PERSONALITY FIXATION: TOWARDS A NEW FRAMEWORK FOR COPYRIGHT PREEMPTION OF STATE PUBLICITY RIGHTS INFRINGEMENT CLAIMS

ANDREW M. JUNG

INTRODUCTION

The “right of publicity” is a state-law creation and is defined as the right to control and license the use of a person’s “identity.”1 For most individuals, publicity rights won’t bear on everyday life, and such rights exist only behind the scenes of advertisements, movies, and literature. Yet, these rights are increasingly the subject of controversy, both in courts and academic literature.2

Owing perhaps to a tortured evolution,3 publicity rights are often criticized for being over-protective of plaintiff interests,4 and at the very least, nebulous and confusing.5 Protection may be considered part of privacy law, a type of personal property, or some sort of hybrid property interest with privacy-based characteristics.6 The scope of individual protection varies – sometimes widely – from jurisdiction to jurisdiction. For example, Indiana protects an array of

---

1 See 5 J. THOMAS McCARTHY, McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28.1 (4th ed. 2004) (defining the right of publicity as “the inherent right of every human being to control the commercial use of his or her identity”); see also Note, Andrew M. Jung, TWITTERING AWAY THE RIGHT OF PUBLICITY: CELEBRITY IMPersonATION ON SOCIAL NETWORKING WEBSITES, 85 Chi. K. L. R. 381, 384 (2010).
2 See, e.g., Wendt v. Host Int’l, Inc., 197 F.3d 1284, 1285-86 (9th Cir. 1999) (Kozinski, J., dissenting); Eriq Gardner, What’s in a Name?, ABA JOURNAL (Nov. 1, 2010) (discussing criticisms that publicity rights are over-protective of plaintiffs, chilling of free speech, and operate as an end-around for other more widely accepted tort claims); Thomas F. Cotter and Irina Y. Dmitrieva, Integrating the Right of Publicity with First Amendment and Copyright Preemption Analysis, 33 Colum. J.L. & Arts 165, 166-68 (2010).
3 See infra Section II.
4 See, e.g., White v. Samsung Elec. Am. 989 F.2d 1512, 1513-14 (9th Cir. 1993) (Kozinski, J. dissenting); Gardner, supra note 2.
5 See Gardner, supra note 2.
6 See Jung, supra note 1, at 385-98.
personal characteristics, from voices and images, to signatures and gestures, for an individual’s life plus one hundred years, yet Puerto Rico does not protect publicity rights at all. And, even in areas where robust protection exists, the extent of such protection is often hard to articulate or control.

Regardless of its doctrinal uncertainty, one fact about the right of publicity is now clear: publicity rights are big business. Protectable aspects of personas – whether they be faces, names, silhouettes, or voices – infiltrate advertisements, movies, music, books, magazines, consumer goods, and even the nightly news. Celebrity endorsements and name or image-licensing deals act as the backbone for popular advertisements. Images of famous musicians or athletes are now commonly used in popular video games, where the ability to play the game as a celebrity is a main selling point.

Lurking in the background of the publicity rights landscape is the proverbial “800lb gorilla”: often a use of an aspect of a person’s identity – say in an advertisement or on product packaging – is incorporated in, and inseparable from, an underlying work protected by federal copyright law, which in turn is owned by someone other than the person whose publicity rights

---

7 See infra Part I.D.
9 See Gardner, supra note 2 (discussing, among other examples, a $600,000 verdict for use of a picture of musician Nikki Sixx in an advertisement); see also, e.g., Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1098, 1102–06 (9th Cir. 1993) (upholding a jury award of over $2 million to singer Tom Waits for a voice appropriation claim under California law).
11 See, e.g. Keller v. EA Sports, 2010 WL 530108, •1 (N.D. CA 2010) (video game that is premised on being able to simulate college football games using the actual players on historical teams); Ahn v. Midway, 965 F.Supp. 1134, 1136 (N.D. IL 1997) (likeness of martial artist used as character in a combat game); Gardner, supra note 1. In particular, Gwen Stefani, singer for the popular band No Doubt, has sued makers of a video game that allows players to “unlock” a digital Stefani, which game-players can then, among other things, make sing songs in a male voice. See 192 Cal.App.4th 1018, ••1-3 (2011); Eriq Gardner, Appeals Court Allows No Doubt to Pursue ‘Band Hero’ Lawsuit Against Activision, THE HOLLYWOOD REPORTER, HOLLYWOOD, ESQ. blog (Feb. 16, 2011), http://www.hollywoodreporter.com/blogs/thr-esq/appeals-court-allows-no-doubt-100278.
are at stake. In reality, it is often impossible to create certain kinds of copyrightable works without “fixing” an aspect of a persona in that work. Live-action movies are not possible without filming actors to portray the characters; that new hit single on the radio is not possible without recording the voice of the lead singer in the band; and, as admittedly tautological as it sounds, a photograph of a person is not possible unless you take a photograph of a person. On the other side of the coin, it is almost impossible to create something that infringes on a person’s publicity rights without “fixing” an aspect of a persona into a “tangible medium of expression,” to use terms that are foundational in copyright law. Publicity rights aren’t infringed in the abstract; some infringing product or creation is necessary.

This entanglement of publicity rights in copyrightable works requires a scheme to separate out and subordinate either one of the two interests, as appropriate. Otherwise, if individuals are allowed to, without restraint, inject publicity rights interests into copyrighted works, authors will not be able to monetize copyrightable works to the full extent contemplated by federal copyright law and creative expression will be stifled to point of creating a “tragedy of the anticommons.” And, if copyright law is allowed to trump all publicity rights, there is no need to have publicity rights – and regardless of how one feels about the efficacy or scope of

---

12 Granted, there is the possibility of digitally creating (or recreating) a human face or voice, or a character’s actions. 13 See (copyright act) (showing fixation in a tangible medium of expression is one requirement for copyright protection). It would seem like the only way to infringe on publicity rights without fixing an aspect of a persona in a tangible medium of expression would be something like a professional impersonator performing in public pretending to be someone else. 14 The “Copyright Clause” in the Constitution is specifically directed at protecting of copyright ownership interests of authors. See U.S. Const. Art. I, §8, cl. 8 (giving Congress the power to legislate to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”). The Copyright Act of 1976, promulgated pursuant to the Copyright Clause, gives “authors” the ability to duplicate, sell, or license copyrighted works in order to monetize the works and financially incentivize creative expression. See 17 U.S.C. 106. The “tragedy of the anticommons” is a term coined by Professor Michael Heller to describe a situation where “multiple owners are each endowed with the right to exclude others from a scarce resource, and no one has an effective privilege of use.” See Michael Heller, The Tragedy of the Anticommons: Property in the Transition from Marx to Markets, 111 HARV. L. REV. 621, 624 (1998). In such a situation, the paralyzing web of different parties’ rights in property makes use of property inefficient and increases the likelihood of holdouts preventing any use at all.
publicity rights protection, this “no-publicity rights” extreme has not been accepted by the vast majority of American jurisdictions.\textsuperscript{15} One potential way to accommodate competing rights of copyright owners and publicity rights holders is through the application of preemption doctrine. Such doctrine resolves the competing rights dilemma by privileging federal law (here, the copyright law codified in Volume 17 of the United States Code) over state law, including publicity rights. However, preemption doctrine in general is hardly a model of simplicity or consistency, and preemption at the intersection of copyright and publicity rights law is no exception. Preemption language in the Copyright Act of 1976 is vague and was written in a time before the modern expansion of publicity rights. And, courts – even from the same jurisdiction – evaluating competing copyrights and publicity rights have been all over the map, or have conflated or ignored pertinent issues.\textsuperscript{16}

This paper will argue that under various preemption theories the Copyright Act of 1976 should preempt state publicity rights in more areas than have been commonly recognized by most jurisdictions. Notably, express preemption may justify the preemption of certain state statutes that give publicity rights protections to photographs, and could affect publicity rights infringement claims by musical performers. Additionally, there are some situations where conflict preemption should force publicity rights to subordinate to copyrights. This paper posits that conflict preemption should be analyzed using a new test. Termed the “predominant value” test, this new framework applies as follows: when a defendant uses a copyrighted work

\textsuperscript{15} Publicity rights exist either at common law or in statute in essentially every American jurisdiction. The possible exception is Puerto Rico. See Guedes v. Martinez, 131 F.Supp.2d 272, 278 (D.P.R. 2001).

\textsuperscript{16} See, e.g., Oliveira v. Frito-Lay, Inc., 251 F.3d 56, 63-64 (2d Cir. 2001) (not discussing preemption, yet finding copyrighted material as a whole is not an aspect of the plaintiff’s persona); Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n, 805 F.2d 663, 674 (7th Cir.1986) (preemption); Brown v. Ames, 201 F.3d 654 (5th Cir.2000) (no preemption); Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619 (6th Cir.2000) (no preemption); Downing v. Abercrombie & Fitch, 265 F.3d 994 (9th Cir.2001); Toney v. L’Oreal U.S.A., Inc., 400 F.3d 964 (7th Cir. 2005) (no preemption); Fleet v. CBS, Inc. 50 Cal.App.4th 1911 (1996) (preemption).
containing the plaintiff’s persona, if the predominant value in the defendant’s use is the copyrighted work, the publicity claim should be preempted; but if the predominant value is in the plaintiff’s persona, the claim should not be preempted. Such a conceptualization of the copyright/publicity interplay strikes a better balance between preventing unfair appropriation of the commercial value or good will associated with a persona and preventing the overprotection of the building blocks of copyrightable works and the chilling of creative expression.

Part I of this paper will provide a brief background on the genesis and evolution of publicity rights. Part II of the paper will introduce the essential building blocks of copyright law, including copyrightable subject matter, the fixation requirement, and concepts of copyright ownership. This section will also discuss the preemption provisions of the Copyright Act of 1976 and other applicable preemption theories. Part III applies preemption theories and discusses the predominant value test.

I. BACKGROUND PUBLICITY RIGHTS CONCEPTS

A. Privacy Gives Way to Property

Now generally considered a kind of personal property right, the right to prevent the unauthorized appropriation of a person’s name or likeness was, for much of its development, a confused mix of tort and property law concepts. This right was first judicially recognized as a stand-alone legal entitlement (and given a formal name – the “right of publicity”) in 1953 in the Second Circuit case *Haelan Laboratories, Inc. v. Topps Chewing Gum*.

However by that time, the closely analogous precursors to publicity rights had been encapsulated as one part of an

---

18 Jung, *supra* note 1, at 385-87.
emerging privacy rights scheme. In the late nineteenth century, Samuel D. Warren and future Supreme Court Justice Louis Brandeis argued in an influential law review article that individuals possessed a right “to be let alone”—primarily from an emerging gossip-mongering news media—that the authors called the “right to privacy.”

Other scholars did not immediately accept privacy rights, and courts were disinclined to recognizing invasion of privacy as a valid tort. For example, in 1902, the highest court in New York held in Roberson v. Rochester Folding Box Co. that an invasion of privacy tort did not exist under New York law, and therefore could not help the plaintiff prevent the defendant from using the plaintiff’s image in a flour advertisement. The New York legislature responded to public outcry over cases like Roberson and enacted a privacy cause of action for “[a]ny person whose name, portrait, picture or voice is used within [New York] for advertising purposes or for the purpose of trade without written consent . . .” But even after this statute was enacted and the right of privacy gained traction in the common law of a few states, the right of privacy doctrine was unrefined and inconsistent.

The eventual split between personality rights and the right of privacy that started in Haelan in the early 1950s was foreshadowed by some cases and commentators who justified personality rights with a natural property rights theory. In the 1907 case Edison v. Edison Polyform Manufacturing Company, Thomas Edison sued a manufacturer using both Edison’s

19. Id. at 76.
23. 64 N.E. at 447–48.
25. See Moore, supra note 22, at 4–7 (citing cases like Roberson and Henry v. Cherry, as well as cases that developed the common law right in various states, but also noting the disagreements between influential commentators like Warren and Brandeis, Hadley, Pound, Melville Nimmer, and William Prosser).
name and picture on the label for its product, a pain remedy called “polyform.” The court enjoined the defendant from using Edison’s name and likeness, reasoning that “the term ‘property right’ is not to be taken in any narrow sense” and that Edison’s right of privacy claim rested somewhat in the inherent property rights in his being. In 1915, Roscoe Pound explained that privacy was part of a broader concept of personality and analogized that the invasion of privacy was an infringement on one’s natural property rights in his personality.

But while cases like Edison had already established the right to use a likeness to make money and the right to exclude others from making such uses, it was not until after Haelan that personality rights truly began to take shape as a kind of property right. Haelan itself dealt with the right of publicity in a very functionalist manner—it created a new right under the common law of New York that was in large part a reflection of common practices in the entertainment industry. In Haelan, a professional baseball player signed an exclusive baseball card contract with the plaintiff company. But, the defendant company printed a competing baseball card with the same player’s image. The real issue in the case was not whether the baseball player could prevent the unauthorized publication of his name and image; existing New York privacy rights would have been sufficient for that purpose. Instead, the court addressed whether the player could properly assign the commercial rights in his likeness to Haelan, thus giving Haelan, rather than the player, the ability to sue for unauthorized commercial use of that likeness.

27. 67 A. 392, 392–93 (N.J. Ch. 1907).
28. Id. at 394–95.
31. Id. at 76–77. Around the time of Haelan, baseball players routinely signed exclusive contracts with baseball card companies, and had been doing so for some time. Id. at 77. Additionally, movie studios licensed the images of their actors to advertisers and merchandisers, despite the fact that courts, using a right of privacy conceptualization of the interests involved, declared such agreements unenforceable. See Michael Madow, Private Ownership of Public Image: Popular Culture and Publicity Rights, 81 CAL. L. REV. 127, 166 (1993); Westfall and Landau, supra note 16 at 78 & n.25.
33. Id.
34. Westfall and Landau, supra note 16, at 77.
found that the rights were assignable to Haelan, and thus made personality rights alienable just like property rights. Yet, in *Haelan*, the court specifically refused to call the right of publicity a “property right.”

Academic commentators in the 1950s and 1960s continued to develop publicity rights. William Prosser wrote that “[i]t seems quite pointless to dispute over whether such a right is to be classified as property,” yet he put publicity rights into his four-part grouping of privacy torts, calling it “appropriation.” In contrast, Nimmer noted that the right of publicity does not fit with the conception of privacy rights because those seeking to protect the commercial value in their persona are not simultaneously seeking to protect their privacy. He also distinguished publicity rights from unfair competition, trademark, contract, and defamation theories by finding that the typical celebrity plaintiff in a right of publicity case could not be afforded an adequate remedy under any of those doctrines. Further, Nimmer felt that there was often value created in the persona of a celebrity by the expenditure of effort, skill, and perhaps even money, and thus tied the right of publicity to a Lockean theory of property rights. Nimmer felt that the right of publicity had features of a property right, and thus should be afforded the same protections as any other commercial property right.

35. *Id.* at 76.
36. *See* Haelan, 202 F.2d at 868 (“Whether it be [labeled] a ‘property’ right is immaterial; for here, as often elsewhere, the tag ‘property’ simply symbolizes the fact that courts enforce a claim which has pecuniary worth”).
38. Prosser’s privacy rights included: 1) intrusion, i.e. the unreasonable and offensive interference with the solitude or seclusion of another; 2) public disclosure of private facts, i.e. the publication of private, truthful information about another that gives offensive publicity to this information; 3) false light, i.e. the presentation of information to the general public in such a manner as to convey a false and offensive impression of the individual; and 4) appropriation, i.e. the use of another person’s name or likeness for one’s own benefit. *See id.* at 389; Moore, *supra* note 22, at 6.
41. *See id.* at 210–15.
44. *Id.*
Similarly, Harold Gordon, another influential academic commentator, wrote in 1960 that the right of publicity involved concrete monetary damages, rather than injured feelings, and thus must be classified as property. But Gordon went further; he stated that since publicity rights must be thought of as property rights, they must also be inheritable. This “property syllogism”—essentially reasoning that because the right of publicity has characteristics as a property right, it must be property, and therefore it must have all sorts of other property characteristics—was used by academics and courts to further expand the right of publicity through the latter half of the 20th century.

**B. Modern Expansion of Publicity Rights Doctrine**

The most basic formulations of publicity rights, as expounded by courts through the middle of the twentieth century, protected against unauthorized appropriation of “names” and “likenesses.” For example, Prosser defined his cause of action as “the appropriation for the defendant’s advantage of the plaintiff’s name or likeness,” and the Restatement (Second) of Torts states that liability exists where a person “appropriates to his own use or benefit the name or likeness of another.” State courts often followed the same sort of conceptualization.

But as publicity rights began to take hold in jurisdictions across the country, courts and legislatures became comfortable expanding publicity rights from protecting merely a plaintiff’s most obvious and recognizable features, to protecting more attenuated aspects of a persona. The

---

47. See Westfall and Landau, supra note 16, at 81–86, 89.
49. Prosser, supra note 41, at 383, 389.
ability to prevent the unauthorized use of a plaintiff’s given name – for example, Thomas Edison\(^{52}\) – has been recognized since the infancy of publicity rights, but courts have been willing to expand publicity rights to cover mere nicknames\(^{53}\) and catchphrases that merely reference a generic first name.\(^{54}\) The latter category stems from a decision in the Sixth Circuit that allowed comedian and late night-television host Johnny Carson to prevent unauthorized use of the phrase “Here’s Johnny” in conjunction with, of all things, portable toilets.\(^{55}\) Similarly, appropriation of a person’s voice has been recognized in publicity rights statutes for decades.\(^{56}\) However, based on a pair of cases, \textit{Midler v. Ford Motor Company} and \textit{Waits v. Frito lay, Inc.}, California law also enables people with famous and distinctive voices to prevent imitators, also called “sound-alikes.”\(^{57}\) In such instances, the actual voice of a plaintiff is not used, yet liability is created because, in part, those employing sound-alikes wish to capitalize on the commercial value of the famous voices without having to secure consent from (and pay) the famous person.

Courts have also gone further, and have allowed the right of publicity to protect even oblique references to personal identities. In \textit{Motschenbacher v. R.J. Reynolds}, the Ninth Circuit held that a race car driver had a cause of action under California law for an unauthorized use of his “likeness” in an advertisement.\(^{58}\) But, the “likeness” at issue did not show any identifiable features of the plaintiff himself - the plaintiff’s face was obscured by a helmet and his body was

\(^{52}\) See \textit{supra} note 31.

\(^{53}\) See Hirsch \textit{v. S.C. Johnson & Son, Inc.}, 280 N.W.2d 129 (WI 1979) (use of plaintiff professional football player’s nickname “Crazylegs” in advertisement for women’s shaving gel).


\(^{55}\) See Carson, 698 F.2d at 836.

\(^{56}\) For example, New York Civil Rights Law § 51 provides a cause of action for appropriation of the “name, portrait, picture or voice” of any person, and California Civil Code § 3344 includes voice appropriation protection and was codified in 1971.

\(^{57}\) See \textit{Jung, supra} note 1 at 394.

\(^{58}\) 498 F.2d 821, 825–27 (9th Cir. 1974).
not visible. Instead, the advertisement featured an altered picture of the plaintiff’s car during a race. The court reasoned that the plaintiff’s own likeness could be identified simply by his automobile’s “several uniquely distinguishing features,” such as its red color, white pinstriping, and oval medallion, even after the defendant company changed the car’s number from “11” to “71” and added a “spoiler” emblazoned with the logo of one of the company’s cigarette brands.

Citing a Prosser treatise on torts that reasoned protection of a person’s name is justified because a name functions merely as a “symbol of [a plaintiff’s] identity,” the court analogized that the same type of protection could be afforded to the driver’s unique car that, in effect, functioned as a symbol of the driver’s identity.

Another polarizing example of the expansion of publicity rights also involved an advertisement where neither the eventual plaintiff’s name nor face was featured. The Ninth Circuit case White v. Samsung Electronics America Inc. involved a print advertisement campaign depicting Samsung’s humorous vision of life in the “futuristic” twenty-first century. The ad in question depicted a robotic game show hostess dressed in a wig, gown, and jewelry that Samsung’s ad agency consciously selected to resemble the hair and dress of popular “Wheel of Fortune” hostess Vanna White. The robot was positioned next to a game show set piece reminiscent of the “Wheel of Fortune” game board, in a stance for which White was famous. The court held White did not have a claim under California’s right of publicity statute because the statute required a use of a name or likeness, and the robot in the advertisement did not

59. Id. at 822, 827.
60. Id. at 822.
61. Id. at 822, 827.
62. Id. at 824 n.9–27.
64. Id.
65. Id. at 1396, 1399.
66. California is one of few states has a publicity rights statute and also recognizes a common-law right of publicity cause of action, largely distinct from the statutory form. See Jung, supra note 1, at 392-93.
actually constitute White’s “likeness” under the statute.\(^{67}\) But, the court explained that the features of the robot and the context of the ad, taken together, “leave little doubt about the celebrity the ad is meant to depict.”\(^{68}\) The court also held that under the common-law right of publicity, “likeness” was a broader concept and that the right was designed to protect the commercial value of a celebrity identity.\(^{69}\) Thus, since the ad was designed to evoke the identity of Vanna White, and Vanna White’s identity was shown to be a commercially valuable commodity, the court held that White’s right of publicity was violated.\(^{70}\) Thus, White not only emphasized the right of publicity’s modern focus on the commercial interest in one’s persona,\(^{71}\) it also conceptualized the right of publicity as including what dissenting Judge Kozinski characterized as the right to “evoke” the identity of a recognizable celebrity.\(^{72}\) Judge Kozinski saw the White case as a “classic case of overprotection” of intellectual property rights that “erects a property right of remarkable and dangerous breadth.”\(^{73}\)

C. Current Publicity Rights Cases

More recently, some high-profile cases have sustained the momentum gained by cases like White and Motsenbacher. In Moore v. The Weinstein Co., LLC, plaintiff Sam Moore of famous soul music duo “Sam and Dave” sued a movie studio over the movie “Soul Men,” starring Samuel L. Jackson and the late Bernie Mack as a soul-singing musical duo.\(^{74}\) A

\(^{67}\) 971 F.2d at 1397.
\(^{68}\) Id. at 1399.
\(^{69}\) Id. at 1397–99 (showing how a common law right of publicity claim is “not so confined” to a strict “name or likeness” appropriation).
\(^{70}\) Id. at 1399.
\(^{71}\) The emphasis on commercial interest in an identity was also echoed by the United States Supreme Court in its one and only decision dealing with the right of publicity. See Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 572-73 (1977). This case also stands as the only Supreme Court case dealing with a “human cannonball” circus act.
\(^{72}\) See White v. Samsung Elec. Am., Inc. 989 F.2d 1512, 1514–15 (9th Cir. 1993) (Kozinski, J., dissenting).
\(^{73}\) Id. at 1514.
\(^{74}\) See Moore v. The Weinstein Co., LLC, Case 3:09-cv-00166 (M.D. TN 2010)
Tennessee district court held that the plaintiff could state a claim for publicity rights infringement under Tennessee law by claiming the “fictional” main characters of the movie were based on the plaintiff’s musical group since the characters physically resemble the plaintiff and his singing partner and the characters sang the plaintiff’s songs in the movie. By recognizing a claim where no voices, names, or likenesses of the plaintiff were actually used, this case runs parallel to the “right to evoke” expounded in *White*. However, there is a new wrinkle added: *White* involved an advertisement, and *Moore* involved a creative, noncommercial work. Granted, motion pictures are money-making vehicles to some extent, but they still retain leeway for creators due to First Amendment implications.

Another round of cases deals with video games, a technology not-yet invented at the time of much of the development of publicity rights, and merely in its infancy when the Ninth Circuit decided *White v. Samsung*. In one group of cases, the defendant is the same: Electronic Arts, Inc., publisher of popular sports video games, among others. Plaintiffs are former football players, either professional or collegiate, and claim that the defendant infringed publicity rights by digitizing characteristics of the players in order to allow game-players the ability to simulate football games with historically accurate teams. In a New Jersey case, *Hart v. Electronic Arts, Inc.*, a former collegiate football player was able to survive a motion to dismiss by analogizing his case to *Motsenbacher*. Specifically, the plaintiff argued that his “persona” was appropriated when defendant used the plaintiff’s “physical characteristics, uniform, and game

---

75 See id.
76 See Cotter and Dmitrieva, supra note 2, at 189-90 (discussing how restrictions on noncommercial speech are subject to strict scrutiny, while restrictions on commercial speech are subject to a form of intermediate scrutiny). Additionally, publicity rights doctrine is imbued with First Amendment defenses for defendants who create expressive, creative works. See Jung, supra note 1, at 412-14 (discussing various First Amendment defenses allowed by courts).
79 Hart, 740 F.Supp.2d at 666.
statistics,” even though game characters did not feature the actual names of players or clearly show players faces underneath football helmets. A case brought by another former collegiate athlete, Keller v. Electronic Arts, Inc., raises essentially the same arguments and is currently working its way through the Ninth Circuit. And, former professional football player (and current football Hall-of-Famer) Jim Brown brought a similar case, but unlike the two mentioned previously, was met with resistance when the federal district court in which the case was brought dismissed non-publicity rights claims and refused supplemental jurisdiction over the remaining California publicity rights infringement claim.

In another group of cases, famous musicians have sued the creators of the music-performance video games for including digital likenesses of the musicians as playable characters in the game. In one case, the California Court of Appeals held that the members of the band “No Doubt” could state a claim against the creator of the game “Band Hero” for publicity rights infringement under California law for inclusions of digital versions of the band, called “avatars,” as characters in the game. Unlike in the football-related cases mentioned above, here the band did license their likenesses to be used in the game, but the game included a feature that would “permit players to use [the digital representations of No Doubt] to perform any of the songs included in the game, including songs that No Doubt maintains it never would have performed.” Specifically, the court highlighted the concerns that game-players could make

---

82 Brown, 2010 WL 2757774.
84 Id.
lead singer Gwen Stefani sing in a male voice, and make male members of the band sing in female voices.85

Like the motion picture at issue in Moore, these video game-related cases also involve an expressive work, entitled to “free speech”-based protections not afforded to, for example, purely commercial products.86 So, much of the debate centers around the limits the First Amendment imposes on publicity rights infringement claims,87 but these cases show how inexplicably intertwined publicity rights and creative, artistic (and almost always copyrightable to some degree) works have become. And, as discussed below, this confluence of copyrights and publicity rights is also hinted at in some state statutory publicity rights schemes.

D. Statutory Publicity Rights Protection

In addition to publicity rights developed through the common law, states have chosen to protect publicity rights through statute. Perhaps the most treaded path in litigation involves California law. California Civil Code Section 3344 provides that: “Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent,” shall be liable for

85 Id.
86 In many cases, including those involving the same video game series at issue in No Doubt, video games have been given First Amendment protection as expressive works more akin to artistic creations than commercial products. See id. at *4-5. See also, e.g., Kirby v. Sega of America, Inc. 144 Cal.App.4th 47, 58 (2006); Video Software Dealers Ass'n v. Schwarzenegger, 556 F.3d 950, 958(9th Cir.2009), cert. granted sub nom. April 26, 2010, Schwarzenegger v. Entertainment Merchants Ass'n, 130 S.Ct. 2398; Romantics v. Activision Pub., Inc. 574 F.Supp.2d 758, 765-766 (E.D.Mich.2008) (finding that Activision's Guitar Hero videogame is “an expressive artistic work that is entitled to First Amendment protection”). Ultimately, the interplay between the First Amendment and publicity rights is outside the scope of this article. For an explanation of those issues, see generally Cotter and Dmitrieva, supra note 2, at 189-207.
87 See Gardner, Appeals Court Showdown, supra note 85.
damages to the injured party. Notable in this conceptualization is that the statute lists protectable personal characteristics, and includes some specific fixations of characteristics including a “signature” (fixing a name) and a “photograph” (fixing a likeness).

Indiana statutory law presents another interesting case. Arguably one of the most generous statutes for plaintiffs, Indiana Code Section 32-36-1-1 et seq. provides protection for an exhaustive list of personal characteristics and derivatives thereof. The statute states that a person “may not use an aspect of a personality's right of publicity for a commercial purpose during the personality's lifetime or for one hundred (100) years after the date of the personality's death without having obtained previous written consent.” The statute then defines “right of publicity” as the “property interest” in a person’s “(1) name; (2) voice; (3) signature; (4) photograph; (5) image; (6) likeness; (7) distinctive appearance; (8) gestures; or (9) mannerisms.” As such, the Indiana statute also protects fixations like signatures and photographs, but includes nebulous concepts like “mannerisms” and “distinctive appearance.” But the danger between intertwining publicity rights and copyrights is more directly apparent: the statute explicitly protects the property interest in a photograph of a person. On its face, this seems duplicitous of copyrights, which are a form of property, and copyrightable subject matter

---

89 By using the word “fixing” here, I mean the act of taking something in the abstract and making it concrete. I use the language specifically to draw a parallel to the Copyright Act’s “fixation” requirement which is the engine that drives the concretion of non-copyrightable “ideas” into copyrightable “expression.”
90 Notable as well, although largely outside of the scope of this article, is the built-in First Amendment-based limitation on California statutory publicity rights. The statute exempts from liability any uses “in connection with any news, public affairs, or sports broadcast or account, or any political campaign.” Cal. Civ. Code at § 3344(d). These sorts of identified areas have been given wide latitude because of Free Speech concerns, especially with regards to news reporting. See Zacchini v. Scripps Howard Broad. Co., 433 U.S. 562 (1977). In a way, statutory provisions such as Section 3344(d) are redundant because of the various First Amendment defenses developed in a few jurisdictions would nevertheless shield the same uses. Courts have repeatedly held that the First Amendment limits publicity rights claims, but have not often agreed on the applicable test. See Jung, supra note 1, at 412-14 (discussing tests like the “transformativeness” test or the “predominant purpose” test).
92 Id. at § 32-36-1-7
includes photographic works. Yet, Indiana apparently recognizes the potential publicity/copyright conflict by exempting from liability some forms of copyrightable, expressive works. In Section 32-36-1-1(C), the statute acknowledge that it “does not apply to the following: (1) The use [protected attributes] . . . in . . . (A) Literary works, theatrical works, musical compositions, film, radio, or television programs[;] (B) Material that has political or newsworthy value[; and] (C) Original works of fine art. . . .” Before delving further into the specific intricacies of the copyright/publicity rights overlap, some basics about copyright law and federal preemption doctrine is necessary.

II. Preemption Doctrine: Section 301 of the Copyright Act of 1976, and Beyond

Copyright law sees its genesis in the Constitution; Article I, Section 8, Clause 8 gives Congress the power to legislate to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” Modern copyright law is codified in the Copyright Act of 1976 (“Copyright Act”), which comprises Volume 17 of the United States Code.

A. Copyright Principles: Subject Matter, Fixation, “Authors,” and Rights Protected

Section 102 of the Copyright Act extends copyright protection to “original works of authorship fixed in any tangible medium of expression….” Copyrightable subject matter therefore subsists of “works of authorship,” which include the following categories: “(1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including

---

93 See infra Part II.
94 Const. Art. I, §8, Cl. 8.
96 Id. at § 102.
any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works." It is worth noting at the outset that in the eight potential media for copyrightable works listed above, aside from category eight (and likely category four), all can, and often do, include personal characteristics protected by publicity rights.

An important limitation in copyrightable subject matter is contained in Section 102(b). In what has come to be termed the “fact/expression” dichotomy, copyright does not extend to “any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” Essentially, this provision means that underlying facts or ideas are not copyrightable – only the eventual fixation and expression of those ideas gains copyright protection, and the protection only extends to the expression itself.

Related to this concept is the “originality” requirement, which also stems from Section 102. Works of authorship must be “original,” which means, according to the Supreme Court, that the work must be independently created by the author, not merely copied from other preexisting works, and must “possesses at least some minimal degree of creativity.” The amount of creativity required, need not be very much. As the Court stated, “to be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, ‘no matter how crude, humble or obvious’ it might be.”

---

97 Id.
99 Id. at § 102(b).
100 See Feist, 499 U.S. at 349-51.
101 Id. at 345.
102 Id. (citing 1 M. Nimmer & D. Nimmer, Copyright § 108 (1990))
The final important requirement in Section 102 is the “fixation” requirement. Copyrightable creative expression must be “fixed” in a “tangible medium of expression.” Section 101 clarifies that a work is “fixed” in a tangible medium of expression when “its embodiment in a copy or phonorecord, … is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” And as the House Report for the Copyright Act states, the same protection subsists regardless the “form, manner, or medium of fixation.” Copyright protection attaches to expression, “whether it is in words, numbers, notes, sounds, pictures, or any other graphic or symbolic indicia, whether embodied in a physical object in written, printed, photographic, sculptural, punched, magnetic, or any other stable form, and whether it is capable of perception directly or by means of any machine or device.”

Copyright ownership is provided to “authors,” a term of art in the Copyright Act. Generally, the “author” is the “party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection.” But, Section 201 of the Copyright Act provides for a situation where the “author” isn’t the actual party creating the work – the “work made for hire.” The Section provides that “[i]n the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author … and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.” A “work made for hire” includes both (1) “a work prepared by an employee within the scope of his or her employment”; and (2) a work “specially ordered or commissioned” as a work in a few enumerated media,

104 Id. at § 101.
105 House Report No. 94-1476 (1976)
106 Id.
including, most applicable to this article, “as a part of a motion picture or other audiovisual work.”

Section 106 of the Copyright Act gives authors the exclusive right to any of the following:

1. to reproduce the copyrighted work in copies or phonorecords;
2. to prepare derivative works based upon the copyrighted work;
3. to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
4. in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
5. in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
6. in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

By granting exclusivity in these rights to the authors, it means that, for example, participants in a work made for hire cannot make or distribute copies of that work, or parts of the work. And for certain types of works in sub-sections 5 and 6, the authors have the exclusive right to control how a work is shown to the public.

B. Preemption Theories

Federal preemption is a byproduct of the Supremacy Clause of the Constitution, which states that “[t]his Constitution, and the Laws of the United States which shall be made in Pursuance thereof . . . shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby; any Thing in the Constitution or Laws of any State to the Contrary

---

108 See 17 U.S.C. § 101. The complete list of works eligible for “work for hire” status are: “a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.” Id. For a “specially ordered or commissioned” work, the parties involved must also agree in writing that the work will be a work made for hire. See id.

notwithstanding." Preemption can be broken down into two main categories: “express preemption,” where a federal statute specifically states that it preempts state laws; and “implied preemption,” which is where preemption is not specifically required by federal statute, but courts nonetheless infer preemption because either the federal law and the state law are in conflict (called “conflict preemption”) or federal law is so pervasive that it is said to “occupy the field” in that area of law (called “field preemption”). It is safe to say that field preemption is not applicable in this sphere because there is no federal regulatory scheme for either property-based publicity concepts, or privacy-based appropriation tort concepts. However, the idea of copyright laws preempts state common-law or statutory law is not new.

i. Express Preemption under § 301 of the Copyright Act

Section 301 of the Copyright Act provides an express preemption framework and states, in relevant part:

“On [the effective date of the Copyright Act], all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, . . . are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.”

This addition definitively resolved any questions of state law copyright protection. In the same section, the statute provides a qualifier, limiting – although not very precisely – the scope of the

---

110 U.S. Const. Art. VI.  
111 For an example of express preemption, see, e.g., 17 U.S.C. § 301 (preemption in the Copyright Act); Altria Group v. Good, 555 U.S. 70 (2008) (discussing preemption under cigarette labeling laws).  
113 17 U.S.C. § 301(a).  
114 Prior to the passage of the Copyright Act of 1976, the Supreme Court had to decide the interplay between the existing copyright scheme (dating from 1909), and California law criminalizing certain reproductions of sound recordings, and ultimately upheld the state law by reasoning that Congress left open certain areas dealing with copyrights that could be filled in by states. See Goldstein v. CA, 412 U.S. 546, 552-58, 560 (1973). But, in passing
express preemption provision. Section 301(b) states: “Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to— (1) subject matter that does not come within the subject matter of copyright … including works of authorship not fixed in any tangible medium of expression . . . .”

Thus the text of Section 301 provides two main requirements for preemption: first, the “equivalency” provision, which requires that the state law creates rights that are “equivalent” to the Section 106 rights (which include rights for copying, distribution, transmission, and public performance of copyrighted works); and second, the “subject matter” provision, which requires that the state laws regulate copyrightable subject matter (like musical works or pictorial, graphical, or sculptural works).

The legislative history behind Section 301 seems to suggest that Congress generally intended to leave state privacy and publicity rights alone. Congressional reports stated that “[t]he evolving common law rights of ‘privacy,’ ‘publicity,’ and trade secrets, and the general law of defamation and fraud, would remain unaffected as long as the causes of action contain elements, such as an invasion of personal rights or a breach of trust or confidentiality, that are different in kind from copyright infringement.”

However, as these reports were created pre-1976, and thus before the drastic expansion of publicity rights seen in cases like Carson v. Here’s Johnny Portable Toilets, Midler v. Ford, White v. Samsung, and before modern statutory

---

115 Id. at § 301(b).
116 See Cotter and Dmitrieva, supra note 2, at 182-83.
117 See id. at 187-88.
publicity rights in states like California and Indiana were established, the applicability of this language in the Congressional reports is likely fairly limited.\textsuperscript{119} It would be a stretch to assume that even though Congress arguably accounted for the “evolving” nature of publicity rights, it certainly could not have foreseen the far-reaching additions to the doctrine throughout the couple decades following the passage of the Copyright Act.

Application of this section has – perhaps understandably – not been very consistent.\textsuperscript{120} Some courts, like the Ninth Circuit in \textit{Laws v. Sony Music}, have latched on to the “subject matter” provision and held that when publicity rights become intertwined with copyrighted works, preemption can ensue.\textsuperscript{121} Others have noted that preemption generally does not occur with regard to publicity rights because things like “names” or “likenesses” in the abstract are not part of the “subject matter” of copyright listed in Sections 102 and 103 of the Copyright Act – even if the likenesses at issue are contained in copyrighted works like photographs or motion pictures.\textsuperscript{122} For example, the Seventh Circuit stated in \textit{Toney v. L’oreal USA, Inc.} that the Illinois right of publicity statute protects “identity,” which the court described as “an amorphous concept that is not protected by copyright law,” and found that a person’s “identity” or “persona” are neither “fixed in a tangible medium of expression” nor a “work of authorship” – two prerequisites for copyright protection.\textsuperscript{123}

\textsuperscript{119} For example, New York Civil Rights Law §§ 50-51 were passed initially in the first decade of the 20th century, but as part of an invasion of privacy statute. California, arguable the most influential publicity rights statute wasn’t passed until 1971, only a couple of years before the overhaul of the Copyright Act, but \textit{after} some of the legislative history discussed \textit{supra} note 125, which importantly shares much of the same language (and likely was merely copied from an initial draft in the mid-1960s).

\textsuperscript{120} See Cotter and Dmitrieva, \textit{supra} note 2 at 183-86.


\textsuperscript{122} See \textit{e.g.}, \textit{Perfect 10, Inc. v. Google, Inc.}, 2008 WL 4217837, *9 (C.D. CA 2008); \textit{Facenda v. NFL Films, Inc.}, 542 F.3d 1007, 1027-28 (3d. Cir. 2008); \textit{Toney v. L’oreal USA, Inc.}, 406 F.3d 905, 910 (7th Cir. 2005); \textit{Downing v. Abercrombie & Fitch}, 265 F.2d 994, 1003-04 (9th Cir. 2001); \textit{Landham v. Lewis Galoob Toys, Inc.}, 227 F.3d 619, 623 (6th Cir. 2000); \textit{Brown v. Ames}, 201 F.3d 654, 661 (5th Cir.2000).

\textsuperscript{123} \textit{Toney v. L’oreal USA, Inc.}, 406 F.3d 905, 910 (7th Cir. 2005).
The California Court of Appeals has held that preemption under Section 301 also depends on whether a defendant has “no legal right to publish the copyrighted work” at issue,\(^{124}\) essentially reasoning that if a defendant reproduced a copyrighted work that featured a plaintiff’s likeness, a plaintiff’s right of publicity claim would be different from—and thus not preempted by—a 3rd party’s copyright infringement claim because the plaintiff, who is not the copyright owner, could not bring a copyright infringement claim. The Ninth Circuit Court of Appeals, on the other hand, has refused to read Section 301 so narrowly and has held that whether a claim is preempted under Section 301 “does not turn on what rights the alleged infringer possesses, but on whether the rights asserted by the plaintiff whether the rights asserted by the plaintiff are equivalent to any of the exclusive rights within the general scope of the copyright.”\(^{125}\)

Some courts narrow discussion based on the type of copyrightable medium at issue. Of those cases, cases involving sound recordings present an interesting study of the conflict between these two major views. For example, the 9th Circuit held in Laws that claims were preempted when they deal with voices as part of musical sound recordings.\(^{126}\) In contrast, and in somewhat of a circuit split, the Third Circuit held in Facenda v. NFL Films, Inc. that claims are not preempted when they deal with voices as part of narration because “voices” do not come within the subject matter of copyright.\(^{127}\) In the case of “sound-alike” recordings, which merely fix vocal imitations of famous voices, preemption would not ensue because no recording of the famous-voiced plaintiff is actually used by the defendant.\(^{128}\)

\(^{ii.}\) \textbf{Implied Conflict Preemption}


\(^{125}\) \textit{See} Jules Jordan Video, Inc. v. 144942 Canada Inc., 617 F.3d 1146, 1154-55 (9th Cir. 2010).

\(^{126}\) \textit{See} Laws, 448 F.3d at 1139-43.


\(^{128}\) \textit{See, e.g.} Waits, 978 F.2d at 1100; Midler, 849 F.2d at 462.
Courts perhaps even less frequently address conflict preemption by the Copyright Act. Conflict preemption is a “particular species of implied preemption that ‘renders state law without effect when without express congressional command, state law conflicts with federal law.’”\footnote{Facenda, 542 F.3d at 1028.} As one copyright treatise states, “the general proposition [of conflict preemption] pertains in copyright law, as elsewhere, that a state law is invalid that ‘stands as an obstacle to the accomplishment of the full purposes and objectives of Congress’ … [or] when compliance with both federal and state mandates is a physical impossibility.”\footnote{1 Nimmer on Copyright § 1.01[B][3][a], at 1-77.}

Ultimately, courts have applied conflict preemption by the Copyright Act in ways that create little in the way of cognizable, useful rules. The Supreme Court has only addressed conflict preemption by the Copyright Act in a single case,\footnote{Cotter and Dmitrieva, supra note 2 at 179-81 (discussing Goldsten v. CA, 412 U.S. 546 (1973)).} which predates the Copyright Act of 1976, and whose holding was largely mooted by the addition of Section 301. In \textit{Goldstein v. California}, the court reasoned that states did not relinquish power to Congress to enact their own copyright laws and that since Congress had not spoken to the precise question at issue (in this case, certain commercial reproduction of sound recordings), states could fill in gaps.\footnote{Id.}

Lower courts have occasionally addressed conflict preemption of publicity rights infringement claims. The Fifth Circuit provides an interesting, albeit perhaps misleading, discussion in \textit{Brown v. Ames}, a case involving a claim for “unauthorized use of [plaintiffs’] names and likenesses to market [plaintiffs’] musical performances on CD's and audio cassettes for which [defendants] also lacked copyrights.”\footnote{201 F.2d 654, 656 (5th Cir. 2000).} The court initially found that express preemption was not applicable to the claims, and then found that implied conflict preemption as
would not apply.\textsuperscript{134} The court framed the applicable conflict preemption rule as follows: “The Supremacy Clause dictates that a state law that obstructs the accomplishment of the full purposes and objectives of Congress is preempted.”\textsuperscript{135} The court then reasoned that the Copyright Act has several purposes: 1) “to promote the progress of Science and useful arts”\textsuperscript{136} “The legislative history of the Copyright Act describes several other objectives: 2) “to promote national uniformity and avoid the difficulties of determining and enforcing rights under different state laws;” 3) “to have copyright protection last for a limited time period, so that scholars and the public can benefit from the dissemination of copyrighted materials;” and 4) “to improve our international dealings in copyrighted materials.”\textsuperscript{137} The court then reasoned that publicity rights infringement claims should not be preempted because “first, the right of publicity that the misappropriation tort protects promotes the major objective of the Copyright Act-to support and encourage artistic and scientific endeavors.”\textsuperscript{138} However, this justification, aside from being essentially devoid of support in the opinion, assumes that celebrity is a money-making endeavor or that celebrities themselves are the ones that cultivate their own fame. Next the court reasons that “industry practice may be to transfer rights in a performer's name or likeness when the copyright is transferred,” so preemption would not ordinarily be an issue.\textsuperscript{139} However, this point is of no use when the “industry practice” is not followed. It also is logically flawed – the court essentially reasons that “preemption issues would be rare, \textit{ergo} no preemption,” and that simply doesn’t make sense.

\textsuperscript{134} Id. at 657-661.
\textsuperscript{135} Id. at 659-60.
\textsuperscript{136} In fact, this purpose comes from the Copyright and Patent Clause of the Constitution. \textit{See} U.S. Const., Art. 1, § 8, cl. 8.
\textsuperscript{137} \textit{See} 201 F.2d at 660 (citing the legislative history of the Copyright Act).
\textsuperscript{138} Id.
\textsuperscript{139} Id.
Scholar David Nimmer has also proposed a slightly different framework for addressing conflict preemption of publicity claims.\textsuperscript{140} Surveying applicable cases, Nimmer observed that when defendants use a copyrighted work “for the purposes of trade,” such as in an advertisement for a product, a plaintiff’s publicity rights infringement claims are not preempted.\textsuperscript{141} But when the defendant’s use constitutes “expressive works,” a plaintiff’s claim is preempted.\textsuperscript{142} The underlying reasoning for such a distinction is that “state law has a role in regulating practices of trade, including advertising[, ] but limiting the way that material can be used in expressive works extends beyond the purview of state law and into the domain of copyright law.”\textsuperscript{143} This framework seems more logically sound and may be of some utility in the conflict preemption analysis, but it feels more like a rubric for application of First Amendment defenses than preemption doctrine, and thus is ultimately unsatisfying.

III. Copyright/Publicity Rights Preemption Framework and the “Predominant Value” Test

To date, judicial application of preemption analysis has created a morass of conflicting and confusing decisions. Courts sometimes fail to separate conflict preemption from express preemption.\textsuperscript{144} This section will first address express preemption under Section 301 of the Copyright Act, and then introduce a new scheme for analyzing conflict preemption cases.

A. Express Preemption Application

\textsuperscript{140} Facenda v. N.F.L. Films, Inc., 542 F.3d 1007, 1029-30 (3d Cir. 2008).
\textsuperscript{141} See 1 Nimmer on Copyright § 1.01[B][3][b][iv][I], at 1-88.2(9)-(11).
\textsuperscript{142} See id. § 1.01[B][3][b][iv][I], at 1-88.2(11).
\textsuperscript{143} Facenda, 54 F.3d at 1030.
\textsuperscript{144} See, e.g., Toney v. L’Oreal USA, Inc., 406 F.3d 905, 910 (7th Cir. 2005).
As detailed above, Section 301 of the Copyright Act provides a built-in framework for determining when preemption occurs. The framework has two prongs that will be addressed separately.

I. The Equivalency Provision

In order for the Copyright Act to preempt state laws, the state laws must satisfy the “equivalency provision” by creating rights that are “equivalent” to the rights specified in Section 106, which includes the exclusive rights of reproduction, preparation of derivative works, distribution, and display. This prong does not require that the state right create the same rights as those in the Copyright Act; merely, the rights must be qualitatively the same as those provided in the Copyright Act.\(^{146}\)

State publicity rights should satisfy this requirement as both publicity rights and copyrights are based fundamentally on the classic “bundle of sticks” right to exclude others from using some form of property, whether it be a copyrighted work on the one hand, or a name, likeness, or voice on the other.\(^{147}\) State publicity rights may not normally state, for example, that

\(^{145}\) See Laws v. Sony Music Ent. Inc., 448 F.3d 1134, 1143 (9th Cir. 2006)

\(^{146}\) See id. (noting that to survive preemption, state rights must be “qualitatively different” from copyright rights).

\(^{147}\) As a bit of an aside, one other latent issue has to do with the “work-for-hire” doctrine. The doctrine itself is not mentioned in any areas covered by the Section 301 express preemption provision, although as noted in Section II.A above, it is a mechanism that affects Section 106 ownership rights by transferring copyright ownership and the associated Section 106 rights to the hiring party. There does seem to be a strong argument that the Copyright Act should preempt some publicity rights infringement claims by a participant in a work made for hire when a publicity rights infringement claim sufficiently conflicts with the ownership-shifting purpose of the work-for-hire doctrine. For example, assume that an actor in a motion picture brings a publicity rights infringement claim against the author of the motion picture (say, the movie’s producer), and is ultimately successful. If the plaintiff could secure an injunction, he could, for example, prevent the author from copying, distributing, or displaying the work – all of which are exclusive rights of the author. Alternatively, if a court limits the plaintiff’s remedy to damages, the court would essentially be giving the plaintiff a financial stake in the work. Normatively, this doesn’t seem particularly fair, especially considering that in hiring the plaintiff to perform in the work, the defendant likely already paid for the plaintiff’s performance. However, it is hard to fit this scenario in the Section 301 scheme as the test doesn’t seem to be formulated to apply, as it focuses primarily on the different subject matters at issue. Conflict preemption may be a possibility as the hypothetical mentioned seems to provide a situation where the state right interferes with one of the main aims or purposes of the Copyright Act – that of assigning copyright ownership. Further conflict is apparent when considering that personality rights may have longer durations than copyrights, which raises the possibility that some form of “ownership” subsists in the participant in the work-for-hire due to the publicity rights at stake, even though the work, according to the Copyright Act, should be in the public domain. The predominant
a putative defendant cannot “distribute copies” of a likeness, but the practical effect is the same: publicity rights prevent putative defendants from “using” a likeness, and the only way for such a party can do so is to cast the likeness in some sort of “copy” like a photograph.

Some courts have found publicity rights “qualitatively different” from copyrights by looking at a state’s “commercial purpose” requirement, which requires a putative defendant’s use of a persona to have a “commercial purpose” before liability may attach. However, this approach is a bit unsatisfactory. For one, “commercial purpose” requirements are not present in every state’s publicity rights scheme. Also, the requirement is more likely included either to save the law from First Amendment issues, as state laws get more leeway when they regulate commercial speech, rather than expressive speech, or is used as a way to increase the certainty of a defendant’s recovery, as it is more probable that damages due to a non-commercial use are speculative, or at the very least, extremely hard to quantify. Thus, the commercial use requirement is not really different from the principles in play in copyright law – putative plaintiffs still have to be able to quantify damages, and putative defendants are more likely to be liable if uses are commercial, rather than expressive or creative.

value test discussed below doesn’t seem to be as applicable if the issue is framed as one of “work-for-hire” rights, but it could still come into play if the issue is re-framed depending on the aspect of the persona at issue and the medium in which it is capture. For example, when a musical sound recording is at issue, the work could also be a work-for-hire, but is analyzed independently of that fact as a voice fixed in a copyrightable sound recording.


149 See Jung, supra note 1, at 392 (observing that some states, especially those relying on the traditionally privacy-tort based formulation, merely require that a use be “to the defendant’s advantage”).

150 The same principles underlie judicial analysis concerning First Amendment defenses to publicity rights infringement. For example, the “predominant purpose” test adopted in Missouri looks to whether the claimed infringement has a predominantly commercial purpose (in which case, no First Amendment defense can be raised) or if the purpose is predominantly expressive (in which case a First Amendment defense can be raised). See Doe v. TCI Cablevision, 110 S.W.3d 363, 374 (Mo. 2003).

151 17 U.S.C. § 107 provides a “fair use” defense to copyright infringement. As the Supreme Court has noted, one of the main factors in the analysis can depend on commercial uses, rather than expressive uses, where commercial uses are more likely to lead to liability. See Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 578-86 (1994).
II. The Subject-Matter Provision

The express preemption analysis does not end with the equivalency provision, however. Section 301 also requires that the state laws must apply to the “subject matter of copyright” as specified in sections 102 and 103 of the Copyright Act, which include such categories as literary works, musical works, pictorial, graphic and sculptural works, audiovisual works, and sound recordings, as well as derivative works, but does not include ideas, facts or “works” not fixed in a tangible medium of expression. Most state publicity rights should fail this prong of the test because, as courts in the Seventh, Fifth, and Third Circuits have noted, aspects of a persona are not “fixed in a tangible medium of expression” and are not listed in sections 102 and 103 of the copyright act. This result is also more appropriate considering the privacy-based history and undertones in the right of publicity. However, certain aspects of state publicity rights can be preempted if they provide protection for fixations of aspects of a persona. For example, as mentioned above, Indiana provides protection for “photographs,” which are “pictorial works” mentioned in section 102 of the Copyright Act. Similarly, New York’s right of publicity statute applies to “portraits” and “pictures,” which would also fall under the “pictorial works” category. Thus, those parts of the New York law should be preempted, even if a putative plaintiff could still bring a claim for unauthorized use of a “likeness.” Additionally, “signatures” are arguable fixations of names, so statutory protection applying to them should also be preempted if the signature includes enough originality and creativity to be copyrightable. If a state law protects “recordings” of voices, rather than or in addition to merely voices, that aspect

---

152 See Laws v. Sony Music Ent. Inc., 448 F.3d 1134, 1143 (9th Cir. 2006); Toney v. L’Oreal USA, Inc., 406 F.3d 905, 910.

153 See Toney, 406 F.3d at 910; Brown v. Ames, 201 F.3d 654, 658-59 (5th Cir. 2000); Facenda v. NFL Films, Inc., 542 F.3d 1007, 1027 (3d Cir. 2008); accord 1 Nimmer on Copyright § 1.01[B][1][c], at 1-30; 2 McCarthy, Rights of Publicity and Privacy § 11:53, at 802.

154 See N.Y CIV. RIGHTS LAW § 51 (McKinney 2010).
of the law would also be preempted as the Copyright Act does directly apply to “sound recordings.”\textsuperscript{155}

A closer call is a relatively recent addition to the Copyright Act called the “performer’s right of fixation.” This right was added to the Copyright Act as part of Congress’s effort to implement the Agreement on trade Related Aspects of Intellectual Property (TRIPs).\textsuperscript{156} It was part of the 1994 Anti-Bootlegging Act and is currently embodied in the Copyright Act at Section 1101. This section grants to performers of live musical performances rights to prevent “the unauthorized fixation of their performances,” and to prevent the copying, distribution, or transmission of that fixation or copies thereof\textsuperscript{157} – i.e. what is typically called “bootlegging” a live performance. The same section also gives rights to prevent the “transmission or other communication to the public” of the “sounds or sounds and images of a live musical performance.”\textsuperscript{158} Notably, these rights are at odds with the rest of the Copyright Act – they apply to works not fixed in a tangible medium of expression and essentially give rights to create a copyrighted work in the future, rather than apply protection as works are created.\textsuperscript{159}

Express preemption would seem to apply to claims involving this right because a publicity rights infringement claim involving some aspect of a musical performance would be essentially the same as a claim based on the performer’s right of fixation – both would involve the unauthorized capturing of a performance, and thus some protectable aspect of a persona like a likeness, image, or voice, in some sort of medium like a sound recording, a motion picture, or a photograph.\textsuperscript{160} And, this section of the Copyright Act is the only one that provides any

\textsuperscript{156} ROBERT A. GORMAN AND JANE C. GINSBURG, COPYRIGHT CASES AND MATERIALS 1 (7th ed. Supp. 2009).
\textsuperscript{157} 17 U.S.C. § 1101.
\textsuperscript{158} Id.
\textsuperscript{159} See J. THOMAS McCARTHY, 2 RIGHTS OF PUBLICITY AND PRIVACY § 11:54 (2d ed. 2011).
\textsuperscript{160} In fact, the Michigan federal district court deciding Armstrong v. Eagle Rock Entertainment Inc. seems to hint as much. The court ultimately found a publicity rights infringement claim preempted by the Copyright Act, primarily
protection for “unfixed” works; the performer’s right of fixation grants rights for future fixation and could be said to apply to aspects of a persona – voices and likenesses in particular – in their latent form. However, the performer’s right of fixation appears to not fit in the Section 301 scheme at all: musical performances themselves are not “fixed in a tangible medium of expression” and the right appears outside of the enumerated media suitable for copyright protection listed in Section 102. Conflict preemption, discussed below, could be an issue in a very small number of cases. However, most of the time, the person claiming a publicity rights violation under state law would be the same as the holder of the performer’s right of fixation under the Copyright Act – i.e. the performer – so the claim could be duplicitous of, but wouldn’t be in conflict with, a publicity rights infringement claim. To have such a conflict, a performer would have to have assigned all rights under the Copyright Act in his performance to another party, who would then acquire the performer’s Section 1101 rights, yet at the same time retain all state publicity rights. This situation doesn’t seem very likely, unless there was an oversight in the assignment agreement.

B. Conflict Preemption application and the Predominant Value Test

Even though many court cases have identified the touchstone of conflict preemption, application of the doctrine has not been very clear or consistent. As such, this paper proposes a new test called the “predominant value” test. This test is based somewhat on a test, called the “predominant purpose” test, used to determine whether First Amendment defenses apply to a

---

because of Section 301 express preemption, see 665 F.Supp.2d 779, 788-89 (E.D. MI 2009), although it also discussed, without much elaboration, that the substantive law of Section 1101 would still preempt state publicity rights laws. See id. at 793-94. The court thus appears to be conflating a claim based on the performer’s right of fixation with a copyright infringement claim based on an already fixed work.

161 See J. THOMAS MCCARTHY, 2 RIGHTS OF PUBLICITY AND PRIVACY § 11:54 (2d ed. 2011).
given instance of publicity rights infringement. Under the predominant value test, whether a claim should be preempted should depend on the “predominant value” of what is being licensed or used by a putative defendant. If the predominant value is in the copyrighted music or motion picture, the appropriate claim would be one of copyright infringement, and thus a publicity rights infringement claim should be preempted. If the predominant value is in an aspect of a persona fixed in the copyrighted work, the publicity rights infringement claim should not be preempted. The determinations about what would be the “predominant value” would likely best be decided as a jury question after each side is able to present evidence or expert testimony, as appropriate.

As an example of how this test would apply, consider the facts of Michigan case Armstrong v. Eagle Rock Entertainment, Inc. In that case, the owner of a copyright in a video recording that captured the plaintiff bass guitar player’s musical performance at a jazz festival licensed that recording to the defendant so that the defendant could make and sell DVD copies of the festival’s performances. The court found that the Plaintiff’s claim was preempted because it could be reduced essentially to an infringement claim of a “recording that happens to include [the plaintiff].” While couching its decision under the Section 301 express preemption framework, the court used more of a conflict-preemption rationale by finding that the plaintiff’s

---

162 The “predominant purpose” test was adopted by a court in Missouri and has been used in publicity rights jurisprudence to determine when a defendant can assert a successful First Amendment defense to infringement. See Doe v. TCI Cablevision, 110 S.W.3d 363, 374 (Mo. 2003) (adopting test from Mark S. Lee, Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface, 23 LOY. L.A. ENT. L. REV. 471, 488–98 (2003)). The test “allowed First Amendment protection when the predominant purpose of a product or work is not to exploit the commercial value of a persona, but is to make an expressive comment on or about a celebrity.” See Jung, supra note 1, at 413-14.


164 See id. at 782-83.

165 Id. at 789. For another court reaching the same result with very similar facts, see also Stanford v. Caesars Entertainment, Inc., 430 F.Supp.2d 749 (W.D. TN 2006).
claim tries to prevent the copyright owner from exercising its exclusive right under Section 106 of the Copyright Act to “reproduce the copyrighted work.” \(^{166}\)

The court didn’t elaborate much how it arrived at its conclusion, but the predominant value test can explain the result. The *Armstrong* court essentially found that the predominant value of the bundle of rights being licensed to Eagle Rock was in the copyrighted expressive work, namely the music and the concert performances – the personae of the performers captured therein are of secondary importance. However, to take the facts of the case and consider a slightly different hypothetical situation, if the licensing of Mr. Armstrong’s performance was to Gibson Guitar Corp. for use in an advertisement about Gibson bass guitars, the value of the thing being licensed is in the fact that Mr. Armstrong plays bass guitars made by Gibson; what music Mr. Armstrong plays in that clip is of secondary importance. \(^{167}\) But, if the same performance was licensed to Gibson for an advertisement regarding all of the famous music made with Gibson-made instruments, the value of the thing being licensed is the music made and the recordings of that music; the personae of the performers is of secondary importance.

As another example, using the facts from the oft-cited case *Landham v. Lewis Galoob Toys Inc.*, \(^{168}\) the predominant value test would actually reach the opposite result of the court ultimately deciding the case. In *Landham*, the defendant company was licensed to create action-figure toys of the characters in the movie *Predator*. \(^{169}\) The plaintiff, and actor in the movie whose character was made into one of the action figures, brought a publicity rights infringement

---

\(^{166}\) *Armstrong*, 655 F.Supp.2d at 789-90.

\(^{167}\) Although, that is not to say that Gibson wouldn’t have to get copyright-based licenses – it certainly would have to do so. Gibson would need a license to use the copyrighted audiovisual work, but also would likely have to secure a “synch” license from the writer of the song being performed (as there is a separate copyright for the musical work) to synch the song being performed with visuals.

\(^{168}\) 227 F.3d 619 (6th Cir. 2000).

\(^{169}\) *Id.* at 621-22.
claim that the Sixth Circuit held was not preempted by the Copyright Act.\textsuperscript{170} However, applying the predominant value test, it would be fairly clear that the plaintiff’s claim would be preempted because the predominant value at issue would be the copyrighted movie and the story and characters therein. As the Landham court notes, “because the [defendant’s] toy is only 1.5 inches tall and has no eyes or mouth, it bears no personal resemblance to [the plaintiff]. Moreover . . . the [defendant’s] employee who designed the toy, purposefully avoided any such resemblance.”\textsuperscript{171} The action figures were meant to capitalize on the copyrighted work that happens to include the plaintiff’s performance, rather than the plaintiff’s persona.

I. Preemption May Depend on the Copyright Principle at Issue

While the predominant value test itself would generally be the same when applied to different subject matter receiving copyright protection, the results of the test may be skewed in one way or the other depending on which of the copyrightable subject matter is at issue. Therefore, to illustrate those differing results, and to give another level of organization to the framework, the following section organizes the application of the predominant value test based on the aspect of a persona at issue and the copyright medium in which it is “fixed.”

a. Voices Fixed in Sound Recordings

The first subset of claims are claims for voice appropriation due to use of a musical sound recording that features a fixation of a plaintiff’s voice, either singing or narrating. The Laws court has, using express preemption framework, held that these sorts of claims are always preempted.\textsuperscript{172} In fact, considering the nature of voice appropriation claims, it would hard to

\textsuperscript{170} Id. at 623-24.
\textsuperscript{171} Id. at 622.
\textsuperscript{172} See Laws v. Sony Music Ent. Inc., 448 F.3d 1134, 1137-45 (9th Cir. 2006); accord Romantics v. Activision Publ’g, 547 F.Supp.2d 758, 767 (E.D. Mich. 2008) (noting that the crux of these cases is that the plaintiff’s publicity
Imagine a scenario where preemption wouldn’t occur. A voice appropriation claim would require that a defendant used a plaintiff’s voice, without consent, and for commercial purposes. A plaintiff’s voice could only be “used” if a defendant has the plaintiff speak or sing in-person (which would almost always presume some sort of consent was in place, making a claim fail) or has some way of capturing the plaintiff’s voice so that it can be re-played. Sound recordings, in copyright terms, are “fixations” of sounds, and can involve music, narration, or even sound effects, and are explicitly mentioned in the Copyright Act as a “work of authorship” subject to copyright protection. The Supreme Court has already noted how the requisite amount of creative expression for a copyrighted work is very low, and, in the context of a musical sound recording, non-copyrightability would be essentially impossible, or at least extremely difficult. Thus, a musical sound recording of a human voice is merely a fixation of a certain publicity right that garners copyright protection. For non-musical sound recordings, copyrightability would still not likely be an issue, especially if the work as a whole was copyrighted and the words narrated were, for example, from a copyrighted script. And thus, it

---

173 Although depending on the jurisdiction, a plaintiff may only need to show that it was to the defendant’s “advantage.” See Jung, supra note 1, at 392.
174 For an example of a claimed copyright in a sound recording of narration, see Facenda v. N.F.L. Films, Inc., 542 F.3d 1007, 1026-27 (3d. Cir. 2008).
175 See 17 U.S.C. § 102(a)(7). Obviously, protection would depend on whether the requisite degree of creativity is met, as well – simply being a “sound recording” doesn’t necessarily equate to copyright protection, although as discussed infra it would be practically impossible for a musical sound recording to not be copyrightable.
177 Non-copyrightability of a sound recording would require an absence of creative expression. If such a sound recording contained a human voice that was identifiable, it would likely be creative enough unless it was, for example, very short in duration (like a short snippet of sound), or not involve really what would be considered “music” – perhaps a single tone is sung, rather than a song performed.
178 In fact, this is the sort of fact scenario present in Facenda v. NFL Films, Inc. See 542 F.3d 1007, 1026 (3d. Cir. 2008). The Third Circuit stated: The NFL notes that it excerpted the sound clips at issue from copyrighted productions of NFL Films. Moreover, the sound clips represent Facenda’s readings of copyrighted NFL scripts, making the clips “derivative works” (of the scripts) in which a distinct copyright exists. See 17 U.S.C. § 106(2) (granting copyright holders the exclusive right to prepare derivative works); id. § 102(a)(7) (allowing copyrights in sound recordings, which are
would follow that a claim for voice appropriation is essentially the same as, and inseparable from, as a copyright infringement claim of a sound recording – the claim would be reduced to one of unauthorized use of a sound recording.

Regardless, it is hard to overcome the argument that “voices” are not themselves copyrightable and thus that express preemption should not apply. While this reasoning conflicts with the Laws decision, the ultimate result should not differ much. Applying the predominant value test, conflict preemption would still apply in virtually every instance. For one, a sound recording – especially involving a musical work – captures a very limited snapshot of a persona, which already stacks the deck against finding the predominant value in a defendant’s use of a sound recording was the persona captured on the recording. Singers are often harder to identify for most people at first listen as opposed to, say, a first glance at a photo. More identifying information about a person can be conveyed, and be conveyed quicker and with more specific detail, in a picture. Thus, most of the time a person would be giving up less of his or her identity when it is fixed in a sound recording than when it is fixed in a photograph, and perhaps normatively that seems like a better result.

Secondly, sound recordings are harder to manipulate and use in different contexts. For example, a company could license the rights to a recording of Janis Joplin singing about her desire for a Mercedes-Benz for use in an advertisement about cars, but the same sound-byte wouldn’t really be useful in an advertisement for Coca-Cola. Yet, if you had a picture of Janis

---

179 JANIS JOPLIN, Mercedes Benz, on PEARL (Columbia Records 1971).
180 The beverage company could license the song and create a sound-alike recording with altered lyrics (for example: “Lord, won’t you buy me a bottle of Coke Zero”), but such an act may not trigger copyright preemption and would subject the company to a publicity rights infringement suit in the vain of Midler and Waits, unless a court analyzed it as a derivative work (which it would be since the lyrics were altered), and as discussed infra in Part III.F could still trigger preemption, although no court has gone so far yet.
Joplin in a Mercedes-Benz, you could use that picture in an advertisement for Coca-Cola by adding in extra text or even altering the photo so that a distinctive Coke bottle is in the singer’s hand.\footnote{Again, depending on the amount of alteration, a derivative work could be created in this instance.}

**b. Voices and Images fixed in Audiovisual Works**

When a claim is based on a use of voices and pictures fixed in audiovisual works, the analysis should be essentially the same as mentioned above, in large part because audiovisual works are essentially sound recordings with an added visual component.\footnote{Audiovisual works are defined in the Copyright Act as “works that consist of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.” \textit{See} 17 U.S.C. 101. Examples of audiovisual works are movies, television shows, or even Youtube videos. The results of claims involving audiovisual works have largely followed cases like \textit{Laws} dealing with sound recordings. \textit{See, e.g.}, Jules Jordan Video, Inc. v. 144942 Canada Inc., 617 F.3d 1146 (9th Cir. 2010); Aronson v. Dog Eat Dog Films, Inc., 2010 WL 3489590 (W.D. Wash. 2010) (Finding federal Copyright preemption of state right of publicity Claim based on defendant's use in a documentary of plaintiff's video of plaintiff and others where plaintiff alleged both federal Copyright and state right of publicity counts.). \textit{See also} J. THOMAS MCCARTHY, 2 RIGHTS OF PUBLICITY AND PRIVACY § 11:54 (2d ed. 2011)} Applying the predominant value test, the outcome would likely be determined based on how much of the copyrighted work is used. The larger the amount used, the more the scales tip toward the work; the less the amount of the work used, the more likely it is that a persona comprises a majority of the value used. For example, if a putative defendant licenses an entire motion picture that features the putative plaintiff as an actor, it would be very hard for the plaintiff to show the value in his persona outweighs the value in the entire motion picture. However, if a putative defendant licenses a very small segment of the motion picture (or even merely a still photograph from the film), a putative plaintiff would have an easier time showing the value in his persona it the predominant value in the work.

**c. Likenesses fixed in Photographs**
Factual scenarios involving photographs have some similarities with scenarios involving sound or audiovisual recordings, but are often even closer calls. Some jurisdictions have latched on to the idea that likenesses are separable from the photographs in which they are contained, and thus there is no preemption. And, even in jurisdictions that have been receptive to the idea that the Copyright Act may preempt some publicity rights infringement claims, for some unarticulated reason, courts seem to be more hesitant to allow for preemption when photographs alone are involved. Part of the hesitance may be due to the qualitative differences between the facets of a persona captured in a sound recording as opposed to a photograph.

It would seem like if one were to follow the Laws-type express preemption reasoning, most cases involving photographs would be preempted. But such a result would likely be too extreme – there would be a real danger of copyright preemption completely swallowing publicity rights. This danger is highlighted because of just how easy it is to create a photo of a person without that person’s consent than to, for example create an unauthorized, yet copyrightable, sound recording. Merely being in a public place allows a person to be photographed without that person realizing it or having any ability to prevent the photograph. This ease of capture raises more fears that the value in a persona can be misappropriated, and qualitatively, if may be that it feels more correct for there to be less limits on claims involving pictures and likenesses than claims involving sound recordings and voices. Thus, in order to strike the proper balance

---

183 The 7th Circuit takes this view, see Toney v. L’Oreal USA, Inc., 406 F.3d 905, 910 (7th Cir. 2005), as does the 5th Circuit, see Brown v. Ames, 201 F.3d 654, 658 (5th Cir. 2000), and Illinois. See Brown v. ACMI Pop Div., 375 Ill.App. 3d 276, 287-89 (2007). Strangely, considering the Laws decision, the 9th Circuit seems to agree, as well. See Downing v. Abercrombie and Fitch, 265 F.3d 994, 1004-05 (9th Cir. 2001).

184 In fact, some cases have dealt with this very same situation. See, e.g. Downing, 265 F.3d at 1004-05 (photograph of surfer taken at surfing competition appears in catalog for defendant’s surf-themed clothing line); Tellado v. Time-Life Books, 643 F.Supp. 904 (D.NJ 1986) (picture of soldier taken during the Vietnam War used to in print advertisement for a non-fiction book on the War).

185 For an example of the different results stemming from cases in the same circuit involving different kinds of copyrighted works, compare Laws, 448 F.3d at 1139-43 with Downing, 265 F.3d at 1004-05. Another issue in play (and ultimately outside of the scope of this paper) is the availability of First Amendment-based defenses. See, e.g.,
between the ability of copyright owners to take full advantage of the rights provided in the Copyright Act and the interest that individuals have in protecting the valuable aspects of their persona, the predominant value test is appropriate.

When applying the test to photographic works, some existing copyright jurisprudence aids in the analysis. In Mannion v. Coors Brewing Company, a federal district court in New York closely examined copyright protection for photographs and focused on what the Supreme Court has called the “sine qua non” of copyrightability: “originality.” After pointing out the maxim that copyright protection in a given work is only afforded to original, creative expression of the copyright author, the court noted that protectable originality in photographic works can be found in three areas: the “rendition” of the photograph, defined as “originality which does not depend on creation of the scene or object to be photographed ... and which resides [instead] in such specialties as angle of shot, light and shade, exposure, effects achieved by means of filters, developing techniques etc”; “timing” of the photograph, which is defined as the originality in a photograph taken “by being at the right place at the right time”; and “creation of the subject,” which is defined as originality “to the extent that the photographer created ‘the scene or subject to be photographed.’”

In applying this framework to the predominant value test, a court would look to whether a specific photograph is used in a specific instance because of any of the three aspects of originality mentioned above or whether the photograph is instead used because of the value of the likeness captured in the photograph. If, for example, a photograph is chosen for use in an

---

187 See id.
advertisement predominantly because of the photograph’s unique use of light and color and because of how the photographer has arranged the subject of the photograph, a publicity rights infringement claim regarding the photograph would be preempted. If, on the other hand, the photograph has unique use of color and lighting and an interesting arrangement of the subject, but its predominant value is in the person photographed, a publicity rights infringement claim would not be preempted.

In all practicality, the result of the application of the predominant value test here would be that hardly any claims would be preempted. The more valuable a likeness is, the more likely it is that it will overcome the relatively weak value in, for example, the rendition of a photograph. The exception could be where a picture captures only a very attenuated aspect of a persona, as in Motschenbacher where the photograph at issue showed the plaintiff driving his race car, but with his face obscured by his helmet and with alterations done to the car itself. In such instances, the more attenuated the characteristic, the more the value of the persona taken would be diminished to the point where it would be much harder to overcome the value in the creative expression in the photograph.

d. A Concluding Note About Derivative Work Rights

The Copyright Act may sometimes preempt publicity rights infringement claims when claims involve a copyright author exercising his Section 106 right to create “derivative works” of a work that fixes an aspect of a persona. Derivative works are defined as a work “based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted.” A scenario like that raised in the preceding section could also be imagined where publicity rights

infringement claims will hamper a copyright author’s ability to exercise its exclusive derivative work right.

However, an additional consideration in this area is the broad scope of the derivate work right. By defining derivate works as including “any” form in which a work may be “recast, transformed, or adapted,” the Copyright Act gives an author of a work a great degree of control over what can be done to an existing work. Allowing the valid exercise of the right to create derivative works to trump publicity rights would drastically limit publicity rights. Thus, the predominant value test may be appropriate here to strike a better balance between the rights of authors under the Copyright Act and the rights of individuals under state publicity rights laws. Applied to a claim framed in this way, the test would look to whether a derivate work based upon the preexisting copyrighted work was predominantly meant to exploit the value of the personae embodied in that work, or was predominantly meant to capitalize on the creative expression of the author or aspects of the copyrighted work separate from the personae fixed therein, such as a motion picture’s story or characters. Claims involving the former scenario would not be preempted, while claims involving the latter, would.

CONCLUSION

State publicity rights claims are often inextricably intertwined with copyrighted works. It doesn’t help matters that both publicity rights doctrine and federal preemption doctrine are not known for being consistent, straightforward, or clear. While much of the debate in publicity rights jurisprudence revolves around the applicability First Amendment-based defenses to infringement, as publicity rights are either expanded by courts and legislatures or become more popular vehicles for lawsuits, courts and litigants will increasingly grapple with copyright
preemption of publicity rights infringement claims. Preemption doctrine is one avenue to prevent a problem the Ninth Circuit warned of in *Laws v. Sony Music Entertainment, Inc.*: “left to creative legal arguments, the developing right of publicity could easily supplant the copyright scheme[, and it] is hard to imagine how a copyright would remain meaningful if its licensees were potentially subject to suit from any performer anytime the copyrighted material was used.”189

To date, there is a great deal of disharmony in jurisdictional approaches to when and where preemption of publicity rights infringement claims will occur. In fact, often a difficult balancing of interests is necessary. As the Ninth Circuit has noted, on one hand, “the holder of a copyright does not have ‘a license to trample on other people’s rights.”’190 Yet on the other hand, “the right of publicity is not a license to limit the copyright holder’s rights merely because one disagrees with decisions to license the copyright.”191 This paper argues that the predominant value test explained herein is one way of negotiating that balance. The test looks to whether the a given action by a defendant, like copying a work or licensing an aspect of the work for display or preparation of a derivative work, was predominantly meant to capitalize on the value in an individual’s persona, or was instead predominantly meant to utilize the “sine qua non” of copyright law: the creative expression of the author. By doing so, the test accounts for both of the competing interests at stake, and helps to resolve a difficult question in a more simplified manner.

---

189 448 F.3d 1134, 1145 (9th Cir. 2008).
190 *Id.*
191 *Id.*