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ESSAY

PROTECTION OF THE ATHLETE'S IDENTITY: THE RIGHT OF PUBLICITY, ENDORSEMENTS AND DOMAIN NAMES*

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&

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The history and growth of the right of publicity is intimately intertwined with sports. The history of the right of publicity was largely developed by the desire of advertisers to attract attention to their goods and services by using the identity of prominent athletes - without paying for that value. This essay will focus on three areas. First, it will discuss the state of the law today as to the right of publicity, focusing especially on the sports dimension. Next, the related area of false endorsement under federal law will be examined. Finally, the new federal and California laws on cybersquatting of personal names will be described.

I. THE RIGHT OF PUBLICITY

A. *The O'Brien Case: 1941*

The key decision that set the stage for the creation of the right of publicity is the Fifth Circuit's 1941 *O'Brien* case.¹ David O'Brien was a famous football player in the 1930s who had played for Texas Christian University (TCU) and then as a professional for the Philadelphia Eagles. O'Brien sued the Pabst Brewing Company, specifically, Pabst Sales Co.,

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1. *O'Brien v. Pabst Sales, Co.*, 124 F.2d 167 (5th Cir. 1941).

for using his photo on Pabst's 1939 beer advertising calendar.² O'Brien was upset because he was active in a group urging teens not to drink and he had refused opportunities to endorse beer.

Interpreting Texas law, the Fifth Circuit threw out O'Brien's case, reasoning that he was not a private person and could not be harmed by more publicity.³ The court adopted the view that if O'Brien did not - and could not - object to the publicity he received in the sports pages, he would not be allowed to object to the publicity he got on advertising for Pabst beer.⁴ The court caught O'Brien in a catch 22: his refusal to voluntarily endorse beer was a waiver of his right to recover in court the reasonable value of his identity used to endorse the sale of beer. The court could not bring itself to view O'Brien's claim as an assertion of a right to stop the unpermitted use of his identity to sell a brand of beer, whether he loved beer or hated it. However, the dissent said the time was ripe to recognize a legal claim for the uncompensated use of the identity of a professional athlete to help sell a product.⁵

B. *The Haelan Case: 1953*

The O'Brien case set the stage for the famous 1953 *Haelan* decision, widely hailed as the case that coined the term "right of publicity."⁶ Forty-eight years ago in February 1953, in the seminal *Haelan* baseball trading card case, Judge Jerome Frank, writing the opinion for the Second Circuit, held that under the law of the state of New York there was something called a "right of publicity" that was separate and apart from the right of privacy.⁷

In *Haelan*, the parties were rival chewing gum makers who were battling to obtain the rights from major league baseball players to use their pictures on trading cards. Plaintiff said that defendant had induced players who had signed exclusive deals with plaintiff to sign a license with defendant. In addition, in some cases, the defendant used players' pictures without asking them at all. Defendant argued that plaintiff had no right to assert, for all that the players' contracts consisted of was a mere waiver of the right to sue for an invasion of privacy.⁸ The waiver, defendant argued, was only a personal and non-assignable waiver of the right

2. *Id.*

3. *Id.* at 169-70.

4. *Id.*

5. *Id.* at 170.

6. *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953).

7. *Id.* at 868-69.

8. *Id.* at 867.

to sue for an invasion of hurt feeling by commercial use of his identity on trading cards.⁹ As the mere holder of a non-assignable waiver, plaintiff could not sue its competitor-defendant.

In rejecting this argument, Judge Frank first created a new kind of property right under a new label.¹⁰ Judge Frank did this to break the logjam of confusion over the meaning of the term "privacy." He wanted to avoid the kind of privacy thinking that dominated the *O'Brien* case. Judge Frank recognized for the first time a property right in identity that can be legally separated from the person in a way that privacy rights cannot.¹¹

After the 1953 *Haelan* decision, the rest is history. Moreover, much of this history of the right of publicity is a series of battles over the uncompensated use of the identity of athletes to sell products and services.

C. What Is The Right Of Publicity?

The question then becomes, at the beginning of the twenty-first century, what is this thing called the right of publicity? What has the law come to in the last forty-eight years since *Haelan*?

The answer is quite simple. There is nothing abstruse or complicated about it. The right of publicity is simply the right of every person to control the commercial use of his or her identity.¹² This means that it is illegal under the right of publicity to use, without a license, the identity of a real person to attract attention to an advertisement.¹³ You can love it or you can hate it. You can embrace it or you can bitterly criticize it. You can argue its fine points or you can attack its very foundations. But that is what it is. The right of publicity is the right of every person to control the commercial use of his or her identity. At least both supporters and critics can agree on what it is we are talking about when we argue about the legitimacy and dimensions of the right of publicity.

D. Free Speech Limits

It must also be clear what the right of publicity can do and what it cannot do. The right can give every person the right to either prevent or

9. *Id.*

10. *Id.* at 868.

11. *Haelan Laboratories*, 202 F.2d at 868.

12. J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:3 (2d ed. 2000).

13. J. Thomas McCarthy, *The Human Persona as Commercial Property: The Right of Publicity*, 19 COLUM.-VLA J.L. & ARTS 129, 130 (1995).

permit, for a fee, the use of his or her identity in an advertisement to help sell someone's product.¹⁴

The right of publicity cannot be used to prevent someone's name or picture in news reporting.¹⁵ It cannot be used to prevent use of identity in an unauthorized biography.¹⁶ In addition, it cannot prevent use of identity in an entertainment parody or satire, such as that of imitator Rich Little and satirical programs such as *Saturday Night Live*.¹⁷

For example, an athlete like San Francisco 49er football star receiver Jerry Rice cannot use the right of publicity to prevent the use of his name and picture in a story in *Sports Illustrated*, and he cannot use it to prevent a sports writer in the *San Francisco Chronicle* from criticizing him. Jerry Rice can use the right of publicity either to prevent or to license for a fee the use of his name to help sell Nike sports equipment. However, he cannot use the right of publicity to stop a writer from doing a biography of his life in print or a partially fictionalized story of his life on a television special. Jerry Rice cannot use the right of publicity to stop the *National Enquirer* from writing an "in depth" expose of his life.

Some people have criticized the right of publicity as posing the danger of invading our free speech rights. In fact, for all practical purposes, the only kind of speech impacted by the right of publicity is commercial speech - advertising - not news, not stories, not entertainment and not entertainment satire and parody - only advertising and other purely commercial uses.¹⁸

The right of publicity is not a kind of trademark. It is not just a species of copyright. And it is not merely another kind of privacy right. It is none of these things, although it bears some family resemblance to all three. The right of publicity is a wholly different and separate legal right.

14. Laura Lee Stapleton & Matt McMurphy, *The Professional Athlete's Right Of Publicity*, 10 MARQ. SPORTS L.J. 23, 25 (1999).

15. McCARTHY, *supra* note 12, at § 8:46.

16. *Matthews v. Wozencraft*, 15 F.2d 432, 439 (5th Cir. 1994) (The publication of an unauthorized book about events in the plaintiff's life was not an infringement of plaintiff's rights of either publicity or privacy. Most of the facts were public and apart from the fictionalization, the basic facts in defendant's book were true. The court found that defendant's book and possible movie version would not damage plaintiff's own factual book about the same story). See also *Ruffin-Steinback v. De Passe*, 82 F. Supp. 2d 723, 730 (E.D. Mich. 2000) (Deceased and living former members of the 1960's singing group "The Temptations" could not use the right of publicity to recover damages from the producer of a television docudrama for presenting a partially fictionalized story of the singing group).

17. McCARTHY, *supra* note 12, at § 8:11.

18. *Id.* at § 1:3.

E. The State Of The Law: 2001

The state of the law in the United States is surprisingly clear:

1. Living persons: as of 2001, under either common law or statute, the right of publicity of living persons has been recognized as the law in twenty-eight states.¹⁹ Of these twenty-eight states, eighteen have statutory provisions and the right of publicity is recognized solely by common law in the other ten states.
2. Deceased persons: under either common law or statute, a post mortem right of publicity has been recognized as the law in seventeen states.²⁰

The newest right of publicity statutes are those in Illinois and Ohio, which were enacted in 1999.²¹ Both of these statutes create a right of publicity for living persons, as well as post mortem rights, lasting for fifty years after death in Illinois, and sixty years in Ohio.²²

There is no post mortem right of publicity under the law of New York.²³ Thus, if the late Jacqueline Kennedy Onassis died a resident of the state of New York, New York law might well apply and, therefore, her estate would have no right of publicity to assert against the Franklin Mint's use of her name and picture to sell faux pearls.

Keep in mind that advertisers who want to run a particular advertisement nationally must comply with the law of all fifty states, not just the law of the state in which the corporate headquarters is located. To run an advertisement nationally, the advertiser must comply with the right of publicity law of the state with the tightest restrictions.

F. Identity Values And Performance Values

I divide all right of publicity cases into two categories: the use of a person's identity for its identification value or use of a person's performance for its performance value.²⁴ By far the most common situation is

19. *Id.* at § 6:3.

20. *Id.* at § 9:18.

21. 765 ILL. COMP. STAT. § 1075/1-1075/60 (2000); OHIO REV. CODE ANN. § 2741.01-.09 (2000).

22. 765 ILL. COMP. STAT. § 1075/30; OHIO REV. CODE ANN. § 2741.02.

23. McCarthy, *supra* note 13, at 132. *See also* Pirone v. MacMillan, Inc., 894 F.2d 579, 586 (2d Cir. 1990) (Photos of the late baseball all-time great Babe Ruth in a baseball oriented engagement calendar did not infringe either trademark rights or the New York right of publicity).

24. McCarthy, *supra* note 13, at 133.

the use of persona for identification values.²⁵ That is, use in advertising or on products to draw attention to the ad.

Cases dealing with performance value are rare. An example of this type of case would be trying to put on a live performance to make the audience think it is 1975 by including an Elvis Presley look-alike performer who puts on a show just like Elvis would have done in 1975.²⁶ The famous 1977 *Zacchini* case also fits in the "performance value" category.²⁷ These kinds of cases are "performance value" cases; they do not focus on the use of identity in an ad to help sell a product.²⁸ They are rare and not typical at all of the run-of-the-mill right of publicity dispute.

What the right of publicity is about ninety-eight percent of the time is the use of some aspect of a person to help sell a product - like drawing attention to an advertisement.

G. *Who Does the Right of Publicity Protect?*

The right of publicity protects everyone - both celebrities and non-celebrities. Still, most of the case law concerns celebrities because usually, only a celebrity's right of publicity is worth enough to justify expensive litigation and appeals.²⁹ The right of publicity does not protect the "persona" of a corporation, partnership or an institution - only of a real human being.³⁰ So it makes no sense to talk about the right of publicity of Microsoft or Toyota - there is no such thing.

H. *Identifiability: The Test of Infringement*

How does one trespass on the right of publicity? The question here is one of identification. The test of infringement is "identifiability;" it does not focus on confusion as to endorsement by the person.³¹

I think that the issue is one of "unaided identification."³² In other words, can more than a de minimis number of ordinary viewers looking at (or listening to) the defendant's advertisement identify the plaintiff?

In the 1998 *Don Newcombe* case, the Ninth Circuit reversed summary judgement dismissal of former all-star baseball pitcher Don New-

25. *Id.*

26. *Estate of Elvis Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981).

27. *Zachinni v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977).

28. McCarthy, *supra* note 13, at 133.

29. *Id.* at 134.

30. McCarthy, *supra* note 12, at § 4:40. See, e.g., *Bear Foot, Inc. v. Chandler*, 965 S.W.2d 386 (Mo. Ct. App 1998) (a corporation does not have a right of publicity).

31. McCarthy, *supra* note 12, at § 3:17.

32. *Id.* at § 3:19.

combe's right of publicity claim against Coors.³³ In a Killian's Beer ad in *Sports Illustrated* magazine, Coors used a drawing of a baseball pitcher in a stance that Newcombe alleged was easily identifiable as him. With echoes of the *O'Brien* case a half century before, Newcombe was particularly upset at the beer ad because he was a recovering alcoholic who was a prominent spokesman warning against the dangers of alcohol. Coors admitted that the drawing of the pitcher in its ad was in fact "based on" a photo of Newcombe pitching in the 1949 World Series.³⁴ The court observed that the Coors drawing and the photo of Newcombe were "virtually identical" except that the uniform number was changed from "36" to "39."³⁵

The court applied the California Civ. Code § 3344(b) test of photos to this drawing.³⁶ Under this test, the person must be "readily identifiable," meaning that a viewer can reasonably determine that the person depicted in the photograph is the same person "as the plaintiff."³⁷ The court held that there was an issue of fact for trial as to whether Newcombe's pitching stance was so distinctive that he was identifiable from the drawing in the Coors beer advertisement.³⁸

The link with the plaintiff to constitute infringement of the right of publicity need not rise to the level that would support a claim for false endorsement. The 1995 *Restatement* also follows this and the case law in demonstrating that deception or false endorsement is not required to prove a case of infringement of the right of publicity.³⁹

Identity can be stolen and used to attract attention to an advertisement or product without giving rise to a valid claim of false endorsement. The identity of a famous person is used to cut through the clutter of advertising and to merely draw attention to the advertisement.

Two hypothetical examples can be imagined: "Clint Eastwood has knocked off lots of bad guys, but he's never tasted Sigmund beer," or "Jerry Rice and Aikon cell phones - both top receivers in their field."

33. *Newcombe v. Adolf Coors Co.*, 157 F.3d 686 (9th Cir. 1998).

34. *Id.* at 689.

35. *Id.*

36. CAL. CIV. CODE § 3344(b) (2000). See McCARTHY, *supra* note 12, at § 6:28.

37. *Newcombe*, 157 F.3d at 692.

38. *Id.* at 696.

39. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 Cmt. b (1995) ("Proof of deception or consumer confusion is not needed for the imposition of liability under this Section."); *Id.* at § 47, Cmt. a ("Proof that prospective purchasers are likely to believe that the identified person endorses or sponsors the user's goods or services is not required for the imposition of liability."). See cases cited at McCARTHY, *supra* note 14, at § 5:19.

There is no false endorsement here, but the hypothetical companies are clearly using identity to help sell a product.

II. FREE SPEECH

A. *Commercial Versus Communicative Uses*

The right of publicity issue that arises most often, and is the most difficult issue to give clear advice to a client, is the free speech issue. My suggestion is that lawyers follow the two categories summarized in the rule of thumb contained in the box in the following outline:

"Commercial Use"	infringement
"Communicative Use"	Immune as fully protected free speech

Definitions: A "*communicative*" use is one in which the policy of free speech predominates over the right of a person to his identity, and no infringement of the right of publicity takes place.⁴⁰ A "*commercial*" use is one in which the right of publicity is infringed because, while there are overtones of ideas being communicated, the use is primarily commercial.⁴¹

The medium used will often determine the result. For example, the unpermitted use of a person's identity on a product such as a coffee mug or a T-shirt will usually be dubbed "commercial" and require a license.⁴² However, the unpermitted use of a person's identity and picture to illustrate a story in a newspaper, magazine or television news program will be "communicative" and immune.⁴³ Telling the client which category the challenged use will fall into is sometimes easy, sometimes very difficult.

B. *The Lew Alcindor Case*

An illustrative and not atypical case is the Lew Alcindor as Abdul-Jabbar case.⁴⁴ General Motors ran a television advertisement for Oldsmobile cars. This ad ran during the NCAA men's basketball tournament. The voice-over asked: "Who holds the record for being voted the most outstanding player of this tournament?" On screen appeared the

40. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:41, at 28-50 (rev. 2001).

41. *Id.*

42. *Id.*

43. MCCARTHY, *supra* note 12, at § 7:20.

44. Abdul-Jabbar v. General Motors Corp., 85 F.3d 407 (9th Cir. 1996).

answer: "Lew Alcindor, UCLA, '67, '68, '69." Once having attracted the viewer's attention, the advertisement proceeded to laud Oldsmobile, using sports metaphors that echoed Alcindor's accomplishment.

The court rejected the advertiser's defense that its use of Alcindor's name was only "incidental" to conveying newsworthy sports information.⁴⁵ The court pointed out that this was not a usage in a sports or news account, instead it was in the context of an advertisement for an automobile.⁴⁶ That is, the distinction the court drew was between conveying information in traditional media on the one hand (free speech protected) and conveying the same information in an advertisement for a commercial product on the other hand (infringement).

C. *The 1969 Mets Case*

Similarly, a New York court rejected the argument that a defendant was only conveying historical information when an apparel manufacturer made a jersey imprinted with the photo of the team members of the famous 1969 New York Mets World Series Champions baseball team.⁴⁷ The court held that this use of personal identity on an item of apparel was a violation of the New York statutory right of publicity.⁴⁸ Thus, regardless of the defendant's motivation for including the photo along with baseball historical information, "the fact remains that [defendant] is attempting to cash in on plaintiffs' skill and renown on the baseball diamond. Without plaintiffs' consent, that is something defendant simply cannot do."⁴⁹

D. *Sports Trading Cards: The Cardtoons Case*

Another issue concerns sports trading cards similar to those in the seminal *Haelan* case. The question is whether trading cards are communicative - like stories in *Sports Illustrated*, or commercial - like the use of a ball player's name on a model of sports shoe or baseball bat.

In the 1996 *Cardtoons* case, the Tenth Circuit applied Oklahoma law and balanced the right of publicity against a First Amendment defense.⁵⁰ In doing this, the court dismissed a right of publicity claim against a company that made baseball cards that parodied prominent professional

45. *Id.* at 416.

46. *Id.*

47. *Shamsky v. Garan, Inc.*, 632 N.Y.S.2d 930, 933 (N.Y. Sup. Ct. 1995).

48. *Id.* at 935-36.

49. *Id.* at 937.

50. *Cardtoons v. Major League Baseball Players Assoc.*, 95 F.3d 959 (10th Cir. 1996).

baseball players.⁵¹ The court found that the parody baseball trading cards were not commercial speech, but were to be classified so as to receive "full First Amendment protection."⁵² The court said that in order to adequately poke fun at the plaintiffs, defendant had no feasible alternative other than to use plaintiffs' identities and to use the baseball trading card format to do so.⁵³ The court concluded that parody trading cards "are not commercial speech - they do not merely advertise another unrelated product."⁵⁴

E. California: The Three Stooges and T-Shirts

Soon a decision will come out of the California Supreme Court that will add to this discussion. The court has been sitting for almost two years on a case that will determine if unauthorized use of a person's identity on a T-shirt is protected by the First Amendment. Defendant artist drew a sketch of the Three Stooges and sold prints and T-shirts with the sketch on it. The owner of the post mortem right of publicity of the Three Stooges obtained an injunction, defendant's profits of \$75,000.00 and attorney fees.⁵⁵ Defendant argued that the First Amendment immunized this use because a T-shirt is a "communicative" medium of expression.⁵⁶ The court rejected this, noting that neither defendant's T-shirts nor its prints conveyed any "message" other than a picture of the Three Stooges.⁵⁷ Similarly, the court rejected the defense that this was "art" and therefore immune.⁵⁸ In March 1999, the California Supreme Court granted a hearing.⁵⁹

F. The Tiger Woods Painting

A last example comes from the *Tiger Woods* case. On summary judgement, the federal court in Ohio dismissed Woods' claim that his right of publicity under Ohio law had been infringed by defendant's use

51. *Id.*

52. *Id.* at 970.

53. *Id.* at 971-72.

54. *Id.* at 970.

55. *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 68 Cal. App. 4th 744 (Cal. Ct. App. 1998).

56. *Id.* at 751-53.

57. *Id.* at 752.

58. *Id.* at 753.

59. *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 973 P.2d 512 (Cal. 1999).

of Woods' likeness in prints of defendant's painting of Tiger Woods in action on the golf course.⁶⁰

The court found that such an unauthorized use of the image of a famous athlete was protected by principles of free artistic expression because "paintings and drawings are protected by the First Amendment."⁶¹ The fact that the painting was reproduced and sold in an edition of 5,000 prints was found not to convert the artistic image into a commercial product. Instead, the court stated that "the print at issue herein is an artistic creation seeking to express a message. The fact that it is sold is irrelevant to the determination of whether it receives First Amendment protection."⁶²

III. FALSE ENDORSEMENT AND LANHAM ACT § 43(A)

A Lanham Act § 43(a) false endorsement claim is often the companion of a right of publicity claim.⁶³ As indicated in the prior Clint Eastwood and Jerry Rice examples, not all uses of a person's identity to help sell goods or services will contain a message of endorsement. However, if it does, there are a number of § 43(a) cases that find false endorsement. For example, the Ninth Circuit puts false endorsement claims in the trademark prong of the statute, saying that the celebrity's identity is like a trademark.⁶⁴

Another issue is whether the use of the identity of a deceased athlete triggers a Lanham Act § 43(a) false endorsement. In other words, would consumers who know that Joe DiMaggio is deceased possibly think that an ad for computer software featuring a photo of "Jolting Joe" doffing his cap to the crowd was endorsed by DiMaggio? Alternatively, would consumers think that it was endorsed after his death by his estate? Remember that for years, Joe DiMaggio did endorse Mr. Coffee brand coffee makers.⁶⁵

60. *ETW Corp. v Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829 (N.D. Ohio 2000) (presently on appeal).

61. *Id.* at 835.

62. *Id.* at 836.

63. Lanham Act § 43(a), 15 U.S.C. § 1125 (2000).

64. *Abdul-Jabbar*, 85 F.3d 407; MCCARTHY, *supra* note 12, at § 5:30.

65. In 2000, a dispute arose over the plan of the City of San Francisco to name the North Beach playground the "Joe DiMaggio Playground," in honor of the great baseball player, who was raised in San Francisco and, when growing up, played baseball on that playground. The Florida executor of DiMaggio's estate objected that this playground was not exalted enough to bear the DiMaggio name and threatened to obtain an injunction to stop it. The City argued that this was not a commercial use that would trigger the California post mortem right of publicity statute. E. Epstein, *S.F. Defies DiMaggio Executor: North Beach Playground To Be*

In the recent Princess Diana case, the executors of the estate of Diana, the late Princess of Wales, and the exclusive licensee of commercial rights, sued the Franklin Mint maker of various items of unauthorized Princess Diana merchandise such as a Franklin Mint Diana doll.⁶⁶ Judge Paez dismissed the right of publicity claims and the decision was subsequently affirmed by the Ninth Circuit.

The claim for infringement of Diana's post mortem right of publicity under the California post-mortem statute was also dismissed.⁶⁷ Using rules of conflict of laws, the court found that the law of the place of the decedent's domicile, in this case Great Britain, should control.⁶⁸ Since Great Britain recognizes neither privacy rights, nor rights of publicity, the claim had to be dismissed.⁶⁹

This left the Lanham Act § 43(a) false endorsement claim; Judge Cooper in Los Angeles dismissed the false endorsement claim on summary judgment.⁷⁰ Judge Cooper found that the most important factor arguing against false endorsement by the estate was the extensive unauthorized use of the name and image of Princess Diana on commercial articles, both before and after her death.⁷¹ This weakened trademark-like rights in her name and image to the point that "her image has truly lost any significance as a mark identifying the source of a product."⁷²

Defendant argued that no consumer would reasonably believe that its products derived from or were authored by Princess Diana, her estate

Named For Yankee Great, S.F. CHRON., Apr. 11, 2000, at A1. A lawsuit filed by the DiMaggio estate in Florida was dismissed.

Eventually, the dispute was settled and the playground was renamed the "Joe DiMaggio Playground." E. Epstein, *Accord Reached In Dispute Over DiMaggio Name: SF Free to Rename Playground*, S. F. CHRON., Oct. 10, 2000, at A17.

66. *Lord Simon Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013 (C.D. Cal. 1998), *aff'd unpublished Op.* Diana Princess of Wales Mem'l Fund v. Franklin Mint Co., 216 F.3d 1082 (9th Cir. 1999). On remand, the court held that a recent legislative amendment to the California right of publicity statute was not a choice of law provision and did not change the result in the *Princess Diana* case. *Cairns v. Franklin Mint Co.*, 120 F. Supp. 2d 880 (C.D. Cal. 2000) ("There is no doubt that the initial drafts of the proposed statute contained a choice-of-law provision that, if enacted, would have overturned this Court's decision in *Cairns* The nature of the legislative process inevitably results in compromise. It is clear from a review of the legislative history here, that the choice-of-law provision in an early version of the proposed statute fell victim to such a compromise and was never enacted.").

67. *Lord Simon Cairns*, 24 F. Supp. 2d at 1029.

68. *Id.* at 1026-28.

69. *Id.* at 1026-29.

70. *Lord Simon Cairns v. Franklin Mint Co.*, 107 F. Supp. 2d 1212 (C.D. Cal. 2000).

71. *Id.* at 1217.

72. *Id.*

or the exclusive licensee.⁷³ Can the use of the identity of a deceased person *ever* trigger a Lanham Act § 43(a) false endorsement claim? While not closing the door to all such claims, this opinion comes close to such an absolute rule. Judge Cooper referred to the unchallenged Andy Warhol paintings of Campbell Soup cans and Marilyn Monroe.

The court appeared to say that the use of the name and image of a deceased celebrity on jewelry, plates and dolls is not a use that conveys a message of endorsement by the estate of the deceased.⁷⁴

IV. CYBERSQUATTING OF PERSONAL NAMES

The Internet is another area where recent legislation has been passed that may deal with the right of publicity. In 1999, Congress added provisions to the federal anti-cybersquatting amendments providing for protection against the use of non-trademarked personal names by cybersquatters.⁷⁵ Cynics say that the personal names part of the Act was tacked on and passed because several Senators were mad about critics and political opponents who reserved the Senators' names as domain names. However, Congress has stated that these provisions are limited and are only directed at a very specific type of cybersquatting.⁷⁶

In the legislation, Congress did not specify where in the United States Code these provisions should be codified. Thus, the legislation is not a part of the Lanham Act. The people whose job it is to codify the enactments of Congress have determined that it should appear in the code as 15 U.S.C.A. § 1129. That is right after the end of the Lanham Act.

The act creates civil liability for the cybersquatting of a personal name, requiring the plaintiff to plead and prove four elements:

- (1) The defendant has registered a domain name;
- (2) Which consists of or is confusingly similar to the name of the plaintiff, who is a living person;
- (3) Without the plaintiff's consent;

73. *Id.* at 1218-20.

74. *Id.* at 1216, 1220.

75. Anticybersquatting Consumer Protection Act (ACPA), 15 U.S.C. § 1125(d), and additional provisions in 15 U.S.C. § 1129 (2000). See also MCCARTHY, *supra* note 40, at § 25:80.

76. 145 CONG. REC. S14715 (daily ed. Nov. 17, 1999) (Senate Section-by-Section Analysis) ("In sum, this subsection is a narrow provision intended to curtail one form of "cybersquatting"—the act of registering someone else's name as a domain name for the purpose of demanding remuneration from the person in exchange for the domain name. Neither this section nor any other section in this bill is intended to create a right of publicity of any kind with respect to domain names. Nor is it intended to create any new property rights, intellectual or otherwise, in a domain name that is the name of a person.").

- (4) The defendant has committed the acts with a specific intent to profit from the plaintiff's name by selling the domain name for financial gain to the plaintiff or any third party.⁷⁷

Two other factors are very important.

(1) *Names protected*: The Senate explanation of the bill stated that it covers full names (e.g. <johndoe.com>), surnames (e.g. <doe.com>) and variations such as <john-doe.com> or <jondoe.com>.⁷⁸ Congress did not state whether it intended "name" to include pen names, stage names or widely recognized nicknames. (e.g. <chersite.com>).

(2) *Intent to profit from the plaintiff's name*. The statute requires that the defendant have a specific intent to profit from the name of another living person.⁷⁹ In the author's opinion, this must mean that the required intent must be to profit from the name as a name specifically identifying the plaintiff. For example, many famous people share a first and last name with many other persons. A person who does not have that name but registers the name with the intent to sell it to that famous person is the intended target of this legislation.

California has its own flavor of anti-cyberpiracy laws covering personal names. On August 21, 2000, the governor signed into law California Business & Professions Code § 17525, a California style Anti-Cybersquatting Act.⁸⁰ The California law is very similar, but not identical to, the federal anti-cybersquatting provisions protecting personal names. Senator Burton, the sponsor of the law, said that he introduced this legislation because he thought the federal act was "flawed" and he wanted to close gaps he perceived in the federal ACPA legislation.⁸¹ The legislation passed without a dissenting vote in the California legislature.

The California act includes the name of a "deceased personality," whereas the federal act is limited to the name of a "living person."⁸² "Deceased personality" is defined as encompassing those persons whose identities are protected under the California post-mortem right of pub-

77. 15 U.S.C. § 1129(1)(A) (2000).

78. 145 CONG. REC. S14715 (daily ed. Nov. 17, 1999) (Senate Section-by-Section Analysis).

79. 15 U.S.C. § 1129(1)(A).

80. CAL. BUS. & PROF. CODE § 17525 (2001).

81. *California Senate Floor Analysis of SB 1319*, at 9 (Aug. 4, 2000) (quoting Senator Burton, the author of the bill). See also Lynda Gledhill, *New Law On Cyber Piracy*, S.F. CHRON., Aug. 23, 2000, at D1 (a news report remarked that the new law "closes a gap" in the federal law).

82. CAL. BUS. & PROF. CODE § 17525 (2001); 15 U.S.C. § 1125(d)(2000).

licity statute: Civil Code § 3344.1.⁸³ This statute creates a post mortem right of publicity lasting for seventy years after death.⁸⁴

V. CONCLUSION

This essay has sketched the general contours of the state of the law today as to the right of publicity, emphasizing the sports dimension. It also discussed the related area of false endorsement, noting the difficulty of bringing such a claim on behalf of a deceased personality. The third point covered was the new federal and California laws on cybersquatting of personal names.

Clearly, there has always been a tension between the legitimate free speech rights of sports commentators and writers on the one hand, and, on the other hand, the rights of athletes not to have their identities used without permission to help sell goods and services. The courts in the future will have to sort out many difficult issues arising at the borderline between free speech and the right of publicity.

83. CAL. CIV. CODE § 3344.1 (2000).

84. *Id.*

