

# Casenotes

## LIKE A CANDLE IN THE WIND: *SHAW FAMILY ARCHIVES, LTD. V. CMG WORLDWIDE, INC.* AND THE FLICKERING RECOGNITION OF MARILYN MONROE'S RIGHT OF PUBLICITY IN NEW YORK

### I. INTRODUCTION

Every year, *Forbes Magazine* lists the highest-earning deceased celebrities.<sup>1</sup> In 2007, the top thirteen now-gone actors, authors, and musicians earned a combined \$232 million from the distribution of their works and the licensing of their likenesses.<sup>2</sup> Not surprisingly, the iconic American sex symbol Marilyn Monroe is a perennial member of this elite list.<sup>3</sup> Forty-six years after her death, the great demand for Monroe's persona earned her estate \$7 mil-

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1. See generally Lea Goldman & Jake Paine, *Top-Earning Dead Celebrities*, FORBES, Oct. 29, 2007, [http://www.forbes.com/2007/10/29/dead-celebrity-earning-biz-media-deadcelebs07\\_cz\\_lg\\_1029celeb\\_land.html](http://www.forbes.com/2007/10/29/dead-celebrity-earning-biz-media-deadcelebs07_cz_lg_1029celeb_land.html) (describing top-earning celebrity list criteria).

2. See *id.* (reporting total income from top-earning estates). The highest earning estate was that of celebrated entertainer Elvis Presley, which generated \$49 million from licensing agreements and increased attendance at Graceland, the artist's former home, during the thirty-year anniversary of his death. See *id.* Musician Bob Marley and actor James Dean represented the low-end earners of these thirteen with their estates making \$4 million and \$3.5 million, respectively, from the licensing of their various works and likenesses. See *id.*

3. See *id.* (ranking Monroe ninth on list, earning \$7 million in 2007); see also Lacey Rose, et al., *Top-Earning Dead Celebrities*, FORBES, Oct. 23 2006, [http://www.forbes.com/2006/10/23/tech-media\\_06deadcelebs\\_cx\\_pk\\_top-earning-dead-celebrities\\_land.html](http://www.forbes.com/2006/10/23/tech-media_06deadcelebs_cx_pk_top-earning-dead-celebrities_land.html) (ranking Monroe ninth in 2006, earning \$8 million); Leah Hoffman, et al., *Top-Earning Dead Celebrities*, FORBES, Oct. 25, 2005, [http://www.forbes.com/2005/10/26/dead-celebrities-earnings\\_cx\\_pk\\_lh\\_deadceleb05\\_1027list\\_7.html](http://www.forbes.com/2005/10/26/dead-celebrities-earnings_cx_pk_lh_deadceleb05_1027list_7.html) (ranking Monroe seventh, earning \$8 million in 2005); Lisa DiCarlo, et al., *Top-Earning Dead Celebrities*, FORBES, Oct. 26, 2004, [http://www.forbes.com/2004/10/25/cx\\_2004deadcelebtars\\_6.html](http://www.forbes.com/2004/10/25/cx_2004deadcelebtars_6.html) (placing Monroe sixth on list, earning \$8 million in 2004); Lisa DiCarlo, ed., *Top-Earning Dead Celebrities*, FORBES, Oct. 24, 2003, [http://www.forbes.com/2003/10/23/cx\\_ld\\_deadcelebtar\\_10.html](http://www.forbes.com/2003/10/23/cx_ld_deadcelebtar_10.html) (ranking Monroe tenth in 2003, earning \$8 million); Betsy Schiffman, ed., *Top-Earning Dead Celebrities*, FORBES, Aug. 12, 2002, <http://www.forbes.com/lists/2002/08/12/0812deadintro.html> (placing Monroe eleventh, earning \$7 million in 2002); Mei Fong & Debra Lau, *Earnings From The Crypt*, FORBES, Feb. 28, 2001, <http://www.forbes.com/2001/02/28/crypt.html> (ranking Monroe twelfth on first reported list of top-earning dead celebrities, earning \$4 million in 2001); *Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.*, 486 F. Supp. 2d 309, 312 (S.D.N.Y. 2007) (discussing Monroe's icon status). The court referred to Monroe as "perhaps the most famous American sex symbol of the twentieth century." *Id.*

lion in 2007, primarily derived from licensing agreements for advertisements and merchandise.<sup>4</sup> A recent battle over licensing infringement may, however, leave Monroe's heirs without control over her likeness.<sup>5</sup>

In *Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.*, the United States District Court for the Southern District of New York found that in 1962, the year Monroe died, New York did not recognize a transferable postmortem right of publicity.<sup>6</sup> Well-settled New York estate law allows testators to devise only the transferable rights they possess at the time of their deaths.<sup>7</sup> Because the court found that the right of publicity did not exist, Monroe did not possess the right when she died; therefore, her will could not have conveyed the right to her heirs.<sup>8</sup> This finding defeated any claim of ownership and thrust Monroe's persona into the public domain, where anyone is free to use it.<sup>9</sup>

This note will explore the existence of a descendible right of publicity in New York State at the time of Monroe's death.<sup>10</sup> Section II will describe the facts and procedural history of *Shaw Family Archives*.<sup>11</sup> Section III will trace the evolution of the right of publicity, including both the tort-based right of privacy and the modern

4. See Goldman & Paine, *supra* note 1 (noting Monroe estate's income in 2007). In recent years, Monroe's estate entered into licensing agreements for advertisements and products bearing Monroe's likeness as well as a new perfume line. See Rose, et al., *supra* note 3 (describing Monroe estate's different sources of income).

5. See *Shaw Family Archives*, 486 F. Supp. 2d at 314 (finding postmortem right of publicity did not exist when Monroe's will was executed). For further discussion of *Shaw Family Archives*, see *infra* notes 101-46 and accompanying text.

6. See *Shaw Family Archives*, 486 F. Supp. 2d at 314 (describing court's ruling). For a further discussion of the court's interpretation of New York law, see *infra* notes 101-46 and accompanying text.

7. See *Shaw Family Archives*, 486 F. Supp. 2d at 315 (discussing New York estate law).

8. See *id.* at 314 (holding that right of publicity did not exist). Monroe could not have possessed the right of publicity at the time of her death, which is required for inheritance under New York law. See *id.* at 315.

9. See *id.* at 320 (granting Shaw Family Archives' cross-motion for summary judgment). The court held that no postmortem right of publicity existed, and therefore Marilyn Monroe LLC could not claim to be predecessors-in-interest to the right. See *id.*

10. See, e.g., *Haelan Labs. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir. 1953) (discussing history of right of publicity and finding common law right of publicity existed in New York in 1953). But see *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 586 (2d Cir. 1990) (determining New York privacy statutes leave no room for common law right of publicity). For a further discussion of the existence of the right of publicity in New York, see *infra* notes 170-218 and accompanying text.

11. For a further discussion of the facts of *Shaw Family Archives*, see *infra* notes 16-29 and accompanying text.

property-based right of publicity.<sup>12</sup> Section IV will evaluate the court's holding that Monroe's estate is not the predecessor-in-interest to her right of publicity.<sup>13</sup> Section V, after thoroughly examining New York law in this field, will evaluate the appropriateness of the court's determination.<sup>14</sup> Finally, Section VI will discuss the effect this decision may have both on New York law and the estates of other legendary American entertainers.<sup>15</sup>

## II. FACTS

The original dispute arose in the state of Indiana from the sale of a t-shirt that bore the photograph of Marilyn Monroe and the maintenance of a website that licensed the photograph.<sup>16</sup> Shaw Family Archives, Ltd. and Bradford Licensing Associates ("SFA") produced the t-shirt and website.<sup>17</sup> Marilyn Monroe, LLC ("MMLLC") and CMG Worldwide, Inc. ("CMG") filed a complaint against SFA in the United States District Court for the Southern District of Indiana, claiming unauthorized use of Monroe's right of publicity.<sup>18</sup> Under Indiana's Right of Publicity Act, one cannot use

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12. For a further discussion of the history of the right of publicity, see *infra* notes 63-81 and accompanying text.

13. For a further discussion of the district court's opinion, see *infra* notes 101-46 and accompanying text.

14. For a further discussion of the right of publicity in New York, see *infra* notes 170-218 and accompanying text.

15. For a further discussion of the impact of *Shaw Family Archives*, see *infra* notes 226-39 and accompanying text.

16. See *Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.*, 486 F. Supp. 2d 309, 313 (S.D.N.Y. 2007) (discussing original dispute). A single t-shirt was sold at a Target store in Indianapolis, Indiana on September 6, 2006 bearing an image of Marilyn Monroe. See *id.* The dispute was also predicated on a website where licenses "for the use of Ms. Monroe's picture, image and likeness on various commercial products" were sold. *Id.*

17. See *id.* at 312-13 (describing "SFA" organizations). Shaw Family Archives, Ltd. is a limited liability company "with its primary place of business in New York." *Id.* at 312. The principals of SFA are the three children of the late Sam Shaw, an accomplished photographer who took many photographs of Monroe during her life. See *id.* at 313. The main assets of the company are the "canonical" images of Marilyn Monroe. *Id.*

18. See *id.* at 310, 312 (describing MMLLC and CMG organizations). MMLLC is a Delaware company formed by Anna Strasberg, the sole heir of Marilyn Monroe's estate, to manage the intellectual property assets of the estate. See *id.*; see also CMG Worldwide - Corporate - Overview, <http://www.cmgworldwide.com/corporate/overview.htm> (last visited May 1, 2008) (outlining corporate location and services). CMG Worldwide notes that it is based in Indianapolis, Indiana and is the business and marketing agent for celebrities including Marilyn Monroe. See *id.* The court referred to the combined defendants as MMLLC, likely because it is the party that claimed ownership over Monroe's likeness.

another's right of publicity — a property right — for commercial purposes without the owner's consent.<sup>19</sup>

MMLLC claimed that Marilyn Monroe's right of publicity transferred to the estate when she died testate on August 5, 1962.<sup>20</sup> MMLLC contended the residuary clause of Monroe's will transferred all property not otherwise described in the will, including the right of publicity.<sup>21</sup> Conversely, SFA claimed the right did not transfer because New York State - her alleged domicile at death and, therefore, controlling jurisdiction on the execution of her will - did not recognize a descendible postmortem right of publicity.<sup>22</sup>

Before being served with the Indiana action, SFA brought a separate suit against MMLLC and CMG in New York seeking a declaratory judgment regarding the existence of Monroe's right of publicity.<sup>23</sup> Eventually, the Indiana and New York causes of action

19. See IND. CODE ANN. § 32-36-1-1 (West 2002) (outlining Indiana publicity rights); see also *id.* §§ 32-36-1-2 -20 (defining and clarifying Indiana statutory protection).

20. See *Shaw Family Archives*, 486 F. Supp. 2d at 313-14 (citing MMLLC's contention). Although the will did not expressly bequeath her right of publicity, the family contended that the residuary clause transferred all property. See *id.*

21. See *id.* at 314 (claiming transfer of publicity rights through residuary clause); *id.* at 312 (tracing transfer of Monroe's right of publicity among parties). MMLLC reported the residuary clause of Marilyn Monroe's will:

SIXTH: All the rest, residue and remainder of my estate, both real and personal of whatsoever nature and whatsoever situate, of which I shall die seized or possessed or to which I shall be in any way entitled, or over which I shall possess any power of appointment by Will at the time of my death, including any lapsed legacies, I give, devise and bequeath as follows:

(a) To MAY REIS the sum of \$40,000 or 25% of the total remainder of my estate, whichever shall be the lesser.

(b) To DR. MARIANNE KRIS 25% of the balance thereof, to be used by her as set forth in ARTICLE FIFTH (d) of this my Last Will and Testament.

(c) To LEE STRASBERG the entire remaining balance.

*Id.* MMLLC contended that the residuary clause transferred the publicity interest, like all other remaining property, to Lee Strasberg at the time of Monroe's death. See *id.* This remainder then transferred to the sole beneficiary of Lee Strasberg's will, his wife Anna Strasberg, upon his death in 1982. See *id.* Anna Strasberg became administratrix of the Monroe estate in 1989 when the original administrator, Monroe's attorney, died. See *id.* Finally, in 2001, Anna Strasberg closed the estate and transferred all assets to MMLLC. See *id.* Thus, MMLLC contends that it controlled Monroe's right to publicity based on the residuary clause of her will. See *id.* at 314.

22. See *id.* at 311-12 (claiming New York State law does not recognize post-mortem right of publicity). SFA further claimed that New York law allows only the transfer of property that the testator controlled at the time of his or her death. See *id.* at 313-14. For a further discussion of the debate over Monroe's domicile at her time of death, see *infra* notes 160-65 and accompanying text.

23. See *Shaw Family Archives*, 486 F. Supp. 2d at 310-11 (reporting lawsuit brought in New York by SFA and others). On April 19, 2005, SFA sought a declara-

were consolidated.<sup>24</sup> Though the consolidated action came before the United States District Court for the Southern District of New York, the court determined that Indiana law applied.<sup>25</sup> On October 25, 2006, MMLLC moved for summary judgment, claiming 100% ownership of properties derived from Monroe's right of publicity under Indiana law.<sup>26</sup> SFA filed a cross-motion for summary judgment claiming that the Indiana publicity statute does not create a new and independent postmortem right of publicity, but merely a way to exercise a pre-existing right.<sup>27</sup> Moreover, SFA claimed that Monroe lacked the testamentary capacity to bequeath her right of publicity because the right was not recognized as a descendible property right at the time of her death.<sup>28</sup> The district court granted

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tory judgment on whether a postmortem right of publicity or right of privacy exists. *See id.* at 310. The suit also sought damages for "certain alleged copyright infringement violations, tortious interference with contractual relations and tortious interference with prospective economic advantage." *Id.* at 310-11.

24. *See id.* at 311 (describing procedural posture of case). On June 3, 2005, MMLLC and CMG filed a motion seeking transfer, dismissal, or a stay of the SFA's New York suit. *See id.* After being served with the Indiana lawsuit, SFA filed a motion for dismissal for lack of personal jurisdiction in Indiana, or in the alternative, a request to transfer the Indiana action to the Southern District of New York. *See id.* The United States District Court for the Southern District of New York ordered a stay on SFA's New York suit pending the determination of personal jurisdiction in the Indiana action. *See id.* On March 23, 2006, the United States District Court for the Southern District of Indiana, pursuant to 28 U.S.C. §1404(a), ordered the Indiana action to be transferred to the Southern District of New York. *See id.* The Southern District of New York then lifted the stay on SFA's New York suit on March 27, 2006, and consolidated the matters on May 2, 2006. *See id.*

25. *See Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.*, 434 F. Supp. 2d 203, 210 (S.D.N.Y. 2006) (memorandum decision regarding choice of law) (finding Indiana law applicable). The court found that the Indiana long-arm statute, recently amended to approach the limitations of due process, created specific personal jurisdiction. *See id.* at 208. The court determined that, because SFA was "amenable to jurisdiction in Indiana," Indiana choice-of-law rules would apply. *Id.* at 210. The court therefore applied Indiana's "first to file" rule, giving the Indiana lawsuit commenced by MMLLC and CMG priority over the New York lawsuit filed by SFA. *See id.* Finding no special circumstances to justify departure from this rule, the Southern District of New York consequently applied Indiana law. *See id.*

26. *See Shaw Family Archives*, 486 F. Supp. 2d at 311 (discussing MMLLC's grounds for motion for summary judgment). MMLLC claims that the Indiana Right of Publicity Act applied regardless of Monroe's domicile at the time of her death. *See id.* Further, MMLLC claims its right to control Monroe's likeness was violated under the Indiana statute because the t-shirt and website were made available to Indiana residents. *See id.*

27. *See id.* (discussing SFA's cross-motion for summary judgment).

28. *See id.* at 311-12 (discussing second part of SFA's cross-motion for summary judgment). SFA claimed that neither California nor New York, the two states where Monroe was possibly domiciled at the time of her death, recognized a post-mortem right of publicity at the time of her death. *See id.* SFA also claimed that MMLLC should be judicially and collaterally estopped from arguing that Monroe was domiciled in California when she died because for forty years the estate claimed she was domiciled in New York. *See id.* at 312. For further discussion of

SFA's motion for summary judgment, finding MMLLC and CMG did not control Marilyn Monroe's likeness.<sup>29</sup>

### III. BACKGROUND

The heart of the case is the distinction between the right of privacy and the right of publicity.<sup>30</sup> The common law rights of publicity and privacy have distinctly different domains.<sup>31</sup> Though privacy and publicity are often thought of as a single legal concept, Professor Melville Nimmer noted in 1954 that publicity is more aptly described as the "reverse side of the coin of privacy,"<sup>32</sup> concluding that one's right to solitude is quite different from one's right to control his or her public persona.<sup>33</sup>

This Section will present a history of the personal right of privacy and its statutory forms.<sup>34</sup> The Section will then examine the evolution of the property-based right of publicity inherent in one's likeness, which may be a statutory or common law right.<sup>35</sup> Finally, this Section will discuss the current recognition of these rights in the jurisdictions pertinent to *Shaw Family Archives*.<sup>36</sup>

#### A. The Right of Privacy

Samuel Warren and Louis Brandeis first proposed a right of privacy in 1890, with a focus on preventing the offensive use of a person's likeness.<sup>37</sup> Their logic stemmed from a series of gradual

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Monroe's domicile on the day of her death, see *infra* notes 160-65 and accompanying text.

29. See *Shaw Family Archives*, 486 F. Supp. 2d at 312 (reporting court's holding). For a further discussion of the court's reasoning, see *infra* notes 101-46 and accompanying text.

30. See *Shaw Family Archives*, 486 F. Supp. 2d at 313-14 (stating disagreement between parties over recognized rights).

31. See Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 203-04 (1954) (discussing control of public and private affairs).

32. *Id.* at 204 (writing in reaction to new scholarly works proclaiming right to privacy).

33. See *id.* (describing inadequacy of right of privacy for mid-twentieth century entertainment industry).

34. For a further discussion of privacy rights, see *infra* notes 37-62 and accompanying text.

35. For a further discussion of the right of publicity, see *infra* notes 63-81 and accompanying text.

36. For a further discussion of current recognition of publicity, see *infra* notes 82-100 and accompanying text.

37. See Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 195-96 (1890) (proposing cause of action based on emotional distress caused by public exposure of private affairs); see also Nimmer, *supra* note 31, at 206-07 (discussing impetus for Brandeis and Warren article). Brandeis and Warren were inspired to write their now famous article after a Boston newspaper reported

expansions in the jurisprudence surrounding the constitutional right to liberty.<sup>38</sup> Focusing on emotional injury rather than economic injury, Warren and Brandeis found the right to privacy to be a personal right, rather than a commercially valuable property right.<sup>39</sup> Courts first recognized Warren and Brandeis's conception of the right of privacy in the landmark case *Pavesich v. New England Life Insurance Co.*<sup>40</sup>

In *Pavesich*, the defendant insurance company used an image of the plaintiff in a newspaper advertisement that encouraged readers to buy life insurance policies from the defendant.<sup>41</sup> The Georgia Supreme Court reasoned that because the photograph of the plaintiff was recognizable to his friends and acquaintances, and because it falsely indicated his purchase of a policy, New England Life Insurance had violated the plaintiff's right to privacy.<sup>42</sup> The court reasoned that the right of privacy derived from natural law.<sup>43</sup> The court also offered its understanding of the right to privacy as an essential aspect of the American ideal of liberty, a far broader concept than the comparatively simple ideas of restraint, servitude and

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"in lurid detail the activities of Samuel Warren and his wife." *Id.* at 206; *see also* William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 383 (1960) (describing motivation for Brandeis and Warren article).

38. *See* Warren & Brandeis, *supra* note 37, at 193 (summarizing reasoning). Warren and Brandeis discussed how the right to liberty was originally understood to include freedom from battery. *See id.* at 193-94. This freedom from injury evolved into a freedom from the fear of such injury when the concept of assault was born. *See id.* at 194. Some time later came the "qualified protection" from disturbances under nuisance law. *See id.* The authors claimed that the right to liberty left the realm of purely physical actions when slander and libel laws created protection for a person's reputation. *See id.*

39. *See id.* at 197 (distinguishing between injured reputation and hurt feelings in libel suits).

40. *See Pavesich v. New Eng. Life Ins. Co.*, 50 S.E. 68, 69 (Ga. 1905) (finding violation of right of privacy for use of photograph in public advertisement); *see also* Harold R. Gordon, *Right of Property In Name, Likeness, Personality and History*, 55 NW. U. L. REV. 553, 558-59 (1960) (citing *Pavesich* as landmark right of privacy decision).

41. *See Pavesich*, 50 S.E. at 68-69 (describing plaintiff's misappropriation claim). The defendant insurance company ran an advertisement in an Atlanta newspaper that used images of two men. *See id.* at 68. Above the image of the plaintiff, who appeared to be of good health, read the words: "Do it now. The man who did." *Id.* Above the image of the other man, who was "ill-dressed and sickly looking" read the words: "Do it while you can. The man who didn't." *Id.*

42. *See id.* at 79 (finding in favor of plaintiff).

43. *See id.* at 70 (discussing history of privacy rights). The court found that even though individuals surrender certain rights as part of their participation in a society, they do not surrender those rights that are presumed to be private. *See id.* at 79-80. The court subsequently found that a person's right to exclusive control of his or her likeness is one of those presumptively private rights. *See id.* at 80.

freedom from imprisonment.<sup>44</sup> Both the Georgia Supreme Court's natural law approach and its conceptualization of liberty as a broad American ideal are consistent with Warren and Brandeis's suggestion that the right of privacy is an inalienable personal right.<sup>45</sup>

In tort, a violation of a personal right is understood as an injury to the individual.<sup>46</sup> Scholars have noted that actions for invasion of privacy grounded in tort trace back to Warren and Brandeis's initial focus on "offensive use."<sup>47</sup> After *Pavesich*, many courts continued to require this offensive use criterion, requiring some level of personal embarrassment or humiliation to prove an actionable injury.<sup>48</sup> Only later would scholars recognize the possible damage to one's persona through lucrative, rather than offensive, improper conduct.<sup>49</sup>

In 1960, in his aptly-titled article, *Privacy*, Dean William L. Prosser offered the next crucial writing in the development of the right of privacy.<sup>50</sup> Prosser's article was a response to Warren and Brandeis's tort-based discussion of the right of privacy.<sup>51</sup> Prosser found that jurisdictions varied greatly in their recognition of the right, and that judicial opinions across the country were marked by inconsistencies and a preoccupation with questions of the right's applica-

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44. See *id.* at 70 (describing right of privacy as part of American liberty). The court concluded that liberty "includes the right to live as one will, so long as that will does not interfere with the rights of another or of the public." *Id.* Liberty includes an individual's right to remain secluded, or the right to keep private certain aspects of his or her life that the law does not otherwise require to be disclosed, such as by the giving of witness testimony. See *id.*

45. Compare *Pavesich*, 50 S.E. at 70 ("The right of one to exhibit himself to the public at all proper times, in all proper places, and in a proper manner is embraced within the right of personal liberty."), with Warren & Brandeis, *supra* note 37, at 199 ("In every such case the individual is entitled to decide whether that which is his shall be given to the public."). Natural law is concerned with the basic freedoms, both physical and emotional, of humankind. See *Pavesich*, 50 S.E. at 70. The idea of liberty is equally concerned with these personal freedoms. See *id.*

46. See *Pavesich*, 50 S.E. at 73 (describing violations as tort invasions of personal rights).

47. Nimmer, *supra* note 31, at 206-07 (discussing Warren and Brandeis's goals). After a Boston newspaper published a story about Warren and his wife, Warren and Brandeis began to work on the topic of privacy. See *id.* at 206. Their concern was offensive use, something quite different from non-offensive publicity. See *id.* at 207.

48. See *id.* at 207 (discussing offensive nature of privacy actions). Many jurisdictions adopted the RESTATEMENT OF TORTS, bringing with it the requirement that conduct offend one of "ordinary sensibilities" to be actionable. See *id.*

49. See Prosser, *supra* note 37, at 401-07 (recognizing individuals may appropriate likeness of another for pecuniary gain).

50. See *id.* at 384-85 (confronting courts' confused application of privacy rights).

51. See *id.* at 383 (discussing personal injury motivation of Warren and Brandeis article).

bility.<sup>52</sup> He contended the confusion likely stemmed from a broad and somewhat simplistic understanding of the right.<sup>53</sup> Prosser therefore offered a more detailed understanding of the right of privacy, narrowing the broad tort into four specific types of conduct or interests.<sup>54</sup> The first privacy interest was intrusion into one's seclusion, solitude or private affairs.<sup>55</sup> The second privacy interest focused on "public disclosure of private facts."<sup>56</sup> The third created a cause of action for plaintiffs who were placed in a false light in the public eye.<sup>57</sup> The fourth privacy interest arose out of the value of one's persona and the gains that can be made by appropriating it.<sup>58</sup> Prosser acknowledged that unauthorized use of a person's persona, both offensive and non-offensive, was grounds for suit.<sup>59</sup> The first three sections of Prosser's analysis dealt with tort injuries caused by unauthorized use of a person's persona.<sup>60</sup> Because it focused specifically on the gains made by the unauthorized use of a public per-

52. *See id.* at 386-88 (citing adoption by states). At the time of publication twenty-six states and the District of Columbia recognized the right of privacy. *See id.* at 386-87. The right was likely to be upheld in seven more states. *See id.* at 387-88. Four states recognized some limited form of the right. *See id.* at 388. Just four states - Rhode Island, Texas, Nebraska, and Wisconsin - had outrightly rejected the right of privacy. *See id.* Hawaii, which had gained statehood in 1959, was not included in Dean Prosser's evaluation. *See id.* at 386-88.

53. *See id.* at 389 (discussing more complex system of privacy rights).

54. *See id.* (outlining four types of privacy rights).

55. *See id.* at 389-92 (discussing intrusions into personal privacy). Prosser traces the right's evolution from physical intrusions to eavesdropping and eventually to modern means of prying into private affairs. *See id.* at 390. Prosser stresses that the "intrusion" prong of his evaluation is designed to deal with mental trauma. *See id.* at 392. Specifically, intrusion is meant "to fill in the gaps left by trespass, nuisance and the intentional infliction of mental distress." *Id.*

56. *Id.* at 392-98 (discussing public disclosure of private affairs). Prosser noted that this was the type of privacy that Warren and Brandeis emphasized seventy years before. *See id.* at 392. The necessary showings under this prong are threefold: (1) the disclosure must be public, (2) the facts disclosed must be private, and (3) the disclosure must offend a "reasonable man of ordinary sensibilities." *Id.* at 393-96. Prosser characterized this privacy interest as "reputation, with the same overtones of mental distress that are present in libel and slander." *Id.* at 398.

57. *See id.* at 398-401 (describing false light in public eye). This interest is violated when "some opinion or utterance" is falsely attributed to a public figure. *Id.* at 398. This interest has found limited use in the courts, but is nonetheless a distinct tort. *See id.*

58. *See id.* at 401-07 (discussing differences between appropriation and other invasions).

59. *See id.* at 403 (finding name "piracy" constitutes violation). This prong of Prosser's discussion focuses on the use of one's likeness by another for some type of pecuniary gain. *See id.* Such use does not require that embarrassment or humiliation befall the owner of the persona; in fact, the "pirate" is likely deriving his or her gains from the strength and credibility of the persona. *See id.*

60. *See id.* at 401 (opining Warren and Brandeis's conception of privacy encompassed Prosser's first three prongs).

sona, the fourth section was fundamentally different from, and vitally important to, the evolution of privacy and publicity.<sup>61</sup> Prosser's analysis was the last major contribution to the right of privacy debate before August 5, 1962, which is the determinative date for Marilyn Monroe's rights: the date of her death.<sup>62</sup>

### B. The Right of Publicity

The Second Circuit Court of Appeals first coined the term "right of publicity" in 1953.<sup>63</sup> In this groundbreaking case, *Haelan Laboratories, Inc. v. Topps Chewing Gum*, the court agreed that privacy statutes appropriately protected a person's right to be free from emotional injury.<sup>64</sup> The court also found, however, that the law should protect a person's right to derive pecuniary value from his or her likeness.<sup>65</sup> The court held that, similar to other forms of valuable property, a person must be able to maintain (or grant to another person) exclusive control of his or her likeness.<sup>66</sup>

The dispute in *Haelan Laboratories, Inc.* arose between rival chewing gum manufacturers who both claimed a right to use a professional baseball player's likeness on trading cards included in their packs of gum.<sup>67</sup> The ballplayer had signed a contract with the plaintiff company granting exclusive use of his photograph.<sup>68</sup> Although the defendant company was aware of this agreement, it continued to pursue the ballplayer and eventually obtained his permission to use his photograph.<sup>69</sup> The defendant claimed that under New York law, the right of privacy was not transferable and

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61. *See id.* at 406-07 (discussing Nimmer's concept of publicity). Prosser mentioned the right of publicity as was recently coined by the Second Circuit's decision in *Haelan Labs. v. Topps Chewing Gum*. *See id.* He entertained the idea that this fourth type of privacy, could be considered property, and may require a different type of analysis than the other privacy torts. *See id.*

62. *See id.* at 383 (being published in August 1960, just two years before Monroe's death on August 5, 1962).

63. *See Haelan Labs. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir. 1953) (drawing sharp distinction between privacy rights and publicity rights).

64. *See id.* at 868 (finding New York derives privacy protection from statute).

65. *See id.* (describing court's rationale). The court held that a celebrity's damages do not stem merely from the embarrassment or emotional damage that the right of privacy is designed to protect, but additionally from the lack of remuneration from the unauthorized use of his or her likeness. *See id.*

66. *See id.* (holding common law right of publicity protects granting of right to exclude).

67. *See id.* at 867 (describing case facts).

68. *See id.* (discussing contract between plaintiff and ballplayer). In addition, the ballplayer agreed not to grant a similar right to any other gum manufacturer during the period of the contract. *See id.*

69. *See id.* (describing defendant's actions and knowledge). The contract between the defendant and the ballplayer authorized the defendant to use the ballp-

the ballplayer's contracts indicated consent.<sup>70</sup> Where there is consent, the defendant reasoned, there is no invasion of privacy.<sup>71</sup> The court disagreed with both contentions, finding that "in addition to and independent of that right of privacy (which New York derives from statute), man has a right in the publicity of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture."<sup>72</sup> The *Haelan Laboratories* court recognized that a personal injury-based concept of privacy was insufficient in the realm of celebrity.<sup>73</sup> The freshly minted "right of publicity," however, would secure an individual's right to exclude others from using his or her likeness without remuneration.<sup>74</sup>

Critical analysis of the right of publicity continued to develop with the publication of Professor Melville Nimmer's influential article, *The Right of Publicity*, just a year after the *Haelan Laboratories* case.<sup>75</sup> Professor Nimmer's discussion of the right of publicity centered on the idea that it is the "first principle of Anglo-American jurisprudence, an axiom of the most fundamental nature, that every person is entitled to the fruit of his labors unless there are important countervailing public policy considerations."<sup>76</sup> Professor Nimmer found that traditional legal theories, such as the tort-based

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layer's photograph to promote the sale of its gum. *See id.* It did not, however, include an exclusivity provision. *See id.*

70. *See id.* (describing defendant's argument). The defendant cited N.Y. CIV. RIGHTS LAW sections 50-51 (McKinney 1992) to support the contention that only violations of privacy were actionable under New York law. *See id.* The defendant claimed that the statutory right was personal, and therefore was not transferred in the ballplayer's contract with the plaintiff. *See id.*

71. *See id.* at 868 (discussing contracts as consent). The defendant contended that the contracts the ballplayer made with both the plaintiff and with the defendant acted as releases of liability. *See id.* These releases authorized both parties to use the ballplayer's likeness without fear of legal action. *See id.*

72. *Id.* (emphasis added). The court found that affixing the label of "property" right was immaterial to the action. *See id.* The court found that the ideological step forward of protecting things of pecuniary value was more important than a label. *See id.*

73. *See id.* ("For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likeness, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways.").

74. *See id.* (discussing affected celebrities' financial deprivation). Individuals cannot make money from their likenesses if they do not exclusively control the right to grant them. *See id.*

75. *See Nimmer, supra* note 31, at 204 (commending Judge Frank's application of publicity in *Haelan Labs.*).

76. *Id.* at 216. Nimmer contends that judicial recognition of the right of publicity as a property right is essential to uphold this basic belief. *See id.*

understanding of privacy as a personal right, were inadequate to deal with the idea that a persona is something of value.<sup>77</sup>

Professor Nimmer contended that traditional theories proved inadequate in four notable ways: first, in order to retain pecuniary value, the right of publicity must be assignable; second, there should be a cause of action regardless of whether the likeness was used in an offensive manner; third, damages ought to be computed in terms of the value of the publicity to the defendant, rather than the injury to the plaintiff; and fourth, that no waiver of this right should occur because one becomes a well-known personality.<sup>78</sup> In addition to these legal misunderstandings, Nimmer noted that courts could use unfair competition doctrines as a possible, but inevitably inadequate, means of redress for misappropriation of likeness.<sup>79</sup> The Second Circuit's opinion in *Haelan Laboratories* combined with the writings of influential scholars, such as Prosser and Nimmer, carved out the domain of publicity as something distinct from existing statutory law.<sup>80</sup> With the right of publicity established as a separate legal concept from that of privacy, the states were left to decide whether to codify publicity as a transferable property right.<sup>81</sup>

### C. Current Recognition in Relevant Jurisdictions

In *Shaw Family Archives*, the Court of Appeals for the Second Circuit applied Indiana law.<sup>82</sup> As per Indiana law, the court was to determine Monroe's domicile, either California or New York, and

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77. *See id.* at 204-10 (discussing weaknesses of traditional legal theories). Nimmer rejects the traditional legal understandings of each of the four issues he discusses throughout the article. *See id.*

78. *See id.* at 216 (summarizing shortcomings of traditional theories).

79. *See id.* at 210-14 (describing inadequacy of unfair competition doctrine). Nimmer found that the unfair competition doctrine does recognize the pecuniary value of likeness. *See id.* at 210. Nevertheless, the requirements of competition between the plaintiff and defendant, the "passing off" of goods under the likeness, and the inability to assign one's likeness in gross, make the doctrine of unfair competition inadequate. *See id.* at 210-12.

80. *Compare Haelan Labs.*, 202 F.2d at 868 (stating "in addition to and independent of that right of privacy . . . man has a right in the publicity value of his photograph"), *with* Prosser, *supra* note 37, at 406-07 (differentiating fourth prong of privacy analysis), *and* Nimmer, *supra* note 31, at 204-15 (finding current legal theories inadequate protection for publicity rights).

81. *See* Prosser, *supra* note 37, at 407 (discussing varied jurisdictional application).

82. *See* *Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.*, 486 F. Supp. 2d 309, 311 (S.D.N.Y. 2007) (applying Indiana law because cause of action arose within that state).

construe her will according to law of that state.<sup>83</sup> This Section will offer a brief overview of the current understanding of the right of publicity in the pertinent jurisdictions.<sup>84</sup>

In Indiana, the right of publicity is statutory.<sup>85</sup> The Indiana law, passed in 1994, defines the right of publicity as an individual's property interest in name, voice, signature, photograph, image, likeness, distinctive appearance, gestures, or mannerisms.<sup>86</sup> Indiana law defines the owner of a publicity right as either (1) the individual himself or herself or (2) a person to whom the right has transferred.<sup>87</sup> Such rights can be transferred through contract, license, gift, trust, testamentary document, or by the operation of intestate succession law in the state where the will is administered.<sup>88</sup>

In California, as in Indiana, the right of publicity is statutory.<sup>89</sup> , Because California created Civil Code Section 3344.1 in 1984, the adoption of a statutory right is also a relatively recent occurrence.<sup>90</sup> California law prohibits the unauthorized use of the "name, voice, signature, photograph, or likeness" of a deceased personality.<sup>91</sup> A person using any of these elements of persona for advertising, selling, or soliciting purchases without prior consent of the owner of the persona is liable under the statute.<sup>92</sup> Subsection (b) of the stat-

83. *See id.* at 314 (finding domicile determination unnecessary because outcome is unaffected).

84. For a further discussion the court's application of the laws of the various jurisdictions, see *infra* notes 105-17 and accompanying text.

85. *See* IND. CODE ANN. § 32-36-1-1 (West 2002) (outlining right of publicity in Indiana); *see also id.* §§ 32-36-1-2 -20 (defining and clarifying Indiana statutory protection).

86. *See id.* § 32-36-1-7 (defining statutory bounds of what constitutes likeness).

87. *See id.* § 32-36-1-17 (defining statutory ownership).

88. *See id.* § 32-36-1-16 (outlining transfer procedures). The code explicitly states that rights can be transferred through a testamentary document. *See id.*

89. *See* CAL. CIV. CODE § 3344.1 (West 1999) (defining right of publicity in California). It is important to note that in 2007 the California legislature amended section 3344.1 of the California Civil Code to recognize the publicity rights of those who died prior to the bill's enactment. *See* CAL. CIV. CODE § 3344.1(b) (West 2007). Moreover, the legislature clearly indicated that *Shaw Family Archives* was one of the cases it intended to abrogate with its amendment. *See id.* As the court in *Shaw Family Archives* based its opinion on the statute before this amendment, this note will refer to the 1999 version of section 3344.1, the last amendment prior to 2007.

90. *See* *Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.*, 486 F. Supp. 2d 309, 314 (S.D.N.Y. 2007) (stating adoption of California statute occurred twenty-two years after Monroe's death); *see also* Laura Parker, *Photographers' Heirs Seek A Cut of Monroe Fortune*, USA TODAY, Oct. 2, 2007, at 4A, available at [http://www.usatoday.com/news/nation/2007-10-01-monroe-estate\\_N.htm?csp=34](http://www.usatoday.com/news/nation/2007-10-01-monroe-estate_N.htm?csp=34) (describing recent statutory amendment efforts).

91. CAL. CIV. CODE § 3344.1(a)(1) (West 1999).

92. *See id.* (explaining parameters of California's publicity right).

ute clearly states that the right of publicity is a property right, and as such is freely transferable.<sup>93</sup>

Unlike Indiana or California, New York does not presently recognize a statutory or common law right of publicity.<sup>94</sup> In 1984, the New York Court of Appeals held that New York privacy statutes encompass any parallel common law right of publicity.<sup>95</sup> New York Civil Rights Law Sections 50 and 51 (“New York privacy statutes”) govern privacy law in the state of New York.<sup>96</sup> The statutes were originally adopted in 1903, just thirteen years after the influential Warren-Brandeis article on the subject.<sup>97</sup> Section 50 prohibits the use of one’s “name, portrait, or picture” for trade or advertisement without written consent; Section 51 provides remedies.<sup>98</sup> It appears that New York may have once recognized a common law right of publicity in addition to the right of privacy outlined by statute.<sup>99</sup> Nevertheless, the varied application of the privacy statutes by state

93. See *id.* § 3344.1(b) (describing statutory right as property right).

94. See *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 586 (2d Cir. 1990) (denying claim of common law publicity right infringement under New York law).

95. See *Stephano v. New Group Publ’ns.*, 474 N.E.2d 580, 583-84 (N.Y. 1984) (holding New York privacy statutes encompass any common law right of publicity); see also Alain J. Lapter, *How the Other Half Lives (Revisited): Twenty Years Since Midler v. Ford - A Global Perspective on the Right of Publicity*, 15 TEX. INTELL. PROP. L.J. 239, 262-63 (2007) (tracing history of New York privacy statutes).

96. See N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1992) (stating New York privacy rights); see also *Pirone*, 894 F.2d at 585-86 (reviewing statutes’ predominance in area of law). But see Sara L. Edelman, *Death Pays: The Fight Over Marilyn Monroe’s Publicity Rights*, THE METRO. CORP. COUNS., July 2007, at 39, available at <http://www.metrocorp.counsel.com/current.php?artType=view&artMonth=July&artYear=2007&EntryNo=6903> (predicting legislative reevaluation of privacy statute).

97. See Lapter, *supra* note 95, at 262-63 (discussing motivation behind adoption of New York privacy statutes). In 1902, the New York Court of Appeals decided *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442 (N.Y. 1902), in which a teenage plaintiff felt humiliated by the widespread distribution of an advertisement that bore his likeness. See *id.* In a narrow decision the court insinuated that legislative action would be appropriate on this matter. See *id.* Soon after the decision was handed down, the legislature enacted the New York privacy statutes. See *id.*

98. See N.Y. CIV. RIGHTS LAW § 50 (McKinney 1992) (outlining protected privacy rights). The statute provides:

A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, or if a minor of his or her parent or guardian, is guilty of a misdemeanor.

*Id.*; see also *id.* § 51 (outlining remedies for violation of N.Y. CIV. RIGHTS LAW section 50 (McKinney 1992)).

99. See *Factors Etc., Inc. v. Pro Arts, Inc.*, *rev’d on other grounds*, 579 F.2d 215, 221 (2d Cir. 1978) (discussing transferable nature of publicity rights in New York); see also *Haelan Labs. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir. 1953) (coining phrase “right of publicity” in application of New York law); *Groucho Marx Prods. v. Day & Night Co.*, *rev’d on other grounds*, 523 F. Supp. 485, 487-88 (S.D.N.Y. 1981) (recognizing New York publicity right); *Price v. Hal Roach Studios*, 400 F. Supp. 836, 844 (S.D.N.Y. 1975), *abrogated by Jim Henson Prods. v. John*

courts has not stopped the New York Court of Appeals from ceasing to recognize the right.<sup>100</sup>

#### IV. ANALYSIS

##### A. Narrative Analysis

In *Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.*, the court focused on three main issues in granting summary judgment in favor of SFA.<sup>101</sup> First, the court held that “Ms. Monroe did not have the testamentary capacity to devise the property rights she did not own at the time of her death.”<sup>102</sup> Second, the court found that Monroe did not “intend” to leave any rights that may later be recognized by either Indiana or California publicity statutes.<sup>103</sup> Third, the court found neither the Indiana nor California statutes allowed for the creation of a postmortem right of publicity for persons who died before enactment of the respective statutes.<sup>104</sup>

##### 1. *The Court’s Concern With Three Jurisdictions*

The court analyzed the possible application of New York, California, or Indiana law to the proceeding.<sup>105</sup> Before examining the

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T. Brady & Assoc., 867 F. Supp. 175, 190 (S.D.N.Y. 1994) (finding evidence of descendible right of publicity in New York).

100. See *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442, 447 (N.Y. 1902) (prompting legislature to enact privacy statute); see also *Gautier v. Pro-Football, Inc.*, 107 N.E.2d 485, 487 (N.Y. 1952) (recognizing pecuniary value of misappropriated likeness); *Brinkley v. Casablancas*, 438 N.Y.S.2d 1004, 1009 (N.Y. App. Div. 1981) (holding statutes may protect public figures who have not given consent); *Frosch v. Grosset & Dunlap, Inc.*, 427 N.Y.S.2d 828, 829 (N.Y. App. Div. 1980) (finding First Amendment concerns limited statutory protection); *Lomax v. New Broadcasting Co.*, 238 N.Y.S.2d 781, 782 (N.Y. App. Div. 1963) (noting partial defenses to statutory written consent requirement); *Pittera v. Parade Publ’ns.*, 225 N.Y.S.2d 478, 478 (N.Y. App. Div. 1962) (holding statute requires use of likeness for trade); *Moglen v. Varsity Pajamas, Inc.*, 213 N.Y.S.2d 999, 1001 (N.Y. App. Div. 1961) (finding statute requires persona used for trade or advertisement); *Miller v. Universal Pictures Co.*, 201 N.Y.S.2d 632, 634 (N.Y. App. Div. 1960) (finding plaintiff did not own property right in big band sound); *Schneiderman v. New York Post Corp.*, 220 N.Y.S.2d 1008, 1009 (N.Y. Sup. Ct. 1961) (finding consent released defendant from liability).

101. See *Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.*, 486 F. Supp. 2d 309, 320 (S.D.N.Y. 2007) (outlining legal issues of case).

102. *Id.* at 314.

103. See *id.* at 317-19 (finding New York estate law does not allow division of rights not owned at time of passing). Though the Indiana statute would control in this case, the court offered an interpretation of California law to show that the jurisdictions unanimously reject the maturation of a transferable publicity right after death, regardless of testator intent. See *id.* at 319.

104. See *id.* at 319-20 (discussing California and Indiana statutes).

105. See *id.* at 314 (analyzing controlling Indiana law and probate law of New York and California).

court's holding, it is important to understand how and why the laws of several jurisdictions were applicable.

The court ultimately determined that Indiana law applied.<sup>106</sup> The United States District Court for the Southern District of New York asserted jurisdiction over the original suit filed by CMG and MMLLC in Indiana when it granted the motion for transfer and consolidated the suit with SFA's pending suit in New York.<sup>107</sup> Nevertheless, the court found that Indiana's choice of law rules applied because the Indiana action commenced before the New York action.<sup>108</sup> As the court's ruling was based on Indiana law, its presence in the court's discussion was not surprising.<sup>109</sup>

New York and California were discussed because they represented Monroe's two possible domiciles at the time of her death.<sup>110</sup> In Indiana, as in the majority of states, a testamentary document is administered under the law of the state in which the testator was domiciled at the time of his or her death.<sup>111</sup> MMLLC and CMG, whom the court referred to simply as MMLLC, contended that Monroe was domiciled in California at the time of her death.<sup>112</sup> SFA claimed that Monroe was domiciled in New York.<sup>113</sup> The court ordered supplemental briefing on the issue of Monroe's domicile.<sup>114</sup> After the briefings, the court found it unnecessary to determine Monroe's domicile.<sup>115</sup> The court reasoned that the laws of her possible domiciles were sufficiently similar as to not affect the outcome of the decision.<sup>116</sup> The court instead examined the viabil-

106. For further discussion of procedural history, see *supra* notes 16-29, and accompanying text.

107. See *Shaw Family Archives*, 486 F. Supp. 2d at 311 (discussing transfer and consolidation of cases).

108. See Memorandum Decision Regarding Choice of Law, *Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.*, 434 F. Supp. 2d 203, 210 (S.D.N.Y. 2006) (citing first-to-file rule).

109. See *Shaw Family Archives*, 486 F. Supp. 2d at 311 (describing application of Indiana choice of law rules).

110. See *id.* at 311-12 (explaining parties' dispute over Monroe's domicile at time of death). New York and California were later described as "the only two states in which Ms. Monroe could conceivably have been domiciled." *Id.* at 315.

111. See *id.* at 314 (reciting majority domicile rule).

112. See *id.* at 312 (stating MMLLC's domicile contention).

113. See *id.* at 312 (noting SFA's domicile argument). SFA argued that MMLLC and CMG "should be judicially and collaterally estopped from arguing" that Monroe was domiciled in California after forty years of arguing that she was domiciled in New York at the time of her death. *Id.* at 312.

114. See *id.* (reporting court order for supplemental briefing following conference held March 12, 2007).

115. See *id.* at 315 ("[I]t is not necessary to resolve the question of domicile . . .").

116. See *id.* (finding similarities in New York and California probate laws).

ity of Monroe's postmortem right of publicity claim under the law of her two possible domiciles, New York and California, as well as the controlling law in the case: Indiana.<sup>117</sup> Using the law of these three jurisdictions, the following subsection will focus on the three legal issues the court addressed: testamentary capacity, intent to transfer future entitlements, and statutory limitations on rights created before enactment.

## 2. *The Court's Three Part Reasoning*

### a. Testamentary Capacity

#### i. Existence of Postmortem Right of Publicity at Time of Death

The *Shaw Family Archives* court held that neither New York, California, nor Indiana recognized a descendible right of postmortem publicity when Monroe passed away in 1962.<sup>118</sup> The court, furthermore, quickly determined that New York did not recognize a common law right of publicity.<sup>119</sup> Relying on *Pirone v. MacMillan, Inc.*, the court found that New York State's protection of persona under the New York privacy statutes was limited to living persons.<sup>120</sup>

The court then examined California Civil Code Section 3344.1 and determined that the state did not recognize a property-based postmortem right of publicity until 1984.<sup>121</sup> The court found that California recognized a right of publicity before 1984; however, that right was not freely transferable or descendible.<sup>122</sup> Similarly, the

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117. *See id.* at 314 (determining neither California nor New York recognized postmortem publicity rights).

118. *See id.* at 314 (stating California was first to recognize descendible "post-mortem" right of publicity in 1984). The court evaluated these three jurisdictions in response to the parties' dispute over domicile. *See id.* Even though Indiana was not a possible domicile, its law was included because the limits of its statutory right of publicity (established by the 1994 Right of Publicity Act) were evaluated in subsequent parts of the decision. *See id.* at 315.

119. *See id.* at 314 (citing *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 586 (2d Cir. 1990)).

120. *See id.*; *see also Pirone v. MacMillan, Inc.*, 894 F.2d 579, 585 (2d Cir. 1990) (finding New York protection only extends to right of privacy). The 1990 *Pirone* opinion cited contemporary opinions and found that the daughters of baseball great Babe Ruth had no cause of action against producers of a calendar using photos of Babe Ruth because New York privacy statutes did not create a descendible right. *See id.*

121. *See Shaw Family Archives*, 486 F. Supp. 2d at 314 (noting when statute was adopted); *see also CAL. CIV. CODE* § 3344.1 (West 1999) (finding adoption of statute created right of postmortem publicity). Originally passed in 1984 as section 990 of the California Civil Code, the statute outlines the rights and limitations on the use of deceased personalities' likenesses. *See id.* For a further discussion of the statutory right of publicity in California, *see supra* notes 89-93, and accompanying text.

122. *See Shaw Family Archives*, 486 F. Supp. 2d at 314 (describing California publicity right) (citing *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454 (Cal.

court concluded that Indiana did not recognize the right until the passage of its own statute in 1994.<sup>123</sup> Prior to 1994, Indiana law recognized a tort-based right of privacy.<sup>124</sup> The court concluded that none of the pertinent jurisdictions recognized a descendible postmortem right of publicity at the time of Monroe's death in 1962.<sup>125</sup> MMLLC next contended that even if a right did not exist at the time of her passing, later statutes conferred the postmortem right of publicity to Monroe and subsequently to her heirs.<sup>126</sup>

## ii. Disposition of Rights After Death

Finding that not one of the pertinent jurisdictions recognized a postmortem right of publicity at the time of Monroe's death, the court next explored the possibility that this right matured after Monroe's death and descended at such time.<sup>127</sup> The court examined the estate law of Monroe's two possible domiciles: New York and California.<sup>128</sup> The court found that New York law cleared determined that a testator's disposable property was limited to that which the testator possessed at the time of his or her death.<sup>129</sup> Similarly, the court found that California probate law required a testator to control all property he or she wished to transfer at the time of

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1979)). In *Guglielmi*, the nephew of a deceased actor brought suit for the misappropriation of his uncle's likeness by a television production company. See 603 P.2d at 455 (describing facts in complaint). The *Guglielmi* court held that although the uncle may have had a right to control the use of his "name, likeness, or personality," this right could not be passed to an heir. *Id.*

123. See *id.* (explaining Indiana publicity right); see also IND. CODE ANN. § 32-36-1-1 (West 2002) (defining postmortem right of publicity under Indiana law). For a further discussion of the statutory right of publicity in Indiana, see *supra* notes 85-88 and accompanying text.

124. See *Shaw Family Archives*, 486 F. Supp. 2d at 314 (explaining that rights of publication in Indiana before 1994 were only available for "personal tort action for invasion of privacy") (citing *Cont'l Optical Co. v. Reed*, 86 N.E.2d 306, 309 (Ind. App. 1949)). In *Continental Optic Co.*, a lens company used a soldier's image in advertisements without authorization. See 86 N.E.2d at 307 (describing basis for claim). The Indiana court found that the right to privacy "like any other right that resides in an individual, may be waived or lost." *Id.* at 309.

125. See *Shaw Family Archives*, 486 F. Supp. 2d at 314 (determining right did not exist in any of three relevant states).

126. See *id.* at 315 (discussing second question of testamentary capacity).

127. See *id.* (finding no relevant jurisdiction recognized right of publicity in 1962).

128. See *id.* at 314-15 (discussing party contentions as to Monroe's domicile).

129. See *id.* at 315 ("A disposition by the testator of all his property passes all of the property he was entitled to dispose of at the time of his death.") (emphasis added) (quoting N.Y. EST. POWERS & TRUSTS LAW § 3-3.1 (West 1998)). The court relied on *In re Estate of Gernon*, 226 N.Y.S.2d 940 (1960), in finding that no property acquired after the death of the testator is transferred by the will. See *id.*

his or her death.<sup>130</sup> MMLLC contended that the residuary clause of Monroe's will allowed for the transfer of property acquired after her death, specifically her right of publicity that California recognized starting in 1984.<sup>131</sup> The court rejected MMLLC's arguments, finding them irrelevant to the law of the pertinent jurisdictions.<sup>132</sup> Finding that no postmortem right of publicity transferred automatically at her death, the court next examined the testamentary document for evidence that Monroe intended to transfer rights that would mature after her death.<sup>133</sup>

#### b. Intent To Transfer Future Entitlements

The court found no indication that Monroe intended to leave any future entitlements through the residuary clause of her will.<sup>134</sup> MMLLC argued that the phrase "to which [she] shall be in any way entitled" in Monroe's will demonstrated her intent to leave future rights, including the now recognized right of publicity, to her heirs.<sup>135</sup> MMLLC relied on New York and California law, which held that evidence of intent is paramount in testamentary interpretation.<sup>136</sup> The court rejected this contention, finding no evidence of intent to leave future entitlements and that the residuary clauses, as read under the law of pertinent jurisdictions, would not permit transfer of property not possessed at the time of death, even with

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130. *See id.* at 315 ("A will passes all property *the testator owns at death*, including property acquired after execution of the will.") (emphasis added) (quoting CAL. PROB. CODE § 21105 (West 2003)).

131. *See id.* at 316. (citing examples of postmortem property acquisition and transfer). MMLLC cites section 2-602 of California Uniform Probate Code, which allows for transfer of "property acquired by the estate after the testator's death." *Id.* MMLLC also relied on *In re Hite*, 700 S.W.2d 713, 717 (Tex. App. 1985), in which a residuary clause transferred property "that the testator may have overlooked, property that lacked particular definition or property that the testatrix did not know she was entitled to at the time the will was executed." *Id.*

132. *See id.* at 316 (rejecting MMLLC's contentions). The court held that the Uniform Probate Code had no bearing on the case because neither New York nor California had adopted the code. *See id.* Similarly, the court found that the Texas case, *In re Hite*, had no effect on the law of the jurisdictions in question. *See id.*

133. *See id.* at 317-19 (rejecting argument that testator intent allowed transfer of property not owned at time of death).

134. *See id.* at 318 (rejecting MMLLC's contentions).

135. *See id.* at 318 (discussing MMLLC's interpretation of Monroe's will).

136. *See id.* at 317-18 (citing New York case law and California probate law). New York law held testator intent to be the primary consideration in will interpretation. *See id.* at 317 (citing *In re Estate of O'Brien*, 627 N.Y.S.2d 544, 544-45 (N.Y. Sur. Ct. 1995)). Similarly, California law recognized intent as the "cardinal rule" of will construction. *See id.* at 317-18 (citing *Estate of Karkeet*, 56 Cal. 2d 277, 279 (1961)).

clear intent.<sup>137</sup> The court examined the language of Monroe's will and found no evidence of special intent to leave her right of publicity.<sup>138</sup> Moreover, the court found that even if intent was evident, residuary clauses do not allow for the division of property not owned at the time of death.<sup>139</sup> Finally, the court rejected a policy argument that disallowing the transfer of property through the residuary clause favors intestacy.<sup>140</sup> Assured that the testamentary document did not dispense Monroe's postmortem right of publicity, the court then examined whether modern publicity statutes recognize the publicity rights of people who predeceased the enactment of the statute.<sup>141</sup>

### c. Statutory Limitations on Rights Created Before Enactment

The *Shaw Family Archives* court examined the Indiana and California publicity statutes and found that neither recognized post-mortem publicity rights for celebrities who died before the states enacted the statutes.<sup>142</sup> The California statute allowed the transfer of the right of publicity only "by contract or by means of a trust or testamentary documents."<sup>143</sup> Similarly, the Indiana publicity statute requires transfer by "contract, license, gift, trust, or testamentary

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137. *See id.* at 317-18 (discussing intent to leave rights created under Indiana or California publicity statutes). The court pointed to its earlier discussion of residuary clauses and found no support for the contention that Monroe's intent to leave property that she did not possess at the time of her death should supersede the limitations placed on residuary clauses by the laws of the pertinent jurisdictions. *See id.*

138. *See id.* at 318 (finding no evidence of Monroe's intent). The court described the residuary clause as "boilerplate language [which] is much too slender a reed on which to hang a devise of postmortem publicity rights that did not come into being until 22 years after her death." *Id.* Examining the structure of the clause, the court found no indication that the language "to which [she] shall be in any way entitled" was intended to incorporate rights that did not exist at the time of her death. *Id.*

139. *See id.* ("Even if the language Ms. Monroe employed clearly demonstrated her intent to devise property she had no capacity to devise, the effect would be to render the disposition invalid, because she had no legal right to dispose of property that did not exist at the time of her death.").

140. *See id.* at 319 (rejecting MMLLC's policy argument). The court stated that MMLLC failed to look at Monroe's "legal incapacity to devise what she did not own." *Id.* The court found that even a broad reading of the residuary clause would not allow for the transfer of non-existent rights. *See id.*

141. *See id.* at 319-20 (discussing statutory limitations of Indiana and California publicity statutes).

142. *See id.* at 319 (discussing possible recognition of postmortem publicity rights for celebrities who passed away before statutory enactments). New York law was not considered because New York does not have a publicity statute. *See id.*

143. *Id.* (quoting CAL. CIV. CODE § 3344.1 (West 1999)). The court held that because an already deceased personality cannot transfer his or her right of publicity in one of these two ways, a postmortem transfer cannot occur. *See id.*

document,” each of which require living parties.<sup>144</sup> After evaluating all the relevant jurisdictions, the court found that the residuary clause of Monroe’s will did not transfer her right of publicity to MMLLC’s predecessors-in-interest.<sup>145</sup> The court therefore denied MMLLC’s motion for summary judgment and granted SFA’s cross-motion for summary judgment, finding that MMLLC had no claim to Monroe’s likeness.<sup>146</sup>

## B. Critical Analysis

The court’s decision consistently focused on determining what Marilyn Monroe owned on the day of her death: August 5, 1962.<sup>147</sup> On that date, all descendible property rights transferred to her heirs.<sup>148</sup> The court’s determination that Monroe’s right of publicity was not a descendible right on that date ultimately forced the court to evaluate other possible ways in which that right could have transferred to her estate.<sup>149</sup> If Monroe’s right of publicity was descendible in 1962, the second and third sections of the court’s opinion become unnecessary, as the right would have transferred under the estate law of her domicile state.<sup>150</sup> Monroe’s most likely domicile at

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144. *Id.* (citing IND. CODE ANN. § 32-36-1-16 (West 2002)). As in California, a deceased personality in Indiana cannot dispose of his or her right of publicity in one of the enumerated ways, and therefore the state does not recognize the transfer. *See id.*

145. *See id.* at 320 (“[A]ny postmortem right of publicity in Marilyn Monroe could not have passed to MMLLC’s predecessors-in-interest through the residuary clause of her will.”).

146. *See id.* at 320 (stating court’s holding).

147. *See id.* at 314 (“Ms. Monroe could not devise by will a property right she did not own at the time of her death.”). The court also determined that “it is not necessary to resolve the question of domicile because neither New York nor California – the only two states in which Monroe could conceivably have been domiciled – permitted a testator to dispose by will of property she does not own at the time of her death.” *Id.* at 315. The court reasoned that “*In re Hite* reaffirmed, rather than undermined, the rule that only property owned at death can be devised by will.” *Id.* at 316. The court relied on “the unequivocal rule that only property owned by the testator at the time of death can be passed by will.” *Id.* at 317.

148. *See id.* at 315 (citing probate laws of relevant jurisdictions).

149. *See id.* at 314 (finding no postmortem right of publicity existed at time of Monroe’s death). The second and third parts of the decision evaluated the other possible sources of the right, such as Monroe’s intent to leave future entitlements and modern statutory recognition of rights existing before enactment. *See id.* at 317-19.

150. *See id.* at 314 (stating Indiana deferred to law of testator’s domicile at time of death for will interpretation). The court discussed these alternative arguments only after determining that the right of publicity did not transfer under the traditional estate laws of either New York or California. *See id.* at 317-20.

the time of her death was New York.<sup>151</sup> Although New York does not recognize a postmortem right of publicity today, it did recognize such a right on August 5, 1962.<sup>152</sup>

### 1. *The Significance of August 5, 1962*

The United States District Court for the Southern District of New York correctly emphasized the importance of determining what descendible rights Monroe possessed on the date of her death.<sup>153</sup> The court clearly stated the significance of making this crucial determination:

[R]egardless of Ms. Monroe's domicile at the time of her death, and regardless of any rights purportedly conferred after death by Indiana Right of Publicity Act or by Cal. Civil Code § 3344.1 - Ms. Monroe could not devise by will a property right she did not own at the time of her death in 1962.<sup>154</sup>

This date of death evaluation was vital because any possible jurisdiction in which Monroe's will could be administered required that the testator possess all rights to be devised at death.<sup>155</sup> The court recognized that Indiana was not a possible domicile of Monroe when she died.<sup>156</sup> The court, applying Indiana law, held that the will would be construed according to the law of Monroe's domicile at the time of her death.<sup>157</sup> The parties disagreed as to whether Monroe was domiciled in New York or California.<sup>158</sup> The

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151. For further discussion of Monroe's domicile, see *infra* notes 160-65 and accompanying text.

152. See *Haelan Labs. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir. 1953) (creating term "right of publicity" in application of New York law); see also *Groucho Marx Prods. v. Day & Night Co.*, *rev'd on other grounds*, 523 F. Supp. 485, 487-88 (S.D.N.Y. 1981) (finding common law right of publicity existed in 1981). *But see Pirone v. MacMillan, Inc.*, 894 F.2d 579, 586 (2d Cir. 1990) (terminating recognition of common law right of publicity in 1990). For a further discussion of the history of the right of publicity in New York, see *infra* notes 170-218 and accompanying text.

153. See *Shaw Family Archives*, 486 F. Supp. 2d at 314 (stating that determination of rights possessed at death is vital).

154. *Id.*

155. See *id.* at 315 (stating New York and California estate law only allowed transfer of rights controlled by testator at time of death).

156. See *id.* (recognizing New York and California as only possible domiciles).

157. See *id.* at 314 ("Indiana follows the majority rule that the law of the domicile of the testator at his or her death applies to all questions of a will's construction.").

158. See *id.* at 314-15 (listing New York and California as Monroe's only possible domiciles).

task for the court thus became determining Monroe's state of domicile, as the law of that state would be crucial to deciding which descendible rights Monroe possessed at death.<sup>159</sup>

2. *Marilyn Monroe Was Domiciled in New York at the Time of Her Death*

SFA claimed that MMLLC should be judicially and collaterally estopped from arguing that Monroe was domiciled in California.<sup>160</sup> SFA also asserted that the Monroe estate, and now MMLLC, had successfully argued for nearly forty years that Monroe was domiciled in New York at the time of her death.<sup>161</sup>

The court did not conclude where Monroe was domiciled.<sup>162</sup> It is apparent from the opinion that the court felt it unnecessary to decide Monroe's domicile because the issue did not impact the outcome of the case.<sup>163</sup> Nevertheless, it appeared that SFA's estoppel claim was warranted, as Monroe's will had long been construed under New York law without protest from her estate.<sup>164</sup> MMLLC's argument for California domicile appeared to be an attempt to avoid seemingly unfavorable New York law, however, New York was Monroe's most likely domicile at the time of her death.<sup>165</sup>

159. *See id.* (discussing estate laws of Monroe's possible domiciles).

160. *See id.* at 312 (discussing SFA's argument for estoppel).

161. *See id.* (stating SFA claim).

162. *See id.* at 315 (finding it unnecessary to resolve issue of domicile because relevant laws of New York and California were similar). The court had previously requested supplemental briefing on the issue of Monroe's domicile at a March 12, 2007 conference. *See id.* at 312.

163. *See id.* at 314-15 (finding that neither New York nor California law recognized descendible right of publicity in 1962). The court noted that New York still did not recognize a transferable right of publicity. *See id.* at 314. The court also found that California did not recognize such a right until 1984. *See id.*

164. *See id.* at 312 (discussing probate of will). The court stated that Monroe's will was "subject to primary probate in New York County Surrogate's Court." *Id.* Moreover, probate in New York was not contested at any time during the probate of the primary beneficiary's will. *See id.*; *see also* Estate of Marilyn Monroe, Deceased, N.Y. L.J., June 20, 2002, at 23, col. 2 (N.Y. Sur. Ct. June 19, 2002) (describing more recent litigation involving Monroe's will). The court discussed *Miracle v. Strasberg*, No. 92-00605, Dec. 23, 1992 (D. Haw.), in which the alleged granddaughter of Marilyn Monroe, Nancy "Miracle" Greene, claimed an inheritance from the Monroe estate. *See id.* The court interpreted the will according to New York law and concluded that Greene was not a pretermitted heir. *See id.*; *see also* *Strasberg v. Odyssey Group, Inc.*, 51 Cal. App. 4th 906, 911 (1996) (stating that Monroe's will was probated in New York). Monroe died in Los Angeles, California, where ancillary proceedings to probate her will began in 1963. *See Strasberg*, 51 Cal. App. 4th at 911. As ancillary proceedings, the California proceedings were merely supplemental to the official New York probate proceedings. *See id.* at 912 n.2.

165. For a further discussion of Monroe's domicile for probate purposes, see *supra* note 164.

### 3. *Dismissal of Possible New York Recognition of Right of Publicity*

Assuming that New York was most likely Monroe's domicile at the time of her death, it becomes important to reexamine the court's evaluation of New York law at the time of her death.<sup>166</sup> Again, this aspect of the court's evaluation goes to the ultimate determination of what rights Monroe possessed at the time of her death and which of those rights were descendible.<sup>167</sup> In a single sentence, the court dismissed the possibility that New York recognized a common law right of publicity in 1962.<sup>168</sup> Today, New York does not recognize a common law right of publicity beyond what is protected by the New York privacy statutes.<sup>169</sup> The following discussion of New York publicity law, however, will show that such a right existed in 1962.

#### a. New York Publicity Law in 1962

*Haelan Laboratories* was both a theoretical landmark in the history of the right of publicity as well as a practical landmark in the judicial history of New York State.<sup>170</sup> As this section will discuss, the court's recognition of the doctrinal separation between privacy and publicity allowed a common law right of publicity to exist alongside the statutory right of privacy for many years.<sup>171</sup> Although New York courts later questioned the existence of this independent right, in 1962 New York recognized a property-based right of publicity.<sup>172</sup>

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166. See *Shaw Family Archives*, 486 F. Supp. 2d at 314-15 (discussing applicable New York law).

167. See *id.* at 314 (stating overarching legal necessity that Monroe possess all rights intended to be devised).

168. See *id.* ("To this day, New York law does not recognize any common law right of publicity and limits its statutory publicity rights to living persons.")

169. See *Stephano v. News Group Publ'ns.*, 474 N.E.2d 580, 583-84 (N.Y. 1984) (finding New York privacy statutes encompass publicity rights).

170. See *Nimmer*, *supra* note 31, at 218 (discussing theoretical evolution and application of New York law regarding right of publicity). For further discussion of *Haelan Labs. v. Topps Chewing Gum*, see *supra* notes 63-74 and accompanying text.

171. See *Haelan Labs. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir. 1953) (juxtaposing privacy and publicity rights). The court clearly stated that "in addition and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph." *Id.*; see also *Price v. Hal Roach Studios*, 400 F. Supp. 836, 843 (S.D.N.Y. 1975), *abrogated by* *Jim Henson Prods. v. John T. Brady & Assoc.*, 867 F. Supp. 175, 190 (S.D.N.Y. 1994) (discussing existence of right of publicity outside statutorily derived right of privacy).

172. See *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 585 (2d Cir. 1990) (finding that New York does not recognize post-mortem right of publicity). *But see Haelan Labs.*, 202 F.2d at 868 (finding existence of publicity right in 1953); see also *Factors Etc., Inc. v. Pro Arts, Inc.*, *rev'd on other grounds*, 579 F.2d 215, 220-21 (2d Cir. 1978) (continuing recognition of right of publicity in New York through 1978).

Further, this common law right of publicity was transferable and descendible.<sup>173</sup>

The discussion of a common law, property-based postmortem right of publicity in New York began in 1952 when the New York Court of Appeals decided *Gautier v. Pro-Football, Inc.*, a year before *Haelan Laboratories*.<sup>174</sup> The plaintiff in *Gautier* was an animal trainer who performed on the field during the halftime show of a professional football game.<sup>175</sup> The plaintiff claimed the Washington Redskins organization violated his right of privacy by broadcasting his halftime performance without his permission.<sup>176</sup> The court found that the New York privacy statutes were inapplicable because the very public nature of the performance constituted a waiver of his privacy right.<sup>177</sup> A concurring opinion, however, indicated that a new understanding of privacy and publicity was in order.<sup>178</sup> In his concurrence, Judge Desmond noted the inadequacy of the New York privacy statutes in this situation saying that “[the plaintiff’s] grievance here is not the invasion of his ‘privacy’ – privacy is the one thing he did not want, or need, in his occupation.”<sup>179</sup> Moreo-

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173. See *Groucho Marx Prods. v. Day & Night Co., rev’d on other grounds*, 523 F. Supp. 485, 487-89 (S.D.N.Y. 1981) (describing New York publicity right as descendible common law right); see also *Factors Etc., Inc.*, 579 F.2d at 221 (discussing transferable nature of publicity rights in New York).

174. See *Gautier v. Pro-Football, Inc.*, 107 N.E.2d 485, 488 (N.Y. 1952) (distinguishing publicity rights from privacy rights).

175. See *id.* at 487 (discussing facts of case). The plaintiff performed his act before 35,000 fans at Griffith Stadium in Washington D.C. See *id.* New York had jurisdiction because an estimated 17,000 television sets in New York were tuned to the game. See *id.* The New York Court of Appeals found that this was sufficient to establish that the plaintiff’s picture was used in New York State. See *id.*

176. See *id.* (stating plaintiff’s complaint). The plaintiff sued the owner of the Washington Redskins football team, Pro-Football, with whom he had signed a contract to perform. See *id.* The plaintiff also brought suit against the companies whose advertisements appeared during the performance, claiming they profited from the use of his likeness. See *id.*

177. See *id.* at 489 (discussing waiver of privacy). The court stated: While not a part of the game proper, he did become a part of the legitimate public spectacle as a while by appearing between the halves, and voluntarily occupying the very center of attraction for several minutes. Under these circumstances it can hardly be said that his right of privacy was invaded.

*Id.*; see also Nimmer, *supra* note 31, at 204-06 (evaluating waiver of privacy). Professor Nimmer described the argument that celebrities waive any right to privacy by performing as one of the shortcomings of the legal system of the time. See *id.* at 205. Turning to *Gautier* in particular, Nimmer found that performers are not concerned with their privacy when they are in front of an audience; instead, they are concerned with their right to control profit and reproduction. See *id.*

178. See *Gautier*, 107 N.E.2d at 489 (Desmond, J., concurring) (recognizing crucial difference between private and public interests in likeness).

179. *Id.*

ver, Judge Desmond wrote that the plaintiff's complaint may well be justified, but was simply not the province of the New York privacy statutes.<sup>180</sup>

*Haelan Laboratories*, decided one year after *Gautier*, appeared to establish that a common law right of publicity did exist in New York in the mid-1950s.<sup>181</sup> It would be more than twenty years until courts would again specifically address the right of publicity in New York.<sup>182</sup> Cases decided in this interim period focused on the application of the New York privacy statutes, and were never pushed to evaluate the existence of the common law rights debated by the higher courts.<sup>183</sup> Nevertheless, when courts took up the topic again in the 1970s, the maturation of the common law right of publicity seemed complete.<sup>184</sup>

*Price v. Hal Roach Studios*, decided in 1975, cited *Haelan Laboratories* and expanded on its findings about the right of publicity, thereby confirming the existence of the right throughout the relative dark-period on the issue.<sup>185</sup> Plaintiffs Lucille Hardy Price and Ida K. Laurel, the widows of silent-era comedians "Laurel and Hardy," sued the film studio for which their late husbands' had

180. *See id.* (discussing N.Y. CIV. RIGHTS LAW sections 50 and 51 (McKinney 1992)). Judge Desmond stated that the New York privacy statutes do not offer redress for this type of invasion. *See id.* No real violation of the "right of privacy" occurred when the plaintiff performed in front of a stadium of people, yet the judge recognized that some cause of action may be warranted. *See id.* at 489-90.

181. For a further discussion of *Haelan Labs.*, see *supra* notes 63-74 and accompanying text.

182. *See* Factors Etc., Inc., v. Pro Arts, Inc., *rev'd on other grounds*, 579 F.2d 215, 220 (2d Cir. 1978) (noting "dearth of New York case law in this area.").

183. *See, e.g.*, Lomax v. New Broad. Co., 238 N.Y.S.2d 781, 782 (N.Y. App. Div. 1963) (holding that oral consent and estoppels are only partial defenses against written consent to use one's likeness under the New York privacy statutes); *Pittera v. Parade Publ'ns.*, 225 N.Y.S.2d 478, 479 (N.Y. App. Div. 1962) (finding claim insufficient under New York privacy statutes because likeness was not used for trade or advertising purposes); *Moglen v. Varsity Pajamas, Inc.*, 213 N.Y.S.2d 999, 1001 (N.Y. App. Div. 1961) (stating dismissal of case was proper because New York privacy statutes require intentional use of likeness for trade purposes); *Schneiderman v. New York Post Corp.*, 220 N.Y.S.2d 1008, 1009 (N.Y. Sup. Ct. 1961) (finding failure to obtain plaintiffs' consent to be mentioned in newspaper article made defendant liable under New York privacy statutes). *Compare* *Miller v. Universal Pictures Co.*, 201 N.Y.S.2d 632, 634 (N.Y. App. Div. 1961) (finding plaintiff, band leader Glen Miller, did not own property right in big band sound), *with* *Price v. Hal Roach Studios*, 400 F. Supp. 836, 845 (S.D.N.Y. 1975), *abrogated by* *Jim Henson Prods. v. John T. Brady & Assoc.*, 867 F. Supp. 175, 190 (S.D.N.Y. 1994) (distinguishing property rights in sound from property rights in publicity).

184. *See, e.g.*, *Price*, 400 F. Supp. at 843 (stating that both privacy and publicity rights existed in New York in 1975)

185. *See id.* at 843-44 (relaying conception of publicity and privacy rights from *Haelan Labs.*).

worked claiming unauthorized use of name and likeness.<sup>186</sup> Applying New York law, the United States District Court for the Southern District of New York found that both Laurel and Hardy had a right of publicity that was “a property right, *distinct from the statutory protection*, in his name and likeness.”<sup>187</sup> The court found this distinction to be so evident that the only issue it felt compelled to discuss was whether the right was descendible.<sup>188</sup> The court found that in claiming the right was not descendible, the defendants had confused the statutory right of privacy, which is not descendible, and the independent right of publicity, which is a property right and therefore is descendible.<sup>189</sup> As the statutory right of privacy in New York was an attempt to “prevent injury to feelings,” it was logical that the right would not be assignable during life and would terminate at death.<sup>190</sup> The right of publicity, on the other hand, had a “purely commercial nature” which was assignable and descendible.<sup>191</sup>

In *Factors Etc., Inc. v. Pro Arts, Inc.*, the Second Circuit Court of Appeals further elaborated on New York’s conception of publicity during this relative dark period.<sup>192</sup> Boxcar Productions was a Tennessee corporation through which legendary entertainer Elvis Presley and his manager marketed Presley’s likeness.<sup>193</sup> When Presley died in 1977, his father was appointed executor of his will and he,

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186. *See id.* at 837-38 (describing claims of case). The defendants claimed they were entitled to use the names and likenesses of the comedians for the following three reasons: (1) employment agreements with the actors gave the studio exclusive and concurrent rights to use the likenesses; (2) the studio had copyrights on the films in which the likenesses were used; and (3) the studio was allowed to use the actors’ likenesses along with the general public because any claim of privacy had been waived. *See id.* at 839.

187. *Id.* at 844 (emphasis added). The plaintiffs, the widows (both residents of California) and Larry Harmon Pictures Corporation (a California corporation), were California residents. *See id.* at 837-38. Defendants, Hal Roach Studios (a Delaware corporation with its principle place of business in New York) and Richard Feiner & Co. (a New York Partnership) were New York residents. *See id.* at 838.

188. *See id.* at 844 (“The question which remains open is whether the right of publicity terminates upon death of the individual or whether it is descendible.”).

189. *See id.* (discussing descendible nature of publicity right).

190. *See id.* (describing intent of N.Y. CIV. RIGHTS LAW sections 50-51 (McKinney 1992)).

191. *See id.* (clarifying distinction between privacy and publicity rights). The court found that the commercial nature of one’s publicity made it logically assignable. *See id.* It found no reason that this assignable right ought to terminate upon the death of the personality. *See id.* The court held the assignable and descendible qualities of publicity were the reasons it was deemed a property right. *See id.*

192. *See* 579 F.2d 215, 220 (2d Cir. 1978) *rev’d on other grounds*, 652 F.2d 278 (2d Cir. 1981) (discussing New York common law right of publicity).

193. *See id.* at 216-17 (discussing control of likeness rights while Presley was alive).

together with Boxcar Productions, granted Factors Etc., Inc. (“Factors”) “the exclusive license to exploit commercially the name and likeness of Elvis Presley.”<sup>194</sup> Factors then brought suit against Pro Arts, Inc. (“Pro Arts”) in the Southern District of New York after Pro Arts marketed a poster memorializing the death of Presley, which was in violation of Factors’s exclusive license.<sup>195</sup> The court discussed Prosser’s four invasions of privacy and focused on the final understanding under which injury is the result of uncompensated exploitation of likeness.<sup>196</sup> The court then focused on the unjust enrichment accruing to Pro Arts, stating that “[n]o social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.”<sup>197</sup> The Second Circuit recounted its own decision in *Haelan Laboratories* where it “recognized that the right of publicity exists independent from the statutory right of privacy and that it can be validly transferred by its owner.”<sup>198</sup> The court held that “there can be no doubt that Elvis Presley assigned to Boxcar [Productions] a valid property right, the exclusive authority to print, publish and distribute his name and likeness.”<sup>199</sup> The court concluded that its decision was in keeping with other applications of New York law that recognized the inherent distinction between the rights.<sup>200</sup>

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194. *Id.* at 217.

195. *See id.* (describing facts and procedural posture of case). Factors warned Pro Arts that it must discontinue the sale of its poster or they would be subject to a lawsuit for injunctive relief. *See id.* Pro Arts did not stop its distribution, but rather filed an action against Factors in the United States District Court for the Northern District of Ohio seeking a declaratory judgment that it had not infringed the rights claimed by Factors. *See id.* Upon discovering the Ohio suit, Factors brought suit against Pro Arts for license infringement in United States District Court for the Southern District of New York. *See id.* Pro Arts failed to carry its burden in requesting a transfer to the Ohio court and the District Court for the Southern District of New York proceeded with action filed by Factors. *See id.* at 218-19. The Court of Appeals for the Second Circuit found no abuse of discretion by the district court for assuming jurisdiction in New York. *See id.* at 219.

196. *See id.* at 220 (applying Prosser’s analysis). For a further discussion of Prosser’s rubric of privacy rights, see *supra* notes 50-62 and accompanying text.

197. *Factors Etc., Inc.*, 579 F.2d at 220 (quoting Harry Kalven, *Privacy in Tort Law – Were Warren and Brandeis Wrong?* 31 LAW & CONTEMP. PROBS. 326, 331 (1966)).

198. *Id.*

199. *Id.* at 221.

200. *See id.* (citing *Price v. Hal Roach Studios*, 400 F. Supp. 836 (S.D.N.Y. 1975), *abrogated by* *Jim Henson Prods. v. John T. Brady & Assoc.*, 867 F. Supp. 175, 190 (S.D.N.Y. 1994)). The court found *Price* “particularly persuasive” because it was an application of New York law to a similar dispute over ownership of commercial rights of the deceased. *Id.*

The United States District Court for the Southern District of New York reaffirmed the existence of a common law right of publicity in New York in *Groucho Marx Productions, Inc. v. Day & Night Co.*<sup>201</sup> The dispute in *Groucho Marx Productions* arose from the production of a musical play featuring characters traditionally portrayed by legendary comedians “The Marx Brothers.”<sup>202</sup> The plaintiffs, heirs of the Marx brothers, claimed infringement and misappropriation of the likenesses that they owned as beneficiaries of the brothers’ respective wills.<sup>203</sup> The court again clearly differentiated between New York’s “statutory protections against the invasion of privacy of living persons” and the publicity rights of dead celebrities which “must stem from common law.”<sup>204</sup> The court offered one of the most definitive summations of New York law regarding publicity at the time: “[a]lthough no state court has ruled on the issue, several federal courts, including the Second Circuit, have concluded that *a right of publicity does exist in New York.*”<sup>205</sup> The court recounted the Second Circuit’s decision in *Haelan Laboratories* — and its affirmation by *Price and Factors, Etc.*, among others — that the right of publicity is fully transferable and therefore cannot be considered a personal right.<sup>206</sup> Finding that the Second Circuit was undoubtedly clear in this determination, the court simply explored whether any recent opinions had disagreed with the federal interpretation of the right.<sup>207</sup> No courts disagreed.<sup>208</sup> The existence of

201. See 523 F. Supp. 485, 487-88 (S.D.N.Y. 1981) (recognizing that several federal courts, applying New York law, have concluded that right of publicity existed in New York).

202. See *id.* at 486 (discussing basis of action). The brothers, Adolph “Harpo” Marx, Julius “Groucho” Marx, and Leo “Chico” Marx, were known for their unique comedic appearance and mannerisms in the 1920s. See *id.*

203. See *id.* (asserting various claims based on ownership of likenesses). The plaintiffs asserted that New York recognizes a common law right of publicity. See *id.* at 487. Moreover, the plaintiffs argued that the right is descendible. See *id.* The plaintiffs also claimed that the First Amendment did not limit the scope of the right of publicity in this case. See *id.*

204. *Id.* at 487.

205. *Id.* (emphasis added).

206. See *id.* at 488 (finding support for New York recognition of publicity rights).

207. See *id.* (remarking on clarity of Second Circuit’s opinion on issue).

208. See *id.* at 488-89 (evaluating two recent New York Supreme Court Appellate Division cases). The court looked first at *Frosch v. Grosset & Dunlap, Inc.*, 427 N.Y.S.2d 828 (N.Y. App. Div. 1980)(mem.), which involved the publication of Marilyn Monroe’s biography. See *id.* at 488. The state court found that the New York privacy statutes did not apply because Monroe was deceased. See *id.* at 489. The court did not, however, dispose of the right of publicity claim as part of the statutory claim. See *id.* Instead, the court dismissed the publicity claim on separate grounds, claiming that First Amendment considerations would prevail over any right that Monroe’s estate may own. See *id.* The court also looked at *Brinkley v.*

a common law right of publicity alongside the statutory right of privacy appeared to exist at least as late as 1981.<sup>209</sup>

New York's recognition of the right of publicity remained until 1984, when the New York Court of Appeals made it clear that the right no longer existed in New York.<sup>210</sup> In *Stephano v. New Group Publications*, a model claimed that an advertiser used a picture of him in a bomber jacket without his consent, in violation of section 51 of the New York Civil Rights Law and the common law right of publicity.<sup>211</sup> This court determined that the New York privacy statutes did indeed apply to this type of misappropriation.<sup>212</sup> Finding that the state's privacy statute actually provided for this type of violation, the court stated that the plaintiff could not claim the existence of common law right of publicity.<sup>213</sup> The court evaluated the claim under the statute, giving no further credence to common law rights.<sup>214</sup>

The Second Circuit adopted New York's new interpretation of publicity in *Pirone v. MacMillan, Inc.*<sup>215</sup> Dorothy Ruth Pirone and Julia Ruth Stevens, daughters of baseball great George "Babe" Ruth, sued the producers of a calendar that contained the name and image of Ruth.<sup>216</sup> Citing *Stephano* and overturning *Factors*, the court

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*Casablanca*, 438 N.Y.S.2d 1004 (N.Y. App. Div. 1981), in which a model sued to enjoin the sale of a poster bearing her likeness. *See id.* The state court concluded that the New York privacy statutes and the state and federal cases defending the common law right of publicity were not suitable in this case. *See id.* The district court took this ruling as an indication that New York courts were indeed willing to recognize the pecuniary value of persona. *See id.*

209. *See id.* at 487 (recognizing that New York's common law right of publicity existed in 1981).

210. *See Stephano v. New Group Publ'ns.*, 474 N.E.2d 580, 583-85 (N.Y. 1984) (finding that New York privacy statutes were sufficiently broad to cover publicity interests).

211. *See id.* at 581 (discussing facts of case).

212. *See id.* at 584 (discussing breadth of statutes). The court found that "the statute applies to any use of a person's picture or portrait for advertising or trade purposes whenever the defendant has not obtained the person's written consent to do so." *Id.*

213. *See id.* (finding right of publicity is "encompassed" by New York privacy statutes).

214. *See id.* at 584-87. (finding New York privacy statutes inapplicable). The court found that the picture used, along with the accompanying text, was sufficiently newsworthy, and therefore not an "advertisement or trade purposes" under the New York privacy statutes. *See id.* at 584-86.

215. *See id.* at 586 (encompassing view of New York privacy statutes from *Stephano*).

216. *See id.* at 581 (describing facts of case). Plaintiffs claimed common law trademark infringement and unfair competition. *See id.* They sought permanent injunction for the use of Ruth's likeness and the name "Babe Ruth" over which they claimed trademark rights. *See id.*

held that the New York privacy statutes encompassed the once-recognized common law right of privacy.<sup>217</sup> After decades of recognition, New York law no longer supported claims based on the common law right of publicity.<sup>218</sup>

#### b. Residuary Clause and Statutory Limitations

The court's evaluation of Monroe's intent to transfer future entitlements through the residuary clause of her will became unnecessary if it was established that the publicity rights in question existed at the time of Monroe's death.<sup>219</sup> The court agreed that the intent of the testator is the "touchstone" of will construction, but found that intent was bound by the limitations of what the testator controlled at death.<sup>220</sup> The court did not question the residuary clause's power to transfer non-enumerated rights that existed at the time of death.<sup>221</sup> If the court determined that a property-based right of publicity existed at the time of death, then the residuary clause would have the power to transfer the right, and the question of Monroe's intent to leave future rights she did not possess would be unnecessary.<sup>222</sup>

The court's discussion of the possibility that the Indiana or California publicity statutes may have allowed transfer of postmortem publicity rights before their enactment becomes similarly unnecessary.<sup>223</sup> The court entertained this discussion only after dismissing the possibility of transfer by the testamentary document.<sup>224</sup> If the

217. *See id.* at 585 (adopting *Stephano* ruling).

218. *See id.* at 586 (stating *Factors Etc., Inc.* no longer good law). *But see id.* at 585 (discussing period of recognition under *Factors Etc., Inc.*).

219. *See Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.*, 486 F. Supp. 2d 309, 318 (S.D.N.Y. 2007) (finding argument of intent to devise future entitlements unpersuasive).

220. *Id.* (discussing intent to leave future entitlements). The court found no evidence that Monroe intended to leave future entitlements. *See id.* Moreover, the court found that even if such intent was present it would not have created a valid transfer because probate law of the relevant jurisdictions prohibited transfer of rights not possessed at time of death. *See id.*

221. *See id.* at 319 (discussing residuary clauses). The court found that residuary clauses should be read broadly, encompassing any interests recognized in law or equity. *See id.* The court stated: "Ms. Monroe explicitly recognizes that her powers of testamentary disposition are limited to property she owns at time of her death." *Id.* at 318.

222. *Compare id.* at 319 (recognizing residuary clause transfer of existent rights), *with id.* at 318 (finding testator intent paramount for existent rights, but not future entitlements).

223. *See id.* at 319 (discussing pre-enactment recognition as last possible transfer means).

224. *See, e.g., id.* at 318 (stating unequivocal division rule). The court concluded that testamentary documents, under the law of either possible domicile,

publicity right indeed existed in New York, and Monroe was indeed domiciled there when she died, then the right would have descended to her heirs and no retroactive statutory recognition from these states would be required.<sup>225</sup>

## V. IMPACT

The estates of New York actors, authors and musicians, whose bodies of work earned them iconic status and posthumous profits, will feel the immediate impact of this case.<sup>226</sup> Although New York courts reevaluated the state privacy statutes in the 1980s and 1990s, this decision may force the legislature to reexamine the efficacy of the current statutes.<sup>227</sup>

The New York privacy statutes were created during the infancy of the right of privacy.<sup>228</sup> The New York legislature enacted the statutes just thirteen years after Warren and Brandeis first voiced their joint concern over the offensive use of likeness.<sup>229</sup> Over the next century, the entertainment industry grew exponentially and the rights associated with likeness changed.<sup>230</sup> Scholars recognized this evolution, as did several state legislatures who enacted statutes to protect commercial interest in likeness.<sup>231</sup> For a time, New York common law followed this evolution and provided protection for its residents.<sup>232</sup> Recent rulings, including *Shaw Family Archives*, have showed the state's reluctance to defend the right of publicity.<sup>233</sup>

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cannot transfer rights not possessed at time of death; thus, recognition - if there is to be any - must come from another source. *See id.*

225. *See id.* at 313-14 (declaring transfer at time of death is primary analysis).

226. For a further discussion of profitability of deceased celebrities, see *supra* notes 1-4 and accompanying text.

227. *See* Edelman, *supra* note 96, at 39 (predicting legislative review).

228. For a further discussion of the New York privacy statutes, see *supra* notes 94-100 and accompanying text.

229. *See* Nimmer, *supra* note 31, at 206 (discussing Warren and Brandeis's concern over emotional injury and embarrassment).

230. *See id.* at 204 (discussing entertainment industry development). Dean Prosser discussed the growing challenges facing the New York privacy statutes. *See id.* Prosser mentioned the profitability issues presented by newspapers and magazines when the statutes were passed. *See id.* Prosser also showed concern with the statutes' ability to adapt to ever-growing exposure on radio, television and film. *See id.*

231. *See id.* at 204-14 (discussing current legal system's inadequate publicity protection); *see also* IND. CODE ANN. §§ 32-36-1-1 -20 (West 2002) (stating Indiana statutory publicity protection); CAL. CIV. CODE § 3344.1 (West 1999) (outlining California statutory protections).

232. For a further discussion of the possible recognition of common law right of publicity in New York, see *supra* notes 170-218 and accompanying text.

233. *See* *Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.*, 486 F. Supp. 2d 309, 320 (S.D.N.Y. 2007) (finding no postmortem right of publicity in New York);

The battle for recognition of this lucrative right in New York has existed for some time.<sup>234</sup> The high-profile nature of the likeness and the great sums of money involved in this case may exert new pressure on the legislature to recognize the right of publicity.<sup>235</sup>

This case also sparked a reevaluation of the right of publicity in California.<sup>236</sup> Unlike New York, however, the California legislature took definite steps by amending section 3344.1 of the California Civil Code to expressly protect the rights of celebrities who passed away before the statute's enactment.<sup>237</sup> California's reactionary expansion of its already progressive publicity statute may well place even greater pressure on New York to recognize the right of publicity in the wake of this decision.<sup>238</sup>

Although the fortunes of entertainment's elite may turn some off to their cause, it is only fair to remember that it is "a first principle of Anglo-American jurisprudence, an axiom of the most fundamental nature, that *every person* is entitled to the fruit of his labors . . . ." <sup>239</sup>

*John C. Fuller\**

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*see also* *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 586 (2d Cir. 1990) (stating New York does not recognize common law right of publicity).

234. *See* *Parker*, *supra* note 90, at 4A (describing recognition efforts). Actors and musicians such as Al Pacino and Yoko Ono have taken part in the debate over likeness in New York. *See id.*

235. *See Shaw Family Archives*, 486 F. Supp. 2d at 312 (recognizing Monroe's popularity). The court describes Monroe as "perhaps the most famous American sex symbol of the twentieth century." *Id.*; *see also* *Goldman & Paine supra* note 1 (calculating \$7 million in MMLC revenues in 2007).

236. *See Parker*, *supra* note 90, at 4A (discussing debate in California). The proponents of the bill were 1960s sitcom-actress-turned-state-Senator Sheila Kuehl, the Screen Actors Guild, and the estate of actor John Wayne. *See id.* Opponents of the bill, supporting photographers' rights, included the estates of actor Marlon Brando and musician Ray Charles. *See id.*

237. *See* CAL. CIV. CODE § 3344.1(b) (West 2007) (expanding publicity rights to already deceased celebrities).

238. *See Parker*, *supra* note 90, at 4A (telling of actors debating publicity issues in New York).

239. *Nimmer*, *supra* note 31, at 216 (emphasis added).

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