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Number Thirty-Two

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MEMORIAL COMPETITION

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FOREWORD

THE MANY PARTICIPANTS and the high quality and breadth of submissions in this year's Nathan Burkan Memorial Competition prove that copyright is no longer a neglected subject in our law schools. Dean John H. Wigmore, as a judge of the first National Competition in 1938, voiced his concern about the lack of academic emphasis in the copyright field. The dramatic transformation of the literary, musical, and artistic fields since the first Competition has contributed to the heightened interest of students and faculty in the copyright area. We are delighted that our law schools have closed the "copyright gap." And we are pleased that we have been able to play a role in this Competition, which has contributed so much to the study of copyright law.

We read 101 papers certified by the deans of 67 law schools to select the scholarly prizewinners included in this volume. The high quality of all the papers made our task difficult, but the excellence of the six we chose was clear.

Kevin S. Marks of Boalt Hall School of Law was awarded First Prize for his lucid discussion of a topic engendering much debate: the right of publicity. He examines four modes of treatment proposed in the oft-cited *Lugosi* decision and concludes that an alternative copyright model should govern the protection of publicity rights in a performance and a performer's image. Mr. Marks views the goal of preventing unjust enrichment as a justification for making the right of publicity descendible, granting post-mortem publicity rights regardless of exploitation during the subject's lifetime, and

granting publicity rights to actors for their dramatic portrayals of fictional characters.

The National Second Prize paper by Marvin J. Nodiff of the Saint Louis School of Law deals with the copyrightability of federal and state government works. The paper takes a close look at the different copyright treatment given to works of these two types of governments. On the basis of the legislative history of the 1976 Copyright Act, judicial decisions, and legal commentary, the author suggests that states have substantial leeway to allow copyright of their government works. Mr. Nodiff regards his proposed extension of copyright to state works as a crucial step toward encouraging both the literary creativity of state employees and the private sector's involvement in state publications.

The Third National Prize went to Janie M. Burcart of the University of Oregon School of Law for her study of the need for copyright protection of literary titles. Ms. Burcart discusses the weakness of case law, which holds that titles are not copyrightable. She finds that other legal theories, such as unfair competition and trademark, provide inadequate protection for literary titles. She suggests that copyright in an overall work should extend to its title. She calls for judicial consideration of the title's context, length, and originality to ensure continuing production of catchy and inventive titles.

Warren Shaw, a Brooklyn Law School student, received Fourth Prize for his analysis of the copyright status of improvised musical works. Mr. Shaw regards these spontaneously composed and recorded works as a hybrid form of music entitled to protection as both sound recordings and musical works under the 1976 Copyright Act. Such dual classification, he argues, would afford both the composer and record manufacturer of an improvised musical recording the full panoply of available statutory rights. On the basis of the history and policy of the 1976 Act, Mr. Shaw advocates more extensive Federal copyright protection for improvised pieces.

We found two papers, by Peter D. Aufrichtig of the Hofstra University School of Law and Craig K. Morris of the Washington and Lee University School of Law, equally worthy of Fifth Prize. Mr. Aufrichtig focuses on the importance of copyright protection for computer programs imprinted in Read Only Memory (ROM) semiconductor chips. His history of the development of the computer provides the nontechnical reader with an understanding of the operation of computers and their significance to modern life. Mr. Aufrichtig notes that Congress and the courts have only begun to recognize the need for realistic protection of computer programs. He recommends a shortened term of copyright protection and the issuance of preliminary injunctive relief to bring the interests of the computer industry and the American consumer into harmony.

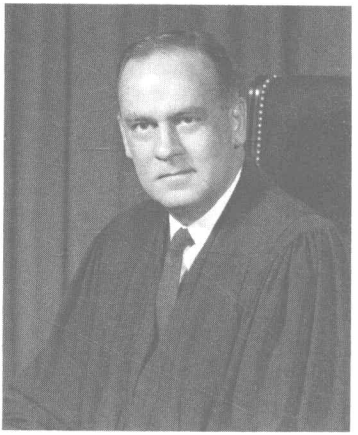
Mr. Morris addresses the proposed elimination of the manufacturing clause from our Copyright Law. He weighs the divergent viewpoints of the book manufacturers who support the clause, and the book publishers who oppose it, by examining its effect on America's economy and on international trade. Mr. Morris deems the manufacturing clause an impediment to free trade that has outlived its usefulness. He suggests that customs duties and tax incentives, rather than the Copyright Law, should protect American book manufacturers against harm from foreign importers.

We extend our hearty congratulations to the National Award winners and to all who participated in the Competition. Their intellectual endeavors are most impressive.

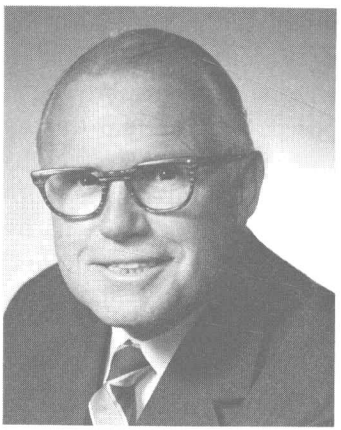
Hon. Potter Stewart (Retired)
United States Supreme Court

Hon. William H. Orrick, Jr.
United States District Court
Northern District of California

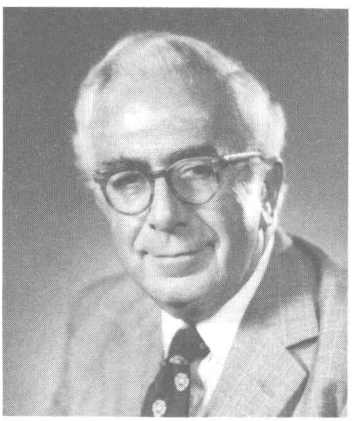
Lloyd N. Cutler



Hon. Potter Stewart



Hon. William H. Orrick, Jr.



Lloyd N. Cutler

PREFACE

THE 1982 NATHAN Burkan Memorial Competition was privileged to have as its judges a most illustrious panel, whose three members have outstanding records of public service and professional achievement. That three such individuals would so generously volunteer their time and effort to take part in this Competition is an inspiration to us all.

Justice Potter Stewart was appointed by President Eisenhower in 1954 to the United States Court of Appeals for the Sixth Circuit and in 1958 to the United States Supreme Court. He received both his undergraduate and legal education at Yale, where he was Editor of the YALE LAW JOURNAL and was graduated in 1941 at the top of his law school class. He served more than three years of active sea duty as an officer of the United States Naval reserve. While in private practice, he was involved in many community and civic affairs. His distinguished record on the bench is, of course, well known. His opinions in the copyright field include *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390 (1968), *Teleprompter Corp. v. CBS, Inc.*, 415 U.S. 394 (1974), and *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151 (1975).

Judge William H. Orrick, Jr., of the United States District Court for the Northern District of California, received his B.A. from Yale University and his LL.B from the University of California. After service as an officer in the United States Army, he entered private practice. He has held two positions

as Assistant Attorney General of the United States, first in charge of the Civil Division, and later, in charge of the Antitrust Division. He was named Deputy Under Secretary of State for Administration in 1962. Following his return to private practice, Judge Orrick was appointed to the District Court. He is the distinguished recipient of the Boalt Hall Alumni Association Citation Award.

Lloyd N. Cutler received his B.A., LL.B, and LL.D, with honors, from Yale University. He became a member of the law firm of Wilmer, Cutler & Pickering in 1962. He served as Counsel to the President and Special Counsel to the President on Ratification of the Salt II Treaty in 1979 and 1980. He has undertaken an impressive array of professional, civic, and educational activities throughout his career and is also a prolific author and legal commentator. Mr. Cutler is frequently mentioned as one of America's outstanding practicing attorneys.

ASCAP's members are greatly indebted to our esteemed panel of judges, as well as to the authors of these prize-winning papers and the devoted deans and faculty members who judged the Competition at each law school. If this Competition continues to attract as timely and thought-provoking essays and as dedicated a group of judges as we are honored to have this year, many valuable contributions to the literature of copyright law are in store for the future.

HERMAN FINKELSTEIN

Rules Governing the Competition

1. *Participating Law Schools:* All accredited law schools are invited to participate in the Competition.
2. *Eligible Students:* Third-year students. In the discretion of the dean, second-year students may also be eligible.
3. *Subject Matter:* Any phase of *Copyright Law.*
4. *Determination of Awards:* The prizes will be awarded to the students who shall, in the sole judgment of the dean—or such other person or committee as he may delegate—prepare the two best papers. The dean may in his discretion withhold the awards entirely, if in his opinion no worthy paper is submitted, or may award only the first or second prize. *Students are not eligible for more than one prize in any Competition.*
5. *Prizes:* A *first prize of $500* and a *second prize of $200* at each participating law school, to be paid through the dean, upon his written certification. Winning papers will be entered in the National Competition, in which the best papers will be considered for awards of $3,000, $2,000, $1,500, $1,000 and $500 (see Rule 10, *infra*).
6. *Requirements as to length and form of manuscript:*
   (a) Manuscript must be typewritten (double-spaced) on 8½″ × 11″ paper, 1″ margin all around. All quotations exceeding four lines must be indented and single-spaced.
   (b) Manuscript must not exceed 50 pages.
   (c) Citations must be in approved law review form.
   (d) Table of Contents (subject matter) must appear inside front cover.
   (e) *Three* copies of manuscript must be submitted.
   (f) Cover for manuscript: any standard form stiff cover with label on outside showing title of paper, author's name, and permanent *home address.*

7. *Submission of papers and publication:*
   (a) Winning papers will be forwarded in *triplicate* by the dean to the Society, which may authorize publication.
   (b) Papers may appear in Law Reviews, provided their entry in the Nathan Burkan Memorial Competition is duly noted.
8. As papers are presumed to represent individual study, collaboration with others in their preparation (other than the usual law review supervision) is not permitted.
9. *Closing date:* August 15th—or any earlier date the dean may specify. Winning papers must be certified to the Society not later than August 31st.
10. *National Awards:* The five best papers selected by a National Awards Panel will receive awards of $3,000, $2,000, $1,500, $1,000 and $500, respectively. Only papers which conform to these rules will be considered for a National Award. The award papers will be printed in the *ASCAP Copyright Law Symposium*.

Contents

NATIONAL FIRST PRIZE, 1982

An Assessment of the Copyright Model in Right of Publicity Cases

KEVIN S. MARKS[1]

BOALT HALL SCHOOL OF LAW

IN POPULAR CULTURE, both a performer's act and his or her name and likeness have commercial value. The right of the performer or publicity figure[2] to control these assets, most appropriately called the right of publicity, is itself the work of creative endeavors by courts and commentators who have attempted to define the scope of the right—its duration, its conditions of applicability, and its benefactors. These attempts have led to the adoption of analogies based on other bodies of law.[3] Nowhere was the use of analogy more evident than in

[1] Associate, Arnold & Porter, Washington, D.C.; J.D. 1982, Boalt Hall School of Law, University of California; A.B. 1979, Stanford University.

[2] The term "publicity figure" describes persons who, by virtue of public exposure, generate an interest in their lives and likenesses. This group includes celebrities, public figures, entertainers, and athletes.

[3] Felcher & Rubin, *The Descendibility of the Right of Publicity: Is There Commercial Life After Death?* 89 YALE L.J. 1125, 1127–32 (1980). The Second Circuit was the first court to recognize a right of publicity distinct from a right of privacy. *See* Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953) (applying New York law). Then Circuit Judge Frank expressly disclaimed reliance on any common law model, writing that "[w]hether [the right of publicity] be labelled a 'property' right is immaterial; for here, as often elsewhere, the tag 'property' simply symbolizes the

the *Lugosi v. Universal Pictures*[4] litigation, which generated four opinions on the ownership of the commercial rights to the image of Bela Lugosi's portrayal of Count Dracula. The four opinions characterized the right of publicity as a property right,[5] a privacy right,[6] an employer owned product of employment,[7] and a proprietary right which should be treated like a copyright.[8]

This article concludes that the personal and societal interests involved in right of publicity cases are best advanced under a common law scheme that parallels copyright law. Copyright law offers, however, two models: a traditional copyright model based on the policies of encouraging creative effort and protecting against unjust enrichment, and an alternative "byproduct" model, based principally on protecting

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fact that courts enforce a claim which has pecuniary worth." *Id.* at 868. Since *Haelan*, courts have used common law labels or models as guides to determine the characteristics of the right of publicity. *E.g.*, Cepeda v. Swift & Co., 415 F.2d 1205, 1206–07 (8th Cir. 1969) (plaintiff had "property right"; sole issue was whether plaintiff's contract authorized "use of plaintiff's name and photograph in the manner in which they were used") ; Uhlaender v. Henricksen, 316 F. Supp. 1277, 1282–83 (D. Minn. 1970) (using a property formulation) ; Lugosi v. Universal Pictures, 25 Cal. 3d 813, 821–24, 603 P.2d 425, 430–31, 160 Cal. Rptr. 323, 328–29 (1979) (holding that the tenets of privacy law are controlling) ; *id.* at 844–49, 602 P.2d at 444–47, 160 Cal. Rptr. at 342–45 (Bird, C.J., dissenting) (using analogy to federal copyright law; Bi-Rite Enterprises, Inc. v. Button Master, 555 F. Supp. 1188, 1200 (S.D.N.Y. 1983) ("This proprietary interest is much like a copyright. . . .").

Commentators have also analyzed the right of publicity by way of analogy. *See, e.g.*, Gordon, *Right of Property in Name. Likeness, Personality, and History*, 55 NW. U.L. Rev. 553 (1960) ; Comment, *The Right of Publicity—Protection for Public Figures and Celebrities*, 42 Brooklyn L. Rev. 527 (1976) (positing that the right of publicity is a property right) ; Comment, *Transfer of the Right of Publicity: Dracula's Progeny and Privacy's Stepchild*, 22 U.C.L.A. L. Rev. 1103, 1124–28 (1975) (suggesting that an analogy be drawn between copyright and the right of publicity).

[4] 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979).

[5] Lugosi v. Universal Pictures Co., 172 U.S.P.Q. (BNA) 541, 548–49 (Cal. Super. Ct. 1972).

[6] 25 Cal. 3d at 819–24, 603 P.2d at 428–31, 160 Cal. Rptr. at 326–29.

[7] *Id.* at 824–28, 603 P.2d at 431–34, 160 Cal. Rptr. at 329–32 (Mosk, J., concurring).

[8] *Id.* at 844–49, 603 P.2d at 444–47, 160 Cal. Rptr. at 342–45 (Bird, C.J., dissenting).

the "byproducts" of creative effort from unjustly enriching would-be commercial exploiters, or in other words, based on the secondary goal of the traditional model. These two models match up with the two types of right of publicity cases—publicity rights to performance and publicity rights to the performer's image. This article argues that performance cases should be guided by the traditional model, and image cases should be determined by applying the byproduct model.

Part I of this article examines the proposed modes of treatment articulated in *Lugosi*. Part II considers an alternative copyright model that protects the images of graphic characters which are byproducts of larger, copyrightable works. Part II concludes that this model should be applied to those publicity cases involving appropriation of a publicity figure's likeness. Part III applies the byproduct model and concludes that the right of publicity is descendible, that post-mortem exploitation should not depend on lifetime exploitation, and that the right inures to an actor in his portrayal of a fictional character.

THE PROPOSED MODELS OF ANALYSIS

THE LUGOSI SCENARIO

Bela Lugosi portrayed Count Dracula in Universal Pictures' 1931 motion picture *Dracula*. Though other notable actors have donned the black cape of the vampire, it was Lugosi's Dracula that created the most vivid and lasting impression.[9] A resurgence of popularity in vintage horror films and

[9] One pop culture critic writes:

> Lugosi, with his slick-back black hair, piercing eyes, predatory profile, and rich Hungarian accent, became permanently identified with the role even though he played it only twice in films (and on one of those occasions, at that, in a comedy). He looked almost nothing like the white-haired, mustachioed old man described by Bram Stoker; but Lugosi's highly theatrical performance was so effective that his face has become Dracula's face and his voice, Dracula's voice.

L. DANIELS, LIVING IN FEAR: A HISTORY OF HORROR IN THE MASS MEDIA 130

their characters began in the early 1960s, several years after Lugosi's death.[10] This was evinced not only in movie houses and on late-night television but also in pop culture merchandise like T-shirts, posters, and models.

Universal entered into licensing agreements with commercial merchandisers authorizing the use of the Count Dracula image. Bela Lugosi's distinct Dracula image ultimately appeared on T-shirts, plastic models, masks, playing cards, picture puzzles, belt buckles, and bar accessories. The *Lugosi* lawsuit was brought to determine the post-mortem rights of control over the actor's name and likeness. Bela George Lugosi and Hope Linninger Lugosi, the actor's surviving son and widow, sought injunctive relief and recovery of Universal's profits on the ground that the studio engaged in allegedly unauthorized exploitation of a valuable property right belonging to the deceased actor's estate.[11]

THE PROPOSED MODES OF TREATMENT

The *Lugosi* litigation generated four opinions seeking to define the "right of value"[12] to one's name and likeness. The opinions articulate a property model, a privacy model, a pro-

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(1975). *See also* I. BUTLER, HORROR IN THE CINEMA 42 (2d ed. 1970) (Lugosi "invested the character with a formidable dignity and stalked about the West End in his cloak and top-hat with a ghastly relish").

Universal's conduct suggests that it believed Lugosi to be the quintessential vampire. Universal obtained Lugosi's written permission to use his likeness for a wax bust in the 1936 film *Dracula's Daughter*. Twelve years later, it asked Lugosi to make a cameo appearance as Count Dracula in *Abbott and Costello Meet Frankenstein*. Lugosi v. Universal Pictures Co., 172 U.S.P.Q. (BNA) 541, 541–42 (Cal. Super. Ct. 1972).

[10] *See* Lugosi v. Universal Pictures Co., 172 U.S.P.Q. (BNA) 541, 542 (Cal. Super. Ct. 1972).

[11] The trial court had earlier determined that Lugosi's estate was the proper plaintiff. After Lugosi's widow and son were subsequently awarded all causes of action belonging to the estate, the litigation culminating in the California Supreme Court decision recommenced.

[12] This term, used by the *Lugosi* majority, 25 Cal. 3d at 819, 603 P.2d at 428, 160 Cal. Rptr. at 326, was first coined by Dean Prosser. *See* W. PROSSER, LAW OF TORTS § 117, at 807 (4th ed. 1971).