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RIGHT OF PERSONALITY

Because the level of protection for a deceased celebrity's personality rights varies from state to state, the choice of state jurisdiction can be a decisive factor in seeking such protection. The authors review the laws of several states and conclude that the state of Washington currently offers the strongest right of personality protection.

No Respect for the Dead: Protecting Deceased Celebrity Personality Rights

By JOHN W. BRANCH, DAVID H. GREEN, AND KARL A. HEFTER

I. Background of Deceased Celebrity Personality Rights

Joe DiMaggio and Marilyn Monroe, one of the 20th century's most iconic married couples, earned substantial incomes for advertising and merchandising their personality rights during their lifetime. Even after their death, their personality rights have continued to earn substantial revenue from similar uses. So why has at least one court recently declined to continue to pro-

tect Monroe's personality rights after her death, while DiMaggio's rights remain intact?

The short answer is that the amount of protection for a deceased celebrity's personality rights can vary widely from state to state, and the state where a celebrity is domiciled at death may determine the existence of their post mortem rights. Consequently, the choice of state jurisdiction is often the decisive factor in protecting deceased celebrity personality rights.

Notably, after several lawsuits had failed to protect the deceased celebrity personality rights of Jimi Hendrix and Marilyn Monroe, the states of Washington and California recently passed new legislation that significantly strengthens their deceased celebrity personality rights statutes.¹ Moreover, the state legislatures of Illi-

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¹ Cal. Civ. Code § 3344.1 (West 2008) (the annotated code notes the effective date of the statute as Jan. 1, 2008); Sub. H.B. 2727, 60th Leg., Reg. Sess. (Wash. 2008) (enactment date was June 12, 2008), available at <http://apps.leg.wa.gov/documents/billdocs/2007-08/Pdf/Bills/Session%20Law%202008/2727-S.SL.pdf>.

nois, New York, and Connecticut are currently in the process of considering an increase in the amount of protection that they provide for deceased celebrity personality rights.²

a. Property Rights v. Privacy Rights

During a celebrity's lifetime, most states protect against the unauthorized commercial use of the celebrity's name, image, likeness, voice, and signature.³ These "rights of publicity" or "personality rights" can empower celebrities to both stop unauthorized uses of these rights and seize goods.⁴ For example, George Clooney was able to stop an Italian clothing company from the unauthorized use of his name as the brand for clothes and watches.⁵

However, after a celebrity's death, the states are far from uniform in how they continue to protect, if at all, these personality rights. Some states, such as New York, provide limited protection for deceased celebrity personality rights,⁶ while other states like Washington, California, and Indiana continue to broadly protect such rights for up to 100 years after death.⁷

Why the discrepancy in state protection for deceased celebrity personality rights? In part, the laws of some states, notably New York, have historically treated personality rights in a manner similar to privacy rights, which usually expire at death.⁸ Other states, such as Washington, California, and Indiana, have treated personality rights like property rights,⁹ that continue to exist after a celebrity's death.¹⁰ After a celebrity's death this "property" right embodied as a personality right typically descends to their heirs or beneficiaries, in a manner similar to a copyright.¹¹ Subsequently, these

"property" rights can be licensed for commercial use or used to stop others from unauthorized use for a limited term.¹²

b. Fluctuating Value of Deceased Celebrity Personality Rights

For highly popular deceased celebrities, the financial value of their personality rights may not significantly diminish after their death. For example, *Forbes* magazine recently published a list of the "Top Earning Deceased Celebrities."¹³ The *Forbes* list included cultural icons such as Marilyn Monroe, Elvis Presley, Albert Einstein, Andy Warhol and even Dr. Seuss. Notably, the beneficiaries of the Elvis Presley estate reportedly continue to earn more than \$49 million a year from licensing.¹⁴ Even though the beneficiaries of the licensing revenue for deceased celebrity personality rights are typically individuals, this revenue may also be bequeathed or assigned to companies and nonprofit institutions.¹⁵

However, for most celebrities, the financial value of their personality rights can fluctuate over time. This fluctuation is often unpredictable and hard to evaluate. For example, the circumstances around the death of a celebrity can cause a sudden increase in the public's curiosity and a corresponding increase in commercial use of their personality rights. Also, a movie or book regarding the life and times of a dead celebrity can cause a substantial increase in the value of their personality rights long after their death. But for most celebrities, unless properly managed, the value of their personality rights decreases substantially within a short period of time after death. Consequently, the financial value for deceased celebrity personality rights is difficult to predict over the statutory term of protection.

II. Personality Rights Development

a. Evolution of Personality Rights

Although each state's protection for a living celebrity's personality rights has evolved somewhat differently, they all generally originated in common law, and not legislation.¹⁶ However, in the last two decades, some state legislatures have codified substantial protection for deceased celebrity personality rights, e.g.,

the beneficiaries or heirs under the laws of [applicable] intestate succession"), with 17 U.S.C. § 201(d) (2008) (stating that copyright may be transferred by "any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession").

¹² Cal. Civ. Code § 3344.1; Ind. Code §§ 32.36.1.1-20; Wash. Rev. Code §§ 63.60.010-080.

¹³ Lea Goldman and Jake Paine, *Top-Earning Dead Celebrities*, *Forbes* (2007) (available at: http://www.forbes.com/2007/10/26/top-dead-celebrity-biz-media-deadcelebs07-cz_lg_1029celeb.html).

¹⁴ *Id.*

¹⁵ See Andy Warhol Foundation Web site, <http://www.warholfoundation.org/>; The Albert Einstein Archives—The Hebrew University of Jerusalem, Web site at <http://www.albert-einstein.org/>.

¹⁶ For example, up until 1998 Washington courts implied that a common law personality right may exist in Washington. See *State ex rel. La Follette v. Hinkle*, 229 P. 317, 319 (Wash. 1924) (noting that the court held that a political party could not use the name of an individual as the name of their party without the individual's authorization).

² See A.B. 6818, 2007 Jan. Sess. (Conn. 2007), available at <http://www.cga.ct.gov/2007/TOB/H/2007HB-06818-R01-HB.htm>; A.B. 8836, 2007-2008 Reg. Sess. (N.Y. 2007), available at <http://assembly.state.ny.us/leg/?bn=A08836&sh=t>.

³ See Wash. Rev. Code § 63.60.010 (2008); Thomas McCarthy, *The Rights of Publicity and Privacy*, §§ 6:3, 6:8 (2d ed. 2008) (noting the different states that protect personality rights).

⁴ See Wash. Rev. Code §§ 63.60.060(3)-(4); McCarthy, *The Right of Publicity and Privacy*, § 11:22.

⁵ Brian Tracey, *Counterfeit Clooney Clothes Line Pulled*, MSNBC (Apr. 13, 2008) (available at: <http://www.msnbc.msn.com/id/24050793/>).

⁶ See *Frosch v. Grosset & Dunlap Inc.*, 427 N.Y.S.2d 828, 828-29 (N.Y. App. Div. 1980) (citing N.Y. Civ. Rights Law § 50 (Consol. 2008) as being only applicable to "any living person" and no other statutory provision to protect deceased celebrity personality right); *Pirone v. Macmillan Inc.*, 894 F.2d 579, 582-83, 13 USPQ2d 1799 (2d. Cir. 1990) (39 PTCJ 287, 2/15/90) (New York does recognize relatively limited protection for the name of a deceased celebrity as a trademark under the Lanham Act. The protection of a deceased celebrity's name extends only to the secondary meaning as "identifying the business of selling [specific] products" and not the use of the name to identify the person).

⁷ Cal. Civ. Code § 3344.1 (West 2008); Ind. Code §§ 32.36.1.1-20 (2008); Wash. Rev. Code §§ 63.60.010-080 (2008).

⁸ See *Pirone*, 894 F.2d at 585.

⁹ See Cal. Civ. Code § 3344.1(b) (West 2008); Ind. Code § 32.36.1.16 (2008); Wash. Rev. Code § 63.60.010.

¹⁰ See Cal. Civ. Code § 3344.1(g); Ind. Code § 32.36.1.8; Wash. Rev. Code § 63.60.040 (2008).

¹¹ Compare Wash. Rev. Code § 63.60.030 (2008) (stating that personality rights "shall be freely transferable . . . by contract . . . [or by] last will and testament, . . . [or bequeathed to]

Washington,¹⁷ California,¹⁸ and Indiana.¹⁹ In contrast, other states, such as New York, have resisted substan-

¹⁷ Prior to 1998, Washington courts only implied the existence of a personality right. *See supra* note 16. Then in 1998, the Washington legislature formally codified protections for deceased celebrity personality rights. H.R. 1074, 55th Leg., Reg. Sess. (Wash. 1998) (current statute Wash. Rev. Code §§ 63.60.010–080).

¹⁸ In 1971, California enacted Cal. Civ. Code § 3344, which originally protected living personality rights. Cal. Leg. ch. 1595, Reg. Sess. Ch. 1306-1821 at 3426 (Cal. 1971). After the passage of the 1971 act, California courts held that personality rights were not descendible after death. *Lugosi v. Universal Pictures*, 603 P.2d 425, 431, 205 USPQ 1090 (1979) (459 PTCJ A-1, 12/20/79). Then in 1988, the California legislature passed Cal. Civ. Code § 990 to protect deceased celebrity personality rights. Cal. Leg. ch. 113 sec. 2, Reg. Sess. Ch. 1-397 at 464 (Cal.

tial statutory protection for deceased celebrity personality rights and continue to rely upon common law, which often refuses to recognize such rights after death.²⁰ Table 1, listed below, illustrates a patchwork quilt of protection for deceased celebrity personality rights in the States of Washington, California, Indiana, and New York.

1988) (§ 990 was renumbered, and the current statute is Cal. Civ. Code § 3344.1).

¹⁹ In 1994, Indiana enacted its deceased celebrity personality rights statute. 1994 Ind. Legis. Serv. P.L.149-1994 (West) (current statute is Ind. Code §§ 32.36.1.1–20)

²⁰ *See* N.Y. Civ. Rights Law §§ 50, 51 (Consol. 2008) (noting the statute does not provide protection of personality rights for celebrities after their death). *See also Pirone*, 894 F.2d at 586.

Table 1

State	Personality Rights After Death		State of Domicile Applicable		Term of Protection	Protection for Celebrities Who Died After Statutory Date
	Yes	No	Yes	No		
Washington ²¹	X			X	75 years after death ²²	Jan. 1, 1948
California ²³	X		X		70 years after death ²⁴	Jan. 1, 1915 ²⁵
Indiana ²⁶	X			X	100 years after death	July 1, 1994 ²⁷

²¹ Wash. Rev. Code § 63.60.040 (the term of protection is seventy-five years for deceased personalities or celebrities whose name, voice, signature, photograph, or likeness had commercial value at the time of his or her death); there is also a term of protection of ten years for other deceased individuals or non-celebrities).

²² Wash. Rev. Code § 63.60.020 (Rights existed and were freely transferable before, on, or after June 11, 1998; also, individuals or non-celebrities (*see supra* note 23) that died after January 1, 1988 are protected).

²³ Cal. Civ. Code § 3344.1.

Table 1 – Continued

State	Personality Rights After Death		State of Domicile Applicable		Term of Protection	Protection for Celebrities Who Died After Statutory Date
	Yes	No	Yes	No		
New York ²⁸		X	N/A	N/A	N/A	N/A

N/A = Not Applicable because the State does not recognize deceased celebrity personality rights

²⁴ The term of protection is also 70 years after Jan 1, 2008, if a suit, involving a celebrity who died before Jan. 1, 1985, was filed before May 1, 2007, and subsequently lost. Cal. Civ. Code § 3344.1(o).

²⁷ Statute enacted in 1994. 1994 Ind. Leg. Serv. P.L.149-1994 (West).

²⁸ See N.Y. Civ. Rights Law § § 50, 51 (Consol. 2008) (noting that the statute does not provide protection for personality rights after a celebrity's death). See also *Pirone*, 894 F.2d at 586 (noting that New York courts do not recognize deceased celebrity personality rights under common law).

b. Mixed Support for Deceased Celebrity Personality Rights

The entertainment industry has generally supported increased protection for deceased celebrity personality rights, while the publishing industry has not. For example, Washington state's recent enactment of a significantly stronger deceased celebrity personality rights statute was supported by Getty Images Inc. and Corbis Corp.²⁹, one of the world's largest archives of digital images of celebrities.³⁰ Similarly, in California, the Screen Actor's Guild sponsored a 2007 statutory amendment,³¹ which abrogated the negative impact of two court decisions that ruled against protecting the personality rights of Marilyn Monroe.³² Additionally, in Indiana, CMG Worldwide Inc., representing the families and estates of deceased celebrities,³³ was the "driving force behind the instatement of Indiana's [personality rights] Statute."

In contrast, other states with a significant publishing industry, such as New York, have a history of opposing statutes that increase the protection for deceased celebrity personality rights. For example, a bill to provide protection for deceased celebrity personality rights,

²⁵ Rights existed and were freely transferable prior to and after Jan. 1, 1985. *Id.* However, the owner of a deceased celebrity's personality rights can only recover damages in California that occurred after the owner registered the interest in such rights with the California secretary of state. *Id.* at § 3344.1(f).

²⁹ H.B. Rept. 60-2727, Reg. Sess., at 4 (Wash. 2008), available at <http://apps.leg.wa.gov/documents/billdocs/2007-08/Pdf/Bill%20Reports/House/2727.HBR.pdf>.

³⁰ See Corbis Corp. Web site, <http://pro.corbis.com/default.aspx>; Getty Images, Inc. Web site, <http://www.gettyimages.com/Editorial/Events.aspx?EventId=76104924>; Andrea James, *Getty Images, Corbis Bank on Interest in Celebrities*, Seattle Post-Intelligencer (Aug. 25, 2007) (available at http://seattlepi.nwsourc.com/business/329003_corbis25.html (noting both companies' desire to provide more celebrity images)).

³¹ Assem. Comm. Rep. 771, 2007 (Cal. 2008), available at http://info.sen.ca.gov/pub/07-08/bill/sen/sb_0751-0800/sb_771_cfa_20070709_103425_asm_comm.html.

³² S.B. 771, 2007, Reg. Sess. (Cal. 2008), available at http://www.leginfo.ca.gov/pub/07-08/bill/sen/sb_0751-0800/sb_771_bill_20071010_chaptered.html.

³³ CMG Worldwide Inc.'s Web site, <http://www.cmgworldwide.com/corporate/overview.htm>.

which was supported by many celebrities,³⁴ was recently introduced to the New York legislature.³⁵ However, the bill was not voted on after receiving opposition from organizations linked to the publishing industry, such as the Association of the Bar of the City of New York,³⁶ the Author's Guild,³⁷ and the American Society of Media Photographers.³⁸

III. State Law Protection for Deceased Celebrity Personality Rights

After the passage of personality rights statutes in several states during the mid 1980s and late 1990s, the protection provided by those statutes for the enforcement of deceased celebrity personality rights in particular jurisdictions appeared to be fairly well understood. All of this changed in 2007, when a series of cases involving the protection of Marilyn Monroe's personality rights began to raise questions about the proper jurisdiction for enforcing the personality rights of long-deceased celebrities.

a. California State Law

In the first Monroe decision in May 2007, the District Court for the Central District of California held that the plaintiffs, CMG Worldwide Inc. ("CMG") and Marilyn Monroe LLC ("MMLLC"), lacked standing to assert Marilyn Monroe's personality rights claim.³⁹ The court reasoned that the California statute did not give personality rights to those who died before its enactment in 1985.⁴⁰ Since Monroe died in 1962,⁴¹ the court found

²⁶ Ind. Code §§ 32.36.1.1-20

³⁴ See A.B. Sum. 8836, 2007-2008 Reg. Sess. (N.Y. 2007) (available at <http://assembly.state.ny.us/leg/?bn=A08836>).

³⁵ *Id.*; S.B. 6005, 2007-2008 Reg. Sess. (N.Y. 2007), available at <http://assembly.state.ny.us/leg/?bn=S06005&sh=t>.

³⁶ See http://www.nycbar.org/pdf/report/Dead_Celebrities.pdf.

³⁷ See <http://www.authorsguild.org/advocacy.html>.

³⁸ See http://www.asmp.org/news/spec2007/CA_publicity_bill.php.

³⁹ *Milton H. Greene Archives Inc. v. CMG Worldwide Inc.*, 2008 U.S. Dist. LEXIS 22213, *5 (C.D. Cal. 2008).

⁴⁰ Cal. Civ. Code § 3344.1; *Milton H. Greene Archives*, 2008 U.S. Dist. LEXIS at *6.

⁴¹ *Shaw Family Archives Ltd. v. CMG Worldwide Inc.*, 486 F. Supp. 2d 309, 312 (S.D.N.Y. 2007) (74 PTCJ 210, 6/15/07).

that Monroe did not have personality rights to transfer upon her death;⁴² therefore, leaving the plaintiffs lacking standing to assert Monroe's personality rights claim.⁴³

The first Monroe opinion caused widespread confusion and concern in the entertainment industry, not just among the executors of celebrity estates, but among merchandise manufacturers, film studios, and advertisers. These businesses, some of which had paid significant fees to license Monroe's personality rights, were left to wonder if their licenses were now enforceable. Additionally, licensees did not know whether they would be found liable if other stake holders could lay claim to their previously licensed deceased celebrity personality rights.

Not surprisingly, California's legislature wasted little time in addressing these concerns regarding deceased celebrity personality rights. In September 2007, the California legislature passed an amendment to clarify that personality rights existed for celebrities that died prior to the statute's enactment.⁴⁴ Therefore, any will or trust and any licenses that existed before the 1985 California statute remained effective to transfer the deceased celebrity's personality rights.⁴⁵ Based on the new amendment, the owners of Monroe's deceased personality rights asked for reconsideration of their previous lawsuit.⁴⁶

In January 2008, on the hearing for reconsideration, the U.S. District Court for the Southern District of California found that under the new statute Monroe had protectable personality rights that existed after her death in California.⁴⁷ Therefore, the court held that MMLLC had standing to enforce Monroe's personality rights.⁴⁸ After finding MMLLC had standing, the court granted its motion for reconsideration.⁴⁹

The court further held that a choice of state law analysis needed to be performed to determine if Monroe had the "testamentary power to bequeath a [deceased celebrity personality right] through her will" to another party.⁵⁰ At the time of her death, Monroe had homes in both California and New York. The court found that state law jurisdiction analysis was needed because California protects deceased celebrity personality rights, but New York does not.⁵¹ The court further held that whether Monroe had testamentary power to bequeath her deceased celebrity personality rights or not depended on whether Monroe was domiciled in California or in New York at the time of her death.⁵² However, the court declined to decide at that time on

the issue of where Monroe was domiciled because of "a premature and incomplete record."⁵³

In March 2008, another trial was held in the District Court for the Central District of California to perform the choice of state law jurisdiction analysis based on what state Monroe was domiciled in at the time of her death.⁵⁴ The court held that despite Monroe's death in her California home while employed in California, the plaintiffs were judicially estopped from arguing that Monroe was domiciled in California.⁵⁵ The court found that Monroe was legally domiciled in New York at the time of her death since Monroe's estate executor had previously chosen New York as the legal domicile of Monroe for probating her will.⁵⁶ Therefore, the court further held that Monroe's deceased celebrity personality rights claim was not actionable because New York law does not protect deceased celebrity personality rights.⁵⁷ As a result Monroe's deceased celebrity personality rights in California were unprotectable,⁵⁸ even though California's law provides deceased celebrity personality rights protection for 70 years after the death of a celebrity.⁵⁹

Registration of the Interest in Deceased Celebrity Personality Rights

For owners of deceased celebrity personality rights seeking to recover damages in Washington, California, and Indiana, only California requires those owners to register their interest in such rights with the secretary of state.⁶⁰ In California, owners of deceased celebrity personality rights may not recover damages that occurred prior to the registration of their interest.⁶¹ As a result, California provides no protection for the unauthorized use of a deceased celebrity's personality rights prior to the registration of those rights.

b. New York State Law

New York provides almost no protection for deceased celebrity personality rights.⁶² For example, in *Pirone v. MacMillan Inc.*, the court held that Babe Ruth's heirs did not state a claim upon which relief could be granted because the New York "Civil Rights Law preempts any common law [personality right] action."⁶³ The court found that since personality rights were "encompassed under the Civil Rights Law as an aspect of the right of privacy, which . . . is exclusively statutory . . . the plaintiff [could not] claim an independent common-law [personality right]."⁶⁴

More recently, in *Shaw Family Archives Ltd. v. CMG Worldwide Inc.*, the District Court for the Southern District of New York further emphasized that New York does not recognize common law deceased celebrity per-

⁴² *Milton H. Greene Archives*, 2008 U.S. Dist. LEXIS at *5.

⁴³ *Id.* at *6-7.

⁴⁴ *Id.* at *10.

⁴⁵ Cal. Civ. Code § 3344.1(b).

⁴⁶ *Milton H. Greene Archives*, 2008 U.S. Dist. LEXIS at *10.

⁴⁷ *Id.* at *57-58.

⁴⁸ Marilyn Monroe's personality rights passed by will to her husband Lee Strasberg. When Mr. Strasberg died, his property, including Monroe's personality rights, passed by will to his wife, Anna Strasberg. Ms. Strasberg then formed Marilyn Monroe, LLC ("MMLLC"), and she transferred Monroe's personality rights to MMLLC. *Id.* at *56-58.

⁴⁹ *Id.* at *85.

⁵⁰ *Id.* at *59.

⁵¹ *Id.*

⁵² *Id.*

⁵³ *Id.* at 65.

⁵⁴ *Milton H. Greene Archives Inc. v. CMG Worldwide Inc.*, 2008 WL 1922980, 2-3 (C.D. Cal. 2008).

⁵⁵ *Id.* at *34.

⁵⁶ *Id.* at *22.

⁵⁷ *Id.* at *3, *34.

⁵⁸ *Id.* at *34.

⁵⁹ Cal. Civ. Code § 3344.1.

⁶⁰ Cal. Civ. Code § 3344.1(f).

⁶¹ *Id.*

⁶² See N.Y. Civ. Rights Law §§ 50, 51 (noting that the statute does not provide protection for personality rights after a celebrity's death); *Pirone*, 894 F.2d at 586.

⁶³ *Pirone*, 894 F.2d at 586 (2d Cir. 1990).

⁶⁴ *Id.* at 585.

sonality rights. In *Shaw*, the court held that Marilyn Monroe could not bequeath property she did not own at the time of her death.⁶⁵ Therefore, since New York does not recognize the existence of personality rights that survive death, any personality rights that Monroe “enjoyed during her lifetime were extinguished at her death” and could not have passed to her heirs.⁶⁶

However, New York does recognize relatively limited protection for the name of a deceased celebrity as a trademark under the Lanham Act.⁶⁷ For example, in *Pirone*, the court found that this type of trademark is generally treated as a descriptive term, which requires that “through usage, [the mark] acquired distinctiveness and secondary meaning.”⁶⁸ Also, the protection of a deceased celebrity’s name extends only to the secondary meaning as “identifying the business of selling [specific] products” and not the use of the name to identify the person.⁶⁹ In *Pirone*, the defendant was selling a calendar with photos of Babe Ruth. The court held that a registered trademark of a celebrity’s name, which was owned by the plaintiffs, only protected the name as associated with the specified trademarked products and did not protect other personality rights, such as photos of the celebrity.⁷⁰

Recently after the *Shaw* case was decided in 2007, bills was introduced in the New York legislature to strengthen the protection for deceased celebrity personality rights.⁷¹ Although the bills have not been voted on, it may gain additional support, given recent public sentiment for newly deceased celebrities, such as Heath Ledger. Under current New York law, little to no protection would be provided for Ledger’s deceased celebrity personality rights if his estate chooses New York as his legal domicile at the time of death. It is noteworthy that celebrities have become more outspoken in supporting stronger protection for deceased celebrity personality rights in New York.⁷² However, publishing interests continue to oppose attempts to enact statutes in the New York legislature that would provide strong protection for deceased celebrity personality rights.⁷³

c. Indiana State Law

Unlike California and New York, Indiana courts have not decided a case regarding the protection of its deceased celebrity personality rights statute,⁷⁴ which was

enacted in 1994.⁷⁵ However, it is not due to a lack of trying. The original Marilyn Monroe lawsuits against Milton H. Greene Inc. and the Shaw Family Archives Inc. were separately filed in the state of Indiana.⁷⁶ Both cases were then transferred to California and New York, respectively, under 28 U.S.C. 1404(a) for judicial efficiency and convenience of the parties and witnesses.

When a case “is transferred from one district to another under 28 U.S.C. § 1404(a), the transferee court [generally]⁷⁷ must adopt the law, including choice-of-law principles, of the transferor court.”⁷⁸ Indiana’s choice of law “seems to adhere to the majority view that the law of the situs of property governs.”⁷⁹ Since deceased celebrity personality rights are intangible personal property,⁸⁰ the situs “is the legal domicile of its owner.”⁸¹ Therefore, most cases transferred out of Indiana require the transferee court to apply a domicile test.

Most recently in Indiana, CMG Worldwide Inc. and Topps Co. filed for a temporary restraining order against Topps competitor Upper Deck Co., alleging wrongful use of the personality rights of eight deceased baseball legends.⁸² Each of the eight baseball players’ personality rights are managed by CMG,⁸³ who exclusively licensed those rights to Topps.⁸⁴ A judge in the District Court for Southern District of Indiana lifted the restraining order in mid-June 2008 after being in place for only one week.⁸⁵ Subsequently, the defendant motioned to transfer venue to the Southern District of New

granted defendants’ motion barring the plaintiff from making any references to another lawsuit based on Ind. Code §§ 32-36-1-1 through 32-36-1-20; *Estate of Ellington v. Gibson Piano Ventures Inc.*, 2005 U.S. Dist. LEXIS 21003 (S.D. Ind. 2005) (the court denied the plaintiff’s motion for summary judgment on the use of a deceased celebrity’s personality rights on pianos because there was a genuine issue of material fact as to the identifiability of a deceased musician’s name being used on pianos. Also, the court did not address the issue of the deceased musician’s death occurring prior to the enactment of the Indiana statute); *Phillips v. Scalf*, 778 N.E.2d 480 (Ind. Ct. App. 2002) (the court affirmed earlier denial of appellants’ motion for change of venue to a different county within Indiana).

⁷⁵ 1994 Ind. Legis. Serv. P.L.149-1994.

⁷⁶ *CMG Worldwide, Inc. v. Milton H. Greene Archives, Inc.*, 2005 U.S. Dist. LEXIS 33816 (S.D. Ind. 2005); *CMG Worldwide, Inc. v. Shaw Family Archives Ltd.*, 2005 U.S. Dist. LEXIS 42493 (S.D. Ind. 2005).

⁷⁷ There is at least one exception to this rule: “where the defendant in the transferred action was not subject to personal jurisdiction in the original forum, then the transferee court must apply its own choice of law rules.” *Shaw Family Archives Ltd. v. CMG Worldwide Inc.*, 434 F. Supp. 2d 203, 208 (S.D.N.Y. 2006).

⁷⁸ *Id.* at 208.

⁷⁹ *Id.* at 211.

⁸⁰ See *Phillips*, 778 N.E.2d at 483; Ind. Code §§ 32.36.1.7 (2008) (noting that personality rights are a property interest).

⁸¹ *Shaw Family Archives*, 434 F. Supp. 2d at 211.

⁸² Boston.com Web site, *Topps Claims Foul Over Use of Images* (June 10, 2008) (available at http://www.boston.com/business/articles/2008/06/10/topps_claims_foul_over).

⁸³ CMG Worldwide Inc. Web site, http://www.cmgworldwide.com/client_lists/Printed_Client_List_Domestic_july08.pdf.

⁸⁴ *Topps Claims Foul Over Use of Images*.

⁸⁵ Sports Collectors Daily, *Upper Deck Free From Restraining Order* (June 19, 2008) (available at <http://www.sportscollectorsdaily.com/latest/upper-deck-free-from-restraining-order.html>).

⁶⁵ *Shaw Family Archives Ltd.*, 486 F.Supp. at 315.

⁶⁶ *Id.*

⁶⁷ See *Pirone*, 894 F.2d at 582-84; J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §§ 13:1-39 (4th ed. 2008).

⁶⁸ *Pirone*, 894 F.2d at 583.

⁶⁹ *Id.* at 584.

⁷⁰ *Id.* at 582-84.

⁷¹ See A.B. 8836; S.B. 6005.

⁷² See <http://blogs.timesunion.com/capitol/archives/7687> (article discusses living celebrities interest and support in protecting deceased celebrity personality rights).

⁷³ See http://www.asmp.org/news/spec2007/CA_publicity_bill.php; <http://www.authorsguild.org/advocacy.html>; http://www.nycbar.org/pdf/report/Dead_Celebrities.pdf.

⁷⁴ See generally *Milton H. Greene Archives*, 2008 U.S. Dist. LEXIS at *3 (case was transferred from the Southern District of Indiana to the Central District of California under 28 U.S.C. 1404(a) and the California court did not apply Indiana’s deceased personality rights laws); *Shaw Family Archives*, 486 F. Supp. at 309 (same); *Janky v. Lake County Convention & Visitors Bureau*, 2007 U.S. Dist. LEXIS 21892 (N.D. Ind. 2007) (case involved alleged copyright infringement, and the court

York. The Indiana court has not yet ruled on the motion to transfer venue, but if the motion is granted, once again a New York court will be ruling on deceased celebrity personality rights. And similar to the Monroe case, the ability to enforce the deceased celebrity personality rights of the eight deceased baseball legends will turn on what state was found to be their domicile at the time of their death.

Although there are no additional rulings at this time, this case may lead to further interpretation or even changes to the Indiana deceased celebrity personality rights statute. For example, Indiana's statute does not have an explicit clause that protects deceased celebrity personality rights to celebrities who died prior to its enactment in 1994.⁸⁶ Since, each of the baseball legends died prior to 1994, this case would be the first Indiana ruling on the applicability of the statute to celebrities who died prior to the statute's enactment. This ruling could create uncertainty as to the enforceability of exclusive license agreements for deceased celebrity personality rights, similar to the issue in California after the first Monroe decision in 2007.

d. Washington State Law

Prior to the first Monroe decision in California, a federal court in Washington state also applied a domicile test in a case involving Jimi Hendrix. Hendrix died in 1970 in London,⁸⁷ but his estate was probated in New York state.⁸⁸ Leaving no will, Hendrix's estate descended to his sole heir and father, Al Hendrix. Al Hendrix placed all of the rights related to Jimi's legacy in several companies in Seattle ("the Hendrix family companies").⁸⁹ When the senior Hendrix passed away, he left control of the Hendrix family companies to other family members, and nothing to Jimi's brother Leon, save one gold record.⁹⁰ During several unsuccessful court challenges to Al Hendrix's will,⁹¹ Leon started the "Jimi Hendrix Foundation."⁹² The "Jimi Hendrix Foundation" is a nonprofit corporation, which promotes various charitable activities in Washington.⁹³ In 2003 the Hendrix family companies sued the Jimi Hendrix Foundation, alleging unauthorized use of Jimi Hendrix's name, signature and image.⁹⁴

In 2005, the District Court for the Western District of Washington held that no personality rights existed for Jimi Hendrix at the time of his death.⁹⁵ The court reasoned that New York Law should apply because it was the domicile of Jimi Hendrix at the time of his death,⁹⁶ and New York does not recognize personality rights af-

ter death.⁹⁷ Thus, the court held that, similar to Marilyn Monroe, Jimi Hendrix's deceased celebrity personality rights did not survive his death and could not have descended to Al Hendrix. Therefore, the Hendrix family companies never acquired Jimi's deceased celebrity personality rights.⁹⁸ The Hendrix family companies appealed the district court's ruling, and the Court of Appeals for the Ninth Circuit affirmed the decision in 2007.⁹⁹

Shortly after the Hendrix district court decision, a company started selling "HENDRIX ELECTRIC VODKA."¹⁰⁰ In an interview, the CEO of the company claimed, "it's like drinking with Jimi. The drunker you get, the more you think you're with him."¹⁰¹ The Hendrix family companies sued over the use of Jimi Hendrix's name as part of a trademark, and the Ninth Circuit recently found that Hendrix Electric Vodka infringed on the various trademarks of the Hendrix family companies.¹⁰² Since the Hendrix family companies did not acquire Jimi's deceased celebrity personality rights, the defendants argued that the Hendrix family companies were barred from any rights derived from trademarks using the name or likeness of Jimi.¹⁰³ However, the court held that there is a distinct difference between trademarks and personality rights.¹⁰⁴ The court further held that the deceased celebrity personality rights "under state law is not necessary to acquire valid trademark rights under federal law."¹⁰⁵ Therefore, owning a deceased celebrity's personality rights is not required to get a valid trademark based on the deceased celebrity's name or likeness.

i. Strengthened Protection

In April 2008, Washington's legislature strengthened its statutes that protect deceased celebrity personality rights. In particular, the legislature broadened Washington's personality rights statutes "to apply to all . . . [deceased] personalities [i.e. celebrities] . . . regardless of . . . [the] place of domicile at time of death."¹⁰⁶ Additionally, the Washington legislation further clarified that deceased celebrity personality rights existed prior to the enactment of the statute. Therefore, celebrities that died prior to the enactment of the Washington statute could transfer or assign their deceased celebrity personality rights by will or other contractual instrument.¹⁰⁷

ii. Non-Celebrity Protection

Washington's personality rights statute also provides protection for deceased non-celebrities, while many other states do not. Washington protects against the un-

⁸⁶ See Ind. Code §§ 32.36.1.1-20 (2008) (noting that the Indiana statute does not have an explicit clause that personality rights existed for celebrities who died prior to the statute's enactment); *Shaw Family Archives*, 486 F.Supp.at 314.

⁸⁷ BBC News Web site, http://news.bbc.co.uk/onthisday/hi/dates/stories/september/18/newsid_3528000/3528692.stm.

⁸⁸ *Experience Hendrix LLC v. James Marshall Hendrix Foundation*, 2005 WL 6051488, ¶ 2 (W.D. Wash. 2005).

⁸⁹ *Id.* at *2-3.

⁹⁰ *In re Estate of Hendrix*, 2006 Wash. App. LEXIS 1526, *1 (2006).

⁹¹ *Id.*

⁹² See *Experience Hendrix LLC v. James Marshall Hendrix Foundation*, 2005 U.S. LEXIS 27533, * 4-5 (W.D. Wash. 2005).

⁹³ *Experience Hendrix*, 2005 U.S. LEXIS at *4-5.

⁹⁴ *Id.*

⁹⁵ *Experience Hendrix LLC v. James Marshall Hendrix Foundation*, 2005 WL 6051488, *13 (W.D. Wash. 2005).

⁹⁶ *Id.* at *1.

⁹⁷ *Id.* at *10-11.

⁹⁸ *Id.* at *13.

⁹⁹ *Experience Hendrix LLC v. James Marshall Hendrix Foundation*, 240 Fed. Appx. 739, 740 (9th Cir. 2007).

¹⁰⁰ See http://news.findlaw.com/andrews/bt/int/20070322/20070322_hendrix.html.

¹⁰¹ James Verini, *Pouring In a Purple Haze*, Los Angeles Times (Mar. 31, 2006) ([available at](http://articles.latimes.com/2006/mar/31/entertainment/et-smallhours31) <http://articles.latimes.com/2006/mar/31/entertainment/et-smallhours31>).

¹⁰² *Experience Hendrix LLC v. Electric Hendrix LLC*, No. C-07-0338, 2008 WL 3243896, at *2-6 (W.D. Wash. Aug. 7, 2008).

¹⁰³ *Id.* at *7-8.

¹⁰⁴ *Id.* at *7.

¹⁰⁵ *Id.* at *8.

¹⁰⁶ Wash. Rev. Code § 63.60.010.

¹⁰⁷ *Id.*

authorized use of a non-celebrity's name, image, likeness, voice, and signature.¹⁰⁸ The protection provided to these deceased non-celebrity personality rights is the same protection as that afforded to deceased celebrity personality rights.¹⁰⁹ However, deceased non-celebrity personality rights are only protected for a term of ten years after death.¹¹⁰ In contrast, California and New York do not protect deceased non-celebrity personality rights.¹¹¹

IV. Value of Deceased Celebrity Personality Rights v. Inheritance Taxes

In general, the estate of a celebrity can often choose from more than one state for probating the will. Since many celebrities frequently split their time between homes in multiple states, the estate typically chooses to declare the celebrity's domicile in one of those states. Often, the decision to choose a particular state as the domicile is influenced by the inheritance tax rates and benefits for doing so.¹¹²

Inheritance tax rates and benefits can greatly vary from state to state. For example, when Marilyn Monroe died, New York's inheritance tax rates and benefits were significantly lower than those in California.¹¹³ And it appears that the higher inheritance tax rates in California were most likely the reason that Monroe's estate chose New York as her legal domicile at the time of her death.¹¹⁴ Although the choice by Monroe's estate of New York as her domicile lessened the inheritance tax liability, that choice is now preventing the enforcement of her deceased celebrity personality rights in California, and thus resulting in the potential loss of millions of dollars in licensing revenue.

An executor of a celebrity estate faces a difficult choice in deciding what state to choose as the legal domicile at the time of the celebrity's death. Inheritance tax rates in a particular state are definable but the future value of a deceased celebrity's personality rights

¹⁰⁸ Wash. Rev. Code §§ 63.60.020(1), 63.60.040(1) (2008) (noting that a non-celebrity is a person whose name, voice, signature, photograph, or likeness had no commercial value at the time of his or her death).

¹⁰⁹ Wash. Rev. Code § 63.60.040(1).

¹¹⁰ *Id.*

¹¹¹ See Cal. Civ. Code § 3344.1(h) (noting that the statute only protects "any natural person whose name, voice, signature, photograph, or likeness has commercial value at the time of his or her death"); N.Y. Civ. Rights Law §§ 50, 51 (noting the statute does not provide protection for any personality rights after a celebrity's death).

¹¹² Some states might assess inheritance tax on the real property and tangible personal property of a non-domicile person, where such property is located in that particular state. See *Milton H. Greene Archives*, 2008 WL at *25.

¹¹³ See *Id.* at *27, n.92.

¹¹⁴ *Id.* (noting that "in arguing in the inheritance tax proceeding that Monroe was domiciled in New York, therefore, [the estate] was clearly acting to preserve and protect the assets transferred to [the beneficiaries].").

are less so. In the past, the financial advantage in lessening the inheritance tax burden was often the primary consideration in choosing the legal domicile of a deceased celebrity. However, the future value and ability to protect deceased celebrity personality rights is now a significant consideration too.

V. Preferred Jurisdiction for Protecting Deceased Celebrity Personality Rights

New York state is not an attractive jurisdiction for protecting deceased celebrity personality rights. Since New York treats personality rights as privacy rights, all personality rights of a celebrity expire at their death. However, New York does provide limited protection for the name of deceased celebrities as a trademark. But, this limited protection does not protect all uses of deceased celebrity personality rights.

Indiana might be a preferred jurisdiction because of the long term of protection it provides to deceased celebrity personality rights, i.e., 100 years of protection which is the longest statutory term available. However, cases brought in Indiana have had a history of being transferred, which can require other states to apply a domicile test, such as New York and California. Also, Indiana's statute does not explicitly protect deceased celebrity personality rights of those celebrities that died prior to its enactment, and it is unclear how Indiana courts will rule on such an issue.

California could also be a preferred jurisdiction if the celebrity was domiciled at their death in a state that protected deceased celebrity personality rights. Since California applies a domicile test, the laws in the state where the celebrity was domiciled at the time of their death determines the amount of protection for deceased celebrity personality rights. Therefore, depending on the legal domicile of the celebrity at their death, the celebrity's estate could lose protection for the deceased celebrity's personality rights.

Currently, Washington's deceased celebrity personality rights statute addresses all of the known issues and problems regarding the protection for deceased celebrity personality rights. Washington's law protects all celebrities regardless of what state they were domiciled in at the time of their death. Additionally, Washington's statute explicitly protects the rights of celebrities who died prior to the statute's enactment.

At this time, Washington state appears to be the best jurisdiction for protecting deceased celebrity personality rights. Washington state's deceased celebrity personality rights statutes provide several advantages: (1) it protects celebrities and non-celebrities regardless of their domicile at the time of their death, (2) it protects celebrities that have been dead for over sixty years, (3) it provides the second longest statutory term of protection (75 years), and (4) registration of the interest in deceased celebrity personality rights is not required. Therefore, Washington is likely to provide best protection for deceased celebrity personality rights.