Right of Publicity Tarnishment and the First Amendment

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Abstract: This Comment proposes a new cause of action for tarnishment of the right of publicity. The claim would protect the rights holder from uses that create offensive or degrading associations and thus harm the value of the protected persona. To prevent undue constraint upon First Amendment protected speech about public figures, publicity rights protection must be carefully balanced against free speech interests. In most cases, a speaker’s right to refer to a public figure will be superior to the publicity rights holder’s interest in controlling the manner in which a persona is used. However, publicity rights holders should prevail when they can establish that the defendant’s speech is not entitled to full First Amendment protection.

Consider the following hypothetical: a brash young filmmaker develops a project that he describes as a fictionalized fantasia inspired by the music, image, and life of Elvis Presley. The script features repeated violent outbursts by Presley, episodes of drug abuse, and sordid parties with pubescent groupies. Elvis’s guilt over his behavior is reinforced by a series of visits from the ghost of his mother Gladys, but, in the end, the pressures and frustrations of his career are too much for him and he spirals downward into decadence, sin, and death. The filmmaker secures financial backing from an independent production company despite the certainty of an NC-17 rating, because the executives are convinced that a film about Elvis can sell a lot of tickets.

The people managing Elvis’s artistic legacy learn of the project from a story in the entertainment press and rush to their lawyers to have the filming enjoined. On what legal theory can they base their claim? The filmmaker has scrupulously constructed his project to avoid the use of any copyright-protected material. Although many of the scenes in the script have no factual basis, defamation law provides no remedy because Elvis and the other real people depicted in the film are dead. An ordinary claim based on Elvis’s right of publicity would also fail. The right of publicity generally grants the power to control the use of a celebrity’s image in advertising and on merchandise, but does not prevent uses in arts or entertainment.

However, the estate’s attorneys construct an alternative theory, borrowing the doctrine of “dilution by tarnishment” from trademark law.
and applying it to the right of publicity. This trademark claim establishes liability for unauthorized uses of a mark that create offensive associations and thereby diminish the trademark's commercial value. The estate's attorneys argue that Elvis's persona is analogous to a well-known and very valuable trademark.

It, too, is vulnerable to damage by offensive or degrading uses. The estate files a complaint alleging that the proposed film will tarnish Elvis Presley's right of publicity and thereby inflict significant economic harm. Attached affidavits attest to the reluctance of third-party licensees to continue with their arrangements if the film were to be widely circulated. In essence, the complaint asserts the right of Presley's people to maintain the value and integrity of Elvis's image by protecting his persona from unauthorized, degrading uses.

In their answers, the filmmaker and production company assert a right under the free speech clause of the First Amendment to create an artistic work inspired by one of the most visible and important public figures of the Twentieth Century. To properly balance these two competing interests, the court must answer a question that has arisen in right of publicity cases since the right was first recognized: how much private control should be granted over the use of the image of a public figure?

A tarnishment action of the sort imagined in this hypothetical brings the conflict between the right of publicity and First Amendment values sharply into focus; the plaintiff's claim asserts a right to control the public image of a celebrity, not simply the right to be paid for its commercial exploitation. This Comment argues that although counter-vailing free speech interests should prevail in most cases, an action for tarnishment of the right of publicity should be recognized.

Part I of this Comment provides a brief introduction to the right of publicity, then outlines the trademark tarnishment claim and explains how it could be used to protect the right of publicity. Part II explains the relationship between the right of publicity and the First Amendment and argues that to prevail in a tarnishment claim, a plaintiff must establish that the defendant's expression is not entitled to full First Amendment protection. Part III examines three arguments that plaintiffs might use to satisfy this requirement.

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1. No reported opinion has discussed the application of a tarnishment theory to the right of publicity. However, courts in several cases have upheld claims for damage to the value of the right of publicity based on associations formed by undesirable uses, and dicta in other opinions suggest that the law should provide a remedy for this type of harm. See cases cited infra notes 24–25.

I. TARNISHMENT AND THE RIGHT OF PUBLICITY

The right of publicity is a well-established form of intellectual property that provides a significant stream of income for many celebrities. There is not, however, a legally recognized claim that protects the value of the right from harm it could suffer as a result of offensive or degrading uses of a celebrity’s persona. Trademark law protects a mark from this type of harm by allowing an action for dilution by tarnishment. This same cause of action could be used to protect the right of publicity.

A. The Right of Publicity: Introduction and Background

The right of publicity is an intellectual property right that gives individuals the power to control the commercial exploitation of their identities. In general, “commercial exploitation” includes advertising and merchandising. Thus, Ken Griffey, Jr. can say “yes” to Chevy and “no” to Ford, and Madonna can decide which photographs will be used on this year’s T-shirts and posters, and both will be paid for these uses of their personas.

The roots of this legal principle have been traced at least as far back as Samuel D. Warren and Louis D. Brandeis’s 1890 Harvard Law Review article, The Right of Privacy. This seminal article argued for recognition of a tort based on the unauthorized publication of private material including, in many cases, photographs taken without permission. Warren and Brandeis’s conception of a personal right has increasingly been replaced with an understanding that the right of publicity is a form of intellectual property. The intellectual property approach substitutes


4. 1 J. Thomas McCarthy, The Rights of Publicity and Privacy § 1.1[A][1] (1997) [hereinafter McCarthy on Publicity]. The Restatement (Third) of Unfair Competition defines a right of publicity infringement as “using without consent the person’s name, likeness, or other indicia of identity for purposes of trade.” Restatement (Third) of Unfair Competition § 46 (1995). Uses “for purposes of trade” include uses in advertising and on merchandise. Id. § 47.


6. Warren & Brandeis, supra note 5, at 205-06.

7. Judicial recognition of the right of publicity as a property right is usually identified with Haeelen Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868-69 (2d Cir. 1953) (holding that baseball players had “right to publicity” that permitted them to sell exclusive licenses for use of their
misappropriation for a sometimes fictional personal harm,\textsuperscript{8} permits more flexible licensing agreements,\textsuperscript{9} and provides support for allowing the right to descend to the heirs of a deceased celebrity.\textsuperscript{10} This last point has been controversial,\textsuperscript{11} but the advocates for a descendible right appear to be winning the debate. As of 1997, seventeen jurisdictions had addressed the question, with fourteen holding that the right survives and may be inherited, and only three holding that it is extinguished upon death.\textsuperscript{12}

B. The Need for a Right of Publicity Tarnishment Claim

Publicity rights derive their value from the associations they carry with the public. This value may be diminished by degrading or offensive uses. An executive from Elvis Presley Enterprises, the organization that controls Presley’s right of publicity, emphasizes the importance of preventing unauthorized uses that “demean the long-term value of what we’ve got.”\textsuperscript{13} Similarly, a recent controversy over a pornographic film photographs on baseball cards). An important early article expounding the intellectual property theory is Melville B. Nimmer, *The Right of Publicity*, 19 Law & Contemp. Probs. 203 (1954). For an interesting examination of the historical tension between the personal right and intellectual property models for publicity rights protection, see Goodenough, *supra* note 5, at 721–46.

8. It was difficult for celebrities to claim that they were personally humiliated and embarrassed by the public exposure from the defendant’s use. *See Haelan Labs.*, 202 F.2d at 868 (“[I]t is common knowledge that many prominent persons (especially actors and ball-players) far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements . . . .”).

9. 1 McCarthy on Publicity, *supra* note 4, § 10.1[B] (comparing limitations on licensing under tort and property rights models).

10. *See, e.g.,* Maritote v. Desilu Prods., Inc., 345 F.2d 418 (7th Cir. 1965) (holding that heirs of Al Capone could not bring right of publicity claim after his death because right was personal and therefore did not survive); Estate of Presley v. Russen, 513 F. Supp. 1339, 1354–55 (D.N.J. 1981) (stating that New Jersey recognizes common law property right in identity and that right may be inherited).


13. Gywnne, *supra* note 2, at 66 (quoting Elvis Presley Enterprises executive Jack Soden). The Presley organization appears to know what it is doing. Presley’s estate was worth an estimated $4.5 million when he died in 1977; shrewd marketing and aggressive enforcement of Presley’s publicity rights have created an industry that generates an estimated $75 million per year. *Id.* at 64. The Presley estate was the plaintiff in several important right of publicity decisions. *See, e.g.,* Elvis
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allegedly featuring the young Marilyn Monroe has pitted the owners of the film against representatives of her estate, who claim the film is a fake. 14 Presumably, the estate’s representatives believe that widespread circulation of these films would damage Monroe’s valuable persona. The recent development of powerful image manipulation technology makes the unauthorized creation of degrading images with no involvement by the celebrity increasingly likely. 15 Moreover, the value of a persona can suffer harm in numerous other ways. Anything from a scandal biography, to an association with the wrong political cause, to a novel featuring a real-life celebrity heroin addict, could damage the value of a famous persona. Despite the somewhat abstract nature of a persona, harm from such uses is far from illusory. The economic stakes can be very high, 16 and many celebrities expend significant resources managing and exploiting their personas. 17

Several well-accepted legal theories provide a right of publicity holder with an indirect remedy for image tarnishment in some cases. If the offensive use is in an advertisement or on merchandise, the publicity rights holder can enjoin it under accepted right of publicity principles. 18 But the conventional understanding of the right provides no relief from harm caused by uses in books, movies, or other non-commercial media. Torts such as defamation 19 and false light invasion of privacy 20 provide


16. See, e.g., Gwynne, supra note 2, at 64 (estimating current Elvis Presley related revenue at $75 million per year); Peter Newcomb, The New Aristocracy, Forbes, Oct. 3, 1988, at 114 (describing increasing amounts earned from exploitation of publicity rights of such celebrities as Jimi Hendrix and Elvis Presley).
17. See, e.g., Gwynne, supra note 2, at 62–66 (describing Presley organization’s efforts to exploit his persona); see also White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1399 (9th Cir. 1992).
18. See supra notes 3–4 and accompanying text (discussing scope of right of publicity).
19. There is no universally accepted definition of defamation. One common formulation is speech that injures the plaintiff by holding him or her up to “hatred, contempt, or ridicule.” W. Page Keeton et al., Prosser and Keeton on the Law of Torts § 111, at 773 (5th ed. 1984).
20. A claim for false light invasion of privacy establishes liability for a publication that suggests something false and offensive about the plaintiff. For example, an honest cabdriver whose photograph was used to illustrate a story about corruption in the taxi industry was allowed to recover against the paper that published the story. Peay v. Curtis Publ’g Co., 78 F. Supp. 305 (D.D.C. 1948); see also 1 McCarthy on Publicity, supra note 4, § 5.12; Diane Leenheer Zimmerman, False Light
some protection because they permit reputational damages to be an element of a plaintiff's recovery. But these tort claims are for personal injuries, and, as such, do not necessarily protect the property right in a persona. These claims do not address situations in which damage to the value of a persona does not produce corresponding personal harm. For example, defamation claims cannot be brought if the defamed individual is dead. Although the right of publicity can continue to have enormous economic value long after a celebrity is dead, and this value can be harmed by speech that holds the celebrity up to "hatred, contempt or ridicule," defamation provides no remedy.

The failure of these indirect remedies to protect the right in every case supports the recognition of a new claim based on harm to the right of publicity. Several reported cases have included damage awards for this type of harm, and others have at least suggested that the law should provide such a claim. However, courts and commentators have neither identified nor described a new cause of action. Such a claim could be modeled on the trademark action for dilution by tarnishment.


21. See Restatement (Second) of Torts § 906 cmt. c (1979).


23. See supra note 19.

24. See, e.g., Eastwood v. National Enquirer, Inc., 123 F.3d 1249, 1256 (9th Cir. 1997) (upholding jury award of damages for right of publicity infringement based on fabricated Enquirer interview); Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1104 (9th Cir. 1992) (upholding jury damage award for injury to "goodwill and future publicity value" from use in Doritos commercial of voice imitating singer Tom Waits).

25. See, e.g., Ali v. Playgirl, Inc., 447 F. Supp. 723, 729 (S.D.N.Y. 1978) (finding that by distributing nude caricature of Muhammad Ali, "defendants appear not only to be usurping plaintiff's valuable right of publicity for themselves but may well be inflicting damage upon his marketable reputation"); Lugosi v. Universal Pictures, 603 P.2d 425, 438 (Cal. 1979) (Bird, C.J., dissenting) (noting that right of publicity infringement may disrupt "the individual's effort to control his public image, and may substantially alter that image"); Southeast Bank, N.A. v. Lawrence, 483 N.Y.S.2d 218, 220–23 (N.Y. App. Div. 1984) (holding that heirs of Tennessee Williams could enjoin use of Williams's name on defendants' theater, in part because productions might not come up to Williams's "standard" and thus could damage value of his name), rev'd, 498 N.Y.S.2d 775 (N.Y. 1985); see also H. Lee Hetherington, Direct Commercial Exploitation of Identity: A New Age for the Right of Publicity, 17 Colum.-VLA J.L. & Arts 1, 16–17 (1992) (arguing that dilution can be important theory of harm in right of publicity infringement cases).
C. Trademark Tarnishment

Dilution by tarnishment is a theory of trademark infringement that establishes liability for the offensive or degrading use of a trademark. In a traditional trademark infringement claim, the plaintiff must prove that consumers are likely to be confused by the defendant's use. In a dilution by tarnishment action, the plaintiff need not prove likelihood of confusion, but instead must show that the defendant's use will damage the value of the mark by creating offensive or disreputable associations.

Uses that involve either pornography or illegal drugs are frequently the subject of tarnishment claims. For example, in Coca-Cola Co. v. Gemini Rising, Inc., the defendant was enjoined from distributing red and white "Enjoy Cocaine" posters imitating the plaintiff's distinctive layout. Most statutes that authorize dilution by tarnishment claims, including the dilution provision in the federal trademark act, require the plaintiff to establish that the mark is sufficiently famous to suffer reputational harm.

D. Right of Publicity Tarnishment

1. The Claim and Remedies

A claim for right of publicity tarnishment provides a clear and coherent theory of harm for which the law should provide a remedy. Personas, like trademarks, can be tarnished by offensive or disreputable associations. Trademark tarnishment actions are invariably authorized by anti-dilution provisions in trademark statutes. Even without a similar

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27. Confusion in a trademark case generally relates to the source of the goods. If a shoe manufacturer puts out a new brand of sneakers bearing a symbol that looks too much like Nike's swoosh, then potential customers considering the product may be confused or misled into believing that the shoes are actually made by Nike. Consumer confusion is the key issue in a traditional trademark infringement claim. See 15 U.S.C. § 1114 (1994) (establishing liability for any unauthorized use of registered mark that is "likely to cause confusion, or to cause mistake, or to deceive"); Restatement (Third) of Unfair Competition § 20 (1995) (describing tests for likelihood of confusion in trademark claim).
31. See Restatement (Third) of Unfair Competition § 25 (stating that trademark dilution actions must be authorized by statute); cf. 3 McCarthy on Trademarks, supra note 26, § 24:78 (suggesting
statute protecting the right of publicity, a court could create a common law action or, perhaps, treat the protected persona as a type of trademark and recognize the action under a trademark anti-dilution statute. As with right of publicity misappropriation claims, injunctions would be the primary remedy. Damages, although available, would, in most cases, be difficult to calculate and less important than the prevention of continuing harm.

2. **Definition of Harm**

An action for tarnishment of the right of publicity should be limited to cases where there has been, or where there threatens to be, an actual reduction in the value of a persona. Judges in trademark tarnishment cases have sometimes found liability for an “offensive or degrading” use of a trademark without finding that the value of the trademark has, in fact, been harmed by the association. For example, in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, the court held that the pornographic film *Debbie Does Dallas* tarnished the plaintiff’s trademark. The court cited no objective evidence of harm, instead supporting its conclusion with the observation that “it is hard to believe that anyone who had seen defendants’ sexually depraved film could ever thereafter disassociate it from plaintiff’s cheerleaders.”

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32. See *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 729 (S.D.N.Y. 1978) (suggesting that defendant is liable for reputational damage as well as for unjust enrichment); cf. 3 McCarthy on Trademarks, supra note 26, § 24:78 (suggesting that trademark dilution actions could be grounded in common law).

33. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992) (analyzing trademark infringement claim in which mark is celebrity persona). The availability of a trademark tarnishment claim does not, however, render a right of publicity tarnishment claim redundant. The property right that the plaintiff seeks to protect is different in each case, indicating that damages and even liability could vary. In addition, in many cases the availability of right of publicity tarnishment for non-celebrities would provide a cause of action for a plaintiff whose name was not sufficiently famous to suffer trademark dilution. See infra notes 39–41 and accompanying text.

34. See Restatement (Third) of Unfair Competition § 48 cmt. b (1995) (stating that injunctions against continuing use are “particularly appropriate” and are “customary” remedy in right of publicity infringement cases).

35. See *Ali*, 447 F. Supp. at 729 (noting difficulty in calculating damages when harm to “reputation, credibility or good will is present”) (citation omitted).

36. 604 F.2d 200, 205 (2d Cir. 1979).

37. *Id.*
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Given the threat to free speech posed by right of publicity tarnishment claims, a fact-finder's individual reaction is simply too arbitrary to serve as a reliable standard; liability should not depend on the values of the particular judge or jury who hears the case. More important, exclusive reliance on the "offensive" nature of a given use ignores the harm to the value of a persona that a tarnishment claim is intended to prevent. Indeed, some scandalous uses may increase the value of a celebrity's persona, and the same use that would reduce the value of, say, Julia Roberts's image might prove a windfall to Mick Jagger's.

The focus of the claim, then, must be on the economic consequences of the use of the persona, not on the characterization of the use as "offensive" or "degrading." The plaintiff should be required to provide affirmative proof that the use in question will damage the value of the persona. Typical forms of evidence would include testimony from current or potential publicity rights licensees who would be reluctant to renew their arrangements; testimony by experts in publicity rights marketing on the effects of the allegedly tarnishing use; and, possibly, testimony or documentation demonstrating that the plaintiff had taken active steps in the past to avoid the associations created by the defendant's use, such as rejected licensing requests or evidence of legal action taken against similar unauthorized uses.

3. The Requirement of Fame

Right of publicity tarnishment, unlike trademark tarnishment, should not require a showing that the persona at issue is famous or distinctive. The trademark requirement derives from the definition of the action as a form of "dilution" or lessening of a mark's present ability to serve as a distinctive identifier for the plaintiff's goods. A "weak" trademark that is either commonplace or not widely identified with the plaintiff's goods cannot suffer this type of harm. A persona, however, is inherently distinctive and valuable. Even a non-celebrity has the potential to contribute value to an advertisement by authorizing the use of her picture or her voice. Because of this inherent value, most jurisdictions recognizing the right of publicity hold that both celebrities and non-

38. See discussion infra Part II.
39. 3 McCarthy on Trademarks, supra note 26, § 24:108.
40. See, e.g., Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 265 (5th Cir. 1980) (dismissing dilution claim because plaintiff's mark was "weak"); see also 3 McCarthy on Trademarks, supra note 26, §§ 24:108–09.
celebrities benefit from the right. Because non-celebrity claims would be rare, this Comment focuses on the First Amendment implications of celebrity tarnishment claims.

II. THE RIGHT OF PUBLICITY AND THE FIRST AMENDMENT

The First Amendment prohibits the enforcement of laws that unduly restrict free and open public discourse. Because plaintiffs who bring right of publicity claims are likely to be prominent public figures, an expansive authorization for such claims would directly conflict with the free speech guarantee. The most serious objection to the recognition of an action for right of publicity tarnishment, therefore, is its potential impact on freedom of expression. Tarnishment claims may be particularly suspect because the expression they target would not generally be commercial speech of the sort at issue in other right of publicity claims, but would be more extensively protected non-commercial speech.

A. The Limited First Amendment Protection for Commercial Speech

Currently, the scope of the right of publicity is limited to controlling the use of a persona in advertising and on merchandise, in part to keep the impact on public discourse limited to a constitutionally acceptable

41. See 1 McCarthy on Publicity, supra note 4, § 4.3[A] ("[T]he vast majority of commentators and courts [assert] that everyone has a Right of Publicity."). Proposed legislation in Washington state provides lesser protection for non-celebrities ("individuals") than for celebrities ("personalities"). Compare H.B. 1074, 55th Leg., Reg. Sess. § 3(3) (Wash. 1997) (allowing for termination of publicity rights for deceased "individual" if rights have not been exploited for three consecutive years), with id. § 3(2) (granting seventy-five year posthumous publicity right for "personalities").

42. U.S. Const. amend. I ("Congress shall make no law . . . abridging the freedom of speech, or of the press . . . "); see also Hustler Magazine v. Falwell, 485 U.S. 46, 50 (1987) ("At the heart of the First Amendment is the recognition of the fundamental importance of the free flow of ideas and opinions on matters of public interest and concern."). The First Amendment prohibits only governmental restrictions on free expression. Although a right of publicity claim is based on private rights, not governmental restrictions, a court's enforcement of the right in a manner restricting speech is sufficient government action to invoke the First Amendment. Cf: New York Times Co. v. Sullivan, 376 U.S. 254, 265 (1964) (holding that state court enforcement of defamation claim was sufficient governmental action to trigger First Amendment protections); see also Robert C. Denicola, Trademarks As Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols, 1982 Wis. L. Rev. 158, 190 n.146 (analyzing "state action" doctrine in cases involving conflicts between intellectual property rights and First Amendment).

43. See Hustler Magazine, 485 U.S. at 51 (holding that there is strong First Amendment protection for speech critical of "public figures who are "intimately involved in the resolution of important public questions or, by reason of their fame, shape events in areas of concern to society at large") (quoting Curtis Publ'g Co. v. Butts, 388 U.S. 130, 164 (1967) (Warren, C.J., concurring)).
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level. Of course, advertising is a form of expression, but under the U.S. Supreme Court's "commercial speech" doctrine it may be restricted without offending the First Amendment. The Court has defined "commercial speech" as any expression that "propose[s] a commercial transaction." Commercial speech enjoys some First Amendment protection, and the Court has developed a test to determine if a restraint on advertising should be permitted. Although the Court has never addressed the issue, most commentators and lower courts agree that an action to restrict the use of a persona in advertising can survive First Amendment scrutiny under the commercial speech test.

The lower level of First Amendment protection given to commercial speech has little bearing on tarnishment claims because commercial uses of identity may be restricted by the right of publicity holder whether or not they are tarnishing. Michael Jordan could enjoin the use of his photograph in a cigarette advertisement, for example, without establishing that the association with smoking harms his image. The extra element of harm in tarnishment claims, then, would most often be used to justify actions directed at non-commercial expression. This extension of the right of publicity creates a potentially severe conflict with principles of free speech.

44. See, e.g., 2 McCarthy on Publicity, supra note 4, § 7.1[B] (outlining conflict between right of publicity and First Amendment in commercial speech context).

45. Board of Trustees of State Univ. of New York v. Fox, 492 U.S. 469, 473-74 (1989) (quotations and citations omitted). This Comment uses the term non-commercial speech to identify the class of all speech that does not propose a commercial transaction.

46. The test begins with the determination that the speech is not misleading and that it promotes a lawful activity. If this threshold test is not met, the speech is not protected at all and the restriction will be upheld without further inquiry. If the threshold test is met, the plaintiff must prove that the government interest advanced by the restriction is substantial, that the restriction directly advances that interest, and that the restriction is not more extensive than necessary to serve that interest. Id. at 475.

47. See, e.g., 2 McCarthy on Publicity, supra note 4, §§ 7.1[B], 8.3; Peter L. Felcher & Edward L. Rubin, Privacy, Publicity, and the Portrayal of Real People by the Media, 88 Yale L.J. 1577, 1606 (1979); Roberta Rosenthal Kwall, The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis, 70 Ind. L.J. 47, 107-12 (1994) (providing framework for analyzing First Amendment implications of right of publicity claims against uses that are primarily commercial).

48. See, e.g., White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1401 n.3 (9th Cir. 1992) (citing commercial speech doctrine as basis for rejecting First Amendment defense of advertisement parodying Vanna White); see also Onassis v. Christian Dior—New York, Inc., 472 N.Y.S.2d 254, 262 (N.Y. Sup. Ct. 1984) ("Little more heed need be given to the contention that somehow this advertisement is privileged as a protected form of free speech. It deals with the sale of goods and not with the promulgation of ideas.").

49. Proof of tarnishment might affect the damage award in a commercial speech case. See infra Part III.A (discussing commercial tarnishment claims).
B. Right of Publicity Claims Directed at Non-Commercial Speech

The threat to free speech posed by an expansive right of publicity is so severe that some commentators have suggested incorporating First Amendment limits directly into the definition of the right. Others have argued for a broader definition of the right and suggest that the free speech implications are best considered on a case-by-case basis. The prospect of facing an undiluted First Amendment defense has not prevented right of publicity plaintiffs from bringing claims against movies, books, stage shows, and even news programs. Most of these claims have failed, but a few have been successful. No general principle has emerged from the cases to determine when a right of publicity claim can prevail over the defendant’s free speech rights.

50. See Restatement (Third) of Unfair Competition § 46 (1995) (defining right of publicity as right to use individual’s identity for purposes of trade); Felcher & Rubin, supra note 47, at 1622.

51. See, e.g., 2 McCarthy on Publicity, supra note 4, § 8.6[E]; Kwall, supra note 47, at 86–112 (weighing First Amendment and right of publicity interests in several commercial and non-commercial contexts). The right of publicity bill currently before the Washington State Legislature is an example of this approach. The bill would grant every individual residing in the state a "property right" in the use of his or her identity "in any medium in any manner." H.B. 1074, 55th Leg., Reg. Sess. § 2(1) (Wash. 1997). The bill then goes on in a separate section to provide a defense for uses in media traditionally protected by the First Amendment, such as news articles and art works. Id. § 6.


56. Certainly the most notable of these cases is the U.S. Supreme Court’s only opinion to date that addresses the right of publicity, Zacchini v. Scripps-Howard Broadcasting Co. In Zacchini, the Court held that the First Amendment did not bar a right of publicity claim by a “human cannonball” circus performer against a television network that had broadcast an unauthorized tape of the performer’s entire act on the evening news. Id. at 565–66. Because the case turned on the station’s having misappropriated Zacchini’s entire performance, a very uncommon situation, it provides little insight into the resolution of more ordinary right of publicity and First Amendment conflicts. Other right of publicity claims directed against non-commercial speech that have been upheld include Estate of Presley and Apple Corps.
Resolving this conflict requires an examination of the interests at stake in the claim for both the plaintiff and the defendant.

III. A FRAMEWORK FOR ANALYZING FIRST AMENDMENT ISSUES IN RIGHT OF PUBLICITY TARNISHMENT CLAIMS

An expression that harms the value of a persona may nonetheless deserve First Amendment protection. The U.S. Supreme Court has noted on several occasions that the right to criticize public figures is central to free speech. Criticism, parody, and even straight reporting of embarrassing facts might damage the value of a celebrity’s image, but rather than provide a remedy for this type of harm, the law protects this type of speech. Courts deciding right of publicity tarnishment claims, then, must determine not just that the use of the persona is harmful, but that the use should not be protected. Although the burden of proof on this issue could conceivably fall on either the plaintiff or the defendant, the public interest in free and open speech about public figures is strong enough that the defendant should not be forced to justify his or her speech; rather, the burden should be on the plaintiff to demonstrate that the claim would not have a stifling effect on public discourse.

There are at least three arguments a plaintiff could use to show that the defendant’s speech is not entitled to First Amendment protection: (1) the infringing use is commercial speech, and thus enjoinable under the commercial speech doctrine; (2) the defendant’s speech meets the “actual malice” requirement for defamation of a public figure; or (3) because the defendant’s use of the persona is peripheral to the defendant’s intended message, the message could be communicated through an alternative means of expression. The commercial speech

57. See, for example, *Hustler Magazine v. Falwell*, 485 U.S. 46, 51 (1988), in which the Court stated:

The sort of robust political debate encouraged by the First Amendment is bound to produce speech that is critical of those who hold public office or those public figures who are intimately involved in the resolution of important public questions or, by reason of their fame, shape events in areas of concern to society at large.

*Id.* (internal quotation and citation omitted).

58. *Id.*

59. Similarly, in defamation claims brought by public figures, the First Amendment requires that the plaintiff prove the statement was made with knowledge of falsity or reckless disregard for its truth or falsity. *New York Times Co. v. Sullivan*, 376 U.S. 254, 279–80 (1964).

60. This list of approaches to the First Amendment problem is not meant to be exhaustive, but to illustrate the types of arguments that the plaintiff could use to overcome the constitutional barrier to the claim. A plaintiff could argue that the defendant’s speech is obscene, *see generally* Lawrence H.
and actual malice assertions, if plaintiffs succeed in proving them, should present the courts with little difficulty: it is well settled that speech in these categories is subject to legal sanctions. The third argument, based on the adequate alternatives test, is much more controversial. Thus, this Part briefly considers the first two arguments before moving on to a more thorough examination of the third.

A. Tarnishing Commercial Speech

Commercial uses of an identity can be enjoined by the right of publicity holder even without a showing of tarnishment. The least controversial tarnishment case, therefore, would involve infringement through commercial speech. Although proof of tarnishment is not required to obtain an injunction against a commercial use, this type of harm provides an independent claim, perhaps increasing the damages in a commercial use case. Also, the determination that a use is commercial is not always clear-cut; in close cases, evidence of harm from tarnishment might encourage the judge or jury to side with the plaintiff. These close cases often involve proof that the defendant’s use, in the words of one New York court, is a “disguised commercial advertisement.” Even a use in a book, movie, or magazine might be held to be commercial if the plaintiff can demonstrate that the reference to the celebrity bears no genuine relation to the expressive content of the work. The plaintiff in such a case would argue that the defendant has simply affixed the celebrity image to an unrelated product to attract consumer attention and increase sales. Featuring a celebrity’s picture on

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Tribe, American Constitutional Law §§ 12–16 (2d ed. 1988), or that it misappropriates the plaintiff’s entire performance, see Zacchini, 433 U.S. at 578–79.

61. See, e.g., Eastwood v. National Enquirer, Inc., 123 F.3d 1249, 1256 (9th Cir. 1997) (upholding judgment for damages from defamation and right of publicity misappropriation for publication of false statements with actual malice); White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1401 n.3 (9th Cir. 1992) (citing commercial speech doctrine as basis for rejecting First Amendment defense of advertisement parodying Vanna White).

62. See supra Part I.A (discussing scope of right of publicity).

63. Frosch v. Grosset & Dunlap, Inc., 427 N.Y.S.2d 828, 829 (N.Y. App. Div. 1980) (holding that right of publicity claim against biography of Marilyn Monroe was barred by author’s right to free expression, unless use of Monroe’s persona was disguised advertisement).

64. See Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454, 457 n.6 (Cal. 1979) (Bird, C.J., concurring) (indicating that right of publicity claim could be brought based on use of celebrity’s name on “wholly unrelated” work); Rogers v. Grimaldi, 875 F.2d 994, 1004 (2d Cir. 1989) (affirming Justice Bird’s analysis from Guglielmi). Such commercial uses are arguably not speech at all, because they contain no message about the celebrity, but instead are analogous to merchandise such as posters and T-shirts featuring a celebrity’s picture.
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the cover of an unrelated work may be particularly suspect.65 One court has suggested that publication of a *Rudolph Valentino Cookbook* would be enjoinable if the recipes bore no legitimate relationship to Valentino.66

In the case of pornographic works, a finding that the use is commercial might not be uncommon. Pornography frequently borrows images from popular culture.67 Some of these references qualify as parody or other commentary on their subjects, but others do not. For example, images created by using a computer graphics program to paste a celebrity’s head onto the body of a disrobed model68 have no discernible expressive content in relation to the celebrity. Even a traditional pornographic film featuring an actor impersonating a celebrity could be enjoined as commercial speech if the film made no attempt to include plot or characterization elements relating to the celebrity’s life.

There are at least two policy justifications for permitting an injunction in these circumstances. One is the prevention of consumer confusion, particularly if the celebrity’s name is used in the title or on the outside packaging of the work.69 Second, this type of infringement is indistinguishable from a traditional commercial use and therefore deserves little First Amendment protection. Rather than expressing a message about a public figure, the defendant is simply using a famous image to draw attention to its product. Because the work communicates nothing about the celebrity, the defendant’s use of the celebrity’s image could be enjoined without stifling legitimate public discourse.

**B. Right of Publicity Tarnishment Using the Actual Malice Standard**

The second approach that a tarnishment plaintiff might take to overcome the First Amendment barrier—proving actual malice—is


67. See, for example, the titles of pornographic films at the “Cult Films” website, including “The Howard Sperm Show.” Ronnie Cramer, *Cult Film Site: Hardcore XXX Films* (visited Nov. 14, 1997) <http://www.sepnet.com/rcramer/hardcore.htm>.


69. See *Rogers*, 875 F.2d at 999 (discussing possibilities for consumer confusion from use of celebrity’s name in title of work).
borrowed from the modern analysis of defamation claims. Under a line of cases beginning with *New York Times Co. v. Sullivan*, the U.S. Supreme Court has held that the First Amendment protects media defendants from defamation claims by public figures unless the plaintiff can prove that the defendant acted with "actual malice." "Actual malice" is defined as publication of a statement with either knowledge of its falsity or with reckless disregard for its truth or falsity.

In *Hustler Magazine v. Falwell*, the Court held that the actual malice standard also applied to an action for intentional infliction of emotional distress. Although the thrust of the Court’s argument was that a plaintiff cannot use alternative theories of harm to escape the requirements of the First Amendment, the Court indicated that the reverse is also true: if actual malice can be proved, the First Amendment does not bar recovery on an alternative theory. For a right of publicity holder, tarnishment provides such an alternative theory.

Although the actual malice standard is very difficult to meet, plaintiffs have succeeded on occasion, as several published opinions demonstrate. Because the plaintiff would have to meet the essential elements of a defamation claim anyway, right of publicity tarnishment with proof of actual malice would be redundant in many cases. But the claim could provide an additional component of a damage award, and,

70. 376 U.S. 254 (1964).
73. Falwell, 485 U.S. at 56.
74. Id. (“PUBLIC FIGURES . . . MAY NOT RECOVER FOR THE TORT OF INTENTIONAL INFLEXION OF EMOTIONAL DISTRESS BY REASON OF PUBLICATIONS . . . WITHOUT SHOWING IN ADDITION THAT THE PUBLICATION CONTAINS A FALSE STATEMENT OF FACT WHICH WAS MADE WITH ‘ACTUAL MALICE’ . . . ”).
76. See Eastwood v. National Enquirer, Inc., 123 F.3d 1249, 1250, 1256 (9th Cir. 1997) (upholding damages for harm to reputation in lawsuit that was based on right of publicity and that included no explicit defamation claim).
for the estate of a deceased but still-famous celebrity, a tarnishment action might be the only remedy available.\footnote{77}{As noted previously, a defamation action cannot be brought in the name of a dead person. See supra text accompanying note 22.}

A recent Ninth Circuit opinion applied the actual malice standard to a right of publicity claim. Clint Eastwood sued the \textit{National Enquirer} for publishing an "Exclusive Interview" with the star that, in fact, never took place.\footnote{78}{Eastwood, 123 F.3d at 1250. Ironically, the interview itself included no negative statements about Eastwood, but focused primarily on his relationship with his infant son and current paramour. The damages were attributable to fans' likely feelings that Eastwood must be washed up as a star if he was giving exclusive interviews to the \textit{Enquirer}. \textit{Id.} at 1256.} Eastwood's claims were for deceptive trade practices and right of publicity misappropriation, but the court noted that "the gist of the complaint is that Eastwood's reputation was damaged."\footnote{79}{\textit{Id.} at 1250.} The circuit court opinion, however, did not identify defamation among the claims Eastwood brought, suggesting that the reputational harm was considered damage to the right of publicity value.\footnote{80}{\textit{Id.}} Thus, the court cited \textit{Waits v. Frito-Lay, Inc.}, an important right of publicity case, in support of the amount of the damage award.\footnote{81}{\textit{Id.} at 1256 (citing \textit{Waits v. Frito-Lay, Inc.}, 978 F.2d 1093, 1104 (9th Cir. 1992)).} In response to the \textit{National Enquirer}'s argument that its story was protected by the First Amendment, the circuit court found that the \textit{Enquirer} published the "interview" with actual malice. Although the opinion does not discuss harm to the right of publicity in any detail, it clearly supports the use of the actual malice standard to overcome the First Amendment defense to such a claim.\footnote{82}{Lloyd Corp. v. Tanner, 407 U.S. 551, 567 (1972).}

\textbf{C. The Adequate Alternatives Test}

As a third option, the plaintiff in a right of publicity tarnishment action could counter a First Amendment defense by arguing that the defendant has "adequate alternative avenues of communication."\footnote{83}{Lloyd Corp. v. Tanner, 407 U.S. 551, 567 (1972).} This test was first used by the U.S. Supreme Court to balance real property rights against the right to free speech and has subsequently been applied to intellectual property cases by several lower courts. In the publicity rights context, the adequate alternatives test would most often turn on the distinction between speech about the celebrity, which must invoke the celebrity's identity, and speech using the image of the celebrity to
communicate a message about something else. Limiting injunctions to the second group would protect the content of public discourse from overreaching assertions of control by publicity rights holders, but would also allow rights holders to prevent needlessly harmful uses.

Imagine, for example, a public service message on the dangers of drug abuse featuring an unflattering picture of Elvis Presley with the words "Dead at 42" as a caption. Since there are numerous ways to express the message "stay off drugs," the owners of Presley’s publicity rights could enjoin this use without restricting the fundamental content of the expression. On the other hand, a parody of Presley, a piece of criticism, or an article describing his last days all have him as their subject. These forms of expression could not exist if the references to Presley were prohibited. Therefore, the owners of Elvis’s publicity rights could not prevent dissemination of such materials without violating the speaker’s First Amendment rights.

1. Evaluation of the Adequate Alternatives Test in Intellectual Property Cases

The adequate alternatives test, unlike the commercial speech or actual malice approaches, poses a genuine threat to speech that otherwise enjoys full constitutional protection under the First Amendment. Accordingly, the courts have applied the test cautiously.

The origin of the adequate alternatives test is a U.S. Supreme Court opinion on a conflict between the First Amendment and real property rights. In *Lloyd Corp. v. Tanner*, the Court held that the owner of a shopping mall could prohibit the distribution of political handbills inside the mall. Because the public spaces around the mall presented an alternative place to distribute the handbills, the plaintiffs' First Amendment rights were not excessively burdened by the enforcement of the mall owner's property rights.

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84. Although this style of message is often called an "advertisement," it does not propose a commercial transaction, and hence would not be enjoinable under the commercial speech doctrine. See *supra* text accompanying notes 44–46 (discussing commercial speech and First Amendment).
85. See *supra* Part III.A.
86. See *supra* Part III.B.
87. 407 U.S. 551.
88. *Id.* at 570. The handbills at issue in the case solicited support for an anti-Vietnam war group. *Id.* at 556. The Court noted, however, that the mall owner had a policy against all leafleting, regardless of content. *Id.* at 567.
89. *Id.* at 566–67.
The application of the adequate alternatives test to intellectual property has been controversial, and trademark tarnishment cases have been an important battleground in this dispute. In *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, the Second Circuit upheld an injunction against *Debbie Does Dallas*, a pornographic film that featured performers wearing imitations of the plaintiff's trademarked uniforms. The court assumed that the defendant's film was protected by the First Amendment; nevertheless, it held that the injunction did not violate the Constitution because there were many alternative ways for the defendant to communicate its message about "sexuality in athletics." Although the court was clearly appalled by the defendant's "gross and revolting" film, the court's holding was not based on a finding of obscenity, or even tarnishment. Instead the court simply imported the adequate alternatives principle from *Lloyd* without modification and held that a rights holder can prevent the use of intellectual property as long as an adequate alternative exists. Read literally, *Dallas Cowboys Cheerleaders* stands for the proposition that an intellectual property owner can enjoin any expression that refers to the property in a manner that is not essential to the message being conveyed. News stories, novels, and movies mentioning a protected trademark could be enjoined under this principle, unless the work was clearly about the corporation or product identified by the mark.

Although the *Dallas Cowboys Cheerleaders* court was particularly brazen in its application of the adequate alternatives principle, other courts have followed the same basic approach. Some courts, however, have criticized the opinion's reliance on the adequate alternatives test in

90. 604 F.2d 200 (2d Cir. 1979).
91. Id. at 202--04, 207.
92. Id. at 206.
93. Id. at 203.
94. Id. at 206 ("Plaintiff's trademark is in the nature of a property right, and as such it need not 'yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.'" (quoting *Lloyd*, 407 U.S. at 567) (citations omitted)).
95. See, e.g., Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397, 402 (8th Cir. 1987) (upholding permanent injunction against using variations of plaintiff's trademark, including "Mutant of Omaha," on merchandise conveying opposition to development of nuclear weapons); Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 759 (9th Cir. 1977) (upholding injunction, based on copyright ownership, against underground comic book featuring lascivious doppelgangers of famous Disney characters); Interbank Card Ass'n v. Simms, 431 F. Supp. 131, 132--33 (M.D.N.C. 1977) (granting injunction against use of Master Charge trademark by religious group in "Give Christ Charge of Your Life" campaign).
an intellectual property case. A later decision by the Second Circuit recast *Dallas Cowboys Cheerleaders* as a false advertising/commercial speech decision, apparently limiting the holding to that context. Courts critical of the adequate alternatives test in intellectual property cases suggest that the test does not provide sufficient protection for freedom of expression. Restrictions on the use of real property relate primarily to the location of the speech; restrictions on the use of intellectual property, on the other hand, affect the actual words that may be spoken. Courts have expressed skepticism that the adequate alternatives test can satisfactorily separate the means of communication from the content of the message.

If right of publicity holders can enjoin the use of their property in non-commercial contexts, they may be capable of imposing severe restrictions on public discourse. One circuit court has argued that permitting any trademark actions against non-commercial speech threatens to give too much control over speech to powerful corporations, control that could be used to stifle discussion of important issues involving the corporations. Similarly, right of publicity tamishment actions threaten to place too much control over discussion of public figures in private hands.

Although these arguments provide an effective critique of the extreme reach of the *Dallas Cowboys Cheerleaders* holding, the suggestion that the First Amendment prevents an intellectual property owner from ever basing a successful tamishment action on the adequate alternatives principle goes too far in the other direction. The potential restrictions on expression posed by such claims are, in fact, much less severe than these courts suggest. Restricting the words that speakers may use does limit

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96. See, e.g., Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 971 (10th Cir. 1996) ("We find, however, that in the context of intellectual property, *Lloyd*'s 'no adequate alternative avenues' test does not sufficiently accommodate the public's interest in free expression.").


98. See, e.g., Cardtoons, 95 F.3d at 971; Rogers 875 F.2d at 999; see also Denicola, supra note 42, at 197 (rejecting use of adequate alternatives test in trademark context because, "[t]hough other means of communication may be available, trademark use often offers opportunities unmatched by more conventional methods of expression").

99. See Rogers, 875 F.2d at 999 ("'[W]e cannot indulge the facile assumption that one can forbid particular words without running a substantial risk of suppressing ideas in the process.'") (quoting Cohen v. California, 403 U.S. 15, 26 (1971)); Cardtoons, 95 F.3d at 971.

100. L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 33 (1st Cir. 1987) ("If the anti-dilution statute were construed as permitting a trademark owner to enjoin the use of his mark in a noncommercial context found to be negative or offensive, then a corporation could shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct.").
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speech, but conservative application of the adequate alternatives principle would minimize this impact. Requiring proof of an alternative means of expression would prevent injunctions against criticism and commentary concerning a celebrity. Because these forms of speech are about the object of the publicity right, there would be no way to communicate the message without invoking the protected property.\textsuperscript{101} Also, the tarnishment claim’s requirement that the defendant’s use is likely to harm the value of the right would severely limit the availability of injunctions.\textsuperscript{102}

Although the U.S. Supreme Court has not squarely addressed the application of the adequate alternatives principle to intellectual property, several Court opinions appear to be in line with a compromise approach. One of these is \textit{Zacchini v. Scripps-Howard Broadcasting Co.}, in which the Court upheld the plaintiff’s claim for right of publicity misappropriation based on a news program’s broadcast of an unauthorized film of his “human cannonball” performance.\textsuperscript{103} The Court emphasized that the defendant’s news program could have reported on Zacchini without broadcasting his entire act, stating that it would have had “a very different case” if Zacchini claimed his right of publicity trumped the station’s right to broadcast \textit{any} report.\textsuperscript{104} Thus, the opinion suggests that the First Amendment did not bar Zacchini’s action because the station had an available alternative for reporting the same news.

The Court’s opinion in \textit{San Francisco Arts & Athletics, Inc. v. United States Olympic Committee}\textsuperscript{105} also supports the use of the adequate alternatives principle. This case involved a challenge to the use of the phrase “Gay Olympics” based on the exclusive, trademark-like rights in the word “Olympics” that Congress granted to the U.S. Olympic Committee by special statute.\textsuperscript{106} Although the Court acknowledged that the challenged use was at least partially a non-commercial message about homosexuals and athletics, it held that an injunction prohibiting the use did not violate the First Amendment.\textsuperscript{107} The Court explained that

\textsuperscript{101} \textit{Id.} at 34 (rejecting application of adequate alternatives test to sexually explicit parody of L.L. Bean catalogue because parody could be interpreted as targeting trademark).
\textsuperscript{102} This principle, however, is one of the reasons for requiring concrete proof of harm. \textit{See supra} Part I.D.2.
\textsuperscript{103} 433 U.S. 562 (1977).
\textsuperscript{104} \textit{Id.} at 569, 574.
\textsuperscript{105} 483 U.S. 522 (1987).
\textsuperscript{106} \textit{Id.} at 525–27.
\textsuperscript{107} \textit{Id.} at 541 (“The mere fact that the SFAA claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to ‘appropriat[e] to itself the harvest
restrictions on speech resulting from prohibitions on the use of particular words must be balanced against proprietary interests in those words that others may have established. An injunction against the use of the phrase “Gay Olympics” would affect only the manner in which the message was conveyed, not its content, and therefore the injunction could stand. Thus, both San Francisco Arts and Zacchini support limited use of the adequate alternatives test to overcome First Amendment challenges in intellectual property cases.

2. Application of the Adequate Alternatives Test in Right of Publicity Tarnishment Claims

The adequate alternatives principle clearly gives priority to freedom of expression over the value of the publicity rights; if both are significantly threatened, the protection for speech should control. But if the restriction on speech would be minimal, the compromise struck by the test allows the rights holder to protect the value of her property. In essence, the plaintiff can prevent needless harm to the value of the right. This use of the adequate alternatives principle in tarnishment cases strikes a reasonable balance between the interests of the rights holders and the values protected by the First Amendment.

Because the potential encroachment on free speech is severe, the courts should be conservative in their application of the adequate alternatives principle to right of publicity tarnishment cases. The plaintiff should be required to make a clear showing of likelihood of harm because this element both justifies the plaintiff’s attack on expression and limits the claims to a narrowly defined class. In addition, courts should consider several potential pitfalls in exercising their power to make judicial findings about the message of the defendant’s speech.

of those who have sown.”) (quoting International News Serv. v. Associated Press, 248 U.S. 215, 239–40 (1918)).

108. Id. at 532. The Court stated:

This Court has recognized that words are not always fungible, and that the suppression of particular words runs a substantial risk of suppressing ideas in the process.... Yet this recognition always has been balanced against the principle that when a word acquires value as the result of organization and the expenditure of labor, skill, and money by an entity, that entity constitutionally may obtain a limited property right in the word.

Id. (internal citations and quotations omitted).

109. Id. at 536.

110. See supra Part I.D.2 (discussing proof of harm).

111. For purposes of this Comment, it is assumed that issues about the message of the defendant’s speech and about the availability of alternatives would be decided by the court as a matter of law.
Proof of adequate alternatives would be difficult, and perhaps impossible, for forms of discourse that do not have a readily identifiable message. The anti-drug advertisement example discussed above expresses a straightforward message, but cases involving more ambiguous or multi-layered expression, such as fiction, might place the court in the inappropriate role of literary critic or editor. The use of a real person in a minor, but scandalous, role in a novel might appear to be a superfluous element of the complete work to a casual reader, but might, in the mind of the author, be an essential thread inextricably woven into the plot of the book. Because the First Amendment provides extensive protection for arts and entertainment as well as more literal forms of expression, courts should defer to defendants’ free speech rights in such cases and disallow claims against expression that cannot be comfortably reduced to a restatable message.

A related problem with the application of the adequate alternatives principle derives from a court’s power to define the defendant’s message. A narrow interpretation could severely restrict the available alternatives and thus favor the defendant’s free speech rights; a broader reading would open up many alternatives and support the plaintiff’s request for an injunction. Once again, the constitutional implications of this test require that the court apply it conservatively and favor the free speech

112. See supra text accompanying note 84.

113. Consider Holmes’s famous statement from a copyright case about the protectability of a lowly circus poster:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke.


114. Cf. Gugliemi v. Spelling-Goldberg Prods., 603 P.2d 454, 460 (Cal. 1979) (“Contemporary events, symbols and people are regularly used in fictional works. Fiction writers may be able to more persuasively, more accurately express themselves by weaving into the tale persons or events familiar to their readers. The choice is theirs.”).


116. For example, the court in Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 206 (2d Cir. 1979), defined the message of the defendant’s film broadly—a parody of sexuality in athletics—and thus found that the defendant had many alternatives for expressing the message. Conversely, in L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 34 (1st Cir. 1987), the court read the message of the defendant’s magazine photo-spread narrowly: instead of being a parody of sex in the outdoors, or of sex and camping gear, it was a parody of the L.L. Bean catalogue itself, and it therefore had to make reference to the L.L. Bean trademark in order to communicate its message.
rights of the defendant in borderline cases. This grant of power to the judge is not so extensive or unusual that the test itself should be discarded; any reviewing court should, however, have de novo power to consider whether the defendant’s expression was construed in a properly deferential and conservative manner.

A final concern relates to the issue of truth. The defendant in a tarnishment claim might argue that, even though adequate alternatives exist, the First Amendment protects the right to use a celebrity’s image in a manner true to the facts of the celebrity’s life. The creators of the hypothetical anti-drug abuse message described above, for example, could claim that Presley really did have a drug problem and that they are therefore justified in using his image.

This argument should fail because truth does not play a role in the compromise that the adequate alternatives principle strikes between property rights and free speech. Under this compromise, rights holders are able to prevent harm that is merely a byproduct of speech about issues other than the celebrity. The truth of any statements or implications about the celebrity is unimportant because the statements are incidental to the expression. Surely it is not reasonable for a speaker to insist on causing incidental damage to another’s property right. The argument in support of the anti-drug message may seem sympathetic, in part, because of the presumption that drug abuse is immoral and therefore deserves to be punished. But imagine instead a similar advertisement by the American Heart Foundation promoting a healthy diet. Should this campaign, too, be permitted to use a photo of an obese Presley as its visual hook? Despite the apparent truth of the implication about Presley’s eating habits, such an advertisement would be needlessly destructive of the commercial value of Presley’s image and should be subject to injunction.

IV. CONCLUSION

Right of publicity tarnishment claims raise issues that are distinct from those in misappropriation claims: the definition of the harm is different, the threat is more immediate and potentially more severe, and the First Amendment problems are more acute. The claim is related to trademark tarnishment and defamation, but the interests protected by the right of publicity are sufficiently distinct that the claim is not redundant. Recognition of right of publicity tarnishment as an independent cause of action would create a legal framework for responding to these interests.
The most complex and troublesome consequence of recognizing a claim for right of publicity tarnishment will ultimately be the conflict with free speech. The operation of the First Amendment analysis proposed in this Comment can be illustrated using the hypothetical Elvis Presley film described in the introduction. Assuming that the evidence of harm is sufficient, the claim would turn on the Presley estate's ability to meet one of the First Amendment exceptions. The film as described does not appear to be commercial speech, and could not be enjoined on that ground. Only if the film consisted of a series of pornographic episodes with no discernible connection to Presley's life could the use of Presley's name and image be enjoined as a commercial use. Similarly, the adequate alternatives test provides little assistance to the estate in a claim against the film as described. Presley is the subject of the film, so there would be no alternative way to make the film without invoking his identity. The estate might then be left with the possibility of a tarnishment claim based on the actual malice standard. The application of defamation principles to fiction has been controversial because such works only make ambiguous truth claims. If the film is clearly inaccurate and clearly harmful, the estate could bring the claim on the theory that the principles of defamation in fiction apply at least as well to tarnishment.

Although the claim might not produce the result that the Presley estate would want in this hypothetical, this resolution serves a greater public good. Courts and commentators have rightly expressed concern that right of publicity claims pose a significant threat to the public's freedom to refer to public figures without paying compensation. Any suggestion that the right should be expanded to include a new cause of action, particularly one based on the content of speech about public figures, must be construed conservatively to avoid infringing rights protected by the First Amendment. However, that the claim is severely constrained by the Constitution does not mean that it serves no purpose whatsoever. Like defamation after Sullivan, it is possible to strike a compromise that favors speech in almost all cases, but still permits the rights holder to enjoin or collect damages for harmful speech that can be restricted without stifling public discourse.
