



I am Dracula; Welcome to my Lawsuit

By James B. Astrachan

We recently negotiated a license with a movie studio to obtain rights to use the nefarious Count Dracula in a series of television commercials. A license was necessary because the Count was depicted in a motion picture entitled “Dracula” and the studio claimed ownership of service mark and copyright.

It was not as if the studio had rights to Bram Stoker’s original vampire, but our client needed to portray a monster that would be immediately recognizable to its audience, and that meant that the Count had to look as if he stepped from the set of the original 1935 Universal Studios picture. And that meant a license was needed.

Reading the submitted license agreement, this line caught my eye: “Additionally, licensee agrees not to utilize a look a like to Bela Lugosi to portray ‘Dracula’.”

“We want the creature to look just like the studio’s original,” explained the client. “Yes, but a stake in the heart awaits you if you do,” I explained.

We had to approach this problem as if it was a picture within-a-picture. In other words, while we had the right to portray the Dracula creature, dressed in black tails and heraldic medallion, just as depicted in the movie, we were agreeing not to make our Dracula look like Bela Lugosi playing the role of Dracula.

An interesting problem for several reasons. It has been very well established that unless the actor had actually created the role, the role cannot be protected by the actor’s assertion of his or her right of publicity. Karloff did not create the Frankenstein Monster

and Lugosi did not create Dracula. They merely stepped into those roles, although they each became deeply associated with the roles they portrayed. So Lugosi's heirs can't stop the portrayal of Dracula.

On the other hand, Charlie Chaplin did create the Little Tramp and Spank McFarland created Spanky from Our Gang Fame. Each of these roles would be protected by assertion of a right of publicity against a person portraying the role, even if the actor, excepting the costume and mannerisms, did not resemble Chaplin or McFarland.

Our problem, then, was to dress an actor to look like the movie Count in order to immediately conjure up an image of the Universal Studios film, while at the same time avoid trampling Mr. Lugosi's right of publicity which, being a property right under California law, descended to his heirs.

Our client's solution should be fairly simple, but the United States Court of Appeals for the Ninth Circuit has decided two cases in the last decade that substantially complicate whether our client can use an actor to portray the legendary vampire without acquiring rights from Lugosi's estate.

In a stunning 1992 decision, that Court held that the right of publicity extends not just to the name, likeness, voice and signature of a famous person, but to anything at all that resembles the person's identity. That case involved the performer Vanna White and its holding was severely criticized by both the minority and judges outside of the Ninth Circuit. Nevertheless, for celebrities whose persona resides within that judicial circuit, this case cannot be ignored.

To reinforce the notion that the Vanna White decision is alive and well, the Ninth Circuit struck again, this time concerning the rights of publicity belonging to characters from the *Cheers* T.V. show.

What happened in that case was that Host International bought a license from Paramount to open a line of *Cheers* airport bars. The bars were populated with animatronic figures resembling Norm and Cliff. One was fat, the other dressed as a mailman.

The actors who portrayed Cliff and Norm sued Host for violation of their rights of publicity. The district court tossed the case because the robots didn't look like the plaintiffs. The facial features were totally different, ruled the Court. But the appellate court reversed, stating that there were issues of material fact concerning the degree to which the robots looked like the plaintiffs.

According to Judge Kozinski, writing the minority opinion in the *Host* case, ... to millions of viewers, [plaintiffs] are Norm and Cliff; it's impossible to exploit the latter without also evoking thoughts about the former.

Under *White*, it is likely that a right of publicity is infringed merely by evoking thoughts. If Judge Kozinski is correct, any depiction of a licensed character might evoke images of the actor associated with the role: Weismuller as Tarzan, and George C. Scott as Patton, to name a couple. Applying these recent decisions it becomes questionable whether a bare studio license to depict this role is enough. This is especially true when it is the intent of an advertiser to recreate the movie role, in this case, Dracula as produced by Universal Studios in the 1930's.

Outside the Ninth Circuit, our client's protection is the Copyright law, in as much as the studio must have the right to reproduce and license others to reproduce the characteristics that bring roles like Dracula, Norm and Cliff to mind. All jokes aside about California being different from the rest of the country, the Ninth Circuit does appear to ignore copyright law and its preemption, under these circumstances, of a cause of action for violation of the right of publicity. The United States Court of Appeals for the Seventh Circuit has recognized this preemption in dealing with a baseball player's

right of publicity versus the club's right to telecast the game under copyright law – a more reasoned decision to be sure.

In the end, is an advertiser who conjures up the image of a performer, without using a look-alike, exposed to liability? As long as *White* and *Host* are good laws, the answer must be “who knows”.

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