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PRESERVING FILM PRESERVATION FROM THE RIGHT OF PUBLICITY[1]

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INTRODUCTION

Newly available digital tools enable content producers to recreate or reanimate people's likenesses, voices, and behaviors with almost perfect fidelity. We will have soon reached the point (if we haven't already) when a movie studio could make an entire "live action" feature film without having to film any living actors. Computer generated images (CGI) could entirely replace the need for human beings to stand in front of cameras and recite lines.

Digital animation raises a number of important legal and social issues, including labor relations between actors and movie studios, the creation and dissemination of fake news items, and the production of

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so-called pornographic "deep fakes."[2] Already, parties are pushing for legal responses that will curtail what they see as the downsides of digital reanimation. In particular, some are arguing for more expansive rights of publicity as a way of limiting nonconsensual digital animation.[3]

Whatever its costs, however, digital reanimation has a number of major benefits. Here, we would like to focus on one: its contribution to film restoration.[4] Film stock is notoriously fragile, and many of the most important cinematic works exist only in damaged and degraded form.[5] Restoring these works has been incredibly time consuming and expensive. Moreover, some portions of movies are so damaged that they simply cannot be restored through traditional means. Digital reanimation offers an opportunity to restore old works to their original luster and to expand their availability to millions of people.

Preservation and restoration of old films is a hugely important cultural matter. As UNESCO asserted when adopting recommendations for film preservation in 1980: "[M]oving images are an expression of the cultural identity of peoples, and because of their educational, cultural, artistic, scientific and historical value, form an integral part of a nation's cultural heritage."[6] The U.S. Congress has similarly concluded that film preservation and restoration serve important cultural goals.[7]

In this comment, we argue that whatever courts and legislatures decide to do about the other issues raised by digital animation, they

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2 *See* Mark A. Lemley & Eugene Volokh, *Law, Virtual Reality, and Augmented Reality*, 166 U. PA. L. REV. (forthcoming 2018); Kevin Roose, *Here Come the Fake Videos, Too*, N.Y. TIMES (Mar. 4, 2018), https://www.nytimes.com/2018/03/04/technology/fake-videos-deepfakes.html (discussing how "[a]rtificial intelligence video tools make it relatively easy to put one person's face on another person's body with few traces of manipulation").

3 *See, e.g.*, Thomas Glenn Martin Jr., Comment, *Rebirth and Rejuvenation in a Digital Hollywood: The Challenge Computer-Simulated Celebrities Present for California's Antiquated Right of Publicity*, 4 UCLA ENT. L. REV. 99 (1996); *Right of Publicity*, SAG-AFTRA, https://www.sagaftra.org/right-publicity (last visited Mar. 7, 2018) ("As you've seen in recent movies and video games, content creators can now create new photo-realistic performances of even deceased performers. Without the right of publicity, a state-based intellectual property right recognized throughout the country, performers and their heirs have no law on the books to protect them.").

4 All of the arguments in this article will focus on film restoration, but they are equally applicable to restoration of sound recordings. *See* Dietrich Schuller, *The Ethics of Preservation, Restoration, and Re-Issues of Historical Sound Recordings*, 39 J. AUDIO ENGINEERING SOC'Y 1014 (1991).

5 1 ANNETTE MELVILLE & SCOTT SIMMON, LIBRARY OF CONG., FILM PRESERVATION 1993: A STUDY OF THE CURRENT STATE OF AMERICAN FILM PRESERVATION (1993).

6 UNESCO Res., 21st Sess., Records of the General Conference, Annex: Recommendation for the Safeguarding and Preservation of Moving Images at 156 (Oct. 28, 1980), http://unesdoc.unesco.org/images/0011/001140/114029e.pdf#page=153.

7 National Film Preservation Act of 1988, Pub. L. No. 100–446, 102 Stat. 1782–88 (codified as amended at 2 U.S.C. §§ 179*l*–179w, 36 U.S.C. §§ 151701–151712 (Supp. IV 2016)); Copyright Term Extension Act, Pub. L. No. 105–298, 112 Stat. 2827–29 (codified at U.S.C. §§ 17 U.S.C. 108, 203(a)(2), 301(c), 302, 303, 304(c)(2) (2012)).

should preserve the ability to use digital technology to restore and remaster existing works. In this case, at least, the benefits of digital reanimation thoroughly swamp any possible costs (and frankly, we have a hard time finding any meaningful costs). Courts and legislators should ensure that publicity rights are never allowed to trump society's interest in having access to already created works of culture.

Below, in Part I, we briefly describe the technology that enables digital animation and the restoration of existing films. Part II discusses some current and pending legal issues with rights of publicity that potentially put digital restoration at risk. Finally, Part III argues that whatever happens with rights of publicity for newly created works, they should not be allowed to limit restoration of existing ones.

I. COMPUTER ANIMATION AND FILM RESTORATION

Although the techniques for digital animation of performers seem new, they have been around for quite a while. Computer animation originated in the mid-twentieth century[8] and was first used in commercially distributed feature films in the 1970s.[9] By the 1990s, television and feature film producers had begun completely composing works with digital imagery.[10] Digital animation and imaging have since become staples of film and television production in ways ranging from the fantastic to the mundane.[11]

At first, the film industry considered the accurate digital recreation of human actors, with whom audiences could emotionally connect, to be a distant dream.[12] In the past decade, however, technology has advanced

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[8] *See* John Wenz, *These Retro Computer Animations Were Way Ahead of Their Time*, POPULAR MECHANICS (June 25, 2015), https://www.popularmechanics.com/technology/design/a16205/these-early-computer-animations-show-how-far-weve-come (noting that "computer-generated graphics have existed since the early 1960s," and providing a number of examples of computer-generated animation from the 1960s and 70s).

[9] Larry Yaeger, *A Brief, Early History of Computer Graphics in Film*, SHINYVERSE.ORG, http://shinyverse.org/larryy/cgi.html (last updated Aug. 16, 2002) (noting that "[t]he first feature film to use digital image processing was *Westworld*, in 1973").

[10] TOM SITO, MOVING INNOVATION: A HISTORY OF COMPUTER ANIMATION 188, 260 (2013) (noting that "the first animated TV series completely done on computer" were "*Inspektors* and . . . *Reboot*," which "debuted in the 1990s" and that "*Toy Story* was . . . the first all-CG film").

[11] Dreamworks Animation SKG, Inc., Annual Report (Form 10-K), at 3–4 (Mar. 28, 2005) (noting that in 2001, due to the success of its CG animated films, Dreamworks Animation shifted to producing only CG animated films, other than films produced with renowned stop-motion studio Aardman Animations); *Pixar*, BOX OFFICE MOJO, http://www.boxofficemojo.com/franchises/chart/?id=pixar.htm (last visited Mar. 3, 2018) (noting that Pixar Animation Studios's 19 feature films have grossed just shy of $12 billion at the global box office); *31 Mind-Blowingly Ordinary Scenes You Won't Believe Are CGI*, CRACKED (Feb. 25, 2015), http://www.cracked.com/pictofacts-269-31-mind-blowingly-ordinary-scenes-you-wont-believe-are-cgi.

[12] Karen Kaplan, *Old Actors Never Die; They Just Get Digitized*, L.A. TIMES (Aug. 9, 1999), http://articles.latimes.com/1999/aug/09/business/fi-64043. (noting that then-President of the Screen Actors Guild, Richard Masur, said that his union's members are not concerned about

such that the dream has become a reality. For instance, digitally de-aging movie stars has recently become a trend in filmmaking.[13] This technique was taken one step further in *Rogue One: A Star Wars Story*, where the late Peter Cushing was digitally resurrected with the help of a motion-capture stand-in, allowing his character, Grand Moff Tarkin, to play a significant supporting role in the film.[14] As technology allows for increasingly realistic three-dimensional recreations of real people, holograms have begun to sell concert tickets and artists sign contracts with the possibility of digital resurrection in mind.[15]

Digital animation is not solely a matter of creating new movies like *Star Wars* or *Avatar*. It also plays an essential role in the digital restoration process. Film owners have long distributed and presented altered versions of their films.[16] For most of the history of the motion picture industry, film materials were transferred from film to videotape, via telecine, for preservation, airing on broadcast television, and, eventually, home video distribution.[17] Further, in order to preserve the original quality and attributes of filmed motion pictures, movies were often transferred from film stock to film stock.[18]

As the preferred media of motion picture production and theatrical exhibition has shifted away from physical celluloid film over the past few decades, digital interventions have played increasingly greater roles in film preservation and restoration processes.[19] After an original

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being replaced by virtual copies, and discussing how an audience may not develop an emotional connection with a virtually-created actor like they would with a flesh-and-blood human); *see also* Nathan Birch, *6 Insane Attempts to Make Movies Starring Dead Movie Stars*, CRACKED (Aug. 13, 2010), http://www.cracked.com/article_18659_6-insane-attempts-to-make-movies-starring-dead-movie-stars.html (discussing films shoddily cobbled together by producers and directors using footage of deceased actors).

13 *See, e.g.*, Joanna Robinson, *Robert De Niro is the Next Acting Legend to Get a Dramatic C.G.I. Facelift*, VANITY FAIR (Dec. 20, 2016, 6:43PM), https://www.vanityfair.com/hollywood/2016/12/robert-de-niro-digital-facelift-the-irishman-martin-scorsese.

14 Alexi Sargeant, *The Undeath of Cinema*, NEW ATLANTIS, Summer/Fall 2017, at 17, https://www.thenewatlantis.com/docLib/20171117_TNA53Sargeant.pdf.

15 *Actors Seek to Protect Posthumous Use of Big-Screen Image*, NEWSWEEK (Dec. 30, 2016, 4:55 PM), http://www.newsweek.com/hollywood-actors-film-movies-carrie-fisher-537461.

16 Warren H. Husband, *Resurrecting Hollywood's Golden Age: Balancing the Rights of Film Owners, Artistic Authors and Consumers*, 17 COLUM.-VLA J. L. & ARTS 327, 327 n.3, 356–57 (1993) (noting panning and scanning, time compression and expansion, and the re-editing of a film or its soundtrack as ways that films have been edited for broadcast distribution, and discussing how film colorization led to increased interest in original black and white versions of films and greater preservation efforts, which in turn "produce[d] restored, higher quality, *complete* prints of old black and white films that never existed before.").

17 *Telecine*, MERRIAM-WEBSTER, https://www.merriam-webster.com/dictionary/telecine (last visited Mar. 8, 2018).

18 FED. AGENCIES DIGITIZATION GUIDELINES INITIATIVE, DIGITIZING MOTION PICTURE FILM: EXPLORATION OF THE ISSUES AND SAMPLE SOW 3 (April 18, 2016), http://www.digitizationguidelines.gov/guidelines/FilmScan_PWS-SOW_20160418.pdf.

19 *See, e.g.*, Mark Caro, *'*Vertigo*': The Restoration*, CHI. TRIB., Oct. 27, 1996, at C5 (discussing in detail how Alfred Hitchcock's *Vertigo* was preserved in the mid-1990s, and that no digital manipulation was done to any imagery, but digital manipulation of audio was deemed necessary); Christine Bunish, *Sound & Picture Restoration*, POST MAG. (Nov. 1, 2012), http://

physical film negative is scanned to digital, each frame is re-touched through both automated and manual processes.[20] For example, when Sony Pictures recently began the process of creating a new 4K digital cinema version of *Lawrence of Arabia*, it had to deal with a film negative that was badly scratched, was missing sections, and had vertical bands running across the image in several scenes.[21] Ultimately, Sony developed a computer algorithm for fixing the film that included digital restoration and color grading techniques.[22]

Similar processes are used when films thought to have been "lost" are rediscovered. For example, from 1913 until 1993, the color version of George Méliès's classic film *A Trip to the Moon* was considered definitively lost.[23] When a color print was discovered in a donation from a private collector in 1993, technology was not yet up to the task to actually restore the film, so the nitrate film prints were tediously unpeeled, unrolled, digitized, and stored on a hard drive until the technology had developed.[24] Eventually, the film received a full-scale digital restoration that garnered substantial acclaim.[25]

Digital techniques already exist to reproduce damaged film frames. Typically, for films to be returned to their original quality, some existing film stock must be used as part of the restoration process. Yet this may soon change. Although we do not know of any movies where an entire shot or scene has been digitally recreated, we can imagine it happening sooner rather than later. Many films are effectively "lost" because they are so thoroughly damaged,[26] but digital techniques will soon make their restoration and preservation possible.

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www.postmagazine.com/Publications/Post-Magazine/2012/November-1-2012/Sound-Picture-Restoration.aspx (discussing how digital tools have made restoring a number of films less costly and more effective); Erin McCarthy, *How to Restore a Classic Film Like* Jaws *for Blu-ray*, POPULAR MECHANICS (Aug. 14, 2012), https://www.popularmechanics.com/culture/movies/a7910/how-to-restore-a-classic-film-like-jaws-for-blu-ray-11651966.

20 Michael Hession, *How Criterion Collection Brings Movies Back from the Dead*, GIZMODO (Feb. 14, 2014, 1:00 PM), https://gizmodo.com/how-criterion-collection-brings-movies-back-from-the-de-1501343511.

21 Bunish, *supra* note 19.

22 *Id.*

23 Daniel Eagan, *A Trip to the Moon as You've Never Seen It Before*, SMITHSONIAN.COM (Sept. 2, 2011), https://www.smithsonianmag.com/arts-culture/a-trip-to-the-moon-as-youve-never-seen-it-before-68360402; Sophia Savage, *Cannes 2011: Méliès's Fully Restored A Trip To The Moon in Color To Screen Fest's Opening Night*, INDIEWIRE (May 2, 2011, 6:06 AM) http://www.indiewire.com/2011/05/cannes-2011-meliess-fully-restored-a-trip-to-the-moon-in-color-to-screen-fests-opening-night-185510.

24 *See* sources cited *supra* note 23.

25 A.O. Scott & Manohla Dargis, *Old-Fashioned Glories in a Netflix Age*, N.Y. TIMES (Dec. 14, 2011), https://www.nytimes.com/2011/12/18/movies/awardsseason/film-favorites-of-a-o-scott-and-manohla-dargis-in-2011.html.

26 *See* MELVILLE & SIMMON, *supra* note 5 (noting that "fewer than 20% of the features of the 1920s survive in complete form").

II. PUBLICITY RIGHTS AND FILM RESTORATION

Film restoration potentially implicates a number of different legal interests. When films are covered by a federal copyright, their restoration is subject to the consent of the copyright holder because restoration requires reproduction of the original film. Yet even when the original film has entered the public domain and is otherwise free to copy, the film's actors might claim that restoration of the work—and thus, of their performance—requires their consent. Actors may assert that restoration, by recreating their likenesses and characteristics, intrudes upon their rights of publicity.[27] In this Part, we briefly explain the legal arguments that actors might be tempted to use. We focus on New York law both because we currently reside in New York and because, at the time of this writing, New York is considering passage of a new statute that could affect rights of publicity.

New York's right of publicity arises under a 1903 privacy statute.[28] The statute attempts to protect the misappropriation of a person's likeness for commercial uses such as trade or advertising.[29] Thus, when a clothing designer published an advertisement using a look-alike of Jacqueline Kennedy Onassis to attract attention to itself, the plaintiff was entitled to enjoin the advertisement and seek damages.[30] Even easier are cases when a defendant uses an actual photo of the plaintiff to sell or promote products. For instance, Hollywood star Cary Grant had a valid right of publicity claim against Esquire when they attached a picture of his face to the dressed torso of another model for purpose of advertising clothing.[31] In cases like these, when a person's likeness or identity is used nonconsensually to advertise products, the plaintiff will be allowed to enjoin the use and recover damages.

As in other states, New York courts have generally—although not

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27 *See* Rebecca Tushnet, *A Mask That Eats into the Face: Images and the Right of Publicity*, 38 COLUM. J. L. & ARTS 1 (2015); Craig A. Wagner, Note, *Motion Picture Colorization, Authenticity, and the Elusive Moral Right*, 64 N.Y.U. L. REV. 628, 669–78 (1989) (discussing right of publicity and right of privacy claims against film colorizers).

28 N.Y. CIV. RIGHTS LAW § 50 (McKinney 1909). The statute attaches liability for only uses "for advertising purposes, or for the purposes of trade." *See id.* It excludes from its reach persons "practicing the profession of photography" among other expressive content as "literary, musical or artistic productions." *See* N.Y. CIV. RIGHTS LAW § 51 (McKinney 1995); *see also* Haelan Labs, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953) ("We think that, in addition to 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. . . This right might be called a 'right of publicity.'"); 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 6:81 (2d ed. 2017).

29 *See generally* JENNIFER E. ROTHMAN, THE RIGHT OF PUBLICITY: PRIVACY REIMAGINED FOR A PUBLIC WORLD (2018).

30 Onassis v. Christian Dior, N.Y., Inc., 472 N.Y.S.2d 254 (N.Y. Sup. Ct. 1984) (referring the case to a magistrate for a discovery on whether there was an actual advertising purpose for the picture).

31 *See generally* Grant v. Esquire, Inc., 367 F. Supp. 876 (S.D.N.Y. 1973)

consistently—interpreted the privacy right's scope to exclude certain "expressive" or noncommercial uses of a person's likeness.[32] These exceptions emerge both from the First Amendment right to protected speech and from the copyright interests of other parties.[33] In that regard, the right of publicity typically only protects someone from nonconsensual uses of their protected attributes in "commercial speech." New York has endorsed this approach and has generally excepted from protection purely expressive and artistic uses of a person's name or likeness.[34] Thus, the University of Notre Dame's president and football team were exempted from protection when depicted in a highly farcical book and motion picture about football's power to affect religion and international relations.[35]

The scope of the expressive use exception is, unfortunately, not altogether clear in New York even though it is perhaps clearer than in other jurisdictions.[36] Even expressive and artistic works will often be tied to some commercial or profit-driven motives. Thus, just because a work is fictitious or creative does not mean that New York allows the use of anyone's publicity rights without their consent.[37] This issue often arises in the docudrama context. In contrast to purely expressive and parodic works that use public figures but are protected by the First Amendment, such as a satirical television show like *South Park*, docudramas potentially incur liability when they are substantially fictitious.[38] In a recent and unusual opinion, the Appellate Division held that production of a partially fictionalized "biopic" of a person's life

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32 *See generally* Jennifer E. Rothman, *Commercial Speech, Commercial Use, and the Intellectual Property Quagmire*, 101 VA. L. REV. 1929 (2015).

33 *Id.;* MCCARTHY, *supra* note 28, § 8:12 ("Different types of constitutional 'speech' are given different levels of weight in a constitutional balancing with countervailing tort or property interests. . . Fictional 'stories' are given the next highest priority, [under news], as being both potentially informative and entertaining." Whereas advertising is given the lowest level of protection.).

34 *See* Bery v. City of New York, 97 F.3d 689, 695 (2d Cir. 1996) ("Visual art is as wide ranging in its depiction of ideas, concepts and emotions as any book, treatise, pamphlet or other writing, and is similarly entitled to full First Amendment protection."). *But see* Yasin v. Q-Boro Holdings, L.L.C., No. 13259/09, 2010 WL 1704889 (N.Y. Sup. Ct. Apr. 23, 2010) (holding that the nonconsensual use of a photograph on a fictional book was for advertising purposes and thus protected).

35 Univ. Notre Dame du Lac v. Twentieth Century-Fox Film, Corp., 256 N.Y.S.2d 301, 302–07 (N.Y. App. Div. 1965) ("Motion pictures . . . are a significant medium for the communication of ideas; their importance as an organ of public opinion is not lessened by the fact that they are designed to entertain as well as to inform; . . . they are a constitutionally protected form of expression[.]") (internal citations and quotation marks omitted).

36 *See* Tushnet, *supra* note 27; Rothman, *supra* note 32, at 1933 ("To date, no convincing basis has been articulated for distinguishing commercial and noncommercial speech and uses in IP laws.").

37 *See* Rothman, *supra* note 32.

38 *See* Porco v. Lifetime Entm't Servs., L.L.C., 47 N.Y.S.3d 769, 771–72 (N.Y. App. Div. 2017) ("The Court of Appeals has held that statutory liability applies to a materially and substantially fictitious biography") (internal citation and quotation marks omitted).

might require the subject's consent.[39] The problem seems to arise when a creator uses the potentially newsworthy person's publicity rights as an advertising hook to engender a wider audience for the author's purely fictitious story: "an advertisement in disguise."[40] However, in order to invoke protection in these cases the plaintiff must be the main focus of the work in question. Therefore, the merely "incidental" nonconsensual appearance of a person's publicity rights in an expressive and fictitious work would not be protected by the statutory right.[41]

Questions involving the reanimation of living or deceased actors raise somewhat different issues. When actors participate in films produced today, they typically assign any publicity rights with respect to that appearance to the film's producer.[42] The producer is also generally the owner of the copyright in the resulting picture.[43] The production company is thereby entitled to make, distribute, and advertise the film. But can the production company restore the film? If the production company licenses the rights to restore the film to another company, can it also transfer the license to the actors' publicity interests?[44] And what about works in the public domain—can these be freely restored without having to negotiate with all or some of the films' performers?

Cases from other jurisdictions have raised the specter of incurring liability for reproducing an actor's likeness in other creative or

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39 *Id.* This issue may turn on whether the fictitious embellishments are injected into, or passed off as, a true occurrence.

40 Messenger v. Gruner & Jahr Printing and Publ'g, 727 N.E.2d 549, 555 (N.Y. 2000)

41 *See* Ladany v. William Morrow & Co., 465 F. Supp. 870, 882 (S.D.N.Y. 1978) (holding that "the individual plaintiff must in fact be 'The subject' of the work in question" and that "[w]hat is 'incidental' cannot be determined without reference to the whole. . . [so] participation in a single scene" would be insufficient to state a cause of action under the New York statute.) (citing Damron v. Doubleday, Doran & Co., 231 N.Y.S. 444 (N.Y. Sup. Ct. 1928) *aff'd*, 234 N.Y.S. 773 (N.Y. App. Div. 1929)).

42 F. Jay Dougherty, *Not a Spike Lee Joint? Issues in the Authorship of Motion Pictures Under U.S. Copyright Law*, 49 UCLA L. REV. 225, 306 (2001) (noting that a "film producer would ordinarily engage actors under work-for-hire agreements, and thus the producer would be considered the author of the actors' contributions under U.S. copyright law").

43 *Id.* at 228.

44 On the alienability of publicity rights, see Jennifer E. Rothman, *The Inalienable Right of Publicity*, 101 GEO. L.J. 185 (2012). In many cases, "[T]he law defines the right of publicity as a form of 'property' right." *See* MCCARTHY, *supra* note 28, § 10:6. As a property right it may be assigned "in gross" or licensed in part by the owner of the right. *Id.* § 10:13; *see also* Haelan Labs. Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 869 (2d Cir. 1953) (rejecting the notion that "the right of privacy was purely personal not assignable") (internal quotation marks and citation omitted); Estate of Presley v. Russen, 513 F. Supp. 1339, 1350 (D.N.J. 1981) ("It has been shown that those parties who have entered into agreements with Elvis Presley, or with his Estate, to make use of the name, likeness and image of Presley have been licensees."). Thus, the scope of the transferability of the right of publicity is a creature of contract law. *See Haelan Labs*., 513 F. Supp. at 869 ("[P]laintiff, in its capacity as exclusive grantee of player's 'right of publicity,' has a valid claim against defendant if defendant used that player's photograph during the term of plaintiff's grant and with knowledge of it." And holding that a subsequent contract between the player and defendant was not valid until the original exclusive grant expired.).

expressive works.[45] For example, the California Supreme Court held that the owner of all of the rights of the comedy act The Three Stooges could assert a right of publicity claim against the maker of t-shirts that bore an original drawing of the troupe.[46] The court noted that the right to control their likeness is "essentially an economic right."[47] So although the defendant's reproduction of the Three Stooges' likeness may be entitled to some First Amendment protection, this use was insufficiently transformative (i.e., injected with creativity) to overcome plaintiffs' economic interest.[48] Similarly, the Ninth Circuit found a triable right of publicity claim under California law against an airport bar with animatronic robots based on the likenesses of actors from the show *Cheers*. Importantly, it was not the similarity to the *Cheers* characters, Norm and Cliff, that mattered (as those rights were held by the show's studio), but instead that the robots looked like the actual actors whose fame arose through the show.[49] In cases like these, courts attempt to balance plaintiffs' publicity interests with defendants' First Amendment interests, and they may be persuaded that the former outweigh the latter even for highly expressive or creative works.[50]

Situations like these also raise issues about the interplay between rights of publicity in expressive works and the set of rights and freedoms created by federal copyright law.[51] For instance, the U.S. District Court for the Southern District of New York held that parties claiming an interest in exploiting Marilyn Monroe's publicity rights could not block the production and distribution of public domain photographs of the star.[52] Whatever publicity interests the plaintiffs may have had could not be allowed to hinder freedoms established by federal

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45 *See, e.g.*, Doe v. TCI Cablevision, 110 S.W.3d 363, 373–74 (Mo. 2003) (finding liability for use of plaintiff's name in a comic book).

46 Comedy III, Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797 (Cal. 2001).

47 *Id.* at 807.

48 *Id.* 807–809 (borrowing the transformative use test from copyright's fair use defense, to say that when "artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.") (citing 17 U.S.C. § 107 (2012); then citing Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 575–76 (1977)).

49 Wendt v. Host Int'l, Inc. 125 F.3d 806, 811 (9th Cir. 1997) ("While it is true that appellants' fame arose in large part through their participation in Cheers, an actor or actress does not lose the right to control the commercial exploitation of his or her likeness by portraying a fictional character.").

50 Often, it seems, courts' views about the aesthetic value of the defendants' speech affects their balancing. Rothman, *supra* note 32, at 1981–82.

51 Tushnet, *supra* note 27.

52 *See* Shaw Family Archives Ltd. v. CMG Worldwide, Inc., No. 05 Civ. 3939(CM), 2008 WL 4298548 (S.D.N.Y. Sept. 11, 2008) (holding that the entities entitled to exploit Marilyn Monroe's likeness lacked the authority to license images of Monroe that fell into the public domain when the original holder of the copyright neglected to renew the copyrights. Likewise, the original holder of the copyrights lacked the authority to stop other uses).

copyright law.[53] Although cases like this one suggest that film restoration will not infringe actors' publicity rights, the legal landscape is not as clear as we might hope.[54]

In the context of film restoration, the interplay between publicity rights, the First Amendment, and copyright law is murkier than we would like. New York and other states grant individuals control over the recreation or reproduction of their likenesses in commercial media. But these rights are subject to significant limitations. New York's current statute contains an express limitation on publicity rights to situations involving commerce or trade. In addition, courts will prohibit assertions of publicity rights when they excessively chill other parties' speech interests. Finally, some courts have been reluctant to allow publicity rights to restrict activities that are otherwise allowable subject to copyright law, including the production of derivative works and the use of public domain materials.[55]

III. PRESERVING FILM PRESERVATION

The statutes and cases discussed in Part II give us reasons to be both hopeful and concerned about the opportunity of using digital animation to restore old films free from the encumbrance of actors' publicity rights. The First Amendment and federal copyright law should both trump the interests of performers in already created work to receive further compensation for those performances or to hold them up entirely. But some cases in New York and elsewhere have been less solicitous of creative expression than we would prefer.[56]

The situation is more concerning in light of a recently proposed overhaul of New York's statute which would replace its century-old regime with any entirely new publicity right that both broadens the scope of the protected interests and extends their duration forty years post mortem.[57] The proposed statute is being pushed by the Screen

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53 Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 UC DAVIS L. REV. 199 (2002).

54 The situation is further complicated by state-to-state variations in the duration of publicity rights. Unlike other jurisdictions such as California, New York's current right of publicity terminates upon the death of the individual, but only if the person dies while domiciled in New York. *See* Pirone v. MacMillan, Inc., 894 F.2d 579, 585 (2d Cir. 1990) ("The right of privacy protection, however, is clearly limited to 'any living person'" and "is personal to the individual and is extinguished upon his death") (internal citations omitted).

55 Tushnet, *supra* note 27. Actors generally will not be considered copyright authors of their performances. *See* Garcia v. Google, Inc., 786 F.3d 733 (9th Cir. 2015); *see also* Christopher Buccafusco, *A Theory of Copyright Authorship*, 102 VA. L. REV. 1229 (2016).

56 *See, e.g.*, Porco v. Lifetime Entm't Servs. L.L.C., 47 N.Y.S.3d 769 (N.Y. App. Div. 2017); *see also* Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797 (Cal. 2001).

57 S.B. 5857, 240th Legis. Sess. § 50-g. (N.Y. 2017) ("Every individual's right of publicity shall continue to exist for forty years after his or her death, and does not expire upon the death of the individual, regardless of whether the law of the domicile . . . recognizes a similar or identical

Actors Guild (SAG) in part to prevent nonconsensual digital animation of actors.[58] SAG and its members are concerned that CGI technologies will allow film studios to avoid paying real actors or to pay them substantially less, because they will be able to regenerate digital simulacra at much lower cost.[59]

Whatever the merits of an amendment to New York's publicity laws for purposes of resolving that dispute, we are deeply anxious about the effect the law could have on film restoration. The proposed statute changes the existing privacy right into a publicity right, and it subjects nonconsensual use of a person's likeness to civil penalty.[60] The statute includes a general recognition of First Amendment limitations. It also includes an exemption for certain expressive works but it excepts from this exemption works that "include[] a commercial use and replicate[] the professional performance or activities rendered by an individual."[61] Depending on whether courts interpret commercial use broadly or narrowly,[62] the new rights created by the statute could be asserted to block restoration of copyrighted and public domain films.

Preservation of old films is a matter of great cultural importance. The U.S. Congress included encouraging film preservation as one of its leading "rationales" for extending copyright duration by twenty years in 1998.[63] Digital reanimation promises better and cheaper film restoration than has ever been possible. Movies that were so thoroughly damaged to be unfixable through traditional means will now be made available to new generations of audiences.[64]

Yet, if actors could assert publicity rights to insist on compensation for recreation of their previously consensually filmed scenes, all of these opportunities would vanish. Even if all of the actors would be willing to consent to the reanimation for free, the transaction costs involved in tracking down actors and their estates would surely swamp

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property right.").

58 *Id.* ("'Likeness' means an image, digital replica, . . . recognizable representation of an individual's face or body, and includes a characteristic. A digital replica is a computer-generated or electronic, photo-realistic reproduction of an individual's likeness, whether animated or static.").

59 *See* Kaplan, *supra* note 12, and accompanying text.

60 S.B. 5857 § 51(2)(a)–(b).

61 *Id.* § 51(2)(d) ("[S]ubject to the First Amendment . . . a work that is exempt under this subdivision that *includes a commercial* use and replicates the professional performance or activities rendered by an individual, shall not be exempt under this subdivision.") (emphasis added).

62 We are uncertain about the extent to which precedents derived from New York's older privacy right will still be deemed applicable to its new publicity right. Although film restoration might not be deemed a commercial use under existing law, courts may approach the situation differently with a new law on the books.

63 Copyright Term Extension Act, Pub. L. No. 105–298, 112 Stat. 2827–29 (codified at U.S.C. §§ 17 U.S.C. 108, 203(a)(2), 301(c), 302, 303, 304(c)(2) (2012)); Eldred v. Ashcroft, 537 U.S. 186, 207 (2003) ("longer terms would encourage copyright holders to invest in the restoration and public distribution of their works.").

64 *See supra* notes 23–26.

the possible benefits the restorers could hope to achieve.[65] Some actors would not be able to be found, while others might hold out for substantial sums of money. But in virtually all of these cases, the actors would already have received compensation for their initial performances. Even if actors have a legitimate claim not to have their likenesses reanimated in new works for which they have not been paid, those who have performed in already-created films have had an opportunity to be paid for their services.

Our arguments are simple. In light of the First Amendment, federal copyright law, and a general policy in favor of the creation, preservation, and distribution of creative expression, courts in New York and elsewhere should never allow publicity rights to stifle film or other media restoration. Moreover, if New York or other states decide to adopt new publicity rights in response to concerns about digital animation, those statutes should explicitly exempt uses of a person's likeness to restore film or other media. The legal doctrines weighing against assertions of publicity rights are multiple. Actors should not be allowed to stifle expressive speech that they have previously consented to merely for another bite at the apple. Further, the interests of both copyright holders (for currently protected works) and members of the public (for public domain works) are matters of federal copyright policy that should not be trumped by state law publicity rights. The opportunities presented by digital preservation and restoration of old films can enrich our culture for decades to come, and they do not undermine interests that have been traditionally protected or that have not already been consented to. The rules we suggest have enormous benefits for the public and virtually zero costs.

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65 *See* NAT'L FILM PRES. FOUND., THE FILM PRESERVATION GUIDE: THE BASICS FOR ARCHIVES, LIBRARIES, AND MUSEUMS 2–3 (2004), https://www.filmpreservation.org/userfiles/image/PDFs/fpg.pdf (discussing "orphan films").