U.S. Federal Right of Publicity

March 3, 1998

Sponsoring Committee: Right of Publicity Subcommittee of the Issues and Policy Committee

Resolution

WHEREAS, at its 1994 Annual Meeting in Seattle, Washington, the Board of Directors of the International Trademark Association (INTA) assigned to the former U.S. Legislation Committee the mission to review the issues involving the right of publicity and recommend to the Board whether the Lanham Act should be amended to meet the needs of trademark owners;

WHEREAS, the new Right of Publicity Subcommittee of the Issues and Policy Committee and the predecessor committee have spent three years studying the issues surrounding right of publicity with the counsel of a distinguished panel of special advisors;

WHEREAS, right of publicity issues sometimes overlap with and are connected to trademark issues; and

WHEREAS, existing state common and statutory law dealing with the right of publicity provides a patchwork of different and inconsistent provisions which create uncertainty for trademark owners and national advertisers.

BE IT RESOLVED, that the INTA Board of Directors approves in principle, federal right of publicity legislation as an amendment to the Lanham Act that embodies all of the following standards:

1. Preempts all state law, both statutory and common law.
2. Harmonizes, to the extent practicable, the divergent laws of various states in a manner that recognizes the principles underlying the right of publicity and fairly balances competing public interests.
3. Recognizes the principles underlying the right of publicity by providing for a descendible and transferable right of publicity for a fixed term after death without regard to whether their right was exploited during a person's lifetime.
4. Protects the public interest by providing, through a "grandfather clause," prior user rights for the owners of names and marks consisting of an aspect of persona lawfully acquired before enactment of federal right of publicity legislation.
5. Protects the public's interest by exempting from liability, uses of persona that meet fair use/First Amendment standards for uses such as, without limitation, news, biography, history, fiction, commentary and parody.

Background

In 1994, the INTA Board authorized the formation of a subcommittee to review the issue of the right of publicity in the United States, and consider whether INTA should advocate an amendment to the Lanham Act which would provide for such a right. Over the course of the next three years, a subcommittee of the former U.S. Legislation Committee and the new Right of Publicity Subcommittee of the Issues and Policy Committee reviewed current state laws and the needs and desires of INTA members with regard to this particular issue. The subcommittees worked with three special advisors: J. Thomas McCarthy, W. Mack Webner and Gary Ropski.

From the beginning of this project, there was a general consensus amongst subcommittee members that there is disparity in the right of publicity law from state to state and that INTA members need to deal with this topic on a national basis. Developments in case law dealing with the exploitation of the name and likeness of deceased celebrities sparked in the launch of the effort to draft a federal right of publicity statute. In addition, the parameters of what is considered trademark law are expanding to meet the needs of a changing commercial environment.

Studies were undertaken of the various issues raised by a federal, preemptive right of publicity statute. Based on those studies and extensive discussions both within the subcommittee and with others, the subcommittee and its special advisors reached certain conclusions and prepared a working draft of the statute. In September 1996, November 1996, and in February 1997, presentations were made to the INTA Board concerning an actual draft of the proposed right of publicity legislation. During these meetings, Board members expressed concern over a number of provisions in the proposal and suggested that the subcommittee continue investigating the matter.

At the 1997 Annual Meeting in San Antonio, the subcommittee decided to seek the Board's approval of a new resolution that, in general outlines the reasons for and the essential provisions of a proposed federal statute. If approval of these general principles is obtained, the subcommittee will then contact other interest groups, including the ABA IP Section (Right of Publicity Subcommittee) and the entertainment and advertising industries, to draft legislation which suits the needs and concerns of all the interested parties. The legislation will of course need to be consistent with the general principles contained in this resolution.

Report of the Right of Publicity Subcommittee on the Proposed Resolution in Support of a Federal Right of Publicity Statute

What is the "Right of Publicity?"

A "right of publicity" is the right of a person to control the commercial use of his or her persona, including, but not limited to attributes such as name, voice, likeness or other indicia of his or her personality (i.e., "persona"). Nicknames and pseudonyms that identify a particular living or

deceased individual also could qualify as an aspect of persona. Examples of the licensed exploitation of the right of publicity include the use of Michael Jordan's name and likeness in ads for GATORADE, and a model turning into Marilyn Monroe in an ad for CHANEL NO. 5. Currently, the aspects of persona of a living person, such as names or photographs can become trademarks upon meeting the usual requirements to be considered trademarks, such as affixation to a product or its packaging.

The Importance of the Right of Publicity to the Membership of INTA

Right of publicity issues frequently overlap with and are connected to trademark issues. They account for numerous decisions involving trademark infringement and unfair competition claims. A recent case involving the name and likeness of SPANKY MCFARLAND for a restaurant involved closely connected issues of right of publicity, trademarks and Section 43(a) of the Lanham Act. See *McFarland v. Miller*, 14 F.3rd 912 (3rd Cir. 1994). Aspects of the persona right, such as a person's name, are often used as or part of registered trademarks, as in AMELIA EARHART luggage, ROY ROGERS restaurants and GIORGIO ARMANI clothes. Currently, the Lanham Act prohibits registration as a mark of a "name, portrait or signature" which identifies a particular living individual without his consent. The Lanham Act is silent on prohibitions for registration as a mark of a name, portrait or signature which identifies a particular deceased individual (except dead Presidents of the United States). In addition to the trademark issues involved, clearance of a mark and review of advertising and packaging may involve issues of right of publicity, such as the name, photograph or characteristics of both living or deceased individuals

Principles for a Federal Right of Publicity Statute

Principles 1 and 2: Preemption and Harmonization of State Laws

A federal right of publicity statute is needed to bring uniformity and predictability to this area of the law. Currently, rights of privacy and publicity are controlled by the vastly differing statutory and case law of the fifty states. To date, seven states have recognized this right exclusively by statute. Eleven states by common law common law. Eight states recognize both a common law and a statutory right of publicity. Businesses wishing to make nationwide use of particular aspects of a living or deceased individual's persona need to analyze all of these laws and apply the most onerous requirements of each state in order to avoid liability.

Additionally, none of the state laws deal adequately with certain issues of concern to INTA members. What if the name of a person who died 65 years ago is being used as a trademark for guitars lawfully, but without consent (as permitted under the Lanham Act and then current state law)? Then, a state passes a law, giving a right of publicity to persons who died within the last 100 years. Is such a law equitable to the owner of the trademark rights for guitars?

Principle 3: Descendible, Transferable, and Fixed Term

Whether the right of publicity survives after the death of the holder has been a point of sharp division among the various states. New York has a statute and case law which limit publicity rights to the lifetime of the person. Twelve statutory jurisdictions that have addressed this issue

treat the right of publicity as descendible. In addition, the states differ as to the duration of the post mortem rights. For example, the duration of the post mortem right is as short as 20 years in Virginia and as long as 100 years in Oklahoma. The states that recognize a post mortem right of publicity by common law have expressed no limitation on its duration.

Principle 4: The "Grandfather Clause"

A "grandfather clause" would recognize expressly the interests of prior users of names and marks consisting of aspects of persona lawfully acquired before enactment and exempt from liability for infringement for continued uses of such names and marks. For example, such a clause would exempt from liability a qualifying use of the mark WINSTON CHURCHILL for encyclopedias without the consent of the heirs or assigns of the famous statesman and author who died in 1963. Thus, trademark rights which were senior to newly created federal person rights would prevail in a dispute between the two.

Principle 5: Exemptions from Liability

As developed in the case law, defenses to claims of infringement of a right of publicity have included legal and equitable defenses such as constitutional free speech, the non-confusing use of a person's own name or other aspects of persona, or that the alleged infringer has obtained consent to the use. The Right of Publicity Subcommittee proposes that federal right of publicity legislation be designed to accommodate First Amendment constitutional and fair use principles and to permit use of aspects of persona in connection with matters of public interest. Expressly permitted uses of aspects of persona would include, but not be limited to, news, biography, history, fiction, commentary, and parody.

Conclusion

Many INTA members enjoy the marketing benefits of exclusive licenses from celebrities and the estates of dead celebrities. Negotiating such licenses and pursuing infringers would be more predictable if the right of publicity was a single national law rather than the present patchwork. Some states have yet to address the question, and some states have lower court decisions that hold there is no right of publicity. To provide clarification and uniformity, the Right of Publicity Subcommittee requests that the Board of Directors adopt the preceding resolution.