

The logo for Astrachan Gunst Thomas features a stylized, swirling graphic in shades of blue and grey behind the firm's name.

astrachan gunst thomas

a professional corporation
attorneys at law
baltimore . washington, d.c.
www.agtlawyers.com

A Candle in the Wind.
Don't Move to Maryland, Elton John

By: Jim Astrachan

A recent New York court decision put the kibosh on the late Marilyn Monroe's rights of publicity, and exemplifies why a national celebrity must not make Maryland his domicile.

The right of publicity is a state law created intellectual property right that reserves to a person – celebrity or not – the exclusive right to exploit the value of his or her persona in commercial advertising. Simply stated, a person has the right to prevent the unauthorized use of his name, photo, likeness, image and voice in advertising or to permit the use and be paid. Damages for violation of this right can be large. Ask the whiskey-voiced singer Tom Waits, who recovered \$2.6 million from Frito-Lay when a Waits sound alike was used in a junk food commercial. The value of this right can be enormous. Consider the revenues generated by exploiting Elvis' name and persona.

There are no federal laws governing this right, except perhaps the ability to claim under the Lanham Act that the use of a celebrity's name implies false endorsement of the advertised product, but the opportunity to claim false endorsement is very rare. Thus, if a celebrity wants to protect his right of publicity he will need to rely on either state common or statutory law.

The modern view is to treat the right of publicity as a property right that can be assigned and bequeathed. The golfer, Tiger Woods, has assigned his right of publicity to his corporate alter ego, ETW, with the instruction that the corporation engage in all licensing of Tiger's right of publicity and the policing of all infringements. John Wayne's estate licensed the Duke's image to Coors for beer ads decades after his death. Consider, also, the millions of tshirts sold worldwide that bear Elvis' name and likeness.

Thirty-six states have recognized the right of publicity, with eighteen of those states enacting statutes that define publicity rights and punish infringement, including California, the state where most movie and TV celebrities have established domicile. The remainder of the states recognize this right under common law.

Maryland does not have a statute and surprisingly, it appears not to even recognize this right under common law even though there is a decades-old decision involving The Baltimore Sun in which the Maryland Court of Appeals correctly declined to find a violation on the basis that the use of a woman's photo to advertise the Sun was incidental because her photo had originally appeared in the Sun as news. That decision did recognize the incidental use exception to a violation of rights under the RESTATEMENT (Second) OF TORTS. But a national treatise fails to even recognize that Maryland has acknowledged the existence of the right of publicity, the Sun notwithstanding.

The Maryland problem goes deeper than whether the right even exists. The publicity right can earn millions for a live celebrity when an advertiser seeks the celebs association with its products. But the publicity rights can earn even more millions of dollars over many years for the heirs or assigns of a deceased celebrity - think Elvis - but only if the law of domicile at the time of death recognizes the right **and** the descendibility or inheritability of the right. Maybe Maryland does recognize the right; it certainly does not recognize that the right is descendible.

Many of the common law states recognize that these rights are descendible. Nearly all of the state statutes provide for descendibility. California, for example, allows these post mortem rights to survive for 70 years; Indiana and Oklahoma for 100 years.

Cast against this legal backdrop is the case of one of America's most famous sex symbol, Marilyn Monroe, and the infringement of her exceptionally valuable right of publicity that she supposedly bequeathed to her acting coach, Lee Strasberg following her 1962 death.

The facts of this are complex, but here's the abridged version. The Shaw Family Archives owns many photos of Monroe to which the Archives claim the copyright. It began to license these photos for use on T-shirts sold in Target stores and it was sued for infringement in Indiana, and the case was transferred to New York.

Monroe left a will in which she bequeathed her residuary estate to Strasberg; she did not specifically name publicity rights as passing under the will. She died domiciled in New York or California, but where was irrelevant to the court because – and here's the crucial point – neither state recognized a **descendible** right of publicity at the time of her death.

In 1984, 22 years after Ms. Monroe's death, California enacted laws recognizing a post mortem right. New York did not, but intensive lobbying is occurring to do so. When the heirs contended that these later enacted California post mortem rights controlled, the court called that contention "untenable." As a result, the court held any publicity rights she enjoyed while alive died with her by operation of law.

The majority rule is that the law or domicile at the time of a testator's death applies to all questions of construction of the will. If a testator does not have a property right at the time of death, or if that right is extinguishable at death, the testator has nothing to bequeath.

Whether a celebrity domiciled in Maryland has a right of publicity has yet to be clearly established by our courts. No Maryland court, however, has ever ruled whether this right, if and to the extent it exists, is descendible as a property right.

The Maryland legislature should consider the enactment of legislation patterned after the many existing state statutes in order to clarify the existence of this right and declare that this right is descendible. Until that occurs, or until the Court of Appeals rules favorably in an applicable case – and I know of none pending – no celebrity who values his right of publicity, during or after life, should be domiciled in Maryland unless doing so is for the estate tax purpose of being able to value those rights at absolute zero.

James B. Astrachan is the author of The Law of Advertising, published by Matthew Bender-Lexis/Nexis.