The Overprotection of Celebrity: A Comment on White v. Samsung Electronics America, Inc.

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COMMENT

THE OVERPROTECTION OF CELEBRITY: A COMMENT ON WHITE V. SAMSUNG ELECTRONICS AMERICA, INC.

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The [majority's] opinion is a classic case of overprotection. Concerned about what it sees as a wrong done to Vanna White, the panel majority erects a property right of remarkable and dangerous breadth: Under the majority's opinion, it's now a tort for advertisers to remind the public of a celebrity .... This Orwellian notion withdraws far more from the public domain than prudence and common sense allow .... It's bad law, and it deserves a long, hard second look.1

OVERPROTECTION OF CELEBRITY

I. INTRODUCTION

The preceding quote was written by Judge Kozinski in a dissenting opinion from an order rejecting the petition for a rehearing en banc of White v. Samsung Electronics America, Inc.2 In White, the Ninth Circuit held that Vanna White had stated valid claims against Samsung Electronics and David Deutsch Associates3 for alleged violations of her right of publicity,4 under both the California common law and section 3344 of the California Civil Code,5 and her right to protect her identity from being used to falsely endorse Samsung products under § 43(a) of the Lanham Act.6 In response to Judge Kozinski’s statements, this Comment analyzes whether the Ninth Circuit was correct in holding that Vanna White had a valid publicity claim; the effect that holding will have on the protection afforded celebrities under the right of publicity in the future; and whether this expansive publicity right undermines the exclusive rights granted to the owners of the copyrights in both Wheel of Fortune7 and in Vanna White’s performance on that program.

By upholding Vanna White’s right of publicity claim, the Ninth Circuit has continued a trend in which courts have become increasingly overprotective of celebrities’ rights to the detriment of the public at large.8 Allowing a right of publicity claim in this case expands the doctrine beyond the point supported by its underlying policies and beyond the scope of prior case law. Additionally, by allowing Vanna White’s publicity right claim in White9 the Ninth Circuit has undermined the exclusive rights granted under the copyright law and, as a result, has improperly removed from the public domain those aspects of Vanna White’s performance which the Copyright Act

2. 971 F.2d 1395 (9th Cir. 1992), reh'g denied, 989 F.2d 1512 (9th Cir.), cert. denied, 113 S. Ct. 2443 (1993).
3. Samsung’s advertising agency.
4. White, 971 F.2d at 1399. “[T]he right of publicity ... protect[s] the commercial interests of celebrities in their identity.” Id. at 1398 (quoting Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831, 835 (6th Cir. 1983)).
5. CAL. CIV. CODE § 3344(a) (West Supp. 1993).
7. Wheel of Fortune is a popular syndicated TV game show involving contestants playing a variation of “Hangman.” The contestants take turns guessing letters of the alphabet to determine what a particular word is. Vanna White gained her fame in her role as hostess of the show, turning over and revealing the correctly guessed letters as they were called out.
8. See text accompanying note 1.
9. 971 F.2d 1395 (9th Cir. 1992), reh'g denied, 989 F.2d 1512 (9th Cir.), cert. denied, 113 S. Ct. 2443 (1993).
has determined properly belong there.\textsuperscript{10}

Part II of this Comment will provide the facts of the \textit{White} case, as well as the Ninth Circuit's holding with regard to the right of publicity. Part III analyzes the right of publicity, its origins, and underlying policies. The scope of protection afforded under the doctrine prior to \textit{White} and how the \textit{White} holding improperly expands the scope of the publicity right are also discussed. Finally, Part IV analyzes the applicability of copyright law to the \textit{White} case and determines whether the case should properly have been decided under copyright law. Specifically, whether Vanna White's publicity right claim should have been preempted for being equivalent to the exclusive rights provided under the Copyright Act and whether Samsung's parody defense should have been found to be a permissive fair use of Vanna White's performance on \textit{Wheel of Fortune} under the Copyright Law will be discussed.

II. \textit{WHITE V. SAMSUNG ELECTRONICS AMERICA, INC.}\textsuperscript{11}

The \textit{White} case involved a Samsung advertisement which Vanna White claimed infringed upon a number of her intellectual property rights.\textsuperscript{12} Samsung Electronics developed a humorous national campaign with a number of advertisements, each depicting a part of current American popular culture along with a Samsung product. The idea of the campaign was to show that no matter how things change in the future, Samsung products will still be in use.\textsuperscript{13} Typical commercials included a depiction of a raw steak with the subtitle "[r]evelled to be health food. 2010 A.D." or a picture of Morton Downey Jr.\textsuperscript{14} with the caption "Presidential candidate. 2008 A.D." alongside Samsung equipment which, the advertisements implied, would still be popular and dependable in those years.\textsuperscript{15} The adver-

\begin{footnotesize}
\begin{enumerate}
\item See infra notes 251-66 and accompanying text.
\item 971 F.2d 1395 (9th Cir. 1992), reh'g denied, 989 F.2d 1512, cert. denied, 113 S. Ct. 2443 (1993).
\item Vanna White alleged three causes of action: 1) violation of her right of publicity under section 3344 of the California Civil Code; 2) violation of her common law right of publicity; and 3) violation of § 43(a) of the Lanham Act. \textit{White}, 971 F.2d at 1396.
\item Defendant’s Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit at 2, \textit{White v. Samsung Elecs. Am., Inc.}, 971 F.2d 1395 (9th Cir. 1992) (No. 90-55840), reh'g denied, 989 F.2d 1512, cert. denied, 113 S. Ct. 2443 (1993) [hereinafter Petitioner’s Brief].
\item Morton Downey Jr. is a former syndicated "shock" TV talk show host known for his abrasive, loud-mouth image and personality.
\item \textit{White}, 971 F.2d at 1396.
\end{enumerate}
\end{footnotesize}
tisement which led to Vanna White’s lawsuit involved Samsung video cassette recorders. The ad was comprised of a futuristic looking *Wheel of Fortune* game show set with a caption reading “[l]ongest-running game show. 2012 A.D.” Standing next to the letter board, in the spot where Vanna White, in her role as hostess, would normally be, was a robot with a wig, an evening gown, and jewelry typical of the type worn by Vanna White on the television show.

The district court granted summary judgment in favor of Samsung on all three of Vanna White’s claims. On appeal, however, the Ninth Circuit only affirmed the district court’s holding that Vanna White had no claim under section 3344 of the California Civil Code, which requires the unauthorized commercial use of another’s “likeness.” It went on to find that the district court erred in granting summary judgment on both the common law right of publicity and the § 43(a) Lanham Act claims. The majority determined that in California, the common law right of publicity affords celebrities broader protection than section 3344 because the common law right is not limited to protecting a “name or likeness.” Rather, the court held that the California common law right of publicity protects the commercial interest of celebrities in their identities and that it is possible to appropriate an individual’s identity without using her name or likeness. Thus, unlike other jurisdictions which recognize

16. *Id.*
17. *Id.* It was conceded by co-defendant advertising agency, David Deutsch Associates, that the wig, jewelry and gown in which the robot was attired were consciously selected to resemble Vanna White. Petitioner’s Brief, *supra* note 13, at 3.
19. *CAL. CIV. CODE* § 3344(a) (West Supp. 1993) provides that “[a]ny person who knowingly uses another’s name, voice, signature, photograph, or likeness, in any manner, . . . for purposes of advertising or selling, . . . without such person’s prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.”
20. *Id.* It was Vanna White’s argument that the robot used in the Samsung commercial constituted the use of her “likeness” within the meaning of *CAL. CIV. CODE* § 3344, but the Ninth Circuit disagreed. *White,* 971 F.2d at 1397.
21. *Id.* at 1399.
22. *Id.* at 1401.
23. *Id.* at 1397-99.
24. “The common law right of publicity reaches means of appropriation other than name or likeness . . . the specific means of appropriation are relevant only for determining whether the defendant has in fact appropriated the plaintiff’s identity. The right of publicity does not require that appropriations of identity be accomplished through particular means to be actionable.” *Id.* at 1398.
either a statutory right of publicity,\(^{24}\) or a common law right,\(^{26}\) the
Ninth Circuit in *White* recognized both a statutory right\(^{27}\) and a
broader common law right that covers aspects of a celebrity's identity
not protected by the state statute.\(^{28}\) Additionally, the Ninth Circuit
rejected Samsung's argument that its advertisement was a parody that
constituted protected free speech under the First Amendment.\(^{29}\)
Samsung subsequently petitioned the Supreme Court, and certiorari
was denied.\(^{30}\) The case proceeded to trial on the right of publicity
and § 43(a) Lanham Act claims, and on January 19, 1994, Vanna
White was awarded $403,000 in damages.\(^{31}\)

25. See KY. REV. STAT. ANN. § 391.170 (Michie/Bobbs-Merrill 1984); MASS. GEN.
LAWS ANN. ch. 214, § 3A (West Supp. 1989); NEB. REV. STAT. §§ 20-202, -208 (1983);
N.Y. CIV. RIGHTS LAW §§ 50, 51 (McKinney 1992); OKLA. STAT. ANN. tit. 21, §§ 839.1-3
(West 1983); R.I. GEN. LAWS § 9-1-28 (1985); TENN. CODE ANN. §§ 47-25-1101 to 1108
(1984); UTAH CODE ANN. §§ 45-3-1 to -6 (1981); VA. CODE ANN. § 8.01-40 (Michie 1984).

In New York, the right of publicity is encompassed in the state privacy statutes, N.Y.
CIV. RIGHTS LAW §§ 50, 51 (McKinney 1992), and protection exists under New York law
only to the extent it can be found in that statute. There is no common law right of publicity
see Leonard A. Wohl, Note, *The Right of Publicity and Vocal Larceny: Sounding Off on
Sound-Alikes*, 57 FORDHAM L. REV. 445, 454 (1988) (noting that the preemption of the com-
mon law right of publicity by sections 50 and 51 of the New York Civil Rights Law may
only apply to right of publicity claims contemplated by the statute, i.e., appropriation
of name, portrait or picture, and that, arguably, other aspects of a celebrity's personality, such as
voice, could be protected under a common law right of publicity in New York).

Ohio common law right of publicity); Bi-Rite Enters. Inc. v. Bruce Miner Co., 757 F.2d 440,
444 (1st Cir. 1985) (noting that Massachusetts, Connecticut, Illinois and Georgia recognize a
common law right of publicity); Douglass v. Hustler Magazine, Inc., 769 F.2d 1128, 1138
(7th Cir. 1985), cert. denied, 475 U.S. 1094 (1986) (using Illinois common law right of
publicity); Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 834 (6th Cir. 1983)
(suggesting that Michigan would adopt common law right of publicity); Eagle's Eye, Inc. v.
mon law right of publicity); Estate of Presley v. Russen, 513 F. Supp. 1339, 1354 (D.N.J.
1981) (using New Jersey common law right of publicity); Uhlaender v. Henricksen, 316 F.
Supp. 1277, 1282 (D. Minn. 1970) (using Minnesota common law right of publicity); Martin
697, 702 (Ga. 1982) (using Georgia common law right of publicity); Fergerstrom v. Hawaiian
Ocean View Estates, 441 P.2d 141, 144 (Haw. 1968) (using Hawaii common law right of
publicity).

27. CAL. CIV. CODE § 3344(a) (West Supp. 1993).

28. *White*, 971 F.2d at 1397-98. Florida, Wisconsin and Texas also recognize both a
statutory and common law right of publicity. See Christopher Pesce, Note, *The Likeness Monster:
Should the Right of Publicity Protect Against Imitation*, 65 N.Y.U. L. REV. 782, 802

29. Petitioner's Brief, *supra* note 13, at 4; *see also* *White*, 971 F.2d at 1401 n.3.


III. THE RIGHT OF PUBLICITY

The modern right of publicity originated as an element of the right of privacy but has since evolved into a distinct cause of action recognized in the majority of jurisdictions in the United States. The right of privacy has its roots in a law review article written by Louis D. Brandeis and Samuel D. Warren entitled "The Right of Privacy." In that article and the subsequent cases that embraced its

White was originally seeking $6.9 million in damages and later offered to settle out of court for $950,000, but Samsung refused. Shauna Snow, Morning Report, L.A. TIMES, Jan. 21, 1994, at F2. The $403,000 in damages that Vanna White received was comprised of $75,000 against defendant Samsung for the right of publicity claim, $75,000 against defendant David Deutsch Associates for the right of publicity claim, $130,000 against defendant Samsung for the § 43(a) Lanham Act claim and $123,000 against defendant David Deutsch Associates for the § 43(a) Lanham Act claim. Telephone Interview with Michael B. Garfinkel, Attorney, Pillsbury Madison & Sutro, counsel for defendants (Feb. 8, 1994).

32. See William L. Prosser, Privacy, 48 CAL. L. REV. 383 (1960), in which the author states that four torts comprise the right of privacy, the fourth of which is in effect the right of publicity. The right of publicity encompasses: "1. [i]ntrusion upon the plaintiff's seclusion or solitude, or into his private affairs; 2. [p]ublic disclosure of embarrassing private facts about the plaintiff; 3. [p]ublicity which places the plaintiff in a false light in the public eye; and 4. [a]ppropriation, for defendant's advantage, of the plaintiff's name or likeness." Id. at 389.


34. Louis D. Brandeis & Samuel D. Warren, The Right to Privacy, 4 HARV. L. REV. 193 (1890). This article is recognized for adding the notion of a right to privacy to our law. Roscoe Pound was quoted as saying it did "nothing less than add a new chapter to our law." A.T. MASON, BRANDEIS: A FREE MAN'S LIFE 70 (1946); see also Prosser, supra note 32, at 383. But see Michael Madow, Private Ownership of Public Image: Popular Culture and Publicity Rights, 81 CAL. L. REV. 125, 148 (1993) (arguing that the right of publicity is not a new legal theory and that the large scale exploitation of famous people dates back at least to
views,\textsuperscript{35} the primary focus of the privacy right was the protection of non-celebrities\textsuperscript{36} against intrusions by the press into their private and personal lives.\textsuperscript{37}

The notion of a comparable right for celebrities was first expressed in \textit{Haelan Laboratories v. Topps Chewing Gum, Inc.}\textsuperscript{38} The holding in \textit{Haelan Laboratories}\textsuperscript{39} was that a celebrity "in addition to and independent of [the] right of privacy . . . has a right in the publicity value of his photograph . . . . This right might be called a 'right of publicity.'"\textsuperscript{40} This notion of a publicity right was further explored and developed the following year in an important article by Professor Melville B. Nimmer,\textsuperscript{41} in which he argued in favor of a right of publicity distinct from the right of privacy because "although the well known personality does not wish to hide under a bushel of privacy, neither does he wish to have his name, photograph and likeness reproduced and publicized without his consent and without remuneration to him."\textsuperscript{42}

The common law right of publicity was first recognized in California in \textit{Eastwood v. Superior Court}\textsuperscript{43} when the California Court of
Appeals stated that a violation of a celebrity's common law right of publicity could be shown by establishing: "1) the defendant's use of the plaintiff's identity; 2) the appropriation of the plaintiff's name or likeness to defendant's advantage, commercially or otherwise; 3) lack of consent; and 4) resulting injury."44 Unlike White, the Eastwood case involved the unauthorized use of an actual photograph of Clint Eastwood45 and of his name.46 The majority in White noted this distinction and determined that, since Eastwood involved the actual use of a celebrity's name and likeness, the Eastwood court had never reached the question of whether the protection of a celebrity's identity extended beyond that point.47 The White court went on to hold that the claim under the California common law right of publicity was not limited exclusively to the appropriation of a celebrity's name or likeness.48 Rather, the majority held, the common law right of publicity encompasses means of appropriation other than name or likeness, and the specific means of appropriation are relevant only for determining whether the defendant has in fact appropriated the plaintiff's identity.49

A. Scope of Protection Under the Publicity Right

"[T]he State's interest in permitting a 'right of publicity' is . . . closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation."50 In fact, the right of publicity does not provide the celebrity with a shield to ward off satire, caricature and parody. Rather, celebrity invites creative comment, and thus the scope of the publicity right should not be so wide as to stifle this creative comment.51

44. Id. at 347. This four element test employed by the California Court of Appeals was the test for the right of publicity set forth by Prosser in his treatise on torts. WILLIAM L. PROSSER, LAW OF TORTS § 117, at 804-07 (4th ed. 1971).
45. Clint Eastwood is an internationally famous television and motion picture star.
46. Eastwood, 198 Cal. Rptr. at 414.
47. White, 971 F.2d at 1397.
48. Id.
49. Id. at 1398.
50. Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 573 (1977); see also Estate of Elvis Presley v. Russen, 513 F. Supp. 1339, 1358 n.18 (D.N.J. 1983) ("Although the right of publicity is not the same as a right in copyright, there are similarities, particularly where a personality's likeness or name is closely connected with a distinctive style of performance.").
A fundamental goal of copyright law is to stimulate artistic creativity for the public good. Protection is granted so that creative work will be encouraged and rewarded. However, since the ultimate aim is to have the public at large benefit from the availability of these creative works, limits are placed on the scope of copyright protection that ultimately moves copyrighted works into the public domain. Similarly, limits must be placed on the scope of the right of publicity so that the public can benefit from a rich public domain.

The White holding expands the scope of a celebrity’s protectable identity under the right of publicity beyond that recognized in prior case law. Since the protection afforded under the right of publicity is not uniform among the various jurisdictions, there is no single outer boundary limiting the scope of celebrity protection. However, the prior statutory and case law is clear as to what has been protected in the past and what the boundaries of protection should be. The White decision goes beyond that point.

1. Protection of Permanent Aspects of Identity

Initially protection was extended only to a celebrity’s “name or likeness.” Over time, the protection of a celebrity’s name has been expanded to include the protection of a celebrity’s first name, pen name, nickname, and the name of a group. However, a single

53. Id.
54. "Creativity is impossible without a rich public domain. Nothing today, likely nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before. Overprotection stifles the very creative forces it's supposed to nurture." White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1513 (9th Cir.)(Kozinski, J., dissenting), cert. denied, 113 S. Ct. 2443 (1993).
57. Cher v. Forum Int'l, Ltd., 692 F.2d 634 (9th Cir. 1982).
59. Hirsch v. S.C. Johnson & Sons Inc., 280 N.W.2d 129, 132 (Wis. 1979) (holding that the nickname "Crazylegs" was sufficient to identify the plaintiff, former football star Elroy Hirsch, and thus was protectable under a right of publicity).
Unauthorized mention of a celebrity's name in a non-commercial use has been held to be insufficient to raise a right of publicity claim, as has the use of a celebrity's name in the title of a fictional or semi-fictional book or movie. Protection of a celebrity's likeness has been held to include photographs, drawings, and look-alikes. Additionally, in *Middle v. Ford Motor Co.*, the Ninth Circuit, noting that "the human voice is one of the most palpable ways in which identity is manifested," expanded the protection of identity by holding that the distinctive voice of a well-known singer is also protected under the right of publicity.

61. Brown v. Twentieth Century Fox Film Corp., 799 F. Supp. 166 (D.D.C. 1992). In this case, James Brown challenged the defendant's use in the motion picture THE COMMITMENTS of a 27-second clip of his performance on a 1965 British television show. The court held that the defendants had obtained the proper rights to use that clip. The only other remaining use of Mr. Brown's persona in the film was a single mention of his name, along with the names of several other entertainers, as a model "soul" performer, whom the members of the fictitious "Commitments" should study and emulate. This was held to be an insufficient appropriation of Mr. Brown's persona to give rise to a right of publicity claim. *Id.* at 172.

62. See Rogers v. Grimaldi, 875 F.2d 994, 1004 (2d Cir. 1989) (holding that the right of publicity will not bar the use of a celebrity's name in a movie title unless the title use was wholly unrelated to the movie or was simply a disguised commercial advertisement for the sale of goods or services); see also Hicks v. Casablanca Records, 464 F. Supp. 426 (S.D.N.Y. 1978); Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454 (Cal. 1979).


65. See generally Tin Pan Apple, Inc. v. Miller Brewing Co., Inc., 737 F. Supp. 826 (S.D.N.Y. 1990); Allen v. Men's World Outlet, Inc., 679 F. Supp. 360 (S.D.N.Y. 1988); Allen v. National Video, Inc., 610 F. Supp. 612 (S.D.N.Y. 1985). All of these cases were in New York State, where the publicity right is narrowly construed to exist only as a part of the state privacy statute, sections 50 and 51 of the New York Civil Rights Law, and therefore look-alikes were not held to constitute a celebrity's "likeness" within the meaning of the statute. However, in each case, the plaintiff was able to prevail on a § 43(a) Lanham Act claim on false endorsement grounds.

66. 849 F.2d 460 (9th Cir. 1988).

67. *Id.* at 463.

68. *Id.* In *Miller*, much like in *White*, the Ninth Circuit held that the plaintiff had no cause of action under section 3344 of the California Civil Code because the statute requires use of a person's "voice," and a sound-alike is not use of the celebrity's voice, but rather an imitation. *Id.* at 462. However, the Ninth Circuit also held that the common law right in California is broader than the statutory right and covers sound-alike appropriations. *Id.* at 463.
2. Protection of Transitory Aspects of Identity

"[T]ransitory adjuncts of personality . . . [such as] hairstyle [or] wardrobe . . . standing alone, are of such dubious originality and confounding subtlety as to be undeserving of independent legal existence."69 Allowing celebrities to have an actionable interest in superficial traits, characteristics, and mannerisms is contrary to the policies of avoiding unjust enrichment and rewarding celebrities for labor performed.70 Unlike permanent incidents of identity, such as a celebrity's name, photograph or distinctive voice, these more abstract characteristics, in and of themselves, are transitory and do not sufficiently distinguish one personality from another to be deserving of independent legal protection under the right of publicity.71 In recent years, the boundaries of what constitute protectable aspects of a celebrity's personality have been expanded. As one commentator noted,

[a]t some point some aspects of the celebrity may transcend his own persona and become evocative of some more general, if not generic concept. The issue thus may be whether use of the persona evokes a broader concept that is properly a part of the public domain and therefore not within the right of publicity.72

There have been a number of cases in which the courts have protected attenuated and transitory aspects of a celebrity's identity that properly belong in the public domain.73 An analysis of a representative sampling of these cases, comparing and contrasting them with the White case, will show how White goes beyond these holdings and is now at the forefront of a line of cases which overprotect publicity rights.

70. See infra notes 122-41 and accompanying text.
71. See Hetherington, supra note 69, at 45.
73. See, e.g., Waits v. Frito-Lay, 978 F.2d 1093 (9th Cir. 1992) (protection of style); Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (protection of a slogan identifying the celebrity); Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974) (celebrity not visible but clearly in the advertisement); Lugosi v. Universal Pictures, 603 P.2d 425 (Cal. 1979) (protection of a "role" identified with a particular celebrity).
a. Protection of a Celebrity's "Style"

In Waits v. Frito-Lay, the defendant, Frito-Lay, broadcast a radio commercial for SalsaRio Doritos which featured a singer imitating Tom Waits' distinctive, raspy voice. Waits, a professional singer and songwriter, successfully sued Frito-Lay on both a right of publicity voice misappropriation claim and a claim under § 43(a) of the Lanham Act. In Waits, there was a dispute as to whether Frito-Lay in fact misappropriated Tom Waits' voice or merely his "style," i.e., his singing style, songwriting style and manner of presentation. The court, in instructing the jury, noted that while the jury could consider whether Waits' voice was misappropriated by imitation, it could not consider "style." Style was held to be unprotectable and style imitation alone was insufficient for liability. The Ninth Circuit held that it was not enough that listeners were reminded of Waits or thought the singer sounded like him. Rather, people had to actually believe that there was no imitation and that it was in fact Tom Waits who was singing.

However, in a complete reversal from the Waits holding, the Ninth Circuit in White not only accepted precisely the same "reminded the public of the celebrity" argument from Vanna White; the majority made the argument itself. The majority offered the following example:

Consider a hypothetical advertisement which depicts a mechanical robot with male features, an African-American complexion, and a bald head. The robot is wearing black high-top Air Jordan basketball sneakers, and a red basketball uniform with black trim, baggy shorts, and the number 23 (though not revealing "Bulls" or "Jordan" lettering). The ad depicts the robot dunking a basketball one-handed,
stiff-armed, legs extended like open scissors, and tongue hanging out. Now envision that this ad is run on television during professional basketball games. Considered individually, the robot's physical attributes, its dress, and its stance tell us little. Taken together, they lead to the only conclusion that any sports viewer who has registered a discernable pulse in the past five years would reach: the ad is about Michael Jordan. 81

By posing this hypothetical as an illustration of why the Samsung advertisement, in total, was an infringement of Vanna White's publicity right, the Ninth Circuit adopts the same view it rejected a year earlier in Waits. 82 The dunking of a basketball "one-handed, stiff-armed, legs extended like open scissors, and tongue hanging out" 83 is certainly a style of playing basketball. Michael Jordan can no more appropriate this style of playing basketball for himself than Tom Waits can appropriate a certain style of singing. 84 Also, the fashion or clothing style of wearing black hightop sneakers, a red uniform with black trimming, and baggy shorts, even with the number 23 on the back, could not be appropriated by Michael Jordan under Waits. The Chicago Bulls are not the only team with red uniforms with black trim, and Michael Jordan is undoubtedly not the only number 23 to have played on those teams. Thus, the court's example in White runs counter to its own holding in Waits a year before.

Based on the lack of protection afforded to a celebrity's style under Waits, Vanna White's fashion style (i.e., wearing an evening gown and jewelry while performing her role as hostess) should not be protected under a publicity right.

b. Protection of Celebrity Identity Where the Celebrity is Not in the Advertisement but Where the Intent is to Evoke the Celebrity's Identity

In Lombardo v. Doyle, Dane & Bernbach, Inc., 85 the plaintiff, Guy Lombardo, sued the defendant for the appropriation of his public personality for commercial purposes. Mr. Lombardo was a well-known band leader famous for presiding over New Year's Eve festivi-

81. Id.
82. Waits, 978 F.2d 1093; see supra text accompanying notes 75-79.
83. White, 971 F.2d at 1399.
84. See Waits, 978 F.2d at 1100 n.2.
He sought to ban a TV commercial in which an actor appeared in silhouette as a band leader in a New Year's Eve setting, using Mr. Lombardo's mannerisms, gestures, musical beat and performing songs that the public associated with Mr. Lombardo. The court, after determining that a publicity right existed in New York, held that "[t]he combination of New Year's Eve, balloons, party hats and 'Auld Lang Syne' [used in the commercial] might amount to an exploitation of [Lombardo's] carefully and painstakingly built public personality." While Lombardo would not be decided this way today (and thus the right of publicity may not even extend as far as the Lombardo court held), it is still distinguishable from and less expansive in scope than White. In Lombardo, the entire intent and focus of the defendant's commercial was to evoke Guy Lombardo's personality in the public's mind in order to call to mind a festive, New Year's Eve type celebration. In White, the goal of the commercial was not to call Vanna White to the minds of the viewers; Vanna White, the individual, was incidental. Rather, the purpose of the commercial was to analogize the long-term, enduring popularity of Wheel of Fortune with the long-term dependability and popularity of Samsung video cassette recorders. The use of the robot in the role of hostess was necessary for an accurate depiction of a Wheel of Fortune set in the future, but Vanna White's persona was incidental and was not being capitalized upon by Samsung in order to sell its video cassette recorders.

86. Id. at 661.
87. Id.
88. Id. at 664. Lombardo was decided prior to Stephano v. News Group Publications, 474 N.E.2d 580 (N.Y. 1984), in which it was held that no separate publicity right existed in New York. Rather, the publicity right was subsumed by sections 50 and 51 of the New York Civil Rights Law. Id. at 584. Today, Lombardo would have been decided differently.
89. Lombardo, 396 N.Y.S.2d. at 664.
90. See supra note 88.
91. See Lombardo, 396 N.Y.S.2d at 664.
92. See infra notes 124-27 and accompanying text and infra note 272.
93. The use of a robot was necessary to give the advertisement the humorous, futuristic feel. "The ad just wouldn't have been funny had it depicted White or someone who resembled her - the whole joke was that the game show host(ess) was a robot, not a real person." White, 989 F.2d at 1514 (Kozinski, J., dissenting).
c. Protection of Identity Where the Celebrity is not Visible but is in the Advertisement

In *Motschenbacher v. R.J. Reynolds Tobacco Co.*, Lothar Motschenbacher, a professional race car driver, claimed the defendants violated his right of publicity in a national cigarette advertisement. Defendants used a photograph of Motschenbacher driving his race-car on a racetrack, although his features were not visible. In making the advertisement, the defendants altered the photograph so as to change the look of the car slightly. However, a number of the unique features that identified the car as Motschenbacher's remained. The Ninth Circuit held that while the "likeness" of Motschenbacher himself was unrecognizable (since he personally was not visible in the photograph), the markings on the car were unique to his race-car and could reasonably cause people to infer that it was in fact Motschenbacher driving the car in the advertisement.

A key distinction between *Motschenbacher* and *White* points out how the *White* court has expanded celebrity publicity rights. In *Motschenbacher*, the plaintiff, although not visible, was actually in the advertisement and was readily identifiable to the public by the distinctive markings on his car. Here, not only is Vanna White not personally identifiable in the Samsung advertisement, it is apparent that she is not in the advertisement at all. The rationale of *Motschenbacher*, that the actual celebrity was still identifiable in the advertisement although his image was altered, does not apply in *White* because Vanna White was not actually in the Samsung advertisement. Thus, she is not identifiable within the meaning of *Motschenbacher* from the use of a robot in her place.

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94. 498 F.2d 821 (9th Cir. 1974).
95. *Id.* at 822.
96. Plaintiff's car was a distinctive red color with narrow white pinstriping and had a unique oval background on which his racing number was displayed. The number clearly separated plaintiff's car from other race cars and identified it as plaintiff's car. This remained unaltered in the commercial. *Id.*
97. *Id.* at 827.
98. *Id.*
99. "No one seeing the ad could have thought this was supposed to be White in 2012." *White*, 989 F.2d at 1514 (Kozinski, J., dissenting).
d. Protection of a "Role" Identified With a Specific Celebrity

"The majority's position seems to allow any famous person or entity to bring suit based on any commercial advertisement that depicts a character or role performed by the plaintiff."\(^{100}\) It is clear that, at times, the public recognizes a celebrity's "identity" not only in the celebrity's name and appearance, but in the celebrity's portrayal of a specific character (e.g., Sean Connery or Roger Moore as James Bond).\(^{101}\) "Substantial publicity value exists in the likeness of each of these actors in their character roles. The professional and economic interests in controlling the commercial exploitation of their likenesses while portraying these characters are identical to their interests in controlling the use of their own 'natural' likenesses."\(^{102}\) In this case, however, Vanna White's natural likeness is indistinguishable from her likeness on *Wheel of Fortune* because she plays herself on the show. "Vanna White is a one-role celebrity. She is famous solely for appearing as the hostess on the *Wheel of Fortune* television show."\(^{103}\) The public only knows Ms. White "in character." As a result, the public only views Vanna White in her role as hostess on *Wheel of Fortune*.

Notwithstanding any copyright preemption issues,\(^{104}\) Vanna White would, perhaps,\(^{105}\) have a valid right of publicity claim if there was an unauthorized use of her actual likeness in the hostess role because such an unauthorized use of her likeness for commercial advantage would clearly be within the scope of protection of the right of publicity. However, this protection would extend only to her likeness, i.e., her image while she portrayed the role of hostess on *Wheel of Fortune*. Nothing in the right of publicity would prohibit another actress or even a robot from portraying the hostess on *Wheel of Fortune*.\(^{106}\) The Samsung commercial uses a robot to portray the hostess

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\(^{100}\) *White*, 971 F.2d at 1407 (Alarcon, J., concurring in part, dissenting in part).


\(^{102}\) *Id.*

\(^{103}\) *White*, 971 F.2d at 1404 (Alarcon, J., concurring in part, dissenting in part).

\(^{104}\) See *infra* notes 223-76 and accompanying text.

\(^{105}\) This is assuming that there is no provision in Vanna White's employment contract expressly addressing the use of her photograph, likeness, etc. and granting all rights in those uses to another party, such as her employer, Merv Griffin Enterprises.

\(^{106}\) See *Lugosi*, 603 P.2d at 445 n.26 (Bird, C.J., dissenting) (noting, for example, that Charlie Chaplin's right of publicity would not prohibit another person from developing and
character. While the robot in the advertisement is similar to Vanna White in that it is wearing a wig, gown and jewelry, that is merely the costume Vanna White wears while in character. Indeed, "an attractive appearance, a graceful pose, blond hair, an evening gown, and jewelry are attributes shared by many women . . . . They are not unique attributes of Vanna White’s identity."

e. Protection of a Slogan Identifying the Celebrity

In Carson v. Here’s Johnny Portable Toilets, Inc., Johnny Carson sued a Michigan corporation that rented and sold portable toilets for using the slogan “Here’s Johnny,” which was widely recognized as the introduction used on Carson’s nightly TV show. The majority held that the defendant’s use of the phrase “Here’s Johnny” constituted an appropriation of Carson’s identity in violation of his publicity right. Carson, much like White, was improperly decided because its outcome was not dictated by the policies underlying the publicity right, i.e., providing celebrities with an incentive to innovate or perform and preventing unjust enrichment. By broadening the publicity right to include phrases merely associated with Johnny Carson, the Carson holding has the effect of allowing celebrities, by merely associating themselves with a common phrase,
to effectively remove it from the public domain.\textsuperscript{116} This has the dangerous effect of allowing celebrities to limit the expressive and communicative opportunities available to the public at large.\textsuperscript{117} In other words, now only Johnny Carson has the power to determine what the phrase “Here’s Johnny” will mean in our society. The \textit{White} holding is analogous to \textit{Carson} in that it gives Vanna White the ability to control the use of the \textit{Wheel of Fortune} set and wigs, jewelry and evening gowns merely because they have been associated with her. As a result, these props can no longer be used together in popular culture for fear of misappropriating Ms. White’s identity.

\textbf{B. Policies Underlying the Publicity Right}

As the preceding section pointed out, the \textit{White} holding expands the scope of protection of celebrity identity under the publicity right beyond that allowed in prior case law. Additionally, by holding that the specific means of appropriation of a celebrity’s identity is relevant only for determining whether in fact appropriation has occurred, the Ninth Circuit has expanded the right of publicity beyond the scope of the policies and justifications underlying the cause of action.

This section will analyze the policies that underlie the protection of celebrity publicity rights and the question of whether the \textit{White} holding was proper in light of these policies. The primary justification for a right of publicity separate and distinct from the right of privacy is that “[t]he appropriation of an individual’s likeness for another’s commercial advantage often intrudes on interests distinctly different than those protected by the right of privacy.”\textsuperscript{118} The interests to be protected under the right of publicity include: 1) avoiding the unjust enrichment of the appropriator who stands to profit from the commercial use of a celebrity’s identity;\textsuperscript{119} 2) allowing the celebrity to reap the rewards of her own endeavors by capitalizing on the commercial value of her own identity;\textsuperscript{120} and 3) avoiding deception of the public by advertisers who misrepresent that celebrities are endorsing their

\begin{itemize}
  \item \textsuperscript{116} \textit{Carson}, 698 F.2d at 837 (Kennedy, J., dissenting).
  \item \textsuperscript{117} \textit{Madow}, \textit{supra} note 34, at 145-46; \textit{see also infra} note 139.
  \item \textsuperscript{118} \textit{Lugosi} v. Universal Pictures, 603 P.2d 425, 437 (Cal. 1979) (Bird, C.J., dissenting); \textit{see Haelen Labs., Inc.} v. Topps Chewing Gum, 202 F.2d 866, 868 (2nd Cir. 1953); \textit{Hetherington, supra} note 69, at 16.
  \item \textsuperscript{119} \textit{See Carson v. Here’s Johnny Portable Toilets, Inc.}, 698 F.2d 831, 834 (6th Cir. 1983); \textit{Hetherington, supra} note 69, at 16.
  \item \textsuperscript{120} \textit{See Zacchini v. Scripps-Howard Broadcasting Co.}, 433 U.S. 562, 573 (1977); \textit{see also Hetherington, supra} note 69, at 16; \textit{Madow, supra} note 34, at 178.
\end{itemize}
1. Avoid Unjust Enrichment

The first interest protected by the right of publicity is the potential financial gain from the commercial exploitation of the celebrity’s own identity. The unauthorized use of a celebrity’s likeness creates an economic advantage in the user (and an economic loss in the celebrity) that amounts to unjust enrichment because the user benefits from the economic value of the celebrity’s name or likeness.

Based on this rationale, it is difficult to justify allowing Vanna White to assert a valid right of publicity claim against Samsung. The Samsung advertisement did not exploit Vanna White’s likeness to its own advantage. Rather, Samsung was exploiting the public’s perception of the Wheel of Fortune television show. It was the ongoing, enduring popularity of the Wheel of Fortune game show that Samsung sought to capitalize on and correlate in the public’s mind with the ongoing and enduring popularity of the Samsung video cassette recorders being advertised. Clearly the use of a robot in the role of hostess, traditionally performed by Vanna White, on the Wheel of Fortune set will call Ms. White to mind for viewers familiar with the program. However, the use of a robot in that role in conjunction with the caption “[l]ongest-running game show. 2012 A.D.” also calls to mind the enduring popularity of Wheel of Fortune, a television show that, by implication, will still be popular in the future, along with Samsung video cassette recorders. Ultimately, Vanna White’s celebrity is incidental to the commercial exploitation of the popularity of Wheel of Fortune and should not be protected.

122. See Carson, 698 F.2d at 834; Hetherington, supra note 69, at 16.
125. The intention of all of the Samsung advertisements was to depict the future in a humorous manner and to tell consumers that Samsung products would be there in the future. See Petitioner’s Brief, supra note 13, at A-47 (reproducing District Court order granting defendant’s motion for summary judgment); see also White, 989 F.2d at 1513 (Kozinski, J., dissenting); White, 971 F.2d at 1405 (Alarcon, J., concurring in part, dissenting in part); David A. Kaplan & Tessa Namuth, I'd Like to Buy a Dollar, NEWSWEEK, Apr. 5, 1993, at 54.
126. See White, 971 F.2d at 1396.
127. The fact that the advertisement uses a robot instead of Vanna White accentuates this point. It is clear from the use of the robot that it is Wheel of Fortune that has the enduring
In this respect, the *White* case is distinguishable from previous celebrity sound-alike or look-alike cases in which the actual identity of the celebrity was used to promote a product without the celebrity’s permission. In those situations, the purpose of the commercials was to exploit the celebrity’s identity through imitation and to allow the public to think that the celebrity was involved in the making of the commercial. In *White*, however, while it was admitted that the robot was purposely dressed in such a way as to resemble Vanna White’s attire on the game show, there was no way that the public could think that Vanna White was actually being used in the commercial. In fact, the opposite was true. By using the robot instead of Vanna White, Samsung clearly was not using Vanna White’s identity for its own commercial advantage.

2. Reap the Rewards of One’s Endeavors

A second rationale underlying the right of publicity is that by providing celebrities with legal protection for the economic value of their identities against unauthorized commercial exploitation, the celebrities will be able to “reap the reward[s] of [their] endeavors.” Additionally, the publicity right protects against unauthorized uses which affect the celebrity’s ability to control her own image and which may substantially alter that image. Protecting celebrities in
this way not only compensates them for the hard work and effort that was required to build up their celebrity identities, but also provides a benefit for the public at large by giving the celebrities an incentive to produce more creative efforts and to remain in the spotlight as personalities valued by the public. The White case is clearly overprotective in this regard because the court not only protects Vanna White’s ability to be compensated for her own endeavors but also allows her to be compensated for the endeavors of others; based on the tenuous assertion that the defendants in some way appropriated her “persona.” The Samsung video cassette recorder advertisement did not use Vanna White at all. Instead, it used a robot to perform the role of hostess that Vanna White currently performs. Ms. White is compensated by Merv Griffin Enterprises for performing this role and to compensate her further when a robot plays the same role goes beyond allowing her to reap the rewards of her own labor. Vanna White merely performs the role of hostess, she did not create the role. Therefore, while she should be compensated for her labor in performing the role, when someone else, or something else in this case, performs the hostess role, there is no labor on her part and no compensation should be given to her.

As stated above, one goal of the right of publicity is to avoid the unjust enrichment of parties exploiting a celebrity’s identity for economic gain without permission. However, by allowing Vanna White’s publicity claim in this instance, the opposite occurs. Vanna White is enriched unjustly because she stands to be rewarded from a situation in which she expended no labor or effort. One danger of

134. See Zacchini, 433 U.S. at 576. This rationale is similar to the fundamental considerations underlying our copyright and patent laws.

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 and useful Arts." Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.

135. White, 971 F.2d at 1396.
137. See supra notes 122-30.
138. Samsung Electronics and David Deutsch Associates expended the effort in creating
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such a broad right is that the right of publicity gives the celebrity the "power, ultimately, to limit the expressive and communicative opportunities of the rest of us." Merely because Vanna White may not appreciate or approve of Samsung’s use of a robot in the role of Wheel of Fortune hostess, because, for example, she may feel that she has some proprietary interest in the role because she, in some way, enhanced it, does not mean that she should have the power and ability to control public perception of the role (and, indirectly, of her image) through her publicity right.

Additionally, if Vanna White’s publicity right is allowed to protect this situation, Merv Griffin Enterprises, as owner of Wheel of Fortune, is harmed because it could be impeded in any attempt to reap the commercial rewards available from the publicity value of Wheel of Fortune itself. In Philadelphia Orchestra Ass’n v. Walt Disney Co., it was held that a publicity right existed in the name and likeness of an orchestra. Similarly, an argument could be made that Merv Griffin Enterprises has a publicity right in the Wheel of Fortune name and likeness. If that is the case, Vanna White is restricting the ability of Merv Griffin Enterprises to reap the full economic value of the Wheel of Fortune identity. As a result, she is effectively given a property right in Wheel of Fortune because a realistic Wheel of Fortune set could not be put to commercial use by Merv Griffin Productions without either including or compensating Vanna White.

3. Avoid Deception of the Public

A third view argues that “celebrity rights, such as the right of publicity, should be grounded in explicit or implicit endorsements of

this advertising campaign involving futuristic advertisements from which they hoped to profit. Samsung had a $7 million advertising account with David Deutsch Associates. See ADVERTISING AGE, Dec. 11, 1989, at 49. Additionally, Merv Griffin Enterprises, as creator and producer of Wheel of Fortune, expended the effort required to make Wheel of Fortune the most successful television program in syndication, thus giving the program its status as a long-term success upon which Samsung ultimately capitalized.

139. Madow, supra note 34, at 145-46. Madow is not concerned with who “owns” the celebrity in the sense of who gets to capture the economic values that attach to the celebrity’s identity. Rather, he is concerned with who gets to control what the celebrity’s identity will “mean” in our culture. For example, who decides what “Madonna” means to our culture? Madow argues that by centralizing this meaning, making power in the celebrity herself, the right of publicity facilitates the top-down management of popular culture and constrains the space available for alternate and oppositional cultural practice. Id. at 146.


141. Id. at 350.
a product by [the celebrity].” 142 The focus, therefore, is on whether there was intent by the advertiser to misrepresent the celebrity’s endorsement of the product. 143 This argument has been offered in response to the recent celebrity sound-alike 144 and look-alike 145 cases that have been decided in favor of celebrities. The justification has been that the advertising industry lacks integrity and, through the use of imitators, preys on and deceives an unsuspecting public. 146

This justification for the right of publicity is similar to the one underlying the § 43(a) Lanham Act cause of action. 147 While an in-depth analysis of Vanna White’s § 43(a) claim and the policies underlying § 43(a) is beyond the scope of this Comment, 148 some analysis is appropriate at this point.

Section 43(a) of the Lanham Act is a federal statute which covers trademark law. The purpose of the statute is to protect consumers from confusion as to the source of goods in the marketplace. 149 “The Lanham Act approach to the protection of a celebrity’s interest in the exploitation of his or her persona represents a parallel thread in the development of the right of publicity . . . . The focus of this approach, however, is not on the celebrity’s interest in the economic value of his identity, but on the public interest in freedom from deception.” 150 The statute was amended in 1988 to encompass, among several other things, false endorsement claims. 151 Section 43(a) now expressly prohibits the use of any symbol or device, including the

143. Suckenik, supra note 121, at 40.
144. See Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992); Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988).
146. Suckenik, supra note 121, at 40.
150. Halpern, supra note 72, at 1241.
distinctive sounds and physical appearances of celebrities, which is likely to deceive customers as to the association, sponsorship or approval of goods or services by another person.\textsuperscript{152}

Based on this rationale, the right of publicity should not protect Vanna White in this case. The possibility of consumer confusion as to Vanna White's endorsement of Samsung video cassette recorders is much less than in sound-alike or look-alike cases in which the public could in fact believe that the celebrity was actually used in the commercial. The use of a robot makes it absolutely clear that it is not Vanna White in the advertisement. Therefore, the likelihood that Samsung intended to misrepresent to the public that Vanna White was endorsing its video cassette recorders is minimal.

\section*{IV. Applicability of Copyright Law to \textit{White} and Its Impact on Vanna White's Right of Publicity}

In analyzing both Vanna White's claims against Samsung and David Deutsch Associates,\textsuperscript{153} and the defendants' parody defense, the Ninth Circuit failed to analyze whether this case should properly have been decided under federal copyright law. This section explains why copyright law should have been controlling in \textit{White} because both the \textit{Wheel of Fortune} game show and Vanna White's performance on that program constitute "original works of authorship" which are protected under the Copyright Act.\textsuperscript{154} The owner of these copyrights is entitled to certain exclusive rights, including the right to prepare or authorize derivative works\textsuperscript{155} such as the Samsung advertisement.\textsuperscript{156} Therefore, the proper analysis should have been to determine: 1) whether the Samsung advertisement constituted copyright infringement\textsuperscript{157} or alternatively, a permissive fair use under § 107 of the Copyright Act;\textsuperscript{158} and 2) whether Vanna White's right of public-

\textsuperscript{152} \textit{Waits}, 978 F.2d at 1107.
\textsuperscript{153} Samsung's advertising agency.
\textsuperscript{156} See infra notes 187-89 and accompanying text.
\textsuperscript{157} Vanna White did not bring a copyright infringement action because her employer, Merv Griffin Enterprises, owns the copyright in Vanna White's performance. See infra notes 170-76 and accompanying text. The analysis is relevant, however, because were Samsung's parody defense not persuasive under 17 U.S.C. § 107, then the advertisement would amount to an infringement of copyright. However, because of the preemption clause of 17 U.S.C. § 301, that infringement cause of action would bar any alternative theory of recovery, such as Vanna White's publicity claim. See infra part IV.B.
ity was, in this case, equivalent to the exclusive rights granted to copyright owners, and therefore preempted by § 301 of the Copyright Act.\footnote{159. See id. § 301.}

A. Copyrightability of Wheel of Fortune and of Vanna White’s Performance

For a work to be protected by copyright, three elements are required: 1) there must be a work of authorship; 2) it must be “original”; and 3) it must be fixed in a tangible medium of expression.\footnote{160. Id. § 102(a).} Works of authorship include, but are not limited to, pictorial works,\footnote{161. Id. § 102(a)(5).} motion pictures and other audiovisual works,\footnote{162. Id. § 102(a)(6).} and dramatic works.\footnote{163. Id. § 102(a)(3).} Originality simply means that the work was independently created by the author and that it possesses some minimal amount of creativity.\footnote{164. Feist Publications Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991).} Fixation, as defined in § 101 of the Act, constitutes “embodiment in a copy . . . by or under the authority of the author [that] is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”\footnote{165. 17 U.S.C. § 101 (1988).}

Looking first to Wheel of Fortune, fixation occurs as soon as the television show is taped.\footnote{166. See id. § 101. “A work consisting of sounds, images, or both, that are being transmitted, is “fixed” for the purposes of this title if a fixation of the work is being made simultaneously with its transmission.” Id. Therefore, if a television show is broadcast on the air live but is being taped simultaneously for rebroadcast at a later time, fixation occurs simultaneously with the initial broadcast.} Additionally, telecasts and television programs contain the requisite originality and creativity to constitute “original works of authorship” within the meaning of § 102.\footnote{167. See, e.g., Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n, 805 F.2d 663, 669 (7th Cir. 1986) (holding that telecasts of major league baseball games are copyrightable); Time Inc. v. Bernard Geis Assocs., 293 F. Supp. 130, 144 (S.D.N.Y. 1968) (holding the Zapruder film of the Kennedy assassination was copyrightable).}

Therefore, it is clear that a copyright exists in the Wheel of Fortune television show and that both Samsung’s parody defense and Vanna White’s publicity claim should have been analyzed in light of the exclusive rights in Wheel of Fortune granted to Merv Griffin Enter-
prizes as owner of the copyright in *Wheel of Fortune.*\(^{163}\)

Vanna White's performance as hostess is similarly fixed in copies of each of her performances of that role on *Wheel of Fortune.*\(^{169}\) If her performance on the show also constitutes an original work of authorship, then a copyright would also exist in each of her performances as the *Wheel of Fortune* hostess.\(^{170}\)

In *Baltimore Orioles v. Major League Baseball Players Ass'n,*\(^{171}\) the Players Association argued that the players' performances in the televised baseball games were not copyrightable works because they lacked sufficient artistic merit to be considered "original works of authorship."\(^{172}\) The court disagreed, noting that "[o]nly a modicum of creativity is required for a work to be copyrightable," and aesthetic merit is not necessary for copyrightability.\(^{173}\) The court went on to note that the fact that the player's performances possessed great commercial value to the public indicated that the minimum creativity needed for copyrightability was present.\(^{174}\) Another commentator noted "[i]f copyright can cover an entire football game, [for

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168. See supra note 136. The parody defense was analyzed by the Ninth Circuit strictly in terms of First Amendment protection without addressing the issue of a fair use defense under the Copyright law. See White, 971 F.2d at 1401 n.3 (holding that "garden variety" commercial speech such as Samsung's is not protected by the First Amendment from a publicity claim). However, the commercial nature of a parodying work is not a bar to protection as a fair use under the copyright law. See infra text accompanying note 205. Moreover, no additional First Amendment analysis is required beyond the application of the fair use test in § 107 of the Copyright Act.

169. White's identity—her look as the hostess of *Wheel of Fortune*—is definitely fixed: It consists entirely of her appearances in a fixed, copyrighted TV show. *White,* 989 F.2d at 1518 n.26 (Kozinski, J., dissenting); see also Randall T.E. Coyne, *Toward A Modified Fair Use Defense In Right Of Publicity Cases,* 29 WM. & MARY L. REV. 781, 808 (1988) (noting that "to the extent that a performance has been reduced to a tangible means of expression—for example, film or record—the sole remedy for infringement is provided by the federal copyright law").

171. 805 F.2d 663 (7th Cir. 1986).
172. Id. at 669 n.7.
173. Id.
174. Id. (citing Justice Holmes: "[I]f . . . [certain works] command the interest of any public, they have a commercial value—it would be bold to say they have not an aesthetic and educational value—and the taste of the public is not to be treated with contempt." *Bleistein v. Donaldson Lithographing Co.,* 188 U.S. 239, 252 (1903)).
example] then certainly it can cover the game's constituent elements, including the expressive moves of individual players.\(^{175}\) It is clear from this analysis that Vanna White's performance as hostess is sufficiently original to her\(^{176}\) and creative enough to constitute a copyrighted performance.

1. Ownership of the Copyright in Vanna White's Performance

The ownership of the copyright in Vanna White's performances on *Wheel of Fortune* is another issue that should be addressed briefly. If a copyrighted work is prepared by an employee within the scope of her employment, then that work will be considered a "work for hire."\(^{177}\) Section 201(b) of the Copyright Act states that for "a work made for hire, the employer . . . for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all the rights comprised in the copyright."\(^{178}\) In *Baltimore Orioles*, the court held that "[b]ecause the [baseball] Players are employees and their performances before broadcast audiences are within the scope of their employment, the telecasts of major league baseball games, which consist of the Players' performances, are works made for hire within the meaning of § 201(b)."\(^{179}\) Similarly, since Vanna White's performance is on a program that is aired on television and the entire purpose of her employment is to perform on this fixed, copyrighted program, Vanna White's performance is likewise a work for hire within the meaning of § 201(b). Therefore, unless her employment contract has specific, express language to the contrary, the copyright in her performance, and attendant exclusive rights, is owned by Merv Griffin Enterprises.\(^{180}\) As will be shown later, the


\(^{178}\) 17 U.S.C. § 201(b) (1988); see also Baltimore Orioles v. Major League Baseball Players Ass'n, 805 F.2d 663, 671 (7th Cir. 1986); MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 5.03[D] (1981).

\(^{179}\) Baltimore Orioles, 805 F.2d at 670.

\(^{180}\) 17 U.S.C. § 201(b) (1988); see also NIMMER, supra note 178, § 5.03[D] (parties
copyright in Vanna White’s performance should have preempted her publicity claim in this case. However, if this is a work for hire, then only Merv Griffin Enterprises, not Vanna White, could have brought a copyright infringement claim leaving Vanna White with no cause of action. Indeed, Vanna White attempted to join Merv Griffin Enterprises as a co-plaintiff in this suit, but Merv Griffin Enterprises declined.

2. Exclusive Rights of the Copyright Owner

The owner of a copyright has a number of exclusive rights, including the rights to reproduce the copyrighted work and to prepare derivative works based upon the copyrighted work. The majority, in reaching its decision in White, did not analyze what effect Samsung’s advertisement and Vanna White’s publicity claim had on these exclusive rights.

A derivative work is defined as “a work based upon one or more preexisting works, such as a[n] . . . art reproduction . . . or any other form in which a work may be recast, transformed or adapted.” Under this definition, the Samsung advertisement, which included a Wheel of Fortune game show set with a robot dressed in a wig, gown and jewelry in the spot where Vanna White would normally stand, constitutes a derivative work of both the copyright in the Wheel of Fortune television show itself and the copyright in Vanna White’s performance on Wheel of Fortune. Since § 102 grants the exclusive right to create derivative works to the owner of

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181. See infra text accompanying notes 228-50.
182. Telephone Interview with Michael B. Garfinkel, Attorney, Pillsbury Madison & Sutro, counsel for defendants (Feb. 8, 1994).
184. Id. § 106(1).
185. Id. § 106(2); see also White, 989 F.2d at 1517-18 (Kozinski, J., dissenting) (noting that federal Copyright law gives the copyright owner the exclusive right to create or license any parodies that borrow too much of the original work to qualify as a “fair use”).
186. White, 971 F.2d at 1396.
188. White, 971 F.2d at 1396.
189. The Samsung advertisement is a derivative work because it is copyrightable itself. The advertisement is fixed in the copies of the magazines in which it was published, and the copyright extends to that material in the advertisement contributed by Samsung (i.e., the robot, layout, etc.) as distinguished from the preexisting material employed in the work. 17 U.S.C. § 103(b) (1978).
these copyrights (Merv Griffin Enterprises) and since Samsung did not receive a license or permission from Merv Griffin Enterprises to prepare this derivative work, the advertisement amounts to infringement of those copyrights, unless a permissive use exists.

3. Samsung’s Parody Defense Under Copyright Law

In copyright law, it is recognized that not every unauthorized use of a copyrighted work constitutes infringement. Rather, certain permissible “fair uses” exist. A parody of a copyrighted work has been held to be a fair use, provided it meets the requirements set forth in § 107 of the Copyright Act of 1976. Parody is defined as “a form or situation showing imitation that is faithful to a degree but that is weak, ridiculous or distorted.” Therefore, by definition, in order to be recognized as a parody, the work must cause the “viewer to ‘recall or conjure up’ the original work . . . .” “A parody must convey two simultaneous—and yet contradictory—messages: that [the imitation] is the original, but also that it is not the original and is instead a parody.” Based on this definition, the Samsung advertisement could be seen as either a parody of Wheel of Fortune itself or of Vanna White’s performance on that program.

As a general rule, parodies and satire are given substantial freedom and legal protection, both as a form of entertainment and of social criticism, because “many a true word is indeed spoken in

191. Consider, for example, Wheel of Fortune or Vanna White’s performance on Wheel of Fortune. See supra text accompanying notes 168-69.
193. WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY 1643 (1976).
194. Berlin, 329 F.2d at 544.
Parody serves a useful function in society by "build[ing] upon the original, using the original as a known element of modern culture and contributing something new for humorous effect or commentary." In *White*, however, the court dismissed defendant's parody defense on First Amendment grounds. The court held that since the advertisement was commercial speech, in that it was designed to sell Samsung video cassette recorders, it was a "knock off" which was not protected by the First Amendment, as opposed to a non-commercial "parody" which apparently could be protected under the First Amendment. By focusing solely on the commercial nature of the Samsung advertisement, the court dismissed the parody defense without analyzing its applicability as a fair use under the copyright law. An analysis of Samsung's parody defense under the copyright law will show that it is indeed arguable that the Samsung advertisement was a fair use of Vanna White's performance.

In § 107, a four-factor test is set forth for determining whether or not a parody (or any unauthorized use of a copyrighted work) constitutes a permissive fair use. The factors include:

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

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196. *Berlin*, 329 F.2d at 545.
198. See supra note 168.
199. *White*, 971 F.2d at 1401. Aside from the point that the commercial nature of a parody is taken into consideration under the first factor of the fair use test in § 107, see infra text accompanying note 205, the commercial nature of an advertisement should not preclude parody status.

In our pop culture, where salesmanship must be entertaining and entertainment must sell, the line between the commercial and the non-commercial has not merely blurred; it has disappeared. Is the Samsung parody any different from a parody on Saturday Night Live or in Spy Magazine? Both are equally profit-motivated. Both use a celebrity's identity to sell things - one to sell VCRs, the other to sell advertising. Both mock their subjects. Both try to make people laugh. Both add something, perhaps something worthwhile and memorable, perhaps not, to our culture. Both are things that people being portrayed might dearly want to suppress. *White*, 989 F.2d at 1520 (Kozinski, J., dissenting).

Subsequent to the *White* case, the Supreme Court handed down a decision in which it specifically held that a commercial parody may still constitute a fair use under § 107 and that a parody's commercial nature is only one element to be weighed in a fair use inquiry. *Campbell v. Acuff-Rose Music, Inc.*, 114 S.Ct. 1164 (1994).
the copyrighted work as a whole; and
4) the effect of the use upon the potential market for or value of
the copyrighted work. 200

In applying this test, the four factors are not to be rigidly ap-
plied. Instead, all four statutory factors are to be analyzed and their
results weighed together and viewed in light of the purposes and
policies underlying copyright law.201 The ultimate purpose of copy-
right is to "promote the [p]rogress of [s]cience and useful [a]rts
... ."202 Therefore, there has always been a recognition in the law
that some borrowing from earlier works must be allowed so that
people can build upon that which came before.203 It is in light of
this purpose that the fair use defense to copyright infringement de-
veloped and it must continue to be with this purpose in mind that the
fair use test is applied.204

Under § 107 fair use analysis, unlike traditional First Amend-
ment analysis, the commercial nature of Samsung’s infringing use is
not dispositive.205 The commercial nature of the use merely goes to
the first of the four factors listed in § 107. Under the recent holding
of the Supreme Court in Campbell, the focus when analyzing the first
fair use factor should be to determine whether the purpose of the
infringing use is to supplant the original or, instead, to alter the ori-
ginal with a new message or meaning.206 The more the purpose of
the parodying work is to alter the original, or provide a different mes-
sage, the less the commercial nature of the parody will weigh against
a finding of fair use.207 Thus, based on the Supreme Court’s most
recent interpretation of § 107, the commercial nature of the Samsung
advertisement would not likely be dispositive, as the message of the
advertisement (the long-running dependability of Samsung products) is

201. Campbell, 114 S.Ct. at 1170.
203. See White, 989 F.2d at 1515 (Kozinski, J., dissenting) ("All creators draw in part on
the work of those who came before, referring to it, building on it, poking fun at it; we call
this creativity, not piracy."); see also Campbell, 114 S.Ct. at 1169 (quoting Emerson v.
Davies, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436)) ("In truth, in literature, in sci-
ence and in art, there are, and can be, few, if any, things, which in an abstract sense, are
strictly new and original throughout. Every book in literature, science and art, borrows, and
must necessarily borrow, and use much which was well known and used before.").
204. Campbell, 114 S.Ct. at 1170 n.10.
205. Id. at 1174.
206. Id. at 1171.
207. Id.
different from the message of the original (the popularity of Vanna White and *Wheel of Fortune*).

Analysis of the second factor (the nature of the copyrighted work) calls for recognition of the fact that certain types of works are entitled to greater copyright protection than others. Thus, fair use will be more difficult to establish when these types of works are copied. For example, unpublished works are favored over published works, and fictional works over factual ones. However, this factor is not likely to be determinative in a parody case, "since parodies almost invariably copy publicly known, expressive works."

A parodist will likely prevail on the third factor of the fair use test provided that the amount and substantiality of the portion of the original used is only the minimum necessary to "conjure up" the original. Once enough of the original has been taken to let the audience recall the object of the parody (e.g., Vanna White) how much more is allowable depends on the extent to which the "overriding purpose . . . is to parody the original or, in contrast, the likelihood that the parody may serve as a market substitute for the original." Applying this third factor to the facts in *White*, it is clear that a *Wheel of Fortune* set that included a robot standing in Vanna White's familiar spot in a wig, jewelry and evening gown is sufficient for audiences to realize that it is a spoof of Vanna White's performance on *Wheel of Fortune*. As Judge Kozinski noted, it is impossible to parody a television show (in this case *Wheel of Fortune*) without at the same time evoking the identities of the actors. "No one seeing the ad could have thought this was supposed to be [Vanna] White in 2012." However, audiences clearly would

208. See id. at 1175.
209. See Salinger v. Random House, Inc., 811 F.2d 90, 95-96 (2d Cir. 1987). But see New Era Publications v. Henry Holt & Co., 873 F.2d 576, 583 (2d Cir. 1989) (upholding district court's refusal to grant injunction against publication of unpublished material but on different grounds, i.e., that plaintiff was barred by laches).
211. *Campbell*, 114 S.Ct. at 1175.
213. *Campbell*, 114 S.Ct. at 1176.
214. *White*, 989 F.2d at 1518 (Kozinski, J., dissenting). Judge Kozinski goes on to give the example of a spoof of *STAR WARS* such as Mel Brooks's *SPACEBALLS*. "You can't have a mock *STAR WARS* without a mock Luke Skywalker, Han Solo, and Princess Leia, which in turn means a mock Mark Hamill, Harrison Ford, and Carrie Fisher." Id.
215. Id. at 1514.
think that this represented what *Wheel of Fortune* would be like in 2012. Additionally, there is no likelihood that the Samsung advertisement would be seen as a market substitute for Vanna White or *Wheel of Fortune*, so it would appear likely that the third factor would favor Samsung.

The fourth factor in the fair use analysis is “the effect of the [parody] upon the potential market for or value of the copyrighted work.”216 This includes the potential market not only of the original but for derivative works as well.217 With regard to a parody, “the economic effect . . . with which we are concerned is not [the parody’s] potential to destroy or diminish the market for the original—any bad review can have that effect—but rather whether it *fulfills the demand* for the original.”218 Indeed, it is likely that a parody will not affect the market for the original in any significant way that is recognizable under the Copyright Act because the original and the parody serve different market functions.219 In this case, the robot does not fulfill the demand for Vanna White in the marketplace or in the role of hostess, nor does the advertisement fulfill the demand for *Wheel of Fortune*. As discussed above,220 Vanna White’s performance was not appropriated in order to endorse Samsung videocassette recorders. Rather, her hostess role was a necessary incident to an accurate depiction of the *Wheel of Fortune* television show. This single spoof of Vanna White will not have the effect of replacing Ms. White in the future. *Wheel of Fortune* will not now seek to replace Ms. White with a robot on the game show, and future advertisers seeking to use Vanna White as a celebrity endorser will not seek to replace her with the robot used by Samsung.221 Based on this analysis, if a suit had been brought for infringement of the copyright in Vanna White’s performance on *Wheel of Fortune*, Samsung would likely prevail under the four-factor test for fair use provided in § 107 of the Copyright Act. Thus, Samsung’s use of a robot would be

218. Fisher v. Dees, 794 F.2d 432, 438 (9th Cir. 1986).
220. See supra text accompanying notes 124-27.
221. That is not to say that no one else will parody or satirize Vanna White in their own advertisements, but that is not the test for fair use. The issue is merely whether this use (this robot) will replace her.
found to be a permissible fair use of the accoutrements of Vanna White’s performance.\(^\text{222}\)

**B. Preemption of Vanna White’s Publicity Right by the Exclusive Rights Found Under Copyright Law**

If Samsung's advertisement is a fair use of Vanna White’s performance, then there is no infringement of the copyright in that performance and the Samsung advertisement would be allowed under copyright law. Therefore, by allowing Vanna White’s state publicity claim in this case the Ninth Circuit has restricted a fair use of her performance that otherwise would be allowable under the federal Copyright Act. As a result, the Ninth Circuit may have run afoul of the preemption clause of the Copyright Act,\(^\text{223}\) because rights granted under state law cannot conflict with the operation of the laws on patent and copyright passed by Congress.\(^\text{224}\)

Section 301(a) of the Copyright Act states that:

\[
\text{[A]ll legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103 . . . are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.}\(^\text{225}\)
\]

Therefore, the question under § 301 is whether Vanna White’s right of publicity claim in this case was equivalent to the exclusive rights that the copyright owner has in Vanna White’s performance

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\(^{222}\) At least one other commentator has argued against the use of fair use analysis with right of publicity claims. Hetherington argues that it is impractical to apply the four factor test in a business environment populated by advertisers, entertainment conglomerates, entertainment attorneys and celebrities. He feels that in the publicity right context, the flexibility and subjectivity of the four factor test makes it ineffective. *See* Hetherington, *supra* note 69, at 28-29.


By refusing to recognize a parody exception to the right of publicity, the [majority] directly contradicts the federal Copyright Act. Samsung didn’t merely parody Vanna White. It parodied Vanna White appearing in “Wheel of Fortune,” a copyrighted television show, and parodies of copyrighted works are governed by federal copyright law.

*White*, 989 F.2d at 1517 (Kozinski, J., dissenting).


under § 106, and, if so, whether her right of publicity, in this case, should therefore be preempted by § 301.  

Section 301 . . . may preempt right of publicity interests that involve more than an individual’s interest in his name or likeness. Other aspects of an individual’s persona can become products with substantial pecuniary value that can be embodied in tangible media of expression . . . . Resulting interests may constitute “fixed works of authorship.” When value attaches to a physical rendering, publicity rights in the product may be subject to regulation under the copyright clause and preemption under section 301 of the 1976 Act. Section 301, in short, may preempt state publicity rights if they resemble those protected by copyright.

1. Preemption Where the Right of Publicity is Equivalent to the Exclusive Right to Reproduce Vanna White’s Performance in a Derivative Work

A right, such as a right of publicity, is equivalent to one of the rights enumerated in § 106 of the Copyright Act if it is “infringed by the mere act of reproduction [in either original or derivative form], performance, distribution or display.” In this case, the Ninth Circuit’s holding that Vanna White stated a valid right of publicity claim was based solely on Samsung’s act of reproducing, in derivative form, Vanna White’s copyrighted performance (i.e., by creating the robot advertisement). Therefore, her publicity action should properly have been preempted.

In Baltimore Orioles, the court held that, like Vanna White’s performance on Wheel of Fortune, major league baseball players’ performances in baseball games were fixed in the telecasts of the

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228. Baltimore Orioles, 805 F.2d at 677 (quoting 1 MELVILLE B. NIMMER & DAVID N. NIMMER, NIMMER ON COPYRIGHT, § 101(B)(1), at 1-14 (1993); see also Donald Frederick Evans & Assoc., Inc. v. Continental Homes, Inc., 785 F.2d 897, 914 (11th Cir. 1986); Ehat v. Tanner, 780 F.2d 876, 878 (10th Cir. 1985).

229. See White, 989 F.2d at 1518 n.26 (Kozinski J., dissenting) (noting that “Vanna White’s identity—her look as the hostess of Wheel of Fortune—is definitely fixed: It consists entirely of her appearance in a fixed copyrighted show.”).
games.\textsuperscript{230} Any rights that the players had in those fixed performances that were the equivalent of the rights encompassed in the Copyright Act were preempted.\textsuperscript{231} Had the baseball games not been recorded for television when played, the players' performances would not be fixed; and thus their rights of publicity would not have been subject to preemption since the fixation requirement for copyright would not be met.\textsuperscript{232}

Similarly, if \textit{Wheel of Fortune} were performed in front of a studio audience and was never taped or broadcast on television, and thus was not fixed, Vanna White's publicity claim would not be preempted. An analogous case was decided by the Supreme Court in \textit{Zachinzi v. Scripps-Howard Broadcasting Co.}\textsuperscript{233} In \textit{Zachinzi}, the plaintiff performed a fifteen-second human cannonball act in which he was shot from a cannon into a net 200 feet away.\textsuperscript{234} Without the plaintiff's consent, a reporter videotaped his entire performance and broadcast it on television the same day. The plaintiff sued for violation of his publicity right, claiming that the broadcast of his entire act posed a substantial threat to the economic value of his performance: if the public could see the act on television, it would be less likely to pay to see his performance live.\textsuperscript{235} The Supreme Court upheld the publicity claim,\textsuperscript{236} but there was no preemption issue. The performance was not copyrightable since it had never been fixed by videotaping or other recording device. If, however, Zachinzi had fixed his performance by recording it for later broadcast and subsequently, a reporter taped his act and showed it on television, the performance would be protected by copyright and Zachinzi would have an infringement action for violation of his exclusive right to reproduce his copyrighted work under § 106.\textsuperscript{237} Since Zachinzi's right of publicity claim would then be equivalent to his exclusive right under § 106, it would be preempted under § 301.\textsuperscript{238}

By performing the same analysis with the facts of \textit{Lombardo},\textsuperscript{239}

\begin{itemize}
\item \textsuperscript{230} \textit{Baltimore Orioles}, 805 F.2d at 674; see also \textit{supra} text accompanying notes 160-65.
\item \textsuperscript{231} \textit{Baltimore Orioles}, 805 F.2d at 674.
\item \textsuperscript{232} \textit{Id.} at 675.
\item \textsuperscript{233} 433 U.S. 562 (1977).
\item \textsuperscript{234} \textit{Id.} at 563.
\item \textsuperscript{235} \textit{Id.}
\item \textsuperscript{236} \textit{Id.} at 578-79.
\item \textsuperscript{237} See \textit{Baltimore Orioles v. Major League Baseball Players Ass'n}, 805 F.2d 663, 675 n.22 (7th Cir. 1986).
\item \textsuperscript{238} \textit{Id.}
\item \textsuperscript{239} \textit{Lombardo v. Doyle, Dane & Bernbach, Inc.}, 396 N.Y.S.2d 661 (App. Div. 1977);
\end{itemize}
the appropriateness of preempting Vanna White's publicity claim in this case can again be emphasized. Guy Lombardo, like Vanna White, sought protection under a right of publicity for appropriation of his performing style\textsuperscript{240} including his gestures, choice of music, movements as a conductor, etc.\textsuperscript{241} Lombardo's publicity claim was not preempted, because these attributes of his personality were developed over 40 years of performances and were not necessarily copyrighted. While some of his gestures and movements were fixed in given performances, as certain of his performances were taped over the years, countless other performances were given by Guy Lombardo that were not fixed in a tangible medium of expression and thus were not subject to copyright protection.\textsuperscript{242} Therefore, Lombardo's "carefully and painstakingly built public personality"\textsuperscript{243} did not consist solely of copyrighted performances. As such, his publicity claim was not equivalent to his exclusive rights in his copyrighted performances under § 106. Conversely, Vanna White's performances on \textit{Wheel of Fortune}, which were parodied by the robot in the Samsung advertisement, were all subject to copyright because they were all fixed in the taped television show.\textsuperscript{244} Therefore, § 301 should properly preempt her publicity action.

The Ninth Circuit itself employed a similar line of reasoning when it addressed a preemption argument raised by defendant Frito-Lay in \textit{Waits}.\textsuperscript{245} Frito-Lay argued that Tom Waits' publicity claim should be preempted because the claim was equivalent to the rights found in § 114 of the Copyright Act.\textsuperscript{246} Section 114 provides the holder of a copyright in a sound recording with the exclusive right to duplicate the sound recording in a work that recaptures the actual sounds fixed in that recording.\textsuperscript{247} Frito-Lay's argument was that Waits' publicity claim against the use of a sound-alike was preempted by his exclusive right under § 114(b) in the actual sounds in his recordings.\textsuperscript{248} The Ninth Circuit rejected this argument, noting that

\begin{itemize}
  \item see \textit{supra} notes 85-91.
  \item Lombardo, 396 N.Y.S.2d at 664; Shipley, \textit{supra} note 226, at 711.
  \item Lombardo, 396 N.Y.S.2d at 664.
  \item See \textit{Shipley, supra} note 226, at 711.
  \item Lombardo, 396 N.Y.S.2d at 664.
  \item See \textit{supra} note 169.
  \item Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992).
  \item \textit{Id.} at 1099-1100; see 17 U.S.C. § 114 (1988).
  \item 17 U.S.C. § 114(b) (1988).
  \item \textit{Waits}, 978 F.2d at 1100.
\end{itemize}
§ 114 only provided rights in the actual recordings of Tom Waits’ songs and that a claim of voice misappropriation not based on the actual taking of his recordings was not equivalent to the rights afforded under the Copyright Act and thus not preempted.249 Had Frito-Lay actually used a Tom Waits’ sound recording in its commercial, rather than a sound-alike, then Waits would have had a claim under § 114, and his publicity claim would have been preempted.

Based on the rationale employed by the Ninth Circuit itself in *Waits*, Vanna White’s publicity claim should have been preempted. Ms. White claimed a violation of her publicity right based on Samsung’s unauthorized use of her persona as a performer on *Wheel of Fortune*. This performance is copyrighted,250 and the right to prepare a derivative work (such as the robot in the Samsung advertisement) based on that performance is listed in § 106 of the Copyright Act. Therefore, any claim that is based on this use of her performance is equivalent to the rights listed in the Copyright Act and should be preempted by copyright law.

2. Preemption Where Vanna White’s Publicity Right Claim Would Provide a Remedy not Allowed Under Copyright Law

Section 102(b) of the Copyright Act states that “[i]n no case does copyright protection for an original work of authorship extend to any idea . . . regardless of the form in which it is described, explained, illustrated or embodied in such work.”251 It is a fundamental principle of copyright law that a copyright does not protect an idea, but only an expression of the idea.252 For example, “[t]he copyright of a book on perspective, no matter how many drawings and illustrations it may contain, gives no exclusive right [to the copyright holder] to the modes of drawing described, though they may never have been known or used before.”253 Additionally, when a subject matter is so narrow that, by necessity, only one or a very limited number of expressions of that idea are possible, the idea and expression merge and a copyright will not be allowed because, if granted, it would give the copyright holder a monopoly that would

249. Id. at 1100.
250. See supra notes 169-76.
253. Id. at 103.
effectively exhaust all possibilities of future use of that idea by others.254

For example, in *Morrissey v. Proctor & Gamble Co.*,255 the plaintiff obtained a copyright in a set of rules for a promotional "sweepstakes" contest.256 Plaintiff sued the defendant for copyright infringement, claiming that the defendant had copied rule #1 of plaintiff's set of rules almost verbatim for use in its own "sweepstakes" contest.257 The court held that the sweepstakes contest rule was uncopyrightable because there are only a limited number of ways to state the idea verbalized in the rule.258 To allow the plaintiff to monopolize that rule would effectively bar anyone else from incorporating the idea behind the rule into their own sweepstakes contest.259

Judge Kozinski, in his dissenting opinion in *White*,260 criticizes the majority opinion on similar grounds:

I can’t publish unauthorized copies of, say, *Presumed Innocent*; I can’t make a movie out of it. But I’m perfectly free to write a book about an idealistic young prosecutor on trial for a crime he didn’t commit. So what if I got the idea from *Presumed Innocent*? So what if it reminds readers of the original? Have I “eviscerated” Scott Turow’s intellectual property rights? Certainly not. All creators draw in part on the work of those who came before, referring to it, building on it, poking fun at it; we call this creativity, not piracy.261

This example is a classic verbalization of the idea/expression concept that pervades copyright law.

Vanna White’s performance as hostess while dressed in an expensive gown and jewelry and standing on the *Wheel of Fortune* set is a copyrightable “expression” of the “idea” of the hostess on *Wheel of Fortune*. While the copyright in her performance262 grants exclusive rights in her own expression of the idea of a *Wheel of Fortune*

255. *Id.* at 675.
256. *Id.*
257. *Id.* at 676.
258. *Id.* at 678-79.
259. *Id.*
261. *Id.* at 1514-15.
262. Again, the copyright is owned by Merv Griffin Enterprises as Vanna White’s employer under § 201 of the Copyright Act, unless her employment contract contains express language to the contrary. *See supra* notes 177-82 and accompanying text.
hostess, those rights do not extend to all possible expressions of that idea.

In 1971, the Ninth Circuit held that "[w]hen the 'idea' and its 'expression' are . . . inseparable, copying the 'expression' will not be barred, since protecting the 'expression' in such circumstances would confer a monopoly of the 'idea' upon the copyright owner free of the conditions and limitations imposed by patent law." By allowing Vanna White to block the alternative expression of a hostess, in the form of a similarly costumed robot, the court essentially gives Vanna White a monopoly over the commercial use of the idea of the Wheel of Fortune hostess.

The Wheel of Fortune set . . . is not an attribute of Vanna White's identity. It is an identifying characteristic of a television game show, a prop with which Vanna White interacts in her role as the current hostess. To say that Vanna White may bring an action when another blond female performer or robot appears on such a set as a hostess will, I am sure, be a surprise to the owners of the show.

Since only expressions of ideas, not ideas themselves, are copyrightable, even the owner of the copyright in Vanna White's performance as hostess would not be able to block other expressions or performances on the show. As a result, Vanna White's publicity claim must be preempted because it provides a remedy not allowed under copyright law.

When an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article. To forbid copying would interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain.

If the owner of the copyright in Vanna White's performance on Wheel of Fortune can not bar the use of another expression under § 102(b), then Vanna White should be preempted from using an equivalent alternative legal theory, in this case the right of publicity.

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263. Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738, 742 (9th Cir. 1971).
264. White, 971 F.2d at 1405 (Alarcon, J., concurring in part, dissenting in part).
265. Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 237 (1963); see also Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 168 (1989) (holding that a Florida statute offering patent-like protection for ideas deemed unprotected under the present federal scheme is in conflict "with the 'strong federal policy favoring free competition in ideas which do not merit patent protection'" and thus is preempted).
to achieve the same result. 266

3. Preemption Based on Equivalent Exclusive Rights in the Copyright in the Wheel of Fortune Game Show

In addition to the exclusive rights granted to the owner of the copyright in Vanna White’s performance, 267 an additional set of rights accompany the copyright in the Wheel of Fortune game show itself. 268 Merv Griffin Enterprises, as owner of that copyright, enjoys both the exclusive right to reproduce Wheel of Fortune 269 and to make derivative works based on the game show. 270 Although not an immediate issue, because Merv Griffin Enterprises was not a party to this lawsuit, 271 it would appear that after White, Vanna White’s publicity right improperly limits both of these exclusive rights and, as a result, is subject to preemption under § 301.

Suppose that, instead of Samsung, Merv Griffin Enterprises wanted to create an advertising campaign celebrating the enduring popularity and success of Wheel of Fortune 272 and as a result created an advertisement identical to the Samsung ad (i.e., a robot in a gown, wig and jewelry on a Wheel of Fortune set with a caption reading “[l]ongest-running game show. 2012 A.D.”). 273 Based on the White holding, Merv Griffin Enterprises would have violated Vanna White’s publicity right because, by using the robot, it would have appropriated aspects of Vanna White’s persona without her permission in order to promote its product (Wheel of Fortune). 274 However, under copyright law, Merv Griffin Enterprises would be completely within its rights, since the advertisement would be a derivative work based on its copyrighted game show. 275 Clearly, this is a conflict between a right under copyright law and Vanna White’s publicity claim. Since, under

266. See Bonito Boats, Inc., 489 U.S. at 156 (holding that “[s]tates may not offer patent-like protection to intellectual creations which would otherwise remain unprotected as a matter of federal law”).
267. See supra text accompanying notes 183-85.
268. See supra text accompanying note 168.
270. Id. § 106(2).
271. See supra text accompanying note 182.
272. Wheel of Fortune has been the most successful syndicated television program over the past decade. It has been the highest rated syndicated program on television for the past 38 sweeps periods, dating back 9 1/2 years. Mike Freeman, King World Still King of Cassandras, BROADCASTING & CABLE, July 5, 1993, at 49.
273. See White, 971 F.2d at 1396.
274. Id. at 1398-99.
§ 301(a), Vanna White is not entitled to any state law right equivalent to Merv Griffin Enterprises' exclusive right to make this derivative work, her claim should be preempted.276

V. CONCLUSION

The Ninth Circuit's holding in White that Vanna White stated a valid right of publicity claim is troubling on a number of levels. Upholding a publicity right claim where a robot, in an advertisement parodying a popular television program, wears jewelry and clothing similar to that worn by a celebrity when performing her role on that television program, is the most expansive application of the right of publicity to date. This holding not only expands the publicity right beyond the prior case law but also beyond the scope of the policies underlying the doctrine.

Further, the majority in White did not consider the applicability of copyright law when analyzing Vanna White's publicity right claim. Copyrights exist in both Wheel of Fortune and in Vanna White's performance in the role of hostess which provide exclusive rights, including the right to create derivative works. Since the Samsung advertisement constitutes a derivative work, a claim could have been brought for infringement of Vanna White's copyrighted performance. However, since that performance was within the scope of her employment, it is a work-for-hire, and the copyright is owned by Merv Griffin Enterprises, not Vanna White. One defense to a copyright infringement claim is fair use under § 107 of the Copyright Act. By dismissing Samsung's parody defense strictly on the commercial nature of the advertisement, the Ninth Circuit failed to apply the four-factor test for fair use in § 107. Based on this test, it would appear that the Samsung advertisement is a fair use and thus is allowable under copyright law.

If Samsung's advertisement is allowable under copyright law, the issue then becomes whether Vanna White's publicity right claim barring that use should have been preempted under § 301 of the Copyright Act. This Comment determines that Vanna White's publicity claim should have been preempted on three bases. First, the aspects of Vanna White's identity allegedly appropriated in the Samsung advertisement consist solely of her clothing style and attire only worn during her copyrighted performances. Therefore, her right

276. 17 U.S.C. § 301(a) (1988); see also notes 264-65 and accompanying text.
of publicity claim is equivalent to a claim of copyright infringement for violation of the exclusive right to prepare derivative works based on those performances and thus should be preempted.

Second, the copyright in Vanna White's performances is limited only to her own expression of the role of hostess on *Wheel of Fortune* and not to the entire idea of a hostess on *Wheel of Fortune*. As a result, Vanna White can not use an alternative legal theory, in this case the right of publicity, to subsequently obtain a monopoly over the entire idea. Under the present holding, Vanna White has obtained the equivalent of a copyright in the idea of a hostess, and since ideas are not protectable by copyright, any alternative legal theory providing that protection should be preempted.

Finally, Vanna White's publicity right provides her with rights equivalent to the exclusive rights that Merv Griffin Enterprises has in *Wheel of Fortune*. Merv Griffin Enterprises, as the copyright owner, has the exclusive right to create derivative works based on *Wheel of Fortune*. However, based on *White*, by doing so Merv Griffin Enterprises would be violating Vanna White's publicity right. By allowing this state cause of action, the Ninth Circuit has effectively undermined the exclusive rights granted to Merv Griffin Enterprises under the federal copyright law.

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