FICTIONAL CHARACTERS AND REAL PEOPLE

Leslie A. Kurtz*

I. INTRODUCTION

Fictional characters and the performers who play them both have a powerful hold on the human imagination and are important parts of our modern myths. Fictional characters are of great value in the ongoing process of creation and serve as building blocks for the development and expansion of our culture. Those who play fictional characters are often celebrities whose personae, in a celebrity-obsessed world, are packed with a rich set of widely understood connotations.1 We live and work within our culture and the language and symbols that inhabit it, and fictional characters and celebrities are among the most important of these symbols. They can encapsulate ideas, evoke emotions or conjure up images.

Fictional characters come in many shapes, sizes and types. They can be used outside their original contexts. They can take on lives of their own, moving from one story to another, from one medium to another, from stories to merchandise and back again. Characters such as Sherlock Holmes, Harry Potter and Mickey Mouse may be more valuable and well-known than any individual work in which they appear. In a world of sequels, spinoffs, remakes and character-marketing programs, characters may be of enormous financial, as well as artistic, importance. Fictional characters are elements of popular culture, an integral part of our social structure, and are of great value in creating new works.2 They are central to the most common types of recycling and reuse in the entertainment business.3

Fictional characters can seem very real to those who create them and those who encounter them. “Bianchon would have saved me!” said Balzac on his deathbed, “referring to the great physician . . . he himself had

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* Professor of Law, University of California, Davis. B.A., Brown University; M.A., New York University; J.D., Columbia University.
2 Id.
3 See Dennis S. Karjala, *Harry Potter, Tanya Grotter, and the Copyright Derivative Work*, 38 ARIZ. ST. L.J. 17, 26 (2006) (“Popular characters have an economic value that extends well beyond the right to reproduce copies of the stories in which they appear or to make movie versions of those stories.”).
created.”4 Sherlock Holmes’ author, Sir Arthur Conan Doyle, said that he never realized what “a living actual personality Holmes had become” until he heard a group of French schoolboys who, when asked what they wanted to see first in London, unanimously opted to see Holmes’ lodgings in Baker Street.5 Agatha Christie’s Belgian detective, Hercule Poirot, received front-page news coverage in the New York Times when his obituary appeared on August 6, 1975, with a headline reading: “Hercule Poirot Is Dead; Famed Belgian Detective; Hercule Poirot, the Detective, Dies.”6 Fan communities care passionately about such works as the Harry Potter, The Lord of the Rings and the Star Trek series.7

Although fictional characters ordinarily appear within the context of a work or works that are protected by copyright, they are not themselves protected works.8 Each book or movie in which Harry Potter appears is copyrightable, but Harry himself is not. However, characters can be used apart from the stories in which they have appeared. Therefore, efforts have been made to determine when and how the use of a character, outside its original context, will be infringing. In deciding whether it is infringing to use a character, or elements of a character, created by another author, courts often focus on whether the character is protected.9 Some fairly clear parameters exist for protecting characters that appear in visual form, such as cartoons.10 They exist to a lesser extent for literary works.11 Those parameters are even murkier for characters appearing in audiovisual works, such as motion pictures and television, where fictional characters are often played by real people.

The performers who play the role of fictional characters are real human beings. Like fictional characters, they play important parts in our culture. There is enormous interest in the lives, careers, personalities and styles of celebrities.12 The aura of celebrity is of enormous value in an age of mass

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5 Arthur Conan Doyle, Sidelights on Sherlock Holmes, in THE BAKER STREET READER, supra note 4, at 11, 14.
7 See infra notes 51–58 and accompanying text.
11 See discussion infra Part II.
production and communications technologies. Celebrities are “leading players in our Public Drama” and “widely used . . . to symbolize individual aspirations, group identities, and cultural values.”

Real people are not protected by copyright; they are not the authors of themselves. In many states, however, they do have the right to prevent the use of elements of their identity under the right of publicity. At the core of the right is protection against the use of the name or likeness of an individual, usually a celebrity, in advertising, without permission. However, wherever the right is recognized, it goes beyond this and protects against the appropriation of the commercial value of a person’s identity, including her name and likeness. The right of publicity is amorphous and varies from state to state. A number of questions can be raised that defy easy answers. What aspects of a person’s identity are protected against appropriation? What does it mean to use a person’s identity commercially? What limits are placed on the right by constitutional guarantees of free speech and free press?

Because fictional characters and celebrities are powerful and valuable signifiers, it is easy to conclude that they should be powerfully protected. But the fact that something is useful and valuable does not lead to the inevitable conclusion that it must be subject to exclusive rights. The cultural power of fictional characters and celebrities is dependent on the connotations and evocations associated with them. The importance of fame and fascination with celebrities in our culture does not answer the question of who, if anyone, should own the accoutrements of that fame. Too great a level of protection will interfere with our ability to reimagine the world and make use of what already exists around us.

Furthermore, when fictional characters are portrayed by real people, the characters will look and sound much like the performers. There is, therefore, a potential conflict between the rights of the copyright owner and the rights of the performer. Duplicate and conflicting rights can complicate still further our ability to make use of cultural resources. This conflict intensifies when we consider the ability of new technology to digitally manipulate and change what actors do on the screen, and to move elements into real-time environments.

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13 Id.
16 See id. § 4:3.
17 Id. § 1:3.
18 Id. § 6:7.
19 See Dreyfuss supra note 1, at 138. Dreyfuss notes that “[t]his is the reason that metaphors, similes and metonyms are so prevalent in discourse.” Id.
Is what is being manipulated the actor, the character or both?

In Part II, this Article looks at the nature and justification for providing federal copyright protection to fictional characters. Part III considers the nature and underlying reasons for the state law right-of-publicity protection given to real people. Part IV looks at the way in which these protections, and their appropriate limits, come together, considering issues that arise when real people play fictional characters, the nature of digital characters created using real people and the importance of allowing the creative use of what exists in our culture.

II. FICTIONAL CHARACTERS AND COPYRIGHT

Fictional characters exist in tangible form within the specific words, pictures and sounds created by their authors. These words, pictures and sounds, however, also create images in the minds of those who perceive them, making it possible to recognize a character in a new situation. These characters, removed from their original contexts, can take on lives of their own.

When a character is born, he acquires at once such an independence, even of his own author, that he can be imagined by everybody even in many other situations where the author never dreamed of placing him; and so he acquires for himself a meaning which the author never thought of giving him.

The reworking of stories and characters draws on what already exists in the culture. “One fact about writers is that the books they love most are also the books they most want to rewrite. It is a ravenous sort of love, a need to fully know and possess the object of desire.” A variety of characters have been used by authors to reimagine the world. Tom Stoppard used two minor characters from Shakespeare’s Hamlet to explore the nature of tragedy in today’s world. In the comedy Wittenberg, the author takes two fictional characters, Hamlet and Dr. Faustus, and puts

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20 See discussion infra Part IV.B.
21 See Kurtz, supra note 9, at 430.
22 See id. at 430–31.
23 See id. at 430–32.
24 LUIGI PIRANDELLO, Six Characters in Search of an Author, in NAKED MASKS; FIVE PLAYS 211, 268 (Eric Bentley ed., 1952).
26 TOM STOPPARD, ROSENCRANTZ AND GUILDENSTERN ARE DEAD (1967).
them together with the real Martin Luther in Wittenberg, Germany in 1517, 
addressing issues of reason versus faith. In Desdemona: A Play About a 
Handkerchief, Paula Vogel looks at Shakespeare’s Othello through the eyes 
of its female characters. Lo’s Diary looks at the events of Nabokov’s 
Lolita from Lolita’s point of view. In March, Geraldine Brooks tells the 
story of the father and Civil War chaplain, absent from nearly all of Little 
Women. Mark Twain’s world of Tom Sawyer and Huckleberry Finn has 
also been recreated by other authors. Becky Thatcher from Tom Sawyer 
and Huck Finn’s father have been taken from Twain’s works and placed 
in the center of stories of their own. Jean Rhys wrote a novel about the 
early life of the first Mrs. Rochester, the mysterious prisoner and setter of 
fires in Jane Eyre, illuminating her character and that of Mr. Rochester. 
The novel Mary Reilly retells the story of Stevenson’s Dr. Jekyll and Mr. 
Hyde through the eyes of the doctor’s maid. Ahab’s Wife tells the story of 
the wife of the hunter of Moby Dick. Wicked tells us of the troubled 
youth of the green-skinned Elpheba, who would become known as the 
Wicked Witch of the West. 

So many books have been written about Sherlock Holmes that he has 
been given his own Library of Congress number. The basic premise of 
the Baker Street Irregulars, the first organization dedicated to studying 
Holmes, is that Sherlock Holmes, Dr. Watson and their adventures are real 
people and events. Sir Arthur Conan Doyle, if he is acknowledged at all,

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Wittenberg tells the story of university colleagues John Faustus (a philosophy professor) and 
Martin Luther (instructor in theology), and their mutual star pupil, Hamlet, Prince of 
Denmark. The play serves as a prequel of sorts to the stories we already know of these 
individuals, and explains how they ended up making the fateful choices that they did.

Looking at New Plays: David Davalos’ Wittenberg,’ ORLANDO THEATER BLOG (Feb. 14, 2008, 8:00 

28 See PAULA VOGEL, Desdemona: A Play About a Handkerchief, in THE BALTIMORE WALTZ 173 
(1996).


30 See GERALDINE BROOKS, MARCH (2005).


33 See JEAN RHYS, WIDE SARGASSO SEA (1966).

34 See VALERIE MARTIN, MARY REILLY (1990).

35 See SENA JETER NASLUND, AHAB’S WIFE (2000).

36 See GREGORY MAGUIRE, WICKED: THE LIFE AND TIMES OF THE WICKED WITCH OF THE WEST 

37 L.C. N. PR 4624, Holmes, Sherlock (fictional character).

38 See Philip A. Shreffler, “Come, Watson, Come. The Game Is Afoot!,” in THE BAKER STREET 
READER, supra note 4, at 3, 4. Baker Street Irregulars have included Dorothy Sayers and Rex Stout. See 
S.C. Roberts, A Biographical Sketch of Sherlock Holmes, in THE BAKER STREETREADER, supra, at 47,
is merely Dr. Watson’s literary agent. 39 Sherlock Holmes,40 Dr. Watson,41 Sherlock’s brother Mycroft,42 the villainous Professor Moriarty,43 housekeeper to Holmes and Watson, Mrs. Hudson44 and the woman, Irene Adler,45 have all been the subjects of “biographies.”46

The Holmes characters have been plucked from their original contexts to live new lives in new books by new authors. Holmes has appeared in the book and film, *The Seven-Per-Cent Solution*, where he is tricked by Watson into following Professor Moriarty to Vienna to be cured of cocaine addiction by Sigmund Freud,47 and another movie features the adventures of a young Sherlock Holmes at Brompton Boarding School in London.48 Laurie R. King has written a series of mystery novels featuring Holmes and his wife Mary Russell (created by King).49 The character of Dr. Gregory House in the television program *House* was inspired in part by Sherlock Holmes, and his friend, Dr. James Wilson, has parallels to Dr. Watson.50


44 See generally Vincent Starrett, The Singular Adventures of Martha Hudson, in *Baker Street Studies*, supra note 41, at 85.


46 Sherlock, Watson, Mycroft, Moriarty and Adler are all extensively biographed on the Internet. Just type a name as a Google query.


50 See Pasha Adams, Reflecting on House with Creator David Shore, *Huffington Post* (Oct. 9, 2012, 4:58 PM), http://www.huffingtonpost.com/pasha-adam/house-david-shore_b_1942525.html; When Does House, M.D. Season 5 Start?, *Yahoo! Answers*, http://answers.yahoo.com/question/index?qid=20080930132757AAWzL3h (last visited Apr. 28, 2013) (“This resemblance is evident in various elements of the series’ plot, such as House’s reliance on psychology to solve a case, his reluctance to accept cases he does not find interesting, his drug addiction, home address (apartment 221B, the same number as Holmes’ home), playing of an instrument, relationship with Dr. James Wilson (who parallels Dr. John Watson), and his encounter with a crazed gunman credited as ‘Moriarty,’ which is the same name as Holmes’ nemesis. Also, series creator David Shore has said that Dr. House’s name is meant as ‘a subtle homage’ to Sherlock Holmes . . . .”).
Fan communities care passionately about such works as the *Harry Potter* and *The Lord of the Rings* series and write fan fiction—innumerable stories featuring their characters. Fan creations “represent a vibrant subculture, one that inspires passion among thousands of people who find creative outlets in shared universes.” A fan can insert herself into a story as a Mary Sue, who may save the *Enterprise*, the *Voyager*, or the fabric of time and space, or battle evil in Sunnydale along with Buffy Summers. She can rewrite a story from the point of view of a minor character of a villain or add explicit sexual content or same-sex pairings. Fan fiction can empower its author and provide a means of contesting cultural stereotypes. The philosophy of fan fiction involves sharing and playing pretend with one another. Fans can “transcend passive reception” and facilitate participation in “the processes by which meaning is made and communicated.”

The ability to rework characters, however, can be affected by copyright. Copyright protects original works of authorship fixed in a tangible medium. Ordinarily, the work in which a character appears—the book, movie, play, television program or game—is copyrightable. Fictional characters are elements of such copyrightable works. But they are agile and slippery creatures, difficult to grasp firmly. They are capable of moving from one story to another, changing, growing and undergoing new experiences. They are capable of an existence independent of the stories that gave them life. Therefore, courts have found it difficult to determine when copyright protection extends to characters, apart from any particular work or works in which they have appeared.

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51 Fan fiction, also called “fan fic,” is a broadly defined term for “stories involving popular fictional characters that are written by fans and often posted on the Internet.” *Fan Fiction*, MERRIAM-WEBSTER, http://www.merriam-webster.com/dictionary/fan%20fiction (last visited Apr. 28, 2013).
55 *Slash Fic*, TVTROPES, http://tvtropes.org/pmwiki/pmwiki.php/Main/SlashFic (last visited Apr. 28, 2013). This is generally known as “slash fiction.” *Id.*
56 Chander & Sunder, supra note 54, at 599.
58 *Id.* at 653–54.
60 See Kurtz, supra note 9, at 430.
61 See id.
62 See id. at 437.
The basic legal tools that are being used in deciding the question of when a character alone, separate from any particular plot, can be protected against copying are derived from cases involving cartoon and literary characters. Cartoon characters have presented few problems. The pictorial nature of a visual character provides something concrete and specific to look at, against which the similarity of another character can be judged. Mickey Mouse and Marge Simpson look the same to you as they do to me. Little imagination is required in perceiving them. Therefore, they are readily found to be protected, and the focus quickly shifts to a comparison of the plaintiffs’ and defendants’ characters to see if the similarity between them is sufficient for infringement.

Literary characters—those depicted by portraits drawn in words—have presented more difficulties and complications. They exist as abstract mental images, seen not by the eyes but with the mind. The author’s words convey different images to different minds. The character may be created initially by the author, but the character may come to life in your mind in a different way than it comes to life in mine. It cannot be directly perceived. It is far easier to compare visual images than abstractions. As a result, courts have struggled to determine when a literary character has those qualities that entitle it to copyright protection. Two basic tests have been created for determining when literary characters will be protected, and neither is clear or easy to apply.

The first, which has become known as the development test, asks whether a character is sufficiently distinctive or well-developed to command protection. It has its origin in a much-quoted statement by Judge Learned Hand in *Nichols v. Universal Pictures Corporation*, where the author of the play *Abie’s Irish Rose* alleged that her play had been infringed by the movie *The Cohens and the Kellys*. Judge Hand said that characters might correspond in plot closely enough for infringement, quite independent of the plot.

If *Twelfth Night* were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight

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63 See generally Walt Disney Prods. v. Air Pirates, 581 F.2d 751 (9th Cir. 1978).
64 See generally Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc., 73 F.2d 276 (2d Cir. 1934). When a Betty Boop doll looked just like the cartoon character Betty Boop, there was infringement. Id. at 278; see also United Artists Corp. v. Ford Motor Co., 483 F. Supp. 89 (S.D.N.Y. 1980). But the animated cougar in the Lincoln-Mercury commercial was too unlike the animated Pink Panther from the *Pink Panther* films for infringement to exist. Id. at 96. The cougar was more realistically catlike and had a different personality. Id.
65 See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).
66 Id. at 120.
who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare’s “ideas” in the play, as little capable of monopoly as Einstein’s Doctrine of Relativity or Darwin’s theory of the Origin of Species. It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.\footnote{Id. at 121.}

The development test is “simple in theory but elusive in application.”\footnote{Anderson v. Stallone, 11 U.S.P.Q.2d (BNA) 1161, 1165 (C.D. Cal. 1989).} Clearly, basic character types are not protected. But what characteristics make a character sufficiently “developed” or “distinctive” to deserve protection? It seems probable that the more idiosyncratic a character is, the more likely it is to be considered distinctive.\footnote{See Kurtz, supra note 9, at 463–64.} A character with well-defined and consistent characteristics may be more memorable and more readily removed from its initial context.\footnote{For a discussion of this point, see id. at 464–65.} It may be difficult to describe just why even such a character is well developed. One court, attempting to explain what it is that makes Tarzan sufficiently distinct for protection, said: “Tarzan is the ape-man. He is an individual closely in tune with his jungle environment, able to communicate with animals yet able to experience human emotion. He is athletic, innocent, youthful, gentle and strong. He is Tarzan.”\footnote{Burroughs v. Metro-Goldwyn-Mayer, Inc., 519 F. Supp. 388, 391 (S.D.N.Y. 1981), aff’d, 683 F.2d 610 (2d Cir. 1982). Of course, except for the last three words, so is Rudyard Kipling’s Mowgli. See generally RUDYARD KIPLING, THE JUNGLE BOOK (1894).} We can feel, in the final three words, a sense of frustration. The description is problematic. Surely another author could write a non-infringing story about an individual in tune with a jungle environment, able to communicate with animals, who is innocent, youthful, gentle and strong.\footnote{Indeed, the description seems to fit Rudyard Kipling’s Mowgli as well as Tarzan. See KIPLING, supra note 71.}

The second test used for literary characters, created by the Ninth Circuit in the \textit{Sam Spade} case,\footnote{Warner Bros. Pictures, Inc. v. Columbia Broad. Sys., Inc., 216 F.2d 945 (9th Cir. 1954).} is even more problematic. It asks whether the character constitutes the story being told or is simply a chessman in the game of telling the story.\footnote{Id. at 950.} In that case, Dashiell Hammett was the author of a mystery novel entitled \textit{The Maltese Falcon}, featuring the fictional detective Sam Spade.\footnote{Id. at 946, 948.} Hammett and his publishers granted Warner Bros.
certain motion picture, radio and television rights to *The Maltese Falcon*\textsuperscript{76} Hammett later reused characters from the novel, including Sam Spade, in new stories and authorized CBS to use them in radio broadcasts called *The Adventures of Sam Spade*.\textsuperscript{77} Warner Bros. claimed that the contract giving it rights to *The Maltese Falcon* gave it the exclusive right to use the *Falcon* characters in motion pictures, radio and television.\textsuperscript{78}

The Ninth Circuit rejected this argument, holding that sequel rights—the right to use the characters and character names in future stories—were not within the rights granted to Warner Bros.\textsuperscript{79} That could have been the end of the case, but the court went on to consider whether characters, with their names, should be protected by the copyright statute.\textsuperscript{80} The court said: “It is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of the protection afforded by the copyright.”\textsuperscript{81} Hammett’s characters were not protected because they “were vehicles for the story told . . . .”\textsuperscript{82}

This means that Hammett is free to use his characters in other stories, but so is everyone else. If taken literally, it limits character protection much more than *Nichols*. For example, Sherlock Holmes or Harry Potter might be considered sufficiently delineated for protection under *Nichols*, but not constitute the story being told. Indeed, each has appeared in a variety of stories. It would exclude virtually any literary character from copyright protection because only a character appearing in a story “devoid of plot” would be protected.\textsuperscript{83} A case from the Second Circuit noted that any conclusion that the characters from *The Maltese Falcon* are in the public domain “would be clearly untenable from the standpoint of public policy, for it would effectively permit the unrestrained pilfering of characters.”\textsuperscript{84} Outside the Ninth Circuit, the case has not been followed, although it has managed to create some confusion.\textsuperscript{85}

More than fifty years after the *Sam Spade* case was decided, its relevance and application within the Ninth Circuit remain uncertain. It is unclear whether the “story being told” standard is holding or dicta, or in

\textsuperscript{76} Id. at 948.
\textsuperscript{77} See id.
\textsuperscript{78} Id. at 948–49.
\textsuperscript{79} Id. at 950.
\textsuperscript{80} Id.
\textsuperscript{81} Id.
\textsuperscript{82} Id.
\textsuperscript{83} Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 755 n.11 (9th Cir. 1978) (internal citation omitted).
\textsuperscript{85} Kurtz, *supra* note 9, at 455–56.
what situations it is applicable.86 In *Walt Disney Productions v. Air Pirates*, the court found that a number of Disney’s cartoon characters, including Mickey and Minnie Mouse, were protected under copyright.87 This was not because they constituted the story being told, but because they were visual characters.88 While a literary character may embody little more than an unprotected idea, said the court, cartoon characters, “which [have] physical as well as conceptual qualities, [are] more likely to contain some unique elements of expression.”89 This leaves open the possibility that a well-developed, distinctively drawn literary character might cross the line from idea to expression and be protected even if it does not meet the “story being told” standard.90

Things become even more confusing when the characters at issue appear in audiovisual works and are played by human beings. Like cartoon characters, they have a visual element, but their appearance, movement and voice are at least partly the result of the individuals who embody them. How are such characters to be protected? Superman has been treated as a cartoon character, but he was also portrayed by a live actor in a movie.91 Regan in the movie *The Exorcist* was treated as a literary character, but she possesses a visual component as well.92 In two district court cases within the Ninth Circuit, courts attempted to find a standard to use in deciding whether Rocky and James Bond were protected characters.93 Both saw the characters as visually depicted, but recognized that characters visually depicted in a movie might not be the same as cartoon characters.94

In the Rocky case, the court said that the characters in the first three *Rocky* films are visually depicted, and thus readily protectable.95 Out of “an abundance of caution,” however, it went on to determine their protection under both the “story being told” and “development” tests.96 The court said

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86 Olson v. Nat’l Broad. Co., Inc., 855 F.2d 1446, 1451, 1452 n.6 (9th Cir. 1988).
87 *Air Pirates*, 581 F.2d at 753 n.5, 755, 760.
88 Id. at 755.
89 Id.
90 See Olson, 855 F.2d at 1452. The court noted that cases subsequent to the Sam Spade case had allowed copyright protection for characters who are especially distinctive, citing *Air Pirates* and several cases out of the Second Circuit. Id. It then found that the characters at issue were not protectable “even under the more lenient standards adopted elsewhere.” Id.
95 Anderson, 11 U.S.P.Q.2d (BNA) at 1166.
96 Id.
that the *Rocky* characters were one of the most highly delineated groups of characters in modern American films.\(^97\) Their interrelationships and development were central to the three previous *Rocky* films.\(^98\) Rocky, in particular, “is such a highly delineated character that his name is the title of all four of the *Rocky* movies and his character has become identified with specific character traits ranging from his speaking mannerisms to his physical characteristics.”\(^99\) In considering the “story being told” test, the court said the *Rocky* characters were so highly developed and central to the three earlier *Rocky* movies that they constituted the story being told.\(^100\) It focused on the development and relationships of the characters, rather than on intricate plots or storylines.\(^101\)

In the James Bond case, the plaintiffs claimed that the copyright in the character, as it appeared in their sixteen *James Bond* films, was infringed by the Bond-like character in the defendants’ Honda commercial.\(^102\) The court noted that within the Ninth Circuit, it is not clear when “visually-depicted characters such as James Bond” can be given copyright protection.\(^103\) The court did not separate what it called the “character delineation” and “story being told” tests.\(^104\) Instead, it stated that James Bond is protectable under either.\(^105\) “Like Rocky, Sherlock Holmes, Tarzan, and Superman, James Bond has certain character traits that have been developed over time through the sixteen films in which he appears.”\(^106\) The defendants claimed that James Bond could not be the “story being told” since he had “changed enormously from film to film” and had been played by a variety of actors.\(^107\) The court turned this lack of continuity into an advantage, finding that the fact that many actors can play Bond shows that he is a unique character with an identifiable set of traits and constant qualities, even though the character changed “from film to film, from actor to actor, and from year to year.”\(^108\) The court concluded by saying that audiences “do

\(^{97}\) Id.

\(^{98}\) Id.

\(^{99}\) Id.

\(^{100}\) Id.

\(^{101}\) Id. at 1166–67. However, the Ninth Circuit had rejected the idea that a group of characters can be protected if together they constitute the whole story. Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 755 n.11 (9th Cir. 1978).


\(^{103}\) Id. at 1295.

\(^{104}\) Id. at 1296.

\(^{105}\) Id.

\(^{106}\) Id. (footnote omitted).

\(^{107}\) Id.

\(^{108}\) Id.
not watch *Tarzan*, *Superman*, *Sherlock Holmes*, or *James Bond* for the story, they watch these films to see their heroes at work."\(^{109}\)

Both courts struggled mightily to avoid a literal application of the "story being told" test to James Bond and Rocky Balboa. A literal approach would likely have left both unprotected, as neither the *James Bond* nor *Rocky* films can be considered stories devoid of plot. Instead, the courts considered the relative importance of the characters and the plot to the film. They found that the *Rocky* films concentrated on the development and relationships of the characters, rather than on intricate plots, and people watch Bond films to see Bond at work.\(^{110}\) A later court said that protectable characters are "larger than a single production or visual representation, and in essence transcend the boundaries of any one copyrighted work."\(^{111}\) Indeed, the *Sam Spade* test seems to be ending, not with a bang, but a whimper. Judge Posner, in the Seventh Circuit, said that the decision was wrong and that the Ninth Circuit has killed the decision, "though without the usual obsequies . . . ."\(^{112}\) Recently, the Ninth Circuit said that while characters "are ordinarily not afforded copyright protection, characters that are ‘especially distinctive’ or the ‘story being told’ receive protection apart from the copyrighted work."\(^{113}\) This liberates lower courts from a need to use or twist the "story being told" test, as they can ignore that part of the newly articulated test and look to whether characters are especially distinctive.\(^{114}\) This is unlikely to differ in any significant way from distinctive. Indeed, one later district court opinion\(^{115}\) found that a character is protected when it is the story being told, highly delineated or plays a central role in an overall work, but not if it is insufficiently delineated or not the central focus of the work.\(^{116}\)

\(^{109}\) Id. In another case, *Titan Sports, Inc. v. Turner Broadcasting Systems*, 981 F. Supp. 65 (D. Conn. 1997), the court found that the Titan Sports-created wrestling "character" Diesel, played by Kevin Nash, was sufficiently delineated to avoid a motion to dismiss. *Id.* at 68–69. The character wore "a goatee beard and moustache, black leather pants, a black leather vest decorated with silver studs and tassels, a black low cut tank-top shirt, a black fingerless glove on the right hand, black elbow pads, black wrist bands, sunglasses, and black leather boots," and was different from those previously portrayed by Nash. *Id.* at 67.

\(^{110}\) See supra notes 101, 108 and accompanying text.

\(^{111}\) *Gaiman v. McFarlane*, 360 F.3d 644, 660 (7th Cir. 2004).


\(^{113}\) *Bach*, 473 F. Supp. 2d at 1134.
The \textit{Rocky} and \textit{James Bond} courts, attempting to work with the unworkable “story being told” test, did not attempt to determine what approach would best be used when human beings played by actors, wearing ordinary clothing, appear not in a book, not in a cartoon, but in a movie. They simply threw a kitchen sink of tests against the characters and found that they were protected.\textsuperscript{117} The diminution of the “story being told” test is useful, but it does not solve the problem of how to treat such characters. They are different from literary characters. Judge Posner put cartoon and film characters into one category, distinguishing them from literary characters: “A reader of unillustrated fiction completes the work in his mind; the reader of a comic book or the viewer of a movie is passive.”\textsuperscript{118} Nevertheless, James Bond and Rocky are not visual in the same way as Mickey Mouse. Their faces were not created by the copyright owner. Nor were they placed in the distinctive costumes, with elements of visual creativity, worn by such audio-visual characters as Superman and Batman. Judge Posner, distinguishing between literary and graphic expression, says that even after a detailed description of Sam Spade in the novel \textit{The Maltese Falcon}, “one hardly knows what Sam Spade looked like. But everyone knows what Humphrey Bogart looked like.”\textsuperscript{119} But the creative expression protected by copyright cannot be found in the physiognomy of the actor or the shape of ordinary clothing. Rocky looks remarkably similar to Rambo and James Bond, played by a variety of actors, appears differently from film to film.

Physical features alone cannot be a sufficient basis for protecting a human character played by an actor.\textsuperscript{120} An audiovisual character tends to be more concrete and specific than a word picture. You and I see the same thing. But the visual elements of such a character are the creations of a motion picture’s author only to a limited extent. Therefore the visual can only be protected to a limited extent. A character consists of more than its appearance. What a character “thinks, feels, says, and does and the

\begin{itemize}
\item \textsuperscript{118} Gaiman v. McFarlane, 360 F.3d 644, 661 (7th Cir. 2004).
\item \textsuperscript{119} Id.
\item \textsuperscript{120} There has been some recognition that it is necessary to go beyond the purely visual in considering such characters and to focus on the nature of the characters. See Metro-Goldwyn-Mayer, 900 F. Supp. at 1296. In finding James Bond to be protected, the court said that Bond has certain character traits that have “been developed over time” and that the fact that he can be played by many actors “is a testament to the fact that Bond is a unique character whose specific qualities remain constant despite the change in actors.” Id. In Anderson v. Stallone, the character of Rocky was an audiovisual character, but Anderson, in his treatment, could not directly copy his visual characteristics. See Anderson, 11 U.S.P.Q.2d (BNA) at 1162.
\end{itemize}
descriptions conveyed by the author through the comments of other characters in the work episodically fill out a viewer’s understanding of the character.”\textsuperscript{121} It is important to look at such things as the character’s personality, behavior, life history and relationships with other characters.\textsuperscript{122}

One court found that a balding, Caucasian male named Bill, dressed in a dollar bill costume and appearing in the plaintiff’s advertisements, was protected.\textsuperscript{123} The character wore a boxy rectangular costume that looked like a stack of dollar bills, and the actor’s arms and legs were covered in a white, form-fitting garment, with the face protruding from the box.\textsuperscript{124} The idea of a man portraying a one-dollar bill was not protected.\textsuperscript{125} Bill, however, possessed not only an appearance, but character traits. He is portrayed as lazy, as a metaphor for money that is not earning a return, and the advertisements suggest that Bill should be put to work.\textsuperscript{126} He sits around watching television, eating or playing with a slinky, and is innocent, unproductive, childlike and naïve.\textsuperscript{127} The appearance and personality together created the necessary distinctiveness.\textsuperscript{128} If the visual aspects were protected alone, this would come very close to giving the plaintiff a monopoly on a character called Bill, dressed as a dollar bill, at least if he is balding and Caucasian.

Too much energy has been spent trying to decide when a character should be protected and too little in focusing on the question of infringement. In order to prove infringement, the plaintiff must show that the defendant has copied protected expression from the plaintiff’s work and that there are substantial similarities between the defendant’s work and protected elements of the plaintiff’s.\textsuperscript{129} There must be not only copying but unlawful or actionable appropriation.\textsuperscript{130} Considering the delineation of a character may be useful in order to exclude stock characters from further consideration,\textsuperscript{131} but for the most part, considering delineation in the abstract, without comparisons, is a sterile exercise. It is much more useful to compare the plaintiff’s and defendant’s characters in order to determine

\textsuperscript{122} See id.
\textsuperscript{124} Id. at 787.
\textsuperscript{125} Id. at 799.
\textsuperscript{126} Id. at 787.
\textsuperscript{127} Id. at 799.
\textsuperscript{128} Id. at 804.
\textsuperscript{129} See 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03(B)(2).
\textsuperscript{130} Id. § 13.01(B).
\textsuperscript{131} Stock characters may include a drunken old bum, a gesticulating Frenchman, a fire-breathing dragon, a talking cat and a masked musician. Gaiman v. McFarlane, 360 F.3d 644, 660 (7th Cir. 2004).
whether the defendant copied the plaintiff’s character and whether the copying was sufficient to be considered unlawful or actionable appropriation.

Furthermore, once a character is found to be protected, there is an unfortunate, although not universal, 132 tendency to find most any use to be infringing. For example, one court, 133 finding that the character “E.T.,” from the motion picture *E.T. the Extra Terrestrial*, was protected, went on to consider infringement. It found that the plaintiffs were likely to prevail in their claim against the manufacturer and distributor of merchandise bearing the inscriptions “I Love You E.T.” and “E.T. Phone Home” despite the fact that all that was taken was the name E.T. and short phrases from the film, an insufficient basis for finding copyright infringement. 134 In another early case, 135 the author of twenty-six *Hopalong Cassidy* novels authorized the making of a series of motion pictures based on the books. 136 The owners of the book rights claimed that televising the motion pictures, then in the public domain, infringed the characters in the books. 137 The court found that the character Hopalong Cassidy was sufficiently delineated to be copyrightable and that the character in the movies was substantially similar to the character in the books. 138 The problem is that the characters were monumentally different. The court described the book version of Hopalong Cassidy as “a diamond in the rough” who was “quick tempered and given to cuss words . . . .” 139 The film Cassidy was a “black-garbed, white-horsed,

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132 For example, in *JB Oxford & Co.*, 427 F. Supp. 2d at 803–04, Dollar Bill was found to be protected, but the defendants’ use of characters dressed in dollar-bill costumes was not infringing in all contexts. Id. The characters in most of its advertisements were not substantially similar. Id. They wore similar costumes, but their character traits were very different from Bill’s, as they did not represent laziness or unproductiveness. Id. at 804. In one advertisement, however, there were three Caucasian males, one of whom was bald, dressed in one-dollar-bill costumes, sprawled around watching television and defined as lazy. Id. at 803–04. This created sufficient similarity to make summary judgment inappropriate. Id. at 804.


134 Id. at 1166. Protection might well be appropriate under the more fluid doctrines of trademarks and unfair competition. Indeed the court found, with far more reason, that the plaintiff was likely to succeed on its claim under Section 43(a) of the Lanham Act and common-law trademark infringement and unfair competition. Id. at 1166–67. For a discussion of these doctrines, see Leslie A. Kurtz, *The Methuselah Factor: When Characters Outlive Their Copyrights*, 11 U. MIAMI ENT. & SPORTS L. REV. 437 (1994).


137 Id. at 61–62.

138 Id. at 65–66.

139 Id. at 65.
alcohol-eschewing straight-shooting Western hero." The court said that the motion-picture Cassidy was the book Cassidy inside out. But inside out or upside down, the characters were not substantially similar.

More recent cases have presented similar problems. In the James Bond case, a television commercial for the Honda automobile involved a “young, well-dressed couple in a Honda del Sol being chased by a high-tech helicopter.” A villain with metal arms jumped from the helicopter to the car’s roof. The pair escaped when the male driver, with a flirtatious turn to his companion, released the Honda’s detachable roof, sending the villain into space. Neither the name “James Bond” nor any of the actors from Bond films were used, and the characters spoke with an American accent. Nevertheless, the court found it likely that the plaintiffs would succeed in showing infringement. Bond and the hero of the Honda commercial were both “young, tuxedo-clad, British-looking men with beautiful women in tow and grotesque villains close at hand . . . .” Furthermore, both “exude uncanny calm under pressure, exhibit a dry sense of humor and wit, and are attracted to, and are attractive to, their female companions.” But there are limits to the character and wit that can be expressed in a short commercial. This approach gives the plaintiffs the ability to prevent others from using a young, tuxedo-clad, British-looking (whatever that means), calm-under-pressure fellow who is attracted and attractive to the opposite sex. It “comes close to giving the copyright owner control not only of the works created by that author but also of a significant part of the genre into which the work falls.”

141 Filmvideo Releasing Corp., 509 F. Supp. at 65.
143 Id.
144 Id.
145 See id. at 1291–92. The accents of the characters changed from British to American during the course of the dispute. Id. at 1292.
146 Id. at 1300–01.
147 Id. at 1298.
148 See id. at 1298. In fairness to the court, it also found that the theme, settings, mood and pace of the two works were similar, and that several specific aspects of the Honda commercial appeared to have been lifted from the Bond films. Id. at 1298–99. My classes have found the use of a villain with oversized goggles and metallic teeth jumping from a helicopter to the roof of the car particularly convincing.
149 Karjalal, supra note 3, at 32.
Jonathan Livingston Seagull was the central character in a very successful book written by Richard Bach and published in 1970.\(^{151}\) Bach alleged that this character was infringed when the defendant used the character as a motivational tool.\(^{152}\) Having found that the character was well defined and the “story being told,” the court went on to consider infringement.\(^{153}\) The defendants were not using the character in another work of fiction but in a motivational campaign as a source of inspiration.\(^{154}\) They sought to inspire their distributors to buy and sell more products, suggesting that their distributors would emerge as an extraordinary group of Jonathans who would become new leaders and lift themselves above their ordinary lives.\(^{155}\) The court found that this raised a triable issue of fact on the question of substantial similarity.\(^{156}\) But should using a character to inspire be sufficient to amount to copyright infringement?

We need a more rigorous infringement analysis in order to distinguish infringement from inspiration, derivation and acceptable borrowing. The scope of protection should be limited. It is not necessary to maximize copyright protection in order to maximize creativity. First, maximizing the number of copyrightable works is not equivalent to maximizing creativity.\(^{157}\) We do not know the optimum level of protection that will promote the creation of the most works; still less do we know the level that will most enhance creativity. Second, incentives are not everything. The ability to access and creatively use that which surrounds us and to participate in making culture is also important.\(^{158}\) Evoking the memory of a copyrighted character is not equivalent to unrestrained pilfering. Copyright law has not kept pace with the proliferation of characters and their uses. It is important to recognize the difference between acceptable borrowing and infringement and limit the scope of character protection in order to avoid unnecessary limits on the ability to create new works. It is because characters can be so important to our cultural discourse that their protection should be carefully and narrowly tailored.

\(^{152}\) Id. at 1113–14. The defendants also used a copyrighted photograph from Jonathan Livingston Seagull and some quotes from the book. Id.
\(^{153}\) Id. at 1114–27.
\(^{154}\) Id. at 1114.
\(^{155}\) See id.
\(^{156}\) See id. at 1127.
\(^{157}\) See id. at 1127.
\(^{158}\) Julie E. Cohen, Creativity and Culture in Copyright Theory, 40 U.C. DAVIS L. REV. 1151, 1152 (2007).
\(^{159}\) See Madhavi Sunder, IP3, 59 STAN. L. REV. 257, 332 (2006) (stating that the law should “ensure that all individuals—not just the most powerful—would have access to the channels of making cultural meaning”).
III. REAL PEOPLE AND THE RIGHT OF PUBLICITY

Real people are not protected by copyright and will seldom own rights to the characters that they portray.\(^\text{159}\) In many states, however, they do have the right to prevent the use of elements of their identity under the right of publicity.\(^\text{160}\) Unlike copyright, the right of publicity is a matter of state law, and the right varies from state to state.\(^\text{161}\) In essence, however, it protects against the appropriation of the commercial value of a person’s identity.\(^\text{162}\) It allows an individual, particularly a celebrity, to control the commercial value of her name and likeness and, in some states, other indicia of identity.\(^\text{163}\) The right may include voice, signature, phrases and even evocation of a celebrity’s image.\(^\text{164}\) The right of publicity can extend to “a person’s nickname, signature, physical pose, characterizations, singing style, vocal characteristics, body parts, frequently used phrases, car, performance style, mannerisms and gestures, provided that these are distinctive and publicly identified with the person claiming the right.”\(^\text{165}\)

The right of publicity can be traced back to an 1890 article by Samuel B. Warren and Louis D. Brandeis,\(^\text{166}\) which urged the creation of a right of

\(^\text{159}\) See generally Angela D. Cook, Should Right of Publicity Protection Be Extended to Actors in the Characters Which They Portray, 9 DePaul L. J. Arts & Ent. L. 309 (1999). These rights will ordinarily belong to the producers of the film or television program. Id. There are, of course, exceptions, such as Groucho Marx. Id. at 316–17.

\(^\text{160}\) The right of publicity is considered in detail in the two-volume treatise, The Rights of Publicity and Privacy. See McCarthy, supra note 15.

\(^\text{161}\) See id. §§ 6.1–6.9.


\(^\text{163}\) See McCarthy, supra note 15, § 1.3 (noting that the right of publicity is “the inherent right of every human being to control the commercial use of his or her identity”).

\(^\text{164}\) See Coonbe, supra note 12, at 367.

\(^\text{165}\) Id.

\(^\text{166}\) Samuel D. Warren & Louis D. Brandeis, The Right to Privacy, 4 Harv. L. Rev. 193 (1890). The
privacy in order to combat an intrusive press that was publishing essentially private information. The article focused on the right of individuals to be left alone and not intruded upon or publicized without permission. The earliest cases in which plaintiffs sought to vindicate the right of privacy, Roberson and Pavesich, involved essentially private people whose photographs were used in advertisements. The plaintiff in Roberson was a young woman whose photograph was used in poster advertisements for flour. She claimed that the display of the posters in public places, including stores, warehouses and saloons, caused her to be “humiliated by the scoffs and jeers of persons who have recognized her face,” and she sought to recover for shock and resulting illness. The court rejected the right of privacy as a cause of action and the plaintiff was unsuccessful in her suit. The first legislation providing a right of privacy, passed in response to the Roberson case, was a 1903 New York statute establishing liability for the unauthorized use of “the name, portrait or picture of any living person” for ‘advertising purposes, or for the purposes of trade.’ In Pavesich, the photograph of the plaintiff, a little-known artist, was used in an advertisement for life insurance. Pavesich’s picture, which was used without his consent, was accompanied by a statement that he bought the defendant company’s life insurance and was happy for its protection. This was untrue, and Pavesich claimed that the advertisement subjected him to ridicule. The appellate court found that he had a basis for a complaint for breach of privacy.

Thus, like other forms of the right of privacy, the right against appropriation began as a largely personal right, addressing dignitary

\[\text{footnotes:} \]

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168 See generally Warren & Brandeis, supra note 166, at 193.
170 Roberson, 64 N.E. at 542.
171 Id.
172 Id. at 543.
173 Id. at 557.
174 Madow, supra note 14, at 167–68 (internal citation omitted).
176 Id.
177 Id. at 69.
178 Id.
179 See generally William L. Prosser, Privacy, 48 CALIF. L. REV. 383 (1960). In 1960, Professor William Prosser wrote an article dividing the right of privacy into four branches, the last of which was appropriation. Id. at 389. The other three were (1) intrusion, (2) public disclosure of private facts and (3) false light. Id.
interests such as mental distress, embarrassment and bruised feelings. In both Roberson and Pavesich, “the plaintiffs had been plucked from obscurity and rudely exposed to widespread and unwanted publicity.” Conceptual difficulties arose when public figures began to sue for the exploitation of their names and likenesses. First, celebrities, the people most likely to need protection against appropriation, could be seen as having waived their right of privacy. For example, in O’Brien v. Pabst, the plaintiff was the most publicized football player of the year. The defendant used the plaintiff’s photograph on its beer advertising calendar, and the court said that the plaintiff had surrendered his privacy by seeking publicity. Second, the right of privacy is essentially concerned with bruised feelings and offensiveness. But celebrities’ feelings are often left unbruised and unoffended by public exposure in appropriation cases, and they often seek to recover, not for unwanted publicity, but for uncompensated publicity. Third, if the right of privacy is personal, it would likely be considered unassignable. Therefore, if A granted B an exclusive license to use her name or likeness, this could amount to no more than a release of the right to sue B for the use; it could not be enforced by the licensee against third parties.

These issues were all dealt with in what can be considered the first modern right-of-publicity case, and the one that gave the tort its name, Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc. The plaintiff and defendant were rival chewing-gum sellers who used the pictures of professional baseball players on chewing-gum cards that were collected and traded, mostly by youngsters. The plaintiff obtained the exclusive right to use baseball players’ pictures in connection with the sale of gum. Nevertheless, the defendant induced some of these ballplayers to agree to allow it to use their names and pictures. The court held that, independent of a right of privacy, “a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his

180 See id.
181 Madow, supra note 14, at 168.
184 Id.
185 Id. at 170.
186 See generally MCCARTHY, supra note 15.
187 See id.
188 Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir. 1953).
189 See id. at 867.
190 Id.
191 Id.
picture. . . . This right might be called a ‘right of publicity.’”192 This right is actionable without offensiveness or bruised feelings; no waiver arises from being in the public eye; damages can be valued in terms of the publicity appropriated; and the right is assignable.193 Thus, a person can effectively grant the exclusive right to publish his picture. The Haelan court specifically declined to decide whether the right is a personal or property right.194 If an individual owns exclusive, assignable rights to her name and likeness, however, the right to forbid use means: (1) the right to profit, to condition use on being paid; and (2) the right to control, by forbidding use, if she wishes, based on personal or pecuniary motives.195

More than half the states have recognized a cause of action based on the right of publicity.196 The right may be common law, statutory or both.197 The contours of the right of publicity are not clear. The nature of protection varies from state to state.198 It is difficult to define what elements of a person’s identity, beyond name and likeness, fall within the right of publicity, and what uses violate that right. States differ on whether the right survives death.199 There are also limits on the right imposed by the constitutional guarantees of a free press and free speech.200 Nevertheless, the right of publicity has, in recent years, been overflowing its proper boundaries. This is in part because of the idea that if some aspect of the plaintiff has value, it should be protected and the plaintiff should be paid.201 It is, therefore, important to look at the reasons for providing a right of publicity in the first place. The fact that the right is largely an economic one, in terms of transferability and available damages, should not obscure the fact that economic justifications for the right have not been particularly convincing.202 The more convincing justifications are, in fact, essentially personal.

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192 Id. at 868.
193 Id.
194 Id.
195 See generally id.
197 Id.
198 See id.
200 See id. § 8.41.
201 See infra notes 203–34 and accompanying text; see also Madow, supra note 14, at 134 (“[T]he main
One reason given for allowing a right of publicity is that the right is needed to provide incentives. Providing a right of publicity will encourage effort and creativity, inducing people to “expend the time, effort, and resources to develop the talents prerequisite to public recognition.” Most celebrities, however, engage in the activities producing fame without reference to the right of publicity and are well compensated for their efforts. It seems unlikely that, in the absence of the right, actors will cease to act and ballplayers will cease to play ball. Some have argued that celebrity has disadvantages, including a loss of privacy and public criticism, and people may be reluctant to “venture onto the stage of public opinion . . . .” But most people seeking to make their mark in fields that create celebrity will not cease their efforts if the right of publicity is abolished. Furthermore, even if the right encourages investment in the development of a public persona, it is not clear that there is a value in promoting the development of fame for its own sake. At best, the incentive rationale is a weak one.

Another argument for the right of publicity is that it promotes the efficient allocation of resources. Under this argument, publicity rights will promote the best and most efficient use of elements of identity, preventing them from losing their value, a “version of the familiar tragedy of the commons argument . . . .” Without exclusive publicity rights, publicity assets would be overused and their value diminished in a scramble
to use them up as quickly as possible. If a celebrity can control the use of her name, likeness and other indicia of identity, she can control their value and maximize their return. However, the elements protected by the right of publicity are not like natural resources that can be depleted by overuse. It may not matter if a celebrity’s photograph is “squeezed dry of advertising value,” as there will always be a supply of new personalities.

Even if the value of a celebrity’s identity in advertising diminishes with overuse, the frequent appearance of a name or picture on such things as shirts, mugs and lunch boxes may increase in value precisely because “everybody’s got one.” Furthermore, allowing the free use of publicity elements may be more advantageous than restricting that use:

An individual baseball card might be worth more money if cards of that player were deliberately made rare, and so sellers (or more likely resellers) of that card might increase their total profit. But do we really think society as a whole would be better off if only one company could make baseball cards and only rich adults could obtain cards featuring famous baseball players?

Providing a right of publicity means that goods with celebrity indicia will be more expensive. Maximizing wealth through the use of publicity rights comes at the expense of competition and lower prices. At best, there is a shrug of the commons, rather than a tragedy.

Yet another argument in favor of publicity rights is based on the Lockean notion that everyone is entitled to the fruits of her labors. “People deserve the right to control and profit from the commercial value of their identities because, quite simply, they’ve earned it.” A person’s name and likeness are not self-created, so it is the publicity value of identity

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213 See id. at 974–75; Matthews v. Wozencraft, 15 F.3d 432, 437–38 (5th Cir. 1994) (“Without the artificial scarcity created by the protection of one’s likeness, that likeness would be exploited commercially until the marginal value of its use is zero.”); Mark F. Grady, A Positive Economic Theory of the Right of Publicity, 1 UCLA ENT. L. REV. 97, 98, 110 (1994) (noting that, in the absence of exclusive control over elements of persona, they will be overused and lose their value).
214 Madow, supra note 14, at 224.
215 Id. at 222; see also Cardtoons, 95 F.3d at 975; Volokh, supra note 206, at 911 n.32.
216 Dogan & Lemley, supra note 205, at 1185; see also Madow, supra note 14, at 224 (noting that a photograph is not a nonrenewable natural resource; there will always be a supply of new personalities).
217 See Dogan & Lemley, supra note 205, at 1185–86. Dogan and Lemley argue that if the value of an image declines with overuse, this is appropriate. Id. Competing producers are expected to increase production until prices drop to marginal costs. Id. There is no reason to insulate producers from such competition in the absence of a need for incentives. Id.
219 See Cardtoons, 95 F.3d at 975.
that is at issue. Celebrities may spend a great deal of time, effort and skill in creating such value. But they do not create this value alone. Celebrities may be the ones most responsible for creating valuable public personae, but the skills and efforts of many other people, such as directors, scriptwriters, coaches, production experts and publicity agents are also involved. The audience, and its needs and interests, also play a part, and fame tends to feed on itself. Perhaps most important, fame need not be based on merit or effort. Much of the value of celebrity may be the result of time and chance.

I returned, and saw under the sun, that the race is not to the swift, nor the battle to the strong, neither yet bread to the wise, nor yet riches to men of understanding, nor yet favour to men of skill; but time and chance happeneth to them all.

Unjust enrichment is also cited as a justification for the right of publicity. “In this view, whether the commercial value of an identity is the result of a celebrity’s hard work, media creation or just pure dumb luck, no social purpose is served by allowing others to freely appropriate it.” However, this approach presumes a property right in publicity values, when the question is whether exclusive rights should be provided. Although there is economic value to and social recognition of celebrity, that does not mean, in itself, that this value should be assigned to anyone. Ordinarily, competitors are permitted to copy and benefit from the

221 Melville B. Nimmer, The Right of Publicity, 19 LAW & CONTEMP. PROBS. 203, 215–16 (1954); see also Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 804–05 (2001) (noting that much investment of time, money, energy can go into creating sufficient reputation to permit an economic return through commercial promotion); Kwall, supra note 205, at 35–36; Madow, supra note 14, at 222.
222 See Coombe, supra note 12, at 369. The creation of a celebrity image occurs in social contexts and draws upon other resources, institutions and technologies—studios, media, public relations agencies, fan clubs, gossip columnists, photographers, hairdressers, teachers, screenwriters, ghostwriters, etc. Id. “[T]he value of a celebrity persona rarely owes itself exclusively—or even primarily—to the efforts of the celebrity.” See Dogan & Lemley, supra note 205, at 1181. Agents, studios, marketing directors, fans, etc., all play a part. Id.
223 Madow, supra note 14, at 188.
224 Id. at 189.
225 Ecclesiastes 9:11 (King James); see also Madow, supra note 14, at 189 (“Fame does not play fair; it plays favorites.”).
226 Cardtoons, L.C. v. Major League Baseball Players Ass’n, 95 F.3d 959, 976 (10th Cir. 1996).
227 Id.; see also supra note 201 and accompanying text.
228 See Grady, supra note 213, at 110. “[J]ust how, when, and where the law should protect investments in ‘intangible’ benefits or goods is not a matter of abstract ‘moral’ principle; rather, it is a matter of carefully weighing relevant competing interests.” Madow, supra note 14, at 203 (internal quotations omitted) (citing WCVB-TV v. Bos. Athletic Ass’n, 926 F.2d 42, 45 (1st Cir. 1991)).
exclusive efforts of others. Exclusive property rights are the exception, not the rule.

The right of publicity may rest in major part on what McCarthy calls a visceral impulse of fairness, an “intuitive and natural human feeling that everyone should have control of the commercial use of their identity . . . .” Professor McCarthy states:

Each and every human being should be given control over the commercial use of his or her identity. Perhaps nothing is so strongly intuited as the notion that my identity is mine—it is my property to control as I see fit. Those who are critical of this principle should have the burden to articulate some important countervailing social policy which negates this natural impulse of justice.

This may not be the case. In a system that values the free market and competition, the burden should ordinarily rest on those who seek to provide exclusive rights.

Our identities, however, are personal things, an integral part of us, and it seems that we should have some say over what is done with them. Locke says that we all have a property right in our own persons, belonging to nobody but ourselves. Kant says that freedom is an innate right, comprising “the attribute of a human being’s being his own master.” But to what extent should this freedom, this self-determination, extend to the right to control our images or other objectifications of ourselves? To what extent does that which identifies me belong to me?

The right of publicity may be a property right, but its underlying justification is seen most convincingly as being based on freedom and

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230 See Madow, supra note 14, at 223; see also Dogan & Lemley, supra note 205, at 1182 (noting that it is not reasonable in a market economy to presume property rights should be granted; someone must own the right to compete in a particular way); Dougherty, supra note 201, at 66 (“Our social baseline favors ‘free appropriability of intangibles.’”).
231 MCCARTHY, supra note 15, § 2:2.
232 Id. § 2:1.
233 See Dogan & Lemley, supra note 205, at 1182 (“[Before assigning property rights] we should test the basic presumption that property rights are appropriate in the first place. The very existence of a right, in other words, requires some justification . . . .”); see also Ralph S. Brown, The Joys of Copyright, 30 J. COPYRIGHT SOC’Y 477, 481 (1983) (“competition is copying”); Robert C. Denicola, Freedom to Copy, 108 YALE L.J. 1661, 1661 (1999) (“Laws that restrain copying . . . restrain competition.”).
234 See LOCKE, supra note 219, at 17–19; MCCARTHY, supra note 15, § 2.1.
236 Id. at 421. Haemmerli suggests that one’s image is the product of the peculiar mix of mental, psychological and physical attributes that make a person unique. Id. at 421–22.
237 See MCCARTHY, supra note 15, § 9.5.
autonomy. When someone’s name and image is used by another in advertising, for example, some aspect of that person is under someone else’s control. It is a form of virtual involuntary servitude, of compelled speech. Our names and likenesses at least are intensely personal and their use without permission can be offensive to personal autonomy and human dignity, particularly if our surrogate selves are out there doing things we would not choose to do, or if we are turned into commodities against our wills. This does not mean that nobody can use a name or image without permission in any circumstance. But it does provide a significant justification for the publicity right. The right may be an economic one, but it is grounded in the personal.

Conceptualizing the right of publicity in this way may help keep the right within bounds. In particular, arguments based on personal autonomy and dignity are far less compelling when being used to suggest protection, not for an actor’s own identity per se, but as something closely associated with the individual, or the actor’s embodiment in a fictional character.

IV. FICTIONAL CHARACTERS AND REAL PEOPLE

When a fictional character is portrayed by a real person, the line between the character and the person can be an uncertain one. When we see Humphrey Bogart playing Sam Spade or Sylvester Stallone playing Rocky, it can be difficult to sort the character from the actor. The copyright owner’s rights to the character can collide with the right of publicity belonging to the real person. This collision cannot be resolved using the doctrine of preemption. It is difficult to make much sense out of the cases dealing with preemption of the right of publicity by federal copyright law and the Supremacy Clause of the Constitution. Treatment of this topic is beyond the scope of this Article, and has been extensively discussed. See generally Joseph P. Bauer, Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976, 10 VAND. J. ENT. & TECH L. 1 (2007); Christopher John Brej, A Fantastic “New National Pastime”: Copyright Preemption and the Public Domain, 48 IDEA 1 (2007); Thomas F. Cotter & Irina Y. Dmitrieva, Integrating the Right of Publicity with First Amendment and Copyright Preemption Analysis, 33 COLUM. J.L. & ARTS 165 (2010); Mark A. Lemley, Beyond Preemption: The Law and Policy of Intellectual Property Licensing, 87 CALIF. L. REV. 111 (1999); Jennifer E. Rothman, Copyright Preemption and the Right of Publicity, 36 U.C. DAVIS L. REV. 199 (2002); Peter K. Yu, Fictional Persona Test: Copyright Preemption in Human Audiovisual Characters, 20 CARDOZO L. REV. 355 (1998). Preemption is unlikely to be useful in resolving conflicts between owners of copyright in characters and the performers who portray them. The cases finding publicity claims to be preempted have involved the use of a copyrighted work itself, created with the plaintiffs’ consent.
communicative value. They may be important elements to use in cultural and individual expression. They can encapsulate individual aspirations and group identities and are important parts of our public vocabulary.

A. Fictional Characters Portrayed by Real People

When a real person is portrayed in a biography, fictionalized biography, docudrama or work of fiction, courts have been largely unwilling to uphold right-of-publicity claims. The right is disfavored, and ordinarily is not applied, when elements of identity appear in genres such as news, movies and television programs. Agatha Christie may be portrayed in a film as an emotionally unstable woman engaged in a sinister plot to murder her husband’s mistress in an attempt to regain his affections, if the fictional nature of the portrayal is revealed. In similar circumstances, Archbishop Marcinkus may be portrayed in a book as plotting to assassinate Soviet Premier Yuri Andropov to prevent further assassination attempts on the Pope. Most cases have found that works of fiction are constitutionally protected in the same way as political treatises and topical news stories. A film may be loosely based on the life of Rudolph Valentino. Billy Tyne and Dale Murphy may be portrayed in a film about a massive storm and the loss of the vessel the Andrea Gale. The Restatement (Third) of Unfair Competition would except from protection “the use of a person’s identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.”

Ideas can be conveyed through fiction, sometimes more powerfully than through factual reports, and entertainment is a form of self-

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243 Volokh, supra note 206, at 904.
244 Hicks, 464 F. Supp. at 429, 433. Actually, Christie was portrayed as an emotionally unstable woman engaged in a plot to make it look like her husband’s mistress murdered her. The court got the plot wrong.
247 Guglielmi, 603 P.2d at 458. The plaintiffs claimed that the portrayal of Valentino was fictional, inaccurate and false. Id.
248 Tyne v. Time Warner Entm’t Co., L.P., 901 So. 2d 802, 804 (Fla. 2005). The account in the film The Perfect Storm was dramatized, taking liberties with character and life stories of the crew members. Id.
expression. Therefore, no distinction should be drawn between factual accounts and ones that incorporate fictional elements. It should not matter if the work is slightly or mostly fictional or whether the fictionalization is revealed. Courts are rightly reluctant to apply the right of publicity to fictional works.

This reluctance, however, has not always appeared where the protection of performances is concerned. In the one Supreme Court case to deal with the publicity right, the plaintiff, Zachinni, was performing a “human cannonball” act at a country fair, in which he was shot from a cannon into a net about 200 feet away. The shooting part of the act lasted fifteen seconds, and a local news station taped the entire fifteen-second act and broadcast it on the eleven-o’clock news without permission. The Court said that state law could, without violating constitutional guarantees of free speech and free press, use the right of publicity to prevent the broadcast of the plaintiff’s entire act. This case, however, was very idiosyncratic. The plaintiff’s act was not simulated by others, but bodily copied. The case was concerned less with the publicity value of the plaintiff’s name and likeness, although they were used, than with the publicity value of the performance. The case involves rights that are more similar to copyright than to the ordinary publicity case.

Some performers, such as Laurel and Hardy and the Marx Brothers, create their own characters, which can be difficult to separate from the real people who create them. Their stage names and appearance can be protected, even if they are not identical to their real names and natural appearance. The widows of Stan Laurel and Oliver Hardy were found to have a right of publicity in the characters their husbands had created. But

250 See Gaglielmi, 603 P.2d at 458–59.
251 See Id. at 459.
253 Id. at 564.
254 Id. at 575–79.
255 See id. at 575.
257 See McCarthy, supra note 15, § 4:68.
258 Price, 400 F. Supp. at 847. The court said that the case was made easier to decide by the fact
the case involved merchandising rights, rather than the use of the characters in a new performance.

The question of the Marx Brothers’ right of publicity arose in a case that did involve new performances. The second act of the play *A Day in Hollywood, A Night in the Ukraine* was a take on how the Marx Brothers would have dramatized Chekhov’s *The Bear*, with the actors reproducing the brothers’ appearance and comedy style. The trial court found that the play infringed the plaintiffs’ right of publicity in the Marx Brothers characters. It said that if the defendants use a celebrity name or likeness primarily to promote the dissemination of thoughts or ideas, the right of publicity gives way to protected expression. But if these indicia of identity are used largely for commercial purposes, such as the sale of merchandise, publicity prevails. Oddly, the court found that the case fell within the second category, where the right of publicity prevails. The play, said the court, does not discuss the lives or careers of the Marx Brothers, but is an unauthorized appropriation of their characters “by imitation of their act.” The defendants duplicated, as faithfully as possible, the Marx Brothers’ performances, and mere imitation lacks a creative component. But a performance in which a playwright and actors seek to depict the way in which the Marx Brothers would have portrayed a Chekhov play seems highly creative. Furthermore, a performance, even an imitative one, is more creative expression than a disguised ad for goods and services. There is a difference between protecting performers’ identities and protecting their creative activities.

We might seek to distinguish between performances that seek merely to duplicate the plaintiff’s performance and exploit the plaintiff’s fame from those that are more creative. However, that line is virtually impossible to draw. Having a court second-guess a creator’s need to make use of a

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Id. at 493. The decision cited *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981). That case, however, involved a live stage show patterned after an actual Elvis Presley stage show, featuring a performer who imitated Presley. Id. at 1348. Thus, it was far more imitative than the performance in the Marx Brothers case. Furthermore, the court refused to enjoin the performance, finding that a skilled imitation of an Elvis Presley performance is in some measure consistent with freedom of expression. Id. at 1361–62. The court’s finding of a violation of the right of publicity nevertheless seems inappropriate in the context of a theatrical performance.
celebrity’s name and likeness is a dangerous impingement upon free expression. The performer does not have the intensely personal—as opposed to professional—interest that most reasonably justifies the publicity right. When a role created by a performer is recreated in a performance by another, it should not fall within the right of publicity. As with works of fiction, performance provides a mode through which thoughts and ideas can be expressed.

The most troublesome case involving a performer who essentially played herself is the Vanna White case. Vanna White was the hostess of the popular game show, Wheel of Fortune. Her job was to turn the letters on a game board while looking good, with blond hair, an evening gown and jewelry. The defendants created and ran a series of print advertisements, each with humorous predictions of how Samsung products would be used in the twenty-first century, conveying the idea that these products would still be in use then. For example, one of the ads made fun of current notions of an unhealthy diet by depicting a raw steak with the caption: “Revealed to be health food. 2010 A.D.” The challenged advertisement in the White case featured a robot dressed in a blond wig and a gown and jewelry that resembled White’s. The robot stood next to a Wheel of Fortune game board, and the ad’s caption read: “Longest-running game show. 2012 A.D.” White did not consent to the ads and was not paid. The court found that White had no cause of action under California’s statutory right of publicity because the robot, with mechanical features, did not look like White and could not be considered

Cases involving performances imitating singers have reached mixed results. See Joplin Enters. v. Allen, 795 F. Supp. 349, 350, 352 (W.D. Wash. 1992) (Act II of the play simulated a concert performance by Joplin; the court dismissed the cause of action for infringement of the right of publicity). See generally Apple Corps Ltd. v. Leber, No. C299149, 1986 WL 215081 (Cal. App. Dep’t Sup. Ct. June 3, 1986) (holding that a Beatlemania stage show consisting of Beatles imitators performing Beatles songs onstage violated Beatles’ right of publicity). If the defendants’ performance is deceptive, remedies can be found under the law of trademarks and unfair competition. Even if it is constitutionally permissible to protect some performances, it is not required.

In the Marx Brothers case, the Court of Appeals did not reach the free speech question, reversing the trial court on the basis that the wrong state’s law had been applied. Groucho Marx Prods., Inc. v. Day & Night Co., 689 F.2d 317, 319–23 (2d Cir. 1982). The appellate court did, however, recognize that the defendants had a substantial First Amendment argument that their play was protected expression as a literary work. Id. at 319 n.2.


Id. at 1396.

Id. at 1399.

Id. at 1396.

Id.

Id.

Id.

Id. 2012 does not seem very futuristic today.
her likeness. 280 Over a strong dissent, 281 however, the court found that summary judgment should not be granted to the defendants on White’s common law right-of-publicity claim. 282 The common-law right of publicity encompasses any commercial exploitation of the plaintiff’s identity. 283 The blond wig, long gown and large jewelry worn by the female-shaped robot in the ad would not be sufficient to identify White. 284 But only Vanna White “dresses like this, turns letters, and does this on the Wheel of Fortune game show.” 285

Although there is little doubt that the robot in the ad did bring White to mind, it did not exploit any aspect of her own, personal, identity. 286 Vanna White is not present in the advertisement. 287 The robot is a futuristic replacement of White, not White herself. 288 It is not even an attribute of the role she plays on the program. 289 The court recognized that merely dressing the robot to resemble White, and even having it turn letters, would be insufficient. 290 It is only the presence of the robot on the Wheel of Fortune set that identifies her and the set is not a part of White’s identity. 291 The taking in this case has little to do with the core notion that our identities are an integral part of us and that we should have some say over what is done with them. The court’s approach is far removed from the idea of a personal-autonomy right, of a property right based on human freedom. White was not being used, only the way she and others dress and a set to which she has no intellectual property rights. It is Wheel of Fortune that is evoked, not Vanna White as an individual. 292 The decision expands the right of publicity from elements that are truly part of a person’s identity, such as her name and likeness, to things that merely remind the public of her. 293 This, as Judge Kozinski has said, “withdraws far more from the public domain than prudence and common sense allow.”

280 Id. at 1397. California Civil Code § 3344 provides a cause of action for use of another’s “name, voice, signature, photograph, or likeness . . . .” CAL. CIV. CODE § 3344 (West 2012).
281 White, 971 F.2d at 1402–08 (Alcaron, J., dissenting in part).
282 Id. at 1399 (majority opinion).
283 See infra notes 287–91 and accompanying text.
284 See White, 971 F.2d at 1403 (Alcaron, J., dissenting in part).
285 See id. at 1403–05.
286 See id.
287 See id. at 1399 (majority opinion).
288 Id. at 1405 (Alcaron, J., dissenting in part).
289 See Halpern, supra note 229, at 864–65 (noting that the defendants did not so much appropriate White’s identity as use it to evoke the show with which she was associated).
290 Both the Sixth and Tenth Circuits have disagreed with this approach. See Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619, 626 (6th Cir. 2000); Cardtoons, L.C. v. Major League Baseball Players
Would the *White* court have protected a street entertainer known as the Naked Cowboy from the use of an M&M candy wearing an outfit like his? In a case decided under New York law, the plaintiff performed in Times Square as the Naked Cowboy, wearing only a white cowboy hat, cowboy boots and underpants, carrying a guitar strategically placed to give an impression of nudity. The defendant began running advertisements featuring a blue M&M, wearing a white cowboy hat, cowboy boots and underpants, and carrying a guitar. The court found that New York law does not "extend to fictitious characters adopted or created by celebrities." But New York law did not recognize a broad common-law right to publicity, as set out by the *White* court under California law. It could be argued that the M&M, dressed as he was, evoked only one person: the plaintiff. Indeed, the defendant conceded that the ads parodied the Naked Cowboy. The *White* court gave short shrift to a parody defense when the parody was embedded in an advertisement. It might, inappropriately, have found a viable common law right-of-publicity claim.

The area in which the rights of copyright owners and the rights of performers are most likely to conflict involves performers playing characters they did not create themselves. When an actor portrays a fictional character, the character is going to look (in the absence of lots of makeup) and sound very much like the actor. And the character, with its name, may become identified, to a greater or lesser extent, with the actor. It may be difficult to separate that which belongs to the copyright owner and that which belongs to the performer.

George McFarland played the character "Spanky," a lovable but mischievous little fellow, in the popular movie and television series *Our Gang* and *The Little Rascals*. The defendant was using the name Spanky McFarland for a restaurant, which also used the plaintiff's image as it

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294 White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting from order rejecting the suggestion for a hearing en banc). In *Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47 (Cal. Ct. App. 2006), the plaintiff, lead singer of a retro funk-dance musical group, was unable to recover for the use of elements of her identity in a video-game character on First Amendment grounds, because the character contained sufficient expressive content to constitute a transformative work.
295 Id.
296 Id. at 448.
297 Id. at 453.
298 See id. at 450.
299 Id. at 455.
301 McFarland v. Miller, 14 F.3d 912, 914 (3d Cir. 1994).
appeared in the *Our Gang* days, without his permission. In deciding whether this violated McFarland’s right of publicity, the court said that the name of the fictional character could identify the actor if the actor’s screen persona was so associated with the real-life actor that it became inseparable from the actor’s own public image. The court said it need not decide who would prevail in a contest between the film studio, with rights to the character, and McFarland. McFarland had rights superior to those of the defendants in the case.

The conflict between actor and copyright owner was clearer in cases involving Bela Lugosi and Dracula and the characters Norm and Cliff in the *Cheers* television series, and the actors who portrayed them. In the Lugosi case, Lugosi’s heirs brought a right-of-publicity action against Universal Pictures for licensing the use of Lugosi’s likeness from the film, *Dracula*, in which he played the title role, on various products. Although the case was decided on the ground that his rights did not survive his death, opinions by Justice Mosk and Chief Justice Bird debated the appropriate scope of the right of publicity when a character is played by an actor. Chief Justice Bird argued that the professional and economic interests of the actors in controlling the commercial exploitation of their likenesses while portraying fictional characters are identical to the interest in controlling their own natural likenesses. Justice Mosk, however, focused on the fact that Lugosi played the role of Dracula, but did not create the character. Unless an actor portrays himself and creates the character, he has no right to exploit it. The right to exploit Dracula vests not in Lugosi, but in the author of the *Dracula* novel, Bram Stoker. Universal exploited not Lugosi qua Lugosi, but products created in the image of Count Dracula, a role Lugosi played.

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303 Id.
304 Id. at 920.
305 Id. at 921.
306 Id.
308 Wendt v. Host Int’l, Inc., 197 F.3d 1284 (9th Cir. 1999).
309 Lugosi, 603 P.2d at 427.
310 Id.
311 Id. at 431–54.
312 Id. at 444 (Bird, C.J., dissenting).
313 Id. at 432 (Mosk, J., concurring).
314 Justice Mosk gave as examples Groucho Marx, Red Skelton, Abbott and Costello, and Laurel and Hardy. Id.
315 Id.
316 Id. at 433.
The *Cheers* case[^317] involved a television show set in a friendly neighborhood bar in Boston, Cheers, where everybody knows your name.[^318] After a number of years, the gang at Cheers seemed like family to many fans. Two of the central characters were Norm, “a fat, endearing, oft-unemployed accountant,” and Cliff, a “mailman and something of a know-it-all windbag.”[^319] The defendant secured a license from Paramount Pictures, which owned the copyright in *Cheers*, and opened a line of Cheers airport bars[^320]. Included in the bars were animatronic figures vaguely resembling Norm and Cliff—one was fat, the other dressed as a mailman[^321]. The actors who played Norm and Cliff sued for violation of their rights of publicity[^322]. Paramount intervened, asserting its copyright rights[^323]. The district court had granted the defendants’ summary judgment because the robots did not look like the plaintiffs[^324]. The court of appeals reversed, finding that whether the robots resembled the actors sufficiently was an issue of fact, not to be decided on summary judgment[^325].

This case presented directly the conflict in rights between the copyright owner and the performers. The district court was right and the court of appeals was wrong—the robots did not look much like the actors playing Norm and Cliff[^326]. But what if they did? Should the actors who play characters be able to interfere with the copyright owner’s ability to market physical aspects of their characters? The copyright owner cannot fully exploit the characters of Norm and Cliff without evoking the images of the actors[^327]. If there is no contract between the copyright owner and the actor, what is the appropriate default rule? Does the copyright owner have the right to commercialize a character in products derived from the copyrighted work or use the character in new films or television series, without the permission of the actor, even if the character does look like the actor?

The *McFarland* case suggested that an actor could have an interest in the exploitation of his name or image merged into a character to the extent that the character was “so associated with [the real-life actor] that it becomes inseparable from the actor’s own public image . . .”[^328] But the

[^317]: Wendt v. Host Int'l, 197 F.3d 1284, 1285 (9th Cir. 1999) (Kozinski, J., dissenting).
[^318]: Id.
[^319]: Id. (footnotes omitted).
[^320]: Id.
[^321]: Id.
[^322]: Id.
[^323]: Id.
[^324]: Id.
[^325]: Id. at 1285–86.
[^326]: Pictures of the robots are on file with the author.
[^327]: *Wendt*, 197 F.3d at 1286 (Kozinski, J., dissenting).
[^328]: McFarland v. Miller, 14 F.3d 912, 920 (3d Cir. 1994).
case did not involve a conflict with the copyright owner’s interests. Furthermore, it is difficult to determine when the character is inextricably associated with the actor, and things change over time. Professor McCarthy said that where several actors play a role, the copyright owner owns all commercial rights to the character or role.\textsuperscript{329} Charlton Heston does not own the right to Moses, nor Bela Lugosi to Dracula.\textsuperscript{330} But, said McCarthy, actors who are inextricably connected with their roles include William Shatner as Captain James T. Kirk of the \textit{Starship Enterprise}.\textsuperscript{331} But that was 1995. In 2009, Chris Pine played a younger version of Kirk in the movie \textit{Star Trek}.\textsuperscript{332} Furthermore, even if an actor is inextricably connected to a role, it is the copyright owner in the works in which the character appears who has intellectual property rights to the character.\textsuperscript{333}

In the absence of an agreement to the contrary, a copyright owner should be able to exploit a character, even if it is associated with a single actor and even if it looks like the actor. The basic question that should be asked is whether it is the character that is being used, or whether it is simply the performer in disguise. If the value of the challenged work is derived primarily from the character, rather than the fame of the actor playing the character, the right of publicity should not apply.\textsuperscript{334} In the \textit{Cheers} case, even if the robots had looked like the actors playing Norm and Cliff, the characters were being portrayed, not the actors as themselves. The same is true of objects bearing the likeness of Dracula, as played by Bela Lugosi. It is primarily the character, not the actor, that is being exploited, and the bulk of the economic value comes from the portrayal of the character rather than the resemblance to the actor. The celebrity likeness is one of the raw materials from which the fictional character has been synthesized.\textsuperscript{335} As the right of publicity is most compellingly seen as based on personal autonomy,
freedom and dignity, protection is far less important when what is at issue is not an actor’s own identity, but the actor’s embodiment in a fictional character.\footnote{See David W. Melville & Harvey S. Perlman, Protection for Works of Authorship Through the Law of Unfair Competition: Right of Publicity and Common Law Copyright Reconsidered, 42 St. Louis U. L.J. 363, 402 (1998). The authors note that a person’s name and likeness are most deserving of protection because their appropriation requires virtually no leaps of association. Id. Greater links are required when the aspect claimed to be an indicia of identity is actually an item involving creative aspects. Id.}

If copyright owners are free to exploit their characters, what of the actors who portray the characters? Should they be allowed to appear, looking and speaking the way the character looks and speaks, without the permission of the copyright owner? Performing in a role should not disable a performer from appearing in ads, on merchandise or in new motion pictures and television programs, wearing whatever clothing and speaking in whatever accents she wishes. Robert Young should be able to appear in an advertisement (as Robert Young) for Sanka Coffee sounding like Marcus Welby, M.D., the role he played for many years.\footnote{See Madow, supra note 14, at 199.} He should even be allowed to wear a white coat.

Most of the cases involving rights of publicity and fictional characters have involved the use of the characters, possibly looking like the actors, on merchandise.\footnote{See, e.g., id. at 199.} But they can also be used in new films or television programs. For example, what if \textit{Cheers} were to be revived, and Norm and Cliff were played by actors of the same physical types as the actors who played them originally, made up, dressed and moving as much as possible like the originals. This should not violate publicity rights. The general reluctance to apply publicity rights to works of fiction would probably prevail, either on free-speech grounds or based on an exception in a right-of-publicity statute. But there is the disconcerting possibility that a court might hold otherwise. The right of publicity should apply to real people, not the fictional characters they play. Copyright should apply to fictional characters, not the real people who play them. Neither the copyright owner nor the performer should be allowed to prevent the other from making appropriate use of what belongs to her.

\section*{B. Digital Characters and Real People}

Digital technology is revolutionizing our ability to create and manipulate fictional characters, and these characters may be composed, at
least in part, out of actors. Once digital material exists, it can be changed in ways not possible in an analog world. Arnold Schwarzenegger, Jim Carrey and Denzel Washington have been scanned by lasers to create digital files that can be used to generate digital copies for use in future scenes that they may be unable to perform.339 Dead actors can be returned to life to play new roles in new projects with new co-stars. In the 2004 movie *Sky Captain and the World of Tomorrow*, for example, Sir Laurence Olivier, who died in 1989, performed in completely original scenes.340 Unlike cartoon characters, like Mickey Mouse, digital characters are derived in some fashion from human beings, from real people. But they are created, in large part, by those employing digital technology. Two means of creating digital characters are computer modeling and performance capture.341

With computer modeling, a laser scan can be used to capture a living actor’s features and body proportions for use in a digital model.342 Preexisting materials—photographs, film footage, recordings of a performer’s voice and the like—can be used to construct a digital model of an actor, living or dead.343 When actors die before completing a film, digital technology can be used to complete it. Digitally modified outtakes of Brandon Lee were used to finish *The Crow*344 and virtual versions of Oliver Reed and John Candy were used to complete scenes in *Gladiator* and *Wagons East*, respectively.345

Digital technology can also be used to make actors do things they could never do in real life. The creators of *Spider-Man 2* wanted their actors to “zoom through the air, around skyscrapers, over trains, and underwater, emoting all the while”346 and looking like the living actors. The film’s

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342 See id.


stars, Tobey McGuire and Albert Molina, spent a day in the laboratory making a variety of expressions, while four cameras photographed their heads and faces, lit from a number of angles. Three-dimensional models of their likenesses were made using laser scans and plaster casts of their faces and heads. These models were then manipulated frame by frame, using photographs and footage of the actors. The technique was also used for *Superman Returns* (2006), *Spider-Man 3* (2007) and *Hancock* (2008).

It takes a great deal of work, time and creativity to create a single frame embodying a high-quality digital character. John Gaeta, the award-winning visual-effects supervisor on the *Matrix* movies, has said that it is technically possible to create digital doubles of movie stars, “but only with an enormous amount of finesse and effort. We’re just scratching the surface of how to simulate all the nuance and detail of the human face as it emotes and speaks.” The technique does not yet create sensitive digital performances with emotive facial performances in close-up. But it is clearly useful in many other contexts, including action films and science fiction.

Digital characters can also be created using “performance capture,” a technique used to create all the characters in the movie *The Polar Express*. Reflector dots are attached to the performers’ body, face and scalp, allowing digital cameras to capture nuances of the performers’ facial movement. In *The Polar Express*, there were 152 facial markers and forty-eight body markers per actor. As the actors performed on a blank stage, the movements of their faces and bodies were precisely recorded and entered into a computer. This gave the digital characters lifelike, subtle movements. Motion capture allows anyone to play any role. Tom

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347 Id. at 70.
348 Id.
349 Id.
351 Huang, supra note 346, at 74.
352 See id.
354 Rea, supra note 341.
355 Desowitz, supra note 342.
357 Id.; see also Desowitz, supra note 342.
Hanks, in *The Polar Express*, played five roles. Only one of them, the conductor, could be recognized as Hanks. However, some aspects of Hanks were mimicked in other characters. For example, Hanks “played” the lead boy, and the boy was given eyebrows similar to Hanks’ since Hanks uses his eyebrows in acting.

Performance capture provides a very useful technique, but it is not without problems. The characters in *The Polar Express* did not appear truly human and were seen as vacant or creepy. One review said the characters looked laminated or embalmed. Another said that the technique “leaches [Hanks’] trademark charm and everyday humanity off the screen,” and that the characters appear remote and zombie-like, with dead eyes and deadened features. Similar complaints were made about the use of motion capture in the 2007 film *Beowulf* and the 2010 film *Tron: Legacy*.

We do not yet have the ability to create digital performers in all their full humanity. It is difficult to model the structure and function of facial muscles to allow for convincing dramatic performances, especially when the camera focuses in on an actor’s face, or to look into the eyes of a digital character and see its soul. We look at other people all the time

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358 See Desowitz, supra note 342; Rea, supra note 341.
359 See Desowitz, supra note 342; Rea, supra note 341.
360 Desowitz, supra note 342.
361 Rasmi Simhan, ‘Polar Express’ Translates OK to 3-D, SACRAMENTO BEE, Dec. 10, 2004, at 28, available at 2004 WLNR 13744737. The review added that the performance-capture method “failed to pick up the tiny but critical shifts in facial muscles that make up even the simplest expressions ….” Id.
366 See Kelly Tyler, Virtual Humans, NOVA ONLINE, http://pbs.org/wgbh/nova/specialfx2/humans.html (last visited Apr. 28, 2013). Ed Catmull, a computer graphics pioneer and a founder of Pixar, has said, “The human face is a unique problem. . . . We are genetically programmed to recognize human faces. We’re so good that most people aren’t even aware of it while they think about it. It turns out, for instance, that if we make a perfectly symmetrical face, we see it as being wrong.” Id.
367 Id. Scott Ross, president of Digital Domain, states: “One of the things that I’m mostly concerned about in terms of virtual actors is that there’s been millions of years of experience in our genetic code.
and are familiar with the way they move and behave. We know how their hair, skin and eyes look and move and reflect the light. In one study, researchers showed real and digital faces to volunteers to see if they could tell the difference; the volunteers were not fooled.368 There is a hypothesis called the “Uncanny Valley,” which holds that when facsimiles of humans look and act almost like actual humans, it causes a response of revulsion among human observers.369 People readily accept cartoon characters, which are simplifications or distortions of the human form, but not really close imitations, as in The Polar Express. As an image looks and behaves more and more like a human, the viewers’ acceptance increases. Beyond a certain point, however, when the image is very close, but not close enough, acceptance drops precipitously and the character enters the uncanny valley.370

Recent efforts have been made to cross the uncanny valley. In the 2008 film The Curious Case of Benjamin Button, the central character, played by Brad Pitt, begins life as a wizened old man and becomes younger as everyone around him ages.371 The first fifty-two minutes of the film featured a digital version of the aged Brad Pitt.372 Digital Domain created lifelike busts of Pitt/Button at sixty, seventy and eighty years of age.373 But the heads could not be stitched onto the small actors hired to play the aged Button without creating problems with lighting, continuity and tracking.374 The busts were scanned to create three-dimensional digital meshes, and Pitt was photographed in 120 different facial poses.375 These digital materials were manipulated to create thousands of possible expressions and retargeted onto the scanned Button heads.376 The next task was creating software tools that allowed a frame-by-frame comparison with the live-action performance of Pitt playing Button to the database of micro-expressions, and the construction of a CG model that matched, and its seamless attachment to the various live-action actors in the film.377 The movie won the Academy...
Award for Best Visual Effects, and the quality of the character was praised. But the result was neither easy nor cheap. More than 200 person-years were reportedly spent creating the character. The movie *Avatar* avoided the uncanny valley altogether with its CGI Na’vi characters, created using a sophisticated version of motion capture called “Facial Performance Replacement.” The Na’vi resembled the actors who played them, but they were blue, elongated, clearly alien and never reached the near-reality required to fall into the valley.

Despite the difficulties, performance capture, computer modeling and other techniques have substantial uses today and may well be improved. Digital characters are capable of being used in new films and other new contexts. The digitalized data used in creating a film does not disappear when the film is complete. A digital version of the actor Robert Patrick performed as the liquid metal cyborg in *Terminator 2: Judgment Day*, and this digitized character was later devoured by a digital T-Rex in *Jurassic Park*. Robert Zemeckis, director of *Beowulf* and *The Polar Express*, has already made scans of the actors in his films. “I know some are worried about what uses will be made of it,” Zemeckis has said, “[b]ut think of what we could have—complete digital versions of actors at various stages in their life.” This kind of material exists, and it is possible to reuse it. This possibility gives rise to a number of legal issues.

Digital characters are created by combining elements of human beings and elements created by human beings. The former may be protected under the right of publicity; the latter under copyright. Currently, we lack the tools to deal intelligently with the protection of audiovisual characters under copyright. Determining copyright protection is likely to be even more problematic with the complex creation that is a digital character.

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378 Newell, supra note 375, at 99.
379 Alexander et al., supra note 350.
382 See id. The Na’vi, inhabitants of the planet Pandora, are ten-foot tall, blue-skinned humanoids. See id. To learn about the Na’vi, scientists used Na’vi human hybrid bodies, called avatars, operated by mental link by genetically matched humans. See id.
384 Id. at 1169.
386 Id.
387 See Beard, supra note 383, at 1168–69.
If preexisting materials, such as photographs, film footage and voice recordings, are used to create a digital character, and this material is sufficiently original, it is protected by copyright.\textsuperscript{388} The same is true of materials created specifically for use in creating a character, including digital data, busts and maquettes.\textsuperscript{389} But the digital performer residing in a computer need not embody elements from underlying works that are protected under copyright. Although the movement of the body and face of the character may be created by studying or using copyrighted film, it is unlikely that the end results will take protected expression from the film.\textsuperscript{390} Rather, they will embody elements of the human actor. Digital materials created for a film may include elements of an actor and her performance, but any copyright will belong, not to the performer, but to those creating the materials.\textsuperscript{391} This is similar to the copyright in a photograph or filmed materials, which belongs, ordinarily, not to the subject but to those creating the photograph or film.\textsuperscript{392} The material created by laser scan may be sufficiently original to protect under copyright.\textsuperscript{393} Performance-capture materials, however, reflect the movements of the actor’s body and face and are unlikely to be copyright protected.\textsuperscript{394} The originator of the captured movements is the actor, but these movements would not be protected by copyright outside the motion-scan context.

Some digital characters can appropriately be treated like cartoon characters. For example, if the visual aspects of a character, created by performance capture, are created by the designer, the copying of original visual elements ordinarily should be considered infringing. But the same is not true for digitally created characters that closely resemble the actors who play them. Like Rocky and James Bond, their distinctive visual and aural elements are largely determined by the appearance, voice and mannerisms of the actors portraying them. These elements are not the original creations of the copyright owner, and physical similarities alone should not be considered sufficiently substantial for infringement. The appearance of this form of digital actor should be only one part of a complex of characteristics to be considered in deciding whether the character is protected by copyright and whether it has been infringed. Infringement should be carefully

\textsuperscript{389} \textit{Id.}
\textsuperscript{391} See, e.g., 17 U.S.C. § 106 (2012); \textit{McCarthy, supra} note 329, at 145.
\textsuperscript{393} See \textit{Beard, supra} note 383, at 1177–78
\textsuperscript{394} See \textit{id.} at 1194.
When there is doubt, it is better to enrich the public domain than to allow exclusive rights. Caution should be used in clogging the channels of creativity.

Many digital characters closely resemble the actors who play them. Their likenesses are being used. When should a performer be able to use the right of publicity to prevent use of materials that use elements of her identity? If a digitized fictional character is used in a commercial or on merchandise, without the permission of the performer, this will likely violate the right of publicity. But using the right of publicity to prevent the use of a digitally created character in a new performance is more problematic. When a real person is portrayed in a biography, fictionalized biography, docudrama or work of fiction, courts have been largely unwilling to uphold right-of-publicity claims. If an actress were to play Angelina Jolie in a biography, or in pure fiction where she meets and affects the life of others, she would be unable to recover under the right of publicity. If a digitized Angelina Jolie was used in the same way, it could be argued that the situation is not substantially different, so long as she is being portrayed as herself, whether in fact or in fiction. The story is about the actor rather than the actor playing a role in a story.

But what if a digitized performer is used to play a role in a new story? Using a digital actor to play a role is a different form of exploitation. It involves “not the appropriation of an entertainer’s reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.” The right of publicity should prevent the use of digital versions of living actors being used to play roles they never played, to cast them in movies and television shows in which they never appeared. The most powerful policy reasons underlying existence of the right of publicity—freedom and autonomy—come into play. Using a digitized version of a performer in this way is a form of virtual involuntary servitude, of compelled speech. Arguments based on personal autonomy and dignity are

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395 See id. at 1259–63; Beard, supra note 390, at 178–80.
396 See supra notes 359–60 and accompanying text.
397 See Beard, supra note 383, at 1259–60.
398 See id. at 1263.
399 See id. at 1205.
400 See id. at 1206. Beard suggests that, under Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977), she should be able to invoke her right of performance as an aspect of the right of publicity. Beard, supra note 383, at 1205.
402 Id. at 576; see also Cardtoons, L.C. v. Major League Baseball Players Ass’n, 95 F.3d 959, 967–68 (10th Cir. 1996).
particularly compelling as it is the actor’s own identity, rather than the actor’s embodiment in a fictional character, that is being taken. 403

It is also possible to make use of motion-capture material, created for one film, in another. 404 The digital data may incorporate elements of identity, such as movement and facial expression, from the actor from whom it is derived, although the actor’s physical image is not used. 405 This data can be used to animate a new character with no physical resemblance to that actor. For example, the digital data created from Tom Hanks in The Polar Express can be used with a newly created visual character that looks nothing like Hanks. 406 The digital data will be protected by copyright. 407 It is arguable the incorporated elements of identity should be protected under the right of publicity. But these elements are not readily identifiable to the actor and what is being used does not implicate the actor’s autonomy and freedom and should not be treated as property belonging to the actor.

C. Fictional Characters, Real People and Cultural Icons

Every artist builds on the creativity of the past, reshaping what already exists in the world. Fictional characters and celebrities are elements of the world in which we live and play important parts in our culture. They help form the modern myths out of which we operate and are an important part of the cultural heritage on which authors can draw to create anew. Authors “may be able to more persuasively, or more accurately, express themselves” 408 by weaving into their creations the people and events, fictional and real, that are part of the culture familiar to themselves and their audience. The desire to discuss and reinterpret popular texts goes back as far as the ancient Greeks. 409

Autonomy plays a major part in justifying publicity rights. 410 It is also a basis for allowing new creators to reimagine the world by using them in new creations. Human dignity is supported by self-expression. “People should be able to participate actively in [cultural discourse] in the creative
aspects of the world around them.” 411 It is important to be able to contest, respond to and reimagine elements of popular culture. 412 What matters is not only what is created, but who does the creating, and how creations are dispersed.

One argument in favor of giving copyright owners tight control over their fictional characters, and giving celebrities tight control over their public images, is that use by others will blur their characteristics and destroy the very things that have made them attractive. 413 Their use in alien contexts may cause them to become overexploited and take on new meanings at war with their original essence. But copyright owners and celebrities engage in this kind of blurring as well. “Copyright owners routinely revamp, rewrite, and even blur their properties to attract new audiences.” 414

For example, Superman has traditionally stood for “truth, justice, and the American way.” 415 But the authorized movie Superman Returns changes the line to “truth, justice, and all that stuff . . . .” 416 In early works, Superman displayed extraordinary leaping ability, which later became the power of flight. 417 Mickey Mouse softened over the years, in both physical appearance and behavior. The original character in Steamboat Willie was “a rambunctious, even slightly sadistic fellow.” 418 Later, he became increasingly well behaved and youthful, developing “a larger relative head size, larger eyes, and an enlarged cranium—all traits of juvenility.” 419 The comic Adam West Batman in the 1960s television program has little resemblance to the brooding character in recent movies. Both versions were authorized. 420

411 Tushnet, supra note 57, at 684.
413 Tushnet, supra note 53, at 165.
414 Id.
415 Id.
416 Id.
418 STEPHEN JAY GOULD, THE PANDA’S THUMB: MORE REFLECTION IN NATURAL HISTORY 95 (1980).
419 Id. at 96.
420 See Tushnet, supra note 57, at 675 (noting that the changes in Batman and Superman occurred because “the characters’ corporate owners hired new artists to continue the lucrative series while vigilantly policing their copyrights”).
Furthermore, characters are not firmly under their creators’ control. In Luigi Pirandello’s play, *Six Characters in Search of An Author*, the character called the Father says:

When the characters are really alive before their author, the latter does nothing but follow them in their action, in their words, in the situations which they suggest to him; and he has to will them the way they will themselves—for there’s trouble if he doesn’t. When a character is born, he acquires at once such an independence, even of his own author, that he can be imagined by everybody even in many other situations where the author never dreamed of placing him; and so he acquires for himself a meaning which the author never thought of giving him.421

Certainly, unauthorized creations can affect the meanings of symbols, such as fictional characters and celebrity personae. But unauthorized creations are unlikely to destabilize meaning; meaning can fork.422 People are capable of holding more than one idea in their minds at a single time. “[H]uman beings have the capacity to hold multiple, even contradictory, meanings simultaneously.”423 Our perceptions of cultural icons are resistant to change.424

Giving too much control over iconic symbols can interfere with our ability to communicate. Judge Kozinski has pointed out that because intellectual property is a thing of the mind it “is inextricably intertwined with the way we communicate with each other.”425 To the extent we limit the uses that can be made of characters like Mickey Mouse, we take something that has become part of our culture and say, in effect, “these characters cannot be used as a means of communication. That really ends up diminishing our ability to speak with one another by choking off some of the vibrancy of our language.”426

V. CONCLUSION

The iconic nature of fictional characters and the performers who play them does not led to the conclusion that they should be powerfully protected. Too great a level of protection can stifle new creations, preventing new authors from reimagining the world and making use of what

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421 PIRANDELLO, *supra* note 24, at 268.
422 Tushnet, *supra* note 53, at 165.
423 Chander & Sunder, *supra* note 54, at 624.
426 Id. at 470.
exists in the surrounding culture. “[L]aw can strengthen the already potent
grip of the culture industries over the production and circulation of
meaning, or it can facilitate popular participation . . . in the processes by
which meaning is made and communicated.” 427

This does not mean that unlimited secondary use of fictional characters
and celebrity personae should be allowed. But the doctrines limiting their
use should be carefully and narrowly tailored. We need a more rigorous
infringement analysis in order to distinguish infringement from inspiration,
derivation and acceptable borrowing. The question of whether a fictional
caracter is infringing should be more carefully considered than it is at
present. The intensely personal nature of the legitimate justifications for
the right of publicity, based on freedom and autonomy, should be
recognized and used to keep the right firmly in bounds. When the rights of
copyright owners and celebrities come into conflict, the default approach
should be permissive. When fictional characters are played by real people,
the work’s copyright owner should be allowed to use the characters within
it, even if they look like the actors who portrayed them. The actors should
also be allowed to use their own personae, even if it bears some
resemblance to the character.

The ability to participate in creating and experiencing culture should
not be limited without a very good reason. Creative interaction is not the
same thing as infringing exploitation. Fictional characters and real people
provide cultural and emotional shortcuts. It is the very power of these
cultural icons to evoke, to encapsulate, to enhance communication that
makes them important, not only to their initial creators, but to everyone
else.

427  Madow, supra note 14, at 141–42.