New York State Bar Association
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Memorandum in Opposition

COMMITTEE ON MEDIA LAW

Media Law #3 June 11, 2013

S. 5196 By: Senator DeFrancisco
A. 7843 By: M. of A. Morelle
Senate Committee: Codes
Assembly Committee: Governmental Operations
Effective Date: One year after it shall have become a law

AN ACT to amend the civil rights law, in relation to the right of publicity

LAW AND SECTION REFERRED TO: Article 3-A of the Civil Rights Law

THE COMMITTEE ON MEDIA LAW OPPOSES THIS LEGISLATION

Overview

The New York State Bar Association's Committee on Media Law ("the Committee") opposes this bill, which would add a new article to the New York Civil Rights Law, Article 3-A, creating a "right of publicity" for deceased persons.[1] The bill would prohibit the use for commercial purposes of the "persona" – defined as the "name, portrait, picture, voice, signature, photograph, image, likeness or distinctive appearance, gesture, mannerisms or other indicia of a deceased individual" – of any person who died a domiciliary of New York 70 years (or less) before the effective date of the legislation or who dies on or after such effective date, without the written permission of such person's heirs, estate or licensees. These rights would be granted retroactively to persons who are already dead and would last for 70 years after death. Currently, the right of publicity in the state is grounded solely in New York Civil Rights Law §§50 and 51, and related case law, and the right is afforded only to living persons.

New York Civil Rights Law §§ 50 and 51 have been on the books since 1903. These laws have always been strictly construed in New York, favoring the right to freely publish all aspects of person's likeness based on First Amendment principles and restricting the publication only in clear cases where the use of a person's image or likeness is for purposes of advertising or trade.

[1] The Committee and similar groups in New York have been consistent in their concerns about state legislation aimed at creating a postmortem right of publicity, having submitted in 2010 memos to the Legislature opposing such bills (S.8373-A-2009 / S.6790-2009).

Any amendment to Civil Rights Law §§ 50 and 51, laws that have generated over 100 years of precedent, should be made only for the most compelling reasons, which we submit are not present here. In creating a new right of publicity on behalf of deceased celebrities, the proposed Article 3-A suggests applications that could run headlong into decades of New York law and practice under First Amendment principles and New York State's constitutional protections for speech. It would certainly generate litigation where none now exists – limited only by a plaintiff's imagination – and put undue stress on the exercise of creative and expressive activities. The bill accomplishes little or promotes few, if any, of the policy goals that a right of publicity is purportedly designed to serve, and creates significant practical difficulties for media entities both in and outside New York State. Finally, the proposed section is unnecessary because deceased individuals are already sufficiently protected by federal trademark laws.

Discussion

The New York Civil Rights Law §§50 and 51 created a limited right to persons to control the commercial value of their image during their lifetimes, and have always been strictly construed in New York courts favoring the free speech rights under the First Amendment of the United States Constitution and Article I, Section VIII of the New York State Constitution. Courts have only restricted publication under these laws in clear cases where the use of the personality's image or likeness is for purposes of advertising or trade. The courts have also limited any encroachment of these provisions on free speech by consistently holding that the state does not recognize a right of publicity beyond that contained in Sections 50 and 51.

The creation of post-mortem publicity rights under proposed Article 3-A would upset this delicate balance. Even as a restriction on commercial speech, these new rights do not meet the requirement under the First Amendment, announced in Central Hudson Gas & Electric Corp. v. Public Service Commission of New York, 447 U.S. 557 (1980), that such restrictions further a "substantial government interest." In fact, given that publicity rights exist to encourage creativity and the development of talent, it is difficult to fathom how the retroactive extension of these posthumous rights furthers any governmental interest at all.

Rather than serving a "substantial government interest," the proposed new section appears to be a private hand-out for the benefit of a few, which nonetheless will impose significant burdens on the ability of publishers, broadcasters and artists to legitimately portray public and private individuals in their work, and thus engage in First Amendment-protected speech.

There are a number of problems with this bill. Listed below are some of the more troubling aspects of the bill:

1. **The Retroactive Applicability of Newly Created Rights –** Not only would the bill create a new class of complainants, but it would apply to uses created before enactment of the legislation, making previously permissible activities suddenly

subject to liability and interfering with rights created under existing contracts. Such retroactive application, particularly the burden on existing materials, is almost certainly legally impermissible, and grossly unfair.

Take, for example, *Bombshell -- The New Marilyn Musical* from the recent NBC television series, SMASH!, or the revival of Broadway shows such as *Fosse or Fiorello!* – shows which celebrate the lives and accomplishments of deceased persons. While the shows themselves may be exempt under the bill, it is doubtful that the sale of posters, t-shirts and other merchandise associated with advertising for the shows would be exempt under the bill. The restrictions that would be placed on such merchandise by this bill may very well threaten the economic viability of the shows altogether. Indeed, while the bill exempts such musicals from its use restrictions, it makes clear that the exemption does not apply if the use can "constitute an advertisement, endorsement or solicitation for the sale or purchase of a product, article of merchandise, good or services, other than for the work itself." An ambitious plaintiff should certainly be expected to test this provision in a claim against any creative work about a deceased person that offers or advertises merchandise. Further, the bill creates uncertainty for individual photographers, filmmakers and image licensing companies in New York State who depend on model releases to grant them permission for advertising use of their images executed during a person's lifetime. As the bill stands, it is unclear whether such releases would be upheld. This would directly impair the ability of photographers and licensing agencies to exploit the copyright in the images they own and represent and could result in distinct, but unintended rules for living persons and for deceased persons. Stock photos now safely licensed and used would draw lawsuits if, unknown to the user or agency, one of the persons photographed were deceased.

2. **The Vagueness of the Rights** – This bill would cast doubt on the legal viability of a variety of expressive works. Unable to predict how a particular use will be interpreted, a publisher, broadcaster or artist may well decide that their use of a celebrity's image is too "close to the line," and that it is safer to avoid the possibility of costly litigation than to speak freely. Similarly, those required to obtain consent before including a deceased's persona in their work may instead forego such use, even at the risk of great artistic, informational or literary value, rather than bear the burdensome task of identifying and getting consent from the deceased's heirs, often many years after the subject's death.

3. **Different Treatment of Living and Deceased Persons** – The proposed Article 3-A also would result in different and distinct rules for living persons and for deceased persons, which may result in unintended and unforeseen consequences. It is also generally unclear whether the identified works that are exempt for deceased personalities are exempt for the living, given that Article 3-A as proposed in this bill and Sections 50 and 51 both prohibit uses without consent for advertising, trade or commercial purposes.

4. **Exemptions Will Always Lack Sufficient Breadth** - The bill also is flawed in only offering a limited list of exempt expressive uses, which chills expression in news, information or pure entertainment uses not enumerated or contemplated. Indeed, the danger of identifying certain exempt expressive works based on traditional forms of media such as theatre books and magazines is that the legislation will certainly overlook new forms of expression created in the future. Take for example, a digital newspaper that wants to create an informational game for tablets using clips or images of newsworthy persons. Because such a use was not enumerated in the bill, its exempt status would only be resolved through costly litigation or by the publication having to start the costly process of clearing the rights of every recognizable person.

   In addition, as many forms of media are supported by advertising or e-commerce, and will continue to do so in the future, the legislature should be wary of creating ambiguity which will lead to expensive permissions, unnecessary litigation and result in a chilling effect on new forms of works.

Several matters of trusts and estates law would also require attention in the event that a posthumous right of publicity is created in New York. In Shaw Family Archives Ltd. v. CMG Worldwide, Inc., 486 F.Supp.2d 309 (S.D.N.Y. 2007), for example, the court concluded that "property not owned by the testator at the time of his death is not subject to disposition by will," strongly suggesting that any posthumous right of publicity cannot be applied retroactively as a matter of law. The new property right might be grabbed by persons other than those the dead celebrity had intended to be his or her beneficiaries, and in any event, would likely lead to additional litigation.

Finally, it bears mentioning that the putative policy concern of the bill's drafters to protect the value of "reputations and bodies of work" by dead celebrities, which they "spent entire careers building" ignores the fact this value is as much, if not more, a creation of the public, publicists, filmmakers, or an accident of parentage (such as, being born into a royal family) than a result of efforts by any one individual. Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 Calif. L. Rev. 125, 134, 140-47, 175-76, 178-205 (1993). Thus, granting posthumous publicity rights to celebrities only gives them far too much credit, and the public too little credit, in shaping their identities. As the late actress Marilyn Monroe once acknowledged, "I knew I belonged to the public and to the world, not because I was talented or even beautiful, but because I had never belonged to anything or anyone else."

Even so, deceased celebrities already receive significant protection from federal trademark laws. The name "Marilyn Monroe," for example, is a federal-registered trademark, providing a potential basis for infringement claims against unauthorized uses. Relief may also exist under Section 43(a) of the Lanham Act, which imposes liability for the unauthorized use of a celebrity's persona in connection with goods or services, where the use is likely to cause confusion as to the celebrity's affiliation or association with, or approval of, such goods and services. 15 U.S.C. § 1125 (2006); Linda J. Wank & Elisabeth H. Cavanagh, *The Lasting Effect of Star Power*, N.Y.L.J., Sept. 17, 2007, S1.

These existing protections are likely to weigh heavily in any First Amendment balancing under the Central Hudson test.

A "right of publicity" for deceased persons as proposed in this bill would be flawed and constitutionally questionable. The proposal poses a number of unnecessary practical difficulties for the vast press, publishing, audiovisual, digital, and creative industries and individuals in New York State.

The Legislature should act with caution in this area, cognizant that New York is a state in which free speech and press have traditionally been a treasured value and the foundation of a hugely vital media industry; that expanding personality rights impoverishes our cultural heritage and language to the detriment of future creators and the public at large; and that §§ 50 and 51 were carefully crafted to maintain a delicate balance of interests. The laws have been applied for many decades with an eye towards serving both the needs of citizens living in the State to protect themselves from being used in advertising for products and services and the needs of citizens to enjoy the benefits of free speech and press. The bill upsets that delicate balance.

Based on the foregoing, the New York State Bar Association Committee on Media Law **OPPOSES** this legislation.

Chair of the Committee: Lynn Oberlander, Esq.