Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases

Pamela Samuelson

Follow this and additional works at: https://scholarship.law.berkeley.edu/facpubs

Recommended Citation
Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases, 57 Tul. L. Rev. 836 (1982)
REVIVING ZACCHINI: ANALYZING FIRST AMENDMENT DEFENSES IN RIGHT OF PUBLICITY AND COPYRIGHT CASES

PAMELA SAMUELSON*

I. INTRODUCTION

The right of publicity—the right of a person to control and benefit from the commercial value of his name, likeness, performance style, and the like—is a newly emerging basis for tort actions. As such, its boundaries, including what defenses may properly be asserted in an action to enforce publicity rights and what standards are to be used in analyzing these defenses, are not yet defined.

In several cases in the past five years, defendants have brandished the first amendment as a shield against liability for interference with the plaintiff's publicity rights. Courts have tried a number of approaches to analyzing first amendment issues in publicity cases. Both in their modes of analysis and their outcomes, the cases are in considerable conflict with one another and with the one Supreme Court opinion in the area. For the most part, courts faced with first amendment defenses in publicity cases have ignored the manner in which similar issues have been resolved in cases involving similar types of intangible rights.

* Assistant Professor of Law, University of Pittsburgh School of Law; J.D. 1976 Yale Law School; M.A. 1972, B.A. 1971 University of Hawaii.

1. See, e.g., Memphis Dev. Found. v. Factors Etc., Inc., 616 F.2d 956, 957 (6th Cir.) ("The famous have an exclusive legal right during life to control and profit from the commercial use of their name and personality"), cert. denied, 449 U.S. 953 (1980); Estate of Presley v. Russen, 513 F. Supp. 1339, 1353 (D.N.J. 1981) ("The term 'right of publicity' has . . . come to signify 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"). Various personal attributes have been protected as publicity rights: names of baseball players used in board games, Uhlener v. Henricksen, 316 F. Supp. 1277 (D. Minn. 1970); names and likenesses of famous persons used in connection with sales of merchandise, Price v. Hal Roach Studios, Inc., 400 F. Supp. 836 (S.D.N.Y. 1975); attributes of performance style along with name or likeness, Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981); and actual performances by an individual, Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977).
The potential for conflict between the exclusive rights asserted by the owner of an intangible property right and the desire of another to use the property arises in copyright as well as in publicity cases. Defendants in copyright cases have sometimes raised first amendment defenses when seeking to be excused from an appropriation of copyrighted material, but, more often, they have sought exemption from liability by arguing that their particular use of the material was a “fair” one under the circumstances. Frequently, both defenses have been raised.

Factors that courts in copyright cases have historically considered in deciding whether a particular use was “fair” have been the purpose and character of the use, the nature of the copyrighted work, the amount and substantiality of the taking, and the effect of the use on the potential market for the copyrighted work. Under the “fair use” defense, satires of copyrighted works, scholarly research incorporating parts of copyrighted works, and similar uses have received protection from infringement suits. Courts sometimes avoid deciding constitutional defenses in infringement suits because an exemption can be granted on fair use grounds. Even when courts must reach the constitutional defenses, the fair use analysis is helpful, because it aids in assessing the substantiality of interference with the copyrights as part of the balancing of interests in a first amendment analysis. Finally, copyright cases have developed a standard for deciding when the first amendment will provide protection for a taking that is not a fair use.

An adaptation of the copyright “fair use” defense in publicity cases would be a sound development in publicity law. As in copyright law, it may be possible for courts to resolve exemption claims on fair use rather than on consitutional grounds. If a use is found to be unfair, the copyright law standard can be used to assess whether the first amendment should nonetheless protect it.

Section II below describes the controversy concerning the nature of publicity rights and argues for the treatment of publicity rights in much the same manner as copyrights. Section III reviews several approaches courts have taken in analyzing the first amendment defenses raised in many publicity cases. Section IV reviews how conflicts between enforcement of the exclu-
sive right and the desire for free access are handled in copyright cases, focusing particularly on those cases in which both fair use and first amendment defenses have been raised. Section V proposes a new analysis for first amendment defenses in right of publicity cases.

II. THE NATURE OF PUBLICITY RIGHTS

The proper label for the right enforced in publicity actions has been a subject of considerable controversy. The author of one recent comment has observed that the various opinions in Lugosi v. Universal Pictures characterized the publicity right asserted there—Lugosi's heirs' right to share in the royalties Universal Pictures was receiving for licensing commercial exploitation of the image of Bela Lugosi as Count Dracula—in four different ways. The predominant trend in publicity cases is to treat the right of publicity as a property right. Some courts and commentators have been more circumspect and described it only as a proprietary right. A few courts still favor a privacy label.

2. Comment, An Assessment of the Copyright Model in Right of Publicity Cases, 70 Cal. L. Rev. 786 (1982) [hereinafter cited as California Comment].


Not every court that has recognized the right of publicity has taken a position on this issue.\(^7\)

This author believes that it is proper to characterize publicity rights as intangible property rights, and further that the closest analogous rights among the constellation of intangible property rights are those of copyright. The intricacies of the controversy over the appropriate label for publicity rights have been explored at length by others.\(^8\) The issues are briefly reviewed here for purposes of laying the groundwork for the author's theories as to how first amendment defenses ought to be analyzed in publicity actions.

A. The Case for a Privacy Characterization

Those who analyze publicity rights as a species of privacy rights rely on Dean Prosser's analysis of the law of privacy.\(^9\) Prosser's review of privacy case law led him to posit that there were four distinct types of intrusions into the private realm that seemed to be protected in privacy actions. He described the following four types:\(^10\)

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 that places the plaintiff in a false light in the public eye.

---


7. See Memphis Dev. Found. v. Factors Etc., Inc., 616 F.2d 956 (6th Cir.), cert. denied, 449 U.S. 956 (1980); Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir.) ("Whether [the right of publicity is] labelled a 'property' right is immaterial; for here, as often elsewhere, the tag 'property' simply symbolizes the fact that courts enforce a claim which has pecuniary worth"), cert. denied, 346 U.S. 816 (1953).


10. 48 Calif. L. Rev. at 389.
4. Appropriation, for the defendant's advantage, of the plaintiff's name or likeness.

Prosser pointed out that invasions of these different interests were "'tied together by the common name, but otherwise have almost nothing in common except that each represents an interference with the right of the plaintiff, in the phrase coined by Judge Cooley, 'to be let alone.' "11

Among the implications of treating an appropriation of a person's name or likeness for unauthorized commercial advantage as an invasion of a right of privacy is that the right will be found to be personal. This generally means it can neither be assigned to12 nor inherited by others.13 In this respect, an action for invasion of privacy resembles defamation actions. Another resemblance is that both actions are typically concerned with harm, potential or actual, to the reputation or feelings of the individual whose rights have been invaded, not with harm to his economic interests.14 Hence, injunctive relief rather than monetary damages is usually the aim of litigation complaining of privacy invasions,15 although some special damages may occasion-

11. Id. (footnote omitted).
13. See, e.g., Maritote v. Desilu Prods., Inc., 345 F.2d 418 (7th Cir.), cert. denied, 382 U.S. 883 (1965) (estate of Al Capone held to have no standing to make a right of privacy type claim against producers of television series depicting him as a gangster and attributing to him crimes not committed by him; the right was personal to Capone and died with him); Frosch v. Grosset & Dunlap, Inc., 75 A.D.2d 768, 427 N.Y.S.2d 828 (N.Y. App. Div. 1980), discussed infra at note 142 (estate of Marilyn Monroe had no right to assert claim for invasion of her privacy since right extended only to living persons). But see National Bank of Commerce v. Shaklee Corp., 503 F. Supp. 533 (W.D. Tex. 1980) (concluding that privacy claim could survive death of the claimant under Texas law so long as suit was initiated before the claimant's death); W. Prosser, Handbook of the Law of Torts § 117, at 815 (4th ed. 1971) (indicating that survivability of the right may depend on the rules of each jurisdiction).
14. This distinction between publicity rights and privacy rights was made by the Supreme Court in Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 573 (1977).
15. See, e.g., Lombardo v. Doyle, Dane & Bernbach, Inc., 58 A.D.2d 620, 396 N.Y.S. 2d 661 (N.Y. App. Div. 1977) (in most New York statutory privacy cases where any damages have been awarded, they have been nominal); Gordon, supra note 8, at 567-68.
ally be claimed as the consequence of the intrusion.\textsuperscript{16}

Part of the reason for the manifest confusion about whether publicity rights derive from or are part of the common law of privacy is that there are some situations in which a defendant's commercial appropriation of the plaintiff's name or likeness truly is an invasion of that person's privacy and some situations in which it manifestly is not. For example, assume that a food company begins to use on the labels of one of its food products the likeness of a woman who is not a public figure and who has not consented to any commercial use of her image. That woman might have a viable claim against the food company to restrain it from further intrusion into her privacy. She might prefer to remain a private person rather than to receive compensation for the commercial use of her image.\textsuperscript{17} On the other hand, a prominent entertainer whose visage is silk-screened onto a T-shirt and sold by someone without authorization may be more concerned about the profits being made by the T-shirt manufacturer than by the public depiction of his image.\textsuperscript{18} As one court has noted, "it 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, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways."\textsuperscript{19}


\textsuperscript{17} This hypothetical parallels the situation in Roberson v. Rochester Folding Box Co., 171 N.Y. 538, 64 N.E. 442 (1902), which led to the enactment of the New York privacy statute. Because there was no precedent for granting relief to the plaintiff and because the court feared the implications of granting such relief, the court of appeals denied recovery to a lady whose image had been employed to advertise defendant's flour. At the next legislative session, in response to this judicial decision, New York's legislature enacted what is now § 51 of the N.Y. Civil Rights Law, see infra note 21, which now provides a cause of action for persons like Roberson. See W. Prosser, Handbook of the Law of Torts § 117, at 803 (4th ed. 1971).

\textsuperscript{18} The author of the California Comment, supra note 2, observes that the entertainer may wish not only to receive compensation for infringements of publicity rights, but may want to restrain some commercializations of his image. The entertainer will have a long-term economic interest in maintaining the commercial value of his image which might only be possible if he can protect against market saturation by all entrepreneurs who might find it in their short-term interest to use the image on their goods. \textit{Id}. at 789 n.13.

\textsuperscript{19} Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir.), \textit{cert. denied}, 346 U.S. 816 (1953). Even a prominent entertainer may occasionally seek not so much the commercial benefit of the use of his likeness as protection from un-
Another reason for the confusion about the proper way to characterize publicity rights is that many of the "privacy" cases involving commercial appropriations have been brought under New York's "right of privacy" statute, which merges commercial appropriations of both privacy and publicity interests. That is, it codifies the fourth of Prosser's privacy categories.\(^2\) Section 51 of New York's Civil Rights Law provides a cause of action for injunctive relief and damages when a person's name, portrait, or picture has been used without that person's consent for purposes of advertising or trade.\(^2\) New York courts generally have not been receptive to attempts to construe section 51 as applying only to "true privacy" types of claims,\(^2\) and, with one exception,\(^2\) have generally refused the many invitations offered them to recognize an independent right of publicity.\(^2\) The coyness of New York courts about whether they will recognize an indepen-


\(^{21.}\) N.Y. Civil Rights Law § 51 reads in pertinent part:

\[\text{[A]ny person whose name, portrait or picture is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained as above provided [in § 50] may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait or picture, to prevent and restrain the use thereof; and may also sue and recover damages for any injuries sustained by reason of such use.}\]

\[\text{... N.Y. Civ. Rights Law § 51 (McKinney Supp. 1982). Some courts have recognized publicity rights to be somewhat broader than this, as for example, a comedy style. See, e.g., Price v. Worldvision Enters., Inc., 455 F. Supp. 252 (S.D.N.Y. 1978). Publicity rights also encompass a style of performance, which might include such things as the performer's gestures and style of dress. See, e.g., Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981).}\]

\(^{22.}\) See, e.g., Brinkley v. Casablancas, 80 A.D.2d 428, 438 N.Y.S.2d 1004 (N.Y. App. Div. 1981) (denying defendant's motion to dismiss on the ground that the model's claim based on use of her image on a poster was essentially a publicity claim, not the privacy claim she alleged).

\(^{23.}\) See Lombardo v. Doyle, Dane & Bernbach, Inc., 58 A.D.2d 620, 396 N.Y.S.2d 661, 664 (N.Y. App. Div. 1977) ("In New York there is a distinction between the statutory right which protects living persons from commercial exploitation of their names and pictures without their written consents, as embodied in sections 50 and 51 of the New York Civil Rights Law, and the common law property right in one's public personality.")

dent common law right of publicity has not prevented federal courts in New York from discerning that a common law right of publicity does indeed exist apart from section 51.25

What New York did by statute, California courts seem to have done by common law. Although characterizing debate on the labelling issue as "pointless," the California Supreme Court in *Lugosi v. Universal Pictures*26 decided it was more appropriate to treat publicity rights as within the privacy rather than the property realm. Lugosi's heirs were denied the recovery awarded by the trial court because the supreme court held that only Lugosi could assert a privacy claim. Curiously enough, despite the choice to characterize the right as a privacy right, the court also noted that had Lugosi exploited his name and likeness as Dracula in connection with products or services during his lifetime, a property right might have been created, which then might have descended to his heirs.27

B. The Case for a Property Characterization

The right of publicity, as such, was invented because a court was faced with circumstances which made obvious one of the limitations of the privacy characterization for commercial appropriations of celebrity names and likenesses. In *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,28 Topps, a chewing gum manufacturer, was sued by a rival firm for infringement of the latter's exclusive licenses from prominent baseball players to use


27. The court of appeals decision adopted by the California Supreme Court reflects a deep concern with the implications of the seemingly perpetual nature of the right if it is characterized as a property right. *Id.* at 822, 603 P.2d at 430, 160 Cal. Rptr. at 328. Thus, one wonders whether the court chose to characterize the right of publicity as a privacy right because the court, for policy reasons, did not think the right should be a descendible one, or whether its conclusion on descendibility is the logical outcome of an analysis as to what kind of right this is. *See also* National Bank of Commerce v. Shaklee Corp., 503 F. Supp. 533 (W.D. Tex. 1980) (concluding that Shaklee's misappropriation of the name and likeness of the well-known giver of domestic advice, "Heloise," in an advertising campaign invaded her right of privacy; no discussion of controversy over property/privacy labels).

the players' names and likenesses on cards enclosed in gum packages. Topps argued that the agreement on which Haelan relied was not an exclusive license, but rather a release of the liability under section 51 of the New York Civil Rights Law which Haelan itself would incur if it put the baseball cards in its packages without the players' written permission. Topps maintained that the players' rights in their names and likenesses were privacy rights, which were personal to the players and could not be assigned. Consequently, Topps argued, Haelan could not assert a claim against it.

To find a legal basis for recognition of what was clearly intended to be an exclusive license, the court had to find some way to characterize the interest at stake other than as a privacy right. The court stated: "[I]n addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and. . .such a grant may validly be made 'in gross,' i.e., without an accompanying transfer of a business or of anything else." Thus, the right of publicity was born.

As Haelan indicates, one of the implications of saying that publicity rights are a subset of privacy rights is that celebrities would be denied the power to assign the right to others. Yet, as the Second Circuit stated, the right of publicity "would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures." Celebrities generally spend most of their time and effort building on the goodwill in their names and likenesses; they generally are not actively involved in subsidiary commercialization efforts. Courts should not adopt rules that will force the celebrities either to do all commercial exploitations of their names and likenesses or lose the benefit of their goodwill.

While it was initially this limitation of the privacy label that caused the court to invent the right of publicity as a separate tort, most courts have rejected the privacy label and adopted a property label for publicity rights because the two theories are
intended to protect different interests. Publicity rights protect economic interests whereas privacy rights protect interests in the reputation or feelings of the complainant. Because of this distinction, the parallel to commercial appropriations of copyright-protected graphic works or trademarks is far stronger than the parallel to revelation of embarrassing facts. Additionally, the privacy label presents linguistic problems. Describing the types of complaints enforced in publicity actions as intrusions on a plaintiff’s “privacy” does more than distort the meaning of the term “privacy.” It contradicts the fundamental basis for granting relief. Publicity plaintiffs seek public exposure; privacy plaintiffs seek anonymity.

Currently, the most controversial issue concerning publicity rights seems to be whether the right should be recognized as capable of surviving the owner’s death and descending to his heirs. Most courts addressing the issue have held that the right is descendible, although the pendulum has begun to swing the other way. It is difficult to predict how the courts will eventually set-

31. Tax cases have had occasion to consider whether publicity rights are to be considered “property” for certain tax purposes. In Miller v. Commissioner, 299 F.2d 706 (2d Cir. 1962), Glenn Miller’s widow argued that the contract whereby she granted to Universal Pictures the exclusive right to make a movie about Glenn Miller’s life represented a sale of a capital asset. The tax code defined “capital asset” as “property held by the taxpayer,” but did not define the term “property.” The law was unclear whether rights such as those she asserted were “property” rights, but even if they were, not everything which might be property at common law would be treated as property for tax purposes. The court decided that for income tax purposes, Mrs. Miller would not be treated as having a capitalizable property interest in the publicity rights of her husband.


33. Courts which have held that the right is not heritable include the California Supreme Court in Lugosi v. Universal Pictures, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979); Guglielmi v. Spelling-Goldberg Prods., 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352 (1979); and the Sixth Circuit Court of Appeals (based on Tennessee law) in Memphis Dev. Found. v. Factors Etc., Inc., 616 F.2d 956 (6th Cir.), cert. denied, 449 U.S. 953 (1980).

Additionally, the Second Circuit Court of Appeals, finding the district court to have been in error by applying New York instead of California law, has recently reversed the granting of summary judgment to a set of publicity plaintiffs who had either inherited...
tle the issue. Most commentators favor descendibility.\(^4\)

Courts have concluded that the right should survive the death of the publicity owner both as a logical result of having defined the right as proprietary, and for policy reasons. Policy considerations that favor descendibility of the right of publicity include the following: (1) rewarding celebrities for the value of their publicity rights; (2) recognizing that the appropriators of a dead celebrity's publicity rights are capitalizing on a value they played no part in creating; and (3) recognizing that other intangible property rights similar to publicity rights are heritable.

Assuming descendibility, courts are divided as to whether their rights or received their rights by assignment from publicity owners now deceased. See Groucho Marx Prods., Inc. v. Day & Night Co., 523 F. Supp. 485 (S.D.N.Y. 1981), rev'd on other grounds, 689 F.2d 317 (2d Cir. 1982).

Deferring to the *Memphis Development* decision because of that court's greater experience with application of Tennessee law, the Second Circuit also recently reversed a judgment granting a permanent injunction to the assignee of Elvis' publicity rights. See Factors Etc., Inc. v. Pro Arts, Inc., 652 F.2d 278 (2d Cir. 1981), cert. denied, 456 U.S. 927 (1989) (*Factors II*). The Second Circuit had previously approved the issuance of a preliminary injunction in that case, in the course of which the Second Circuit had found the right to be descendible. See Factors Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215 (2d Cir. 1978), cert. denied, 440 U.S. 908 (1979) (*Factors I*). Judge Newman, writing for the *Factors II* court, indicated that were he serving on the Tennessee Supreme Court or even had he sat on the Sixth Circuit panel in *Memphis Development*, he probably would have held the right to be descendible, but that was not the issue. 652 F.2d at 282. Judge Mansfield in dissent pointed out that deference in this case may have been inappropriate since the reasoning of *Memphis Development* was not in any way derived from or based upon an interpretation of the law of Tennessee. Id. at 284. (Not even one reference was made to Tennessee law in the *Memphis Development* case.) In the meantime, a lower Tennessee court has rejected the *Memphis Development* "interpretation" of Tennessee law and held that the right of publicity is descendible in Tennessee. See Commerce Union Bank v. Coors of Cumberland, Inc., 551 Pat. Trademark & Copyright J. (BNA) A-3 (Tenn. Ch. App. 1981) (estate of country musician sued because of use of decedent's image in defendant's beer commercials; citing approvingly Judge Mansfield's dissent in *Factors II* which predicted Tennessee courts would find the right to be inheritable in order to protect and preserve Tennessee as an important center for country music and musicians). See also Comment, *Inheritability of the Right of Publicity Upon the Death of the Famous*, 33 Vand. L. Rev. 1251 (1980); Note, *Right of Publicity—Descendibility of a Celebrity's Right to Benefit From Fame*, 47 Tenn. L. Rev. 886 (1980). Both are highly critical of the *Memphis Development* decision.

the heir or assignee of the right must show that the celebrity before his death recognized the commercial value of his publicity right, and as to what evidence is acceptable. In most cases some sort of prior history of assigning use of the celebrity's name or likeness has been established. Nevertheless, a few publicity heirs or assignees have lost their right to relief for lack of commercial exploitation by the celebrity.

Among the courts to have described the nature of the publicity right as a "proprietary" right is the United States Supreme Court, in Zacchini v. Scripps-Howard Broadcasting Co. The plaintiff in that case sought compensation for a television station's appropriation of the performance of the act by which he earned his livelihood. The Court did not explain what it meant by calling Zacchini's interest in his act a "proprietary" interest, but presumably the Court recognized the right had some, but perhaps not all, of the characteristics of property. It was enough that, in contrast to privacy rights, publicity rights protected the plaintiff's economic interests in the performance by which he made his living. Other courts and commentators which have described the right as a proprietary one similarly have not defined which attributes of property are shared by publicity rights and which are not.

The author of one article has given several reasons why


38. 433 U.S. at 575-76.


40. California Comment, supra note 2. Even Prosser, who otherwise treats commercial appropriations of names and likenesses as privacy rights, recognizes some element of property in these rights. See W. Prosser, Handbook of the Law of Torts § 117, at 807 (4th ed. 1971): "It seems quite pointless to dispute over whether such a right is to be classified as 'property'; it is at least clearly proprietary in its nature" (footnote omitted).
publicity rights ought to be regarded as proprietary rights, rather than as property rights. The author regards a property label as flawed because it fails to take into account "counter-vailing social interest in free enterprise and free expression." Calling publicity rights "property" would mean giving a full range of monopoly rights to prominent persons. This author seems to have been swayed by a recent opinion of the Sixth Circuit Court of Appeals, which posited that to some extent the names and faces of famous persons ought to be available for public use, even uses that might generate money to others. He fears that the free exchange of information concerning prominent persons might be chilled if the full monopoly rights of "property" are conferred on publicity rights. Yet he also would have publicity rights treated in the manner in which copyrights are treated.

While it is true that publicity rights are limited somewhat by the operation of the first amendment and social policies favoring free enterprise and free competition, similar limitations exist as to other types of intellectual property. Trademarks, for example, may be used, even commercially, by others so long as there is no likelihood that the second use will generate public confusion as to the source of the goods. Copyrighted material may also be used by persons other than the copyright owner so long as the use is a fair one. Yet, these rights are generally considered to be property rights. Publicity rights should be treated, then, as a species of property right akin to other intel-

41. California Comment, supra note 2, at 793-97.
42. Id. at 789.
44. California Comment, supra note 2, at 789.
45. Id. at 790.
46. Id. at 787.
47. See, e.g., Girl Scouts of the United States v. Personality Posters, Inc., 304 F. Supp. 1228 (S.D.N.Y. 1969) (no liability where no likelihood that public would think poster showing pregnant Girl Scout with legend "Be Prepared" was sponsored by the organization); Reddy Communications, Inc. v. Environmental Action Found., 477 F. Supp. 936 (D.D.C. 1979) (environmental group's use of service mark not an infringement because no likelihood public would think utility sponsored the use).
48. See infra § IV, subsection B.
C. Specific Similarities of Publicity Rights to Copyright

In addition to the similarities between copyright and publicity rights that naturally flow from their designation as "property," there is a significant similarity in the rationale for granting protection to these rights. Enforcement of a copyright or publicity right is aimed in part at compensating the owner for the time and effort spent to create the property right and for the public benefit derived. The compensation is an economic incentive to further creative effort. As the Supreme Court stated in the copyright case *Mazer v. Stein*:

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in "Science & useful Arts." Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.

This similarity between copyright and publicity was explicitly noted by the Supreme Court in the publicity case *Zacchini v. Scripps-Howard Broadcasting Co*.

One also sees in any litigation to enforce copyright or publicity rights the same sets of interests—private and public—being weighed and adjudicated: the private interest of one who claims the exclusive right is balanced against the private interest of the one who claims that the right may lawfully be

---

50. Following the principle that like things ought to be treated alike, all intellectual property rights ought to be treated as similarly as is feasible and reasonable. If courts are dissatisfied with application of first amendment precedents from the trademark or copyright field to publicity right cases, perhaps it is more appropriate to rethink whether the deference given to property interests in those types of cases is the best policy rather than to carve out a special exception for publicity rights, giving little or no weight to the comparable property interests in this type of case.

51. That is, both types of rights are assignable, either in gross or in part. Both are often the subject of licensing agreements that are paid in royalties. See Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157 (9th Cir. 1977); Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981). Descendibility may also be said to flow naturally from the property designation at least in those jurisdictions where it is recognized.

52. 347 U.S. 201 (1954).

53. Id. at 219.

appropriated by him. The public interest in granting economic reward to the one who created the right, which will encourage creative activity, is balanced against the public interest in free enterprise and free dissemination of ideas.\(^5\)

Both copyrights and publicity rights protect the interest holder not only from direct and complete appropriations, but also from takings of such a substantially similar character that there is a recognizable resemblance between the items complained of and the protected matter.\(^6\) Both protect not only the economic benefits the owner is already exploiting for himself—the selling of copies of a copyrighted book by the author, or the selling of T-shirts with the celebrity's image on them by the publicity owner or his assigns—but also a range of commercial opportunities the owner of the monopoly may not yet have exploited, but which the monopoly entitles him to exploit. The copyright gives the author of a novel the right to adapt the novel to a screenplay. The publicity right gives the owner the right to extend his merchandising of his image from T-shirts to puzzles or paper dolls.\(^7\)

Both types of law are concerned not only with direct economic injury to the owner, but with prevention of unjust enrichment as well.\(^8\) In proper cases, not only direct damages to the owner's interest, but also the profits from the misappropriator's

---

55. See, e.g., Goldstein, Copyright and the First Amendment, 70 Colum. L. Rev. 983 (1970); California Comment, supra note 2.

56. Copyright infringement liability will be imposed if the allegedly infringing matter is "substantially similar" to the copyrighted work. See generally Lombardo v. Doyle, Dane & Bernbach, Inc., 58 A.D.2d 620, 396 N.Y.S.2d 661 (N.Y. App. Div. 1977) (television advertisement featuring band leader and New Year's Eve celebration which resembled that normally associated with Guy Lombardo infringed Lombardo's privacy or publicity rights despite the fact that the actor in the commercial did not physically resemble Lombardo); 3 M. Nimmer, supra note 49, § 13.03.

57. The right to prepare derivative works is one of the exclusive rights which the copyright law bestows on the owner of a copyright. See 17 U.S.C. § 106(2) (Supp. V 1981). The fact that the copyright owner has not and may not intend to adapt the work does not give anyone else the right to do an adaptation. See 2 M. Nimmer, supra note 49, § 8.09. Similarly, that Laurel and Hardy had not themselves commercially exploited their names and likenesses in connection with sales of merchandise did not prevent a court from holding that their heirs and assigns had enforceable publicity interests when others sold merchandise featuring their likenesses. Price v. Hal Roach Studios, Inc., 400 F. Supp. 836 (S.D.N.Y. 1975).

58. See California Comment, supra note 2, at 795 (concerning unjust enrichment concerns in both copyright and publicity cases).
infringing activity, may be awarded to the owner.\textsuperscript{59} Injunctive relief may sometimes be appropriate.\textsuperscript{60}

Still another similarity is that the owner of the right should have the right to control when and in what manner he wishes to “go public” in order to reap the economic reward for his creative effort.\textsuperscript{61} The owner’s exclusive rights exist in a latent state before he goes public, and nothing need be done to preserve the right to exercise it when the person chooses.\textsuperscript{62} Still, an affirmative act is required to establish a copyright monopoly once the author publishes his work; he must affix a copyright notice to the work.\textsuperscript{63} No such affirmative act seems to be required to establish a publicity monopoly.\textsuperscript{64} There is no question but that one who might be entitled to obtain the exclusive rights of copyright or publicity can, by his actions, dedicate that right to the public domain.\textsuperscript{65} At least one court has analyzed a claim of abandon-

\textsuperscript{59} The copyright statute allows the copyright owner to recover not only any actual damages to his economic interest caused by the infringement, but also any profits of the infringer which are attributable to the infringement (and have not already been taken into account in computing actual damages). See 17 U.S.C. § 504 (Supp. V 1981). Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977), is an example of a case in which a publicity plaintiff sought to recover for actual damages arising from the infringement. The publicity plaintiffs in Groucho Marx Prods., Inc. v. Day & Night Co., 523 F. Supp. 485 (S.D.N.Y. 1981), \textit{reid on other grounds}, 689 F.2d 317 (2d Cir. 1982), sought a royalty from the producers of the Broadway play which was alleged to infringe the Marx Brothers’ publicity rights. Chief Justice Bird, in her dissent in Lugosi v. Universal Pictures, 25 Cal. 3d 813, 855, 603 P.2d 425, 452, 160 Cal. Rptr. 323, 348 (1979), suggests that publicity cases should look to copyright and patent cases for guidance as to remedies for infringement.

\textsuperscript{60} Cases in which injunctive relief was sought and obtained have included Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981) (restraining imitation Elvis Presley musical performance); Price v. Worldvision Enters., Inc., 455 F. Supp. 252 (S.D.N.Y. 1978), \textit{aff’d without opinion}, 603 F.2d 214 (2d Cir. 1979) (enjoining a television series which was to portray Laurel and Hardy as a comedy team). Injunctive relief in copyright infringement cases is issued as a matter of course whenever there is any danger of continuing or additional infringements. See 3 M. Nimmer, supra note 49, § 14.06(B).

\textsuperscript{61} California Comment, supra note 2, at 809.

\textsuperscript{62} Usually, the issue of prior commercial exploitation arises in cases where the heirs of the rights owner are asserting their claims. See supra notes 35-36 and accompanying text. Yet at least one case suggests that prior exploitation may be necessary even when the celebrity is still living. See Lerman v. Chuckleberry Publishing, Inc., 521 F. Supp. 228, 232 (S.D.N.Y. 1981).

\textsuperscript{63} This includes the copyright symbol, the name of the copyright owner, and the year for which the copyright is claimed. There are copyright regulations as to where the notice must be placed. See 17 U.S.C. § 401 (Supp. V 1981).

\textsuperscript{64} The requirement of some prior commercial exploitation by the publicity right owner may serve this function in those jurisdictions which require it.

\textsuperscript{65} One might find a dedication to the public domain by some act or statement...
ment of a publicity right by reference to the showing necessary to show abandonment of a copyright.\footnote{66}

The present state of the law accords different durations to the copyright and publicity monopolies. Copyright protection may be afforded to an author only for his life plus fifty years.\footnote{67} In some jurisdictions, publicity rights last only as long as the celebrity's life. In other jurisdictions, publicity rights would seem to have no time limits, in this respect resembling common law copyrights.\footnote{68} Judges in several recent cases have suggested that given the similarities between copyright and publicity rights, it would be appropriate to look to copyright law as a basis for establishing limitations on duration of publicity rights.\footnote{69}

indicating that the celebrity had no objection to others cashing in on the value of his name or likeness. Inaction in response to blatant infringements of publicity rights also might give rise to an inference of public dedication.


\footnote{67}{As to all works "fixed" in a tangible means of expression on or after January 1, 1978, which is the effective date of the new Copyright Act, life plus 50 years is the duration of the copyright monopoly right. See 17 U.S.C. § 302(a) (Supp. V 1981). As to works fixed prior to that time, copyright protection will be afforded in accordance with § 302 unless the work has previously been published and subject to a federal copyright, in which case copyright protection in accordance with the old statutory scheme will be provided, giving the owner a 28 year initial term from the date of publication which can be renewed once for another 28 year period. See 17 U.S.C. §§ 303-304 (Supp. V 1981).}

\footnote{68}{Under the 1909 Copyright Act, there was no federal copyright protection until a work had been "published" with an appropriate copyright notice. Common law copyright protected unpublished works, and was unlimited in duration. The new copyright law provides for federal copyright protection from the time the work is fixed in a tangible means of expression. All common law copyright protection which is equivalent to federal copyright protection is preempted. See 17 U.S.C. § 301 (Supp. V 1981). There may still be a realm for common law copyright as to "unfixed" works such as live performances. These rights would still be perpetual.}

\footnote{69}{See, e.g., Factors Etc., Inc. v. Pro Arts Inc., 652 F.2d 278, 287-88 (2d Cir. 1981) (Mansfield, J., dissenting and agreeing with Chief Justice Bird's suggestion in Lugosi), cert. denied, 456 U.S. 927 (1982); Estate of Presley v. Russen, 513 F. Supp. 1339, 1355 n.10 (D.N.J. 1981) (suggesting that the New Jersey legislature should decide the duration limit, and that the copyright statute might serve as a guideline); Lugosi v. Universal Pictures, 25 Cal. 3d 813, 847, 603 P.2d 425, 446, 160 Cal. Rptr. 323, 344 (1979) (Bird, C.J., dissenting) (suggesting that courts develop a common law limitation on publicity rights by looking to the law of copyright duration). See also California Comment, supra note 2, at 807 (policy support for this limitation). One judge has suggested that there may be a natural limitation on the duration of the monopoly right because, even though there might be a spurt of commercial interest in the celebrity at the time he dies, over time public interest in him is likely to decline, so that exploitation of the monopoly is, therefore, likely to occur at most for only a few years after the celebrity's death. Factors Etc., Inc. v. Pro Arts, Inc., 652 F.2d 278, 287 (2d Cir. 1981) (Mansfield, J., dissenting), cert. denied, 466 U.S. 927 (1982).}
While copyrights and publicity rights are certainly not identical to intellectual property rights,\textsuperscript{70} they are similar in a great

\textsuperscript{70} There are, of course, some differences between copyright and publicity rights. The most obvious difference between a copyright and a publicity right is that the former is a federal statutory right, and the latter—if recognized at all—is a state common law right. The former has a basis in the U.S. Constitution and has long been recognized as a protectible right; the latter is a relatively recent development in the law. Another obvious difference between the two is that copyright attaches only to original works of authorship which are “fixed” in a tangible means of expression (books, sound recordings, and the like), whereas publicity may attach to works which are “unfixed” (such as a human cannonball act or a jazz pianist’s spontaneous composition of music) or to aspects of a “fixed” work which may not be affected by the copyright. One author has pointed out that strong arguments can be made that enforcement of many publicity rights may be preempted by operation of § 301 of the copyright law. Shipley, \textit{Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption}, 66 Cornell L. Rev. 673 (1981). Concerning the appropriation of a live performance, Shipley points out that if filmed or recorded by their owner, the copyright on that film could not be enforced to prevent another person from filming the act from a different perspective. Query then whether courts ought to allow the owner of the act to prevent anyone from filming his act, which thereby would enforce a right broader than that granted by the copyright law. \textit{Id.} at 710-12. Concerning publicity rights which are said to inhere in a copyrighted work, questions of preemption also arise. If there are copyrights covering all of Laurel and Hardy’s movies, does state enforcement of publicity rights in their names, likenesses, costumes, mannerisms, or simulation of voices grant protection which is equivalent to copyright and which should therefore be preempted under § 301? \textit{Id.} at 715-19. The preemption argument has been rejected by publicity cases which have considered it. \textit{See, e.g.}, Factors Etc., Inc. v. Pro Arts, Inc., 496 F. Supp. 1090, 1097-99 (S.D.N.Y. 1980), rev’d on other grounds, 652 F.2d 278 (2d Cir. 1981).

Publicity rights, insofar as they attach to names and likenesses of their owners, do somewhat resemble trademarks, which also encompass names and visual images. Both the trademark and the publicity symbol (the celebrity’s face, for example) may in some sense represent the goodwill associated with the owner of the right. \textit{See Sims, Right of Publicity: Survivability Reconsidered}, 49 Fordham L. Rev. 453, 457-59 (1981). Some celebrities have even obtained trademark rights in their names and likenesses. Elvis Presley’s heirs, for example, have registered his name as a trademark with the approval of the Tennessee Attorney General. \textit{See Op. Tenn. Att’y Gen. No. 473} (1981), 550 Pat. Trademark & Copyright J. (BNA) A-6. Prosser likens recognizing liability for commercial appropriations of a celebrity’s name or likeness to giving the celebrity a kind of trademark right in his name and image. \textit{See W. Prosser, Handbook of the Law of Torts} § 117, at 807 (4th ed. 1971). But there are significant differences in the scope and function of these two types of rights. The scope of trademark rights is narrower in some ways than the scope of publicity rights. To have a trademark right, one must have used it in connection with the sale of merchandise or services, and the trademark right that is acquired extends only to that merchandise or service (or to a narrow band of logical product extensions). Unless registered in accordance with the federal statutory scheme, the trademark right extends only to that geographical area in which the trademark has been used (or is likely to be used by logical extension of growth). Publicity rights, by contrast, need not have been embodied in any particular form for the owner to assert them against those who exploit the publicity right. Also, the publicity owner need not have sold the same kind of product or service in order to have enforceable rights. Publicity rights are also national in scope. Thus, in these respects, publicity rights resemble copyright more than trademarks.
many respects. The similarities between the rights make it appropriate for courts to deal with the first amendment implications of enforcement of these intellectual property rights in the same way.

III. THE PUBLICITY-FIRST AMENDMENT CASES: THE SEARCH FOR A STANDARD

Courts have taken a variety of approaches in assessing first amendment defenses in publicity cases. Often, first amendment questions have not been analyzed in great depth. In the cases in which some attempt was made to fashion a standard for decision, the analysis has not always been very satisfactory, particularly as a guide for resolution of other first amendment privilege claims.

The Supreme Court decision in *Zacchini v. Scripps-Howard Broadcasting Co.* contains one of the most thorough analyses of first amendment issues in publicity cases. The Court concluded that when a television station broadcasted a performer's "entire act," there was no first amendment protection for the broadcast, even if it was shown as part of a news program. In his dissent, Justice Powell raised questions about whether the "entire act" standard was adequate to explain the Court's decision. He was most disturbed, however, at the lack of guidance this standard supplied for the numerous other factual situations in which similar questions might arise.

Using another approach (discussed in subsection III B), one set of publicity-first amendment cases has been decided upon

---

Part of the reason for the difference in the scope of trademark and publicity rights is attributable to the difference in the function of the two types of rights. The function of a trademark is to serve as a designation of the origin of goods and to give the purchaser of goods or services some kind of reassurance of consistency in the level of quality. Publicity rights do not have this function. Generally speaking, a purchaser has no interest in the trademark in and of itself. The purchaser's interest is primarily in the goods or services and only incidentally in the trademark insofar as it provides information. By contrast, merchandise bearing names or images which have publicity value are purchases primarily for the name or image and only incidentally because of the nature of the goods to which they are attached. In this respect, publicity rights are more like copyrights, since the copyrighted matter is also desired for its intrinsic value. Publicity rights are also more like copyrights than trademarks in that one need not show any likelihood of confusion as to the source of the goods or service in order to establish liability against an appropriator of the right.

the courts’ assessment of whether the publicity right appropriated by media was “newsworthy.” The analysis of the newsworthiness issue has often been sparse. As will be shown below, this approach has led to inconsistency in the outcome of some cases. The Supreme Court decision in Zacchini also suggests that more must be considered than just the newsworthiness issue.

Still other cases have attempted to draw principles for resolution of publicity-first amendment claims from privacy-first amendment cases. These efforts, described in subsection III C, have been unsatisfactory primarily because of the very different nature of the interest each tort action is meant to protect. As the Supreme Court decision in Zacchini points out, the standard that may be appropriate to one is distorted when applied to the other.

Some courts faced with first amendment privilege claims have used an approach proposed in a recent law review article\(^7^2\) which focuses on the purpose of the defendant’s use of the publicity right. If “exploitative,” the use has been deemed to be unprivileged. If not exploitative, the use has been said to be permissible. There are several problems with this standard: (1) exploitation is an elusive concept, (2) it would seem to permit more substantial takings of publicity rights than may, in the long run, be desirable, and (3) it is inconsistent with the Supreme Court’s analysis in Zacchini.

Instead, what is needed is a new framework for analysis of first amendment claims in publicity cases that revives Zacchini and provides it with a broader and firmer base than the “entire act” test has provided. Subsection III E demonstrates that Zacchini can be seen as positing that the first amendment does not generally exempt a defendant from the taking of a substantial property interest of a publicity owner, just as the first amendment does not generally exempt a defendant from taking a substantial part of a copyrighted work. Copyright cases have not read Zacchini as narrowly as have the publicity cases. What the Supreme Court had the most trouble articulating in

\(^{72}\) Felcher & Rubin, Privacy, Publicity and the Portrayal of Real People by the Media, 88 Yale L.J. 1577 (1979) [hereinafter cited as Felcher & Rubin, Privacy, Publicity].
Zacchini was a general test for determining how substantial the taking must be to constitute infringement. Section V below contains a proposal for a mechanism to make that determination in all publicity first amendment cases.

A. One Perspective on Zacchini: The "Entire Act" Standard

The only publicity-first amendment case to come before the Supreme Court is Zacchini v. Scripps-Howard Broadcasting Co. Zacchini was by profession a "human cannonball," performing his act at events such as county fairs. No separate admission fee was charged for his show, but the fair grounds were enclosed so that the public did not have free access to the show. A reporter from a local TV station attended the fair, and, contrary to the express wishes of Zacchini, videotaped his human cannonball act. A fifteen-second film clip of the act was shown that night on the evening news. Zacchini sued to recover damages.

The trial court granted summary judgment in the broadcaster's favor. The intermediate appellate court in Ohio reversed on the ground that the first amendment did not privilege the press to violate a performer's publicity rights by showing his entire performance on a news program without recompense. Reversing once again, the Ohio Supreme Court declared that absent some privilege, the broadcaster would be liable for the appropriation of Zacchini's publicity right, but the court thought a finding of privilege to be mandated in this instance by the first amendment because the film clip of the act was part of a news broadcast. The court's decision to grant a privilege to this broadcaster stemmed largely from its doubt that courts could develop a standard for distinguishing between proper and improper appropriations and still adequately protect the journalistic integrity so valued by the first amendment:

The press, if it is to be able to freely report matters of public interest, must be accorded broad latitude in its choice of how

74. The causes of action seem to have included misappropriation, common law copyright infringement, and conversion as well as a publicity infringement. Only the publicity claim was before the Court. Id. at 564.
75. 47 Ohio St. 2d 224, 351 N.E.2d 454 (1976). Only if the broadcaster had appropriated the publicity right for some non-privileged purpose or had intended thereby to harm the publicity owner would there have been no privilege. Id. at 351 N.E.2d at 461.
much it presents of each story or incident, and of the emphasis to be given to such presentation. No fixed standard which would bar the press from reporting or depicting either an entire occurrence or an entire discrete part of a public performance can be formulated which would not unduly restrict the "breathing room" in reporting which freedom of the press requires.\footnote{76}

The difficulty of formulating a rule by which courts could properly decide all first amendment privilege claims raised by the press also troubled the majority of the Zacchini Court. Rather than attempting to formulate a broad rule, the Court announced a rule for the case before it: "Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast performer's entire act without his consent."\footnote{77}

Emphasizing Zacchini's proprietary interest in his act, the Court stated: "The Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner."\footnote{78}

Justice Powell, joined by Justices Brennan and Marshall, dissented. Irritated by the majority's "repeated incantation" of "a single formula"—the taking of an "entire act"—Justice Powell stated his doubt that the Court's standard was clear enough even to resolve Zacchini's case.\footnote{79} In particular, he questioned whether the "entire act" was fifteen seconds in duration. He assumed that the actual firing of the cannon was preceded by a fanfare of some sort, an introduction of the performer, some description of the act and its danger, last-minute checking of the equipment, and entry into the cannon.\footnote{80} These events too, Justice Powell thought, were probably part of the act, and were not captured in the fifteen-second newsclip. Thus, to Justice Powell, the majority standard could not explain the Court's decision in

\footnote{76} Id. at 235, 351 N.E.2d at 461.
\footnote{77} 433 U.S. at 574-75.
\footnote{78} Id. at 575.
\footnote{79} Id. at 579 (Powell, J., dissenting). In only 16 pages the majority opinion refers to Zacchini's "entire act" (or a slight variant of the phrase) 12 times.
\footnote{80} Id. at n.1.
favor of Zacchini.

Justice Powell also argued that the "entire act" standard had little if any precedential value for other publicity cases. Indeed, Zacchini is the only one of the reported publicity-first amendment cases in which an actual performance (or some part of it) was appropriated by a defendant. Thus, it is not surprising that none of the publicity-first amendment cases decided since Zacchini have been decided based on an "entire act" standard.81

B. The "Newsworthiness" Cases

Zacchini was one of several publicity-first amendment cases that raised the issue of whether the taking of a publicity right was justified on account of its intrinsic newsworthiness or the newsworthiness of some event with which it was connected. Zacchini conceded that his appearance at the fair and his act were newsworthy.82 But the "newsworthiness" of the event was not the end of the inquiry. Although recognizing that entertainment enjoys first amendment protection and that entertainment can itself be news, the Zacchini Court did not think that the media had a license to appropriate the entertainment without compensating the performer just because it broadcast the act on a news program.83

Justice Powell was disturbed about this aspect of the Court's decision in Zacchini for several reasons. First, the Court


82. The Ohio Supreme Court perceived the principle of Time Inc. v. Hill, 385 U.S. 374 (1967), and New York Times Co. v. Sullivan, 376 U.S. 254 (1964), to be that "the press has a privilege to report matters of legitimate public interest even though such reports might intrude on matters otherwise private." 47 Ohio St. 2d 224, 234, 351 N.E.2d 454, 461 (1976). The court concluded that this principle should be extended to grant the press a similar privilege when it reported on a person who publicly exploited his talent while trying to keep the benefits private. See Zacchini v. Scripps-Howard Broadcasting Co., Id. at 234, 351 N.E.2d at 461.

83. The Court emphasized that "neither the public nor respondent will be deprived of the benefit of petitioner's performance as long as his commercial stake in his act is appropriately recognized." 433 U.S. at 578.
made no attempt to distinguish this case, in which the report was a routine part of an ordinary news broadcast, from those where there had been unauthorized commercial broadcasts of such occurrences as sporting events. Secondly, Justice Powell worried about fostering media self-censorship. The dissent would have started the first amendment analysis not with a quantitative assessment of the taking of the publicity right, but with an inquiry into the use. He would have held privileged all uses of publicity rights in a news broadcast unless there was a strong showing that the claim of news coverage was a subterfuge for commercial exploitation of the publicity right.

Cases raising "newsworthiness" defenses to publicity claims, both before and after the Zacchini decision, have employed a standard nearer to Justice Powell’s than to that of the Zacchini majority’s opinion. An example is Paulsen v. Personality Posters, Inc., which was decided before Zacchini. A comedian purporting to have entered the presidential race sued to restrain a poster manufacturer from selling a poster of his photograph with the caption "FOR PRESIDENT." Paulsen had licensed a California company to use his name and likeness in an extensive merchandising campaign based on the mock presidential candidate routine. Personality Posters successfully defended against Paulsen’s suit by arguing that the contribution it was making to political debate and the free dissemination of ideas provided it with first amendment protection.

The court discussed Personality Poster’s first amendment defense primarily in connection with the treatment of the New York statutory privacy claim. The court noted that while sometimes it is desirable to construe privacy rights liberally, “troublesome confrontations with constitutionally protected areas of speech and press have also caused our courts to engraft exceptions and restrictions onto the statute to avoid any conflict

84. Id. at 580-81 (Powell, J., dissenting).
85. Id. at 581 (Powell, J., dissenting).
87. Paulsen also claimed an infringement of his common law copyright in the previously unpublished photograph. The facts concerning the circumstances under which the defendant obtained the photograph from Paulsen were sharply disputed. 299 N.Y.S.2d at 504.
88. See supra text accompanying note 21 (concerning New York’s statutory right of privacy).
with the free dissemination of thoughts, ideas, newsworthy events, and matters of public interest." The fact that Personality Posters was selling the posters for profit did not necessarily mean that it was being done "for the purposes of trade" as the statute required. The court viewed Paulsen's mock campaign for the presidency as a newsworthy event, and the fact that he was doing it as a joke did not remove it from constitutional protection. Paulsen had thrust himself into the political arena, which made him fair game for almost any kind of public comment.

Turning from the statutory privacy claim to the right of publicity claim, the court noted that the privacy statute had been enacted to redress injuries for invasion of the individual's right to be let alone, not "to fill gaps in the copyright law or to afford substitute relief for breaches of contract or violations of various other species of property rights." Without taking a position on whether New York would recognize the right of publicity, the court observed that such a right could not be construed as giving prominent persons an exclusive right to control every public use of their name and likeness. In particular, the court stated that the doctrine could have no application where the use was in connection with a matter of public interest.

In contrast, the death of Elvis Presley was indisputably a newsworthy event and of considerably greater interest to the public than the Paulsen mock candidate routine. But new-

89. 299 N.Y.S.2d at 505.
90. The court defined newsworthiness broadly:
   The scope of the subject matter which may be considered of "public interest" or "newsworthy" has been defined in most liberal and far reaching terms. The privilege of enlightening the public is by no means limited to dissemination of news in the sense of current events but extends far beyond to include all types of factual, educational and historical data, or even entertainment and amusement, concerning interesting phases of human activity in general.
299 N.Y.S.2d at 506.
91. Id. at 508.
92. Id. See also Current Audio, Inc. v. RCA Corp., 71 Misc. 2d 831, 337 N.Y.S.2d 949 (N.Y. Sup. Ct. 1972) (publisher of "talking magazine," i.e., a phonograph record with accompanying written material, which featured an "issue" on Elvis Presley which included a press conference with Elvis, was not infringing on an exclusive recording and publicity contract held by RCA; press conference was a newsworthy event); Rosemont Enters., Inc. v. Random House, Inc., 58 Misc. 2d 1, 294 N.Y.S.2d 122 (N.Y. Sup. Ct. 1968) (assignee of Howard Hughes' publicity rights tried to prevent publication of biography on Hughes on the ground that the book was a commercial exploitation of Hughes' publicity rights; relief denied because he was a newsworthy personality and his actions were of public interest), aff'd, 301 N.Y.S.2d 948 (1969).
sworthiness was rejected as a basis for a first amendment exemption in two Elvis Presley memorabilia cases, *Factors Etc., Inc. v. Creative Card Co.*,93 and *Factors Etc., Inc. v. Pro Arts, Inc.*94 Both cases were decided after *Zacchini*. The district court in *Creative Card* summarily dismissed the constitutional claim, saying “[t]here is no constitutional protection for selling posters of Elvis Presley as Elvis Presley.”95 It distinguished *Paulsen* on the ground that “Paulsen’s choice of the political arena for satire made him newsworthy in the first amendment sense.”96 A preliminary injunction was issued in both cases to restrain further manufacture and distribution of Elvis memorabilia by defendants. The Second Circuit Court of Appeals on the *Pro Arts* appeal reiterated the basis upon which the district court in *Creative Card* had distinguished *Paulsen*, and simply announced that it could not accept Pro Arts’ contention that by putting the legend “In Memory 1935-1977” on an enlarged replication of a photograph of Elvis, Pro Arts made the poster “newsworthy.”97 The two federal court decisions, however, seem difficult to reconcile with the *Paulsen* rationale, because it was Paulsen’s mock campaign and not the poster that was found to be newsworthy and hence a subject of expression protected by the first amendment. Similarly, it was the character of Elvis Presley and not the Elvis poster that was newsworthy. 

Two other “newsworthiness” cases adjudicated in the Southern District of New York, both decided after *Zacchini* and both purporting to apply New York law, reached conclusions on the issue of “newsworthiness” which also seem difficult to reconcile. Both *Ali v. Playgirl, Inc.*98 and *Ann-Margret v. High Society Magazine, Inc.*99 dealt with statutory privacy claims as well as common law right of publicity claims. Both cases involved

95. 444 F. Supp. at 285.
96. Id. (footnote omitted). The *Creative Card* decision was incorporated by reference in the district court's decision in *Pro Arts*.
magazine articles that featured representations of celebrities in different states of undress. The picture of the partially nude woman was found to be newsworthy; the picture of the nude man was found not to be newsworthy.

In *Ali*, Playgirl published an article that featured a drawing of a nude man in a boxing ring. The caption referred to the figure as a "Mystery Man," but the facial features resembled Muhammad Ali. A reference to "the Greatest" in the verse next to the drawing was another indication that the drawing was meant to depict Ali. As in *Paulsen*, the "newsworthiness" issue was discussed chiefly in connection with the privacy claim, although the defense was raised with respect to the publicity claim as well. In one of the clearest examples of the obfuscatorv use of the word "clearly," the court conclusively stated that the portrait of Ali was clearly included in the magazine for trade purposes. There was, the court said, "no such informational or newsworthy dimension to defendants' unauthorized use of Ali's likeness." A preliminary injunction was issued to prevent distribution of the magazine issue thus depicting Ali.

In contrast, the first issue of Celebrity Skin Magazine featured five pages of photographs of Ann-Margret as well as her image on the front cover, for which she was paid nothing and to which she had not consented. The actress' privacy claim focused on one of the photographs that showed her partially naked; her publicity claim on the use of all the photographs of her in the issue. As in *Ali*, the "newsworthiness" issue was discussed chiefly in the privacy claim portion of the case. Without directly confronting the *Ali* conclusion with respect to newsworthiness, the court noted that statutory privacy rights may be "severely circumscribed" where a newsworthy element is present. The photograph showing her partially unclothed had come from a film in which she had appeared. That made it "a matter of great interest to many people." While the court did not regard this

100. 447 F. Supp. at 727.
101. Id.
102. *Ali* was described thusly: "unauthorized drawing of the former champion portrayed in the nude, 'accompanied by a plainly fictional and allegedly libellous bit of doggerel' . . . held to be violation of plaintiff's right of privacy." 498 F. Supp. at 404 (quoting 447 F. Supp. at 727).
103. 498 F. Supp. at 405.
104. Id.
as a very important event, "the scope of what constitutes a newsworthy event has been afforded a broad definition and held to include even matters of 'entertainment and amusement, concerning interesting phases of human activity in general.'"\(^{106}\) It was broad enough to give the magazine the right to use her photograph without her permission and without compensating her despite the fact that the accompanying text was of no independent legitimate interest.\(^{106}\)

"Newsworthiness," although sometimes viewed by the courts as an excuse for appropriation of the publicity right of a plaintiff, is not in itself a satisfactory basis for analyzing first amendment claims in publicity cases. For one thing, courts that have relied on this aspect as a determining factor seem to announce their conclusions rather than persuasively reason their

---

105. \textit{Id.}

106. \textit{Id.} at 405 n.8. A somewhat better ground for the decision on the privacy count might have been that she had waived what rights she might have had. At one point the court observed:

\begin{quote}
It has been held that when an individual consents to be viewed in a certain manner during the course of a public performance, such as in a movie, it cannot then be argued that a subsequent faithful reproduction (no allegation has been made that the picture has been altered) of that appearance constitutes an invasion of privacy. \textit{Id.} at 405. But even this is hard to justify in light of her insistence on reaching an agreement with the film makers that no still photographs be made from the film of her performance. \textit{Id.} at 403 n.2.
\end{quote}

In the discussion of the publicity claim the newsworthiness issue as such was not directly mentioned. The court indicated that to the extent publicity rights were recognized in New York, they would only be recognized when the use was made for advertising purposes, or for the purposes of trade. The court stated that it was "well established that simple use in a magazine that is published and sold for profit does not constitute a use for advertising or trade sufficient to make out an actionable claim, even if its 'manner of use and placement was designed to sell the article so that it might be paid for and read.'" \textit{Id.} at 406 (quoting \textit{Oma v. Hillman Periodicals, Inc.}, 281 A.D. 240, 244, 118 N.Y.S.2d 720, 724 (N.Y. App. Div. 1953)). The court concluded that under neither the common law nor the first amendment could the plaintiff assert a publicity claim against the magazine publishers. \textit{Id.}

The court wholly ignored the holding in \textit{Grant v. Esquire, Inc.}, 367 F. Supp. 876 (S.D.N.Y. 1973). See \textit{infra} note 144, which distinguished between magazine articles which use photographs of famous persons as models (which would result in liability) or as part of reports on news events (no liability). It would seem the use by \textit{Celebrity Skin} was more like the former than the latter. See also \textit{Cher v. International Forum, Ltd.}, 213 U.S. P.Q. 96 (C.D. Cal. 1982) (magazines were found liable in damages for, among other things, unauthorized publication of interviews of Cher. "The privilege of using a public figure's picture in connection with an item of news does not extend to commercialization of his personality through a form of treatment distinct from the dissemination of news or information." \textit{Id.} at 102).
way to those conclusions. A more serious problem with the "newsworthiness" cases is that they fail to take into account the extent to which the property interest of the plaintiff may have been impaired by a defendant's action. The Zacchini case would seem to require that there be some assessment of this economic interest.\footnote{107} Just as newspapers and magazines are enjoined from publishing the copyrighted works of others,\footnote{108} perhaps they also ought on occasion to be enjoined from publishing something that constitutes an appropriation of the publicity right of a plaintiff. The problem lies in deciding which occasions warrant such restraints and which do not. This evaluation may be a difficult task, but it can be done.

C. Use of Privacy-First Amendment Standards in Publicity-First Amendment Cases

The Zacchini opinion contains a rather lengthy discussion of the major privacy-first amendment cases. These cases were the principal basis upon which the Ohio Supreme Court decided that the first amendment provided Scripps-Howard with a privilege to appropriate Zacchini's act as a news item. The United States Supreme Court rejected the argument that the privacy-first amendment cases provided a useful analytic framework for publicity-first amendment claims. It did so because publicity is an "entirely different tort" from privacy.\footnote{109} While the author believes that the Supreme Court was correct in rejecting the privacy-first amendment analogies, several courts both before and after Zacchini have analyzed publicity claims within that framework.\footnote{110} Most of the publicity-first amendment cases that have

\footnote{107. It is interesting to note that the "newsworthiness" cases since Zacchini have generally not mentioned that case in connection with their first amendment analyses. The Cher case is rare in even making a reference to Zacchini, and even it does not discuss the holding of the case, let alone explore its implications.}

\footnote{108. See, e.g., New York Times Co. v. United States, 403 U.S. 713, 731 n.1 (1971) (White, J., concurring) ("no one denies that a newspaper can properly be enjoined from publishing the copyrighted works of another.").}

\footnote{109. 433 U.S. at 571.}

\footnote{110. Pre-Zacchini cases relying on the privacy-first amendment cases include Paulsen v. Personality Posters, Inc., 59 Misc. 2d 444, 299 N.Y.S.2d 501 (N.Y. Sup. Ct. 1968), see supra note 86; and Rosemont Enters., Inc. v. Random House, Inc., 58 Misc. 2d 1, 294 N.Y.S.2d 122 (N.Y. Sup. Ct. 1968), aff'd, 301 N.Y. S.2d 948 (1969). In Rosemont, the assignee of the publicity rights of Howard Hughes sued to restrain publication of a biography of Hughes' life, claiming that the book was not being published to disseminate newsworthy information, but to exploit commercially Hughes' namé, likeness, and per-
drawn from the privacy-first amendment cases have been "newsworthiness" cases, but as the *Hicks* case discussed below indicates, other types of cases have drawn from this source as well. These courts have ignored the reasoning of *Zacchini* as to why privacy-first amendment cases should not be treated as determinative in publicity cases.

In *Hicks v. Casablanca Records,* 111 the heirs of Agatha Christie sued to prevent the distribution and marketing of a movie, "Agatha," a fictionalized speculation as to what Ms. Christie might have done during a mysterious eleven-day disappo...
pearance, on the ground that it infringed the right of publicity of the writer and her heirs. Initially taking its cue on publicity rights from *Factors Etc., Inc. v. Pro Arts, Inc.*, the district court said that the right of publicity was a valid property right which was transferable and capable of surviving the death of the owner if commercially exploited during the owner’s life. The court found that Agatha Christie had commercially exploited her own name and likeness to a sufficient degree that, under the reasoning set forth in *Factors*, the right had descended to her heirs.

The question the *Hicks* court then posed itself was whether the right of publicity would attach where the name or likeness was used in connection with a book or movie. The court noted that “more so than posters, bubble gum cards, or some other such ‘merchandise’, books and movies are vehicles through which ideas and opinions are disseminated and, as such, have enjoyed certain constitutional protections, not generally accorded ‘merchandise.’” Despite its earlier assertion of the proprietary nature of publicity rights, in analyzing the constitutional aspect of the case, the court reverted to privacy analogies, “due to the similarity between the nature of the interests protected” by the “intertwined” privacy and publicity rights. It looked to the judicial limitations previously placed on privacy actions to see what limitations should be placed on publicity actions. Among the categories of privileged uses in privacy cases were factual matters of public interest such as news, history, and biography. The same privileges, the court thought, should be “engrafted” on the right of publicity. Even so, the court found that none of these recognized privacy exemptions provided a defense for the defendant.

Yet the court addressed the further question whether the defendant’s fictionalization should be constitutionally protected for other reasons. It balanced “society’s interest in the speech for which protection is sought and the societal, commercial or governmental interests seeking to restrain such speech.”

---

113. 464 F. Supp. at 430.
114. *Id.*
test, the court observed, had been used in New York Times Co. v. Sullivan and Time, Inc. v. Hill. Speech interests were to be protected unless there were countervailing legal or policy reasons. Nowhere in the first amendment analysis was there any mention of the proprietary interest of Christie or her heirs in the commercialization of her name.

It is not surprising that publicity-first amendment cases should look to privacy-first amendment cases such as Time-Hill for guidance. As indicated previously, publicity rights were to some extent an outgrowth of privacy actions. Also, the types of parties generally pitted against one another in litigation in the two types of cases are often the same—an individual complainant against the publisher of a newspaper, magazine, or book—and the issue of the media's right to intrude on the complainant's intangible rights is often presented. Further, Time-Hill is an important case placing first amendment limitations on state tort actions.

The Supreme Court in Zacchini concluded that the first amendment analysis in privacy cases is not applicable in publicity cases. This was accomplished by reviewing the factual circumstances of Time-Hill to emphasize the differences between the two torts. In Time-Hill, a person whose family had been involved in a well-publicized incident in the distant past sued Life Magazine for having connected his family's name to a similar incident depicted in a currently popular play and for having falsely described the family's experience and conduct when the incident originally occurred. The complainant sought damages for humiliation and suffering said to have been caused by this invasion of privacy. Because the linkage between the play and the past incident were matters of public interest, the Court de-

119. The court then discussed at length two New York privacy cases, only one of which it seemed to think was pertinent. The court concluded that as long as the public would not be misled into thinking that a fictionalized account of some part of a person's life was a true account, the speech interests outweighed any publicity interests the person might have. 464 F. Supp. at 433. The two cases relied on were Spahn v. Julian Messner, Inc., 23 A.D.2d 216, 260 N.Y.S.2d 451 (N.Y. App. Div. 1965) (liability imposed for fictionalized biography) and University of Notre Dame Du Lac v. Twentieth Century-Fox Film Corp., 22 A.D.2d 452, 256 N.Y.S.2d 301 (N.Y. App. Div. 1965), aff'd, 15 N.Y.2d 940, 259 N.Y.S.2d 832 (1965) (University of Notre Dame unable to sustain a privacy action since New York's privacy statute applies only to living persons).
termined that Hill could not recover without showing that the Life report was published with knowledge of its falsity or with reckless disregard for the truth.

The Zacchini Court pointed out the differences between the two torts. First, the interest protected in privacy cases was the reputation and feelings of the individual, whereas it was a proprietary interest that was protected in publicity cases. Second, there was an important difference in the impact of enforcement of rights on the dissemination of information. In privacy cases, the complainant generally sought to prevent the public from having any access to certain information, whereas in publicity cases the complainant generally sought only to be in control of decisions as to when, where, and how access is to be obtained. Such a complainant typically wants the public to have access to the information, for public exposure is how his livelihood is earned.

While it may be only in "false light" privacy cases that knowledge of falsity or a reckless disregard for the truth will be required, some sort of malice would still seem to be required to negate first amendment protection in the other two types of true privacy cases—those involving intrusions into the plaintiff's private realm or those involving public disclosure of embarrassing facts about the plaintiff. Furthermore, the two distinctions the Supreme Court made in Zacchini between the "false light" privacy cases and publicity actions seem equally pertinent to distinguish publicity from the other types of privacy actions. Publicity courts should no longer look to privacy-first amendment cases for guidance in determining first amendment defenses for two reasons. First, the entirely different nature of the two types of torts makes such analogues illogical. Second, the Supreme Court in Zacchini has said it is inappropriate to do so.

120. 433 U.S. at 573-74. The Supreme Court cases subsequent to Time-Hill on which Zacchini relied were distinguishable because they involved defamation claims, not appropriations of publicity rights. In fact, none of the cases relied on by Zacchini involved an attempt to broadcast or publish that for which the performer normally gets paid. See also National Bank of Commerce v. Shaklee, 503 F. Supp. 533 (W.D. Tex. 1980) (rejecting constitutional privilege claim based on Time-Hill on the ground that Zacchini required different assessment of issues); Grant v. Esquire, Inc., 367 F. Supp. 876 (S.D.N.Y. 1973) (court stated publicity defendant's reliance on Time-Hill was misplaced).
D. The "Exploitative Purpose" Cases

A recent article by Peter Felcher and Edward Rubin has explored some of the first amendment implications of enforcement of publicity and privacy rights. The article offers a serious critique of the rationales used in many of the cases. The authors claim to have discerned in the morass of the privacy-publicity case law certain principles, which, although not articulated by the courts, explain the decisions the courts actually made. Felcher and Rubin propose a new framework for assessing media liability for appropriations of publicity and privacy rights. Because some courts have looked to Felcher and Rubin's analysis to assist in analyzing first amendment defenses in recent publicity cases, and because their proposal departs so radically from the approach the Supreme Court took in Zacchini, it is important to discuss their thesis at some length.

One of the criticisms Felcher and Rubin make against the law of media portrayals—whether based on libel, privacy, or publicity rationales—is that it fails to incorporate first amendment considerations into the conceptual framework of the tort asserted. They contend that the courts have been treating the first amendment as only an external limitation of the enforcement of these rights. The failure to incorporate first amendment concerns into the definitions of the torts has, in their view, led to distortions and uncertainties in the law.

Felcher and Rubin also complain that first amendment considerations seemed to be undervalued in many of the media portrayal cases. For example, in privacy cases, the balancing test which weighs the interest of the individual in retaining his privacy against the interest of the invader in publication of the offending matter (and the societal interest in both) is inappropriate because it "implies that rights of equal value are involved, when in reality the First Amendment necessarily takes precedence over any competing, non-constitutional policy." The authors express concern about the "chilling effect" that vigorous

121. Felcher & Rubin, Privacy, Publicity, supra note 72.
122. Felcher and Rubin define "media" broadly to include "any medium for transmission of a portrayal to the public—newspapers, magazines, motion pictures, television, posters, and commercial products." They also define "portrayal" as "any generally disseminated representation of a natural person." Id. at 1577 n.1.
123. Id. at 1588.
enforcement of privacy and publicity rights is likely to have on the media, whose copious expenditures to produce these portrayals may thereby be jeopardized.124

Felcher and Rubin create a different framework for the competing social policies involved in these cases. They perceive the primary legal protection of media portrayals to be based on the first amendment guarantees of free speech and free press. They see the first amendment as performing two socially useful functions: maintenance of the integrity of our democratic system by granting citizens the right to engage in non-defamatory speech, which contributes to the public debate on social and political issues, and the communication and enrichment of our cultural experience.125

Felcher and Rubin characterize media portrayals of real people as being of one or more of three types: (1) those that inform, (2) those that entertain, or (3) those designed only to sell a product, which are essentially commercial in nature.126 The first of these categories of portrayal serves the first function of the first amendment, as identified by Felcher and Rubin. The second category serves the second first amendment function. The third serves neither first amendment function, so that media portrayals of the third type are entitled to little if any first amendment protection.127 Countervailing social policies that Felcher and Rubin identify as limiting media portrayals include protection of the freedom of the individual, protection against fraudulent business practices, and encouragement of individual achievement by granting the individual the right to reap the economic rewards of his achievement.128

Their proposal for how media portrayal cases ought to be decided involves two steps. The first step would, in their view, incorporate first amendment considerations into the definition of the tort. This step would focus on the purpose of the portrayal: “if it serves an informative or cultural function, it will be

124. Id. at 1595.
125. Id. at 1596-97. Felcher and Rubin state that this “second function may not be as uniformly accepted as the first, but most commentators include it among the social purposes that the First Amendment serves.” Id.
126. Id. at 1597.
127. Id. at 1597-99.
128. Id. at 1599-1601.
immune from liability; if it serves no such function but merely exploits the individual portrayed, immunity will not be granted.”129 The second step in the analysis proposed by Felcher and Rubin is only to be applied if the use is found to be merely exploitative. If so, the inquiry is whether there has been “some observable injury, of a generally accepted nature.”130 Only if injury is established would the media be found liable for the appropriation.131

129. Id. at 1596. Their first step resembles the inquiry which the dissenting Justice Powell would have the courts begin with in the publicity-first amendment cases. As Felcher and Rubin note at 1601 n.112, the more common method of analysis begins with an examination of the harm to the plaintiff.

130. Id. at 1596.

131. See also Chief Justice Bird’s concurrence in Guglielmi v. Spelling-Goldberg Prods., 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352 (1979). Guglielmi claimed to be the heir of Rudolph Valentino’s publicity rights and to be entitled thereby to compensation for SGP’s production of a fictionalized version of Valentino’s life because of its appropriation of his name, likeness, and personality. The court affirmed the trial court’s dismissal of Guglielmi’s request for relief on the ground that California did not recognize the descendibility of publicity rights. Justice Bird, who disagreed with the court on the descendibility issue, agreed that Guglielmi was not entitled to relief. Her concurrence argues at length that the plaintiff’s publicity rights must yield to first amendment concerns when the appropriated publicity right has been incorporated into a fictionalization of the life of the owner.

Justice Bird found the plaintiff’s characterization of the limited nature of the constitutional guarantees of free expression to be flawed. Free speech is guaranteed not just to facilitate the democratic order but also to protect “our fundamental respect for individual development and self-realization.” Id. at 866, 603 P.2d at 458, 160 Cal. Rptr. at 356. The manner of expression, as well as the content of expression, is protected by the first amendment. Courts have often observed that entertainment is entitled to the same constitutional protection as other types of expression, partly because it is often difficult to draw the line between informing and entertaining, and because entertainment is a mode of self-expression which is valuable in itself. Fiction is as constitutionally protected as political treaties and newspapers. Justice Bird found no constitutional basis for distinguishing between fictional and factual accounts of Valentino’s life. Id. at 868, 603 P.2d at 459, 160 Cal. Rptr. at 357.

The fact that the film was produced for profit and that use of Valentino’s name and likeness significantly increased the value and marketability of the films was of little consequence. Justice Bird replied to the former concern by saying that “[t]he First Amendment is not limited to those who publish without charge.” Id. at 868, 603 P.2d at 459, 160 Cal. Rptr. at 357. As to the latter concern, she pointed out that:

No author should be forced into creating mythological worlds or characters wholly divorced from reality. The right of publicity derived from public prominence does not confer a shield to ward off caricature, parody and satire. Rather, prominence invites creative comment. Surely, the range of free expression would be meaningfully reduced if prominent persons in the present and recent past were forbidden topics for the imaginations of authors of fiction. Id. at 869, 603 P.2d at 460, 160 Cal. Rptr. at 358. Valentino had become a legend, a symbol of the romantic lover, and therefore he was an apt subject for fiction or biography.
Two recent cases that have cited Felcher and Rubin approvingly and have relied in part on their approach to media portrayal cases are Estate of Presley v. Russen and Groucho Marx Productions, Inc. v. Day & Night Co. Despite this approval of the Felcher and Rubin approach, the courts in these cases have, in this author's view, drawn back from the implications of those authors' proposal and applied a standard more consistent with Zacchini and the copyright precedents discussed in section IV below.

A preliminary injunction was granted in Russen to restrain production of "The Big El Show," a musical performance featuring an Elvis Presley look-alike, garbed as Presley, singing Presley songs in a Presley style with a back-up band closely resembling that which accompanied Elvis. It appeared that Russen made every effort to make "The Big El Show" as much like a live performance by Elvis as possible. Some memorabilia and recordings had also been sold in connection with the program.

The Russen court began its discussion of whether the first amendment gave Russen a privilege to appropriate the Elvis estate's publicity rights by summarizing what it perceived to be Felcher and Rubin's thesis: if a portrayal mainly served informative or cultural enrichment purposes, it would generally be immune; if it were primarily commercially exploitative, liability might be imposed. Applying these principles to the case at hand, the court noted that "The Big El Show" did not clearly fall on one side or the other. After careful consideration, the
court concluded that, although the show contained an element of information and entertainment, the show served primarily to exploit Presley's likeness without making a valuable or substantial social contribution.

Initially, it would seem that "The Big El Show" would be more readily classifiable as an "entertainment" than as something "designed only to sell a product," or "essentially commercial in nature." Felcher and Rubin made some effort to expand this third category to distinguish between entertainment that was entertainment (i.e., in the second category), and entertainment that was commercially exploitative (i.e., in the third category):

[a] non-informative entertainment portrayal... must rely on its own creative elements as the basis of its claim of social value; if it is the product of some observable creative effort, it will often be deemed worthy of protection... But a work that merely capitalizes on the attributes of another, without contributing anything substantially unique or new, is likely to be subject to liability.

If this extension of the third category is accepted, then perhaps the Russen decision is consistent with Felcher and Rubin's analytic framework. But one might also say that Russen was contributing something new and unique to popular culture: a live "Elvis" performance that could no longer be supplied by the originator of the style because of his death. To avid Elvis fans—and there are millions of them—no greater cultural achievement would be possible. If this contribution to culture is recognized, then under Felcher and Rubin's analysis, Russen should have been immune.

This author believes that while the Russen court started out with a Felcher and Rubin approach, it ended up applying—and rightly so—a Zacchini approach, by looking at the extent and substantiality of the taking of the publicity rights and deciding that too much of the right had been appropriated for the first amendment to shield the show. At one point the Russen court noted that to some degree the performer in "The Big El Show"...
had, like Scripps-Howard in *Zacchini*, "appropriated the 'very activity . . . by which [Presley] acquired his reputation'" and earned his living. Presley's heirs had the right to reap the economic rewards of Presley's talents, even after his death.

In *Groucho Marx Productions, Inc. v. Day & Night Co.*, the assignee of publicity rights of two of the Marx Brothers and an heir of the same rights of a third sued the producers of the Broadway play "A Day in Hollywood/A Night in the Ukraine" for infringement of the Marx Brothers' publicity rights in their names, likenesses, gestures, and comedy style. Half of the play featured a Marx Brothers' style spoof. Among the defenses raised by Day And Night was that the first amendment protected dramatic performances of literary works such as this play. On summary judgment, the defense was rejected, and Day And Night was held liable for a violation of the Marx Brothers' publicity rights.

Unquestionably, said the Marx court, first amendment concerns must be considered. Quoting *Zacchini* to the effect that entertainment enjoys first amendment protection, the court said "the purpose or function of such entertainment must be scrutinized in determining the scope of the right of publicity" and cited the Felcher and Rubin article. The general rule it found in the publicity-first amendment cases was that if the defendant's works were primarily designed to promote the dissemination of thoughts and ideas, then the right of publicity gives way to the speech interests. But if the defendant's works were largely for commercial purposes, such as the sale of merchandise, the right of publicity would be enforced. Day And Night argued that New York courts in particular had given great weight to first amendment rights in publicity cases involving literary works. But the

140. The complaint included a multitude of other claims, but plaintiff made its summary judgment motion only on the publicity claim.
141. 523 F. Supp. at 492.
court distinguished the major New York precedent on the ground that, unlike this case, it did not involve unauthorized imitations of an entertainer's act.

Day And Night also contended that the contested part of the play was a satirical comment on Hollywood movies of a particular era. It drew an analogy to the protection satire enjoys in copyright law, arguing that its satirical purpose ought to exempt the play from this publicity claim. The court rejected this argument, saying that the defendant's play "does not present a parody on [the Marx Brothers'] parody but instead successfully reproduced the Marx Brothers' own style of humor." The wholesale nature of the appropriation of the Marx Brothers characters overshadowed whatever literary or satiric intent the playwright might have had. Relying on Russen, the court seemed to have been persuaded that Day And Night's use here was primarily a commercially exploitative one, and hence the taking was not privileged.

Had Felcher and Rubin's analysis been adopted and applied more closely in Marx, the plaintiffs probably would not have successfully established their right of publicity claim. The purpose of the use of the dead performers' style was for entertainment. There was clearly a considerable amount of independent creative effort added by the author of the entertainment. Thus, the entertainment value of the performance was only partly attributable to the Marx Brothers' comedy style. It was somewhat disingenuous for the court in Marx to indicate that this case was like Russen, for while there might have been an element of information or entertainment in the "Big El" appropriator's performance, the show was designed basically to exploit the public-

favor of the defendants. Without taking a position as to whether New York courts would or should recognize a common law right of publicity which would survive the death of the owner, the court stated that even if such right existed, no cause of action based on it could be maintained in this case. The appellate division reasoned that "[i]t is enough that the book is a literary work and not simply a disguised commercial advertisement for the sale of goods or services." 427 N.Y.S.2d at 829. Frosch made no mention of the Felcher and Rubin article, but its conclusion is consistent with these authors' position. See also Chief Justice Bird's dissent in Lugosi v. Universal Pictures, 25 Cal. 3d 813, 828-59, 603 P.2d 425, 434-54, 160 Cal. Rptr. 323, 332-52 (1979), discussed supra at note 3 (first amendment does not come into play when the matter complained of is the sale of an image on a kite). Her conclusion is also consistent with the Felcher and Rubin analysis (although she does not cite the article), and with the outcome and analysis in Frosch.
ity rights of the originators without contributing anything original. In fact, the *Marx* court, like the court in *Russen*, began with Felcher and Rubin's approach, but finally applied a *Zacchini* approach, focusing on the wholesale appropriation of valuable attributes of the Marx Brothers' characters.

Although they do not say so, Felcher and Rubin are mounting an indirect attack on the Supreme Court's decision in *Zacchini*. The analytical structure they propose is merely a slightly modified version of the standard proposed by Justice Powell in his *Zacchini* dissent. Applying the Felcher and Rubin test to the facts in *Zacchini*, one would ask first what purpose Scripps-Howard had in broadcasting Zacchini's act. Zacchini conceded that it was a news purpose. Because the newscaster was providing information to the public, it had a purpose that Felcher and Rubin believe deserves immunity. They would agree with Justice Powell that that should be the end of the inquiry.

The simple response to the Felcher and Rubin proposal is that it is not the law. The *Russen* and *Marx* courts, although temporarily drawn off course by the attractiveness of the Felcher and Rubin thesis, in the end recognized this point. It was the property interest of the original creator that was protected, and appropriation of that interest was called "exploitation" to justify the conclusion that there had been theft. The interest in one's name and likeness is protected not only against unauthorized sales of merchandise such as bubble gum cards, puzzles, and T-shirts, but also against other kinds of commercializations of the celebrity such as shows imitating the owner's performance. This approach is consistent with *Zacchini* and with copyright precedent. Entertainers and authors should have no greater rights to appropriate publicity rights than they have to infringe the copyrights.

E. A Second Look at Zacchini: Unauthorized Takings of Substantial Property Interests

There are at least two ways to interpret the *Zacchini* case. One is narrow. It holds that when an "entire act" of a performer has been appropriated by a newscaster (or anybody else), that use is not protected by the first amendment. Many publicity cases since *Zacchini* have seemed to treat the case that way, finding in it no guidance for other publicity-first amendment conflicts, because "entire acts" were not involved. The manner
in which Justice White announced the standard almost seems to invite such treatment. In this author's view, this reading of Zacchini mistakes the tree for the forest.

A broader view of the Zacchini holding would be that it restricts first amendment protection when substantial property interests of the plaintiff have been interfered with or appropriated. The taking of an entire act, then, is one circumstance in which the Supreme Court was able to identify an appropriation of a substantial property interest. Copyright cases have interpreted Zacchini in this broader fashion and have made more frequent and effective use of it than have the publicity-first amendment cases. The problem in publicity cases has been to identify what takings other than of "entire acts" are substantial enough to overcome the first amendment interests asserted by defendants. Publicity cases can seek guidance from copyright cases that have grappled with these same problems. Section V contains a proposal for a mechanism, incorporating copyright

144. One publicity-first amendment case which is consistent with the broader view of what Zacchini held should be discussed, Grant v. Esquire, Inc., 367 F. Supp. 876 (S.D.N.Y. 1973), is a publicity-first amendment case which was decided prior to Zacchini. Although neither cited nor discussed in the Zacchini opinion, of all the publicity cases it is, curiously enough, closest to the spirit and reasoning of Zacchini.

The actor Cary Grant sued Esquire Magazine for using a photograph of his face superimposed on a photograph of a man modeling a cardigan sweater in a somewhat satirical article on men's fashions. Although Grant might have permitted use of his photograph in the 1946 article, that did not mean he had thereby agreed to allow Esquire to use that photograph in any issue, and particularly not where the image was being used to model clothing. The question presented was "whether Esquire had the right to compel Mr. Grant to contribute his face for free." 367 F. Supp. at 878. The situation required an examination of whether granting the privilege in this particular case would serve the purposes which underlie the first amendment. The court observed that the Supreme Court scrutinizes obscenity prosecutions and sets strict libel standards to curtail the risk of inhibiting legitimate expressions. However, risks of this sort were not, in the Grant court's view, present in this case. The court did not see any likelihood of a substantial chilling effect on speech, noting that "there is no shortage of celebrities who—for appropriate fee—are only too happy to lend their faces, names and reputations for exploitations in such enterprises as the one here involved." Id. at 883 (footnote omitted). Furthermore there was no artistic purpose served by the use of Grant's face which would not have been served by the use of other celebrities' faces. The property interest of Grant outweighed the free speech interests asserted by Esquire. Id.

principles set out in section IV, by which the publicity courts can assess the substantiality of the property interests of the plaintiff to be counterbalanced against the speech interests asserted by the defendants.

IV. COPYRIGHT LAW: FIRST AMENDMENT AND FAIR USE DEFENSES

First amendment defenses have been raised with increasing frequency in copyright infringement cases in the past decade. Yet, defense victories based on the first amendment are more uncommon in copyright cases than they are in publicity cases. Courts confronted with first amendment defenses have been careful to protect the property interests of the copyright owners. So long as there have been adequate means—other than by infringement—for the defendant to express himself, first amendment interests have been considered to be fairly protected.\textsuperscript{146}

\textsuperscript{146} First amendment challenges to appropriations of trademark symbols have been treated in much the same way as in copyright cases. One case rejecting such a defense was Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200 (2d Cir. 1979). The star of the defendant's film "Debbie Does Dallas" had worn a uniform like that worn by Dallas Cowboys Cheerleaders (as to which the Cheerleaders had trademark rights) and engaged in sex acts in it during the film. Responding to the first amendment claim, the court said:

No other first amendment doctrine protect defendants' infringement of plaintiff's trademark. That defendants' movie may convey a barely discernible message does not entitle them to appropriate plaintiff's trademark in the process of conveying that message . . . . Plaintiff's trademark is in the nature of a property right, [citations omitted] and as such it need not "yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist." Lloyd Corp. v. Tanner, 407 U.S. 551 (1972). Because there are numerous ways in which defendants may comment on "sexuality in athletics" without infringing plaintiff's trademark, the district court did not encroach upon their first amendment rights in granting a preliminary injunction.

Id. at 206 (parallel citation omitted). See also Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183 (E.D.N.Y. 1972) (rejecting defendant's contention that its poster, closely resembling the Coca-Cola trademarked label on which was written "Enjoy Cocaine" in the distinctive Coca-Cola script, was expression protected by the first amendment).

There are other cases, however, where conflicts between the property rights of a trademark owner and the expressive rights of one who has appropriated the symbol have been resolved without resort to the first amendment as a defense. So long as a defendant's use of the mark does not create a likelihood of public confusion as to the source of sponsorship of the goods or services, there is said to be no trademark infringement. Caricature of a trademark is one such non-infringing use of this type of intellectual property right. See, e.g., Reddy Communications, Inc. v. Environmental Action Found., 477 F. Supp. 936 (D.D.C. 1979) (environmental group's caricature of electric utility symbol in pamphlets, which depicted the utility in a negative light, did not create sufficient poten-
In almost every copyright case in which a first amendment defense has been raised, a "fair use" defense has also been raised.\textsuperscript{147} The result of these cases indicates that if a use is not fair, it probably will not be found to be protected by the first amendment either. Were there no fair use defense, it can be surmised that there would have been even more first amendment defenses raised in copyright cases, some successfully.\textsuperscript{148}

There is considerable controversy about what interplay or overlap exists between "fair use" and first amendment defenses. Most courts and commentators agree there is some overlap, in

\begin{itemize}
\item There is also a fair use defense available in trademark infringement cases. Fair use has a statutory basis in the federal trademark statute. Section 33(b)(4) of the Lanham Act, 15 U.S.C. § 1115 (b)(4) (1976), provides that it shall be a defense to trademark infringement actions if the defendant can establish:
  \begin{itemize}
  \item that the use of the name, term, or device charged to be an infringement is a use, otherwise than as a trade or service mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe to users the goods or services of such party, or their geographic origin . . . .
  \end{itemize}
\end{itemize}


The scope of the fair use defense in trademark law is somewhat narrower than in copyright law, partly because many of the kinds of uses of trademarks which in copyright law might be within the scope of fair use are considered non-infringing without resort to a trademark fair use defense. As mentioned previously, \textit{see supra} note 146, when the defendant's use of a mark is not one which would make it likely that the public would think that the trademark owner sponsored or was the source of the product or service, there is no infringement. \textit{See, e.g.}, Stop the Olympic Prison v. United States Olympic Comm., 207 U.S.P.Q. 237 (S.D.N.Y. 1980) (use of word "Olympic" and the Olympic interlocking ring symbol by non-profit group on poster criticizing proposal to convert the Lake Placid Olympic Village into a prison after the Olympic Games was held not a trademark infringement).

\textit{See also} cases discussed \textit{infra} in subsection D.

\textit{148.} Elsmere Music, Inc. v. National Broadcasting Co., 482 F. Supp. 741 (S.D.N.Y.), \textit{aff'd per curiam}, 623 F.2d 252 (2d Cir. 1980), is a case in which fair use was found but which, in the absence of fair use, might have been found privileged by the first amendment. If any first amendment defense was raised in the case, it is not reflected in the opinions. Elsmere was the owner of the copyrighted song "I Love New York," parts of which performers on NBC's "Saturday Night Live" used in a skit satirizing New York City's campaign to clean up its image. The skit was commenting on a then current political issue. Whatever harm the skit might have wrought would more likely have been due to the sting of the political satire than to the appropriation of the plaintiff's work. \textit{See also} cases discussed \textit{infra} in subsection D.
that "fair use" analysis permits a balancing of first amendment concerns along with concerns about the degree of interference a particular use may cause to the copyright owner's property interest.

Some take the position that the first amendment and fair use defenses in copyright cases are coextensive. Others perceive considerable overlap, although perhaps not complete congruence. Most courts find it unnecessary to map the boundaries of each defense, because the factual circumstances presented to them allowed them to resolve the case without resolving that issue. Some judges and commentators believe that the defenses do have different scopes and have undertaken to delineate what boundaries the defenses should have. One scholar has suggested that the "fair use" defense be considered before the first amendment defense. If the use is found to be fair, it is unnecessary to address the first amendment defense. If the use is found to be unfair, the first amendment defense is not to be upheld unless the defendant's use of the plaintiff's material is found to be necessary to make a contribution to public debate on an issue.

Within section IV, subsection A below briefly describes how courts have analyzed the first amendment defenses in those few cases in which "fair use" defenses were not raised. Subsection B explains what the "fair use" defense is and describes some analytical rules developed over the years to help courts cope with "fair use" issues. Subsection C reviews the cases that suggest a difference between the two defenses but do not undertake to explore the difference. Subsection D reviews the body of law that either incorporates first amendment analysis into its "fair use" analysis or treats the two defenses as coextensive. Subsection E discusses a few cases in which "fair use" has been treated as a preliminary screen for first amendment defense claims. A successful "fair use" defense may allow courts to refrain from addressing the constitutional defense. Subsection F describes how courts and scholars have recently framed the boundaries of the two defenses. This author believes this overall framework may be useful in setting boundaries for these same defenses in publicity cases.

A. The Copyright-First Amendment Cases in Which No "Fair Use" Defense Was Raised

In the few copyright-first amendment cases raising a fair
use defense, it is easily discernible which values courts protect when a conflict is claimed between the first amendment and cop-
yright monopoly rights. In all such cases to date, the property
interests of the copyright owner have prevailed over the asserted
rights to free expression raised by the appropriators. The courts
have expressed their conviction that the first amendment should
not be used as a shield by plagiarists and pirates.

One reason courts have found first amendment defenses un-
persuasive is that implicit in the copyright law is one mechanism
for resolving the potential conflict between the first amendment
and copyright law. The property interest of the copyright owner
does not extend to the ideas in the copyrighted work, but only to
the particular manner of the author’s expression of the ideas. As
long as there are alternative ways—besides an appropriation of
the copyrighted work—to express the ideas, the first amendment
will not preclude enforcement of the property rights.

This idea-expression distinction was the basis for the deci-
sion against McDonald’s first amendment defense in Sid &
Marty Krofft Television Productions, Inc. v. McDonald’s
Corp. Krofft had complained that the “McDonaldland” televi-
sion advertising campaign infringed Kroffts’ copyright in the
“H.R. Pufnstuf” characters used in its children’s television pro-
gram. McDonald’s main defense was that there was too insub-
stantial a similarity between the two works to warrant a finding
of “copying.” At most, McDonald’s argued, what it had taken

149. There has been at least one copyright case in which a claim of conflict be-
tween copyright law and the first amendment has been made by a plaintiff. See Schnap-
per v. Foley, 471 F. Supp. 426 (D.D.C. 1979) (challenge to copyright granted to private
party for government-funded television series concerning the American system of justice
on the ground that the copyright was unconstitutional because it interfered with dissemin-
ation of important information and, therefore, abridged free speech rights; complaint

150. 562 F.2d 1157 (9th Cir. 1977). The first amendment claim appears to have
been an afterthought, for it was raised for the first time on appeal. Id. at 1169 n.14.
McDonald’s appears to have expected to win on the infringement issue alone. While the
constitutional defense could first be raised on appeal, a statutory defense like fair use
could not. However, it may be that McDonald’s chose not to raise a fair use defense in
this case in part because the availability of fair use seems to be somewhat constricted in
Publication, Inc. v. Knight-Ridder Newspapers, Inc., 626 F.2d 1171 (5th Cir. 1980) (ad-
vertisement using TV Guide cover in ad for competing television programming magazine
found to be fair use).
was the "idea" embodied in the H.R. Pufnstuf show and not Krofft’s "expression" of the idea.\textsuperscript{151} Since only the "expression" of an idea could be protected by the copyright, there was no taking of a protected right. The response by the Ninth Circuit was that the jury had resolved that issue against McDonald’s and that there was no clear error in the jury findings.\textsuperscript{152}

The contours of the McDonald’s first amendment defense were rather fuzzy, but, to the extent it could be discerned, the court regarded it as a reargument of the basic infringement point.\textsuperscript{153} The court was satisfied that the "idea-expression" dichotomy adequately accommodated the possible conflict between copyright law and the first amendment. Quoting a prominent copyright scholar, the court stated:

\begin{quote}
[T]he idea-expression line represents an acceptable definitional balance as between copyright and free speech interests. In some degree it encroaches upon freedom of speech in that it abridges the right to reproduce the "expression" of others, but this is justified by the greater public good in the copyright encouragement of creative works. In some degree it encroaches upon the author’s right to control his work in that it renders his "ideas" per se unprotectible, but this is justified by the greater public need for free access to ideas as part of the democratic dialogue.\textsuperscript{154}
\end{quote}

Since McDonald’s could have chosen any number of other ways to express its idea of a fantasyland, its right to free expression was not infringed.\textsuperscript{155} Having chosen instead to copy the plain-

\textsuperscript{151} The "idea" was said to be "a fantasyland filled with diverse and fanciful characters in action." 562 F.2d at 1165.

\textsuperscript{152} Id. at 1167. The court also rejected McDonald’s argument that exact duplication or near-identity rather than substantial similarity was necessary to establish infringement when the copyright was in something other than a dramatic work. Id. at 1167-69.

\textsuperscript{153} McDonald’s seemed to say that because courts had been expanding the scope of first amendment protection in areas such as obscenity and defamation, a similar expansion should be made in the copyright area. The expansion sought by McDonald’s to accommodate satisfactorily first amendment interests would mean that something more than a substantial similarity between the two works would need to be shown by plaintiffs. 562 F.2d at 1169.

\textsuperscript{154} Id. at 1170 (quoting Nimmer, \textit{Does Copyright Abridge The First Amendment Guarantees of Free Speech and Press?}, 17 U.C.L.A. L. Rev. 1180, 1192-93 (1970) [hereinafter cited as Nimmer-UCLA]).

\textsuperscript{155} 562 F.2d at 1171. The court noted that there might be "rare instances" where first amendment considerations would limit copyright protection in expression, but this was not such a case. Id.
tiff's expression, it was liable for the appropriation of the plaintiff's rights.\textsuperscript{166}

The importance of the existence of alternative means of expression was also emphasized in United States v. Bodin.\textsuperscript{167} Bodin asserted that the criminal copyright charges against him should be dismissed because these laws interfered with Bodin's right to disseminate and the public's right to enjoy artistic expression in sound recordings. The court found Bodin's appropriation of the copyrighted recordings to be "piracy" and not an infringement of his expressive rights. "What he seeks is not the freedom to express himself artistically or otherwise, but the right to make exact and identical copies of sound recordings produced by others."\textsuperscript{168} Bodin's right to express himself was adequately protected by the freedom he had to hire singers, musicians, technicians, and others to make his own recordings of the popular songs he was pirating. The public's right to hear the sound recordings was adequately served by the availability of the recordings placed in the market by the producers of the records. Piracy—outright theft—the court asserted, is not protected by the first amendment.\textsuperscript{169}

B. The "Fair Use" Doctrine

Defendants in copyright suits, in order to escape liability for infringement, often claim that they have made only a "fair use"

\textsuperscript{156} Both McDonald's and Krofft licensed use of their characters' images on other products. After McDonald's campaign got underway, Krofft began experiencing difficulties in obtaining new or extending old licensing agreements. The H.R. Pufnstuf characters were even replaced by the McDonaldland characters in the Ice Capades show. \textit{Id.} at 1162.


\textsuperscript{158} 375 F. Supp. at 1267.

\textsuperscript{159} \textit{See also} Dealer Advertising Dev., Inc. v. Barbara Allan Fin. Advertising, Inc., 197 U.S.P.Q. 611 (W.D. Mich. 1977) (constitutional challenge made to a preliminary seizure of allegedly infringing materials summarily dismissed with the statement that the first amendment was not intended to protect infringers of copyrights or misappropriators). \textit{See also} Nimmer-UCLA, \textit{supra} note 155, at 1185 n.19 (discussing Smith v. California, 375 U.S. 259 (1963), in which the state apparently argued that no free speech rights could attach to copyrighted works. The Supreme Court reversed the obscenity conviction without reaching this issue, but it seems most unlikely that the Supreme Court would adopt such an extreme position).
of the copyrighted material. "Fair use" is most frequently defined as "a privilege in others than the owner of a copyright to use the copyrighted material in a reasonable manner without his consent, notwithstanding the monopoly granted to the owner [of the copyright]." Until the effective date of the Copyright Act of 1976, the fair use defense was a kind of equitable exemption from copyright liability. Fair use is now embodied in the copyright statute. The legislative history of the 1976 Act indicates that the fair use provision adopted by Congress was "intended to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way."

160. Generally speaking, any act which interferes with any of the exclusive rights to reproduce, sell, prepare derivative works, perform, and display the copyrighted works granted to authors under 17 U.S.C. § 106 (1976) will be an infringement of the copyright unless there is a specific statutory exemption. The statutory exemptions are found in 17 U.S.C. §§ 107-118 (1976).

161. W. Ball, The Law of Copyright and Literary Property 260 (1944), quoted in, e.g., Wainwright Secs., Inc. v. Wall St. Transcript Corp., 558 F.2d 91, 94 (2d Cir. 1977), cert. denied, 434 U.S. 1014 (1978), and Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc., 626 F.2d 1171, 1174 (5th Cir. 1980). The Register of Copyright Report submitted to the House Judiciary Committee gave this definition of fair use: "broadly speaking it means that a reasonable portion of a copyrighted work may be reproduced without permission when necessary for a legitimate purpose which is not competitive with the copyright owner's market for his work." House Comm. on the Judiciary, Copyright Law Revision, Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 87th Cong., 1st Sess. 24 (1961).

The term "fair use" is sometimes misused to refer to situations in which the similarity between the copyrighted material and the allegedly infringing material is so insubstantial that no infringement can be found, see 3 M. Nimmer, supra note 49, § 13.05 at 13-55 to 13-56, or in which only the ideas in the copyrighted work have been appropriated, see Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 54 (2d Cir.), cert. denied, 298 U.S. 669 (1936). The modern view is that there must first be a determination that an infringement has occurred before any fair use defense is considered.


163. The origin of the fair use doctrine is usually said to be Folsom v. Marsh, 9 F. Cas. 342 (C.D. Mass. 1841) (No. 4,901). Folsom was the publisher of a 12 volume work on George Washington which included a considerable amount of Washington's correspondence. A later publisher of a biography of Washington included a number of the letters in which Folsom claimed a copyright. An infringement was found, but Judge Story's statement of the considerations indicated that, in a proper case, an exemption might be permitted despite the existence of copying:

[W]e must often, in deciding questions of this sort, look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work.

Id. at 348.


Courts and commentators often decry the imprecision of the fair use doctrine. The question of fair use is frequently said to be "the most troublesome in the whole law of copyright," and the doctrine is described as "entirely equitable and . . . so flexible as virtually to defy definition." Each case must be decided on its own facts. Yet, even before the doctrine of fair use was codified in the copyright statute, there was general agreement concerning the factors courts should consider when faced with a claim of fair use and how those factors should be weighed. Notwithstanding the complaints about the "troublesomeness" of fair use, courts do not seem to have experienced a great deal of difficulty in actually deciding the cases, and there is sufficient consensus about the parameters of fair use to give rise to scholarly scoldings when courts on occasion misuse the doctrine.

Report.


169. In the process of refinement of the fair use doctrine, courts and commentators have differed somewhat on how many and which factors are to be considered, and how they are to be phrased. See, e.g., Sobel, Copyright and the First Amendment: A Gathering Storm?, 19 Copyright Law Symp. ASCAP 43, 51-54 (1971), which describes some of the different approaches courts and scholars have taken to delineating what factors should be used in the fair use determination.

170. Nimmer states that the harm or potential harm to the copyright owner's market is the most important factor. 3 M. Nimmer, supra note 49, § 13.05[A][4], at 13-64 to 13-65. There seems to be a consensus that the taking of all or virtually all of a copyrighted work cannot be a fair use. See, e.g., Universal City Studios, Inc. v. Sony Corp. of Am., 659 F.2d 963, 973 (9th Cir. 1981), cert. granted, 102 S. Ct. 2926 (1982); Robert Stigwood Group, Ltd. v. O'Reilly, 346 F. Supp. 376, 384-85 (D. Conn. 1972). But see Williams & Wilkins Co. v. United States, 487 F.2d 1345 (Ct. Cl. 1973), aff'd by an equally divided Court, 420 U.S. 376 (1975) (photocopying of articles from medical journals held fair use).

The preamble of the statutory fair use provision gives some guidance about what kinds of secondary uses of copyrighted material Congress intended should be privileged: "[T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright." But more specific guidance about what is or may be a fair use is given by the remainder of the provision, which outlines the following four factors courts are to use in determining whether the secondary use in any particular case is a fair one:

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
(2) the nature of the copyrighted work;
(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
(4) the effect of the use upon the potential market for or value of the copyrighted work.\footnote{73}

While courts are directed to consider these four factors, the statute and the legislative history indicate that other factors—where pertinent—may also be included in the analysis.\footnote{74} However, these four factors seem to be adequate to decide most cases.\footnote{75}

Purpose of the use is the first factor to consider. While non-profit, educational purposes are more favored than commercial ones, it is a mistake to think that non-commercial motives will shield the user from liability. Fair use defenses have been rejected in many cases in which there were clearly non-profit ac-


\footnote{172. 17 U.S.C. § 107 (1976).}

\footnote{173. \textit{Id.}}

\footnote{174. The statute provides that in deciding whether a use is fair, the factors to be considered "shall include" the four listed. An example of a case in which a factor other than these was considered is Iowa State Univ. Research Found., Inc. v. American Broadcasting Cos., 463 F. Supp. 902 (S.D.N.Y. 1978), aff'd, 621 F.2d 57 (2d Cir. 1980), in which the surreptitious manner employed by the defendant in obtaining the copyrighted material from its proprietor was a factor weighing against a finding of fair use. See infra text accompanying note 233.}

\footnote{175. \textit{See, e.g.,} Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc., 626 F.2d 1171, 1175 n.10 (5th Cir. 1980) ("normally these four factors would govern the analysis").}
tivities under challenge. Additionally, many cases decided in the past several years have emphasized that a defendant may successfully rely on a fair use defense, despite having commercial motives. Nevertheless, it does seem that having a commercial purpose generally cuts against a fair use finding.

The nature of the copyrighted work is a more elusive factor. In many cases this second factor is simply not significant. Still, there are circumstances in which the nature of the work is important. When a teacher makes and distributes multiple copies of a portion of a copyrighted work for classroom use, it will matter whether the work is a textbook designed for class use or another type of printed material having a limited circulation, or material with a broad distribution, such as a newspaper. The former type of material makes a finding of fair use less likely. There is some suggestion in the case law that more leeway may be given to one who takes from a copyrighted work that required merely diligence rather than creativity to produce. More freedom will also be given to reproduce works that are out-of-print.

176. See Wihtol v. Crow, 309 F.2d 777 (8th Cir. 1963) (music teacher's duplication of arrangement of copyrighted song and distribution to choir members was infringement of the copyright); Encyclopedia Britannica Educ. Corp. v. Crooks, 447 F. Supp. 243 (W.D.N.Y. 1978) (non-profit educational service enjoined from videotaping educational programs off the air for rebroadcast within the school system). Non-commercial recordings of television programs on video-recorders have been held not to be a fair use of the copyrighted works in Universal City Studios v. Sony Corp. of Am., 659 F.2d 963 (9th Cir. 1981), cert. granted, 102 S. Ct. 2926 (1982). The Ninth Circuit, relying on Leon Seltzer's analysis in Exemptions and Fair Use in Copyright (1978), took the position that for a use to be fair the appropriator must not use the copyrighted work for the same intrinsic purpose as the work was created to serve. The appropriator must instead make a productive use of the work. 659 F.2d at 969-72.

177. See, e.g., Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc. 626 F.2d 1171, 1175 (5th Cir. 1980) (criticizing district court for having focused its fair use analysis solely on the defendant's commercial motive; publisher of an advertisement for a competing publication allowed to use the cover of the plaintiff's publication in its ads); New York Times Co. v. Roxbury Data Interface, Inc., 434 F. Supp. 217, 221 (D.N.J. 1977) ("[T]he fact that defendants seek to profit financially will not preclude their use from being a fair use"); publisher of an index to the annual New York Times indices found to have made fair use of the material).


179. See, e.g., Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc., 626 F.2d 1171, 1176 (5th Cir. 1980) (fact that TV Guide was a commercial publication neither supported nor hurt Knight-Ridder's fair use claim).

180. Senate Report, supra note 165, at 64.

or otherwise difficult to obtain.\textsuperscript{182}

The amount and substantiality of the taking is frequently a factor of great importance in the fair use analysis. There is unanimity of opinion that "the defense of fair use is never available to immunize copying which . . . is complete or almost verbatim."\textsuperscript{183} Courts often take a quantitative approach, calculating the number of words or percentage of the whole of the copyrighted work which has been appropriated.\textsuperscript{184} It is not, however, simply the quantity, but also the quality of the material taken that is significant; a relatively small quantity will still be considered a "substantial" taking if what has been taken is a valuable portion of the work.\textsuperscript{185} But incidental uses of portions of copyrighted works have often been held to be fair and non-infringing.\textsuperscript{186}

The harm or potential for harm to the plaintiff's market is often said to be the most significant factor in fair use analysis.\textsuperscript{187}

\begin{flushright}
\textsuperscript{182} Senate Report, supra note 165, at 64-65. \\
\textsuperscript{183} 3 M. Nimmer, supra note 49, § 13.05[D][1], at 13-72.5. See also Robert Stigwood Group, Ltd. v. O'Reilly, 346 F. Supp. 376, 384-85 (D. Conn. 1972). \\
\textsuperscript{184} The computations in Meeropol v. Nizer, 560 F.2d 1061 (2d Cir. 1977), cert. denied, 434 U.S. 1013 (1978), discussed at infra note 231, are fairly typical. There, portions of 28 letters from a copyrighted collection were said to have been incorporated verbatim into the defendant's book. The total number of words taken was 1,957. They composed approximately one percent of the defendant's work. \\
\textsuperscript{185} See Wainwright Secs., Inc. v. Wall St. Transcript Corp., 558 F.2d 91 (2d Cir. 1977) (publication of predictive part of financial research report deemed substantial in quality), cert. denied, 434 U.S. 1014 (1978). See also Meeropol v. Nizer, 560 F.2d 1061 (2d Cir. 1977), cert. denied, 434 U.S. 1013 (1978), discussed at infra note 231 (indicating that the issue is not what portion of the defendant's work has been taken from the plaintiff's work, but what proportion of the plaintiff's work has been appropriated by the defendant). A taking of as little as three sentences has been held a sufficient taking to be an infringement. See Henry Holt & Co. v. Liggett & Myers Tobacco Co., 23 F. Supp. 302, 303-04 (E.D. Pa. 1938). \\
\textsuperscript{186} See Italian Book Corp. v. American Broadcasting Cos., 458 F. Supp. 65 (S.D.N.Y. 1978) (challenge to news broadcast of ethnic festival which included band playing plaintiff's music; use of copyrighted work was incidental, and hence a fair use); Mura v. Columbia Broadcasting Sys., Inc., 245 F. Supp. 587 (S.D.N.Y. 1965) (use of hand puppets on Captain Kangaroo show was incidental and non-infringing of copyright); Karll v. Curtis Publishing Co., 39 F. Supp. 836 (E.D. Wisc. 1941) (quotation from Green Bay Packer song printed in magazine article on the football team was incidental and fair use); Broadway Music Corp. v. F-R Publishing Corp., 31 F. Supp. 817 (S.D.N.Y. 1940) (magazine's use of 12 lines from song in commentary on death of an actress was fair use). See also 3 M. Nimmer, supra note 49, § 13.05[D][3], at 13-72.7 to 13-73. \\
\textsuperscript{187} See, e.g., Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc., 626 F.2d 1171, 1177 (5th Cir. 1980) (the harm factor is that "which is widely accepted to be the most important"); 3 M. Nimmer, supra note 49, § 13.05[A][4], at 13-64 to 13-65.
\end{flushright}
The concern of the courts is partly to compensate for direct damage to the plaintiff's economic interests. Awards such as loss of royalties the plaintiff might have received had the defendant not pirated his work are generally given. Judicial concern extends, moreover, to indirect encroachments on the plaintiff's economic interest and seeks to prevent an erosion of the potential value of the work that the plaintiff may not yet have tapped. The fact that a plaintiff who authored a novel has not yet written a screenplay that is in competition with the screenplay of the defendant will not help the infringing defendant; the copyright owner has the exclusive right to adapt his work as well as to reproduce it in its original form. The fact that the plaintiff's copyrighted work may not have been successful, either initially or at the time of the defendant's infringement, does not mean that there is no harm to the plaintiff's interests, because the copyright owner is entitled to the potential for profit from his work as well as any actual profit. Arguments that the defendant's successful use of the copyrighted material will enhance the value of the plaintiff's interest, thereby conferring on the defendant a right to use it for free, are almost universally rejected. Another consideration in assessing the harm factor is "whether unrestricted and widespread conduct of the sort engaged in by the defendant (whether in fact engaged in by the defendant or by others) would result in a substantially adverse impact on the potential market for or value of the plaintiff's work." If so, fair use should not be found.

One scholar has proposed that a comparison be made of the function of each work without regard to the presently existing form of the work as a way to test the effect of the defendant's use on the plaintiff's economic interests. The scope of fair use is said to be "constricted where the two works in issue fulfill the

---

188. See Iowa State Univ. Research Found. v. American Broadcasting Cos., 621 F.2d 57 (2d Cir. 1980) (rejecting ABC's argument that the market for plaintiff's film was enhanced after national telecast of portions of plaintiff's film during ABC's Olympic coverage), discussed at infra note 222; Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Prods., Inc., 479 F. Supp. 351 (N.D. Ga. 1979) (rejecting argument that a successful staging of defendant's light musical based on Gone with the Wind would enhance the demand for one plaintiff's book and another's movie).


same function in terms of actual or potential consumer demand, and expanded where such functions differ.\textsuperscript{191} For example, a news weekly which published with some regularity the predictive portions of financial research reports was fulfilling some portion of the public demand for the longer reports because it was performing the same basic function as the original. This identity of function made it less likely that the research reports would be purchased. Consequently there was harm to plaintiff's market and fair use was not established.\textsuperscript{192}

The first amendment concern for the dissemination of information and the expressive rights of individuals fit into fair use analysis through the assessment of the "purpose of the use" factor. The other three fair use factors deal chiefly with different ways to gauge the degree of impairment of the property rights of the plaintiff.\textsuperscript{193} Thus, as subsections C and D reveal, courts mixing the first amendment and fair use defenses will often blur their discussion of the "purpose of the use" factor into the two defenses.

C. Cases Recognizing Separate but Undefined Roles for First Amendment and Fair Use Defenses in Copyright Cases

In many cases decided in the past decade, alleged infringers have raised first amendment and fair use defenses to bar imposi-

\textsuperscript{191} Id. at 13-71.
\textsuperscript{192} Wainwright Secs., Inc. v. Wall St. Transcript Corp., 558 F.2d 91, 96-97 (2d Cir. 1977), cert. denied, 434 U.S 1014 (1978). Had the same news weekly published some portion of the same financial reports as part of a longer news coverage concerning a particular company or industry on only one or two occasions, the use might have been fair, the functions of the original and the copy being more dissimilar, with the latter no longer serving as a substitute for the former. It was the regularity of the Transcript's use of plaintiff's reports and its intent to provide a summary version of the plaintiff's work that made the use unfair.

\textsuperscript{193} One scholar has argued that the fair use factors can all be viewed as a way to test for economic competition between the plaintiff and the defendant:

[I]n calling upon courts to examine the extent of appropriation, fair use doctrine focuses attention on the degree to which the defendant's work may function as a substitute for that of the plaintiff. An examination of the purpose of the defendant's use may reveal an intention to benefit from the market demand for the appropriated expression. Similarly, consideration of the nature of the copyrighted work can fix the scope of plaintiff's economic interests by indicating the markets that the work may be expected to serve.

Denicola, supra note 171, at 302. The actual or potential harm to the plaintiff's market obviously also measures the economic competition, and the injury or potential injury resulting from the competition.
tion of copyright liability. This section discusses those double-defense cases in which the courts treated the defenses as different, albeit raising similar concerns. Sometimes the fair use discussion has preceded treatment of the first amendment, serving as a basis for the court's conclusion on a brief first amendment analysis. Sometimes the first amendment discussion has been more fully developed, and the fair use discussion abbreviated. Usually, however, the basis for resolution of the fair use and first amendment issues has been the same, focusing on the substantiability of the taking of the plaintiff's property interest.

In addition, while these cases all recognize that there is overlap between the first amendment and fair use defenses, they make no effort to define where the overlap ends or interplay ceases. They merely point to the mystery and leave it for others to resolve.

Wainwright Securities, Inc. v. Wall Street Transcript Corp.\(^\text{194}\) is such a case. Wainwright was a securities firm that periodically produced in-depth financial reports on particular companies for distribution to 900 clients. The Transcript was a weekly newspaper that reported on business and financial news. Its Wall Street Roundup column featured excerpts from institutional research reports. Wainwright sued the Transcript because of the paper's publication of portions of several of Wainwright's reports in this column. The Transcript claimed its use was a fair one, relying heavily on its purpose to use the works as news. The court viewed the fair use doctrine

as a means of balancing the exclusive rights of a copyright holder with the public's interest in dissemination of information affecting areas of universal concern, such as art, science and industry. Put more graphically, the doctrine distinguishes between "a true scholar and a chiseler who infringes a work for personal profit."\(^\text{195}\)

Both the trial and appellate courts regarded the use as unfair because the takings had been substantial, because publication of the excerpts probably had reduced the value of the Wainwright reports, and because the Transcript could prepare its own re-

\(^{194}\) 558 F.2d 91 (2d Cir. 1977).

\(^{195}\) Id. at 94, (quoting Hearings on Bills for the General Revision of Copyright Law Before the House Comm. on the Judiciary, 89th Cong., 1st Sess. 1706 (1966) (statement of Rep. John Schulman)).
ports about these companies so that there was no significant interference with the Transcript's right to disseminate information.

The Transcript's first amendment defense, like its fair use defense, focused on the paper's new purpose in printing the Wainwright excerpts. Although describing the issue of first amendment protections for news appropriations of portions of copyrighted works as a provocative one, the court made no attempt to explore the issue, observing only that "[c]onflicts between interests protected by the first amendment and the copyright laws thus far have been resolved by application of the fair use doctrine."\(^{196}\) What the Transcript had done was to appropriate "almost verbatim the most creative and original aspects of the reports, the financial analyses and predictions, which represent a substantial investment of time, money and labor."\(^{197}\) Its use of Wainwright's reports was not "legitimate coverage of a news event; instead it was, and there is no other way to describe it, chiseling for personal profit."\(^{198}\) Therefore, neither its first amendment nor its fair use claim could be upheld.

Neither the fair use nor the first amendment privilege claims were upheld in *Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Cooperative Productions, Inc.*\(^{199}\) Performance of a musical stage production, *Scarlett Fever*, was enjoined, because it infringed copyrights in the book and movie *Gone With the Wind*. The play was found to be substantially similar to the movie in terms of basic structure, locale, character development, plot, and even dialogue. Showcase argued that its production was a parody or satire of *Gone With the Wind* and, as such, was entitled to fair use protection. Showcase argued that for the parody to work, it had to use characters and scenes similar to those in the original work so that people would know what was being

---

196. *Id.* at 95. *See also* McGraw-Hill, Inc. v. Worth Publishers, Inc., 335 F. Supp. 415 (S.D.N.Y. 1971) (A preliminary injunction against publication of economics textbook was denied because similarities between plaintiff's and defendants' works were attributable to the subject matter and use of common sources. The court did not find it necessary to discuss fair use, except to comment that it seemed to be a colorable defense. "Defendants' First Amendment argument, in so far as it is distinguishable from their claim of fair use, can be dismissed as flying in the face of established law." *Id.* at 422).
197. 558 F.2d at 96.
198. *Id.* at 96-97.
Although the court saw some elements of parody, it found the play, viewed as a whole, to be not a parody, but a musical adaptation, with some comic and serious dramatic elements. But even assuming that the work had been wholly satiric, fair use could not have been found both because too much of the original work was taken and because there was harm to the plaintiffs’ potential market for adaptation. The first amendment discussion was brief. The MGM court did not think that even the broad view of the first amendment for which Showcase argued would give Showcase the right to appropriate such substantial portions of the copyrighted works. Scarlett Fever was not a

200. Showcase argued that no harm would be done to the market because a previous effort to stage a play based on the movie had been unsuccessful and no further efforts were being planned. The court observed that Showcase had demonstrated that a superior production might be successful. MGM or the Mitchell heirs might now be more likely to seek to adapt the work or to authorize adaptation. Therefore, there was harm to their market. Id. at 360-61.

201. Parody was also the basis for similarly unsuccessful first amendment and fair use claims in Walt Disney Prods. v. Air Pirates, 345 F. Supp. 108 (N.D. Cal. 1972), aff’d in part, rev’d in part, 581 F.2d 751 (9th Cir. 1978), cert. denied, 439 U.S. 1132 (1979). Air Pirates had produced a rather bawdy comic book depicting Mickey Mouse and other Disney characters as dope-smoking hippies. The district court concluded that the taking from the copyrighted work was too substantial for fair use to be found, and said its determination of the fair use issue “would seem to resolve the further contention that the First Amendment works to prevent issuance of a preliminary injunction.” 345 F. Supp. at 115. The court of appeals agreed with the district court that more than was necessary of both the conceptual and physical aspects of the Disney characters had been appropriated for the use to be fair satire or to be protected by the first amendment. “[E]xcessive copying precludes fair use.” 581 F.2d at 758-59.

In Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Poster, Inc., 600 F.2d 1184 (5th Cir. 1979), the defendant Scoreboard was the distributor of a poster showing five former Dallas Cowboys cheerleaders in outfits and poses against a backdrop nearly identical to that shown in a copyrighted poster of current cheerleaders. In the Scoreboard poster the women were topless; in the official cheerleader poster the women wore halter tops. In affirming the preliminary injunction granted by the district court, the appeals court said the first amendment was “not a license to trammel on legally recognized rights in intellectual property.” Id. at 1188. It was clear to the court that the Scoreboard poster was intended to imitate the official cheerleader poster “so it could derive parasitic value from it.” Id. As in MGM and Air Pirates, parody was claimed to be the purpose of the imitation of the copyrighted work, and the basis for the fair use claim. Although the court did not review the fair use factors, and hinted that Scoreboard might have prevailed had it taken more care to develop its fair use defense, id., this seems to be another case in which the taking was too substantial to be fair use as parody. Less than near identity would have “conjured up” the official cheerleader poster. See Benny v. Loew’s, Inc. 239 F.2d 532 (9th Cir. 1956), aff’d by an equally divided Court sub nom. Columbia Broadcasting Sys., Inc. v. Loew’s, Inc., 356 U.S. 43 (1958); Walt Disney Prods., Inc. v. Air Pirates, 581 F.2d 751, 756 (9th Cir. 1978), cert. denied, 439 U.S. 1132 (1979).
 satire and did not constitute the sort of critical commentary that would bring the first amendment into play.\(^{202}\)

In Robert Stigwood Group, Ltd. v. O'Reilly,\(^{203}\) a group of Catholic priests who had given more than fifty public performances of slightly modified version of the rock-opera "Jesus Christ Superstar" were sued for infringement of the "Superstar" copyright.\(^{204}\) They defended on both fair use and first amendment grounds. There were three prongs to the O’Reilly group’s first amendment defense. First, they argued they were performing the concert in exercise of their musical ministry rights under the first amendment. Second, they argued that their performance of a revised version of "Superstar" was a protest against the “sick and perverted” version of the gospel depicted in "Superstar" and, because of this, the first amendment gave them a privilege. Third, they argued that they had a right to express themselves through music and lyrics, including that to which Stigwood claimed exclusive rights. The court held that free exercise of religious rights does not permit “wholesale appropriation of another’s literary, artistic and musical works.”\(^{205}\) The court found the protest argument to be similarly unpersuasive. The O’Reilly group had made only a few minor variations on "Superstar"; their work was “outright plagiarism.”\(^{206}\) While they were free to compose their own music, their rights to free expression did not extend to unauthorized performances of a copyrighted work. The fair use defense received less attention from the court, but the “practically verbatim” reproduction of the "Superstar" work was also the basis for denying the fair use exemption claim.

D. Copyright-Fair Use Cases in Which First Amendment Defense Was Said To Be Coextensive with or Incorporated into


\(^{204}\) Another defendant in the action was a non-profit corporation owned and controlled by the priests. This entity received the $300,000 grossed from the performances, with a net income reported to be $220,000. Although none of the priests received a personal share, the money was used to support themselves and their charitable activities.

\(^{205}\) 346 F. Supp. at 383.

\(^{206}\) Id. at 384.
the Fair Use Defense

As the discussion above indicates, some courts are of the opinion that fair use analysis incorporates some first amendment concerns and that a decision on fair use may also resolve the first amendment issue raised separately. None of these cases, however, expressed the idea that fair use and the first amendment were necessarily coextensive; the cases they had been faced with had not required a more precise delineation between the two.

A case in which the court treated the defenses as if they were coextensive was *Keep Thomson Governor Committee v. Citizens For Gallen Committee.*

207 The incumbent Republican's committee sued the Democratic challenger's committee for using part of its copyrighted campaign song in Democratic radio commercials for its candidate. The Republican committee had been using the song in its own political commercials and in connection with political commentary. The Democratic commercials also started with the Republican tune, but most of the three minute commercial was devoted to criticizing the Republican's record. The Democratic committee responded that use was both fair and protected by the first amendment.

Relying on *Wainwright,* the court stated its belief that "[c]onflicts between interests protected by the First Amendment and the copyright laws can be resolved by application of the fair use doctrine." 208 It then reviewed the four fair use factors. The purpose of the Gallen committee's use of the copyright song was non-commercial and part of a political campaign, which clearly implicated first amendment concerns. 209 It noted that the nature of both works were political campaign messages. The amount

---

208. *Id.* at 960 (citing Wainright Secs. Inc. v. Wall St. Transcript Corp., 558 F.2d 91, 95 (2d Cir. 1977), *cert. denied,* 434 U.S. 1014 (1978)).
209. While the first amendment defense was not separately decided by the court, there was considerable discussion of the first amendment implications of the issue prior to the court's fair use analysis. The court indicated that special regard should be taken when political candidates seek to impose restrictions on a rival's campaigning strategy. Political debate must be allowed to be robust and uninhibited to enable citizens to choose among the candidates seeking political office. Had the fair use defense not been adequate to the task in *Thomson,* it appears likely that the court here would have found the Gallen committee's use of the Thomson song to have been protected under the first amendment.
taken was relatively small—fifteen seconds out of a three-minute commercial. And the effect on the plaintiff's market was "nil" because the recordings of the song were still selling.\(^{210}\) It appears that part of the injury the Thomson committee claimed it might suffer was the possible loss of the election by Thomson.\(^{211}\) This loss is not the sort of injury against which the copyright law is meant to protect. The use was, therefore, a fair one. The court did not address the first amendment issue separately.

In a number of other cases, the courts, without saying that the two defenses are coextensive, seem to have opted to treat fair use and first amendment defenses together. In practice, this has meant that the first amendment has been incorporated into the fair use defense. This incorporation had, at least for a time, a distorting effect on both fair use and first amendment analyses because of the overemphasis some of the cases placed on the public interest in the subject matter of the allegedly infringing work.

*Rosemont Enterprises, Inc. v. Random House, Inc.*\(^{212}\) is the case that started the trend of focusing on the "public interest," almost as if it were a separate fair use factor. Criticism of the case has focused on the fact that it gave too little attention to the substantial property interests of copyright owners and gave undue weight to the "public interest" in the infringing work.\(^{213}\) More recently, courts have moved away from the underemphasis on property rights and overemphasis on public interest which *Rosemont* represents.

*Rosemont* was a corporation controlled by Howard Hughes that had purchased the copyright to three *Look* Magazine articles on Howard Hughes. Rosemont complained that a biography of Hughes published by Random House infringed its copyright because substantial portions of the articles had been incorporated into the book. The district court concluded that fair use

\(^{210}\) Id. at 961. This argument is similar to that made in *Triangle*, see infra note 248 and accompanying text, that a competitor's use of its magazine covers might cause the magazine to lose sales. In both cases it would not be the appropriation of the copyrighted material, but the existence of healthy competition that might cause the injury to the plaintiff's interest.

\(^{211}\) 457 F. Supp. at 960.

\(^{212}\) 266 F. Supp. 55 (S.D.N.Y.), rev'd, 366 F.2d 303 (2d Cir. 1966).

had not been established, because in its view much of the copyrighted material had been taken. 214 The court pointed out that the book was not a profound or scholarly biography of Hughes but a popularized journalistic account of his life. It regarded availability of fair use as a defense to be severely restricted if the author’s purpose was neither scholarly nor critical. Random House’s haste in preparing the biography, its decision not to allow the author time and money to conduct his own interviews and do other research, and its encouragement of the author to paraphrase the Look articles, all suggested to the court that Random House had decided it was easier to infringe the articles’ copyright than produce a work of independent effort. Although not assessing the value of the Look articles, the court said “whatever value they had was ‘sensibly diminished’ by the use made of portions of them in the Random House biography . . . .” 215 No free speech rights of Random House were violated, according to the district court, because Random House was free to publish any biography of Hughes that did not infringe the copyrights owned by Rosemont.

As reasonable as the district court’s decision might seem, the Second Circuit took issue with it on almost every point. This court treated the extent of infringement as if it were quite minor. 216 It saw no harm in the appropriation because Look had done nothing with these articles for the previous twelve years and was not receiving any royalties from them. Also, it did not appear that Look would have sued for the infringement alleged here had Rosemont not bought the copyright.

The heart of the disagreement between the court of appeals and the district court concerned the weight to be given to the purpose of the use and nature of the copyrighted work factors. The court of appeals gave much greater weight than had the dis-

214. Rosemont complained of 41 separate instances of copying, arguing that 27% of the first article had been taken and 14% of all three had been used in the book. Random House admitted that 31 lines from the articles had been quoted in the book, and another eight lines had been paraphrased. The district court did not articulate just how much more of the articles it thought had been appropriated by Keats, but it seems to have been convinced more than the conceded amount was taken. See 256 F. Supp. at 61-62.

215. Id. at 64.

216. The court of appeals described the substantiality of the takings to be the two direct quotations and eight paraphrasings which Random House had conceded. 366 F.2d at 306.
strict court to the nature of the works\textsuperscript{217} and much less to the commercial purpose of the defendants, noting that "whether the privilege may justifiably be applied to particular materials turns initially on the nature of the materials, e.g., whether their distribution would serve the public interest in the free dissemination of information and whether their preparation requires some use of prior materials dealing with the same subject matter."\textsuperscript{218} These were the considerations that had led courts to extend fair use to scientific, historical, and biographical works. The appeals court thought that this book should be treated as within the broad category of biographical and historical works. It might be a valuable source of material for future scholars. That it might be a popularized rather than scholarly work and published for commercial gain, the court said, "has no bearing on whether a public benefit may be derived from such a work."\textsuperscript{219}

The public benefit at stake in this case was described thus: "By this preliminary injunction, the public is being deprived of an opportunity to become acquainted with the life of a person endowed with extraordinary talents who, by exercising these talents, made substantial contributions in the fields to which he chose to devote his unique abilities."\textsuperscript{220} Balancing the equities, the court thought the public interest in knowing about Hughes outweighed the copyright interests asserted by Rosement.

Given the breadth of the language in \textit{Rosemont}, it is not surprising that other defendants have sought to use \textit{Rosemont} to argue that the public interest of their work was great enough to make fair rather substantial takings from copyrighted works. One case that so used \textit{Rosemont}, and which has been criticized as much as if not more than \textit{Rosemont}, was \textit{Time Inc. v. Ber-
It was primarily the public interest in the author's theory about the Kennedy assassination that caused the Time court to find that use of more than twenty of the most significant frames from a copyrighted film of the assassination was fair.

Also relying on the Rosemont dicta about public interest in the subject matter of a work, the defendant in Marvin Worth Productions v. Superior Films Corp. argued that its film biography of Lenny Bruce, *Dirtymouth*, ought to be privileged to use portions of Bruce's copyrighted works. Worth had the exclusive license to use material from the copyrighted books in a movie about Bruce and had produced such a movie (as yet undistributed), and sought to prevent Superior Films from distributing *Dirtymouth*. The court was influenced by Rosemont, yet was unpersuaded that application of Rosemont should result in a verdict for Superior Films. The four tests for whether Superior Films' use was fair were said to be:

1. Was there a substantial taking, qualitatively or quantitatively?
2. If there was such a taking, did the taking materially reduce the demand for the original copyrighted property?
3. (As stated in Rosemont, supra), does the distribution of the material serve the public interest in the free dissemination of information? And
4. does the preparation of the material require the use of prior materials dealing with the same subject matter?

The court first found twenty-two instances of infringement of the copyrights and described these as substantial in quality and quantity. Second, it found that distribution of *Dirtymouth* would reduce the demand for Worth's movie on Bruce. In response to Superior Films' most forcefully argued position, that the public was being denied the opportunity to see a film biography of Bruce, the court stated that the non-infringing portions of *Dirtymouth* demonstrated that it was possible to portray Bruce's style, manner, philosophy, and message without using

223. 319 F. Supp. at 1274.
copyrighted material. While recognizing that some use of copyrighted material might be needed for some biographical purposes, the court did not find sufficient need for Superior Films' movie to justify the extent of the taking. "Here what is sought is not restriction of the dissemination of information about Bruce, but reasonable protection of his creative work." 224

Rohauer v. Killiam Shows, Inc. 225 was another case led analytically astray by Rosemont that nonetheless was decided correctly. Killiam was the assignee of the copyright in the 1926 movie The Son of The Sheik. Rohauer held the movie and television rights to the book under the renewal copyright and complained that a television broadcast of the movie infringed his copyright. Killiam and the broadcaster raised fair use defenses to the infringement claim. The court referred to the four fair use factors in Worth, and said, also relying on Rosemont, that the most important was whether the defendant's conduct would serve the public interest in free dissemination of information. The court considered only this factor and discerned no public interest in dissemination of the movie sufficient to justify the infringement. 226

Fortunately, the courts eventually began to back away from the Rosemont public interest focus. The Second Circuit reversed summary judgment on a fair use defense in Meeropol v. Nizer. 227

224. Id. at 1276.
226. Had the Court in Rohauer used the four § 107 factors, discussed supra in text accompanying note 173, it would undoubtedly have reached the same conclusion but by a different route. First, the purpose of Killiam's use of the copyrighted material was identical to that of Rohauer: to make money from television broadcasts of a movie version of a novel. Any purpose to disseminate information or ideas (assuming the movie contained any of either) would be incidental to this main purpose. Second, the nature of the copyrighted work on which Rohauer relied was a novel, adaptation rights for which had been granted at different times to Rohauer and to Killiam's predecessors-in-interest. Third, the taking was substantial, for the whole film was shown. And fourth, there was identifiable harm to Rohauer's market; Killiam alone was reaping the reward of the television broadcast. While Killiam might deserve some portion of the reward since it held the copyright in the movie, nevertheless some portion of the reward was due to the author (or his assignee Rohauer) whose creative effort has produced the basic work. The first, third, and fourth factors weighed heavily against Killiam, and the use was not and should not have been determined to be fair. The court also thought that the demand for Rohauer's work might be diminished by the defendant's showing of the work. 379 F. Supp. at 733 n.9.
The heirs of Julius and Ethel Rosenberg had sued Louis Nizer because of Nizer's use of portions of twenty-eight copyrighted Rosenberg letters in his book, *The Implosion Conspiracy*. Nizer had claimed his use was fair, primarily because there was considerable public interest in the subject matter, and the district court had agreed.

Although the Copyright Act of 1976 had not yet taken effect, the court of appeals looked to the four factors now embodied in section 107 in its fair use analysis.228 Concerning the purpose of the use, the court noted that the book might be described as "a popularized account of the Rosenberg trial lacking substantial scholarship and published for commercial gain . . . ."229 Whether Nizer had included the Rosenberg letters in his book for scholarly or exploitative purposes was a fact in issue for remand.230 The court of appeals made no mention of the importance of allowing Nizer free rein to disseminate his ideas about the Rosenbergs. Instead, *Rosemont* was distinguished because the taking there had been less substantial.231 Nizer had taken almost two thousand words verbatim, whereas in *Rosemont* only two direct quotations had been taken. Concerning the harm to the plaintiff's market, the court observed that the fact that the Rosenberg letters had been out of print for twenty years did not mean that there was no injury to the market for the copyrighted work. The market for republication or for sale of movie rights might be affected by Nizer's book, and

228. *See supra* note 173.

229. 560 F.2d at 1069. The district court, relying on the broad language in *Rosemont*, had regarded the Nizer book as within the category of historical works. 417 F. Supp. at 1209. The court of appeals in *Nizer* did not even mention the nature of the work factor, although in *Rosemont* that had seemed to be the most important consideration.

230. That the letters were quoted out of chronological order, were undated in Nizer's book, and were not edited but quoted in full, also raised questions as to the scholarly purpose of Nizer. 560 F.2d at 1071.

231. The district court had been influenced by the fact that the letters constituted less than one percent of the Nizer book. The Second Circuit emphasized that the substantiality issue must focus on how much of the plaintiff's work has been appropriated, and also observed that the advertising campaign for Nizer's book had emphasized the Rosenberg letters. *Id.* at 1071; *see supra* note 184. *Rosemont* was distinguished on the ground that Random House had taken less from its plaintiff than Nizer had from his, and that Rosemont appeared to have been acting in bad faith in enforcing the copyright. The copyright seemed to have been purchased by Rosemont from the original owner in order to suppress publication of a legitimate biography of Howard Hughes. 560 F.2d at 1069.
this possibility was another issue of fact that should be resolved at trial.

In Iowa State University Research Foundation, Inc. v. American Broadcasting Cos., a fair use defense centered on Rosemont’s focus on the importance of dissemination of information. Iowa State University (ISU) sued American Broadcasting Companies (ABC) and ABC Sports for infringement of its copyright in a student-made film about a wrestler who performed in the 1972 Olympics. On three separate occasions ABC had used portions of the film in sports telecasts concerning the Olympic games. The district court focused much of its fair use discussion on the bad faith manner in which ABC had acquired the copyrighted film. The student who made the film tried to sell it to ABC. ABC borrowed the film while considering the purchase and then made a copy of part of it without informing the student. Because the legend on the film notified ABC of ISU’s copyright, its failure to seek ISU’s permission was another instance of its bad faith. The district court also noted that ABC had “appropriated something of value for which, from the nature and extent of their business, they were well prepared to pay, if necessary . . . .”

ABC’s main argument on appeal was that it was “exempt from liability because the benefits of broad public dissemination outweighed any harm to the owner of the copyright.” Much of the fair use discussion was devoted to the purpose of the use factor. ABC relied heavily on Rosemont and the laudable historical, biographical, and news reporting purposes its broadcasts of the film served. While recognizing that ABC had an unfettered right to use factual information from the film, the Second Circuit did not see a need to appropriate ISU’s expression of that information: “The fair use doctrine is not a license for corporate theft, empowering a court to ignore a copyright whenever it determines the underlying work contains material of possible public importance.” The court of appeals doubted whether ABC would have taken the same position on the issue had another network appropriated portions of one of its telecasts. Because

233. 463 F. Supp. at 905.
234. 621 F.2d at 58.
235. Id. at 61.
the Olympic coverage was a source of commercial gain to ABC, one could also say the that film was used in part for commercial exploitation. On balance, the court did not regard ABC's purpose as favoring ABC's defense.

Additionally, the nature of the copyrighted and the infringing works was regarded by the court as the same, which weighed against a finding of fair use. The substantiality of the takings was apparent from the fact that ABC had used the film every time it had occasion to refer to the career of the wrestler. ABC's argument that its telecast had enhanced rather than harmed ISU's market for the film was unavailing, the court concluding that "ABC did foreclose a significant potential market to Iowa—sale of its film for use on television in connection with the Olympics." A further equitable consideration was ABC's bad faith. In combination, fair use could not be found.

In considering the issues presented by these cases, one author maintains that fair use and the first amendment defenses should be coextensive. In Sobel's opinion, the idea-expression dichotomy, along with an undistorted fair use defense, were adequate to protect against wrongful incursions into the realm of free speech. In his view *Rosemont* and *Time-Geis* had improperly distorted fair use doctrine by focusing on the public interest in unfettered access to the copyrighted material. He believed those cases could be read to privilege appropriations much too substantial to be truly fair uses. If the logic of *Rosemont* and *Time-Geis* was followed to its conclusion, the greater the contribution made by the copyright owner to an understanding of matters of public interest, the less he would be protected. Thus, the writer of a work of great importance would seem to be disqualified from copyright protection altogether. Sobel describes *Rosemont* and *Time-Geis* as authorizing "wholesale theft." While in the short run such a policy might result in more information being disseminated, in the long run, allowing publishers to print and distribute without paying royalties any material that involves a matter of public interest would destroy authors'
incentive to create.\textsuperscript{240} Thus he concludes that "in the long run the interests of authors and publishers in a sound system of copyright protection is a good deal weightier than the public's short-run interest in completely unfettered access to worthwhile literary material."\textsuperscript{241}

E. Copyright-First Amendment Cases in Which Fair Use Was Found And There Was No Need to Reach the First Amendment Claim

In two cases in which both fair use and the first amendment privileges have been asserted, courts have found it unnecessary to reach the first amendment privilege claim because a fair use privilege was found to exist.

In \textit{Italian Book Corp. v. American Broadcasting Cos.},\textsuperscript{242} a television news report on an ethnic festival that included a one-minute segment showing a band playing the plaintiff's music was held privileged as fair use. The fair use analysis focused chiefly on the purpose and harm factors. The court was satisfied that ABC's purpose in showing the band was to inform the public about a newsworthy event. The fact that ABC's crew had not known the band would play when it got there was indicative that there had been no intent to infringe, and the broadcast was not a subterfuge for commercial exploitation. The court pointed out that the House Report on the bill that eventually was enacted as the Copyright Act of 1976 gave as an example of fair use "'the incidental and fortuitous reproduction, in a newsreel or broadcast, of a work located in the scene of an event being reported.'"\textsuperscript{243} Indeed, there was a stipulation between the parties that there had been no damage to the market for the music. Under the circumstances, the use was considered fair.\textsuperscript{244}

\textsuperscript{240} Sobel recognized this might seem an overly dramatic conclusion so he gave an example to illustrate the point. He knew of a teacher who had once written a book for use in junior high school English classes. The book had sold well in the first year, but in the second year sales slowed considerably. The teacher discovered that the reason for the decrease in sales was that English teachers across the country had been making multiple photocopies of the book, thinking this was proper because it was being done for an educational purpose. Her incentive to write any additional educational materials had shrunk significantly. \textit{Id.} at 78-79.

\textsuperscript{241} \textit{Id.} at 79.

\textsuperscript{242} 458 F. Supp. 65 (S.D.N.Y. 1978).

\textsuperscript{243} \textit{Id.} at 71 (quoting House Report, \textit{supra} note 165, at 65).

\textsuperscript{244} The defendant in \textit{Italian Book} relied on \textit{Zachcini}, probably in part because
Although the court found it unnecessary to reach the alternative defense based on the first amendment, it devoted a footnote to a discussion of the relationship between copyright law and the first amendment. The court seemed to agree that the spirit of the first amendment applies to the copyright law and that the courts should not permit a litigant to use the copyright law to interfere with the public's right to know. Copyright law was meant to protect the economic interests of the authors, not to afford a means of censorship. The court also considered the footnote in Zacchini which reflected that copyright law does not abridge the first amendment because it does not restrain the communication of ideas and concepts. The Italian Book court was of the opinion that in a case where compensation and not restraint on communication was at issue, "recourse to the First Amendment may be inappropriate as well as unnecessary." The copyright owner should be compensated, it said, for infringing uses of its protected matter unless the use was a fair and reasonable one, in which case a privilege should be found and no compensation owed. The court declared itself unsure what role the first amendment could perform in resolution of copyright infringement claims.

Another such case was the Fifth Circuit Court of Appeals decision in Triangle Publications Inc. v. Knight-Ridder Newspapers, Inc. Knight-Ridder published a newspaper which had introduced a new Sunday supplement intended to be competitive with TV Guide. As part of the promotional campaign for this supplement, Knight-Ridder caused to be published a number of newspaper and television advertisements that used covers of prior issues of TV Guide magazine and compared the new supplement to its competitor. The publishers of TV Guide sued to restrain the unauthorized use of the copyrighted TV Guide covers in these advertisements.

the television station had been held liable for showing only a fifteen-second clip of the plaintiff's act. The telecast of Italian Book's song had been one minute in length. Italian Book also looked to Zacchini because of its emphasis on the need for the property owner to have control over broadcasts of its work in order to preserve the work's economic value. Without explaining its reasoning, the court in Italian Book said that Zacchini turned on narrow facts, and that under the standard of either the majority or minority opinions of that case, ABC would prevail on its defense. 458 F. Supp. at 71.

245. 433 U.S. at 577-78 n.13.
247. 626 F.2d 1171 (5th Cir. 1980).
The district court in Triangle, which held that the use was not a fair one, focused its fair use analysis only on the “purpose of the use” factor. The Fifth Circuit characterized the district court’s decision on fair use as establishing “what amounts to virtually a per se rule that commercial motive destroys the defense of fair use.” While certainly a commercial motive is pertinent in fair use analysis and does tend to cut against the defense, the court of appeals indicated that the legislative history of the act, as well as the opinions of many courts and commentators, accepts that a commercial motive is not incompatible with a successful assertion of the defense.

The critical factor was the effect of the use on the market or value of the protected matter. The only apparent harm the Knight-Ridder advertisements might have caused to TV Guide would be to persuade some former TV Guide customers to buy the new television supplement, but that would be a harm resulting from healthy commercial competition, not from any wrongful appropriation of the copyrighted work. The Fifth Circuit concluded that a fair use defense had been made out. Because Knight-Ridder’s use of the TV Guide covers was privileged as fair use, the court saw no need to address the first amendment claim.

F. Circumstances in Which a First Amendment Defense Might Be Successful Despite an Unsuccessful Fair Use Defense

Only one court that has entertained both fair use and first

248. The district court believed that the fair use doctrine had developed because of “the importance of permitting non-profit educational institutions to utilize portions of a copyrighted work and the perceived need for the media to be permitted to disseminate criticism, literary or otherwise, of a work submitted for public consumption.” 445 F. Supp. 875, 880 (S.D. Fla. 1978). It observed that the text of § 107 seemed to contrast a commercial purpose with a non-profit educational purpose, the latter being the sort of purpose the section was meant to protect. This court rejected Knight-Ridder’s attempt to elevate its commercial purpose to a form of commercial criticism. The only kinds of criticism the district court thought could be protected as a fair use were literary reviews or the like, “not commercial critiques designed to enhance the marketability of a particular product.” Id. So strong was the taint of the commercial purposes to the district court that it did not even address the other fair use factors.

249. 626 F.2d at 1175. See supra note 178 and accompanying text.

250. Id. Neither the nature of the copyrighted work nor the amount or substantiality of the taking seemed to weigh strongly for or against a finding of fair use. As to the substantiality of the taking, the court pointed out that there was no copying of the schedules or articles of the magazine which the court described as its essence.
amendment defenses in a copyright infringement case has ruled that the defendant's use of copyrighted matter was not a fair use, but was privileged by operation of the first amendment. That was the district court in *Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc.* 251 The court of appeals affirmed the result of the district court but disagreed with the district court's conclusion on fair use. Although the majority ruled it unnecessary to reach the first amendment issue, two judges on the panel wrote separate opinions on the first amendment privilege issue.

The district court had perceived a need for a closer look at the first amendment-copyright conflict questions as a result of the recent extension of first amendment protection to commercial speech. Reviewing *Bates v. State Bar of Arizona,* 252 in which the Supreme Court struck down an Arizona rule prohibiting advertisement of legal services, the district court noted the emphasis placed by the Supreme Court on the important informational aspects of advertising. Advertising can serve both individual and societal interests in facilitating more educated decision making. The comparative advertising in *Triangle* was "clearly undertaken to inform the public that they [sic] should purchase the Miami Herald TV supplement rather than buy TV Guide because it provides more value for the money." 253 It concluded that a literal interpretation of section 106 of the copyright laws 254 would conflict with first amendment interests. 255 Rather than

---

251. 445 F. Supp. 875 (S.D. Fla. 1978), aff'd, 626 F.2d 1171 (5th Cir. 1980).
254. The pertinent portions of 17 U.S.C. § 106 (app. 1976) provide:
Subject to sections 107 through 118, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:
(1) to reproduce the copyrighted work in copies or phonorecords;
(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.
255. A "subtle tension" existed, it said, between copyright law and the interests protected by the first amendment. 445 F. Supp. at 881. The court saw a similarity in the objectives of copyright law and the first amendment: both were "oriented toward the preservation of an atmosphere conducive to the interchange of ideas." Id. at 882. Mostly the two rules are in harmony. But when they are not, the court was sure that "the primacy of the First Amendment mandates that the Copyright Act be deprived of effectuation." Id.
striking down the whole Copyright Act, the district court decided not to enforce section 106 in this instance on the ground that the purposes of the copyright law would not be served by such enforcement.

Judge Tate, concurring in the Fifth Circuit's opinion in *Triangle*, agreed with the majority that in most cases—including this one—proper application of the fair use principle would avoid most potential conflicts between copyright law and the first amendment. However, Judge Tate thought it necessary to state that if fair use had not protected the defendant's use of the copyrighted cover in this case, he would have agreed with the district court that the first amendment would not permit an injunction restraining reproduction of the TV Guide cover in a comparative advertisement.256

Judge Brown257 thought it necessary to address the first amendment privilege issue because he regarded the district court's decision sustaining the privilege to have been in error. Allowing it to stand unchallenged would, he thought, lead to confusion in the Fifth Circuit law of copyright. First, in this case there was actually no tension between the copyright law and the first amendment because the copyright law's fair use doctrine provided an adequate "safety valve" to reconcile the potential for conflict.258 Second, the district court had read the commercial free speech cases too expansively. No free speech rights were absolute. They must be always analyzed in light of other legitimate interests. The Supreme Court had cautioned that commercial speech would likely be given a more limited measure of protection under the first amendment. None of the commercial speech cases had yet involved copyright questions. And there were ways other than infringement for Knight-Ridder to have accomplished its objective. The benefits of comparative advertis-

256. Judge Tate thought Judge Brown wanted to adopt the idea-expression dichotomy as the sole touchstone for determining the sensitive issues of first amendment values. 626 F.2d at 1178-82 (Brown, J., concurring in part and dissenting in part). Judge Tate disagreed, and would have had the court await a case in which the defendant's use of the copyrighted material was a fair use, but where the use seemed necessary to permit adequate expression of the thought to decide what the first amendment standard ought to be.

257. Judge Brown wrote the majority opinion, as well as this separate partially concurring, partially dissenting opinion.

258. 626 F.2d at 1181 (Brown, J., concurring in part and dissenting in part).
ing could as easily have been achieved by verbal references to TV Guide or use of a facsimile of the TV Guide cover, (either of which, the TV Guide publisher had conceded, would have not been subject to challenge) as from use of the actual copyrighted cover.

Third, the district court had ignored the "idea-expression dichotomy," which Judge Brown thought to be essential in an assessment of the first amendment issue. The first amendment is concerned only with restraints on ideas; copyright protects only expression. What was taken by Knight-Ridder was expression. In Judge Brown's view, the "idea" that the TV Guide cover expressed could have been expressed by Knight-Ridder in other ways, and thus the application of the idea-expression test would suggest no first amendment protection for Knight-Ridder's actions.

But even if, as Knight-Ridder argued, this was a case in which idea and expression were inextricably merged, Judge Brown disagreed with the district court's conclusion that any conflict between the copyright protection and the first amendment must be resolved in favor of the first amendment. In Judge Brown's view, when the idea and expression are merged, copyright interests "should nearly always prevail over the generally incidental First Amendment concerns." Judge Brown doubted that the first amendment concerns which attached to the "idea" in the TV Guide covers was "in any way significant." Hence, he would not find that the first amendment privileged Knight-Ridder's use of the copyrighted magazine covers in this instance.

If Triangle was not an appropriate case for a first amendment justification for use of copyrighted material, the question arises as to whether there have been or could be imagined any cases in which a justification would be upheld. Commentators have suggested that there is at least one copyright infringement case in which the first amendment rather than fair use doctrine should have been applied to privilege the taking of a substantial portion of copyrighted material.260

259. Id. at 1182 (Brown, J., concurring in part and dissenting in part).
260. See Denicola, supra note 171, at 300-03; Nimmer-UCLA, supra note 154, at 1200-03; Sobel, supra note 169, at 46-49.
The *Time Inc. v. Bernard Geis Associates* decision has been criticized for having missed this opportunity to make the first amendment a basis for the exemption it permitted. Geis was the publisher of a book on the Kennedy assassination that took issue with the Warren Commission conclusion that there had been only one gunman involved in the shooting. The chief evidence on which Thompson, the author, relied was selected frames from a home movie that recorded the assassination. Time had purchased the film from Zapruder and was the owner of the copyright in it. Portions of twenty-two of the Zapruder film frames were reproduced by charcoal sketch and displayed in the book. The author had obtained copies of the Zapruder film frames from Life Magazine offices by stealth. After obtaining them, he tried unsuccessfully to negotiate with Time Inc. for the right to reproduce the frames in return for a payment of some sort. When Time refused, he decided to use the frames anyway. These aspects of the author's conduct caused the court to be somewhat reluctant to find the use of the Zapruder film to be "fair." Nevertheless, the decisive factor in the *Time-Geis* fair use analysis was the "public interest in having the fullest information available on the murder of President Kennedy."262

Judge Wyatt perceived little if any harm to Time's economic interest if the Geis book were published using portions of the film. He noted that there was no competition between the parties to the litigation, and that the plaintiffs did not sell pictures from the Zapruder film as such. While Time had indicated an intent to use the Zapruder film in future projects, the court regarded as speculative Time's claim that Thompson's use of some of the frames in his book would have a negative effect on the market for those projects. If anything, the court decided the book might enhance the value of the copyrighted work.

One of the scholars who has taken the position that *Time-Geis* was an appropriate case for a first amendment privilege—and an inappropriate case for finding a fair use—is Mel-

---

262. *Id.* at 146 (following *Rosemont*). See supra text accompanying note 221. Although reciting the fair use provision which eventually became § 107 of the Copyright Act, only one of the factors was discussed at any length—that concerning the effect of Thompson's use on the market for the Zapruder film. Much of the scholarly criticism of the court's decision has focused on the unsatisfactory nature of the discussion of the harm factor.
Nimmer believes that the first amendment should not override copyright protection in all instances in which it might be difficult or impossible to distinguish between the "idea" of a work and its "expression." Graphic works, such as paintings, he points out, cannot adequately be described in words or other non-infringing forms of expression. However, that did not mean courts should give anyone who wants to copy such works a first amendment privilege to do so. Indeed, in most such cases copyright interests ought to be protected because balanced against the speech interests in free access is the stronger copyright interest in encouraging creation of such works. Graphic works do not, for the most part, contribute much to democratic dialogue, the most precious of the interests that the first amendment was meant to protect.

However, Nimmer identifies one situation in which free speech interests should outweigh copyright interests: news photographs. Nimmer points out that the news photographs of the My Lai massacre had made a unique contribution to public understanding of that event:

No amount of words describing the "idea" of the massacre could substitute for the public insight gained through the photographs. The photographic expression, not merely the idea, became essential if the public was to fully understand what occurred in that tragic episode. It would be intolerable if the public's comprehension of the full meaning of My Lai could be censored by the copyright owner of the photographs.

A similarly compelling set of circumstances was presented in the Time-Geis case. "[T]he Zapruder film gave the public authoritative answers it desperately sought; answers that no other source could supply with equal credibility." Democratic dialogue was furthered by allowing use of the Zapruder film, and would have

263. Nimmer-UCLA, supra note 154, at 1200-03. This article was incorporated in a slightly modified form into Nimmer's treatise on copyright law. See 1 M. Nimmer, supra note 49, § 1.10.

264. Nimmer notes that there might be a problem in defining when a photograph was a "news photograph." He offers this pragmatic definition: "a photograph is a news photograph only if the event depicted in the photograph, as distinguished from the fact that the photograph was made, is the subject of news stories appearing in newspapers throughout the country." 1 M. Nimmer, supra note 49, § 1.10(C), at 1-84 (footnote omitted).

265. Id. at 1-83.

266. Id. at 1-83 to 1-84.
been diminished if access were not permitted.

Even so, Nimmer believes that the proper remedy was not to make access to the copyrighted work free, but to grant the defendant a license to use the work in exchange for a reasonable royalty.267 Any other result would threaten the commercial viability of the news photograph industry. The first amendment might justify "some limited use of the scalpel, [but] it does not legitimize wholesale amputation in vital copyright areas."268

Nimmer does not discuss the extent to which fair use might act to exempt certain appropriations of copyrighted material which in the absence of fair use as a defense might be found exempt under the first amendment. He does not seem to see an interrelation between the two doctrines. He differentiates between fair use and first amendment privileges thus:

The scope and extent of fair use falls within the discretion of the Congress. The limitations of the First Amendment are imposed upon Congress itself. Fair use, when properly applied, is limited to copying by others which does not materially impair the marketability of the work which is copied. The First Amendment privilege, when appropriate, may be invoked despite the fact that the marketability of the copied work is thereby impaired.269

Nimmer thought *Time-Geis* an unfortunate precedent, because it relied on fair use to justify a very substantial taking that could not but injure the economic value of the copyright. Only the first amendment could justify such a windfall to the defendant.

Another scholar who has attempted to structure a "workable accommodation between the first amendment and the prop-

267. Nimmer proposes that the compulsory license be patterned after that for translations in the Universal Copyright Convention:
* If within one month of the making of the "news photograph" it has not appeared in the newspapers, magazine [sic], or television news programs servicing a given area, then anyone may reproduce the photographs in such area with no obligation other than to pay to the copyright owner of the photograph what the court may determine to equal a reasonable royalty.

Id. at 1-85. Nimmer recognizes that courts may be reluctant to adopt this proposal without legislation. *Id.* at 1-85 to 1-86.

268. *Id.* § 1.10[D], at 1-86.

269. *Id.* at 1-86 to 1-86.1. Nimmer thinks that the failure to distinguish between the fair use and first amendment privileges present a "grave danger" to copyright. *Id.* at 1-86.
erty rights” of the copyright owner is Denicola. Denicola states that the copyright law internally accommodates the first amendment in two ways. First, through the idea-expression distinction copyright law avoids some conflict with the first amendment, which abhors restraints on ideas. Denicola notes that the idea-expression dichotomy is “sometimes fragile,” but he also states that it is “perhaps the most significant internal bulwark provided by copyright law against infringement of first amendment rights.”

A second type of internal accommodation of copyright and first amendment concerns is that which permits certain uses to be declared fair and non-infringing even though some part of the author’s expression, and not just his ideas, are appropriated by another. The fair use doctrine, Denicola states, has the capacity to ease much of the inherent tension between copyright law and the first amendment. In focusing attention on [such things as] the public interest in the flow of information, it seeks to further many of the same interests as the right of free speech. Yet at the same time, in assessing the necessity for a particular type or degree of use, it seeks to insure that copyright interests are not sacrificed needlessly where alternative means of producing the desired result are available.

Even though the fair use doctrine may ease the tension, Denicola believes it “unnecessary and perhaps unwise” to conclude that the fair use doctrine is in essence a constitutional one, derived from or possibly coextensive with the first amendment. Admittedly, there is some overlap between the two doctrines—that is, sometimes fair use will permit a taking which, in the absence of the fair use defense, might be permitted by operation of the first amendment. But, Denicola states that the purposes of both copyright and constitutional law are probably best served if the two doctrines are seen as separable and capable of performing different functions. The problem then is to define where fair use ends and where the first amendment protection, as such, begins. Denicola argues that where the plaintiff makes a

270. Denicola, supra note 171, at 284.
271. Id. at 290. A potential inadequacy of this distinction, Denicola states, may be presented when an idea can be expressed only in a very similar way to that which has been copyrighted. Id. at 292. In cases of this sort, the “copying” is usually permitted.
272. Id. at 297.
273. Id. at 299.
showing that the defendant’s use of his copyrighted material would impair the market value of the work, fair use should not be available. If, however, in such a case the defendant’s work was necessary to inform the public about an issue, then Denicola would argue the first amendment should bar liability for the appropriation. Denicola would have the courts focus not so much on the perceived importance of the issue (as the courts in Rosemont and Time-Geis did) as on the necessity for the taking of plaintiff’s work in order for the defendant to make his contribution to the public debate of the issue. Only if there was a necessity for a taking of that magnitude in order to secure meaningful access to ideas would the defendant’s free speech rights overcome the plaintiff’s property rights.

Like Nimmer, Denicola was of the opinion that only rarely would there be a case presenting circumstances in which such necessity could be shown. Like Nimmer, Denicola thought Time-Geis to be such a rare case. A verbal description of what the Zapruder film showed and how it supported the author’s thesis was simply not sufficient to enable the author to convey his message. It was necessary to include the film frames themselves in the book for the proof to be made. Unlike Nimmer, Denicola did not attempt to carve out a category of circumstances in which necessity for the copyrighted work would most likely be shown. Also unlike Nimmer, Denicola disapproved of the idea of compensating the plaintiff by granting a compulsory license to any defendant who was able to show such a necessity as to bring the first amendment to his defense. That “would require that the defendant purchase his right to speak from the copyright owner—a result hardly in keeping with the concept of ‘free’ speech.”

274. Id. at 310 n.122. Two other authors who disapprove of diluting the copyright owner’s exclusive right to publish his work by allowing extensive takings of copyrighted works on public interest grounds are Perlman and Rhinelander, supra note 171. They focused on the Supreme Court decision in Williams & Wilkins Co. v. United States, 487 F.2d 1345 (Ct. Cl. 1973), aff’d by an equally divided Court, 420 U.S. 376 (1975), which affirmed a ruling that a government library’s photocopying of articles from medical research journals for library users was a fair use of the journals. Perlman and Rhinelander disapproved of both the decision on the merits and the way the courts characterized the issue:

The core propositions of the Court of Claims required a balancing of the advance of medical research stimulated by photocopying against the detriment to the publishers. Structured in this way, the public interest is seen as paramount. If copyright were recognized as a property interest, however, the court,
V. USE OF COPYRIGHT ANALYSIS IN PUBLICITY CASES

A. A Proposal for First Amendment Analysis in Publicity Cases

This author proposes that courts engage in a two-step process in analyzing first amendment claims in publicity cases. The first step would be to assess the substantiality of the property interest asserted by the complainant and the degree of impairment of that interest that would result from the appropriation of the right. The mechanism for this assessment of the property interest would be a slightly modified version of the fair use copyright doctrine. In publicity cases, the factors to be considered would include:

1. the purpose and character of the appropriator's use of the publicity right, including whether such use is of a commercial nature or is for non-profit purposes;
2. the nature of the asserted publicity right;
3. the amount and substantiality of the appropriation of the publicity right by the defendant; and
4. the effect of the defendant's appropriation upon the potential market for or value of the publicity right.

If the defendant's use of the publicity right was found to be fair, in order to find for the libraries, would be required to distinguish between forcing authors and publishers, but not other property owners, to subsidize research.

Pearlman & Rhinelander, supra note 171, at 373. One of the amicus parties in Williams & Wilkins argued that fair use has a constitutional basis under the first and ninth amendments which together protect the right of access to information. Perlman and Rhinelander replied that the copyright system seeks the same end by encouraging the development and dissemination of information through its incentive for publication as the first amendment does by preventing government intervention. The purported conflict is thus really in method not purpose. Id. at 404. They also pointed out that in analogous situations the Supreme Court rejected first amendment right to free access claims. In Miami Herald Publishing Co. v. Tornillo, 418 U.S. 241 (1974), for example, the Supreme Court invalidated a statute giving a candidate for public office a right to reply to any newspaper article critical of him. The candidate wanted to get for free the same amount of space in the newspaper as the critical article had had. In Miami Herald, the Court "refused to permit the government to require a private individual to utilize his property to subsidize the attainment of values associated with the First Amendment." Pearlman & Rhinelander, supra note 171, at 407. Other values than dissemination of information or encouragement of public debate had to be considered. But see Rosenfield, The Constitutional Dimension of "Fair Use" in Copyright Law, 50 Notre Dame Law. 790 (1975) (arguing that the fair use doctrine has a constitutional basis and should have priority over the mere statutory privilege of copyright unless the copyright owner shows the use is not protected as a fair one).
the court would be able to arrive at a conclusion of privilege without having to reach the first amendment claim.\footnote{275}

If fair use was not established, the second step should be to presume that the taking was not privileged by the first amendment because of its impingement on a substantial property right of the plaintiff. This presumption is justifiable because, although the first amendment does extend to entertainment and merchandise as well as to artistic and political expression, the first amendment does not generally require the owner of a significant property interest to give it away for free.\footnote{276} "[N]o social purpose is served by having the defendant get for free some aspect of the plaintiff that would have market value and for which he would normally pay."\footnote{277}

Although the presumption would be that the first amendment would not supply a privilege if there had been such a substantial taking that fair use could not be found, this presumption could be overcome by proof that access to the protected matter was necessary to achieve the dissemination of information and public debate objectives which underlie the first amendment. Proof that the subject matter of the defendant's work is of considerable public interest should be considered if at all only in weighing this necessity for the defendant's use of the plaintiff's right to fulfill the information function. Denicola notes in his analysis of the role of the first amendment in copyright cases that "such factors as the public interest in the sub-

\footnote{275. Two notes written about Zacchini shortly after the Supreme Court decision have also suggested that some sort of fair use analysis might help resolve some publicity infringement claims. \textit{See Comment, Privacy, Appropriation, and the First Amendment: A Human Cannonball's Rather Rough Landing}, 1977 B.Y.U. L. Rev. 579, 606 (1977) (suggestion made but not developed); Note, \textit{Human Cannonballs and the First Amendment: Zacchini v. Scripps-Howard Broadcasting Co.}, 30 Stan. L. Rev. 1185, 1206-08 (1978) (suggesting that an abbreviated fair use analysis might have been applied in Zacchini and perhaps other performance cases to balance the competing interests) [hereinafter cited as Stanford Note].}

\footnote{276. As the court pointed out in Grant v. Esquire, Inc., 367 F. Supp. 876 (S.D.N.Y. 1973), with respect to Esquire's claim of entitlement to use Grant's picture in an article on men's fashions, Esquire was "in no different position than a painter who feels he needs certain pigments and oils to create a contemplated masterpiece . . . . [N]obody would seriously contend that artistic need would authorize a painter to walk into a supply store and help himself to whatever he might require." \textit{Id.} at 883.}

ject matter or the public benefit derived from defendant’s contribution should not be elevated to independent significance.\textsuperscript{278} Public interest as the test for what takings should be allowed distorts intellectual property doctrine and has the unfortunate consequence of rewarding least those who have contributed most.

Two recent publicity cases in which first amendment defenses were decided have come close to suggesting the sort of analytic process that this article proposes. Both discussed fair use within the context of their first amendment analyses. Whether these two courts saw fair use as part of the first amendment defense, as a substitute for it, or as an additional but separate defense was not clarified, these distinctions perhaps being unnecessary because the fair use defenses would not in any event have been successful.

In \textit{Estate of Presley v. Russen},\textsuperscript{279} the court considered that, at least in some publicity cases, there might be a sufficiently strong social interest in “creative comment” about prominent public figures to preclude a publicity action.\textsuperscript{280} This idea was regarded as similar to the fair use doctrine in copyright law. The court even suggested that “[t]he doctrine of fair use may provide guidance as to what types of uses of a name or likeness should be allowed.”\textsuperscript{281} The court’s conclusion of infringement of Presley’s publicity interest seems to have been based largely on Russen’s failure to show that his Elvis show was “intended to or acts as a parody, burlesque, satire or criticism of Elvis Presley.”\textsuperscript{282} The court did not engage in a full-fledged fair use analysis, but the implication of its observations about the situation it was judging make it clear that no fair use could be found.\textsuperscript{283}

\begin{footnotesize}
\begin{enumerate}
\itemsep-0.5pt
\item 278. Denicola, \textit{supra} note 171, at 315.
\item 281. 513 F. Supp. at 1358 n.18.
\item 282. \textit{Id.} at 1359.
\item 283. Had the court developed the fair use analysis, it would most likely have concluded that Russen’s purpose was predominantly a commercial one; that, as in \textit{Zacchini}, the nature of the protected right was the act by which Elvis (and after his death, his heirs by license) had made a substantial portion of his income; that both qualitatively and quantitatively the taking was very substantial; and that there was clear harm to Elvis’ heirs since their right to grant exclusive licenses for such performances was im-
\end{enumerate}
\end{footnotesize}
The defendants in *Groucho Marx Productions, Inc. v. Day & Night Co.* did claim an intent to burlesque or parody Hollywood comedy of the era from which the Marx Brothers as a comedy team emerged. Citing *Russen* as the source for the suggestion, the trial court observed that copyright law and the fair use doctrine might provide useful analogies for courts faced with publicity claims and that "parody, burlesque, satire and critical review might be immune from the right of publicity because of their contribution as entertainment and as a form of literary criticism." As in *Russen*, the court in *Marx* did not engage in a full-dress fair use analysis of Day And Night's appropriation of the Marx Brothers' comedy style. Finding as it did that the intent to criticize or parody was "substantially overshadowed" by the "wholesale appropriation of the Marx Brothers characters," the court did not regard the appropriation as privileged by a kind of fair use doctrine or the first amendment.

paired. Here, as in *Zacchini*, the correctness of the court's decision on the first amendment issue is more convincing after fair use analysis has been completed.

Even assuming there had been some element of parody or criticism of Elvis in the Russen show, it is likely that the substantiality of the taking of Elvis' publicity rights, like that in Jack Benny's parody of the melodrama in *Gaslight* in *Benny v. Loew's, Inc.*, 239 F.2d 532 (9th Cir. 1956), *aff'd by an equally divided court sub nom.* Columbia Broadcasting Sys., Inc. v. Loew's Inc., 356 U.S. 43 (1958), would have been too great for the use to have been a fair one.


285. *Id.* at 493.

286. Again, had the court engaged in a full fair use analysis, it probably would have reached the same conclusion as it did on the first amendment defense. Although there were elements of parody in the play, certainly the court was right in thinking that this was not a parody of the Marx Brothers, but an appropriation of the Marx Brothers' style of parody. The purpose of the use was for entertainment and for profit, neither of which, as such, disqualified Day And Night from the benefit of a fair use, but neither of which favored a fair use finding either. The nature of the protected right was, as in *Russen* and *Zacchini*, the essence of that from which the performers' reputation had derived, in this case the style of comedy created by the Marx Brothers. The amount of the taking was substantial. It consisted not only of a replication of their likenesses, but of their gestures, speaking styles, manner of dress, and comic devices. As in *Russen*, the producers consciously attempted to make it seem as though the Marx Brothers had come to life again and had created a new comedy for public enjoyment. One-half of the play was devoted to the imitation Marx Brothers comedy. The effect on the market was harmful to the Marx heirs since not only might the play compete with Marx Brothers movies, but it might make valueless or less valuable the heirs' right to license others to develop the Marx Brothers' comedy style for plays or movies.

287. 523 F. Supp. at 493.
B. A Re-examination of Zacchini in Light of the Proposal

If a fair use defense had been raised in the Zacchini case, the broadcaster would probably not, for reasons outlined below, have been successful, and the first amendment privilege claim would still have had to have been separately addressed and decided. Yet, an assessment of fair use might have laid a more convincing foundation for the Court’s conclusion on the first amendment defense, perhaps such that even the dissenting Justices might have been satisfied that the first amendment did not bar Zacchini’s claim.

A fair use analysis would have begun where Justice Powell’s dissent in Zacchini would have had the Court begin: with the purpose of the use made of the film by the broadcaster. Despite the fact that the broadcaster was engaged in a commercial enterprise and received revenues from advertisers which supported the news program, it would strain credibility to characterize the use in Zacchini as predominantly commercial. The film clip was used as a routine portion of a regular evening news program and no special or additional revenues came to the broadcaster as a result of the showing of Zacchini’s act on the news.288 It is noteworthy that news reporting is explicitly named in section 107 of the copyright statute as one of the types of uses that may be privileged as a fair use.289 It would seem that the news purpose of the use factor favored granting immunity to the broadcaster.

Justice Powell, along with Felcher and Rubin, would have the first amendment inquiry end here. “[A]bsent a strong showing by the plaintiff that the news broadcast was a subterfuge or cover for private or commercial exploitation,”290 Justice Powell would say the use must be privileged. Fair use analysis, however, would not end here. Even though the purpose of the use in Zacchini would seem to be in the defendant’s favor, this is but one of the factors to be considered. Fair use case law is replete with examples of claims that a concededly socially beneficial use—including a news use—has been made of copyrighted mate-

---

288. The broadcaster did have an obligation to its advertisers, among others, to fill up the evening news program, something which in Geauga County, Ohio, may not always be easy.

289. See supra text accompanying note 172.

290. 433 U.S. at 581 (Powell, J., dissenting).
rial and yet fair use was not found.  

The nature of the protected matter is the second fair use factor to be considered. In Zacchini, the protected matter was the act which Zacchini performed to earn his living. For this reason, the nature of the right factor weighs rather strongly against the broadcaster. Had the protected matter been only the name, or the name and likeness, of the plaintiff, there would have been less at stake as a consequence of the defendant's appropriation.

Third, the substantiality factor also would weigh against granting a privilege to the broadcaster in Zacchini. In copyright law, there is no simple rule as to how much a defendant can safely take as a fair use. But there are some rules to guide the court's judgment on this factor. One is to look not so much to how much of the defendant's work has come from the plaintiff, but how much of the whole of the plaintiff's work has been taken. Another rule is that the taking is measured in qualitative, as well as quantitative, terms. A third rule is that a taking of the whole of a copyrighted work is not a fair use. Although only fifteen seconds in duration, the film clip of Zacchini's act was, if not of its entirety, then surely of its essence. Had the film clip shown Zacchini before the feat gesticulating about what he was about to do or perhaps climbing into the cannonball, it might have been, qualitatively speaking, a less substantial taking. But the film clip showed him being shot out of the cannon—the very thing the audiences were attracted to his performances to see. The taking was, therefore, a substantial one qualitatively.

Finally, the effect of the broadcast on the value of Zacchini's act would also weigh against the finding of fair use. The broadcaster argued that because of the announcer's praise for Zacchini's act and his insistence that people should see the act for themselves, the broadcast would not have harmed Zacchini; in fact, it may have increased attendance at his performances. The Supreme Court responded to the enhance-

291. See, e.g., Wainwright Secs., Inc. v. Wall St. Transcript Corp., 558 F.2d 91 (2d Cir. 1977) (news reporting purpose; fair use not found), cert. denied, 434 U.S. 1014 (1978); Robert Stigwood Group Ltd. v. O'Reilly, 346 F. Supp. 376 (D. Conn. 1972) (criticism and free exercise of religious purposes asserted; fair use not found); Walt Disney Prods. v. Air Pirates, 581 F.2d 751 (9th Cir. 1978) (satirical purpose; fair use not found), cert. denied, 439 U.S. 1132 (1979).
292. See supra notes 183-86 and accompanying text.
293. 433 U.S. at 575 n.12. Similar arguments that secondary uses of copyrighted
ment argument by pointing out that if Zacchini were unable to show some injury to his proprietary interest, that would, of course, preclude recovery of damages, but Zacchini should have the opportunity to make his proof. Zacchini asserted that the news broadcast of his act posed "a substantial threat to the economic value of that performance."\footnote{294} The Supreme Court pointed out that "[m]uch of [the act's] economic value lies in the 'right of exclusive control over the publicity given to its performance'; if the public can see the act free on television, it will be less willing to pay to see it at the fair."\footnote{295} The potential for harm was great because the film—short as it was—showed precisely what the crowds would come to see. Using Nimmer's functionality test, the two works—at least as far as the audience was concerned—fulfilled the same function.

That direct injury to the plaintiff's interest was caused by this defendant's action is not the only consideration in this fourth factor's harm analysis. The court must also inquire about the injury that might result if others similarly situated to the defendant were allowed to do the same thing. To say that Scripps-Howard would be privileged to broadcast Zacchini's act on the local evening news would be to say that all television stations could do the same. Seen in this light, the substantiality of the threat to Zacchini's economic interest is more apparent.

While these four factors would most likely be sufficient in publicity as well as in copyright law to resolve the fair use issue presented in most cases, other equitable considerations may be appropriate in some instances. The surreptitious manner in which the reporter for Scripps-Howard shot the film after having been told not to film the act by Zacchini also would weigh against a finding of fair use by Scripps-Howard, just as similar devious actions by the defendants in \textit{Iowa State} and \textit{Time-Geis...}
weighed against fair use findings in those copyright cases.\textsuperscript{296}

A review of the fair use analysis above reveals that only the purpose of the use factor favors granting Scripps-Howard a privilege. The other factors all weigh against Scripps-Howard. While some cases might present more difficult fair use problems, Zacchini is a case in which the use was clearly not fair. A substantial property interest of Zacchini was appropriated by Scripps-Howard.\textsuperscript{297}

Following the standard proposed by this article, there would be a presumption that the Scripps-Howard appropriation, since it was not a fair use, would not be privileged by the first amendment. The question then would be whether there was any necessity for that taking by Scripps-Howard in order to further the first amendment access to information interests. The Supreme Court observed that not granting Scripps-Howard the right to show Zacchini's act for free would not mean that the public would be unable to see the act. For one thing, Zacchini was not seeking injunctive relief against the station, only damages. But even if he had sought to restrain the broadcast, other parts of the opinion suggest that first amendment concerns might have been adequately safeguarded by allowing Scripps-Howard to report verbally on Zacchini and his act. Or perhaps a shorter film clip or a film clip of the prelude to the cannon blast or a still photograph of the act might have been permitted without liability.

Although the Supreme Court in Zacchini recognized that entertainment is protected by the first amendment, it did not

\textsuperscript{296} See supra notes 174 & 231.

\textsuperscript{297} One student commentator would have reduced the fair use analysis to two factors: "(1) the purpose of the infringing expression; and (2) the scope of the infringement and the resulting degree of economic injury to the artist." Stanford Note, supra note 275, at 1206. The Note's author did not find the purpose test to be very helpful in making distinctions about news reports featuring performances such as Zacchini's, and did not say in which direction he concluded this factor tipped in the balancing process. His analysis of the harm factor was somewhat confusing. The author regarded it as necessary to have a "precise determination of economic disincentive" which defendant's use would cause to the plaintiff's interest, id. at 1206, but he did not draw upon the fair use harm analysis rules cited above. The author noted, though, that Zacchini's act was his livelihood and the telecast might have diminished attendance at his performances. Id. at 1208. The author did not state a conclusion as to whether the Supreme Court would (or should) have reached the same result using a fair use analysis as it did through the first amendment analysis.
seem to regard the societal need for news reports on entertainment to be as compelling as news reports on political events and the like. On the whole, then, there does not seem to have been any necessity for the appropriation of Zacchini's act to serve first amendment purposes. Under the standard proposed by this article, Scripps-Howard would not be exempt from liability to Zacchini based on its free speech rights.

C. Fair Use and First Amendment Analysis in Other Publicity Cases

Adoption of a fair use analysis as a useful first step in first amendment analysis in publicity cases would permit courts to avoid unnecessary decisions on constitutional defenses. Generally, courts prefer to render decisions on other than constitutional grounds if possible. Adoption of a fair use defense in publicity actions may also discourage publicity defendants from raising first amendment defenses in some cases since another defense would be available that would permit consideration of the factors defendants often raise in support of first amendment claims.

*Hicks v. Casablanca Records* is one case in which a fair use defense might have been upheld without having to address the first amendment claim. While fair use analysis usually begins with the purpose of the use factor, in this case it may be better first to examine what Casablanca appropriated. Unfortunately, the *Hicks* court did not clarify what publicity right it thought might have been interfered with. Analysis of the other fair use factors must be grounded upon a clear understanding of the nature of the right appropriated by the defendant.

Certainly Ms. Christie's name was appropriated. Her first name was the title of the book and movie. Her last name was prominently featured in the body of the movie, as well as in the advertisements and promotional materials. Most courts considering the issue have treated a person's name as a publicity right.

298. See, e.g., *Ashwander v. Tennessee Valley Auth.*, 297 U.S. 288, 341-56 (1936) (Brandeis, J., concurring) ("The Court will not pass upon a constitutional question although properly presented by the record, if there is also present some other ground upon which the case may be disposed of." Id. at 347).
in which he and his heirs have a property interest. However, that Ms. Christie lived in England, that she had a husband named Archibald, that her husband had a mistress, that she disappeared and then returned to her ordinary life after eleven days, and various other aspects of her personal history which were incorporated into the movie would seem to be historical facts concerning which neither she nor her heirs would have any exclusive publicity rights.

Ms. Christie's "identity" as a famous mystery writer was also appropriated. Whether this is also within the scope of her publicity rights is less clear, and the court does not appear to take a position on the issue. One might argue that her identity as a mystery writer was another historical fact in which the heirs can have no exclusive interest. But the better argument would be that her identity as a mystery writer was inextricably linked with the appropriation of her name. Had the name alone been appropriated and applied to a character having a very different personal history, no publicity claim would have been viable. It was because of the movie producer's desire to appropriate her persona as a very clever deviser of murder plots that her name and not that of a fictitious female mystery writer was used.

There was some evidence that Ms. Christie cultivated somewhat the commercial value of her name at least in connection with sales of her books. There was also evidence that she shied away from publicity and led, for the most part, a rather reclusive life. Certainly she did not engage in anything like the commercial exploitation of her name and likeness that public personalities such as Elvis Presley have done. Her name and likeness, as such, do not seem to have been sources of her economic interests. Thus the nature of the right appropriated seems not to weigh against a fair use finding.

Concerning the amount and substantiality of the taking, it

300. See supra text accompanying notes 37-50.
301. The court's opinion says nothing about whether it considered these facts to be within the scope of the publicity rights. In copyright law, no copyright protection is afforded to facts contained in a copyrighted work even if the author was the first to uncover or theorize about them. See Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 979 (2d Cir. 1980). There is one publicity case, Uhlaender v. Henricksen, 316 F. Supp. 1277 (D. Minn. 1970), in which facts in the public domain (statistics on baseball players' batting averages, et al.) coupled with the use of name and likeness have been held to be an infringement of a publicity right.
is notable that only her name and identity as a famous writer were appropriated.\textsuperscript{302} This taking was less in amount than the takings in any other of the publicity-first amendment cases considered in section III.\textsuperscript{303} While Ms. Christie and her heirs had a substantial enough property interest in her name so that not every taking of it would be immune from a publicity action,\textsuperscript{304} the taking of it here was not so substantial as to weigh strongly against a finding of fair use.\textsuperscript{305}

Casablanca’s purpose in using Ms. Christie’s name in the movie was partly to enhance the entertainment value of the film,

---

\textsuperscript{302} There was no claim in Hicks that both Ms. Christie’s name and likeness were taken by Casablanca. If both had been taken, the taking would seem to have been more substantial. However, Ms. Christie’s appearance—unlike her name—was not a familiar one to the public and had no intrinsic commercial value. Since it is unlikely that she was as comely as Vanessa Redgrave, it is probable that use of her likeness would not have added to the prospects for commercial success of the movie.

\textsuperscript{303} There are several cases in which publicity-type claims have failed where the appropriation was less than that in Hicks. See Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711 (9th Cir. 1970) (summary judgment against Ms. Sinatra, who complained that her manner of performance of a popular song had been imitated), cert. denied, 402 U.S. 906 (1971); Booth v. Colgate-Palmolive Co., 362 F. Supp. 343 (S.D.N.Y. 1973) (TV actress denied right to recover for imitation of her voice in defendant’s commercial).

\textsuperscript{304} An appropriation of Ms. Christie’s name and identity as a mystery writer for a board game sold by toy manufacturers or an appropriation as the nom de plume for another mystery writer might still be actionable.

\textsuperscript{305} One might also argue that the taking of Ms. Christie’s identity as a mystery writer was more akin to the taking of the title of a copyrighted work or of a fictional character from a copyrighted work. The taking of a copyrighted work’s title is generally regarded as not being a copyright infringement. See 1 M. Nimmer, \textit{supra} note 49, § 2.16. But titles to copyrighted works have been protected under other unfair competition theories. See, e.g., Warner Bros. Pictures, Inc. v. Majestic Pictures Corp., 70 F.2d 310 (2d Cir. 1934) (injunction against use of title \textit{The Gold Diggers} for movie unless film was conspicuously differentiated from plaintiff’s films of same name), cert. denied, 348 U.S. 971 (1955). There is some controversy about whether the taking of a character from a copyrighted work can be an infringement. Compare Warner Bros. Pictures, Inc. v. Columbia Broadcasting Sys., Inc., 216 F.2d 945 (9th Cir. 1954) (Dashiell Hammett held entitled to use his character Sam Spade in radio series despite assignment of certain rights in \textit{The Maltese Falcon} to Warner Bros.; suggesting that fictional characters may not be within the scope of copyright protection), cert. denied, 348 U.S. 971 (1955), with Walt Disney Prods. v. Air Pirates, 581 F.2d 751 (9th Cir. 1978) (holding that cartoon characters in a copyrighted work may be protected against infringement), cert. denied, 439 U.S. 1132 (1979). But even if courts decided, generally speaking, that the taking of a name alone could not be a publicity infringement, when both the name and likeness of a prominent person have commercial value and both are appropriated by the defendant, that should be an infringement just as the taking of the cover of a copyrighted work is a copyright infringement. See Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc., 626 F.2d 1171 (5th Cir. 1980); Conde Nast Publications, Inc. v. Vogue School of Fashion Modeling, Inc., 105 F. Supp. 325 (S.D.N.Y. 1952).
and hence its profitability. As the copyright-fair use discussion above indicates, neither motive disqualifies a defendant from fair use. Another purpose of the use of her name may have been to speculate on what Ms. Christie did during her mysterious disappearance, promulgating an idea in a literary form.306 Use of Ms. Christie's name was clearly part of what made the film commercially valuable. But the use of her name was not the film's only commercially valuable attribute. The performances of Vanessa Redgrave and Dustin Hoffman as well as the quality of the cinematography and script also contributed to its value. More than in Russen or Marx, it appears that although some element of the defendant's success might be attributable to the appropriation of Ms. Christie's publicity right in her name, the greater part of the secondary work's success would be due to the independent creative effort of its author.

The issue of whether there might have been some impairment of the value to the Christie heirs of licensing fictional depictions of the mystery writer's life was not raised by the heirs or by the court. One does not get the sense that this kind of commercial exploitation of Ms. Christie's name and likeness was a goal of the writer during her life or of her heirs after her death.307 They did not seek a royalty. They sought an injunction to prevent distribution of the movie and book, which depicted the writer in what to her heirs might well seem an unfavorable light. As in Rosemont, the complainant in this case may well have had a censorship purpose in pursuing the litigation. Raising a publicity claim—as if the heirs sought only to be enriched from the commercial value of her name—may have been disingenuous. On balance, then, the use of Ms. Christie's name by Casablanca would probably have been a fair one. The first amendment issue would not directly have to be reached.

In addition to the usefulness of fair use as an analytic tool for deciding what secondary uses of publicity rights should be permitted, and as a way to avoid unnecessary constitutional decisions, there are other reasons why it is desirable to adopt the

306. One cannot know, of course, what purposes the producers truly had since the court did not make any inquiry into the matter.
PUBLICITY RIGHTS

proposed fair use-first amendment copyright analysis for publicity cases. One advantage is that a body of factually and legally analogous copyright cases would be available and useful in deciding whether publicity right infringements have taken place. The Marx court relied on Zacchini and Russen to support its conclusion that the appropriation of the right was too substantial to be privileged by the first amendment. Several of the copyright-fair use-first amendment cases would have provided even closer analogies. Appropriation of the Marx Brothers' characteristics resembles closely the appropriation of the features of the copyrighted Mickey Mouse cartoon character in the Air Pirates case. The Marx Brothers portion of A Day in Hollywood/A Night in the Ukraine was no more a parody of the Marx Brothers than the light musical Scarlett Fever was a parody of Gone With The Wind in the MGM case. In both cases, the author of a secondary work appropriated a substantial component of the creative effort of others, and the success of the secondary work was largely attributable to the goodwill built up because of the public's attachment to the original effort. Therefore, rewards belonged, at least in part, to the originator.

Developing a more explicit interchange between publicity and copyright cases might also enrich fair use and first amendment analysis in copyright cases. To some degree, this crossover has already occurred. Zacchini was discussed extensively in Italian Book and, as was noted above, has been cited in support of a denial of first amendment privilege claims in several other copyright cases.

D. Circumstances in Which a First Amendment Defense Might Prevail in a Publicity Case

Just as in copyright law, there may be some publicity cases in which it would be appropriate for the court to reject a claim that a defendant's use of the plaintiff's publicity right was fair,

308. Walt Disney Prods. v. Air Pirates, 581 F.2d 751 (9th Cir. 1978), cert. denied, 439 U.S. 1132 (1979). Had Mickey Mouse been a person rather than a cartoon character, the complaint in that case would have been in publicity.
309. See supra text accompanying note 200.
310. The Dallas Cowboys Cheerleader case, 600 F.2d 1184 (5th Cir. 1979); discussed supra at note 201, might prove a useful analogy for future publicity poster cases such as Factors and Paulsen.
311. See supra note 242 and accompanying text.
yet to uphold the use as one protected by the first amendment.\textsuperscript{312} As has been discussed in section IV, copyright scholars have attempted to delineate separate functions for fair use and first amendment defenses in copyright infringement cases.\textsuperscript{313} Denicola has argued that the first amendment must be brought into play only when the internal mechanisms of copyright law (the idea-expression dichotomy and the fair use defense) fail to permit a use of a copyrighted expression which is needed to ensure meaningful public debate on an issue. Relief based on a first amendment privilege under this standard is likely to be quite rare.

An example may be helpful. If a First Lady decided to sue the manufacturers or vendors of dolls and postcards using her name and likeness and showing her robed in ermine and crowned in diamonds, she might seem to have a cause of action for an infringement of her publicity rights.\textsuperscript{314} A fair use defense to this action might not be successful because the motives of the defendants would probably be partly if not largely commercial, the taking of both the name and likeness is a substantial one, and the First Lady might have been harmed in her ability to license

---

\textsuperscript{312} While adoption of a fair use defense may lead to a reduction in the number of publicity cases in which first amendment claims would be litigated, it may also be that publicity defendants will choose to raise both defenses. Many defendants charged with copyright infringement in the past ten years have raised both fair use and first amendment defenses. In most such cases, both were raised with equal—and negative—success. In those cases in which one of the defenses was successful, it was the fair use defense and not the first amendment defense which succeeded. See supra note 242 and accompanying text. The same may be expected in publicity cases. In any event, courts should not be particularly burdened by having another defense to contend with. Laying the groundwork on the fair use analysis should be part of the analytic process for adjudging the first amendment claim.

\textsuperscript{313} See supra notes 269-83 and accompanying text.

\textsuperscript{314} The author does not know whether our current First Lady, Nancy Reagan, licenses manufacturers to use her image in connection with goods and services. These days almost anyone can do so. Pope John Paul II, for example, granted licenses for use of his name and likeness on some 250 products (including T-shirts, balloons, and gold watches) to help defray the cost of his trip to England. It is not clear whether courts require some sort of prior commercial exploitation to maintain a publicity action. The decision in Lerman v. Chuckleberry Publishing, Inc., 521 F. Supp. 228 (S.D.N.Y. 1981), suggests that prior exploitation is required. Most of the cases which have focused on the issue of prior exploitation of the right have regarded such exploitation as necessary if the right is to survive the death of the prominent person. The discussion in the text will assume that the First Lady in question does license some commercial use of her image or that the law of the jurisdiction in which the suit was brought would not require a showing of prior commercial exploitation.
others to use her image on postcards and dolls.

To the extent that this depiction of a First Lady is intended to convey criticism of her style, her husband's style, and also of the political values which her style may be thought to represent, some contribution to public debate is achieved. Because of this, the first amendment should shield the manufacturers and vendors of the merchandise from possible tort liability.

Thus the same considerations that make it appropriate to distinguish between the roles of fair use and first amendment as defenses in copyright infringement actions make it appropriate to make this distinction in publicity cases. Fortunately, publicity and copyright are such similar types of property interests that the same standard can and presently should be employed in publicity cases to distinguish between the two defenses.

315. Fair use would probably be sufficient to handle cases involving the use of a prominent person's image in a political cartoon. The purpose of the use would be criticism, and harm to the economic interest of the prominent person would, assuming no libel, be nil. If fair use was not sufficient to protect this interest, though, this would be another example of a circumstance in which a first amendment defense might prevail.

316. This example illustrates the grave danger that enforcement of publicity rights might be used to impose a kind of censorship on political commentators. The danger is too great to say that fair use is the only limitation on publicity rights.