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## Deciding Who Cashes in on the Deceased Celebrity Business

Kathy Heller\*

### INTRODUCTION

According to the annual list published by Forbes.com, the thirteen “Top Earning Dead Celebrities” grossed a combined total of \$232 million in twelve months ending October, 2007.<sup>1</sup> The Forbes list is topped by the estate of Elvis Presley, which generated \$49 million, and includes familiar names like Albert Einstein and John Lennon, as well as relative newcomers, such as the rapper, Tupac Shakur, and the “Godfather of Soul,” James Brown.<sup>2</sup> According to industry estimates, “after Mr. Presley, Ms. Monroe and James Dean are the most valuable dead-celebrity brands.”<sup>3</sup>

The licensing of postmortem publicity rights—the commercial use of a deceased celebrity’s name and image—is one of the most valuable sources of income for a celebrity’s estate.<sup>4</sup> Although the lucrative licenses are carefully marketed, and unlicensed users are often rigorously pursued, postmortem publicity rights are currently not recognized by federal law.<sup>5</sup> Furthermore, the right does not exist in common law, and only a few states have enacted postmortem publicity rights legislation.<sup>6</sup>

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<sup>1</sup> Jake Paine, *Top-Earning Dead Celebrities* (Lea Goldman & David M. Ewalt eds.), FORBES.COM, Oct. 29, 2007, [http://www.forbes.com/2007/10/29/dead-celebrity-earning-biz-media-deadcelebs07\\_cz\\_lg\\_1029celeb\\_land.html](http://www.forbes.com/2007/10/29/dead-celebrity-earning-biz-media-deadcelebs07_cz_lg_1029celeb_land.html).

<sup>2</sup> *Id.*

<sup>3</sup> Nathan Koppel, *Blonde Ambitions: A Battle Erupts Over the Right to Market Marilyn*, WALL ST. J., Apr. 10, 2006, at A1.

<sup>4</sup> *Id.* (“In 2004, Robert F.X. Sillerman paid Lisa Marie Presley \$100 million for an 85% stake in Elvis Presley Enterprises Inc., which licenses Mr. Presley’s image and music.”).

<sup>5</sup> Unauthorized use of a deceased celebrity’s name, voice or likeness may give rise to a false endorsement claim under Section 43(a) of the Lanham Act if it causes consumers to be deceived or confused as to whether the celebrity is associated with the goods or services, much like a trademark. *See, e.g.,* *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992); *White v. Samsung Elecs. Am.*, 971 F.2d 1395, 1400 (9th Cir. 1992) (“In cases involving confusion over endorsement by a celebrity plaintiff, ‘mark’ means the celebrity’s persona.”). However, a right of publicity claim does not require evidence of likely consumer confusion. The United States Supreme Court considered the right of publicity in *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) and found that the First Amendment rights of a television news program were outweighed by an entertainer’s right to earn a living when the program aired the entertainer’s entire performance without his consent.

<sup>6</sup> *See, e.g.,* CAL. CIV. CODE § 3344.1 (West 2008); IND. CODE ANN. § 32-36-1-8 (West 2002); TENN. CODE ANN. § 47-25-1105 (Supp. 2001).

California created a personal publicity right for living persons in 1971 and thirteen years later recognized a postmortem publicity right.<sup>7</sup> The courts have struggled to interpret California's postmortem publicity law and have been reluctant to expand postmortem rights without clear legislative intent. When courts have ruled contrary to the claims of a celebrity's heirs, residuary heirs, and most recently the heir of a residuary heir,<sup>8</sup> the California legislature has responded by amending or "clarifying" California law, each time expressing its clear intent to identify exactly who controls a celebrity's postmortem publicity rights.<sup>9</sup>

The impact of California's law on the rights and remedies available to claimants reaches well beyond its borders. Courts generally look to the last domicile of the deceased to determine applicable law,<sup>10</sup> and California is the current home and last domicile of many celebrities. The California legislature crafted its law to achieve jurisdiction whenever a deceased celebrity's image is used "on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services."<sup>11</sup>

### I. EVOLUTION OF THE RIGHT OF PUBLICITY

The right of publicity has its origins in the common law tort of invasion of the right of privacy, which includes a cause of action for appropriation of the plaintiff's name or likeness.<sup>12</sup>

The gist of the cause of action in a privacy case is . . . a direct wrong of a personal character resulting in injury to the feelings . . . of the individual . . . [that] is mental and . . . subjective . . . [and] impairs the mental peace and comfort of the person and may cause suffering much more acute than that caused by a bodily injury.<sup>13</sup>

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<sup>7</sup> See CAL. CIV. CODE §§ 3344, 3344.1 (West Supp. 2008); see also *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 799–800 (Cal. 2001).

<sup>8</sup> See *Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*, No. CV 05-02200 MMM (MCX), 2008 U.S. Dist. LEXIS 22213 (C.D. Cal. Jan. 7, 2008).

<sup>9</sup> See, e.g., *Comedy III Prods.*, 21 P.3d at 799 (noting that the California legislature responded in 1984 with section 3344.1 after the court's holding in *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979)).

<sup>10</sup> See *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1146 n.5, 1147 (9th Cir. 2002). Pursuant to California Civil Code section 946, the decedent must be a resident of California or a resident of another jurisdiction that has similar postmortem rights. The trustee of the Diana Princess of Wales Memorial Fund sued a California-based business that was selling a broad range of memorabilia without permission. The court determined that, regardless of the location of the violation, the law of the forum where the rights-holder resides controls, unless there is a local law to the contrary. Since the Trust and deceased person (Princess Diana) were not California residents, and the UK did not have a similar right of postmortem publicity, there was no violation of California's post-mortem publicity rights. *Id.* at 1146–47.

<sup>11</sup> CAL. CIV. CODE § 3344.1 (West 2008).

<sup>12</sup> See *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (Ct. App. 1983) (stating that "California has long recognized a common law right of privacy."); see also William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960) (identifies and defines appropriation under common law torts and the privacy rubric).

<sup>13</sup> *Fairfield v. Am. Photocopy Equip. Co.*, 291 P.2d 194, 197 (Cal. Dist. Ct. App. 1955); see also

### A. Origins of the Right of Publicity

The common law right of privacy was first recognized in California in 1931,<sup>14</sup> and the Ninth Circuit identified a common law cause of action for the right of publicity—distinct from the right of privacy in 1974.<sup>15</sup> The right of publicity was first recognized in 1953 by the Second Circuit when the New York Giants' catcher, Wes Westrum, signed contracts giving two rival bubble-gum firms the exclusive right to put his image on their baseball cards.<sup>16</sup> The two companies turned to federal court, which recognized an enforceable right of publicity entitling celebrities to a portion of the profits derived from merchandise which displays their likeness.<sup>17</sup> The court found that the right of publicity would only have value if it could be the subject of an exclusive grant—unlike the right of privacy, which cannot be assigned or transferred.<sup>18</sup>

### B. Right of Publicity is Descendible to Heirs Regardless of whether the Celebrity Exploited the Right while Alive

More than twenty years later, the widows of Stanley Laurel and Oliver Hardy sued Hal Roach Studios, which owned the copyright to the Laurel and Hardy films, alleging misappropriation of the names and likeness of the two deceased comedians for commercial merchandising purposes.<sup>19</sup> The *Price* court held that Laurel and Hardy had a property right in their names and likeness during their lifetime and that the right descended to their heirs whether or not they exploited the right during their lifetimes.<sup>20</sup> This was the first expansion of the right of publicity beyond the celebrities' lifetime.

### C. Early Judicial Limitations on Descendible Rights of Publicity

Four years after the district court in New York decided *Price*, which recognized a descendible right of publicity for heirs regardless of whether the celebrity exploited the right while alive, the California Supreme Court reached a very different conclusion.<sup>21</sup> In 1966, the son and widow of Bela Lugosi filed a complaint against Universal Studios, claiming that Lugosi had a protectable property or proprietary right in his likeness of the Count

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Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

<sup>14</sup> *Melvin v. Reid*, 297 P. 91, 92 (Cal. Ct. App. 1931). In 1972, California added privacy to the inalienable rights granted to all people under the California Constitution. "All people are by nature free and independent and have inalienable rights. Among these are enjoying and defending life and liberty, acquiring, possessing, and protecting property, and pursuing and obtaining safety, happiness, and privacy." CAL. CONST. art. I, § 1 (amended Nov. 7, 1972, to add the word, "privacy").

<sup>15</sup> *Motschenbacher v. R. J. Reynolds Tobacco Co.*, 498 F.2d 821, 826 n.15 (9th Cir. 1974).

<sup>16</sup> *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953).

<sup>17</sup> *Id.* at 868.

<sup>18</sup> *Id.*

<sup>19</sup> *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 839 (S.D.N.Y. 1975).

<sup>20</sup> *Id.* at 844, 846–47.

<sup>21</sup> *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979).

Dracula character which descended to his heirs under his will.<sup>22</sup> Lugosi portrayed Count Dracula in a Broadway production and in the Universal films, *Dracula*,<sup>23</sup> *Dracula's Daughter*,<sup>24</sup> and *Abbott and Costello Meet Frankenstein*.<sup>25</sup> Lugosi's heirs sought a share of the profits from Universal's licensing of Lugosi's image as the character Count Dracula.<sup>26</sup>

In 1960, four years after his death, Universal began to license the use of Lugosi's image as the Count Dracula character.<sup>27</sup> Universal granted more than fifty licenses over the next decade for the use of the character's image in the sale of a wide variety of products, including: "plastic toy pencil sharpeners, plastic model figures, T-shirts and sweat shirts, card games, soap and detergent products, picture puzzles, candy dispensers, masks, kites, belts and belt buckles, and beverage stirring rods."<sup>28</sup>

The California Supreme Court denied the claims of Lugosi's heirs, not because Lugosi had contracted with Universal to exploit his Dracula image, but because "the right to exploit name and likeness is personal to the artist and must be exercised, if at all, by him during his lifetime."<sup>29</sup> Lugosi's heirs may have received a descendible right of publicity "if [the right] had been crystallized into a business by Lugosi during his lifetime" such that his name or likeness was used "in connection with any business, product, or service so as to impress a secondary meaning of such business, product, or service."<sup>30</sup>

Four days after the *Lugosi* decision, the California Supreme Court again concluded that rights of publicity were not descendible under California law unless exploited during the celebrity's lifetime.<sup>31</sup> Rudolph "Rudolpho" Valentino's nephew and legal heir, Jean Guglielmi, filed suit seeking damages and injunctive relief claiming that defendant Spelling-Goldberg Productions misappropriated Valentino's right of publicity by producing a biographical film.<sup>32</sup> *Guglielmi*, citing *Lugosi* as controlling, held that "the right of publicity protects against the unauthorized use of one's name, likeness or personality, but that the right is not descendible and expires upon the death of the person so protected."<sup>33</sup>

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<sup>22</sup> *Id.* at 427.

<sup>23</sup> DRACULA (Universal Pictures 1931).

<sup>24</sup> DRACULA'S DAUGHTER (Universal Pictures 1936). It should be noted that Bela Lugosi did not play an actual role in the film, however he gave permission to display in the film a wax image of his face and head as Count Dracula. *Lugosi*, 603 P.2d at 434.

<sup>25</sup> BUD ABBOTT & LOU COSTELLO MEET FRANKENSTEIN (Universal International Pictures 1948).

<sup>26</sup> *Lugosi*, 603 P.2d at 427.

<sup>27</sup> *Id.* at 435.

<sup>28</sup> *Id.*

<sup>29</sup> *Id.* at 431.

<sup>30</sup> *Id.* at 428 & n.5.

<sup>31</sup> *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454 (Cal. 1979).

<sup>32</sup> *Id.* at 455.

<sup>33</sup> *Id.*

## II. CODIFICATION OF PUBLICITY RIGHTS

## A. California Creates a Statutory Right of Publicity for the Living

While the *Lugosi* case was moving through the courts at glacial speed, the California legislature created a statutory right of publicity, available to everyone, regardless of celebrity status, which terminates upon death.<sup>34</sup> The statute, California Civil Code section 3344, prohibits “knowingly” using a person’s “name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services,” without prior consent.<sup>35</sup> The statute created an exemption for “news, public affairs, or sports broadcast or account, or any political campaign,”<sup>36</sup> and provides for both monetary damages and attorney fees.<sup>37</sup>

The *Lugosi* court explained that section 3344 “fills a gap which exists in the common law tort of *invasion of privacy* in the state of California[.]”<sup>38</sup> adding that “it is consistent with the common law limitation on the right to privacy for the statute not to provide for an action by one’s heirs.”<sup>39</sup>

## B. New York Federal Courts Follow California’s Lead

The District Court in New York looked to the *Lugosi* case when Groucho Marx Productions—assignee of the Marx Brothers—sued the producers of a Broadway play for interference with their publicity rights.<sup>40</sup> The play, *A Day in Hollywood/A Night in the Ukraine*, included three principal performers reproducing the appearance and comedy style of the Marx Brothers.<sup>41</sup> Following the holding of *Lugosi*, the District Court concluded that the Marx Brothers’ right of publicity was properly asserted because they had exploited their rights in their self-created characters during their lifetime.<sup>42</sup>

C. California Reacts to *Lugosi* by Creating a Statutory Right of Publicity for the Dead

In response to *Lugosi* and *Groucho Marx Productions*, the California legislature—prompted by the Screen Actors Guild, celebrities, and heirs of deceased celebrities—vested a right of publicity in celebrities’ heirs by

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<sup>34</sup> CAL. CIV. CODE § 3344 (West 2008).

<sup>35</sup> *Id.* § 3344(a).

<sup>36</sup> *Id.* § 3344(d).

<sup>37</sup> *Id.* § 3344(a).

<sup>38</sup> *Lugosi v. Universal Pictures*, 603 P.2d 425, 443 n.23 (Cal. 1979) (emphasis in original) (quoting Letter from John Vasconcellos, Cal. State Assembly, to Ronald Reagan, Governor, Cal. (Nov. 10, 1971)).

<sup>39</sup> *Id.*

<sup>40</sup> *Groucho Marx Prods., Inc. v. Day & Night Co.*, 523 F. Supp. 485 (S.D.N.Y. 1981).

<sup>41</sup> *Id.* at 486.

<sup>42</sup> *Id.* at 491–92 (further holding that commercial exploitation does not necessarily require connection with the operation of a business or the sale of a particular product or service).

enacting Civil Code section 990.<sup>43</sup> With automatically vesting rights, heirs no longer needed to overcome the *Lugosi* requirement of showing that publicity rights were exploited during the decedent's lifetime. This new statute was opposed by the American Civil Liberties Union, as well as copyright holders, including the Motion Picture Association of America, the Alliance of Motion Picture and Television Producers, CBS, NBC, and Ron Smith's Celebrity Look-Alikes.<sup>44</sup>

Section 990 granted the heirs and transferees of a "deceased personality" the right to consent to the use of the name, photograph, or likeness on or in products, or in advertisements for products for fifty years after the individual's death.<sup>45</sup> "Deceased personality" is defined as someone who died after 1935 and whose name or personality had commercial value at the time of his death.<sup>46</sup> The law retroactively created "property rights," freely transferable, in whole or in part, by contract or by means of trust or testamentary documents.<sup>47</sup> If the decedent did not sign a will or other transfer document, section 990 clarified the order in which surviving heirs—including spouse, children, grandchildren, and parents—inherit the rights.<sup>48</sup> If none of the specified heirs remain, the publicity rights permanently enter the public domain.<sup>49</sup>

While section 990 reflected the legislature's narrow focus on preventing courts from following the *Lugosi* and *Groucho Marx* decisions, it left courts to face the difficulty of interpreting section 990's language.<sup>50</sup>

### III. COMPARING SECTION 990'S POSTMORTEM RIGHTS TO SECTION 3344'S PUBLICITY RIGHTS FOR THE LIVING

When section 990 was enacted, deceased celebrities enjoyed a broader set of publicity rights than afforded to the living. In some aspects, the differences were distinct: Heirs of deceased celebrities possessed a "freely transferable and enforceable property right" in the use of the deceased personality's likeness,<sup>51</sup> while section 3344 contains no language granting transferable property rights to living celebrities. A living celebrity is required to prove that a defendant "knowingly" used the living person's

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43 CAL. CIV. CODE § 990 (West 2008) (renumbered 3344.1 in 1999).

44 Stephen F. Rohde, *Dracula: Still Undead*, CAL. LAW., Apr. 1985, at 51, 53.

45 *Id.*

46 *Id.*

47 *Id.*

48 *Id.*

49 CAL. CIV. CODE § 990(h) (West 2008) (superceded by section 3344.1). Section 990 was amended in 1999 and renumbered as § 3344.1. See *infra* Part VI.B.

50 Heirs were granted postmortem publicity rights under Section 990 if the deceased personality's "name, voice, signature, photograph, or likeness has commercial value at the time of his or her death." CAL. CIV. CODE § 990(h) (West 2008). The statute provides no further direction on how "commercial value" is to be determined, nor did it suggest how to determine the existence of unused commercial value.

51 *Id.* § 990.

name, voice, signature, photograph, or likeness,<sup>52</sup> while section 990 provided liability without proof of knowledge regarding the unlicensed use.<sup>53</sup>

The difference in scope of protection—for the living in section 3344 and the deceased in section 990—allows heirs to enforce publicity rights that the living celebrity would not have possessed. For example, a living person whose image is captured as part of a photograph cannot seek damages under section 3344 unless they are represented in the photograph as an individual “rather than solely as members of a definable group” such as a “crowd at any sporting event, a crowd in any street or public building, the audience at any theatrical or stage production, a glee club, or a baseball team.”<sup>54</sup> But section 990 merely required that the deceased personality is “readily identifiable from a photograph when one who views the photograph with the naked eye can reasonably determine who the person depicted in the photograph is.”<sup>55</sup>

A living baseball player could not prohibit the commercial use of his image in a team photograph under section 3344, nor could a well-known celebrity prohibit the commercial use of his image depicting him in a crowd at a sporting event.<sup>56</sup> But their heirs would be able to deny commercial use of the same photograph by withholding consent under section 990.

#### IV. REFINEMENT OF PUBLICITY RIGHTS AFTER SECTION 3344 AND SECTION 990

After the California legislature enacted postmortem publicity rights in section 990, still-living celebrities continued to pursue their publicity rights in court. But the courts looked to the common law, rather than section 3344, as the source of publicity rights for the living. As a result, California common law publicity rights continued to expand in scope and became more clearly defined.<sup>57</sup>

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<sup>52</sup> If a plaintiff is unable to prove a “knowing” use of name or likeness, the court will not find a violation of California Civil Code section 3344. See *White v Samsung*, 971 F.2d 1395, 1397 (9th Cir. 1992). Without a section 3344 violation, the living must look to a common law right of publicity for relief. See Stacey L. Dogan, *An Exclusive Right to Evoke*, 44 B.C. L. REV. 291, 306 n.97 (2003).

<sup>53</sup> CAL. CIV. CODE § 3344.1(a)(1) (West 2008).

<sup>54</sup> *Id.* § 3344(b)(2).

<sup>55</sup> *Id.* § 990.

<sup>56</sup> See, e.g., Tim Buckley, *Jazz Run Out of Gas in L.A.*, DESERET MORNING NEWS, Nov. 5, 2007, <http://deseretnews.com/article/1,5143,695224968,00.html> (depicting Jack Nicholson in the crowd at a basketball game).

<sup>57</sup> Alain J. Lapter, *How the Other Half Lives (Revisited): Twenty Years Since Midler v. Ford*, 15 TEX. INTELL. PROP. L.J. 239, 260 (2007) (“Unlike the traits enumerated under § 3344(a), the common law right of publicity embraces an expansive, yet ultimately ambiguous, set of indicia. It is precisely the court’s plaintiff-generous extension of protectable indicia that has significantly expanded a celebrity’s exclusive right to control the commercial use of his identity.”).



### A. Distinguishing Between Common Law and Statutory Rights of Publicity

The actor, Clint Eastwood sued *The National Enquirer* for commercial appropriation of his name, photograph and likeness under both California common law and section 3344.<sup>58</sup> Because section 3344(a) “requires a *knowing* use [of the celebrity’s likeness] whereas under case law, mistake and inadvertence are not a defense against commercial appropriation. . . and section 3344(g) expressly provides that its remedies are cumulative and in addition to any provided for by law[,]” the *Eastwood* court viewed section 3344 as the legislative compliment to—and not the source of—the right of publicity.<sup>59</sup> The *Eastwood* court also noted that a section 3344 claim required allegations of a “direct . . . connection . . . between the [infringing] use and the commercial purpose.”<sup>60</sup>

### B. Further Expansion of the Right of Publicity

Courts further expanded common law publicity rights to include imitations of a professional singer’s distinctive voice for commercial purposes,<sup>61</sup> as well as any symbols that might “evoke” a celebrity’s identity for commercial gain, such as a futuristic robot version of a game show hostess in an advertising context.<sup>62</sup> Although a person may have abandoned his birth name by legally changing it, and commercial use of the previous name was abandoned, the courts still recognized a right of publicity in the use of the name.<sup>63</sup> Courts also expanded the meaning of “name and likeness” to encompass “attributes” which suggest a celebrity’s identity.<sup>64</sup>

Not all celebrities were successful in persuading the court that common law or section 3344 afforded them a remedy when their likeness was commercially exploited.<sup>65</sup> The “public affairs” exemption of section 3344(d) permitted the use of an individual’s name and image in a commercial video about famous surfers,<sup>66</sup> as well as the use of a singer’s voice in a

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<sup>58</sup> *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 344 (Ct. App. 1983).

<sup>59</sup> *Id.* at 346 & n.6 (emphasis in original) (citation omitted).

<sup>60</sup> *Id.* at 347 (internal quotations omitted).

<sup>61</sup> *See, e.g., Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992).

<sup>62</sup> *White v. Samsung*, 971 F.2d 1395 (9th Cir. 1992).

<sup>63</sup> *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407 (9th Cir. 1996).

<sup>64</sup> *See, e.g., Motschenbacher v. R. J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (held print advertisement featuring race car identifiable as the plaintiff’s as a use of his identity, even though the plaintiff himself was not visible in the ad); *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (held that a phrase commonly used to introduce a specific celebrity was protected).

<sup>65</sup> *See, e.g., Montana v. San Jose Mercury News, Inc.*, 40 Cal Rptr. 2d 639 (Ct. App. 1995) (celebrity’s image originally used for newsworthy purposes, may be used to advertise the periodical itself); *Newton v. Thomason*, 22 F.3d 1455 (9th Cir. 1994) (use of a celebrity’s name for a character in a Television series was an acceptable use); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001) (picture in magazine was not pure commercial speech, and thus was protected by the First Amendment).

<sup>66</sup> *Dora v. Frontline Video, Inc.*, 18 Cal. Rptr. 2d 790 (Ct. App. 1993).

pay-per-call opinion poll.<sup>67</sup>

The California Legislature largely ignored these judicial refinements of publicity rights for the living. But, when the publicity rights of the deceased were called into question, the legislature acted quickly by amending section 990.<sup>68</sup>

## V. THE CASE OF FRED ASTAIRE'S IMAGE

### A. The Courts Limit Postmortem Publicity Rights by Recognizing an Exception to Section 990 for Non-Abusive Video

In 1969, Fred Astaire granted the Ronby Corporation an exclusive license to use his name, pictures, and likeness in connection with the operation of dance studios, schools, and related activities.<sup>69</sup> Fred Astaire died in 1987, leaving control over the rights to his film clips to his widow.<sup>70</sup> Two years later, Ronby entered into an agreement with Best Film & Video Corp. to manufacture and distribute a series of dance videos using the Fred Astaire Dance Studios name and licenses.<sup>71</sup> The "Fred Astaire Dance Series" videos began with ninety second clips from two of Astaire's films and contained still photographs of Astaire.<sup>72</sup> Astaire's widow sued Best, claiming that the ninety second film clips violated her rights under section 990.<sup>73</sup>

The Ninth Circuit Court of Appeals considered the "fairly convoluted statutory scheme" of section 990, reasoning that "to exempt a film or television program but not a videotape creates an absurd result . . ."<sup>74</sup> The court concluded that "the only interpretation of [section 990's] plain language which is internally consistent and gives effect to each phrase and clause of the provisions leads to the conclusion that Best's use of the Astaire film clips is exempt."<sup>75</sup> After reviewing the legislative history of section 990, the court determined that "Best's use in no possible way subjects Fred Astaire to abuse or ridicule. Best's use is also nothing like the exploitative marketing uses described in these legislative staff reports."<sup>76</sup>

It took less than two years for the California legislature to express its disapproval of *Astaire*. The response, SB 209, was unambiguously titled the Astaire Celebrity Image Protection Act.<sup>77</sup>

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<sup>67</sup> *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302 (9th Cir. 1992).

<sup>68</sup> *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997).

<sup>69</sup> *Id.* at 1299.

<sup>70</sup> *Id.*

<sup>71</sup> *Id.*

<sup>72</sup> *Id.*

<sup>73</sup> *Id.*

<sup>74</sup> *Id.* at 1301.

<sup>75</sup> *Id.* at 1302.

<sup>76</sup> *Id.* at 1303.

<sup>77</sup> S.B. 209, 1999–2000 Reg. Sess. (Cal. 1999).

B. The Legislature Responds to the Judicial Limitation on Postmortem Publicity Rights

According to its author, the Astaire Celebrity Protection Act (“Astaire Act”) was necessary “to correct [an] inappropriate application of the current law[,]”<sup>78</sup> to close “loopholes[,]”<sup>79</sup> and “to provide greater protections to the heirs of deceased celebrities by broadening the right to publicity that is descendible to them.”<sup>80</sup> The source of the legislation was the Screen Actors Guild,<sup>81</sup> and the same cast of characters from the section 990 debate, returned to lobby over the Astaire Act.<sup>82</sup>

Proponents reiterated the state goals of section 990, stating that the amendments were necessary “to correct inappropriate application of the current law to help prevent the improper use of celebrities’ hard-earned images once they are no longer here to protect them themselves.”<sup>83</sup> The proponents also emphasized the Astaire Act’s goal of protecting celebrities’ images and concern for the widows, children and dependants:

We are living in an era when images of prominent artists, living and deceased, are used to sell and promote an increasing variety of products in every conceivable medium at a time when advancing technology provides the means for virtually unlimited manipulation of images and their instantaneous distribution. When image thieves step in, there is no limit to the extent of the damage that can be done to the integrity of (an artist’s) career and vision. . . . Not only do authorized users suffer by this theft, but owners of the rights lose important compensation, on which many heirs—widows, children and others—depend on to live.<sup>84</sup>

Despite such lofty goals, the Astaire Act made only four changes in section 990. First it amended section 990(n)—used by the *Astaire* court to determine that the dance video fell within the excluded category of “film”<sup>85</sup>—by adding that films are not excluded from liability “if the claimant proves that the use is so directly connected with a product, article of merchandise, good, or service as to constitute an act of advertising, selling, or soliciting purchase of that product, article of merchandise, good, or service by the deceased personality.”<sup>86</sup>

Second, the Astaire Act added twenty years of additional protection, extending control over postmortem publicity rights to seventy years beyond the date of death.<sup>87</sup> On the front end, the Astaire Act extended the reach of

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78 S.B. 209, 1999–2000 Reg. Sess. (Cal.) (as amended and reported on Sept. 1, 1999).

79 *Id.* (mentioning *Astaire v. Best Film & Video Corp.* as an example of the need for the Bill).

80 *Id.*

81 S.B. 209, 1999–2000 Reg. Sess. (Cal.) (as amended and reported by S. Rules Comm. on Mar. 3, 1999).

82 *See id.*

83 S.B. 209, 1999–2000 Reg. Sess. (Cal.) (as amended and reported on Sept. 1, 1999).

84 *Id.*

85 *Astaire v. Best Film & Video Corp.* 116 F.3d 1297, 1303 (9th Cir. 1997).

86 S.B. 209, 1999–2000 Reg. Sess. (Cal.) (as amended and reported on Sept. 1, 1999); *see also* CAL. CIV. CODE ANN. § 3344.1(n) (West Supp. 2008).

87 *See* CAL. CIV. CODE ANN. § 3344.1(f)(3) (West Supp. 2008).

its protection to include celebrities who died at any time after 1915.<sup>88</sup>

Third, it extended California law, permitting plaintiffs to sue when “the liability, damages, and other remedies arise from acts occurring directly in [California,]”<sup>89</sup> or for a prohibited “use, on or in products, merchandise, goods, or services, or the advertising or selling, or soliciting purchases of, products, merchandise, goods, or services . . . .”<sup>90</sup>

Fourth, the Astaire Act renumbered and moved section 990 to section 3344.1 so that the postmortem publicity statute would immediately follow the statute granting publicity rights to living persons.<sup>91</sup>

Although the Astaire Act was enacted in California with very little opposition, similar legislation introduced in New York engendered criticism. The attorney for Time, Inc. argued that “the wrong that these bills appear to redress is that the heirs of celebrities evidently do not feel that they are getting enough money for the use of the persona of their famous ancestors, . . . the name of the game here is money.”<sup>92</sup> Opponents of the legislation acknowledged that Astaire’s estate prevented the unlicensed commercial use of Astaire’s image on products such as jewelry, cologne, and tuxedos.<sup>93</sup> But they derided the estate’s granting of a license to digitally remove Fred Astaire’s dance partner, Ginger Rogers, from a film clip and to replace her with a Dirt Devil vacuum cleaner in a commercial.<sup>94</sup> This commercial exploitation raised particular ire because the estate had previously prevented the Kennedy Center for the Performing Arts from using Fred Astaire clips for its televised tribute to Ginger Rogers in 1992.<sup>95</sup> Filmmakers who create documentaries and anthologies also complained about the difficulty involved with obtaining permission from the Astaire estate, despite their position that their work was not “commercial” and therefore exempt.<sup>96</sup> Though never enacted, critics of the New York legislation raised the concern that new postmortem protections would create “impossible restrictions for photographers or artists selling their work.”<sup>97</sup>

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<sup>88</sup> *Id.* § 3344.1(h). Previously postmortem protection only reached celebrities who had died after 1935. See *supra* text accompanying note 46.

<sup>89</sup> CAL. CIV. CODE ANN. § 3344.1(n) (West Supp. 2008).

<sup>90</sup> *Id.*

<sup>91</sup> S.B. 209, 1999–2000 Reg. Sess. (Cal.) (as amended and reported by S. Rules Comm. on Mar. 3, 1999).

<sup>92</sup> Adam Z. Horvath, *Heirs Dispute Rights to Celebrity*, NEWSDAY (New York), May 16, 1989, at N8.

<sup>93</sup> Irene Lacher, *Fred is Her Co-Pilot*, L.A. TIMES, Aug. 17, 1997, at C1.

<sup>94</sup> See Eileen, Clarke, *The Last Dance: When Fred Astaire, Died 12 Years Ago, The Battle over his Work Began*, ENT. WKLY., June 18, 1999, at 88, available at <http://www.ew.com/ew/article/0,,273770,00.html>.

<sup>95</sup> *Id.* “The licensing and use of dead celebrities’ images has been controversial for decades. There was a public debate in the late 1990s when movie images of John Wayne were digitally inserted into a Coors beer commercial after his death.” Patrick McGreevy, *A Bid to Protect Stars’ Images*, L.A. TIMES, July 23, 2007, at B1.

<sup>96</sup> Lacher, *supra* note 93.

<sup>97</sup> Adam Z. Horvath, *Heirs Dispute Rights to Celebrity*, NEWSDAY (New York), May 16, 1989, at N8.

## VI. THE CASE OF MARILYN MONROE'S IMAGES

Marilyn Monroe's image was captured by some of the greatest photographers of her time, including Milton Greene, Tom Kelley, and Sam Shaw. Those images remain part of popular culture more than forty-five years after her death. During her life, Monroe transferred her rights in the photos to the photographers by signing a modeling release. The copyright to these images currently belongs to the photographers' estates, and the estates license the use of the Monroe photographs. But the holders of Monroe's postmortem publicity rights require the payment of an additional license fee—a second rent—whenever Monroe's photographs are commercially used.<sup>98</sup>

When Marilyn Monroe died in August 1962, she left a 623-word will which provided for her mother and a few others.<sup>99</sup> The will then included the following residuary clause:

All the rest, residue and remainder of my estate, both real and personal of whatsoever nature and whatsoever situate, of which I shall die seized or possessed or to which I shall be in any way entitled, or over which I shall possess any power of appointment by Will at the time of my death, including any lapsed legacies, I give, devise and bequeath as follows:

- (a) To MAY REIS the sum of \$40,000 or 25% of the total remainder of my estate, whichever shall be the lesser.
- (b) To DR. MARIANNE KRIS 25% of the balance thereof, to be used by her as set forth in ARTICLE FIFTH (d) of this my Last Will and Testament.
- (c) To LEE STRASBERG the entire remaining balance.<sup>100</sup>

Six years after Monroe's death, her acting coach, Lee Strasberg, married Anna Strasberg—who was left as the sole beneficiary under Strasberg's will when he died in 1982.<sup>101</sup> Monroe's will was subject to probate in New York County Surrogate's Court, which appointed Anna Strasberg, a woman Monroe likely never even knew, as the administratrix of her estate.<sup>102</sup> In 2001, the court authorized Anna Strasberg to close the estate and transfer the residuary assets to Marilyn Monroe, LLC—a Delaware company formed by Ms. Strasberg to hold and manage the intellectual property assets of the residuary beneficiaries of Monroe's will.<sup>103</sup>

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<sup>98</sup> See Nathan Koppel, *Blonde Ambitions: A Battle Erupts Over the Right to Market Marilyn*, WALL ST. J., Apr. 10, 2006, at A1.

<sup>99</sup> *Strasberg v. Odyssey Group, Inc.*, 59 Cal. Rptr. 2d 474, 475 (Ct. App. 1996).

<sup>100</sup> See *infra*, Appendix A.

<sup>101</sup> *Id.*

<sup>102</sup> *Id.* After her husband, Lee's death, Anna Strasberg promptly auctioned the bulk of the items Monroe willed to Lee—for about \$13.4 million dollars. See Koppel, *supra* note 98 (“In 1999, Ms. Strasberg commissioned auction house Christie's to sell many famous items Ms. Monroe left behind, including the sequined gown she wore when she sang ‘Happy Birthday’ to President John Kennedy in 1962. The auction raised \$13.4 million, but the sale irked many of Ms. Monroe's fans and friends.”).

<sup>103</sup> See *id.* (“[Ms. Strasberg] has a controlling interest in [Marilyn Monroe, LLC]; the Anna Freud Centre, a London psychiatric institute that inherited Dr. Kris's stake [in the Monroe's estate] owns the rest.”).

#### A. Courts in New York Limit the Extent of Postmortem Rights

Marilyn Monroe, LLC and its licensing agent, CMG Worldwide, claim the postmortem right of publicity to Monroe's image and have asserted that right in connection with the licenses granted by the photographer's estates.<sup>104</sup> In 2005, Marilyn Monroe, LLC and CMG Worldwide brought action against certain photographers, their estates, and their agents in the Southern District of Indiana.<sup>105</sup> Indiana, home to CMG, "creates a descendible and freely transferable right of publicity that survives for 100 years after a personality's death."<sup>106</sup> Indiana jurisdiction is established when the deceased's likeness is used in any "act or event that occurs within Indiana, regardless of a personality's domicile, residence, or citizenship."<sup>107</sup>

Shortly thereafter, the Shaw Family Archives brought suit in the Southern District of New York "seeking a declaratory judgment on whether there is any postmortem right of privacy or publicity in the name, likeness, and image of Marilyn Monroe . . ."<sup>108</sup> The Archives also sought damages for copyright violations, tortious interference with contractual relations, and tortious interference with prospective economic advantage.<sup>109</sup>

The two cases were consolidated in the Southern District of New York, which held that a postmortem right of publicity could not have been passed by will in 1962 because "only property actually owned by a testator at the time of her death can be devised by will."<sup>110</sup> While Indiana recognized postmortem publicity rights by the time of trial, neither Indiana nor Monroe's two possible states of domicile<sup>111</sup> "recognized descendible post-mortem publicity rights at the time of Ms. Monroe's death in 1962 . . ."<sup>112</sup>

Because "the majority rule that the law of the domicile of the testator at his or her death applies to all questions of a will's construction[.]"<sup>113</sup> and neither California nor New York allowed for the transfer of postmortem publicity rights inherited through wills of personalities who were already deceased prior to the statute's enactment, the *Shaw Family Archives* court concluded that, although state law might grant Monroe's postmortem right of publicity to her statutorily specified heirs, the purported transferees

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<sup>104</sup> *Shaw Family Archives*, 486 F. Supp. 2d 309.

<sup>105</sup> *Id.* at 310.

<sup>106</sup> *Id.* at 313.

<sup>107</sup> *Id.*

<sup>108</sup> *Id.* at 310. New York law does not recognize any common law right of publicity and limits its statutory publicity rights to living persons. *Id.* at 314.

<sup>109</sup> *Id.* at 310–11.

<sup>110</sup> *Id.* at 313–14.

<sup>111</sup> *See id.* at 314–15 ("There are disputed issues of fact concerning whether Ms. Monroe was domiciled in New York or California at the time of her death. (There is absolutely no doubt that she was *not* domiciled in Indiana.)").

<sup>112</sup> *Id.* at 314.

<sup>113</sup> *Id.*

could not, and did not, hold such a right.<sup>114</sup>

#### B. Courts in California Limit the Extent of Postmortem Rights

The estate of a second Monroe photographer, Milton H. Greene Archives, Inc. (“MHG”), filed a contemporaneous action against CMG Worldwide, Marilyn Monroe, LLC, and Anna Strasberg in the Central District Court of California.<sup>115</sup> The court granted MHG’s motion for summary judgment, concluding that “under either California or New York law, Marilyn Monroe had no testamentary capacity to devise, through the residual clause of her will, statutory rights of publicity that were not created until decades after her death . . . .”<sup>116</sup> The court further concluded that, “even if Marilyn Monroe’s estate was open at the time the statutory rights of publicity were created, it ‘was not [an] entity capable of holding title to the rights.’”<sup>117</sup>

To reach this decision, the court examined California Civil Code section 3344.1, finding that “[g]iven the clear common law prescription that a testator cannot devise property not owned at the time of death, and the presumption that the California legislature knew of this . . . prescription . . . [with respect to] personalities who died before its enactment, the California right of publicity statute vested the posthumous publicity right in designated heirs rather than in the ‘personality’ himself or herself.”<sup>118</sup> Because section 3344.1 “did not reveal a legislative intent that was contrary to general principles of property and probate law,” Marilyn Monroe, LLC and CMG Worldwide lacked standing to assert postmortem publicity rights.<sup>119</sup> While limiting the extent of postmortem publicity rights, the *Milton Greene* court noted that the California and Indiana legislatures were in no way prohibited “from enacting a right of publicity statute that vested the right directly in the residuary beneficiaries of a deceased personality’s estate, or in the successors-in-interest of those residuary beneficiaries.”<sup>120</sup>

#### C. Legislative Response to the Monroe Limitation on Postmortem Rights

A scant six weeks after the Central District’s ruling, California State Senator Sheila Kuehl fast-tracked Senate Bill 771.<sup>121</sup> The bill, sponsored by the Screen Actors Guild, was meant to amend section 3344.1 in re-

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<sup>114</sup> *Id.* at 315–20.

<sup>115</sup> *Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*, No. CV 05-02200 MMM (MCx), 2008 U.S. Dist. LEXIS 22213 (C.D. Cal. Jan. 7, 2008).

<sup>116</sup> *Id.* at \*10.

<sup>117</sup> *Id.* (brackets in original).

<sup>118</sup> *Id.* at \*6–7.

<sup>119</sup> *Id.* at \*7.

<sup>120</sup> *Id.* at \*9.

<sup>121</sup> *Id.* State Senator Sheila Kuehl (D-Santa Monica) also starred in the 1959–63 CBS Series, *The Many Loves of Dobie Gillis*. Matthew Belloni, *Marilyn’s Image Fuels Right-of-Publicity Row*, HOLLYWOOD REP., Sept. 14–16, 2007, at 90.

sponse to the recent Monroe cases.<sup>122</sup> In September 2007, Senate Bill 771 passed both houses of the California legislature and was signed by Governor Schwarzenegger on October 10, 2007.<sup>123</sup>

According to the proponents of SB 771, it *clarifies* that the rights to “a deceased personality’s name, voice, signature, photograph or likeness in a commercial product is freely descendible by means of trust or any other testamentary instrument executed before or after January 1, 1985.”<sup>124</sup> The Bill also *specifies* that the publicity rights are deemed to have existed at the time of death of any person who died prior to 1985, and that such property rights vest in the persons entitled to them under a trust or other testamentary instrument of the deceased personality.<sup>125</sup> A provision in the testamentary instrument disposing of the residue of the deceased personality’s assets shall be effective to transfer those assets—including publicity rights—as of the date of death.<sup>126</sup>

SB 771 amended section 3344.1(b)—which vested postmortem publicity rights in the family members identified in the statute—and substituted the following:

The rights recognized under this section are property rights, freely transferable or descendible, in whole or in part, by contract or by means of any trust or any other testamentary instrument, executed before or after January 1, 1985. The rights recognized under this section shall be deemed to have existed at the time of death of any deceased personality who died prior to January 1, 1985, and, except as provided in subdivision (o), shall vest in the persons entitled to these property rights under the testamentary instrument of the deceased personality effective as of the date of his or her death. In the absence of an express transfer in a testamentary instrument of the deceased personality’s rights in his or her name, voice, signature, photograph, or likeness, a provision in the testamentary instrument that provides for the disposition of the residue of the deceased personality’s assets shall be effective to transfer the rights recognized under this section in accordance with the terms of that provision. The rights established by this section shall also be freely transferable or descendible by contract, trust, or any other testamentary instrument by any subsequent owner of the deceased personality’s rights as recognized by this section. Nothing in this section shall be construed to render invalid or unenforceable any contract entered into by a deceased personality during his or her lifetime by which the deceased personality assigned the rights, in whole or in part, to use his or her name, voice, signature, photograph or likeness, regardless of whether the contract was entered into before or after Janu-

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<sup>122</sup> *Post-Mortem Publicity Rights of Deceased Celebrities: Hearing on S.B. 771 Before the S. Rules Comm. Assemb.*, 2007–08 Reg. Sess. 4 (Cal. Sept. 4, 2007). In addition to the Screen Actors Guild, the bill was supported by California Labor Federation, AFSCME, Motion Picture and Television Fund, and about a dozen celebrity heirs and their foundations. The only opposition came from photographers and their estates. *Id.* at 5–6.

<sup>123</sup> *Milton Greene*, 2008 U.S. Dist. LEXIS at \*9.

<sup>124</sup> *Id.* at 2.

<sup>125</sup> *Id.*

<sup>126</sup> *Id.*



ary 1, 1985.<sup>127</sup>

SB 771 also added the following subsection to section 3344.1:

(o) Notwithstanding any provision of this section to the contrary, if an action was taken prior to May 1, 2007, to exercise rights recognized under this section relating to a deceased personality who died prior to January 1, 1985, by a person described in subdivision (d), other than a person who was disinherited by the deceased personality in a testamentary instrument, and the exercise of those rights was not challenged successfully in a court action by a person described in subdivision (b), that exercise shall not be affected by subdivision (b). In such a case, the rights that would otherwise vest in one or more persons described in subdivision (b) shall vest solely in the person or persons described in subdivision (d), other than a person disinherited by the deceased personality in a testamentary instrument, for all future purposes.

(p) The rights recognized by this section are expressly made retroactive, including to those deceased personalities who died before January 1, 1985.<sup>128</sup>

Individual photographers, their estates, and photography organizations opposed the bill. They argued that, prior to SB 771, publicity rights descend to designated heirs, and that SB 771 “strips those family members of deceased personalities of the rights they have owned and enjoyed for 22 years, without notice, compensation or justification. The Amendment is therefore unconstitutional both because of its attempted retroactive effect and because it deprives persons of their property ex post facto without compensation.”<sup>129</sup> Opponents also argued that SB 771 vests rights in residuary beneficiaries which, under the previous law, would have fallen into the public domain upon death unless the statutory heirs were alive.<sup>130</sup>

#### D. Courts Apply the New Legislation

Following the passage of SB 771, the U.S District Court for the Central District of California granted a motion for reconsideration of the *Milton Greene* decision.<sup>131</sup> Citing SB 771 and its legislative history, the court stated that “[i]t is the intent of the Legislature to abrogate the summary judgment orders” in *Milton Greene* and *Shaw Family Archives*.<sup>132</sup> The court agreed with statements by Senator Kuehl that SB 771 was a legislative “clarification” rather than a change or modification in existing law.<sup>133</sup> The court concluded that Marilyn Monroe, LLC has standing to assert the right of publicity under the “clarified” California law.<sup>134</sup> As of January

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<sup>127</sup> CAL. CIV. CODE § 3344.1(b) (West 2008) (asterisks and underlining omitted).

<sup>128</sup> *Id.* § 3344.1(o)–(p).

<sup>129</sup> Letter from The Soni Law Firm, representing The Milton H. Greene Archives, Inc. & Tom Kellery Studios, Inc., to Senator Bob Margett, California Senate 2 (Sept. 7, 2007) (on file with author) [hereinafter Soni Letter] (emphasis omitted).

<sup>130</sup> *Id.* at 3.

<sup>131</sup> *Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*, No. CV 05-02200 MMM (MCx), 2008 U.S. Dist. LEXIS 22213 (D. Cal. 2008).

<sup>132</sup> *Id.* at \*18 (brackets in original).

<sup>133</sup> *Id.* at \*14, \*29.

<sup>134</sup> *Id.* at \*57–58.

2008, the only remaining issue before the court was the location of Marilyn Monroe's domicile at time of death. If Monroe was domiciled in California, SB 771 granted her the retroactive testamentary power to bequeath a posthumous right of publicity through her will.<sup>135</sup> If domiciled in New York, her publicity rights would derive exclusively from statute—personal to the individual and extinguishing at death.<sup>136</sup>

## VII. POSTMORTEM PUBLICITY RIGHTS: A GROWTH INDUSTRY

### A. Legislative Intent Behind the Enactment of Postmortem Publicity Rights

The sponsors and proponents of California's postmortem publicity legislation have repeatedly stated that its purpose is to create a means of protecting a deceased celebrity's name or likeness from unseemly uses. The sponsors of the Astaire Celebrity Protection Act and SB 771 quoted the legislative history from the enactment of California's first postmortem publicity rights statute in 1984, which declared:

[This] bill is intended to address circumstances in . . . which . . . a celebrity or public figure is subjected to abuse or ridicule in the form of a marketed product. Such goods or services typically involve[ ] the use of a deceased celebrity's name or likeness, e.g., on posters, T-shirts, porcelain plates, and other collectibles; in toys, gadgets, and other merchandise; [or] in look-alike services.<sup>137</sup>

California's first postmortem publicity law, enacted in 1984, vested postmortem publicity rights in specified family members, because the legislature determined that close family members are most likely to be sensitive to protecting a deceased celebrity's name and likeness from "abuse or ridicule."<sup>138</sup> Under this version of the law, if no close family members remained, due to death, or the passage of fifty years, the rights fell into the public domain.<sup>139</sup>

<sup>135</sup> *Id.* at \*59–60; cf. *Cairns v. Franklin Mint Co.*, 292 F.3d 1139 (9th Cir. 2002). Pursuant to California Civil Code section 946, the *Cairns* court determined that postmortem publicity rights would exist if the decedent was resident of California or a resident of another jurisdiction that has similar postmortem rights. In *Cairns*, the trustee of the Diana Princess of Wales Memorial Fund sued a California based business that was selling a broad range of Princess Diana memorabilia without permission. The *Cairns* court determined that, absent any contrary law in the local forum, the rights are based on the location of the rights-holder's residence, and not based on the location of the claimed violation. Since neither the plaintiff trust nor the deceased person were California residents, and because the United Kingdom did not have a similar right of postmortem publicity, the court determined that section 3344.1 was not violated. *Cairns*, 292 F.3d at 1147.

<sup>136</sup> *Milton Greene*, 2008 U.S. Dist. LEXIS 22213 at \*59–60.

<sup>137</sup> *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297, 1303 (9th Cir. 1997) (emphasis omitted) (quoting *Report on S.B. 613 Before the Assemb. Comm. on Judiciary*, 1983–84 Reg. Sess. (Cal. 1984) (statement of Cal. Sen. John Campbell) (as amended June 12, 1984), at 3–4 [hereinafter *Report on S.B. 613*]).

<sup>138</sup> See *Commercial Appropriation of Image: Deceased Celebrities, Hearing on S.B. 209 Before S. Judiciary Comm.*, 1999–2000 Reg. Sess. (Cal. 1999) (statements of Cal. Sen. John Burton) [hereinafter *Burton Hearing*].

<sup>139</sup> See *Comedy III Prods. v. Gary Saderup, Inc.*, 21 P.3d 797, 800 (Cal. 2001) (describing the original fifty-year consent period following the death of a personality). Under the current revised sta-

Subsequent legislation vested publicity rights in the residuary clause of a celebrity's will unless a contrary intent is expressly stated in the will.<sup>140</sup> Since an inheritable right of publicity did not even exist prior to 1984, it is highly unlikely that it would be specifically bequeathed in wills drafted prior to that date, and therefore the rights will almost always pass to the residuary heirs. By granting control of a celebrity's postmortem rights to the residuary heirs, assignees, and transferees for seventy years,<sup>141</sup> the legislation almost ensures that the rights are eventually owned and controlled by an individual or entity with very limited sensitivity to "abuse or ridicule" of the celebrity's name and likeness.

According to the Screen Actors Guild, "In recent years, it has become increasingly important to protect [postmortem publicity] rights in the face of increasing avenues of commercial exploitation, while still taking care not to hamper the creative process. The passage of SB 771 will help to protect these public figures while still allowing for creative expression."<sup>142</sup> Representatives of Marilyn Monroe, LLC assert that they have "carefully guarded the publicity rights of Marilyn Monroe's image in order to maintain her legacy as she intended. However, due to recent court decisions, Ms. Monroe's publicity rights could be released into the public domain only to result in offensive and exploitive uses of her image."<sup>143</sup> The legislative sponsor of SB 771 noted that "[d]igital technology now permits advertisers to manipulate the images of dead people, like the infamous 1997 commercial in which Fred Astaire danced with a vacuum cleaner."<sup>144</sup>

#### B. Practical Effects of Granting Postmortem Publicity Rights

While licensors have sued to prevent unlicensed (and therefore unpaid) uses, they have also sold licenses for a wide variety of goods and services, including all of the items listed by legislative sponsors as *typically* subjecting a celebrity or public figure to "abuse or ridicule."<sup>145</sup> Legislators have specifically listed "posters, T-shirts, porcelain plates," "toys, gadgets," and "other collectibles" as well as "look alike services" as items with high potential for ridicule.<sup>146</sup>

Perhaps the swift passage of SB 771 left little time for the legislature to look closely at the currently licensed uses of Monroe's image. The web-

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tute, the consent period lasts seventy years beyond the death of the personality. See CAL. CIV. CODE § 3344.1(g) (West 2008).

<sup>140</sup> *Id.* § 3344.1(b).

<sup>141</sup> *Id.* § 3344.1(g).

<sup>142</sup> *Deceased Personalities: Transfer of Publicity Rights by Testamentary Instrument: Hearing on SB 771 Before the S. Judiciary Comm.*, 2007–08 Reg. Sess. (Cal. 2007) (statement of Cal. Sen. Sheila Kuehl) [hereinafter *Kuehl Hearing*], available at [http://info.sen.ca.gov/pub/07-08/bill/sen/sb\\_0751-0800/sb\\_771\\_cfa\\_20070906\\_123814\\_sen\\_comm.html](http://info.sen.ca.gov/pub/07-08/bill/sen/sb_0751-0800/sb_771_cfa_20070906_123814_sen_comm.html).

<sup>143</sup> *Id.*

<sup>144</sup> Jim Zarroli, *Law Decides Who Owns a Dead Star's Image*, NAT'L PUB. RADIO, Oct. 11, 2007, <http://www.npr.org/templates/story/story.php?storyId=15198298>.

<sup>145</sup> See *supra* text accompanying note 137.

<sup>146</sup> *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297, 1303 (9th Cir. 1997).

site of Marilyn Monroe, LLC includes an “official online store” which offers a wide array of products containing her image, including: stemware, purses, candles, jewelry, T-Shirts, costumes, refrigerator magnets, stickers, swim suits, and a 5’7” stand-up featur[ing] a famous 1950s image of Marilyn wearing net stockings, black heels and fitted bodice, leaning back on a table.”<sup>147</sup> The website’s “Licensing Resource Center” encourages prospective licensees to “[b]uild your brand with Marilyn Monroe and maximize the appeal and demand for your product or service by incorporating the most famous Hollywood icon of all time.”<sup>148</sup>

According to CMG Worldwide’s website, the company represents “over 200 diverse clients from all realms of stardom”<sup>149</sup> and offers to “develop successful licensing programs in a variety of categories including Apparel, Collectibles, Jewelry, Sporting Goods, Gourmet food, Gaming and Electronics, Restaurants and Toys just to name a few.”<sup>150</sup> While the postmortem publicity rights were intended to protect against abuse or ridicule, it appears that Marilyn Monroe, LLC has considered licensing celebrity images for the very products and services that carry high potential for ridicule or abuse.

Marilyn Monroe, LLC and its licensing company, CMG Worldwide, Inc., were before the California and New York courts as a result of their efforts to prevent professional photographers and their estates from licensing the use of their copyrighted photographs without an additional license for the postmortem publicity rights.<sup>151</sup> These cases involved the sale of a second license by the postmortem publicity rights holder, not prevention of abuse or ridicule.

### C. Alternate Goals of Postmortem Publicity Rights: Protecting Charities

Another stated purpose of the law is to protect the income—in the form of licensing fees—of charities when a celebrity’s will names the charity as a residual beneficiary.<sup>152</sup> The *Milton Greene* court expressed a similar concern, stating that it “reached [its] conclusion with reluctance because some personalities who died before passage of the California and Indiana right of publicity statutes had left their residuary estates to charities[,] . . . [who] assumed that they controlled the personality’s right of publicity . . . .”<sup>153</sup> Denying the right would have the effect of divesting the charity

<sup>147</sup> Marilyn Monroe’s Official Website, <http://www.marilynmonroe.com> (describing the stand-up as “[a]n unforgettable addition to any Marilyn collection!”) (last visited Mar. 27, 2008).

<sup>148</sup> MarilynMonroe.com, <http://business.marilynmonroe.com/licensing/index.htm> (last visited Mar. 27, 2008).

<sup>149</sup> CMG Worldwide Services, <http://services.cmgww.com> (last visited Mar. 30, 2008).

<sup>150</sup> CMG Worldwide Services, <http://services.cmgww.com/marketing/merchandise.htm> (last visited Mar. 30, 2008).

<sup>151</sup> See *supra* Part VII.A–B.

<sup>152</sup> “Kuehl also says that over the years, many celebrities have left their estates to nonprofit foundations; the law ensures that they were within their rights to do so.” Zarroli, *supra* note 144.

<sup>153</sup> *Milton H. Greene Archives v. CMG Worldwide*, No. CV 05-02200 MMM (MCx), 2008 U.S.

of the celebrity's posthumous right of publicity.<sup>154</sup>

But neither the legislature nor the court provided examples of potentially affected charities. SB 771 addressed a similar concern with respect to family members—that they would retroactively lose rights—by carving out an exception for statutory heirs who have exercised a celebrity's right of publicity and who were never successfully challenged in court.<sup>155</sup> The legislature does not appear to have considered carving out a similar exception for charities or any other exculpatory measures like a grandfather clause.

There appears to be one remaining goal for California's postmortem publicity laws. This goal has become the primary, and arguably, the only, focus of its sponsors and proponents: "to address circumstances in which . . . commercial gain is had through the exploitation of the name, voice, signature, photograph, or likeness of a celebrity or public figure in the marketing of goods or services . . ." <sup>156</sup>

#### D. Unresolved Issues Arising out of Publicity Rights

In its rush to protect deceased celebrities, the California legislature ignored or dismissed critics of the legislation and of existing law, and therefore missed an opportunity to address concerns and resolve issues.

Courts repeatedly struggle with balancing the right of publicity and the First Amendment. While some find that an artist's First Amendment right to paint a picture of Tiger Woods outweighs the right of publicity,<sup>157</sup> other courts have used a transformative test to find that an artist's charcoal drawing of the Three Stooges violated their postmortem publicity rights.<sup>158</sup> The Ninth Circuit has found that the publications are protected from right of publicity claims unless the "publishers knew that their statements were false or published them in reckless disregard of the truth."<sup>159</sup> Courts and commentators have repeatedly wrestled with the balance between the right to expressive speech that incorporates a celebrity's likeness and the right of publicity that grants control over the use of a celebrity's likeness.<sup>160</sup>

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Dist. LEXIS 22213, at \*9 (C.D. Cal. Jan. 7, 2008).

<sup>154</sup> *Id.*

<sup>155</sup> See CAL CIV. CODE § 3344.1(o) (West 2008).

<sup>156</sup> Burton *Hearing*, *supra* note 138 (quoting *Report on SB 613*, *supra* note 137).

<sup>157</sup> See *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003) (held that artist's First Amendment right of expression in painting of Tiger Woods outweighed the golfer's publicity rights).

<sup>158</sup> See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001). Artist Gary Saderup drew the Three Stooges on canvass with charcoal and sold lithographs and T-shirts bearing reproductions of his drawing. The court looked to whether the new work was "transformative" of the original photograph, finding that if a work "adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message;" then it is sufficiently transformative to garner its own protection. *Id.* at 808. In this case, the court found that Saderup's artwork was not transformative and therefore a violation of the right of publicity. *Id.* at 811.

<sup>159</sup> *Cher v. Forum Int'l, Ltd.*, 692 F.2d 634, 637 (9th Cir. 1982) *cert. denied*, 462 U.S. 1120 (1983).

<sup>160</sup> See, e.g., Jordan Tabach-Bank, Note, *Missing the Right of Publicity Boat: How Tyne v. Time Warner Entertainment Co. Threatens to "Sink" The First Amendment*, 24 LOY. L.A. ENT. L. REV. 247

Some commentators have cautioned against expanding publicity rights,<sup>161</sup> and others have argued against postmortem publicity rights because the information—the likeness of the deceased celebrity—should be in the public domain.<sup>162</sup> Other commentators have raised questions about the intersection of publicity rights and copyrights.<sup>163</sup>

Another issue involves publicity rights in the context of the Internet. California's postmortem publicity rights statute does not clearly state what publicity rights exist online.<sup>164</sup> A substantial number of Internet images are not involved in the advertising or sale of goods or services, and those that are, may fall into the excluded category of audiovisual work.<sup>165</sup>

In enacting SB 771, California granted extended publicity rights protection retroactively by an additional twenty years. But this new protection may affect pre-existing contracts and licenses. Licensees of copyrighted material will presumably be required to obtain a second license. If the licensee has invested in production and marketing, another publicity rights license could prove very costly.<sup>166</sup> Finally, publicity rights that may have entered the public domain under the old laws may be resurrected as private property because of SB 771's retroactive grant. Anyone utilizing such rights may be required to obtain a license.

The California Legislature's rush to "abrogate" the Monroe cases is not the first time a state legislature came to the rescue of celebrity estates. When the estate of Elvis Presley lost in court, the Tennessee Legislature responded by passing broad protections that last longer than in any other state—theoretically in perpetuity—so long as the publicity right is not abandoned.<sup>167</sup>

Indiana, "which is often considered the most aggressive and well-defined statutory scheme in the United States,"<sup>168</sup> is home to CMG Worldwide, Inc. The Indiana statute provides for a cause of action without regard for the plaintiff's or defendant's domicile if any infringing material is lo-

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(2004); W. Mack Webner & Leigh Ann Lindquist, *Transformation: The Bright Line Between Commercial Publicity Rights and the First Amendment*, 37 AKRON L. REV. 171 (2004).

<sup>161</sup> See, e.g., Dogan, *supra* note 52, at 296–97.

<sup>162</sup> See, e.g., Jeremy T. Marr, *Constitutional Restraints on State Right of Publicity Laws*, 44 B.C. L. REV. 863, 864–65 (2003).

<sup>163</sup> See, e.g., Aaron A. Bartz, *...And Where It Stops, Nobody Knows: California's Expansive Publicity Rights Threaten the Federal Copyright System*, 27 SW. U. L. REV. 299 (1997); Brown v. Ames, 201 F.3d 654, 658–60 (5th Cir. 2000) (finding that Congress did not intend to preempt); Toney v. L'Oreal U.S.A., Inc., 384 F.3d 486 (7th Cir. 2004) (finding publicity right preempted by copyright law).

<sup>164</sup> See Pamela Lynn Kunath, *Lights, Camera, Animate! The Right of Publicity's Effect on Computer-Animated Celebrities*, 29 LOY. L.A. L. REV. 863, 883 (1996).

<sup>165</sup> See, e.g., *id.*; Joseph D. Schleimer, *Problems Encountered in Protecting Living and Deceased Actors' 'Virtual Rights'*, 16 ENT. L. & FIN., Oct. 2000, at 1; Thomas Glenn Martin Jr., Comment, *Rebirth and Rejuvenation in a Digital Hollywood: The Challenge Computer-Simulated Celebrities Present for California's Antiquated Right of Publicity*, 4 UCLA ENT. L. REV. 99, 101 (1996); Perfect 10, Inc. v. Cybernet Ventures, Inc., 213 F. Supp. 2d 1146 (C.D. Cal. 2002).

<sup>166</sup> See Soni Letter, *supra* note 129.

<sup>167</sup> TENN. CODE ANN. § 47-25-1104(b)(2) (Supp. 2001).

<sup>168</sup> Lapter, *supra* note 57, at 259.

cated within Indiana,<sup>169</sup> a provision used by CMG Worldwide to gain jurisdiction for the Monroe cases in Indiana. California's statute affords plaintiffs similar reach, applying whenever

the liability, damages, and other remedies arise from acts occurring directly in this state. [A]cts giving rise to liability shall be limited to the use, on or in products, merchandise, goods, or services, or the advertising or selling, or soliciting purchases of, products, merchandise, goods, or services . . . .<sup>170</sup>

Perhaps, not surprisingly, as SB 771 was zipping through the legislative process in California, legislation was introduced in New York to create postmortem publicity rights for the first time.<sup>171</sup> The bill would create rights for any person who died after 1938, and like Tennessee's law, continue unless abandoned.<sup>172</sup> A pending New York bill would immediately make unlawful uses of a person's "portrait, name, voice, signature or picture that are currently legal[.]" and prohibit use of a name or likeness even if it was authorized by the person before death.<sup>173</sup>

#### CONCLUSION

The owners and licensors of postmortem publicity rights have enjoyed legislative victories in key states, as each victory broadened the scope of their rights and strengthened available enforcement mechanisms. While Indiana and California may become a plaintiff's venue of choice, some courts will continue to struggle with diverse and ambiguous state laws. As a result, some, including the American Bar Association, recommend enactment of a federal publicity rights statute "in order to curb significant forum shopping and to provide advertisers and celebrities with the precise boundaries of protection."<sup>174</sup> The Internet, satellite television, and the growth of a global economy have called for an international copyright protection scheme within international intellectual property treaties.<sup>175</sup>

If the postmortem publicity rights industry is as successful in a national and international arena as it has been in California, the \$232 million earned by the thirteen top grossing dead celebrities in 2007 is only the beginning of a very lucrative future.

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<sup>169</sup> IND. CODE ANN. § 32-36-1-1 (West 2006).

<sup>170</sup> CAL. CIV. CODE ANN. § 3344.1(n) (West Supp. 2008).

<sup>171</sup> Mitchell M. Gans et al., *Postmortem Rights of Publicity: The Federal Estate Tax Consequences of New State-Law Property Rights*, YALE L.J. ONLINE POCKET PART, Apr. 1, 2008, <http://www.thepocketpart.org/2008/04/01/ganscrawfordblattmachr.html> ("California recently passed legislation that creates retroactive, descendible rights of publicity. The New York State Assembly is poised to enact similar legislation.")

<sup>172</sup> Tennessee's right of publicity terminates upon proof of non-use in two of any ten years after the person's death. TENN. CODE ANN. § 47-25-1104(b)(2) (Supp. 2001).

<sup>173</sup> Sara L. Edelman, *Death Pays: The Fight Over Marilyn Monroe's Publicity Rights*, METROPOLITAN CORP. COUNSEL, July 2007, at 39.

<sup>174</sup> Lapter, *supra* note 57, at 243; *see also* Marr, *supra* note 162, at 864; Symposium, *Rights of Publicity: An In-Depth Analysis of the New Legislative Proposals to Congress*, 16 CARDOZO ARTS & ENT. L.J. 209 (1998).

<sup>175</sup> Lapter, *supra* note 57, at 244.

## APPENDIX A:

## LAST WILL &amp; TESTAMENT OF MARILYN MONROE\*

I, MARILYN MONROE, do make, publish and declare this to be my Last Will and Testament.

FIRST: I hereby revoke all former Wills and Codicils by me made.

SECOND: I direct my Executor, hereinafter named, to pay all of my just debts, funeral expenses and testamentary charges as soon after my death as can conveniently be done.

THIRD: I direct that all succession, estate or inheritance taxes which may be levied against my estate and/or against any legacies and/or devises hereinafter set forth shall be paid out of my residuary estate.

## FOURTH:

(a) I give and bequeath to BERNICE MIRACLE, should she survive me, the sum of \$10,000.00.

(b) I give and bequeath to MAY REIS, should she survive me, the sum of \$10,000.00.

(c) I give and bequeath to NORMAN and HEDDA ROSTEN, or to the survivor of them, or if they should both predecease me, then to their daughter, PATRICIA ROSTEN, the sum of \$5,000.00, it being my wish that such sum be used for the education of PATRICIA ROSTEN.

(d) I give and bequeath all of my personal effects and clothing to LEE STRASBERG, or if he should predecease me, then to my Executor hereinafter named, it being my desire that he distribute these, in his sole discretion, among my friends, colleagues and those to whom I am devoted.

FIFTH: I give and bequeath to my Trustee, hereinafter named, the sum of \$100,000.00, in Trust, for the following uses and purposes:

(a) To hold, manage, invest and reinvest the said property and to receive and collect the income therefrom.

(b) To pay the net income therefrom, together with such amounts of principal as shall be necessary to provide \$5,000.00 per annum, in equal quarterly installments, for the maintenance and support of my mother, GLADYS BAKER, during her lifetime.

(c) To pay the net income therefrom, together with such amounts of principal as shall be necessary to provide \$2,500.00 per annum, in equal quarterly installments, for the maintenance and support of MRS.



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\* On file with N.Y. Surr. Ct., 4th Dist., available at [http://www.courts.state.ny.us/courts/4jd/warren/surrogates\\_will\\_monroe.shtml](http://www.courts.state.ny.us/courts/4jd/warren/surrogates_will_monroe.shtml).



MICHAEL CHEKHOV during her lifetime.

(d) Upon the death of the survivor between my mother, GLADYS BAKER, and MRS. MICHAEL CHEKHOV to pay over the principal remaining in the Trust, together with any accumulated income, to DR. MARIANNE KRIS to be used by her for the furtherance of the work of such psychiatric institutions or groups as she shall elect.

SIXTH: All the rest, residue and remainder of my estate, both real and personal, of whatsoever nature and wheresoever situate, of which I shall die seized or possessed or to which I shall be in any way entitled, or over which I shall possess any power of appointment by Will at the time of my death, including any lapsed legacies, I give, devise and bequeath as follows:

(a) to MAY REIS the sum of \$40,000.00 or 25% of the total remainder of my estate, whichever shall be the lesser,

(b) To DR. MARIANNE KRIS 25% of the balance thereof, to be used by her as set forth in ARTICLE FIFTH (d) of this my Last Will and Testament.

(c) To LEE STRASBERG the entire remaining balance.

SEVENTH: I nominate, constitute and appoint AARON R. FROSCH Executor of this my Last Will and Testament. In the event that he should die or fail to qualify, or resign or for any other reason be unable to act, I nominate, constitute and appoint L. ARNOLD WEISSBERGER in his place and stead.

EIGHTH: I nominate, constitute and appoint AARON R. FROSCH Trustee under this my Last Will and Testament. In the event he should die or fail to qualify, or resign or for any other reason be unable to act, I nominate, constitute and appoint L. Arnold Weissberger in his place and stead.

Marilyn Monroe (L.S.)

SIGNED, SEALED, PUBLISHED and DECLARED by MARILYN MONROE, the Testatrix above named, as and for her Last Will and Testament, in our presence and we, at her request and in her presence and in the presence of each other, have hereunto subscribed our names as witnesses this 14th day of January, One Thousand Nine Hundred Sixty-One

Aaron R. Frosch residing at 10 West 86th St. NYC  
Louise H. White residing at 709 E. 56 St., New York, NY