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Statement in Opposition to Bill A8155-b
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The 2017 FX television series *Feud* depicted the Hollywood Golden Age rivalry between Bette Davis and Joan Crawford, as portrayed by Jessica Lange and Susan Sarandon. It received critical acclaim and was nominated for 19 Emmy awards. Yet a bill now being rushed through the New York Legislature threatens to make this artistic and entertaining series unlawful — or at least to create enough uncertainty to strongly discourage such productions in the future. Olivia de Havilland objected to the way *Feud* presented her character (played by Catherine Zeta-Jones) and sued under California law; thankfully her effort to silence this speech was rejected by an appellate court, but it is unclear whether the result would be the same if the proposed New York legislation is enacted.

I write to strongly oppose Assembly Bill A8155-b, which unwisely and haphazardly expands ownership rights in personal image. It does so without any careful consideration of existing legal remedies that have proven effective. The bill also risks significant damage to artistic and political expression, and may violate the First Amendment as currently written.

QUALIFICATIONS

I am a tenured full professor of law at the University of Minnesota. For over a decade I have taught and written scholarship about the intersection of free speech and intellectual property rights such as trademarks and rights of publicity.[1] A forthcoming essay, *Selfmarks*, carefully

[1] *See Selfmarks*, 56 Houston Law Review __ (forthcoming 2018); *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 Washington Law Review 713 (2015); *Confusion Isn't Everything*, 89 Notre Dame Law

studies individuals' rights in the commercial use of their identities. It concludes that existing law at the federal and state level should be interpreted to protect those interests and that further expansions of intellectual property rights are unnecessary. In addition, I am a national authority on privacy law. I have written one of the first law school casebooks on the topic.[2] I also wrote one of the earliest and most detailed examinations of the application of privacy and publicity rights to advertising messages involving ordinary people on social media platforms such as Facebook.[3] I was born and raised in New York City, and from 1993 to 1998 I served as a legislative aide to then-Rep. Charles Schumer and the late Rep. Louise Slaughter.

EXISTING REMEDIES

The first problem with the bill and the legislative process surrounding it is the lack of attention to existing legal remedies. Indeed, I have yet to see any clear articulation of a problem supposedly addressed by A8155-b that is not already handled, more effectively and with greater interpretive guidance from precedent, by existing law. The lengthy and complex provisions of the bill need to be compared carefully to existing law.

The current language in New York Civil Rights Law § 50 and § 51 effectively protects a celebrity's persona from unauthorized appropriation, backed by a century of strong judicial precedent from state and federal courts. Numerous individuals, both celebrities and ordinary people, have recovered damages using current law for the unauthorized appropriation of their identity in a manner that violates their privacy rights. Its limitations and exceptions are well understood under existing case law. Although § 2(e) of the new publicity rights provision attempts to keep this precedent in place, it is deeply confusing, because it talks about the maintenance of existing rules pertaining to a right that has not previously existed in New York law. Rather than disrupting this settled body of state law, the Legislature should evaluate whether that law already delivers all or almost all the aims of this bill.

Review 253 (2013) (with Mark P. McKenna); *The Trademark Fair Use Reform Act*, 90 Boston University Law Review 2267 (2010); *Rethinking Trademark Fair Use*, 94 Iowa Law Review 49 (2008).

[2] PRIVACY AND DATA PROTECTION LAW (2016; 2d ed. Forthcoming 2019).

[3] *Disclosure, Endorsement, and Identity in Social Marketing*, 2009 University of Illinois Law Review 1105 (2009).

Federal law adds further legal safeguards. Lanham Act § 43(a) prevents "false endorsement," where the use of celebrity identity might inaccurately suggest a celebrity is connected to goods or services or approves of them. Lanham Act § 2 prevents the registration of trademarks that trade on a person's identity without permission. As discussed in *Selfmarks*, these provisions handle a great deal of the same work done by publicity rights statutes in some states. Because of the steady expansion of both the scope of trademark rights and their applicability to individuals, much of the arguable need for distinct publicity rights regimes has been subsumed by the growing trademark rights associated with persona. Those trademark rights are anchored in the commercial uses that provide the most justification for regulation. They are also embedded in substantial doctrinal rules that have already confronted many of the issues that come up in this area, including speech protection and complex questions of property law.

At a minimum, lawmakers should conduct a thorough analysis of both state and federal law to see whether they already provide everything necessary to ensure respect for persona rights, without any risk of disruption. Even if careful study demonstrated some small areas could be improved, a more narrowly tailored bill focused on these particular areas would be better than a rushed and sweeping legislation like Assembly Bill A8155-b.

SPEECH INTERESTS

Because trademarks and publicity rights involve control over language, there is great risk that overly broad control will prevent valuable speech, or at least discourage it by making litigation threats more effective.

The draft bill includes some specific exemptions for a range of expressive works, but these are defined narrowly and some are technology-specific. Their boundaries have not been tested under New York law, even if there is some precedent from other states that might prove helpful. Federal courts in New York have moved to a comprehensive test that is less constrained by specific forms of expression. Under *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), a court asks simply (1) whether the claim is against an expressive work, (2) whether the use of the persona had some artistic relevance to the expressive work, and (3) whether the expressive work is "explicitly misleading" as to the authorization or involvement of the person now asserting trademark or publicity rights. I would encourage the Legislature

to incorporate study of that case into its process, something that was not possible in the rush to enact this far-reaching legislation.

It is no answer to say that courts will intervene when the new rights overstep First Amendment boundaries, because that could only be decided case-by-case in court, which would be an expensive and difficult undertaking for any defendant sued by celebrities or their heirs. Even if the speech-related exceptions were comprehensive and perfectly effective — which they are not — creating new rights in this fashion imperils speech. I am among numerous scholars who have documented the ways that rights in brands or personalities chill speech even when they might not be enforceable on the merits if the case were fully litigated. Rightsholders assert their prerogatives against parodists, critics, and commentators through informal cease-and-desist letters. The existence of the right gives at least some credibility to these litigation threats. Recipients of such demands frequently capitulate, lacking the resources, time, knowledge, and institutional support to fight for their free speech rights. Not only do these speakers lose their access to free speech, but

CONCLUSION

There is no emergency demanding quick action on Assembly Bill A8155-b. In fact, existing law covers most of the territory already. I strongly encourage the Legislature to step back, examine the issues more carefully, consider the adequacy of existing law, and be especially cautious about speech restrictions in this area. I would be happy to assist in this effort.