

Shake It Off, Arnold

By all rights, Gov. Schwarzenegger should not defeat the bobble-head.

By Marc S. Cooperman and Brian C. Kwok

a All the late-night mocking by Leno and Letterman have apparently pushed the Governor past his limit. In an effort to prove to the world that he has a firm head on his shoulders, Arnold Schwarzenegger is suing a doll manufacturer for marketing bobbing-head dolls bearing his name, photograph, and likeness without his permission.

The bobble-head dolls portray the California governor in a statesman-like business suit and military bandoleer, brandishing an assault rifle. The bobble-head packaging juxtaposes depictions of Schwarzenegger as a politician with depictions of him as a Hollywood action hero.

On April 30, Schwarzenegger's production company, Oak Productions Inc., filed a complaint

in Los Angeles Superior Court alleging that doll manufacturer Ohio Discount Merchandise Inc. (ODM) is misappropriating his name, photograph, and likeness for commercial purposes. The governor believes that by advertising, marketing, promoting, and selling the Arnold Schwarzenegger bobble-head dolls, ODM is infringing on his publicity rights and committing the commercial tort of unfair competition. He seeks relief in the amount that ODM has been "unjustly enriched," as well as punitive damages, and has petitioned for preliminary and permanent injunctions enjoining ODM from further use of his publicity rights.

ODM responds that the manufacture of Schwarzenegger bobble-head dolls is constitutionally protected under the First Amendment. The company asserts that the bobble-head dolls are constitutionally privileged free speech and do not violate anyone's rights of publicity.

PUBLICIZING ONESELF

Schwarzenegger's suit is premised on the common law right of publicity—that is, a person's right to control the commercial use of his own

identity. The right of publicity was first recognized by the U.S. Court of Appeals for the 2nd Circuit in *Haelan Laboratories Inc. v. Topps Chewing Gum Inc.*, 202 F.2d 866 (1953), where the court held that a baseball player had the right to grant the exclusive privilege of publishing his picture to a manufacturer for commercial purposes. The 2nd Circuit explained that without the right of publicity, many prominent persons would not be compensated for the commercial use of their likenesses.

Twenty-four years later, the U.S. Supreme Court recognized the right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977). The Court likened the rationale for the right of publicity to that for patents and copyrights—to provide an economic incentive for the performer.

Although the reach of the publicity right appears broad, it is limited to commercial contexts. Schwarzenegger has the right to prevent people from using his likeness to make money in a strictly commercial setting. For example, he could argue that a manufacturer of steroids cannot use his name, likeness, or photograph to advertise its products without infringing on his right of publicity.

SCHWARZENEGGER VS. THE FIRST

Where the governor/action hero probably does not have a case is where his name, likeness, or photograph is being used in the news or for any other non-commercial purpose. There the right of publicity is significantly constrained by the First Amendment privilege of free speech.

Political speech lies at the heart of the First Amendment. Thus, in a right-of-publicity action that implicates political expression, the courts must balance commercial publicity rights with the protections of the First Amendment.

Of course, Schwarzenegger's longtime attorney is not seeking to litigate this case on free speech grounds. In a letter demanding that ODM immediately cease and desist selling the bobble-head dolls, Martin Singer of the Los Angeles entertainment litigation firm Lavelly & Singer cited *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), to support the right-of-publicity action. In that case, Ford hired a "sound-alike" to sing "as much as possible" like Bette Midler in a commercial to sell automobiles. The 9th Circuit held

that deliberately imitating the distinctive voice of a professional singer is actionable when it is used to sell a product.

Unfortunately for Schwarzenegger, because of the political and "transformative" nature of ODM's bobble-head doll, that kind of favorable precedent is in short supply. Far more daunting for his case are decisions like *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003).

In *Winter*, the California Supreme Court applied a balancing test to find that a publisher did not infringe on two aging rock stars' rights of publicity by including likenesses of the musicians in a comic book. The court ruled that the comic book transformation of Edgar and Johnny Winter into Johnny and Edgar Autumn contained "significant creative elements." The comic books did not depict the plaintiffs literally; instead, they distorted their images for the purposes of lampoon, parody, or caricature.

The state court in *Winter* likened its holding to that in *Cardtoons v. Major League Baseball Players*, 95 F.3d 959 (10th Cir. 1996). There the 10th Circuit held that trading cards that caricature and parody prominent baseball players deserve First Amendment protection. *Cardtoons* produced trading cards that ridiculed many Major League Baseball players using a variety of themes. The cards violated an Oklahoma statute that prohibited the use of a person's name or likeness on commercial merchandise without consent.

Nonetheless, the 10th Circuit recognized *Cardtoons*' First Amendment defense—that the cards provided social commentary on public figures who are involved in a significant commercial enterprise. The court explained that the protections of the First Amendment have never been limited to newspapers, books, and comparatively more august outlets. Thus, even if the trading cards were not a traditional medium of expression, they were still subject to some First Amendment protection.

In reaching its conclusion, the 10th Circuit balanced Major League Baseball's publicity rights with the privilege of free speech. The court recognized that parody is a valuable form of self-expression and social criticism and a vital commodity in the marketplace of ideas. Restricting the use of celebrity identities for parody would restrict the communication of ideas. Elevating the right of publicity over the First Amendment right to free expression, the court concluded, would essentially

allow Major League Baseball to censor criticism of its members. According to the 10th Circuit, "the last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them."

ARNOLD IS A BOBBLE-HEAD

In other words, "Judgment Day" does not look promising for Schwarzenegger, given his new political role. As in *Winter* and *Cardtoons*, the Schwarzenegger bobble-head dolls are not literal depictions of the governor. They include transformative elements that distort Schwarzenegger's image for satire, parody, or caricature.

In particular, dressing the doll in a business suit while arming him with an assault rifle obviously juxtaposes Schwarzenegger's role as a governor with his celebrity career. But more broadly, the form of the expression itself—the figurine with a disproportionately sized head that bobs in all directions—has something to say. The doll may represent the artist's own self-expression, or it may be a form of social criticism that allows the artists to communicate their ideas.

And what exact ideas do they want to communicate? Given the added First Amendment protection afforded ODM because of the core "political speech" included, it doesn't really matter. The message could be as simple as, "Arnold is a bobble-head."

Whether or not the artists are poking fun at the idea of "The Terminator" as governor, ODM is likely protected under the First Amendment. Just like those trading cards in *Cardtoons*, bobble-head dolls do not become pure commercial speech, which can be barred under the right of publicity, just because they are sold for profit. Indeed, it can be argued that the bobble-head dolls express both the artist's and the purchaser's views of Schwarzenegger as a public figure.

The key distinction here is that with the bobble-head dolls, the likeness of a public figure is not being usurped merely to advertise another product unrelated to the public figure. As the Supreme Court wrote in *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557 (1980), commercial speech is "expression related solely to the economic interests of the speaker and its audience." And this means that the *Midler* case that Schwarzenegger's attorney cited is most likely not on point when it comes to bob-

ble-heads. A reasonable facsimile of Bette Midler's voice was used in an advertisement to sell automobiles that had absolutely no connection to Midler. Here, Schwarzenegger's likeness is part and parcel of the product itself.

SAY 'HASTA LA VISTA'

The limited case law illustrates that the First Amendment may outweigh the rights of publicity for all public figures, including celebrities who sell their own image. However, Schwarzenegger is not just any celebrity—he is also the governor of California. As a politician, Schwarzenegger does not get to play by the same rules as other movie stars.

Specifically, the law has long protected the right of the public to subject politicians to unbridled, unrestrained commentary and criticism, as the court put it in *Paulson v. Personality Posters Inc.*, 299 N.Y.S.2d 501 (N.Y. Sup. Ct. 1968). There, the court held that even a comedian who conducted a mock campaign for the presidency could not prevent a commercial printer from marketing posters of him. The strength of our democracy and the First Amendment is rooted in Americans' freedom to criticize their political system in any way they please.

Even assuming that Schwarzenegger arguably had a viable right-of-publicity case as a celebrity, he essentially said "hasta la vista" to such a claim when he took office. This is not to say that he has literally waived all his publicity rights, but in the context of commentary on his

political aspirations, the First Amendment protects the commentators. Just like he has to put up with ridicule on the "Tonight Show" and the Internet (have you seen the new proposed seal for the State of "Kahlifoania," which depicts Arnold as a muscular Conan the Barbarian?), the Governor must put up with being treated as a bobble-head.

Nor will the economic incentive policy that underlies the right of publicity rescue Schwarzenegger. It would take a Terminatorlike attack to establish that he would not have sought office if he had known that these dolls were going to be made. Especially damning to any argument that he expected to profit financially from his political career is the fact that he has refused his government salary as governor.

EVERYONE ELSE IS DOING IT

Schwarzenegger is not the only political figure to be so honored with his own bobble-head doll. ODM also sells likenesses of George W. Bush, Ronald Reagan, Richard Nixon, Hillary Clinton, and other well-known political figures. As of now, none of them has followed Schwarzenegger's lead and headed to court.

Remember Spiro Agnew, the not-beloved-by-all vice president of the early Nixon years? During Agnew's term in office, there were unflattering Agnew wristwatches, dartboards, and punching bags. Although Agnew's attorney initially objected, ultimately

there was no litigation. According to J. Thomas McCarthy's *The Rights of Publicity and Privacy*, the manufacturer of the dartboard asserted that it was "legitimate social satire of a critical nature" and opined that any lawsuit would be "a good test of the First Amendment."

Similarly, Schwarzenegger's suit may clarify whether a celebrity-turned-politician is afforded more publicity rights than mere politicians. Let us hope that the answer is no.

The First Amendment privilege of free speech is rooted in our democratic values. The Constitution guarantees each citizen the right to express political viewpoints and provide commentary even if it is irritating to the objects of that commentary. This long-valued tradition cannot be compromised by giving a political figure the power to censor political speech—even if commercial aspects are mixed into the commentary.

Arnold Schwarzenegger the celebrity chose to become Arnold Schwarzenegger the political figure. He is naturally and intentionally the focus of political free speech. If he can't accept the public's right to make fun of him, he should look for another starring role. ■

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