, and belief to induce consent to certain dominant core assumptions about social life’. Thus the celebrity as a widely recognised cultural sign, can encourage the public who identify with such attributed ideological values to consume the celebrity itself as a commodity (eg by watching the movies of a particular actor) or products associated with the celebrity (eg by purchasing celebrity-endorsed products). On the other hand, the celebrity semiotic sign, as a result of its publicly identifiable encodings, also presents rich opportunities for alternative codings to challenge these ‘typical ways of behaving, feeling and thinking in contemporary society’ representative of majoritarian ideals. The next two sections will highlight insights from writings on the celebrity sign in these two areas that may be relevant to right of publicity doctrine.

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91 Barthes, above n 80, 110-1. See also Bosland, above n 26, 106.
93 Bosland, above n 26, 107.
94 Kellner, above n 18, 58. The concept of ideology was set out in *The German Ideology* and was used to attack ideas which legitimated ruling class hegemony or which disguised the interests of the dominant class as general ones in order to further class domination. Karl Marx and Friedrich Engels, *The German Ideology* (C J Arthur ed, 1970).
1 Meaning Transfer in Contemporary Consumption

The understanding of how the *symbolic* value of the social significance of celebrities to the audience – regardless of how they have achieved their well-knownness – translates into an *economic* value in a cultural economy where celebrity-related information, images, performances and goods are produced and consumed can help courts to better articulate the meaning of ‘commercial appropriation’.

Dyer’s conclusions in his defining works *Stars* and *Heavenly Bodies* have been featured prominently in the writings of other scholars on the significance of the celebrity sign in contemporary consumption – that the celebrity personality is (i) the epitome of the individual for identification and idealisation in society; (ii) determined by a combination of the cultural producers’ representations and audiences’ readings of these dominant cultural expressions; and (iii) a commodity that is a form of valorisation of the individual that is coherent with capitalism and the associated consumer culture.96 In his critique of consumption, Jean Baudrillard contends that the consumer ‘no longer relates to a particular object in its specific utility, but to a set of objects in its total signification.’97 Thus, increasingly, when consumers buy various consumer goods, they ‘buy into’ the significations of these commodities in the construction of their self-identities.98

Like Barthesian myths, celebrity images in advertising ‘contain subject positions and models for identification that are heavily coded ideologically.’99 Dyer emphatically pronounced that ‘[s]tars are made for profit.’100 Marshall has also argued that the celebrity ‘operates as a brand name for the organization of production and consumption

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96 Eg Marshall, above n 19, 19; Turner, above n 19, 103 (describing Dyer’s works as ‘amongst the most useful and succinct analyses of the cultural function of celebrities in general.’). See also Sean Redmond and Su Holmes (eds), *Stardom and Celebrity: A Reader* (2007) 2 (crediting Dyer’s introduction of ‘the first full-scale textual and ideological examination of this phenomena’ as a ‘defining moment’).
99 Kellner, above n 18, 248.
100 Dyer, *Heavenly Bodies*, above n 74, 5. See also Turner, ibid 34 (‘Celebrities are developed to make money.’).
of cultural commodities”101 in an ‘affective economy.’102 Similarly, in *Celebrity*, Chris Rojek postulates that:

[The celebrity] embodies desire in an animate object, which allows for deeper levels of attachment and identification than with inanimate commodities. Celebrities can be reinvented to renew desire, and because of this they are extremely efficient resources in the mobilization of global desire. In a word, they humanize desire.103

Using a celebrity in advertising, product merchandising and other commercial contexts is likely to have a positive effect on consumers’ brand perceptions and purchasing decisions; this is commonly referred to as the ‘positive halo effect’ within branding and marketing research.104 In buying a product associated with a celebrity, the consumer can buy into some of the glamour, self-indulgence and decadence of the charmed life of a movie star or into the athleticism and success of a sporting icon. Such symbolic celebrity images attempt to create an association between the products offered and the ideologically desirable traits in order to produce the impression that if one wants to be a certain type of person, then one should buy the particular product.105 This is evident in the multi-million dollar endorsement contracts that globally recognised actors and athletes sign each year with brands as diverse as American Express, Louis Vuitton, Nike, Rolex and Gillette. While cultural scholars like Dyer have acknowledged the commoditised status of the celebrity, it was Grant McCracken who in 1989 connected empirical socio-psychological and economic research with cultural studies writings on the semiotic significance of celebrities to consumption.106 McCracken’s conclusion that a celebrity sign is ‘persuasive’ to consumers because the sign is ‘made up of certain meanings that the consumer finds compelling and useful’ provided a good foundation for further investigative work on the impact of celebrities on contemporary consumption.107

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101 Marshall, above n 19, 245.
102 Ibid 247.
103 Rojek, above n 9, 189.
104 Eg Pringle, above n 67, 72.
105 Kellner, above n 18, 248.
106 McCracken, above n 13.
The meaning-transfer model advanced by McCracken – that the symbolic affective values embodied by the celebrity sign is transferred to the product that the celebrity is associated with – supports the raison d’être of the right of publicity to prevent the commercial appropriation of the associative value of identity. In addition to perceiving the celebrity sign as embodying a bundle of meanings, it is argued that the cultural circuit of movement of meaning is complete when members of the public, in expressing their identification with a particular celebrity, consume the celebrity commodity by purchasing products associated with that celebrity. Generally, celebrity endorsements translate into better product sales only when consumers feel that whatever cultural meanings attached to the celebrity can shift along unimpeded paths from the celebrity to the product. In the words of Stuart Hall, this would be an idealised state where the advertiser assumes a ‘dominant-hegemonic position’ and the ‘perfectly transparent communication’ results in the audience’s consumption of the product. The relevance of this insight to legal doctrine will be explored further in Chapter 4 in its discussion of the commercial appropriation element of a right of publicity claim.

2 Contesting Meaning in Identity Politics

Apart from their economic significance, reading culture politically can reveal how celebrity signs can ‘reproduce the existing social struggles in their images, spectacle, and narrative.’ First mentioned in Stars, and later more thoroughly explored in Heavenly Bodies, Dyer’s analysis of the use of the Judy Garland semiotic sign by the gay community provided a valuable foundation for subsequent studies on the use of celebrity personalities by subcultural groups in their identity formation. Described as a ‘foundational observation’ in the study of the cultural function of celebrities, Dyer claims that ‘[s]tars articulate what it is to be a human being in contemporary society.’ Most celebrities may be seen ‘as representing dominant values in society, by affirming what those values are in the “hero” types (including those values which are relatively appropriate to men and women)’ or as alternative or subversive types ‘that express

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108 Hall, above n 14, 136.
109 Kellner, above n 18, 56.
110 See also Rojek, above n 9, 70 (‘Judy Garland’s iconic status in gay culture partly derived from her ability to cope with disapproval, rejection and marginalization’); Madow, above n 33, 194; Coombe, ‘Objects’, above n 32, 1876-7.
111 Turner, above n 19, 103.
112 Dyer, Heavenly Bodies, above n 74, 7.
discontent with or rejection of dominant values. His work on the politics and cultural dominance of whiteness also exposes an Anglo-Saxon hegemony said to be characteristic of American society. According to Dyer’s pioneering analyses, celebrities can have an ideological function of not only reiterating dominant values, but also concealing prevalent contradictions or social problems. More generally, cultural scholars have argued that ‘identities can function as points of identification and attachment only because of their capacity to exclude, to leave out, to render “outside” abjected.’ This theme of popular subcultural resistance permeates much of contemporary cultural studies.

The relevance here to right of publicity doctrine is the observation that different groups in society can use particular celebrity images in a variety of ways to represent their cultural identities and convey their political ideologies. Scholars like John Fiske and Iain Chambers have extended popular resistance beyond that of oppositional groups like subcultures to the potential of audience reconstruction with dominant symbols of a culture. Fiske coined the term ‘semiotic democracy’ to describe a world where empowered audiences freely and widely engage in the use of cultural symbols to express meanings that are different from the ones intended by their creators. Like Chambers, Fiske examines the construction of meanings by the audience, which plays with, parodies and actively subverts the dominant encoding of the sign. Similarly Jane Gaines, in her incisive cultural analysis of law and the circulation of signs, concludes that ‘the sign is disputed territory’. Indeed there is a significant emphasis in contemporary cultural studies on the notion of audience participation – be it their complicity or resistance – in

113 Dyer, Stars, above n 19, 52. See also Dyer, Heavenly Bodies, above n 74, 12 (‘the star phenomenon reproduces the overriding ideology of the person in contemporary society’).
115 Dyer, above n 70, 27-8. See also Turner, above n 19, 102-7; McDonald, above n 70, 192-3.
119 Fiske, above n 14; Chambers, above n 14.
120 Gaines, Contested Culture, above n 31, 230.
the hegemony of cultural texts propagated by the media and other producers. It is in these studies of semiotic disruptions that one may find the relevant tools for establishing a conceptual framework within First Amendment doctrine that addresses the political agenda of the active audience.

The writings of Rosemary Coombe and Michael Warner on subaltern groups and counterpublics have approached the constitution and politics of social and individual identity as being predicated on a power struggle between dominant and subordinate groups. The term ‘subaltern’ or ‘subculture’ is frequently used in cultural studies to denote the subordination of particular identities by a dominant ideological hegemony; the ‘subaltern’s place [in society] is subsumed within … an experience of oppression which privileges particular exemplars as the “proper” figures of identity.’ Building on Jürgen Habermas’ work on the public sphere, Warner’s analysis of the struggles that bring individuals together as a public postulates that ‘subaltern counterpublics’ usually articulate alternative power relations with the dominant public defined by race, gender, sexual orientation and other subordinated status. In an influential article, Nancy Fraser similarly contends that

Members of subordinated social groups – women, workers, peoples of color, gays and lesbians – have repeatedly found it advantageous to constitute alternative publics … [where they] invent and circulate counterdiscourses to formulate oppositional interpretations of their identities, interests and needs.


122 Coombe, Cultural Life, above n 32.


124 Ibid 92.

125 Eg Jürgen Habermas, The Structural Transformation of the Public Sphere: An Inquiry into a Category of Bourgeois Society (Thomas Burger trans, 1989); Craig Calhoun (ed), Habermas and the Public Sphere (1992).

126 Warner, above n 123, 44-63, 117-120.

127 Nancy Fraser, ‘Rethinking the Public Sphere: A Contribution to the Critique of Actually Existing Democracy’ in Craig Calhoun (ed), Habermas and the Public Sphere (1992) 109, 122-3.
Thus counterpublics are ‘counter’ to the extent that they try to supply different ways of imagining participation within a political or social hierarchy by which its members’ identities are formed and transformed.128 According to Warner, a counterpublic maintains ‘an awareness of its subordinate status … [with respect] not just to ideas or policy questions but to the speech genres and mode of address that constitute the public’.129 The structural domination of a white Anglo-Saxon heterosexual male social identity that occupies a privileged public identity suggests that other identities organised around being non-white, homosexual or female will have socially subordinate positions. Other exemplars based on different combinations of race, class, gender, athleticism and sexual desirability also create multiple privileged social identities each valuing a particular ideological position over another. Thus a particular celebrity – like movie star Angelina Jolie or global sport icon Tiger Woods 130 – who is symbolic of a privileged public identity can be seen to represent a majoritarian ideological position. This makes the celebrity sign open to a recoding challenge by minority groups.

With reference to the Beckham example in Part IIIB,131 the dominant coding for the Beckham sign may be construed to represent not just sexual desirability, but also reinforcing the hegemony of white heterosexual desirability (thus excluding the representation of the non-white non-heterosexual). Viewed in this manner, those opposing this majoritarian signification may want to recode the Beckham sign to highlight their subordinate or hidden status in society, and to increase the visibility of their political participation through the use of the celebrity symbol. In the words of Whannel, known for his writings on the signification of sporting celebrities, the image of Beckham that departs ‘from the dominant masculinised codes of footballer style’ may also represent ‘a challenge to the heterosexual conformity of sport’s modes of male self-presentation.’132

128 Warner, above n 123, 121-2.
129 Ibid 119.
131 See accompanying text to above nn 91-93.
132 Whannel, above n 9, 202.
Thus, if one accepts that ideological challenges may be effected through certain recoded uses of the celebrity sign, then one could use a celebrity sign like Beckham to interrogate

the categories of whiteness, men, ruling class, heterosexuality, and other dominant powers and forms that ideology legitimates, showing the social constructedness and arbitrariness of all social categories and the binary system of ideology.

This also means that those who support the prevailing hegemony may also use the celebrity sign in an appropriate manner to express their ideological positions. According to US constitutional scholar Robert Post, in First Amendment jurisprudence, the ultimate purpose of the constitutional concept of public discourse is ‘to enable the formation of a genuine and uncoerced public opinion in a culturally heterogeneous society.’ Although Post does not discuss the point further, he observes that

Speech about prominent celebrities may therefore influence in subtle and indirect ways public deliberation of public policy: it may provide common points of reference for debate, or crystallize common concerns, or shape common metaphors of understanding.

The deconstructive agenda usually encounters much hostility in legal doctrine which tends to seek solutions to problems in the form of myriad formulations and frameworks. When faced with the possibility of a right of publicity claim, those who wish to use recodings of celebrity signs as an expression of their social identities need to reframe the dialogic practice as political speech in the form of a legal argument within the context of a First Amendment defence. Legal commentators who invoke cultural studies as an analytical tool usually phrase their arguments in the language of

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133 Arguments have been made regarding the use of trademarks and copyrighted works in a similar fashion. Eg Coombe, Cultural Life, above n 32; Aoki, above n 29; Katyal, above n 118; Leslie A Kurtz, 'The Independent Legal Lives of Fictional Characters' [1986] Wisconsin Law Review 429.

134 Kellner, above n 18, 61.


136 Post, ibid 674.

commodification and the contestation of meanings within the public domain; however these postmodern or poststructural approaches rarely seek to engage with the orthodoxy of First Amendment doctrine and risk alienating such writings from judges and lawyers.\textsuperscript{138} Indeed contemporary identity-based politics ‘need a revamped, culture-conscious First Amendment jurisprudence’\textsuperscript{139} and Chapter 5 will explore how cultural studies perspectives on the political potential of the celebrity sign can contribute to reframing the First Amendment defence in a right of publicity claim.

IV INTERIM OBSERVATIONS

The interdisciplinary nature of cultural studies blends together the richness of other disciplines like semiotics, sociology and economics, and this Chapter has provided an overview of what a pragmatic multiperspectival approach to cultural studies can offer to right of publicity jurisprudence. The reality is cultural producers engage target audiences via ‘textual signification’ – for example, through advertisements containing prominent celebrity signs – and audiences ‘connect with [them] through interpretive and affective processes of semiotic engagement.’\textsuperscript{140} This Chapter has also identified two key insights on the celebrity phenomenon that are relevant to the development of right of publicity laws in a manner that is sensitive to cultural practices of identity formation and consumption.

The first insight on the definition of the contemporary celebrity as one who is well-known to the public based on its widespread circulation can support the legal recognition of all evocative aspects of identity as actionable indicia in a right of publicity claim; and this will be discussed further in the next Chapter.

The second insight about how the celebrity, functioning as a cultural sign that represents particular ways of behaving, feeling and thinking, as well as majoritarian

\begin{footnotes}
\item[139] Sunder, ibid 157.
\item[140] MacRury, above n 88, 190.
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ideals and values, has important implications both for contemporary consumption and identity politics. These implications will be separately considered in two chapters. Chapter 4 will discuss how the symbolic value of the celebrity translates into an economic value for the consuming audience, especially when used in association with products in a commercial context. In particular, this Chapter will argue that the judicial inquiry on whether commercial appropriation has occurred should take into account how brand perceptions and purchasing decisions of the consumers may be affected by the commercial use of the celebrity identity. Chapter 5 will focus on the political potential of the celebrity sign and its significance to political speech in a participatory democracy. It will argue that, because of its widespread public recognition, the celebrity sign may be important to counterpublics in their political communications that challenge dominant majoritarian ideals. The impact of these political recodings on legal doctrine will be evaluated in the context of the First Amendment defence in a right of publicity claim.

Chapter 6 will assess the relevance of the two insights to the passing off action, the equivalent claim used by celebrities in the United Kingdom and Australia to seek redress for the unauthorised commercial uses of their personae.
CHAPTER 3  RIGHT OF PUBLICITY AND INDICIA OF IDENTITY

This Chapter argues that the judicial recognition of an expansive list of actionable indicia of identity in right of publicity cases is supported by cultural studies perspectives. Through an analysis of doctrine and an investigation of cultural and consumption practices, this Chapter contends that more courts could consider the adoption of an evocative identification standard when determining, as a threshold question, whether the identity of a plaintiff has been used by the defendant. Such an approach will properly give effect to how the identity of a well-known individual with a well-differentiated public personality is called to the minds of the contemporary audience.

Part I explains how the use of identity requirement in a right of publicity claim interacts with the other elements of the claim and highlights the judicial and academic concerns that have been raised over an expanding interpretation of identity. Part II examines how the courts have approached the issue of identification when determining an unauthorised commercial appropriation of a celebrity’s identity, paying particular attention to evocative uses which have attracted the greatest controversy. It proposes that courts should recognise that all indicia of identity are in fact evocative in nature, and that there is no real need to create different artificial categories of actionable characteristics. Part III supports this finding through its investigation of how the contemporary celebrity as defined by its ‘well-knownness’ possesses specific attributes which enable its widespread public identification. It will critically evaluate the application of the proposed evocative identification standard to the different indicia of a celebrity’s identity. Finally, Part IV concludes that insights from cultural studies on the creation of the contemporary celebrity, through widespread public recognition of its distinctive characteristics and its semiotic significance, support the expansive definition of the indicia of identity, and courts could consider referring to such observations to augment judicial reasoning particularly in cases that deal with evocative aspects of identity.

I  THE ‘USE OF IDENTITY’ REQUIREMENT IN A RIGHT OF PUBLICITY CLAIM

Each of the US states that recognise the right of publicity has a different definition of identity. This means that the celebrity plaintiff is likely to go ‘forum shopping’ for the
state which extends the most generous right of publicity protection, and ‘any national advertiser … must abide by the laws of the state or [C]ircuit with the most liberal views on publicity rights to avoid a lawsuit in that jurisdiction.’

To establish a prima facie case, a plaintiff must usually prove that his or her identity has been used, that is, ‘more than de minimis number of ordinary viewers of [the] defendant’s use identify the plaintiff.’ This is a question of fact for the jury. As the Ninth Circuit has pointed out, ‘identifiability … is a central element of a right of publicity claim.’ There are a number of acceptable methods of proving identifiability of the plaintiff from the defendant’s use. They include (i) a simple courtroom ‘on its face’ comparison; (ii) evidence of a number of elements in the context of the defendant’s use which cumulatively point to the plaintiff; (iii) evidence of unsolicited identification by reasonable persons who made comments to the plaintiff about the similarity; (iv) survey evidence of the relevant ‘universe’ of purchasers of the defendant’s product or service, showing that they are able to identify the plaintiff from the defendant’s use; and (v) direct or circumstantial evidence of the defendant’s intent to trade upon the identity of the plaintiff, from which identifiability can be presumed.
The classic definition of identity in a common law claim is usually ‘name and likeness’ with a number of states recognising ‘persona’ as a broader concept encompassing all aspects of identity,\(^\text{11}\) while the definition in a statutory cause of action tends to enumerate specific actionable aspects of identity like ‘name, voice, signature, photograph or likeness’.\(^\text{12}\) It is important to appreciate that an expansive interpretation of what constitutes actionable aspects of identity does not equate liability for the defendant. Theoretically, once the plaintiff is identified from the defendant’s use, one should proceed to consider if the commercial value of that identity has been appropriated by the defendant.\(^\text{13}\) In the final and most significant hurdle, the right of publicity, whether common law or statutory in nature, must be weighed against the preeminent position of the freedoms of speech and press guaranteed in the First Amendment. In articulating the First Amendment defence, the conflict between free speech values and the plaintiff’s proprietary right of publicity presents a significant challenge for courts attempting to formulate different balancing tests to resolve this issue.\(^\text{14}\)

\(^\text{11}\) Eg Eastwood v Superior Court of Los Angeles County, 149 Cal App 3d 409 (1983) (‘Eastwood’) (California); Rogers v Grimaldi, 875 F 2d 994 (2nd Cir. 1989) (Oregon); State ex rel Elvis Presley International Memorial Foundation v Crowell, 733 SW 2d 89 (Tex Ct App, 1987) (Tennessee); Estate of Elvis Presley v Russen, 513 F Supp 1339 (DNI, 1981) (New Jersey).


\(^\text{13}\) Although the Restatement of the Law (Third) of Unfair Competition § 46 and Haelan Laboratories have defined an unauthorised appropriation of the commercial value of a person’s identity, courts have not been consistent in considering this element of the claim. The proof of a ‘direct connection’ is required under certain statutory claims. Eg CCC § 3344(e). See further discussion in Chapter 4.

\(^\text{14}\) The First Amendment defence in a right of publicity claim, as well as the statutory exemptions of particular uses which incorporate free speech considerations, will be discussed in Chapter 5. A celebrity plaintiff will typically argue that an advertisement containing the unauthorised use of his or her identity amounts to ‘commercial appropriation’. However, the counter-argument by the defendant would be to claim that there were artistic elements in the advertisement, or that the expressive use of the celebrity’s identity amounted to political speech or social commentary, hence entitled to First Amendment protection despite its commercial purpose. See generally Hoffman v Capital Cities/ABC Inc, 255 F 3d 1180, 1185 (9th Cir, 2001) (‘Hoffman’); White I, 971 F 2d 1395, 1407 (9th Cir, 1992); Cardtoons LC v Major League Baseball Players Association, 95 F 3d 959, 969-76 (10th Cir, 1996) (‘Cardtoons’); Comedy III Productions Inc v Gary Saderup Inc, 25 Cal 4th 387, 396-410 (2001) (‘Comedy III’); McCarthy, above n 3, § 8:97.
As the analysis in Part II will demonstrate, state jurisdictions like California and New York, which are home to significant numbers of celebrities in the film and entertainment industries where numerous high profile celebrity claims have been decided, as well as the Sixth and Ninth Circuits, have extended the actionable indicia of identity to any distinctive aspect of a celebrity’s public personality. The Restatement has also chosen the California approach as its model code in allowing claims for the unauthorised use of ‘name, likeness, or other indicia of identity’. It has been said that the right of publicity is no longer limited to

the name and likeness of an individual, but now extends to a person’s nickname, signature, physical pose, characterization, singing style, vocal characteristics, body parts, frequently used phrases, car, performance style, mannerisms, and gestures, provided that these are distinctive and publicly identified with the person claiming the right.

The judicial and academic criticisms of this expanding interpretation of identity, especially in a common law right of publicity claim, seem to centre on: (i) creating confusing precedent that will result in exposing advertisers and other performers to lawsuits by celebrities; (ii) overprotecting negligible aspects of persona or ‘ephemeral

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15 Paul Cirino, ‘Advertisers, Celebrities, and Publicity Rights in New York and California’ (1994) 39 New York Law School Law Review 763, 788-92. In New York, the celebrity can only make a claim under the NYCRL §§ 50-51, but the courts have given the statutory definition of ‘name, portrait or picture’ a broad interpretation to include lookalikes and evocative aspects of identity that may constitute a visual depiction or representation of the plaintiff. Eg Onassis, 472 NYS 2d 254 (1984); Ali, 447 F Supp 723 (SD NY, 1978); Lombardo, 396 NYS 2d 661 (1977). New York does not recognise an independent common law right of publicity claim but the NYCRL ‘not only encompasses a right to privacy which minimizes the intrusion or publication of damaging material to a person by use of their name or picture, but also encompasses a right to publicity, which protects the proprietary nature of the person’s public personality.’ DeClemente v Columbia Pictures Industries Inc, 860 F Supp 30, 50 (ED NY, 1994) (‘DeClemente’).

16 Eg Carson, 698 F 2d 831 (6th Cir, 1983); Midler, 849 F 2d 460 (9th Cir, 1988); White I, 971 F 2d 1395 (9th Cir, 1992); Wendt I, 125 F 3d 806 (9th Cir, 1997).


19 Eg White I, ibid 1405 (Ajarcon J); Fred Weiler, ‘The Right of Publicity Gone Wrong: A Case for Privileged Appropriation of Identity’ (1994) 13 Cardozo Arts and Entertainment Law Journal 223, 271 (‘advertisers should be able to remind the public of a celebrity, so long as the advertiser does not link the celebrity to the product in order to make the product more desirable.’); Andrew W Eaton, ‘We’re Not Gonna Take It!: Limiting the Right of Publicity’s Concept of Group Identity for the Good of Intellectual Property, the Music Industry, and the People’ (2006) 14 Journal of Intellectual Property 173, 203 (‘The vision of protectible identity in White, however, stretched the right of publicity beyond the scope of reason.’).
trends’; and (iii) according celebrities an overarching property right that chills speech and impoverishes the cultural domain.

Unfortunately, courts do not always adhere to a formulaic step-by-step approach when evaluating publicity claims. The courts usually equate identification with misappropriation. The presumption is that a commercial advantage was obtained by the defendant if the plaintiff has succeeded in proving that his or her identity has been used by the defendant in a commercial context – combining the first and second elements of the claim. The courts may also look at the totality of the situation and conclude that since the alleged unauthorised use was in an advertisement, it is commercial speech and its intended effect must be to evoke the celebrity in the minds of the audience in order to free-ride on a celebrity’s fame – effectively combining all three elements of the claim in one analysis.

In short, judges have not been consistent in addressing each element of a right of publicity claim separately. It appears from cases like White v Samsung, Wendt v Host International and Lombardo v Doyle, Dane & Bernbach, that the courts are open to

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21 Eg ETW Corp v Jireh Publishing, 332 F 3d 915, 931-8 (Graham J) (6th Cir, 2003) (‘ETW Corp’); White II, 989 F 2d 1512, 1519-21 (Kozinski J) (9th Cir, 1993); Coombe, above n 18, 395 (‘It is through creative cultural practices of articulation that the social world is given meaning, and [these practices are] central to democratic politics.’); Rochelle Cooper Dreyfuss, ‘We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity’ (1996) 20 Columbia-VLA Journal of Law & the Arts 123, 156 (important rhetorical resources will be taken out of the public domain and this cannot be squared with First Amendment values).

22 Eg White II, 989 F 2d 1512, 1516-7 (Kozinski J) (9th Cir, 1993); Carson, 698 F 2d 831, 839, 842-5 (Kennedy J) (6th Cir, 1983); Michael Madow, ‘Private Ownership of Public Image: Popular Culture and Publicity Rights’ (1993) 81 California Law Review 127, 140 (‘the law has moved more and more of our culture’s basic semiotic and symbolic resources out of the public domain and into private hands’); Rosemary J Coombe, ‘Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue (1991) 69 Texas Law Review 1853, 1855 (‘intellectual property laws stifle dialogic practices – preventing us from using the most powerful, prevalent, and accessible cultural forms to express identity, community and difference’).

23 Eg Eastwood, 149 Cal App 3d 409, 420 (1983); Midler, 849 F 2d 460, 463 (9th Cir, 1988).

24 White I, 971 F 2d 1395, 1401 (9th Cir, 1992).


26 Wendt v Host International Inc, 197 F 3d 1284 (9th Cir, 1999) (‘Wendt II’).

finding liability as long as the celebrity in question can be identified from the unauthorised commercial use. The typical right of publicity cases are traditionally divided into two categories: (i) appropriation of name and likeness (which includes any literal depiction like a portrait or photograph); and (ii) evocation that reminds the audience of a particular celebrity (which includes voice, characterisation and objects closely associated with the celebrity). In the appropriation of name and likeness cases, the identifiability element of the claim is usually not a contentious issue, and the courts tend to focus on First Amendment arguments. The evocative cases are more complex, and the courts often combine the ‘use of identity’ and ‘commercial appropriation of the value of identity’ as one analysis which may result in a decision like White which has been the subject of much criticism. However, Part II, in its doctrinal analysis, will attempt to disaggregate the use of indicia of identity from the commercial appropriation element.

II IDENTIFIABILITY: NAME, LIKENESS AND OTHER INDICIA OF IDENTITY

Since the landmark recognition of publicity rights in Haelan Laboratories Inc v Topps Chewing Gum Inc, courts have had difficulty determining ‘the extent to which a use must evoke or appropriate a celebrity’s identity before violating his or her right of publicity.’ Commentators have bemoaned that ‘[d]efining the contours of celebrity identity is an uncommonly puzzling legal undertaking.’ Unlike its statutory counterpart which often delimits the indicia of identity, a common law claim tends to embrace a broader conception of indicia of identity encompassing many aspects of an individual’s persona. In the absence of a federal standard, it is not surprising that most state jurisdictions which recognise a common law right of publicity continue to struggle for a clear and precise definition of this first element.

28 Eg ETW Corp, 332 F 3d 915, 932 (6th Cir, 2003) (majority opinion rejecting the application of White); Landham v Lewis Galoob Toys Inc, 227 F 3d 619, 625-6 (6th Cir, 2000) (‘Landham’) (unanimous opinion rejecting the application of White); Wendt, 197 F 3d 1284, 1285-8 (9th Cir, 1999) (Kozinski, Kleinfeld & Tashima JJ dissenting); Arlen W Langvardt, ‘The Troubling Implications of a Right of Publicity “Wheel” Spun Out of Control’ (1997) 45 University of Kansas Law Review 329; Weiler, above n 19; Welkowitz, above n 20.
29 202 F 2d 866 (2nd Cir, 1953) (‘Haelan Laboratories’).
31 Eaton, above n 19, 204.
Of all the US states, California, boasting a disproportionately high concentration of celebrities in the film, television and entertainment industries, has the broadest definition of ‘identity’ making it an attractive forum for a celebrity to commence a claim. Faced with a stream of celebrity claims for right of publicity infringements over the last thirty years, the California State Supreme Courts and the Ninth Circuit have led the expansion of the definitional parameters of the indicia of identity, and other state and Circuit courts have frequently looked to them for guidance.

Courts have used the term ‘persona’ as an all-encompassing label for all those elements which identify a person. According to McCarthy, ‘persona’ was apparently adopted as a convenient label when courts realised that the traditional phrase ‘name and likeness’ was inadequate to describe the many aspects of a person that can identify him or her. Twenty-five years ago, Sofaer J held that the right of publicity ‘provides the persona – the public image that makes people want to identify with the object person, and thereby imbues his name or likeness with commercial value marketable to those that seek such identification.’ Today, courts in different states usually agree that only individuals who are recognisable by the public from the alleged misappropriation may have any claim for an unauthorised use of identity; it is not sufficient that only the plaintiff knows that his or her persona has been used without consent.


33 According to Circuit Judge Kozinski, ‘we are the Court of Appeals for the Hollywood circuit.’ White II, 989 F 2d 1512, 1521 (9th Cir, 1993). For cases applying California law, see eg, Hoffman, 255 F 3d 1180 (9th Cir, 2001); Wendi, 125 F 3d 806, 811 (9th Cir, 1997); White I, 971 F 2d 1395 (9th Cir, 1992); Waits, 978 F 2d 1093 (9th Cir, 1992); Midler, 849 F 2d 460 (9th Cir, 1988).


36 McCarthy, above n 3, § 4:45.

37 Bi-Rite Enterprises Inc v Button Master, 555 F Supp 1188, 1199 (SD NY, 1983).

While the three sections below analyse the different attributes of persona that cover the traditional categories of name and likeness and a more general category titled ‘evocative aspects of identity’, it should be emphasised that in a significant number of cases, the courts have held that it does not matter whether the celebrity plaintiff was identifiable by any one of these indicia, or several in combination; the ultimate issue is identifiability by the audience from the defendant’s use.\(^{39}\)

### Name

The use of ‘name’ has been widely accepted to include a plaintiff’s real name,\(^{40}\) nickname,\(^{41}\) stage name\(^{42}\) or fictitious name.\(^{43}\) But the plaintiff’s name has to be used as ‘a symbol of identity’\(^{44}\) to obtain a commercial advantage and not as a mere name.\(^{45}\) In *Doe v TCI Cablevision*, it was held that although the fictional character in a comic book (the subject of the alleged unauthorised appropriation) and the real Tony Twist (a well-known former professional hockey player) bore ‘no physical resemblance to each other … aside from the common nickname’,\(^{46}\) nevertheless the name was understood by the public as referring to the plaintiff.\(^{47}\) The courts have made it clear that mere namesameness of a fictional character is not sufficient identifiability to satisfy a right of publicity claim;\(^{48}\) the courts will consider ‘plus factors’\(^{49}\) like whether the defendant intentionally named a character after the plaintiff and whether the target audience for the defendant’s product was the same as the plaintiff’s audience.

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\(^{39}\) Eg *White I*, 971 F 2d 1395, 1398 (9th Cir, 1992); *Abdul-Jabbar v General Motors Corp*, 85 F 3d 407, 414 (9th Cir, 1996) (‘Abdul-Jabbar’); *Carson*, 698 F 2d 831, 837 (6th Cir, 1983).

\(^{40}\) Eg *Abdul-Jabbar*, 85 F 3d 407 (9th Cir, 1996); *Cepeda v Swift & Co*, 415 F 2d 1205 (8th Cir, 1969); *Parks v LaFace Records*, 329 F 3d 437 (6th Cir, 2003) (‘Parks’); *Uhlaender v Henriksen*, 316 F Supp 1277 (D Minn, 1970) (‘Uhlaender’).

\(^{41}\) Eg *Doe*, 110 SW 3d 363 (Mo banc, 2003); *Hirsch*, 280 NW 2d 129, 137 (Wis, 1979).

\(^{42}\) Eg *Cher v Forum International Ltd*, 692 F 2d 634 (9th Cir, 1982); *Guglielmi v Spelling-Goldberg Productions*, 25 Cal 3d 860, 603 P 2d 454 (1979) (‘Guglielmi’).


\(^{44}\) Eg *Doe*, 110 SW 3d 363, 369 (Mo banc, 2003); *Nemani v St Louis University*, 33 SW 3d 184, 185 (Mo banc, 2000) (‘Nemani’).

\(^{45}\) Eg *Nemani*, ibid 185.

\(^{46}\) *Doe*, 110 SW 3d 363, 366 (Mo banc, 2003).

\(^{47}\) The plaintiff later recovered a US$15 million jury verdict in the case. *Doe v McFarlane*, 207 SW 3d 52 (Mo Ct App ED, 2006).

\(^{48}\) Eg *Newton v Thomason*, 22 F 3d 1455 (9th Cir, 1994); *DeClemente*, 860 F Supp 30 (ED NY, 1994); *Hooker v Columbia Pictures Industries Inc*, 551 F Supp 1060 (ND Ill, 1982).

\(^{49}\) McCarthy, above n 3, § 4:48.
The touchstone for identification appears to be that the ‘name’ must identify the plaintiff as the celebrity that the consuming public is familiar with. Thus the use of his real name ‘John William Carson’ which does not identify Johnny Carson the celebrity would not satisfy the identifiability requirement in a right of publicity claim.\(^50\) However, when Lew Alcindor converted to Islam and adopted the Muslim name Kareem Abdul-Jabbar, the Ninth Circuit held that the unauthorised use of the plaintiff’s little-known birth name ‘Lew Alcindor’ together with other factual information of his basketball victories in an advertisement nevertheless may sufficiently enable the audience to identify Kareem Abdul-Jabbar the celebrity.\(^51\)

Generally, the use of name in a publicity claim is not a controversial area.\(^52\) The question reduces to whether purchasers of the defendant’s product would identify the plaintiff celebrity from the defendant’s use of name. The issue usually arises as to whether an unauthorised use of name was for a purely commercial purpose or whether there was some expressive elements protected by the First Amendment, such as the use of civil rights activist Rosa Parks’ name as the title of a song.\(^53\)

B Likeness

Like the use of ‘name’, the plaintiff must be capable of being clearly identified by the audience from a visual image. ‘Likeness’ is a generic label used, particularly in a common law publicity claim, to encompass two- and three-dimensional visual representations that portray the plaintiff’s persona through his or her physical appearance.\(^54\) Examples of ‘likeness’ include picture, portrait, image and photograph in a

50 Carson, 698 F 2d 831, 837 (6th Cir, 1983).
51 Abdul-Jabbar, 85 F 3d 407, 416 (9th Cir, 1996).
52 This position tends to be valid for common law claims. A narrower construction of ‘name’ appears to be adopted for some statutory claims, particularly under NYCRL § 50. See, eg, Hampton v Giare, 600 NYS 2d 57 (1st Dept, 1993); Geisel v Poynter Products Inc, 295 F Supp 331 (SD NY, 1968); McCarthy, above n 3, § 4:57.
53 Parks, 329 F 3d 437 (6th Cir, 2003) (reversing grant of summary judgment in favour of band OutKast and allowing Rosa Parks to pursue a claim for use of her name in the title of a song). Contra the example of the song title Bette Davis Eyes given in the majority opinion of another case where it was thought to be permissible artistic expression: Rogers v Grimaldi, 875 F 2d 994, 999-1000 (2nd Cir, 1989).
54 See also Jeffrey Malkan, ‘Stolen Photographs: Personality, Publicity, and Privacy’ (1997) 75 Texas Law Review 779, 788 (“the features of his or her face express … a unique meaning. This meaning is the plaintiff’s personality.’).
variety of media like painting, drawing and sculpture, where the facial characteristics of the plaintiff are recognisable.\textsuperscript{55}

In a statutory claim, the relevant statute will enumerate the actionable attributes, and ‘likeness’ is usually, but not always, listed with ‘photograph’, ‘image’ or ‘portrait’, as a visual aspect of identity. Where the statute does not comprehensively list the different types of visual representations, the courts have held that ‘likeness’ could be interpreted to include any recognisable image of a person, as long as the person is ‘readily identifiable … with the naked eye’.\textsuperscript{56} In \textit{Newcombe v Adolf Coors Co}, the drawing of a baseball player depicting him in a distinctive windup stance was held to be readily identifiable as the plaintiff by the public.\textsuperscript{57} In \textit{Ali v Playgirl}, it was held that a drawing of a nude black man in a boxing ring accompanied by the words ‘The Greatest’ was a ‘portrait or picture’ of Muhammad Ali.\textsuperscript{58} In \textit{Allen v National Video}\textsuperscript{59} and \textit{Onassis v Christian Dior-New York},\textsuperscript{60} both Woody Allen and Jacqueline Kennedy Onassis succeeded in obtaining injunctions against the use of pictures featuring their lookalikes in advertisements. Even where the likeness has been altered, for example in a video game or comic book character\textsuperscript{61} or in a digitally manipulated photograph,\textsuperscript{62} this may be sufficient to identify the celebrity in question.\textsuperscript{63}

In summary, when more than a de minimis number of people in fact identify the plaintiff from the use of a likeness, it is difficult for a court to hold that identifiability has not been proven for the purposes of establishing a prima facie case.

\textsuperscript{55} Eg \textit{Ali}, 447 F Supp 723 (SD NY, 1978) (drawing that identified Muhammad Ali); \textit{Grant v Esquire Inc}, 367 F Supp 876 (SD NY, 1973) (‘Grant’) (photograph of Cary Grant); \textit{Martin Luther King Jr Center for Social Change Inc v American Heritage Products Inc}, 296 SE 2d 697 (Ga, 1982) (three-dimensional bust of Martin Luther King Jr).


\textsuperscript{57} \textit{Newcombe}, ibid 692.

\textsuperscript{58} \textit{Ali}, 447 F Supp 723, 726 (SD NY, 1978).

\textsuperscript{59} \textit{Allen v National Video Inc}, 610 F Supp 612 (DC NY, 1985) (‘Allen’).

\textsuperscript{60} \textit{Onassis}, 472 NYS 2d 254 (1984).


\textsuperscript{62} Eg \textit{Hoffman}, 255 F 3d 1180 (9th Cir, 2001); \textit{Grant}, 367 F Supp 876 (SD NY, 1973).

\textsuperscript{63} However, the celebrity may still fail in his or her right of publicity claim on First Amendment grounds because a particular use has significant transformative elements. Eg \textit{Kirby}, 144 Cal App 4th 47 (2006); \textit{Winter}, 30 Cal 4th 881 (2003); \textit{Hoffman}, ibid. Contra \textit{Doe}, 110 SW 3d 363, 369 (Mo banc, 2003).
C Evocative Aspects of Identity

The word ‘evoke’ means ‘to call forth’, ‘to conjure up’ or ‘to bring to mind or recollection’. Presently, all the other indicia of identity outside of ‘name’ and ‘likeness’ which are recognised by the courts fall into three broad categories, united by their ability to – either singularly or in various combinations – ‘evoke’ the celebrity in the minds of the audience in a manner that readily identifies the plaintiff. These three categories are: (i) a distinctive voice that evokes the celebrity (as represented by the typical soundalike imitation cases); (ii) a role or character that is evocative of the plaintiff (as represented by the typical use of a film or television character popularised by the plaintiff); (c) other indicia that evoke the celebrity (as seen in the more difficult cases where the defendant may have used a combination of objects, dress, makeup, performing style, music, set design etc).

The Circuit decisions for the state of California have expanded the meaning of identity in a common law publicity claim beyond ‘name and likeness’ to include virtually any attribute associated with a celebrity individual. Even where the use of a robot that was identified with Vanna White probably did not constitute a likeness of the celebrity, the Ninth Circuit held that it may nonetheless be an appropriation of her identity under a common law claim and remanded the case for trial. In particular, the court commented that:

Advertisers use celebrities to promote their products. The more popular the celebrity, the greater the number of people who recognize her, and the greater the visibility for the product. The identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice.

But the definitions of identity in common law and statutory actions usually do not indicate ‘to whom or to what degree the plaintiff must be identifiable from the alleged

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65 Eg White I, 971 F 2d 1395 (9th Cir, 1992); Waits, 978 F 2d 1093 (9th Cir, 1992); Midler, 849 F 2d 460 (9th Cir, 1988); Motchenbacher, 498 F 2d 821 (9th Cir, 1974).
66 White I, ibid 1399.
67 Ibid (emphasis added).
As a general rule, the courts, especially the Ninth Circuit, tend to consider the defendant’s use in its entirety when deciding the issue of identifiability.\(^\text{69}\) Although the NYCRL § 50 allows only recovery for unauthorised uses of ‘name, portrait or picture’, dicta from the New York Supreme Court indicated that:

There are many aspects of identity. A person may be known not only by objective indicia – name, face, and social security number, but by other characteristics as well – voice, movement, style, coiffure, typical phrases, as well as by his or her history and accomplishments.\(^\text{70}\)

Similarly, the Third Circuit, in interpreting New Jersey law, extends a generous reading of identity to any ‘defining trait that becomes associated with a person when he [or she] gains notoriety or fame.’\(^\text{71}\)

In summary, some courts are prepared to find that the identity requirement is satisfied as long as a clear reference to a celebrity has been evoked by an advertisement – that is, where the celebrity in question is ‘readily identifiable’ by the audience – from which there was a commercial advantage to be gained by the defendant.\(^\text{72}\) Thus the identity requirement so broadly construed can include a distinctive and widely recognised voice, an iconic character, and a distinctive costume, makeup or setting – any characteristic that is clearly evocative of a particular celebrity in the minds of the audience.

1 **Voice**

A voice can conjure up visions of a celebrity in the audience’s mind as effectively as a name or a likeness. According to the Ninth Circuit, ‘[a] voice is as distinctive and

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\(^{69}\) ‘Viewed separately, the individual aspects of the advertisement in the present case say little. Viewed together, they leave little doubt about the celebrity the ad is meant to depict.’ White I, 971 F 2d 1395, 1399 (9th Cir, 1992). See also above nn 6-10; Restatement (Third) of Unfair Competition § 46 cmt d (1995).


\(^{71}\) McFarland v Miller, 14 F 3d 912, 923 (3rd Cir, 1994) (‘McFarland’).

\(^{72}\) Eg Midler, 849 F 2d 460 (9th Cir, 1988); Waits, 978 F 2d 1093 (9th Cir, 1992); White I, 971 F 2d 1395 (9th Cir, 1992).
personal as a face. The human voice is one of the most palpable ways identity is manifested." It appears that a distinctive voice possesses characteristics like a ‘readily identifiable accent, range, quality, or pitch which would distinguish it to the ordinary listener from many others or identify it with any particular person.’ But the plaintiff’s voice must be considered apart from any particular song which he or she has recorded.

_Midler v Ford Motor Company_ represents a typical imitation case where the defendant uses a soundalike of a celebrity singer in an advertisement, usually as a result of the particular celebrity refusing to appear in the advertisement or endorse the product. Such cases present a strong argument for the enforcement of the right of publicity as the defendant is usually shown to have obtained a commercial advantage through capturing the associative value of a celebrity’s identity without the payment of an appropriate fee to the celebrity. The _Midler_ decision, affirmed in the subsequent soundalike case of _Waits v Frito-Lay Inc_, does not stand for the proposition that every imitation of the voice of a celebrity singer to advertise a product is actionable. The law requires the celebrity to have a ‘distinctive’ voice that is ‘widely known’ as an identifying characteristic.

2 **Role or Characterisation**

Celebrity actors can have a public persona that is so embodied in a distinctive role or character that this fictitious persona may become inseparable from the celebrity individual. A character is a composite of a ‘name, physical appearance, attributes,
mannerisms, speech and expression, habits, attire, setting, and locale. The courts have 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.’ The cases have generally established that ‘although exploitation of a fictional character may, in some circumstances, be a means of evoking the actor’s identity … the focus of any right of publicity analysis must always be on the actor’s own persona not the character’s.’ Recently, the courts have established a high threshold in what is commonly called the ‘inextricably identified’ test for satisfying the identifiability requirement with respect to evocation of the plaintiff by a fictional character: the plaintiff must prove that ‘the character [is] so associated with him as to be indistinguishable from him in public perception.’

In 1992, the Ninth Circuit’s decision in White left unanswered the question of whether a distinction ought to be made between the celebrity individual and the fictional character the celebrity has played in movies or television. Although Vanna White was not performing the role of a fictional character on the Wheel of Fortune, the majority’s holding in White has opened the door for actors to assert a right of publicity claim for an unauthorised commercial use of a role or character that they have played. The subsequent Ninth Circuit’s opinion in Wendt avoided tackling the issue of identifiability by characterisation. In considering whether the animatronic robots in airport restaurants and bars of the characters Cliff and Norm from the Cheers television series evoked the identity of the actors John Ratzenberger and George Wendt, the court instead defined the issue as one of ‘physical likeness’ and remanded the case for trial by jury.

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79 Cook, above n 1, 349 (quoting Dean Niro, ‘Protecting Characters through Copyright Law: Paving a New Road Upon Which Literary, Graphic and Motion Picture Characters Can All Travel’ (1992) 41 DePaul Law Review 359, 360).
80 Eg Wendt I, 125 F 3d 806, 811 (9th Cir, 1997); Lugosi, 160 Cal Rptr 323, 330 (1979).
81 Landham, 227 F 3d 619, 625 (6th Cir, 2000).
82 This test was first enunciated by the Third Circuit in McFarland, 14 F 3d 912, 920-1 (3rd Cir, 1994). See also McCarthy, above n 3, § 4:71. Although it has been cited with approval by the Sixth Circuit and some state courts, it has not been considered by the Ninth Circuit. See, eg, Landham, ibid 625; Pesina, 948 F Supp 40, 42 (ND Ill, 1996).
83 McFarland, ibid 914.
84 For an illustration of how the ‘sweeping standard’ in White can prevent copyright holders from presenting derivative works, see Wendt II, 197 F 3d 1284, 1286-7 (Kozinski J dissenting) (9th Cir, 1999).
85 White I, 971 F 2d 1395, 1405 (Alarcon J dissenting) (9th Cir, 1992); White II, 989 F 2d 1512, 1515-8 (Kozinski J dissenting) (9th Cir, 1993). See discussion in section below on ‘Other Indicia’.
86 Wendt I, 125 F 3d 806, 812 (9th Cir, 1997). For a criticism of the decision, see Yu, above n 2. The case was eventually settled out of court.
In 1994, the Third Circuit had to consider how far they were prepared to extend the White holding in a right of publicity action brought by George McFarland, who played the character Spanky in the movie and television versions of Our Gang and Little Rascals throughout his movie career; McFarland appeared as Spanky in a total of ninety-five films over six years.\(^{87}\) The court recognised that the actor playing the character may be the most direct link to the character in the public’s mind, even though others may be involved in the creation and presentation of the character to the public. The Third Circuit considered the concurring opinion of Mosk J in Lugosi v Universal Pictures\(^{88}\) which recognised that Bela Lugosi the actor was distinguishable from the Count Dracula character he played,\(^{89}\) but held that whether an actor was ‘inextricably identified’ with a character should not hinge on whether the actor had created the character.\(^{90}\) Applying New Jersey law, it reversed the lower court’s summary judgment for the defendant and remanded for the plaintiff to prove at trial that the name Spanky McFarland as used by the defendant for the restaurant, identified the plaintiff and ‘not just the little urchin Spanky he portrayed in the movie and television series.’\(^{91}\)

In 2000, the Sixth Circuit agreed with the narrower interpretation of identifiability of a plaintiff from a fictional character that he or she has performed, citing McFarland with approval: the celebrity plaintiff must prove that (i) the character’s identity and the actor’s identity are ‘inseparable in the public’s mind’;\(^{92}\) and (ii) the unauthorised use ‘invokes his [or her] own persona, as distinct from that of the fictional character’.\(^{93}\)

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\(^{87}\) McFarland, 14 F 3d 912, 915 (3rd Cir, 1994). McFarland commenced an action against the defendant for using ‘Spanky McFarland’ as the name of his restaurant. The restaurant has over 1,000 photos of movie characters, including some of the Little Rascals. It also displays two murals of Our Gang which include McFarland, and the menu makes numerous references to the characters. Ibid 916.

\(^{88}\) The majority joint opinion did not discuss identifiability as they held that because the right of publicity descended from the law of privacy, it was therefore a ‘personal’ right and could not be assigned to Lugosi’s heirs. Lugosi, 160 Cal Rptr 323, 329 (1979).

\(^{89}\) Lugosi, ibid 330-1. The judicial disagreement in Lugosi does not seem to be one as to the legal principle, but rather as to how the rule applied to the facts in that case. Both the majority and the dissent appear to endorse the rule that an actor might play a role in such a unique and distinctive manner that the particular characterisation is indelibly linked with that actor. See McCarthy, above n 3, § 4:72.

\(^{90}\) McFarland, 14 F 3d 912, 920 (3rd Cir, 1994). For a criticism that this test is too narrow, see Langvardt, above n 28, 392.

\(^{91}\) McFarland, ibid 914.

\(^{92}\) Landham, 227 F 3d 619, 625 (6th Cir, 2000).

\(^{93}\) Ibid 626.
Hence, the rule appears relatively straightforward. It becomes a triable issue of fact as to public identification: does the defendant’s use primarily identify the role or characterisation, or does it identify the actor? If it identifies the actor, then the actor’s identity has been used, and the threshold requirement of identifiability has been satisfied. In the ‘easy’ cases, the actor has not only created the character, but has performed it to the extent that he or she is inextricably identified with character. Examples include those of Charlie Chaplin, the Marx Brothers, Laurel and Hardy and Woody Allen. However, in the ‘hard’ cases, where the actor is usually either not the creator of his or her role or not the actor who has played that role exclusively, the courts seem reluctant to hold that the plaintiff was identifiable as a person separate from the character. Moreover, from Mosk J’s explanation in Lugosi, it would seem that a famous historical or literary character ‘that had been garnished with the patina of age’ is less likely to be exclusively associated or inextricably identified with a particular actor:

[N]either Lugosi during his lifetime not his estate thereafter owned the exclusive right to exploit Count Dracula any more than Gregory Peck or his heirs could possess common law exclusivity to General MacArthur, George C. Scott to General Patton, James Whitmore to Will Rogers and Harry Truman, or Charlton Heston to Moses.

In particular, Mosk J explained that Lugosi had been hired to learn his lines and play a role, which no matter how memorable his performance, ‘gave him no more claim on Dracula than that of countless actors on Hamlet who have portrayed the Dane in a unique

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94 These cases pre-date the ‘inextricably identified’ test laid down by the Third Circuit in McFarland, but their analyses of the close association between the actor and the character in the minds of the public contain similar elements.

95 Chaplin v Amador, 93 Cal App 538 (1928).


97 Price, 400 F Supp 836 (SD NY, 1975).


99 Eg Lugosi, 160 Cal Rptr 323 (1979) (Count Dracula character is not exclusively identified with Bela Lugosi); West v Lind, 186 Cal App 2d 563 (1960) (the Diamond Lil character is not exclusively associated with Mae West); Nurmi v Peterson, 10 USPQ2d (BNA) 1775 (CD Cal, 1989) (denying Maila Nurmi, the creator-performer of a 1950s television character Vampira, a right of publicity claim against Cassandra Peterson, who created and performed a similar 1980s character Elvira).

100 Lugosi, ibid 325.

101 Ibid 330. The majority opinion also noted that other actors like Christopher Lee, Lon Chaney and John Carradine have played the role of Dracula in the movies. Ibid 325.
manner.\textsuperscript{102} The Third Circuit also gave some examples of how being known for playing a particular role was different from being indistinguishable from the role. The court explained that Adam West’s association with the role of Batman or Johnny Weissmuller with Tarzan was different from McFarland’s identification with Spanky. While ‘a triable issue of fact as to whether McFarland had become so inextricably identified with Spanky\textsuperscript{103} that his own identity would be invoked by the name Spanky, it was thought that ‘West’s identity did not merge into Batman and Weissmuller did not become indistinguishable from Tarzan.’\textsuperscript{104}

In conclusion, courts other than the Ninth Circuit have adopted a narrower view of the evocative standard in \textit{White}. To obtain a publicity right in a role or character,\textsuperscript{105} the plaintiff needs to be either (i) the substantial creative force behind the character; or (ii) satisfies the ‘inextricably identified’ requirement that the film or television character has become ‘so synonymous\textsuperscript{106} or ‘so associated [with the actor] that it becomes inseparable from the actor’s own public image’.\textsuperscript{107} The discussion here has focused on the unauthorised use of characterisations in traditional commercial contexts like advertisement, promotion and merchandising. However, it should be noted that artistic and entertainment uses of a character inextricably identified with an actor – for example, a parody of Charlie Chaplin or Spanky McFarland – are usually permitted by the First Amendment.

3 \textbf{Other Indicia}

In the most controversial category of identifiability, the courts have held that a combination of elements outside of the traditional categories of name and likeness may be considered by the jury when determining whether the plaintiff is in fact identified from the defendant’s use. The Ninth Circuit’s decision in \textit{White} has ‘probably gone the farthest

\begin{itemize}
\item \textsuperscript{102} Ibid 330.
\item \textsuperscript{103} \textit{McFarland}, 14 F 3d 912, 921 (3\textsuperscript{rd} Cir, 1994).
\item \textsuperscript{104} Ibid 921 fn 15.
\item \textsuperscript{105} Like voice appropriation, federal copyright preemption issues also arise in character appropriation cases. However, the courts have generally found that the right of publicity in a fictitious character is not preempted by the \textit{Copyright Act}. See, eg, \textit{Landham}, 227 F 3d 619, 623 (6\textsuperscript{th} Cir, 2000); \textit{Wendt}, 125 F 3d 806, 810 (9\textsuperscript{th} Cir, 1997).
\item \textsuperscript{106} \textit{Landham}, ibid 625.
\item \textsuperscript{107} \textit{McFarland}, 14 F 3d 912, 920 (3\textsuperscript{rd} Cir, 1994).
\end{itemize}
in any case in any court in the United States of America”\(^\text{108}\) in protecting publicity rights. The expansive approach in White may have a considerable influence in other state jurisdictions because of the deference that Ninth Circuit decisions are usually given in cases concerning publicity rights;\(^\text{109}\) it is also binding precedent on California courts. Refusing to ‘permit the evisceration of the common law right of publicity’,\(^\text{110}\) the Ninth Circuit majority held that the identifiability of the plaintiff in a common law right of publicity action extended beyond name and likeness to anything that evoked the plaintiff’s personality.\(^\text{111}\) Thus like a name, likeness, voice or fictitious character, different combinations of objects, symbols, gestures, words, music and other indicia can also trigger the public’s recognition of the plaintiff.

Beginning with Motschenbacher v RJ Reynolds Tobacco Co in 1974, the Ninth Circuit held that a triable issue of fact existed in California law as to whether a racing car driver was identifiable by a distinctive racing car used in an advertisement which he claimed was closely associated with him.\(^\text{112}\) In 1977, the Appellate Division of the New York Supreme Court referred to Motschenbacher with approval when deciding that the ‘combination of New Year’s Eve, balloons, party hats, and “Auld Lang Syne”’\(^\text{113}\) in a television commercial raised an issue of identifiability in a right of publicity claim which should proceed to trial. In that case, Guy Lombardo had invested forty years in developing his widely recognised public personality as ‘Mr New Year’s Eve’, performing with his band on New Year’s Eve.

Decided in 1983, Carson v Here’s Johnny Portable Toilets Inc continues the trend of cases which recognise that different indicia of identity can evoke a particular celebrity

\(^{108}\) Clay, above n 30, 486.

\(^{109}\) Langvardt, above n 28, 330-1.

\(^{110}\) White I, 971 F 2d 1395, 1399 (9th Cir, 1992).

\(^{111}\) Ibid 1398-9. The majority referred to Motschenbacher, Midler and Carson with approval.

\(^{112}\) Motschenbacher, 498 F 2d 821 (9th Cir, 1974). In its television advertisement, the defendant used a photograph that showed the plaintiff’s racing car – with its ‘distinctive decorations’ – in the foreground; however, the plaintiff’s facial features were obscured, and the number on the racing car was changed from ‘11’ to ‘71’.

in the minds of the audience. Concerned with the defendant free-riding on the economic associative value of Johnny Carson’s identity, the Sixth Circuit held:

The right of publicity … is that a celebrity has a protected pecuniary interest in the commercial exploitation of his identity. If the celebrity’s identity is commercially exploited, there has been an invasion of his right whether or not his ‘name or likeness’ is used.115

Focusing on the fact that ‘the public tends to associate … the words “Here’s Johnny” with the plaintiff’,116 the court found that ‘Carson’s identity as a celebrity’117 has been appropriated. The majority judgment emphasised that there would have been no violation of Carson’s right of publicity if his real name John William Carson was used; the crux of the issue was whether the commercial use identified the celebrity in the minds of the audience so as to capture the pecuniary value of the celebrity identity.118

In 1992, the Ninth Circuit handed down its watershed decision of White v Samsung. Samsung had run a print advertising campaign promoting its consumer electronics that capitalised on the audience’s familiarity with particular personalities and trends in popular culture in order to depict outrageous outcomes for Samsung products in the future. Unlike the other celebrities used in the campaign, White neither consented to the advertisements nor was she paid. In one of the advertisements for video-cassette recorders (VCRs), a robot was dressed in a wig, gown and jewellery reminiscent of Vanna White’s hair and dress. The robot was posed next to a game board which was instantly recognisable as the Wheel of Fortune game show set, in a stance for which White was famous. The caption read ‘Longest-running game show. 2012 A.D.’. Vanna White, the letter-turner of Wheel of Fortune, claimed, inter alia, that Samsung has infringed both her common law and statutory right of publicity.

114 Carson, 698 F 2d 831 (6th Cir, 1983). Johnny Carson had licensed his catch phrase ‘Here’s Johnny’ to a chain of restaurants and was president of and part owner of an apparel company that sold clothing featuring the plaintiff’s name and likeness under the label ‘Here’s Johnny’.
115 Ibid 835. The majority relied on Hirsch (use of celebrity’s nickname), Ali (use of likeness) and Motschenbacher (evocative use) to support the extension of indicia of identity.
116 Ibid 836.
117 Ibid 837.
118 Ibid 837-8.
119 White I, 971 F 2d 1395 (9th Cir, 1992).
Under the *CCC § 3344(a)*, White has the exclusive right to use her ‘name, voice, signature, photograph or likeness’ for commercial purposes. But Samsung did not use any of the enumerated indicia and the Ninth Circuit correctly dismissed her statutory claim. However, the majority, relying on *Motschenbacher, Midler* and *Carson*, held that so long as the robot in the Samsung advertisement reminded the audience of Vanna White, regardless whether they believed that White was endorsing the advertised product, a jury could decide whether Samsung had infringed her right of publicity; hence the case was remanded for trial. In cases like *White, Carson* and *Lombardo*, the celebrity plaintiffs were indeed well-known personalities who enjoyed a heightened media presence. The *Wheel of Fortune* game show, one of the most popular game shows in US television history, has a daily audience viewership of about forty million, making Vanna White a widely recognised household celebrity.

Exhibiting a reluctance to circumscribe the boundaries of the expanding indicia of identity, the majority asserted, without explanation, that

[a] rule which says that the right of publicity can be infringed only through the use of nine different methods of appropriating identity merely challenges the clever advertising strategist to come up with the tenth.

In the evocative-of-identity test enunciated by the *White* majority, if an advertiser uses visual or auditory cues that evoke a celebrity’s persona in the minds of the audience, then the advertiser would have infringed the celebrity’s right of publicity. According to the majority, it is ‘not important how the defendant has appropriated the plaintiff’s identity, but whether the defendant had done so.’

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120 White I, ibid 1396-7.
122 Ibid 1396.
123 Ibid 1398. This view was endorsed in *Landham*, 227 F 3d 619, 624-5 (6th Cir, 2000); *Abdul-Jabbar*, 85 F 3d 407, 413-5 (9th Cir, 1996).
124 Ibid.
D  Interim Conclusions

The courts have approached the issue of identification over the last three decades with an increasing appreciation of the associative value that the celebrity personality commands in contemporary society. The evocative-of-identity rule as stated by the White majority resonates with the core principle articulated in the Restatement (Third) of Unfair Competition: ‘[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’.\textsuperscript{125} It is generally accepted that a ‘highly valuable identity is attained when the name, image, or likeness of an individual is readily identifiable’\textsuperscript{126} and the right of publicity protects the individual celebrity’s exclusive use of ‘the commercial identifications of him or herself.’\textsuperscript{127}

If the audience has not identified the plaintiff from the defendant’s use – i.e. the plaintiff has not been called forth in or brought to the minds of the audience – then there can be no taking of anything of value from the plaintiff. As demonstrated in this Part, whether it is the use of a name as a symbol of identity,\textsuperscript{128} a likeness that readily identified the plaintiff,\textsuperscript{129} a distinctive voice that is widely known,\textsuperscript{130} a character that is inextricably identified with the plaintiff,\textsuperscript{131} or a combination of different elements that included words, objects and symbols\textsuperscript{132} – they all evoke the plaintiff in the minds of the audience. Sometimes a well-known phrase like ‘Here’s Johnny’ can evoke a more vivid identification of the celebrity than a visual likeness. The Illinois Right of Publicity Act already recognises that identity is ‘any attribute that serves to identify that individual to an ordinary, reasonable viewer or listener’,\textsuperscript{133} and the Pennsylvania statute is similarly

\textsuperscript{125} Restatement of the Law (Third) of Unfair Competition § 46 (1995) (emphasis added). See also Stacey L Dogan, ‘An Exclusive Right to Evoke’ (2003) 44 Boston College Law Review 291, 303 (‘The right of publicity is, at core, a business right to control use of one’s identity in commerce’).


\textsuperscript{127} Ibid 479.

\textsuperscript{128} Eg Parks, 329 F 3d 437 (6th Cir, 2003); Abdul-Jabbar, 85 F 3d 407 (9th Cir, 1996); Doe, 110 SW 3d 363 (Mo banc, 2003).

\textsuperscript{129} Eg Newcombe, 157 F 3d 686 (9th Cir, 1998); Ali, 447 F Supp 723 (SD NY, 1978).

\textsuperscript{130} Eg Midler, 849 F 2d 460 (9th Cir, 1988); Waits, 978 F 2d 1093 (9th Cir, 1992).

\textsuperscript{131} Eg McFarland, 14 F 3d 912 (3rd Cir, 1994); Landham, 227 F 3d 619 (6th Cir, 2000).

\textsuperscript{132} Eg White I, 971 F 2d 1395 (9th Cir, 1992); Carson, 698 F 2d 831 (6th Cir, 1983); Motschenbacher, 498 F 2d 821 (9th Cir, 1974); Lombardo, 396 NYS 2d 661 (1977).

\textsuperscript{133} IRPA, 765 Illinois Compiled Statutes 1075/5; Toney, 406 F 3d 905, 908 (7th Cir, 2005).
In Texas, courts have held that the right of publicity ‘may be violated when a defendant employs an aspect of that person’s persona in a manner that symbolizes or identifies the person.’ Thus, this thesis suggests that there is no real need to enumerate specific actionable indicia of identity and the objective of the right of publicity – which is to prevent the unauthorised commercial appropriation of a valuable persona – is better served by the adoption of an all-encompassing evocative identification standard. However, evocation is a necessary, but not sufficient, prerequisite to a right of publicity claim. What the numerous critics of the White approach appear to have overlooked is the fact that evocation does not equal liability; there are yet other hurdles in a publicity claim which the plaintiff has to overcome.

Drawing from relevant writings in cultural studies, the next Part will consider how cultural studies can support the adoption of an overarching evocative identification test.

III EVOCATIVE USE AND IDENTIFICATION

It is a common view in cultural studies that the celebrity personality is ‘imbued with euphoric values’, and the aim of advertisements featuring celebrities is to produce an audience desire to resemble physically the idealised image or to identify with the celebrity personality through the consumption of products associated with the celebrity.

As outlined in Chapter 2, writings in cultural studies suggest that a contemporary celebrity is any individual who is widely recognised by the public, and therefore the distinctive characteristics of a particular celebrity has the capacity to trigger instant

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134 Pennsylvania Statute Annotated, title 42, § 8316(e) (‘Any attribute of a natural person that serves to identify that natural person to an ordinary, reasonable viewer or listener’); Facenda v NFL Films Inc, 488 F Supp 2d 491, 501 (ED Pa, 2007).
135 Henley, 46 F Supp 2d 587, 591 (ND Tex, 1999); Elvis Presley Enterprises Inc v Capece, 950 F Supp 783, 801 (SD Tex, 1996). The Texas courts have cited cases like White, Carson, Motschenbacher, Ali and Hirsch with approval in extending protection to all aspects of persona that can identify the plaintiff.
136 Eg Weiler, above n 19, 269 (‘Yet judicial inquiry should not end, nor should liability unfailingly ensue, solely upon a determination that viewers of an advertisement can identify a celebrity from certain clues’).
137 These elements will be discussed in Chapters 4 and 5.
recognition amongst the public. Section A will demonstrate – through an evaluation of key writings on the definition of the contemporary celebrity – how the mass circulation of the celebrity contributes to widespread public recognition. This is pertinent to the issue of identifiability in a right of publicity claim since it is a question of fact that is put to the jury who represents the ordinary viewer or listener. Section B argues that these findings help strengthen the case for the judicial adoption of an evocation identification standard that extends actionable indicia of identity beyond name and likeness to all aspects of persona that evoke the celebrity in the minds of the audience.

A The ‘Well-knownness’ of a Celebrity: A Cultural Studies Perspective

As outlined in Chapter 2, Daniel Boorstin’s definition of a celebrity as ‘a person who is known for his well-knownness’ has been adopted as a starting point for a broad definition of a contemporary celebrity based on a ubiquitous media presence and public recognition by influential cultural studies scholars like David Marshall, Chris Rojek, Graeme Turner and Garry Whannel. As Marshall observes:

In the public sphere, a cluster of individuals are given greater presence and a wider scope of activity and agency than are those who make up the rest of the population … We tend to call these overtly public individuals celebrities.

Similarly, Turner et al suggest that:

celebrities are people that the public is interested in; if the public is interested in this person, they are a celebrity; therefore, anyone the public is interested in is a celebrity.

144 Marshall, above n 140, ix.
What is relevant to the issue of identifiability in a right of publicity claim is whether the plaintiff is well-known to a significant section of the public, or as McCarthy puts it, ‘a more than de minimis number of ordinary viewers of the defendant’s use identify the plaintiff’. This thesis makes the argument that because a celebrity is characterised by his or her well-knownness in society, his or her commercial value may be easily captured without an obvious reference to name or likeness as the celebrity can be evoked by many other means familiar to the consuming public. This argument is supported by both the increasing circulation of the performances of the celebrity in his or her chosen field and the incessant popular media coverage of the celebrity’s activities outside this field that showcase particular aspects of the celebrity individual that the audience later can easily ‘bring to mind or recollection’.

The courts appear to implicitly recognise this when putting the ‘well-knownness’ of the plaintiff to the test before the jury on the identifiability issue. If one is not well-known, then the law often finds no protectable value in one’s identity. Although prevailing dicta from the courts indicate that all individuals in theory have a right of publicity, a number of recent cases have required that the plaintiff’s ‘name, likeness, or persona had such value prior to the plaintiff’s association with [the defendant’s product]’. In Pesina v Midway Manufacturing Co, a martial arts expert who had no

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146 See McCarthy, above n 3, § 3:17 and accompanying text. There must be ‘some “de minimis” rule to filter or screen out the frivolous cases where only the plaintiff and a few sympathetic relatives and friends can see any connection between defendant’s use and plaintiff.’ McCarthy, above n 3, § 3:20.

147 This was noted in passing reference by the White majority. White I, 971 F 2d 1395, 1399 (9th Cir, 1992).

148 This is sometimes referred to as ‘intertextual knowledge’ for film stars or ‘on-field performances’ for sport celebrities. See, eg, Christine Geraghty, ‘Re-examining Stardom: Questions of Texts, Bodies and Performance’ in Sean Redmond and Su Holmes (eds), Stardom and Celebrity: A Reader (2007) 98, 106-7; Whannel, above n 143, 30-9.

149 Terms like ‘extratextual’ or ‘narrativisations’ have been used to refer to the type of coverage given to film stars and celebrity athletes in popular media like the tabloids, fanzines and infotainment programs. See, eg, Geraghty, ibid; Whannel, ibid 52-63. In fact, it has been claimed that ‘mass media use is now the third-ranked activity after work and sleep’ in the United States. Jib Fowles, Starstruck: Celebrity Performers and the American Public (1992) 263.

150 Eg Carson, 978 F 2d 1093, 1102 (9th Cir, 1992); Motschenbacher, 498 F 2d 821, 824 (9th Cir, 1974); Dora v Frontline Video Inc, 18 Cal Rptr 2d 790, 792 (Cal Ct App, 1993); Onassis, 472 NYS 2d 254, 260 (1984); Restatement of the Law (Third) of Unfair Competition § 46 comment d (1995).

151 Pesina, 948 F Supp 40, 42 (ND Ill, 1996). In particular, the Supreme Courts of Georgia, Utah, Alabama and Oregon have rejected claims brought by non-celebrities. Other jurisdictions like District of Columbia, Kentucky, Maryland, Minnesota, Missouri, Ohio and Texas have also used strong language disfavouring such claims. In addition, courts in California, Illinois and New York have at times required the plaintiff to show that his or her well-knownness has endowed his or her identity with commercially exploitable opportunities. See, eg, Martin Luther King Jr Center for Social Change
‘celebrity status or public recognition’ failed to prove that the use of a ‘Mortal Kombat’
video game character that was modeled on his movement infringed his publicity or
trademark rights. Similarly, in DeClemente v Columbia Pictures Industries, the
plaintiff’s public personality as the ‘Karate Kid’ simply ‘has not reached the magnitude
of public notoriety necessary to be actionable under the statute as a matter of law.’

Widespread recognition appears to be the sine qua non of the contemporary
celebrity. In addition, the sustained interest of the public in any particular celebrity is
only possible if the cultural producers are able to continuously provide them with the
celebrity commodity. The critical role that the popular media, as a cultural producer,
has played in the circulation of the celebrity in society resulting in an individual’s
recognition by numerous audience segments has led some scholars to equate the celebrity
with a ‘spectacle’. In cultural studies, the celebrity personality may be seen as a
commodity spectacle that is created and sustained by a combination of forces in
advertising, marketing, public relations and journalism.

Thus the complex – and often complementary – interactions of the constituents of
the celebrity trinity combine to endow this persona with a set of specific personality traits
over time, and the individual of whom ‘the descriptions are predicated has spatio-
temporal continuity, and can thus be identified.’ An analysis of the literature in

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152 Pesina, 948 F Supp 40, 42 (ND Ill, 1996) (only 6% of 306 Mortal Kombat users identified Pesina as
the model for the video game character).
153 DeClemente, 860 F Supp 30, 53 (ED NY, 1994). According to the evidence, the plaintiff was and is
known as the Karate Kid only to a small group of people who learned and taught karate in Queens and
Brooklyn during the mid-1960s, and perhaps in Florida in the mid-1970s, and to any business
associates he developed a relationship with over the years.
154 The term ‘commodity’ is used here broadly to include information on the celebrity (eg gossip and
photographs), products relating to the celebrity (eg fan-related merchandise) and most importantly, the
celebrity as product (eg movies featuring a celebrity actor or sports events featuring the celebrity
athlete in competition).
155 See generally Guy Debord, The Society of the Spectacle (1967); Douglas Kellner, Media Spectacle
(2003).
156 Catherine McCall, Concepts of Person: An Analysis of Concepts of Person, Self and Human Being
metaphysics, philosophy and sociology about the concept of identity is beyond the scope of this thesis. However, Catherine McCall’s comprehensive study on the concept of identity, with its critique of the works of influential scholars in this area like P F Strawson,\textsuperscript{157} John Perry\textsuperscript{158} and Amelie Rorty,\textsuperscript{159} concludes that the understanding of any individual as a person is a ‘public understanding’ as a consequence of ‘properties attributed to the individual by others’.\textsuperscript{160} Therefore, an individual is identified not just by ‘physical attributes which can be recorded and measured’, but also by ‘properties or attributes which are thought of the entity.’\textsuperscript{161} In other words, what makes a contemporary celebrity so well-known is a result of a public identity that is reinforced through a social process of where the celebrity is ‘individuated, identified and reidentified’.\textsuperscript{162} These observations on identity being located in the social framework of language and cultural communication are also supported by numerous cultural studies scholars like Richard Dyer,\textsuperscript{163} Marshall\textsuperscript{164} and Turner\textsuperscript{165} in their research on the contemporary production of celebrities.

The circulation of a particular personality in contemporary society can happen through numerous channels like print, broadcast, film, internet, merchandising and even through daily social conversations. Through these channels, a celebrity personality is reproduced countless times with its recognition gaining an ever-increasing familiarity amongst members of the public through each interaction.\textsuperscript{166} These observations support the Ninth Circuit’s assumption in White that the most popular celebrities are the easiest to evoke. For example,

A film star’s image is not just his or her films, but the promotion of those films and the star through pin-ups, public appearances, studio hand-outs and so on, as

\textsuperscript{157} Eg P F Strawson, Individuals: An Essay in Descriptive Metaphysics (1959); Zak Van Straaten (ed), Philosophical Subjects: Essays Presented to P F Strawson (1980) 272.
\textsuperscript{159} Eg Amelie Oksenburg Rorty, ‘Persons, Policies and Bodies’ (1973) 13 International Philosophical Quarterly 63; Amelie Oksenburg Rorty (ed), The Identities of Persons (1976).
\textsuperscript{160} McCall, above n 156, 178.
\textsuperscript{161} Ibid 177 (emphasis added).
\textsuperscript{162} Ibid 187. This dynamic approach to identification allows for the audience to take into account changes in physical attributes over time so that a celebrity’s public identity can be constantly renewed.
\textsuperscript{163} Eg Richard Dyer, Stars (1979) 2-4, 6-8, 24-32.
\textsuperscript{164} Eg Marshall, above n 140, 61-71.
\textsuperscript{165} Eg Turner, Understanding Celebrity, above n 142, 4-20.
\textsuperscript{166} Eg Jean Baudrillard, Simulations (Paul Foss, Paul Patton and Philip Beitchman trans, 1983 ed) 11. See also Turner, Understanding Celebrity, above n 142, 34-41; Turner et al, above n 145, 13.
well as interviews, biographies and coverage in the press ... Further, a star’s image is also what people say or write about him or her, as critics or commentators, the way the image is used in other contexts such as advertisements, novels, pop songs, and finally the way the star can become part of the coinage of everyday speech.  

For the purposes of illustrating how certain distinctive characteristics of celebrities can gain widespread public recognition and thereby merit protection by publicity right laws, this section will briefly consider how celebrities may be circulated in the popular media.

‘Traditional’ Coverage. First, through the so-called ‘traditional’ portrayal of the celebrities in their chosen fields of endeavour, the public becomes familiar with the names and likenesses of these individuals. For film stars, the widespread release of movies will first thrust the actor into public consciousness and the continued circulation of his or her images and information in advertising and relating to his or her life outside of the movies in the popular media will maintain a public visibility. For television celebrities, their familiarity with the audience is enhanced by their constant appearances right in the intimate settings of the living rooms and kitchens of viewers all around the world. In sport, global television and web broadcasts of the Olympics and the FIFA World Cup, as well as major tournaments in golf, tennis, basketball, baseball and soccer, can also result in high-performing athletes becoming household names.

Advertising. Second, the growing use of celebrities in advertising is a highly managed process in maintaining their public visibility. It is important to note that

167 Madow, above n 22, 193.
170 For example, the 2004 Athens Olympic Games had over 300 channels broadcasting to 220 countries and territories resulting in a record of 3.9 billion people having access to the coverage. International Olympic Committee, Global TV viewing of Athens 2004 Olympic Games breaks records (2004) <http://en.beijing2008.cn/16/87/article211928716.shtml> at 3 March 2008. For an analysis of the media coverage of sports, see Whannel, above n 143, 30-9, 190-212.
advertising not only uses celebrities, it also helps make them.\textsuperscript{171} An advertising campaign, especially a global advertising campaign with a multi-million dollar budget like Nike and TAG Heuer, exposes a particular celebrity to large segments of the public,\textsuperscript{172} contributing to a greater awareness not just of the product, but also the featured celebrity. In a visual print or broadcast advertisement, it is often an individual’s ‘likeness’ that is used by the advertiser, and it is this likeness that is readily identified by the audience-consumer. At the same time, these advertisements also transmit a particular identity configuration of each celebrity to the audience, fixing particular images of each individual celebrity in the minds of the viewers.

Because different advertisers can use a particular celebrity to endorse a wide range of products, the cumulative effect of these advertisements can reinforce a mental image of the celebrity, to the extent that even the use of a distinctive hairstyle at a specific point in time (like David Beckham’s iconic ‘Mohican-Mohawk’ in 2001-2002) can evoke the celebrity in the absence of visible facial features.\textsuperscript{173} Complementing the circulation of a celebrity’s identity in advertisements, the constant coverage of a celebrity’s life by the tabloid media thrusts even more information and images into the public eye. For example, Beckham’s hairstyles are chronicled in the minutest detail in the tabloids, and even in mainstream newspapers, to the extent that a more than de minimis number of members of the public are likely to be familiar with his latest image.

\textit{Popular Infotainment Media.} Third, the popular infotainment media, which includes print, broadcast and internet, represents an effective channel of raising the public awareness of celebrities through a relentless coverage of information and images relating


\textsuperscript{173} Pringle, above n 171, 68-9. See also Milligan, above n 172, 81-4 (discussing Beckham’s defining hairstyles).
Generally, the efforts of the cultural producers – the studios, public relations managers and advertisers – in promoting the ubiquity of the celebrities have been significantly aided by the proliferation of tabloid magazines, infotainment programs and internet sites. While one may view the tabloid press and its attendant paparazzi to be infringing on the privacy of celebrities, the sustained coverage of any celebrity invariably keeps him or her in the public eye and maintains his or her ‘well-knownness’. Thus the relationship between the celebrity individual and the media, in particular the paparazzi, may be antagonistic, but at the same time, it is symbiotic. Although the scandalous exposures may sometimes threaten the professional survival of the celebrities, the ‘unparalleled personal visibility’ makes them ‘irresistible as the quickest route to the public.’ On the internet, celebrity pictorial sites proliferate. On television, complete channels are devoted to news coverage of celebrities and their lifestyles. Even the mass-market women’s magazines have increased their focus on celebrity culture. Celebrity gossip and news weeklies like Star, National Enquirer, Hello!, and OK!, which deal with almost nothing but celebrity, are globally syndicated and their content include a combination of paparazzi photographs, speculative stories and collaborative celebrity features. With the rising popularity of the internet in the last few years, the tabloid press has moved online, probably capturing an even larger audience base. The proliferation of tabloids at checkout counters of supermarkets, especially in

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174 Boorstin makes a trenchant comment that ‘celebrities are “the names” who, once made by news, now make news by themselves.’ Boorstin, above n 139, 61. See also Whannel, above n 143, 203.
175 An integrated media presence linking television broadcast with an online infotainment site is common as key players in the industry compete for the audience’s attention. Eg ET Online <http://www.etonline.com> at 30 June 2009; TMZ <http://www.tmz.com> at 1 July 2009.
179 Globally syndicated programs like Entertainment Tonight focus on celebrity information, while highly popular talk shows like The Oprah Winfrey Show (‘TOWS’) frequently features celebrity guests. TOWS boasts about 6.9 million weekly viewers in the US (ranked 4th), while Entertainment Tonight has 6.8 million (ranked joint 4th). TV By The Numbers (2009) <http://tvbythenumbers.com/category/ratings/syndicated/nielsen-weekly-top-syndicated-tv-show-ratings> at 11 February 2009.
181 This has also resulted in a decline in the sales of daily tabloids like The Sun in the UK. Reuters, UK’s Sun tabloid’s circulation falls below 3 mln (2008) <http://uk.reuters.com/article/idUKL1111362720080114> at 6 July 2009.
the US, has also contributed to the increased exposure of celebrities and a concomitant increase in the household recognition of the celebrities featured within its pages.\footnote{Eg Turner et al, above n 145, 137.}

What the above demonstrates is the infotainment coverage of a particular celebrity will reveal far more than a film, a telecast of a sporting event or an advertisement that features a well-groomed image or likeness of the celebrity. Because of the extensive circulation of the infotainment television programs and the tabloid press, their continuous focus on specific themes relating to each individual celebrity may result in the audience perceiving certain attributes, symbols or objects to be ‘closely associated’ with that celebrity.\footnote{Eg Motschenbacher, 498 F 2d 821, 827 (9th Cir, 1974). The court held that the preliminary evidence that several persons who said they had immediately recognised the plaintiff’s car from the advertisement was sufficient to enable Motschenbacher to prove the issue of identifiability at trial.} Like in the case of David Beckham, the features on his hairstyles and his tattoos can result in these distinctive symbols of his identity being ‘readily identifiable’ as David Beckham the celebrity footballer by members of the public.\footnote{According to Whannel, a ‘novel or striking appearance helps to bring a [sporting] star to public attention. As the fame of the star grows, appearance becomes more central as a signifier … [and] in the construction of star images.’ Whannel, above n 143, 194.} It is most likely that a significant number of people can point to a Mohican-Mohawk hairstyle in 2001-2002, which was extensively copied especially by the youth, and say that is a Beckham hairstyle. Hence, an advertiser who features the back of the head of a Caucasian model sporting a Mohican, with perhaps a diamond ear-stud and a soccer ball, may be evoking the identity of Beckham ‘by either consciously or subconsciously conjur[ing] up images’\footnote{Newcombe, 157 F 3d 686, 693 (9th Cir, 1998).} of Beckham.

In summary, the media coverage, as well as the popular narratives found in internet sites and other social contexts, have all contributed to the creation and circulation of a well-recognised public personality for particular individuals in society whom we call ‘celebrities’. The ‘well-knownness’ of these individuals are enhanced by transnational corporations who sign on celebrities to front their advertising campaigns. This further exposure of a particular celebrity will in turn heighten the well-knownness of that personality, leading to even greater media and public attention: ‘Anything that makes a well-known name still better known automatically raises its status as a celebrity.’\footnote{Boorstin, above n 139, 58.}
The following section will suggest that the proposed all-encompassing evocative standard of identification in a right of publicity claim is supported by the ubiquitous circulation and widespread recognition of the contemporary celebrity; the audience, who will be familiar with the myriad manifestations of a particular celebrity, do not require an obvious or literal reference to name or likeness in order to identify that celebrity.

B Evocative Identification of a Well-known Individual by the Audience

This section addresses the controversy surrounding the judicial expansion of the meaning of indicia of identity beyond name and likeness to an indeterminate range of identifying characteristics evocative of the celebrity. The dissents in cases like Carson, White and Wendt, as well as a number of academics, have highlighted the dangers of expanding the right of publicity as a result of an overtly generous interpretation of the identifiability requirement of a right of publicity claim. However, this thesis argues that the broad interpretation given to identity is supported by perspectives in cultural studies and is in line with a contemporary understanding of the associative value of a celebrity’s identity.

Although the prevailing orthodoxy is that every person has a right of publicity, regardless of whether he or she is a celebrity or non-celebrity, courts have in practice awarded summary judgment to the defendant when the plaintiff is unable to make a prima facie case based on the plaintiff’s ‘well-knownness’ to a more than de minimis number of ordinary viewers of the defendant’s use. The rationale appears to have been aptly captured in the argument advanced by Peter Felcher and Edward Rubin that unless the plaintiff has the potential to profit from his or her persona, he or she would not have suffered ‘an objectively ascertainable economic loss from the portrayal [by the

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187 Eg Motschenbacher, 498 F.2d 821, 824 (9th Cir, 1974); Onassis, 472 NYS 2d 254, 260 (1984); Tellado v Time-Life Books Inc, 643 F Supp 904, 909 (DNJ, 1986); Dora v Frontline Video Inc, 18 Cal Rptr 2d 790, 792 (1993). Generally, it appears that the level of the plaintiff’s fame goes only to the amount of damages, not to the very existence of a right. According to the Ninth Circuit, “[w]ell known” is a relative term, and differences in the extent of celebrity are adequately reflected in the amount of damages recoverable. Waits, 978 F 2d 1093, 1102 (9th Cir, 1992). See also McCarthy’s observations on why ‘non-celebrities’ may not bring right of publicity claims at all. McCarthy, above n 3, § 4:20.

188 Eg Pesina 948 F Supp 40, 42 (ND Ill, 1996); DeClemente, 860 F Supp 30, 53 (ED NY, 1994); Cox v Hatch, 761 P 2d 556, 564 (Utah, 1988).
defendant[189] and there would be nothing of value for the right of publicity to protect. This view is supported by the cultural analysis of how the audience-consumer relates to a bundle of meanings that the celebrity signifies. In cultural studies, the celebrity personality is seen to be a cultural symbol replete with meanings for the audience. According to Marshall and many other cultural studies scholars in this area, the ‘celebrity’ is a sign that represents well-known individuals who often skilled in the differentiation of their personalities to intensify their well-knownness.190 The example of David Beckham in Chapter 2 has illustrated how a particular celebrity sign may be encoded with certain positive meanings. This sign acquires a protectable market value as an economic commodity because of the meanings that audiences vest in them and because of the consumption behaviour of the audiences that respond to them.191 The audience-consumer who identifies a particular celebrity that he or she likes will naturally gravitate towards products that that celebrity is associated with. It does not matter whether it is through a name, likeness or some other visual or auditory cue that this favourable recognition is triggered.

In his seminal analysis of consumer responses to celebrity endorsements, Grant McCracken observes that

when consumers respond to [a celebrity’s] ‘attractiveness,’ they are, in fact, responding to a very particular set of meanings. They are identifying with a bundle of symbolic properties … Celebrities have particular configurations of meanings that cannot be found elsewhere.192

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189 Peter L. Felcher and Edward L. Rubin, ‘Privacy, Publicity and the Portrayal of Real People by the Media’ (1979) 88 Yale Law Journal 1577, 1613.
190 Eg Boorstin, above n 139, 65.
191 ‘Stars are examples of the way people live their relation to production in capitalist society’. Richard Dyer, Heavenly Bodies: Film Stars and Societies (2nd ed, 2004) 5. See also Dyer, ibid 16-7; Turner, Understanding Celebrity, above n 142, 89-127. The market value or the associative value of the celebrity identity will be discussed in Chapter 4 when considering the ‘commercial appropriation’ element of a right of publicity claim.
192 Grant McCracken, ‘Who is the Celebrity Endorser? Cultural Foundations of the Endorsement Process’ (1989) 16 Journal of Consumer Research 310, 312, 315. Celebrities draw on these powerful meanings from the ‘roles’ they assume in their movie, television, sporting or other careers. According to the McCracken approach, whether one plays a character in a movie or plays football in the sporting arena, the celebrity is in fact fulfilling a cultural role which contains a configuration of meanings to the public audience. It is the ‘accumulated meanings of celebrities that make them so potent a source of significance.’ Ibid 316.
The right of publicity as understood by the Ninth Circuit in a number of cases implicitly recognises that an unauthorised use of a celebrity identity in a commercial context has the effect of enhancing consumption values of a product that the celebrity personality is associated with. Legal commentator George Armstrong also postulated that ‘[t]he saturation of the airwaves with celebrity performances increases public awareness of the dramatic style, mannerisms, intonation or voice of a star. Public recognition of these additional features of the persona permits advertisers to imitate these traits … to achieve the same or greater promotional benefit than they would obtain by using the celebrity’s name or likeness.’ When used in a commercial context like in advertising or merchandising, all uses of identity are calculated to capitalise on the affective relationship between the celebrity and the consumer; these uses succeed in doing so when they ‘evoke’ the celebrity in the minds of the audience.

If the identity of the celebrity was not evoked in the minds of the audience – regardless of whether it was through name, likeness, voice or other indicia – it would have been pointless using a particular referencing device in an advertisement. The celebrity plaintiffs in cases like Midler, Waits, Onassis and Lombardo have all refused to be featured in the defendants’ advertisements. Regardless, the defendants in each case then proceeded to recreate specific distinctive characteristics of the celebrities in question for the advertisements. Ford and Frito-Lay, through their advertising agencies, sourced for a soundalike to imitate Bette Midler’s and Tom Waits’ voices. Christian Dior intentionally dressed a lookalike to evoke the Jacqueline Kennedy-Onassis persona. Doyle, Dane & Bernbach designed an elaborate New Year’s Eve setting to capture the performing style of Guy Lombardo. If the plaintiffs were indeed well-known from their circulation in the media, then the public should have no problem identifying them from these portrayals in the advertisement. It would be premature for courts to dismiss the claims summarily and not put the issue of identifiability to the jury.

193 Eg Abdul-Jabbar, 85 F 3d 407 (9th Cir, 1996); Waits, 978 F 2d 1093 (9th Cir, 1992); White I, 971 F 2d 1395 (9th Cir, 1992); Midler, 849 F 2d 460 (9th Cir, 1988).
This section argues that all forms of identification is through ‘evocation’ – that a celebrity is called to mind as a result of the audience’s visual or auditory cognition – and therefore there is no need to artificially create different categories of actionable indicia. Thus, this thesis proposes that the relevant inquiry for identifiability be: Is the plaintiff reasonably and readily identifiable by a more than de minimis number of people from the total context of the defendant’s use? This threshold question of evocative identification covers the uses of all indicia of identity. The more well-known a plaintiff, the more commercially valuable his or her identity will be, and the more readily he or she will be identified from a particular use. If the answer to the question is in the affirmative, the court should proceed to the next element of the claim, and ask whether the associative value of the plaintiff’s identity has been appropriated by the defendant (see next Chapter). If the answer is in the negative, then judgment should be awarded to the defendant.

1 Name

In the ‘name’ cases discussed in Part IIA, the use of the name of a well-known celebrity clearly calls to mind the particular individual. Generally, when a name is used, it is obvious from the decisions that the courts engage in an assessment of the level of well-knownness of the plaintiff when determining whether the name was used as a symbol of the plaintiff’s celebrity identity. It is implicit in numerous cases that the plaintiff was evoked in the minds of the audience and was reasonably and readily identified by the public from the defendant’s use. In Doe, where a famous hockey player’s nickname ‘Tony Twist’ was used for a comic character that bore no resemblance to him, the court found it significant that he was ‘immensely popular with hometown fans’ and ‘hosted the “Tony Twist” television talk show for nearly two years’. In Hirsch, the court found the plaintiff’s nickname ‘Crazylegs’ to be well-known as he was ‘a sports figure of national prominence’, referring to his outstanding professional football track record and numerous appearances in advertisements using the moniker

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196 This test borrows from the ‘de minimis’ concept proposed by McCarthy and its evocative standard of review is supported by comments from various commentators and state courts. See McCarthy, above n 3, §§ 3:7, 3:17-3:22; Schlachter, above n 126, 477; Halpern, above n 222, 866; Lapter, above n 222, 320-1; Henley, 46 F Supp 2d 587, 595 (ND Texas, 1999); Newcombe, 157 F 3d 686, 692 (9th Cir, 1998); McFarland, 14 F 3d 912, 923 (3rd Cir, 1994).
197 Doe, 110 SW 2d 363, 366 (Mo banc, 2003).
198 Hirsch, 280 NW 2d 129, 131 (Wis, 1979).
‘Crazylegs’.\textsuperscript{199} In \textit{Ali}, the court noted that Ali’s efforts to identify himself in the public mind as ‘the Greatest’ have been so successful that he was regularly identified as such in the news media, even on the cover of \textit{Time} magazine.\textsuperscript{200} However in cases like \textit{Pesina} and \textit{DeClemente}, where the plaintiffs were not well-known individuals, the courts have rightly denied recovery.\textsuperscript{201}

2 \quad \textbf{Likeness}

In the ‘likeness’ cases highlighted in Part IIB, it is clear that current case law generally requires the plaintiff to be ‘readily identified’ by the audience from a visual representation. A visual perception of a physical attribute, especially the facial features, is the most straightforward way of evoking or calling to mind the identity of a well-known individual. The courts have acknowledged this in the lookalike cases of \textit{Onassis} and \textit{Allen}, the cases featuring drawings of celebrities like \textit{Ali} and \textit{Comedy III}, and the cases involving photographs of the plaintiffs taken many years ago like \textit{Negri} and \textit{Downing}.\textsuperscript{202}

3 \quad \textbf{Evocative Aspects of Identity}

In the ‘evocative aspects of identity’ cases examined in Part IIIC, it emerged that a number of state and Circuit courts are willing to extend protection from the traditional criteria of name and likeness to any indicia of identity that evoked a well-known plaintiff. Although a mere reminder of the celebrity will not satisfy the identification requirement, it is unclear to this date just how one can confidently distinguish the difference between mere non-actionable reminder and actionable evocation.\textsuperscript{203} However, the suggestion by a commentator – that the solution lies in the distinction between protectable permanent and non-protectable transitory aspects – is untenable.\textsuperscript{204} While one may agree that ‘transitory adjuncts of personality … [such as] hairstyle [or] wardrobe … standing alone, are of such

\textsuperscript{199} Ibid 131-2.
\textsuperscript{200} \textit{Ali}, 447 F Supp 723, 727 (SD NY, 1978).
\textsuperscript{201} See above nn 151-153 and accompanying discussion.
dubious originality and confounding subtlety as to be undeserving of independent legal existence’, an overarching approach to identification through evocation obviates the need for any pre-determined set of actionable indicia. As explained earlier, this approach takes cognisance of the prior knowledge of the audience of all the defining symbols, characteristics or attributes of a well-known individual at a particular point in time and appropriately allows the jury to determine whether the plaintiff was indeed reasonably and readily identifiable from the context of the defendant’s use.

The ‘voice’ cases are similar to the ‘name’ and ‘likeness’ cases where the voice as an aural sign triggers the audience’s recognition of a famous plaintiff in the same way a linguistic sign and a visual sign can evoke the plaintiff. Members of the jury who are supposed to represent ordinary viewers – and listeners – should be able to recall the particular plaintiff from the defendant’s use; if indeed there exists a distinctive voice that is not widely known, then it probably does not have a commercial value worth protecting. When confronted with sound recordings in a right of publicity claim, courts should ask the simple question of whether the plaintiff is ‘reasonably and readily identified’ by the defendant’s use allowing the jury to rely on their prior knowledge of the plaintiff’s voice to make such a factual determination.

Regarding the ‘role or characterisation’ cases, the McFarland court’s ‘inextricably identified’ test is the correct approach to determining whether the defendant’s use of a fictional character evoked the actor-plaintiff in the minds of the audience. As Part IIC has shown, the plaintiff has to be widely known to the public as an individual whose claim to fame is inextricably identified with the character he or she has created or played. Where a popular historical or literary character is involved, like Count Dracula in Lugosi and the Batman and Tarzan examples discussed in the cases, the courts are less likely to find that an actor’s right of publicity has been infringed. Although the proposed controlling requirement that the plaintiff be reasonably and readily identified from the defendant’s use does not change, however, for the reasons enunciated

206 This would bring ‘voice’ cases in line with ‘likeness’ cases. See, eg, Newcombe, 157 F 3d 686, 692 (9th Cir, 1998).
207 See above nn 99-104 and accompanying text.
by the Third and Sixth Circuits, a further requirement of ‘inextricably identified’ ought to be imposed for characterisation cases so that the right of publicity is not construed to give a celebrity total control over a particular genre of roles. Courts should therefore properly direct juries to determine whether a celebrity had become so inextricably identified with a role or character – both on film and television – such that his or her human persona would be invoked by the particular role or character.

Most of the ‘other indicia’ cases, like Carson and Lombardo, would also have found support from a cultural studies analysis and passed the muster of the proposed ‘reasonably and readily identified’ standard. In Carson, the audience-consumer would be reacting to the famous phrase ‘Here’s Johnny’ in its total signification; the readily identifiable phrase would be evocative of the widely known television personality Johnny Carson who has been introduced on The Tonight Show with the distinctive phrase since 1962. The celebrity personality of Johnny Carson, as the Sixth Circuit rightly points out, would not be evoked by his real name, but by the distinctive introductory slogan. When consumers are attracted to products associated with Carson, they are in fact responding to the affective meanings signified by Carson. In a similar manner, Guy Lombardo, a popular entertainer who has spent forty years performing as ‘Mr New Year’s Eve’, ought to be reasonably and readily identified by an audience when ‘the defendants utilized the services of an actor conducting a band and provided him with the same gestures, musical beat and choice of music … with which plaintiff had been associated in the public’s mind for several decades.’

Finally, in White, it is indisputable that Vanna White is the quintessential contemporary celebrity whom Boorstin would have described as ‘a person who is known

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208 See above nn 87-93 and accompanying text.
209 See also White I, 971 F 2d 1395, 1405 (Alarcon J dissenting) (9th Cir, 1992); White II, 989 F 2d 1512, 1515 (Kozinski J dissenting) (9th Cir, 1993). Contra Wendt I, 125 F 3d 806, 811 (9th Cir, 1997) (‘an actor or actress does not lose the right to control the commercial exploitation of his or her likeness by portraying a fictional character’).
210 Eg McFarland, 14 F 3d 912, 921 (3rd Cir, 1994) (‘We hold only that there exists at least a triable issue of fact’).
211 Baudrillard, above n 166, 27.
212 Carson, 698 F 2d 831, 836 (6th Cir, 1983).
213 In dissent, Kennedy J thought the phrase was ‘merely associated’ with Carson and not sufficiently distinctive. Carson, 698 F 2d 831, 840 (6th Cir, 1983). See also Pesce, above n 20, 801-3.
for [her] well-knownness'. She is neither known for any particular acting, sporting, artistic, literary or intellectual abilities; nor is she known for any heroic endeavour. Yet White was seen by forty million people on television daily. But contrary to the view of the Ninth Circuit majority, and despite the defendant’s reference to the advertisement as the ‘Vanna White ad’, the advertisement may arguably be evocative of the Wheel of Fortune show and not Vanna White the celebrity. Unlike Carson and Midler, where the distinctive catch phrase and the voice of the soundalike were evocative of the celebrity individuals Johnny Carson and Bette Midler, the elements in the Samsung advertisement were arguably evocative of a popular television program on which White performed a particular role. Alarcon J, in dissent, pointed out that White possesses the ‘common attributes’ of ‘an attractive appearance, a graceful pose, blond hair, an evening gown, and jewelry’ which are ‘evident among game-show hostesses, models … and other women in the entertainment field.’ However, if the advertisement was indeed evocative of White – as Vanna White may be reasonably and readily identified by a more than de minimis number of people from the total context of Samsung’s advertisement – since she was playing a role on the Wheel of Fortune show, the next question that the court should address is whether White was ‘inextricably identified’ with the role of a blond hostess in a long gown with fine jewellery. Similarly, in Wendt, rather than dodging the question, the Ninth Circuit should have considered the application of the ‘inextricably identified’ test to determine whether the personae of Wendt and Ratzenberger were inseparable from their Cheers characters.

As Kozinski J pointed out in his impassioned dissent where an application for en banc hearing was rejected, ‘[i]t’s the “Wheel of Fortune” set, not the robot’s face or dress or jewelry that evokes White’s image … White [is given] an exclusive right not in what she looks like or who she is, but in what she does for a living.’ Indeed the concern that

215 Boorstin, above n 139.
216 White I, 971 F 2d 1395, 1396 (9th Cir, 1992).
217 Ibid 1396.
218 Ibid 1405.
219 McFarland, 14 F 3d 912, 920 (3rd Cir, 1994). Although McFarland was decided after White, there were ample authorities on a distinction between performer and role when considering identifiability of the plaintiff from the defendant’s use. But the majority made no reference to these cases.
220 The Ninth Circuit held that it was a ‘likeness’ issue with regard to identifiability that was to be determined. Wendt I, 125 F 3d 806, 810 (9th Cir, 1997).
221 White II, 989 F 2d 1512, 1515 (9th Cir, 1993). See also White I, 971 F 2d 1395, 1405 (Alarcon J dissenting) (9th Cir, 1992) (‘The Wheel of Fortune set, however, is not an attribute of White’s identity. It is an identifying characteristic of a game show.’).
‘every famous person now has an exclusive right to anything that reminds the viewer of her [or him]’\(^\text{222}\) has resulted in Sixth and Tenth Circuits refusing to follow White.\(^\text{223}\)

### IV SUMMARY & CONCLUSIONS

Increasingly, it seems that any readily recognisable characteristic of a celebrity is likely to be construed by the courts to possess a pecuniary value by which an unauthorised appropriation is actionable under the common law right of publicity. One of the most interesting aspects of celebrity is the intensifying degree – as illustrated in Part IIIA – to which the celebrity has been incorporated into our daily lives. The cultural and social pervasiveness of the celebrity suggest that members of the public can identify a particular celebrity by more than just a mention of name or a photograph in the newspapers. Moreover, the study of entertainment celebrities by Marshall have also shown that ‘[e]ach industry produces a range of celebrity types that not only are constructed to have distinctive qualities when compared with other celebrities within that industry, but are differentiated from the production of celebrities in each of the other domains of the entertainment industry.’\(^\text{224}\) These distinctive qualities may be ‘a complex configuration of visual, verbal and aural signs.’\(^\text{225}\)

Insofar as the cases hold that a celebrity may be identified by any attribute or a combination of elements beyond name and likeness, they are supportable by observations and research in cultural studies on the contemporary celebrity. This Chapter has made the argument that as audiences relate to the celebrity in all its significations, there is no need to categorise different actionable indicia of identity since all forms of identification are by their very nature ‘evocative’, albeit to different degrees. If some limits are to be imposed on an expanding right of publicity, a restrictive reading of identity is not the appropriate manner to do so. On the contrary, Chapter 5 will show that the First Amendment defence provides a robust constraint on the right of publicity, particularly

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\(^{223}\) Landham, 227 F 3d 619, 624 (6\(^{\text{th}}\) Cir, 2000); ETW Corp, 332 F 3d 915 (6\(^{\text{th}}\) Cir, 2003); Cardtoons, 95 F 3d 959 (10\(^{\text{th}}\) Cir, 1996).

\(^{224}\) Marshall, above n 144, 186. Marshall’s seminal work outlines how the film, television and pop music industries have organised their production of celebrities around particular characteristics.

\(^{225}\) Dyer, above n 191, 38.
when construing a wider range of uses of the celebrity identity to be protectable as political speech that contributes to democratic deliberation and debate.

In summary, this Chapter concludes that judges and scholars have been unduly concerned about evocation as a separate category of indicia of identity. Identifiability of a plaintiff through evocation outside of name and likeness does not equate to liability in a right of publicity action. However, courts in rushing to protect numerous aspects of the celebrity identity in a right of publicity claim need to proceed with a more in-depth analysis of the nature of the relationship between the celebrity and the audience in contemporary consumption. Courts should not be confusing identification with misappropriation by assuming that the defendant has gained a benefit simply because the unauthorised use was in a commercial context. There should only be misappropriation if the affective values of a particular celebrity have been transferred to the defendant’s products. Thus the next Chapter will make the argument that, once the celebrity has been identified, the relevant judicial inquiry should be into whether the associative value of the celebrity was appropriated by the defendant.
CHAPTER 4  RIGHT OF PUBLICITY AND THE APPROPRIATION OF COMMERCIAL VALUE OF IDENTITY

This Chapter examines how the second element of a typical right of publicity claim by a celebrity – the appropriation of commercial value of identity – has been the subject of perfunctory treatment and inconsistent interpretation by the courts. It argues that courts should consider drawing from cultural studies perspectives on the associative value of the celebrity commodity to formulate a test that determines whether a direct and substantial connection exists between the unauthorised use of the plaintiff’s identity and the commercial benefit gained by the defendant’s use. Such an approach also represents an extension of the current incidental use doctrine.

Part I explains how the ‘appropriation of commercial value’, also known variously as the requirement of commercial advantage, benefit or damage depending on the particular state jurisdiction, is an important but oft-neglected element in a right of publicity claim. It dissects the meaning of the two concepts of ‘commercial value’ and ‘appropriation’ to reveal the potential for undertaking a cultural studies analysis of when an appropriation in fact takes place.

Part II discusses how a use of identity in a commercial context is different from a use of the associative value of identity, drawing upon the experiences of particular state jurisdictions that require a direct connection between the use of the plaintiff’s identity and the defendant’s commercial purpose. It argues that courts should refocus their attention instead on first principles as articulated in Haelan Laboratories v Topps Chewing Gum – that the right of publicity is an independent right vindicating well-known individuals who were deprived of an endorsement fee for the use of their images – which were rooted in an unjust enrichment rationale.¹

Part III evaluates how the contemporary celebrity possesses particular positive connotational meanings for the audience, and how these affective values can be transferred to the products with which the celebrity is associated. Research on the consumption behaviour of audiences has revealed that a product which is perceived to be

¹ 202 F 2d 866, 868 (2nd Cir, 1953) (‘Haelan Laboratories’).
associated with a celebrity tends to be accorded a higher consumption value than one which is not. This underscores the importance of focusing the judicial inquiry on the intent of the defendant to exploit this associative value in a right of publicity claim: the defendant should be deemed to have appropriated the commercial value of a celebrity’s identity if the defendant intended to evoke the celebrity in the minds of the audience and intended that the audience react in a particular manner to that use of a celebrity’s identity to the defendant’s advantage. This thesis argues that insights from cultural studies support the application of a ‘direct and substantial connection standard’ to all right of publicity claims such that only an appropriation of the associative value of a well-known individual’s identity will be actionable in law.

Finally, Part IV concludes that a more detailed judicial consideration of the ‘appropriation of commercial value’ is necessary in right of publicity claims. This will ensure that not all unauthorised commercial uses of identity are misappropriations; only an unauthorised use of the associative value of identity should be prohibited by right of publicity laws.

I THE ‘APPROPRIATION OF COMMERCIAL VALUE’ REQUIREMENT IN A RIGHT OF PUBLICITY CLAIM

The second requirement in a right of publicity claim, as identified in Chapter 1, is an elusive concept for several reasons. First, the Restatement (Third) of Unfair Competition has not been clear on how and when the ‘commercial value of a person’s identity’ may be appropriated ‘for the purposes of trade’. Since the right of publicity has its origin in the misappropriation of name and likeness privacy tort, the Restatement (Second) of Torts has also been a source of judicial reference, however, clarity is not to be found here either. Second, while it is generally accepted that proof of deception or consumer confusion is not required for the imposition of liability, nevertheless the right of publicity ‘indirectly affords protection against false suggestions of endorsement or

3 Restatement (Second) of Torts § 652C (1977) (‘One who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of his privacy.’); Matthews v Wozencraft, 15 F 3d 432, 437 (5th Cir, 1994) (‘Matthews’).
sponsorship, thus overlapping with the Lanham Act § 43(a) false endorsement claim. Third, the courts have usually assumed that once a plaintiff has been identified from the defendant’s commercial use (as discussed in Chapter 3), the defendant has gained a commercial advantage, and the next step is to consider whether a First Amendment defence is applicable. It was only in the occasional statutory claim that the courts have considered whether there was a direct connection between the use of the plaintiff’s identity and the commercial advantage gained by the defendant.

This thesis contends that the courts and academic commentators have largely ignored an important analysis of whether the commercial value of the plaintiff’s identity has been appropriated by the defendant such that the defendant has gained a commercial advantage, and this Chapter attempts to fill the gaps in this area. In view of the mire of different and often inconsistent approaches presently adopted for the resolution of First Amendment issues in a right of publicity claim, and the desire of Circuit and state courts to avoid the constitutional issue of the First Amendment when a case may be decided on non-constitutional grounds, a closer examination of ‘commercial appropriation’ will benefit the courts by allowing them to: (i) enunciate clearer rules regarding the exploitation of the commercial value of identity; and (ii) particularly in the absence of a coherent standard established by the US Supreme Court, avert the engagement with complex and controversial First Amendment balancing exercises.

The right of publicity as first recognised in Haelan Laboratories, and subsequently affirmed by the US Supreme Court in Zacchini v Scripps-Howard

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8 A notable exception is Lee Hetherington’s analysis and proposed test that involves ‘a requirement that the unauthorized usage be both direct in nature and primarily commercial in its motivation.’ H Lee Hetherington, ‘Direct Commercial Exploitation of Identity: A New Age for the Right of Publicity’ (1992) 17 Columbia-VLA Journal of Law & the Arts 1, 32.
9 The analysis of how the enforcement of the right of publicity may be constrained by First Amendment doctrine is discussed in Chapter 5. See also below n 49 and accompanying text.
10 Eg Astaire v Best Film & Video Corp, 116 F 3d 1297, 1304 (9th Cir, 1997) (By broadly construing the language of a statutory exemption, it ‘also has the commendable effect of avoiding potential First Amendment concern’); Fogel v Forbes Inc, 500 F Supp 1081, 1089 (ED Pa, 1980).
11 202 F 2d 866 (2nd Cir, 1953).
Broadcasting Co,\textsuperscript{12} was primarily concerned with the unjust enrichment of the defendant through the commercial exploitation of the plaintiff’s identity which has ‘pecuniary worth’,\textsuperscript{13} resulting in the ‘commercial benefit [of the publicity]’ accruing to the defendant instead of the plaintiff.\textsuperscript{14} This Part will analyse how the state jurisdictions have approached the protection of the commercial value of identity based on these principles. Section A below briefly examines how courts have construed the meaning of ‘commercial value’ and ‘appropriation’ in right of publicity claims. Section B evaluates whether courts have adequately considered how this commercial value may be exploited by the defendant.

\textbf{A \quad Definition of ‘Commercial Value’}

The focus on an appropriation of the value of identity as the crux of a right of publicity claim is recognised by the \textit{Restatement (Third)}.\textsuperscript{15} Similarly, the \textit{Restatement (Second)} also recognises that tortious liability for the appropriation of name or likeness is intended to protect the commercial value of an individual’s identity.\textsuperscript{16} As explained in Chapter 3, a well-known individual may be identified by evoking any of a wide range of indicia of identity that are reasonably and readily identifiable by the consuming public. These readily recognisable indicia of identity are conferred an economic value when a licence fee is paid to the individual to use his or her persona for commercial purposes.\textsuperscript{17} Hence, the more well-known – and more well-liked – an individual, the greater will be

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\item \textsuperscript{12} 433 US 562, 576 (1977) (‘Zacchini’) (‘No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.’).
\item \textsuperscript{13} Haelan Laboratories, 202 F.2d 866, 868 (2\textsuperscript{nd} Cir, 1953).
\item \textsuperscript{14} Zacchini, 433 US 562, 573 (1977).
\item \textsuperscript{15} \textit{Restatement (Third) of Unfair Competition} § 46 cmt c (1995).
\item \textsuperscript{17} The term ‘for purposes of trade’ is defined in the \textit{Restatement (Third)} as the use of a person’s identity ‘in advertising the user’s goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user.’ \textit{Restatement (Third) of Unfair Competition} § 47 (1995). Some state publicity statutes include a broader range of actionable commercial uses that cover uses on or in connection with the sale of goods, advertising and fundraising. Eg \textit{Pennsylvania Statute Annotated}, title 42, § 8316(a); \textit{Tennessee Code Annotated} § 47-25-1105. See also \textit{The Right of Publicity Act}, 765 \textit{Illinois Compiled Statutes Annotated} 1075/1 (‘IRPA’); \textit{Indiana Code} § 32-15-1-2; \textit{Ohio Revised Code Annotated} § 2741.01; \textit{Florida Statute Annotated} § 540.08(1); \textit{New York Civil Rights Law} §§ 50-51 (‘NYCRL’).
\end{itemize}
the potential commercial value of that identity.\textsuperscript{18} Courts have generally concluded that ‘the value of the right of publicity lies in the association between celebrity and product.’\textsuperscript{19} As Bird CJ aptly puts it:

Such commercial use of an individual’s identity is intended to increase the value or sales of the product by \textit{fusing the celebrity’s identity with the product} and thereby \textit{siphoning some of the publicity value or good will in the celebrity’s persona into the product}. This use is premised, in part, on public recognition and association with that person’s name or likeness, or an ability to create such recognition.\textsuperscript{20}

When the Ninth Circuit first expanded the protectable indicia of identity beyond name and likeness in \textit{Motschenbacher v RJ Reynolds Tobacco Company}, the court recognised a need for the law to protect an individual’s interest in the commercial exploitation of the value of his or her identity.\textsuperscript{21} Subsequent decisions in the Second,\textsuperscript{22} Third,\textsuperscript{23} Fifth,\textsuperscript{24} Sixth,\textsuperscript{25} Seventh,\textsuperscript{26} Eighth,\textsuperscript{27} Ninth\textsuperscript{28} and Tenth\textsuperscript{29} Circuits have held that a celebrity’s identity can be valuable in the promotion of products and the law therefore protects against an unauthorised commercial exploitation of that associative value. There is usually a presumption that a plaintiff’s identity has an economic value – especially for celebrities – when it has been used by a defendant in a commercial context; indeed it would be futile for an advertiser or a trader to appropriate an identity that had no market

\begin{itemize}
\item \textsuperscript{18} The cultural studies perspectives on how the semiotic sign of the celebrity may influence consumption decisions will be discussed in Part IIIA below.
\item \textsuperscript{19} \textit{McFarland v Miller}, 14 F 3d 912, 919 (3rd Cir, 1994) (‘\textit{McFarland}’). See also \textit{White I}, 971 F 2d 1395, 1398 (9th Cir, 1992); \textit{Wendi v Host International Inc}, 125 F 3d 806, 811 (9th Cir, 1997) (‘\textit{Wendi I}’); \textit{ETW Corp}, 332 F 3d 915, 953 (6th Cir, 2003); \textit{Landham v Lewis Galoob Toys Inc}, 227 F 3d 619, 624 (6th Cir, 2000) (‘\textit{Landham}’).
\item \textsuperscript{20} \textit{Lugosi v Universal Pictures}, 25 Cal 3d 813, 834 (1979) (emphasis added) (‘\textit{Lugosi}’).
\item \textsuperscript{21} 498 F 2d 821, 826 (9th Cir, 1974).
\item \textsuperscript{22} \textit{Eg Rogers}, 875 F 2d 994 (2nd Cir, 1989).
\item \textsuperscript{23} \textit{Eg McFarland}, 14 F 3d 912 (3rd Cir, 1994).
\item \textsuperscript{24} \textit{Eg Matthews}, 15 F 3d 432 (5th Cir, 1994).
\item \textsuperscript{25} \textit{Eg Carson}, 698 F 2d 831 (6th Cir, 1983); \textit{Parks}, 329 F 3d 437 (6th Cir, 2003).
\item \textsuperscript{26} \textit{Eg Toney v L’Oreal USA Inc}, 406 F 3d 905 (7th Cir, 2005) (‘\textit{Toney}’).
\item \textsuperscript{27} \textit{Eg CBC Distribution and Marketing Inc v Major League Baseball Advanced Media LP}, 505 F 3d 818 (8th Cir, 2007) (‘\textit{CBC}’).
\item \textsuperscript{28} \textit{Eg Miller v Ford Motor Company}, 849 F 2d 460 (9th Cir, 1988) (‘\textit{Miller}’); \textit{White I}, 971 F 2d 1395 (9th Cir, 1992).
\item \textsuperscript{29} \textit{Eg Cardtoons LC v Major League Baseball Players Association}, 95 F 3d 959 (10th Cir, 1996) (‘\textit{Cardtoons}’).
\end{itemize}
value since such an appropriation would not be providing any discernible benefit. Legal commentators have also observed that:

The phenomenon of celebrity generates commercial value. A celebrity’s persona confers an *associative value*, or economic impact, upon the marketability of a product. Whether we like commercialization of personality or not, the economic reality persists … The market place recognizes an associative economic value.

In a way, celebrity endorsements can function in much the same manner as trademarks in communicating information and enhancing the appeal of brands and marketability of products. Thus the commercial value of identity lies in its ‘associative value’.

**B Definition of ‘Appropriation’**

The courts have not defined ‘appropriation’, but the plain meaning of ‘appropriate’ means ‘to take or make use of without authority’. The essence of a publicity claim is the defendant taking, or seeking to take, something of value away from the plaintiff without the plaintiff’s consent. In other words, the ‘appropriation of commercial value’, as expressed in the *Restatement (Third)*, occurs when the defendant gains or seeks to gain a commercial advantage or benefit from the use of the plaintiff’s identity without the payment of an appropriate fee to the plaintiff. The courts appeared to have predominantly relied on an unjust enrichment rationale to prevent the commercial}

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35 It has been argued that the plaintiff may also suffer damage as a result of a diminution of the endorsement value of his or her identity. Eg *Lugosi*, 25 Cal 3d 813, 835-6 (1979); *Motschenbacher*, 498 F 2d 821, 824 (9th Cir, 1974); Mark F Grady, ‘A Positive Economic Theory of the Right of Publicity’ (1994) 1 *UCLA Entertainment Law Review* 97, 115-23; Xavier S Frascogna and H Lee Hetherington, *Successful Artist Management* (1990) 145-8. However, the extent of pecuniary loss appears to be more relevant to the assessment of monetary relief or damages. *Restatement (Third) of Unfair Competition* § 49 cmt d (1995).
free-rider from exploiting the associative value of the plaintiff’s identity. Thus ‘there is no tort’ unless ‘the defendant [has] appropriated to his own use or benefit the reputation, prestige, social or commercial standing’ of the plaintiff’s identity. In Onassis v Christian Dior-New York, the court chastised the defendants for using a Jacqueline Kennedy Onassis-lookalike model in one of their print advertisements, entering a judgment in favour of Onassis. The court stated,

[1]et the word go forth – there is no free ride. The commercial hitchhiker seeking to travel on the fame of another will have to learn to pay the fare or stand on his own two feet.

It is precisely this raison d’être that originally impelled the Second Circuit in Haelan Laboratories to declare the recognition of an actionable right of publicity in 1953, but as the protectable indicia of identity expanded over the years, some courts appeared to have lost sight of this imperative.

The low threshold for the commercial advantage element in a common law right of publicity claim as presently accepted by the courts is a result of the assumption that the defendant should be held liable simply because ‘it received a benefit by getting to use a celebrity’s name for free in its advertising’ or when the celebrity’s identity is used ‘to attract the consumers’ attention.’ When evaluating the issue of misappropriation, the predominant judicial focus is on determining the intent or purpose of the defendant to exploit the value of the plaintiff’s identity as construed from the circumstances rather

37 Restatement (Second) of Torts § 652C cmt c (1977). See also Hooker v Columbia Pictures Industries, 551 F Supp 1060, 1062 (ND Ill, 1982); Pooley v National Hole-In-One Association, 89 F Supp 2d 1108, 1111 (D Ariz, 2000) (‘Pooley’).
38 472 NYS 2d 254, 261 (1984) (‘Onassis’).
39 Haelan Laboratories, 202 F 2d 866, 868 (2nd Cir, 1953).
40 Eg White v Samsung Electronics America Inc, 989 F 2d 1512, 1512-21 (Kozinski, O’Scanlaimn & Kleinfeld JJ dissenting) (9th Cir, 1993) (‘White II’); Wendt v Host International Inc, 197 F 3d 1284, 1285-9 (Kozinski, Kleinfeld & Tushima JJ dissenting) (9th Cir, 1999) (‘Wendt II’).
41 Eg Henley, 46 F Supp 2d 587, 597 (ND Tex, 1999); Newcombe v Adolf Coors Company, 157 F 3d 686, 693 (9th Cir, 1998) (‘Newcombe’).
42 Eg Newcombe, ibid; Abdul-Jabbar, 85 F 3d 407, 416 (9th Cir, 1996); Eastwood, 149 Cal App 3d 409, 420 (1983).
than on the damage that the unauthorised use has inflicted on the plaintiff. But some Circuit decisions like *Cardtoons LC v Major League Baseball Players Association* and *ETW Corp v Jireh Publishing*, in dismissing the plaintiffs’ claims, appear to have been unduly influenced by the irrelevant consideration of the extent of damage to the celebrity’s overall income and endorsement opportunities. Such decisions go against the principle that there is no need for the plaintiff to prove actual commercial damage to the value of his or her identity in order to establish a publicity claim.

The preponderance of academic writings tend to be concerned with the overly broad protectable indicia of identity, the different tests inconsistently applied by the courts to uphold First Amendment values, and the impact of the right of publicity on the cultural domain. This Chapter brings a different perspective to the debate by urging a more thorough judicial consideration of whether commercial appropriation has in fact taken place. The right of publicity acquires a broad berth beyond its original conceptual

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43 Eg *Benavidez v Anheuser Busch Inc*, 873 F 2d 102, 104 (5th Cir, 1989); *Doe v TCI Cablevision*, 110 SW 3d 363, 369 (Mo banc, 2003) (‘Doe’); *Henley*, 46 F Supp 2d 587, 596-7 (ND Tex, 1999). See also *Restatement (Second) of Torts* § 652C cmt d (1977).
44 95 F 3d 959, 972 (10th Cir, 1996).
45 332 F 3d 915, 933, 938 (6th Cir, 2003).
46 This is arguably an issue more relevant to the assessment of monetary relief than to the determination of actionable appropriation. Eg *Restatement (Third) of Unfair Competition* § 49 cmt d (1995) (‘Celebrities … may also recover for any reduction in the commercial value of their identity caused by the defendant’s unauthorized use’).
47 Damage is presumed once the plaintiff has proven that the defendant has used the identity with the intent to obtain a commercial advantage. Eg *McCarthy*, above n 30, § 3:2; *Ainsworth v Century Supply Co*, 295 Ill App 3d 644, 650 (1998); *James v Bob Ross Buick Inc*, 167 Ohio App 3d 338, 344 (2006).
moorings when courts begin to equate any identifiable use of a celebrity’s identity in a commercial context with the gain of a commercial advantage by the defendant. The oft-quoted phrase from *Eastwood v Superior Court for Los Angeles County* that “[t]he first step toward selling a product or service is to attract the consumers’ attention”\(^{51}\) has been interpreted by courts to stand for the proposition that to the extent that an identifiable celebrity has attracted the consumers’ attention, the defendant has gained a commercial advantage and a misappropriation has occurred.\(^{52}\) The origin of this phrase may be traced to legal commentator James Treece who in 1973 pointed out that ‘to the extent that the use of a likeness attracts attention to a product, that use benefits an advertiser.’\(^{53}\) But in determining misappropriation, what many courts and commentators today have ignored is an examination of the connection between the use of the plaintiff’s identity and the defendant’s gain based on the public’s positive reaction to the associative value of that identity.\(^{54}\)

In conclusion, the state and Circuit courts have generally accepted that it is the associative value of a celebrity’s identity that is protected by the right of publicity, but they have paid little attention to analysing whether this value was in fact appropriated by the defendant’s commercial use. It is important to note that in the award of monetary relief in a right of publicity claim, as pointed out in the *Restatement (Third)*, the measure of compensatory damages or an accounting of the defendant’s profits that is attributable to the unauthorised use ‘properly focuses on the pecuniary loss to the plaintiff or the unjust pecuniary gain to the defendant.’\(^{55}\) This nexus between compensation and harm further suggests that courts ought to accord greater consideration to the ex ante issue of appropriation of commercial value.


\(^{52}\) Eg *Wendt I*, 125 F 3d 806, 811-2 (9th Cir, 1997); *Newcombe*, 157 F 3d 686, 693 (9th Cir, 1998). See also McCarthy, above n 30, § 1:35.

\(^{53}\) James M Treece, ‘Commercial Exploitation of Names, Likenesses, and Personal Histories’ (1973) 51 *Texas Law Review* 637, 644 (noting that advertising research has affirmed that consumers do draw inferences of approval or sponsorship from the use of celebrity names and pictures in advertisements).

\(^{54}\) The significance of this connection and the reaction of consumers to the use of a celebrity’s identity in advertising will be considered through the lens of perspectives in cultural studies and consumer research in Part IIIIB below.

\(^{55}\) *Restatement (Third) of Unfair Competition* § 49 cmt b (1995). See also ibid § 49 cmt d.
II THE DIFFERENCE BETWEEN USE IN A COMMERCIAL CONTEXT AND USE OF ASSOCIATIVE VALUE

The right of publicity, generally accepted by courts as a form of property right, started off as ‘an interest protected by tort law [and] became a commodity as it entered commerce, guarded first from trespass, then endowed with alienability and heritability.’

Characterisation of a value as property, however, does not resolve the question about the content of the right of publicity and how this proprietary right may be interfered with. For example, the action of trespass may be brought by a plaintiff against a defendant who sets foot on his or her land without permission – even if the value of the land has not been diminished and the plaintiff has suffered no commercial damage – because the proprietary interest in land may be defined, inter alia, as ‘a legal right to exclude others from enjoying it.’ The defendant has committed a tort because he or she has interfered with the plaintiff’s right to the enjoyment of the land to the exclusion of others. But the origin of the right of publicity lies in the protection of the value of one’s persona. As a commentator observed, the right of publicity reflected ‘historical and ideological responses to the needs of celebrities … and hardly resembled any property interest that

56 George M Armstrong Jr, ‘The Reification of Celebrity: Persons as Property’ (1991) 51 Louisiana Law Review 443, 467. An ‘interest’ is private ‘property’ when it is considered a legal right – that has ‘the expectancies embraced in the concept of property’ – which has the law behind it. Eg Kaiser Aetna v United States, 444 US 164, 178 (1979) (‘Kaiser Aetna’) (‘an “economic advantage” that has the law back of it to such an extent that courts may “compel others to forbear from interfering with [it] or to compensate for [its] invasion.”’); United States v Willow River Company, 324 US 499, 502 (1945). The California Supreme Court has enunciated an even broader definition that ‘extends to every species of right and interest capable of being enjoyed as such upon which it is practicable to place a money value.’ Motschenbacher, 498 F 2d 821, 826 (9th Cir, 1974) (citing Yuba River Power Co v Nevada Irrigation District, 207 Cal 521, 523 (1929)). See also Adam Mossoff, ‘What is Property? Putting the Pieces Back Together’ (2003) 45 Arizona Law Review 371.

57 Granted that the use of the term ‘property’ may be metaphorical rather than having legal significance as a real property right, a tortious action for infringement of the right of publicity is nevertheless treated by courts in numerous cases as if it was an interference with the enjoyment of a property right. See, eg, Haelan Laboratories, 202 F 2d 866, 868 (2nd Cir, 1953); Huw Beverley-Smith, Angsar Ohly and Agnès Lucas-Schloetter, Privacy, Property and Personality: Civil Law Perspectives on Commercial Appropriation (2005) 52. But this property label has its share of problems. Eg Mark P McKenna, ‘The Right of Publicity and Autonomous Self-Definition’ (2005) 67 University of Pittsburgh Law Review 225, 245-6 (‘Unfortunately, calling the new claim “property” has not led to clarity … There is nothing inherent in the notion of property that logically requires all of the constitutive rights in the bundle be marshaled in favor of identity’).

had ever existed before.”¹⁵⁹ Unlike a trespass action in property,¹⁶⁰ the relevant ‘trespass’ in a right of publicity action occurs only when the commercial value of one’s identity has been interfered with;¹⁶¹ hence it follows that there is no ‘trespass’ in a mere unauthorised use of identity in a commercial context. In the words of legal commentator Sheldon Halpern, there should be an interference with the ‘associative economic value’.¹⁶²

In my view, since the right of publicity is fundamentally different from a ‘physical thing’ as contemplated in a number of decisions by the US Supreme Court,¹⁶³ it is the ‘possession, control, and disposition’ of the ‘economically realizable value’ of identity that are the ‘valuable rights that inhere in the property’ and not identity as property per se.¹⁶⁴ Commercial appropriation occurs when the plaintiff’s identity is used to sell the defendant’s products thereby taking something of value from the plaintiff’s identity and transferring it to the defendant’s products. This Part argues that unlike a legal interest in tangible property like land, the ‘purely commercial nature’ of the right of publicity, as acknowledged in Haelan Laboratories – that many celebrities ‘would feel sorely deprived if they could no longer receive money for authorizing advertisements’¹⁶⁵ – requires courts to pay closer attention to whether the commercial value of identity has been ‘trespassed’ by the defendant.

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¹⁶⁰ The US Supreme Court has held that held that ‘a property right was taken even when infringement of that right arguably increased the market value of the property at issue’. Loretto v Teleprompter Manhattan CATV Corp, 458 US 419, 437 (1982) ("Loretto"); Phillips v Washington Legal Foundation, 524 US 156, 167-8 (1998) ("Phillips"). However, this holding was based on the interference with ‘the group of rights which the so-called owner exercises in his dominion of the physical thing,’ such as ‘the right to possess, use and dispose of it.’ United States v General Motors Corporation, 323 US 373, 378 (1945) ("General Motors").

¹⁶¹ The ‘misappropriation of one’s name or public personality is a compensable trespass to property [that] has been the recognition of the so-called “right of publicity.”’ Uhlaender v Henricksen, 316 F Supp 1277, 1281 (D Minn, 1970) ("Uhlaender"). See also Halpern, above n 31, 1240 (‘One useful tool that appears to avoid the “property” circle is the concept of “value”… Celebrity is marketable both for itself directly and for the associative spillover that follows from our interest in celebrity.’).

¹⁶² Halpern, above n 31.

¹⁶³ Eg Loretto, 458 US 419, 437 (1982); General Motors, 323 US 373, 378 (1945).


¹⁶⁵ Haelan Laboratories, 202 F 2d 866, 868 (2nd Cir, 1953).
A Incidental Use Doctrine to exclude First Amendment-Protected Uses

As explained in Part IA, the commercial value of identity is associational in nature. The Restatements, as well as a number of cases, have explained that the value of a plaintiff’s identity is not appropriated when the identity has been used for purposes other than taking advantage of the plaintiff’s reputation, prestige or other value associated with him or her, but unfortunately do not offer any meaningful suggestions on how courts may go about making such determinations.66 However, Lee Hetherington proposes that a direct commercial usage ought to be the touchstone of liability and defines this to be ‘[a]ny substantial form of remuneration, financial or otherwise, including, but not limited to, the generation of good will, favorable publicity, or other means of furthering the user’s immediate financial interests’.67 Generally, to succeed in a right of publicity claim, the plaintiff is required to prove that the defendant has derived some direct commercial benefit from the use of the plaintiff’s identity – hence ‘appropriated’ the value of the plaintiff’s identity because the defendant has gained something by paying the plaintiff nothing – as opposed to an incidental use where no direct benefit was derived. Although Hetherington’s categorisation of recurring patterns of commercial use are of great assistance to the analysis of how commercial appropriation may occur,68 his ambitious attempt to fuse First Amendment principles with considerations of commercial usage into one overarching test69 is likely to result in even more judicial confusion in its application.70

This Chapter argues that the considerations of commercial appropriation and the First Amendment defence ought to be kept separate as the onus is on the plaintiff to prove that commercial appropriation has taken place, but the burden is on the defendant to prove that the use of identity is protected by the First Amendment or falls under a statutory exception that enshrines free speech values. The thesis agrees with the observation in Eastwood that the use of a celebrity’s name or picture on the cover of a magazine – and related advertisements – constitutes prima facie commercial

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66 Restatement (Second) of Torts § 652C cmt d (1977); Restatement (Third) of Unfair Competition § 47 cmts a-c (1995); McCarthy, above n 30, §§ 7:12-7:19.
67 Hetherington, above n 8, 41.
68 Ibid 33-6.
69 Ibid 32.
70 The difficulties of applying an overarching test for hybrid uses of identity where commercial and First Amendment interests are inextricably intertwined will be examined in Chapter 5.
appropriation. This is because the magazine has gained a commercial advantage by leveraging the ‘celebrity’s audience appeal … to generate maximum curiosity and the necessary motivation to purchase [the magazine].’ However, it is established law that the media will not be liable for such uses because the First Amendment confers protection for publication of newsworthy information, matters of public concern or matters in the public interest; this privilege is recognised both in common law and in statute. But if the media has presented news about the celebrity to the reader ‘with knowledge of their falsity or with reckless disregard for the truth’, the constitutional protection would be forfeited, and the defendant would be liable for the ‘commercial exploitation’ of the commercial value of the celebrity’s identity. In other words, the news account is seen as ‘a coverup or subterfuge for commercial appropriation.’ Similar issues arise when a non-media defendant has used the plaintiff’s identity in an artistic or entertainment context: the logical sequence should be to first determine whether an unauthorised taking of an associative value has occurred, and then whether this taking is nonetheless protected by the First Amendment. Hence the courts should make it clear when the use of the associative value of a plaintiff’s identity to attract the consumer to buy the defendant’s product amounts to ‘commercial appropriation’, and when the defendant may be exonerated because of overriding First Amendment protection.

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72 Eg Solano v Playgirl Inc, 292 F 3d 1078, 1088-9 (9th Cir, 2002) (‘Solano’); Dora v Frontline Video, 15 Cal App 4th 536, 542-3 (1993); Finger v Omni Publications International Ltd, 564 NYS 2d 1014, 1016-7 (1990); CCC § 3344(d); NYCRL § 51; Florida Statute Annotated § 540.08(3)(a); IRPA § 35(b)(2).
73 The courts have generally adopted the ‘actual malice’ standard applicable to media-defendants in defamation law. Furthermore, in a right of publicity claim, the celebrity plaintiff is deemed to be a ‘public figure’ or whose activities are deemed to be a ‘matter of public interest’ or ‘matter of public concern’. Eastwood, 149 Cal App 3d 409, 423-4 (1983). See also New York Times v Sullivan, 376 US 254, 279-80 (1964); Carlisle v Fawcett Publications Inc, 201 Cal App 2d 733, 746 (1962).
74 Eastwood, ibid 426. See also Solano, 292 F 3d 1078, 1089 (9th Cir, 2002); Eastwood v National Enquirer Inc, 123 F 3d 1249, 1256 (9th Cir, 1997).
75 Eastwood, ibid 423.
76 Eg Parks, 329 F 3d 437, 454, 461 (6th Cir, 2003) (holding that ‘reasonable people could find that the name was appropriated solely because of the vastly increased marketing power of a product bearing the name of a national heroine of the civil rights movement’ and there exists ‘a genuine issue of material fact regarding the question of whether the title to the song is or is not “wholly unrelated” to the content of the song’); Rogers, 875 F 2d 994, 1004-5 (2nd Cir, 1989) (although the court held that the use of the movie title ‘Ginger and Fred’ was ‘clearly related to the content of the movie’ and ‘not a disguised advertisement for the sale of goods or services’). See also ETW Corp, 332 F 3d 915 (6th Cir, 2003); Doe, 110 SW 3d 363 (Mo banc, 2003). The First Amendment issues will be discussed in Chapter 5 Part II below.
Since the use of a person’s identity in ‘news reporting, commentary, entertainment, works of fiction or nonfiction’\(^{77}\) is ordinarily not an infringement of the right of publicity, the courts have held that the commercial use of identity in advertising or in promoting such uses is also not actionable.\(^{78}\) Rather confusingly, this is sometimes referred to as the incidental use doctrine which covers not just insignificant or fleeting uses of identity,\(^ {79}\) but also advertising for the particular protected work in question. This incidental use rule has also been extended to permit the use of identity in general advertising for the medium in which the use appears, so long as the advertisement does not falsely suggest an endorsement by the identified person.\(^{80}\) Perhaps it is more appropriate to refer to such uses not as ‘incidental’ but as ‘protected’ or ‘exempted’ uses because of their protection by the First Amendment guarantees of freedom of press and speech.

This thesis concurs with McCarthy, who correctly points out that it creates ‘semantic confusion’ to refer to commercial uses that are protected by the First Amendment as ‘incidental uses’ or even ‘exempt incidental uses’.\(^ {81}\) Thus while it is clear that the use of a person’s identity to advertise a newspaper, magazine, broadcast news program, film or book is a commercial use from which the defendant is likely to obtain a commercial advantage, such uses are deemed not to have appropriated the commercial value of the person’s identity because the advertisement shares the First Amendment privilege enjoyed by the original protected work.\(^{82}\) However, the unauthorised commercial use of identity in merchandise has not been accorded the same First Amendment protection analogous to that which advertisements promoting the different


\(^{79}\) Eg McCarthy, above n 30, § 7:20 (mere insignificant or fleeting use of identity in an advertisement will not trigger liability when ‘such a usage will have only a de minimis commercial implication’); Rand v Hearst Corp, 298 NYS 2d 405 (1969) (‘Rand’) (the use of Ayn Rand’s name in a critical review excerpt on the back of a book was merely incidental to the right of the publisher to inform the public of the nature of the book); Moglen v Varsity Pajamas Inc, 213 NYS 2d 999 (1961) (‘Moglen’) (a piece of a newspaper containing an article concerning the plaintiff that was reproduced as an obscure part of a pattern on the fabric used by defendant in the manufacture of pajamas was incidental use).

\(^{80}\) Restatement (Third) of Unfair Competition § 47 cmt a (1995).

\(^{81}\) McCarthy, above n 30, § 7:19.

media of communication have enjoyed.\footnote{Eg \textit{Restatement (Third) of Unfair Competition} § 47 cmt b (1995); \textit{Factors Etc Inc v Pro Arts Inc}, 579 F 2d 215, 222 (2\textsuperscript{nd} Cir, 1978) (an Elvis Presley ‘In Memory’ poster is not like a political campaign poster protected by the First Amendment); \textit{Lugosi}, 25 Cal 3d 813, 851 (1979) (no First Amendment implications in sale of pencil sharpeners, soap, stirring rods etc bearing the likeness of Bela Lugosi as Count Dracula).} Therefore, an ‘incidental use’ should comprise only insignificant or fleeting uses with a de minimis commercial implication – leaving aside free speech arguments to be considered separately under the First Amendment defence.

\section*{B A Nexus between Commercial Advantage and Exploitation of Associative Value}

The issue of when an appropriation has occurred was succinctly stated by Bird CJ in \textit{Lugosi v Universal Pictures}:

\begin{quote}
An unauthorized commercial appropriation of one’s identity converts the \textit{potential economic value} in that identity to another’s advantage. The user is enriched, reaping one of the benefits of the celebrity’s investment in himself [or herself].\footnote{\textit{Lugosi}, 25 Cal 3d 813, 835 (1979). See also \textit{Factors Etc Inc v Creative Card Co}, 444 F Supp 279, 283 (SD NY, 1977); \textit{Kalven}, above n 36, 331; \textit{Treece}, above n 53, 642-6.}
\end{quote}

More recently, the California Court of Appeal affirmed that ‘[t]he critical question is [the plaintiff’s] ability to attract the attention and \textit{evoke a desired response} in a particular customer audience’ and that the response is a kind of ‘\textit{recognition value} generated by [the plaintiff].’\footnote{\textit{Christoff v Nestlé USA Inc}, 62 Cal Rptr 3d 122, 143 (Cal App Ct, 2007) (‘\textit{Christoff}’) (emphasis added).} Thus, if it is an associative use that defines the essence of commercial appropriation, then the judicial inquiry should be directed at examining the nexus between the commercial advantage sought by the defendant and the associative value of the plaintiff’s identity.

The following uses, albeit in a commercial context, should not amount to actionable appropriation: (i) where there was a fleeting or insignificant use of the plaintiff’s identity with a de minimis commercial implication – eg a passing mention or brief glimpse of the plaintiff in print, film or a broadcast program;\footnote{These scenarios are covered by the incidental use doctrine applied in cases like \textit{Rand} and \textit{Moglen}. See above n 79. See also \textit{Comins v Discovery Communications Inc}, 200 F Supp 2d 512 (D Md, 2002)} and (ii) where
Despite the prominent use of the plaintiff’s identity, the defendant may be shown to be exploiting the associative value of another property, and the consumer is primarily responding to the associative value of that property or to other creative elements present in the defendant’s advertisement or product. In both scenarios, there are compelling arguments that the defendant has not taken anything from the value of the plaintiff’s identity as the defendant was not enriched by seeking to elicit a positive response from consumers through leveraging on the plaintiff’s fame.

This thesis maintains that the mere fact that an advertisement containing an aspect of the plaintiff’s identity was published – or that a product incorporating the plaintiff’s identity was sold – is insufficient to conclude that there was commercial appropriation. There has to be something more; and this lies in finding an associative use where the defendant has directly exploited the plaintiff’s identity to sell products. This is a view shared by a number of state courts outside California who have declined to follow the line of precedents since Eastwood that adopted a generous reading that equated attracting the consumers’ attention with commercial advantage, focusing instead on the intent of the defendant to elicit a positive consumption response from a target audience. If the defendant had intended to use the plaintiff’s identity to secure a commercial benefit or advantage, then the defendant will not be shielded from liability because ‘the product

87 This other ‘property’ may arguably include the goodwill or reputation of something other than the plaintiff’s identity with which the consumer has an affective relationship. Eg Vinci v American Can Company, 69 Ohio App 3d 727 (1990) (‘Vinci’) (an associative connection with the Olympic Games); Elvis Presley Enterprises v Capece, 950 F Supp 783 (SD Tex, 1996) (‘Capece’) (an era in which Elvis Presley was a part of); White II, 989 F 2d 1512 (9th Cir, 1993) (the Wheel of Fortune show); Wendt II, 197 F 3d 1284 (9th Cir, 1999) (the Cheers program). These cases will be discussed in Part IIIIB below.

88 A number of New York cases have illustrated that ‘merely the juxtaposition of a person’s likeness with a frankly commercial presentation is not determinative.’ Eg Booth, 223 NYS 2d 737, 744 (1962) (discussing Gautier, 304 NY 354 (1952)). See also Falooma v Hustler Magazine Inc, 607 F Supp 1341, 1360 (ND Tex, 1985); National Bank of Commerce v Shaklee Corp, 503 F Supp 533, 540 (WD Tex, 1980).


90 There is a variation across different state laws on whether an intent to infringe another’s right of publicity is an element of liability. Generally in a common law publicity claim, proof of intent is not required, although it is relevant in determining the appropriate relief. Restatement (Third) of Unfair Competition § 46 cmt e, § 47 cmt e, § 49 cmt c (1995). In the absence of intent, monetary relief may be denied and the plaintiff limited to an injunction against an innocent infringer. Eg Brinkley v Casablancas, 438 NYS 2d 1004 (1981).
promoted is undesirable, the ad [is] clumsy or somewhat ineffective, or sales slump[ed] during the relevant time period.\footnote{Henley, 46 F Supp 2d 587, 597.} In these situations where the defendant had failed to make profits, a commercial benefit is nevertheless deemed to have been gained by the defendant because the defendant had avoided payment of a licensing fee for that particular commercial use; the plaintiff may still recover ‘damages based on the fair market value of the unauthorized use’\footnote{Restatement (Third) of Unfair Competition § 49 cmt d (1995). Some state courts have held that even where the defendant has made a loss despite the use of the plaintiff’s identity, it would nevertheless be a commercial appropriation if it is proven that the defendant had intended to free-ride on the associative value of the plaintiff’s identity. If the plaintiff succeeds, then the plaintiff is entitled only to damages – the fair market value of what the defendant should have paid to use the plaintiff’s name in connection with its products. Eg Henley, 46 F Supp 2d 587, 597 (ND Tex, 1999); Doe, 110 SW 3d 363, 371 (Mo banc, 2003).} or obtain an injunction relief.\footnote{Restatement (Third) of Unfair Competition § 48 cmt b (1995).} 

In conclusion, a ‘trespass’ to identity is not the same as trespass to land; the interference with one’s proprietary interest in the associative value of identity is different from the interference with one’s right to the exclusive enjoyment of land. Furthermore, not all uses of the celebrity identity in a commercial context are uses of the associative value of identity – in the sense that the defendant has gained a commercial benefit by ‘siphoning some of the publicity value … in the celebrity’s persona into the product’, \footnote{See above n 20 and accompanying text.} or that the plaintiff has been deprived of a potential endorsement fee. Part III will explain, with support from cultural studies perspectives and empirical consumer research, how this associative value is derived and its significance to the audience-consumer. It will contend that right of publicity laws should properly determine whether an appropriation of the associative value of identity has occurred from the total context of the defendant’s use – this is achieved by examining whether the defendant had intended to use the plaintiff’s identity to directly improve brand recall or to enhance the social and emotional consumption values of the defendant’s products.

### III APPROPRIATING THE ASSOCIATIVE VALUE OF A CELEBRITY’S IDENTITY

Celebrity endorsements affect consumer purchase decisions in different ways, like enhancing product or brand familiarity, and improving the perception of product or brand quality. The ‘associative value’ that a celebrity brings to a brand is the transfer of the perceived attributes of the celebrity – for example, success, glamour, beauty and talent –
directly to the brand he or she is associated with. Whether a movie star, an athlete or a musician, each well-known individual has the power to connect the product brand to consumers in the context of their familiar and likeable domains of film, sport or music.

This Part delves deeper into the insights on the celebrity sign highlighted in Chapter 2 and aims to provide a better understanding of the meaning of ‘associative value’ through an analysis of relevant writings in cultural studies. Section A below will examine key perspectives on the semiotic nature of the celebrity sign and how cultural producers and audiences have attributed particular meanings to different types of celebrities. Section B evaluates the significance of these connotational meanings in influencing contemporary consumption and advocates that the adoption of a ‘direct and substantial connection’ standard can best focus the judicial inquiry on whether the associative value of the plaintiff’s identity has been appropriated by the defendant.

A The Semiotic Sign of the Celebrity and its Connotational Meanings

The value of cultural studies to the right of publicity here lies in its ‘active audience thesis’ and its examination of ‘the process and meaning of consumption or reception.’ This focus helps us better understand why a celebrity’s identity is commercially valuable, how a celebrity’s identity may be exploited for economic gain and how audiences respond to uses of a celebrity’s identity for the purposes of trade. This investigation of the celebrity as commodity will in turn inform the critique of how the ‘appropriation of commercial value’ requirement in a right of publicity claim can be interpreted in a manner that is congruent with contemporary consumption.

As discussed in Chapters 2 and 3, the celebrity personality is seen in cultural studies to be a cultural symbol infused with different meanings for the audience. Due to the meticulously constructed public personae of many celebrities – particularly movie stars and sport icons – the ‘semiotic sign’ of these well-known individuals is usually

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interpreted by the audience to represent a defined cluster of affective meanings.\(^{97}\) What is pertinent for this thesis is how the *symbolic* value of the social significance of celebrities to the audience – regardless of how they have achieved their well-knownness – translates into an *economic* value in a cultural economy where celebrity-related information, images, performances and goods are produced and consumed.

Although disagreements may arise as to the specific social values or attributes a particular celebrity may signify, there is a consensus amongst cultural studies scholars that celebrities are semiotic signs, as much as they are commodities possessing intrinsic economic value. Typically, movie stars are represented as objects of aspiration, glamour and desire, and celebrity athletes signify heroism, human transcendence and a love for the pure authentic game.\(^{98}\) In movies, the celebrities are portrayed as ‘figures that embody in terms of contemporary references maximum states of age, beauty [and] strength’\(^{99}\) and in many examples, the audience tend to associate the semiotic signs of different celebrities as representing these attributes from their screen personae.\(^{100}\) In sport, Nike’s emotional representations of Michael Jordan as the premier global celebrity express his personality as

an attitude composed of intensity of purpose and desire, focus, and confidence … [and the man as] a sophisticated muse – a man who knows himself and appears at one with himself, a man who demonstrates that the exercise of will enables transcendence of circumstance.\(^{101}\)

Michael Jordan’s celebrity personality took on a life of its own as the combination of outstanding basketball talent, illuminated and amplified by media coverage and

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98 See discussion in Chapter 2 Part IIIB.


100 For example, Marilyn Monroe signifies glamour and sexual desirability and Charlton Heston is associated with masculine beauty and heroism. Charlton Heston has been said to ‘mean’ Charlton Heston ‘regardless of what the film is trying to do with him’ and ‘his presence in any films whatsoever suffices to create beauty’. Dyer, ibid 131. See also Richard Dyer, *Heavenly Bodies: Film Stars and Society* (2nd ed, 2004) 17-63 (a discussion of Monroe and representations of sexuality); Grant McCracken, ‘Marilyn Monroe, Inventor of Blondness’ in Grant McCracken, *Culture and Consumption II: Markets, Meaning and Brand Management* (2005) 93.

commercials that emphasised his ‘transcendent skill and iron determination’, elevated him to the position of a unique transnational cultural icon.  

Similarly, it has been observed that ‘in a time of increasing racial polarization along social and economic lines, Tiger Woods emerged as a popular icon from whom the American populace could derive a sense of intimacy, pride, and reassurance.’ Therefore, when Jordan’s or Woods’ identity is used in association with a product, the commercial producer is understood to be seeking to imbue the related commodities with the symbolic meanings of these celebrities.

Generally, a particular celebrity will assert his or her individual values by using ‘personification’ to cultivate an individual image which acts as what Barry King calls ‘personal monopoly’ – the bid by the celebrity ‘to represent a set of meanings which are uniquely marketable’ to consumers. As Stuart Hall points out:

> It is this set of decoded meanings which ‘have an effect’, influence, entertain, instruct or persuade, with very complex perceptual, cognitive, emotional, ideological or behavioural consequences.

For example, the celebrity signs of Vanna White, Rosa Parks or Jacqueline Kennedy Onassis, as articulated through widely distributed photographic and televisual images, carry certain semiotic meanings for the audience. As noted in Chapter 2, consumers have

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been observed to relate to objects in their total signification, and in an advertisement, the encoded meanings – which include the celebrity sign, the linguistic message and other coded and non-coded iconic messages – have to be decoded by the audience. Every use of a celebrity sign in a commercial context – like in the case of White in a Samsung advertisement, Parks’ name in the title of an OutKast song or an Onassis-lookalike in a Christian Dior advertisement – ‘connotes a quality, situation, value or inference, which is present as an implication or implied meaning, depending on the connotational positioning.’ In Parks, the Sixth Circuit observed that the plaintiff was ‘an international symbol of freedom, humanity, dignity and strength’; while in Onassis, the court noted that Onassis was a ‘historic archetype’ who possessed ‘qualities of charisma, sophistication, elegance, trend-setting and uniqueness’. It is these connotational symbolic meanings and qualities that may influence consumers to purchase the OutKast record or Christian Dior products. Thus the celebrity as a commodity is symbolically ‘consumed’ by the audience through the physical consumption of products closely associated with the celebrity.

However, most writings in cultural studies that examine the role of celebrity in economic consumption tend to be dialectical in nature and do not provide much empirical evidence regarding whether the meanings that consumers associate with the celebrity sign do eventually transfer to the products that a particular celebrity is associated with and subsequently increase consumption of these products – thus endowing the celebrity

110 White I, 971 F 2d 1395 (9th Cir, 1992).
113 Hall, ibid 133. In the parlance of Hall, it may be said that objective of advertisers is to use the celebrity sign in a ‘dominant-hegemonic position’ so that consumers ‘operating inside the dominant code’ will decode the message in terms of the advertisers’ reference code in which it has been encoded. The desired effect of this idealised symmetrical decoding will be the consumption of the products perceived to be associated with the celebrity sign. Ibid 136. See also Sut Jhally, The Codes of Advertising: Fetishism and the Political Economy of Meaning in the Consumer Society (1990).
identity with ‘commercial value’. While these critiques tend to focus on the significance of signs and present a poststructural reading of their social, cultural and political impact on society, the empirical research undertaken in the areas of marketing and consumer behaviour is instructive in supporting some of the assertions made in cultural studies regarding the consumption of the celebrity commodity. In the cultural studies tradition, Dyer’s influential work in *Stars*, while explaining how the celebrity sign is embedded with cultural meanings for audiences, unfortunately made only a passing reference to celebrities as ‘idols [of consumption] expressing in ideological form the economic imperatives of society’, without significant discussion of the nature of their economic value. Later, David Marshall, in his investigation of the general public’s desire to associate with celebrities, contends that celebrities function in consumer culture as a ‘connecting fiber’ and an ‘affective link’ between commodity production and ‘the meaning that is bestowed on consumer objects’. Marshall, adopting Hans Robert Jauss’ approach to integrating cultural factors into the reading of a text, has studied the different forms of identification – admiring, sympathetic and associative – relevant to the film, television and popular music celebrity and how studios, advertisers and merchandisers have harnessed the affective power of these celebrities for commercial gain. Chris Rojek, in his cultural studies critique of how ‘capitalism requires consumers to develop abstract desire for commodities’, also points out that the contemporary celebrity ‘embodies desire’ and ‘provides consumers with compelling standards of emulation.’ Similarly, Graeme Turner agrees that celebrities in different fields like cinema, sport,


117 ‘Consumer research’ generally refers to ‘the study of consummation’ or the study of consumer behaviour in ‘attaining customer value or achieving satisfaction’. It has been suggested that consumer research is a separate discipline, although borrowing from the fields of economics, psychology, philosophy, sociology and more recently, cultural studies. Eg Morris B Holbrook, *Consumer Research: Introspective Essays on the Study of Consumption* (1995) 86-99.

118 Dyer, above n 97, 42.


121 Eg Marshall, ibid 100-17, 143-7, 165-73 (discussing Tom Cruise, Oprah Winfrey and New Kids On The Block).

122 Rojek, above n 97, 187.
popular music and television carry different ‘cultural content’ with each ‘operat[ing] within a different semiotic economy’. 123

In summary, Dyer, Marshall, Rojek, Turner and other cultural scholars have collectively provided a useful conceptual framework on the semiotic significance of the celebrity sign in relation to culture and consumption for further empirical research. The next section will discuss how the complementary works of Grant McCracken, 124 Jib Fowles 125 and Jagdish Sheth et al 126 in the area of consumer research have extended the cultural studies scholarship and the contribution they can make to a legal understanding of when the associative value of identity has been appropriated.

B The Associative Value of the Celebrity and the Meaning Transfer Effect

Courts have long acknowledged that an individual’s identity is ‘commercially valuable … only because the public recognizes it and attributes goodwill and feats of skill or accomplishments of one sort or another to that personality.’ 127 If the semiotic sign of the celebrity connotes particular positive characteristics and values as perceived by the audience, like in the examples of the celebrities highlighted in Section A, then it follows that these characteristics and values can be transferred to the products that the celebrity is associated with. This Section examines how the economic value of identity is realised in the consumption process, and proposes a legal test for determining an appropriation of the commercial value of identity that is guided by this understanding of contemporary consumption.

123 Turner, Understanding Celebrity, above n 97, 14-5.
124 McCracken, above n 95.
127 Uhlaender, 316 F Supp 1277, 1283 (D Minn, 1970). See also Lagosi, 25 Cal 3d 813, 824 (1979) (‘the reaction of the public to name and likeness … endows the name and likeness of the person involved with commercially exploitable opportunities’).
1 Impact on the Audience’s Consumption Decisions

In 1989, the seminal article by Grant McCracken, building on the ‘source models’ previously propounded by Carl Hovland and William McGuire, connected empirical social, psychological and economic research with the writings in cultural studies on the semiotic meanings of celebrities. In studying endorsements by celebrities like Bill Cosby, John Wayne and Ringo Starr for particular products, he points out that a celebrity individual is ‘persuasive’ to consumers because he or she is ‘made up of certain meanings that the consumer finds compelling and useful’ with respect to them making a consumption decision. Thus McCracken posits a ‘meaning transfer model’ comprising three stages. McCracken appears to draw significantly from cultural studies when he argues that the meaning of class, status, gender, age, personality and lifestyle types as embodied by the semiotic sign of the celebrity ‘begins as something resident in the culturally constituted world’ (Stage 1) and ‘then moves to consumer goods’ when used in conjunction with a product (Stage 2). The ‘cultural circuit of the movement of meaning is complete’ when consumers perceive these goods not as commodities of utility but also as bundles of meanings with which to construct their social identity’ (Stage 3). In summary, the endorsement process depends upon the symbolic properties of the celebrity endorser. Using a ‘meaning transfer’ perspective, these properties are shown to

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131 McCracken, above n 95, 311.

132 Ibid 312.

133 Ibid 313.

reside in the celebrity and move from celebrity to consumer good and from good to consumer.\textsuperscript{135}

The initial affective relationship between the celebrity and the audience translates to an economic one between the celebrity/product and the audience/consumer. It is at Stage 2 that the actionable commercial appropriation occurs as this is the point in the consumption process where the celebrity’s persona is ‘transferred’ into the product, thereby realising the potential economic value through its associative use.\textsuperscript{136} Affirming McCracken’s analysis, research by Shekhar Misra and Sharon Beatty found that consumers tend to rate a product as better or of higher quality if it was seen to be endorsed by a congruent celebrity:

[R]ecall of brand information is significantly higher when the [celebrity] spokesperson is congruent with the brand … when the celebrity spokesperson is congruent with the brand, a transfer of affect takes place.\textsuperscript{137}

In his study of advertising and popular culture, Fowles also observed that in exemplifying relevant social norms, celebrities enjoy ‘a sort of equity that advertisers can only eye covetously.’\textsuperscript{138} It is worth noting that each celebrity has his or her own unique set of characteristics and connotational meanings; and different celebrities have different

\textsuperscript{135} McCracken, above n 95, 310. McCracken lists four types of celebrity endorsements: (i) explicit mode (‘I endorse this product’); (ii) implicit mode (‘I use this product’); (iii) imperative mode (‘You should use this product’) and (iv) copresent mode (in which the celebrity appears with the product). McCracken’s defining works on the cultural meaning of consumption combines particular aspects of cultural studies with economic analysis, and have been oft-cited in journals on advertising, marketing and consumer research. See also Grant McCracken, Culture and Consumption II: Markets, Meaning and Brand Management (2005); Grant McCracken, Culture and Consumption: New Approaches to the Symbolic Character of Consumer Goods and Activities (1990). This flow of meaning from the celebrity to the product is not just a theoretical concept but has been empirically measured. See Walker et al, above n 95.

\textsuperscript{136} See Lugosi, 25 Cal 3d 813, 834-5 (1979). See also above nn 19-20, 84 and accompanying text.


\textsuperscript{138} Fowles, above n 95, 119. He also affirms McCracken’s thesis of meaning transfer in consumption. Ibid 127-31.
associative values. Generally, celebrity endorsements result in better product sales only when consumers feel that whatever cultural meanings attached to the celebrity can shift along unimpeded paths from the celebrity to the product. Advertisers often ‘deploy a [celebrity] signifier, already conventionally related to a mental concept they wish to attach to their product, as a means of providing their product with that meaning.’ In the ‘copresent’ mode popular with many advertisers today, a direct endorsement by the celebrity as spokesperson is not necessary for the meaning transfer to take place, and this is evident in the contemporary advertising practices of successful brands like TAG Heuer, Louis Vuitton and Nike that utilise the copresent mode. Often the juxtaposition or mention of a celebrity in connection with a product is sufficient for the audience to ‘decode’ the semiotic meaning and make the affective link between the celebrity and the product. By consuming the product, consumers seek to attach this ‘iconic logo’ to themselves, hoping that their bodies and their environments might ‘reflect some of the [cultural] ideas … encapsulated.’

According to a study on consumption values by Sheth et al, the use of the celebrity personality in advertising would be seen to increase the emotional and social consumption values of brands. The associative value of the celebrity identity is realised when the enhanced emotional and social consumption values of brands translate to improved sales and customer loyalty. These observations suggest that the value of identity is appropriated by the defendant only when the products, to which have been

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140 Turner, above n 134, 15 (discussing semiotics in practice).

141 This is where the advertisement simply depicts the celebrity next to the product with no explicit endorsement text. See above n 135. See also Uche Okonkwo, Luxury Fashion Branding: Trends, Tactics, Techniques (2007) 156-64; Brian D Till and Michael Busler, ‘Matching Products with Endorsers: Attractiveness versus Expertise’ (1998) 15 Journal of Consumer Marketing 576.


transferred the positive semiotic meanings associated with the celebrity, are perceived to be more attractive by consumers. Cultural studies scholar Jonathan Gray observes that advertisements have become masters of semiotics … engaging in careful and ingenious encoding at the level of connotation and mythology … Advertisers, of course, use stars’ names to cash in on the trust, respect, affect, and/or adulation that people have for them.¹⁴⁴

Indeed, an Australian court has acknowledged that ‘[a]n association of some desirable character [or celebrity] with the product proceeds more subtly to foster favourable inclination towards it, a good feeling about it, an emotional attachment to it.’¹⁴⁵ Similarly, the English courts have also noted that ‘those in business have reason to believe that the lustre of a famous personality, if attached to their goods or services, will enhance the attractiveness of those goods or services to their target market.’¹⁴⁶

To audiences who have a positive affective relationship with the celebrity, a product that is merely juxtaposed with the celebrity can embody desire and represent a compelling standard of emulation.¹⁴⁷ For example, in Onassis,¹⁴⁸ the defendant in choosing an Onassis-lookalike for the advertisement, gains a commercial benefit because, unlike a generic beautiful model, Onassis is ‘a kind of exemplary inspirational figure to the consumer’¹⁴⁹ and the consumer is persuaded to buy the product because he or she identifies with the symbolic meaning of the Onassis personality. In Carson¹⁵⁰ and Motschenbacher,¹⁵¹ it may also be argued that the use of a well-known phrase as the name of a product and a distinctive racing car in an advertisement are merely exploitative

¹⁴⁵ Pacific Dunlop Ltd v Hogan (1989) 23 FCR 553, 583-4. The defendant was found liable in passing off for evoking the plaintiff’s screen persona in advertisements. Arguably, like George McFarland and the Spanky character in McFarland v Miller, Paul Hogan’s public persona was inextricably identified with the Crocodile Dundee character he played in the movies. According to Burchett J, ‘[n]o logic tells the consumer that [the] boots are better because Crocodile Dundee wears them for a few seconds on the screen … but the boots are better in his eyes, worn by his idol.’ Ibid 584. See also David Tan and J Thomas McCarthy, ‘Australia – Protecting goodwill and reputation’ in McCarthy, above n 30, § 6:158.
¹⁴⁶ Irvine v Talksport Ltd [2002] 1 WLR 2355, 2368.
¹⁴⁷ Rojek, above n 97, 187.
¹⁴⁹ McCracken, above n 95, 317.
¹⁵⁰ 698 F 2d 831 (6th Cir, 1983).
¹⁵¹ 498 F 2d 821 (9th Cir, 1974).
devices that the commercial defendants have chosen primarily for their desirable symbolic properties to deliver the salient selling message to consumers. If the consumption values of the defendant’s product have been directly and substantially enhanced by the use of the plaintiff’s identity, then the defendant has obtained a commercial benefit, and this would constitute an infringement of the right of publicity.

2 The Application of a ‘Direct and Substantial Connection’ Standard

This Chapter has so far demonstrated that it is the positive connotational meanings of a particular celebrity as perceived by the audience, and the affirmative consumption response of the audience because of this affective relationship, which confer on that identity an economic value when used in association with goods and services. As Part II has explained, not all uses of a celebrity’s identity in a commercial context are uses of its associative value. It is not identity per se that the right of publicity aims to protect, but the associative value of identity.

Drawing on the insights regarding the meaning transfer from the celebrity semiotic sign to the products that the sign is associated with, this thesis proposes that in a common law right of publicity claim, the relevant inquiry for the courts when evaluating whether an appropriation has taken place should be: Is the commercial benefit sought by the defendant directly and substantially connected to the associative value of the plaintiff’s identity?\(^\text{152}\) The application of this proposed standard follows from the argument that there is ‘commercial appropriation’ because something of value was taken from the plaintiff as a result of the defendant transferring or siphoning some of the value of the plaintiff’s identity into the product.

\(^{152}\) This proposed test finds support in a similar formulation suggested by Lee Hetherington who argued that the ‘protectability of a celebrity’s identity involves a requirement that the unauthorized usage be both direct in nature and primarily commercial in its motivation’ as this ‘relates to the nexus between the specific personality usage and purpose served, and not to the manner or extent of the usage.’ Hetherington, above n 8, 32. It is also supported by the ‘direct connection’ test in CCC § 3344(e) and § 3344.1(k) and the ‘incidental use exception’ for insignificant and fleeting uses under New York law. See McCarthy, above n 30, §§ 6:31, 6:90; Aligo v Time-Life Books Inc, 1994 WL 715605 (ND Cal, 1994); Clark, 2000 WL 33535712 (CD Cal, 2000); Smith v NBC Universal, 524 F Supp 2d 315, 329 (SD NY, 2007) (‘Smith’); Donahue, 2002 WL 523407 (SD NY, 2002). For similar considerations in other jurisdictions like Arizona, Florida, Maryland, Missouri and New Jersey, see, eg, Pooley, 89 F Supp 2d 1108 (D Ariz, 2000); Epic Metals Corp v CONDEC Inc, 867 F Supp 1009 (MD Fla, 1994); Comins, 200 F Supp 2d 512 (D Md, 2002); Doe, 110 SW 3d 363, 371 (Mo banc, 2003); Prima v Darden Restaurants Inc, 78 F Supp 2d 337 (D NJ, 2000).
The threshold question is whether the use of identity was fleeting, transitory or insignificant with a de minimis commercial implication;\(^\text{153}\) as discussed in Part II above, such incidental uses do not take anything from the value of the plaintiff’s identity\(^\text{154}\) and the defendant would not have made any direct or substantial use of the associative value of the plaintiff’s identity. If the answer is yes, then there is no commercial appropriation. If there was a prominent use of the celebrity identity – whether name, likeness or other evocative aspects of identity – in the defendant’s advertisement or product, then the court should require the plaintiff to prove by adducing relevant evidence that the defendant’s actual or intended pecuniary gain was directly and substantially connected to the exploitation of the associative value of the plaintiff’s identity.

The proposed test also has support from the dicta expressed in recent cases. In \textit{Matthews v Wozencraft}, the Fifth Circuit has required the plaintiff to prove, inter alia, that the defendant appropriated the plaintiff’s identity ‘for the value associated with it’ and ‘not in an incidental manner’, and that the defendant has gained some ‘advantage or benefit’.\(^\text{155}\) The California Supreme Court, in \textit{Winter v DC Comics}, has explained that ‘if the marketability and economic value of the challenged work do not derive primarily from the celebrity’s fame, “there would generally be no actionable right of publicity.”’\(^\text{156}\) In \textit{Zoll v Ruder Finn}, a New York court, citing Second Circuit authorities, dismissed the plaintiff’s claim for failing to show ‘a causal connection between the [d]efendants’ actionable unauthorized uses of her image and specific sales’.\(^\text{157}\)

Finally, the proposed ‘direct and substantial connection’ standard when applied to cases considering incidental use is likely to yield the same results, since fleeting and insignificant uses of the plaintiff’s identity like in \textit{Moglen} and \textit{Rand} will not have a direct

\(^{153}\) For example, brief mention of a name in a printed interview, use of a name as a minor character in a comic book or a brief glimpse of a person in a film. See McCarthy, above n 30, §§ 6:31, 7:20.

\(^{154}\) See accompanying text to above nn 79 and 86.

\(^{155}\) \textit{Matthews}, 15 F 3d 432, 437 (5\textsuperscript{th} Cir, 1994). See also \textit{Almeida v Amazon.com Inc}, 456 F 3d 1316, 1326 (11\textsuperscript{th} Cir, 2006).

\(^{156}\) 30 Cal 4th 881, 889 (2003) (‘Winter’) (quoting \textit{Comedy III}, 25 Cal 4th 387, 407 (2001)). See also \textit{Smith}, 524 F Supp 2d 315, 325 (SD NY, 2007) (applying California law) (the market would not have paid Smith any consideration for his appearance in the portions of the video as the commercial value of the defendant’s product was not enhanced by the use of the plaintiff’s identity).

\(^{157}\) \textit{Zoll}, 2004 WL 527056 *5 (SD NY, 2004) (citing \textit{Big Seven Music Corp v Lennon}, 554 F 2d 504, 510 (2\textsuperscript{nd} Cir, 1977); \textit{Davis v Gap Inc}, 246 F 3d 152, 159 (2\textsuperscript{nd} Cir, 2001)).
and substantial connection to the defendant’s intended or actual commercial benefit.\textsuperscript{158} As the media and artistic use exceptions were designed to give effect to First Amendment values that protect the freedom of press and speech, they would more appropriately be dealt with either under the First Amendment defence or as specific exempt categories of use as opposed to being treated as incidental uses. Thus an unauthorised use of identity in an advertisement for a newspaper, artistic work or entertainment program may be directly and substantially connected to the defendant gaining a benefit, but the defendant may ultimately escape liability because of a successful plea of the First Amendment defence.

(a) \textit{Name and Likeness Cases}

In the unauthorised commercial use of name and likeness cases discussed in Chapter 3 Part II – like \textit{Doe, Abdul-Jabbar, Hirsch, Newcombe} and \textit{Onassis} – the courts have either decided in favour of the plaintiff or allowed the claims to proceed to trial. For example, in \textit{Doe}, the defendants based a major comic character on a well-known hockey player and marketed the product directly to the plaintiff’s fan base.\textsuperscript{159} In \textit{Onassis}, the defendants hired a celebrity-lookalike to capitalise on the desirable qualities embodied by Jacqueline Kennedy Onassis for their advertisement.\textsuperscript{160} It is clear in these cases that the defendants had sought to transfer the symbolic properties associated with the celebrity plaintiffs to their products either through the use of their identities in advertising or directly in the creation of the products. In 2007, the Eighth Circuit, in considering the use of the identities of baseball players in an internet fantasy baseball game, pointed out that the defendant’s use there ‘does not fit neatly into the more traditional categories of commercial advantage, namely, using the individuals’ names for advertising and merchandising purposes in a way that states or imitates that the individuals are endorsing a product.’\textsuperscript{161} However, a direct and substantial connection would have been made out as the court found that players’ identities were clearly used by the defendant ‘for purposes of profit … [and] for commercial advantage’.\textsuperscript{162}

\textsuperscript{158} Eg \textit{Moglen}, 213 NYS 2d 999 (1961); \textit{Rand}, 298 NYS 2d 405 (1969); \textit{Preston}, 765 F Supp 116 (SD NY, 1991); \textit{Comins}, 200 F Supp 2d 512 (D Md, 2002). As explained in Part IIA, this category of cases should not include those concerning media and artistic use exceptions. See above nn 79-83 and accompanying text.

\textsuperscript{159} \textit{Doe}, 110 SW 3d 363, 366-71 (Mo banc, 2003).


\textsuperscript{161} \textit{CBC}, 505 F 3d 818, 822 (8th Cir, 2007).

The use of the proposed ‘direct and substantial connection’ standard enables courts in certain circumstances to dispose of a claim without the need to engage in First Amendment considerations. For example, the Ohio Court of Appeals has held that the use of an Olympic gold medalist’s name and likeness on a series of promotional drinking cups was not an appropriation of identity as the use ‘within the context of accurate, historical information was incidental to the promotion of the Dixie Cups by the partnership between the Minute Maid Corporation and the United States Olympic Committee.’\textsuperscript{165} It is arguable that through the licensing arrangement with the US Olympic Committee, the defendant has sought to transfer the positive connotational meanings of the Olympic Games to its products, and the listing of athletes who have achieved Olympic success in this context is not directly or substantially exploiting the affective relationship between the athletes and the audience; it obviates the need for the court to consider whether the plaintiff’s proprietary interest in identity is trumped by the First Amendment’s protection of newsworthy information. Similarly, in disposing of the plaintiffs’ statutory claim, the California Court of Appeal found that a textbook which reprinted an article containing the plaintiffs’ names and likenesses had used it as ‘an educational tool’; it was neither ‘a primary reason for the textbook’ nor ‘was it a substantial factor in the students’ purchases of the book’.\textsuperscript{164} Indeed the evidence showed that the defendants did not seek to make use of the associative value of the plaintiffs’ identity and the direct and substantial connection standard clearly has not been fulfilled.

In particular, the court in \textit{Elvis Presley Enterprises v Capece} commented that there is no appropriation ‘without the intent or effect of exploiting [the plaintiff’s] identity or persona’.\textsuperscript{165} While the court held that the use of images of Elvis Presley in the advertisements to promote ‘The Velvet Elvis’ – a bar operated by the defendant – was an infringement of the plaintiff’s publicity rights, the use of the name ‘The Velvet Elvis’ and Elvis memorabilia as décor were not commercial appropriations.\textsuperscript{166} The decision implicitly suggests a recognition that the associative value of Elvis Presley’s celebrity

\begin{footnotesize}
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\item[165] Capece, 950 F Supp 783, 802 (SD Tex, 1996).
\item[166] Ibid 801-2.
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persona has not been transferred to the defendant’s bar when the court opined that ‘the function … is not to promote a product or capitalize on the personality of Elvis himself but rather to create an era of which Elvis was a public part.’\textsuperscript{167} Under Hetherington’s ‘direct commercial exploitation’ approach, he would have classified such a use as ‘merely draw[ing] on a performer’s popularity in a general or generic manner without directly pirating his identity … [which is] incidental and, therefore, collateral to the celebrity interest’;\textsuperscript{168} a similar conclusion would be reached under the proposed direct and substantial connection standard.

Finally, there is the intractable problem of resolving the conflict between copyright preemption and the right of publicity.\textsuperscript{169} There has been significant discussion of the issues involved,\textsuperscript{170} but it is not within the scope of this thesis to consider them. In determining the plaintiffs’ common law right of publicity claim in Wendt, the Ninth Circuit held that the ultimate issue was for the jury to decide ‘whether the defendants were commercially exploiting the likeness of the [animatronic] figures to Wendt and Ratzenberger intending to engender profits to their enterprises.’\textsuperscript{171} But the majority does not adequately discuss whether Host International was in fact exploiting the associative value of the \textit{Cheers} program in its use of animatronic figures in the \textit{Cheers} airport bars built to resemble the pub in the television program\textsuperscript{172} and whether the reproduction of the characteristics that bring the plaintiffs to mind in the context of the bars, like the Velvet Elvis Bar in \textit{Capece},\textsuperscript{173} were only intended to recreate the bonhomie ambience that fans of the television program identified with. The court ought to have awarded summary judgment to the defendant as the defendant held a valid copyright licence and had

\begin{footnotesize}
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    \item \textsuperscript{167} Ibid 802.
    \item \textsuperscript{168} Hetherington, above n 8, 36.
    \item \textsuperscript{169} Eg \textit{Laws v Sony Music Entertainment Inc.}, 448 F 3d 1134 (9th Cir. 2006); \textit{Stanford v Caesars Entertainment Inc.}, 430 F Supp 2d 749 (WD Tenn, 2006); \textit{Toney}, 406 F 3d 905 (7th Cir. 2005); \textit{Landham}, 227 F 3d 619 (6th Cir, 2000); \textit{Wendt II}, 197 F 3d 1284 (9th Cir. 1999); \textit{Baltimore Orioles Inc v Major League Baseball Players Association}, 805 F 2d 663 (7th Cir. 1986).
    \item \textsuperscript{171} \textit{Wendt I}, 125 F 3d 806, 811 (9th Cir, 1997).
    \item \textsuperscript{172} The defendant has secured the relevant licence from Paramount, the copyright holder, which carries with it the right to make derivative works based on its character. See Kozinski J’s dissent in \textit{Wendt II}, 197 F 3d 1284, 1285-6 (9th Cir, 1999).
    \item \textsuperscript{173} See above nn 165-167.
\end{itemize}
\end{footnotesize}
avoided the use of the plaintiffs’ names and images in the bars. As Kozinski J correctly pointed out, ‘Host did not plaster Wendt’s face on a billboard with a Budweiser logo. It cashed in on the Cheers goodwill by creatively putting its familiar mise-en-scene to work.’ Thus this thesis contends that there was no commercial appropriation in Wendt as the benefit sought by the defendant was not directly and substantially connected to the associative value of the plaintiffs’ identity.

(b) Other Evocative Aspects of Identity Cases

In the evocative of identity cases examined in Chapter 3 Part II, the defendants have made use of different indicia of identity that included voice, characterisation and other distinctive attributes of the plaintiffs in a commercial context. As Hetherington explains, where the celebrity identity has been merged into a product – for example in Carson (a range of portable toilets adopts as its brand name a famous phrase associated with Johnny Carson) and McFarland (a restaurant is named after the screen persona inextricably identified with the celebrity) – this is the ‘clearest illustration of direct commercial exploitation’ because the star quality of the celebrity has been transferred into the product by evoking attributes of the celebrity’s identity. Where the celebrity identity is associated with the product like the use in advertisements, the defendant’s intent is usually to ‘translate the performer’s popularity with a large and clearly identifiable group of consumers into a high volume of product sales.’ In cases like Midler, Waits, Motschenbacher and Lombardo, the defendants have deliberately evoked the plaintiffs’ personae in the advertisements, and from the evidence, it appears that the defendants intended to influence the consumption decisions of the target audience.

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174 Courts have been more reluctant to find preemption of the right of publicity for the commercial use of a picture or photograph. Eg Downing, 265 F 3d 994, 1005 (9th Cir, 2001); Toney, 406 F 3d 905, 910 (7th Cir, 2005). The plaintiffs could arguably have a right of publicity claim if the defendant had used cardboard cutout figures of their likeness or robots moulded to their exact facial features in the bars. In such a scenario, the ‘plaintiffs’ right to control the commercial exploitation of their likeness [should not be] preempted by Paramount’s right to exploit the Norm and Cliff characters however it sees fit’. Cf Wendt II, 197 F 3d 1284, 1287 (9th Cir, 1999). A settlement was reached in 2001, but the terms were never made public.


176 Hetherington, above n 8, 33.

177 McCracken, above n 95, 310-4.

178 Ibid 34.
through exploiting their affective relationship with the particular celebrities evoked. The proposed direct and substantial connection standard would be easily satisfied.

In part, the controversy generated by the Ninth Circuit’s decision in *White v Samsung* is precisely because of the court’s superficial treatment of whether, despite the identification of Vanna White from the advertisement, the defendant in fact ‘appropriated’ the commercial value of White’s identity by gaining a commercial advantage from Vanna White’s celebrity persona. In *White*, the defendants Samsung and its advertising agency David Deutsch Associates (DDA) created a series of print advertisements with a national circulation. In what the defendants referred to as the ‘Vanna White’ ad, a robot was depicted dressed in a wig, gown, and jewellery, and posing next to a game board which was instantly recognisable as the *Wheel of Fortune* game show set. The caption of the advertisement read: ‘Longest-running game show. 2012 A.D.’ In the accompanying advertisement on the facing page, a futuristic shot of Samsung’s electronic equipment was depicted with the caption, ‘The VCR you’ll tape it on. 2012 A.D.’ The principal features of the *White* advertisement were:

Each of the advertisements in the series followed the same theme. Each depicted a current item from popular culture and a Samsung electronic product. Each was set in the twenty-first century and conveyed the message that the Samsung product would still be in use by that time. By hypothesizing outrageous future outcomes for the cultural items, the ads created humorous effects.

The *White* majority, citing only three cases to illustrate how the defendant’s actions in each ‘directly implicated the commercial interests which the right of publicity is designed to protect’, failed to adequately examine whether the associative value of Vanna White’s identity has been exploited by Samsung. In their haste to prevent ‘the

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179 *White I*, 971 F 2d 1395, 1396 (9th Cir, 1992).
181 *White I*, 971 F 2d 1395, 1396 (9th Cir, 1992).
182 Ibid 1398 (considering *Motschenbacher*, 498 F 2d 821 (9th Cir, 1974); *Carson*, 698 F 2d 831 (6th Cir, 1983); *Midler*, 849 F 2d 460 (9th Cir, 1988)).
evisceration of the common law right of publicity’, the majority appeared to have equated evocative identification with the gaining of a commercial advantage and hence the appropriation of the value of White’s identity. Arguably, White is very different from Motschenbacher (where the defendant intentionally preserved the ‘distinctive decorations’ of the racing car that identified the plaintiff), Midler (where the defendant deliberately ‘used an imitation to convey the impression that Midler was singing for them’ after she had earlier refused to do so) and Carson (where the defendant admitted that he knew ‘the public tends to associate the [phrase with Carson] and probably absent that identification, he would not have chosen it’). In these three cases, the defendants clearly intended to transfer the positive connotational meanings of the individual celebrities to their products (McCacken’s Stage 2) and to induce customers to buy these products perceived to be associated with the celebrities. Regrettably, the dissenting judgments of Alarcon J and Kozinski J, regarding the denial for en banc hearing, overlooked a legal analysis of whether the value of White’s identity has been appropriated, and focused mainly on two issues: the overly broad evocation of identity standard and the application of the First Amendment.

Samsung’s series of ads was a lampoon of outcomes for the future. Despite the defendants internally referring to the ad as the ‘Vanna White’ ad instead of the ‘Wheel of Fortune’ ad, the primary focus of the advertisement was on evoking the consumers’ recognition of the Wheel of Fortune show, and the evocation of White was incidental. Commentators like David Welkowitz have also pointed out that ‘[n]ot all uses of a

\[\text{183} \quad \text{Ibid 1399.}\\ 
\text{184} \quad \text{Motschenbacher, 498 F 2d 821, 827 (9th Cir, 1974).}\\ 
\text{185} \quad \text{Midler, 849 F 2d 460, 463 (9th Cir, 1988).}\\ 
\text{186} \quad \text{Carson, 698 F 2d 831, 836 (6th Cir, 1983).}\\ 
\text{187} \quad \text{See above n 128-135 and accompanying text.}\\ 
\text{188} \quad \text{White I, ibid 1402-8 (Alarcon J); White II, 989 F 2d 1512, 1512-21 (Kozinski J) (9th Cir, 1993). In particular, Kozinski J’s hyperbolic language has provoked a direct rebuttal from McCarthy for construing the First Amendment as ‘a hurricane of a legal concept, which blows away all personal torts and property rights.’ J Thomas McCarthy, ‘Is Vanna White Right and Judge Kozinski Wrong?’ in McCarthy, above n 30, App A.}\\ 
\text{189} \quad \text{Kozinski J points out that it is the game board and not White that is the hallmark of the Wheel of Fortune show. White II, 989 F 2d 1512, 1515 (9th Cir, 1993) (‘Remove the game board from the ad, and no one would think of White … But once you include the game board, anybody standing beside it – a brunette woman, a man wearing women’s clothes, a monkey in a wig and gown – would evoke White’s image, precisely the way the robot did.’). It may also be argued that Samsung had used White ‘only as a symbol or metaphor for the concept of durability’ and there was ‘no use of White’s image’. Franke, above n 49, 981. See also Arlen W Langvardt, ‘The Troubling Implications of a Right of Publicity “Wheel” Spun Out of Control’ (1997) 45 University of Kansas Law Review 329, 423.}
celebrity constitute wrongful appropriation”, and White was a case where the defendant did not seek ‘to associate the positive values of the celebrity with the product’ but only used the evocation ‘merely [as] a point of reference’ to the Wheel of Fortune. The total context of the paired ads – with the slogans asserting that it was the Wheel of Fortune as the ‘Longest-running game show’ that a Samsung VCR was going to be used to ‘tape it on [in] 2012 A.D.’ – suggests that it was not the use of White’s identity, but the evocation of the Wheel of Fortune show that was a significant contribution to the defendant’s commercial purpose. The appeal of Samsung to the consumer lies not in its association with Vanna White but with the popular game show. As highlighted in Part II, this may be a scenario where, in addition to humour, the defendant was exploiting the associative value of another ‘property’ – by relying on the connotational meanings of the Wheel of Fortune show – and not the celebrity identity in order to gain a commercial advantage.

Furthermore, White ‘offered no evidence that any portion of the consuming public was deceived.’ Although this is more relevant to a Lanham Act false endorsement claim, the lack of any evidence here – even a mere possibility of some confusion as to White’s connection with Samsung – strongly suggests that the transfer of affective value from the celebrity evoked to the defendant’s product has not occurred. On balance, the overall use of humour, parody and satire in the entire print campaign that portrays Samsung as ‘The future of electronics’ and the lack of any evidence of consumers responding to White’s possible association with Samsung suggests that any commercial benefit gained by the defendant was not directly and substantially connected to White’s identity. Perhaps this is the occasion where ‘the clever advertising strategist [has] come

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191 Welkowitz, ibid 79-80. See also Weiler, ibid 271 (“advertisers should be able to remind the public of a celebrity, so long as the advertiser does not link the celebrity to the product in order to make the product more desirable”). However, the commercial value of White’s identity may have been ‘taken’ by Samsung ‘if the metallic robot used had a label reading “Vanna W-357693” or if Samsung pictured an android with distinctive Vanna White features.’ Cf McCarthy, above n 30, App A.

192 This raises an issue whether by using a depiction of the program’s set, the relevant copyright holder has an infringement claim against the defendants. Nevertheless, the fair use doctrine is likely to protect the defendants’ parody of the program. Eg Campbell v Acuff-Rose Music Inc. 510 US 569, 579 (1994).

193 Contra McCarthy, above n 30, App A.

194 Eg John Fiske, Reading the Popular (1989) 133-8 (observing that quiz shows like Wheel of Fortune ‘articulates openly the everyday ability of people to detach the pleasures and meanings of spending from the pain and subjection of earning’).

195 White I, 971 F 2d 1395, 1406 (Alarcon J) (9th Cir, 1992).

196 See above nn 135-137 and accompanying text.
up with the tenth [method] that does not appropriate the commercial value of a celebrity’s identity.

IV SUMMARY AND CONCLUSIONS

The concept of ‘commercial appropriation’ in right of publicity jurisprudence is not well-defined and has not benefited from much academic discussion. But not every unauthorised commercial use is an appropriation. This Chapter has argued that judicial inquiry ought to focus on the context of the use, and ask whether the defendant has sought to transfer the star quality of the celebrity, and whatever attributes that the particular celebrity sign might connote, to the product in question.

This Chapter urges a return to first principles where the right of publicity was evolved to prevent unjust enrichment by providing a remedy against the exploitation of the goodwill or reputation that an individual has developed in his or her identity. It has provided a pragmatic framework for the use of cultural studies to assist legal analysis. As Part III has shown, the positive connotational meanings of the celebrity sign are transferred to the products that celebrities are perceived to be associated with, thereby enhancing the attractiveness of these products for consumers. Whether or not one supports the commercialisation or commoditisation of personality, ‘the economy reality persists [that] the market place recognizes an associative value.’ In developing the right of publicity which has been recognised in a majority of states since 1953, the law needs to deal with the phenomenon of celebrity in a coherent and principled fashion. From a cultural studies perspective, supported by empirical research in consumption behaviour, the mere fact that the plaintiff’s identity has been evoked by the defendant in a commercial context is insufficient to constitute appropriation; the defendant must use the identity for the purpose of transferring affective meanings that are associated with the plaintiff hence receiving a de facto celebrity endorsement. Commentators have also argued that ‘the appropriator must be using the celebrity’s image not just to conjure up the celebrity to the viewer, but to project a star quality association between the celebrity

197 White I, 971 F 2d 1395, 1398 (9th Cir, 1992).
198 Halpern, above n 31, 1242-3.
199 Henley, 46 F Supp 2d 587, 597 (ND Tex, 1999). See also Polsby, 1997 WL 680550, 4* (DDC, 1997); Restatement (Second) of Torts § 652C cmt d (1976).
and the advertised product.\textsuperscript{200} As commented in the \textit{Restatement (Second)}, the defendant must have appropriated, to his or her own use or benefit, the value that inheres in the plaintiff’s identity and ‘[u]ntil the value of the [identity] has in some way been appropriated, there is no tort.’\textsuperscript{201}

Thus the unauthorised commercial use of a celebrity’s identity, whether literally or in an evocative manner, does not in every situation appropriate the associative value of a celebrity’s identity. In considering whether a direct and substantial connection exists between the unauthorised use of the plaintiff’s identity and the benefit gained by the defendant, the ‘right of publicity may be bounded intelligently’\textsuperscript{202} with the court properly focused on determining whether an ‘appropriation of the commercial value’ of the plaintiff’s identity has taken place. Where the defendant can provide evidence of humour, irony, ridicule and social comment, the unauthorised commercial use of identity is usually not perceived to be commercial free-riding which a right of publicity claim may vindicate. The audience-consumer does not react to a parody or satire in the same way he or she would react to a literal depiction of the celebrity in an endorsement advertisement designed to enhance the transfer of the affective value of the celebrity to the featured product; the former amuses, the latter seduces. These arguments are often also presented in the context of a First Amendment defence in a right of publicity claim, and the next Chapter will next examine how perspectives in cultural studies can make a meaningful contribution to free speech jurisprudence.

\textsuperscript{200} Welkowitz, above n 190, 93. See also Hetherington, above n 8, 34; Weiler, above n 190, 270-2.
\textsuperscript{201} \textit{Restatement (Second) of Torts} § 652C cmt c (1976).
\textsuperscript{202} Halpern, above n 31, 1255 (arguing that a legal analysis should focus on the commercial interest in the associative value of personality).
This Chapter argues that a use of celebrity identity, in addition to its economic significance in consumption, considered in the previous chapter, may be ‘political speech’ protected by the First Amendment, depending on its content, form and context. While links between celebrity identity and political speech have been raised in existing scholarship that draws on cultural studies, this Chapter uses cultural studies differently from scholars like Rosemary Coombe and Michael Madow who argue against the legal recognition of a right of publicity. As highlighted in Chapter 1, this dissertation starts from the position that since the right of publicity is recognised by a majority of states, it is likely to remain in the law, and a multiperspectival approach to cultural studies can be used to develop current First Amendment jurisprudence relevant to publicity laws.

If a plaintiff has succeeded in proving that he or she has been identified by the defendant’s use (Chapter 3) and that the defendant has appropriated the associative value of his or her identity (Chapter 4), the plaintiff still may have to face the formidable argument by the defendant that the unauthorised commercial use is nevertheless protected by the First Amendment. In the absence of clear US Supreme Court precedent, Circuit and state courts have been struggling to articulate a comprehensive standard to resolve the clash between the right of publicity – widely recognised as a private property right – and free speech values as enshrined in the First Amendment. This has led commentators to propose a number of possible tests to resolve these competing claims, with significant lamentation that the current state of the First Amendment defence is ‘a confusing morass of inconsistent, incomplete, or mutually exclusive approaches, tests, and standards.’ It is important to recognise that this thesis does not purport to resolve all the issues regarding

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the interaction of the right of publicity with the First Amendment. Its objective is to assess how cultural studies can contribute to right of publicity jurisprudence, focusing on what should be the result when a celebrity’s persona is appropriated for expressive uses in identity politics. This Chapter maintains that one can find significant support in cultural studies for an argument that such expressive uses qualify for the highest level of First Amendment protection as political speech.

This Chapter adopts the premise that the underlying rationale of the First Amendment is the advancement of a democracy where the public can freely participate in deliberating issues important to decisionmaking in a democracy (‘participatory democracy’). This is a plausible and well-supported view of the First Amendment. The Chapter further contends that the augmentation of this participatory theory of the First Amendment with cultural studies insights is likely to lead to better outcomes in cases because more speech of ‘greater’ constitutional value is protected – i.e. speech that contributes to an increased awareness and debate of public issues – while speech of ‘lesser’ value need not be accorded the same level of protection.

Part I will show that First Amendment jurisprudence, especially Supreme Court decisions, supports an overarching approach to the First Amendment in terms of a participatory theory that places the highest constitutional value on political speech.

Part II argues that the various tests formulated to give effect to First Amendment goals in right of publicity claims do not accord sufficient protection to political speech because they do not adequately address how uses of the celebrity identity may contribute to the advancement of democratic deliberation and debate. This is demonstrated through an analysis of the three main judicial tests presently used to articulate a First Amendment defence in publicity claims.

Part III contends that cultural studies writings on the political significance of the celebrity semiotic sign can assist the development of First Amendment jurisprudence and judicial tests in this area. It advances the analysis by recommending ways in which the three tests may incorporate relevant insights on the recoding potential of the celebrity sign especially as used by subaltern groups or counterpublics as an integral part of political and social identity formation.
Part IV concludes that this use of cultural studies allows current First Amendment jurisprudence to be refined to protect political speech in a manner that more effectively negotiates the competing right of the celebrity individual to exploit the commercial value of his or her identity and the right of the public to use the celebrity sign as an expressive communicative resource in a participatory democracy.

I  OVERVIEW OF THE FIRST AMENDMENT

This Part establishes a framework for an analysis of the use of celebrity identity as ‘political speech’ that contributes to raising public awareness and stimulating participation in democratic debate on issues relating to identity politics.

It has been noted by free speech scholar Rodney Smolla that ‘[c]ontemporary free speech doctrines are extraordinarily detailed and often confusing’ and that ‘[m]odern First Amendment law abounds in three-part and four-part tests of various kinds’. 3 Similarly, Lillian BeVier and Thomas McCarthy have expressed despair at how ‘First Amendment theories have multiplied, the case law has become ever more chaotic, and consensus on fundamental issues has remained elusive both on and off the Court’ 4 and how the rules are ‘often maddeningly vague and unpredictable’. 5 While it is not the purpose of this dissertation to propose a systematic reconciliation or reconstruction of the contentious doctrines and rules of the First Amendment, this Part argues that participatory understandings of democracy can provide a strong foundation for articulating an appropriate standard of protection for political speech under right of publicity laws.

This Part will first review goals and theories of the First Amendment (Section A) and then analyse how these are advanced by the present judicial approaches in classifying and protecting speech within a First Amendment hierarchy (Section B). It will show that while most First Amendment jurisprudence on the impact of governmental regulation on

freedom of speech offers limited assistance to the formulation of a test to resolve the conflict between the private proprietary right of publicity and free speech values, the adoption of a participatory theory nonetheless can reinterpret and refashion the First Amendment defence in publicity claims to protect political speech that is widely recognised to have the highest constitutional value in a democracy.

A Goals and Theories of the First Amendment

Courts generally are concerned that the enforcement of publicity rights does not have a ‘chilling effect’ on free speech. There are various theories of the First Amendment but this thesis adopts a participatory theory of democracy involving deliberation and debate for two key reasons. First, in addition to the centrality of such an understanding in justifying free speech in any representative democracy, it is also an integral feature of many other prominent theories. Second, US case law has consistently demonstrated the ‘preferred position’ of political speech at the apex of a speech hierarchy, and this in turn indicates the preeminence of participatory understandings of democracy. However, it should be noted that courts may also consider other justifications that cover non-political expressions as there is no single overarching theory that can account for the protection given to different types of speech.

Mutually supportive theories for the First Amendment have been said to rest on the tripartite goals of the Framers of the US Constitution that comprise sponsoring enlightenment or the discovery of truth, self-fulfillment and citizen participation in a deliberative democracy. There are numerous writings by political philosophers and

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7 Richard H Fallon Jr, ‘How to Choose a Constitutional Theory’ (1999) 87 California Law Review 535, 577-8 (’All else being equal, one theory should therefore be preferred to another if it is more consonant with widely-shared values or has better prospects of attaining broad acceptance’).


9 Rodney Smolla argues that all three theories should be understood ‘not as mutually exclusive defences of freedom of speech, but rather as mutually supportive rationales’. Smolla and Nimmer, above n 3, § 2:7. See also McCarthy, above n 5, §§ 8:2-8:8; Rodney A Smolla, Free Speech in an Open Society (1992) 14-7; Barendt, above n 6, 7-21. There have been different variations of the goals advanced by the First Amendment, but they cover essentially the same themes. E.g Whitney v California, 274 US
jurists advocating the protection of free speech principles, and this thesis will not be revisiting the arguments by theorists such as John Stuart Mill, Alexander Meiklejohn, Thomas Emerson and Ronald Dworkin. Instead this Part will focus only on how the First Amendment is traditionally viewed as essential for the protection of speech from governmental regulation, and how the courts have determined a hierarchy of different types of speech with the highest protection accorded to political speech and a lower level of protection for commercial speech.

In its earlier conceptions, the First Amendment goal of enlightenment or the discovery of truth is represented most prominently by Oliver Wendell Holmes’ theory of a ‘marketplace of ideas’ in which ‘the ultimate good desired is … reached by free trade in ideas’, and that ‘the best test of truth is the power of the thought to get itself accepted in the competition of the market.’ The marketplace theory is perhaps ‘the most famous and rhetorically resonant of all free speech theories’ but it also exhibits a strong underlying democratic theory, evident in the oft-quoted phrase from New York Times v Sullivan that there is a ‘profound national commitment’ to the principle that ‘debate on public issues should be uninhibited, robust, and wide-open.’

In contrast, the self-fulfillment function shifts the attention from the ideas marketplace to individual dignity. While the Supreme Court has acknowledged that ‘the human spirit … demands self-expression’, there have been relatively few decisions

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10 For an excellent review of such works, see, eg Barendt, above n 6, 1-36; Schauer, above n 6, 35-46. See also John Stuart Mill, On Liberty and Other Essays (John Gray ed, 1998); Alexander Meiklejohn, Free Speech and Its Relation to Self-Government (1948); Thomas I Emerson, Toward A General Theory of the First Amendment (1966); Ronald M Dworkin, Freedom’s Law (1996).


12 Abrams, ibid.


discussing this as a central goal of the First Amendment. Nevertheless, it has been argued that although this theory might regard a right to express personal beliefs and political attitudes as a reflection of what it means to be human, the exercise of free speech might be also seen to be of value to democracy in ‘leading to the development of more reflective and mature individuals and so benefitting society as a whole.’

However, the Supreme Court has more recently embraced a ‘participatory theory of democracy’ that is concerned with the enlightenment of public decisionmaking in a democracy through enabling public access to information and promoting public discourse. This theory has been viewed as drawing on elements of the other two theories: the minorities in a representative democracy have the right to contribute to political debate as they may have better ideas than the majority, and the right of individuals to dignity and self-fulfillment may be expressed through their engagement in public discourse. Often known as the Madisonian ideal of deliberative democracy, different but related versions of this theory has been prominently championed by constitutional scholars like Robert Post, Cass Sunstein and Jack Balkin. The participatory theory is also supported by the more philosophical writings of Meiklejohn.

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19 Smolla refers to this as the 'democratic self-governance' rationale. Smolla and Nimmer, above n 3, § 2:28.


22 Balkin argues that the purpose of free speech is to promote a ‘democratic culture’ that is even broader than deliberation about public issues such that each individual has ‘a fair chance to participate in the production of culture, and in the development of the ideas and meanings that constitute them and the communities and subcommunities to which they belong.’ Balkin, above n 8, 4. See also Jack M Balkin, ‘Populism and Progressivism as Constitutional Categories’ (1995) 104 Yale Law Journal 1935, 1948-9.

Dworkin\textsuperscript{25} and Owen Fiss.\textsuperscript{26} Although the Supreme Court has never ruled that to qualify for the highest levels of constitutional protection speech must relate to self-government,\textsuperscript{27} Justice Stephen Breyer, speaking in an extra-judicial capacity, has advocated an approach to constitutional adjudication centred on ‘active liberty’ similar to Post’s participatory theory.\textsuperscript{28} An acceptance of the participatory theory has important implications for the continuing development of judicial approaches in resolving the tension between free speech values and property rights in a right of publicity claim as it focuses on not an abstract notion of the quest for truth but on how the nature and content of communication can ‘ensure that the individual can effectively participate in and contribute to our republican system of self-government’\textsuperscript{29} where ‘national identity [is understood] to be endlessly controversial’\textsuperscript{30}.

The Supreme Court has never made an ‘official choice’ among competing theories.\textsuperscript{31} But this thesis concurs with the observation that ‘where the doctrinal implications of different prominent theories … collide, courts will tend to give priority to the participatory theory of democracy.’\textsuperscript{32} As the next section will demonstrate, the Supreme Court’s articulation of a hierarchy of protectable speech, with political speech at its apex, is compatible with this understanding.

\textsuperscript{25}Eg Dworkin, above n 10, 15-26.
\textsuperscript{26}Eg Owen M Fiss, ‘Free Speech and Social Structure’ (1986) 71 Iowa Law Review 1405, 1409-10.
\textsuperscript{29}Globe Newspaper Co v Superior Court, 457 US 596, 604 (1982).
\textsuperscript{30}Post, above n 3, 2369. See also Barendt, above n 6, 48-9.
\textsuperscript{32}Post, above n 3, 2371. According to Schauer, the ‘narrowness of the argument from democracy is also its greatest strength … it does furnish several strong reasons for giving special attention and protection to political speech’. Schauer, above n 6, 44. It is noted that the opposition to the participatory theory comes most strongly from those who argue from a position of individual autonomy. Eg C Edwin Baker, ‘Harm, Liberty and Free Speech’ (1997) 70 Southern California Law Review 979, 981; David Strauss, ‘Persuasion, Autonomy and Freedom of Expression’ (1991) 91 Columbia Law Review 334, 354-5.
B Scope of Freedom of Speech

The protection of speech – which generally includes symbolic or expressive conduct – by the First Amendment depends on its position in a hierarchy of protectable speech, the applicable level of scrutiny of the governmental action and the nature of the other rights it is in conflict with. However, the US Supreme Court has not established ‘a clear theory to explain why and when speech qualifies for the top tier’, with the plurality opinion in Dun & Bradstreet v Greenmoss Builders conceding that the inquiry ‘must be determined by [the expression’s] content, form and context’.

The Supreme Court has highlighted that while freedom of speech has been recognised ‘as indispensable to a free society and its government… [it] has not meant that the public interest in free speech … always has prevailed over competing interests of the public.’ Most existing First Amendment jurisprudence is concerned with governmental action that abridges speech, with less attention given to discussing how private action can also significantly restrict speech. However, right of publicity laws are not seen as content-based or viewpoint-based governmental regulation of speech, thus resulting in the bulk of case law on governmental action being unhelpful to an analysis of First

35 Sunstein, Democracy and the Problem of Free Speech, above n 22, 11.
36 472 US 749, 761 (1985) (‘Dun & Bradstreet’).
38 The Supreme Court has employed a ‘heightened scrutiny methodology’ drawn from the Fourteenth Amendment jurisprudence where governmental regulation has to satisfy the relevant strict, intermediate or rational scrutiny standards, depending on whether it was content-neutral or content-based. Content-neutral time, place and manner restrictions are usually permitted if they serve a substantial governmental interest, but content-based restriction of protectable speech will be subject to strict scrutiny, which is usually fatal to the challenged regulation. Eg Smolla and Nimmer, above n 3, §§ 2:12, 3:1-3:2; United States v Playboy Entertainment Group Inc, 529 US 803, 817 (2000) (‘Playboy’); Reno, 521 US 844, 874-9 (1997); RAV, 505 US 377, 382 (1992); City of Renton v Playtime Theatres Inc, 475 US 41, 46-7 (1986); Susan Williams, ‘Content Discrimination and the First Amendment’ (1991) 139 University of Pennsylvania Law Review 615; Martin H Redish, ‘The Content Distinction in First Amendment Analysis’ (1981) 34 Stanford Law Review 113.
Amendment issues in a publicity claim. Nonetheless, the general recognition of the right of publicity as a private property right creates a head-on collision with the defendant’s free speech interests, as well as the audience’s interest in receiving the communication, thus requiring courts to formulate appropriate tests to resolve this conflict.

This Part contends that such judicial formulations should adopt as a starting point a consideration of the constitutional value of the different types of protectable speech. The participatory theory clearly elevates political discourse to a special status at the top of the speech hierarchy and this is reinforced by Supreme Court decisions that consistently accord to political speech the highest constitutional value in the system of American democracy.\(^{40}\) Although the Court has categorised art and entertainment together with political speech as belonging to the ‘core’ of the First Amendment, such expressions do not appear to enjoy same level of constitutional protection in the absence of a clearly articulable message;\(^{41}\) commercial speech has received a lower level of protection,\(^{42}\) with fighting words, obscenity and child pornography receiving none at all.\(^{43}\)

It seems that the Supreme Court has implicitly accepted the participatory theory with frequent pronouncements such as the First Amendment ‘was fashioned to assure unfettered interchange of ideas for the bringing about of political and social changes desired by the people’\(^{44}\) and to enable ‘the practice of persons sharing common views banding together to achieve a common end is deeply embedded in the American political


process. Generally, political speech covers all discussion on public issues, especially if intended by the speaker to influence governmental action. Political speech has been defined by commentators as speech that has ‘a reasoned, cognitive connection to some identifiable political issue that has the potential of entering the legislative arena;’ or ‘which bears, directly or indirectly, upon issues with which voters have to deal’; or ‘when it is both intended and received as a contribution to public deliberation about some issue.’

Although art and entertainment are protected by the First Amendment as having value in themselves, courts often examine their ‘political value’. This is demonstrated by decisions that assess their contribution to public debate through the articulation of a particular viewpoint or through critical commentary or parody. The Supreme Court in *Hurley v Irish-American Gay, Lesbian and Bisexual Group of Boston* commented, but without further explanation, that:

> a narrow, succinctly articulable message is not a condition of constitutional protection, which if confined to expressions conveying a ‘particularized message,’ would never reach the unquestionably shielded painting of Jackson Pollock, music of Arnold Schöenberg, or Jabberwocky verse of Lewis Carroll.

But the Court has not declared that all entertainment and artistic expression were protected by the First Amendment, and the decisions of the Circuit courts are anything but consistent. For example, in evaluating governmental action, the Ninth Circuit has developed a test which protects merchandise that conveyed ‘a religious, political, philosophical or ideological message’; while the Second Circuit uses a weighing methodology to determine whether the defendant’s work was ‘predominantly expressive’

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47 Garry, above n 27, 516.
48 Meiklejohn, above n 10, 79.
52 Eg *ACLU Nevada*, 333 F 3d 1092, 1107 (9th Cir, 2003).
in order to separate expressive art from commercial merchandise.\textsuperscript{53} Generally, courts have difficulty drawing ‘[t]he line between the informing and the entertaining’,\textsuperscript{54} and will continue to face problems in publicity claims when deciding whether uses of a celebrity image contribute to public debate (thereby securing the highest protection as political speech) or provide entertainment (hence getting a lesser degree protection). The subsequent decisions of some courts have read down the Hurley dicta regarding the protection of apolitical artworks.\textsuperscript{55} It appears unavoidable that judges will have to grapple with ascertaining the constitutional value of the defendant’s use of the celebrity personality in artistic or entertainment contexts.

A significant number of right of publicity claims involve unauthorised uses in advertising.\textsuperscript{56} Advertising is the quintessence of commercial speech,\textsuperscript{57} receiving some constitutional protection against governmental regulation under the Central Hudson standard\textsuperscript{58} as it ‘car[ries] information of import to significant issues of the day’\textsuperscript{59} and the information it provides is needed for ‘private economic decisions’.\textsuperscript{60} However, the unauthorised use of a celebrity identity to propose a commercial transaction is unlikely to receive First Amendment protection. The courts have not held that the constitutional protection of commercial speech can immunise one from liability in a publicity claim\textsuperscript{61} and this is evident in the various judicial tests used to delineate between protectable expressive uses and non-protectable commercial uses.

\textsuperscript{53} Eg Mastrovincenzo, 435 F 3d 78, 96 (2\textsuperscript{nd} Cir, 2006); Bery v City of New York, 97 F 3d 689, 696-7 (2\textsuperscript{nd} Cir, 1996).
\textsuperscript{54} Winters, 333 US 507, 510 (1948).
\textsuperscript{55} Eg Mastrovincenzo, 435 F 3d 78, 94-5 (2\textsuperscript{nd} Cir, 2006).
\textsuperscript{57} Commercial speech is one that ‘proposes a commercial transaction’. Eg Fox, 492 US 469, 482 (1989); Virginia Pharmacy, 425 US 748, 761 (1976).
\textsuperscript{59} 44 Liquormart, ibid 512.
\textsuperscript{60} Virginia Pharmacy, 425 US 748, 765 (1976).
In summary, this Part has argued that political speech is the most ‘valuable’ type of speech under the participatory theory and is also an important feature of other First Amendment theories. Recent cases have become more focused on the constitutional value of a communication to public political discourse. Indeed the courts have eschewed a case-by-case balancing approach to governmental regulation of protectable speech, employing a heightened scrutiny methodology that investigates whether there was viewpoint discrimination. However, in disputes involving non-governmental parties, where free speech rights protected by the First Amendment clash with other rights guaranteed by the Constitution – eg protection of private property under the Fifth and Fourteenth Amendments – courts appear willing to consider the relative burdens placed on the exercise of the respective rights. As the right of publicity is considered by courts to be a ‘property right’ and in some instances, a form of intellectual property right, there ought to be a coherent framework that allows it to be balanced against First Amendment values, drawing on appropriate analogies with either real property or intellectual property, where the courts weigh the harm to the holder of a private property right against the impact of burden on the freedom of speech on the speaker and the audience. Part II will assess if the First Amendment tests in publicity claims adequately protect political speech when discharging the challenging task of balancing countervailing property and speech rights.

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63 ‘No person shall be … deprived of life, liberty, or property, without due process of law’. United States Constitution, Amdt V.
64 ‘No State shall … deprive any person of life, liberty, or property, without due process of law; nor deny to any person within its jurisdiction the equal protection of the laws.’ United States Constitution, Amdt XIV.
65 McCarthy, above n 5, §§ 8:31-8:32. In the shopping centre cases, courts are also concerned with the availability of alternative channels of communication, the presence of state action and whether the property has become a public forum. Eg PruneYard, 447 US 74, 83-4 (1980); Lloyd Corp, 407 US 551, 567-70 (1972); Stanley H Friedelbaum, ‘Private Property, Public Property: Shopping Centers and Expressive Freedom in the States’ (1999) 62 Albany Law Review 1229.
66 Although the court in Haelan Laboratories was not explicit about the meaning of the label ‘property’, the Second Circuit clarified in a later decision that the right of publicity was indeed a ‘property right’. Topps Chewing Gum Inc v Fleer Corp, 799 F 2d 851, 852 (2nd Cir, 1986). For a list of states which have explicitly recognised this in either case law or statute, see McCarthy, above n 5, §§ 8:29-8:33, 10:6-10:9. See also Restatement (Third) of Unfair Competition § 46 cmt g (1995); Restatement (Second) of Torts § 652C cmt a (1977).
67 Eg Acme Circus Operating Co Inc v Kuperstock, 711 F 2d 1538, 1541 (11th Cir, 1983).
II THE FIRST AMENDMENT DEFENCE IN A RIGHT OF PUBLICITY CLAIM

This Part demonstrates that the judicial tests currently used in common law right of publicity claims, which purport to advance First Amendment goals, do not accord sufficient importance to political speech that contributes to democratic deliberation and debate.

Insofar as statutory publicity rights are concerned, McCarthy observes that it is ‘difficult to group the statutes into any sort of coherent “types” or subspecies’ and they present ‘a crazy quilt of different responses at different times to different demands on the legislatures.’ Nonetheless, the relevant legislation will usually enumerate exclusion or exemption categories of use that incorporate by reference the ‘core’ speech protections of the First Amendment. These statutes do not make a distinction between the constitutional values of the different types of speech: once the defendant’s use has been found to be within the statutory description of what constitutes permissible use in news, public affairs, political campaign, sports broadcast, original works of fine art, literary, dramatic, musical or artistic works etc, or by particular types of media, the plaintiff is barred from making a statutory claim. Under this categorical approach, the unauthorised use of a celebrity’s identity in a work of fine art is treated the same as its use in a political rally; both will be permitted regardless of the value of their contribution to the debate of public issues.

As Part I has shown, a preponderance of Supreme Court decisions and scholarly writings support the view that the central goal of the First Amendment is to advance democratic deliberation. Therefore, it follows that the defendant’s use of the celebrity identity may be classified as political speech with the highest constitutional value if it contributes to democratic processes, and such uses should be accorded a greater value

69 Eg CCC §§ 3344(d), 3344.1(a)(2); Florida Code Annotated § 540.08(3)(a); Illinois Compiled Statutes Annotated Ch 765 § 1075/35(b); Indiana Code § 32-13-1-1(c)(1); Ohio Revised Code Annotated §§ 2741.02(D), 2741.09(A).
70 Eg CCC § 3344(f); Illinois Compiled Statutes Annotated Ch 765 § 1075/35(b); Indiana Code § 32-13-1-1(c)(1)(D); Ohio Revised Code Annotated § 2741.02(E); Tennessee Code Annotated § 47-25-1107(c).
than artistic speech or entertainment. However, political speech does not occupy a paramount position in the current judicial tests which have been formulated to resolve the conflict between the plaintiff’s proprietary right in identity and the First Amendment.

Section A will examine why most ‘classic’ First Amendment jurisprudence concerned with governmental action offers limited guidance to the formulation of the First Amendment defence in publicity claims. Section B will investigate how, in the absence of a clear direction from the Supreme Court, lower courts have developed a mélange of tests that are not based on a particular theory of the First Amendment. Through a critical analysis of three main judicial approaches, it will demonstrate that these tests do not adequately promote public discourse and debate, and that reference to cultural studies perspectives may help to articulate the ‘operationalisation’ of the participatory theory in right of publicity claims.

A Limited Guidance from the US Supreme Court

As a general rule, a private person may exclude speakers from his or her property without violating the First Amendment.\(^\text{72}\) Under the \textit{O'Brien} principles, the enforcement of the right of publicity by the states may be viewed as content-neutral protection of personal property – an ‘important and substantial governmental interest’ – that is subject to intermediate scrutiny, and consequently upheld even though there may be incidental and indirect interference with speech.\(^\text{73}\) Thus the First Amendment cases on governmental regulation of speech, including time-place-manner restrictions, do not offer much assistance to the formulation of a First Amendment defence in publicity claims and have not been the subject of much consideration by Circuit and state courts.

The Supreme Court, in its only decision to have ever considered a clash between the right of publicity and the First Amendment, eschewed the heightened scrutiny doctrine used in the governmental regulation of speech cases.\(^\text{74}\) \textit{Zacchini v Scripps-Howard Broadcasting Co} was unusual on its facts because what was appropriated was


\(^{73}\) \textit{O'Brien}, 391 US 367, 377 (1968). See also \textit{Lloyd Corp}, 407 US 551 (1972) (where the Court upheld the use of trespass laws to exclude speakers from private shopping centres).

\(^{74}\) \textit{Zacchini v Scripps-Howard Broadcasting Co}, 433 US 562 (1977) (‘\textit{Zacchini}’).
the plaintiff’s entire fifteen-second human cannonball act. Indeed the Zacchini decision may be distinguished from most right of publicity claims which involve an unauthorised use of name, likeness or other evocative aspects of identity rather than the performance value of identity.\textsuperscript{75} Thus many commentators and courts have construed Zacchini to be of limited precedential value, relevant only to the rare situation where the plaintiff’s ‘entire act’ has been appropriated.\textsuperscript{76} As a result, as Part B will show, lower courts have independently formulated their own tests to resolve the property-speech conflict. However, this thesis argues that Zacchini is important here on two key points: (i) the reluctance of the Court to apply the actual malice standard for a media defendant to a publicity claim; and (ii) its direct balancing approach to resolving the conflict between the plaintiff’s property right and the First Amendment.

First, it is significant that the Supreme Court considered the line of authorities that included *New York Times v Sullivan*,\textsuperscript{77} *Time v Hill*,\textsuperscript{78} *Gertz v Robert Welch*\textsuperscript{79} and *Time v Firestone*,\textsuperscript{80} which dealt with defamation and invasion of privacy claims by public figures, and declined to extend the actual malice standard to media defendants for right of publicity claims.\textsuperscript{81} This suggests that the Supreme Court does not embrace an overarching constitutional actual malice standard that applies to all communications by media defendants, and appears to make a distinction between cases where there was damage to the dignitary or reputational interests of the plaintiff (eg invasion of privacy, defamation) and where there was damage to commercial exploitation opportunities (eg infringement of right of publicity). Hence it presents ample possibilities for the judicial


\textsuperscript{77} 376 US 254 (1964).

\textsuperscript{78} 385 US 374 (1967).

\textsuperscript{79} 418 US 323 (1974) (‘Gertz’).

\textsuperscript{80} 424 US 448 (1976).

\textsuperscript{81} Zacchini, 433 US 562, 571-5 (1977). The actual malice standard requires a public figure to prove that the publication by media defendant was made ‘with knowledge that it was false or with reckless disregard of whether it was false or not’. *NYT*, 376 US 254, 280 (1964). Despite Zacchini, some courts have adopted the actual malice standard. Eg Hoffman v Capital Cities/ABC Inc, 255 F 3d 1180, 1186-8 (9th Cir, 2001) (‘Hoffman’); Eastwood v National Enquirer Inc, 123 F 3d 1249, 1255 (9th Cir, 1997). See also Casondra Kevorkian, ‘Reinterpreting Jurisprudence: The Right of Publicity and Hoffman v Capital Cities/ABC, Inc’ (2003) 37 Loyola LA Law Review 85, 93-103.
development of an appropriate First Amendment test to determine the liability of media defendants in publicity claims by public figures, which include politicians and celebrities.  

Second, despite the frequent rejection of case-by-case balancing in First Amendment cases involving state action, the Zacchini majority recognised that the proprietary right of publicity is not always trumped by free speech. The majority appeared to balance, on the one hand, the threat to the economic value of the plaintiff’s performance and the impact of his ability to earn a living, and the social purposes of preventing ‘unjust enrichment’ and providing ‘an economic incentive … to make the investment to produce a performance of interest to the public’, and on the other hand, the benefit of news and entertainment to the public. However, without elaboration, the majority held that the plaintiff was entitled to compensation as the media was not always immunised by the First Amendment in right of publicity claims, a conclusion that was criticised by the dissent for its perfunctory brevity.

In contrast to the majority opinion which focused on the economic value of the plaintiff’s act and whether this value was taken by the defendant, the dissent looked to the intent of the media defendant as a starting point in their analysis. Nevertheless, both the majority and the dissent ‘recognized that any formula to be used when deciding the First Amendment issue should be based on a consideration of the public’s benefits and losses

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82 Under the Gertz classification, celebrities are viewed as those ‘who, by reason of the notoriety of their achievements or the vigor and success with which they seek the public’s attention, are properly classed as public figures’. Gertz, ibid 342. See also Howard I Berkman, ‘The Right of Publicity-Protection for Public Figures and Celebrities’ (1976) 42 Brooklyn Law Review 527; David Branson and Sharon Sprague, ‘The Public Figure-Private Person Dichotomy: A Flight from First Amendment Reality’ (1986) 90 Dickinson Law Review 627; Frederick Schauer, ‘Public Figures’ (1984) 29 William & Mary Law Review 905.


85 Ibid 576-7.

86 Ibid 578.

resulting in the absence of the privilege. 88 This aspect of Zacchini is often ignored by judges and commentators who champion a particular test. For present purposes, it is notable that the Zacchini balancing approach can accommodate a participatory theory of democracy, where greater protection may be given to uses of the celebrity identity that promote attention to public issues and engender public debate. 89

B Judicial Approaches

Regardless of the judicial test ultimately used, the Circuit and state courts agree that if the defendant’s use of the plaintiff’s identity is categorised as protected ‘core’ speech – eg political speech, entertainment, art – then the defendant may be immune from liability; but if it is classified as commercial speech, the defendant will be liable for the commercial exploitation of the associative value of the plaintiff’s identity. 90

Generally, the use of the celebrity identity by the media has a presumptive constitutional protection known as the ‘newsworthiness’ exception which may be explained by both the First Amendment theories of the marketplace of ideas and participatory democracy; this protection of the media in conveying news to the masses has been broadly construed to include virtually all types of information and entertainment communicated by the media. 91 Moreover, as a constitutionally protected medium – owing in part to its being singled out by the Free Press Clause – the media may also advertise itself by reproducing previous articles, programs and news stories containing the celebrity identity. 92 In applying the newsworthiness exception, courts are generally unconcerned if the media’s use of the celebrity’s identity contributes to democratic deliberation. 93

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89 See Part III below for a discussion of such uses as political speech by minority groups.
90 As pointed out by McCarthy, “[i]mposing liability for the unpermitted taking of one’s identity to attract attention to the product or its advertisement in no way impairs the constitutional right to “the free flow of commercial information”.” McCarthy, above n 5, § 7:3.
strong presumption in favour of the media is based primarily on the enlightenment function of the First Amendment; thus a media defendant who invokes the newsworthiness exception often escapes liability. However, for non-media defendants, the courts are more circumspect about protecting such speech under the newsworthiness exception. Unauthorised uses of the celebrity identity in merchandise like posters, buttons, t-shirts and games are often held to be infringing uses despite the presence of some newsworthy content.

As this Chapter is concerned with uses of celebrity identity in political speech, often by non-media speakers, the rest of this Part will focus on an analysis of three judicial tests most prominently used by non-media defendants to articulate a First Amendment defence – the direct balancing approach, the transformative elements test and the predominant purpose test. At present, these approaches tend to ignore the political significance of the celebrity sign, and overwhelmingly focus on the informational, artistic and entertainment aspects of the defendant’s use. The following sections will discuss the limitations of these three approaches in their evaluation of how particular uses of the celebrity identity contribute toward advancing participation in democratic deliberation.

1 Direct Balancing Approach in Russen and Cardtoons

The direct balancing approach explicitly engages in the weighing of benefits and harms to determine if the public interest served by the First Amendment (eg expressing a political viewpoint, commentary, criticism, informing or entertaining the public) outweighs the public interest served by publicity rights (eg recognising the right to

536, 546 (1993); Peter L. Felcher and Edward L. Rubin, ‘Privacy, Publicity and the Portrayal of Real People by the Media’ (1979) 88 Yale Law Journal 1577, 1596-9.

94 The courts usually will not allow the non-media defendant to wrap ‘its advertising message in the cloak of public interest, however commendable the educational and informational value’. Beverley v Choices Women’s Medical Center Inc, 579 NYS 2d 637, 641 (1991). See also Downing v Abercrombie & Fitch, 265 F 3d 994, 1002 (9th Cir, 2001); Abdul-Jabbar v General Motors, 75 F 3d 1391 (9th Cir, 1996); Titan Sports Inc v Comic World Corp, 870 F 2d 85 (2nd Cir, 1989).


96 Other tests include the ‘artistic relevance’ test applicable to the title of artistic works and the ‘relatedness’ test proposed by the Restatement (Third), Eg Rogers v Grimaldi, 875 F 2d 994, 997 (2nd Cir, 1989); Restatement (Third) of Unfair Competition § 47 cmt c (1995).
exploit the value of one’s property, preventing unjust enrichment, providing an incentive to engage in artistic or sporting endeavour). Although it does not on its face accord special status to political speech, its open-ended nature potentially allows greater ‘weight’ to be given to political speech relative to art or entertainment that does not contribute anything of substantial value to democratic debate. It can expose policy considerations requiring courts to explain the constitutional value given to different types of speech. However, its shortcomings lie in its potential for abstract application, as illustrated by the courts balancing what they perceive to be the public interests that the parties’ rights represent rather than the direct benefits and harms to each party.

In *Estate of Elvis Presley v Russen*, a New Jersey district court relied on the reasoning of the *Zacchini* majority and weighed the public interest in the informational value of the defendant’s speech against the ‘right of the individual to reap the reward of his endeavors.’ The court found the defendant’s ‘use of the likeness of [Elvis Presley] in a performance mainly designed to imitate that famous entertainer’s own past stage performances’ in *The Big El Show* ‘does not really have its own creative component and does not have a significant value as pure entertainment’. Implicitly endorsing the participatory theory, the court points out that ‘although [the defendant’s use] contains an informational and entertainment element, the show serves primarily to commercially exploit the likeness of Elvis Presley *without contributing anything of substantial value to society*’.100

Fifteen years later, the Tenth Circuit in *Cardtoons LC v Major League Baseball Players Association* rejected the framework established in *Lloyd Corp v Tanner* to reconcile the conflict between free speech and property rights in the context of governmental regulation, and opted instead to ‘directly balance the magnitude of the speech restriction against the asserted governmental interest in protecting the intellectual

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98 Ibid 1361.
99 Ibid 1359. The 90-minute show, billed as ‘A Tribute to Elvis Presley’, is a stage production patterned after an actual Elvis Presley stage show. The court concluded that the defendant ‘has made no showing … that the production is intended to or acts as a parody, burlesque, satire, or criticism of Elvis Presley.’ Ibid 1348-9, 1359.
100 Ibid 1339 (emphasis added).
101 407 US 551, 567 (1972) (where it would be ‘an unwarranted infringement of property rights to require [the owner] to yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist’). The *Zacchini* court did not consider the application of *Lloyd Corp* to publicity claims.
property right.¹⁰² Relying on a combination of different First Amendment theories, the court examined the value of parody of celebrities ‘both as social criticism and a means of self-expression … in the marketplace of ideas.’¹⁰³ The court was attuned to how celebrities, as a result of their symbolic significance, are ‘an important element of the shared communicative resources of our cultural domain.’¹⁰⁴ The court then weighed the consequences of limiting the defendant’s right to free speech¹⁰⁵ against the effect of infringing the plaintiffs’ right of publicity¹⁰⁶ and concluded that the detrimental effect of upholding free speech on the plaintiffs’ publicity rights in that case was negligible.¹⁰⁷ Some courts in California¹⁰⁸ and the Eighth Circuit¹⁰⁹ have applied the direct balancing approach, but it is unclear if other courts are likely to follow suit. This form of ad hoc balancing has been applied in other areas of constitutional law like in procedural due process analysis¹¹⁰ and has received some support from Supreme Court justices who advocate a more candid approach to resolving free speech conflicts.¹¹¹

For courts that favour a participatory theory of democracy, direct balancing can be used to examine how the presence of expressive content in the defendant’s speech contributes to democratic deliberation and debate. This thesis contends that if courts adopt the balancing approach, they ought to consider, on the one hand, the content, form and context of the defendant’s speech and the benefit of the communication to both the defendant and the intended recipient, and on the other hand, the harm to the celebrity individual in having his or her identity used in that manner. This refined approach allows courts to examine the constitutional value of the communication and better evaluate the relative benefits and harms to the parties in a claim.

¹⁰² 95 F 3d 959, 972 (10th Cir, 1996) (‘Cardtoons’). Legal commentators McCarthy and Kwall have also endorsed this approach. McCarthy, above n 5, § 8:39; Kwall, above n 1, 63.
¹⁰³ Ibid.
¹⁰⁴ Ibid (referring to John B Thompson, Ideology and Modern Culture: Critical Social Theory in the Era of Mass Communication (1990) 3; Madow, above n 39, 128).
¹⁰⁵ Ibid 972-3.
¹⁰⁶ Ibid 973-6.
¹⁰⁷ Ibid 976.
¹⁰⁹ CBC Distribution & Marketing Inc v Major League Baseball Advanced Media LP, 505 F 3d 818, 823 (8th Cir, 2007) (‘CBC’).
¹¹¹ Eg Branzburg v Hayes, 408 US 665, 745-6 (1972) (Stewart J); Dennis v United States, 341 US 494, 525 (1951) (Frankfurter J); Barenblatt v United States, 360 US 109, 126-7 (1959) (Harlan J delivering opinion of the Court).
Transformative Elements Test in Comedy III

The ‘transformative elements’ test, also known as the ‘transformative use’ test, was initiated by the California Supreme Court in *Comedy III*.\(^{112}\) It draws from the first factor of the fair use doctrine in copyright law:\(^{113}\) an unauthorised use of celebrity identity would be permitted if it was ‘transformative’. However, its lack of clear guidelines can encourage judges to be art critics or to base decisions on external factors like the fame of the artist.\(^{114}\) Furthermore, ‘fair use’ has been criticised as one of copyright’s ‘most nebulous and unpredictable aspects’ and should only be ‘invoked as a last resort [in publicity claims] after all other solutions have been tried and found wanting’\(^{115}\). In addition, the cryptic judicial comments that literal depictions like Andy Warhol’s silkscreens of celebrities may also be transformative if they carry a particular social message\(^{116}\) lend little guidance to how a court may meaningfully determine what constitutes the criteria for transformative use. As shown by recent California decisions, the test is focused on visual transformation which can be overprotective of art and entertainment that contribute little to the discussion of public issues, but underprotective of political speech which may be contextually transformative (because of its recoding) though not visually transformative. However, dicta from the *Comedy III* court suggest that contextually transformative uses could also be protected.

The key question for courts adopting this test is ‘whether the depiction or imitation of the celebrity is the very sum and substance of the work in question’ (in which case the defendant is liable for commercial appropriation of identity) or ‘whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness’ (in which case the

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\(^{114}\) Eg *Kwall*, above n 1, 58; *Levine*, above n 1, 216-9; *Volokh*, above n 1, 914-25. See also *Cartoons LC v Major League Baseball Players Association*, 868 F Supp 1266, 1272 (ND Okla, 1994) (the analysis loses integrity when only one of the fair use factors is considered).

\(^{115}\) *McCarthy*, above n 5, § 8.38.

\(^{116}\) *Comedy III*, 25 Cal 4th 387, 408-9 (2001) (“Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself”).
First Amendment trumps the plaintiff’s claim). The *Comedy III* court has also looked to determine whether the marketability and economic value of the challenged work derives primarily from the fame of the celebrity depicted.

In *Comedy III*, the court held that charcoal drawings of the Three Stooges (used on T-shirts sold to the public) were not sufficiently transformative. The court observed that

the transformative elements or creative contributions that require First Amendment protection are not confined to parody and can take many forms, from factual reporting to fictionalized portrayal, from heavy-handed lampooning to subtle social criticism.

Thus it appears that a transformative use of identity may be determined by reference to the content, form and context of the expression. This suggests that contextual transformations – like the recoded use of a celebrity identity to challenge the majoritarian values that the celebrity sign represents – may merit First Amendment protection. But the court seems to contradict itself when it later emphasised the primacy of visual transformation: that the inquiry is ‘in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.’

Two years later, the California Supreme Court, in a case involving a well-known comic book using depictions of musicians Edgar and Jonathan Winter as worm-like creatures, applied the transformative elements test to conclude that the use was visually transformative. The court initially suggested that a qualitative or non-visual transformation by the defendant, like communicating a different message from that which is ordinarily conveyed by the celebrity sign, may be sufficiently transformative. But it later held that ‘[w]hat matters is whether the work is transformative, not whether it is parody or satire or caricature or serious social commentary or any other specific form of

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117 Ibid 406.
118 Ibid 407.
119 Ibid 406.
120 Ibid 407 (emphasis added).
expression’. This seems to indicate that as long as the defendant’s depiction of a celebrity is visually different from his or her literal likeness, it will meet the transformative standard without the further need for the defendant to convey any discernible message. Furthermore, the court appeared to reject a consideration of the origin of the economic value of the defendant’s work, which was referred to in Comedy III, when it added: ‘the question is whether the work is transformative, not how it is marketed.’ Subsequently, in Kirby v Sega of America, the California Court of Appeal found that the defendant’s videogame character that was based on the likeness of the plaintiff, pop singer Keirin Kirby, was transformative as the defendant has ‘added creative [visual] elements to create a new expression.’ The court declined to refine the transformative elements test by considering whether the defendant’s use of the plaintiff’s identity has to ‘say anything – whether factual or critical or comedic – about a public figure’.

On closer inspection, the application of the transformative elements test in Winter and Kirby may be seen as an attempt to limit the Ninth Circuit’s controversial decision in White v Samsung that generously expanded the actionable indicia of identity. The reasoning of the California courts in these cases indicates that any evocative visual depiction of a celebrity, as long as it is not an exact literal reproduction of the celebrity’s likeness, can be deemed transformative and hence invoke the protection of the First Amendment to defeat the plaintiff’s claim without any further balancing.

In summary, the usefulness of this test appears confined to visual depictions of the plaintiff, and the extent to which the defendant’s use has departed from a realistic rendition of the plaintiff’s likeness. The judicial application of the test in Winter, Kirby and ETW Corp suggest that these rules do not necessarily entail greater awareness and

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122 Ibid 891. Cf Campbell, 510 US 569, 579 (1994) (‘Parody has an obvious claim to transformative value ... Like less ostensibly humorous forms of criticism, it can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one.’).

123 Winter, ibid 891 (2003). However, the court did make a passing remark that ‘fans who want to purchase pictures of them would find the drawings of the Autumn brothers unsatisfactory as a substitute for conventional depictions’. Ibid 890.

124 144 Cal App 4th 47, 59 (2006) (‘Kirby’). The court ignored the fact that a Sega affiliate had previously approached Kirby to endorse the game, but when negotiations failed, the defendant nevertheless created a videogame character that appeared to be an imitation of her performing persona. Ibid 56, 60.

125 Ibid 60.

126 McCarthy is especially critical of the transformative elements test. McCarthy, above n 5, § 8:72.

discussion of public issues. On the other hand, political speech comprising literal depictions of celebrities that are recoded by counterpublics to express a particular viewpoint may not be sufficiently transformative under the present judicial approach. Hence the current test tends to overprotect artistic speech but underprotect political speech despite the latter’s greater constitutional value.

3 Predominant Purpose Test in Doe

First proposed by intellectual property litigator Mark Lee, the predominant purpose test was adopted by the Missouri Supreme Court in Doe v TCI Cablevision, protecting an unauthorised use of identity if it was ‘predominantly expressive’ but finding an infringement of the right of publicity if it was ‘predominantly commercial’. Although this test can offer significant protection to uses that convey predominantly expressive political speech, it currently makes no distinction between the constitutional values of political speech and apolitical art/entertainment, and does not provide clear criteria to resolve hybrid uses (eg where there is a mix of political speech and commercial speech – like selling of celebrity-related merchandise in connection with a political rally).

The Missouri court was especially critical of the transformative elements test, observing that it gave ‘too little consideration to the fact that many uses of a person’s [identity] have both expressive and commercial components’ and operated to ‘preclude a cause of action whenever the use of [identity] is in any way expressive regardless of its commercial exploitation’. Hence, the predominant purpose test is purportedly designed to address works that are both expressive and commercial, and may be stated thus:

If a product is being sold that predominantly exploits the commercial value of an individual’s identity, that product should … not be protected by the First Amendment, even if there is some ‘expressive’ content in it that might qualify as ‘speech’ in other circumstances. If, on the other hand, the predominant purpose of

128 It is worth noting the Sixth Circuit’s critical observation that: ‘crying “artist” does not confer carte blanche authority to appropriate a celebrity’s name’ and ‘crying “symbol” does not change that proposition and confer authority to use a celebrity’s name when none, in fact, may exist.’ Parks v LaFace Records, 329 F 3d 437, 454 (6th Cir, 2003) (‘Parks’).
129 Lee, above n 1, 488-500.
130 Doe, 110 SW 3d 363, 373 (Mo banc, 2003).
131 Ibid 374.
132 Levine, above n 1, 220.
the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.\textsuperscript{133}

Unlike the transformative elements test, the mere presence of any visually expressive elements will not bar a right of publicity claim; for the defendant to escape liability, the use of the celebrity’s identity must rise above bare transformation to significant expressive commentary. The \textit{Doe} court found, inter alia, that the defendant’s use of hockey player Tony Twist’s identity as the name and persona of a comic book character and its targeted marketing to the plaintiff’s fan base to be ‘predominantly a ploy to sell comic books and related products rather than an artistic or literary expression’ and hence ‘free speech must give way to the right of publicity.’\textsuperscript{134}

The predominant purpose test arguably uses ‘commercial advantage’ as its foundation, remaining more faithful to the origins of the right of publicity as expressed in \textit{Haelan Laboratories} and \textit{Zacchini}. This test has been rejected by the California courts,\textsuperscript{135} and it has not been explicitly applied by jurisdictions outside Missouri.\textsuperscript{136} It does have particular shortcomings.\textsuperscript{137} Although the test purports to strike a better balance between free speech and property rights, its definitional approach based on the judicial determination of the defendant’s predominant purpose does not, unlike the \textit{Cardtoons} approach, engage in a balancing exercise that exposes the values and interests at stake. Moreover, the test fails to consider the hierarchy of First Amendment-protected speech, and offers little guidance to judges in relation to the determination of what qualifies as ‘predominantly expressive’.

Perhaps the predominant purpose test produced the correct result in \textit{Doe}, aided by the defendant’s admission that the use was not to make any expressive comment about

\textsuperscript{133} \textit{Doe}, 110 SW 3d 363, 374 (Mo banc, 2003) (citing Lee, above n 1, 500).
\textsuperscript{134} Ibid 374.
\textsuperscript{135} Eg \textit{Kirby}, 144 Cal App 4th 47, 60-1 (2006).
\textsuperscript{136} However, the methodology of other courts in focusing on the intent of the defendant in examining whether commercial exploitation of the associative value of the plaintiff’s identity has taken place resembles the ‘predominant purpose’ test. Eg \textit{Pooley v National Hole-In-One Association}, 89 F Supp 2d 1108, 1113 (D Ariz, 2000).
Twist\textsuperscript{138} and the sustained efforts of the defendant in exploiting the associative value of Twist’s identity through marketing merchandise directly to his fan base.\textsuperscript{139} In other situations, where the defendant asserts the presence of a parodic element or other social commentary,\textsuperscript{140} or where the defendant has not so blatantly marketed its product to the plaintiff’s fans,\textsuperscript{141} or where the defendant makes a living by selling works of art,\textsuperscript{142} it is unclear what criteria the courts will use to determine the ‘predominant purpose’ of the defendant.

While the predominant purpose test does not explicitly rely on a particular theory of the First Amendment, its focus on protecting expressive comment is compatible with a participatory understanding of democracy. It appears that the defendant’s unauthorised use of a celebrity’s identity will most likely be deemed ‘predominantly expressive’ if it contributed to debate on public issues or drew attention to the subordinate position of minority groups and, at the same time, the celebrity’s fan base has not been specifically targeted as potential customers of the defendant’s product. In practice, the court’s multi-factor analysis to determine whether expressive or commercial components predominate resembles the direct balancing approach. The judicial evaluation of the different factors in \textit{Doe} may well have been performed under the rubric of ‘direct balancing’ where the constitutional value of the defendant’s comic book, in terms of its critical commentary and contribution to debate about public issues, is taken into account, and policy considerations more openly discussed.

\textbf{C \hspace{1cm} Interim Conclusions}

As this Part has demonstrated, the three main judicial approaches used in claims involving non-media defendants are not based on any clearly defined theory of the First Amendment. They also do not adequately advance the deliberative democratic ideals that the Supreme Court suggests are important in the cases concerning governmental

\begin{footnotesize}
\begin{enumerate}
\item[138] \textit{Doe}, 110 SW 3d 363, 374 (Mo banc, 2003).
\item[139] Ibid 371.
\item[141] Eg \textit{Kirby}, 144 Cal App 4th 47 (2006); \textit{Parks}, 329 F 3d 437 (6\textsuperscript{th} Cir, 2003).
\item[142] Eg \textit{ETW Corp}, 332 F 3d 915 (6\textsuperscript{th} Cir, 2003).
\end{enumerate}
\end{footnotesize}
regulation of speech. Unlike these cases, only a handful of right of publicity decisions have accorded any prominence to the discussion of the value of the defendant’s expression to democratic deliberation.¹⁴³

Certain commercial uses of the celebrity identity can transcend their apparent status as mere celebrity memorabilia depending on the content, form and context of the message conveyed by the defendant speaker. Political speech extends beyond expressing support for or opposition to candidates and issues about elections and public office. As the Supreme Court has noted on numerous occasions, the First Amendment ‘was fashioned to assure unfettered interchange of ideas for the bringing about of political and social changes desired by the people.’¹⁴⁴ Part III will show how the analysis of the political symbolism of the celebrity semiotic sign in cultural studies can assist courts in determining when the non-media use of the celebrity identity may be categorised as ‘purely political speech in a special category [that] helps considerably to clear the decks for a clearer analysis of the First Amendment significance of celebrity merchandise.’¹⁴⁵ It will examine cultural studies perspectives on the use of the celebrity personality by minority groups in contemporary society to express their cultural – and political – identities, and explore how this understanding can help shape the development of the First Amendment defence.

III  IDENTITY POLITICS AND THE CELEBRITY: A CULTURAL STUDIES PERSPECTIVE

This Part argues that writings on the semiotic significance of the celebrity sign can contribute to First Amendment jurisprudence and illustrates this by showing how the three main judicial tests discussed in Part II may be refined to give better protection to political speech.

As highlighted in Chapter 2, it is important to frame legal arguments in the context of a First Amendment defence. If the celebrity semiotic sign is recognised to represent the values/ideals of a majoritarian public, then the debate and opposition to these ‘encoded’ values/ideals may be expressed by using the same signs in a ‘recoded’

¹⁴⁴ See above n 44.
¹⁴⁵ McCarthy, above n 5, § 7:22.
manner, and such counterpublic uses can therefore be categorised as ‘political speech’. This Part suggests that in order for political speech to be given adequate breathing space, it would be beneficial to understand the free speech issues in publicity claims within the context of a First Amendment theory that ‘preserves the independence of public discourse so that a democratic will within a culturally heterogeneous state can emerge under conditions of neutrality, and so that individuals can use the medium of public discourse to persuade others to experiment in new forms of community life.’

Section A explores, through the lens of cultural studies, how the celebrity personality may be used in the construction and contestation of social and political identities and the significance that particular celebrity personalities may have for minority groups in expressing a particular viewpoint. Section B argues that the use of celebrity signs by these groups may be categorised as political speech in First Amendment doctrine, and examines how the three judicial tests considered above may be refashioned to take this into account.

A The Celebrity Personality as a Political Site of Interpretive Practice and Contested Meanings

This section demonstrates that cultural studies perspectives can complement and augment a participatory theory of the First Amendment because uses of the celebrity identity by those who are ‘subordinated’ to communicate their disagreement with majoritarian values/ideals and to draw wider public attention to their social positions can be viewed as political speech. This contention was mooted three decades ago in Richard Dyer’s star studies regarding the gay community’s use of the Judy Garland star sign; and other scholars today can be seen to draw on the classic idea of the political significance of star signs, with the support of the general writings of Roland Barthes and Stuart Hall about recoding of semiotic signs.

Dyer’s *Stars*, which laid the groundwork for the celebrity studies of Marshall and Turner, appears to have influenced the thinking of legal commentators like...

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146 Post, ‘Constitutional Concept’, above n 21, 684.
Rosemary Coombe and Michael Madow. In the later *Heavenly Bodies*, Dyer contends:

Stars are also embodiments of the social categories in which people are placed and through which they have to make sense of their lives – categories of class, gender, ethnicity, religion, sexual orientation, and so on.

Using a postmodern analysis, Coombe argues how the value of a celebrity’s image may reside ‘in its character as a particular human embodiment of a connection to a social history’ when one is provoked to reflect upon one’s ‘own relationship to the cultural tradition in which the star’s popularity is embedded.’ Coombe’s description of the political potential of the contemporary celebrity draws much from Dyer:

The celebrity image is a cultural lode of multiple meanings, mined for its symbolic resonances and, simultaneously, … invested with … social longings and political aspirations.

In highlighting the ‘radical potential of the stars’, Dyer further observes that there is a political dimension to the use of stars for repressed groups like ‘the working class, women, blacks, gays – who have been excluded from the culture’s system of representations in all but marginal and demeaning forms’; the subordinated social groups are using these star signs which are associated with the dominant ideology to appropriate power for themselves in a democracy.

In the US, the ‘structural barriers or limits of class [that] would obstruct [the] process of cultural absorption’ have not assisted the ‘democratic enfranchisement of all

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151 Madow, above n 39.
154 Ibid 365. See also the discussion in Chapter 2 Part III.
155 Dyer, above n 147, 183–4.
citizens within political society’. As pointed out in Chapter 2, individuals outside the majoritarian value-system often have an ‘alternative foci of integration’ and are thus defined as ‘sub-cultural’ or ‘subaltern’ or ‘counterpublics’; and there is an increasing judicial recognition of these groups asserting their alternative views in the political sphere. Hence the celebrity identity acquires a political dimension, and can be seen as a ‘discursive space … for contesting and engendering the American character.’

Hall has also defined the taking of an existing meaning and reappropriating it for new meanings as ‘trans-coding’ and explained that repressed groups may use trans-coding strategies to reverse stereotypes, substitute ‘negative’ portrayals with ‘positive’ ones or contest subordinate representations from within. For example, if the Jacqueline Onassis sign is widely accepted as an ‘historic archetype’ who possessed ‘qualities of charisma, sophistication, elegance, trend-setting and uniqueness’, then one may challenge this ideological signification by using Onassis’ identity in an oppositional mode. The commercial use by Christian Dior in an advertisement is tantamount to a reinforcement of the hegemony of the Onassis sign with the primary purpose of appropriating its associative value; but other recoding uses, depending on the content, form and context of the message, may be categorised as political speech that constitute a legally legitimate challenge to the dominant ideologies of class, race or gender.

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158 Ibid 62.


161 Eg *Hurley*, 515 US 557 (1995) (where the defendants professed to express its members’ pride as openly gay, lesbian, and bisexual individuals and support their march in the New York St Patrick’s Day parade); *Raymen v United Senior Association Inc.*, 409 F Supp 2d 15 (DDC, 2006) (‘Raymen’) (where the defendants were protected by the First Amendment in the use of the plaintiff’s images in an advertising campaign which challenged various public policy positions taken by the American Association of Retired Persons).


164 Hall, ibid 270-5. For example, the genre of real person slash (‘RPS’) or real person fiction (‘RPF’) which features celebrity individuals is a form of fan fiction that adopts the public personae of celebrities as their own characters, building a fictional universe based on the supposed real-life histories of these celebrities. Eg Sonia K Katyal, ‘Performance, Property, and the Slashing of Gender in Fan Fiction’ (2006) 14 *Journal of Gender, Social Policy and the Law* 461, 489.

In summary, from a cultural studies perspective, the political agenda of counterpublics or subaltern groups may be best communicated to mainstream society through the use of widely recognised celebrity signs to which the public have ascribed particular representative values or characteristics. For example, with respect to gay and lesbian communities, legal commentator Madhavi Sunder explains that:

Central to this project is a cultural play with signs and symbols aimed, first, at illustrating that gays, lesbians, and bisexuals always have been and always will be part of the ‘normal’ operations of society and, second, challenging the normality of such operations by exposing the hidden homosexual.166

Thus the celebrity signs that are constitutive of cultural heritage – like ‘Judy Garland’, ‘Marilyn Monroe’, ‘Tiger Woods’ and ‘David Beckham’ – each transcend the human individuals who bear these names, and are symbolic of the ideological hegemonies of social identities in contemporary society. Their recoding by counterpublics may be viewed as ‘[p]ractices of articulating social difference [that] are central to democratic politics.’167 The next section will investigate when such practices ought to be categorised as political speech that merits the highest level of First Amendment protection.

**B Using Celebrity Signs within First Amendment Doctrine**

1 **Rethinking the Use of the Celebrity Sign as Political Speech**

The recoding practices of subaltern groups, as Coombe astutely points out, may ‘seem distant, if not utterly divorced from the legal regime of personality rights’168 and ‘are neither readily appreciated using current juridical concepts nor easily encompassed by the liberal premises that ground our legal categories.’169 But closer inspection reveals that through different modes of expressing the celebrity personality – like adulation, parody, satire and burlesque – subaltern groups are able to advance their political ideologies and assert alternative identities that ‘affirm both community solidarity and the

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166 Sunder, above n 162, 167.
168 Coombe, above n 153, 386.
legitimacy of their social difference by empowering themselves with cultural resources that the law deems the properties of others.\textsuperscript{170}

At first sight, the public forum doctrine\textsuperscript{171} in First Amendment jurisprudence appears to have some relevance for right of publicity laws as one may argue that the celebrity persona, because of the audience’s active role in its production, circulation and consumption, can be treated as a \textit{quasi}-public forum.\textsuperscript{172} However, it is inapposite to apply public forum principles to uses of the celebrity identity for expressive activity as the celebrity persona lacks the quintessential qualities of government control, physical location and public access as evident in cases which primarily dealt with disputes in relation to shopping arcades and malls, pedestrian sidewalks and schools.\textsuperscript{173} Courts have to consider whether there is sufficient state action to ‘transform government property into a public forum’.\textsuperscript{174} Moreover, the public forum rules have only been applied to determine whether government regulation of expressive activity in a particular category of forum was subject to heightened scrutiny; generally, content- or viewpoint-based legislation in traditional and designated public fora are subject to strict scrutiny while time-place-manner restrictions may be permitted. Although a number of attempts have been made to categorise privately owned shopping malls as public fora, the Supreme Court has steadfastly held that there is no constitutional right to engage in expressive activity on such private properties.\textsuperscript{175} In addition, in order to convert a privately owned business location into a public forum, courts have required ‘either a symbiotic relationship or a

\begin{enumerate}
\item Coombe, above n 153, 366.
\item Eg Leslie Kim Treiger-Bar-Am, ‘The Moral Right of Integrity: A Freedom of Expression’ in Fiona MacMillan (ed), New Directions in Copyright Law Volume 2 (2006) 127, 157. The assertion that ‘the public forum argument could be raised by modifiers of speech’ with respect to cultural icons like Mickey Mouse or Barbie is unfortunately not explained.
\item Eg Hotel Employees & Restaurant Employees Union, Local 100 of New York, NY & Vicinity, AFL CIO v City of New York Department of Parks & Recreation, 311 F 3d 534, 540 (2\textsuperscript{nd} Cir, 2002) (in distinguishing between a public and a non-public forum for free speech purposes, a court should examine the forum’s physical characteristics and the context of the property’s use, including its location and purpose); Kokinda, ibid 726-30; Pruneyard, 447 US 74, 79-85 (1980).
\item Perry, 460 US 37, 47 (1983). The state action doctrine, related to the public forum doctrine, requires a significant nexus, not just between the state and the private actor, but also between the state and the allegedly unconstitutional act, before the court would find state action. Eg Moose Lodge No 107 v Irvis, 407 US 163, 175-6 (1972); Alexander, above n 72, 23-6.
\item Eg PruneYard, 447 US 74 (1980); Hudgens, 424 US 507 (1976). See also Lloyd Corp, 407 US 551, 569 (1972) (‘property [does not] lose its private character merely because the public is generally invited to use it for designated purposes.’).
\end{enumerate}
sufficiently close nexus between the government and the private entity so that the “power, property and prestige” of the state has been in fact placed behind the challenged conduct. Unlike the disputes in public fora cases regarding the physical space on which expressive activity takes place, the celebrity identity is an intangible symbol which would usually form an integral part of the alleged expressive activity – it is not a functional equivalent of town halls, public parks and downtown business districts. It is more appropriate to consider other approaches in First Amendment jurisprudence to give effect to the semiotic significance of celebrity signs.

The participatory theory of the First Amendment supports the protection of the making of ‘representations about self, identity, community, solidarity, and difference’ or the articulation of political and social aspirations using the celebrity sign within a ‘dialogic democracy’ as political speech. In First Amendment doctrine, such recoded circulations can be viewed as a form of political activism akin to Raymen v United Senior Association Inc, characterised by their ability to ‘reverse perceptions of social devaluation or stigma, articulate alternative narratives of national understanding, and challenge exclusionary imaginaries of citizenship.’

In this light, the recoding of celebrity signs by gay and lesbian counterpublic groups may be conceived as political speech expressing an opposition to ‘heteronormativity’ that embodies ‘a constellation of practices that everywhere disperses heterosexual privilege as a … central organizing index of social membership.’ Similar arguments may be made for other subaltern categories of race,

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176 Eg City of West Des Moines v Engler, 641 NW 2d 803, 806 (Iowa, 2002); State v Wicklund, 589 NW 2d 793, 802 (Minn, 1999). Of the 24 states whose courts have ruled on the issue, twenty states have declined to extend any right of free expression on privately owned property. Eg Shad Alliance v Smith Haven Mall, 66 NY 2d 496 (1985); Illinois v DiGuida, 604 NE 2d 336 (Ill, 1992). California, interpreting its State Constitution, has held that mall owners must permit such access in certain instances, and has employed a balancing test to resolve the issue. Eg Golden Gateway Center v Golden Gateway Tenants Association, 26 Cal 4th 1013 (2001); Albertson’s Inc v Young, 107 Cal App 4th 106 (2003) (“Albertson’s”).

177 Coombe, Cultural Life, above n 150, 248-9.


180 Heteronormativity has been defined as ‘the institutions, structures of understanding, and practical orientations that make heterosexuality seem … privileged.’ Warner, above n 160, 188 fn 3.

181 Ibid 195.
gender or class. For example, the celebrity signs of Tiger Woods or Jacqueline Onassis, as articulated through widely distributed photographic and televisual images, especially in advertising, embody certain values/ideals for the majoritarian public.\(^\text{182}\) Therefore, their recoding, like an ironic use of the Tiger Woods image by National Association for the Advancement of Colored People (NAACP)\(^\text{183}\) to highlight the discrimination of coloured people or on t-shirts ‘as an extensive … message of social advocacy’ to express their pride in being associated with a successful African-Asian American icon in a festival or parade,\(^\text{184}\) can be categorised as political speech because of their pertinent viewpoints that significantly contribute to democratic participation and debate.\(^\text{185}\)

However, conferring on such uses the status of political speech does not guarantee immunity from liability for every subaltern group or individual speaker who tacks on a political message to unauthorised uses of the celebrity sign. As McCarthy cautioned:

[I]f all it took for a defendant to wrap itself in the First Amendment was to add an appropriate ‘Express Your Support for _____’ slogan on all celebrity merchandise, then the right of publicity to control the commercial property value in his or her identity would be destroyed.\(^\text{186}\)

In assessing a publicity claim, especially in the context of advertising, courts should distinguish whether the recoding of the celebrity sign is ‘genuinely a political statement’ or an attempt to ‘appropriate “difference” … in order to sell a product’.\(^\text{187}\) Accordingly, if one views the First Amendment as informed by a pragmatic cultural studies approach, regardless of whatever formulation the court adopts, one should consider: (i) the content of the expressive elements of the use of the celebrity personality (eg whether it was to advance a political cause or affirm the political identity of a particular social group); (ii) the form of expression (eg whether the use was commercial in the form of advertising,

\(^{182}\) Eg ETW Corp, 332 F 3d 915 (6th Cir, 2003); Onassis, 472 NYS 2d 254 (1984).
\(^{183}\) The mission of the NAACP is to ensure the political, educational, social and economic equality of rights of all persons and to eliminate racial hatred and racial discrimination. See NAACP <http://www.naacp.org/about/mission/index.htm> at 1 July 2009.
\(^{184}\) Eg Ayres, 125 F 3d 1010, 1014 (7th Cir, 1997); One World One Family Now v City & County of Honolulu, 76 F 3d 1009, 1012 (9th Cir, 1996); Heffron v International Society for Krishna Consciousness Inc, 452 US 640, 647 (1981).
\(^{185}\) NAACP also seeks, inter alia, to ‘remove all barriers of racial discrimination through democratic processes’. See NAACP <http://www.naacp.org/about/mission/index.htm> at 1 July 2009.
\(^{186}\) McCarthy, above n 5, § 7:22.
\(^{187}\) Hall, above n 163, 273 (emphasis in original).
character merchandising or product sale, or non-commercial, or a hybrid); and (iii) the context of the use (eg whether it was to express a particular viewpoint at a parade, rally or some other public forum). In propertising identity, right of publicity laws should aim to strike a balance between protecting, on the one hand, both the proprietary right of the celebrity individual to exploit the associative value of identity and his or her right as an individual speaker not to propound a particular point of view, and on the other hand, the right of others to express a political viewpoint through connotative recoded uses of the celebrity sign. The next section will evaluate how the three main judicial tests may take into account such politically expressive uses.

2 Revisiting the Current Judicial Approaches

This section will focus on examining how the three main judicial tests can accommodate the classification of recoded uses of the celebrity identity as political speech within their analyses. To illustrate their operationalisation, the revised tests will be applied to the facts of two cases which have attracted significant commentary and judicial discussion – White v Samsung (involving the attractive blond Anglo-Saxon television personality Vanna White) and ETW Corp v Jireh Publishing (involving African-Asian American sport icon Tiger Woods).

The facts of White and an analysis of the indicia of identity and commercial appropriation have been covered in Chapters 3 and 4. The Ninth Circuit had rejected the defendant’s First Amendment defence which posited that the advertisement was a parody of White’s television act and was therefore protected speech. As a semiotic sign, White is widely associated with a consumption culture epitomised by the gameshow, or can be seen to represent, like Marilyn Monroe and other blond Anglo-Saxon celebrities, the privilege of ‘whiteness’ in contemporary American society. If the sign of Vanna White...

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188 The location of the speech is important. In Ayres, the selling of expressive t-shirts by the Marijuana Political Action Committee to be worn at City-sponsored festivals in Grant Park was held to be political speech. Ayres, 125 F 3d 1010, 1013-4 (7th Cir, 1997).
189 Hurley, 515 US 557, 574-5 (1995) (recognising the Council’s ‘right as a private speaker to shape its expression by speaking on one subject while remaining silent on another’).
190 Richard Dyer, White (1997) 73, 138. Dyer also comments that through ‘narrative structural positions, rhetorical tropes and habits of perception … white people in white culture are given the illusion of their own infinite variety’ and is one of the means by which subordinated social groups are ‘categorised and kept in their place’. Ibid 12. See also Dyer, Heavenly Bodies, above n 152, 17-63;
were recoded as a critique of these values/ideals, and particularly by subaltern groups who seek to ‘achieve equality of rights and eliminate race prejudice among the citizens of the United States’, then the relevant speech may be categorised as political speech. In Raymen, for example, the court found that the advertisement, which features the photograph of the plaintiffs kissing, was part of a campaign by USA Next challenging various public policy positions purportedly taken by the American Association of Retired Persons, ‘discusses public policy issues that are currently the subject of public debate’ and USA Next, a non-governmental organisation, is therefore protected by the First Amendment against liability for right of publicity infringement. However, the Samsung print advertisement in White, unlike the Raymen or infamous Benetton advertisements, contains no discernible political expression that contributes to democratic debate.

In ETW Corp, the defendant Jireh Publishing, a commercial company, released for sale over 5,000 prints bearing Tiger Woods’ likeness based on a painting by Rick Rush titled The Masters of Augusta, which commemorates Woods’ historic victory. In the foreground of Rush’s painting are three views of Woods in different poses; in the background is the Augusta National Clubhouse and likenesses of famous past golfers

Grant McCracken, ‘Marilyn Monroe, Inventor of Blondness’ in Grant McCracken, Culture and Consumption II: Markets, Meaning and Brand Management (2005) 93.

For example as reflected in one of the principal objectives of the NAACP in its constitution. NAACP <http://www.naacp.org/about/mission/index.htm> at 1 July 2009.

409 F Supp 2d 15, 19 (DDC, 2006). The photograph featured the plaintiffs, a gay couple, kissing, and was said to be used in the advertisement 'to incite viewer passions against the AARP because of its alleged support of equal marriage rights for same-sex couples'. Ibid.

Ibid 24.


looking down on Woods. The accompanying text contains laudatory narrative of Woods’ achievement at Augusta. The Sixth Circuit dismissed both Woods’ right of publicity and *Lanham Act* claims, noting that ‘sports and entertainment celebrities have come to symbolize certain ideas and values in our society and have become a valuable means of expression in our culture’, but without discussing the constitutional value of the defendant’s speech. Cultural commentators C L Cole and David Andrews argue that Woods as a popular American icon is ‘coded as a multicultural sign of color-blindness’ and such ‘racially-coded celebrations [can] deny social problems and promote the idea that America has achieved its multicultural ideal.’ This dominant coding of the Woods celebrity sign offers myriad possibilities for recoding by subaltern African-American or Asian-American groups to assert their particular viewpoints about the role of race and ethnicity in public policy. However, the almost literal rendition of Woods’ image and its contextual setting against the background of other famous golfers and the clubhouse lack important elements of criticism or parody that usually suggests a high constitutional value. The defendant’s depiction of Woods, despite its momentous occasion, contains no definable political expression and contributes little to any public awareness or discussion of the issues relating to minority groups in American society.

(a) Direct Balancing Approach

The Supreme Court has acknowledged a ‘fundamental interdependence exists between the personal right to liberty and the personal right in property’ and both are ‘basic civil rights’. It has also been observed that ‘[p]rivate property rights, despite the

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196 *ETW Corp*, ibid 918.
197 Ibid 919 fn 1.
200 Ibid 70.
201 Woods has been said to be a ‘multicultural myth’ perpetrated by advertisers, particularly by Nike in their commercial advertisements as an ‘emblem’ of ‘racial progress … that combined race, sport, masculinity, national healing, and proper citizenship.’ Ibid 78, 82.
public interests to which they have been compelled to yield during the past century, remain firmly entrenched in American constitutional fabric. Direct balancing can take into account this special status of property rights, and at the same time, give ‘greater weight’ to political speech by counterpublics that use the celebrity identity to challenge majoritarian beliefs or positions, compared to that accorded to art or entertainment that do not express a political viewpoint. Presently, the balancing test tends to be applied at an abstract level and does not clearly balance the benefit to the defendant speaker against the harm to the celebrity plaintiff, including the plaintiff’s own First Amendment rights, if the right of publicity was not enforced.

Of the three tests examined, its open-ended nature best allows courts to consider the content, form and context of the use of the celebrity identity and to explicitly evaluate the relative harms and benefits to the parties involved. In recognising the recoding possibilities of the celebrity identity for political speech, the factors that a court may consider include: (i) the primary motivation of the defendant speaker in using the celebrity plaintiff’s identity; (ii) the nature of the defendant’s commercial enterprise; (iii) the content of the defendant’s expressive speech; (iv) the medium of the defendant’s expression; (v) the occasion and location of the defendant’s use; (vi) the presence of alternative avenues of communication; and (vii) the intended audience of the defendant’s communication.

In evaluating the harm to the plaintiff, the court may consider: (i) the nature and extent of damage to the plaintiff’s ability to exploit the associative value of his or her identity; and (ii) whether the defendant’s products were a substitute for products offered by the plaintiff or the plaintiff’s authorised licensees. This approach can better provide adequate breathing space to the freedoms protected by the First Amendment and is compatible with the Supreme Court’s current analysis involving speech on private

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204 Friedelbaum, above n 65, 1262.
205 After a lengthy review of various approaches to incorporate First Amendment considerations into right of publicity doctrine, McCarthy, citing the Cardtoons direct balancing approach with approval, has also concluded that one needs to ‘meet the conflict head on’ and ‘[t]he balance must be laboriously hacked out case by case’. McCarthy, above n 5, § 8.39.
206 Eg Doe, 110 SW 3d 363, 367 (Mo banc, 2003) (where the plaintiff introduced evidence that the defendant’s use ‘resulted in a diminution in the commercial value of his name as an endorser of products’ and has in fact lost endorsement opportunities).
property that require balancing of the competing interests of the property owner and of the public with respect to the particular property to determine ‘expressive access’.\footnote{\textit{Eg PruneYard}, 447 US 74, 82-8 (1980); \textit{Hudgens}, 424 US 507, 518-21 (1976); \textit{Lloyd Corp}, 407 US 551, 563 (1972). See also \textit{Albertson’s}, 107 Cal App 4th 106, 113-4, 123 (2003).}

\textit{White v Samsung}

In dismissing the defendant’s First Amendment defence, the Ninth Circuit found that the case involved ‘a true advertisement run for the purpose of selling Samsung VCRs’ and ‘the ad’s spoof of Vanna White and Wheel of Fortune is subservient and only tangentially related to the ad’s primary [commercial] message’.\footnote{\textit{White I}, 971 F 2d 1395, 1401 (9th Cir, 1992).} Even if the court had used a direct balancing approach, the low constitutional value of Samsung’s speech in the context of an advertisement for VCRs contributes little to the debate of public issues and would have been outweighed by the damage to White’s ability to exploit the associative value of her identity.

\textit{ETW Corp v Jireh Publishing}

The majority’s ‘single-sentence attempt at balancing’ was criticised by the dissent as falling ‘woefully short of any meaningful consideration of the matter.’\footnote{\textit{ETW Corp}, 332 F 3d 915, 949 (Clay J) (6th Cir, 2003).} In phrasing the issue as one that requires ‘balancing the societal and personal interests embodied in the First Amendment against Woods’s property rights’,\footnote{Ibid 938.} the former will inevitably prevail.\footnote{\textit{ETW Corp}, ibid 959; \textit{Carson v Here’s Johnny Portable Toilets Inc}, 698 F 2d 831, 841 (Kennedy J dissenting) (6th Cir, 1983).} As indicated above, a better approach to balancing is to consider the direct harms and benefits to the parties involved.\footnote{\textit{Cardtoons}, 95 F 3d 959, 971-6 (10th Cir, 1996).} Rush’s depiction of Woods arguably constitutes the type of conventional depiction of the celebrity likeness in traditional merchandising that appeals to fans. Clearly the content of the defendant’s expression may not be classified as political speech for African-American or Asian-American counterpublic groups; the sale of the prints was not in the context of expressing a particular viewpoint about social or political identity. When one weighs the relatively low constitutional value of the defendant’s artwork against the interference with the
proprietary publicity right of Woods, it appears that Jireh Publishing may not avail itself of the protection of the First Amendment.

(b) Transformative Elements Test

Under its present formulation as applied in Winter and Kirby, the transformative elements test may restrict subaltern groups from appropriating celebrity signs for the construction of their social identities in everyday activities unless the celebrity’s likeness has been *visually* transformed. For example, the groups may be prohibited from using a literal depiction (e.g., a photograph) of a particular celebrity on silkscreened t-shirts or other merchandise bearing the celebrity’s image for sale to group members to highlight a public issue like the subordinated social position of the homosexual community.

However, this Chapter argues that depending on the identity of the speaker and the context of the unauthorised use, certain expressive uses of merchandise may qualify as political speech, like the wearing of black armbands in *Tinker v Des Moines Independent Community School District* or flag-burning in *Texas v Johnson.*

For example, of the sale of t-shirts by counterpublic groups like Lambda Legal[216] bearing the images of actors like Heath Ledger, Jake Gyllenhaal and Tom Hanks – who have been honoured at the Academy Awards for playing gay characters in critically acclaimed movies – to be worn at a Gay Pride Parade should be viewed as ‘transformative’ because the recoded meaning of the celebrity signs now carries significant political content. Moreover, in *Comedy III,* where the transformative elements test was first articulated, the court had emphasised that ‘the transformative elements or creative contributions that require First Amendment protection … can take many forms … from heavy-handed lampooning to subtle social criticism’.[217] Thus, by examining the content, form and context of the impugned use, the transformative elements test may be adapted to protect non-visually transformative uses of the celebrity identity.

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215 See above n 33 and accompanying text.

216 Lambda Legal is a national organisation in the US committed to achieving full recognition of the civil rights of lesbians, gay men, bisexuals, transgender people and those with HIV through impact litigation, education and public policy work. See Lambda Legal <http://www.lambdalegal.org/about-us/> at 1 July 2009.

White v Samsung

The transformative elements test had not been formulated when White was handed down. Although there may not be a politically expressive message that presents a critique of the privilege of whiteness in American society, Samsung’s use of a robot evocative of Vanna White nevertheless can be argued to be contextually transformative as a recoding of her Wheel of Fortune persona to comment on the interchangeability of the contemporary celebrity. The advertisement’s suggestion – that a human role may be replaced by a robot in 2012 AD – may be construed as a critical comment on the artificiality or dehumanisation of the contemporary celebrity sufficient to meet the transformative standard.218

ETW Corp v Jireh Publishing

Applying the transformative elements test, the Sixth Circuit majority held that Rush’s artwork was more than a literal rendition of the celebrity golfer, and that the artist had ‘added a significant creative component of his own to Woods’ identity.’219 However, the painting of Woods was a conventional depiction of the celebrity golfer that resembled the literal charcoal drawing of the Three Stooges in Comedy III. In a tenuous application of the test, the majority concluded that the artwork was transformative because the work conveyed a message ‘that Woods himself will someday join that revered group’220 and it ‘communicates and celebrates the value our culture attaches to such events’.221 By attempting to analyse the constitutional value of the defendant’s use, the Sixth Circuit appears to have refined the transformative elements test in a manner that contrasts sharply with the refusal of the California courts to do so.222 But as explained earlier, Rush’s painting of Woods conveys no discernible political expression that contributes to

219 ETW Corp, 332 F 3d 915, 938 (6th Cir, 2003). In a highly critical dissent, Clay J would have entered summary judgment for the plaintiff based on the lack of transformative elements in Rush’s literal rendition of Woods, finding that it is ‘nearly identical to that in the poster distributed by Nike’. Ibid 959-60.
220 Ibid 936.
221 Ibid.
222 See above nn 122 and 125.
democratic deliberation, and the Sixth Circuit should have followed the reasoning in *Comedy III* and found a right of publicity infringement.\(^{223}\)

(c) Predominant Purpose Test

As highlighted in Chapter 3, *New York Civil Rights Law* § 50 grants a de facto publicity right by offering protection against unauthorised commercial uses of identity for advertising purposes or for the purposes of trade under the rubric of privacy. In *Beverley v Choices Women’s Medical Center*, although the New York court did not use Missouri’s predominant purpose test, it appears that the defendant’s commercial use of the plaintiff’s identity must have significant constitutional value in order to avail itself of the First Amendment defence:

> [A]lthough women’s rights and a host of other worthy causes and movements are surely matters of important public interest, a commercial advertiser … may not unilaterally neutralize or override the long-standing and significant statutory privacy protection by wrapping its advertising message in the cloak of public interest, however commendable the educational and informational value.\(^{224}\)

In *Raymen*, the use of a photograph of the plaintiffs in an advertisement by USA Next to challenge various public policy positions was rightly categorised as political speech that trumped the plaintiffs’ right of publicity.\(^{225}\) Under the predominant purpose test, non-governmental organisations and civic groups, like NAACP and Legal Lambda that highlight the subordinated position of minorities in American society and lobby the government for policy changes, are more likely to benefit from the protection of the First Amendment than commercial enterprises. But to protect all speech that is ‘predominantly expressive’ does not make a distinction between speech that arguably has a higher constitutional value (because it contributes to public debate about political issues) and speech that has a comparatively lower value (because it merely entertains or is simply aesthetic).

\(^{223}\) See also criticisms of the application of the transformative elements test by the *ETW Corp* majority in Franke, above n 1, 970-4; Webner and Lindquist, above n 1, 200-1; Sloan, above n 195, 918-20.


\(^{225}\) See above nn 192-193.
Most advertisements will be deemed ‘predominantly commercial’ unless the advertisement clearly conveys a politically expressive viewpoint that draws public attention to particular social issues or is critical of a public figure or public policy. As explained in Part IIIB1, the content, form and context of the use must be examined. However, it is doubtful a commercial defendant like Samsung can show that an advertisement is predominantly expressive when its product is also depicted in the advertisement. Unlike the Benetton advertisements which poignantly highlight political issues like religious, racial, sexual and moral conflicts, the White advertisement – bearing the caption ‘The VCR you’ll tape it on. 2012 A.D.’ – suggests an infringement of the plaintiff’s publicity right as it is predominantly commercial with ‘[the] primary message: “buy Samsung VCRs.”’

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*The Masters of Augusta* appears to be a commemorative work produced for sale to the public and does not contain ‘expressions of value, opinion, or endorsement’ of significant democratic value. The work does not critically comment on a specific attribute of Tiger Woods – like his ethnic heritage or the values he embodies – or draw attention to political or social issues facing subaltern groups. Neither Rush nor Jireh Publishing had recoded the Woods sign, and the literal rendition simply reproduces the dominant preferred reading of the Woods celebrity sign as a national hero consistent with his commercial positioning. Consequently, the Sixth Circuit should have decided that the freedom of speech would not have been impermissibly abridged by the prohibition of the sale of the prints.

In contrast, if the NAACP or other subaltern groups had produced literal depictions of Woods for sale to support their advocacy efforts, such uses arguably may be construed as politically expressive. In these circumstances, the commercial nature of the

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226 See above n 194.
227 White I, 971 F 2d 1395, 1401 (9th Cir, 1992).
sale of prints and any other products bearing Woods’ likeness can be said to be incidental to the predominant purpose of constructing particular social identities for minority groups by these non-profit counterpublics which will in turn empower their political participation. For example, the use of the images of Ledger, Gyllenhaal or Hanks – as a result of the connotations of their celebrity signs from the widely lauded gay characters they have portrayed in the movies Brokeback Mountain and Philadelphia – by Legal Lambda to convey the subordinated status of homosexuals in society and to advocate policy changes can also be considered political speech. But this does not mean that counterpublics have carte blanche to appropriate the identities of celebrities under the banner of political speech. Each case has to be evaluated based on the content, form and context of the use, and one needs to be on the lookout for defendants who tack on a political message to products that exploit the associative value of identity in the hope of securing First Amendment protection. 230

IV  SUMMARY & CONCLUSIONS

The investigation of judicial decisions, legal commentary and cultural studies writings undertaken in this Chapter has yielded the following conclusions.

First, a participatory theory in which the First Amendment is seen to be advancing public decisionmaking in a democracy suggests that expressive uses of the celebrity identity, particularly by subaltern groups, that contribute to democratic processes have a higher constitutional value than either artistic speech or entertainment. This observation is reinforced by the Supreme Court’s consistent positioning of political speech at the apex of the speech hierarchy. The cultural studies analysis of politically expressive uses of the celebrity identity also augments the participatory argument that political speech ought to be given greater weight in the First Amendment defence as articulated in right of publicity claims.

Second, in the absence of clear Supreme Court precedent governing the treatment of free speech arguments by non-media defendants in publicity claims, lower courts have developed various tests that do not cohere with the prevailing speech hierarchy that appears to accord political speech the highest constitutional value. Most of First

230 See above n 186 and accompanying text.
Amendment jurisprudence is focused on an examination of governmental control of speech, but this Chapter has examined the private control of speech through right of publicity laws with the assistance of the lens of cultural studies. Its major conclusion is that existing tests under the First Amendment defence as argued in publicity claims do not make a clear distinction between the constitutional value of different kinds of speech, and consequently can unduly restrict political speech.

Third, the broad definition of political speech in First Amendment jurisprudence would easily encompass the recoding of celebrity signs by counterpublics that enables ‘the practice of persons sharing common views banding together to achieve a common end [which] is deeply embedded in the American political process.’\footnote{NAACP, 458 US 886, 906 (1982). See above nn 44-46 and accompanying text.} As such, cultural studies can inform the revision of existing judicial tests to better take into account the content, form and context of politically expressive uses of the celebrity identity when engaging in an evaluation of the conflict between property and speech rights.

However, a cautionary note is warranted about the judicial use of cultural studies. In reaching its decision in ETW Corp, the Sixth Circuit majority departed from the traditional examination of the clash between publicity and First Amendment rights, and attempted – in a most unsatisfactory and inadequate manner – to import cultural studies into its judicial reasoning. The court dedicated just three paragraphs to a cursory mention of the symbolic value of the celebrity sign and the associative value of Woods’ identity,\footnote{ETW Corp, 332 F 3d 915, 938 (6th Cir, 2003).} without any discussion of the uses of the celebrity sign by audiences in their interpretive practices. If the court were to consider the political significance of recoded celebrity signs and the consequent constitutional value of the defendant’s speech that incorporated Woods’ identity, the outcome in ETW Corp might have been different. Unfortunately, the court devoted much of its analysis to the rationales for recognising a right of publicity\footnote{Ibid 931-38. Contra ibid 955 (Clay J dissenting) (‘Despite various commentary and scholarship … the fact remains that the right of publicity is an accepted right’).} instead of how social groups use the celebrity personality as a communicative resource in a manner that deserves First Amendment protection.\footnote{Passing comments were made with regard to the use of the celebrity personality as an important expressive and communicative resource to ‘symbolize individual aspirations, group identities and cultural values’, but no further analysis was undertaken of what particular uses merit First Amendment protection. Ibid 935.}
type of brief reference to cultural studies as ex-post facto rationalisation is not a desirable practice.235 But, as this Chapter has shown, judicial reference to cultural studies could be much more productive.

In conclusion, this Chapter has demonstrated that cultural writings on the political value of the celebrity sign, its meaning and potential uses by counterpublics or subaltern groups, can add to the richness of First Amendment jurisprudence. It adds to the legal scholarship through its examination of the potential importance of the celebrity sign in political advocacy efforts and its illustration of how these insights may be incorporated into the judicial tests. Courts like the Sixth Circuit can benefit from a structured analysis of how cultural studies may be meaningfully integrated into the First Amendment defence. Regardless of the confusing morass that may surround the application of First Amendment considerations to a right of publicity claim,236 recognising the potential of the celebrity sign to function as a political site of contestations offer valuable assistance to the refinement of the current tests.

235 Jones, above n 76, 957 (‘in many instances the courts’ reasoning is result oriented, with the court creating a test that validates the result it wants to reach in the given case’).
236 See above nn 1-2.
While right of publicity doctrine does take into account the myriad interests of the constituents of the celebrity trinity, it tends to address primarily the tension between the celebrity individual and the cultural producers when determining whether there was actionable commercial appropriation of the value of identity. The presumption of prima facie liability upon identification of the celebrity individual arguably assigns a less significant role to the audience-consumer. Ultimately, as evident in recent Circuit and state court decisions, the inquiry shifts to an evaluation of the availability of a free speech defence. The interests of audiences tend to be examined as speakers together with those of the producers, rather than as consumers, through the rhetoric of free speech which includes the First Amendment defence, as well as the newsworthiness exemption and other statutory exclusions. In contrast, the common law passing off action considers the interests of all three constituents simultaneously when evaluating the commercial implications of an unauthorised use of identity and subsequent liability based on a misrepresentation to the audience of an association between the celebrity individual and the producer.

The recognition of a proprietary interest in the identity of a well-known individual in right of publicity doctrine is analogous to the recognition of a proprietary interest in goodwill or reputation of the celebrity in a common law passing off claim. Both actions acknowledge that the law should protect the commercial interests of these individuals and prevent unlawful profiting. However, it is established law that a right of publicity claim does not require any evidence that a consumer is likely to be confused as to the plaintiff’s association with or endorsement of the defendant’s use. Therefore it appears more expansive in its protection against an unauthorised use of identity compared to a common law passing off claim. Celebrities in common law jurisdictions like the United Kingdom (UK) and Australia generally rely on the action of passing off and equivalent statutory claims if their identities have been used without their consent in advertising or trade as

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the right of publicity is not recognised in these jurisdictions.\(^2\) In addition, section 52 of the \textit{Trade Practices Act 1974} (Cth) provides a statutory remedy for Australian plaintiffs.\(^3\) Unlike in a right of publicity claim, it is necessary to show in passing off that consumers have been misled or deceived as to the celebrity’s endorsement of, or association with, the defendant’s products. It is important to note that the common law passing off action finds an equivalent in the US, where the broad language of the federal \textit{Lanham Act} § 43(a) creates a civil cause of action against any person who identifies his or her product in such a way as to likely cause confusion among consumers or to cause consumers to make a mistake or to deceive consumers as to the association of the producer of the product with another person or regarding the origin of the product or the sponsorship or approval of the product by another person.\(^4\) Plaintiffs in the US often invoke § 43(a) to protect intellectual property rights in ‘trademarks’ or ‘marks’, but it is increasingly used by celebrities ‘to vindicate property rights in their identities against allegedly misleading commercial use by others.’\(^5\)

This Chapter contends that the extended common law passing off action, as presently recognised by the courts in the UK and Australia, provides adequate protection against unlawful exploitation of the celebrity persona. It follows from the analyses in Chapters 2 to 5 and draws on the findings that are relevant to the passing off action. Part I


\(^3\) In Australia, plaintiffs often bring concurrent actions in passing off and for misleading or deceptive conduct under section 52 of the \textit{Trade Practices Act 1974} (Cth) (“\textit{TPA}”). Although the TPA confers wider protection and is more flexible in its remedies, it is generally similar enough to common law passing off to be discussed together. The Australian High Court has often addressed the issue of misrepresentation under both common law passing off and the TPA simultaneously. Eg \textit{Parkdale Custom Built Furniture Pty Ltd v Puxa Pty Ltd} (1982) 149 CLR 191, 219 (“Puxa”); \textit{Hornsby Building Information Centre Pty Ltd v Sydney Information Centre Pty Ltd} (1978) 140 CLR 216, 227; Scott Ralston, ‘Australian Celebrity Endorsements: The Need for an Australian Right of Publicity’ (2001) 20(4) \textit{Communications Law Bulletin} 9, 9; David Tan and J Thomas McCarthy, ‘Australia – Protecting goodwill and reputation’ in J Thomas McCarthy, \textit{The Rights of Publicity and Privacy} (2nd ed, 2000) § 6:158. See also \textit{Campanor Sociedad Limitada v Nike International Ltd} (2000) 2002 CLR 45, 88 (“\textit{Campanor}”) (“Section 52 is designed to protect consumers, However, passing off, at least so far as concerns equitable relief, protects injury to the goodwill built up by activities of the plaintiff”).

\(^4\) 15 USC § 1125(a).

\(^5\) Parks, 329 F 3d 437, 445 (6th Cir, 2003). See also Parks, ibid 447 (noting that ‘courts routinely recognize a property right in celebrity identity akin to that of a trademark holder under § 43(a)’). There appears to be a growing trend in celebrities filing concurrent right of publicity and \textit{Lanham Act} claims for unauthorised commercial uses of their identity. Eg White v Samsung Electronics America Inc, 971 F 2d 1395, 1399-400 (9th Cir, 1992) (“White I”); \textit{Waits v Frito Lay Inc}, 978 F 2d 1093, 1110 (9th Cir, 1992) (“\textit{Waits}”); Abdul-Jabbar, 85 F 3d 407, 410 (9th Cir, 1996); \textit{Landham v Lewis Galoob Toys Inc}, 227 F 3d 619, 626 (6th Cir, 2000) (“\textit{Landham}”); \textit{Allen v National Video Inc}, 610 F Supp 612, 624-5 (SD NY, 1985) (“\textit{Allen}”).
outlines the elements of the modern extended passing off action as applied by courts. Part II discusses how insights from cultural studies can contribute to a better understanding of the first key element of the passing off claim – the subsistence of local goodwill. It contends that the subsistence of promotional goodwill in a celebrity persona may reside in a wide range of evocative indicia of identity as long as they are readily identifiable by the relevant segment of consumers. Part III discusses how courts have increasingly adopted an impressionistic approach to determining the second element of the claim – misleading or deceptive conduct. It further argues that this approach to the issue of misrepresentation may be supported by cultural studies perspectives on the transfer of affective meanings from the celebrity sign to the celebrity-related product in contemporary consumption. Part IV examines the relevance of these cultural perspectives to the element of damage and argues that the protection of the semiotic freight embodied by a celebrity persona in the context of commercial consumption can support a broader interpretation of damage. Finally, Part V concludes that the focus on the impression that is created in the minds of consumers in a passing off action can overcome some of the doctrinal objections to characterising indicia of identity as personal property, and the element of misrepresentation – which requires courts to examine whether in fact the affective meanings of a celebrity persona have been transferred as a result of consumers perceiving an endorsement, approval or association of a celebrity plaintiff with the defendant’s products – is consonant with contemporary consumption of the celebrity commodity.

I THE EXTENDED PASSING OFF ACTION

The view in a number of common law jurisdictions like the UK and Australia is that there is no actionable proprietary right in one’s identity equivalent to the right of publicity in the United States. The classic common law tort of passing off was originally intended to protect against rival traders in the same field of business ‘passing off’ their products as the products of another competitor (‘trading goodwill’), with its rationale being the prevention of commercial dishonesty. Subsequently, passing off has broadened

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7 Eg Reddaway (Frank) & Co Ltd v George Banham & Co Ltd [1896] AC 199, 204 (“Reddaway”); Erven Warnink BV v J Townsend & Sons (Hull) Ltd [1979] AC 731, 742 (“Erven Warnink”); Irvine, ibid 2360. See also Tan & McCarthy, above n 3; Alison Laurie, ‘The Big Sell: The Value and
to protect goodwill ‘not in its classic form of a trader representing his goods as the goods of somebody else, but in an extended form.’\textsuperscript{8} In the UK, it appears settled law that the extended action of passing off today does not require the plaintiff to prove a common field of activity;\textsuperscript{9} and it appears that the passing off action is capable of protecting the goodwill or valuable reputation of a person/business against any unauthorised claim of association or connection by another (‘promotional goodwill’).\textsuperscript{10} This position resonates with the Australian cases.\textsuperscript{11}

The passing off action does not recognise a proprietary interest per se in a name, likeness or other indicia of identity,\textsuperscript{12} but it protects goodwill as ‘the attractive force which brings in custom’\textsuperscript{13} by preventing a trader from gaining an unfair competitive advantage through associating itself or its products with a well-known personality. In order for a celebrity to obtain legal recourse for interference with his or her goodwill, the claimant must prove all the elements of the passing off tort. Despite there being ‘no generally accepted definition of passing off’, the element of misrepresentation or misleading/deceptive conduct is considered to be ‘central to the tort’.\textsuperscript{14} However, the misrepresentation must relate to the plaintiff’s goodwill and harm it in some way, and

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\item Erven Warnink, ibid 739. However, one commentator has argued that the early cases revealed ‘clear signs of the courts’ willingness to protect valuable personal reputations … [and] it is apparent that the law of passing off has not changed substantially since these early times’. See Ian Tregoning, ‘What’s In A Name? Goodwill in Early Passing-Off Cases’ (2008) 34 Monash University Law Review 75, 101.
\item Eg Samuel K Murumba, Commercial Exploitation of Personality (1986) 65. See also Arsenal FC plc v Reed [2001] RPC 922, 930-1.
\item This is in contrast to the right of publicity where an unauthorised commercial use of identity is perceived to be a tortious interference with a property right. Eg Haelan Laboratories Inc v Topps Chewing Gum Inc, 202 F 2d 866 (2nd Cir, 1953); White I, 971 F 2d 1395 (9th Cir, 1992); Waits, 978 F 2d 1093 (9th Cir, 1992); Abdul-Jabbar, 85 F 3d 407 (9th Cir, 1996).
\item Inland Revenue Commissioners v Muller & Co’s Margarine Ltd [1901] AC 217, 224 (‘Muller’). See also Federal Commissioner for Taxation v Murry (1998) 193 CLR 605, 615 (‘Murry’).
\item Halsbury’s Laws of Australia (2008) [240-4510]. See also ConAgra Inc v McCain Foods (Aust) Pty Ltd (1992) 33 FCR 302, 356 (‘ConAgra’) (it ‘contains sufficient nooks and crannies to make it difficult to formulate any satisfactory definition’); Irvine [2002] 1 WLR 2355, 2360 (it ensures ‘a degree of honesty and fairness in the way trade is conducted’).
\end{itemize}
“mere misrepresentation/confusion alone is not sufficient”.\textsuperscript{15} The elements of a common law passing off action in both the UK and Australia follow the position set out by the House of Lords in \textit{Reckitt & Colman Products Ltd v Borden Inc}\textsuperscript{16} in that there are three key elements of goodwill or valuable reputation, misrepresentation or deceptive conduct and damage.\textsuperscript{17} Over the last two decades, the courts have increasingly recognised that it is a prevalent commercial practice ‘whereby, to gain a competitive advantage, goods and services are marketed to the public by associating them with a well-known personality, real or fictitious … who has developed an identifiable reputation among potential purchasers … [thus appearing] more desirable to consumers.’\textsuperscript{18} However, although it has been noted that ‘passing off has been expanded further by Australian courts than most other countries … in keeping with the corresponding development in the practice of character merchandising’,\textsuperscript{19} the courts there, as well as in the UK, have consistently rejected the recognition of a general tort of unfair competition.\textsuperscript{20}

It is generally accepted that consumers are often influenced in their choice of products because of a perceived association between those products and a celebrity personality. As an Australian federal court judge remarked, the use of celebrities in advertising seeks to ‘foster favourable inclination towards [the product], a good feeling about it, an emotional attachment to it’ such that the product is ‘better in [the] eyes’ of consumers than a comparable product without such an association.\textsuperscript{21} The typical celebrity claims made in passing off actions are that the use of name, likeness, voice or other indicia of identity mislead a significant proportion of consumers by implying:

(i) that the celebrity \textit{approved} of the advertiser/trader or its product;

(ii) that the celebrity \textit{consented} to the use of his/her identity by the advertiser/trader; or

\textsuperscript{15} Hazel Carty, ‘Heads of Damage in Passing Off’ (1996) 18 \textit{European Intellectual Property Review} 487, 487. See also \textit{Anheuser-Busch Inc v Budejovicky Budvar NP} [1984] FSR 413 (‘Budweiser case’).

\textsuperscript{16} [1990] 1 All ER 873 (‘Reckitt & Colman’).


\textsuperscript{18} Laurie, above n 7, 12.

\textsuperscript{19} Ibid 12.


\textsuperscript{21} \textit{Crocodile Dundee case} (1989) 25 FCR 553, 583-4 (Burchett J).
(iii) that there is some \textit{connection or association} between the celebrity and the advertiser/trader (impressionistic association).

Over the last decade, there have been relatively few passing off claims by celebrities in the UK or Australia, compared to the right of publicity litigation in the US. The most high profile case arguably is Formula One driver Eddie Irvine’s claim against Talksport for using a digitally altered photograph of him holding a portable radio bearing the name of the radio station in a promotional brochure. Commentator Hazel Carty, in a comparative analysis of publicity rights and passing off, has remarked that Irvine ‘signals a marked advance in [celebrities’] quest for image rights’ but the ‘problem with the discussion in Irvine is that a tight definition of “endorse” is not applied.’ Irvine was awarded damages at first instance amounting to £2,000, but this was increased to £25,000 on appeal, being the ‘reasonable endorsement fee’ the defendant ‘would have had to pay in order to obtain lawfully that which it in fact obtained unlawfully’. The decision of Laddie J at first instance, with its ringing endorsement of the Australian case of \textit{Henderson v Radio Corporation Pty Ltd} in eliminating the need to show a common field of activity, suggest that the English and Australian cases may be converging in the area of passing off claims by well-known individuals. It is also important to note that Laddie J’s views appear to have been accepted by the English Court of Appeal. Although Laddie J does not refer to the Australian passing off cases involving claims by celebrities like Paul Hogan and Kieren Perkins, his judgment indicates that the English courts may be prepared to go as far as the Australian courts in finding that impressionistic association may suffice as misrepresentation in the context of the use of celebrity images in advertisements. In particular, Laddie J observes,

\begin{itemize}
  \item the court can take judicial notice that it is common for famous people to exploit their names and images by way of endorsement … those in business have reason to believe that the lustre of a famous personality, if attached to their goods or
\end{itemize}

\begin{flushright}
\textbf{References:}
\begin{enumerate}
  \item \textit{Irvine} [2002] 1 WLR 2355.
  \item Ibid 256.
  \item \textit{Irvine v Talksport Ltd (Damages)} [2003] 2 All ER 881, 903 (‘\textit{Irvine (Damages)}’).
  \item \textit{Irvine} [2002] 1 WLR 2355, 2365, 2368.
  \item \textit{Irvine (Damages)} [2003] 2 All ER 881, 887.
  \item See discussion in Parts II and III below.
\end{enumerate}
\end{flushright}
services, will enhance the attractiveness of those goods or services to their target market.\textsuperscript{29}

One should note that \textit{Irvine} is a factually straightforward celebrity false endorsement case, and the court’s observations need not be applicable to all passing off cases. The dicta merely indicates that courts may adopt, as evident in the Crocodile Dundee litigation in Australia,\textsuperscript{30} a less stringent view of misrepresentation when the celebrity persona has been used by the defendant in advertising and merchandising.

From a cultural studies perspective, it may be argued that the passing off action correctly focuses on the interrelationships between the celebrity individual, producers and audiences in determining legal liability, whereas the right of publicity appears more concerned with conferring and protecting a property right of the celebrity individual from being interfered with by free-riding producers. Based on a number of contentious rationales like Lockean labour and unjust enrichment justifications,\textsuperscript{31} the recognition by right of publicity laws that a well-known individual is entitled to a property right over the indicia of his or her commercially valuable persona has encountered fervent criticisms.\textsuperscript{32} In not regarding identity to be a property right, the passing off action offers a less controversial approach to enforcing one’s interest against unauthorised commercial exploitation of identity only under the conditions where the associative value of identity has been misappropriated. Rather than rely on a presumption,\textsuperscript{33} the passing off action requires courts to examine the impact of an unauthorised use of identity on audiences in the determination of liability. As Laddie J has emphasised in \textit{Irvine}, what is at issue in a passing off claim is the ‘likely effect’ of the defendant’s use of the celebrity persona on the intended consumer segment.\textsuperscript{34}

\textsuperscript{29} \textit{Irvine} [2002] 1 WLR 2355, 2368.
\textsuperscript{33} As highlighted in Chapter 4 Part IB, it is presently accepted by the courts, in right of publicity cases, that the defendant should be held liable because ‘it received a benefit by getting to use a celebrity’s name for free in its advertising’ or when the celebrity’s identity is used ‘to attract the consumers’ attention.’ Eg \textit{Eastwood v Superior Court of Los Angeles County}, 149 Cal App 3d 409, 420 (1983) (‘Eastwood’); \textit{Abdul-Jabbar}, 85 F 3d 407, 416 (9th Cir, 1996); \textit{Henley}, 46 F Supp 2d 587, 597 (ND Tex, 1999).
\textsuperscript{34} \textit{Irvine} [2002] 1 WLR 2355, 2376.
Drawing on the observations in the previous chapters, the next three Parts argue that the key elements in passing off doctrine finds strong support in cultural studies for their potential to take into account the celebrity trinity as well as the research findings on contemporary consumption behaviour.

II GOODWILL AND WELL-KNOWNNESS OF THE CELEBRITY

A Existence of Local Goodwill

The threshold requirement of goodwill is analogous to the issue of identification in a right of publicity claim. Although the courts have conceded that ‘goodwill’ was ‘a thing very easy to describe, very difficult to define’, it is accepted that the issue is usually a question of whether the plaintiff has the requisite local goodwill or reputation to support an action in passing off where it is shown that a substantial number of people would consider the name, get-up or other indicia to be distinctive of the goods or services of the plaintiff. In advertising or merchandising involving celebrity personalities, as the property protected in passing off is the goodwill or reputation which attaches to the name, likeness or other indicia of identity rather than property in those indicia themselves, the passing off action, unlike the right of publicity, does not protect any commercial exploitation right per se in the indicia of identity. As the Australian High Court has emphasised, ‘goodwill is not something which can be conveyed or held in gross; it is something which attaches to a business’.

In a passing off claim, a celebrity has to show that he or she has a protectable commercial goodwill or reputation within a particular area or location in which the relevant misrepresentation is alleged to have taken place. The terms ‘goodwill’ and

36 Eg Reckitt & Colman (1990) 1 All ER 873, 880; ConAgra (1992) 33 FCR 302, 346-50.
38 In Australia, it is not necessary for the plaintiff to have a business presence in Australia; it is sufficient that he or she has a reputation among the persons there. Eg ConAgra (1992) 33 FCR 302, 340-4. The specific thing in which goodwill is vested must also be identified. Eg Conan Doyle v London Mystery Magazine Ltd (1949) 66 RPC 312, 313-4 (goodwill only in existing stories and not generally in all aspects of Sherlock Holmes character).
reputation’ have been used interchangeably. In other words, it is recognised that the reputation of a plaintiff in the forum is the source of his potential business there; and a ‘sufficient reputation’ to be actionable ‘requires something more than a reputation among a small number of persons’. So far the celebrities who have brought a passing off claim in UK and Australia – like Eddie Irvine, Paul Hogan and Kieren Perkins – have previously exploited their goodwill through endorsements. Unlike the inquiry pertaining to commercial traders, the question of ‘what form of activity on the part of the plaintiff is required before it can be said that he has a “business” here to which goodwill can attach?’ should not be relevant in cases where the celebrity individual brings a passing off claim. The celebrity individual often does not manufacture or trades in a particular product. The actionable goodwill of celebrities lie in their commercial potential or associative value at the time when passing off is alleged. Even for celebrities who have not previously exploited their fame through endorsements, cultural studies perspectives would support a finding of goodwill based on their well-knownness to audiences and the affective meanings that their personae embody. For most individuals who have become well-known to the public through their endeavours in the fields of sports, entertainment or popular culture, it appears that they will have no problem satisfying the first element of a common law passing off claim in the UK or Australia. Expert evidence, survey evidence and results from focus groups are often admitted as evidence used to prove the subsistence of goodwill.

In Henderson v Radio Corp, in arriving at the conclusion that the professional ballroom dancing couple has the requisite protectable reputation, the Supreme Court of New South Wales in Australia examined the ‘publicity [the plaintiffs] received through their public performances, personal and on television, through their lectures and

40 ConAgra, ibid 346.
41 Eg Budweiser case [1984] FSR 413, 465. See also Star Industrial Company Limited v Yap Kwee Kor [1976] FSR 256, 269 (‘Yap’).
43 However, courts are more reluctant to place great weight on expert testimony and survey evidence as proof of misrepresentation. Eg Britt Allcroft (Thomas) LLC v Miller (2000) 49 IPR 7, 15-6. See further Halsbury’s Laws of Australia (2008) [240-4595] fn 8.
demonstrations, and by means of articles, photographs and advertisements which have appeared in the press. It does not matter to the courts how the goodwill of a celebrity has become fixed in the minds of the relevant section of the public, as long as it has gained a distinctive character recognised by the public through repeated exposure in the entertainment and communications media.

B Identification of the Celebrity

The House of Lords has recognised that the tort of passing off is ‘wide enough to encompass other descriptive material, such as slogans or visual images … provided always that such descriptive material has become part of the goodwill of the product.’ Similarly, the Australian High Court, in a unanimous decision, has recognised

the adaptation of the traditional doctrine of passing off to meet new circumstances involving the deceptive or confusing use of names, descriptive terms or other indicia to persuade purchasers or customers to believe that goods or services have an association [with], quality or endorsement [of] … another.

Although passing off cases in the UK and Australia have yet to consider evocative aspects of identity to the extent that right of publicity cases like White v Samsung have in the US, it appears that evocative aspects of identity – like the ‘Here’s Johnny’ slogan in Carson v Here’s Johnny Portable Toilets and the distinctive racing car in Motschenbacher v RJ Reynolds Tobacco Company – which allow a relevant section of the public to identify a particular celebrity would be ‘protected’ in passing off as long as the celebrity meets the local standard of goodwill/reputation. In fact, Pincus J of the Australian Federal Court made explicit reference to Motschenbacher: that where a well-known personality may be identified by consumers through indicia associated with him, it is open to the plaintiff then to show wrongful association of goods with him. On the

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44 Henderson (1960) SR(NSW) 576, 579.
45 E.g. Hutchence (1986) 6 IPR 473; Twentieth Century Fox Film Corp v South Australian Brewing Co Ltd (1996) 34 IPR 225, 230-2 (‘Duff Beer case’).
48 698 F 2d 831 (6th Cir, 1983).
49 498 F 2d 821 (9th Cir, 1974).
other hand, despite the plaintiff being a well-known personality, there can be no liability if the plaintiff was not sufficiently identified by a significant segment of the target audience from the defendant’s use. This first element of passing off mirrors the threshold requirement of identification in a right of publicity claim (as discussed in Chapter 3).

The reasoning in two Australian cases involving a lookalike and a role played by a celebrity plaintiff suggest that courts there are willing to extend the passing off action to cover evocative indicia of identity. Such an observation resonates with the likeness appropriation in right of publicity cases like Onassis v Christian Dior-New York Inc and Allen v National Video Inc, where the New York courts in both cases found that the unauthorised use of lookalikes constituted an infringement of the New York Civil Rights Law § 50. In the same vein, the Third Circuit has held that a right of publicity action was available to an individual where a role or character was inextricably identified with him or her. In Newton-John v Scholl-Plough, the Australian Federal Court had to decide whether an advertisement featured an Olivia Newton-John lookalike with the slogan ‘Olivia? No, Maybelline’ in ‘large and striking letters’ constituted passing off. The court acknowledged that Maybelline had ‘[made] use of elements which belong to the reputation of [the celebrity]’ and there was ‘an appropriation of the appearance of the applicant’. It was held that

the casual reader would get the impression that indeed the advertiser had made use of Olivia Newton-John’s reputation to the extent of gaining attention, but not to the extent of making any suggestion of an association.

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51 10th Cantanae Pty Ltd v Shoshana Pty Ltd (1987) 79 ALR 299, 302-3, 308 (‘10th Cantanae’). The majority required that the plaintiff be ‘unequivocally’ or ‘plainly’ identified from the defendant’s advertisement. Contra Shoshana Pty Ltd v 10th Cantanae Pty Ltd (1987) 18 FCR 285, 291 (where the trial judge found that ‘many readers … would associate an advertisement concerned with television, and picturing an attractive brunette, with the well-known television image of Sue Smith’).

52 472 NYS 2d 254 (NY Sup Ct, 1984) (‘Onassis’).

53 610 F Supp 612 (SD NY, 1985) (‘Allen’).

54 McFarland v Miller, 14 F 3d 912, 920-1 (3rd Cir, 1994).

55 Newton-John v Scholl-Plough (Australia) Ltd (1986) 11 FCR 233, 234 (‘Newton-John’). The advertisement also contained the words: ‘For the “Olivia Look” use “Blooming Colours” Neapolitan Frosts eyeshadows … Maybelline makes anything possible.’

56 Newton-John, ibid 234 (citing Radio Corporation Pty Ltd v Disney (1937) 57 CLR 448, 457).

57 Ibid.

58 Ibid 235. Contra Eastwood, 149 Cal App 3d 409, 420 (1983) (‘Because of a celebrity’s audience appeal, people respond almost automatically to a celebrity’s name or picture … To the extent their use attracted the readers’ attention, the Enquirer gained a commercial advantage’).
In *Pacific Dunlop v Hogan*, a parodic television commercial evoked the character Mick Dundee, the screen persona of actor Paul Hogan.\(^59\) Although the court was split on the issue of misrepresentation, all justices were of the view that the well-known knife scene from the *Crocodile Dundee* movie evoked by the advertisement grabbed audiences’ attention, and had exploited the substantial commercially valuable goodwill of the character created and played by Hogan.\(^60\) The actor in the television commercial bore no facial resemblance to Hogan but the distinctive elements of the clothes worn were identifiable as those worn by Mick Dundee in the movie. By holding that an unauthorised evocation of the distinctive clothes and mise-en-scène may constitute an appropriation of goodwill, this aspect of the decision finds its parallel in the right of publicity cases like *Wendt* (where animatronic figures in a *Cheers* bar setting evoked the actors), *White* (where the presence of the *Wheel of Fortune* set evoked Vanna White) and *Motschenbacher* (where a distinctive racing car evoked the driver).

### C  Cultural Studies and the Value of Well-knownness

In Chapters 2 and 3, it was observed that the ubiquitous circulation in contemporary society of an individual’s name, image or other distinctive characteristics can result in that individual gaining an ever-increasing familiarity amongst members of the public, thus becoming ‘well-known’.\(^61\) The judicial evaluation of whether the plaintiff has established the requisite local goodwill or reputation takes into account precisely these channels of communication, considering a wide range of media exposure from print publicity to advertising circulation, as well as television audience figures indicated by ratings.\(^62\)

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\(^59\) *Crocodile Dundee* case (1989) 23 FCR 553. Similarly, a koala image in a ‘Dundee Country’ setting was held to be evocative of the Mick Dundee character from the same movie. *Koala Dundee* (1988) 20 FCR 314, 323, 327.

\(^60\) Ibid 567-9, 575-7, 583-4. By a 2-to-1 majority, the Federal Court found that misrepresentation was made out and Paul Hogan succeeded in his passing off claim.


\(^62\) Eg *Duff Beer* case (1996) 34 IPR 225, 230-2; Irvine [2002] 1 WLR 2355, 2370-3. In a more recent case, the court examined press and radio interviews, fan mail and television appearances. See *Knight v Beyond Properties Pty Ltd* [2007] FSR 813, 831-2 (‘Knight’).
It has been demonstrated in earlier chapters that celebrities possess particular configurations of meanings; and can ‘offer peculiarly powerful affirmations of belonging, recognition, and meaning in the midst of the lives of their audiences’.\(^{63}\) For example, because of the ‘semiotic freight’\(^{64}\) embodied by a well-known movie star, these positive cultural meanings translate to an economic value (i.e. promotional goodwill) when the celebrity is attached to or associated with a particular film, event or product. Consumers are said to be able to ‘shap[e] a sense of self through the object of fandom’ by consuming such commodities associated with celebrities.\(^{65}\) As Ellis Cashmore contends, ‘having the approval of a celebrity may convince some consumers that they are buying something authentic, substantial, or even profound’ and points out that ‘[v]alue doesn’t exist in any pure form: products are invested with value.’\(^{66}\)

This cultural studies perspective that the positive semiotic meanings of a particular well-known celebrity can be transferred to products that he or she is seen to be associated with has been implicitly endorsed by recent judicial observations.\(^{67}\) In its threshold evaluation of whether the plaintiff enjoys the requisite local goodwill based on a geographical delimitation, passing off can quickly dispose of claims where the plaintiff is not a well-known individual who possesses a commercially valuable reputation to exploit. Thus, like in the right of publicity cases where the defendants were granted summary judgment on the grounds that the plaintiffs were not well-known personalities,\(^{68}\) a similar result would also be expected in passing off on the basis of the absence of goodwill. By focusing on goodwill, the passing off action dispenses with the debate about

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\(^{64}\) Madow, above n 32, 128.


\(^{66}\) Cashmore, above n 63, 167.

\(^{67}\) Eg Irvine [2002] 1 WLR 2355, 2368.

\(^{68}\) Eg DeClemente v Columbia Pictures Industries Inc, 860 F Supp 30, 53 (ED NY, 1994) (‘DeClemente’) (“The plaintiff’s public personality as the Karate Kid simply has not reached the magnitude of public notoriety necessary to be actionable … and is known as the Karate Kid only to a small group of people’); Pesina v Midway Manufacturing Co, 948 F Supp 40, 42-3 (ND Ill, 1996) (the plaintiff ‘is not a widely known martial artist and the public does not even recognize him as a model for Johnny Cage [the video game character]’).
the recognition of a proprietary right of publicity in evocative aspects of identity.\textsuperscript{69}

Unlike passing off disputes between commercial traders, where the absence of business activities may be an indication of a lack of local trading goodwill,\textsuperscript{70} the unique position of celebrities in that they do not trade but instead lend their affective aura to products and services demands a different analysis of this kind of promotional goodwill. The more exacting requirement of local business activity in the Budweiser case, decided over 25 years ago\textsuperscript{71} is inapposite in its application to the contemporary celebrity phenomenon. The ABBA case, decided over 30 years ago, is also out of step with transnational appeal of many celebrities today.\textsuperscript{72} Julie King argues that, in light of ABBA’s mass popularity as demonstrated by their record sales, “it seems extraordinary to maintain that ABBA had no business in the U.K. and therefore no goodwill.”\textsuperscript{73}

The goodwill inquiry should not be focused on whether there was prior commercial exploitation of the celebrity persona in terms of endorsements or merchandising, but rather on whether the plaintiff was well-known in the jurisdiction based on promotional or publicity campaigns, television appearances, radio or newspaper interviews, as well as internet presence.\textsuperscript{74} This proposition is supported by the House of Lord’s decision in IRC v Muller & Co’s Margarine Ltd, which has often been cited as the leading English case that definitively laid out the principles of goodwill, which includes regarding goodwill as ‘whatever adds value to a business by reason of … name and reputation’.\textsuperscript{75} In a comprehensive survey of English and Australian decisions, the

\textsuperscript{69} Eg White I, 971 F 2d 1395 (9th Cir, 1992); Wendt, 125 F 3d 806, 814 (9th Cir, 1997). Arguably the controversy also surrounds the property right in a role or character. Eg McFarland v Miller, 14 F 3d 912 (3rd Cir, 1994); Lugosi, 25 Cal 3d 813 (1979); Nurmi v Peterson, 1989 WL 407484 (CD Cal, 1989); Peter K Yu, ‘Fictional Persona Test: Copyright Preemption in Human Audiovisual Characters’ (1998) 20 Cardozo Law Review 355.


\textsuperscript{71} Budweiser case [1984] FSR 413, 470. The court held that goodwill should not be equated with ‘mere reputation which may, no doubt, and frequently does, exist without any supporting local business, but which does not by itself constitute a property which the law protects’.

\textsuperscript{72} Lyngstad v Anabas Products Ltd [1977] FSR 62, 64 (‘Lyngstad’) (finding that the pop group ABBA lacked the requisite local goodwill).

\textsuperscript{73} Julie King, ‘The Protection of Personality Rights for Athletes and Entertainers under English Intellectual Property Law: Practical Difficulties in Relying on an Action of Passing Off’ (2000) 7 Sports Lawyers Journal 351, 361. King also argues that existing case law suggests that the possibility existed for the court to recognise that ABBA had the requisite goodwill in the UK. Ibid 362, 365.

\textsuperscript{74} See, eg, the court’s recent examination of some of these channels of communication when determining whether an author possessed the requisite goodwill in Knight [2007] FSR 813.

\textsuperscript{75} Muller [1901] AC 217, 235. See also Yap, above n 70, 451.
Singapore Court of Appeal observed that ‘[i]t is the goodwill between a trader and his customers which is protected’,\textsuperscript{76} this suggests that evidence of widespread audience recognition and affectation for the celebrity can support a finding of goodwill. Moreover, the court also urged a ‘commonsense approach’ to the issue of goodwill that is ‘in line with commercial reality’.\textsuperscript{77} In the US, celebrities like Tom Waits\textsuperscript{78} who have consistently shunned commercial endorsements were held to have an actionable Lanham Act § 43(a) claim. What is important is the commercial potential of the well-known individual because of the ‘semiotic freight’ of his or her public persona.\textsuperscript{79} Waits should be held to possess the requisite goodwill in the UK or Australia as long as he is well-known in the relevant forum.\textsuperscript{80} Likewise, Jacqueline Kennedy Onassis who was found by the New York court to be ‘a well-known personality in her own right’\textsuperscript{81} and whose persona was ‘endow[ed] … with the qualities of charisma, sophistication, elegance, trend-setting and uniqueness’\textsuperscript{82} should also be able to satisfy the requirement of goodwill in a passing off claim. More recently, it was held that ‘where a trader ceases to carry on his business he may none the less retain for at any rate some period of time the goodwill attached to that business’.\textsuperscript{83} It seems that so long as the court has determined that there is goodwill subsisting in connection with the claimant’s potential reactivation of the business, it would be prepared to enforce the claimant’s rights in respect of any name or image which is attached to that goodwill.

Nonetheless, courts still have to confront the question whether the plaintiff has been identified by the relevant group of consumers through the defendant’s use. However, this inquiry may sometimes be deferred to the misrepresentation stage, where the court would determine if, based on an overall impression, consumers were misled as to the

\textsuperscript{76} CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550, 567.
\textsuperscript{77} Ibid 572.
\textsuperscript{78} Waits, 978 F 2d 1093, 1097 (9\textsuperscript{th} Cir, 1992) (‘Waits does not, however, do commercials. He has maintained this policy consistently during the past ten years, rejecting numerous lucrative offers to endorse major products.’).
\textsuperscript{79} Madow, above n 32, 138.
\textsuperscript{80} The law will not protect ‘the goodwill which any reasonable person would consider trivial’. See Sutherland v V2 Music Ltd [2002] EMLR 28 at [22]. In practice, the court will look to find at least one customer to help establish that a foreign plaintiff has the requisite goodwill. Athlete’s Foot Marketing Association v Cobra Sports Ltd [1980] RPC 343, 347.
\textsuperscript{81} Onassis, 472 NYS 2d 254, 256 (NY Sup Ct, 1984).
\textsuperscript{82} Ibid 262. Like Waits, the former First Lady ‘has never permitted her name or picture to be used in connection with the promotion of commercial products’. Ibid 257.
celebrity plaintiff’s approval of the product. For example, from the facts in White, it is clear that Vanna White would satisfy the requirement of goodwill in a passing off claim. But it is open whether consumers would have the impression that the robot in a blond wig conveys her endorsement of or personal association with Samsung; the court does not have to confront the question of whether White has a property right in a robot, or in the image of a man or monkey in the particular get-up.

Generally, like the issue of identification in a right of publicity claim, goodwill should not be a significant hurdle for international celebrities whose name, likeness and other distinctive characteristics have been widely circulated in both the traditional and new media. Unlike some of the passing off cases decided in the last century, well-knownness in the 21st century often transcends national geographical boundaries. For example, Susan Boyle, a contestant on the British reality television program Britain’s Got Talent in 2009, literally became an overnight global phenomenon through the circulation of her audition performance on the internet and subsequent coverage by print and broadcast media. It is arguable that she would have the requisite local goodwill to commence an action in passing off in Australia should an advertiser attempt to exploit her persona without her consent. Similarly, under a Lanham Act § 43(a) false endorsement claim, Boyle would not have a problem with the well-knownness of her mark; it was reported that ‘[s]he reached a rare pinnacle of American culture when Jay Leno put on a wig and dress and did his best Susan Boyle – and everyone in the audience knew exactly whom he meant.

It is clear that the passing off action is ‘a remedy for the invasion of a right of property not in the mark, name or get-up improperly used, but in the business or goodwill

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84 Eg White I, 971 F 2d 1395 (9th Cir, 1992).
85 White v Samsung Electronics America Inc., 989 F 2d 1512, 1515 (Kozsinki J) (9th Cir, 1993) (‘anybody standing beside it – a brunette woman, a man wearing women’s clothes, a monkey in a wig and gown – would evoke White’s image, precisely the way the robot did’).
86 See discussion in Chapter 3.
87 Eg Lyngstad [1977] FSR 62.
90 Jordan, above n 88.
likely to be injured by the misrepresentation”. Each movie star, sport icon or contestant from a popular reality television program will have his or her respective appeal to particular segments of the consuming public, and the concomitant goodwill. A celebrity persona has commercial value because it is ‘the attractive force that brings in custom’. This key aspect of goodwill – as a thing of value that attaches to an indicia of identity – distinguishes it from the identifiability element of a typical right of publicity claim, which generally assumes value to reside in the indicia of identity themselves.

As the next Part will demonstrate, if courts embrace an impressionistic approach toward determining misrepresentation, the passing off action can provide robust protection against the unauthorised exploitation of the commercial value of the celebrity persona, and may even extend greater protection to the celebrity plaintiff than the right of publicity. Although there has been criticism that adopting an impressionistic approach to misrepresentation is tantamount to recognising a de facto tort of misappropriation of personality, it is argued here that attuning judicial inquiry to whether the affective value of the celebrity persona has been perceived to have transferred to the defendant’s product can mitigate this concern of equating identification with liability.

III MISLEADING CONDUCT AND MEANING TRANSFER IN CONSUMPTION

A Proving Misrepresentation

Despite a general recognition that one may have a proprietary interest in goodwill that may be enforced through a passing off action – language that is evocative of the concept of misappropriation in a right of publicity claim – courts are nevertheless adamant that ‘there is still a need to demonstrate a misrepresentation because it is that misrepresentation which enables the defendant to make use or take advantage of the claimant’s reputation.’ The misrepresentation must lead to confusion; this is sometimes referred to as the requirement of deceptive conduct. Australian courts have also established that the finding of deceptive conduct must be assessed taking into

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93 Eg Katekar, above n 7; Carty, above n 23.
consideration all the circumstances and the overall effect or impression on the consumers or potential consumers; the courts rely on ‘a combination of visual impression and judicial estimation of the effect likely to be produced’ by the defendant’s conduct on consumers. 95

However, the case law ‘does not indicate [clearly] what type of misrepresentation must be alleged.’ 96 Some cases, particularly in the UK, appear to have adopted a distinction between unauthorised uses of the celebrity persona in advertising (more likely to be misleading as to sponsorship, endorsement or association) and merchandising (less likely to be misleading); 97 this presumption is aptly captured by Laddie J:

When people buy a toy of a well known character because it depicts that character, I have no reason to believe that they care one way or the other who made, sold or licensed it. When a fan buys a poster or a cup bearing an image of his star, he is buying a likeness, not a product from a particular source. 98

At least in the UK, celebrity claimants generally have a greater burden to discharge in proving misrepresentation in respect of merchandising compared to advertisements; 99

95 Australian Woollen Mills Ltd v FS Walton & Co Ltd (1937) 58 CLR 641, 659. Evidence of actual deception is not conclusive; ultimately it was ‘a question of fact to be decided by considering what [was] said and done against the background of all surrounding circumstances.’ Taco Co of Australia Inc v Taco Bell Pty Ltd (1982) 42 ALR 177, 202 (‘Taco Bell’); 10th Centaurae (1987) 79 ALR 299, 318. See also Sydneywide Distributors Pty Ltd v Red Bull Australia Pty Ltd (2002) 55 IPR 354; Anheuser-Busch Inc v Budjovecky Budvar Narodni Podnik (2002) 56 IPR 182; Mark Foys Pty Ltd v TVSN (Pacific) Ltd (2000) 104 FCR 61. Although the English and Australian courts have not enumerated a list of factors to be examined, in practice, most of the Downing factors – in the context of a Lanham Act § 43(a) celebrity false endorsement claim – are considered. See Downing v Abercrombie & Fitch, 265 F 3d 994, 1007-8 (9th Cir, 2001) (‘Downing’) (restating the Sleekcraft factors to be considered in the context of celebrity claims for an unauthorised use of identity).

96 Halsbury’s Laws of Australia (2008) [240-510] fn 1. See also Beverley-Smith, above n 42, 72-97 (comparing different types of connection misrepresentation in the UK and Australia). Similar observations have also been made about the Lanham Act. See Sheldon W Halpern, ‘The Right of Publicity: Commercial Exploitation of the Associative Value of Personality’ (1986) 39 Vanderbilt Law Review 1199, 1242 (‘Indeed, confusion exists about the nature and degree of “confusion” required to make out a Lanham Act claim.’).

97 Eg Irvine [2002] 1 WLR 2355, 2359 (merchandising ‘involves exploiting images, themes or articles which have become famous … It is not a necessary feature of merchandising that members of the public will think the products are in any sense endorsed’); Elvis Presley Trade Marks [1999] RPC 567, 585; Elvis Presley Trade Marks [1997] RPC 543, 552.


Australian courts may be less influenced by this distinction. But this apparent advertisement/merchandising dichotomy has been criticised for being ‘at best … just another tool used by the judge to justify an order to a defendant to stop what the judge perceives to be unfair trading’.

It has been observed that the Australian courts are generally sympathetic toward celebrity plaintiffs whose goodwill have been misappropriated in the course of trade. In Australia, Burchett J of the Federal Court thought that the judicial focus should not be on determining the nature of ‘precise representations’, but rather on ‘suggestions by [the trader] that may inveigle the emotions into false responses’; in particular, the ‘subliminal effect of an advertisement … may be deceptive even without making any [explicit] untrue statement.’ This impressionistic approach, especially with the findings of misrepresentation in the parodic advertisement in the *Crocodile Dundee case* and in the get-up of the koala image in *Koala Dundee*, has led commentators to lament that ‘mere identification was enough to suggest an association and therefore a misrepresentation.’ The unpredictability of this approach is also demonstrated in Olympic swimmer Kieren Perkins’ claim against Telecom Australia for using a photograph of him wearing a swimming cap with the defendant’s logo in an advertisement which allegedly highlighted Perkins’ achievements to promote the sport of swimming. The Full Federal Court there reversed the trial judge’s decision, finding that the advertisement misrepresented that Perkins ‘was sponsored by it [and] had consented

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100 In a number of Australian cases involving character merchandising, the plaintiffs succeeded in proving misrepresentation. However, most of these involve fictitious characters, rather than human personalities. Eg *Duff Beer case* (1996) 34 IPR 225, 230-2 (Duff beer product based on *The Simpsons* cartoon series); *Fido Dido Inc v Venture Stores (Retailers) Pty Ltd* (1988) 16 IPR 365 (Fido Dido character merchandising); *Koala Dundee* (1988) 20 FCR 314 (merchandise based on *Crocodile Dundee* character); *Children’s Television Workshop Inc v Woolworths (NSW) Ltd* [1981] 1 NSWLR 273 (Muppets merchandise). Cf *Hutchence* (1986) 6 IPR 473 (merchandising with respect to pop band INXS).


104 Ralston, above n 19, 10 (emphasis in original). See also Mark Davison and Maree Kennedy, ‘Proof of Deception and Character Merchandising Cases’ (1990) 16 *Monash University Law Review* 111, 115 (this is a ‘spectacular departure from the passing off requirement of factual misrepresentation’). It should also be noted that passing off is not made out ‘merely because members of the public would be caused to wonder whether it might not be the case that two products come from the same source.’ *Puxu* (1982) 149 CLR 191, 209.
to its use of his name, image and reputation”. More importantly, the court held that the relevant target audience in passing off included

the astute and the gullible, the intelligent and the not so intelligent, the well educated as well as the poorly educated, men and women of various ages pursuing a variety of vocations, and [the plaintiff] could rely on any meaning which was reasonably open to a significant number of the newspaper readership.

Thus, even in the absence of an explicit misrepresentation, it appears that courts are increasingly open to accepting that the overall or ‘gestalt’ impression of the defendant’s use can constitute misleading or deceptive conduct. As Burchett J commented in the Crocodile Dundee case, ‘[i]t would be unfortunate if the law merely prevented a trader using the primitive club of direct misrepresentation, while leaving him free to employ the more sophisticated rapier of suggestion, which may deceive more completely.’

It is worth noting that when The Number (UK) used a caricature based on what long-distance runner David Bedford looked like in the 1970s in its advertisement without securing the his consent, Bedford complained to the Ofcom Content Board and secured a finding that the ad breached Rule 6.5 of the ITC Advertising Standards Code. All that was needed was evidence to show that Bedford has been caricatured – a very low threshold for a breach of the Advertising Standards Code – and there is no direct parallel between the Ofcom findings and the likely outcome of any court action. Although Bedford did not pursue a claim in passing off, commentary on the Ofcom decision suggests that Bedford was also unlikely to succeed as the finding of caricature does not

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106 Ibid 446 (citing Taco Bell (1982) 42 ALR 177, 202).
109 ‘Outcome of Appeal by The Number (UK) Ltd regarding Complaint by David Bedford’, Ofcom <http://www.ofcom.org.uk/tv/obb/adv_comp/content_board/> at 8 February 2010. Rule 5.6 states that: ‘With limited exceptions, living people must not be portrayed, caricatured or referred to in advertisements without their permission.’
necessarily translate to actionable misrepresentation.\textsuperscript{111} As courts take into account all the circumstances of the unauthorised use and the impression on customers,\textsuperscript{112} the ‘nature of the campaign, the time that had passed since [Bedford’s] sporting success, and the divergence between his modern day appearance and that of the 118 running twins make [misrepresentation] highly unlikely.’\textsuperscript{113} It is also doubtful if Bedford could satisfy the requirement of local goodwill; the fact that he might have been famous in the 1970s does not mean that he is still well-known today. The ephemeral nature of fame suggests that it would be appropriate for courts to examine whether an individual who was once well-known still enjoyed widespread public recognition at the time of the alleged passing off.

Finally, the use of prominent disclaimers can alleviate any likelihood of confusion. Even though the consumers’ attention would have been captured by the defendant’s use of the celebrity persona – eg an Olivia Newton-John lookalike in a print advertisement – the passing off claim would fail if consumers were not misled or deceived as to the celebrity’s connection with the defendant.\textsuperscript{114} Due to the number of possible variations where disclaimers are involved, courts have been reluctant to establish any general formula for determining the effect of disclaimers in favour of approaching each case on its own facts.\textsuperscript{115}

\textbf{B Free Speech Defence}

Although there are free speech guarantees in the UK and Australia – under Article 10 of the \textit{European Convention on Human Rights} (‘ECHR’) for the UK\textsuperscript{116} and the


\textsuperscript{112} See above n 95.

\textsuperscript{113} Dresden and Andrews, above n 110, 83.

\textsuperscript{114} Newton-John (1986) 11 FCR 233, 234-5 (even the ‘very casual reader … will not be deceived’).

\textsuperscript{115} Eg Duff Beer case (1996) 34 IPR 247, 251; Halsbury’s Laws of Australia (2008) [240-4740].

\textsuperscript{116} Article 10 tends to be balanced with Article 8 which guarantees individual privacy. Courts appear to rank types of speech on a hierarchy based on their contribution to democratic debate when engaging in a balancing exercise. Eg \textit{Campbell v MGN Ltd} [2004] 2 AC 457 (‘Campbell’); \textit{Von Hannover v Germany} (2005) 40 EHR 1 (‘Von Hannover’). Although Article 10 has a horizontal application, it has not been invoked in passing off cases. Laddie J referred to the \textit{ECHR} and the \textit{Human Rights Act} 1998 (UK) ‘by way of postscript’ but did not mention Article 10. \textit{Irvine} [2002] 1 WLR 2355, 2379.
implied constitutional freedom of political communication for Australia\textsuperscript{117} – there is no equivalent of the First Amendment defence recognised by US courts when evaluating right of publicity or Lanham Act § 43(a) claims. This section will first consider how US courts handle free speech arguments in false endorsement claims, and then offer some observations on whether the English and Australian courts are likely to adopt a similar approach when giving effect to free speech values in the future.

In the US, even though the First Amendment offers protection to commercial speech from undue governmental interference under the Central Hudson standard, it is established law that misleading commercial speech does not enjoy constitutional protection.\textsuperscript{118} However, the Supreme Court has not offered a clear indication of an appropriate test to use when the presence of artistic expression may nevertheless result in consumer confusion. When deciding Lanham Act claims, several Circuit courts use the two-pronged test from Rogers v Grimaldi under which the title of an expressive work will be immune as protected artistic speech unless it has ‘no artistic relevance’ to the underlying work or if there was artistic relevance, the title ‘explicitly misleads as to the source or content of the work’.\textsuperscript{119} Rogers was a case where a Federico Fellini film bore the title ‘Ginger and Fred’, evocative of the well-known entertainers Ginger Rogers and Fred Astaire. The film tells the story of two fictional Italian cabaret performers who, in their heyday, imitated Rogers and Astaire and became known in Italy as ‘Ginger and Fred’. The Second Circuit found against Rogers; it held that despite the presence of evidence of actual confusion, ‘the slight risk that such use of a celebrity’s name might


implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression’. 120 The initial articulation of the test was based on the rationale that

[t]itles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker’s expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined.121

In particular, US courts are concerned that an ‘overextension of [the] Lanham Act restrictions in the area of titles might intrude on First Amendment values’ and therefore the Act must be construed ‘narrowly to avoid such a conflict’.122 It is not surprising, therefore, that some courts have extended the artistic relevance test to uses of the likeness of a celebrity.123 However, the Sixth Circuit has cautioned that ‘the First Amendment cannot permit anyone who cries “artist” to have carte blanche when it comes to naming and advertising his or her works, art though it may be.’124

Notwithstanding this, it suffices to note that the pro-speech culture in the US can lead to diminished protection for celebrity plaintiffs.125 Even where a defendant has capitalised on a celebrity’s fame and popularity for commercial benefit, a finding of artistic relevance would allow the defendant a free ride on the celebrity’s star value.126 The artistic relevance threshold is an easy one to meet, and courts require plaintiffs to show explicit misleading conduct on the part of the defendants in such circumstances. Based on the facts of Koala Dundee and the Crocodile Dundee case, if actor Paul Hogan had filed a Lanham Act claim in the US, he would not have the same success he enjoyed

120 Rogers, ibid 1000.
121 Ibid 998.
122 Ibid.
124 Parks, 329 F 3d 437, 447 (6th Cir, 2003). The Ninth Circuit has also declined to apply the artistic relevance test when the occasion presented an opportunity. Eg Wendi, 125 F 3d 806 (9th Cir, 1997).
125 Eg Rogers, 875 F 2d 994 (2nd Cir, 1989); ETW Corp, 332 F 3d 915 (6th Cir, 2003). The courts also apply a nominative fair use test under trademark analysis, which further erodes protection of the celebrity persona against unauthorised commercial exploitation. Eg New Kids On The Block v News America Publishing Inc, 971 F 2d 302 (9th Cir, 1992); Cairns v Franklin Mint Co, 292 F 3d 1139 (9th Cir, 2002); Clark v America Online Inc, 2000 WL 33535712 (CD Cal, 2000).
126 Zimdahl, above n 119, 1854.
in Australia. The artistic – and parodic – elements in the koala image and the television advertisement would be relevant to the content of the defendants’ works and were not explicitly misleading as to the content under the Rogers test.

In a case arguably involving celebrity merchandising, where an American artist sold lithographs bearing an almost literal depiction of Tiger Woods in a pose reminiscent of his stance in a Nike poster, the Sixth Circuit by a majority found that ‘the presence of Woods’s image in Rush’s painting The Masters Of Augusta does have artistic relevance to the underlying work and that it does not explicitly mislead as to the source of the work.’

Again, despite survey evidence that ‘some members of the public would draw the incorrect inference that Woods had some connection with Rush’s print’, the ‘risk of misunderstanding … [was] outweighed by the interest in artistic expression’. At least one commentator has argued that Tiger Woods would have fared better under a passing off action in Australia – that ‘the evidence of consumer confusion would not have been so quickly eclipsed by First Amendment concerns.’ Similarly in Kirby v Sega of America, where pop singer Keirin Kirby alleged that Sega had developed a video game character that appropriated her identity, the California Court of Appeal applied the transformative elements test to find that the defendant has ‘added creative elements to create a new expression’ protectable by the First Amendment. This was sufficient to bar both the plaintiff’s right of publicity and Lanham Act claims. However, in cases where the celebrity has been portrayed in a straightforward manner in an advertisement especially in the copresent mode – whether through the use of a lookalike or through an evocative device – the outcome in the US courts is likely to mirror the Australian passing off experience.

128 Ibid.
130 In addition to some visual similarities, the video game character’s name ‘Ulala’ is a phonetic variant of ‘ooh la la’, a phrase often used by Kirby and associated with Kirby. 144 Cal App 4th 47, 56 (2006) (‘Kirby’).
131 Ibid 59.
132 Ibid 61.
133 McCracken, above n 65. See section below for a further discussion.
134 Eg Allen v Men’s World Outlet Inc, 679 F Supp 360 (SD NY, 1988); Onassis, 472 NYS 2d 254 (NY Sup Ct, 1984); Lombardo v Doyle, Dane & Bernbach Inc, 396 NYS 2d 661 (1977).
Recent English cases on celebrity privacy, litigated as breach of confidence claims, suggest that Article 10 of the ECHR may in certain circumstances accord defendants free speech protection in its horizontal application. In such cases, where the right to privacy guaranteed by Article 8 clashes with the freedom of expression under Article 10, the courts have adopted a balancing approach. However, there has been a paucity of cases on how courts would resolve a conflict between intellectual property rights, in particular, copyright, and Article 10; and the issue of freedom of expression under Article 10 has not been raised in English passing off cases. Some commentators however have considered whether Article 10 could impose an external limitation on intellectual property rights.

According to legal scholar Bernt Hugenholtz, this is unlikely as courts have generally ‘shied away from direct application of [Article 10] … preferring instead to treat freedom of expression as a normative principle to be used in “interpreting” existing statutory limitations.’ Similar observations have been made by Gavin Phillipson that the English courts are more likely to want to retain ‘a measure of discretion as to the force given to Convention principles in any given case, thus preserving the essentially flexible and pragmatic nature of the common law.’ In particular, the English Court of Appeal has concluded that Art 10 should have no impact on the regular course of copyright litigation and that English courts would apply copyright laws ‘in a manner that accommodates the right of freedom of expression’.

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135 Eg Campbell [2004] 2 AC 457; Mosley v News Group Newspapers Ltd [2008] EMLR 20 (‘Mosley’). The ECHR was incorporated into English domestic law by the Human Rights Act 1998 (UK) which came into effect on 2 October 2000. Article 10(1) states: ‘Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers.’ The English courts appeared to have incorporated Art 10 considerations into the public interest defence.


137 Eg P Bernt Hugenholtz, ‘Copyright and Freedom of Expression in Europe’ in Rochelle Cooper Dreyfuss, Harry First and Diane Leenheer Zimmerman (eds), Expanding the Boundaries of Intellectual Property (2001) 343.

138 Hugenholtz, ibid 354. Hugenholtz also cites the examples of courts in Austria, France and Germany preferring to ‘internalise’ freedom of expression considerations within the framework of copyright laws, which are seen to incorporate speech protections in doctrines like idea-expression dichotomy and fair use/dealing. See also Ashdown v Telegraph Group Ltd [2001] Ch 685, 696 (‘the balance between the rights of the owner of the copyright and those of the public have been struck … in the legislation … There is no room for any further defences outside the code which establishes the particular species of intellectual property in question.’).


The European Court of Human Rights has repeatedly stated that intellectual property rights are protected by the general right to property under Article 1 of the First Protocol to the ECHR; in Irvine, it was alluded to, but not discussed, by Laddie J that the claimant had a ‘property right in his goodwill’ and that this Article may be invoked to protect intangible property. If one construes goodwill in a passing off claim to be proprietary in nature, it is arguable that, by analogy, the internalisation approach – where freedom of expression considerations are incorporated into existing legal doctrine – may be applicable to passing off. This means that expressive uses of the celebrity persona can be taken into account when assessing whether there was misleading conduct.

The persistence of common law doctrines, with selective consideration of the ECHR and Strasbourg jurisprudence where appropriate, appears to be the preferred approach of the English courts, and this would fall squarely within the broad margin of appreciation accorded to Member States. Although it appears that defendants in a passing off claim are unlikely to be able to argue an affirmative Article 10 defence akin to the Rogers artistic relevance approach, this does not mean that political recodings of the celebrity sign will not be protected.

Both English courts and the European Court of Human Rights have consistently held that political speech deserves the highest protection, thereby implicitly adopting a participatory theory; this augurs well for defendants in a passing off claim who

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142 Irvine [2002] 1 WLR 2355, 2379.

143 See above Part IIA.


146 Eg Campbell [2004] 2 AC 457, 490, 499-500; Von Hannover (2005) 40 ECHR 1, 25-6; Handyside v United Kingdom (1979-80) 1 EHRR 737, 754; Langens v Austria (1986) 8 ECHR 407, 418-9; Müller v Switzerland (1991) 13 EHRR 212, 228 (artistic speech is protected less vigorously than political speech and is subjected to the duties and responsibilities imposed by Art 10(2)). In particular, Baroness Hale has declared: ‘Top of the list is political speech. The free exchange of information and ideas on matters relevant to the organisation of the economic, social and political life of the country is crucial to any democracy.’ Campbell, ibid 499.
legitimately recode the celebrity persona to assert a particular viewpoint that is relevant to the democratic process. A comprehensive survey of European law has concluded that, in most situations, it is clear that the ‘use of a celebrity’s picture or name in advertising or merchandising does not provide the public with socially useful information or contribute in any way to a debate of public interest.’ It appears that in order to avoid liability in passing off, the recoding of the celebrity persona must, at the bare minimum, contribute to ‘a debate of general interest’. If English courts do entertain an independent Article 10 argument in passing off at all, rather than consider the expressive nature of the unauthorised use as a factor in determining misrepresentation, they are likely to evaluate such recodings under the rubric of ‘public interest’ presently employed in breach of confidence/privacy claims.

The Australian situation appears more straightforward. The landmark judicial recognition in 1992 of an implied constitutional freedom of political communication, based on its indispensability to the efficacious working of the system of representative democracy and responsible government provided by the Australian Constitution, suggests that political communication may have a broad ambit that can embrace the discussion of all matters of public affairs and the ‘free flow of information and ideas bearing on Commonwealth, State and Territory government, government arrangements and institutions’. However, a subsequent unanimous High Court decision in Lange v Australian Broadcasting Corporation, anchored the doctrine to the necessary

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148 Von Hannover (2005) 40 ECHR 1 at [76]. The approach of the European Court of Human Rights in analysing the value of the speech at issue in relation to its contribution to democratic debate has been consistently applied by English Courts. Eg Mosley [2008] EMLR 20 at [132]-[133]; McKennitt v Ash [2008] QB 73, 93-7 (‘McKennitt’); Campbell, ibid. The House of Lords has also intimated that while one may gain First Amendment protection in the United States for a particular publication, English law does not necessarily confer such broad protection to speech. Douglas v Hello! [2008] 1 AC 1, 50. Parody has only been argued once in passing off, but the argument was unsuccessful on the facts. The court held that ‘[w]hether a customer is confused is the ultimate question. If the defendant employs a successful parody, the customer would not be confused, but amused.’ See Clark v Associated Newspapers Ltd [1998] 1 WLR 1558, 1567 (citing Nike Inc v ‘Just Did It’ Enterprises, 6 F 3d 1225, 1227-8 (7th Cir, 1993)). See also Michael Spence, ‘Intellectual Property and the Problem of Parody’ (1998) 114 Law Quarterly Review 594.

149 Eg Campbell [2004] 2 AC 457; Mosley, ibid; McKennitt, ibid.

150 Nationwide News (1992) 177 CLR 1; ACTV (1992) 177 CLR 106. These decisions appear to accept a participatory theory of democracy. See discussion in Chapter 5 Part IA.

151 Eg ACTV (1992) 177 CLR 106, 142; Theophanous v Herald & Weekly Times Ltd (1994) 182 CLR 104, 121-3 (‘Theophanous’).

152 ACTV, ibid 217.
implications from the text and structure of the Constitution, and framed the freedom more narrowly as ‘freedom of communication between the people concerning political and government matters which enables the people to exercise a free and informed choice as electors’. Furthermore, the High Court has been ‘reticent about using the language of rights to describe [this] freedom’. The Court has emphasised that this Australian implication is negative in character, being a restriction on the exercise of legislative and executive power rather than a source of positive rights.

Under the *Lange* test established by the High Court, a law will be invalid if it ‘effectively burden[s] freedom of communication about government or political matters’ and it is not ‘reasonably appropriate and adapted to serve a legitimate end in a manner which is compatible with the maintenance of the constitutionally prescribed system of representative and responsible government.’ Generally, Australian courts appear to be focused on a vertical application of this constitutional freedom as a check on the exercise of state powers to restrict communication that contribute to democratic debate and discussion of governmental matters, and are not prepared to expand this freedom to the extent of either the First Amendment or Article 10 of the ECHR. Although certain expressive conduct like social activism against duck shooting and use of insulting words in a public place alleging police corruption may qualify as protectable speech, the judicial focus in these cases is on the vertical effect of state action. From the jurisprudence, it is unlikely that the implied freedom of political communication would function as an affirmative defence applicable to passing off or section 52 of the *Trade*

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153 (1997) 189 CLR 520, 566 (‘*Lange*’). It was also pointed out that the High Court is invoking an institutional rather than participatory theory of democracy by tethering the freedom to the constitutional text and structure. Chesterman, above n 117, 73-4.
155 Stone, ‘Interpretive Disagreement’, above n 117, 33. See also *Lange*, ibid 560 (‘These sections do not confer personal rights on individuals’); *Cunliffe v Commonwealth* (1994) 182 CLR 272, 327.
157 *Coleman v Power* (2004) 220 CLR 1, 50 (restating the *Lange* test) (‘*Coleman*’).
160 The High Court’s strong opposition to personal rights might also be understood to be a rejection of the horizontal rights concept of Art 10 of the ECHR. See also Buss, ibid 441.
Practices Act 1974 (Cth). In the context of the implied freedom, the unanimous High Court in Lange held that ‘the common law must conform with the Constitution’;\(^{163}\) the Court appears unwilling to create any constitutional defences and prefers to interpret the common law in a manner that is in harmony with the Australian Constitution.\(^{164}\) Notwithstanding the fact that the implied freedom offers a much weaker protection to speech compared to Art 10 of the ECHR, it is arguable that similar to the English position, political recodings of the celebrity sign that contribute to the dissemination of information, opinions and arguments concerning government and political matters that affect the electorate may be taken into account when determining misleading conduct. In that way, the common law passing off action might be reshaped slightly to better accommodate political communication, in a similar fashion to the development by the High Court of a broader qualified privilege defence within common law defamation.\(^{165}\)

C Cultural Studies and the Transfer of Affective Meaning

Contrary to the arguments of some commentators that there is a ‘need for an Australian right of publicity’ and that ‘the right is consistent with the fundamental rationales underlying intellectual property law’,\(^{166}\) the insights from cultural studies on meaning transfer in consumption suggests that the passing off action may be adequate in protecting the associative value of the celebrity identity.

Chapters 2 and 4 have explained how fame is in part defined and conferred upon a celebrity individual by the consuming public, and in part constructed and propagated by the cultural producers. As Marshall avers, ‘[I]he celebrity’s power is derived from the collective configuration of its meaning … the audience is central in sustaining the power

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\(^{163}\) Lange (1997) 189 CLR 520, 566. See also discussions of this conformity in Buss, above n 159, 429-39.

\(^{164}\) Lange, ibid 564-6. See also an examination of the use of common law methodology in cases dealing with freedom of political communication post-Lange, see Buss, ibid 435, 450-7.

\(^{165}\) Lange (1997) 189 CLR 520, 571-5.

of any celebrity sign." One may therefore argue that the touchstone for liability for the unauthorised commercial exploitation of a celebrity’s identity, as pointed by Laddie J in *Irvine*, ought to take into account the *effect* of such a use on the audience-consumer. McCracken’s observations, about how affective meaning that is conferred on the celebrity (Stage 1) may flow into the product that the celebrity is associated with (Stage 2), are also relevant here. If one accepts that the celebrity identity has an associative value only because of the semiotic meanings conferred on it by the audience, then public perception becomes the natural reference point for the determination of liability. An analysis of the research on source credibility and source attractiveness models has revealed that ‘the movement of meanings from [the celebrity to] consumer goods [and ultimately] to the individual consumer is accomplished through the efforts of the consumer.’ Although the advertisers can choose the particular configuration of culturally constituted meanings they wish to convey, which is examined in passing off under the rubric of the intent of the trader, but regardless of their intent, the final act of meaning transfer is performed by the consumer, who must glimpse in a moment of recognition … the cultural meanings contained in the people, objects, and contexts of the advertisement are also contained in the product.

The more recent Australian cases have held that the plaintiff could ‘rely on any meaning which was reasonably open to a significant number of the [target audience]’ thus directing the judicial focus in passing off to the impact of the unauthorised use on the

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168 See above n 34 and accompanying text.


170 These models investigate the conditions under which endorsement messages are perceived by consumers and postulate that the effectiveness of a message depends on the trustworthiness and familiarity/likeability of the celebrity. For a discussion of various findings, see McCracken, ibid 310-2.

171 McCracken, ibid 313.

172 Eg *Irvine* [2002] 1 WLR 2355, 2376-7; *Crocodile Dundee case* (1989) 23 FCR 553, 575-6, 586. For *Lanham Act* § 43(a) cases, it is one of the factors to be considered in determining the likelihood of confusion. Eg *Downing*, 265 F 3d 994, 1007-8 (9th Cir, 2001).

173 McCracken, above n 65, 314.

174 Eg *Talmax* [1997] 2 Qd R 444, 446. See also the impressionistic approach taken in *Crocodile Dundee case* and *Koala Dundee* discussed in Part IIIA.
audience-consumer. Thus unlike the right of publicity, the tort of passing off accords
greater prominence to the third constituent of the celebrity trinity:

the test of whether a celebrity’s image may be used in commerce depends on the
court’s appreciation of the attitude the average consumer may take to it, rather
than leaving it up to the celebrity to decide, with limitations posed by the public
interest (a consumer-based test instead of an individual rights-based test). 175

If there is no likelihood that a typical consumer would be led to believe that a
celebrity endorses or is connected to the defendant’s product, then arguably no
associative value has flowed to the product, and accordingly there should be no liability.
In the copresent mode frequently employed in print advertisements where a celebrity is
juxtaposed with a brand or product,176 there may be no explicit indication of endorsement.
Hence in this form of ‘enhancement advertising’, the endorsement can be ‘by inference
only, not in express words but by the association of a celebrity with a product, merely by
them appearing together.’177 It should therefore be open to the court to determine whether,
as a matter of impression, consumers are likely to be confused as to the celebrity’s
connection with the product when depicted in this manner. The fact is advertisers rely on
the well-knownness of celebrities with global goodwill to lend their star aura to their
brands and products by simply being present in the advertisement. No explicit
endorsement message is required; the mere presence of the celebrity suggests an approval
or association sufficient to persuade relevant segments of consumers to buy the
product.178

Courts in recent years appear to be cognisant of such advertising practices and the
resulting consumption behaviour. In the context of a Lanham Act claim, summary

175 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, 458 (emphasis added). See also 10th Cantanae

176 McCracken, above n 65, 310. See also Tan, above n 31, 963.

177 Carty, above n 23, 217. Carty, however, is reluctant to endorse a broad interpretation of
misrepresentation, pointing out that ‘[m]erely taking something of value without paying is not a good
reason to interfere with an unauthorised use of a celebrity persona’ and the ‘exposure of celebrities to
such [enhancement advertising] use should be seen as the price of fame’. Ibid 258.

178 In his analysis, Cashmore noted that advertising has ‘moved away from the utilitarian approach in
which product information was at the forefront. Many global brands avoid even mentioning products in
an attempt to create synonymy between their brand and the celebrity’. Cashmore, above n 63, 172.
judgment was awarded to Woody Allen on the basis that the defendant’s use of a lookalike in an advertisement created a likelihood of confusion over whether Allen ‘endorsed or was otherwise involved in [the defendant’s] services.’\(^{179}\) The court remarked that ‘[w]hen a public figure of Woody Allen’s stature appears in an advertisement, his mere presence is inescapably to be interpreted as an endorsement.’\(^{180}\) The *Allen* holding finds a parallel in the passing off case of *Irvine*, in which the advertisement featuring Eddie Irvine in the copresent mode was found to have conveyed the message to the audience that Talk Radio was so good that it was endorsed and listened to by the claimant.\(^{181}\) This understanding of consumption behaviour supports the impressionistic approach in passing off to determining misrepresentation and it appears that this type of ‘connection misrepresentation … is now accepted to be part of the tort.’\(^{182}\)

As observed in the *Crocodile Dundee* case, it is the association with the celebrity that ‘proceeds more subtly to foster favourable inclination towards it’ such that the products are better in the consumer’s eyes.\(^{183}\) Similarly, in *Irvine*, the defendant was liable not simply because the advertisement was designed ‘with the intention of grabbing the attention of the audience’, but because the representation of Eddie Irvine’s support of Talk Radio ‘would make it more attractive to potential listeners with the result that more would listen to its programmes and that would make Talk Radio an attractive medium in which to place advertisements.’\(^{184}\) Unlike the more generous interpretation of commercial appropriation often seen in right of publicity claims – that the defendant has impermissibly gained a commercial advantage by attracting the consumers’ attention with an unauthorised use of a celebrity’s persona\(^{185}\) – liability in passing off is only imposed at the point in the consumption process where the celebrity’s persona has been ‘transferred’ into the product, thereby realising the potential economic value through its associative

\(^{179}\) *Allen*, 610 F Supp 612, 627 (SD NY, 1985).

\(^{180}\) Ibid 627 fn 8.

\(^{181}\) *Irvine* [2002] 1 WLR 2355, 2377.


\(^{184}\) *Irvine* [2002] 1 WLR 2355, 2377-8.

\(^{185}\) Eg *Eastwood*, 149 Cal App 3d 409, 421 (1983).
use. This point is signified by the consumers being misled as to the celebrity’s association with or endorsement of the defendant’s products. The Australian High Court has consistently considered the degree of care that the target segment of consumers would exercise in examining their purchases. Even if courts adopt the broader impressionistic approach to determining misrepresentation, this approach nevertheless still adheres to discovering whether the transfer of semiotic values from the celebrity persona to the defendant’s product has occurred, based on the perception and behaviour of the relevant segment of consumers. If this ‘transfer’ has not occurred, because the consumers were not misled as to the plaintiff’s association with the defendant, then it is arguable that the plaintiff has lost nothing of commercial value. Courts have to be careful not to equate identification with misrepresentation, otherwise the assumption that the copresent mode in advertising represents approval or association becomes an irrefutable fact.

Finally, passing off allows the English and Australian courts to properly evaluate whether the affective meaning has been transferred as a result of the perception of consumers, and not be mired in First Amendment rhetoric commonly witnessed in the US cases. In *ETW Corp* and *Kirby*, the US courts were more concerned with whether the defendants’ free speech interests were protected rather than whether consumers were misled as to the celebrity’s association with the defendants. Although these may be classified as character merchandising cases – the almost literal depiction of Woods in lithographs and a video game character evocative of Kirby – the courts made virtually no attempt to examine whether there was a likelihood of confusion under the *Lanham Act* claims once it was found that the defendants’ expressions were protectable speech. Despite Laddie J’s observations with regard to character merchandising, it is nevertheless open to the courts in passing off cases to consider whether, in the light of all

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186 See discussion in Chapter 4 Part IIIB1 regarding the issue of appropriation in right of publicity doctrine.


188 This is where the effective use of a disclaimer can disrupt this transfer of semiotic meanings from the celebrity to the defendant’s product. *Eg Newton-John* (1986) 11 FCR 233. However, under right of publicity doctrine, the defendant is likely to be liable. According to a hypothetical scenario by the Tenth Circuit, “[i]f Mitchell Fruit posted a billboard featuring a picture of Madonna and the phrase, “Madonna may have ten platinum albums, but she’s never had a Mitchell banana,” Madonna would not have a claim for false endorsement. She would, however, have a publicity rights claim, because Mitchell Fruit misappropriated her name and likeness for commercial purposes.” *Cardtoons LC v Major League Baseball Players Association*, 95 F 3d 959, 968 (10th Cir, 1996).

189 See above n 98 and accompanying text.
the circumstances, like in *Koala Dundee* and *Hutchence v South Sea Bubble Co*, consumers were misled as to the plaintiff’s association with the defendant’s products.

### IV Damage and Meaning Transfer in Consumption

#### A The Requirement of Damage

Although courts have remarked that ‘[t]he law relating to which heads of damage are (or should be) judicially recognised under the tort of passing off is notoriously difficult’, there is insufficient attention given to the element of damage in passing off. In most cases, there is an intrinsic likelihood of damage to goodwill once the misrepresentation has been made out; it is only in the rare instance that the court will find that there is no damage to the trading plaintiff’s goodwill because the plaintiff has no business presence despite enjoying local goodwill. Generally, courts require actual or probable damage to goodwill to be shown. In a classic setting, the common types of damage – sometimes known as ‘narrow’ definition of damage – are diversion of trade or loss of sales, and devaluation or debasement of reputation or injurious association. In more contentious situations involving commercial traders, there has been judicial support for a ‘broad’ definition of damage such as the loss of control over the plaintiff’s own reputation, erosion of distinctiveness and dilution of the profit potential of the

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190 See above n 95 and accompanying text.

191 *Novelty Pie Ltd v Amanresorts Ltd* [2009] FSR 763, 805 (‘Amanresorts’).


193 Eg *Budweiser case* [1984] FSR 413, 468-72. In certain situations, the court has required ‘clear and cogent proof … of actual damage or the real likelihood of damage to the [claimants’] property in their goodwill … be substantial’. *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501, 547 (‘Stringfellow’).

194 Eg *Reddaway* [1896] AC 199.

195 Eg *Erven Warnink* [1979] AC 731; *Unitex Ltd Union Texturing Co* [1973] RPC 119; *Annabel’s (Berkeley Square) Ltd v Schock (G)* (t/a Annabel’s Escort Agency) [1972] FSR 261; *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273.


plaintiff’s name. The law in this area is anything but consistent. In a number of decisions concerning commercial traders, the English courts seem to have drawn a line at recognising as a legitimate item of damage a restriction on expansion potential, but the Australian courts have been willing to accept an interference with the licensing or merchandising potential of celebrity individuals as a head of damage. In Henderson, the court held that the ‘appropriation of [the] professional or business reputation’ of the well-known ballroom dancers for the defendant’s ‘commercial ends’ and thus depriving them of their right ‘to withhold or bestow at will’ is ‘an injury in itself’. Similar language regarding wrongful appropriation of reputation in commercial trading has been used by the English Court of Appeal in finding that once misrepresentation has been shown, although the defendants’ ‘Elderflower Champagne’ would ‘not reduce the … plaintiffs’ sales in any significant or direct way’, erosion of the singularity and exclusiveness of the Champagne description nonetheless qualified as ‘serious’ damage.

In a more recent celebrity passing off case, it appears that the English Court of Appeal, like the Australian courts, is prepared to extend heads of damage to include potential loss of licensing opportunities, although it has not been explicit whether it would allow a claim in a situation where the claimant has yet to license his or her name for the purposes of sponsorship, endorsement and merchandising. So far, the passing off cases involving celebrity claims in an unauthorised endorsement context have been instituted by individuals who have a history of commercial sponsorships – like the Spice Girls and Eddie Irvine in the UK, and Paul Hogan, Olivia Newton-John, Kieren Perkins and Gary Honey in Australia. As argued in Part IIC above, a contemporary celebrity who

198 Eg Taittinger, ibid; Lego [1983] FSR 155; Alfred Dunhill Ltd v Sunoptic SA [1979] FSR 337. However, Carty has argued that ‘injury to commercial magnetism or commercial potential … do not necessarily involve damage to goodwill’ in a passing off action. Carty, above n 15, 487. There was an intimation, but without further elaboration, by English court that not all confusion causes damage. See also criticisms in Hazel Carty, ‘Dilution and Passing Off: Cause for Concern’ (1996) 112 Law Quarterly Review 632.

199 Eg Newsweek Inc v BBC [1979] RPC 441; Stringfellow v McCain Foods (GB) Ltd [1984] RPC 501. See also Lyngstad v Anabas Products Ltd [1977] FSR 62 (regarding Abba merchandise, but the case was arguably disposed on the goodwill issue).


201 Henderson [1969] RPC 218, 236.


203 Irvine (Damages) [2003] 2 All ER 881, 903.

204 It was not an issue in Irvine as Eddie Irvine ‘has been engaged to sponsor a variety of products including, amongst others, sun glasses, mens’ toiletries, fashion clothing, footwear and car racing helmets’. Irvine [2002] 1 WLR 2355, 2371.
is a well-known mediated persona like Susan Boyle can possess valuable goodwill because of her well-knownness. This celebrity goodwill can exist where the individual has not had the opportunity to endorse any product, or even where the celebrity has refused to endorse any product. If a well-known individual is accepted by the court to have the requisite goodwill, then once misrepresentation has been shown, there is no compelling reason to deny remedy on the grounds that there is no damage because there was no prior history of commercial endorsement. If Waits v Frito-Lay had been litigated in the UK or Australia under a passing off claim, the fact that Tom Waits had publicly ‘maintained [his] policy consistently during the past ten years, rejecting numerous lucrative offers to endorse major products’ should lead to a finding of damage in the form of debasement of reputation. The degree of harm to the celebrity may be appropriately assessed in the award of damages; for example, one who has a track record of commercial endorsements, like Eddie Irvine, may receive more substantial compensation based on previous licensing arrangements than one has not agreed to any public endorsements. The English Court of Appeal has recently intimated that in the award of damages, the computation would be based on what the market would have paid if the celebrity had agreed to be in the advertisement. It has also been argued that when misrepresentation has been proven, even where a plaintiff ‘cannot prove direct loss or damage to his goodwill, the damages for the defendant’s wrongdoing will be calculated as if the defendant had acted properly in seeking a license prior to using the plaintiff’s image.’

It is notable that some academic commentators are not so ready to gloss over the element of damage, arguing that ‘backdoor unprincipled extensions are not acceptable’. Yet in a breach of confidence context involving the wedding photographs

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205 See above nn 86-90 and accompanying text.
206 See above nn 78-82 and accompanying text.
207 Waits, 978 F 2d 1093, 1097 (9th Cir, 1992). He has also expressed his philosophy that musical artists should not do commercials because it detracts from their artistic integrity. Ibid.
208 See also Sim v Heinz [1958] RPC 22 (notwithstanding the fact that there was evidence of confusion whether the voice of a well-known actor has been reproduced in a voiceover, the court held that the jury would have to decide the issue of whether the plaintiff’s reputation as an actor has been damaged by the association with the cartoon character).
209 See Irvine (Damaages) [2003] 2 All ER 881, 903.
210 Bryniczka, above n 183, 188.
of Michael Douglas and Catherine Zeta-Jones, a majority in the House of Lords seemed cognisant of the commercial potential of the contemporary celebrity and was prepared to extend greater protection to celebrities in preventing unauthorised commercial uses of their images, with Lord Hoffmann remarking that being a celebrity is a lawful trade and that the law should be flexible enough to protect even the commercial value of information relating to celebrities.\footnote{OBG Ltd v Allan; Douglas v Hello! [2008] 1 AC 1, 49.} There is no reason to doubt that the willingness shown by the House of Lords to adapt the breach of confidence action to protect the commercial value of the celebrity persona is also likely to extend to the passing off claim.\footnote{It was raised by Laddie J, but without further discussion, that Article 8 of the ECHR may be relevant in influencing the development of the law in this area. Irvine [2002] 1 WLR 2355, 2379. Perhaps, the passing off claim may be extended to protect against the invasion of one’s privacy through the appropriation of one’s name and likeness for another’s benefit – a privacy tort recognised in the United States. See, eg, Restatement (Second) of Torts § 652C (1977); William L Prosser, ‘Privacy’ (1960) 48 California Law Review 383, 389.}

\section*{B \hspace{1cm} Cultural Studies and the Active Audience-Consumer}

Generally, like in the analysis of goodwill, cultural studies perspectives would support a broad notion of damage. A well-known individual is likely to embody a set of affective meanings for the audience-consumer, and an unauthorised commercial use of this well-known persona is therefore likely to draw on these semiotic values. Whether damage is couched in the terms of ‘actual loss’ or ‘debasement of reputation’ or ‘dilution’, the fact is the affective value of the celebrity persona has been compromised in some manner by the defendant’s use. Understanding the role of the active audience-consumer in shaping and infusing the celebrity persona with meaning – and consequently commercial value – can assist a better evaluation of the notion of damage in passing off. Damage must be viewed in conjunction with the other two elements of goodwill and misrepresentation.\footnote{Eg Knight [2007] FSR 813, 836; Amanresorts [2009] FSR 763, 798.} An advertisement – or merchandise – that incorporates the celebrity persona is a polysemic text open to different interpretations. It is accepted in an overwhelming majority of contemporary cultural writings that the audience is not passively imbibing the message communicated to them by cultural producers.\footnote{Eg Tony Wilson, Understanding Media Users: From Theory to Practice (2009) 29, 36-9, 112-29; Iain MacRury, Advertising (2009) 5-6, 49-51, 181-3; 189-90; David Morley, Television, Audiences and Cultural Studies (1992) 119-27.} In the context of passing off, one should be attuned to the inquiry of how meaning is understood...
by the target group of consumers. How is it received – or rejected – by the audience-consumer? Hence audience response to an unauthorised use of the celebrity persona is as relevant to damage as it is to misrepresentation.

If one agrees with the contention in Part IIIC that there is misrepresentation when the relevant segment of consumers has perceived a transfer of semiotic values from the celebrity persona to the defendant’s product, then depending on the nature of the association, it is arguable that the unauthorised use has diverted custom away from the celebrity individual or has devalued the goodwill of the celebrity persona. *Stringfellow v McCain Foods (GB) Ltd* is an unusual case where, although members of the public may have been mistaken about the connection between the plaintiff’s famous nightclub and the defendant’s new oven chips, the plaintiff failed in passing off because harm to goodwill was not established.\(^\text{216}\) In *Knight v Beyond Properties Pty Ltd*, the court held that the claimant failed to prove that he has suffered damage caused or likely to be caused by the initial confusion as he had no ‘real prospect’ or ‘real likelihood’ of securing broadcasting interest in his television programme concept.\(^\text{217}\) In passing off cases involving celebrities, damage should be more easily made out as celebrities do not engage in a particular field of trading activity, but rely on the expansion potential of their fame across a kaleidoscope of products and services. The damage in *Irvine* was clearly a diversion of custom in the denial of an endorsement fee; while that in the *Crocodile Dundee case* and *Koala Dundee* can fall under loss of control of reputation or dilution of profit potential.

The doctrinal objections against recognising dilution of profit potential as a head of damage can be overcome in celebrity passing off scenarios by attuning the damage inquiry to exactly the same cultural observations pertinent to misrepresentation. It has been argued that the ‘notion of dilution [as a head of damage] focuses on the plaintiff’s interests alone’.\(^\text{218}\) When an individual misrepresents his or her product to be endorsed by or associated with another, the defendant is ‘not simply borrowing that other’s reputation … but is more fundamentally assuming that other’s identity … potentially

\(^{216}\) *Stringfellow* [1984] RPC 501, 546-7.

\(^{217}\) *Knight* [2007] FSR 813, 838.

\(^{218}\) Carty, above n 198, 650.
altering the way in which that identity is perceived by others.”

Dilution as a head of damage is indeed a controversial area. If one views it from the perspective of the celebrity individual, the unauthorised and misleading use of persona may be construed as interfering with individual autonomy, then this edges the passing off tort into the territory of misappropriation. On the other hand, if one considers the intent of the commercial defendant to gain a benefit from the use of the celebrity persona without the payment of a licence fee, then one may invoke an unjust enrichment rationale to support the finding of liability. It may be difficult to separate out the issues of principle from arguments of policy; as commentator Michael Spence laments that ‘the tort of passing off is in a state of confusion and change.’

However, in the context of celebrity passing off cases, this deadlock may be resolved by examining the behaviour of the active audience-consumer. The cultural studies literature suggests that advertisers invariably intend that by engaging with a particular advertisement, ‘further associative links might form in consumers’ minds’; hence the relevant damage in passing off may be assessed by inquiring whether such a process has ‘establish[ed] the product-idea or brand-idea, nudge[d] it into position in [consumers’] sensitivity and lives, relative to other competitor brands … leading to further engagements and brand owners’ profits.’

The notion of affective transfer underlies both the elements of misrepresentation and damage. There is a hint in Taittinger SA v Allbev Ltd that courts may be open to considering semiotic meanings of signs. If the positive semiotic meanings of a particular celebrity – like glamour or sexual desirability – are perceived by the audience-consumer to have transferred to (or rubbed off on) the defendant’s products, then the defendant has gained something of value. Conversely, the celebrity individual has ‘lost’ something from his or her commercial

219 Spence, above n 94, 497-8. Commentator Jeremy Waldron also points out that a Hegelian understanding of personal autonomy requires individuals ‘to be able to “embody” the freedom of their personality in external objects so that their conceptions of themselves as persons cease to be purely subjective and become concrete and recognizable to themselves and others in a public and external world’. Jeremy Waldron, The Right to Private Property (1988) 353.
220 Ibid 472.
221 Eg McCracken, above n 65; Sheth, Newman and Gross, above n 65.
222 MacRury, above n 215, 271.
223 Ibid (internal citations omitted).
224 Taittinger [1993] FSR 641, 678 (‘a reference to champagne imports nuances of quality and celebration, a sense of something privileged and special … [it is not] unfair to deny the defendants the opportunity to exploit, share or … cash in on that reputation’).
225 This may be increased brand or product familiarity and/or favourability, which may be measured in terms of an increase in the economic value of the defendant’s product.
potential (often calculated as the licence fee which the defendant should have paid for leveraging this ‘semiotic freight’\(^{226}\)), and one may more confidently conclude that the misrepresentation has ‘harmed’ the celebrity’s connection with the audience-consumer or goodwill.

V CONCLUSIONS

The celebrity persona is ‘the attractive force which brings in custom’\(^{227}\) and those in business believe that ‘the lustre of a famous personality, if attached to their goods or services, will enhance the attractiveness of those goods or services to their target market.’\(^{228}\) Unlike in the ABBA case, courts today need to recognise that the goodwill of the contemporary celebrity extends well beyond the field of activity – like acting, singing or sport – from which the individual first derived his or her well-knownness.\(^{229}\) As evident in the plethora of celebrity-linked advertising and products, from Madonna modeling for Dolce & Gabbana in the Spring 2010 advertising campaign to the range of Beckham fragrances, the ephemeral nature of fame compels the contemporary celebrity to seek different avenues of exploiting their promotional goodwill.\(^{230}\) Unlike in right of publicity doctrine, which may generally impose liability for misappropriation – based on identification of a celebrity plaintiff from the defendant’s unauthorised commercial use\(^{231}\) – the passing off action places an onus on the plaintiff to prove misrepresentation of the celebrity’s association with the defendant. Its focus on the impression that is created in the minds of consumers can overcome some of the doctrinal objections to characterising indicia of identity as personal property, and ‘has the potential to acknowledge the existence of celebrity images in popular culture as a shared resource or heritage.’\(^{232}\) Political recodings that contribute to the democratic process may be protected if they do not mislead the consumer as to the association of the celebrity with the defendant’s

\(^{226}\) See above n 64 and accompanying text.

\(^{227}\) See above n 13.

\(^{228}\) See above n 29.

\(^{229}\) See Irvine [2002] 1 WLR 2355, 2368 (‘it is common for famous people to exploit their names and images by way of endorsement. They do it not only in their own field of expertise but … wider afield also.’). See also King, above n 73, 365 (this includes ‘commercial endorsements, parallel career paths, and merchandising’).

\(^{230}\) See also Bryniczka, above n 183, 185.

\(^{231}\) But see the argument in Chapter 4 that courts should in fact focus on whether the associative value of identity has been appropriated through the consideration of a direct and substantial connection test, rather than merely whether the celebrity may be identified from the defendant’s use.

product. Furthermore, as legal commentator Marshall Leaffer argues, there is potential to agree on ‘an international norm for the protection of [a] personality right based on false endorsement’.233

The most valuable insight that cultural studies can bring to passing off jurisprudence lies in its investigation and analysis of consumers’ interactive identification with the psychological ‘narrative project’ or ‘normative proposition’ of cultural producers that culminates in product acquisition.234 The unequivocal focus on misrepresentation, unlike misappropriation in right of publicity cases, directs courts to the moment at which harm or damage to the celebrity occurs, i.e. there has been an unauthorised transfer of the semiotic meanings of the celebrity’s persona to the defendant’s product as a result of the product becoming more valuable in the eyes of the consumers. The celebrity endorsement studies conducted by McCracken and other scholars have demonstrated that it is this impression of association as a result of the process of interactive identification that makes the defendant’s products more attractive to a relevant group of consumers to whom a particular celebrity persona connotes positive affective meanings. Fears that the passing off action may impose liability for pure misappropriation may be allayed. Only if consumers perceive this association from the defendant’s unauthorised use of the celebrity persona, then the impression engendered is a false one, and accordingly the defendant’s conduct is misleading. The perceived damage, in commercial terms, is the denial of a fee to the well-known individual for the use of his or her affective value in this manner, regardless of whether he or she has previously endorsed products.

The value of the mediated persona of a well-known individual is sustained by a complex interplay of encoding by cultural producers and decoding by audiences. The passing off action should be nuanced to acknowledge the important differences between a commercial trader and a celebrity. A history of prior endorsements could be relevant but not critical to establishing the elements of goodwill or damage. For example, when Leona Lewis won the widely watched X-Factor reality television show on 16 December 2006,235


234 Wilson, above n 215, 119-21. See also MacRury, above n 222, 189-90 (highlighting how audiences connect with advertisements through interpretive and affective processes of semiotic engagement).

it was clear that she literally had become a celebrity overnight, one whose persona was now invested with semiotic meanings that might be commercially exploited. If an unauthorised commercial trader had used her image for the first time next to a product in an advertisement in the week following her victory, it would be egregious to hold that she was not able to fulfill either the goodwill or damage requirements in a passing off claim. Courts, in recognising contemporary celebrity endorsement practices, have held that the denial of a potential licence fee or the diminution of endorsement opportunities is sufficient to satisfy the requirement of damage in a passing off claim. Ultimately, it is the finding of misrepresentation/likelihood of confusion that will be determinative, and this is where cultural studies makes the most valuable contribution to the jurisprudence with its analysis of affective transfer. Thus a close examination of the evidence regarding consumer impression in each case will ensure that liability is found only when there is misrepresentation and not pure misappropriation based on identification.

The findings in this Chapter suggest that the extended passing off claim in UK and Australia not only appears to be adequate in protecting against unauthorised exploitation of the associative value of a celebrity’s persona, but is also able to consider, in a more holistic manner than in a right of publicity claim, the interests of the constituents of the celebrity trinity. Legal commentator Alison Laurie alluded to this when she said ‘the issue of protection of character merchandising rights involves the striking of a balance between three sets of competing interests’, but did not explore this further. The celebrity individual is accorded control over the associative value of his or her commercially valuable persona, but only in circumstances where his or her star aura is transferred to other commodities. The producers as commercial traders are allowed to compete more freely, but not dishonestly. And finally, almost conspicuous by their

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236 Common law passing off jurisprudence in Australia has been influenced by the *Trade Practices Act* 1974 (Cth). Loss or diminution of an opportunity to exploit a commercial advantage is ‘loss or damage’ within *TPA s 82(1)*, and this is generally accepted as the position for passing off claims. Eg *Talma* [1997] 2 Qd R 444, 452; *McMullan*, above n 166, 90-2. See also *Colorado Group Ltd v Strandbags Group Pty Ltd* (2006) 67 IPR 628, 642 (“To prove damage it is no longer necessary to show loss of sales or disparagement of goodwill. It is enough if the exclusivity of the goodwill is eroded.”). The award of damages mirror the ‘damage’ suffered. In *Irvine*, the English Court of Appeal awarded to Eddie Irvine £25,000, representing the ‘reasonable endorsement fee’ the defendant ‘would have had to pay in order to obtain lawfully that which it in fact obtained unlawfully’. *Irvine (Damages)* [2003] 2 All ER 881, 903.

237 Even in Australia where arguably a broader notion of passing off has been endorsed by the courts, the High Court did not intend that passing off should be adapted to cover mere misappropriation akin to a tort of unfair competition. Eg *Moorgate Tobacco [No 2]* (1984) 156 CLR 414, 445.

238 *Laurie*, above n 7, 14. See also similar considerations in *Katekar*, above n 7, 197; *Leaffer*, above n 233, 1370-2.
absence in right of publicity doctrine, the audiences who invest meanings in the celebrity personality are examined as *consumers* in the determination of whether manipulative consumption has occurred.


CHAPTER 7 SUMMARY OF CONTRIBUTIONS OF CULTURAL STUDIES AND CONCLUSIONS

This final chapter provides a summary of the contributions that cultural studies can bring to right of publicity and passing off laws. It revisits the idea of the celebrity trinity and concludes that cultural studies yields a pragmatic framework within which ideological codings, identity formation and consumption practices may be incorporated into legal analysis. Part I discusses the findings that the concepts of evocative identification, associative appropriation and political recoding can all contribute to a more nuanced articulation of right of publicity laws that is consonant with contemporary cultural practices. It also highlights how developments in passing off may be supported by cultural insights on well-knownness and meaning transfer. Part II compares how right of publicity and passing off doctrine protect the associative value of identity. This dissertation concludes that cultural studies has the demonstrated potential to contribute to the development of laws that regulate the commercial exploitation of the celebrity personality.

I SUMMARY OF CONTRIBUTIONS OF CULTURAL STUDIES

This dissertation set out to investigate what contributions cultural studies can make to right of publicity jurisprudence. Two principal insights, as highlighted in Chapter 2, on the definition of the contemporary celebrity based on widespread identification, and on the semiotic significance of the celebrity sign in consumption and identity politics, were further analysed in Chapters 3, 4 and 5. In adopting a pragmatic approach to evaluating how these insights might influence three key elements of a typical right of publicity claim, three important concepts emerged, each with the capacity to reinforce or reshape legal doctrine.

If courts had considered these cultural studies perspectives, perhaps the outcomes in high-profile Circuit cases like White v Samsung,\(^1\) Wendt v Host International\(^2\) and

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ETW Corp v Jireh Publishing would have been different. The preponderance of legal literature on these three cases, each of which was determined by a majority vote, have expressed much criticism of the courts’ reasoning. In the most recent decade, decisions appear to be concerned with the expansive reach of the publicity right, and a number of judges seem to have resorted to a convenient invocation of the First Amendment to permit commercial exploitation of the celebrity persona in situations even where there is little contribution to democratic debate. Cases like Kirby v Sega of America and CBC Distribution and Marketing v Major League Baseball Advanced Media, which involve video and online games, do not engage in significant examination of the democratic value of such commercial uses when dismissing the plaintiffs’ publicity claims. This dissertation suggests that judicial deliberation may benefit from a better appreciation of how consumers respond to uses of the celebrity persona in their purchasing decisions and how audiences make use of semiotic signs in identity politics.

A Right of Publicity

1 Evocative Identification

Starting with Daniel Boorstin’s observation that a celebrity is simply ‘a person who is known for his well-knownness’, the mantra of heightened public identifiability of the contemporary celebrity has been repeated by many influential cultural scholars like Richard Dyer, David Marshall and Graeme Turner who investigate the celebrity

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2 Wendt v Host International Inc, 125 F 3d 806 (9th Cir, 1997) (‘Wendt I’); Wendt v Host International Inc, 197 F 3d 1284 (9th Cir, 1999) cert denied 121 S Ct 33 (2000) (‘Wendt II’) (en banc hearing denied). The Ninth Circuit was unanimous in remanding the case for trial, but was split when considering a petition for rehearing. Kozinski J led an impassionate dissent in favor of en banc consideration.

3 332 F 3d 915 (6th Cir, 2003) (‘ETW Corp’). Clay J’s comprehensive dissent was longer than the majority’s judgment.


5 144 Cal App 4th 47 (2006) (‘Kirby’).


phenomenon. A number of judges and other legal commentators have similarly acknowledged that celebrities may be viewed as cultural phenomena which owe their existence to audiences and to their dramatic magnification by technological advances in media and communication. Similarly, in his leading treatise, Thomas McCarthy has accepted a broad definition of celebrity as ‘merely a person whom “many” people talk about or know about.’ As examined in Chapter 3, it is generally recognised that celebrities ‘have very high public awareness and people are able to visualize them very easily as they are so familiar with them.’ Indeed it is this evocative aspect of celebrity – easy audience recall through the ‘marginal differentiation of their personalities’ – which spurs advertisers to offer lucrative endorsement contracts to celebrity individuals to exploit their names and images in conjunction with a wide range of products and services.

Contemporary celebrities have used, and are continuing to use, a broad spectrum of identity signifiers to distinguish themselves. Despite Rosemary Coombe’s criticism of the right of publicity, she concedes that

the attributes that are legally protected as an individual’s ‘persona’, however, are those that are *publicly identified* with him or her; it is the degree to which the particular attribute is socially distinctive or publicly recognizable that determines its protection against unauthorized use.

The investigation of case law strongly suggests that any well-known and distinctive attributes may evoke a celebrity plaintiff in the minds of the consumers – whether triggered visually or aurally. Thus the use of a lookalike or soundalike could trigger the public’s identification of the relevant celebrity and result in a triable issue of fact for

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8 See Chapter 3 Part IIIA.
9 Eg *ETW Corp*, 332 F 3d 915, 933 (6th Cir, 2003); *Cardtoons LC v Major League Baseball Players Association*, 95 F 3d 959, 972 (10th Cir, 1996) (‘*Cardtoons*’).
11 McCarthy, above n 6, § 4:2.
13 Boorstin, above n 7, 65.
similar arguments may be made for objects or occasions well-known to be closely associated with a particular celebrity.\textsuperscript{16}

The concept of ‘well-knownness’ lends credence to the view that all evocative indicia of identity are prima facie actionable. This should not be due cause for alarm. Such an approach to identification cogently draws on the understanding that the celebrity personality is made up of three key constituents: the individual (who is identified by these indicia), the cultural producers (who produce and circulate these distinctive indicia through different communication channels) and the audience (who identifies a particular celebrity personality and the semiotic meanings attached to that personality). Courts can be more open to admitting evidence that a particular distinctive attribute – eg hairstyle, gesture or pose – calls to mind the celebrity plaintiff at the point in time and in the locality that the tort was allegedly committed. However, this threshold inquiry merely establishes identification of the plaintiff from the defendant’s use, and is not to be equated with liability.

Chapter 3 has shown that cultural studies perspectives affirm the Ninth Circuit’s assertions in \textit{White I}\textsuperscript{17} and \textit{Wendt I},\textsuperscript{18} as well as statutory definitions,\textsuperscript{19} that any readily recognisable aspect of a celebrity’s identity that is likely to possess a commercial value may be the subject of unauthorised appropriation. An evocative identification standard that requires the plaintiff to be reasonably and readily identifiable by a more than de minimis number of people from the total context of the defendant’s use adequately encompasses all aspects of a plaintiff’s valuable persona that are publicly identifiable. But \textit{White v Samsung} is a difficult case. In my view, while the principle of evocative identification enunciated by the majority in \textit{White} is supportable, the conclusion is questionable. The unauthorised commercial uses in \textit{Motschenbacher}, \textit{Midler} and \textit{Carson} – cases cited by the majority – all employed identifying characteristics unique to the

\begin{itemize}
  \item \textit{Onassis v Christian Dior-New York Inc}, 472 NYS 2d 254 (1984);
  \textit{Estate of Elvis Presley v Russen}, 513 F Supp 1339 (DNJ, 1981);
  \textit{Apple Corps Ltd v ADPR Inc}, 843 F Supp 342 (MD Tenn, 1993);
  \textit{Midler v Ford Motor Company}, 849 F 2d 460 (9\textsuperscript{th} Cir, 1988) (‘Midler’).
  \item \textit{Lombardo v Doyle, Dune & Bernbach Inc}, 396 NYS 2d 661 (1977);
  \textit{Motschenbacher v RJ Reynolds Tobacco Co}, 498 F 2d 821 (9\textsuperscript{th} Cir, 1974) (‘Motschenbacher’).
  \item \textsuperscript{17} 971 F 2d 1395, 1401 (9\textsuperscript{th} Cir, 1992).
  \item \textsuperscript{18} 125 F 3d 806, 811 (9\textsuperscript{th} Cir, 1997). Although the Ninth Circuit phrased the issue there as one of ‘likeness’, the court nevertheless affirmed \textit{White I}: “[the right of publicity] protects against appropriations of the plaintiff’s identity by other means.” Ibid.
  \item \textsuperscript{19} \textit{Illinois Right of Publicity Act}, 765 Ill Comp Stat Ann § 1075/5.
\end{itemize}
celebrities, which were the only information as to the identity of the particular celebrity evoked; hence a triable issue of fact was raised as to whether their identities have been appropriated. However, in White, the advertisement did not affirmatively identify Vanna White the individual. As Alarcon J points out in his dissent, those things which Vanna White claims identify her are not unique to her. They are, instead, attributes of the role she plays. The representation of those attributes, therefore, does not constitute a representation of Vanna White.\(^1\)

Undoubtedly Vanna White is well-known to American audiences, and she has been the only letter-turner on the Wheel of Fortune since 1982. Regrettably, the majority’s pronouncement that she was ‘the only one’ who ‘dresses like this, turns letters, and does this on the Wheel of Fortune game show’\(^2\) failed to consider whether the advertisement in fact evoked a role or character she played on the program, and whether White has a valuable public persona separate from her television role or character.

Similarly, in Wendt I, the animatronic figures in the Cheers airport bars raised an issue of whether the plaintiffs Wendt and Ratzenberger or their sitcom characters Norm and Cliff were evoked; but this was unfortunately overlooked by the Ninth Circuit. However, Kozinski J, voting for en banc rehearing, understandably was concerned that ‘the sweeping standard … adopted in White’ would result in ‘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’.\(^3\) Arguably the presentation of the robots in the Cheers bars is a derivative work under copyright law, like a play or musical based on the TV series, or ‘Norm’ and ‘Cliff’ action figures.\(^4\) This sets up a

\(^{1}\) White I, 971 F 2d 1395, 1404 (9th Cir, 1992).

\(^{2}\) Ibid 1399.

\(^{3}\) Wendt II, 197 F 3d 1284, 1286 (9th Cir, 1999).

\(^{4}\) As the copyright owner of the television series Cheers, Paramount owns the copyright to all its copyrightable components. Eg Warner Bros Inc v American Broadcasting Cos, 720 F 2d 231, 235 (2nd Cir, 1983) (‘Plaintiffs own the copyrights in various works embodying the character of Superman and have thereby acquired copyright protection for the character itself.’); Universal City Studios Inc v JAR Sales Inc, 216 USPQ 679, 683 (CD Cal, 1982) (‘As an element of the copyrighted motion picture “E.T. The Extra-Terrestrial”, the character is protected subject matter. Protection extends to expressions of that character not only in motion pictures, but in other media as well, including three-dimensional expressions such as dolls and other forms of sculpture.’).
clash between two rights holders.\textsuperscript{24} Whether one views cultural studies as approaching popular culture from a ‘they’ perspective (how the audience is controlled, manipulated or resists the imposition of meaning) or a ‘we’ perspective (how the audience participates in the creation and circulation of meaning),\textsuperscript{25} it is difficult to discern how a conflict between the celebrity individual and the cultural producers may be resolved. While cultural studies may bolster the argument for evocative identification based on uses of distinctive characteristics, its contribution is relatively limited in the area of evocation based on a role or character.

The analysis undertaken in this dissertation has revealed that these cultural insights can support the recognition of a broad range of evocative indicia of identity, but they do not assist with the determination of the extent to which the right of publicity should be privileged over copyright. Evocative identification may be sound in law, but it will continue to encounter significant difficulties in practice. As Kozinski J points out in \textit{White II}:

But once you include the game board, anybody standing beside it – a brunette woman, a man wearing women’s clothes, a monkey in a wig and gown – would evoke White’s image, precisely the way the robot did.\textsuperscript{26}

For instance, one may reasonably and readily identify actors Brandon Routh, Christopher Reeve, Dean Cain or George Reeves from a likeness of another actor performing the part of Superman in an advertisement for the defendant’s product, but the inquiry should not end there. One may ‘think of’ any one of these actors, but it does not mean that the character is synonymous with a particular actor.\textsuperscript{27} The logical question next should be whose persona, if any, is so inextricably intertwined with his screen persona that the character becomes his ‘property’. As McCarthy remarks, identification ‘must be interpreted to mean something more than that some people “think of” an actor who once

\textsuperscript{24} It is widely accepted in recent times that the right of publicity is not preempted by federal copyright. Eg \textit{Facenda v NFL Films Inc}, 542 F 3d 1007 (3rd Cir, 2008) (‘Facenda’); \textit{Brown v Ames}, 201 F 3d 654 (5th Cir, 2000); \textit{Landham v Lewis Galoob Toys Inc}, 227 F 3d 619 (6th Cir, 2000) (‘Landham’); \textit{Toney v L’Oreal USA Inc}, 406 F 3d 905 (7th Cir, 2005); \textit{Wendt I}, 125 F 3d 806 (9th Cir, 1997).


\textsuperscript{26} \textit{White II}, 989 F 2d 1512, 1515 (9th Cir, 1993).

\textsuperscript{27} Eg McCarthy, above n 6, § 4:70. See also \textit{Wendt II}, 197 F 3d 1284, 1286-7 (Kozinski J) (9th Cir, 1999).
portrayed the role … Similarly, that many people “think of” Johnny Weissmuller whenever they see a Tarzan-type character in a television advertisement does not automatically mean that they “identify” Johnny Weissmuller.’

This ‘something more’ is perhaps most adequately captured by the McFarland ‘inextricably identified’ test.

Finally, cultural studies insights can support the contention that unaided identification should be the triggering threshold since the ‘identification is made by a mental comparison of what one has in mind or memory with whatever it is that the defendant uses.’ As the cultural writings have observed, the commercial advertisements and popular media narratives, as well as those found in internet sites and other social contexts, have all contributed to the creation and circulation of a well-recognised public persona for particular individuals, some with highly distinctive characteristics like hairstyle, makeup and other insignia. The heightened media focus on each individual celebrity may result in audiences perceiving certain attributes, symbols or objects to be ‘closely associated’ with that celebrity.

For example, in the case of David Beckham, the extensive coverage of his hairstyles and his tattoos can result in these distinctive symbols of his identity being ‘readily identifiable’ as David Beckham the celebrity footballer by members of the public.

The standard of ‘unaided’ identification is more appropriate than ‘aided’ identification as it requires the juror to recognise the plaintiff by virtue of a comparison with a pre-existing mental impression of the celebrity plaintiff’s persona.

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28 McCarthy, above n 6, § 4:69. McCarthy also appears to place much importance on the fact that actors like the Marx Brothers and Chaplin have created their characters and are therefore more deserving of publicity right protection. Ibid.

29 McFarland, 14 F 3d 912, 921 (3rd Cir, 1994). Commentator Angela Cook has illustrated the difficulty of according the appropriate publicity right protection to actors playing characters, and recommended a ‘sliding scale approach’ in which the most compelling protection is accorded when ‘the actor plays himself or herself as a character’ or when ‘the actor creates the character’ to a situation where no protection is given to an actor who simply portrays a character and whose public personality is not inseparable from that character. Angela D Cook, ‘Should Right of Publicity Protection be Extended to Actors in the Characters in which They Portray’ (1999) 9 De-Paul LCA Journal of Art & Entertainment Law 309, 314-32. Michael Albano also proposed a useful list of factors to assist courts in their determination of when an actor merely popularises a given character and when the character is not synonymous with the actor. Michael J Albano, ‘Nothing to “Cheer” About: A Call for Reform of the Right of Publicity in Audiovisual Characters’ (2001) 90 Georgetown Law Journal 253, 293-4.

30 McCarthy, above n 6, § 3:20.

31 Eg Motschenbacher, 498 F 2d 821, 827 (9th Cir, 1974). The court held that the preliminary evidence that several persons who said they had immediately recognised the plaintiff’s car from the advertisement was sufficient to enable Motschenbacher to prove the issue of identifiability at trial.

32 According to Whannel, a ‘novel or striking appearance helps to bring a [sporting] star to public attention. As the fame of the star grows, appearance becomes more central as a signifier … [and] in the construction of star images.’ Garry Whannel, Media Sports Stars: Masculinities and Moralities (2002) 194.

33 The concepts of ‘aided’ and ‘unaided’ identification are not commonly found in the case law. They are
the juror makes the mental connection between the defendant’s advertisement and the plaintiff – that is, the advertisement evokes the plaintiff in the minds of the audience – then this is unaided identification based on the familiarity of the audience with the plaintiff beforehand. Using this kind of unaided identification as the test of liability would not cause the identifiability issue to be biased in favour of the plaintiffs since the ‘commercial advantage is created only in the minds of those persons who identify the plaintiff by comparing what they already have in mind with whatever is shown in the defendant’s commercial use.’\textsuperscript{34} Hence the more that there are distinctive features that a well-known individual possesses, the greater is the likelihood of ready recognition by members of the public. Limiting the actionable attributes of identity to the classic indicia of name and likeness would be inconsistent with contemporary cultural understanding of the celebrity phenomenon. The ‘appropriate limitations’\textsuperscript{35} to the right of publicity may be found in a stricter requirement of commercial appropriation or a more robust First Amendment defence, but not in a restrictive interpretation of identifiability.

2 Associative Appropriation

What is certain about the right of publicity is its evolution to meet ‘the needs of Broadway and Hollywood’\textsuperscript{36}. This thesis agrees with the view that the celebrity is ‘a commodity that possesses in its humanness and familiarity an affective link in consumer culture to the meaning that is bestowed on consumer objects by groups.’\textsuperscript{37} As Chapters 2 and 4 have shown, in particular through the works of Stuart Hall and Grant McCracken, the celebrity persona is encoded with culturally constituted meanings and these meanings can move from the celebrities into the products they are associated with, and finally from the products into the consumers.\textsuperscript{38} Although a number of Circuit Court decisions have clearly stated that the plaintiff must show that his or her ‘identity has been commercially described terms proposed by McCarthy in an attempt to ‘organize and rationalize thinking about problems of “identification” in right of publicity law’. McCarthy proposes that in most cases the triggering test for liability should be ‘unaided identification.’ See McCarthy, above n 6, § 3:19.
\textsuperscript{34} Ibid.
exploited by a defendant’, there has been no significant judicial discussion of the meaning of commercial exploitation or appropriation. These cultural observations and consumer research studies offer a valuable contribution to the law when considering whether an unauthorised use of the celebrity identity in a commercial context has the effect of enhancing the consumption values of a product.

The right of publicity should not be construed as a pure misappropriation tort. As Sheldon Halpern points out, a ‘celebrity’s persona confers an associative value – an economic impact – upon the marketability of a product.’ Chapter 4 has pointed out the importance of returning to the crux of a publicity claim – whether there was associative appropriation. This inquiry is better attuned to the commercial harm suffered or likely to be suffered by the plaintiff. In the words of Bird CJ, has the defendant ‘increase[d] the value or sales of the product by fusing the celebrity’s identity with the product and thereby siphoning some of the publicity value or good will in the celebrity’s persona into the product’? This may not be a protracted inquiry in all cases, but it is important in the ‘hard’ cases like White v Samsung and Wendt v Host International, where the affective value may be appropriated from a sign other than the celebrity sign. Thus this thesis has argued that the defendant should only be liable if the defendant either had sought to secure an economic impact or had realised an economic benefit through the unauthorised use of the celebrity persona.

Although under the Restatement (Third) of Unfair Competition, liability should only be imposed when one ‘appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity’, most courts in practice do not consider whether ‘commercial value’ has been misappropriated. The inquiry is largely focused on identification of the plaintiff from the defendant’s use. Thus a fundamental shortcoming in right of publicity doctrine lies in its presumption that

39 Eg Parks v LaFace Records, 329 F 3d 437, 460 (6th Cir, 2003); Landham, 227 F 3d 619, 624 (6th Cir, 2000).
41 Lugosi v Universal Pictures, 25 Cal 3d 813, 834 (1979) (‘Lugosi’).
42 See also Elvis Presley Enterprises v Capice, 950 F Supp 783, 801-2 (SD Tex, 1996) (the court decided the use of the name ‘The Velvet Elvis’ and Elvis memorabilia as décor were not commercial appropriations but were used to create an era of which Elvis was a public part). See discussion in Chapter 4 Part IIIB2.
an unauthorised use of the celebrity persona in a commercial context has resulted either in an economic gain to the defendant or a loss of a licence fee to the plaintiff. Courts have acknowledged that celebrities can offer the consumer an excellent shortcut to a branding or advertising message, frequently with a visual immediacy that generates a high mass-market impact. Indeed using a celebrity in advertising, merchandising or other commercial contexts can have a positive effect on consumers’ brand attitudes and purchasing decisions. But, as discussed in Chapter 4, the defendant should not be held liable merely because the celebrity’s identity has been used ‘to attract the consumers’ attention.’ There must have been an unauthorised use of the associative value of identity in order to attract liability. The defendant should be deemed to have gained a commercial benefit through the use of a particular celebrity’s persona because in the eyes of the fans, the defendant’s product has become more attractive, and its consumption values have been enhanced. The initial affective relationship between the celebrity and the audience would have translated into an economic one between the celebrity/product and the audience/consumer. The findings from cultural studies support the contention that the defendant should be liable because he or she has exploited the ‘affective link’ between the celebrity and the audience for commercial gain; this suggests that a causal connection should be found between the use of the celebrity identity and the benefit gained by the defendant. However, this inquiry is different from the finding of a likelihood of confusion under a Lanham Act §43(a) or passing off claim. Although it is argued that the notion of affective transfer should be relevant to a finding of liability

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44 Commonly perceived to have formed strong affective relationships with their audiences, actors are the most frequently used celebrity group in advertisements in the United States. Eg Sejung Marina Choi, Hee-Jung Kim and Wei-Na Lee, ‘Lessons from the Rich and Famous: A Cross-Cultural Comparison of Celebrity Endorsement in Advertising’ (2005) 34 Journal of Advertising 85, 94. See Chapter 4 Part IIIB.


47 Marshall, above n 37, 245.

48 Evidence that points to such exploitation include targeting the plaintiff’s fan base as potential consumers of the defendant’s products and where the use of the plaintiff’s identity is ‘integral’ or ‘crucial’ to the defendant’s commercial purpose – eg the defendant’s business enterprise is primarily built upon the use of the indicia of the plaintiff’s valuable persona or the plaintiff is the central feature of the defendant’s advertisement. Eg Doe v TCI Cablevision, 110 SW 3d 363, 366-7, 371 (Mo banc, 2003) (‘Doe’); McFarland, 14 F 3d 912 (3rd Cir, 1994) (‘Spanky McFarland’s’ as the name of a restaurant); Carson, 698 F 2d 831 (6th Cir, 1983) (‘Here’s Johnny’ as the brand name of portable toilets); Newcombe, 157 F 3d 686, 693-4 (9th Cir, 1998) (‘the drawing which resembled Newcombe was a central figure in the advertisement and the purpose of the advertisement was to attract attention’).
under both the right of publicity and passing off actions, it is nuanced differently and tailored to the distinctive elements of each claim.

The proposed requirement in Chapter 4 that the commercial benefit sought by the defendant be directly and substantially connected to the associative value of the plaintiff’s identity has been instituted in some form or other in a handful of states as a ‘direct connection’ test or under the incidental use doctrine where unauthorised uses which have de minimis commercial implications are not subject to liability. The requirement also adheres to the crux of a publicity claim that the appropriator must ‘project a star quality association between the celebrity and the advertised product’, the Restatement (Second) of Torts similarly acknowledges that the value that inheres in the plaintiff’s identity must have been appropriated in order for a tort to be committed. An examination of whether there was a direct and substantial connection would focus attention on the audience’s perception of whether the affective meaning have moved from the celebrity sign to the defendant’s product and determine liability accordingly. Admittedly, this sounds like importing a requirement of misrepresentation through the backdoor, but it is reasonable to require at least some evidence of consumer confusion in order to infer that affective transfer has taken place. Although the “‘mere possibility” that consumers may be misled is insufficient’ to prevail on a Lanham Act § 43(a) false endorsement claim, this evidence of consumer confusion may nevertheless contribute to a finding of a direct and

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49 California has a statutory rule that contains a ‘direct connection’ test which states that it is not an infringement of the right of publicity ‘solely because the material containing such use’ is in a ‘commercial medium’; it is ‘a question of fact’ whether the use of persona was so ‘directly connected with the commercial sponsorship or with the paid advertising’. California Civil Code §§ 3344(e), 3344.1(k).

50 States like New York, Florida, Maryland and Oregon, through the incidental use rule, engage in a similar inquiry. McCarthy, above n 6, §§ 6:90, 7:20.


52 Restatement (Second) of Torts § 652C cmt c (1976).

53 Cairns v Franklin Mint Co, 292 F 3d 1139, 1221 (9th Cir, 2002); Newton v Thomason, 22 F 3d 1455, 1461 (9th Cir, 1994). A likelihood of confusion is synonymous with ‘probable’ confusion; the courts have noted that ‘[s]ome confusion is always possible: but there must be some threshold quantum that crosses from mere possibility into a probability.’ WE Media Inc v General Electric Co, 218 F Supp 2d 463, 479 (SD NY, 2002) (applying the Polaroid factors – the equivalent of the Sleekcraft factors). This is the standard upheld by all the Circuit courts. See J Thomas McCarthy, McCarthy on Trademarks and Unfair Competition (4th ed, 1996) § 23:3.
substantial connection especially where the defendant has evinced a clear intention of exploiting the plaintiff’s well-known persona.\textsuperscript{54}

If the direct and substantial connection inquiry had been undertaken in \textit{White I}, \textit{Wendt I} and \textit{ETW Corp}, the outcomes would likely have been different. It was discussed in Chapter 4 that \textit{White I} was a case where the defendant did not seek ‘to associate the positive values of the celebrity with the product’ but only used the evocation ‘merely [as] a point of reference’\textsuperscript{55} to the \textit{Wheel of Fortune}. Arguably, the consumption values of Samsung VCRs may have been enhanced solely as a result of the defendant’s exploitation of the affective link between the audience and the long-running \textit{Wheel of Fortune} program.

In \textit{Wendt I}, Host International had paid a licence fee to Paramount, the copyright owner of the \textit{Cheers} series, to operate airport bars based on the popular television program. The inclusion of animatronic figures that evoke the characters from \textit{Cheers} should be construed as being part and parcel of the defendant’s licence to exploit the affective link that audiences have with the \textit{Cheers} program. Kozinski J correctly asserted that when depicting a character who was portrayed by an actor, ‘it is impossible to recreate the character without evoking the image of the actor in the minds of viewers.’\textsuperscript{56} The commercial benefit sought by Host was not directly and substantially connected to the associative value of Wendt and Ratzenberger, but rather to the \textit{Cheers} program.

In \textit{ETW Corp}, contrary to the majority’s peremptory dismissal, it is plausible that the defendants have sought to exploit the commercial value of Tiger Woods’ star aura. As Clay J in dissent observed, ‘the rendition done by Rush is nearly identical to that in the poster distributed by Nike’ for which Woods was paid an endorsement fee.\textsuperscript{57} It is clear that Nike had paid a fee to Woods in order to obtain permission for the commercial

\textsuperscript{54} Eg \textit{Carson}, 698 F 2d 831 (6th Cir, 1983); \textit{Bi-Rite Enterprises Inc v Button Master}, 555 F Supp 1188 (SD NY, 1983). The case law indicates that intent is not a necessary element in finding liability as the focus is on the commercial loss to the plaintiff and the commercial advantage to the defendant, but it is taken into account in the award of damages. McCarthy, above n 6, § 3:35; \textit{Restatement (Third) of Unfair Competition} § 49 (1995).


\textsuperscript{56} \textit{Wendt II}, 197 F 3d 1284, 1286 (9th Cir, 1999).

\textsuperscript{57} \textit{ETW Corp}, 332 F 3d 915, 959 (Clay J dissenting) (6th Cir, 2003).
exploitation of the affective value of Woods identity through the use of his likeness on the posters. By analogy, it is therefore arguable that Rush is also exploiting the affective link that Woods has with his fans by selling prints that bear a striking resemblance to the Nike image of Woods; the economic value of Rush’s prints may be said to be derived primarily from the fame of the celebrity depicted. Unlike the Samsung advertisement where the focus was on the *Wheel of Fortune*, here ‘the focus of the print is not the Masters Tournament or the other golfers who have won the prestigious green jacket award, but that of Woods holding his famous golf swing while at that tournament.’

Thus, rather than assume that the defendant has gained a commercial benefit as a result of the audience’s identification of the celebrity, the investigation of an associative appropriation as informed by insights from cultural studies has the advantage of attuning one to the examination of whether the defendant has exploited the affective link between the celebrity personality and the audience. This approach suggests that there should have been no commercial appropriation of the associative value of White’s or Wendt’s and Ratzenberger’s identities but prima facie liability should have been found in *ETW Corp*.

### 3 Political Recoding

As pointed out in Chapter 1, the consumer-citizen in hybrid mode presents a challenge for the law in its regulation of commercial and expressive aspects of consumption. Contemporary cultural studies has devoted much energy to studying genres of media representation that are consumed, resisted and recoded by groups within society. Protected by intellectual property and tort laws, these representations – which include celebrity personalities – are ‘prevalent and promising cultural forms with which to consider cultural authority, subcultural formations, and hegemonic struggles.’ A semiotic democracy may be supported by an appropriate First Amendment defence that is powered by principles that underpin the advancement of democracy deliberation and

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60 *ETW Corp*, 332 F 3d 915, 959 (6th Cir., 2003).
61 Coombe, above n 14, 31.
debate. Chapter 5 has outlined how subcultural and subaltern groups can identify with and utilise celebrity signs as a powerful symbolic force to express their views in a democratic society. Through the examination of the significant work done in cultural studies on counterpublic practices that challenge the construction of identities, it has attempted to situate these challenges within First Amendment jurisprudence that considers the democratic value of the use of the celebrity identity in political speech.

Chapter 5 has also illustrated a more complex interplay in the arena of identity politics where the delineation of the celebrity individual, cultural producer and audience becomes blurred. All three entities may be speakers who contest over the use of the celebrity sign in advancing a particular viewpoint pertinent to democratic deliberation and debate. Although the celebrity persona may be regarded as having an important function in symbolic speech, the celebrity individual is also recognised as a valid holder of a private property right over his or her commercially valuable public persona. This duality of semiotic sign/property presents formidable issues when the right of publicity conflicts with free speech values, as the celebrity individual wrestles with the producers and audiences over the control of the sign/property.

One contribution that cultural studies can bring to the consideration of free speech interests in right of publicity laws is its understanding of how celebrity signs may be used by societal groups to advance their political agenda. The writings of cultural scholars like Dyer and Marshall have demonstrated this potential. In particular, Hall has discussed how these repressed groups may use trans-coding strategies to reverse stereotypes, substitute ‘negative’ portrayals with ‘positive’ ones or contest subordinate representations. Legal scholarship has also begun to explore the recoding possibilities

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63 Like semiotic meanings embodied by a celebrity sign, other cultural signs like the American flag also connote particular values. Although the symbolism of a celebrity sign may not evoke similarly strong feelings, nonetheless an analogy may be drawn with flag burning, cross burning, display of the nativity scene and menorahs, where expressive uses of symbols are recognised by courts to be relevant to the free speech and establishment clauses of the First Amendment. Eg Texas v Johnson, 491 US 397 (1989); RAV v City of St Paul, Minnesota, 505 US 377 (1992); Allegheny County v ACLU, 492 US 573 (1989). See also Chapter 5 Part IIIB1.
64 Eg Richard Dyer, Stars (1979) 30; Dyer, above n 37, 143 (noting that the Judy Garland celebrity sign may speak of “the homosexual identity in self-oppressive modes characteristic of oppressed groups – distancing, denying, denigrating”); Marshall, above n 37, 48.
65 Stuart Hall, “The Spectacle of the “Other”” in Stuart Hall (ed), Representation: Cultural Representations and Signifying Practices (1997) 223, 270. The term ‘transfunctionalize’ has also been
that challenge dominant representations. In her critique of legal commodification of cultural symbols, Coombe contends that cultural practices illustrate the ‘vibrant role played by these cultural icons in the self-authorings of minority, subaltern, or alter/native social groups.’

The counterpublics are ‘counter’ to the extent that they try to supply different ways of imagining participation within a political or social hierarchy by which its members’ identities are formed and transformed. Thus, from a cultural studies perspective, the political agenda of these groups may be best communicated to the dominant culture through the use of widely recognised celebrity signs to which the mainstream public have ascribed particular representative values or characteristics. From a legal perspective, these communications may be categorised as political speech which merit the highest protection in First Amendment doctrine.

Arguing that the purpose of freedom of speech is to promote a democratic culture, legal scholar Jack Balkin made a strong case for ‘a fair chance to participate in the production of culture, and in the development of the ideas and meanings that constitute them and the communities and subcommunities to which they belong.’ As this thesis has adopted a participatory theory of democracy that underpins the First Amendment’s protection of speech, it has maintained that not all speech shares the same constitutional value; the highest constitutional value should be accorded to political speech – i.e. speech that contributes to public discourse and public access to information in a democracy so that people can make informed choices in politics and other socially important areas. Chapter 5 has shown that a participatory theory of the First Amendment supports the protection of the making of ‘representations about self, identity, community, solidarity, and difference’ or the articulation of political and social aspirations using the celebrity

used to describe how subcultures assign new and often contradictory meanings to signs as understood by mainstream society. Paul Nathanson, Over the Rainbow: The Wizard of Oz as a Secular Myth of America (1991) 241. Hall, ibid 270-5.

Coombe, above n 14, 89. Lawrence Lessig points out that even the white Anglo-Saxon male patriarchy occupies a fragile identity space in hope of benefiting from the rewards that mainstream society hands out to those who fit a particular essentialised idea of power. Lawrence Lessig, ‘The Regulation of Social Meaning’ (1995) 62 University of Chicago Law Review 943, 955.


Balkin, above n 62, 4.

sign within a ‘dialogic democracy’ as political speech which can involve either affirmations of or opposition to hegemonic ideologies.

The defendants’ uses of the celebrity persona in White I and Wendt I carry no discernible content that is of value to democratic deliberation and debate; the Samsung ad and the Cheers bars could hardly be perceived as political speech. Similarly, in ETW Corp, the artist Rick Rush’s almost literal rendition of Tiger Woods made no attempt to recode the celebrity sign to express any viewpoint that may contribute to public decisionmaking in a democracy. As discussed in Chapter 5, Woods’ depiction contributes little to any public awareness or discussion of issues relating to his dominant coding. Beyond determining what type of expressive uses of celebrity iconography may be classified as political speech, the larger difficulty remains with regard to the classification of other types of speech and the appropriate level of protection. For example, if Samsung’s depiction of Vanna White was categorised as a parody or satire that was non-political in nature, it is unclear how a cultural studies approach would resolve the conflict. Drawing on cultural studies, legal scholars like Coombe and Madow would probably argue that allowing the celebrity individual to exclusively control the use of his or her images would threaten cultural pluralism and amount to private censorship of popular meaning-making, however, others like Hughes have also canvassed for appropriate restrictions to be imposed on uses of the celebrity persona so as to maintain the background stability of the semiotic sign in order to facilitate social discourse.

In the absence of guidance from the Supreme Court, Circuit and state courts have employed a number of different approaches to the First Amendment defence in a

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70 Coombe, above n 14, 248-9.
71 As highlighted in Chapter 5 Part III B2, Vanna White may be perceived as a symbol of the privilege of ‘whiteness’, and her celebrity sign may therefore be susceptible to recoding challenges. However, this is no evidence of any counterpublic recoding in the Samsung advertisement.
73 Eg Coombe, above n 14; Madow, above n 10.
75 The only right of publicity case considered by the Supreme Court did not yield a clear First Amendment defence applicable to such cases. As highlighted in Chapter 5 Part II A, what emerged from the majority’s judgment appears to be the inapplicability of the actual malice standard for the media defendant, and the use of a direct balancing approach. See Zacchini v Scripps-Howard Broadcasting Co, 433 US 562 (1977). See also Halpern, above n 40, 867 (‘the Supreme Court has not dealt directly with a paradigmatic right of publicity case’).
right of publicity claim. Although Chapter 5 has explored how according certain uses of the celebrity identity the status of political speech may impact the application of three dominant tests, this thesis is inclined toward the direct balancing approach as the most preferred one that adequately takes into account not only the semiotic and political significance of the celebrity sign, but also the speech interests of both the celebrity plaintiff and the defendant speaker.\textsuperscript{76} The categorisation of the defendant’s use of the plaintiff’s identity as ‘political speech’, ‘commentary’, ‘art’ or ‘entertainment’ is only an answer to the threshold question of whether the impact of an enforcement of the right of publicity on the speech at issue is subject to any First Amendment scrutiny.\textsuperscript{77} It should not confer automatic immunity on the defendant’s speech against a right of publicity claim. For example, if a board game, wall poster or some form of merchandise contains a depiction of a celebrity intertwined with political expression, the fact that the defendant has added significant transformative components or whose predominant purpose is expressive only serves to define the type of speech that is being regulated and the judicial inquiry should not end there.\textsuperscript{78} But it is worthwhile to note that, as McCarthy cautions, at some point along the spectrum ranging from traditional informational media to useful objects, the goals served by the First Amendment can become so highly speculative and attenuated that they are clearly outweighed by the publicity rights of the individual.\textsuperscript{79}

Virtually all the current First Amendment tests employed by courts in publicity claims, such as the transformative elements test or predominant purpose test, do not address how different types of speech merit different degrees of protection. The application of definitional rules, like what categories of speech and mediums are protected by the First Amendment, requires a subsequent step of taking into account the relative benefits and harms in determining whether the plaintiff or the defendant should prevail. A number of decisions from Circuit and state courts suggest that what is significant is the medium, not the message, and have denied First Amendment protection for the unauthorised use of identity in messages on items like t-shirts, dishes or drinking mugs.\textsuperscript{80} It is arguable, however, that, depending on the context, political speech can

\textsuperscript{76} See also McCarthy, above n 6, § 8:39 (‘[t]he balance must be laboriously hacked out case by case’).
\textsuperscript{77} As discussed in Chapter 5 Part IB, courts generally adopt a two-step approach when considering the constitutional validity of governmental restriction on speech. First, to determine the type of speech at issue, and second, to apply the appropriate level of scrutiny to the governmental regulation.
\textsuperscript{78} Eg Facenda, 542 F 3d 1007, 1017-8 (3rd Cir, 2008) (discussing how to classify hybrid speech).
\textsuperscript{79} McCarthy, above n 6, § 7:21.
\textsuperscript{80} Ibid § 7:22.
nonetheless inhere in celebrity merchandise as ‘First Amendment doctrine does not disfavor nontraditional media of expression’.\(^{81}\) In certain situations, the commercial defendant may be a speaker, or facilitating political speech by others, in expressing a counterculture viewpoint through, for example, the recoded likeness of a celebrity on t-shirts. It may be underprotective of speech to withhold protection solely based on the medium of expression.\(^{82}\) Albeit in the context of matters of public concern, the Supreme Court has indicated that the balancing of a society’s interest in the freedom of speech against its interest in upholding other values must be determined with regard to the ‘content, form, and context’ of the expression in question.\(^{83}\) The Court’s preference is ‘to focus on the narrower interface’;\(^{84}\) and in a right of publicity case, such a balancing focus should be on the impact of the enforcement of the right of publicity on the defendant’s message, taking into account its content, form and context of dissemination, weighed against the damage suffered by the plaintiff as a result of the unauthorised use of his or her identity in the defendant’s speech. One should also be careful not to be overprotective of speech by focusing only on the recoding interests of the audience-speaker. Right of publicity laws should aim to strike a balance between protecting, on the one hand, both the proprietary right of the well-known individual to exploit the associative value of identity and his or her right as an individual speaker to not a propound a particular point of view,\(^{85}\) and on the other hand, the right of others to express a political viewpoint through recoding or trans-coding of the celebrity sign. Such a consideration takes into account the competing interests of all three constituents of the celebrity trinity.

The Supreme Court’s ruling in *Hurley v Irish-American Gay, Lesbian & Bisexual Group of Boston* presents an interesting example here. The Court recognised that the South Boston Allied War Veterans Council had the ‘right as a private speaker to shape its

\(^{81}\) *Comedy III*, 25 Cal 4th 387, 399 (2001). While wearing a recoded celebrity identity t-shirt in a particular context may be political speech, it is unlikely, as the courts have decided, that games and memorabilia wall posters qualify for First Amendment protection. Eg *Rosemont Enterprises Inc v Urban Systems Inc*, 340 NYS 2d 144 (1973); *Factors Etc Inc v Pro Arts Inc*, 579 F 2d 215 (2nd Cir, 1978). Contra *CBC*, 505 F 3d 818 (8th Cir, 2007).

\(^{82}\) Eg *Ayres v City of Chicago*, 125 F 3d 1010, 1014 (7th Cir, 1997) (‘The T-shirts that the plaintiffs sells carry an extensive written message of social advocacy’). Cf McCarthy, above n 6, § 7:30.

\(^{83}\) *City of San Diego v Roe*, 543 US 77, 83 (2004); *Connick v Myers*, 461 US 138, 147 (1983). See also *Cox Broadcasting Corp v Cohn*, 420 US 469, 491 (1975) (‘Cox’) (‘In this sphere of collision between claims of privacy and those of the free press, the interests on both sides are plainly rooted in the traditions and significant concerns of our society’); *Time Inc v Hill*, 385 US 374, 387-8 (1967).

\(^{84}\) Eg *Cox*, ibid.

expression by speaking on one subject while remaining silent on another" and hence could exclude a group from marching in the parade to express its members’ pride in their Irish heritage as openly gay, lesbian, and bisexual individuals, and to show that there are such individuals in the community. Under what circumstances should a celebrity individual be able to prohibit his or her persona from being used to advance someone else’s political views because he or she personally professes a contrary view or chooses to remain silent on the matter? It is clear that even with respect to political speech, ‘the First Amendment does not guarantee the right to communicate one’s views at all times and places or in any manner that may be desired’. A balancing analysis has been consistently used by courts to resolve whether a trespass on private property may otherwise be justified on First Amendment grounds. It has also been used on a number of occasions by the Supreme Court to balance ‘the competing private and public interests at stake in the particular circumstances shown.’ Unlike a private shopping centre which can post disclaimers or disavow any connection with the viewpoint being expressed, it would not be practicable for the celebrity individual to express his or her personal viewpoint vis-à-vis every trans-coded use of his or her identity in political speech.

Finally, one should also acknowledge the present limitations of cultural studies in its contribution to First Amendment jurisprudence. For many cultural studies scholars, the field has been defined by an ‘array of theoretical and political positions which … share a commitment to examining cultural practices from the point of view of their intrication with, and within, relations of power’. As much of the cultural studies writings are founded on concerns of power, the insights that they bring are far more

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86 Ibid 574.
90 Eg Barenblatt v United States, 360 US 109, 126 (1959); New York v Ferber, 458 US 747, 763-4 (1982); Employment Division, Department of Human Resources v Smith, 494 US 872, 899, 910-11 (1990). It should be noted that the Supreme Court is highly divided over the use of balancing in resolving constitutional guarantees. Eg Bendix Autolite Corp v Midwesco Enterprises, 486 US 888, 897 (Scalia J) (1988) (‘the scale analogy is not really appropriate … since the interests on both sides are incommensurate. It is more like judging whether a particular line is longer than a particular rock is heavy.’).
91 Eg PruneYard, 447 US 74, 87 (1980).
valuable to the discussion of political speech or a participatory theory of the First Amendment than for other kinds of speech like artistic speech. However, some scholars like John Hartley have avoided framing interactions in popular culture in the language of power, and have instead focused on examining communicative encounters between parties as highly coded dialogues.\textsuperscript{93} Indeed there are other exciting research possibilities that lie ahead for the study of the cultural implications of the depiction of the celebrity persona in art,\textsuperscript{94} in particular non-political recodings, and their potential influence on right of publicity and free speech jurisprudence.

B Passing Off

The cultural studies insight about the notion of well-knownness that defines the contemporary celebrity is as applicable to the threshold requirement of local goodwill in passing off as it is to identification in a publicity claim. Modern communications have accelerated the widespread dissemination of celebrity images and information, resulting in indicia of identity beyond name and likeness being capable of evoking a particular celebrity in the minds of the audience. Local goodwill functions much like the first element of a typical publicity claim: the inquiry is whether the celebrity as identified by the consumer possesses the requisite actionable goodwill or reputation in the particular jurisdiction.\textsuperscript{95} Since it is the well-knownness and the affective meanings of the contemporary celebrity that contribute to the subsistence of promotional goodwill that is capable of adding value to any product it is associated with, there is no real need to prove the existence of any trading activities in the jurisdiction. The cases have so far demonstrated that the existence of prior trading or advertising is relevant only when a commercial trader alleges that another trader lacks the requisite local trading goodwill.\textsuperscript{96} When an individual claims to possess the requisite goodwill because of his or her well-knownness, the courts examine not just the claimant’s commercial endorsement history, but also the media coverage and appearances and fan mail received.\textsuperscript{97}

\textsuperscript{93} Hartley, above n 25, 4-5. See generally, Gibson, above n 25.
\textsuperscript{94} The work in this area is limited. But see, John A Walker, \textit{Art and Celebrity} (2003).
\textsuperscript{96} Eg Erven Warnink v Townsend [1979] AC 731; BBC v Talbot Motor Co Ltd [1981] FSR 228.
\textsuperscript{97} Eg Irvine v Talksport Ltd [2002] 1 WLR 2355; Knight v Beyond Properties Pty Ltd [2007] FSR 813.
With regard to misrepresentation, courts, especially in Australia, appear to be moving away from a narrower requirement of direct endorsement or approval toward a broader concept of *impressionistic association* when considering passing off claims involving celebrities. Such developments are unequivocally supported by the cultural studies insights on affective meaning transfer in consumption. Although the English courts have been more insistent than their Australian counterparts that at least a real likelihood of damage, such as a loss of licensing opportunity, has to be shown, it was argued in Chapter 6 that misrepresentation and damage should be considered together in celebrity passing off cases guided by an understanding of affective transfer. The analyses in Chapters 2, 4 and 6 collectively have demonstrated that the affective meanings of a particular celebrity semiotic sign are transferred to a brand or product that the celebrity persona is perceived to be associated with, even when the celebrity merely appears in the copresent mode in an advertisement. As illustrated in the celebrity endorsement studies conducted by McCracken, it is this impression of association that makes the defendant’s products more attractive to a relevant group of consumers to whom a particular celebrity persona connotes positive affective meanings.

In justifying an expansive interpretation of the right of publicity, the *Eastwood* court has famously declared that “[t]he first step toward selling a product or service is to attract the consumers’ attention”. However, attracting the audience’s attention is not sufficient in itself to attract liability in passing off. Ultimately, there is no hard rule; it is ‘a question of fact and degree, and each case will need to be assessed on its own merits in light of all the surrounding circumstances.’ Chapter 6 has shown that the focus on misrepresentation, unlike misappropriation in right of publicity cases, directs courts to the moment at which actionable damage to the celebrity occurs, i.e. the celebrity was not paid a fee for the transfer of the semiotic meanings of his or her persona to the defendant’s product as a result of the product becoming more valuable in the eyes of the consumers. As Iain McRury explains, when engaging with advertisements, ‘associative links may form in the consumers’ minds, or become reaffirmed’; such a manipulative process will establish the ‘product-idea or brand idea … in readers’ sensibility and lives, 

relative to other competitors brands and other valued signs, leading to further engagements and brand owners’ profits.” Such observations resonate with judicial comments in celebrity passing off cases like Pacific Dunlop v Hogan and Irvine v Talksport Ltd. As discussed above in respect of the right of publicity, these insights are also relevant to determining associative appropriation—whether the defendant has sought to gain a commercial benefit from these associative links that might form in the consumers’ minds.

Instead of assuming that meaning has been transferred from celebrity to product, as in a typical right of publicity claim, passing off requires courts to examine whether in fact these meanings have been transferred as a result of consumers perceiving an endorsement, approval or association of a celebrity plaintiff with the defendant’s products. There should be no fear of impoverishing the public domain of cultural symbols since the celebrity individual obtains redress for an unauthorised use of the associative value of his or her persona only in circumstances where his or her star aura has been transferred to other commodities. It is also under these circumstances where there is an actual or a real likelihood of damage to the associative value of the celebrity persona; the celebrity individual may have been denied his or her customary endorsement fee or may have experienced a diminution of commercial attractiveness as a result of the defendant’s use. Moreover, political recordings of the celebrity persona, as well as other expressive elements like parody, may be taken into account in the determination of misrepresentation. Rather than be mired in a conflict of property versus speech, judicial evaluation of the defendant’s expressive conduct in passing off is attuned to the perception of the audience: whether the defendant is using a particular celebrity persona, and its connotative meanings, to convey a particular viewpoint that contributes to democratic debate or is seeking to transfer its affective meanings to the defendant’s product.

II CONCLUSIONS

A Pragmatic Framework for Legal Analysis

The pragmatic contributions of cultural studies to right of publicity laws, through its understanding of contemporary consumption and identity politics, can assist judges in their articulation of legal rules that better reflect cultural practices. This thesis contends that the right of publicity doctrine has not been well interpreted by courts over the years. However, it does not claim that cultural studies is a complete antidote to these problems; rather it claims that cultural studies can provide valuable insights that may advance doctrinal development.

This dissertation has shown that cultural studies insights on the celebrity phenomenon support both an expansive interpretation of identification in a right of publicity claim and, at the same time, a more restrictive application of the requirement of commercial appropriation. It has also demonstrated how a refined understanding of ideological codings of the celebrity persona as political speech may be incorporated into free speech jurisprudence, and what some of the likely outcomes would be under various formulations of the First Amendment defence as argued in publicity claims. In addition, these cultural insights have similar relevance to passing off laws in the context of unauthorised uses of the celebrity persona, supporting a broad interpretation of goodwill and a standard of impressionistic association to be sufficient to constitute misleading conduct.

Although the Restatement (Third) of Unfair Competition and some judicial comments have alluded to the publicity tort as one of misappropriation of the value of identity rather than simply the misappropriation of identity, the decisions overwhelmingly suggest that identification is presumptive of misappropriation and judges often rely on the First Amendment defence to exonerate the defendant. Due to the

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105 Eg Eastwood, 149 Cal App 3d 409, 420 (1983); Abdul-Jabbar, 85 F 3d 407, 416 (9th Cir, 1996); Wendt I, 125 F 3d 806, 811-2 (9th Cir, 1997); Kirby, 144 Cal App 4th 47, 59 (2006); CBC, 505 F 3d 818, 823-4 (8th Cir, 2007).
perceived expansion of the right of publicity by the Ninth Circuit in recognising evocative indicia of identity as actionable under the common law, other courts appeared to have responded by strengthening the First Amendment defence. This has resulted in increased uncertainty on how courts tackle the First Amendment issue – as evident in the different tests used by Circuit and state courts discussed in Chapter 5 – and outcomes that may be based less on evidentiary proof of commercial appropriation of the associative value of the celebrity persona than on the judges’ proclivity toward free speech protection.

This dissertation has demonstrated that an analytical framework based on concepts of **evocative identification, associative appropriation** and **political recoding**, distilled from an analysis of relevant writings in cultural studies, can all contribute to a more nuanced understanding of right of publicity doctrine. The cursory judicial nod given to observations in cultural studies, such as by the Sixth Circuit majority in *ETW Corp*\(^{106}\) or the Eighth Circuit in *CBC*,\(^{107}\) can be a dangerous thing when courts do not engage in a thorough examination of cultural practices and consumption behaviour, but instead rely on platitudes that appear merely to support the outcomes they desire. The appeal of cultural studies to some judges may presently rest with how, as used by scholars like Madow and Coombe, it ‘prioritizes unfettered public discussion ahead of further accumulation of rights by top celebrities.’\(^{108}\) But as pointed out by legal commentator Michael Sloan, courts may be retreating too quickly behind the cultural studies doctrine, ‘never supporting its assertions with evidence presented during trial.’\(^{109}\)

The more controversial cases of *White I, Wendent I* and *ETW Corp* would have benefitted from a thorough consideration of these insights. Samsung might not have been liable, as it was arguable that it was the *Wheel of Fortune* gameshow that was evoked and from which the affective meaning was siphoned into Samsung’s VCRs. Host might have obtained summary judgment as it was directly cashing in on the positive cultural meanings vested in the *Cheers* program through its chain of airport bars based on the

\(^{106}\) 332 F 3d 915, 933 (6\(^{th}\) Cir, 2003) (‘Through their pervasive presence in the media, sports and entertainment celebrities come to symbolize certain ideas and values … Celebrities, then, are an important element of the shared communicative resources of our cultural domain.’)

\(^{107}\) 505 F 3d 818, 824 (8\(^{th}\) Cir, 2007) (the right of publicity is barely implicated since ‘major league baseball players are rewarded, and handsomely, too, for their participation in games and can earn additional large sums from endorsements and sponsorship arrangements’).

\(^{108}\) Sloan, above n 4, 928.

\(^{109}\) Ibid 929.
show, and not on the fame of the individual actors. And Tiger Woods might have been successful in his claim against Rush, whose lithographs made no attempt to recode his celebrity sign in a manner that contributed to participatory democracy. This thesis has presented courts with an opportunity to adopt a systematic and principled framework to using cultural studies when examining right of publicity claims. In evocative identification, courts can consider a broad range of communication channels and popular cultural practices to determine whether a particular attribute used by the defendant was distinctive and readily identifiable with the celebrity individual. The concept of associative appropriation tethers an expanding right of publicity to the examination of whether the defendant has sought to transfer the affective value of the celebrity persona to the defendant’s products; liability should only be imposed when consumers have perceived this affective transfer or when the defendant has clearly intended for the transfer. While numerous right of publicity cases overwhelmingly rely on an unjust enrichment rationale to prevent the defendant from free-riding on the plaintiff’s fame, the notion of affective transfer strikes a more balanced analysis with attention to whether the plaintiff has suffered harm or loss caused by consumers perceiving a transfer of affective values. Finally, political recoding of the celebrity sign offers a critical understanding how counterpublic uses of the celebrity persona that contribute to democratic debate and deliberation may be meaningfully considered in First Amendment jurisprudence.

Similar considerations may be taken into account by courts in other common law jurisdictions such as the UK and Australia when adjudicating passing off claims. Passing off protects the affective values of the celebrity persona by imposing liability when the audience perceives or is likely to perceive a transfer of these values to the defendant’s products. The focus is on the causative harm to the celebrity persona as a result of affective transfer. Uses that primarily recode the celebrity persona – especially counterpublic trans-coding practices – should be evaluated based on their contribution to democratic deliberation and debate. As explained in Chapter 6, political recoding may be taken into account when assessing misleading conduct, and for the UK, such an internalisation approach would be within the margin of appreciation accorded to Member States in giving effect to the European Convention on Human Rights. Similarly, the accommodation of such recodings within misrepresentation doctrine would conform to the implied freedom of political communication in Australia.
In a right of publicity claim, it would be wrong to automatically conclude that the audience’s identification of a particular celebrity from the defendant’s commercial use should result in prima facie liability, since the defendant may not have intended to exploit or have exploited the affective meanings of that celebrity persona. If one accepts – as this thesis has argued – that the next step is to interrogate whether associative appropriation has occurred, then one is in fact seeking to determine if the affective connotative meanings of the celebrity persona are perceived to have been transferred. It is at this juncture that right of publicity and passing off doctrines converge. Although there is no clear approach here, courts in right of publicity cases appear to direct their inquiry to the *behaviour of the defendant* when they do, on occasion, attempt to establish if there was indeed an appropriation of associative value.\(^\text{110}\) In the *passing off* cases, the judicial focus is on the *perception of the consumers* as to whether they are likely to be confused into thinking that the celebrity persona is associated with the unauthorised user. From a cultural studies perspective, both inquiries share a fundamental similarity – courts will find liability for an unauthorised use of the celebrity persona if there was a perceived transfer of affective values from the celebrity sign. In other words, the free-riding defendant has exploited the ‘positive halo effect’\(^\text{111}\) of celebrity. The courts, in cases like *Eastwood*, *Newcombe* and *Abdul-Jabbar*, in ruling on the right of publicity usually presume that the audience’s *identification* of the celebrity – including evocative aspects of identity – is equivalent to the *perception* that affective meaning has been transferred, because by attracting the consumer’s attention the defendant has gained a benefit.\(^\text{112}\) In contrast, the claimant has to prove in passing off, on a balance of probabilities, that there was such a likelihood of such a perception of transfer by the consumer under the requirement of misrepresentation; the analysis in Chapter 6 has shown that this requirement is not a difficult one to satisfy as the courts are increasingly adopting the concept of impressionistic association in passing off cases involving celebrity claimants.\(^\text{113}\) It was also argued in Chapter 6 that a strict interpretation of damage in passing off is unnecessary in the context of a celebrity claim. The *sine qua non* of passing

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\(^\text{110}\) Eg *Doe*, 110 SW 3d 363, 367 (Mo banc, 2003) (that the defendant ‘directly targeted hockey fans – Twist’s primary fan base’); *Carson*, 698 F 2d 831, 836 (6th Cir, 1983) (that the defendant ‘admitted that he knew that and probably absent that identification, he would not have chosen [the name]’); *Midler*, 849 F 2d 460, 461 (9th Cir, 1988) (that the plaintiff was ‘not interested’ in the commercial when addressed by the defendant).


\(^\text{112}\) Eg *Newcombe*, 157 F 3d 686, 693 (9th Cir, 1998); *Abdul-Jabbar*, 85 F 3d 407, 416 (9th Cir, 1996);


\(^\text{113}\) See Chapter 6 Part IIIA.
off is likelihood of consumer confusion; if consumers have perceived affective transfer, then it is the assessment of damages that should appropriately reflect the relevant degree of harm. Thus it appears that the extended passing off action measures up to the right of publicity, and can offer comparatively robust protection against unauthorised commercial uses of the celebrity persona.

However, once free speech considerations enter the fray, the protection offered by the right of publicity significantly wanes in comparison. Publicity cases in the last decade have revealed that courts are willing to employ a range of different tests that purport to give effect to First Amendment values with the result of protecting, inter alia, artistic expression that has no discernible contribution to democratic deliberation and debate, caricatures, and video and internet fantasy sports games. In contrast, the common law jurisdictions of the UK and Australia do not share the heightened speech protection culture characteristic of the United States. Despite the presence of conventional and constitutional guarantees of freedom speech in these jurisdictions, the passing off cases there, as well as other intellectual property cases, suggest that courts would not consider taking a subsequent step of evaluating a free speech defence. Elements of parody or commentary, if present, are taken into account as part of factual matrix when determining misleading conduct. Celebrities have succeeded in instances where there was parody, and even where the merchandise only evoked the celebrity persona.

A methodical consideration of the content, form and context of each expressive use is essential to resolving publicity and passing off disputes. For example, one may read the Supreme Court’s reasoning of the use of parody in *Campbell v Acuff-Rose* as

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114 Eg *ETW Corp*, 332 F 3d 915 (6th Cir, 2003) (an almost literal depiction of Tiger Woods at a golf tournament).
115 Eg *Cardtoons*, 95 F 3d 959 (10th Cir, 1996) (parody trading cards featuring caricatures of major league baseball players).
117 See Chapter 6 Part IIIB.
118 *Pacific Dunlop Ltd v Hogan* (1989) 25 FCR 553 (‘Crocodile Dundee case’) (parodic television advertisement of celebrity actor based on a scene from his movie).
119 *Talmax Pty Ltd v Telstra Corp Ltd* [1997] 2 Qd R 444 (print advertisement that provided information on an Olympic swimmer’s achievements to promote the sport of swimming nevertheless held to have misrepresented the plaintiff’s association).
120 *Hogan v Koala Dundee Pty Ltd* (1988) 20 FCR 314 (koala merchandise in get-up evocative of Paul Hogan).
extending to the audience an ‘invitation to contrast’.

Where it may be shown that the defendant is using the celebrity persona to criticise or comment on the core connotative values of the celebrity sign, or on the celebrity individual as denoted by the particular sign, it is arguable that the audience-consumer will not perceive the affective meanings embodied by the celebrity sign to have been transferred to the defendant’s product for the purposes of both the right of publicity and passing off claims.

B  Concluding Remarks

Consumption goes beyond an acquisition of commodities to an active shaping of a sense of self through using the meanings embodied in the celebrity commodity. Moreover, it is a frequent theme in contemporary cultural studies that the audience-consumer originates meaning. Contrary to the passive audience thesis of the Frankfurt School, it is not a top-down process; neither does meaning automatically move from product into the consumer. As Cashmore succinctly puts it:

All the corporate power in the world can’t put meaning into merchandise. [It depends on] … a receptive population of consumers who read the celebrities in a way that makes them attractive, credible, or invests those celebs with the right kinds of meaning.

The analysis in cultural studies of audiences’ reading of cultural texts, which include celebrity signs, suggests that the passing off action, which determines liability based on the consumers’ impression of particular uses of a celebrity’s persona, offers a more holistic consideration of the celebrity trinity. The element of misrepresentation requires courts to examine whether in fact these meanings have been transferred because of audiences perceiving an endorsement, approval or association of a celebrity individual with a profit-motivated cultural producer. Presently, right of publicity laws tend to presume that the meaning transfer has occurred once the celebrity has been identified in an advertisement that grabs the audience’s attention but as shown in the analysis of White v Samsung, this may not always be the case. On the other hand, the passing off inquiry can better determine liability for unauthorised exploitation of associative value in its

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121 Dreyfuss, above n 10, 152.
focus on whether this affective transfer has occurred as a result of the audience’s perception.

In conclusion, this dissertation has shown that, far from being merely a theoretical discipline focused on ideological codings and the politics of power and identity, cultural studies has the potential to provide important insights that can assist in the advancement of laws that regulate the commercial exploitation of the celebrity persona. Even one of the most ardent proponents of the right of publicity concedes: ‘The complex questions, such as those raised by White v Samsung, and the unsettled boundary at the interface of evocation and appropriation, require continuing efforts to articulate principled bases for both the limitations and the expansion of the right.’ 123 The proposed analytical framework, based on notions of well-knownness, semiotic codings and meaning transfer, facilitates an instrumental approach to using cultural studies in right of publicity – and passing off – jurisprudence. While this dissertation started off with an observation that the right of publicity is usually thought to offer greater protection to the commercial value of the celebrity identity compared to the passing off action, a closer interrogation of the legal literature and cultural insights has suggested the contrary. The extended passing off action – free of the confusing and confused strictures of the First Amendment – has the potential to offer celebrities more robust protection against unauthorised commercial uses of their persona. The multiperspectival investigation undertaken in this research project has yielded a pragmatic framework – centred on the key elements of the right of publicity and passing off claims – which judges and lawyers can draw on to articulate more nuanced legal arguments that are consonant with cultural and consumption practices today. The laws that protect the commercial value of personality operate in ‘a semiosphere combining social, market and cultural significations seamlessly’. 124 There is no doubt that the extra-legal perspectives of cultural studies on the meaning, production and consumption of the celebrity personality provide a vital resource for the formulation of better legal solutions in contemporary times. Global brands are continuing to sign multi-million dollar deals with movie stars, pop singers and sporting icons for the privilege of using their personae in association with their products. Celebrity sells – the fact is, you will have to pay for it too; there is no free-ride.

123 Halpern, above n 40, 873.
124 MacRury, above n 101, 274.
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