

Part II:

Aggressive Lawyering to Protect the "Virtual Rights" of Living and Deceased Actors

by

Joseph D. Schleimer, Esq.
Schleimer & Freundlich LLP
Beverly Hills, California

(Part II of II)

*(See, also, [PART I: "Legal Problems in Protecting the 'Virtual Rights' of Living and Deceased Actors"](#)
by Joseph D. Schleimer, Esq., *Entertainment Law & Finance*, October, 2000)*

The motion picture industry is experiencing a revolution in computer-generated imaging, and the technology already exists to make new motion pictures which "star" deceased actors. Unfortunately, as discussed in Part I of this article, legal protection for the "virtual rights" of actors has been undermined by recent court rulings, and industry lobbying has watered down statutory protection, thus creating a legal environment in which such films could potentially be made without the consent of the actors' estates.

The purpose of this article is to show how the legal hurdles to the protection of "virtual rights" can be overcome through aggressive lawyering--and how to develop the law to ensure that actors' *post mortem* "virtual rights" are vigorously protected.

Common Law Protection for "Virtual Rights"

With the right case, in the right forum, a *common law* action to protect "virtual rights" *could* be successful:

In Brown v. Ames, 201 F.3d 654 (5th Cir. 2000), the Fifth Circuit applied the common law to enforce the right of publicity in an *entertainment context*. The court defined the Texas tort of "misappropriation of personality" as including *any* use of name, image or likeness "for the value associated with it and not in an incidental manner or for a newsworthy purpose....."

Significantly, Brown v. Ames expressly rejected a "preemption" defense. The court cited the legislative history of the preemption clause of the Copyright Act (17 U.S.C. §301) and concluded that Congress had *considered* preempting right-of-publicity claims--but had elected *not* to do so. Id., 201 F.3d at 658-60.

While the Fifth Circuit was rejecting the "preemption" doctrine, the Ninth Circuit was embracing it. Comedy III Productions, Inc. v. New Line Cinema, 200 F.3d 593 (9th Cir. 2000), decided at virtually the same time as Brown v. Ames, specifically held that the Copyright Act preempts trademark and right of publicity claims by actors. Comedy III cited and relied on Fleet v. CBS, Inc. (1996) 50 Cal.App.4th 1911, an earlier decision by the California Court of Appeal which held that an actor's claim for name and likeness infringement under California law was preempted by the Copyright Act.

Such reliance on California precedent may have been premature. At about the same time the Comedy III case was being decided, the California Court of Appeal was retreating from its earlier ruling in Fleet. In KNB Enterprises v. Matthews (2000) 78 Cal.App.4th 362, the court expressly "[limited] *Fleet's* broad language regarding preemption of the actors' section 3344 claims to the unique facts of that case." In support of its opinion, the court cited *Nimmer on Copyright* to the effect that "a *persona* can hardly be said to constitute a 'writing' of an 'author'....[A] name and likeness do not become a work of authorship simply because they are embodied in a copyrightable work such as a photograph."

KNB Enterprises is consistent with a number of cases which have held that the right of publicity is *not* preempted by the Copyright Act because the tort requires proof of an "extra element" to establish

liability. Thus, despite the problems created by the Comedy III ruling, a strong case can be made for limiting that decision to its facts, or even outright reversal.

Georgia Law Offers Strong Protection for "Virtual Rights"

Entertainment lawyers seeking to vigorously protect the "virtual rights" of actors may want to consider making their stand in Georgia. The Supreme Court of Georgia recognizes a strong *post-mortem* right of publicity--and applies it to *any* commercial use of a celebrity's likeness. In Martin Luther King, Jr., Center for Social Change, Inc. v. American Heritage Products, Inc. (1982) 250 Ga. 135, 296 S.E.2d 697 (incorporated and re-published at 694 F.2d 674 (11th Cir. 1983)), the Supreme Court of Georgia adopted Dean Prosser's broad definition of the right of publicity tort--and rejected any requirement for exploitation during life:

"A well known minister may avoid exploiting his prominence during life because to do so would impair his ministry. Should his election not to take commercial advantage of his position during life ipso facto result in permitting others to exploit his name and likeness after his death? In our view, a person who avoids exploitation during life is entitled to have his image protected against exploitation after death just as much if not more than a person who exploited his image during life."

Since Georgia provides strong protection for the "virtual rights" of actors, can *actors who reside in other states* sue in Georgia--based on a *national* infringement which reaches into the territory of Georgia?

Possibly not. In The Diana Princess of Wales Memorial Fund v. Franklin Mint Co., 1999 U.S. App. Lexis 34568 (9th Cir. 1999), the United

States Court of Appeals for the Ninth Circuit refused to apply California right-of-publicity law on behalf of the survivors of the late Princess, because Diana was domiciled in Great Britain at the time of her death. British common law does not recognize a post-mortem right of publicity, so the unfavorable choice-of-law ruling meant there was no remedy available in that case.

A *living* actor can choose the state law which will protect his or her "virtual rights" by changing domicile, but it does not seem likely that many celebrities will be willing to relocate to Georgia and *die* there--just to obtain a sympathetic venue and favorable law for their heirs.

However, the Georgia venue could potentially be invoked through an *assignment* of an actor's virtual rights to a licensing corporation *headquartered* in that state. Thus, a cottage industry for licensing (and protecting) *post-mortem* "virtual rights" may well spring up in Atlanta.

Developing California Law To Protect *Post Mortem* "Virtual Rights"

California is the domicile of many celebrities, and as such it is clearly the most important state where the protection of virtual rights is concerned. As the result of industry lobbying, however, California Civil Code §3344.1(a)(2) expressly excludes *entertainment* uses from *post mortem* protection of the right of publicity.

Moreover, the California Supreme Court has held, under common law, that the right of publicity is not "descendible," i.e., it cannot be enforced after an actor's death. Lugosi v. Universal Pictures (1979) 25 Cal.3d 813, 603 P.2d 425.

Despite these problems, a common law claim for violation of *post mortem* virtual rights *could* still succeed under California law, for the following reasons:

First, the Civil Code, while not helpful, does not *hinder* common law protection. In fact, the statute which created the *post mortem* right of publicity in a commercial advertising context contains an express

disclaimer, stating that *other* legal remedies are *not* limited by it. See, California Civil Code §3344.1(m).

Second, where *entertainment* uses of name and likeness are concerned, Lugosi can actually be cited to *support* such rights. The reason is, the Lugosi decision involved merchandising, not entertainment, and the California Supreme Court's *ratio decidendi* was based on Mr. Lugosi's failure to exploit merchandising rights while he was still alive:

**"Lugosi could have created during his lifetime through the commercial exploitation of 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, the effect of which would have been to impress such business, product or service with a secondary meaning, protectable under the law of unfair competition."
Id., 25 Cal.3d at 818**

As per this reasoning, Lugosi imported the trademark concept of "usage-in-trade" as an element of a *post mortem* name-and- likeness claim. As such, the California Supreme Court actually set the stage for *recognition* of a common law doctrine of *post mortem* virtual rights *in entertainment*, because any famous, deceased actor will obviously have used his or her name, voice and likeness "in trade" while still alive. Indeed, the sole reason why deceased movie stars are likely to be computer "reanimated" in the first place is because their filmed performances have left a legacy of good will and "general acceptance" which is worthy of exploitation after death.

One recent motion picture ("*Gladiator*") contained an entire, computer-generated scene starring a principal cast member (Oliver

Reed) who had died during filming. With the new "synthespian" technology about to make a major impact, the time is ripe for a test case in California, to establish *post mortem* "virtual rights" under California common law *in an entertainment context*.

To put it another way, any film producers who rely on Lugosi and Civil Code §3344.1(a)(2) to use "virtual" performances by deceased actors *without permission* should expect to get *sued*.

Rebutting the "First Amendment" Defense

As pointed out in Part I of this article, unauthorized "biographical," public affairs and docudrama programs using photorealistic reanimations of celebrities *may* have First Amendment immunity against right-of-publicity suits. However, the courts have already recognized three *exceptions* to First Amendment protection in an analogous context:

First, in Eastwood v. Superior Court (1983) 149 Cal.App.3d 409, 198 Cal.Rptr. 342 ("Eastwood I"), the court created a "subterfuge" rebuttal to the First Amendment defense. In that case, the *National Enquirer* had run a cover story entitled "*Clint Eastwood in Love Triangle With Tanya Tucker*," accompanied by a photograph of Mr. Eastwood. The headline, and the photograph, were also used in television advertising for the tabloid.

Eastwood sued for, among other things, violation of his right of publicity. The Superior Court dismissed Eastwood's right of publicity claims based on the First Amendment and the "news account" immunity to the right of publicity tort. The Court of Appeal reversed, and reinstated Eastwood's claim, characterizing the journalistic guise of the story as a "subterfuge." The Court of Appeal viewed the "news" report as nothing more than a thinly-disguised attempt to trade on the actor's immense popularity, to advertise and sell newspapers.

The second exception was established by Eastwood's *second* lawsuit against the *National Enquirer*: In Eastwood v. National Enquirer, Inc., 123 F.3d 1249 (9th Cir. 1997)("Eastwood II"), the Ninth Circuit

recognized injurious falsehood--together with "actual malice"--as a means of rebutting a First Amendment defense to a right-of-publicity claim. In that case, the tabloid ran an "exclusive interview" with Eastwood--which was completely fabricated. Although the fake "interview" was innocuous and non-defamatory in its content, Eastwood's lawyers convinced the court that it would damage the actor's reputation if his fans thought he had even *given an interview* to the notorious tabloid. Although the Ninth Circuit held that Eastwood is a "public figure" and applied the rigorous "actual malice" standard from libel law to his right of publicity claim, the court held that the test was satisfied because the *Enquirer* should have known the interview was faked.

The third exception, which for lack of a better name could be called "*excessive appropriation*," was laid down by the U.S. Supreme Court in *Zacchini v. Scripps-Howard Broadcasting, Co.*, 433 U.S. 562, 576 (1977). In that case, a television news broadcaster filmed and aired a "human cannonball" performance in its entirety. Mr. Zacchini sued for violation of his right of publicity, and the television station argued that it had a First Amendment right to "cover" the plaintiff's performance because it was newsworthy. The Supreme Court described Zacchini's right of publicity as a *property* right, which the station had violated because it broadcast his *entire act*. Although the film clip was only a few seconds long, this went beyond an "incidental" use of the entertainer's name or picture and the broadcaster was guilty of "the appropriation of the very activity by which the entertainer acquired his reputation in the first place."

The same argument would apply to a virtual reanimation of an actor. Virtual realism in the portrayal of *entertainers* is not essential to create a filmed biography, nor any other public affairs program. The "virtual rights" of actors, living and deceased, should be respected, and the First Amendment should not be exploited as a subterfuge, because otherwise an important *property right* will be destroyed.

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