







The Florida Bar Entertainment, Arts and Sports Law Section

Welcome Guest!

Wednesday, November 09, 2011

[Home](#) [Account](#) [Search](#) [Articles](#) [Events](#) [Links](#) [Rules](#) [Directory](#) [Contact](#)

Share

 0

EASL

My EASL

- [Home](#)
- [My Account](#)
- [Submit News](#)
- [View Latest Articles](#)
- [View Latest Web Links](#)
- [View Upcoming Events](#)

EASL Membership

- [Member Profiles](#)
- [Member Application](#)
- [Affiliate Application](#)

EASL Bylaws

- [EASL Bylaws \(Current\)](#)

EASL Resources

- [EASL Index of Articles](#)
- [EASL Articles by Topic](#)
- [EASL Research Links](#)
- [EASL Document Archives](#)

EASL Officers

- [EASL Executive Council](#)

EASL History

- [Past Officers](#)
- [Past Events Before 6/4](#)
- [View All Events Past 6/4](#)

EASL Media

- [EASL Photo Gallery](#)
- [EASL JukeBox](#)

EASL ListServes

- [Section Members](#)
- [Executive Council](#)
- [ListServ FAQs](#)

EASL Sponsors

- [List of Sponsors](#)
- [Sponsor Application](#)

View In Your Language

Chinese-Simple

Translate

Online

There are 18 unregistered users and 0 registered users on-line.

You can [log-in](#) or [register for a user account](#) here.

State Right Of Publicity Not Preempted By Copyright Act

on Friday, June 10, 2005 - 07:09 AM - 6090 Reads



A MODEL OPINION - FEDERAL APPEALS COURT RULES THAT STATE RIGHT OF PUBLICITY IS NOT PREEMPTED BY FEDERAL COPYRIGHT LAW

By David R. Ellis, Attorney at Law
Largo, Florida

In May 2005, a federal appeals court in Illinois reconsidered its own earlier opinion and ruled that the right of publicity under state law is not preempted by the U.S. Copyright Act. *Toney v. L'Oreal USA, Inc.*, No. 03-2184 (7th Cir. May 6, 2005).

June Toney was a model who had appeared in print advertisements, commercials, and runway shows. She signed a contract authorizing Johnson Products Company to use her likeness on the packaging of a hair-relaxer product called "Ultra Sheen Supreme" for five years from November 1995 until November 2000. She also authorized the use of her likeness in national magazine advertisements for one year.

In the year 2000, L'Oreal USA and Wella Corporation acquired the Ultra Sheen Supreme line of products. Toney claimed that L'Oreal and Wella used her likeness in connection with the packaging and promotion of the relaxer product after the contract expired. As a result, she sued them in state court, alleging that they violated her right of publicity under the Illinois Right of Publicity Act and also violated her rights under the federal Trademark (Lanham) Act.

The defendants removed the case to federal district court on the basis of federal question jurisdiction. The district court ruled that her right of publicity claims were preempted by Section 301 of the Copyright Act, 17 U.S.C. §301. She later voluntarily dismissed her Lanham Act claim with prejudice, and appealed the district court's preemption determination.

Section 301 of the Copyright Act provides that state laws that provide "rights that are equivalent to any of the exclusive rights within the general scope of copyright ... in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright ... are governed exclusively by" the federal copyright statute. Thus any state law that provides the same or similar rights to those protected by the Copyright Act are preempted by the supremacy of federal law, and rights purportedly granted by the state are of no effect.

On appeal, the Seventh Circuit Court of Appeals initially affirmed the district court's decision, saying that the plaintiff's right of publicity claim under Illinois law was preempted. *Toney v. L'Oreal USA, Inc.* (7th Cir. Sept. 21, 2004). Subsequently, the court agreed to reconsider the case, whereupon it reversed itself and decided that the right of publicity claim was not preempted by federal copyright law and could indeed proceed.

In determining whether her claim had been preempted by federal law, the court first decided whether the work at issue was fixed in a tangible form and whether it was within the subject matter of copyright as specified in §102 of the Copyright Act. That section defines the subject matter of copyright as "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated" The court then considered whether the state right of publicity is equivalent to any of the rights set forth in §106, which include the right to reproduce, adapt (prepare derivative works), distribute, and publicly perform and display the copyrighted work.

The court found that Toney's identity was not fixed in a tangible medium of expression and was not a "work of authorship." A person's likeness, i.e. her persona, is not authored and is not fixed. An image of a person might be fixed in a copyrightable photograph but that does not make her identity itself fixed. As a result, the right of publicity protected by the state statute is not "equivalent" to any of the exclusive rights within the scope of copyright set forth in §106.

The court said that the purpose of the right of publicity is to allow a person to control the commercial value of his or her identity. Unlike copyright law, "commercial purpose" is an element of the publicity law. The defendants used the plaintiff'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, was irrelevant to her claim because the basis of her right of publicity concerned the message, namely whether the plaintiff endorsed or appeared to endorse the product in question. The use of a photograph without a person's consent can harm the person photographed and thus it can constitute a colorable claim under the state publicity statute.

The court concluded by attempting to clarify an apparent conflicting precedent created by its earlier decision in *Baltimore Orioles v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986). In that case, major league baseball players claimed that televised broadcasts of games made without their consent violated their rights of publicity in their performances. The court found that the telecasts were fixed in tangible form because they were recorded simultaneously with their transmission and were audiovisual works within the subject matter of copyright. The court further found that the baseball clubs owned the copyrights in the telecasts, and that the players' rights of publicity in their game-time performances were not significantly different from the rights conferred by the copyright law, so that the players' rights of publicity in their performances were preempted under §301.

The Toney court sought to clarify the distinctions between its holding and the *Baltimore Orioles* opinion. The court said that the earlier case does not simply stand for the proposition that state right of publicity laws are preempted in all instances by federal copyright law. Rather, the case holds that state laws that intrude on the domain of copyright are preempted even if the particular expression is neither copyrighted nor copyrightable. Such a result is essential in order to preserve the extent of the public domain established by copyright law.

Therefore, states may not create rights in material that was published more than 95 years ago, even though that material is not subject to federal copyright. Also, states may not create copyrightlike protections in materials that are not original enough for federal protection, such as a telephone book with listings in alphabetical order.

The court said that *Baltimore Orioles* itself makes clear that a player's right of publicity in his name or likeness would not be preempted if a company, without the consent of the player, used the player's name to advertise its product. The court thus reversed its previous decision and ruled that the plaintiff's claim under the Illinois right of publicity statute was not preempted by federal copyright law.

Copyright (c) 2005 David R. Ellis
All rights reserved

David Ellis is a Largo, Florida attorney practicing computer and cyberspace law; copyrights, trademarks, trade secrets, patents, and intellectual property law; business, entertainment and arts law; and franchise, licensing and contract law. A graduate of M.I.T. and Harvard Law School, he is a registered patent attorney and the author of the book, *A Computer Law Primer*. He has taught Intellectual Property and Computer Law as an Adjunct Professor at the Law Schools of the University of Florida and Stetson University.

Please direct comments to ellislaw@alum.mit.edu

<http://www.lawyers.com/davidrellis>

Related links

- [More about Defamation & Publicity](#)
- [News by ellislaw](#)

Most-read story in Defamation & Publicity:
[Court Rules ESPN Didn't Defame Evel Knievel](#)

[Home](#) [Account](#) [Search](#) [Articles](#) [Events](#) [Links](#) [Rules](#) [Directory](#) [Contact](#)