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How the Guernsey Image Rights Ordinance interacts with the US doctrine of preemption?
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Abstract: How does the Guernsey Image Rights Ordinance interact with the US doctrine of preemption? When a state law threatens to encroach on a federal law, such as the Copyright Act, the court must consider whether the federal law preempts the state law claim. Guernsey image rights involve the commercial protection and exploitation of a person's identity and associated images linked to that person, in a similar manner to the right of publicity. Generally, courts have found that a persona does not fall within the subject matter of copyright. The "work" that is the subject of the right of publicity is the persona, i.e., the name and likeness of a celebrity or other individual. A persona can hardly be said to constitute a "writing" of an "author" within the meaning of the Copyright Act. Nonetheless, a right of publicity claim (either statutory or under the common law) fails if it is too similar to a copyright claim; in such a case, the state right-of-publicity law is preempted by federal copyright law. By registering a Guernsey Image Right, the distinction between a copyright claim and a publicity claim will become more distinct.

I. Introduction

How does the Guernsey Image Rights Ordinance interact with the US doctrine of preemption? In the United States there are few issues of legal balance more important that the balance between federal and state powers. When a state law threatens to encroach on a federal law, such as the Copyright Act, the court must consider whether the federal law preempts the state law claim. Nevertheless, an Illinois state appellate court held on August 2, 2007 that the right of publicity claims of James Brown's alleged representatives were not preempted by the United States Copyright Act.[1] The great majority of courts have held that there is no copyright preemption of the right of publicity.[2] Restatement 3rd, *Unfair Competition*, states that "claims for infringement of the right of publicity are thus not generally preempted by federal law."[3]

The Image Rights (Bailiwick of Guernsey) Ordinance (IRO) establishes a new and registrable form of intellectual property similar to a publicity right. Two key concepts anchor the legislation: (1) the "registered personality", and (2) "images" which are associated with or registered against that registered personality. The core right is the registered personality. According to s.2(1) IRO, "A registered personality is a property right obtained by the registration of a personality in the Register in accordance with the provisions of this Ordinance". "Personality" refers to the personality of the following types of person or subject, which is described in the Image Rights Ordinance as the "personnage". Section 1(1) IRO describes a "personnage" as follows:

(a) a natural person,
(a) a legal person,
(b) two or more natural persons or legal persons who are or who are publicly perceived to be intrinsically linked and who together have a joint personality ('joint personality'),
(c) two or more natural persons or legal persons who are or who are publicly perceived to be linked in common purpose and who together form a collective group or team ('group'), or (e) a fictional character of a human or non-human ('fictional character'), whose personality—
  (i) is registered under this Ordinance (and is accordingly a 'registered personality' for the purposes of this Ordinance), or
  (ii) is the subject of an application to be so registered.

"Image rights" are defined in s 5(1) IRO as "exclusive rights in the images associated with or registered against the registered personality". Section 3(1) IRO defines "image" as:

a. the name of a personnage or any other name by which a personnage is known,
b. the voice, signature, likeness, appearance, silhouette, feature, face, expressions (verbal or facial),gestures, mannerisms, and any other distinctive characteristic or personal attribute of a personnage, or

[1] *James Brown v. ACMI Pop Division*, No. 1-06-0870 (Ill. Ct. App. 4th Div.)
[2] *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977)
[3] Restatement 3rd, *Unfair Competition*, Section 46, Comment i (1995)

c. any photograph, illustration, image, picture, moving image or electronic or other representation('picture') of a personnage and of no other person, except to the extent that the other person is not identified or singled out in or in connection with the use of the picture.

II. The Elements of Right of Publicity

Image rights involve the commercial appropriation or exploitation of a person's identity and associated images linked to that person, in a similar manner to the right of publicity. They are related to the distinctive expressions, characteristics or attributes of, or associated with, a personality made available to public perception. Image rights are an integral part of artistic expression and a product of celebrity or sporting achievement in the 21st century. The value of image rights is such that they are already being actively managed and traded, despite the lack of clear legal recognition and the lack of clarity as to the extent of the rights. Likewise, the Restatement 3rd, *Unfair Competition*, Section 46, provides as follows: one who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability for the relief appropriate.[4] This right of publicity is based upon common and state statutory law.[5]

For example, California protects publicity rights by statute and common law. Generally speaking, the Right of Publicity in California protects against unauthorized uses of a person's name or likeness for commercial and certain other exploitative purposes.

A. What the Statutory Right of Publicity Protects

California's statute, Cal. Civ. Code § 3344, protects a person's:

- name,
- voice,
- signature,
- photograph, and
- likeness.

The term "voice" applies only to a person's actual voice, not to imitations.[6] However, the common law right of publicity might apply to voice imitators. The term "photograph" includes still or moving pictures, but the person in question must be "readily identifiable" (meaning someone could "reasonably determine" that the photo depicts the plaintiff). However, pictures of crowds, such as on public streets or at sporting events, do not run afoul of the statute as long as no people are "singled out as individuals" in the photo.[7] The term "likeness" is the most difficult of the five protected categories to precisely define. Courts have used the "readily identifiable" test to conclude that drawings, if sufficiently detailed, can constitute a "likeness."[8] In another case, the court ruled that a robot, if sufficiently detailed, could be a "likeness."[9] Less detailed robots, though, may fall short of the "likeness" mark.[10]

California's statute protects against uses of a person's likeness for advertising purposes. Specifically, the statute prohibits "knowing" use of a person's name/likeness, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent.[11] The mere fact that a person's likeness is used in connection with a commercial product or service does not violate the statute. Rather, the statute focuses specifically on advertising uses of a person's likeness: "[I]t shall be a question of fact whether or not the use of the person's name, voice, signature, photograph, or likeness was so directly connected with the commercial sponsorship or with the paid

[4] As set forth in other sections of this Restatement, which provide for injunctive relief and recovery of the value of the appropriation.
[5] The various legislatures and courts have varied in their interpretations of the scope of this right. Only about half the states recognize the right of publicity, although some which do not recognize may protect under their right of privacy or unfair competition laws.
[6] *Midler v. Ford*, 849 F.2d 460, 463 (9th Cir. 1988)
[7] Cal. Civ. Code §3344(b)(3)
[8] *Newcombe v. Adolf Coors Co.*, 157 F.3d 686, 692-93 (9th Cir. 1998)
[9] *Wendt v. Host Intern., Inc.*, 125 F.3d 806, 810 (9th Cir. 1997)
[10] *White v. Samsung*, 971 F.2d 1395, 1397 (9th Cir. 1992)
[11] Cal. Civ. Code § 3344(a)

advertising as to constitute a use for which consent is required."[12] Courts have thus interpreted the statute to impose a three-step test:

1. Was there a "knowing" use of the plaintiff's protected identity?
2. Was the use for advertising purposes?
3. Was there a direct connection between the use and the commercial purpose?[13]

If the answer to all three questions is "yes," then there has been a violation of the statute. The statute also contains an explicit exception for uses "in connection with any news, public affairs, or sports broadcast or account, or any political campaign."[14]

B. The Common Law Right

Courts generally describe California's common-law right as a four-step test, in which a plaintiff must allege:

1. The defendant's use of plaintiff's "identity";
2. The appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise;
3. Lack of consent; and
4. Resulting injury.[15]

Though the second prong of the standard four-step test mentions "name or likeness," courts held that the common law right is actually much broader: the focus instead is on the term "identity."[16] Courts have interpreted "identity" broadly, covering more uses than does the statutory right of publicity. For example, imitating someone's voice is not a violation of the statute, but it may violate the common law right.[17] A picture of a distinctly-decorated race car can be a common-law violation, even if the driver himself is not visible.[18] A robot can constitute a common-law violation, even if not sufficiently detailed to violate the statute.[19]

A right of publicity claim (either statutory or under the common law) fails if it is too similar to a copyright claim; in such a case, the state right-of-publicity law is preempted by federal copyright law. For example, in *Laws v. Sony Music*, Sony licensed one of the plaintiff's songs and sampled it in a new recording. The plaintiff tried to bring a right of publicity claim, but the court ruled that Sony's use of a licensed recording fell under copyright law, thus preempting the state claim.[20] Generally speaking, if the allegedly-infringing use of a person's identity primarily involves use of copyrighted work, there is a chance that the state-law claim will be preempted.

III. Preemption Doctrine

Federal preemption begins with the Constitution's Supremacy Clause, which provides that "[t]his Constitution, and the Laws of the United States which shall be made in pursuance thereof… shall be the supreme law of the land; and the judges in every state shall be bound thereby, anything in the constitution or laws of any state to the contrary notwithstanding."[21]

Federal laws and regulations may preempt state laws in three ways. The first is through express preemption, where the federal law or regulation explicitly states that it preempts state or local regulation. The second is field preemption, which arises when there is a conflict between the state and federal regulation or where attempting to comply with both federal and state laws would create a conflict. The third means of preemption is implied preemption where it can be inferred from the language of the federal law that state law is preempted. State law should be deemed preempted by federal law in any of these scenarios.

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[12] Cal. Civ. Code § 3344(e)
[13] *Newcombe v. Adolf Coors Co*., 157 F.3d 686, 692 (9th Cir. 1998)
[14] Cal. Civ. Code §3344(d)
[15] *White v. Samsung*, 971 F.2d 1395, 1397 (9th Cir. 1992)
[16] *Abdul-Jabbar v. General Motors*, 85 F.3d 407, 413-14 (9th Cir. 1996)
[17] *Waits v. Frito-Lay*, 978 F.2d 1093, 1098-1100 (9th Cir. 1992)
[18] *Motschenbacher v. R.J. Reynolds Tobacco*, 498 F.2d 821, 827 (9th Cir. 1974)
[19] *White v. Samsung*, 971 F.2d 1395, 1397-99 (9th Cir. 1992)
[20] 294 F.Supp.2d 1160 (C.D. Cal. 2003)
[21] U.S. Constitution, Article VI, cl.2

The Copyright Act does not protect an individual's persona, but rather "works of authorship;" therefore the Federal Copyright Act may not preempt state-based claims that address only persona and do not attempt to limit or control "works of authorship" that incorporate the subject persona. However, state-based claims cannot be the "equivalent" of copyright infringement claims, or they will be preempted. The Sixth Circuit Court of Appeals has held that the Copyright Act "expressly withdraws from the state courts any jurisdiction to enforce the provisions of the Act and converts all state common or statutory law 'within the general scope of copyright' into federal law to be uniformly applied throughout the nation."[22] Moreover, "a claim asserted to prevent nothing more than the reproduction, performance, distribution, or display of a dramatic performance captured on film is subsumed by copyright law and preempted."[23]

A. Express Preemption

Section 301 of the Copyright Act expressly addresses copyright preemption, and provides:

> "On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State."[24]

Section 106 provides copyright holders with the exclusive rights to reproduction, adaptation, publication, performance and display. Section 301(f)(1) expands the preemption right to apply to the rights of attribution and integrity which includes the following rights:

1. to claim authorship of that work;
2. to prevent the use of his or her name as the author of any work of visual art which he or she did not create;
3. to prevent the use of his or her name as the author of the work of visual art in the event of a distortion, mutilation, or other modification of the work which would be prejudicial to his or her honor or reputation;
4. to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation, or modification of that work is a violation of that right; and
5. to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right.[25]

State laws which purport to expand or decrease these exclusive rights would be preempted by the Copyright Act, according to Section 301. A finding of copyright preemption means that a claim must be brought under the Copyright Act or not at all. If copyright preemption does not apply, the plaintiff can bring a state law claim (as well as a Copyright Act claim).

To avoid a preemption claim, state law (whether common law or statutory) must regulate conduct other than that associated with those exclusive rights provided by the Copyright Act. The language of Section 301 creates a two-part test for determining preemption: (1) whether the work is within the subject matter of the Copyright Act; and (2) whether the state law creates rights equivalent to those exclusive rights protected by the Copyright Act.[26]

For example, the Court in *Fleet v. CBS* considered the issue of whether actors in a motion picture may bring an action for misappropriation of their name, image, likeness, or identity under the California right of publicity

[22] *Ritchie v. Williams, 395* F.3d 283, 285-86 (6th Cir. 2005)
[23] *Fleet* v *CBS, Inc., 50* Cal. App. 4th 1911, 1924 (Cal Ct. App. 1996)
[24] 17 U.S.C. § 103(a)
[25] Enumerated in 17 U.S.C. § 106A
[26] *Briarpatch Ltd., L.P. v. Phoenix Pictures, Inc*., 373 F.3d 296, 308 (2d Cir. 2004)

statute when the alleged exploitation occurred through the distribution of the actors' performance in a motion picture.[27] The *Fleet* court held that "a claim asserted to prevent nothing more than the reproduction, performance, distribution, or display of a dramatic performance captured on film is subsumed by copyright law and preempted." [28] Pursuant to federal copyright law, CBS owned the copyright in the motion picture that included the plaintiffs' performance.[29] The *Fleet* court held that "for preemption to occur under the Act, two conditions must be met: first the subject of the claim must be a work fixed in a tangible medium of expression and come within the subject matter or scope of copyright protection. . . and second, the right under state law must be equivalent to the exclusive rights contained in section 106."[30] With regard to the first factor, the court quickly concluded that plaintiffs' performances were dramatic works fixed in a tangible medium of expression, and therefore, came within the scope of copyright law.[31] With regard to the second factor, the court noted that the plaintiffs sought to "protect the physical images of their performances captured on film in the subject motion picture and no others."[32] The court reasoned that plaintiffs "may choose to call their claims misappropriation of right to publicity, but if all they are seeking is to prevent a party from exhibiting a copyrighted work they are making a claim 'equivalent to an exclusive right within the general scope of copyright."[33] Based on the above, the court held that a "claim asserted to prevent nothing more than the reproduction, performance, distribution, or display of a dramatic performance captured on film is subsumed by copyright law and preempted."[34]

Many courts do not focus on the first part of this two-prong test because whether a work falls under copyright subject matter is not in dispute.[35] When considering the second step of the preemption analysis, courts have developed tests to determine whether the rights at issue "are equivalent to" one of the copyright owner's exclusive rights, and whether the state law cause of action is, in fact, "qualitatively different" from a claim of copyright infringement. If a qualitative difference is not demonstrated, the state law claim will be preempted.[36] A further test is sometime required as the court wrote in *Giordano v. Claudio*, "[i]f a state law cause of action 'requires an extra element' in addition to or instead of an act of reproduction, performance, distribution or display that would be prohibited under the Copyright Act, there is no preemption of the state cause of action, provided the 'extra element' changes the nature of the action so that it is qualitatively different from a copyright infringement claim."[37] In addition, this " 'extra element' must be more than just an intent or state-of-mind requirement: it must be an extra substantive element that has independent analytical content, beyond mere violation of one or more of the rights of a copyright holder specified in Section 106."[38]

Express preemption and the extra element test apply only when the "exclusive rights" of copyright holders are at issue.[39] If those "exclusive rights" are not at issue, general preemption law must be applied.[40]

2. Field Preemption

Field preemption, or implicit preemption, occurs where "[t]he scheme of federal regulation [is] so pervasive as to make reasonable the inference that Congress left no room for the States to supplement it."[41] In this situation, "the federal interest is so dominant that the federal system will be assumed to preclude enforcement of state laws on the same subject."[42] In the context of the Copyright Act the argument could be made that if

[27] 50 Cal App 4th 1911 (Cal Ct App 1996)
[28] Ibid at 1924
[29] Ibid at 1916 - 17
[30] Ibid at 1919
[31] Ibid
[32] Ibid at 1920
[33] Ibid
[34] Ibid at 1924
[35] *Landham v Lewis Galoob Toys, Inc.,* 227 F.3d 619 (6th Cir. 2000)
[36] See, e.g., *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1143-45 (9th Cir. 2006) (right of publicity claim preempted), cert. denied, 127 S. Ct. 1371 (2007); *Briarpatch,* 373 F.3d at 305-06 (unjust enrichment claim preempted); *Del Madera Props. v. Rhodes & Gardner, Inc.*, 820 F.2d 973, 977 (9th Cir. 1987) (misappropriation claim preempted).
[37] No. 09-1456, 2010 U.S. Dist. LEXIS 48148 (E.D. Pa. May 14, 2010)
[38] *Harper & Row, Publishers v. Nation Enterprises*, 723 F.2d 195, 200 (2d Cir. 1983), rev'd on other grounds 471 U.S. 539 (1985)
[39] *Computer Assoc. Int'l, Inc. v. Altai, Inc.,*982 F.2d 693, 716 (2d Cir. 1992)
[40] *Foley v. Luster*, 249 F.3d 1281, 1286 (11th Cir. 2001)
[41] *Rice v. Santa Fe Elevator Corp.*, 331 U.S. 218, 230, 67 S.Ct. 1146, 1152, 91 L.Ed. 1447 (1946)
[42] Ibid

any type of copyright claim were brought under state laws, the suit would be preempted under the theory of field preemption. There is no need to infer intent from statutory language. The intent is clearly and explicitly stated in the Copyright Act and legislative history.

3. Conflict Preemption

A state law claim may also be preempted under the theory of conflict preemption, which provides that state laws that create obstacles to the purposes and objectives of the Copyright Act are preempted. Conflict preemption "arises when compliance with both federal and state regulations is a physical impossibility, or where state law stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress."[43] The first type of conflict, physical impossibility, does not apply to copyright rights, precisely because they are rights, not obligations, and the registrant could choose to not take advantage of those rights in order to comply with state regulations. The second type of conflict, where the state law is an obstacle to the accomplishment and execution of the full purpose and objectives of Congress, may apply to copyright law.

The Constitution and case law clearly state the purpose of the Copyright Act. Congressional intent is enumerated in the Copyright Clause of the Constitution as "the Power… to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[44] The Supreme Court has further explained that there is both a private and public purpose for the Copyright Act. "The immediate effect of our copyright law is to secure a fair return for an 'author's' creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good."[45] Another purpose of copyright law may be "to protect copyright holders in a comprehensive and uniform way."[46] When a state law is an obstacle to any of these purposes, that state law would be preempted under the theory of conflict preemption.

IV. Comparing the Copyright Interest to the Publicity Interest

The Copyright Act confers the right to reproduce, distribute, make derivatives, publicly perform, and publicly display works of authorship. "Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following: (1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending; (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audio-visual works, to perform the copyrighted work publicly; (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audio-visual work, to display the copyrighted work publicly; and (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission."[47]

The Library of Congress draws distinctions among copyright, right of publicity and right of privacy:

> "While copyright protects the copyright holder's **property rights in the work** or intellectual creation, privacy and publicity rights **protect the interests of the person(s)** who may be the subject(s) of the work or intellectual creation. Issues pertaining to privacy and publicity may arise when a researcher contemplates the use of letters, diary entries, photographs or reportage in visual, audio, and print formats found in library collections. Because two or more people are often involved in the work (e.g., photographer and subject, interviewer and interviewee) and because of the ease with which various media in digital format can be reused, photographs, audio files, and motion pictures represent materials in which issues of privacy and publicity emerge with some frequency."[48]

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[43] *Pacific Gas and Elec. Co. v. State Energy Res. Conservation and Dev. Comm'n,* 461 U.S. 190, 204, 103 S.Ct. 1713, 1722, 75 L.Ed.2d 752 (1983)
[44] U.S. Constitution, Article VI, cl.2
[45] *Twentieth Century Music v. Aiken*, 422 US 151, 156 (1975).
[46] *Foley* at 1286
[47] 17 U.S.C. § 106
[48] See, http://www.loc.gov/homepge/legal.html (emphasis added)

The distinctions among privacy rights publicity rights, and copyright are best illustrated by example. In *Brown v Ames*, a group of musicians sued a record company for copyright infringement and misappropriation of their names and likenesses in the unauthorized promotion of their songs.[49] The defendants adopted the position that the misappropriation claims were preempted by the Copyright Act and should therefore be dismissed. The court held that because the plaintiffs' claims were directed to their name and likeness and not to the copyrightable songs themselves, the plaintiffs' state law claims were not copyright-based claims. The Fifth Circuit explained that the tort of misappropriation, which provides protection from the unauthorized appropriation of one's name, image or likeness, is "best understood as a species of the right of publicity or of privacy."[50] Relying upon the Restatement (Second) of Torts § 652C definition of "misappropriation" as protecting "the interest of the individual in the exclusive use of his own identity, in so far as it is represented by his name or his likeness, and in so far as the use may be of benefit to him or to others," the Court found that the tort protects a person's persona.[51]

Quoting *Nimmer on Copyright*, the Court ruled that a persona does not fall within the subject matter of copyright. Further, the plaintiffs' names and likenesses did not become copyrightable simply because they were used to identify the source of a copyrightable work.[52] Professor Nimmer observed that although the personal traits of the performer are embodied in copyrightable works such as photographs and videos, said traits do not automatically become a "work of authorship" subject to the Copyright Act. The "work" that is the subject of the right of publicity is the persona, i.e., the name and likeness of a celebrity or other individual. A persona can hardly be said to constitute a "writing" of an "author" within the meaning of the Copyright Clause of the Constitution. Therefore, it is not a "work of authorship" under the Act. Such name and likeness do not become a work of authorship simply because they are embodied in a copyrightable work such as a photograph.[53]

The Court further relied upon the decision in *Fleet* noting that *"Fleet*[54]*,* like *Daboub*[55], involved a claim of misappropriation of something - in *Fleet,* dramatic performances; in *Daboub,* songs - within the subject matter of copyright."[56] The *Brown* court concluded that that case "in contrast, involves a claim of misappropriation of name and/or likeness, which is not within the subject matter of copyright."[57] Therefore, the misappropriation claims did not fit the terms of a §301 preemption.

The *Landham* court followed this reasoning when an actor who appeared in the movie "Predator" claimed that the unauthorized marketing by the defendant toy manufacturer and defendant movie company of an action figure toy based on his character in the movie violated the actor's right to publicity. The actor never executed an assignment of merchandising rights in his character to the movie company.[58] The defendants argued that the actor's claim was preempted merely because it involved a copyrighted work - in that case, the movie "Predator". No copyright in the action figure was at issue. The plaintiff's claims were directed to the action figure alone and not to the movie. Based on these distinguishing facts, the court found preemption lacking because the plaintiff was "not claiming the right of publicity in order to gain rights in the telecast of his performance, or to contest Fox's [defendant's] rights to create derivative works from its copyrighted work in general."[59] Instead, the Sixth Circuit concluded that Landham alleged "that the toy evokes his personal identity -- an inchoate 'idea' which is not amenable to copyright protection...."[60]

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[49] 201 F.3d 654 (5th Cir. 2000)
[50] Ibid
[51] Ibid
[52] Ibid
[53] Melville B. Nimmer & David Nimmer, Nimmer on Copyright, § 1.0l[BJ][1][c] (citations omitted)
[54] *Fleet v CBS, Inc*., 50 Cal App 4th 1911 (Cal Ct App 1996)
[55] *Daboub v. Gibbons*, 42 F.3d 285 (5th Cir. 1995)
[56] *Brown,* 201 F.3d at 658
[57] Ibid
[58] *Landham v. Lewis Galoob Toys, Inc.,* 227 F.3d 619 (6th Cir. 2000)
[59] Ibid
[60] Ibid

In *Downing v. Abercrombie & Fitch*, the Ninth Circuit held that misappropriation claims did not involve rights that fell within the subject matter of copyright, and thus were not preempted.[61] In that case, the plaintiffs were surfers who won a surfing competition in 1965. A photographer who had taken a picture of the competition winners in 1965 sold the photograph in 1998 to an employee of Abercrombie & Fitch ("Abercrombie"), an upscale retailer that caters to young people. The photograph was used in an Abercrombie & Fitch catalogue that had a surfing theme. The plaintiffs sued Abercrombie, alleging, among other claims that the defendant misappropriated their names and likenesses in violation of California's statutory and common law protections against commercial misappropriation. On summary judgment motion, Abercrombie contended that its right to reproduce and publish the photograph of the surfers was governed by the federal Copyright Act, so that the plaintiffs' state law claims were preempted by federal copyright law. The Ninth Circuit first noted the two-part test for preemption. In addressing one prong of the test, that the content of the protected right must fall within the subject matter of copyright as described in the Copyright Act, the Court quoted the following portion of the Act: "Copyright protection subsists…in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include pictorial, graphic, and sculptural works."[62]

Thus, the photograph itself, as a "pictorial work of authorship," is subject matter which is protected by the Copyright Act.[63] However, the Court ruled that it was not the publication of the photograph itself, as a creative work of authorship that was the basis for the plaintiff's claims. Rather, the claims were based upon the use of their likenesses and their names pictured in the published photograph.

V. Conclusion

So, how does the Guernsey Image Rights Ordinance interact with the US doctrine of preemption? As seen above, when a state law threatens to encroach on a federal law, such as the Copyright Act, the court must consider whether the federal law preempts the state law claim. Guernsey image rights involve the commercial protection and exploitation of a person's identity and associated images linked to that person, in a similar manner to the right of publicity. Generally, courts have found that a persona does not fall within the subject matter of copyright. A celebrity's name and likeness does not become copyrightable simply because they were used to identify the source of a copyrightable work. These personal traits of the performer may be embodied in copyrightable works such as photographs and videos, but said traits do not automatically become a "work of authorship" subject to the Copyright Act. The "work" that is the subject of the right of publicity is the persona, i.e., the name and likeness of a celebrity or other individual. A persona can hardly be said to constitute a "writing" of an "author" within the meaning of the Copyright Clause of the Constitution. Therefore, it is not a "work of authorship" under the Act.

Nonetheless, a right of publicity claim (either statutory or under the common law) fails if it is too similar to a copyright claim; in such a case, the state right-of-publicity law is preempted by federal copyright law. By registering a Guernsey Image Right, the distinction between a copyright claim and a publicity claim will become more distinct.

Hitherto, there has been no means for the legal registration of personality and image rights anywhere. The ability to publicly assert, exploit and protect image rights has instead depended on the use of a number of laws that seek to protect specific types of intellectual property, but where none are specifically designed for protecting such rights. In contrast to the existing legal concepts, 'personality' has now become a *property* right – i.e. not just something that happens to a person, but something that can be commercially exploited by, but also stolen from, a person. The Image Rights Ordinance of Guersey provides a legal framework which protects both economic and dignitary interests, without having to sacrifice one for the other.

[61] 265 F.3d 994 (9th Cir. 2001)
[62] Ibid, quoting, 17 U.S.C. § 102
[63] See, 17 U.S.C. § 101 providing that "pictorial, graphic, and sculptural works include…photographs"

This note is only intended to give a brief summary and general overview of this area of law. It is not intended to be, nor does it constitute, legal advice and should not be relied upon as doing so.

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