The Right of Publicity in Digitally Produced Images: How the First Amendment is Being Used to Pick Celebrities' Pockets

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I. INTRODUCTION

The digital altering of photographs presents one example of a recurring legal problem: How courts should apply existing legal doctrines to emerging technologies. Often, new technologies raise issues that preexisting case law does not adequately address. As technology continues to evolve and improve, it is likely that courts will have to decide issues relating to new technology without resorting to traditional legal doctrine, recognizing that new situations do not always contain parallels to precedent. In this article, I intend to examine one narrow issue of law implicated by the new technology of digitally altering photographs: Celebrities' right of publicity in their digitally altered images.

In *Hoffman v. Capital Cities/ABC, Inc*,[1] the Ninth Circuit adopted a publicity rule for digitally altered images that severely undercuts celebrities' interest in their own images. The *Hoffman* Court held that digitally altered images that are not used as part of a traditional advertisement are entitled to the same First Amendment protection as other non-commercial speech. Thus, in order to prevail in a suit against the publisher of a digitally altered image, a celebrity must prove that the image was published with the intent to create a false impression in the mind of the reader that the image had not been altered. However, digitally altered images implicate privacy and property interests for celebri-

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[1] 255 F.3d 1180 (9th Cir. 2001).

ties that were not addressed in the *Hoffman* case. In this article, I will examine those interests within the broader framework of the publicity tort as a privacy and a property interest. First, I will discuss the facts of the *Hoffman* case within the context of current publicity case law. Second, I will identify the privacy and property interests unique to digitally altered images. Third, I will examine the likelihood that either of the interests will be vindicated in the wake of *Hoffman*. Ultimately, given the broad First Amendment protection that the *Hoffman* Court is willing to extend to publications in their use of digitally altered images, it appears that only a property theory of the publicity tort, and not a privacy theory, may be successful in future cases.

II. The Hoffman Case in Context

In its March 1997 issue, Los Angeles Magazine ("LAM") published an article titled "Grand Illusions," which contained digitally altered film stills of famous celebrities, making it appear that the actors were wearing the latest designer fashions. LAM altered a well-known image from the movie "Tootsie," placing actor Dustin Hoffman's head on the body of a male model who was wearing a woman's dress and shoes; the new image bore the caption: "Dustin Hoffman isn't a drag in a butter-colored silk gown by Richard Tyler and Ralph Lauren heels."[2] LAM did not obtain permission from either Columbia Pictures, which holds the copyright to "Tootsie," or Mr. Hoffman to publish this image.[3]

In April 1997, Mr. Hoffman filed a complaint against LAM's parent company, Capital Cities/ABC, Inc. The complaint alleged that LAM's publication of the altered photograph misappropriated Mr. Hoffman's name and likeness, violating California's common law and statutory publicity right.[4] After a bench trial, the district court found for Mr. Hoffman on all of his claims, rejecting LAM's defense that its use of the photograph was protected by the First Amendment.[5] The court awarded Mr. Hoffman $1,500,000 in compensatory damages, and $1,500,000 in punitive damages. LAM appealed the district court's

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[2] *Id.* at 1183.

[3] *Id.* The court did not address whether Columbia Pictures would have a cause of action against LAM for copyright infringement. Presumably, whether the image had been "significantly altered" would determine whether a copyright violation exists. *See* Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990) (noting that the doctrine of fair use allows the unauthorized use of copyrighted material if the challenged use is "transformative," *i.e.*, if the copyrighted matter is "used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings").

[4] At common law these suits are referred to as publicity or misappropriation torts.

[5] Hoffman v. Capital Cities/ABC, Inc., 33 F. Supp. 2d 867 (C.D. Cal. 1999).

judgment and the Ninth Circuit reversed, stating that LAM's publication of the photograph was not commercial speech and was therefore protected by the First Amendment.[6]

The *Hoffman* case presents a case of first impression: What is a celebrity's publicity interest in her digitally altered image?[7] Previous cases have held that a celebrity has a publicity interest in her likeness, allowing her to recover when companies publish advertisements that include her picture,[8] voice,[9] or an image intended to evoke the identity of the celebrity.[10] It has been established that although commercial speech — *e.g.*, an advertisement — may often be the basis for tort recovery, a feature that is noncommercial in nature is entitled to stronger First Amendment protection.[11]

The *Hoffman* Court concluded that a celebrity's right to recover for misappropriation in a noncommercial publication is subject to the "actual malice" standard set forth in *New York Times Co. v. Sullivan*.[12] At issue in *Sullivan* was the right to recover for a defamatory editorial piece detailing the abusive behavior of Alabama law enforcement officers. Although the piece contained several inaccuracies, the Supreme Court held that the plaintiff could not recover for false statements in a noncommercial piece without showing "that the statement was made with 'actual malice' – that is, with knowledge that it was false or with reckless disregard of whether it was false or not."[13]

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[6] *Hoffman*, 255 F.3d at 1186.

[7] A similar issue arose in *Grant v. Esquire, Inc*, 367 F. Supp. 876 (S.D.N.Y. 1973), in which actor Cary Grant sued Esquire magazine for publishing an image of his face grafted (presumably, given the date of the litigation, without "digital" technology) onto the body of another model. Grant had originally agreed to pose for photographs, which appeared in a 1946 issue of the magazine. In 1971, Esquire republished the same picture, but substituted for Mr. Grant's body the body of a model wearing modern clothing. *Id.* at 877-78. The *Grant* Court denied Esquire's motion for summary judgment, stating that the question would be left to the jury "whether defendant Esquire has appropriated plaintiff Grant's picture for purposes of trade – *e.g.*, merely to attract attention – or whether the picture was used in the course of some legitimate comment on a public figure or subject of public interest with which plaintiff has voluntarily associated himself." *Id.* at 880-81.

[8] Newcombe v. Adolf Coors Co., 157 F.3d 686, 692-93 (9th Cir. 1998).

[9] Midler v. Ford Motor Co., 849 F.2d 460, 461 (9th Cir. 1988) (allowing recovery for use in commercial of "sound-alike" rendition of song plaintiff had recorded).

[10] White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1399 (9th Cir. 1992) (finding that an advertisement showing a robot dressed in an evening gown and standing in front of a game board that resembled Wheel of Fortune infringed on the publicity rights of game show hostess Vanna White).

[11] *See* Lorillard Tobacco Co. v. Reilly, 533 U.S. 525, 553 (2001) (explaining that "commercial speech does not fall outside the purview of the First Amendment," but rather commercial speech is afforded "a measure of First Amendment protection 'commensurate' with its position in relation to other constitutionally guaranteed expression") (citations omitted).

[12] 376 U.S. 254 (1964).

[13] *Id.* at 279-80.

Here, having decided that the "Grand Illusions" feature was not commercial speech,[14] and that LAM had not "intended to create the false impression in the minds of its readers that when they saw the altered 'Tootsie' photograph they were seeing Hoffman's body,"[15] the court concluded that no actual malice existed, and thus no recovery for misappropriation was warranted. However, in applying the *Sullivan* actual malice test, the court ignored the property and privacy interests implicated in digitally altering a celebrity's image.[16]

Traditional misappropriation cases rest on the theory of protecting the celebrity's interest in her identity, which may be valuable in the promotion of products, from unauthorized commercial exploitation.[17] However, the creation of a digitally altered image has additional implications for the protection of identity. First, the privacy concerns of a celebrity are heightened in digitally altered images. Even if, as in *Hoffman*, the new image is accompanied by a disclaimer that the image has been altered, it may still be a source of emotional discomfort to the celebrity or may still do reputational harm. Moreover, the use of digital technology gives publications the ability to create images of celebrities that are far more damaging than any actual photograph. Technological advances may simulate an actual posed photograph "accurately enough to convince the average person that a piece of computer animation is actually an image of a real person."[18] Second, the property concerns of a celebrity are heightened in digitally altered images. These altered images implicate a celebrity's basic earning potential. Permitting magazines to publish digitally altered images of celebrities without obtaining consent allows those publications to deprive the celebrities of the fees that they would otherwise be able to collect for appearing in a photo shoot for the publication.

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[14] "These facts [that the body double was identified as wearing Ralph Lauren shoes and that there was a Ralph Lauren advertisement elsewhere in the magazine] are not enough to make the 'Tootsie' photograph pure commercial speech. . . . LAM did not use Hoffman's image in a traditional advertisement printed merely for the purpose of selling a particular product." Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1185 (9th Cir. 2001).

[15] *Id.* at 1187.

[16] Arguably, because the LAM article did not contain an assertion of fact, the *Sullivan* test was inapplicable. *See* Hustler Magazine v. Falwell, 485 U.S. 46, 57 (1988) (White, J., concurring).

[17] *See, e.g.*, Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983).

[18] Brian Guenter et al., *Making Faces*, *in* PROCEEDINGS OF THE 25TH ANNUAL CONFERENCE ON COMPUTER GRAPHICS AND INTERACTIVE TECHNIQUES 55 (1998); *see also* Eihachiro Nakamae et al., *A Montage Method: The Overlaying of the Computer Generated Images onto a Background Photograph*, *in* PROCEEDINGS OF THE 13TH ANNUAL CONFERENCE ON COMPUTER GRAPHICS AND INTERACTIVE TECHNIQUES 207 (1986).

III. Privacy & Property Interests in Digitally Altered Images

Legal commentators have historically disagreed whether the interest protected by publicity suits is a privacy interest or a property interest. Some commentators have insisted that "every man has a right to prevent the commercial exploitation of his personality, not because of its commercial worth, but because it would be demeaning to human dignity to fail to enforce such a right,"[19] while other commentators maintain that "[t]he interest protected is not so much a mental as a proprietary one, in the exclusive use of the plaintiff's name and likeness as an aspect of his identity."[20]

The characterization of the publicity tort as a suit either in privacy or in property has influenced court decisions. The early case of *Roberson v. Rochester Folding Box Co.*[21] denied a plaintiff relief for the unauthorized use of her photograph as part of an advertising flier, because the plaintiff based her suit on a theory of privacy. [22] The court indicated that the plaintiff might have prevailed if she had characterized her suit as a vindication of her property rights, stating that to succeed the plaintiff needed to prove "breach of trust or that plaintiff had a *property right* in the subject of litigation which the court could protect."[23] Thus, in evaluating the publicity rights of celebrities in digitally altered images, the ultimate success of claims may depend upon the court's perception of the tort's underlying theory.

A. *Privacy Interests*

Traditionally, some commentators have argued in favor of a privacy theory of the misappropriation tort. For example, Edward Bloustein wrote:

> It is a mistake, however, to conclude from these "right of publicity" cases that all the cases involving commercial use of name or likeness are founded on a proprietary interest. Moreover, the very characterization of these cases as involving a "right to publicity" disguises the important fact that *name and likeness can only begin to command a commercial price in a society which recognizes that there is a right to privacy*, a right to control the conditions under which name and like-

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[19] Edward J. Bloustein, *Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U. L. Rev. 962, 989 (1964).

[20] William L. Prosser, *Privacy*, 48 Calif. L. Rev. 383, 406 (1960).

[21] 171 N.Y. 538 (1902).

[22] The court recognized that she was "greatly humiliated by the scoffs and jeers of persons who have recognized her face and picture . . . and her good name has been attacked, causing her great distress and suffering both in body and mind." *Id.* at 542-43.

[23] *Id.* at 550 (emphasis added).

> ness may be used. . . . Thus, there is really no "right to publicity"; there is only a right, under some circumstances, to command a commercial price for abandoning privacy.[24]

The earliest decision recognizing the right of publicity relies on a privacy theory.[25] In *Pavesich v. New England Life Insurance Co.*,[26] the plaintiff's photograph was used without his consent in a newspaper advertisement for life insurance. The Georgia Supreme Court, relying heavily on the germinal Warren and Brandeis article,[27] allowed the plaintiff to recover for "a trespass upon [his] right of privacy."[28] There was no suggestion in the case that the plaintiff sought to vindicate a property interest. The *Pavesich* Court held that the misappropriation of one's likeness brings "even the individual of ordinary sensibility, to a realization that his liberty has been taken away from him; and, as long as the advertiser uses him for these purposes, . . . he is no longer free."[29]

The unauthorized publication of a digitally altered image may violate a celebrity's right to privacy because it infringes upon her human dignity.[30] The image may cause the celebrity considerable personal embarrassment, even to an extent not possible by the publication of the printed word or an accurate photograph. But the *Hoffman* Court neglected to consider this issue, focusing instead on whether LAM intended to create the impression that the model in the altered image was actually Mr. Hoffman. Because the magazine included statements indicating that the image had been altered, the court concluded that LAM did not intend to create a false impression, and thus the article was

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[24] Bloustein, *supra* note 19 (emphasis added).

[25] An earlier case before the New York Court of Appeals rejected a privacy based theory of the misappropriation tort. The case of *Roberson v. Rochester Folding Box Co.*, 171 N.Y. 538 (1902), denied a plaintiff relief for the unauthorized use of her photograph as part of an advertising flier, yet recognized that she was "greatly humiliated by the scoffs and jeers of persons who have recognized her face and picture . . . and her good name has been attacked, causing her great distress and suffering in both body and mind." *Id.* at 542-43. The Roberson majority indicated that to succeed in such a case the plaintiff would have to prove "breach of trust or that plaintiff had a property right in the subject of litigation which the court could protect." *Id.* at 550.

[26] 50 S.E. 68 (Ga. 1905).

[27] Samuel D. Warren & Lewis D. Brandeis, *The Right of Privacy*, 4 HARV. L. REV. 193 (1890).

[28] *Pavesich*, 50 S.E. at 81.

[29] *Id.* at 80.

[30] *See* Bloustein, *supra* note 19. Note that the *Pavesich* Court appears to have based its privacy analysis on a right to self determination. *See* text accompanying *supra* note 29. The right to dignity and the right to self determination are two of several rights often grouped together under the title of "privacy." *See generally* Anita L. Allen, *Constitutional Privacy*, *in* A COMPANION TO PHILOSOPHY OF LAW AND LEGAL THEORY 140 (Dennis Patterson, ed., 1996).

protected under the *Sullivan* actual malice test.[31] In effect, the court held that so long as a publication prints an accompanying disclaimer, explaining that the image has been digitally altered, tort recovery is barred.

There are several problems with a rule that makes a disclaimer a *per se* bar to recovery. First, the court does not require a very informative disclaimer. The court notes that the photo included a caption stating "Digital composite by ZZYZX" and that the text of the article explained that it clothed celebrities "with the help of digital magic and today's hottest designers."[32] The court also cites the Contributors page of the magazine, which stated that the artist who designed the images used computer software to create the composites and proclaimed that "with computers . . . you can transform anything – even the past," as evidence that the editors did not intend "to suggest falsely to the ordinary reader that he or she was seeing Hoffman's body in the altered 'Tootsie' photograph."[33] However, these disclaimers do not make the extent of the digital manipulation clear. For example, the disclaimer did not indicate that the body wearing the designer gown did not belong to Mr. Hoffman.[34] On the contrary, one of the magazine's editors testified that she "wanted the male model whose body would appear in the altered 'Tootsie' photograph to have Hoffman's body type."[35] Furthermore, none of these disclaimers stated that the image was altered without Mr. Hoffman's approval or consent.

Second, if a publication finds some value in printing an image, despite having to include a disclaimer that the image is not accurate, then the existence of that value suggests that the disclaimer may not alleviate all of the possible harm done by the altered image to the celebrity's dignity. Courts are willing to conclude that the publication of an altered image without a disclaimer is actionable, because they recognize that an inaccurate photo could harm its subject. For example, a magazine might decide to publish a digitally altered image of a celebrity engaged in an adulterous embrace to illustrate an article discussing rumors of the celebrity's infidelity. If the magazine were to publish the image without a disclaimer, the celebrity could recover against the publication.[36] However, if a disclaimer were included, applying the *Hoffman* analysis, no right of recovery would exist. If we examine the

[31] Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1187-88 (9th Cir. 2001).
[32] *Id.* at 1187.
[33] *Id.* at 1188.
[34] *Id.*
[35] *Id.*
[36] Under these facts the celebrity would recover for libel rather than for misappropriation.

magazine's motive in publishing a photograph, which the magazine must admit is not accurate, it becomes clear that a disclaimer may not offer a celebrity adequate protection. For example, the editors might hope to attract readers who will purchase the magazine because they see a scandalous photograph on the cover, but do not see the disclaimer. Just as potential readers might overlook the disclaimer, so too might the friends and family of the celebrity. Or perhaps the magazine hopes to make its article discussing the alleged infidelity appear more credible, by supplying an image.[37] The friends and family of the celebrity might also believe the rumors to be more credible, thereby placing a great strain on the celebrity's personal relationships, the presence of the disclaimer notwithstanding.

Finally, regardless of the inclusion of a disclaimer, digital technology has the capability to create images that may be far more damaging to a celebrity than a photograph that could otherwise be secured. For example, the situation has arisen on several occasions where the face of a celebrity has been digitally imposed on the naked body of an unknown model.[38] Apparently, under *Hoffman*, so long as the publication includes a disclaimer, such digitally created pornography could not be the subject of a publicity suit.[39] This issue arises in a less blatant form in the *Hoffman* case. The dress used in the LAM feature was much more revealing than the original "Tootsie" dress. While Mr. Hoffman was willing to don women's clothing for his role in "Tootsie" – a movie about gender inequality – he may have been unwilling to

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[37] For example, to illustrate expert testimony in law suits, attorneys will often provide visual aides to illustrate the expert's theory of the case. These visual aides make the expert's testimony more plausible to the jury, as the jury is able to visualize the testimony of the expert.

[38] As one attorney noted, "a common problem is having a photo of a celebrity's head superimposed on a naked body. Before the *Hoffman* decision came down, I would have never thought someone could assert a First Amendment defense to that kind of thing . . . ." Peg Brickley, *Movie Star Loses Case on First Amendment Rights: Lawsuit Is a Drag for Dustin Hoffman*, CORP. LEGAL TIMES, Sept. 2001, at 64.

[39] *But see* Ali v. Playgirl, Inc., 447 F. Supp. 723 (S.D.N.Y. 1978) (granting boxer Mohammed Ali an injunction against a women's magazine that published a nude drawing of a boxer, which was clearly intended to depict Ali).

Although a publicity suit may be precluded under *Hoffman*, a celebrity in this situation might nevertheless be able to sue for recovery. For example, a suit for intentional infliction of emotional distress might not be precluded by a disclaimer, as a court could find the image to be outrageous despite the existence of the disclaimer. However, like the publicity tort, any privacy tort may encounter difficulties. As in publicity cases, the First Amendment may be used to protect the publication, even if it is highly offensive. *See, e.g.*, Hustler Magazine v. Falwell, 485 U.S. 46 (1988) (finding that the First Amendment protected a magazine from a claim of intentional infliction of emotional distress, which arose from publication of a fictitious interview in which the plaintiff supposedly admitted to drunken incestuous intercourse with his mother in an outhouse).

pose wearing the dress published in LAM, which could be seen as sexually suggestive.

Unfortunately, the *Hoffman* Court neglected to address these unique privacy concerns. It instead chose to treat the digitally altered image as it would any other publication, and found that LAM's First Amendment rights precluded tort recovery.

B. *Property Interests*

Although originally recognized as a privacy tort, the notion of the publicity right as a property interest has found continued support in the case law.[40] For example, in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,[41] the Second Circuit recognized the right of publicity as a property right that protects "prominent persons" who "far from having their feelings bruised through public exposure of their likeness, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways."[42] As a property right, courts have often limited recovery for misappropriation to commercial speech, *e.g.*, advertisements. However, the altered image in *Hoffman* does not fall neatly within the pre-existing division of commercial and noncommercial speech. The exact test of whether speech is commercial, and thus entitled to less First Amendment protection, is unclear.[43] Cases involving new technology, *e.g.*, the internet, have further obscured the distinction.[44] In *Hoffman*, the court placed special emphasis on the apparent lack of commercial gain by the magazine from having

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[40] *See supra* notes 25-29 and accompanying text.

[41] 202 F.2d 866 (2d Cir. 1953).

[42] *Id.* at 868.

[43] *See* Dawn H. Dawson, Note, *The Final Frontier: Right of Publicity in Fictional Characters*, 2001 U. ILL. L. REV. 635 (focusing on the lack of uniform publicity protection and advocating enactment of a federal statute protecting the right of publicity). *Compare* Dworkin v. Hustler Magazine, Inc., 867 F.2d 1188, 1197-98 (9th Cir. 1989) (finding that a feature published to increase a magazine's circulation did not transform the feature into commercial speech; the feature was still entitled to First Amendment protection); *with* Ali v. Playgirl, Inc., 447 F. Supp. 723 (S.D.N.Y. 1978) (granting boxer Mohammed Ali an injunction against a women's magazine that published a nude drawing of a boxer, which was clearly intended to depict Ali, when only commercial aspect of drawing was that it increased circulation of publication).

[44] *See* Ken Roberts Co. v. Go-To.Com, No. C99-4775, 2000 U.S. Dist. LEXIS 6470 (N.D. Cal. 2000) (finding unlawful appropriation in using the name of plaintiff's founder in connection with various webpages on defendant's website to attract customers); Michaels v. Internet Entm't Group, Inc., 5 F. Supp. 2d 823, 837 (C.D. Cal. 1998) (finding unlawful commercial appropriation in unauthorized display of videotaped segments of plaintiff engaging in sexual activity where those segments were displayed over the defendant's paid subscription service).

placed Mr. Hoffman in clothes from any particular designer in deciding that the feature was non-commercial.[45] This suggests that if the magazine *had* received some sort of consideration from the designers, Mr. Hoffman would have had a cause of action.[46]

Focusing on whether speech is commercial in nature to determine the availability of recovery creates three problems: First, although the *Hoffman* Court focused on the economic gain of a publication in determining First Amendment protection, it did not consider that LAM's use of digital technology to create a new image allowed it to avoid paying a fee to Columbia Pictures (to use the copyrighted image from the movie) or to Mr. Hoffman (to pose for a new photo). As the Supreme Court said in *Zacchini v. Scripps-Howard Broadcasting Co.*, "[n]o social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay."[47] Second, it seems inequitable to condition Hoffman's property interest in his own image on the existence of a commercial relationship between the magazine and the designers. Hoffman suffers the same harm — the inability to control the use of his likeness for commercial gain[48] — regardless of the commercial relationship between LAM and the designers. Third, using Mr. Hoffman's highly recognizable face in a feature allows LAM to increase its circulation.[49] The magazine had the option to use another male model in a fashionable gown to recreate the scene from "Tootsie," however, the magazine

[45] Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1185 (9th Cir. 2001).

[46] This reading is further supported by the Ninth Circuit's subsequent decision in *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001), in which it allowed a misappropriation suit where a photograph of plaintiffs was published in a catalogue, despite the fact that the photograph was published with an article about surfing lifestyle rather than as part of an advertisement. The *Downing* Court specifically distinguished *Hoffman* on the grounds that "L.A. Magazine was unconnected to and received no consideration from the designer for the gown depicted in the article." *Id.* at 1004 n.2.

[47] Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 576 (1977) (quoting Harry Kalven, Jr., *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966)).

[48] This inability appears to be of special concern to Hoffman who "maintains a strict policy of not endorsing commercial products for fear that he will be perceived in a negative light by his peers and motion picture industry executives, suggesting that his career is in decline and that he no longer has the business opportunities or the box office draw as before." Hoffman v. Capital Cities/ABC, Inc., 33 F. Supp. 2d 867, 870 (C.D. Cal. 1999).

[49] While some courts have been willing to accept the increased circulation argument as evidence that a piece is commercial, other courts have rejected this argument. *Compare* Dworkin v. Hustler Magazine, Inc., 867 F.2d 1188, 1197-98 (9th Cir. 1989) (rejecting the argument that a feature published to increase a magazine's circulation transformed the feature into commercial speech; the feature was still entitled to First Amendment protection); *with* Ali v. Playgirl, Inc., 447 F. Supp. 723 (S.D.N.Y. 1978) ("The nude portrait was clearly included in the magazine solely 'for purposes of trade—e.g., merely to attract attention.'") (quoting Grant v. Esquire, Inc., 367 F. Supp. 876, 881 (S.D.N.Y. 1973)).

felt that there was some added value (presumably commercial as well as artistic)[50] in using Mr. Hoffman's face; thus the feature was not without commercial value.

In addition, by allowing LAM to raise a First Amendment defense and applying the actual malice test (*i.e.*, focusing only on whether the magazine intended to create a false impression in the mind of the reader that the image had not been altered), the *Hoffman* Court completely ignored the larger property interests implicated by digitally altered images. The actual malice test focuses on determining falsity, which, in the publicity context, only addresses Hoffman's reputational concerns and not his property interests. The publicity right in a digitally altered image implicates not only the protection of an identity for commercial promotion, but also the celebrity's earning ability.[51] Allowing magazines to publish digitally altered images of celebrities permits publications to deprive the celebrities of the fees that they would normally collect for appearing in posed photographs for the publication. Like a commercial endorsement, a fashion shoot requires a celebrity's consent and may often include a sizable fee. Indeed, this "may be the strongest case for a 'right of publicity' involving, not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the . . . activity by which the entertainer acquired his reputation . . . ."[52]

In the wake of *Hoffman*, magazines may digitally paste the faces of famous supermodels onto other models' bodies, publish those new images on their covers, and obtain the same selling power of having secured a famous covergirl, without having to pay the higher fees. By extension, using old film footage and new digital technology, movie studios could release films with old images of actors inserted into new scenarios and reciting new scripts without having to compensate the actors.[53] In *Grant v. Esquire, Inc.*,[54] a court was presented with a ques-

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[50] "Viewed in context, the article as a whole is a combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors. Any commercial aspects are 'inextricably entwined' with expressive elements, and so they cannot be separated out 'from the fully protected whole.'" *Hoffman*, 255 F.3d at 1185 (quoting Gaudiya Vaishnava Soc'y v. San Francisco, 952 F.2d 1059, 1064 (9th Cir. 1991)).

[51] *See* Erin Giacoppo, Note, *Avoiding the Tragedy of Frankenstein: The Application of the Right of Publicity to the Use of Digitally Reproduced Actors in Film*, 48 HASTINGS L.J. 601 (1997) (arguing for a publicity right in digitally altered images under a royalties or salary theory).

[52] *Zacchini*, 433 U.S. at 576.

[53] *See* Brickley, *supra* note 38 (noting that the Screen Actors guild has expressed concern over technology that allows such manipulation); *see also* Giacoppo, *supra* note 51, at 602 (noting that the technology needed to resurrect dead actors to star in new films is likely to be available "in the near future"); Jerome E. Weinstein, *Abbott and Costello Meet Frankenstein,*

tion similar to the question posed in *Hoffman* — a celebrity's publicity rights in a photograph in which his face had been mechanically "cut and pasted" onto the body of another model.[55] The *Grant* Court concluded that:

> [I]t by no means follows that publishers could present an apparently posed picture of [supermodel] Twiggy and – without her consent – use it in competition with other pictures for which she had professionally posed or in competition with (or in substitution for) the professionally posed pictures of other models. *A fortiori*, no magazine could without her consent crop her head off a posed photograph and superimpose it on the torso of another model.[56]

In contrast, the *Hoffman* ruling allows publishers to create new works of art without obtaining consent or paying a salary, and protects this behavior under the First Amendment. Notably, the *Hoffman* opinion does not mention the *Grant* case, even though, ironically, one of the other film stills in the LAM article featured actor Cary Grant.

Rather than confining its analysis of the LAM article to a simple determination of whether the piece (1) constituted commercial speech and (2) satisfied the *Sullivan* actual malice test, the *Hoffman* Court should have considered the property interests implicated by the article.[57] For example, the court could have evaluated the article in terms of a right of performance. The right of performance is a corollary to the right of publicity. This right was recognized by the Supreme Court in *Zacchini v. Scripps-Howard Broadcasting Co.*,[58] in which the Court allowed a plaintiff to recover against a broadcasting company for the unauthorized broadcast of his human cannonball act. The *Zacchini* Court noted that:

Dracula and the Wolf Man in the Year 2000 or the Birth of the Synthespian, 32 BEVERLY HILLS B. ASS'N J. 32 (1997) (describing technology available to create an image of a deceased actor, which is capable of appearing in new films).

[54] 367 F. Supp. 876 (S.D.N.Y. 1973).

[55] *See supra* note 7.

[56] *Grant*, 367 F. Supp. at 880.

[57] For example, a recent California Supreme Court case attempted to confront the property interests implicated in the artistic use of the images of the comedy trio the Three Stooges in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001), *cert. denied*, 122 S.Ct. 806 (2002). The *Comedy III* Court fashioned a modified transformative use test (which is often used in copyright fair use cases, *see supra* note 3) and a subsidiary inquiry, ultimately deciding that the defendant's work did not warrant protection under the First Amendment protection because it failed to add significant transformative elements or creative contributions to the celebrities' likenesses and the work derived its value primarily from the fame of the celebrities depicted. *Comedy III*, 21 P.3d at 811. For a detailed description and analysis of this case, see Pete Singer, Note, *The Three Stooges Latest Act: Attempting to Define the Scope of Protection The First Amendment Provides to Works of Art Depicting Celebrities*, 27 DAYTON L. REV. 313 (2002).

[58] 433 U.S. 562 (1977).

> The broadcast of a film of petitioner's entire act poses a substantial threat to the economic value of that performance. . . . [This] may be the strongest case for a 'right of publicity' — involving, not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.[59]

Those commentators who champion the existence of a right of performance, base their arguments on *Zacchini* and a number of lower court decisions.[60] Although these decisions do not explicitly rely upon a right of performance,[61] but instead rest their rulings on other tort doctrines (*e.g.*, the right of publicity), these cases establish that the right of publicity extends beyond protecting celebrities from unauthorized use of their identities for commercial advertisements. Especially helpful from these cases is the Court's balancing of a defendant's First Amendment rights against a plaintiff's "right of exclusive control over the publicity given to his performance."[62] Recognizing that a celebrity's professional livelihood encompasses not only whatever activity from which her fame is primarily derived (*i.e.*, an actor primarily derives her fame from acting in films, television, etc.), but also other career-related activities, such as publicity campaigns, interviews, and appearing in magazines, may result in more favorable treatment of complaints against the publishers of digitally altered images. Such recognition may allow a celebrity to recover in such an action because the publishing of a digitally altered image would "go[ ] to the heart of petitioner's ability to earn a living as an entertainer."[63]

Although we want to encourage free expression and avoid the chilling of speech, we do not want to deprive actors and other celebrities of

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[59] *Id.* at 575-76.

[60] *See e.g.*, Weinstein, *supra* note 53, at 36-43.

[61] *See, e.g.*, Ettore v. Philco Television Broad. Corp., 229 F.2d 481 (3d Cir. 1956); Estate of Elvis Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981); Price v. Worldvision Enters., Inc., 455 F. Supp. 252 (S.D.N.Y. 1978), *aff'd*, 603 F.2d 214 (2d Cir. 1979); Pittsburgh Athletic Co. v. KQV Broad. Co., 24 F. Supp. 490 (W.D. Pa. 1938); Chaplin v. Amador, 269 P. 544 (Cal. Ct. App. 1928); Lennon v. Pulsebeat News, Inc., 143 U.S.P.Q. 309 (N.Y. Sup. Ct. 1964); Nat'l Exhibition Co. v. Fass, 143 N.Y.S.2d 767 (N.Y. Sup. Ct. 1955). *But see* Astaire v. Best Film & Video Corp., 116 F.3d 1297 (9th Cir. 1997), *cert. denied*, 525 U.S. 868 (1998).

[62] *Zacchini*, 433 U.S. at 575. In deciding that the unauthorized broadcast of an entertainer's live act was not protected by the First Amendment, the *Zacchini* Court explained that:

> [t]here is no doubt that entertainment, as well as news, enjoys First Amendment protection. . . .But it is important to note that neither the public nor respondent will be deprived of the benefit of petitioner's performance as long as his commercial stake in his act is appropriately recognized.

Id. at 578.

[63] *Id.* at 576.

compensation for their most valuable possession – their highly recognizable faces and names. Just as the First Amendment would not allow a magazine to contract with a celebrity to pose for the cover of their magazine and then refuse to pay her after the picture is taken, it should not allow publications to circumvent the salary owed to celebrities by artificially creating a photo shoot through the use of digital technology.

IV. Which Theory of Publicity is Likely to Prevail?

The largest stumbling block to the success of any publicity case is the First Amendment. For each publicity claim, courts must balance the interests of the celebrity against the interests of the public in reading the contested publication. Because courts have traditionally favored the rights of the public to have unfettered access to information, celebrities must find a way to remove the consideration of digitally altered images from the traditional First Amendment equation if they are to prevail in these publicity suits.

Although digitally altered images create new privacy issues, it is unlikely that these additional issues will tip the First Amendment scales in favor of celebrities. The realistic appearance of digitally altered images allows publishers to create fictional images that are virtually indistinguishable from actual photographs.[64] However, so long as the images are accompanied by disclaimers, they are still entitled to First Amendment protection as non-factual works.[65]

One of the justifications for allowing the publication of a celebrity's photograph obtained without her permission is that the item is "newsworthy." One would assume that once the image has been altered, the item arguably ceases to be newsworthy, as it is no longer truthful.[66] However, courts have extended the deference afforded to communications that are newsworthiness to fiction based art, but modify the inquiry to ask whether the matter is of "public interest" or has "social value."[67] Such a test may result in near total deference since *all* art arguably has *some* value, however small, to some portion of the public. Some courts have recognized that the amount of protection accorded to works of art should not be as great as that given to factual works because "[t]he law generally recognizes a greater need to dissem-

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[64] *See supra* note 18 and accompanying text.

[65] *See supra* notes 31-32 and accompanying text.

[66] See Bridgette Marie de Gyarfas, *Right of Publicity v. Fiction-Based Art: Which Deserves More Protection?*, 15 Loy. L.A. Ent. L.J. 381 (1995) (arguing that fiction-based art should be entitled to less First Amendment protection than fact-based art, as fiction-based art is not "newsworthy").

[67] *Id.* at 397.

inate factual works than works of fiction or fantasy."[68] But other courts have declined to make such a distinction.[69] Thus, once it determined that the article was not a traditional advertisement and thus not commercial speech,[70] the *Hoffman* Court's only additional inquiry was whether LAM intended to convey the false impression that Hoffman posed for the picture. Even though a credible argument can be made that this is not the proper inquiry,[71] the courts' preexisting decisions regarding art and "non-factual statements" seem to present an insurmountable bar to recovery under a privacy theory.[72]

The most significant privacy issue created by digitally altered images is the potential to create images that are more emotionally distressing than any photograph that could be published. As discussed above, digital alteration allows for the creation of synthetic images of celebrities in embarrassing or highly offensive situations.[73] The publication of such images may be very distressing to the celebrity, yet, so long as they image is accompanied by a disclaimer, it is unlikely that such image would be actionable. Stories and photographs of celebrities' personal lives have long been the legitimate, though vacuous, topic of publication. Courts have likewise held that fictitious accounts of public figures' lives – even if highly offensive – are entitled to First Amendment protection.[74] Mere reputational harm is not sufficient to effectively challenge the First Amendment;[75] thus, digitally altered

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[68] Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 563 (1985).

[69] *See* Univ. of Notre Dame Du Lac v. Twentieth Century-Fox Film Corp., 256 N.Y.S.2d 301 (1965) (implying that entertaining works are deserving of the same level of protection as factual works, but discussing the protection of books versus motion pictures).

[70] *See* Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1185 (9th Cir. 2001), stating:

> These facts [that the body double was identified as wearing Ralph Lauren shoes and that there was a Ralph Lauren advertisement elsewhere in the magazine] are not enough to make the 'Tootsie' photograph pure commercial speech. . . . LAM did not use Hoffman's image in a traditional advertisement printed merely for the purpose of selling a particular product.

[71] The tort of misappropriation does not "require[ ] falsity or fiction" but "involves a use for the defendant's advantage." Prosser, *supra* note 20, at 407.

[72] *See supra* notes 67-69 and accompanying text.

[73] *See supra* notes 37-38 and accompanying text.

[74] *See, e.g.*, Hustler Magazine v. Falwell, 485 U.S. 46 (1988) (finding that the First Amendment protected a magazine from a claim of intentional infliction of emotional distress, which arose from publication of a fictitious interview in which the plaintiff supposedly admitted to drunken incestuous intercourse with his mother in an outhouse).

[75] In *Zacchini* the Supreme Court explained the difference between the interests protected by the false light tort and the right of publicity. The false light tort protects the reputation and (to an extent) protection against emotional distress. The interest protected by the right of publicity is a proprietary interest. The Court then concluded that while the false light tort (and the interests it protected) was not sufficient to overcome the First Amendment arguments, the right of publicity could prevail. *See* Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 572-73 (1977).

images, no matter how offensive, are unlikely to overcome First Amendment protection based on a privacy theory.

Because of the deference that courts accord to speech, any argument attacking digitally altered images *as speech* is unlikely to succeed. However, an attempt to characterize the images *as property* rather than as speech may receive better treatment in the courts. Unlike privacy rights, under which, if an individual is a public figure, are almost always subservient to the free speech rights of noncommercial publications, property rights have fared somewhat better against the First Amendment. For example, an absolutist reading of the Constitution would suggest that copyrights are invalid because the First Amendment allows unauthorized use of information, including copyrighted texts.[76] Yet, the validity of copyrights has repeatedly been recognized. Indeed, copyrights have been characterized as "categorically immune from First Amendment challenge."[77] A recent California case suggests that courts may be increasingly willing to draw parallels between copyright law and publicity claims.[78] The *Zacchini* decision also drew several parallels between an entertainer's publicity rights in his performance and the rights of a copyright holder.[79]

Moreover, the right to performance,[80] a corollary of the right to publicity, distinguishes between the right of the media to "report[ ] the newsworthy facts" about a celebrity[81] and "the appropriation of the very activity by which the entertainer acquired his reputation in the first place."[82] If a publicity plaintiff can convince a court that posing

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[76] *See* Jed Michael Silversmith & Jack Achiezer Guggenheim, *Between Heaven and Earth: The Interrelationship Between Intellectual Property Rights and the Religion Clauses of the First Amendment*, 52 Ala. L. Rev. 467, 468 (2001) (making this observation); *see also* Jed Rubenfeld, *Freedom of Imagination: Copyright's Constitutionality*, 112 YALE L.J. 1 (2002). But note that the Constitution explicitly recognizes the existence of copyrights, but does not acknowledge a right of publicity.

[77] Rubenfeld, *supra* note 76, at 11 (quoting Eldred v. Reno, 239 F.3d 372, 375 (D.C. Cir. 2001)).

[78] *See* Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797 (Cal. 2001) *cert. denied* 122 S.Ct. 806 (2002); *see also supra* note 57; Roberta Rosenthal Kwall, *Preserving Personality and Reputational Interests of Constructed Personas Through Moral Rights*, 2001 U. ILL. L. REV. 151 (arguing that a celebrity's interest in an altered image ought to be evaluated under a copyright theory).

[79] The *Zacchini* court stated:

> [T]he States's interest in permitting a 'right of publicity' is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment. . . . [T]he State's interest is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors . . . .

Zacchini, 433 U.S. at 573.

[80] *See supra* notes 58-63 and accompanying text.

[81] *Zacchini*, 433 U.S. at 574.

[82] *Id.* at 576.

for a magazine photo spread would normally entitle her to a fee and that the use of a digitally altered image deprives her of that fee, then the court may be willing to recognize the image as the plaintiff's *property*. Once the image is characterized as property rather than as speech, the court will not consider a First Amendment defense relevant to the case, allowing the recognition of the plaintiff's right of publicity in her digitally altered image and recovery for its unauthorized publication.[83]

In conclusion, because the publication of digitally altered images raises new privacy and property interests for celebrities, courts need to look beyond the traditional categorization of commercial and non-commercial speech when analyzing a celebrity's publicity interest in an altered image. They should recognize the property interests that a celebrity has in a digitally altered image in determining whether the publication of these images ought to be entitled to First Amendment protection. A publication should not be permitted to "get free" the use of a celebrity's image through digital technology because a celebrity's image "[has] market value [for which the publication] would normally pay."[84]

[83] *See supra* text accompanying note 77.
[84] *Zacchini*, 433 U.S. at 576.