Washington and Lee Law Review

Volume 64 | Issue 2 Article 6

Spring 3-1-2007

Lose the Illusion: Why Advertisers' Use of Digital Product Placement Violates Actors' Right of Publicity

Brandon D. Almond

Lose the Illusion: Why Advertisers' Use of Digital Product Placement Violates Actors' Right of Publicity

Brandon D. Almond*

Table of Contents

I. Introduction 626

II. Digital Advances Have Forced Companies to Rely on Nontraditional Advertising Methods 628
A. An Introduction to Digital Product Placement 630
B. Americans Are Noticing the Product Placement Trend 632

III. Viewers and Artists May Have No Recourse Against Digital Product Placement 633
A. Consumer Requests for Product Placement Regulation Have Been Unsuccessful 633
B. Artists Have Not Had Much Success Either 635
1. The "Work Made for Hire" Exception to the Copyright Act 635
2. American Television Artists Currently Enjoy No Moral Rights Protection 637

IV. Future Implications of—and Possible Solutions to—Digital Product Placement 638

V. Digital Product Placement is an Attractive Advertising Alternative—But Not for Actors 640
A. Product Placements Can Create Implied Celebrity Endorsements 642

* Candidate for J.D., Washington and Lee University School of Law, May 2007; B.A., University of Virginia, 2003. I would like to thank Professor Thomas Cotter for his helpful insights throughout the development of this Note. I would also like to thank Laura Chernitsky Pyle and Kyle McNew for their invaluable guidance, and my family for their unwavering support.

B. Such Endorsements Could Clash With Actors' Wishes 643
C. Actors Cannot Easily Avoid These Problems Through Contract 644

VI. One Potential Solution: The Right of Publicity 646
A. An Overview of the Right of Publicity 646
B. Does Digital Product Placement Implicate the Right of Publicity? 651

VII: Federal Preemption: The Right of Publicity and the Copyright Act 652
A. Right of Publicity Claims Preempted 653
B. Right of Publicity Claims Not Preempted 655

VIII. The Copyright Act Will Not Preempt Properly Crafted Right of Publicity Claims 659
A. How Actors Can Successfully Assert Their Right of Publicity 660
1. Avoid the Subject Matter and General Scope Prongs of the Copyright Act 660
2. Sue the Advertiser for Misuse of the Non-copyrightable Persona 663
B. Addressing Potential Counter-arguments 666

IX. Conclusion 670

I. Introduction

Jennifer Aniston is a well-known actress who rose to stardom by portraying the fictional character Rachel Green on the popular television series *Friends*. As she became more of a household name, the commercial value of her identity increased such that companies were willing to pay her to appear in their advertisements or on the packaging of their products. Traditionally, these companies would work with Aniston up front in order to create an endorsement deal suitable to both parties. Aniston would remain free to bargain for her own terms or even to reject advertising contracts outright. When *Friends* ended, Aniston went on to star in many Hollywood movies and has continued to enter into deals whereby companies use her image to help sell their products. The world of advertising is changing, however, and Aniston may soon help companies sell their products in endorsements which she never approved of—nor even knew were going to take place.

Modern technological advances—such as digital recording devices like TiVo, online television episodes, and downloadable shows—now allow viewers to bypass traditional television advertisements and thus watch programs like *Friends* without commercial interruption. As a result, companies are starting to market their merchandise in formats other than the traditional thirty-second commercial. One such method, digital product placement, can take place without viewers—or actors—ever recognizing that it has occurred. Although product placement has long been used in television shows, usually to the knowledge of consumers and actors alike, digital product placement is a more recent phenomenon that poses many potential problems for actors like Aniston because it occurs after filming is complete. This Note addresses many of these issues and concludes that, if actors like Aniston properly craft their arguments, they can claim that a company's use of digital product placement has violated their right of publicity.

Part II of this Note discusses the advent of digital technology that enables viewers to skip traditional commercials and notes how companies have responded by turning to alternative advertising methods such as digital product placement.[1] Part III outlines some reasons why consumers and artists may not have much legal ammunition against digital alterations to television shows: (1) past consumer calls for product placement disclosure have failed; (2) the "work made for hire" doctrine of the Copyright Act ensures that television studios rather than actors own the copyright in an actor's performance; and (3) actors currently enjoy no moral rights protection in the United States.[2] In Part IV, this Note addresses some of the potential implications of digital product placement and notes a few solutions that commentators have previously suggested.[3] Part V, however, points out that despite these suggestions, digital product placement is growing ever more beneficial for television studios and advertisers but provides no corresponding benefits for actors.[4] Thus, in Part VI, this Note provides an overview of the right of publicity in order to determine whether actors can rely on this doctrine to fight troublesome digital product placements.[5] Part VII evaluates whether the Copyright Act preempts an actor's

1. *See infra* Part II (discussing the rise of digital video recorders and the response from advertisers, and noting other methods in which viewers can watch television shows commercial-free).

2. *See infra* Part III (outlining ways in which both consumers and artists may not have recourse against product placement and digital alterations).

3. *See infra* Part IV (noting the various problems digital product placement could pose for actors and a few solutions that scholars have offered).

4. *See infra* Part V (noting that digital product placement is both cost effective and easy to use for studios but provides no gains to actors).

5. *See infra* Part VI (outlining the right of publicity).

state law right of publicity claim and concludes that in certain situations, it does not do so.[6] Finally, Part VIII concludes that to bring successful right of publicity claims, actors will have to sue the advertising companies instead of the television studio. Doing so will ensure that actors avoid federal preemption, while guaranteeing that they receive some recourse in light of the onslaught of digital product placement.[7]

II. Digital Advances Have Forced Companies to Rely on Nontraditional Advertising Methods

The last century has seen technological growth in nearly every realm of life, from the birth of the Internet to electric cars to satellite radio. The world of television has experienced numerous technological advances as well. Since the inception of TiVo in 1997,[8] digital video recorders (DVRs) have quickly become a staple in many U.S. households.[9] One significant reason consumers prefer this technology is because it gives them the ability to skip commercials that appeared in a show's original broadcast.[10] And given Americans' increased reliance on and exposure to technology as a part of everyday life, the digital recording trend will not slow any time soon.[11] Complementing this

6. *See infra* Part VII (discussing cases in which federal copyright law has and has not preempted state right of publicity claims and concluding that, because a performance is distinguishable from an actor's underlying persona, the Copyright Act will not always preempt an actor's right of publicity claim).

7. *See infra* Part VIII (concluding that to avoid copyright preemption, actors will have to bring suit against the companies that misappropriate their images, rather than the television studios that allow such digital alterations to occur).

8. *See* TiVo Inc., TiVo Investor Relations, http://investor.tivo.com/ (last visited Mar. 26, 2007) (providing investment information) (on file with the Washington and Lee Law Review). TiVo and other similar digital recording devices automatically find and digitally record hundreds of hours of programming, storing the programs on an internal hard drive; they also allow viewers to pause, rewind, and watch live television in slow motion. See Wikipedia.org, TiVo, http://en.wikipedia.org/wiki/Tivo (last visited Mar. 26, 2007) (on file with the Washington and Lee Law Review), for a comprehensive overview of TiVo and other DVR technology.

9. A business research firm recently conducted a survey in which it found that 15% of consumers own DVRs. Amy Johannes, *Product Placements Lags Behind TV Spots: Survey*, PROMO, Aug. 24, 2005, http://promomagazine.com/news/prod-placement_survey_082405/index.html [hereinafter *Product Placements*] (on file with the Washington and Lee Law Review).

10. *See id.* ("Sixty-two percent of [survey] respondents said they used digital recording devices so they don't have to watch commercials; 55% said they use the device to watch the program faster by eliminating commercials.").

11. *See* Amy Johannes, *Starring Role*, PROMO, Apr. 1, 2005, http://promomagazine.com/

trend, viewers can now watch many of their favorite television shows online,[12] or, in the alternative, download commercial-free episodes onto their computers or portable media players (e.g., iPods or even cell phones) for a small charge.[13] This practice shows no signs of slowing either.[14]

Such digital advances do not solely impact television viewers. Because of the increased use of this commercial-skipping technology, advertisers have had to find new ways beyond the traditional thirty-second commercial to get their messages out. One alternative method advertisers are starting to use more frequently is that of product placement. As some commentators have observed,

---

mag/marketing_starring_role/index.html ("The use of TiVo to skip commercials is skyrocketing . . . . Most consumers suffer from the 'instant gratification takes too long' syndrome.") (on file with the Washington and Lee Law Review). As a testament to the changing trend in television viewing methods, TiVo recently held a mock funeral service for the VCR. Michael Singer, *TiVo Buries the VCR*, CNET NEWS.COM, Oct. 14, 2005, http://news.com.com/TiVo+buries+the+VCR/2100-1038_3-5895835.html (on file with the Washington and Lee Law Review).

12. *See, e.g.*, ABC.com, http://dynamic.abc.go.com/streaming/landing (last visited Mar. 26, 2007) (offering free episodes of several shows, including "LOST," "Grey's Anatomy," and "Desperate Housewives") (on file with the Washington and Lee Law Review); CBS Innertube, www.cbs.com (last visited Mar. 26, 2007) (offering free episodes of shows such as "CSI" and "Survivor") (on file with the Washington and Lee Law Review); NBC 24/7 Video, www.nbc.com (last visited Mar. 26, 2007) (offering free episodes of shows such as "30 Rock," "Friday Night Lights," and "The Apprentice") (on file with the Washington and Lee Law Review). Admittedly, most episodes begin with a brief commercial, and the webpage usually has content such as "this episode brought to you by Ford Motor Company." Additionally, some shows are split into segments, with each new segment featuring the same commercial that began the episode. These online broadcasts, nonetheless, are shorter than the original television broadcasts and feature far fewer commercial breaks.

13. *See, e.g.*, Apple-iTunes, http://www.apple.com/itunes/store/tvshows.html (last visited Mar. 26, 2007) (providing instructions on how to download TV shows—at a cost of $1.99—onto iTunes, for viewing on a computer, or uploading onto a portable media device such as an iPod) (on file with the Washington and Lee Law Review).

14. *See, e.g.*, Darryn Simmons, *TV Goes PC*, MONTGOMERY ADVERTISER, Nov. 27, 2005 (quoting a magazine editor as stating "[a]lternatives to traditional television viewing are getting to be more and more popular"); Tom Abate & Ellen Lee, *Tech Chronicles: A Daily Dose of Postings from the Chronicle's Technology Blog*, SAN FRANCISCO CHRONICLE, Aug. 15, 2006, at D1 (noting that FOX recently offered episodes of "24" on MySpace.com, a website which has about 75 million users); *Downloading 2006 Trends: What's Next*, THE TORONTO STAR, Jan. 2, 2006, at D1. The article states:

> Whether played on your video iPod, computer, or plasma TV set, easily downloadable television shows are yet another threat to the broadcasting world, which must also contend with video-capable mobile phones, video on demand and digital video recorders. . . . The good news is that . . . you can still . . . go aggressive with product placement.

Id. See also TV Show Tracker, www.tvshowtracker.com (last visited Mar. 26, 2007) (allowing users to select to be notified when any of the hundreds of shows listed become available for download on iTunes) (on file with the Washington and Lee Law Review).

"[t]he onslaught of ad-skipping technology has sent spending on product placement skyrocketing."[15] Indeed, over the last few years the number of advertising firms doing product placement has jumped from just a handful to over 600.[16] Furthermore, one market research firm recently found that the value of television product placement jumped 46.4% to $1.87 billion in 2004, and predicted that the trend will likely continue due to the "growing use of [DVRs] and larger placement deals as marketers move from traditional advertising to alternative media."[17] In fact, over 100,000 product "cameos" appeared on prime-time network television during the 2004–2005 season alone.[18] In addition to increasing their use of product placements, advertisers have also begun employing an even newer advertising method—digital product placement.

A. An Introduction to Digital Product Placement

Although product placement has been around in some form for years, this Note will focus on the more recent merchandising trend of digital product placement.[19] This advertising format essentially fights fire with

---

15. *For 29%, Recording a TV Show Means Skipping Ads: Study*, PROMO, Mar. 30, 2005, http://promomagazine.com/news/breakingnews/TVadskipping/index.html (on file with the Washington and Lee Law Review); *see also* Jube Shiver Jr., *FCC Asks for Help on Stealth TV Ads*, L.A. TIMES, June 15, 2005, at C3 ("With digital video recorders allowing viewers to skip commercials, TV advertisers have increasingly turned to product placements in dramas and situation comedies as a more effective way to reach viewers."); Amy Johannes, *TV Placements Overtake Film*, PROMO, May 1, 2005, http://promomagazine.com/entertainmentmarketing/marketing_tv_placements_overtake/index.html ("Marketers are obviously extremely wary of ad-stripping technologies and this is only going to . . . increase the role of product placement . . . to compensate for the perceived diminished effectiveness of the 30-second television spot.") (on file with the Washington and Lee Law Review).

16. *See Evaluating Product Placement for TV Nets, International Distribution*, VIDEO AGE INT'L, May 2004, http://www.videoageinternational.com/articles/2004/05/article1.html (discussing the increased use of product placements in television) (on file with the Washington and Lee Law Review).

17. *See* Johannes, *TV Placements Overtake Film, supra* note 15 (quoting a marketing association president as saying "product placement is the biggest thing to hit the advertising industry in years," and noting that PQ Media predicts the value of product placement will grow at a compound rate of 14.9% to reach $6.94 billion by 2009).

18. *See Deals That Will Change Everything (Maybe)*, ENT. WKLY., Oct. 28, 2005, at 52 (noting the increase in product placement deals, including a $200 million agreement between Volkswagen and NBC Universal for the placement of Volkswagen's automobiles in NBC Universal's movies, television shows, and even theme parks).

19. *See* Pamela A. MacLean, *The New IP Battlefront: Product Placement*, NAT'L L.J., May 23, 2005, at P4 (noting that product placement began with Katherine Hepburn's character dumping Gordon's gin overboard in *The African Queen*). Digital product placement also has

fire, using digital technology to combat the rise in commercial-skipping digital recording devices and downloadable television shows. Digital product placement occurs when advertisers insert images of products into television shows after they have already been filmed, in scenes where originally there appeared an unbranded product or none at all.[20] This technology has been used for years to superimpose a yellow first-down line into football broadcasts or to insert product logos behind home plate during televised baseball games.[21] In the context of television shows, the technology can be used when the show is first broadcast or when it is in off-network syndication.[22] For example, Warner Brothers Domestic Television Distribution (Warner Bros.) has entered into deals with advertisers for digital product placement in syndicated sitcoms including *Friends*, *Will & Grace*, and *The Drew Carey Show*.[23] Additionally, one advertising company has already booked scenes (where at least six seconds of footage is available) in most of Warner Bros.' sitcoms; the scenes typically include video of kitchen counters, desks, coffee tables, or portray characters holding unbranded products.[24] Digital product placement is indeed making headway in the industry; in fact, one Warner Bros. executive predicted that a host of products could be inserted and stated that the studio views the practice as a growing profit center alongside its traditional advertising sales business.[25]

---

been referred to as "virtual product placement" and "digital branded integration," but for consistency's sake, this Note will use the term "digital product placement."

20. *See* Wayne Friedman, *Virtual Placement Gets Second Chance*, ADVERTISING AGE, Feb. 14, 2005, at 67 (discussing efforts to incorporate digital product placement into television).

21. *Id.*

22. *See* Sam Lubell, *Advertising Twilight Zone: That Signpost up Ahead May Be a Virtual Product*, N.Y. TIMES, Jan. 2, 2006, at C1 (discussing the possibilities of digital product placement).

23. Friedman, *supra* note 20, at 67. For examples of digital product placement, see Marathon Ventures, http://www.marathonventures.com/dbi-slide_show.html (last visited Mar. 26, 2007) (showing actual clips from a television show in which digital product placement has already occurred) (on file with the Washington and Lee Law Review); Princeton Video Image, http://www.pvi.tv/pvi/index.html (last visited Mar. 26, 2007) (displaying samples of the technology) (on file with the Washington and Lee Law Review).

24. Friedman, *supra* note 20, at 67. For example, one company's promotional reels showed David Schwimmer, who plays the character Ross on *Friends*, eating Oreos where before he was eating unbranded cookies, while another scene featured a bag of Baked Lays sitting in front of actors on *Will & Grace*. *See* Peter Kafka, *Spot the Spot*, FORBES, Nov. 10, 2003, at 68 (discussing the advent of digital product placement technology).

25. Friedman, *supra* note 20, at 67.

B. Americans Are Noticing the Product Placement Trend

As marketers and studios further blur the line between advertising and entertainment, viewers, business leaders, attorneys, and even industry regulators are taking notice of the increased use of product placement.[26] At the annual meeting of the International Trademark Association (INTA) in May 2005, which attracted over 7000 lawyers and corporate leaders, participants focused on the legal and ethical questions that may arise as a result of the product placement phenomenon.[27] Furthermore, Jonathan S. Adelstein, Commissioner of the Federal Communications Commission (FCC), recently spoke out about the "increasing commercialization of American media."[28] Although his speech primarily focused on undisclosed endorsements occurring during video news releases (e.g., newscasts), he did note that "outside of newscasts, product placement is even more rampant. Again, everything from Coke to soap is subliminally hawked in TV programs."[29] As product placement becomes more commonplace, members of the advertising and entertainment industries will continue to evaluate the trend's implications. Likewise, television viewers and performers must question whether such subliminal advertising conflicts with their rights as consumers or artists.

---

26. *See, e.g., Evaluating Product Placement for TV Nets*, *supra* note 16 (noting that television networks are starting to develop methodology for evaluating product placements); Johannes, *TV Placements Overtake Film*, *supra* note 15 (noting that a recent survey found that two-thirds of Americans polled said they see more product placement in television shows and movies); Nielsen Media Research, *Nielsen to Launch Collaborative Product Placement Research Study*, www.nielsenmedia.com, Aug. 11, 2005 (follow "More" hyperlink under "Latest News"; then select "2005" from the menu under "From"; then follow the green arrow hyperlink; then follow the hyperlink under "August 11, 2005") (noting the recent launch by Nielsen Media Research (the organization that monitors television viewership numbers) of a study that will for the first time assess factors impacting product placement effectiveness) (on file with the Washington and Lee Law Review).

27. *See* MacLean, *supra* note 19, at P4 (discussing potential issues that could arise due to increased product placement); *see also Product Placement Booms in TV and Movies*, INTA DAILY NEWS, May 17, 2005, at 6, *available at* http://www.inta.org/annual/ 2005/pdf/INTA_ Tues.pdf (reporting on a panel discussion on increased product placement that occurred at the International Trademark Association 2005 meeting). Among other things, INTA attendees discussed fraud and protecting a celebrity's image or commercial rights. MacLean, *supra* note 19, at P4.

28. *See* Jonathan S. Adelstein, Comm'r, FCC, "Fresh is Not as Fresh as Frozen:" A Response to the Commercialization of the American Media 3, 9 (May 25, 2005), *available at* http://hraunfoss.fcc.gov/edocs_public/attachmatch/DOC-258962A1.pdf (discussing the rise of product placement in various media formats, calling for consumer response, and declaring that he will make the prominent disclosure of product placements his priority).

29. *Id.* at 7.

III. Viewers and Artists May Have No Recourse Against Digital Product Placement

As discussed in Part II, product placement and digital product placement are poised to become common advertising methods with the potential to displace traditional thirty-second commercials. Such alternative marketing strategies—especially those involving digital alterations—could affect both viewers and the artists who create television programming by causing consumer confusion or infringing artistic interest, for example. Before considering what recourse viewers or artists may have, however, this Note briefly discusses why these citizens may find it difficult to challenge the changing face of advertising.

A. Consumer Requests for Product Placement Regulation Have Been Unsuccessful

Although Commissioner Adelstein may have had good intentions in calling for consumer response to product placements, numerous complaints from public interest groups requesting industry regulation have failed over the years. Such complaints have been brought in part because, aside from limited FCC regulation and advertising bans resulting from tobacco settlement agreements, state and federal governments do not strictly regulate product placements.[30] As a result, in 1989 the Center for Science in the Public Interest petitioned the attorneys general of every state, as well as the FCC, seeking a requirement that paid product placements be removed from films unless they are disclosed in the movie credits.[31] Most recently, in late 2003 a consumer watchdog group named Commercial Alert filed separate complaints with both the Federal Trade Commission (FTC) and the FCC, petitioning for the prominent disclosure of embedded advertisements—both before a television

30. *See* Matthew Savare, Comment, *Where Madison Avenue Meets Hollywood and Vine: The Business, Legal, and Creative Ramifications of Product Placements*, 11 UCLA ENT. L. REV. 331, 365 (2004) (outlining the current regulatory approach to product placements).

31. *Id.*; *see also* Douglas C. McGill, *Questions Raised on "Product Placements,"* N.Y. TIMES, Apr. 13, 1989, at D18 (noting that the group requested state attorneys general to investigate whether product placements violate consumer protection laws). Two years later, a coalition of public interest groups, including the Center for the Study of Commercialism, filed a similar petition with the FTC demanding that filmmakers disclose product placements before a movie is shown. Savare, *supra* note 30, at 365; *see also Group Asks Action on Product Placements*, L.A. TIMES, May 31, 1991, at F16 (quoting one co-signer of the petition as stating, "In this way, audiences will be alerted to the fact that those bright products serve no artistic purpose, but are in the movie simply to be advertised").

program begins and when the placement occurs—including product placement and virtual advertising (digital product placement).[32]

But despite Commercial Alert's pleas for product placement disclosure, the FTC ruled in early 2005 that such disclosure was unnecessary, concluding that failure to identify product placements as advertising does not appear to violate Section 5 of the FTC Act.[33] The FTC did agree, however, to continue its policy of considering on a case-by-case basis whether a specific advertising practice is deceptive, especially "as advertisers develop creative new forms of promotion."[34] Although the FTC rejected Commercial Alert's petition, the group's request to the FCC is still pending.[35] And while the FCC has given no official word as to when or how it may decide the issue, consumers could view Commissioner Adelstein's speech to members of the media as a good sign that the FCC may soon respond positively to Commercial Alert's request.[36] Given the numerous failed consumer requests for regulation of product placement over the past several years, however,[37] the FCC could just as easily follow the FTC's lead in rejecting Commercial Alert's petition, similarly finding that

32. *See* Patricia Odell, *Watchdog Group Files Complaints with Feds over Product Placements*, PROMO, Oct. 2, 2003, http://promomagazine.com/legal/marketing_watchdog_group_files/index.html (reporting the filing of the two complaints) (on file with the Washington and Lee Law Review); Savare, *supra* note 30, at 365–66 (discussing Commercial Alert's complaints before the FTC and FCC); *see also* COMMERCIAL ALERT, Complaint to the Federal Trade Commission, Request for Investigation of Product Placement on Television and for Guidelines to Require Adequate Disclosure of TV Product Placement, Sept. 30, 2003, at 17–18, *available at* http://www.commercialalert.org/ftc.pdf; COMMERCIAL ALERT, Complaint to the Federal Communications Commission, Complaint, Request for Investigation, and Petition for Rulemaking to Establish Adequate Disclosure of Product Placement on Television, Sept. 30, 2003, at 12, *available at* http://www.commercialalert.org/fcc.pdf.

33. *See* Letter from Mary K. Engle, Assoc. Dir. for Adver. Practices, Fed. Trade Comm'n, to Gary Ruskin, Executive Dir., Commercial Alert 2 (Feb. 10, 2005) [hereinafter FTC Letter], *available at* http://www.commercialalert.org/FTCletter2.10.05.pdf (rejecting Commercial Alert's request that the FTC require prominent disclosure of television product placements). The FTC did agree, however, that there may be times in which the line between advertising and entertainment may be blurred such that consumers would be deceived absent sufficient disclosure, but stated that it believed the current regulatory and statutory framework provides the necessary tools for challenging deceptive advertising practices. *Id.* at 5.

34. *Id.*

35. *See* MacLean, *supra* note 19, at P4; Commercial Alert, Product Placement, http://www.commercialalert.org/issues/culture/product-placement (last visited Mar. 26, 2007) (stating that the FCC has yet to respond to Commercial Alert's complaint) (on file with the Washington and Lee Law Review).

36. *See* Adelstein, *supra* note 28, at 3 (calling for consumer response to undisclosed product placements).

37. *See supra* notes 31–34 and accompanying text (noting recent failed attempts by consumer groups at convincing federal agencies to regulate disclosure of product placements).

existing guidelines are sufficient to address the problem.[38] As things stand now, it appears that, as one industry insider has predicted, consumer challenges to product placement are unrealistic because "we live in a branded world."[39]

B. Artists Have Not Had Much Success Either

Throughout the past few years, concerned viewers have failed to secure increased regulation of product placements in entertainment media. But given advertisers' increased use of such alternative marketing, and the unknown possibilities of digital product placement, consumers may well continue to challenge regulators to address the product placement trend. Federal agencies such as the FTC and FCC, however, have not responded to such attempts positively, and thus the solution to alternative advertisements may lie elsewhere.

1. The "Work Made for Hire" Exception to the Copyright Act

Indeed, television viewers are not the only people who may be harmed by the influx of product placements and other new advertising formats into television. The artists who create the programs in which such advertisements occur could take issue with the increasingly blurry line between their creative work and the advertising world.[40] Much like the various consumer groups that have failed to staunch the increasing product encroachment into entertainment programs, however, concerned artists may also find it difficult to fight the tide of technological change.

The major problem facing the writers, directors, and actors (collectively "television artists") who work together to create television programming is that they have virtually no control over the final product.[41] Under Section 201(a) of the Copyright Act, the copyright in a work initially belongs to the author of that

---

38. *See* FTC Letter, *supra* note 33, at 5 (stating that the current regulatory framework provides the necessary tools for combating deceptive advertising practices).

39. *See Product Placements: Legitimate Branding or Unethical Subliminal Advertising?*, 70 BNA'S PAT. TRADEMARK & COPYRIGHT J. 54 (2005) (discussing the growth of alternative advertising formats given the proliferation of DVRs).

40. *See, e.g., id.* (posing the question of whether product placement undermines the artistic integrity of a movie or TV program); Savare, *supra* note 30, at 382 (suggesting that digital product placement reduces actors' ability to control their images). This Note will return in depth to the subject of digital product placement and actors' images in Part VI, *infra*.

41. Although this Note focuses primarily on actors in Parts V–VIII, *infra*, the work made for hire doctrine applies to all artistic contributors employed to create a television show.

work.[42] Section 201(b), however, contains the "work made for hire" exception, under which the employer or other person for whom the artistic work was made (i.e., the television studio) is considered the author and thus the owner of the copyright in the completed work.[43] Section 101 of the Copyright Act defines "work made for hire" as:

> (1) a work prepared by an employee within the scope of his or her employment; or (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work . . . if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.[44]

The work made for hire doctrine, therefore, renders television studios the "authors" of the work, such that they receive transferred ownership in the work's copyright, as well as sole creative control over its final edit and any future alterations that may occur.[45]

Under the "work made for hire" doctrine, upon completion of a television program, the artists who created the program will no longer have any copyright interest in it.[46] Should the studio or production company later enter into an

---

42. *See* 17 U.S.C. § 201(a) (2000) ("Copyright in a work protected under this title vests initially in the author or authors of the work.").

43. *See id.* § 201(b). Section 201(b) states:

> In the case of a work made for hire, the employer or other person 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 of the rights comprised in the copyright.

Id.

44. *Id.* § 101. The qualifying categories of "specially ordered or commissioned works" include motion pictures and other audiovisual works. 1 NIMMER ON COPYRIGHT § 5.03[B][2][a][i], at 5-40 (2005) [hereinafter NIMMER]. The Copyright Act defines "audiovisual works" as works that contain a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied. 17 U.S.C. § 101 (2000).

45. *See, e.g.*, John M. Kernochan, *Ownership and Control of Intellectual Property Rights in Motion Pictures and Audiovisual Works: Contractual and Practical Aspects; Response of the United States to the ALAI Questionnaire, ALAI Congress, Paris, Sept. 20, 1995*, 20 COLUM.-VLA J.L. & ARTS 379, 384 (1996) (discussing the role of contracts in ownership and control of rights in U.S. films); Craig A. Wagner, Note, *Motion Picture Colorization, Authenticity, and the Elusive Moral Right*, 64 N.Y.U. L. REV. 628, 656 (1989) (discussing copyright law in the face of cinematic alterations).

46. Although the Copyright Act allows an artist to contract out of the "work made for hire" exception (e.g., by contracting for rights otherwise accruing to the employer), 17 U.S.C. § 201(b) (2000), this is a rare occurrence. *See, e.g.*, Wagner, *supra* note 45, at 658–59 ("While a few filmmakers have achieved celebrity status and can therefore exert greater pressure at the bargaining table, those without such name recognition cannot afford to risk losing employment

agreement that calls for the insertion of products or other advertisements into the show, television artists who feel that such placement damages their artistic contribution will have no ability under the Copyright Act to challenge such an action. Given the increase in product placements and other novel advertising methods in television, therefore, the creative minds behind entertainment programming will have to look outside the Copyright Act if they want protection against such digital alterations.

2. American Television Artists Currently Enjoy No Moral Rights Protection

Because copyright laws prevent television artists from asserting creative control over their works, many scholars and members of the entertainment industry have pushed for the adoption of moral rights protection for television and other performing artists.[47] The term "moral rights" refers to the set of theoretical rights that "confer on the artist a set of entitlements that relate to how his works are treated, presented, displayed, and otherwise utilized after he has relinquished title over the physical objects in which those works are embodied."[48] Moral rights contain two primary aspects: (1) paternity rights, also known as attribution rights, which involve artists' rights to identify themselves with their works or to disassociate themselves from works that others have significantly changed; and (2) integrity rights, which allow artists to prohibit alterations to their works that are injurious to their honor or reputation.[49] In the context of product placements, therefore, an actor who enjoys moral rights protection could presumably prevent a studio from employing damaging advertising methods, or at least cut ties with the particular work. Despite several attempts by artists, however, Congress has yet to enact moral rights legislation which might protect performing artists.[50] Without

---

by insisting on some measure of artistic control.").

47. *See* Savare, *supra* note 30, at 387 & n.383 (citing various articles that advocate moral rights for members of the creative community). *See generally* Clint A. Carpenter, Note, *Stepmother, May I?: Moral Rights,* Dastar, *and the False Advertising Prong of Lanham Act Section 43(a)*, 63 WASH. & LEE L. REV. 1601 (2006).

48. Burton Ong, *Why Moral Rights Matter: Recognizing the Intrinsic Value of Integrity Rights*, 26 COLUM. J.L. & ARTS 297, 298 (2003).

49. *Id.* at 298.

50. *See* Savare, *supra* note 30, at 388–89 (outlining the numerous failed attempts by filmmakers at securing moral rights for their films). Note, however, that the Visual Artists Rights Act of 1990 (VARA) did grant some moral rights to authors of "works of visual art." *See* 17 U.S.C. § 106A (2006) (codifying VARA). Section 101 narrowly defines "works of visual art" to encompass paintings, drawings, prints, sculptures, or still photographs for exhibition purposes only, existing in a single copy or in a limited edition of 200 copies or fewer that are

moral rights or copyright protection, therefore, television artists will have to look elsewhere for protection from the harms of digital product placement discussed in Part IV.

IV. Future Implications of—and Possible Solutions to—Digital Product Placement

Many entertainers, viewers, and even advertising companies are concerned about the changing face of advertising. A recent study found that 30% of consumers felt product placement was not acceptable in any type of show.[51] Similarly, many directors, producers, and screenwriters believe that the use of product placement tarnishes their work and thus refuse to accept it in their television shows or movies.[52] Such concerns are especially magnified with respect to digital product placements, as industry insiders worry how much this technology may change the viewing environment.[53] For instance, one commentator predicts that, using digital product placement technology, "it will be possible to sell product placement permanently, or just for a specified time or regional market. Actors might appear to be drinking Coke in a movie when it was seen in Florida, but might appear to be drinking Pepsi to people seeing the same movie in California."[54] Similarly, Jeff Chester, executive director of the Center for Digital Democracy, shares his concerns: "A family might see a virtual image of a station wagon inserted into a programme while their single

---

signed and consecutively numbered by the author. 17 U.S.C. § 101 (2006). Works made for hire are explicitly excluded from protected works. *Id.*

51. Johannes, *Product Placements*, *supra* note 9.

52. *See, e.g.*, Savare, *supra* note 30, at 364 (discussing possible ways to curb the insertion of product placements into programming). Such refusal may be futile in the case of digital product placements inserted subsequent to the work's completion, however, in light of the "work made for hire" doctrine discussed *supra* in Part III.B.1.

53. *See, e.g.*, Rebecca J. Brown, *Genetically Enhanced Arachnids and Digitally Altered Advertisements: The Making of Spider-Man*, 8 VA. J.L. & TECH. 1, ¶ 28 (2003), http://www.vjolt.net/vol8/issue1/v8i1_a01-Brown.pdf. Brown quotes Barry Levinson, movie director:

> Manipulation is . . . to the point where we no longer are quite sure where reality is and those things which are fabricated. And it gets to be, I think, more sinister as time goes along because you'll be able to do even more things . . . . [I]f seeing is no longer believing, then where are we?

Id.

54. *See* Glen Emerson Morris, *Virtual Product Placement*, ADVERTISING & MARKETING REV., http://www.ad-mkt-review.com/public_html/air/ai200008.html (last visited Mar. 26, 2007) (discussing the implications of digital product placement) (on file with the Washington and Lee Law Review).

neighbour might see a virtual image of a sports car. This is a kind of creeping fungus that will invade our lives in ways we never thought possible."[55] Finally, although he is a proponent of digital product placement, Brown Williams, co-founder of PVI—a company that specializes in digital advertising—perhaps best sums up the collective uncertainty in the industry: "We think we're going to change the definition of what an ad is. It scares the heck out of guys who make ads. And it scares the heck out of me."[56] With digital technology constantly advancing, product placement and other creative advertising formats could indeed expand in unforeseeable directions; therefore, it is vital that someone be given the ability to control this growth before it gets out of hand.

Opponents of the product placement trend have suggested various solutions to the problems that they believe exist. In the context of digital alterations to motion pictures, one writer has argued that because neither copyright law nor moral rights theory protects filmmakers, cultural property rights should instead protect the nation's film heritage.[57] To counteract the effects of product placements in television, Savare proposes that regulatory agencies within the entertainment industry partner with consumer groups like Commercial Alert to develop alternative solutions that are less obtrusive than disclosure requirements like those suggested by Commercial Alert.[58] He also joins the ranks of scholars who have previously pushed Congress to enact moral rights protection, specifically for artists who face the digital alteration of their works.[59] Although these suggestions appear plausible, it is unclear whether any will prove successful, especially given the long history of failed attempts by artists and consumers to garner protection against commercial or digital alterations of audiovisual works.

---

55. Brown, *supra* note 53, ¶ 41.

56. *Id.* ¶ 61.

57. *See* Helen K. Geib, Comment, *Classic Films and Historic Landmarks: Protecting America's Film Heritage from Digital Alteration*, 33 J. MARSHALL L. REV. 185, 200–08 (1999) (opining that because films are an important part of our cultural heritage, the National Film Preservation Act should be amended to prohibit digital alterations to films).

58. *See* Savare, *supra* note 30, at 378 (noting that Commercial Alert's requested disclosure requirement "seems greater than necessary to effectuate the government's interest, as frequent disclosures will interrupt the flow of the program," and suggesting a rating system that would alert viewers to the nature and extent to which a forthcoming program contains product placements). For a discussion of Commercial Alert's disclosure proposals, see *supra* note 32 and accompanying text.

59. Savare, *supra* note 30, at 393, 396 (suggesting that such legislation should require copyright owners to get permission from a work's original author before making material alterations to it, and arguing that because many writers and directors "abhor" product placements, they would view digital product placement as just such a "material alteration").

V. Digital Product Placement is an Attractive Advertising Alternative—But Not for Actors

As discussed, both television viewers and artists have expressed concern over the rise in alternative advertising formats. Despite the numerous consumer calls for regulation and novel solutions scholars have offered, to date no one has found a cure for the influx of product placement into entertainment media.[60] Furthermore, while many scholars would agree that, in principle, traditional product placement is an acceptable advertising practice,[61] others warn that "the quagmire deepens when the placed products are not physically present during the filming [of a work], but rather, added through digital editing."[62] Television artists who have completed their work in a program will not know that studios will make such post-filming alterations, even though studios and advertisers will depend on the technology with greater frequency over time. Indeed, although digital product placement is still relatively new to the marketplace, it has already impressed many members of the advertising and entertainment industries, and looks to continue to do so for years to come.[63]

Studios have begun to use digital product placement more frequently because the practice has proven to be quite profitable.[64] A digital product placement costs the same as a thirty-second commercial but only appears on screen for a few seconds, so studios can thus earn more money per second on a digital product placement than they can for a traditional commercial.[65] A studio can realize further earning potential when it considers the possibilities for new

---

60. *See supra* notes 30–33, 57–59, and accompanying text (noting various consumer attempts at regulation and solutions posed by academics).

61. *See, e.g.*, Brown, *supra* note 53, ¶ 8 (pointing out that, although some viewers distrust product placement, its use is accepted as a fair advertising practice); *Evaluating Product Placements for TV Nets*, *supra* note 16 (quoting an industry insider as saying that product placements can prove to be both low risk and financially rewarding to a production studio).

62. Brown, *supra* note 53, ¶ 8.

63. *See id.* ¶¶ 8, 11 (noting that digital product placement has "steadily been gaining steam since the early 1990s," and that it will "become commonplace within the next few years").

64. *See, e.g.*, *id.* ¶ 10 ("While television stations initially were afraid that they would lose significant advertising revenue, it is now understood by the stations that virtual product placement can complement traditional 30-second spots."). Similarly, the president of advertising sales at one television production company noted that digital product placement on a show such as *Baywatch Hawaii* would cost the same as a traditional commercial, or about $150,000. *Id.*; *see also* Kafka, *supra* note 24, at 68 (noting that digital advertising company PVI charges rates similar to a thirty-second commercial).

65. *See, e.g.*, Friedman, *supra* note 20, at 67 (noting that a sitcom clip needs six seconds of video in order to be "appropriate" for a digitally inserted product); Savare, *supra* note 30, at 356–57 (quoting one advertising agent as asserting that product placements can be much more profitable than traditional commercials).

deals and product rotation throughout a show's syndicated run. For instance, as one author predicts, "a bottle of beer strategically placed in a scene from a syndicated TV series could carry almost any label. Rights holders could sell the space over and over again. Whenever the program is repeated, a different product could appear in the virtual space provided for it."[66]

In addition to realizing the financial possibilities of inserting digital products into programs, studios and their advertisers are increasingly finding that using this digital technology can be a much simpler—and quicker—process than traditional product placement. For example, in his overview of the business of traditional (i.e., non-digital) product placements, Savare outlines the "highly coordinated and sophisticated" process of placing a product into an audiovisual work.[67] In contrast, when it comes to digital product placements:

> Producers appreciate that the insertion does not affect the work of the show. For instance, it does not need to be accounted for on the set or written into the script. In addition, shots of a product, unlike real brand insertion, cannot be cut out by late editing changes. Many of [one company's] digital placements can be done in a single day.[68]

Similarly, one studio executive said, "we can bypass all the production nonsense," and went on to add that her company has moved away from real product placements in recent years specifically because of these production issues.[69] In sum, digital product placement will prove to be a lucrative and easy option for studios and advertisers, but the question remains whether actors will similarly benefit from the technology.

Although digital product placement can provide substantial benefits to both television studios and their commercial sponsors, this unique advertising practice does not look to grant any such returns to the actors who will appear on screen with these digitally inserted products. As outlined previously, most television artists cede their copyright interest in a work to the work's owner, and the United States does not currently offer any moral rights protection for such artists.[70] While some "A-list" actors can negotiate agreements covering

---

66. Brown, *supra* note 53, ¶ 11 (quoting Rafi Azim-Khan, *Virtual Advertising*, 12 ENT. L. REV. 95, 96 (2001)); *see also* Lubell, *supra* note 22, at C1 (noting that digital product placement in movies could see similar profitability through product rotation as the movie goes from first release to video or DVD release). Similarly, with an increasing number of television shows being released on DVD, yet another situation arises in which "repeating" digital product placement could become quite pervasive.

67. *See* Savare, *supra* note 30, at 358–61 (providing a good summary of how traditional product placement ends up in a program).

68. Lubell, *supra* note 22, at C1.

69. *Id.*

70. *See supra* Part.III.B.1–2; *see also* Savare, *supra* note 30, at 356 ("Proponents of

their possible interaction with traditional product placements during a given episode, most actors do not have this level of control over their image.[71] Furthermore, with reference to digital product placement, which usually will occur long after an actor has completed filming, even the most well-known celebrity will not have the chance to approve or disapprove of the future digital alteration of a scene in which he or she appears.[72] Finally, the extent to which studios might soon rely on digital product placements further magnifies actors' concerns. Given the increasing profitability and simplicity of the technology,[73] coupled with the decreased utility of traditional commercials due to advances such as DVRs and online television,[74] this Note examines what impact the influx of such digital alterations could have on actors' images.

A. Product Placements Can Create Implied Celebrity Endorsements

Many of the problems that actors might encounter in the face of increased digital product placement will arise in large part because an actor's appearance on screen with a product can create an implied celebrity endorsement of that product.[75] For instance, "product placement can put a client['s] brand into the hand or mouth of almost any high profile celebrity . . . . It is this celebrity's

---

product placements believe that the practice offers many benefits, not only to advertisers and manufacturers, but also to producers, studios and the consuming public."). Actors are conspicuously absent from this list.

71. *See* Savare, *supra* note 30, at 364, 382 (noting that major actors have more control over their images and at times have been able to reject product placement deals, but also stating that it is "'very rare' for mid-range or aspiring actors to secure such broad rights, since studios and production companies wish to maintain as much control and flexibility as possible"); Wagner, *supra* note 45, at 658–59 (noting that in the entertainment industry, "those [filmmakers] without such name recognition cannot afford to risk losing employment by insisting on some measure of artistic control").

72. *See, e.g.*, Savare, *supra* note 30, at 382 ("After the program has been completed, however, actors are seemingly powerless to prevent the digital alteration or insertion of a product.").

73. *See supra* notes 64–69 and accompanying text (discussing how digital product placements earn the same profit as traditional commercials, even with less airtime, and noting that studios prefer the technology because it enables them to bypass many production hurdles).

74. *See supra* notes 8–16 and accompanying text (noting the increased use of devices that enable consumers to skip commercials, thus causing many advertisers to seek alternatives to the traditional thirty-second commercial).

75. *See* Savare, *supra* note 30, at 356 (quoting the partner of a product placement company as asserting that product placements benefit advertisers and manufacturers by creating "indirect celebrity endorsement[s]"); Johannes, *TV Placements Overtake Film*, *supra* note 15 (quoting the president of a marketing firm as stating that product placement is "an implied endorsement. . . . [it] moves and motivates people").

association with the brand that acts as a powerful and subtle endorsement of the product."[76] Notably, although direct celebrity endorsements are relatively rare and expensive,[77] even an indirect, yet brief, celebrity endorsement created by a product placement can be as effective as a traditional commercial.[78] Advertisers and television studios thus have an obvious interest in creating apparent endorsements between actors and the products with which they interact. In light of the digital product placement revolution, however, the question arises of what control, if any, the actors put in this indirect endorsement situation can possibly have over their images, whether at the time of filming or after future digital insertions occur.

B. Such Endorsements Could Clash With Actors' Wishes

Digital product placements do indeed raise several potential problems for actors. Primarily, because studios will not have many digital placement deals in place at the time actors sign their contracts or even when they complete filming, the actors will not know what products they will appear to endorse in the future.[79] Such uncertainty seems especially problematic considering that "[e]ndorsing or indirectly endorsing a product may reduce a celebrity's publicity value, conflict with an existing contractual obligation, or preclude that celebrity from making other lucrative deals."[80] One can imagine such possibilities as an actor with a Coca-Cola endorsement contract "drinking" a digital can of Pepsi in a future broadcast, or an actress being denied a desirable Revlon deal because her character seemingly advertises other cosmetic products in reruns.[81] Furthermore, the current structure of the entertainment industry

---

76. Feature This!, Benefits, http://www.featurethis.com/benefits/endo.html (last visited Mar. 26, 2007) (on file with the Washington and Lee Law Review); *see also* 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 4:8, at 195–96 (2d ed. 2005) ("[A]lmost one third of all television advertisements involve a celebrity, and retention of information in a commercial message is greater when a readily identifiable person is used.").

77. *See* Feature This!, *supra* note 76 ("The cost for a celebrity to feature in a television or cinema commercial can run into millions and a large number of celebrities refrain from featuring in commercials.").

78. *See Evaluating Product Placement for TV Nets*, *supra* note 16 (noting that an implied endorsement, such as Jerry Seinfeld eating out of a box of cereal, is equivalent in value to one second of a traditional commercial segment, according to a company that has created a valuation tool that quantifies the effectiveness of product placements).

79. *See, e.g.*, Savare, *supra* note 30, at 381–85 (discussing problems actors may face as a result of digital product placement).

80. *Id.* at 383.

81. These scenarios assume that viewers will not know they are watching digital alterations. Given that a key purpose of digital product placement is "seamless integration,"

lends itself to potential conflict of interest issues because, for example, many companies have both management and production divisions. As such, when a production company also represents an actor, there could be a conflict due to the producer's interest in both a lucrative product placement deal and the management of an actor's image.[82] An actor could also have a personal conflict with a future implied endorsement of a digitally inserted product. For instance, many actors today are well-known for supporting political or social causes and might not want to be seen endorsing a product that they believe runs contrary to their personal views.[83] Of course the final, most salient consideration remains simply that actors—a large number of whom rely heavily on advertising income—have a right to be compensated for endorsements that they did not agree to or did not know would occur.[84]

C. Actors Cannot Easily Avoid These Problems Through Contract

Although digital product placement can cause problems for actors, some commentators believe proper contracting will alleviate these concerns. Brown states that "[v]irtual product placements, though potentially unsettling, are entirely legal," and goes on to assert that the practice will be

---

however, viewers will likely assume the product is a natural part of the scene. *See* Johannes, *TV Placements Overtake Film*, *supra* note 15 (quoting the president of PQ Media regarding "seamless integration"); Marathon Ventures, Digital Brand Integration, http://www.marathonventures.com/digital_brand_integration.html (last visited Mar. 8, 2006) (noting that the digital technology has the ability to "minimize the effects of clutter and achieve contextual in-program integration") (on file with the Washington and Lee Law Review).

82. *See* Savare, *supra* note 30, at 384 (discussing potential conflicts of interest arising out of digital product placements).

83. The Ninth Circuit has further observed that "it is quite possible that the appropriation of the identity of a celebrity may induce humiliation, embarrassment and mental distress." Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 824 n.11 (9th Cir. 1974); *see also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. b ("[C]elebrities are not precluded from establishing cognizable injury to personal interests in addition to commercial loss . . . ."); *id.* § 49 cmt. b (1995) ("Celebrities, although often primarily concerned with protecting the commercial value of their identities, may also suffer emotional distress or humiliation from an unauthorized exploitation of their name or likeness.").

84. *See, e.g.*, 1 MCCARTHY, *supra* note 76, § 4:8, at 196 (noting that members of the Screen Actors Guild rely on advertising jobs for about 48% of their income); Grant v. Esquire, Inc., 367 F. Supp 876, 880–81 (S.D.N.Y. 1973) (holding that because actor Cary Grant did not want anyone to profit from the commercial value of his identity, he had a right to prevent its unauthorized use and the opportunity to recover damages for injured feelings and the value of his identity); *see also infra* notes 113–15 and accompanying text (noting that actors can have right of publicity claims even without digital product placements creating apparent endorsements).

commonplace "if contract drafting accurately represents the rights of all involved parties."[85] Savare acknowledges several of the problems facing actors due to digital product placement, yet he nevertheless concludes that "astute agents, managers, and entertainment lawyers should factor such considerations into their negotiation strategies."[86] These suggested strategies include bargaining for broad consultation and approval rights,[87] negotiating for approval rights with regard to future digital alterations or insertions,[88] staying aware of potential conflicts of interest with respect to product placements,[89] and requesting some form of compensation from either the production company or marketer for any product placements involving the actors.[90]

Both Savare and Brown make plausible suggestions, but given the nature of digital product placements and the current environment in the entertainment industry, most actors will not be able to protect themselves through contract. Although actors would likely prefer to negotiate for the right to approve or reject product placements, Savare himself notes on several occasions the difficulty actors face in attempting to negotiate the use of their images.[91] Of further importance, digital product placement is still in its formative years. As with all contractual settings, actors cannot know up front what challenges they will face when the digital placement industry takes off in unforeseeable directions. Even actors with the clout to negotiate for future approval rights might be surprised by some new technology that is not covered by their agreements. These considerations are even more important to the majority of actors, who will not be able to secure up front the right to consultations regarding future digital alterations or product insertions.

---

85. Brown, *supra* note 53, ¶¶ 9, 11. Brown further states that such contracting will assure that neither "the rights of advertiser[s] [nor] viewers would be violated," but does not address how contracting might protect concerned actors. *Id.*

86. Savare, *supra* note 30, at 397.

87. *Id.* at 383.

88. *Id.*

89. *Id.* at 384.

90. *Id.*

91. *See* Savare, *supra* note 30, at 382–84 (stating that it is "very rare" and "certainly . . . difficult" for mid-range and aspiring actors to secure broad approval rights, and further noting that such actors usually receive no compensation for product endorsements); *id.* at 395 ("Because this nation's copyright, tort, and federal trademark laws do not adequately protect artists' creative rights, they must rely on contract law. We have seen, however, that collective bargaining and individual contract negotiations have also failed to defend these rights.").

VI. One Potential Solution: The Right of Publicity

Actors stand to suffer the most at the hands of digital product placement. As television studios and their commercial sponsors continue to realize the advantages of digital advertising, they will profit from actors' images at a growing rate, potentially long after the actors have fulfilled their contractual obligations. Given these possibilities, and the lack of copyright and moral rights protection for television artists, actors must be given the power to control their images in the face of the digital advertising revolution. Although actors have never asserted their rights of publicity in a product placement context, the doctrine may be the source of control that actors need in order to stem unforeseen digital advertising.

A. An Overview of the Right of Publicity

A concerned actor may be able to assert his right of publicity in order to combat unwanted digital alterations that enable companies to benefit from his commercial value as a figure in the public eye. The right of publicity slowly evolved from the right to privacy until courts first recognized the doctrine in 1953.[92] Since then, twenty-eight states have adopted the doctrine—ten by common law,[93] ten by statute,[94] and eight by a

---

92. *See id.* at 379 & n.326 (outlining the history of the right of publicity, and noting that the first case to explicitly recognize the right was Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir. 1953)). The right of publicity, however, is distinct from the right of privacy:

> [T]he right of publicity does not require an invasion of personal privacy to make out a cause of action. It is true that the rights of publicity and of privacy evolved from similar origins; however, whereas the right of privacy protects against intrusions on seclusion, public disclosure of private facts, and casting an individual in a false light in the public eye, the right of publicity protects against the unauthorized exploitation of names, likenesses, personalities, and performances that have acquired value for the very reason that they are known to the public.

Balt. Orioles, Inc. v. MLB Players Ass'n, 805 F.2d 663, 678 n.26 (7th Cir. 1986); *see also* KNB Enters. v. Matthews, 92 Cal. Rptr. 2d 713, 717 (Cal. Ct. App. 2000) ("What may have originated as a concern for the right to be left alone has become a tool to control the commercial use and, thus, protect the economic value of one's name, voice, signature, photograph, or likeness.").

93. The ten states that recognize the common law right of publicity are Arizona, Alabama, Connecticut, Georgia, Hawaii, Michigan, Minnesota, Missouri, New Jersey, and Pennsylvania. *See* 1 MCCARTHY, *supra* note 76, at § 6:3, 769–74.

94. The ten states that have statutory rights of publicity are: Indiana (IND. CODE ANN. §§ 32-36-1-1 to -20 (West 2002)); Massachusetts (MASS. GEN. LAWS. ANN. ch. 214, § 3A (West 2002)); Nebraska (NEB. REV. STAT. §§ 20-201 to -211 (2002)); Nevada (NEV. REV. STAT. ANN.

combination of the two.[95] Although the right of publicity varies from state to state,[96] and no federal statute currently encompasses the right,[97] treatise author J. Thomas McCarthy generally defines it as "the inherent right of every human being to control the commercial use of his or her identity."[98] Building upon that broad definition, at common law a plaintiff can plead a claim for right of publicity by alleging "(1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of [plaintiff's] consent; and (4) resulting injury."[99] As a statutory example, the California Civil Code makes it unlawful to "knowingly use[] another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent."[100] Interestingly, under this statute the term "photograph" includes any photographic reproduction, still or moving, or any videotape or live television transmission of the plaintiff that an average person could readily identify.[101] Such a broad definition could prove

---

§§ 597.770–597.810 (LexisNexis 2002)); New York (N.Y. CIV. RIGHTS LAW §§ 50, 51 (McKinney 2002)); Oklahoma (OKLA. STAT. ANN. tit. 21, §§ 839.1–839.2 (West 2001)); Rhode Island (R.I. GEN. LAWS §§ 9-1-28 to -28.1 (2001)); Tennessee (TENN. CODE ANN. §§ 47-25-1101 to -1108 (2001)); Virginia (VA. CODE ANN. § 8.01-40 (2002)); and Washington (WASH. REV. CODE ANN. §§ 63.60.010–63.60.080 (West 2002)).

95. The states that recognize a combination of statutory and common law rights of publicity include: California (CAL. CIV. CODE §§ 3344–3344.1 (West 2002)); Florida (FLA. STAT. ANN. § 540.08 (West 2002)); Illinois (765 ILL. COMP. STAT. ANN. 1075/1–60 (LexisNexis 2006)); Kentucky (KY. REV. STAT. ANN. § 391.170 (LexisNexis 2001)); Ohio (OHIO REV. CODE ANN. §§ 2741.01–2741.09 (LexisNexis 2000)); Texas (TEX. PROP. CODE ANN. §§ 26.001–26.15 (Vernon 2000)); Utah (UTAH CODE ANN. §§ 45-3-1 to 3-6 (2002)); and Wisconsin (WIS. STAT. ANN. § 995.50 (West 2001)).

96. *See* Savare, *supra* note 30, at 379–80 & n.328 (noting that some of the major differences include the duration, scope, and remedies available under the right).

97. *See id.* at 379 & n.327 (noting further that many commentators have recommended that the federal government adopt a unifying statute in order to "ameliorate the confusion and abrogate the conflicts among the various state laws").

98. 1 MCCARTHY, *supra* note 76, § 1:3, at 3.

99. Wendt v. Host Int'l, Inc., 125 F.3d 806, 811 (9th Cir. 1997) (citing PROSSER, LAW OF TORTS §117, at 804–07 (4th ed. 1971)). Notably, a claimant need not prove actual commercial damage to identity or persona in order to establish a claim for liability—some damage to the commercial value of identity is presumed once it is proved that the defendant made an unauthorized use of a particular aspect of identity in a commercial context such that one can claim such damage is likely. 1 MCCARTHY, *supra* note 76, § 3:2, at 112.

100. CAL. CIV. CODE § 3344(a) (West 2002). Most of the state statutes recognizing publicity rights cover similar inidicas of identity. *See supra* notes 94–95 (listing the eighteen statutes that include some form of the right of publicity).

101. CAL CIV. CODE § 3344(b). A few other right of publicity statutes define "photograph" in a similarly broad way. *See, e.g.*, TENN. CODE ANN. § 47-25-1102 (2001) ("'Photograph'

helpful to an actor bringing a right of publicity claim in the context of televised digital product placements.

The Restatement (Third) of Unfair Competition also recognizes the right of publicity, stating that an individual or entity violates the right when it "appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade."[102] Furthermore, Section 46 of the Restatement does not require a plaintiff to prove that a defendant deceived or confused consumers in order to impose liability,[103] and unless mandated by an applicable statutory provision, a plaintiff need not establish that a defendant intended to infringe the plaintiff's right of publicity.[104] Additionally, Comment C to Section 46 notes that, "[w]ith its emphasis on commercial interests, the right of publicity . . . secures for plaintiffs the commercial value of their fame and prevents the unjust enrichment of others seeking to appropriate that value for themselves."[105]

Much like California's right of publicity statute,[106] the Restatement further provides that a defendant uses the name, likeness, and/or other indicia of a

---

means any photograph or photographic reproduction, still or moving, or any videotape or live television transmission, of any individual, so that the individual is readily identifiable."); WASH. REV. CODE ANN. § 63.60.020 (West 2002) (same); TEX. PROP. CODE ANN. § 26.001 (Vernon 2000) ("'Photograph' means a photograph or photographic reproduction, still or moving, videotape, or live television transmission of an individual in a manner that allows a person viewing the photograph with the naked eye to reasonably determine the identity of the individual."); NEB. REV. STAT. § 20-202 (2002) (covering the exploitation of a "natural person"). Some statutes, however, prohibit the right of publicity's application to television shows unless certain conditions are met. *See, e.g.*, OHIO REV. CODE ANN. § 2741.01 (LexisNexis 2000) (noting that the statute does not apply to audiovisual works unless the claim involves an advertisement or commercial announcement); 765 ILL. COMP. STAT. ANN. 1075/1–60 (LexisNexis 2006) (excluding the use of an individual's identity in an attempt to portray, describe, or impersonate that individual in a live performance, including a television work); WASH. REV. CODE ANN. § 63.60.020 (West 2002) (stating that the statute does not apply to, inter alia, television shows unless the use of a persona inaccurately claims or states an endorsement). One statute excludes the right of publicity's application to television shows without exception. *See* IND. CODE ANN. § 32-36-1-1 (West 2002) (stating that the chapter does not apply to the use of a personality's likeness in any television program).

102. RESTATEMENT (THIRD) OF UNFAIR COMPETITION §46 (1995).

103. *Id.* § 46 cmt. b.

104. *Id.* § 46 cmt. e.

105. *Id.* § 46 cmt. c; *see also* Matthew Savare, *The Price of Celebrity: Valuing the Right of Publicity in Calculating Compensatory Damages*, 11 UCLA ENT. L. REV. 129, 146–49 (2004) (discussing the policy rationales for the right of publicity); *infra* notes 111–15 and accompanying text (discussing the right of publicity's underlying policy of preventing unjust enrichment).

106. *See supra* note 100 and accompanying text (outlining CAL. CIV. CODE § 3344(a) (West 2002)).

plaintiff's identity "for purposes of trade" if it uses the plaintiff's image in advertising its goods or services, or places the image on its merchandise, or uses the image in connection with services it renders.[107] As to available remedies, Restatement Section 48 states that a court may award injunctive relief to prevent the defendant from the continuing or threatened appropriation of the commercial value of a plaintiff's identity.[108] Additionally, a court may hold a defendant liable for the pecuniary loss to the plaintiff caused by the appropriation or for the plaintiff's own pecuniary gain resulting from the appropriation, whichever is greater, unless an applicable statute precludes such relief or the court determines such relief is otherwise inappropriate.[109]

At its core, the right of publicity prevents companies from exploiting a celebrity's commercially valuable image (e.g., by using the celebrity's image to endorse or draw attention to their products) without that person's authorization.[110] Unlike the right to privacy, which can redress injury when a defendant's unauthorized use of a plaintiff's image imposes mental injury on the plaintiff (such as loss of dignity), the right of publicity recognizes legal injury when such un-permitted use causes the plaintiff a "loss of the financial rewards flowing from the economic value of [his or her] human identity."[111] As

---

107. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (1995).

108. *Id.* § 48.

109. *Id.* § 49. Under the various right of publicity statutes, a wide array of remedies is available, whether in the form of injunctive relief, compensatory damages, or punitive damages. *See supra* notes 94–95 and accompanying text (listing the eighteen state codes which recognize some form of statutory publicity rights).

110. *See, e.g.*, Wendt v. Host Int'l, Inc., 125 F.3d 806, 811 (9th Cir. 1997) ("The so-called right of publicity means in essence that the reaction of the public to name and likeness . . . endows the name and likeness of the person involved with commercially exploitable opportunities."); McFarland v. Miller, 14 F.3d 912, 919 (3d Cir. 1994) ("[T]he value of the right of publicity is associational. People link the person with the items the person endorses and . . . that link has value."). The right of publicity does not require that plaintiff's identity be "exploited," however. *See, e.g.*, Abdul-Jabbar v. Gen. Motors Corp., 85 F.3d 407, 415 (9th Cir. 1996) ("[T]he right of publicity protects not only a celebrity's 'sole right to exploit' his identity . . . but also his decision not to use his name or identity for commercial purposes.") (citations omitted). Although some courts have proposed that only a "celebrity" can exercise the right of publicity, the majority of commentators and courts hold that all people, whether celebrities or not, have a right of publicity. *See* 1 MCCARTHY, *supra* note 76, § 4:14, at 203–04 ("While a celebrity's right of publicity will usually have a greater economic value than that of a noncelebrity, this governs only the amount of damages, not the very existence of a right."). For consistency's sake, however, this Note will refer to potential plaintiffs as "actors" or "celebrities."

111. *See* 1 MCCARTHY, *supra* note 76, § 2:2, at 80–83 (noting that using another's image without permission to promote the sale of one's own goods can also be viewed as "reaping where one has not sown," "riding on another's coattails," "unjust enrichment," or "unfair competition"); *see also* Savare, *The Price of Celebrity*, *supra* note 105, at 146–49 (discussing the policy rationales behind the right of publicity).

such, McCarthy illustrates the basic policy premise that the right of publicity should be protected in the same manner as other property rights:

> If you see someone taking your coat from a hook in a restaurant, the natural impulse is to say "Excuse me, but you are taking something that belongs to me." In the same way, a plaintiff who asserts the right of publicity says to the defendant, "Excuse me, but you are using my identity to draw attention to your commercial advertisement. That belongs to me."[112]

Furthermore, although a defendant's use of a plaintiff's image can create the implication that a plaintiff endorses defendant's product,[113] the right of publicity does not require a defendant's use to create an endorsement of any kind.[114] In the context of digital product placements, therefore, an actor could have a right of publicity claim merely because a defendant has used the actor's image to draw attention to its product within a television show, regardless of whether viewers believe the actor is endorsing the defendant's product.[115]

Outside the product placement realm, however, plaintiffs traditionally have brought right of publicity claims when an entity makes use of some aspect of their identity—such as their name or photograph—to endorse or draw attention to a physical product without their consent. For example, in *Uhlaender v. Henricksen*,[116] plaintiffs Major League Baseball players sued a company that had used their names and athletic statistics without permission to create a parlor game in which fans could create and manage their own baseball

---

112. 1 MCCARTHY, *supra* note 76, § 2:2, at 83–84.

113. *See supra* Part V.A (discussing implied celebrity endorsements).

114. *See* 1 MCCARTHY, *supra* note 76, § 2:8, at 104 ("[T]he right of publicity is infringed where a defendant uses plaintiff's identity to draw the consumer's attention to an advertisement, whether endorsement is expressed, implied, or not present at all."). Notably, a false endorsement is separately actionable under state law or Lanham Act § 43(a) as a form of false or misleading advertising. *Id.* Therefore, although some instances implicating the right of publicity will involve elements of falsity, a plaintiff need not prove that a defendant's advertisement deceives or confuses viewers in order to show the defendant has infringed the plaintiff's right of publicity. *See id.* § 5:19, at 418–19 (noting, additionally, that when a defendant's un-permitted use of a person's identity creates a false implication of endorsement, a plaintiff will have valid allegations of both false advertising and infringement of the right of publicity).

115. *See, e.g.*, *id.* § 5:19, at 418 (noting that proof of viewer deception or confusion is not necessary to a plaintiff's right of publicity claim); *supra* notes 103–05 and accompanying text (noting that a right of publicity claim under the Restatement does not require proof of consumer confusion or deception, nor does it mandate that a defendant intend to infringe plaintiff's right of publicity). This Note will discuss actors' right of publicity claims stemming from digital product placements in television shows in Part VIII, *infra*.

116. *See* Uhlaender v. Henricksen, 316 F. Supp. 1277, 1283 (D. Minn. 1970) (holding that "[d]efendants have violated plaintiffs' rights by the unauthorized appropriation of their names and statistics for commercial use").

teams.[117] The court first noted that the defendant's use of the players' names and statistical information made defendant's games more marketable to the public than otherwise would be the case.[118] Then, reasoning that public figures have a valuable property right in their names and images, the court held that plaintiffs were entitled to injunctive relief.[119] Similarly, in *Russell v. Marboro Books*,[120] a bed sheet manufacturer used photos of a fashion model—which it had obtained from a bookstore the model had previously posed for—in "racy, sexy, earthy, and objectionable"[121] advertisements without the model's consent. Although several other issues warranted the judge's instruction to the plaintiff to amend her complaint, the court nonetheless agreed that defendant had violated plaintiff's statutory right to privacy by using her picture for impermissible advertising.[122] Although both of these cases involve the appropriation of mere aspects of a person's image, this Note will argue in Part VIII that the right of publicity should cover the images of the actors as whole persons when used to endorse a digitally placed product.

B. Does Digital Product Placement Implicate the Right of Publicity?

Although many states do recognize actors' potential right of publicity claims, not everyone agrees that advertisements in the form of digital product placements can implicate such a right. On one side, Savare asserts that "virtual

---

117. *Id.* at 1278.

118. *Id.*

119. *Id.* at 1282–83. The court further stated:

> [A] celebrity has a legitimate proprietary interest in his public personality. A celebrity must be considered to have invested his years of practice and competition in a public personality which eventually may reach marketable status. That identity, embodied in his name . . . and other personal characteristics, is the fruit of his labors and is a type of property.

Id.

120. *See* Russell v. Marboro Books, 183 N.Y.S. 2d 8, 27–28 (Special Term 1959) (holding that defendant violated plaintiff's statutory right of privacy through its use of her picture for advertising purposes contrary to her written consent).

121. *Id.* at 29.

122. *Id.* at 30. The right of privacy at issue here is governed by N.Y. CIV. RIGHTS LAW §§ 50, 51 (McKinney 2002). Section 50 reads: "A person . . . that uses for advertising purposes . . . the name, portrait or picture of any living person without having first obtained the written consent of such person . . . is guilty of a misdemeanor." *Id.* § 50. Section 51 allows actions for damages and/or an injunction for such conduct. *Id.* § 51. Although this statute is entitled "[r]ight of privacy," the rights it protects are very similar to those in various other "right of publicity" statutes. *See supra* notes 94–95 (listing the state statutes that recognize some form of the right of publicity).

product placements diminish actors' ability to control their image and . . . may infringe upon their right of publicity, if the content owner does not obtain the actors' permission before digitally inserting a product into a program in order to create an 'indirect celebrity endorsement.'"[123] On the other hand, another commentator argues that, at least in the context of televised sports, "any potential individual player's publicity right is preempted by Section 301 of the Copyright Act with regard to the rights in the broadcast."[124] Nevertheless, this Note concludes in Part VIII that situations do exist in which digital product placements implicate the right of publicity and that the Copyright Act will not preempt actors' properly crafted right of publicity claims.

VII: Federal Preemption: The Right of Publicity and the Copyright Act

Before asserting a state law right of publicity, an actor must first ensure that federal law does not preempt the claim. Pursuant to the Supremacy Clause of the U.S. Constitution, if a state law directly conflicts with federal law, federal law will control.[125] Under Section 301 of the Copyright Act, federal copyright law preempts a state-law claim if that claim implicates two conditions: (1) the "general scope" requirement; and (2) the "subject matter" requirement. A plaintiff raises the "general scope" prong if it asserts a state-law claim seeking to vindicate "legal or equitable rights that are equivalent" to any of the exclusive rights already protected by federal copyright law under Section 106.[126] Section 106 grants the copyright owner the exclusive rights: (1) to reproduce the copyrighted work; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies of the copyrighted work to the public by sale or other transfer of ownership; (4) in the case of motion pictures and other audiovisual works, to perform the copyrighted work publicly; (5) in the case of motion pictures and other audiovisual works, to display the copyrighted work publicly; and (6) in the case of sound recordings, to perform the

123. Savare, *supra* note 30, at 382–83.

124. Askan Deutsch, *Sports Broadcasting and Virtual Advertisement: Defining the Limits of Copyright Law and the Law of Unfair Competition*, 11 MARQ. SPORTS L.J. 41, 68 (2000). The distinction between a television actor and an athlete appearing in a televised sports broadcast is beyond the scope of this analysis, but this Note will discuss whether the Copyright Act preempts an actor's right of publicity in Part VII.

125. *See* U.S. CONST. art. VI, § 2 ("This Constitution, and the Laws of the United States which shall be made in Pursuance thereof . . . shall be the supreme Law of the Land . . . .").

126. 17 U.S.C. § 301(a) (2000); Deutsch, *supra* note 124, at 68 n.162 (discussing preemption).

copyrighted work publicly.[127] Thus, a court will hold that a plaintiff's state law right is equivalent to one of the rights covered by copyright if "the act of reproduction, performance, distribution or display" of the work in question infringes upon the plaintiff's asserted right.[128]

The "subject matter" prong arises if the work, which the plaintiff alleges violates his right of publicity, falls within the type of works protected by copyright as specified by Sections 102 and 103.[129] Section 102 states that copyright protection exists "in original works of authorship fixed in any tangible medium of expression" and notes that such works of authorship include "motion pictures and other audiovisual works."[130] Furthermore, Section 103 provides that the subject matter as specified by Section 102 includes compilations and other derivative works.[131]

Given the conditions of Copyright Act Section 301, therefore, it would seem that if actors allege that digital product placement violates their right of publicity, federal law would preempt this state law claim. The "general scope" requirement makes clear that the studio has the ownership rights to broadcast—and rebroadcast—the work.[132] Additionally, the "subject matter" requirement would define a television show as an original work of authorship in a fixed medium of expression, whether in its original or digitally altered format. Federal copyright law would likely preempt an actor's right of publicity claim in these circumstances, but upon further consideration of cases dealing with federal copyright preemption, certain conditions exist under which actors could bring successful right of publicity claims stemming from digital product placements.[133]

A. Right of Publicity Claims Preempted

Throughout the years, many actors and other professionals have seen the Copyright Act preempt their right of publicity claims. In *Fleet v. CBS, Inc.*,[134]

---

127. 17 U.S.C. § 106.

128. Donald Frederick Evans & Assocs., Inc. v. Cont'l Homes, Inc., 785 F.2d 897, 914 (11th Cir. 1986) (citing 1 NIMMER ON COPYRIGHT § 1.01[B], at 1-11–1-12).

129. 17 U.S.C. § 301(a); Deutsch, *supra* note 124, at 68 n.162 (discussing preemption).

130. 17 U.S.C. § 102(a).

131. 17 U.S.C. § 103(a).

132. 17 U.S.C. § 106 (2000).

133. *See infra* Part VII.B–VIII (discussing the conditions necessary for actors to bring successful right of publicity claims).

134. *See* Fleet v. CBS, Inc., 58 Cal. Rptr. 2d 645, 653 (Cal. Ct. App. 1996) (holding that federal copyright law preempted actors' right of publicity claims where they merely sought to

California actors informed the defendant distribution company that because it had not compensated them, it could not continue to distribute and promote a film in which they had appeared.[135] After the defendant nonetheless released the film on videotape, plaintiffs brought suit alleging that the defendant had violated California's right of publicity statute, and thus sought to enjoin the defendant from reproducing their performance.[136] In holding that federal copyright law preempted plaintiffs' claims,[137] the court stated:

> Appellants seek to protect physical images of their performances captured on film in the subject motion picture and no others. Appellee seeks to display or reproduce those images and no others. The owner of a copyright—either the "author" (actor) or his employer (the producer)—is vested with exclusive rights to . . . "reproduce the copyrighted work" and "display the copyrighted work publicly." Appellants may choose to call their claims misappropriation of right to publicity, but if all they are seeking is to prevent a party from exhibiting a copyrighted work they are making a claim "equivalent to an exclusive right within the general scope of copyright."[138]

---

prevent the reproduction of their performances in a movie). In *Fleet*, a financing company completed a film in which the plaintiffs were actors, then refused to pay their salaries. *Id.* at 647. Subsequently, the plaintiffs informed the defendant distribution company that because the financing company had not compensated them, the defendant "did not have permission to utilize their names, pictures, or likenesses in conjunction with any exploitation of the film." *Id.* The plaintiffs argued that their personae were not copyrightable, and thus copyright law did not preempt their right of publicity claims. *Id.* at 650. The court held, however, that because an individual performance in a film is copyrightable, and because the plaintiffs were seeking only to prevent the defendant from reproducing and distributing their performances, federal copyright law preempted their claims. *Id.* at 650–51.

135. *Id.* at 647.

136. *Id.*; *see also* CAL. CIV. CODE § 3344(a) (West 2002) (outlining California's statutory right of publicity).

137. *Fleet*, 58 Cal. Rptr. 2d at 650–51.

138. *Id.* (quoting 17 U.S.C. § 106); *see also* KNB Enters. v. Matthews, 92 Cal. Rptr. 2d 713, 715 (Cal. Ct. App. 2000) (holding that "because a human likeness is not copyrightable, even if captured in a copyrighted photograph," federal copyright law did not preempt models' claims against the unauthorized publisher of their photographs). Regarding *Fleet*, the court in *KNB Enterprises* stated:

> *Fleet* stands for the solid proposition that performers in a copyrighted film may not use their statutory right of publicity to prevent the exclusive copyright holder from distributing the film. As between the exclusive copyright holder and any actor, performer, model, or person who appears in the copyrighted work, the latter may not preclude the former from exercising the rights afforded under the exclusive copyright by claiming a violation of the right of publicity. In an action against the exclusive copyright holder, "the state law right to publicity action is preempted where the conduct alleged to violate the right consists only of copying the work in which the plaintiff claims a copyright."

In addition to holding that plaintiffs had implicated the general scope prong of federal copyright preemption, the *Fleet* court also found that plaintiffs' claim violated the subject matter requirement, stating that "[t]here can be no question that, once appellants' performances were put on film, they became 'dramatic work[s]' . . . 'fixed in [a] tangible medium of expression' . . . . At that point, the performances came within the . . . subject matter of copyright law protection."[139]

Similarly, in *Baltimore Orioles v. Major League Baseball Players Ass'n*,[140] plaintiff Major League Baseball players claimed that broadcasts of baseball games without their express written consent violated their rights of publicity to their "performances" within the games.[141] In holding that the Copyright Act preempted plaintiffs' claim, however, the Seventh Circuit reasoned that the right of publicity argued by the baseball players was in essence an asserted right to prevent the rebroadcast of games whose broadcast rights were already owned by the baseball clubs.[142] The court stated that "the Players have attempted to obtain *ex post* what they did not negotiate *ex ante*. That is to say, they seek a judicial declaration that they possess a right—the right to control the telecasts of major league baseball games—that they could not procure in bargaining with the Clubs."[143] Both of these cases illustrate the application of the general scope and subject matter requirements of copyright preemption, and although they seem to close the door on potential right of publicity claims that actors might assert in response to digital product placements, the cases in the next section show that actors are not completely without recourse.

B. Right of Publicity Claims Not Preempted

Although the cases cited above hold that plaintiffs may not bring right of publicity claims to enjoin defendants from distributing or promoting their performances within a copyrighted medium, recent court decisions show that a

---

Id. at 721 (citations omitted).

139. Fleet v. CBS, Inc., 58 Cal. Rptr. 2d 645, 650 (Cal. Ct. App. 1996) (quoting 17 U.S.C. § 102(a)).

140. Balt. Orioles, Inc. v. MLB Players Ass'n, 805 F.2d 663, 674 (7th Cir. 1986) (holding that the baseball clubs' copyright in the telecasts of Major League Baseball games preempted players' rights of publicity in their game-time performances).

141. *Id.* at 674.

142. *Id.* at 674, 677; *see also* Brown v. Ames, 201 F.3d 654, 659 (5th Cir. 2000) ("[T]he right of publicity claimed by the baseball players [in *Baltimore Orioles*] was essentially a right to prevent rebroadcast of games whose broadcast rights were already owned by the clubs. Viewed in this way, the case is the same as *Fleet, Inc. v. CBS*.").

143. *Balt. Orioles*, 805 F.2d at 679.

person's public image includes more than just his or her copyrightable performance. In *Toney v. L'Oreal U.S.A., Inc.*,[144] a model agreed that a company could use her likeness to advertise its product for a set time period, but a second company subsequently acquired the first company and all its copyright interests soon after the model's contract expired.[145] When the defendant successor company later used the model's photograph without her permission, she filed suit alleging that the defendant had violated her statutory right of publicity.[146] Although the defendant had acquired the copyright to the plaintiff's photograph, and even though the copyrighted photograph contained the plaintiff's fixed image, the court nonetheless held that the photograph did not author or fix the plaintiff's likeness or persona, and thus the Copyright Act did not preempt her from asserting her right of publicity claim.[147]

In explaining its reasons for holding that plaintiff could bring her right of publicity suit, the Seventh Circuit stated:

> Clearly the defendants used Toney's likeness without her consent for their commercial advantage. The fact that the photograph itself could be copyrighted, and that defendants owned the copyright to the photograph that was used, is irrelevant to the [Illinois Right of Publicity Act] claim. The basis of a right of publicity claim concerns the message—whether the plaintiff endorses, or appears to endorse the product in question. One can imagine many scenarios where the use of a photograph without consent, in apparent endorsement of any number of products, could cause great harm to the person photographed. The fact that Toney consented to the use of her photograph originally does not change this analysis. The defendants did not have her consent to continue to use the photograph, and therefore, they

144. *See* Toney v. L'Oreal U.S.A., Inc., 406 F.3d 905, 910 (7th Cir. 2005) (holding that federal copyright law did not preempt a model's right of publicity because the Copyright Act does not protect a person's "persona" or "identity"). In *Toney*, an Illinois plaintiff argued that a hair products company—which had acquired her photograph from a similar company she had previously modeled for—had used her likeness to endorse its product without her permission, and thus had violated her statutory right of publicity as protected under the Illinois Right of Publicity Act (IRPA), 765 ILL. COMP. STAT. 1075/1-60 (LexisNexis 2002). *Toney*, 406 F.3d at 907. In deciding whether copyright law preempted plaintiff's claim, the Seventh Circuit stated that a person's likeness or persona is neither authored nor fixed, and thus held that although a person's image might be fixed in a copyrightable medium, that copyrightable medium does not fix or author the underlying image. *Id.* at 910. The court then concluded that the rights the IRPA protects are not "equivalent" to any of the exclusive rights within the Copyright Act, regardless of the fact that the defendant owned the copyright to the photograph it used. *Id.*

145. *Id.* at 907.

146. *Id.*; *see also* 765 ILL. COMP. STAT. 1075/1-60 (LexisNexis 2002) (outlining Illinois' statutory right of publicity).

147. *Toney*, 406 F.3d at 910.

> stripped Toney of her right to control the commercial value of her identity.[148]

In essence, the court was separating plaintiff's commercially valuable image from the copyrightable medium in which that image appeared. It described this separation in terms of a "persona":

> A photograph "is merely one copyrightable 'expression' of the underlying 'work,' which is the plaintiff as a human being. There is only one underlying 'persona' of a person protected by the right of publicity." In contrast, "[t]here may be dozens or hundreds of photographs which fix certain moments in that person's life. Copyright in each of these photographs might be separately owned by dozens or hundreds of photographers." A persona, defined this way, "can hardly be said to constitute a 'writing' of an 'author' within the meaning of the copyright clause of the Constitution."[149]

The difference between a copyrightable medium and a person's underlying image or persona will prove vital to this Note's analysis in Part VIII.

Many other cases have addressed the difference between a persona and the copyrightable medium in which it appears.[150] In *Downing v. Abercrombie & Fitch*,[151] in response to the plaintiffs' allegation that the defendant had published their photos and names in a catalog without authorization, the Ninth Circuit stated that "[a] person's name or likeness is not a work of authorship within the meaning of 17 U.S.C. § 102. This is true notwithstanding the fact that [plaintiffs'] names and likenesses are embodied in a copyrightable photograph."[152] Similarly, the Fifth Circuit held in *Brown*

---

148. *Id.*

149. *Id.* at 908–09 (citations omitted).

150. *See, e.g.*, Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619, 623 (6th Cir. 2000) (holding that copyright law did not preempt an actor's claim that the marketing of a toy based on his character in the movie *Predator* violated his right of publicity because he was not attempting to gain rights to the telecast of his performance, and further noting that "personal identity [is] an inchoate 'idea' which is not amendable to copyright protection"); Seifer v. PHE, Inc., 196 F. Supp. 2d 622, 628 (2002) ("[A] person's name and likeness do not become copyrightable merely because they have been placed on works which are subject to copyright law. . . . Plaintiff herein has sought to protect her right to control the use of her name and likeness, not to control her performance."); KNB Enters. v. Matthews, 92 Cal. Rptr. 2d 713, 715 (Cal. Ct. App. 2000) ("We conclude that because a human likeness is not copyrightable, even if captured in a copyrighted photograph, [plaintiffs' statutory right of publicity] claims against the unauthorized publisher of their photographs are not the equivalent of a copyright infringement claim and are not preempted by federal copyright law.").

151. *See* Downing v. Abercrombie & Fitch, 265 F.3d 994, 1004 (9th Cir. 2001) (upholding plaintiffs' right of publicity claim against defendant for publishing their photo and names in a catalog without their consent).

152. *Id.* The court further stated that:

v. Ames[153] that copyright law did not preempt claims by musicians that a record company had misappropriated their images for use in album packaging.[154] In so holding, the court stated that the content of the right protected by Texas' misappropriation tort—which it stated was "best understood as a species of the right of publicity"—does not fall within the subject matter of copyright.[155] The Fifth Circuit reasoned that this right protects the "interest of the individual in the exclusive use of his own identity, in so far as it is represented by his name or likeness, and in so far as the use may be of benefit to him or to others."[156] The Fifth Circuit concluded, therefore, that the tort of misappropriation of someone's name or likeness protects that individual's persona, which does not fall within the subject matter of copyright.[157]

In *Brown*, the Fifth Circuit drew a helpful distinction between that case and other cases in which the Copyright Act preempted state law right of publicity or misappropriation claims.[158] First, the court asserted that because a

---

> The photograph itself, as a pictorial work of authorship, is subject matter protected by the Copyright Act. However, it is not the publication of the photograph itself, as a creative work of authorship, that is the basis for [plaintiffs'] claims, but rather, it is the use of the [plaintiffs'] likenesses and their names pictured in the published photograph.

Id. at 1003 (citations omitted).

153. *See* Brown v. Ames, 201 F.3d 654, 659 (5th Cir. 2000) (holding that federal copyright law did not preempt claims by musicians that a record company misappropriated their images for use in album packaging because a person's name and likeness are not themselves copyrightable).

154. *Id.*

155. *Id.* at 657–58. To prevail under the Texas misappropriation tort, a plaintiff must prove that "(1) the defendant misappropriated the plaintiff's name or likeness for the value associated with it and not in an incidental manner or for a newsworthy purpose; (2) the plaintiff can be identified from the publication; and (3) the defendant derived some advantage or benefit." *Id.*

156. *Id.* at 658 (quoting RESTATEMENT (SECOND) OF TORTS § 652C (1977)).

157. *Brown*, 201 F.3d at 658. Many of the opinions discussing the difference between a copyrightable performance and a persona cite the *Nimmer on Copyright* treatise:

> Invasion of privacy may sometimes occur by acts of reproduction, distribution, performance, or display, but inasmuch as the essence of the tort does not lie in such acts, pre-emption should not apply. The same may be said of the right of publicity.
>
> A *persona* can hardly be said to constitute a "writing" of an "author" within the meaning of the Copyright Clause of the Constitution. *A fortiori*, it is not a "work of authorship" under the Act. Such name and likeness do not become a work of authorship simply because they are embodied in a copyrightable work such as a photograph.

1 NIMMER, *supra* note 44, § 1.01[B][1][c], at 1-28–1-29.

158. *See Brown*, 201 F.3d at 658 (comparing the case at bar with both *Fleet*, discussed

person cannot copyright a name or likeness, the defendant was wrong to rely on the Fifth Circuit's previous decision in *Daboub v. Gibbons*, in which the court held that the Copyright Act preempted musicians' claims that another band had misappropriated their song:[159] "The crucial difference between the two cases is that in *Daboub* the basis of the misappropriation claim . . . was the song itself, bringing it within [17 U.S.C. § 301]'s ambit, whereas here the basis of the misappropriation claim was defendants' use of plaintiffs' names and/or likenesses."[160] The Fifth Circuit further reasoned that *Fleet* shares the same factual difference because that case, like *Daboub*, involved a claim for the misappropriation of something within the subject matter of copyright (in *Fleet*, performance in a film; in *Daboub*, songs), whereas the case at bar involved the misappropriation of a name and/or likeness, "which is not within the subject matter of copyright."[161] In essence, therefore, a persona can best be viewed as the non-copyrightable "idea" of a person's image, regardless of whether that image appears in a copyrightable medium.[162] Actors must therefore keep this distinction in mind when contemplating bringing right of publicity suits stemming from digital product placements.

VIII. The Copyright Act Will Not Preempt Properly Crafted Right of Publicity Claims

As discussed in Part V.B, digital product placement gives rise to the potential that actors who have not contracted for protection of their images from future digital alterations or product insertions might take issue with the implied endorsement that can occur when companies force them to share the

---

supra, at note 134, and *Daboub*, discussed *infra* note 159).

159. *See id.* (citing Daboub v. Gibbons, 42 F.3d 285, 291 (5th Cir. 1995)). In *Daboub*, the court held that the Copyright Act preempted plaintiff musicians' claim that the band ZZ Top misappropriated their song *Thunderbird* because the reproduction of a song falls within the subject matter of copyright. *Id.* (citing *Daboub*, 42 F.3d at 290).

160. *Id.*

161. *Id.*

162. *See* Jeffrey Malkan, *Stolen Photographs: Personality, Publicity and Privacy*, 75 TEX. L. REV. 779, 827 (1997) ("Federal copyright, moreover, extends only to works that are tangibly fixed in a medium of expression; it does not protect the underlying ideas (or persona) embodied in those works."); Michael J. McLane, *The Right of Publicity: Dispelling Survivability, Preemption and First Amendment Myths Threatening to Eviscerate a Recognized State Right*, 20 CAL. W. L. REV. 415, 423 (1984) ("One's persona . . . is incapable of reduction to tangible form. Arguments that one's persona may be captured in various tangible media and therefore may be protected by the Copyright Act reveal a fundamental misconception of the nature and extent of the Act's protection.").

screen with their merchandise. In addition to the professional and personal conflicts that may arise from such apparent endorsements,[163] actors' biggest concern remains the fact that, much like the model in *Toney*, their personae might be used for commercial benefit without their permission, regardless of whether such use creates an implied endorsement.[164] Actors thus have several potential grievances they can assert under their right of publicity, but they still must consider the preemption requirements discussed in Part VII if they wish to prevail on such claims.

A. How Actors Can Successfully Assert Their Right of Publicity

1. Avoid the Subject Matter and General Scope Prongs of the Copyright Act

To be successful, an actor's right of publicity claim stemming from a digital product placement cannot implicate the subject matter prong of copyright preemption. The subject matter requirement at first seems like a problem because a television show, whether in its original or rebroadcast form, is an authored work fixed in a tangible medium of expression.[165] Under this definition, a television show falls within the "type of works protected by copyright as specified by Sections 102 and 103" and thus would appear to invite federal preemption.[166] The subject matter of a right of publicity claim, however, does not have to be the particular medium—here, a television show—in which the plaintiff appears.[167] For instance:

> [W]hat is protected by the right of publicity is the very identity or persona of the plaintiff as a human being . . . .
>
> While copyright in a given photograph might be owned . . . the exact image in that photograph is not the underlying "right" asserted in a right of publicity case. To argue that the photograph is identical with the person is to

163. *See supra* notes 79–84 and accompanying text (discussing potential conflicts of interest and other problems that actors may experience as a result of digital product placements).

164. *See supra* notes 144–49 and accompanying text (discussing Toney v. L'Oreal U.S.A., Inc., 406 F.3d 905 (7th Cir. 2005)); *see also supra* notes 111–15 and accompanying text (noting that a plaintiff can bring a right of publicity claim when a defendant uses his or her image to draw attention to its products, whether or not such use creates an endorsement).

165. *See* 17 U.S.C. § 102(a) (2000) (noting that such works include motion pictures and other audiovisual works).

166. *Id.* § 301(a).

167. *See* 2 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 11:52, at 755–57 (2d ed. 2005) (discussing the difference between a copyrightable medium and a persona).

> confuse illusion and illustration with reality. Thus, assertion of infringement of the right of publicity because of defendant's unpermitted commercial use of a picture of plaintiff is *not* assertion of infringement of copyrightable "subject matter" in one photograph of plaintiff.[168]

To avoid violating the subject matter prong of copyright preemption, therefore, a plaintiff should not argue that a defendant has violated his right of publicity by using his *performance* within a copyrightable television show for commercial gain. Rather, the plaintiff must emphasize the fact that the defendant has used his underlying *persona* within that captured medium to draw attention to a product without his consent.[169] Having avoided implicating the subject matter requirement, therefore, the plaintiff must then turn to the general scope requirement.

An actor's right of publicity claim will not always violate the general scope condition of copyright preemption either. The general scope requirement covers a broader spectrum than the subject matter requirement, becoming an issue essentially whenever a claimant asserts that a defendant's actions infringe some state law right "by the mere act of reproduction, performance, distribution, or display" of a work.[170] For instance, the plaintiff's claim in *Fleet* failed because he sought to enjoin the defendant from distributing his dramatic performance, even though the distribution company owned the copyright to the film and thus had the sole power to distribute it.[171] Likewise, because the television studio usually owns the copyright in actors' performances within a given television show, if an actor sought to enjoin a studio from broadcasting the performance in which a digital product placement occurred, the Copyright Act would preempt this right of publicity claim under the court's reasoning in *Fleet*.[172]

An actor asserting a right of publicity claim in response to a digital product placement, therefore, would have to seek a remedy other than an injunction against the television studio. In fact, as Nimmer stated:

---

168. *Id.* § 11:52, at 755, 757; *see also supra* notes 150–62 and accompanying text (discussing the difference between a person appearing in a copyrightable medium and his or her underlying persona).

169. This Note will return to the topic of performance and persona *infra* notes 190–97 and accompanying text.

170. 1 NIMMER, *supra* note 44, § 1.01[B][1], at 1-12.

171. *See* Fleet v. CBS, Inc., 58 Cal. Rptr. 2d 645, 653 (Cal. Ct. App. 1996) (holding that federal copyright law preempted actors' right of publicity claims where the plaintiffs sought to prevent the reproduction of their performances in a movie).

172. *Id.*

> [I]f under state law the act of reproduction, performance, distribution, or display, no matter whether the law includes all such acts or only some, will *in itself* infringe the state-created right, then such right is pre-empted. But if qualitatively other elements are required, instead of, or in addition to, the acts of reproduction, performance, distribution, or display, in order to constitute a state-created cause of action, then the right does not lie "within the general scope of copyright," and there is no pre-emption.[173]

Thus actors who contend that a digital product placement constitutes misappropriation of their images for commercial gain cannot enjoin a studio from broadcasting or re-broadcasting their digitally altered performances.[174] Such an argument would be analogous to the preempted claim in *Fleet v. CBS, Inc.*,[175] which one court has described as "a case where preemption occurred because the actors tried to use a state law to prevent the holder of copyright in a film from exercising its legitimate federal right to distribute the copyrighted film."[176] Actors can only avoid the general scope prong of copyright preemption, therefore, if they do not bring suit against the television studio.

Given the two conditions of copyright preemption discussed above, actors will not be able to prevent television studios from displaying or reproducing their performances within a specific television show.[177] First, a plaintiff who alleges that the defendant misappropriated a particular performance would violate the subject matter restriction of the Copyright Act because television

---

173. 1 NIMMER, *supra* note 44, § 1.01[B][1], at 1-13. The legislative history of the Copyright Act also supports this conclusion. *See* H.R. REP. NO. 94-1476, at 132 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5748 ("The evolving common law right[] of . . . 'publicity' . . . would remain unaffected as long as the cause[] of action contains elements . . . that are different in kind from copyright infringement.").

174. Many right of publicity statutes, however, do allow injunctive relief against persons other than the copyright holder. *See supra* notes 94–95 (listing the eighteen state codes that contain a right of publicity).

175. *See Fleet*, 58 Cal. Rptr. 2d at 653 (holding that federal copyright law preempted actors' right of publicity claims where the plaintiffs merely sought to prevent the reproduction of their performances in a movie).

176. 2 MCCARTHY, *supra* note 167, § 11:54, at 770 (discussing the interpretation of *Fleet v. CBS, Inc.* by the court in *KNB Enters. v. Matthews*, 92 Cal. Rptr. 2d 713, 715 (Cal. Ct. App. 2000) (holding that because human likeness is not copyrightable, even if captured in a copyrighted photograph, federal copyright law did not preempt models' claims against the unauthorized publisher of their photographs)).

177. This could be why some states, such as California, specifically prohibit suits against television studios. *See, e.g.*, CAL. CIV. CODE § 3344(f) (West 2002) (stating that the statute shall not apply to the owners or employees of any medium used for advertising, including television networks and stations, by whom any advertisement in violation of the right of publicity is portrayed, unless it is established that the owners had knowledge of the unauthorized use of the person's image).

performances clearly fall within the subject matter of copyrightable materials.[178] Second, a plaintiff would also trigger the general scope requirement if he attempted to enjoin a defendant from displaying or reproducing that performance because the general scope prong of the Copyright Act gives copyright holders the sole power to distribute their copyrighted works.[179] These restrictions do not mean, however, that actors will never succeed in protecting their publicity rights in the face of the digital product placement revolution. In fact, all actors need to do is shift the focus of their right of publicity claims.

2. *Sue the Advertiser for Misuse of the Non-Copyrightable Persona*

A plaintiff who believes that a digital product placement has implicated his right of publicity should bring this claim not against the television studio that facilitated the digital alteration, but rather against the company that inserted its merchandise into the show in order to take advantage of the plaintiff's underlying commercial value. Such a claim would not focus on the television studio's display and distribution of the plaintiff's performance but would instead arise out of the advertiser's use of the plaintiff's image to help sell its products. Even though the plaintiff's image appears within a copyrighted television performance, the plaintiff nonetheless has a right of publicity claim because the company has misused his underlying, non-copyrightable persona to its commercial advantage. An individual's persona is distinct from the copyrightable medium in which it appears; therefore, although copyright law would preempt a plaintiff's right of publicity claim involving a television performance, it would not do so for a similar claim involving his or her distinct image as a human being.[180] Finally, as to remedies, because the plaintiff cannot prevent the studio from distributing a work that contains digital product placements, he should instead demand that the advertiser itself cease its digital insertions, or that the advertiser pay damages equivalent to the commercial value it gains from its unauthorized use of plaintiff's image.[181]

For example, assume actor John Doe completes his work on a television show and moves on to another project. Under the work made for hire doctrine, the television studio that produced the series now owns the copyright in Doe's

178. *See supra* notes 129–31 and accompanying text (discussing subject matter preemption).

179. *See supra* notes 126–27 and accompanying text (discussing general scope preemption).

180. *See supra* notes 147–62 and accompanying text (discussing the difference between an individual's persona and the copyrightable medium in which it appears).

181. The vast majority of right of publicity statutes provide for some form of damages. *See supra* notes 94–95 (listing the eighteen rights of publicity statutes).

performance.[182] Because Doe, like the majority of actors, does not have the clout to secure much control over his image, the studio will be free to display his performance in any number of ways.[183] Given this lack of control, as well as the numerous possibilities of digital product placement, viewers will quite possibly see Doe advertising a product which he did not agree to endorse, which conflicts with his other advertising agreements or personal values, and for which he has not been compensated.[184] Even if consumers do not view Doe as endorsing the digitally inserted product, the company who placed its merchandise into the television show still has used Doe's image to draw attention to its product, an act which in itself implicates Doe's right of publicity.[185] Despite Doe's concerns over such misappropriation of his image, however, he cannot claim breach of contract, because nothing in his contract (or within his contractual power) prohibits digital product placements.[186] Furthermore, he has no moral rights or copyright protection in his performance.[187] Moreover, the Copyright Act would preempt any attempt by Doe to enjoin the studio's re-broadcast of his performance that contains the unauthorized use of his image.[188]

Doe should therefore file his claim against the company that convinced the television studio—presumably at some point after Doe completed his employment contract with the studio—to allow it to use Doe's image for its advertising purposes. Depending on the conflict the digital product placement creates or the amount of commercial gain Doe's misappropriated image provides the company, he should seek to recover damages from the company or to halt the company's digital advertisements altogether. Such a claim would include many elements similar to the model's successful right of publicity suit

182. *See supra* notes 40–45 and accompanying text (discussing the work made for hire doctrine of the Copyright Act).

183. *See supra* note 71 and accompanying text (noting that only the most famous actors can contract for approval rights).

184. *See supra* notes 79–84 and accompanying text (outlining various potential problems that could result from digital product placements).

185. *See supra* notes 110–15 and accompanying text (noting that the policy behind the right of publicity is to protect against a defendant's use of a plaintiff's image to draw attention to its product, without compensating the plaintiff, regardless of whether such use creates an endorsement).

186. *See supra* note 71 and accompanying text (noting that only the most famous actors can contract for approval rights).

187. *See supra* notes 41–50 and accompanying text (discussing the lack of copyright or moral rights protection for actors).

188. *See supra* notes 176–78 and accompanying text (noting why such injunctive relief would fail under copyright preemption).

in *Toney v. L'Oreal U.S.A., Inc.*,[189] namely: (1) removal of the association between a plaintiff's likeness and a product, or damages accruing because of such association; (2) even though the likeness appears within a copyrightable medium of expression; (3) against a defendant that does not own the copyright to that medium; (4) by a plaintiff who itself does not have a copyright interest in the work; and (5) that arises at some point after the plaintiff completes his contractual relationship with the actual copyright holder.[190] Finally, although the successful plaintiff in *Toney* asserted a more traditional right of publicity claim stemming from defendant's use of her photograph, a court should not deny Doe's claim just because it involves the as-of-yet unchallenged realm of digital product placement. As the advertising market moves in new directions, courts must be willing to adapt accordingly in order to accommodate the novel problems that digital product placement will present.

Although television studios are free to distribute and display their employees' performances, such freedom should not extend to companies that wish to place digital products within a particular show. The right of publicity must be expanded in such a manner so that actors will have ammunition with which to combat the increased likelihood that digital alterations will enable companies to take advantage of their commercially valuable, non-copyrightable images. If companies have notice that a digital product placement will subject them to injunctive or monetary liability, they will be more likely to obtain an actor's authorization before using that actor's image to draw attention to its products. This threat of liability will minimize the potential for companies to make rampant digital alterations that prove harmful to actors' images, create professional or personal conflicts, or take advantage of actors' hard-earned commercial value. Importantly, extending the right of publicity to include digital product placement will ensure that actors receive publicity protection where copyright and moral rights doctrines fail them. Digital product placement is on the rise, but the current legal landscape provides no check on the possibility that new advertising methods could violate the rights of actors. Actors, just like all people, should remain free from the unauthorized use of their property for the benefit of others.

---

189. *See supra* notes 144–49 and accompanying text (discussing Toney v. L'Oreal U.S.A., Inc., 406 F.3d 905 (7th Cir. 2005), in which a model successfully brought a right of publicity claim against a company that had used her image without consent, even though she did not own the copyright to the picture in which her image appeared).

190. *See* Toney v. L'Oreal U.S.A., Inc., 406 F.3d 905, 910 (7th Cir. 2005) (outlining the elements of plaintiff's complaint).

B. Addressing Potential Counter-Arguments

The suggestions in this Note are, of course, open to criticism and doubt.[191] Those who believe that the right of publicity should not be extended to cover digital product placements might challenge an important assumption upon which this Note relies: that an actor's persona can indeed be separated conceptually from his or her performance within a televised work. Although numerous courts have recognized the distinction between an artist's appearance in a copyrightable medium and his or her underlying, non-copyrightable persona or likeness, none of these cases involved an audiovisual performance.[192] Moreover, courts have held that federal copyright laws can preempt right of publicity claims stemming from a plaintiff's performance in a given work.[193] These latter cases, however, all involve plaintiffs seeking to enjoin the copyright holder from distributing or displaying their copyrightable performances, thus implicating copyright preemption.[194] Furthermore, no court

191. One interesting and relevant legal debate—the fair analysis of which falls outside the scope of this Note—centers on whether a company's use of digital product placements could receive enhanced "expressive" or "mixed message" speech protection under the First Amendment, thereby increasing a plaintiff's burden of proving the company has violated its right of publicity. *Compare* Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1185 (9th Cir. 2001) (holding that defendant magazine, which had digitally altered plaintiff's image from the *Tootsie* movie poster as part of a fashion spread, could receive increased First Amendment protection against plaintiff's right of publicity suit because its use of his image was "inextricably intertwined" with expressive elements and thus was not purely commercial speech), *with* Savare, *supra* note 30, at 369–74 (arguing that product placements should be classified as commercial speech—thus receiving less First Amendment protection than expressive speech—because product placements: (1) "are not 'inextricably intertwined' with the noncommercial elements of creative expression"; (2) "are economically motivated by the 'placer'"; (3) are composed of content that "propose[s] a commercial transaction"; and (4) reflect the motivation of the speaker while referencing a specific product).

192. *See Toney*, 406 F.3d at 910–11 (holding that federal copyright laws did not preempt a model's right of publicity claim because the Copyright Act did not protect her persona within a copyrightable photograph); Downing v. Abercrombie & Fitch, 265 F.3d 994, 1004 (9th Cir. 2001) (upholding plaintiffs' right of publicity claim against defendant for publishing their photo and names in a catalog without their authorization); KNB Enters. v. Matthews, 92 Cal. Rptr. 2d 713, 715 (Cal. Ct. App. 2000) ("We conclude that because a human likeness is not copyrightable, even if captured in a copyrighted photograph, [plaintiffs' statutory right of publicity] claims against the unauthorized publisher of their photographs are not the equivalent of a copyright infringement claim and are not preempted by federal copyright law.").

193. *See* Balt. Orioles v. MLB Players Ass'n, 805 F.2d 663, 678 (7th Cir. 1986) (holding that baseball clubs' copyright in telecasts of major league baseball games preempted plaintiff players' rights of publicity in their game-time performances); Fleet v. CBS, Inc., 58 Cal. Rptr. 2d 645, 653 (Cal. Ct. App. 1996) (holding that federal copyright law preempted actors' right of publicity claims where the plaintiffs merely sought to prevent the defendant from reproducing their performances in a movie).

194. *Balt. Orioles*, 805 F.2d at 678; *Fleet*, 58 Cal. Rptr. 2d at 653.

has yet addressed whether actors can claim rights to their non-copyrightable images occurring within a copyrightable audiovisual performance in conjunction with a product placement, digital or otherwise. With digital product placement on the rise, however, courts may soon face the very question this Note poses, and should then rule in favor of expanding actors' publicity rights in the face of such exponential technological growth.

Perhaps the issue of whether actors' personae can be culled from their copyrightable performances has never come up because television performances are indeed copyrightable, and thus studios believe that they can broadcast such performances without restriction. A studio's act of broadcasting an actor's performance, however, is clearly distinct from a company's act of digitally placing a product into that performance. Furthermore, companies that digitally insert products into a scene do not rely on the actor's performance or interaction with merchandise to create an implied endorsement of their product, but instead trust that the mere appearance of the actor's image near the item will draw viewers' attention to the product.[195] These advertisers are not using actors' fictional roles or dramatic performances to their advantage, but rather are taking clips featuring the actors' commercially marketable celebrity images and creating a valuable link between the image of the product and the human likeness of the actors.[196] Put another way, digital product placement creates the opportunity for companies to use a television show as the copyrightable vehicle through which they can appropriate an actor's likeness in order to endorse or draw attention to their products. That such use involves a copyrightable television show is irrelevant; just as the defendant in *Toney* put a model's copyrighted picture on its merchandise without her consent,[197] digital product

---

195. *See, e.g.*, *supra* notes 75–78 and accompanying text (discussing implied celebrity endorsements); Friedman, *supra* note 20, at 67 (quoting a television executive as noting that characters will have little interaction with virtual products); Marathon Ventures, *supra* note 23 (displaying a slide show featuring real examples of recent digital product placements, in which actors are not interacting with the products themselves).

196. *See* 1 MCCARTHY, *supra* note 76, § 4:8, at 195 (discussing why celebrities' identities are commercially valuable). McCarthy quotes one scholar as explaining:

> Attracting the consumer's attention to a product is the first step in selling the product, and to the extent that the use of a likeness attracts attention to the product, that use benefits an advertiser. Names and pictures . . . suggest endorsements and otherwise motivate decisions to purchase . . . . Celebrity endorsements, however, do even more. They give the consumer an opportunity to associate himself with a public figure, however fleetingly and remotely. Many, perhaps most, consumers value this association, at least unconsciously.

Id. (quoting James M. Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV. 637, 644–45 (1973)).

197. *See* Toney v. L'Oreal U.S.A., Inc., 406 F.3d 905, 910–11 (7th Cir. 2005) (holding that

placement enables an advertiser to put a picture of merchandise into a copyrightable scene next to a celebrity's image without first clearing it with the actor. The latter scenario is merely a revolutionized version of the former, as both involve merchandising a product through celebrity-image packaging.

Several additional facts support this Note's assertion that an actor's persona is a separate concept from his or her television performance and that the right of publicity thus can be broadened to accommodate digital product placement concerns. Although an actor's portrayal of a character primarily benefits the television studio by adding copyrightable artistic value to a work, that same actor's underlying image as a celebrity provides him with his own marketable, non-copyrightable commercial value warranting publicity rights.[198] Although right of publicity cases historically have dealt with the appropriation of particular aspects of a person's identity (such as a name or photograph) rather than a televised image of the whole person,[199] many courts have observed that the right cannot be limited to defined methods of appropriating a person's image.[200] Along these lines, some states currently recognize publicity rights in audiovisual images or even in the "natural person."[201] Furthermore, those states that do not recognize broader publicity rights should keep in mind that, "[w]hile a photograph or motion picture is certainly 'fixed,' the underlying real appearance of the subject is not 'fixed' . . . . The photographic copy is 'fixed,'

---

federal copyright laws did not preempt a model's right of publicity claim because the Copyright Act did not protect her persona within a copyrightable photograph).

198. *See, e.g.*, Bi-Rite Enters., Inc. v. Button Master, 555 F. Supp. 1188, 1199 (S.D.N.Y. 1983) ("[The right of publicity] protects the persona—the public image that makes people want to identify with the object person, and thereby imbues his name or likeness with commercial value marketable to those that seek such identification."); 1 MCCARTHY, *supra* note 76, § 4:45, at 270 ("A 'persona' has commercial value in that it can attract consumers' attention to an advertisement or product. In creating a right of publicity, the law recognizes the existence of this economic reality.").

199. *See Toney*, 406 F.3d at 910–11 (holding that federal copyright laws did not preempt a model's right of publicity claim because the Copyright Act did not protect her persona within a copyrightable photograph); Downing v. Abercrombie & Fitch, 265 F.3d 994, 1004 (9th Cir. 2001) (upholding plaintiffs' right of publicity claim against defendant for publishing their photos and names in a catalog without their authorization).

200. *See, e.g.*, Abdul-Jabbar v. General Motors Corp., 85 F.3d 407, 414 (9th Cir. 1996) ("A rule which says that the right of publicity can be infringed only through the use of nine different methods of appropriating identity merely challenges the clever advertising strategist to come up with the tenth."); White v. Samsung Elec. Am., Inc., 971 F.2d 1395, 1398 (9th Cir. 1992) ("It is not important *how* the defendant has appropriated the plaintiff's identity, but *whether* the defendant has done so."); Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 837 (6th Cir. 1983) ("[I]dentity may be appropriated in various ways.").

201. *See supra* notes 94–95 and accompanying text (discussing the various state statutes that broadly define the types of images that the right of publicity protects).

but the underlying reality of the subject can never be 'fixed.'"[202] The artistic content of a television show and the performances therein—whether at first broadcast or in syndication—will remain the same for as long as the studio airs the program, but the value of an actor's individual identity changes every day. Digital product placements will contribute to the changing value of actors' images for better or for worse; therefore, the right of publicity should be broadened to account for the ever-increasing practice of companies using digital advertising to benefit from such images without actors' consent.

Finally, the distinction between actors and the fictional characters they portray on television further supports the argument that actors should have publicity rights in the images underlying their performances. While actors' performances further the artistry of copyrightable television shows, they also affect the commercial value of the actors' underlying images as public figures. In fact, courts have recognized that "the focus of any right of publicity analysis must always be on the actor's own persona and not the character's."[203] Thus, the popularity or notoriety of a particular fictional character does not affect whether the person portraying that character has a commercial interest in his or her image. Fortunately, just because an actor gains fame by playing a specific character on television does not mean he loses the right to benefit from the newfound commercial value of his likeness.[204] The television studio may reap the rewards of creating a popular fictional character, but the actor who fills this role should not have to cede the commercial value of his non-fictional identity as the actor portraying that character. In this light, actors who believe a digital product placement has violated their rights to control the use of their images can separate their portrayal of a character for the benefit of a studio from the image of themselves as celebrities used to endorse or draw attention to a company's merchandise without their consent. Companies can—and will—benefit from placing digital product placements into a television performance but must first consult with the actors whose underlying images they wish to use to their commercial advantage.

---

202. 2 MCCARTHY, *supra* note 167, § 11:52, at 758–59.

203. *See, e.g.*, Landham v. Lewis Galoob Toys, Inc. 227 F.3d 619, 626 (6th Cir. 2000) (holding that plaintiff had no right of publicity claim because he had failed to show that defendant's toy, which was only one and one-half inches tall and had no eyes or mouth, evoked his own persona and identity, as distinct from the character he played).

204. *See* Wendt v. Host Int'l, Inc., 125 F.3d 806, 811 (9th Cir. 1997) ("While it is true that [plaintiffs'] fame arose in large part through their participation in *Cheers*, an actor or actress does not lose the right to control the commercial exploitation of his or her likeness by portraying a fictional character.").

IX. Conclusion

Technological advances like digital recording devices and downloadable television programs, which allow viewers to skip commercials or avoid them altogether, are well on their way to rendering the traditional thirty-second commercial advertisement obsolete. In order to keep up, many companies are themselves turning to digital technology, inserting their products into television shows after filming is complete and, importantly, long after actors have surrendered their artistic rights in their performances. Actors have a commercial interest in their underlying images, however, and digital product placement runs the risk of violating actors' right of publicity by appropriating their valuable personae without their consent. Although no case has yet addressed whether an advertiser's use of product placement implicates the right of publicity, actors should be concerned in light of the changes in television advertising that will enable post-production digital advertisements to occur. Courts should likewise be prepared to address these issues and to recognize that the right of publicity can—and should—be expanded to give actors the increased protection they need.

As McCarthy notes, "[c]ommercial users and advertisers will undoubtedly come up with variations [of identity appropriation] now unforeseeable. The pressures of commercial rivalry may drive merchants to devise subtle, yet legally actionable, variations in order to take a free ride on the persona of others."[205] Indeed, the unknown possibilities of digital product placement, which remains a rapidly growing practice, combined with advertisers' needs to combat the increased use of commercial-skipping technology, will lead to more companies hitching a "free ride" on television actors long after the actors have completed their employment in a given television series. Because the Copyright Act insulates television studios from suit, and actors have no moral rights to their performances, the right of publicity is likely the sole avenue toward curbing companies' misappropriation of actors' images for their commercial benefit. As creative methods of advertising such as digital product placement increase, so too must the control that the law grants to actors over their images; courts must recognize the expanding means by which advertisers can violate actors' right of publicity and extend the doctrine accordingly. By carefully crafting right of publicity claims against companies that use digital technology to benefit from their past performances, actors can protect their hard-earned commercial value while avoiding copyright preemption. We may live in a branded world, but that is no reason to confuse illusion and illustration with reality.

---

205. 1 MCCARTHY, *supra* note 76, § 4:45, at 272.