FCJ-104 Materialities of Law: Celebrity Production and the Public Domain

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The brand's image and its customer's self-image will be refracted through the 'prism' of a star's persona and produce a new set of perceptions … the reason it is tricky is that celebrities are unusual brands in that they talk back and they may also change their behaviour, their views and their perceived personality quite quickly, literally making them not the person they used to be and certainly not the individual with whom the brand originally partnered.

— Pringle, *Celebrity Sells*

Saddam Hussein wants to keep advertisers from using his picture in unflattering contexts. Clint Eastwood doesn't want tabloids to write about him. Rudolf Valentino's heirs want to control his film biography. The Girl Scouts don't want their image soiled by association with certain activities. George Lucas wants to keep Strategic Defense Initiative fans from calling it "Star Wars." … Uri Geller thinks he should be paid for ads showing psychics bending metal through telekinesis. … And scads of copyright holders see purple when their creations are made fun of.

— *White v Samsung Electronics*

Introduction: The Commercial-Cultural Formations of Celebrity Persona [1]

These opening quotations illustrate that the celebrity figure is able to produce considerable economic and social meaning, it is a 'locus of formative social power in consumer capitalism' (Marshall, 1997: 51). As a commercial product, the celebrity offers to the advertising and merchandising sector an indispensable strategic element within marketing. Data from UK advertising industry figures, for example, demonstrates that a celebrity product endorsement can more than double sales revenue and dramatically increase market share (Pringle, 2004: 282-299). In addition, a major revenue stream for sports and entertainment industries is offered by celebrity merchandising and 'tie-ins' through the reproduction and distribution of celebrity images on t-shirts, caps, mugs, toys and sportswear. As Chris Rojek explains, celebrity association 'operates on the principle that the public recognition of the celebrity as an admirable or desirable cultural presence can be transferred onto the commodity in a commercial' (Rojek, 2001: 92). The fundamental power of celebrity endorsement was judicially considered in the Paul Hogan merchandising case in which Burchett J found that an 'association of some desirable character with the product proceeds more subtly to foster favourable inclination towards it, a good feeling about it, an emotional attachment to it' (*Pacific Dunlop v Hogan*14, 45*)*.

In addition to the material economic function, a number of media scholars have suggested that the celebrity operates as a crucial symbolic element in market economies by representing to the audience the behaviours and processes of consumption. For David Marshall, the film star symbolises the 'independent individual' of consumerist capitalism able to 'supersede the constraints of institutions for the true expression of personal freedom' (Marshall, 1997: 83). Similarly, Rojek suggests that 'celebrities humanise the process of commodity consumption' so much so that 'consumers desire to possess them' (Marshall, 1997: 14-15). This desire to possess may be realised after the death of the celebrity through the buying of posthumous commemorative memorabilia such as the golf clubs belonging to President Kennedy, Andy Warhol's collection of watches (Rojek, 2001: 59) or Princess Diana's dresses: in 2005, a copy of the wedding dress worn by Diana was sold for £100,000 (Monsters and Critics, 2005). Regulating how a celebrity manages the commercial appropriation of her image, likeness, persona, name or voice has significant economic ramifications through a wide range of the sports and entertainment industries.

If the celebrity performs an important commercial function in contemporary culture, its productive social value must also be acknowledged. US courts have recognised that celebrity can play a 'non-economic' social role since 'celebrities are an important part of our public vocabulary' (*Cardtoons LC v Major League Baseball Players Association*). This shared vernacular, this 'peculiar yet familiar idiom' as Michael Madow puts it (1993:125), allows the articulation and public discussion of a broad range of social, political and moral issues through semiotic appropriation or technological remix. Richard Dyer, for example, has shown the degree to which the meanings of star persona

can be reinterpreted by audiences in radical, oppositional ways. The image of Judy Garland represented a vehicle through which urban gay culture of 1960s America could represent the pain of adhering to mainstream gender roles (Dyer, 2004: 137-191). From a feminist perspective, Catharine Lumby argues that celebrity gossip helps to redefine and 'democratise' the public sphere by blurring the, often masculinist, divide between the public and private domains, enabling a 'diversification not only of voices but of ways of speaking about personal, social and political life' (Lumby, 1999: xiii). For other commentators, the function played by celebrity culture is explored as the extent to which the phenomena resembles and hence may replace the socio-political functions of declining institutions such as the monarchy, religion, the nuclear family and local community (e.g. Rojek, 2001; Frow, 1998). Of course, not all elements of celebrity culture are enthusiastically endorsed by media theorists. Daniel Boorstin, for example, is exemplary of the disapproving stance adopted by some commentators. Rather than earning the right to fame, through labour, achievement or skill, celebrities are merely 'well known for their well knowness', to use Boorstin's oft quoted definition (Boorstin, 1992: 57).

We shall return to consider the complexity of labour in remixing and reformulating the celebrity figure. But for our purposes now, there is a crucial component involved in the production of celebrity. Whether in celebration or condemnation, most critics acknowledge the allure of celebrity culture is inflected by the process through which the celebrity figure is able to forge an intimate link with its audience, often producing public expressions of profound compassion, respect or revulsion. As Graeme Turner notes, this dynamic depends on the interplay between the public and private spheres:

> We can map the precise moment a public figure becomes a celebrity. It occurs at the point at which media interest in their activities is transferred from reporting on their public role (such as their specific achievement in politics or sport) to investigating the details of their private lives. Paradoxically, it is most often the high profile achieved by their public activities that provides the alibi for this process of 'celebritisation' (Turner, 2004: 8).

This process, however, is complicated by emerging participatory media forms whose impact is experienced as new conditions of possibility for celebrity production and consumption. As Marshall argues, video mash-ups of celebrity interviews, for example, are dramatically changing the relation between celebrity and audience (Turner, 2006: 640). Meanings produced by these audience authored texts challenge the extent to which a celebrity might control her image. For Marshall, these are pressing legal questions in an era increasingly defined by such texts which function to narrow the 'representational gap' between celebrity and fan (Turner, 2006: 640). As he puts it:

> In contrast to traditional media, it is less clear where a product begins and where it ends as this new system of production implies multiple forms produced by users … Perhaps what is even more interesting is that these indiscretions of reproduction and remaking have legal implications related to when a user actually possesses and makes a cultural form his/her own (Turner, 2006: 641).

The image or persona of the celebrity, then, is a significant economic and cultural tool which presents to the user an opportunity to wield financial and social power. As paradigmatic of the era of 'public privacy' (Kitzmann, 2004), the celebrity occupies an ambiguous position between 'private ownership and public image' (Madow, 1993: 127) making regulation of such appropriation a complex economic, legal and cultural challenge.

Although the celebrity figure has been thoroughly researched in relation to its patterns of consumption; semiotic power; and industry construction (e.g. Gamson, 1994; Marshall, 1997; Turner, 2004; Dyer 2008;), less attention has been paid to the forms of celebrity governance enabled by legislative and case law settings. [2] As I have argued elsewhere (2008: 93-103), this research imbalance has real impacts for students who often find it difficult to recognise the cultural architecture and materialities shaping media policy and law. In other words, students may enthusiastically endorse the semantic fluidity at play in the representation of law through popular culture, for example, and, similarly, explore the multiplicity of meanings generated by the celebrity figure. Yet it is often difficult to demonstrate to students that, perhaps, media legislation, itself, is similarly mutable and hence, requires analytical reading.

In response, this paper maps the origins and scope of that 'peculiarly American right' (Gaines, 1997: 131): the right of publicity. It will be seen that the basis for protection, in property or privacy,

has been problematic, with consequential complexity surrounding the scope, defences and remedies of the action. That uncertainty has echoes in the varied legal avenues used to protect celebrity image in Australia. Beyond such doctrinal issues, questions of principle remain as to the place of economic and autonomy-based rationales for law's engagement with the celebrity image.

Section One: The Origins and Scope of US Publicity Rights

A The origins of publicity rights in privacy law

The US right of publicity has been defined as: 'the right of an individual, especially a public figure or a celebrity, to control the commercial value and exploitation of his name and picture or likeness and to prevent others from unfairly appropriating this value for their commercial benefit' (*Presley's Estate v Russen*). The right has been endorsed in a number of decisions as a property right (*Waits v Frito-Lay Inc*) with the capacity, therefore, for inheritance or descendability (eg *Martin Luther King v American Heritage Products*). Such a right may be assigned or licensed (McCarthy §10:10), and remedies can include damages and injunction (*Presley's Estate v Russen* 1339, 1382). There is no uniform federal, 'right of publicity' in the US because of the variations in its treatment through common law and state statutes (Caudill, 2004: 263). While at least 27 US states have recognised publicity rights, there remains considerable doctrinal variation affecting the regulation, licensing and exploitation of the celebrity image (Zapparoni, 2004). As the major entertainment production centre of the US, it is not surprising that California offers personality protection through both statutory and common law regimes (Dawson, 2001: 662-663). Adding complexity to the doctrine is its development though both privacy and property law and the extent to which court decisions have been 'mired in confusion between property and privacy principles' (Flagg, 1999: 179).

Samuel Warren and Louis Brandeis

It is widely accepted that the 'principal historical antecedent of the right of publicity is the right of privacy (*Unfair Competition* § 46') and that it can be traced to 'one of the most influential pieces of writing in American legal history' (McCarthy § 1:10), the 1890 article by Samuel Warren and Louis Brandeis entitled 'The Right to Privacy'. Significantly, the 'necessity' for such a right arose, according to Warren and Brandeis, from the increasing intrusion of the press who were 'overstepping in every direction the obvious bounds of propriety and of decency' and invading 'the sacred precincts of private and domestic life' (Warren and Brandeis, 1890: 196). The authors distinguish the right of privacy from proprietary rights within intellectual property, explaining that the 'principle which protects personal writings and all other personal productions, not against theft and physical appropriation, but against publication in any form, is in reality not the principle of private property, but that of an inviolate personality' (Warren and Brandeis, 1890: 205). As we shall see, despite the distinction made by the authors between doctrines of privacy and property, as the right of publicity has evolved, through decisions driven by questions of celebrity image, the conceptual difficulties involved in the 'property-privacy divide' (Zapparoni, 2004: 705) have remained evident.

Roberson v Rochester Folding Box (1900): action denied

One of the earliest judicial considerations of the Warren and Brandeis article arose in the 1901 case of *Roberson v Rochester Folding Box*. Roberson brought action for invasion of privacy against a flour company that, in its marketing, had produced, printed and circulated on publicity posters a large lithograph portrait of her face. The trial judge held in the plaintiff's favour: 'her face is her own private property, and no photographer would have a right to take advantage' (1900). However, on appeal her action failed as the court worried that a decision in her favour would invite a 'vast amount of litigation', its scope 'bordering on the absurd' (1902).

Despite the failure in *Roberson* to recognise 'the so-called "right of privacy"' (1902), and perhaps in response to the 'storm of public disapproval' (Prosser, 1960: 385) that followed, New York's legislature enacted the first US privacy legislation in 1903. The statute made it 'both a misdemeanour and a tort to use the name, portrait or picture of any person for "advertising purposes or for the purposes of trade" without written consent' (McCarthy 25, § 6:74). Thomas McCarthy notes that, since the statute was not designed to endorse the broad principles expressed by Warren and Brandeis but simply to overturn *Roberson*, it imposed a narrow scope for deciding cases. What began as an innovative development became a 'straitjacket locking New York law into the factual pattern of the Roberson case' (25, § 6:74).

Pavesich v New England Life Ins Co (1905): action recognised

Shortly after enactment of the New York legislation, the Georgia Supreme Court established a common law right of privacy in *Pavesich v New England Life Ins Co*. Reversing the trial decision and relying substantially on the dissenting view in *Roberson* the court found for Pavesich. The case resembled *Roberson* factually since both involved unauthorised photographing and publication of the plaintiff's face in advertising. The court unanimously held that an invasion of privacy constitutes the publication 'of one's picture without his consent by another as an advertisement, for the mere purpose of increasing the profits and gains of the advertiser' (81). In a decision that analogised the publication of Pavesich's image to slavery, the court found his liberty had been 'taken away', he was now 'under the control of another … no longer free and … a slave without hope of freedom, held to service by a merciless master' (80).

Notably, the court considered whether a famous person should have similar recourse to protection as those not in the public eye, deciding that 'the mere fact that a man has become what is called a public character' does not give 'to everyone the right to print and circulate his picture' (80). What the court had not considered, however, was where a public figure might actually desire publication of their image for their own commercial profit or may seek to protect that image from unauthorised, commercial exploitation by another. That the law had hitherto dealt inadequately with such situations was Melville Nimmer's argument in his 1954 article, which became the 'foundation stone of the right of publicity' (McCarthy § 1:27). According to Nimmer, a major shortcoming of using privacy doctrines to protect 'publicity value' (Nimmer, 1954: 204) lies in the principle of celebrity waiver. In contrast to *Pavesich* which did not endorse the view that celebrity status waives the right to privacy (Nimmer, 1954: 26), certain courts have found the very fact of celebrity status means a person has dedicated their life to the public and waived protection. Although some US courts have held that the 'public personality' is entitled to protect a private, 'non-professional' aspect to their lives, these courts have not been able to provide protection for 'the appropriation by others of the valuable use' of 'name and portrait' (Nimmer, 1954: 205).

For some commentators, it appears paradoxical that the right of publicity has its origins in privacy doctrines since, as John Frow suggests the rights can be seen 'in direct opposition to each other' (1995:158). However, as noted above, celebrity is produced in part by the dynamic interplay *between* private and public spheres, the 'public display of the private' in Marshall's words (2006: 638). Given this decisive element of celebrity production, it is perhaps understandable that a legal and economic mechanism developed which would address specifically the management of the socio-economic interplay between the private and public persona, and that the law would find such a task challenging.

B Scope of publicity rights through key decisions in US common law

This section outlines the scope of the right of publicity, examining its judicial recognition; implications of its conceptual connections with both privacy and property law; free speech and parody defences; the test for identity and remedies to infringement. These elements will be traced though key decisions in the US common law of publicity rights.

As noted above, historically an obstacle preventing successful deployment of the right of publicity may have been its close connection with privacy doctrines. As McCarthy explains, famous plaintiffs began to bring actions over the unauthorised use of their image in advertising. The problem facing courts was that the complaint often:

> sounded out of tune with the concept of 'privacy'. Their complaint was not that they wanted no one to commercialise their identity, but rather that they wanted the right to control when, where and how their identity was so used …mesmerized by the 'privacy' label, judges could not see how such plaintiffs had a claim for invasion of 'privacy' since they often already had become well-known in the press and in commercial use by permitted licenses (§ 1:7).

***Haelan Laboratories v Topps Chewing Gum* (1953): recognition of the right**

In 1953, the landmark case of *Haelan Laboratories v Topps Chewing Gum* addressed these concerns by judicially establishing the 'right of publicity' and recognising the right could operate distinctly from privacy. In the majority decision Frank J found that 'in addition to and independent of that right of privacy … a man has a right in the publicity value of his photograph … the right to grant the exclusive privilege of publishing his picture'. The dispute in *Haelan*concerned two rival chewing gum manufacturers who were competing for rights to use photographs of base ball players. These players had entered into contracts giving Haelan Laboratories the exclusive right to use their

photographs in advertising. Haelan brought action against Topps arguing it had 'deliberately induced' (868) the same players to assign use of their photographs to Topps, breaking the exclusive contracts held with Haelan. The defendants questioned the effectiveness of the Haelan contracts, arguing they constituted mere 'waivers' to possible invasion of privacy actions. Since, under New York statute, the right of 'privacy is personal, not assignable' the plaintiff would have no '"property" right or other legal interest' which the defendant's 'conduct invaded' (867). In rejecting this defence, the common law right of publicity was established.

In 1960, William Prosser set out further analysis for developing a publicity right. Drawing on arguments made by Warren and Brandeis and summarising the relevant privacy case law, Prosser created a taxonomy of four torts:

1. intrusion upon the plaintiff's seclusion or solitude, or into his private affairs;
2. public disclosure of embarrassing private facts, about the plaintiff;
3. publicity which places the plaintiff in a false light in the public eye;
4. appropriation, for the defendant's advantage, of the plaintiff's name or likeness (1960: 389).

The fourth of these torts, concerning appropriation, has commonly been viewed as central to publicity. It forms the 'basis for commercial appropriation of personality or right of publicity claims' (Flagg, 1999: 187).

If *Haelan* established the existence of the right of publicity and made it distinct from the limitations of a privacy doctrine, this did not prevent future judicial uncertainty. Indeed, in creating a demarcation between privacy and publicity rights, *Haelan* may have symbolised 'a wrong turn' in the coherent application of the doctrine (Haemmerli, 1999: 403). Conceptual uncertainty now existed in the development of publicity rights, as Alice Haemmerli has explained. On the one hand, publicity rights were understood as an economic property right with the provision, therefore, of transferability and descendiblility. On the other hand, publicity rights remained a 'personal' privacy right, nonassignable and non descendible (Haemmerli, 1999: 403).

***Zacchini v Scripps-Howard Broadcasting Co* (1977): free speech defences to infringement**

This case was the first, and indeed remains the only, US Supreme Court decision to affirm publicity rights (McCarthy § 1:33). It is also noteworthy because of its treatment of possible defences to publicity rights in the form of First Amendment freedom of the press. Hugo Zacchini sued over the videotaping and broadcast of his 'human cannonball' act in which he was shot from a cannon over 200 feet into a net. This 15 second clip, constituting Zacchini's entire performance at an Ohio county fair, was broadcast on television news. He sought damages for 'unlawful appropriation' of his 'professional property' (564). In contrast to the 'classic situation' (McCarthy § 1:33) of publicity rights involving commercial appropriation of identity, *Zacchini* was unusual because it concerned a news broadcast. The Ohio Supreme Court reversed earlier judgments for the plaintiff because 'a TV station has a privilege to report in its newscasts matters of legitimate public interest which would otherwise be protected by an individual's right of publicity' (565). However, this judgment was reversed by the US Supreme Court, which held that the First Amendment does not 'immunize the media when they broadcast a performer's entire act' (575). Also significant about *Zacchini* is its emphasis on the doctrine as a form of property right, 'closely analogous to the goals of patent and copyright law' (575). In this way, the court distinguished the pecuniary elements of the right from the 'false light' privacy tort, relying upon an argument for providing economic incentives to justify the protection of publicity. Zacchini's act, the court found,

> is the product of petitioner's own talents and energy, the end result of much time, effort, and expense. … [T]he protection provides an economic incentive for him to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright laws long enforced by this Court (575).

Zacchini conferred 'prominence and respectability' (McCarthy § 1:33) upon publicity rights, yet because it so narrowly construed the facts – publicity rights were said to subsist in the broadcast of 'entire performance' – it has provided limited guidance to the doctrine (Flagg, 1999: 195 n 55).

***Martin Luther King v American Heritage Products* (1982): descendability of right**

If *Zacchini* established the right of publicity as conceptually analogous to copyright and trademark law insofar as it adheres to the principles of property rather than privacy, then this decision

further enhanced the connection by endorsing descendability. As McCarthy has explained, the post-mortem survival of publicity rights is a key factor in the "'property" versus "personal"' debate (§ 9:3). In this case, the Estate of Martin Luther King brought action against a company for unauthorised manufacture and sale of plastic busts of Luther King, claiming these violated his post-mortem right of publicity which had been inherited by his heirs (697). Citing a number of decisions regarding the proprietary element of the right of publicity, [3] the Supreme Court of Georgia found for the Estate, holding that the right of publicity is distinct from privacy; it is 'assignable during the life of the celebrity', survives the owner's death; and is 'inheritable and devisable' (*King v American* 704-705).

The court also considered whether descendibility depended on the degree to which publicity rights had been utilised by celebrities during their lifetime, the so-called 'lifetime exploitation' principle (McCarthy § 9:13). The court found it pertinent that previous case law on this issue had been concerned with entertainers rather than, as here, those involved in public life for other reasons.

> A well known minister may avoid exploiting his prominence during life because to do otherwise would impair his ministry. Should his election not to take commercial advantage of his position during life ipso facto result in permitting others to exploit his name and likeness after his death? (*King v American*706)

The Georgia Supreme Court therefore held that there is no 'necessity to exercise the right of publicity during one's life in order to protect it from use by others or to preserve any potential right of one's heirs' (705). Since the 1980s, the 'lifetime exploitation' requirement within post-mortem publicity rights has been on the decline. At the time of writing, only the state of Utah mandates that in order to descend to airs, the publicity right must have been commercially exploited before death (McCarthy § 9:15). More broadly, it is notable that only two US states do not recognise the descendability of the publicity right at common law (McCarthy § 9:19). [4]

***White v Samsung Electronics* (1992): indicia of identity and the parody defence**

This case raises significant issues of remixing celebrity production in the public domain. If the 'right of publicity protects the commercial value of a person's identity' (*Unfair Competition*), how should law define the scope of identity? Furthermore, how will the law decide when a particular identity has been recognised and, therefore, liability triggered? In *White v Samsung Electronics* these questions were explored through an action brought by well known US game show host, Vanna White, over an advertising campaign for Samsung electronic products. The print advertisements attempted to convey the products' longevity by placing well known figures in futuristic settings together with humorous predictions. However, unlike the other celebrities in the campaign, White neither consented to nor was renumerated for these publications. The particular advertisement at issue depicted a robot posing alongside a game board that was 'instantly recognisable' as the original 'Wheel-of-Fortune' game show set (1396). The robot was dressed in a blonde wig, gown and jewellery that was 'consciously selected to resemble White's hair and dress' in the long running series (1396). The advertisement carried a caption that read: 'Longest-running game show 2012 AD' and, as Kozinski J put it, 'perhaps failing to see the humour' White sued (1514).

Since the case arose under Californian law, both statutory and common law publicity claims were available. Under § 3344(a) of the Californian Civil Code, a cause for action will exist against 'any person who knowingly uses another's name, voice, signature, photograph, or likeness … for purposes of advertising or selling … without such person's prior consent'. Unfortunately for White, the District Court found that because Samsung had not used White's name, likeness, voice or signature, it did not infringe on her statutory right. Her common law claim similarly failed because it could not satisfy the test established by *Eastwood v Superior Court*, namely 'appropriation of plaintiff's name or likeness'. On appeal, the decision was reversed in relation to the common law claim. In relation to *Eastwood,* the Court of Appeals for the Ninth Circuit held that 'the common law right of publicity is not so confined' (1397) and hence there was scope beyond the 'name or likeness formulation' for the appropriation of identity that Samsung had achieved. The decision significantly expanded the indicia of identity to cover appropriation through 'impersonation' or any other means by which to 'evoke' identity: 'It is not important *how* the defendant has appropriated the plaintiff's identity, but *whether* the defendant has done so' (1398). With Kozinksi J dissenting, the Ninth Circuit rejected a petition for rehearing en banc and on remand a Los Angeles jury found for White and awarded her $403,000 in damages (McCarthy § 4.86).

In his vociferous dissent, Kozinksi J argues the decision is a 'classic case of overprotection' and, more worryingly, warns that expansion of the right

> impoverishes the public domain, to the detriment of future creators and the public at large. Instead of well-defined, limited characteristics such as name, likeness or voice, advertisers will now have to cope with vague claims of 'appropriation of identity' claims often made by people with a wholly exaggerated sense of their own fame and significance (1516).

Kozinksi J also expressed concern over the failure of the defendant's parody defence. Samsung argued that their use of Vanna White's image constituted protected speech in the form of parody, citing as authorities successful defences used by *Hustler* magazine and Drake Publishers defending as parodies their appropriations of famous identities in advertisements. The majority decision, however, did not accept these authorities had been even 'remotely relevant' since the former were involved in 'poking fun' whereas Samsung was a 'true advertisement' and the parodic, 'spoof' aspect was 'subservient and only tangentially related to the ad's primary message: "buy Samsung VCRs"' (1401). In response Kozinksi J asked 'so what'? (1591). He pointed out that although commercial speech may attract less protection under First Amendment rights, it remains protected 'nonetheless' (1591). Commercial parodic speech may perform a valuable social and political role and the right to 'mock for fun as well as profit' should be protected (1521). Similar arguments were expressed by Alarcon J in his partial dissent from the majority opinion of the Court of Appeal, which, he said, had given the parody defence 'short shrift'. Finding the case law relied upon to be 'unpersuasive', Alarcon J points out that the parodic advertisements used by the magazines, also involved a 'purely commercial purpose of selling soft-core pornographic magazines' (1407). [5]

The decision in *White* is said to have 'elicited a storm of controversy over its expansive application of the right of publicity' (Dawson, 2001: 643). Relevant to this paper on the conditions of possibility for image remix, is the criticism voiced by those arguing that failing to recognise a parody exception threatens to impoverish the public domain. Gretchen Pemberton, for example, suggests the case represents a dangerous precedent, effectively creating 'a new cause of action against those who parody celebrities' (99). Instead, Pemberton argues that publicity rights ought to protect parodic use of celebrity image in much the same way as US copyright and trademark law recognise parody as fair use. Pemberton's critique has clear implications for parodic celebrity remixes. I am thinking here, in particular, of the plethora of Tom Cruise parodies circulating thru video sharing websites together with the notoriously litigious Church of Scientology (Denton, 2008; O'Connell, 2008).

In this section we have traced the evolution of the publicity right in US law, paying particular attention to its origin within privacy and uncertainty in its subsequent treatment though the courts. We examined the right's scope by reviewing key decisions, the test for identification and possible exceptions to infringement. This provides a useful context from which to examine the Australian approach to protecting celebrity image. Such an examination is valuable since personality rights have recently attracted considerable attention with regard to the Australian media (Tyacke and Walker, 2007), and a number of commentators have called for Australia to adopt an 'American Style' right of publicity (e.g. Bowman, 2003; McMullan, 1997; Ralston, 2001).

Section Two: Australian Legal Approaches to the Protection of Celebrity Image

Although Australian law has no direct equivalent to the US right of publicity as a discrete cause of action (Bowman, 2003: n 104), unauthorised use of celebrity image has been protected through a number of statutory and common law provisions including: the tort of passing off; sections of the *Trade Practices Act* 1974 (Cth) (TPA); copyright and trademark infringement and the tort of defamation. However, as we shall see there are differences between the approaches of the two jurisdictions.

Broadly speaking, the Australian approach to the unauthorised use of celebrity image through the doctrines of 'passing off' and the statutory provisions of the TPA, is underpinned by a focus on misrepresentation and misleading or deceptive conduct. This situation contrasts with the US conceptual framework where the focus centres on the proprietary nature of the personality right and, therefore, the cause of action is triggered by 'taking of property': there is not the same requirement to prove public deception and misrepresentation (Zapparoni, 2004: 697). In other

words, Australia does not grant to celebrities the right to 'own' their personality insofar as they 'do not own the commercial value of their personality' (Weathered, 2000: 161). As Peter Heerey puts it, 'Australian law holds there is no property in character or personality' (Heerey, 1999: 10). In common with the US, however, is a rhetorical focus on what has been called the 'fruits of labour' argument (Nimmer, 1954: 216), that is, the 'economic welfare' of the particular identity controlling 'commercial exploitation of personal features which … result from his/her labour' (Richardson, 2007). Also comparable is the availability, though applied with limited success, of a 'parody' type defence. This section traces the development of Australian law for the protection of celebrity image through key illustrative decisions.

A Passing Off and the TPA

The classic formulation actionable through the common law tort of passing off is one in which a trader is representing his or her goods as those of someone else. The elements required for establishing a cause of action were articulated in the *Advocaat* case by Lord Diplock in what has been identified as the 'modern starting point' (Catty, 1993: 293) for understanding the tort of passing off. In this case, five required characteristics were defined:

a) a misrepresentation;

b) made by a trader in the course of trade;

c) to prospective customers or ultimate consumers of goods or services supplied by him or her;

d) which is calculated to injure the business or goodwill of another trader;

e) which causes actual damage to business or goodwill of the plaintiff

(*Venootschap v Townend)*.

The common law tort of passing off together with its allied statutory provisions of 'misleading or deceptive conduct' under the TPA have been the 'primary means' for celebrities to seek protection for unauthorised use of their image (Tyacke and Walker, 2007: 15). [6] Although there are significant procedural and conceptual differences between the two avenues, legal consensus exists that the similarities between the actions justify their joint discussion. Indeed, 'almost all actions for passing off are brought in tandem with an action' under s 52 and/or s 53 of the TPA (Richardson, 2007).

Radio Corporation v Henderson: (1960) 'common field of activity' unnecessary in passing off

Henderson has been credited with providing the 'first real judicial recognition of the practice of character merchandising' (Ricketson, 1990: 193) and for establishing a clear 'affinity' between Australian law and the right of publicity (Ralston, 2001: 10). Action was brought by two well known professional ballroom dancers, the Hendersons, for unauthorised use made by a record producer and distributor of their photograph for the cover of a ballroom dance record. Although the pair was not identified on the cover, they were recognised by witnesses familiar with ballroom dancing. Moreover, it was established by expert evidence that the photograph suggested they 'had endorsed or sponsored the record and had been remunerated … for their photograph being used' (*Radio v Henderson* 626). On appeal, the NSW Supreme Court found that passing off had occurred because consumers within the relevant market for the record would assume the cover illustration 'indicated the plaintiffs' recommendation or approval of the record', and the defendant had wrongfully appropriated the plaintiffs' professional or business reputation 'by falsely representing that the plaintiffs recommended its product' (622).

In relation to the development of actions for false celebrity endorsement, the decision's significance concerns the issue of a 'common field of activity'. This element had been established by the UK case *McCulloch v Lewis* in 1947. At trial, Sugarman J followed *McCulloch* and held that 'it is essential to show a common field of activity in which, however remotely, both the plaintiff and the defendant are engaged' (*Radio v Henderson 627*). The appeal upheld the trial result, but on different grounds. It was not necessary to establish a common field of activity, 'in which the activities of A and B conflict'. Of critical importance for the protection of image rights, courts following *Henderson*recognised that the 'lustre of a famous personality' (*Irvine v Talkspor*) provides to the market a crucial advertising tool and, moreover, that the 'common field of activity' test was not best suited to regulating the increasing power of this sector.[7]

Newton-John v Scholl-Plough (Australia) (1986): Maybelline case and disclaimers

In this case Australian pop singer Olivia Newton-John brought action for passing off and breaching s52 of the TPA against cosmetic company Maybelline for the unauthorised use of her image in advertising. The advertisement in question carried a colour photograph of a young woman, bearing a 'considerable likeness' to Newton-John. Indeed this model had answered an advertisement placed by Maybelline for a Newton-John 'look-alike' (233). The advertisement included a 'disclaimer', stating in 'very large and striking letters' the phrase: 'Olivia? No, Maybelline'. Newton-John's grievance was that, despite the disclaimer, the prominence given to the photograph of the model and the fact that Newton-John's name was mentioned twice would lead readers to assume that she had some type of association with the advertisement. Although Burchett J found there was a clear 'inference' that there had been an 'appropriation of the appearance' of the plaintiff and, further, there was a possibility of 'subliminal' deception, Newton-John was unsuccessful in her claim for an injunction. The disclaimer provided grounds for dismissal. It 'tells even the most casual reader, at even the first glance, that in fact it is not Olivia Newton-John who is represented in the advertisement'. The court could not find evidence of the required deception on the part of Maybelline owing to the disclaimer. The cosmetic company may have 'made use of' Newton-John's 'reputation to the extent of gaining attention, but not to the extent of making any suggestion of an association'.

While this case suggests the efficacy of disclaimers to avoid legal action in 'personality' advertising, this is not always a reliable strategy (e.g. *Twentieth Century Fox v SA Brewing*). In any event, such defences have attracted criticism on the basis that what is at stake for the celebrity is not misleading or deceptive conduct that would be ameliorated by a disclaimer but, rather, 'something closer to a "taking without permission"' (McMullan, 1997: 86). More generally, such arguments can be used to suggest that Australian law requires stronger protection for celebrity rights since to succeed in the available actions requires a certain degree of artificiality. In passing off, for example, showing 'misrepresentation' does not always capture the plaintiff's complaint.That the public might be confused about the false endorsement of a product is not of itself the complaint. Rather, the celebrity may wish to be paid for their 'implied support' of the particular product (Bowman, 2003: 7).

Pacific Dunlop v Hogan: expansion of 'misrepresentation'

Although there are a number of significant personality and merchandising cases which could be considered in relation to passing off or the TPA, [8] *Pacific Dunlop v Hogan* is useful to understand the expansion of passing off. It is also worth contrasting with *Maybelline*, since their facts were 'largely similar' (McMullan, 1997: 87) yet the judicial outcome was not. This apparent unpredictability has led some commentators to call for a US style publicity right. (eg McMullan, 1997; Bowman, 2003).In a leading Australian character merchandising case, Paul Hogan sued for passing off and misleading conduct under s52 of the TPA. His complaint concerned unauthorised advertising that Dunlop used for one of their products, Grosby Leatherz shoes. The TV advertisement presented a parody of the well known 'knife scene' from the film *Crocodile Dundee*, the lead character of which was played by Hogan in a manner that was 'largely an extension of his own personality already widely known through television commercials' (*Pacific Dunlop v Hogan* 14*)*

The advertisement depicted a look alike dressed as Paul Hogan's character, Mick Dundee, and wearing Grosby Leatherz shoes (*Hogan v Pacific Dunlop* 409). Instead of saying 'that's a knife', as in the original film, the Hogan character declares to the mugger 'you call those leather shoes? Now these are leather shoes Grosby leather soft comfortable, action packed leather' (410). The defence attempted to avoid infringement by 'miscalling' theadvertisement a parody. It was difficult to parody a parody Burchett J reasoned: the 'essence of Mr Hogan's performance is parody, which can hardly itself be parodied, at least by what would be more accurately described as a parasitic copy — parasitic because its vitality is drawn entirely from the audience's memory of the original (*Pacific Dunlop v Hogan* 47). At trial, Gummow J found there was a 'real likelihood that a substantial number of viewers would have responded to the advertisement' on the basis that Hogan had 'some association of a commercial nature with the production of the advertisement' or with the shoes (*Hogan v Pacific Dunlop* 426). On that basis he found both passing off and misleading conduct had occurred under s52. The decision was upheld by majority in the Federal Court.

The significance of this case for character merchandising is that it made more flexible the test for establishing misrepresentation within an action of passing off (Ricketson, 1990: 196). Rather than

require an overt connection be drawn between the personality and a commercial product, *Hogan* established that the peculiar nature of character merchandising depended for its success on subtle processes of association. As Burchett J explained, the 'whole importance of character merchandising is the creation of an association of the product with the character; not the making of precise representations. Precision would only weaken an impression' (*Pacific Dunlop v Hogan* 46). Furthermore, law should appreciate the subtle processes in order effectively to regulate the marketplace: 'it would be unfortunate if the law merely prevented a trader using the primitive club of direct misrepresentation, while leaving him free to employ the more sophisticated rapier of suggestion, which may deceive more completely' (*Pacific Dunlop v Hogan* 46).Commentators have read the Hogan decision in varying ways. Scott Ralston, for example, argues the case demonstrates that courts are straining toward an American style right of publicity. As he puts it, 'the search for a misrepresentation is sometimes artificial' since it 'disguises what the courts are really looking for'. Indeed, perhaps a quasi publicity right is already in operation: 'The Federal court may be, in substance already applying a right of publicity-style approach' (Ralston, 2001:10). Similarly, Hazel Carty suggests that the decisions in *Henderson* and*Hogan* demonstrate that Australia has 'developed a publicity right' from the former case and, in the latter, has established 'the equivalent right for proprietors of characters' (Carty, 2003: 293). Megan Richardson and others, however, suggest that what is being illustrated is a judicial recognition of the subtlety involved in the business of personality or character merchandising, and therefore, greater flexibility offered in dealing with the semantic range of misrepresentation (Richardson,2007: 27).

B Further protection of image rights in Australia: Copyright, Trade Marks and Defamation

Although passing off and the relevant provisions of the TPA have been the central legal instruments for protecting personality or character merchandising, there are further statutory and common law mechanisms briefly to consider.

Copyright Certain areas of intellectual property lend themselves conceptually to protecting the exploitation of the celebrity personality (Heerey, 1999: 15). When considered as a right of reproduction, a cause of action could be brought under the *Copyright Act 1968* (Cth) against, for example, unauthorised merchandising (Richardson, 2007: 29). However, the limiting factors need to be acknowledged, namely that copyright subsists in the physical expression of literary, dramatic, musical and artistic works or other subject matter rather than in the persona, image or nickname of a person. Furthermore unless a person holds copyright they cannot prevent a work being reproduced or published even if it includes their own image (Alderson, 1997: 4) Thus copyright has been of 'limited utility' in regulating personality rights in Australia (Ralston, 2001: 9).

In *Telstra v Royal & Sun Alliance Insurance* ('Goggomobil'), for example, Telstra was unsuccessful in their copyright claim against a car insurer for use made of the advertising character, 'Mr Goggomobile', which had been created for Telstra. Telstra sued in passing off, misleading or deceptive conduct and copyright in relation to advertisements that Shannons produced which had 'reprised the character' (71) from Telstra's own advertising. They used the same actor as in the original campaign and, according to the court, retained all the features of the Telstra advertisement 'that made it famous, popular and instantly recognisable'. Although the court decided in favour of Telstra on the grounds of passing off and the TPA, the copyright action failed because, while the offending advertisement conjured up the Telstra advertisement and its 'ideas or concepts' it did not 'reproduce a substantial part of the substance or expression of the "dramatic" events comprising that advertisement' (48). *Goggomobil* demonstrates the difficulty of bringing copyright claims to protect character or personality merchandising. Derivative or spin off advertising, as Therese Catanzariti Oppermann points out, which'merely includes some of the characters or some of the events of the original, or a film which is "inspired by" another may not infringe copyright' (16).

Trade Mark

Trade mark law may also provide an avenue for the protection of character merchandising or personality rights, especially since the reforms enacted in the *Trade Marks Act 1995* (Cth). In brief, these reforms shifted the focus from one where the mark acts as a 'badge of origin' to an indication of 'authorised licence, sponsorship or approval' (Black, 2002: 103). This shift is important in relation to the exploitation of celebrity personality because the nature of celebrity endorsements means that often 'the celebrity will not be connected in any way to the source or

origin of the product'. (Weathered 163). Having to establish that a trade mark indicates the origin of a product in order to qualify for the granting of a trade mark, would not pose a difficultyfor those class of personality endorsements used by Paul Newman, for example, when 'his face on the label and his signature clearly act as a badge of origin by indicating the source of the product' (Weathered, 200: 167). However, this statutory provision offered little scope for protecting against unauthorised exploitation when the personality merchandising 'carries images that are not used in order to indicate the origin of the goods but simply for their own innate appeal' (Bowman, 2003: 9). In addition to relaxing the 'badge of origin' threshold, the 1995 Act also broadened considerably the categories registrable for a trade mark. The criteria for a registrable trade mark were a 'device, brand, heading, label, ticket, name, signature, word, letter or numeral' to which were added in the 1995 Act, any 'aspect of packaging, shape, colour, sound or scent' (*Trade Marks Act* 1995 [Cth] s 6).

*Defamation*Another legal action to note in relation to personality rights is defamation. The sources of law for defamation in Australia are found through state statute and common law, which is now largely uniform. However, prior to reforms effective from January 2006, the varied law throughout Australia was 'extremely problematic' for national media (Butler and Rodrick, 2007: 28). To the extent that defamation protects reputation rather than a proprietary interest in the commercial exploitation of image, defamation is, perhaps, more similar to protection offered by passing off than it is to action under copyright or trademark law. Arguably, however, it is a narrower form of protection than passing off since to succeed the action must establish the public would think less of a person in connection with the offending published material (Bowman, 2003: 8). A personality who wishes to control the use of his/her image in relation to an unauthorised commercial association, for example, could not look to defamation for protection if the endorsement or association does notlower reputation (Catanzariti, 2002: 139). However, protecting endorsement or merchandising capacity may not be the only concern for a public figure. In *Ettingshausen v Australian Consolidated Press*, for example, a famous rugby player sued over naked photographs of him published in the magazine *HQ*. Ettingshausen's argued his reputation was harmed because the public would assume he had consented to the publication of a 'lewd' and 'indecent' photograph of himself. Although the trial had a complex procedural history, much of it concerned with damages, Ettingshausen was successful in his claim, with defamation providing some control – or at least recompense for – the use of his naked image. [9]

In this section we have examined the main causes of action for the protection of celebrity image in Australia. Although Australia has no distinct right of publicity, there has been significant judicial consideration of the commercial and social power of personality merchandising. However, existing actionshave certain limitations. In summary these constraints relate to establishing misrepresentation within passing off; the idea/expression dichotomy within copyright law; meeting the 'use as a trade mark' test within trade mark law; and the limits imposed by the requirement for harm to reputation in defamation.

A case recently before the courts is a useful point on which to conclude this section since it draws together a number of the actions discussed above. In *Bingle v Emap Australia*, Australian model Lara Bingle brought action against the publishers of men's magazine, *Zoo Weekly*, in relation to their use of topless photographs of her posing on a beach, the images carrying the quite shocking caption, 'I'll make you come', presumably a 'witty' comment on her promotional work with the Tourism Australia advertisement that asked 'Where the bloody hell are you?'. Bingle sued for misleading conduct under theTPA; passing off; copyright infringement and defamation. Echoing Ettingshusen, Bingle claimed that the publication included an imputation that she was 'the sort of model who would allow herself to be photographed for a magazine scantily clad and making an overtly sexual invitation'. While Bingle consented to posing for the original photographic shoot, she did not condone their publication in the magazine or associated promotions. This is the sort of dispute that could have implications for the development of Australian 'personality rights'.

Conclusion: Debates about the Public Domain and the Protection of Celebrity Image

According to McCarthy the time for debate is over, in the US at least. As he puts it with characteristic zeal: the 'initial phase of questioning what the right of publicity is, and whether it should exist at all, has passed into history'. (McCarthy § 1:34). Michael Madow, however, with equal conviction, threatens to 'rain hard' on McCarthy's 'parade' (Madow, 1993: 134). These two legal scholars represent distant points on a spectrum of analysis about the validity and efficiency of the

right of publicity. This debate, however, is not limited to the United States with similar arguments occurring in comparable jurisdictions. [10] Australian legislators and courts have regularly been called upon to consider the implementation of a US style 'right of publicity'. Michael Bowman, for example, is representative of these calls when he writes that 'clearly many courts in Australia feel that the law should protect against the misappropriation of one's personality' and, based on passing off decisions that find misrepresentation or misleading conduct, 'it is evident that the public assumes such rights already exist'. Like McCarthy, Bowman declares 'the debate about whether they are necessary would already seem to be concluded' (Bowman, 2003: 9). Similarly, Ralston evaluates the Australian protective regime for image rights as 'relatively meagre' in contrast with the US jurisdictions (Ralston, 2001, 8). Others however, view the Australian approach more positively. David Caudill, for example, argues that contrary to popular academic opinion, the 'US right of publicity is not as strong as celebrities and professional athletes would like'. Furthermore, 'Australian's protective alternatives to the right of publicity' may in fact 'accomplish as much' as the US approaches to publicity rights (Caudill, 2004: 263).

Caudill raises a key issue at stake in the debate surrounding the scope of protection afforded to image rights when he observes that 'both the property right and the privacy right remain in play in various judicial opinions concerning the right of publicity' (Caudill, 2004: 267). As discussed, conceptual and legal tensions involved in this so-called divide have been a major point of contention in the literature on regulating celebrity image. Legal judgments such as those in *White* demonstrate, as Rosina Zapparoni explains, the 'difficulty courts have in balancing the private property interests of individuals with public access to cultural forms where the property in question is human identity' (Zapparoni, 2004: 713). In relation to public domain arguments and the 'labour' of celebrity production, the rationale advanced for a model of publicity rights based on the proprietary interest in personality often draws on Lockean labour theory. Briefly put, this position argues that entitlement to property flows from labour invested in its creation. The extrapolation to publicity rights is that a celebrity has a proprietary right in their image because of the labour invested in its creation. According to Nimmer this is a 'first principle of Anglo-American jurisprudence' and so should protect 'persons who have long and laboriously nurtured the fruit of publicity values' (Nimmer, 1954: 216). In Australian debates the majority of those arguing for a distinct right of publicity, use this as the rationale. Ralston, for example, suggests that the 'celebrity deserves to be rewarded' for the skill and labour invested in their persona (Ralston, 2001: 10).

A weakness in this argument is its implicit assumption that the image of a celebrity is due to solitary labour. Determining the 'author' of celebrity is complex since the star image may be authored, as Rosemary Coombe enumerates, by 'studios, the mass media, public relations agencies, fan clubs, gossip columnists, photographers, hairdressers, body-building coaches, athletic trainers, teachers screenwriters, ghostwriters, directors, lawyers and doctors' (Coombe, 1998: 94). Moreover, Madow suggests that the 'labour theory' rationale for publicity rights is an ideological assumption originating from the market of celebrity management itself. He writes 'the notion that a star's public image is nothing else than congealed star labor is just the folklore of celebrity, the bedtime story the celebrity industry prefers to tell us and, perhaps, itself' (Madow, 1993:183). Recent media research supports this view, notable in the increasing number of works which concentrate on the production of celebrity rather than, as had been the case, on the textual analysis of celebrity image, often divorced from economic bases of its creation. The consequence in recognising the multifarious nature of celebrity authorship is, for a number of commentators, to locate any proprietary right of publicity within the public domain. Recognising the complexity of socio-technical patterns of labour, Kembrew McLeod comments that:

> because mass-media audiences are not lifeless, it is no surprise that people draw on … images and texts to actively make sense of their own lives and the world that surrounds them. But "right of publicity" law centralises the celebrity's decision-making power in determining what he or she "means" to an audience by allowing that celebrity the ability to decide what parts of his or her image to magnify, what parts to distort, and what parts to delete [however] the celebrity is no more the author of his or her image as it is reconstructed within popular culture than is the fan, whose intertextual associations work to construct meaning for an individual and a community (McLeod, 2006: 656-661).

While critics such as Madow and Coombe advance erudite and cogent arguments for the restriction on the US style publicity right, they do not capture what we might call the 'D list

problem'. We could return to the *Bingle* case to understand the complexities and to some degree, the shortcomings of the arguments against a publicity right. With all due respect to Ms Bingle, she is not quite an A list celebrity. She is not yet someone who the public has authored in quite the same way as is the case with, for example, Madonna. We cannot easily, therefore, apply the same model that Madow does in relation to the public domain and the ownership of image:

> a celebrity like Madonna cannot say of her public image what the carpenter can say of his chair: "I made it." And because she cannot say this of her public image, she cannot lay a convincing moral claim to the exclusive ownership or control of the economic values that attach to it (Madow, 1993:196).

Although the cause of action for Bingle was in relation to commercial appropriation of image, that was not the entire scope of her complaint. [11] Merely because the public has, to a limited degree perhaps, helped author her image does not justify the manner in which *Zoo Weekly* treated it. While the parties involved in the defamation action appear to have settled the more general point raised by the case in terms of the ongoing debate over publicity rights might usefully be put as one of 'personal dignity and autonomy'. In her sophisticated reconciliation of the bifurcated nature of the debate, Haemmerli argues that we need to recast the strict dichotomy that exists between, on the one hand, a pecuniary, proprietary right of publicity and a personal, non-pecuniary right of privacy on the other hand. She does not view as mutually exclusive these rights nor does she argue for the abolition of one in favour of the other but, instead, suggests the publicity right itself contains 'both an economic and an autonomy function'. Countering the argument advanced by Madow she reasons that:

> The public (or audience's) investment or participation in the creation of a celebrity's fame does not necessarily imply an entitlement to use of the celebrity's identity. Identity remains something intrinsic to the individual, subject to individual control as an autonomy-based property right, no matter what or who has affected its level of fame (Madow, 1999: 423).

Haemmerli's arguments seems particularly well suited to apply to the Bingle case where, surely, what is at stake is something like 'dignity'. As noted above, seeking financial relief for possible damage to revenue does not solve the problematics of this case, which, considering the specific caption used by *Zoo*, involve quite an abusive treatment of Bingle's personal dignity.

In recognising a dual nature to the right of publicity – that is an infringement should be actionable to protect both commercial, public interest as well as personal private rights – Haemmerli advances an argument echoing the concerns of contemporary media theory on how celebrity functions within the public domain. These critical perspectives focus on the dynamic relation between celebrity/persona and audience/author suggesting the fields are not, as was once held, completely distinct. Indeed, as this paper has argued, the operation of the celebrity image within commercial, cultural and legal settings, demonstrates that the power of celebrity depends on how this complex interplay is negotiated. However, during the paper I also pointed out that aspects of the celebrity image, as it is reconfigured through multiple socio-technical platforms, represent a challenge for judicial, legislative and cultural reform. Such reform, operating at both the statutory and symbolic levels governing the circulation of celebrity image, must take seriously the materialities of law. Too often, across institutionalised media theory, law is represented as a question of compliance: a copyright template tacked to a course outline, for example, or the habitual dismissal of law from the critical field of textual analyses, effected by the deployment of terms such as 'legalistic'; terms intimately embedded in the language of compliance. These rhetorical strategies render law immaterial. However, as argued by the editors of a special issue of *Cultural Studies* devoted to 'The Politics of Intellectual Properties':

> intellectual property law matters, materially (since) it disturbs material and epistemological boundaries, recodes existing significations and patterns of information flow, and helps to actualise nascent modes of thought, conduct, affect, expression and embodiment (Striphas and McLeod, 2006: 121-122).

By examining in close detail the judicial treatment and legislative developments of the US 'right of publicity' and comparable regulatory frameworks within Australia, I have insisted on the specificities of legal production that structure the materiality of law.

Author's Biography

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Notes

[1] Following Rosemary Coombe, unless otherwise stated, the terms 'persona', 'image', 'identity' and 'personality' in relation to the term 'celebrity' designates a range of character indicia including visual, verbal, aural, graphic and pictorial. See Rosemary J Coombe, *The Cultural Life of Intellectual Properties: Authorship, Appropriation and the Law*(1998) 335 fn 5. [back]

[2] Two notable exceptions: John Frow, 'Elvis' Fame: The Commodity Form and The Form of the Person' *Cardozo Studies in Law and Literature* 7 (1995):131-171; and Kembrew McLeod, 'The Private Ownership of People' in Marshall (ed), *The Celebrity Culture Reader* (2006). [back]

[3] *Pavesich v New England Life Ins* Co 50 SE 68 (1905) and *Lugosi v Universal Pictures* 160 Cal Rptr 323 (1979) (holding that heirs of the actor who played Dracula could not inherit his publicity rights). [back]

[4] New York courts do not recognise a post-mortem right of publicity and have ruled there are no common law rights of privacy or publicity in New York (McCarthy § 6:73.). See also the recent decision concerning estate of Marilyn Monroe in which a New York court ruled 'publicity rights' did not survive her death. *Shaw Family Archives Ltd. v. CMG Worldwide, Inc.,* 486 F. Supp. 2d 309 (2007). [back]

[5] A parody defence to publicity rights infringement has had varied treatment in US courts. For judgments where a parody defence has succeeded see *Cardtoons LC v Major League Baseball Players Association* 95 F 3d 959, 972 (10th Cir, 1996); *Burnett v Twentieth Century Fox Film Corp* 2007 WL 1662343 (CD Cal 2007); and, although more properly a trademark infringement case, see *Mattel Inc v MCA Records Inc* 28 F Supp 2d 1120 (1998). [back]

[6] See also *Moorgate Tobacco Co Ltd v Phillip Morris Ltd* (1984) 56 ALR 193 which ruled out a 'tort of unfair competition' for Australia and, effectively, made stronger the need to rely on passing off and the TPA for the protection of celebrity image. [back]

[7] However, as *Wickham v Association of Pool Builders* (1988) 12 IPR 567 demonstrates, it is not possible to claim unequivocally that Henderson completely removed the 'common field of activity' from the tort of passing off. [back]

[8] See eg *Hogan v Koala Dundee Pty Ltd* (1988) 20 FCR 314 (Paul Hogan successfully sued retailer for using a koala dressed to resemble his Crocodile Dundee character); *Hutchence v South Sea Bubble Co Pty Ltd* (1986) 6 IPR 473 (music group INXS were successful in their action against a company selling unauthorised images on t-shirts; disclaimer that the t-shirts were 'bootleg' was not sufficient protection for defendants to avoid infringement of passing off and breach of TPA); *10th Cantanae Pty Ltd v Shoshana Pty Ltd* (1988) 79 ALR 299 (well known reporter, Sue Smith, failed in her claim for passing off in relation to the use of her name in a video advertisement); *Talmax Pty Ltd v Telstra Corporation Ltd* [1997] 2 Qd R 444 (Olympic swimmer, Kieren Perkins, was successful in his passing off claim against Telstra for use they made of his image in relation to their advertising); and *Sony Music Productions Pty Ltd v Tansing* (1993) 27 IPR 640 (Tansing defended a passing off action by use of a disclaimer on bootleg Michael Jackson CDs). [back]

[9] For a detailed review of the case, see David Rolph, 'Dirty Pictures: Defamation, Reputation and Nudity' (2006) 10*Law Text Culture* 101. [back]

[10] See for example the discussion concerning the Canadian situation, Flagg; discussion concerning the UK, Simon Smith, *Image, Persona and the Law* (2001). [back]

[11] The defamation claims were heard in December 2006 where Edmonds J dismissed Emap's motion to strike out claims that *Zoo Weekly* was an "obscene" and "smutty" publication. However, no further judgments or reports have appeared, suggesting to case has been settled, perhaps confidentially, by the parties. [back]

References

Alderson, Mathew (ed.) *Passing Off: Personality Rights and Trade Practices Law* (St. Leonards , NSW: Prospect Media, 1997).

Black, Hilary May. 'The Role of Trade Mark Law in the Protection of Celebrity Personality', *Media & Arts Law Review*7 (June, 2002):101-115.

Boorstin, Daniel J. *The Image: A Guide to Pseudo-Events in America* (New York: Vantage, 1992, 1962).

Bowman, David. 'The Price of Fame: Protection of Personality Rights in Australia', *Communications Law Bulletin* 22.2 (2003): 6-9.

Butler, Des and Rodrick, Sharon. *Australian Media Law*, 3rd ed (NSW: Thompson, 2007).

Caines, Catherine. 'Top models haunted by sexy shots', *Sunday Telegraph* (Sydney) 26th November 2006, 86.

Catanzariti, Therese. 'Swimmers, Surfers, and Sue Smith – personality rights in Australia', *Entertainment Law Review*13 (June, 2002): 135-141.

Catanzariti, Therese. 'The Plot Thickens Formats, Sequels and Spinoffs after Goggomobil', 22:4 *Communications Law Bulletin* (2003):13-18.

Catty, Hazel. 'Character Merchandising and the Limits of Passing Off', 13 *Legal Studies* (1993): 289 – 307.

Caudill, David. 'Once More into the Breach: Contrasting US and Australian Rights of Publicity', 9 *Media & Arts Law Review* (2004): 263-282.

Coombe, Rosemary J. *The Cultural Life of Intellectual Properties: Authorship, Appropriation and the Law* (Durham: Duke,1998).

Dawson, Dawn. 'The Final Frontier: Right of Publicity in Fictional Characters', *University of Illinois Law Review (*2001): 635-668.

Denton, Nick. 'Church of Scientology Claims Copyright Infringement', *Gawker*,

January 16th 2008, https://gawker.com/5002319/church-of-scientology-claims-copyright-infringement

Dyer, Richard. *Heavenly Bodies: Film Stars and Society* (London: Routledge, 2nd ed, 2004).

Dyer, Richard. *Stars* (London: British Film Institute, 2nd ed. 2008).

Flagg, Mitchell A. 'Star Crazy: Keeping the Right of Publicity Out of Canadian Law', *Intellectual Property Journal* 13 (1999): 179-236.

Frow, John. 'Is Elvis a God? Cult, Culture, Questions of Method', *International Journal of Cultural Studies* 1 (1998):197-210.

Frow, John.

'Elvis' Fame: The Commodity Form and The Form of the Person', *Cardozo Studies in Law and Literature* 7 (1995):131-171.

Gaines, Jane. 'Reincarnation as the Ring on Liz Taylor's Finger: Andy Warhol and the Right of Publicity' in Austin Sarat and Thomas R Kearns (eds), *Identities, Politics, and Rights* (Ann Arbor: University of Michigan Press1997), 131-192.

Gamson, Joshua. *Claims to Fame: Celebrity in Contemporary America* Berkeley: University of California Press, 1994).

Haemmerli, Alice. 'Whose Who? The Case for a Kantian Right of Publicity', *Duke Law Journal* 49 (1999): 383 – 474.

Heerey, Peter. 'Character and Personality: Where to for Protection in the Intellectual Property Area?' *Intellectual Property Forum* 39 (1999): 8.

Kitzmann, Andreas. *Saved From Oblivion: Documenting The Daily From Diaries To Web Cams* (New York: Peter Lang, 2004).

Lumby, Catharine. *Gotcha: Life in a Tabloid World* (St Leonards: Allen & Unwin, 1999).

McCarthy, J Thomas. *The Rights of Publicity and Privacy* (looseleaf).

McLeod, Kembrew. 'The Private Ownership of People' in Marshall, P. David (ed.). *The Celebrity Culture Reader* (New York: Routledge, 2006), 649-665.

McMullan, J. 'Personality Rights in Australia', *Australian Intellectual Property Journal* 8 (1997): 86-95.

Madow, Michael. 'Private Ownership of Public Image: Popular Culture and Publicity Rights', *California Law Review* 81 (1993):127-240.

Marshall, P David. 'New Media – New Self: The Changing Power of Celebrity' in David Marshall (ed.). *The Celebrity Culture Reader* (New York: Routledge, 2006), 634-644.

Marshall, P David. *Celebrity and Power: Fame in Contemporary Culture* (University of Minnesotta Press, 1997).

Milne, Esther. 'The pedagogy of media law', *Media and Arts Law Review*, 13.1 (2008): 93-103.

Monsters and Critics. 'Copy of Princess Diana's 1981 Wedding Dress Sold for £100,000.' *Monsters and Critics*, https://people.monstersandcritics.com/royalwatch/news/article_1067563.php/

Nimmer, Melville B. 'The Right of Publicity', *Law and Contemporary Problems* 19 (1954): 203-223.

O'Connell, Jerry. 'Tom & Jerry' (2008): https://www.youtube.com/watch?v=nWSlPYV_U7w

Pemberton, Gretchen A. 'The Parodist's Claim to Fame: A Parody Exception to the Right of Publicity', (1993) *UC Davis Law Review* 27 (1993): 97-132.

Pringle, Hamish. *Celebrity Sells* (West Sussex: John Wiley, 2004).

Prosser, William. Privacy', *California Law Review* 48 (1960): 383-423.

Ralston, Scott. 'Australian Celebrity Endorsements: The Need for an Australian Right of Publicity' *Communications Law Bulletin* 20.4 (2001): 9-12.

Richardson, Megan. 'Australian Contribution', *Comparative Aspects of Personality Rights: Research Project and Case Studies*, (2007) https://www.law.ed.ac.uk/ahrc/files/92_pppcasestudiesfinaljan07.pdf.

Ricketson, Sam. 'Character Merchandising in Australia: Its Benefits and Burdens' (1990) 1 *Intellectual Property Journal* 1 (1990): 191-211.

Ricketson, Sam and Richardson, Megan. *Intellectual Property: Cases, Materials and Commentary* (NSW: Butterworths, 3rd ed, 2005).

Rojek, Chris. *Celebrity* (London: Reaktion,2001).

Rolph, David. 'Dirty Pictures: Defamation, Reputation and Nudity', *Law Text Culture* 10 (2006):101-134.

Smith, Simon. *Image, Persona and the Law* (UK: Sweet & Maxwell, 2001).

Striphas Ted and McLeod Kembrew (eds). 'The Politics of Intellectual Properties': A Special Issue of *Cultural Studies* 20.2/3 (2006).

Turner, Graeme, *Understanding Celebrity* (2004).

Tyacke, Nicholas and Walker, Tara. 'Where the Bloody Hell are my Personality Rights? *Australian Intellectual Property Law Bulletin* 20:2 (2007): 14-18.Van Caenegem, William. *Intellectual Property* (NSW: Butterworths, 2nd ed, 2006).

Warren, Samuel and Brandeis, Louis. 'The Right to Privacy' (1890) 4 *Harvard Law Review* (1890): 193-220.

Weathered, Lynne, 'Trade Marking Celebrity Image: The Impact of Distinctiveness and Use as a Trade Mark', *Bond Law Review* 12 (2000): 161-182.

Zapparoni, Rosina, 'Propertising Identity: Understanding the United States Right of Publicity and Its Implications – Some Lessons for Australia', 28 *Melbourne University Law Review* 28 (2004): 690-723.

Cases

10th Cantanae Pty Ltd v Shoshana Pty Ltd (1988) 79 ALR 299.

Bingle v Emap Australia (No 1) [2006] FCA 1704 (8 December 2006).

Burnett v Twentieth Century Fox Film Corp 2007 WL 1662343 (CD Cal 2007).

Cardtoons LC v Major League Baseball Players Association 95 F 3d 959 (10th Cir, 1996).

Eastwood v Superior Court 149 Cal App 3d 409 (1983).

Erven Warnink Bestolen Venootschap v J Townend & Sons (Hull) Ltd [1979] AC 731 (*Advocaat* case).

Haelan Laboratories Inc v Topps Chewing Gum Inc 202 F 2d 866 (2nd Cir, 1953); cert denied 346 US 816 (1953).

Hogan v Koala Dundee Pty Ltd (1988) 20 FCR 314.

Hogan v Pacific Dunlop (1988) 83 ALR 403.

Hustler Magazine v Falwell 485 US 46 (1988).

Hutchence v South Sea Bubble Co Pty Ltd (1986) 6 IPR 473.

Irvine v Talksport [2002] 1 WLR 2355.

LL Bean Inc v Drake Publishers Inc 811 F 2d 26 (1st Cir, 1987).

Lugosi v Universal Pictures 160 Cal Rptr 323 (1979).

McCulloch v Lewis A May (Produce Distributors) Ltd [1947] 2 All ER 845.

Martin Luther King Jr Center for Social Change Inc v American Heritage Products Inc 296 SE 2d 697 (1982).

Mattel Inc v MCA Records Inc 28 F Supp 2d 1120 (1998).

Moorgate Tobacco Co Ltd v Phillip Morris Ltd (1984) 56 ALR 193.

Newton-John v Scholl-Plough (Australia) (1986) 11 FCR 233.

Pacific Dunlop v Hogan (1989) 87 ALR 14.

Pavesich v New England Life Ins Co 50 SE 68 (1905).

Presley's Estate v Russen 513 F Supp 1339 (DC NJ, 1981).

Radio Corporation Pty Ltd v Henderson [1960] NSWR 279; (1960) 1A IPR 620.

Roberson v Rochester Folding Box Co 65 NYS 1109 (1900).

Roberson v Rochester Folding Box Co 171 NY 538 (1902).

Shaw Family Archives Ltd. v. CMG Worldwide, Inc., 486 F. Supp. 2d 309 (2007).

Sony Music Productions Pty Ltd v Tansing (1993) 27 IPR 640.

Talmax Pty Ltd v Telstra Corporation Ltd [1997] 2 Qd R 444.

Telstra v Royal & Sun Alliance Insurance (2003) 57 IPR 453.

Twentieth Century Fox v SA Brewing Co Ltd (1996) 34 IPR 225.

Waits v Frito-Lay Inc 978 F 2d 1093 (9th Cir, 1992).

White v Samsung Electronics America Inc 989 F 2d 1512 (9th Cir, 1993).

White v Samsung Electronics America Inc 971 F 2d 1395 (9th Cir, 1992).

Wickham v Association of Pool Builders (1988) 12 IPR 567.

Zacchini v Scripps-Howard Broadcasting Co 433 US 562 (1977).

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