MODEL RELEASES, RIGHT OF PUBLICITY AND MISAPPROPRIATION OF NAME AND LIKENESS

By Pablo Balana

At Nimia Legal we are sure that at some point in your professional careers you have raised or will raise questions or concerns related to or in connection with the issues that revolve around model releases: "do I, or do I not need a model release and why? If I don't have one, what can I or can't I do?" These questions are related to the law of right of publicity.

This article aims at providing you with a general overview of right of publicity and the rationale behind the dichotomy of the terms commercial and editorial. We will focus our analysis on the law in California, a state with abundant and interesting case law. What this article will not cover, however, are issues related to copyright and trademark infringement, often raised in conjunction with infringement of the right of publicity. Those issues deserve a separate and detailed analysis.

For those of you not in a common law country (Europe, LatAm, etc.), the right of publicity might sound unfamiliar or even foreign. You should view it as a derivative of the constitutionally protected rights to dignity, honor and image, keeping in mind that the right of publicity in the U.S. is intended to protect control and economic interests related to the commercial exploitation of one's identity, not the moral rights attached to one's personality. Think of the right of publicity as a sort of copyright on one's persona.

The first part of this article focuses on California's statutory and common law right of publicity; background information and the elements of each claim.

The second and third sections examine commercial and editorial productions to help determine when consent –a model release- is needed or exempted or superfluous.

The fourth and final section will explore real life examples in which the line that separates commercial from editorial is confusing and arguable, and how courts have decided the cases.

Producers and advertisers should be aware that not all uses of a protected attribute necessarily require a model release in commercial productions and not all editorial productions are exempted from obtaining a release. An accurate understanding of the law will allow producers and advertisers to exploit footage at its fullest while maintaining litigation risks at its lowest.

I. FROM PRIVACY TO PUBLICITY

The right to privacy protects the right to be left alone and comprises four separate torts: (i) intrusion upon seclusion, solitude or into private affairs; (ii) public disclosure of embarrassing private facts; (iii) publicity which places a person in false light in the public eye; and (iv) appropriation, for defendant's advantage, of plaintiff's name or likeness.

The later tort, also known as misappropriation of name and likeness, protects one's proprietary interest in the use of his name or likeness, as well as a reputational interest (deciding which products/services to be associated with and, therefore, how the public perceives oneself), and mental integrity by preventing hurt feelings from public misperception.

The right of publicity derives from the tort of misappropriation of name and likeness and protects a person's monetary interest in the commercial exploitation of his persona. In California the common law tort of misappropriation coexists with and is complemented by a statutory right of publicity, a property right that is descendible and lasts for a period of 70 years after death.

A) Misappropriation of name and likeness in California

The common law tort of misappropriation of name and likeness is broader than the statutory right of publicity because in interpreting its scope of protection, courts focus more on a broader concept of identity than in likeness.

The following are instances of uses of identity that would not be considered a use of likeness:

- Imitation of someone's voice (Waits v. Frito-Lay, Inc., 978 F. 2d 1093 - Court of Appeals, 9th Circuit 1992);
- A picture of a distinctly-decorated race car even if driver is not visible (Motschenbacher v. RJ Reynolds Tobacco Company, 498 F. 2d 821 - Court of Appeals, 9th Circuit 1974);
- A robot evoking somebody, even if not sufficiently detailed as to constitute a statutory use (White v. Samsung, 971 F.2d 1395, 1397-99 – Court of Appeals, 9th Circuit 1992).

The elements of a common law action for misappropriation according to Eastwood v. Superior Court, 149 Cal.App.3d 409, 416, 198 Cal.Rptr. 342 (1983) are (1) use of plaintiff's identity; (2) appropriation of plaintiff's name and likeness to defendant's advantage, commercial or otherwise; (3) lack of consent; and (4) resulting injury.

B) California's Statutory right of publicity

California's right of publicity is codified in Section 3344 of the Civil Code and its core definition reads as follows:

> *"any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner . . .in or on goods or for purposes of advertising or selling, or*

soliciting purchases . . . without such person's prior consent . . . shall be liable for any damages sustained by the person or person injured as a result thereof".

Let's take a look at the most important elements and illustrate them with real case examples.

Who is protected?

Only natural persons have a right of publicity. Under the common law tort of misappropriation, non-celebrities were not adequately covered due to the lack of commercial value of their name and the difficulty of proving damages. The statutory right of publicity filled that gap and protects both celebrities and public figures in the entertainment industry as well as non-celebrities or the "little man" as the California Court of Appeals noted in Miller v. Collectors Universe, Inc., 72 Cal. Rptr. 3d 194 – Cal. Court of Appeal, 4th Appellate Dist. 2008.

Courts have interpreted the right of publicity to apply to music groups such as No Doubt, the Beatles, the Rolling Stones, and Judas Priest, Molly Hatchett, Devo, Styx, and Iron Maiden.

What is protected?

The scope of the right of publicity is broad and includes name, voice, signature, photo and likeness. The term voice does not include voice imitations in statutory claims, although it does in tort claims for misappropriation. The term photograph is defined by the statute as "*photograph or photographic reproduction, still or moving, or any videotape or live television transmission, of any person, such that the person is readily identifiable*".

A person is readily identifiably if someone could reasonably determine –i.e., with the naked eye- that the photo depicts him. In a photo of a crowd of people, a person is readily identifiable if he is singled out as an individual rather than being merely a member of the group.

The term likeness presents the problem of how identifiable an image must be to constitute a likeness. In Newcombe v. Adolf Coors Co., 157 F. 3d 686 - Court of Appeals, 9th Circuit 1998 the court used the readily identifiable test in view of the connection between photo and likeness: "*a photograph is a visual image of a person that is obtained by using a camera while likeness is as visual image of a person other than a photograph*".

How is it protected?

The statutory right of publicity protects against unconsented and knowing uses of name, voice, signature, photo, and likeness, either on or in products (merchandising), or for purposes of advertising.

Courts apply a 3-step test to determine whether there is a statutory violation:

1- Was there a knowing use of the plaintiff's protected identity?
2- Was the use for advertising purposes?
3- Was there a direct connection between the use and the commercial purpose?

Are there any exemptions?

Section 3344 (d) of the California Civil Code exempts from obtaining prior consent (and, thus, from liability) if a use of a protected identity is in connection with any news, public affairs, or sports broadcast or account, or any political campaign. This safe harbor or exemption, known as newsworthiness in the context of common law tort of misappropriation, derives from the supremacy clause of the Constitution and the First Amendment protections of freedom of speech and expression.

Photos or videos classified as 'editorial' in the stock industry are generally those lacking a release because a lack of consent means a substantial risk of being sued for the violation of the right of publicity or misappropriation. However, that doesn't mean editorial content is barred from being used 'commercially' in the sense of 'for making a profit'. You should not associate the term editorial with the concept 'not for a profit' as the First Amendment protection is not waived by the fact that a production is made for a monetary gain.

Making a motion picture, or a documentary, or writing a book, or issuing a newspaper, for instance, are activities ordinarily undertaken for a profit and still fully protected under the First Amendment. In short, the term editorial refers to the statutory or constitutional exemption and should be read as the equivalent to 'other than advertisement or merchandising'.

Courts have expanded the scope of exemption –or editorial category- to include advertisements of exempted expressive works. In the words of the Supreme Court of California in Guglielmi v. Spelling-Goldberg Productions, 603 P. 2d 454 – Cal. Supreme Court 1979 "*since the use of Valentino's name and likeness in the film was not an actionable infringement of Valentino's right of publicity, the use of his identity in advertisements for the film is similarly not actionable*".

II. COMMERCIAL PRODUCTIONS

Commercial speech was defined by the U.S. Supreme Court in Bolger v. Youngs Drug Prods. Co., 463 U.S. 60, 66, 103 S.Ct. 2875, 77 L.Ed.2d 469 (1983) as "speech that does no more than propose a commercial transaction". The line between commercial (advertisement + merchandising) and non-commercial (expressive/editorial) has yet to be clearly drawn and courts take a case-by-case approach when deciding whether a disputed work falls within a category.

The distinction is of paramount importance because a categorization as commercial entails that publicity is more probable to trump First Amendment protection and, vice versa, a categorization as editorial entails that publicity will most probably be overridden by First Amendment.

Section 3344 (a) of the California Civil Code codifies two uses for which a release or consent is needed:

a) Use of protected identity on or in products, merchandise or goods -merchandising; or
b) Use of protected identity for purposes of advertising or selling or soliciting purchases of products, merchandise or goods -advertisement.

Is consent/release always necessary?

Obtaining consent or a release for a commercial production may be superfluous if the use of a protected identity is deemed to be incidental. The incidental use exception is a doctrine not well defined in California yet. The rationale behind the doctrine is that an incidental use has no commercial value and allowing recovery to anyone briefly depicted or referred to would unduly burden expressive activity (Pooley v. National Hole-In-One Ass'n, 89 F. Supp. 2d 1108 - Dist. Court, D. Arizona 2000).

The general rule under the incidental use doctrine is that an incidental use of name or likeness does not give rise to liability under misappropriation or right of publicity. To determine whether a use is incidental, courts look at the role that the use plays in the main purpose and subject of the work at issue, taking into consideration that, generally, a name is not appropriated by the mere mention of it.

In deciding whether a case falls within the incidental use exception, courts (Yeager v. Cingular Wireless LLC, 673 F. Supp. 2d 1089 - Dist. Court, ED California 2009) look at the following four factors:

1) whether the use has a unique quality or value that would result in commercial profit to the defendant;
2) whether the use contributes something of significance;
3) the relationship between the reference to the plaintiff and the purpose and subject of the work; and
4) the duration, prominence or repetition of the name or likeness relative to the rest of the publication.

However, if the use of protected identity stands out prominently within the advertisement, the use cannot be considered incidental even if the mention is brief. In Pooley v. National Hole-In-One Ass'n, 89 F. Supp. 2d 1108 - Dist. Court, D. Arizona 2000 the court determined that the use of Pooley's name and likeness was crucial for the advertisement "Million Dollar Hole-in-One" even if the use was as brief as for 6 seconds in a total 8 minutes video. Pooley was a professional golfer and became famous for having made a hole-in-one shot and wining a million dollars for it.

III. EDITORIAL PRODUCTIONS

Editorial productions are productions that, by virtue of the First Amendment protection of freedom of speech and expression, or its codified exemption under California's Section 3344 (d), a release is not needed when a protected identity is used. Editorial productions are expressive works such as books, films, documentaries, video games, newspapers, magazines, etc. It does not matter whether the work might be technically classified as news or entertainment: both forms are protected alike under the First Amendment freedom of speech and expression.

In Dora v. Frontline Video, Inc., Cal. App. 4th 536, 18 Cal. Rptr. 2d 790(Ct. App. 1993) surfer Mickey Dora sued for violation of his right of publicity in the video documentary "The Legends of Malibu". The documentary chronicled the early days of surfing, showing contemporaneous footage of famous surfers, including Dora. Dora was never interviewed or ever consented to the use of his protected identity but he lost the case on the grounds that the documentary contained matters of public interest and public affairs and, thus, was exempted under Section 3344 (d) of the California Civil Code.

Limits to the exemption

So far we have taken a look at how commercial productions generally require model releases to avoid claims for misappropriation or right of publicity, whereas editorial productions are generally exempted from obtaining consent or a release. The question that concerns us now is what are the limits of the statutory/constitutional exemption? Put in a different way: when is consent not exempted and, therefore, a release needed for editorial productions?

Zacchini v. Scripps-Howard Broadcasting, Co., 433 US 562 - Supreme Court 1977 is the only right of publicity claim heard by the Supreme Court of the United States. In Zacchini, a TV station broadcasted on the news, without consent or compensation, a 15 second video featuring Hugo Zacchini's human cannonball show, where a human was shot from a canon into a net some 200 feet away.

The court looked at whether the TV station was privileged to broadcast the entire show under the newsworthiness exception (no consent or compensation needed in such case) and ruled favorably for Zacchini after taking into consideration an economic approach to the right of publicity: the right of publicity protects a proprietary interest of the individual in his act, in part to encourage such entertainment.

The broadcast of the entire show posed a substantial threat to the economic value of the performance because, the court reasoned, if the public could see the show for free on television it would be less willing to see it live. It also distinguished between mere appropriations of reputation from the strongest case of a right of publicity claim, i.e., appropriations of the very activity by which the entertainer acquired his reputation in the first place.

IV. EDITORIAL V. COMMERCIAL PRODUCTIONS

As we mentioned earlier, the line between commercial speech/advertisement and expressive work is not clearly drawn and some instances are susceptible of being classified, at first glance, as editorial and commercial at the same time. Here are some examples of how courts have dealt with arguable editorial and commercial productions:

In Downing v. Abercrombie & Fitch, 265 F.3d 994 –Court of Appeals, 9th Circuit 2001, Downing and other surfers sued for infringement of the right of publicity and misappropriation in Abercrombie's issue of a catalog using, without consent, their names and likenesses. The catalog's theme was surfing and the surf culture, and it had a section under the title 'Surf Nekkid' where a 700-word article described the history of Old Man's Beach at San Onofre, California. Following the article, the catalogue exhibited photos of the plaintiffs taken in 1965 Makaha International Surf Championship in Hawaii. Two pages immediately after, the catalog featured t-shirts labeled 'Final Heat Tees' which were identical to those worn by the plaintiffs in the prior photos. The catalog also included two other articles on surfing and an interview to former world surf champion Nat Young.

The district court ruled that Abercrombie's use of plaintiffs' names and likenesses was expressive and protected under the Frist Amendment and, therefore, Abercrombie was exempted from obtaining plaintiffs' consent. However, the court of appeals reversed on the grounds that, even though surf and the surfing culture is a matter of public interest (remember the case on Mickey Dora's documentary cited above), Abercrombie had used the plaintiffs' names and photos "essentially as window dressing to advance the catalog's surf-theme". The court reasoned that the illustrative use of plaintiffs' photos did not contribute significantly to a matter of public interest and therefore Abercrombie's catalog could not be exempted under the First Amendment.

In Facenda v. N.F.L. Films, Inc 542 F. 3d 1007 –Ct. Of Appeals, 3d Circuit 2008, the court dealt with what was labeled as a 'documercial' broadcasted prior to the release of the video game Madden NFL. The 'documercial' consisted of a 22 minutes long production/documentary featuring interviews with NFL players and the game's producers and included several sequences comparing the video game's virtual environment with the actual NFL environment.

To underscore the degree to which the video game authentically recreated the NFL experience, the production used a total 13 seconds of sound recording taken from earlier NFL Film's productions of three sentences read by John Facenda: *"Pro football, the game for the ear and the eye … This sport is more than a spectacle, it is a game for all seasons … X's and O's on the blackboard are translated into imagination on the field"*. The end of the production featured a countdown to the video game's release.

The court of appeals held that (i) the production was commercial in nature, i.e, an advertisement rather than a documentary; (ii) NFL had violated Facenda's right of publicity –the voice's commercial value was undisputed, it was used for a commercial purpose (advertising)

and the release did not cover endorsements; and (iii) Facenda's state right of publicity was not preempted by the NFL's federal copyright.

In Stewart v. Rolling Stone LLC., 181 Cal. App. 4th 664 – Cal. Court of Appeal, 2010 plaintiffs filed a claim against the Rolling Stone Magazine for using their artistic names for the commercial purpose of advertising cigarettes. The case involved an editorial feature entitled 'Indie Rock Universe' that named plaintiffs' bands together with over 100 other bands and an advertisement of Camel cigarettes. The trial court characterized the editorial feature as commercial and the court of appeals reversed and found it to be protected under the First Amendment. The court of appeals cited the Supreme Court of California and the 9th Circuit's criteria in deciding whether a given use is for commercial/advertisement or expressive/editorial purposes:

- In Kasky v. Nike, Inc., 45 P. 3d 243 – Cal. Supreme Court 2002 the supreme court of California said that "when a court must decide whether particular speech may be subjected to laws aimed at preventing false advertising or other forms of commercial deception, categorizing a particular statement as commercial or noncommercial speech requires consideration of three elements: the speaker, the intended audience, and the content of the message."
- In Mattel, Inc. v. MCA Records, Inc., 296 F. 3d 894 - Court of Appeals, 9th Circuit 2002 the court of appeals differentiated between commercial and noncommercial in the following manner: "although the boundary between commercial and noncommercial speech has yet to be clearly delineated, the core notion of commercial speech is that it does no more than propose a commercial transaction. If speech is not `purely commercial'— that is, *if it does more than propose a commercial transaction*—then it is entitled to full First Amendment protection".

V. CONCLUSION

The law of privacy and the law of publicity are two distinct but very connected areas of the law. When the stock video or photo industry differentiates between editorial and commercial content on the basis of the lack or the availability of a release it does no more than apply the general principles of the law of privacy and publicity, that is, consent is required for advertisements and merchandising and is exempted for expressive or editorial productions. This is, however, a very broad approach to privacy and the right of publicity.

The law as applied and interpreted by the courts is much more complex and challenging. It might happen that an editorial production requires a model release because the use of a protected attribute falls outside of the scope of exemption and, vice versa, it might be that a commercial production is exempted from obtaining consent if a given use of a protected

attribute is *de minimis* or is incidental. If you have further questions related to model releases and right of publicity, contact Nimia at legal@nimia.com or call 206 388 8092.

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