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"It's a Little Known Fact" that Copyright Law is in Conflict with the Right of Publicity

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"It's a Little Known Fact" that Copyright Law is in Conflict with the Right of Publicity

Cover Page Footnote

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“IT’S A LITTLE KNOWN FACT” THAT COPYRIGHT LAW IS IN CONFLICT WITH THE RIGHT OF PUBLICITY

*Madeline O'Connor**

INTRODUCTION

In 1997, the United States Court of Appeals for the Ninth Circuit decided the case of *Wendt v. Host International, Inc.*,¹ which involved a conflict between the state statutory and common law right of publicity and federal copyright law.² The decision in *Wendt* continues to be cited by many circuits,³ even though the court’s resolution of the conflict was not clear, and leaves behind the question of whether actors are able to unfairly exploit the right of publicity to lay claim to characters that are not their own. In *Wendt*, actors George Wendt and John Ratzenberger sued Host International, Inc. (“Host”) in district court claiming their trademark and publicity rights were violated when Host, without their permission, placed animatronic robotic figures (“robots”) based upon their likenesses in airport bars, modeled upon the television show *Cheers*.⁴ The court had to decide whether the California statutory and common law right of publicity prevented Host from using robots based upon the actors’ likenesses,⁵

* J.D. Candidate, 2010, Touro College Jacob D. Fuchsberg Law Center. I would like to thank many special people: first, Professor Rena Seplowitz for her constant support and assistance; second, Professors Melniker and Barshay, who have not only helped me throughout my education, but have also guided me in reshaping my future; third, my good friend James Lucarello, Editor-in-Chief of the Touro Law Review, and one of the finest human beings I have had the pleasure of knowing; and, finally, I would like to thank my loving parents, children, family, friends, and teachers who have stood beside me and helped me succeed in a very difficult time in my life.

¹ *Wendt v. Host Int’l, Inc. (Wendt II)*, 125 F.3d 806 (9th Cir. 1997).

² *Id.* at 809.

³ *See, e.g.,* *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1025 (3d Cir. 2008); *McBee v. Delica Co., Ltd.*, 417 F.3d 107, 114 (1st Cir. 2005); *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1008 (9th Cir. 2001); *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 623 (6th Cir. 2000).

⁴ *Wendt II*, 125 F.3d at 808-09.

⁵ *Id.* at 809.

and whether the use of their likenesses created a likelihood of confusion that Wendt and Ratzenberger were endorsing Host's products, in violation of Section 43(a) of the Lanham Act.⁶ Also confronting the court were the arguments of Host and Paramount Pictures Corporation ("Paramount") that the appearance of the robots invoked the characters "Norm" and "Cliff," rather than Wendt and Ratzenberger as individuals, rendering the plaintiffs' right of publicity claims meritless.⁷ Further, Host and Paramount argued that the characters "Norm" and "Cliff" were the property of Paramount based upon Paramount's copyrights in these characters, and, therefore, plaintiffs had no claim under the right of publicity.⁸

The court was placed in the difficult position of reconciling the conflicting rights of copyright law and the right of publicity. While Paramount had copyright ownership of the characters "Norm" and "Cliff," and licensed the right to create the robotic figures to Host, it was also true that the characters "Norm" and "Cliff" were developed through the unique personalities and personae of the actors George Wendt and John Ratzenberger. Undeniably, both plaintiffs and defendants had valid rights to the same intellectual property: Paramount and Host to the fictional characters "Norm" and "Cliff" that they had created and protected under copyright law, and Wendt and Ratzenberger to their likenesses in their roles as characters "Norm" and "Cliff," which are protected by the right of publicity.

This Comment will analyze Section 102 of the Copyright Act, the right of publicity in common law and as codified in state statutes, and Section 43(a) of the Lanham Act, and the analyses and application of these laws by different circuits. Further, this Comment will suggest alternative tests, modeled upon trademark law, that courts may use in the future in similar situations to reach more equitable determinations.

⁶ *Id.* at 812; 15 U.S.C.A. § 1125 (West 2006).

⁷ *Wendt v. Host, Int'l. Inc. (Wendt I)*, Nos. 93-56318, 93-56510, 1995 U.S. App. LEXIS 5464, at *7 (9th Cir. Mar. 16, 1995). Paramount was an applicant in intervention. *Id.* at *1.

⁸ *Id.* at *7.

I. THE COMPETING LAWS

A. Copyright Law

Copyright law's ultimate purpose is to "enrich[] the general public through access to creative works," and to promote creativity of authors and inventors.⁹ Section 102 of the Copyright Act protects "original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of machine or device."¹⁰ The copyright in a work "vests initially in the author or authors of the work."¹¹ Thus, copyright law provides protection to an author of an original work that is set forth in tangible form.¹² A work is considered original when "it is the independent creation of its author," and "is creative if it embodies some modest amount of intellectual labor."¹³ Only a small degree of creativity is necessary for copyright protection.¹⁴

Further, Section 106 of the Copyright Act provides copyright holders with "the exclusive right[] . . . to prepare derivative works based upon the[ir] copyrighted work."¹⁵ Inherent in this right is the ability of copyright holders to take advantage of markets beyond the original market which featured the work.¹⁶ The copyright holders may also grant licenses of their copyrighted work to others to create derivative works.¹⁷ In the case of *Wendt*, Paramount had obtained

⁹ *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 527 (1994).

¹⁰ 17 U.S.C.A. § 102(a) (West 2009). *See, e.g.*, *Feist Publ'ns., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

¹¹ 17 U.S.C.A. § 201(a) (West 2009).

¹² *See id.*

¹³ *See Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 668 (7th Cir. 1986); *see also Feist*, 499 U.S. at 345 (stating that an original work is one that is "independently created by the author").

¹⁴ *Orioles*, 805 F.2d at 668.

¹⁵ 17 U.S.C.A. § 106 (West 2009). Section 107 of the Copyright Act provides that the public at large has "the right to make 'fair use' parodies," as well as other transformative works. *White v. Samsung (White II)*, 989 F.2d 1512, 1517 (9th Cir. 1993) (Kozinski, J., dissenting). *See, e.g.*, *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). *See also* 17 U.S.C.A. § 107 (West 2009).

¹⁶ Peter K. Yu, Note, *Fictional Persona Test: Copyright Preemption in Human Audiovisual Characters*, 20 CARDOZO L. REV. 355, 387 (1998).

¹⁷ *White II*, 989 F.2d at 1517 (Kozinski, J., dissenting). *See also* 17 U.S.C.A. § 106(2).

copyright protection for their characters “Norm” and “Cliff” and then had licensed the right to create a derivative work, the robotic figures, to Host.¹⁸ Thus, Host and Paramount claimed that copyright laws protected their actions.¹⁹

B. Trademark Law

Trademark law also provides for a claim of unfair competition in right of publicity types of cases.²⁰ These claims arise when a defendant’s use of a celebrity’s persona causes likelihood of confusion as to whether the celebrity endorsed the defendant’s product.²¹ In the case of *Wendt*, Wendt and Ratzenberger argued that Host’s robots created a likelihood of confusion that Wendt and Ratzenberger endorsed Host’s airport bars.²²

Section 43(a) of the Lanham Act provides for a civil action against

[a]ny person who, or in connection with any goods or services, . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof, . . . which – (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person²³

Courts analyze whether a likelihood of confusion exists by applying the following factors: “ ‘1) strength of the plaintiff’s mark; 2) relatedness of the goods; 3) similarity of the marks; 4) evidence of actual confusion; 5) marketing channels used; 6) likely degree of purchaser care; 7) defendant’s intent in selecting the mark; and 8) likelihood of expansion of the product lines.’ ”²⁴

¹⁸ *Wendt I*, 1995 U.S. App. LEXIS 5464, at *7.

¹⁹ *Id.*

²⁰ See 15 U.S.C.A. § 1125(a)(1)(A).

²¹ *White v. Samsung (White I)*, 971 F.2d 1395, 1400 (9th Cir. 1992).

²² *Wendt II*, 125 F.3d at 811.

²³ 15 U.S.C.A. § 1125(a)(1)(A).

²⁴ *Newton v. Thomason*, 22 F.3d 1455, 1462 (9th Cir. 1994) (quoting *White I*, 971 F.2d

C. The Right of Publicity

The right of publicity is intended “to protect the commercial interest of celebrities in their identities.”²⁵ The assumption is that a celebrity’s identity is valuable in the endorsement of products, and the celebrity should be able to prevent any “unauthorized commercial exploitation of that identity.”²⁶ In the case of *Wendt*, Wendt and Ratzenberger argued that their publicity rights were violated by Host’s use of the robotic figures, which were based upon the likenesses of Wendt and Ratzenberger.²⁷

1. California Civil Code Section 3344

California Civil Code provides, in relevant part, that [a]ny person who knowingly uses another’s name, voice, signature, photograph or likeness, in any manner, . . . for purposes of advertising or selling, . . . without such person’s prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.²⁸

Thus, under California law, an individual’s right of publicity is violated when “another appropriates for his advantage the individual’s name, image, identity or likeness.”²⁹ The law requires a deliberate use of the individual’s “ ‘name, photograph, or likeness for purposes of advertising or solicitation of purchases.’ ”³⁰ Additionally, the courts require a direct connection “ ‘between the use and the commercial purpose.’ ”³¹ Damages are awarded as either “seven hundred fifty dollars [] or the actual damages suffered” as a result of the unauthorized use—whichever is greater—and any additional profits that

at 1400). The circuits phrase these factors differently.

²⁵ *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983).

²⁶ *Id.*

²⁷ *Wendt II*, 125 F.3d at 809.

²⁸ CAL. CIV. CODE § 3344(a) (West 1997).

²⁹ *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 649 (Cal. Ct. App. 1996).

³⁰ *Id.* (quoting *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 347 (Cal. Ct. App. 1983)).

³¹ *Id.* (quoting *Eastwood*, 198 Cal. Rptr. 342 at 347).

are not considered when computing the actual damages.³² The statute provides for an award of punitive damages and attorney's fees to the damaged party.³³

2. *California Common Law Right of Publicity*

California also has a common law right of publicity that provides protection against appropriation of a person's name or likeness.³⁴ To plead this common law right of publicity, a plaintiff must allege: "1) the defendant's use of the plaintiff's identity; 2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; 3) lack of consent; and 4) resulting injury."³⁵

California's common law right of publicity provides greater protection than California Civil Code Section 3344, in that, in addition to protecting against "the knowing use of a plaintiff's name or likeness for commercial purposes[,] . . . [i]t also protects against appropriations of the plaintiff's identity by other means."³⁶ For example, the common law right of publicity also protects an individual from misappropriation of his identity,³⁷ voice,³⁸ and even his vehicle.³⁹ Thus, California's common law right of publicity protects more aspects of an individual's persona than does California's statutory right of publicity.

D. *Summary of Rights Protected*

Whereas copyright law protects an individual's creative efforts by preventing the unlawful appropriation of his original works,⁴⁰ unfair competition under trademark law safeguards against the misappropriation of an individual's persona that creates the false im-

³² CAL. CIV. CODE § 3344(a).

³³ *Id.*

³⁴ *Wendt II*, 125 F.3d at 811 (citing *Eastwood*, 198 Cal. Rptr. at 346).

³⁵ *Id.* (citing *Eastwood*, 198 Cal. Rptr. at 347).

³⁶ *Id.*; see also *Downing*, 265 F.3d at 1001 (noting that the remedies provided under the statutory right of publicity are complementary to the remedies provided under the common law).

³⁷ *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407, 415 (9th Cir. 1996).

³⁸ *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988).

³⁹ *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1974).

⁴⁰ See 17 U.S.C.A. § 106.

pression of sponsorship of another's goods or services.⁴¹ Similar to trademark law, which, in part, prohibits the misappropriation of an individual's persona for commercial advantage,⁴² the right of publicity guards an individual from having his identity misappropriated for commercial advantage.⁴³ In sum, copyright law protects an individual's creative efforts,⁴⁴ while trademark's unfair competition laws and a state's right of publicity laws secure the individual's persona and identity.⁴⁵

II. FEDERAL PREEMPTION OF CALIFORNIA'S STATE LAWS

California's right of publicity laws are "subject to preemption under the [S]upremacy [C]lause of the United States Constitution" if the laws conflict with federal statutes or obstruct the execution of the " 'full purposes and objectives of Congress.' "⁴⁶ Section 301(a) of the Copyright Act expressly proscribes state legislation in the area of copyright law by stating that

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, whether created before or after that date and whether published or unpublished, 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.⁴⁷

Therefore, in order for the Copyright Act to preempt California's state laws, the claimed infringement "must be [of] a work fixed in a

⁴¹ *White II*, 989 F.2d at 1400 (Kozinski, J., dissenting).

⁴² 15 U.S.C.A. § 1125(a)(1)(B).

⁴³ *Wendt II*, 125 F.3d at 811.

⁴⁴ See 17 U.S.C.A. § 102(a).

⁴⁵ See *White II*, 989 F.2d at 1400 (Kozinski, J., dissenting); *Carson*, 698 F.2d at 835.

⁴⁶ *Fleet*, 58 Cal. Rptr. 2d at 649 (quoting *Edgar v. MITE Corp.* 457 U.S. 624, 631 (1982)).

⁴⁷ 17 U.S.C.A. § 301(a) (West 2009).

tangible medium of expression” that falls within the scope of copyright protection, and the right alleged under California’s laws must correspond to the exclusive rights included in Section 106 of the Copyright Act.⁴⁸

In situations in which an actor alleges a right of publicity claim, the actor may assert the claim as an infringement of the actor’s human persona, or as an infringement of the actor’s fictional character.⁴⁹ An actor’s human persona refers to the “actor’s unique personal attributes such as name, voice, likeness, physical mannerisms, and personality traits,” but not general characteristics such as “sex, size, or hair color.”⁵⁰ The Copyright Act does not preempt California’s state rights regarding human personae, because the actor’s human persona does not fall within the confines of the Copyright Act.⁵¹ A human persona is not “a work of authorship,” but is rather a work of nature.⁵² Further, a human persona is not “‘fixed in a tangible medium’ ” because it changes over time.⁵³

A fictional persona, on the other hand, refers to the abstract character that is produced separately by writers, and includes the “character’s general physical appearance, personality traits, and physical mannerisms” but not any of the actor’s distinctive personal attributes.⁵⁴ Fictional personae fall within the scope of the Copyright Act because they are creations of writers, and thus are “works of authorship”,⁵⁵ and they are generally “fixed in a tangible medium of expression” because the embodiment of a fictional persona on film is “‘sufficiently permanent . . . to permit it to be perceived [or] reproduced . . . for a period of more than transitory duration.’ ”⁵⁶ Since a

⁴⁸ *Fleet*, 58 Cal. Rptr. 2d at 649 (citing *Del Madera Properties v. Rhodes and Gardner, Inc.*, 820 F.2d 973, 976 (9th Cir. 1987); *Trenton v. Infinity Broadcasting Corp.*, 865 F. Supp. 1416, 1427-28 (C.D. Cal. 1994)).

⁴⁹ Yu, *supra* note 16, at 375.

⁵⁰ *Id.*; see, e.g., CAL. CIV. CODE § 3344(a) (prohibiting the unauthorized commercial use of another’s “name, voice, signature, photograph or likeness”).

⁵¹ Yu, *supra* note 16, at 378.

⁵² *Id.* at 379; see also 17 U.S.C.A. § 102(a).

⁵³ Yu, *supra* note 16, at 381 (quoting 17 U.S.C.A. § 102(a)).

⁵⁴ Yu, *supra* note 16, at 376-77.

⁵⁵ *Id.* at 381 (quoting 17 U.S.C.A. § 102(a)); see also *Feist*, 499 U.S. at 345 (stating that an original work is one that is “independently created by the author”); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884) (stating that an author is one to whom something “owes its origins”).

⁵⁶ Yu, *supra* note 16, at 381 (quoting 17 U.S.C.A. § 101) (defining fixation); see also 17 U.S.C.A. § 102(a).

fictional persona falls within the scope of the Copyright Act, state laws regarding right of publicity that protect a fictional persona may be preempted.⁵⁷

In order for preemption to occur, the right alleged under California's laws must correspond to one of the exclusive rights included in Section 106 of the Copyright Act.⁵⁸ Courts have developed two different methods for determining whether an equivalent right is involved.⁵⁹ Under the first approach, a state law will be preempted if a particular act would infringe on both the state law and an exclusive right that the Copyright Act protects, "unless the state law 'contain[s] elements . . . that are different [] from copyright infringement.'"⁶⁰ Under the second approach, a state law is preempted if it presents an obstacle to the implementation of Congress's objectives and purposes.⁶¹

III. WENDT V. HOST

Actors George Wendt and John Ratzenberger exclusively played the roles of "Norm" and "Cliff" on the television show *Cheers*. Host, which operated airport restaurants and bars, procured a license from Paramount to recreate the *Cheers* setting in its airport restaurants, including robotic figures of the characters "Norm" and "Cliff" sitting on their usual stools at the bar.⁶² The actors refused to grant right of publicity licenses to Host.⁶³ However, Paramount claimed an exclusive right to commercially use the characters "Norm" and "Cliff" based on its copyrights.⁶⁴ Host attempted to alter the appearances of the robots and changed the robots' names to "Hank" and "Bob."⁶⁵ Nonetheless, actors Wendt and Ratzenberger claimed that Host had misappropriated their likenesses for commer-

⁵⁷ Yu, *supra* note 16, at 381. See discussion *infra* Part III.

⁵⁸ *Fleet*, 58 Cal. Rptr. 2d at 650.

⁵⁹ Yu, *supra* note 16, at 381.

⁶⁰ *Id.* (quoting *Wendt II*, 125 F.3d at 810); see, e.g., *Wendt I*, 1995 U.S. App. LEXIS 5464, at *2; *Harper & Row Publishers, Inc. v. Nation Enters., Inc.*, 723 F.2d 195, 200 (2d Cir. 1983) (articulating the "extra elements" test), *rev'd*, 471 U.S. 539 (1985).

⁶¹ Yu, *supra* note 16, at 382 (citing *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941)).

⁶² Lauri S. Thompson, *The Current State of Actors' Rights in Characters they Portray*, 12 J. CONTEMP. LEGAL ISSUES 611, 613 (2001); see also *Wendt II*, 125 F.3d at 809.

⁶³ Thompson, *supra* note 62, at 613.

⁶⁴ *Id.*; see also *Wendt II*, 125 F.3d at 811.

⁶⁵ Thompson, *supra* note 65, at 613; see also *Wendt II*, 125 F.3d at 811.

cial gain.⁶⁶

Initially, the district court granted summary judgment to defendants Host and Paramount, finding that the robots Hank and Bob were not sufficiently similar to Wendt and Ratzenberger to amount to their likenesses under California Civil Code Section 3344.⁶⁷ However, the Ninth Circuit disagreed, finding that “disputed issues of material fact preclude[d] summary judgment.”⁶⁸

At the outset, the circuit court acknowledged that Wendt’s and Ratzenberger’s right of publicity claims were “not preempted by federal copyright law.”⁶⁹ The court stated that their claims contained elements of invasion of personal property rights by the unauthorized commercial use of their identities, which were different from the elements of copyright infringement.⁷⁰ Both California’s Civil Code Section 3344 and California’s common law right of publicity claims “require proof that the defendant’s use of the plaintiff’s ‘likeness’ or ‘identity’ was commercial, . . . whereas copyright infringement occurs with any unauthorized copying of the protected material.”⁷¹

Although it may seem odd that copyright law protects against any unauthorized infringement of an original work while the right of publicity protects only against infringement of celebrities’ likenesses for commercial purposes, the distinction can be justified by the fact that celebrity plaintiffs, like Wendt and Ratzenberger, chose occupations that measure success by recognizability and popularity among the public. Thus, protecting their likenesses and identities from all copying would prevent media exposure,⁷² thereby achieving the opposite effect of their intended goal to become popular actors.

When analyzing *Wendt*, Peter Yu, in his Note, *Fictional Persona Test: Copyright Preemption in Human Audiovisual Characters*,⁷³ criticizes the argument presented by actors Wendt and Ratzenberger “that the state created right ‘contain[s] elements, such as

⁶⁶ Thompson, *supra* note 65, at 613; see also *Wendt II*, 125 F.3d at 808-09.

⁶⁷ *Wendt I*, 1995 U.S. App. LEXIS 5464, at *3-*4.

⁶⁸ *Id.* at *4.

⁶⁹ *Id.* at *2.

⁷⁰ *Id.* (citing *Waits v. Frito Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992)).

⁷¹ *Id.* at *3.

⁷² Media exposure is subject to permission and fair use. See, e.g., *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster*, 545 U.S. 913 (2005).

⁷³ Yu, *supra* note 16.

invasion of personal rights.’ ”⁷⁴ In Yu’s opinion, the personae at issue were Wendt’s and Ratzenberger’s fictional rather than human personae, and because fictional personae are devoid of any personal attributes, some courts would find that the state right did not contain any additional elements that would prevent preemption by the Copyright Act.⁷⁵ However, it is arguable that Yu has confused which personae truly were at issue. Wendt and Ratzenberger were not claiming that their fictional personae as portrayed by the characters “Norm” and “Cliff” were misappropriated, but rather their human personae as George Wendt and John Ratzenberger were misappropriated.

The circuit court in *Wendt* noted that Wendt and Ratzenberger were not attempting “to prevent Paramount from exhibiting its copyrighted work,” but rather seeking to prevent their personal rights from being invaded.⁷⁶ Although the robots were placed in *Cheers* themed bars, they were neutrally named “Hank” and “Bob,” and had different facial features from Wendt and Ratzenberger.⁷⁷ Neither the attributes defined as a fictional persona nor the attributes defined as a human persona were clearly prevalent. Thus, Wendt and Ratzenberger could just as easily have argued that the recognizability of the robots was based on their human, rather than fictional, personae. As such, Wendt’s and Ratzenberger’s claims of violations of their human personae under California’s right of publicity laws would not be preempted by federal copyright law.

In a concurring opinion in *Lugosi v. Universal Pictures*,⁷⁸ Justice Mosk suggested that an individual could receive protection for a novel creation of a fictional character if the creator portrayed the fictional character.⁷⁹ In *McFarland v. Miller*,⁸⁰ the Third Circuit indicated that while originality was an important factor, protection of fictional personae under the right of publicity should be provided when an actor’s fictional persona has become so associated with the actor

⁷⁴ *Id.* at 381-82.

⁷⁵ *Id.* at 382.

⁷⁶ *Wendt II*, 125 F.3d at 810.

⁷⁷ *Id.* at 809-11. The circuit court’s observations undermine rather than support Plaintiffs’ claims.

⁷⁸ 603 P.2d 425 (Cal. 1979) (Mosk, J., concurring).

⁷⁹ *Id.* at 432 (stating, for example, that “Groucho Marx just being Groucho Marx, with his [mustache], cigar, slouch and leer, cannot be exploited by others”).

⁸⁰ 14 F.3d 912 (3d Cir. 1994).

as to be inseparable.⁸¹ However, the court indicated that “an actor becom[ing] known for a single role” would not be enough to garner protection.⁸² While the courts in *Lugosi* and *McFarland* discussed the existence of right of publicity protection for fictional characters, that protection was intended only when the actor had been portraying himself, and had developed a fictional character out of his own unique traits.⁸³ For example, Woody Allen prevented the misappropriation of his “schlemiel” persona that he had cultivated through his role in the movie *Annie Hall*.⁸⁴ In the case of *Wendt*, the right of publicity was asserted to protect the likenesses of Wendt and Ratzenberger as their human personae rather than their fictional personae.⁸⁵ It is unlikely that Wendt and Ratzenberger would have received protection for their fictional personae since the fictional personae were not their own creations or portrayals of themselves, but rather the creations of Paramount.⁸⁶

The circuit court then discussed California’s Civil Code Section 3344(b), and defined “likeness” as “a visual image of a person, other than a photograph.”⁸⁷ The court, citing *White v. Samsung Electronics America, Inc.*,⁸⁸ stated that when determining whether an image is a “likeness” under Section 3344, the image must be evaluated without considering the context in which it appears.⁸⁹ The circuit court noted the distinction between “likeness” and “identity” as elaborated in *White*.⁹⁰ In *White*, the defendants aired a commercial containing a metallic, mechanical robot wearing a blonde wig, which stood in plaintiff’s traditional position on a replicated set of the *Wheel of Fortune* game show.⁹¹ The court in *White* found that when

⁸¹ *Id.* at 920.

⁸² *Id.* at 921 n.15 (stating, for example, that actor Adam West’s portrayal of the fictional character Batman did not cause his identity to merge into and become indistinguishable from Batman, unlike Groucho Marx who was indistinguishable from his stage persona, and, therefore, West’s mere portrayal of Batman would not be enough to warrant protection).

⁸³ See *Lugosi*, 603 P.2d at 432; *McFarland*, 14 F.3d at 920.

⁸⁴ *Allen v. Men’s World Outlet, Inc.*, 679 F. Supp. 360, 362 (S.D.N.Y. 1988).

⁸⁵ *Wendt II*, 125 F.3d at 810.

⁸⁶ *Wendt I*, 1995 U.S. App. LEXIS 5464, at *1-*2.

⁸⁷ *Id.* at *4 (citing *Midler*, 849 F.2d at 463; CAL. CIV. CODE § 3344(b) (defining “photograph”)).

⁸⁸ 971 F.2d 1395 (9th Cir. 1992).

⁸⁹ *Wendt I*, 1995 U.S. App. LEXIS 5464, at *5.

⁹⁰ *Id.* (citing *White I*, 971 F.2d at 1397).

⁹¹ *Wendt I*, 1995 U.S. App. LEXIS 5464, at *4-*5; see also *White I*, 971 F.2d at 1399.

the robot was viewed in isolation, it was not the “likeness” of Vanna White according to Section 3344, but when considered in the context of the game show setting, there was a “material issue of fact as to whether the defendants had appropriated plaintiff’s *identity* within the common law meaning of the California common law right of publicity.”⁹² Thus, to determine whether the defendants’ robots “Hank” and “Bob” were likenesses of Wendt and Ratzenberger as defined by Section 3344, the circuit court had to consider the images without reference to the setting in which the robots appeared.⁹³

Upon comparison of the photographs of Wendt and Ratzenberger with photographs of the robots, the court “took ‘judicial notice’ of the fact that the figures were not identical to [Wendt and Ratzenberger].”⁹⁴ However, the circuit court, without addressing the district court’s judicial notice of facts, stated that the true issue was whether the robotic “figures [were] sufficiently similar to [Wendt and Ratzenberger] to constitute their likenesses.”⁹⁵ The circuit court determined that it could not be stated that as a matter of law the robots were so different from Wendt and Ratzenberger that “no reasonable trier of fact could find . . . them to be ‘likenesses.’ ”⁹⁶ The court further stated that a comparison of the actual robots and human beings was required to make a proper determination.⁹⁷

The circuit court additionally addressed Wendt’s and Ratzenberger’s claims of common law right of publicity and concluded that there was unquestionably “a disputed issue of material fact.”⁹⁸ Even though Paramount and Host argued that the setting and dress in which the robots appeared evoked the characters “Norm” and “Cliff,” rather than Wendt and Ratzenberger, and that “Norm” and “Cliff” were Paramount’s property, the court stated that the resemblance between Wendt’s and Ratzenberger’s human physical characteristics and those of the robots was enough to produce “a disputed issue of material fact.”⁹⁹

In its analysis of Wendt’s and Ratzenberger’s common law

⁹² *Wendt I*, 1995 U.S. App. LEXIS 5464, at *5; see also *White I*, 971 F.2d at 1399.

⁹³ *Wendt I*, 1995 U.S. App. LEXIS 5464, at *5.

⁹⁴ *Id.* at *6.

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ *Id.* at *6-*7.

⁹⁸ *Wendt I*, 1995 U.S. App. LEXIS 5464, at *6-*7.

⁹⁹ *Id.*

right of publicity claims, the Ninth Circuit scarcely considered the context in which the robots were displayed.¹⁰⁰ Although Paramount and Host discussed the setting and dress in which the robots appeared,¹⁰¹ the court itself failed to consider the robots in the context of the *Cheers* themed airport bars to determine whether plaintiffs' identities were misappropriated, as the court had considered context in the *White* case.¹⁰² Rather, the court merely mentioned that Wendt and Ratzenberger had "raised genuine issues of material fact concerning the degree to which the [robots] look[ed] like them."¹⁰³ Although conceding that Wendt and Ratzenberger had valid common law right of publicity arguments, by failing to acknowledge the context in which the robots appeared, the court's analysis of California's common law right of publicity was nearly indistinguishable from its analysis of California's statutory right of publicity. In *White*, on the other hand, the court acknowledged that the common law right of publicity was more expansive than the statutory right of publicity because "the [common law] right of publicity is not limited to the appropriation of name or likeness."¹⁰⁴ The court in *White* appreciated that the identities of celebrities are not only targets for appropriation by advertisers, but their identities are easy to appropriate by means other than name or likeness.¹⁰⁵ Thus, the law should protect a celebrity's identity which is a product of her own "energy and ingenuity" and has become a commodity because of television and media exposure.¹⁰⁶ While "the individual aspects of the advertisement in [*White*] sa[id] little," when examined in the context of the *Wheel of Fortune* game show set, there was little doubt that the advertisement meant to depict Vanna White.¹⁰⁷ The court, in *White*, concluded that the identity of

¹⁰⁰ See generally *Wendt I*, 1995 U.S. App. LEXIS 5464.

¹⁰¹ *Id.* at *7.

¹⁰² *White I*, 971 F.3d at 1399.

¹⁰³ *Wendt II*, 125 F.3d at 811.

¹⁰⁴ *White I*, 971 F.2d at 1398.

¹⁰⁵ *Id.* at 1399.

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* Although the analysis requires consideration of the context in which the alleged misappropriation occurred, in *White* and *Wendt*, the plaintiffs did not own the contexts. For example, Vanna White did not own the *Wheel of Fortune* game show set, and in *Wendt*, George Wendt and John Ratzenberger did not own the context of the *Cheers* bar setting. In fact, the contexts in those cases were subject of copyright. See *White II*, 989 F.2d at 1517 (Kozinski, J., dissenting); *Wendt II*, 125 F.3d at 811.

Vanna White had been misappropriated.¹⁰⁸ The court, in *Wendt*, failed to undertake a similar analysis.

Finally, the circuit court addressed Wendt's and Ratzenberger's claims for unfair competition under Section 43(a) of the Lanham Act.¹⁰⁹ Under this claim, Wendt and Ratzenberger would have to show that " 'Host's conduct . . . created a likelihood of confusion as to whether [Wendt and Ratzenberger] were endorsing Host's product.' " ¹¹⁰ The court analyzed the eight applicable factors to determine whether a likelihood of confusion existed.¹¹¹ The circuit court stated that because it had already determined there was a disputed issue of material fact as to the third factor, "similarity of the marks," summary judgment was inappropriate on the unfair competition claim.¹¹²

The circuit court reversed the judgment of the district court and remanded.¹¹³ On remand, the district court again granted summary judgment in favor of Host and Paramount on the claims of violations of the Lanham Act and California's statutory and common law right of publicity.¹¹⁴ The district court performed its own inspection of the robots and determined that it was unable to find any similarity between the robots "and the live persons of Mr. Wendt and Mr. Ratzenberger, . . . except that one of the robots . . . [was] heavier than the other,"—similar to the plaintiffs.¹¹⁵

Wendt and Host again appealed to the Ninth Circuit arguing that the district court had erred in finding that the robots were not likenesses of Wendt and Ratzenberger, because "likeness" does not have to be "identical or photographic," and that, in any event, the jury should make the determination rather than the court.¹¹⁶ The court performed its own inspection of the robots and found that material issues of fact existed concerning the degree of likeness between the plaintiffs and the robots, and thus reversed the grant of summary judgment on the claim of right of publicity under Section 3344.¹¹⁷

¹⁰⁸ *White I*, 971 F.2d at 1399.

¹⁰⁹ *Wendt II*, 125 F.3d at 812. See *supra* text accompanying note 26.

¹¹⁰ *Id.* (quoting *Wendt I*, 1995 U.S. App. LEXIS 5464, at *7).

¹¹¹ *Id.* at 812-14 (citations omitted).

¹¹² *Wendt I*, 1995 U.S. App. LEXIS 5464, at *7-*8.

¹¹³ *Id.* at *8.

¹¹⁴ *Wendt II*, 125 F.3d at 808-09.

¹¹⁵ *Id.* at 809.

¹¹⁶ *Id.*

¹¹⁷ *Id.* at 809-10.

The circuit court also reaffirmed that federal copyright law did not preempt Wendt's and Ratzenberger's right of publicity claims.¹¹⁸ It noted that Wendt and Ratzenberger were not attempting to bar Paramount from exhibiting its copyrighted work, but rather preventing the invasion of their personal rights.¹¹⁹

On the issue of California's common law right of publicity, Host and Paramount argued that the robots depicted the "identities of the characters Norm and Cliff, to which Paramount owns the copyrights, [rather than] the identities of Wendt and Ratzenberger, who merely portrayed those characters on television and retain[ed] no licensing rights to them."¹²⁰ They further argued that Wendt and Ratzenberger could not base their misappropriation of identity claims on "indicia, such as the *Cheers* bar sett[ing], [which was] the property of, or licensee of, a copyright owner."¹²¹ Wendt and Ratzenberger agreed that they had no rights to the characters "Norm" and "Cliff," but maintained that Paramount's copyright of the characters "Norm" and "Cliff" did not encompass the robots named "Hank" and "Bob," and that the "physical likeness to Wendt and Ratzenberger, not Paramount's characters [was the] commercial value to Host."¹²² Wendt's and Ratzenberger's argument suggests that in order for Paramount to have had copyright protection over the robots, the robots should have remained named "Norm" and "Cliff" and born a greater likeness to their fictional personae as developed by Paramount rather than more general characteristics.

The circuit court observed that while Wendt's and Ratzenberger's fame arose largely due to their participation in the television show *Cheers*, they did not lose their right to prevent commercial exploitation of their likenesses by portraying the characters "Norm" and "Cliff."¹²³ The court reiterated that Wendt and Ratzenberger had "raised genuine issues of material fact" regarding the degree of likeness between the robots and plaintiffs.¹²⁴ The court stated that a jury had to ultimately decide whether defendants commercially exploited

¹¹⁸ *Id.* at 810.

¹¹⁹ *Wendt II*, 125 F.3d at 810 (citing *Wendt I*, 1995 U.S. App. LEXIS 5464, at *2).

¹²⁰ *Id.* at 811.

¹²¹ *Id.* (citing *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 716 (9th Cir. 1970)).

¹²² *Id.*

¹²³ *Id.*

¹²⁴ *Wendt II*, 125 F.3d at 811.

the likenesses of Wendt and Ratzenberger for their own financial gain and, therefore, reversed the grant of summary judgment on the common law right of publicity claim.¹²⁵

Again, the court failed to consider the context of the robots in the airports' *Cheers* bars when analyzing Wendt's and Ratzenberger's claims of violation of their common law right of publicity. Rather than considering whether plaintiffs' identities had been misappropriated, the court merely stated that the issue to be addressed was whether the defendants had commercially exploited plaintiffs' likenesses.¹²⁶ While the court acknowledged that plaintiffs had a valid claim under common law right of publicity, the court failed to state that the analysis should consider the plaintiffs' likenesses within the context of the *Cheers* themed settings. When considering the robots within the context of the *Cheers* settings, there is a greater possibility of finding a misappropriation of the plaintiffs' likenesses than if the robots were considered in isolation; plaintiffs would have a greater chance of prevailing under their common law right of publicity claims.¹²⁷ Therefore, the court unwittingly reduced plaintiffs' chances of success on these claims.¹²⁸

Wendt and Ratzenberger also appealed the district court's granting of summary judgment to Host and Paramount on their claims of violations of Section 43(a) of the Lanham Act.¹²⁹ The Ninth Circuit observed that, on remand, the district court merely "compared the robots with [Wendt and Ratzenberger] in the courtroom and" did not find any similarity.¹³⁰ The circuit court found that the district court erred by failing to analyze any of the other factors needed to determine the "likelihood of confusion [among] consumers

¹²⁵ *Id.* at 811-12; see also *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 349 (Cal. Ct. App. 1983) ("The first step toward selling a product or service is to attract the consumer's attention. Because of a celebrity's audience appeal, people respond almost automatically to a celebrity's name or picture.").

¹²⁶ *Wendt II*, 125 F.3d at 811.

¹²⁷ See, e.g., *Wendt I*, 1995 U.S. App. LEXIS 5464, at *4-*5 (stating that when the robot in *White* was examined in isolation, it was not the "likeness" of Vanna White according to Section 3344, but when considered in the context of the game show setting, there was a "material issue of fact as to whether the defendants had appropriated plaintiff's identity within the meaning of the California common law right of publicity.").

¹²⁸ This conclusion is based on the supposition that the Ninth Circuit's analysis in *White* was correct.

¹²⁹ *Wendt II*, 125 F.3d at 812.

¹³⁰ *Id.*

as to whether [Wendt and Ratzenberger] sponsored, approved of, or were otherwise associated with the Cheers bar[.]”¹³¹

The circuit court analyzed the factors to determine whether a likelihood of confusion existed.¹³² The court observed that as to the first factor—strength of each plaintiff’s mark—in situations involving celebrities, the mark refers to the “celebrity’s persona and the strength of the mark refers to the level of recognition the celebrity enjoys.”¹³³ The court found that because Wendt and Ratzenberger were the primary players on *Cheers*, they were unmistakably well-known among the target customers of Host’s *Cheers* bars; thus, a reasonable jury could conclude that their mark was strong.¹³⁴ However, the court’s analysis of this first factor is problematic. The court, when determining the strength of plaintiffs’ marks, considered the mark to be Wendt and Ratzenberger relative to their roles as “Norm” and “Cliff” on *Cheers*.¹³⁵ Thus, the court did not consider the plaintiffs’ mark as being their human identities, but rather their identities as the fictional characters “Norm” and “Cliff.” Under such an analysis, one could question whether the mark of “Norm” and “Cliff” was really a mark belonging to plaintiffs or belonging to Paramount, the copyright holder of the characters “Norm” and “Cliff.” If the mark actually belonged to Paramount, then plaintiffs’ claim of violation under the Lanham Act would fail. Alternatively, it could be argued that because Wendt and Ratzenberger had expended so much of their effort and talent developing the characters “Norm” and “Cliff,” the mark was also very much their own.¹³⁶

This distinction is clearer within the Ninth Circuit’s analysis of this first factor in *Downing v. Abercrombie*.¹³⁷ In *Downing*, defendant Abercrombie & Fitch, a clothing outfitter, distributed advertising catalogs of its merchandise; including a photograph of the plaintiffs, professional surfers, which had been published without their permis-

¹³¹ *Id.*

¹³² *Id.* at 812-14.

¹³³ *Id.* at 812 (citing *White I*, 971 F.2d at 1400).

¹³⁴ *Wendt II*, 125 F.3d at 812.

¹³⁵ *Id.*

¹³⁶ See *Carson*, 698 F.2d at 838-39 (Kennedy, J., dissenting) (arguing that because the phrase “Here’s Johnny” was merely associated with Johnny Carson and was not part of an identity that he created, the use of the phrase did not violate his right of publicity).

¹³⁷ 265 F.3d 994 (9th Cir. 2001).

sion.¹³⁸ The court acknowledged that plaintiffs' names and images were highly recognizable among society, and that as "legendary surfers, . . . there [was] a reasonable inference that [the plaintiffs] would be known" by those buying from the catalogs.¹³⁹ In the case of *Downing*, the celebrity plaintiffs' marks referred to their personal identities as famous surfers.¹⁴⁰ Similarly, in the case of *White*, the court noted, when analyzing the first factor, that Vanna White was "well-known" to the public, the audience targeted by the advertisement.¹⁴¹ Again, in *White*, the celebrity plaintiff's mark referred to plaintiff Vanna White's personal identity, rather than to any fictional identity. However, in *Wendt*, the marks could refer to more than one identity. The marks could refer to either "Norm" and "Cliff," the fictional characters as portrayed by Wendt and Ratzenberger, or to Wendt and Ratzenberger, as actors who had portrayed these fictional characters. Thus, the analysis of the first factor in cases involving celebrity plaintiffs, in which the plaintiffs' identities are linked to their portrayal of a fictional character, is not nearly as clear cut as in cases involving celebrity plaintiffs whose identities are not intermingled with identities of fictional characters.

The court next found that the second factor, relatedness of the goods, also weighed in plaintiffs' favor because plaintiffs' goods, their skill and fame as actors, were "obviously related to Host's 'goods,' " which were the *Cheers* bars and the products sold in them, "even if they [were] not strictly competitive."¹⁴² The court noted that the source of both plaintiffs' and Host's fame was the same: the *Cheers* television show.¹⁴³ A jury could conclude that a customer would "be confused as to the nature of Wendt's and Ratzenberger's association with Host's *Cheers* bars and the goods sold there."¹⁴⁴

With respect to the third factor, the similarity of the marks, the court concluded that a reasonable jury might find that this factor weighed in Wendt's and Ratzenberger's favor, because they had raised triable issues of material fact regarding "the degree to which

¹³⁸ *Id.* at 1000.

¹³⁹ *Id.* at 1008.

¹⁴⁰ *Id.*

¹⁴¹ *White I*, 971 F.2d at 1400.

¹⁴² *Wendt II*, 125 F.3d at 812-13.

¹⁴³ *Id.* at 813.

¹⁴⁴ *Id.*

the robots resemble[d] the appellants.”¹⁴⁵ The court noted that an *in camera* inspection was insufficient under the Lanham Act, and that “the district court must view the marks ‘as they appear in the marketplace.’ ”¹⁴⁶ The court also found that plaintiffs offered evidence from which a reasonable jury might infer actual consumer confusion—the fourth factor.¹⁴⁷ Wendt and Ratzenberger offered evidence that they had been approached by various people who remarked on the resemblance between Wendt and Ratzenberger and the robots in the airport bars.¹⁴⁸ Additionally, the circuit court determined that survey evidence of consumer confusion submitted by Wendt and Ratzenberger, which had been rejected by the district court, “should not have been excluded.”¹⁴⁹ The circuit court found the district court’s refusal to admit the survey evidence to be an abuse of discretion, noting that as long as the surveys were “conducted according to accepted principles, . . . [c]hallenges to the survey[s]’ methodolog[ies]” went to the weight given them rather than their admissibility.¹⁵⁰

The court’s analysis of the similarity of the marks, like its consideration of ownership under the first factor, confused the personae at issue. Plaintiffs’ evidence, that members of the public remarked on the resemblance between Wendt and Ratzenberger and the robots in the airport bars, did not identify whether those members of the public noted the similarity between the robots and Wendt and Ratzenberger as themselves, or the robots’ similarity to “Norm” and “Cliff” as portrayed by Wendt and Ratzenberger. If the similarity between the robots and Wendt and Ratzenberger was based upon a resemblance to “Norm” and “Cliff,” rather than to the human beings Wendt and Ratzenberger, then plaintiffs should not prevail on this factor, because the similarity was based on a likeness to Paramount’s copyrighted characters rather than Wendt’s and Ratzenberger’s personal identities.

Moreover, the circuit court found that “[t]he fifth factor, marketing channels used, weigh[ed] in [Wendt’s and Ratzenberger’s] fa-

¹⁴⁵ *Id.*

¹⁴⁶ *Id.* (quoting *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1291 (9th Cir. 1992)).

¹⁴⁷ *Wendt II*, 125 F.3d at 813.

¹⁴⁸ *Id.*

¹⁴⁹ *Id.*

¹⁵⁰ *Id.* (citing *E. & J. Gallo Winery*, 967 F.2d at 1291; *Prudential Ins. Co. of Am. v. Gibraltar Fin. Corp.*, 694 F.2d 1150, 1156 (9th Cir. 1982)).

vor.”¹⁵¹ The court noted a similarity in marketing channels because Host targeted fans of the *Cheers* television show as customers for its bars.¹⁵² In addition, the court found that “[t]he sixth factor, likely degree of purchaser care, weigh[ed] in favor of appellants.”¹⁵³ The court stated that consumers were not expected to be careful in determining who endorsed or was affiliated with an airport bar where they may purchase a beverage.¹⁵⁴ Further, it would be most unlikely that consumers would analyze the source of robots, which were not for sale and were merely used to attract customers to the bars.¹⁵⁵ The court cited its decision in *White*, in which it stated that “consumers are not likely to be particularly careful in determining who endorses VCRs, making confusion as to their endorsement more likely.”¹⁵⁶ Again, this analysis is faulty. The court did not discuss whether the consumers believed that the endorsement of the airport bars was an endorsement by Wendt and Ratzenberger as individuals, or as the *Cheers* characters “Norm” and “Cliff,” in which case the endorsement stemmed from Paramount. In fact, if consumers were not likely to analyze the source of the robots, one could just as easily argue that consumers believed the source of the endorsement to be the copyright holder of the fictional characters “Norm” and “Cliff” and not the individuals Wendt and Ratzenberger.

Upon analyzing the seventh factor, defendant’s intent in selecting the mark, the court found that Wendt and Ratzenberger had alleged facts, from which it could be inferred that Host was attempting to confuse customers as to sponsorship or endorsement of the *Cheers* bars.¹⁵⁷ Wendt and Ratzenberger had submitted evidence to show that Host intentionally designed the robots to resemble the plaintiffs, and that Host knew that the association with Wendt and Ratzenberger “was a major drawing card of the ‘Cheers’ concept.”¹⁵⁸ Moreover, after Wendt and Ratzenberger refused to grant right of publicity licenses to Host, “Host altered the robots cosmetically” and renamed them from “Cliff” and “Norm” to “Hank” and “Bob,” re-

¹⁵¹ *Id.*

¹⁵² *Wendt II*, 125 F.3d at 813.

¹⁵³ *Id.*

¹⁵⁴ *Id.*

¹⁵⁵ *Id.*

¹⁵⁶ *Wendt I*, 971 F.2d at 1400.

¹⁵⁷ *Wendt II*, 125 F.3d at 813.

¹⁵⁸ *Id.*

spectively, but would not recast the robots as a “friendly neighborhood couple” as suggested by Paramount.¹⁵⁹ Thus, the court determined that it could be inferred that Host intentionally exploited Wendt’s and Ratzenberger’s fame by maintaining a similarity between the robots and Wendt and Ratzenberger.¹⁶⁰ Nonetheless, by failing to differentiate between the human personae of Wendt and Ratzenberger and the fictional personae of “Norm” and “Cliff,” the court did not consider that Host’s use of the fictional characters “Norm” and “Cliff” based upon a license from Paramount was not an exploitation of Wendt and Ratzenberger as individuals, but rather a proper use of their license to portray the characters “Norm” and “Cliff” in their *Cheers* themed airport bars. Host may very well have designed the robots to look like Wendt and Ratzenberger, not as their human personae, but as the identically featured fictional personae of “Norm” and “Cliff,” without any intention to create consumer confusion.

Finally, the court found that the eighth factor, likelihood of expansion of the product lines, weighed in Wendt’s and Ratzenberger’s favor.¹⁶¹ The court quoted *AMF, Inc. v. Sleekcraft Boats*, as stating that “ ‘[i]nasmuch as a trademark owner is afforded greater protection against competing goods, a ‘strong possibility’ that either party may expand his business to compete with the other will weigh in favor of finding that the present use is infringing.’ ”¹⁶² Ratzenberger had submitted evidence that he was inclined “to appear in advertisements for beer.”¹⁶³ Consequently, the court found that because Ratzenberger’s potential future “endorsement[s] of [] beers would be confused with his alleged endorsement of the beers sold at Host’s [airport] bars,” this factor weighed in his favor.¹⁶⁴ Once again, by failing to consider which personae were at issue, the analysis of the likelihood of expansion of the product lines factor came up short. Had Host intended to utilize the fictional rather than human personae of Wendt and Ratzenberger, then the endorsement of the beers sold at Host’s airport bars would have been the endorsement of Paramount

¹⁵⁹ *Id.*

¹⁶⁰ *Id.*

¹⁶¹ *Id.* at 814.

¹⁶² *Wendt II*, 125 F.3d at 814 (quoting *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 354 (9th Cir. 1979)).

¹⁶³ *Id.*

¹⁶⁴ *Id.*

and Host, the owners and licensees of the fictional personae of "Norm" and "Cliff." Thus, Ratzenberger's future endorsement of beer would have been unaffected. Nonetheless, the circuit court ultimately concluded that a jury could reasonably find "that most of the factors weigh[ed] in appellants' favor and that Host's alleged conduct create[d] at least the likelihood of consumer confusion," and that a jury should determine whether appellants' Lanham Act claim should prevail.¹⁶⁵

In summary, the court's analysis of Wendt's and Ratzenberger's claims of unfair competition under the Lanham Act contained many flaws. An unfair competition claim arises when a celebrity's persona is used, causing confusion as to whether the celebrity endorsed defendant's product.¹⁶⁶ In *Wendt*, when analyzing plaintiffs' unfair competition claims, the court failed to differentiate between the human personae of Wendt and Ratzenberger, and their fictional personae as "Norm" and "Cliff."¹⁶⁷ Each factor, as analyzed by the Ninth Circuit, considered Wendt and Ratzenberger in their roles as "Norm" and "Cliff." However, these fictional personae that were identified as the marks were arguably the property of Host and Paramount under copyright law, rather than the property of Wendt and Ratzenberger. Had the court analyzed these factors by considering Wendt and Ratzenberger as individuals in their own human capacity, the result may have been quite the opposite. Thus, the court's analysis of plaintiffs' unfair competition claims was flawed.

IV. LANDHAM V. LEWIS GALOOB TOYS, INC.

While there are many right of publicity claims asserted by celebrities in the circuit courts,¹⁶⁸ there are surprisingly few asserted by

¹⁶⁵ *Id.* While other circuits have analyzed the likelihood of confusion as a question of law, or as a mixed question of both fact and law, the Ninth Circuit analyzes it as a question of fact. See *Quicksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 759 (9th Cir. 2006).

¹⁶⁶ *White II*, 989 F.2d at 1514-15 n.17 (Kozinski, J., dissenting).

¹⁶⁷ *Wendt II*, 125 F.3d at 809.

¹⁶⁸ See, e.g., *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (involving a race car driver); *Carson*, 698 F.2d 831 (involving a talk show host); *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407 (9th Cir. 1996) (involving a professional basketball player); *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (involving a singer); *White I*, 971 F.2d 1395 (involving a game show hostess); *Downing*, 265 F.3d 994 (involving professional surfers); *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905 (7th Cir. 2005) (involving a model); *Facenda, Inc.*, 542 F.3d 1007 (involving a sports broadcaster).

plaintiffs who are actors seeking to protect their personal identities relative to a fictional role they portrayed.¹⁶⁹ Subsequent to *Wendt*, the Sixth Circuit decided *Landham v. Lewis Galoob Toys, Inc.*,¹⁷⁰ in which the plaintiff, Landham, had portrayed the role of “Billy” in Fox’s movie *Predator*.¹⁷¹ Fox licensed the right to produce toys based upon the movie *Predator* to toy manufacturer Galoob.¹⁷² One of the toys was a “Billy” action figure.¹⁷³ Though the figure was only 1.5 inches tall, had no mouth or eyes, and showed no similarity to Landham, Landham claimed that the toy violated both his right of publicity and the Lanham Act.¹⁷⁴ Galoob argued that Landham’s claim was preempted by the Copyright Act because the movie *Predator* was protected by copyright.¹⁷⁵ However, the court determined that because Landham claimed that Galoob’s toys evoked his personal identity to his financial detriment, his claim involved a right separate from those protected by copyright law, because copyright law does not protect a personal identity, and thus would not be preempted.¹⁷⁶

Upon analyzing Landham’s claim that the defendants had violated his right of publicity, the court acknowledged that in right of publicity situations, a plaintiff must show that his identity was associated with the item in commerce, and that the association had a commercial value.¹⁷⁷ The court suggested that the mere misappropriation of the plaintiff’s identity might itself indicate that the association had a commercial value.¹⁷⁸ In Landham’s case, the court found that Landham had not submitted evidence to show that the use of his personal identity in association with the toy had a significant commercial value.¹⁷⁹ Further, the court stated that Landham’s “argument

¹⁶⁹ See, e.g., *Lugosi*, 603 P.2d 425; *McFarland*, 14 F.3d 912; *Wendt I*, 1995 U.S. App. LEXIS 5464; *Landham*, 227 F.3d 619.

¹⁷⁰ *Landham*, 227 F.3d 619.

¹⁷¹ *Id.* at 621.

¹⁷² *Id.* at 622.

¹⁷³ *Id.*

¹⁷⁴ *Id.*

¹⁷⁵ *Landham*, 227 F.3d at 623. Implicit in this argument was that Fox had the right to create derivative works, including Galoob’s toys, based upon its copyright ownership of the movie *Predator*.

¹⁷⁶ *Id.* at 623 (citations omitted).

¹⁷⁷ *Id.* at 624.

¹⁷⁸ *Id.*

¹⁷⁹ *Id.*

[that Galoob's use of his identity was sufficient evidence of a commercial value] assumes that by identifying its toy as 'Billy,' Galoob has evoked Landham's identity in the public mind," and that assumption of identification would not be enough to sustain a right of publicity claim.¹⁸⁰ Thus, the court found that Landham had not shown that his personal identity had significant commercial value, or that the toy had even evoked his personal identity.¹⁸¹

The Sixth Circuit discussed the difficulty a court faces in ascertaining the point at which the identity of an actor's human persona has become so similar to that of his fictional persona, that the actor has a valid claim against the exploitation of his fictional persona.¹⁸² The court emphasized that even though an actor may have obtained his fame solely through the portrayal of his fictional character, if the public nevertheless identifies the actor with his fictional character, then the actor has a claim for violation of his right of publicity.¹⁸³ The Sixth Circuit observed that courts tend to protect plaintiffs' personae only when their human personae have become inseparable from their fictional personae in the public's outlook.¹⁸⁴ Although the court in *Landham* cited the case of *Wendt* to support this assertion, the previous discussion in section III of this Comment suggests that courts have been unable or unwilling to determine whether such "inseparability" exists.¹⁸⁵

The Sixth Circuit in *Landham* also pointedly refused to apply the analysis of *White*, finding it a deviation from the rule that right of publicity cases should focus on the actor's human persona rather than the actor's fictional persona.¹⁸⁶ The *Landham* court declared that while the robot in *White* did not have similar facial features to Vanna White's, because the robot was wearing a blond wig and comparable clothing and jewelry to White's typical attire, and because the robot was turning game board letters in a similar manner as White, those factors, when observed collectively, evoked White's personal identity, even though they would not when individually observed.¹⁸⁷ The

¹⁸⁰ *Landham*, 227 F.3d at 624.

¹⁸¹ *Id.* at 624.

¹⁸² *Id.*

¹⁸³ *Id.* at 625.

¹⁸⁴ *Id.*

¹⁸⁵ *Landham*, 227 F.3d at 625.

¹⁸⁶ *Id.* at 626.

¹⁸⁷ *Id.* at 625.

Landham court explicitly disapproved of the *White* court's analysis, which considered the entire context in which the possible misappropriation occurred.¹⁸⁸ It would seem that the *Landham* court failed to recognize that the *White* court undertook separate analyses for the statutory and common law right of publicity claims, and that observing the entire context in which the alleged misappropriation occurred was part of its common law right of publicity analysis.¹⁸⁹ In fact, even though the *Landham* court observed that the right of publicity is both a common law right and statutory right in Kentucky,¹⁹⁰ it never differentiated between the two in its own analysis. While the court additionally recognized that "case law on [the right of publicity] is exceedingly rare, both in Kentucky and nationwide, and because of the general constitutional policy of maintaining uniformity in intellectual property laws, courts typically give attention to the entire available body of case law when deciding right of publicity cases,"¹⁹¹ the court nevertheless chose not to follow the common law right of publicity analysis utilized by the court in *White*. As a result, the court failed to consider whether the "Billy" toy could, in fact, evoke Landham's personal identity when all of the aspects of the toy were considered collectively. For example, it may have been possible that the public had identified Landham's personal identity, because the toy was named "Billy," and perhaps was dressed in similar clothing to Landham's, had similar hair, and was packaged and sold as part of a series of *Predator* movie toys.¹⁹² Nonetheless, the Sixth Circuit stated that it would not "give every individual who appears before a television or movie camera, . . . the right . . . to compensation for every subtle nuance that may be taken by someone as invoking his identity without [proof of] significant commercial value and identi-

¹⁸⁸ *Id.* at 626.

¹⁸⁹ Just as the *White* court stated that California's statutory right of publicity was limited to the appropriation of name or likeness, Kentucky's statutory right of publicity is limited to the appropriation of name, likeness or "some element of an individual's personality." See KY. REV. STAT. ANN. § 391.170(1) (Baldwin 2009). The *Landham* court noted that Kentucky courts have not identified the right's specific elements of proof. *Landham*, 227 F.3d at 623 (citing *Cheatham v. Paisano Publications, Inc.*, 891 F. Supp. 381, 385 (W.D. Ky. 1995)).

¹⁹⁰ *Landham*, 227 F.3d at 623.

¹⁹¹ *Id.* at 622 (internal citations omitted).

¹⁹² The additional facts about the appearance of the toy, such as the toy's clothing and hair, were not provided in the case of *Landham*, and, thus were hypothesized for purposes of this Comment's analysis.

fiability.”¹⁹³

The Sixth Circuit also held that Landham had not proved his federal Lanham Act claim.¹⁹⁴ Upon applying the “eight-factor test for determining likelihood of confusion,”¹⁹⁵ the court found that as to the first factor, the strength of the plaintiff’s mark, because Landham’s prior work was geared towards adults, and he had not produced evidence that his name was recognizable among children, his mark did not seem to have any particular strength among the toy-buying public.¹⁹⁶ Unfortunately, this analysis fails to account for the fact that adults are usually the purchasers of toys for children, and that because Landham’s prior work was geared towards adults,¹⁹⁷ it is just as likely that the adult consumers would recognize him, and that his mark did, in fact, have strength.

Furthermore, the court found that the factors: similarity of the marks; defendant’s intent in selecting the mark; and, likelihood of expansion of the product lines weighed against Landham, though the court did not provide its reasoning.¹⁹⁸ On the other hand, the court found that the factors: relatedness of the goods; marketing channels used; and, likely degree of purchaser care weighed in Landham’s favor.¹⁹⁹ Again, however, the court did not provide its reasoning. The court concluded with its subjective determination that Landham had not shown any likelihood of confusion that he had endorsed Galoob’s toy.²⁰⁰ The conclusory treatment of Landham’s claim of violation of the Lanham Act may indicate that when actors assert this type of claim, the court’s perfunctory analysis could lead to an arbitrary result.

¹⁹³ *Landham*, 227 F.3d at 626.

¹⁹⁴ *Id.* at 627.

¹⁹⁵ *Id.*

¹⁹⁶ *Id.* at 626-27.

¹⁹⁷ *Id.* at 621 (stating that Landham had acted in numerous pornographic movies, in addition to acting in the movies *48 Hours*, *Action Jackson*, and *Maximum Force*).

¹⁹⁸ *Landham*, 227 F.3d. at 627.

¹⁹⁹ *Id.*

²⁰⁰ *Id.*

V. APPLYING A TRADEMARK MODEL TO CASES INVOLVING COPYRIGHT LAW AND THE RIGHT OF PUBLICITY

In *Wendt*, the Ninth Circuit had to decide whether Paramount and Host should be allowed, based on copyright ownership, to use robots derived from the characters “Norm” and “Cliff,”²⁰¹ or whether George Wendt and John Ratzenberger could prevent the use because the right of publicity prohibited the unauthorized exploitation of their likenesses.²⁰² Ultimately, the court did not analyze whether Paramount and Host should prevail on their copyright claims because it found that copyright law did not preempt Wendt’s and Ratzenberger’s successful right of publicity claims.²⁰³ However, it is questionable whether defendants’ copyright claims should have been dismissed entirely. Fairness dictates weighing both plaintiffs’ right of publicity claims and defendants’ copyright claims. Moreover, it seems that Paramount and Host were unfairly denied the right to use the robots. It is arguable that because Paramount owned copyrights in the characters “Norm” and “Cliff,” Paramount should have been able to license to Host the right to create robots and place them in airport restaurants, regardless of the robots’ similarity to “Norm” and “Cliff” as well as to George Wendt and John Ratzenberger.²⁰⁴ Because the court found that right of publicity was not preempted by federal copyright law,²⁰⁵ Paramount and Host were prevented from exercising their exclusive right to license²⁰⁶ and prepare derivative works as guaranteed by copyright law.²⁰⁷ Thus, it is evident that whenever a copyright of a celebrity’s fictional persona is involved, the copyright holder will sacrifice many of the rights guaranteed by

²⁰¹ *Wendt I*, 1995 U.S. App. LEXIS 5464, at *7.

²⁰² *Wendt II*, 125 F.3d at 809.

²⁰³ *Wendt I*, 1995 U.S. App. LEXIS 5464, at *2, *6; *Wendt II*, 125 F.3d at 811.

²⁰⁴ Though Host changed the robots names to “Hank” and “Bob” after Wendt and Ratzenberger refused to grant right of publicity licenses, it is arguable that naming the robots “Norm” and “Cliff” would have strengthened defendants’ argument under copyright law that the robots were a derivative work. See *Wendt II*, 125 F.3d at 813 (citing *Sinatra*, 435 F.2d at 716).

²⁰⁵ *Id.* at 810.

²⁰⁶ *White II*, 989 F.2d at 1517-18 (Kozinski, J., dissenting).

²⁰⁷ 17 U.S.C.A. § 106(2); see also *Wendt v. Host Int’l, Inc. (Wendt III)*, 197 F.3d 1284, 1286. (9th Cir. 1999) (Kozinski, J., dissenting) (arguing that the use of the robots in the *Cheers* bars was a derivative work “just like a TV clip, promotion, photograph, poster, sequel or dramatic rendering of an episode”).

copyright law because of the celebrity's right of publicity. This outcome undercompensates the copyright owner. While a celebrity's identity and likeness are protected by the right of publicity, this result tends to undermine the copyright owners' incentive to expend time, money, and creativity in developing fictional characters if they are unable to benefit further from the fruits of their labor.

However, a competing argument can be made for protecting a celebrity's right of publicity. A celebrity expends significant time, effort, and talent in creating unique fictional characters. As noted by Chief Justice Bird, in his dissenting opinion in *Lugosi*, celebrities' "professional and economic interests in controlling the commercial exploitation of their likenesses while portraying [their] characters are identical to their interests in controlling the use of their own 'natural' likenesses."²⁰⁸ Further, Chief Justice Bird noted that because a celebrity focuses on the development of a character for his profession, extending protection to the celebrity's character might be more important to the celebrity than protecting his own "natural" appearance.²⁰⁹

In the case of *Wendt*, in which robots that looked like Wendt and Ratzenberger also resembled the characters "Norm" and "Cliff," the question became, whose intellectual property should be protected? Should Paramount, the copyright holder of the fictional characters "Norm" and "Cliff," or Wendt and Ratzenberger, the owners of the individual identities prevail?²¹⁰ Perhaps, putting aside the preemption issue, the answer can be found in trademark law, which focuses on *source*.²¹¹ "The purpose of a trademark is to identify and distinguish the goods of one party from those of another."²¹² If the goal of trademark law is to identify and distinguish goods, trademark analyses may determine whose goods were implicated by the use of the robots in *Wendt*. Applying the analyses and reasoning found in trademark infringement cases to this type of situation may provide a more equitable result.

²⁰⁸ 25 Cal. 3d at 844 (Bird, C. J., dissenting).

²⁰⁹ *Id.*

²¹⁰ Ideally, the parties involved should provide for this contingency in their contract.

²¹¹ *Colt Def. L.L.C. v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 705 (1st Cir. 2007) (emphasis added).

²¹² *Id.*

A. Distinctiveness Analysis

One possible approach to reconciling competing claims of copyright protection and right of publicity would be to borrow from trademark law's "distinctiveness analysis."²¹³ Under trademark law, a mark is protectable when it either is "sufficiently distinctive or has acquired secondary meaning."²¹⁴ To determine whether a mark is distinctive, the court categorizes it as either: "[G]eneric, descriptive, suggestive, arbitrary or fanciful."²¹⁵ The level of protection of a mark depends on the category into which it falls.²¹⁶

The first category consists of generic terms, which receive no protection because they are the least distinctive and unable to distinguish between the goods of different producers.²¹⁷ A generic term can be said to "identify the nature of the good, rather than [the] source."²¹⁸ The second category consists of descriptive terms, which describe characteristics or qualities of a good, and are not protectable unless they acquire secondary meaning.²¹⁹ The third category consists of suggestive terms, which suggest, rather than describe, a characteristic of a good.²²⁰ A suggestive term requires no proof of secondary meaning in order to receive trade name protection.²²¹ The fourth and fifth categories, "arbitrary or fanciful term[s], bear[] no relationship to the product or service and [are] also protectable without proof of secondary meaning."²²²

Adapting this analysis to a copyright or right of publicity situation, there could be categories of uses for which protection would fall either with the copyright holder or with the actor depending upon the use of the likeness. Although it is understood that in the copyright/right of publicity circumstances, the likeness of the individual in

²¹³ *Security Ctr., Ltd. v. First Nat'l Security Ctrs.*, 750 F.2d 1295, 1298 (5th Cir. 1985) (citing *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 425 (5th Cir. 1984)).

²¹⁴ *Id.* (citing *Sicilia Di R. Biebow*, 732 F.2d at 425).

²¹⁵ *Id.*

²¹⁶ *Id.*

²¹⁷ *Colt*, 486 F.3d at 705.

²¹⁸ *Id.* (citing 15 U.S.C. § 1064(3); *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 641 (Fed. Cir. 1991)).

²¹⁹ *Vision Ctr. v. Opticks, Inc.*, 596 F.2d 111, 115 (5th Cir. 1979).

²²⁰ *Id.*

²²¹ *Id.* at 116.

²²² *Id.*

question is already protected under both copyright by the copyright holder, and under the right of publicity by the actor, the analytical framework for trademark protection would be beneficial to resolving the competing claims and determining the prevailing party.

Hence, adapting the generic category to the copyright/right of publicity situation would confer protection on a celebrity under right of publicity, and the copyright holder would receive no protection under copyright law if the copyright holder's use of that celebrity's likeness was generic. Under this theory, rather than the generic mark's not having a source, its source would be the celebrity. In other words, the use of the likeness would be an unquestionable copying of the celebrity's identity, including his true name, appearance, and traits, without utilizing any of the celebrity's fictional characteristics. An example of a generic use in the case of Wendt would be placing the robots at a bar, naming them "George" and "John," giving them identical facial and bodily features to Wendt and Ratzenberger, and dressing them in jogging suits rather than a mailman's uniform and a business suit. This copying of Wendt's and Ratzenberger's individual rather than their fictional identities, would make the individuals George Wendt and John Ratzenberger the source of the robots because their human identity traits alone were utilized.

At the other end of the spectrum, if the use of the likeness was in a fanciful setting, like that of the copyright holder's portrayal on television, then the protected use of the likeness would lie with the copyright holder as the source of the characters. For example, robots placed in *Cheers* themed bars, wearing a mailman's uniform and a business suit, and named "Norm" and "Cliff," would be a use of the copyright holder's work, thus making the copyright holder the source. Therefore, the copyright holder's use would be protected and the celebrities would have no claim for infringement under the right of publicity.

In the middle of the spectrum would fall the descriptive and suggestive categories. For purposes of a modified copyright/right of publicity analysis, these categories could be combined and would allow the copyright holder to prevail only upon acquisition of a secondary meaning. An example of this category would be robots named "Norm" and "John," sitting at an ordinary bar, wearing a mailman's uniform and a jogging suit. In this case, the source would be difficult to identify because one robot is named for the actor but

dressed like the television character, while the other robot is named for the television character but dressed differently.

Applying these adapted categories to the *Wendt* facts, it would seem that Host's use of the likenesses of George Wendt and John Ratzenberger fell closer to the fanciful category. The setting in which the likenesses are portrayed should play an important role in determining who will receive protection of the use. In *Wendt*, the robots were placed in a mock *Cheers* setting, which was the original use of the fictional likenesses as invented by Paramount and protected under Paramount's copyright. Had Host merely placed robots bearing similar likenesses to Wendt and Ratzenberger at bench seats in the middle of their restaurants, which were not decorated like the *Cheers* setting, then it could be said that Host's use of the likenesses was more generic and protection of the likenesses should fall with Wendt and Ratzenberger. Therefore, by applying a categorical analysis of the use involved in *Wendt*, Paramount, the copyright holder of "Norm" and "Cliff," would have been the source of the use involved and should have been given protection under copyright law.

B. Dilution

Another possible method for reconciling copyright/right of publicity conflicts would be to apply a dilution analysis. The Lanham Act provides a remedy for dilution of famous and distinctive marks.²²³ The Federal Trademark Dilution Act ("FTDA") provides factors for determining whether a mark is famous, and defines "dilution by blurring" of marks as an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark."²²⁴ The factors identified by the FTDA to determine whether a mark is famous include:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties; (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark; (iii) The extent of actual recognition of the mark; [and] (iv)

²²³ See 15 U.S.C.A. § 1125(c)(1).

²²⁴ See *id.* § 1125(c)(2)(B).

Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.²²⁵

Adapting the definition of dilution of marks to the realm of copyright/right of publicity, a court would first determine whether the fictional persona created by the copyright holder is famous and distinctive, and then would determine whether there was a lessening of the capacity of the fictional persona to identify and distinguish goods or services. In other words, a copyright owner would receive protection for his distinctive and famous fictional persona unless it has become diluted.²²⁶

This analysis initially focuses on the copyright holder's mark rather than a celebrity's mark.²²⁷ Once a copyright holder has established that the mark is distinctive and famous, the mark will receive protection unless it has become diluted. Although many may argue that protection should begin with the individual actors, this approach can be justified by the fact that actors voluntarily choose to capitalize on copyright owners' creative works to further their own careers, and that if actors would like protection for their individual personae, then they should expend their own time and effort to create fictional characters and television shows.

Applying this analysis to the facts in *Wendt*, the court could first examine Paramount's marks, "Norm" and "Cliff," and apply the factors to determine whether those marks were distinctive and famous. For example, the court could note that under the second factor, Paramount's show, *Cheers*, and the characters, "Norm" and "Cliff," had been on television for eleven years,²²⁸ and that "Norm" and "Cliff" had always been integral, if not focal, parts of the program. Further, the court could acknowledge that "Norm" and "Cliff" had been portrayed only by actors George Wendt and John Ratzenberg-

²²⁵ *Id.* § 1125(c)(2)(A)(i)-(iv).

²²⁶ While the Lanham Act provides injunctive relief if a "person who, at any time after the owner's mark has become famous, commences use of a mark . . . that is likely to cause dilution . . . of the famous mark," for purposes of this analysis in the copyright/right of publicity situation, the relief will be provided for the copyright holder of the famous and distinctive mark *unless* his mark has become diluted. See 15 U.S.C.A. § 1125(c)(1).

²²⁷ In this situation, the fictional persona is the equivalent of a mark in the dilution analysis.

²²⁸ Bill Carter, *Why 'Cheers' Proved So Intoxicating*, N.Y. TIMES, May 9, 1993, at 2.

er,²²⁹ thus the likenesses of the fictional characters never changed.

The court could also take notice that under the third factor, the show had been advertised during the eleven years that it ran. In addition, the court could observe under the fourth factor that the show *Cheers* had become successfully syndicated worldwide.²³⁰ Under the fifth factor, the show *Cheers*, and the marks “Norm” and “Cliff,” were shown through the medium of television. Additionally, the degree of recognition of the marks, “Norm” and “Cliff,” on television was significant, and that because the show *Cheers* had received twenty-six Emmy Awards, its popularity was evident and thus recognition of the marks, “Norm” and “Cliff,” was exceptionally likely.²³¹ Finally, the court could discern that the characters “Norm” and “Cliff” were copyrights owned by Paramount.²³² Under this analysis, it seems apparent that Paramount’s marks, “Norm” and “Cliff,” were famous and distinctive.

After establishing that the marks were famous and distinctive, the court would then have to determine whether the marks had become diluted. In other words, the court would resolve whether there was a lessening of the capacity of the fictional personae to identify and distinguish the copyright protected goods or services. In the trademark sense, the court decides whether defendant’s use of the mark blurred its product identification or harmed positive associations attached to the mark.²³³ To do so, the court would determine whether consumers make a “mental association” with the copyright holder’s use of the mark and the other uses of the mark, and whether the other uses of the mark cause a different impression of the copyright holder’s mark.²³⁴ If so, there would be a lessening of the capacity of the copyright holder’s mark to identify and distinguish his goods or services.²³⁵

Adapting this analysis to the *Wendt* copyright/right of publici-

²²⁹ IMDB.com, Full Cast and Crew of Cheers, <http://www.imdb.com/title/tt0083399/fullcredits> (last visited Jan. 2, 2010).

²³⁰ IMDB.com, Cheers Release Dates, [http://www.imdb.com/title/tt0083399/release info](http://www.imdb.com/title/tt0083399/release%20info) (last visited Jan. 2, 2010).

²³¹ IMDB.com, Cheers Awards, <http://www.imdb.com/title/tt0083399/awards> (last visited Jan. 2, 2010).

²³² *Wendt I*, 1995 U.S. App. LEXIS 5464, at *7.

²³³ *Moseley*, 537 U.S. at 425.

²³⁴ *Id.* at 434.

²³⁵ *Id.*

ty situation, the court would ascertain whether consumers would make a mental association between Paramount's marks of "Norm" and "Cliff" and actors George Wendt and John Ratzenberger. While it is obvious that consumers would make such an association, the key question would be whether George Wendt and John Ratzenberger in any way caused a different impression of the copyright holder's mark, which would decrease the association of the marks "Norm" and "Cliff" with Paramount's show *Cheers*. The court could allow both parties to present evidence to prove whether this dilution occurred. This evidence would include whether actors Wendt and Ratzenberger had portrayed any other fictional characters on television which would cause consumers to make other associations with their personae in addition to "Norm" and "Cliff." Of course, if the consumers initially associated the robots with Wendt and Ratzenberger rather than with "Norm" and "Cliff," then copyright holder Paramount would have no claim at all.

Dilution could be observed by examining this situation with the actress Kirstie Alley, who portrayed the fictional character, "Rebecca Howe," on *Cheers*. The mark, "Rebecca," was developed five years after the show's premiere.²³⁶ Thus, the duration of the mark "Rebecca" was less than the duration of the marks "Norm" and "Cliff" and perhaps had less recognition or popularity. More importantly, Alley has portrayed other fictional characters on television and in movies, which could cause possible dilution of Paramount's mark, "Rebecca." Prior to her acting on the show *Cheers*, Alley had performed in a supporting role in the movie *Star Trek 2: The Wrath of Khan*; had co-starred in a television series called *Masquerade*; and had acted in the acclaimed miniseries *North and South*.²³⁷ After portraying "Rebecca" on *Cheers*, Alley went on to act in movies *Look Who's Talking*, *Look Who's Talking Too*, *Look Who's Talking Now* and in the television show *Veronica's Closet*.²³⁸ Of course, the analysis of dilution would occur at the time that the claimed infringement occurred. So, in the case of Alley, the court would examine the characters that Alley depicted prior to her role as "Rebecca," and any

²³⁶ IMDB.com, Full Cast and Crew for *Cheers*, <http://www.imdb.com/title/tt0083399/fullcredits> (last visited Jan. 2, 2010).

²³⁷ IMDB.com, Kirstie Alley, <http://www.imdb.com/name/nm0000263/> (last visited Jan. 2, 2010).

²³⁸ *Id.*

subsequent roles she acted in until the time of infringement, to determine whether those roles caused dilution of the mark "Rebecca."

In the case of Alley, it is easier to see that consumers may not immediately associate the mark "Rebecca" with the show *Cheers*, because Alley's success in other television shows and movies has caused her persona to be identified with marks other than "Rebecca." Because this dilution occurs when actors become successful in avenues other than their roles as the copyright protected marks, the result is fair to both the copyright holders and the actors. If an actor has capitalized on a single role of a copyright protected fictional character, then the actor's career has developed at the expense of the copyright holder's creativity in inventing that character. On the other hand, if an actor is chosen to portray a copyright protected fictional character, and has achieved fame from activities independent of the role of the fictional character, then the copyright holder has capitalized on the actor's fame and talent to advance its own television show.²³⁹ This analysis ultimately rewards either the copyright holder or the individual actor, depending upon who has created the greatest opportunity for the advancement of the other's goods, whether those goods are the actor's talent and fame, or the television show's popularity.

C. Secondary Meaning

Trademark law provides protection for descriptive marks that have acquired secondary meaning.²⁴⁰ Secondary meaning occurs when widespread advertising creates for consumers a connection between the mark and its source.²⁴¹ A plaintiff must establish that a secondary meaning existed at the time that the defendant began to use the mark.²⁴² An example of some factors to be considered in a secondary meaning analysis would include:

- (1) the extent of sales and advertising leading to buyer association;
- (2) length of use;
- (3) exclusivity of use;
- (4) the fact of copying;
- (5) customer surveys;
- (6) cus-

²³⁹ This statement is equally applicable to other media besides television.

²⁴⁰ *Vision Ctr.*, 596 F.2d at 115.

²⁴¹ *Vista India v. Raaga, L.L.C.*, 501 F. Supp. 2d 605, 618 (D.N.J. 2007) (citing *Commerce Nat'l Ins. Servs, Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 438 (3d Cir. 2000)).

²⁴² *Id.* (citing *Commerce Nat'l Ins. Servs, Inc.*, 214 F.3d 432, 438).

tomers testimony; (7) the use of the mark in trade journals; (8) the size of the company; (9) the number of sales; (10) the number of customers; and (11) actual confusion.²⁴³

As discussed previously, in the situation of copyright/right of publicity conflicts, descriptive marks would be those marks that fall in a category in between generic and fanciful.²⁴⁴ The source of these marks would be difficult to identify because both the individual actor's personal attributes and the fictional character's attributes were utilized. Under this analysis, a plaintiff/actor would have to establish that a secondary meaning existed at the time the copyright holder used the mark. For example, in order to protect their individual personae, Wendt and Ratzenberger would have to show that when Host used the robots in the airport bars, they had already established secondary meaning in the marks "Norm" and "Cliff," rendering Host's use of the marks a violation of Wendt's and Ratzenberger's rights.

Applying the factors to determine whether secondary meaning existed, Wendt and Ratzenberger could argue that they were advertised as the characters "Norm" and "Cliff;" they had portrayed the characters "Norm" and "Cliff" for the entire eleven year duration of the television show *Cheers*;²⁴⁵ they had exclusively played the roles of "Norm" and "Cliff" on the television show *Cheers*; the robots were nearly identical likenesses of Wendt and Ratzenberger; and customers believed the robots were replicas of the characters "Norm" and "Cliff" as portrayed by Wendt and Ratzenberger alone. Wendt and Ratzenberger could further provide evidence of the number of customers who drank at the airport bars because of the robots, which looked like "Norm" and "Cliff," and that actual confusion occurred because customers believed that Wendt and Ratzenberger endorsed the airport bars because of the presence of the robots. This analysis would protect a copyright holder's use of his protected marks unless the individual actor could prove that a secondary meaning in the fictional character marks existed, and, therefore, the individuals could prevent the use of the fictional character marks which had become

²⁴³ *Id.* (quoting *Commerce Nat'l Ins. Servs, Inc.*, 214 F.3d 432, 438).

²⁴⁴ See discussion *supra* Part V(A).

²⁴⁵ IMDB.com, Full Cast and Crew for *Cheers*, <http://www.imdb.com/title/tt0083399/fullcredits> (last visited Jan. 2, 2010).

associated with the human actors.

In fact, the Supreme Court of California performed an analysis of secondary meaning in *Lugosi*.²⁴⁶ The court observed that Lugosi had not used his name or likeness as the fictional character “Dracula” in “connection with any business, product or service so as to impress a secondary meaning on such business, product or service.”²⁴⁷ The court stated that Lugosi could have created a protectable secondary meaning by commercially exploiting “his name, face and/or likeness in connection with the operation of any kind of business or the sale of any kind of product or service a general acceptance and good will for such business, product or service among the public.”²⁴⁸ Similarly, Wendt and Ratzenberger could have created protectable secondary meanings for their names, faces, and likenesses as the characters “Norm” and “Cliff” by commercially exploiting them to their own advantage. However, the facts in *Wendt* suggest that the actors had not capitalized on their names, faces, or likenesses as the characters “Norm” and “Cliff” for their commercial advantage, and that Ratzenberger had only suggested he might do so in the future.²⁴⁹

While the court in *Wendt* analyzed the factor of likelihood of expansion of the product lines in its analysis of the unfair competition claims, focusing on Wendt and Ratzenberger’s future commercial exploitation of their likenesses, an analysis of secondary meaning would examine the current and prior commercial exploitation of their fictional personae. If Wendt and Ratzenberger had commercially exploited their fictional likenesses prior to bringing suit, then under this analysis, they could have acquired a secondary meaning for their fictional personae, which would have become more distinctive.

D. Trademark Abandonment

Another possible method for analyzing copyright and right of publicity conflicts is by utilizing the analysis of trademark abandonment. Trademark abandonment occurs when the use of the mark has been discontinued with no intent to resume such use, or “[w]hen any course of conduct of the owner . . . causes the mark to become the

²⁴⁶ *Lugosi*, 603 P.2d at 428.

²⁴⁷ *Id.*

²⁴⁸ *Id.*

²⁴⁹ *Wendt II*, 125 F.3d at 814.

generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark.”²⁵⁰ In the copyright/right of publicity situation, it can be argued that when an actor portrays a fictional character, that the actor has abandoned his individual likeness to that character. Once an actor has voluntarily chosen to assume the role of the fictional character, the copyright holder of the fictional character now has a valid claim to the likeness of the actor in his fictional role. Thus, the actor’s likeness no longer uniquely identifies the actor alone, but also identifies the copyright holder’s product, which is the fictional character. Similarly, when a trademark holder’s mark has become generic, it no longer identifies the trademark holder’s product alone, and thus does not deserve protection.²⁵¹

In *American Thermos Products Comp. v. Aladdin Industries, Inc.*, both plaintiff and defendant manufactured and sold vacuum-insulated containers.²⁵² Plaintiff, American Thermos, alleged that defendant, Aladdin Industries, threatened to sell its containers under the name “thermos,” of which plaintiff owned eight U.S. trademark registrations.²⁵³ Aladdin Industries argued that the terms “thermos” and “thermos bottle” had become generic words, and thus were no longer protectable.²⁵⁴ The court had to decide whether the word “thermos” had become a “generic descriptive term for a vacuum-insulated container” or remained a trademark which uniquely identified plaintiff’s product.²⁵⁵

In its analysis, the court quoted Judge Learned Hand as stating, “ ‘[t]he single question, as I view it, in all these cases, is merely one of fact: [w]hat do the buyers understand by the word for whose use the parties are contending?’ ”²⁵⁶ The court noted that the evidence supported the conclusion that a large majority of the consumer public used the term “thermos” generically and that only a minority

²⁵⁰ 15 U.S.C.A. § 1127(2) (West 2009).

²⁵¹ *Am. Thermos Prods. Co. v. Aladdin Indus., Inc.*, 207 F. Supp. 9, 10 (D. Conn. 1962), *aff’d*, 321 F.2d 577 (2d Cir. 1963).

²⁵² *Id.* at 10.

²⁵³ *Id.*

²⁵⁴ *Id.*

²⁵⁵ *Id.*

²⁵⁶ *Am. Thermos*, 207 F. Supp. at 23 (quoting *Bayer Co., Inc. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921)).

of the public recognized “Thermos” as the plaintiff’s trademark.²⁵⁷ The court then stated that it had to consider whether a finding that the word “thermos” had become a part of the public domain would create a likelihood that consumers would be deceived into purchasing “defendant’s or some other manufacturer’s” vacuum insulated containers instead of plaintiff’s.²⁵⁸ The court concluded that the risk of confusion could be eliminated by imposing “limitations and conditions [] upon the generic use of ‘thermos.’ ”²⁵⁹ For example, requiring the defendant to precede the word “thermos” with its name “Aladdin,” and confining the use of the word “thermos” to only lower case letters.²⁶⁰

In the case of *Wendt*, Paramount and Host would have the burden of proving that Wendt and Ratzenberger had abandoned their likenesses by assuming their roles as “Norm” and “Cliff,”²⁶¹ which had resulted in their likenesses becoming generic. The court would have to first determine whether the consumers in the airport restaurants understood the robots to be representations of “Norm” and “Cliff” or, rather, representations of George Wendt and John Ratzenberger. Wendt and Ratzenberger had presented evidence that members of the public had approached them and commented on the similarities between Wendt and Ratzenberger and the robots.²⁶² Wendt’s and Ratzenberger’s evidence did not clarify whether the public had recognized Wendt and Ratzenberger as individuals or as their fictional characters “Norm” and “Cliff.” Furthermore, both parties could submit additional evidence, by way of survey, to prove the understanding of the general public. Once the court determines the understanding of the consuming public, it would then have to decide whether the consumers were confused as to whether Wendt and Ratzenberger were endorsing the restaurants.

This analysis would be similar to that performed by the court for Wendt’s and Ratzenberger’s claim of violation under the Lanham

²⁵⁷ *Id.* at 22.

²⁵⁸ *Id.* at 26.

²⁵⁹ *Id.* at 27.

²⁶⁰ *Id.*

²⁶¹ See *Electro Source, L.L.C. v. Brandess-Kalt-Aetna Group, Inc.*, 458 F.3d 931, 935 n.2 (9th Cir. 2006) (“[T]he party asserting abandonment, is required to ‘strictly prove’ its claim.”) (citation omitted).

²⁶² *Wendt II*, 125 F.3d at 813.

Act;²⁶³ however, it would be a more direct analysis. It would specifically address the very basic question presented by Judge Learned Hand, “ ‘[w]hat do the buyers understand by the word for whose use the parties are contending?’ ”²⁶⁴ Or in this case, whom do the buyers understand the robots to represent? If the court finds that the robots represent Ratzenberger and Wendt in the consumers’ eyes, then Wendt and Ratzenberger should prevail. On the other hand, if the consumers believe the robots represent “Norm” and “Cliff” in a mock *Cheers* setting, then Paramount and Host should prevail. Ultimately, the court must determine whether Wendt and Ratzenberger had abandoned their likenesses to their fictional characters, such that their likenesses no longer uniquely identified the actors, but also identified Paramount’s products, which were the fictional characters, “Norm” and “Cliff.” This approach would achieve a just result for two equally compelling claims to the same piece of intellectual property.

CONCLUSION

Wendt has brought to the forefront the very complex problem that occurs when copyright law clashes with right of publicity laws. Copyright laws were enacted to protect an author from the misappropriation of his original creations, and to promote creativity.²⁶⁵ Copyright laws are also meant to ensure that an author may reap the benefits of his work by exploiting commercial opportunities.²⁶⁶ However, these goals of copyright law may be extinguished when the copyrighted work happens to be a fictional character who is portrayed by an actor. When the copyright protected creation is a fictional character, the actor who portrays the fictional character may exert his right of publicity to protect his individual likeness, thereby preventing the copyright holder from utilizing the likeness of the fictional character to his own advantage. This inequitable result should be addressed. Congress should consider revising the copyright laws or enacting a right of publicity law in order to address this specific conflict. Alternatively, courts may utilize new analyses to determine whose rights should prevail depending upon the specific facts of each case. In any

²⁶³ *Id.* at 812.

²⁶⁴ *Am. Thermos*, 207 F. Supp. 9 at 23 (quoting *Bayer*, 272 F. at 509).

²⁶⁵ See 17 U.S.C.A. § 102(a); *Fogerty*, 510 U.S. at 526.

²⁶⁶ *Yu*, *supra* note 16, at 387. See also *Fogerty*, 510 U.S. at 526.

event, as the laws stand today in most circuits, the mug of copyright holders is only half full.