

**From:** Eric Keawe [ekeawe@msn.com]  
**Sent:** Saturday, April 04, 2009 9:02 AM  
**To:** JUDtestimony  
**Subject:** SB1005 SD2 HD1 Hearing Tuesday April 07, 2009 2PM Rm 325

HOUSE OF REPRESENTATIVES  
THE TWENTY-FIFTH LEGISLATURE  
REGULAR SESSION OF 2009

COMMITTEE ON JUDICIARY  
Rep. Jon Riki Karamatsu, Chair  
Rep. Ken Ito, Vice Chair

Rep. Della Au Belatti	Rep. Hermina M. Morita
Rep. Rida Cabanilla	Rep. Blake K. Oshiro
Rep. Mele Carroll	Rep. Joseph M. Souki
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Rep. Sylvia Luke	Rep. Glenn Wakai
Rep. Angus L.K. McKelvey	Rep. Barbara C. Marumoto
Rep. John M. Mizuno	Rep. Cynthia Thielen

NOTICE OF HEARING

DATE: Tuesday, April 07, 2009  
TIME: 2:00 p.m.  
PLACE: Conference Room 325  
State Capitol  
415 South Beretania Street

Response to Points of interest brought up by recent committee:

How "contract rights" will not be lost... the whole point of SB1005 is that a commercial user of another person's name/likeness/voice/photograph must have a contract (license). If the user now has a license, SB1005 would not affect them. If the user doesn't not have a license, that is EXACTLY the harm that SB1005 is trying to prevent.

Three Hawaii legislative committee reports this session, including Senate JUD, have found SB1005 to be well-balanced.

This is an important subject on fairness in the use of ones name/photo/signature/voice. Do not allow this bill to stall at this point. There is support from Palani Vaughan, Kanikapila Records, Inc., Sam Ako who some are musicians/composers/artists in their own right.

Mahalo for hearing this.

Eric K. Keawe - President  
Genoa Keawe Records, Inc.



**SB1005, SD2, HD1  
RELATING TO PUBLICITY RIGHTS**

**House Committee on Judiciary**

April 7 , 2009  
Room 325

2:00 p .m.

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Aloha Chair Karamatsu, Vice Chair Ito, and Members. **OHA strongly supports, with an amendment, Senate Bill No. 1005, SD2, HD 1 Relating to Publicity Rights.**

The purpose of this bill is to help protect in Hawaii the music of Hawaii, and all other works of authorship, by establishing a property right in the commercial use of a person's name, voice, signature, photograph, or likeness. This right is generally called a "right of publicity." It protects an individual or personality from the unauthorized appropriation by promoters and marketers of the music of Hawaii, without the permission of the artists or their heirs, and the sale of products that are objectionable to the artists and heirs, yet feature the artist's name, voice, signature, photograph, or likeness.

The bill is detailed, including provisions relating to transfer of the right, injunctions and damages for infringement of the right, and exemptions for situations where the law would not apply. We believe the bill strikes a reasonable balance between protecting the right and recognizing that the right is not absolute.

We respectfully request that your Committee amend Section 3 of the bill to make the Act effective upon its approval.

Mahalo for the opportunity to testify.

**From:** ERB [ERB@bfsf.com]  
**Sent:** Monday, April 06, 2009 11:27 AM  
**To:** JUDtestimony  
**Subject:** Senate Bill 1005

**BENDET, FIDELL, SAKAI & LEE**

**Attorneys at Law, A Law Corporation**

**841 Bishop Street, Suite 1500**

**Honolulu, Hawai'i 96813**

**(808) 524-0544**

April 6, 2009

TO: Chair Jon Riki Karamatsu, Vice Chair Ken Ito, and Members, Committee on Judiciary

The Hawai'i State House of Representatives

SUBJECT: SB 1005 (Regarding Publicity Rights)

Dear Representative Karamatsu, Representative Ito and Members:

We represent Surfside Hawaii, Inc., a small, independent, family-owned record company, which for many years has been distributing recordings of Hawaiian music under the Lehua and Mahalo labels. We are writing on our client's behalf to request an amendment to SB 1005, which bill would create a right of publicity in Hawai'i.

Surfside does not oppose the recognition of a right of publicity in Hawai'i. However, we and our client believe that right should not apply where an individual has voluntarily and willingly participated in the creation of the product in question. For example, someone should not have the right to manufacture and sell a T-shirt with Don Ho's photograph on it without the consent of Don Ho or his heirs. But where a singer voluntarily and willingly participates in a recording session arranged by a recording company for the purpose of making a phonograph record, the manufacture and sale by the recording company (or its successor-in-interest) of a record containing that performance should not constitute an infringement of the performer's right of publicity, and neither should the use of packaging or promotional materials for that recording which contain the performer's name or likeness.

It is clearly not "theft" of the artist's voice, name or likeness for the recording company to manufacture and sell records containing the very performances that the artist willingly participated in at the recording session or to use the artist's name and likeness to promote the sale of those records. To the contrary, in this situation, the recording company is

simply doing what all concerned expected would be done following the recording session, i.e., marketing records containing the performances recorded at the session.

Section 5 of the current version of the bill does contain language specifying that an infringement of the right of publicity does not occur if the performer gave express or implied consent to the use of his or her performance, name or likeness. However, with regard to performances that were recorded decades ago, as a practical matter, it is going to be extremely difficult, and in some cases impossible, to prove consent, and we believe that in certain situations, the statute should provide a rebuttable presumption that such consent was given.

Back in the 1940's, 50's and 60's, business in Hawai'i was conducted much more informally than it is today. As a result, many recordings were made in those days with no written recording contracts. The artist and the recording company would simply agree on a flat fee for the recording session, and it was understood by all that the artist's performance at the session would be included in the record and that the recording company would be using the artist's name and likeness on the packaging for the record and in promotional materials for the record. This type of normal commercial usage should not constitute an infringement of the artist's right of publicity.

In the late 1960's and early 1970's, Surfside purchased all the master recordings owned by the Mahalo, Makaha and Sounds of Hawaii record labels. All those companies were actively engaged in the manufacture and sale of recordings of Hawaiian music, and to the best of our client's knowledge, none of them had written recording contracts with the artists. Since then, Surfside has continued to manufacture and sell sound recordings containing these performances. In no case did any performer claim that his or her performance contained in one of these recordings was included in the recording without his or her consent.

Now, many of the artists from the old days are deceased, and if SB 1005 is passed in its present form, then after August 1, 2009, their heirs will be free to claim that the continued sale of recordings containing their deceased relative's voice and containing the names and photographs of their deceased relative infringe that person's right of publicity.

Considering the informal style of doing business in prior decades, considering the very long period of time these recordings have been on the market, and considering that many of the artists and many of the original owners of the recording companies are unavailable to testify because they have passed away, we believe it would be reasonable and appropriate for the statute to create a rebuttable presumption that in certain specific circumstances, the artist's consent to these older recordings was given.

We would propose that in order to obtain the benefit of the presumption, two conditions must be met.

First, the recording must have been first manufactured and sold prior to January 1, 1978. That is the date the present U.S. Copyright Act became effective. Prior to that date, many of the recording companies considered the artists to be "employees for hire" and on that basis claimed copyright in the sound recordings they produced, including the performances contained in those recordings. However, under the present Copyright Act, employment for hire agreements are required to be in writing. Therefore, January 1, 1978 would be an



appropriate starting date for a recording company not to be permitted to rely on an unwritten employment for hire arrangement and to start requiring the recording companies to bear the burden of proof on the issue of consent, which as a practical matter, would require them to be able to produce a written recording contract.

The second requirement we propose is that from the date of the initial release of the recording up to January 1 of this year, no legal action was instituted claiming that the use of the artist's voice in the recording or the use of the artist's name or likeness in connection with the recording was without the artist's consent. If over 30 years have gone by and no suit was ever filed objecting to the sale of the recording or the use of the artist's name or likeness in connection with the recording, we believe it is reasonable and appropriate for a presumption to arise that the use was with the artist's consent. The presumption would be rebuttable, but in light of the fact that these recordings are several decades old, we believe that to overcome the presumption, a claimant should have the burden of doing so by clear and convincing evidence.

Accordingly, we would propose the following as an amendment to SB 1005:

“With respect to any sound recording first manufactured and publicly sold prior to January 1, 1978, unless prior to January 1, 2009, an individual or an heir of an individual commenced legal action claiming that such individual's performance contained in the recording was included therein without the consent of that individual, it shall be presumed that such individual consented to the inclusion of his or her performance therein, as well as to the use of his or her name, photograph and likeness thereon and in connection with the promotion thereof. This presumption may be rebutted by clear and convincing evidence to the contrary.”

We would propose that this language be added at the end of Section 5 of the bill.

We would note that our client's position is not unique and that other small record companies are in the same position as Surfside.

Finally, we would also like to point out that even though the new law proposed by SB 1005 would not become effective until August 1, 2009, it would nevertheless have a retroactive effect, because it would affect a record company's right to continue to sell CDs and other sound recordings derived from master recordings that were made many, many years before a right of publicity was recognized in Hawai'i, and because it would also adversely affect the value of recording rights acquired in business transactions entered into in good faith many years before such a right of publicity existed. We believe that making the new right of publicity applicable to such pre-existing master recordings and such completed business transactions would expose the statute to a serious challenge on constitutional grounds. As to sound recordings, we believe that this concern could be eliminated by exempting from the operation of the statute all sound recordings derived from master recordings recorded prior to the effective date of the statute, as well as all containers of and promotional materials for such recordings. However, a similar concern also exists as to other works, and to avoid constitutional problems, such an exemption should undoubtedly also apply to motion pictures and to literary, photographic and other artistic works completed prior to the effective date of the statute. If such exemptions are written into the statute, the burden

of proof issue discussed above would become moot, and the additional language proposed above for Section 5 of the statute would not be necessary.

Thank you very much for your consideration of our thoughts and concerns regarding this matter.

Sincerely yours,

Edward R. Bendet

For Surfside Hawaii, Inc.



MOTION PICTURE ASSOCIATION OF AMERICA, INC.  
1600 EYE STREET, NORTHWEST  
WASHINGTON, D.C. 20006  
(202) 293-1966

**MEMORANDUM IN OPPOSITION  
TO HAWAII SENATE BILL 1005**

The Motion Picture Association of America, Inc. (MPAA) respectfully submits this memorandum in opposition to Senate Bill 1005, a bill to establish a “right of publicity” for the commercial use of a person’s name, voice, signature, or likeness.

MPAA is a trade association representing the leading producers and distributors of motion pictures in the United States. All MPAA member companies\* produce and distribute motion pictures for theatrical exhibition and for subsequent release on DVD, videocassette, pay, cable, satellite, Internet and broadcast television.

We respectfully submit that SB 1005 would violate the First Amendment by chilling constitutionally-protected speech, is overbroad and unclear, and is problematic for many reasons. Among other things, this sweeping legislation would create rights for individuals whose attributes do not have commercial value. Moreover, the bill is unnecessary and contrary to established law, would unconstitutionally regulate and restrict storytelling in audiovisual works, and would discourage motion picture production, particularly in Hawaii.

**SB 1005 Violates the First Amendment.**

The First Amendment to the U.S. Constitution is designed to remove governmental restraints from public discussion and encourage the free flow of information and ideas. This includes comment, criticism and parody by filmmakers and other storytellers about public figures and personalities, the use of iconic public figures in debate about public issues, culture and values,

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\* The Motion Picture Association of America, Inc. includes: Walt Disney Studios Motion Pictures; Paramount Pictures Corporation; Sony Pictures Entertainment, Inc.; Twentieth Century Fox Film Corporation; Universal City Studios LLLP; and Warner Bros. Entertainment Inc.

in motion pictures and television shows, and in other forms of expression. See Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495 (1952); Eronoznik v. City of Jacksonville, 422 U.S. 205 (1975); and Jenkins v. Georgia, 417 U.S. 153 (1974). The free flow of information and ideas is also protected from state and federal laws that would result in a chilling effect on speech, which includes motion pictures and television programs. The U.S. Supreme Court has ruled many times that laws that promote self-censorship because of the fear of legal consequences violate the First Amendment as much as laws that directly ban certain speech. See also Smith v. California, 361 U.S. 147, 154 (1959).

The bill as currently drafted fails to protect expressive works clearly and unambiguously. The bill must be revised to provide a comprehensive and inclusive exemption for First Amendment protected activity, including all expressive works in any medium now known or hereafter devised. The failure to provide such an exemption will cause the bill to fail constitutional scrutiny.

### **SB 1005 is Vague, Ambiguous and Overbroad.**

SB 1005, as currently drafted, precludes the use of attributes of both “individuals” (all natural persons) and “personalities” (individuals whose attributes have commercial value). Application of this bill applies to all individuals whether or not there is any commercial value in the person’s name, signature, voice or likeness, and renders the bill overbroad and vague. The right of publicity protects the commercial value in a person’s name, signature, voice, or likeness, thus the existence of commercial value is a fundamental requirement for such a right. Moreover, legislation that extends this right to all individuals would make it impossible for filmmakers to determine with any certainty as to whether their use of an individual’s name in telling a story could give rise to a lawsuit.

This bill also contains no limits as to who can receive its protection. Any person could come to Hawaii and assert a claim under this bill. There need be no nexus between Hawaii and the person who would make a claim. The bill makes no requirement regarding domicile, and thus a person need not establish or demonstrate any connection with Hawaii.

In addition, the bill, which contains provisions allowing for the transfer of a personality’s right of publicity, is confusing as to how to

accomplish the transfer and how to put the public on notice that a right of publicity exists and has been transferred. Without a procedure for registering a transfer of a right of publicity, those who would like to obtain consent to use a personality's attributes on or in goods, merchandise, or products would have no way of determining who is authorized to give consent for such use. The bill should have a registration requirement and procedure to give certainty to those who may seek consent to use a personality's name, voice, signature, or likeness.

Further, SB 1005 fails to make clear that the right of publicity persists for a specified time period of seventy years following the death of a personality, and further fails to – but should – expressly state that no action may be brought for any use occurring after the expiration of seventy years after the date of the personality's death. Without such clarification, this bill will cause an explosion of litigation as litigants seek to clarify confusing terms of this legislation.

In addition, the remedies provided by this bill are problematic. The availability of injunctive relief prior to publication runs afoul of the First Amendment. A court may grant a temporary restraining order prohibiting the dissemination of First Amendment-protected material, but only in very extraordinary circumstances, such as national security situations. In addition, the impounding of First Amendment-protected content prior to final judgment is on its face unconstitutional. The risk of this bill to our member companies is that copies of a film about to be shown in theatres would be seized by a court, at great cost and expense to the producer and distributor.

### **This Bill is Unnecessary and Relief Can Be Sought at Common Law.**

Most states do not have this kind of statute and are guided by common law in this arena. The misappropriation of another's name or likeness is an invasion of privacy and actionable under common law. It is unnecessary to create a broad statute which infringes on the rights of creators in order to address the commercial use of a personality's image or likeness.

We also respectfully submit that this legislation would not be complementary to the economic development goals and objectives of the Hawaii Legislature to encourage and motivate an increase in location motion picture and television production. The likely result of this legislation is that

motion picture producers would be discouraged from telling stories about public figures because of the threat of litigation under SB 1005.

For the reasons specified, we respectfully oppose SB 1005 and urge adoption of amendments to address the issues raised in this Memorandum.

*April 2009*



**Report Title:**  
Publicity Rights; Commercial Uses

**Description:**  
Establishes property rights in the commercial use of a person's name voice, signature, photograph, or likeness.

THE SENATE  
TWENTY-FIFTH LEGISLATURE, 2009  
STATE OF HAWAII

**S.B. NO.** 1005

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## A BILL FOR AN ACT

RELATING TO PUBLICITY RIGHTS.

**BE IT ENACTED BY THE LEGISLATURE OF THE STATE OF HAWAII:**

SECTION 1. The purpose of this Act is to establish a property right in the use of a personality's name, voice, signature, or likeness on or in goods, merchandise, or products, or for purposes of advertising products, merchandise, goods or services. This right is generally called a "right of publicity."

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SECTION 2. The Hawaii Revised Statutes is amended by adding a new chapter to be appropriately designated and to read as follows:

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"CHAPTER

PUBLICITY RIGHTS

§ -1 Property right in use of name, voice,

signature, or likeness. A personality has a property right

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in the use of his or her name, voice, signature, or

likeness on or in goods, merchandise, or products, or for

purposes of advertising products, merchandise, goods or

services. This right exists in the name, voice, signature,

or likeness of personalities living or deceased. This

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right shall be freely transferable, assignable, and

licensable, in whole or in part, by any otherwise

permissible form of inter vivos or testamentary transfer,

including without limitation a will or other testamentary

instrument, trust, contract, community property agreement,

or cotenancy with survivorship provisions or payable-on-

death provisions, whether the will or other testamentary

instrument, trust, contract, community property agreement,

or cotenancy document is entered into or executed by the

deceased personality or by any subsequent owner of the

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deceased personality's right, as recognized by this chapter;

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or, if none is applicable, then the owner of the right,

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shall be determined under the laws of intestate succession

applicable to interests in intangible personal property.

The property right does not expire upon the death of the

personality. The right exists whether or not it was

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commercially exploited by the personality during the

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personality's lifetime. This chapter is intended to apply to a living personality whose domicile or residence is in Hawaii, or to a deceased personality whose domicile or residence was in Hawaii on the date of the personality's death.

§ -2 Definitions. As used in this chapter, unless the context clearly requires otherwise:

"Deceased personality" means an individual whose name, voice, signature, or likeness had commercial value at the time of his or her death, whether or not during the lifetime of that individual he or she used his or her name, voice, signature, or likeness on or in products, merchandise or goods, or for purposes of advertising products, merchandise, goods, or services, and whose domicile or residence was in Hawaii on the date of the personality's death.

"Likeness" means an image or other clear representation of a personality's face, body, or parts thereof.

"Name" means the actual or assumed name, or nickname, of a living or deceased personality that is intended to identify that personality.

"Person" means a natural person, firm, association, partnership, corporation, joint stock company, syndicate,

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**Deleted:** In the case of a deceased individual or personality, the rights recognized under this chapter shall be deemed to exist at the time of death of any deceased individual or personality or subsequent successor of their rights for the purpose of determining the person or persons entitled to these property rights as provided for in section -3.

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**Deleted:** "Fund-raising" means an organized activity to solicit donations of money or other goods or services from persons or entities by an organiza... [1]

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receiver, common law trust, conservator, statutory trust, or any other concern by whatever name known or however organized, formed, or created, and includes nonprofit corporations, associations, educational and religious institutions, political parties, and community, civic, or other organizations.

"Personality" means an individual whose name, voice, signature, or likeness has commercial value, whether or not that individual uses his or her name, voice, signature, or likeness on or in products, merchandise, or goods, or for purposes of advertising products, merchandise, goods, or services, and whose domicile or residence is in Hawaii.

"Signature" means the one handwritten or otherwise legally binding form of a personality's name, written or authorized by that personality, that distinguishes the personality from all others.

§ -3 Transfer. (a) The right recognized under this chapter shall be freely transferable, in whole or in part, by contract or inter vivos transfer. This right shall not expire upon the death of the personality, but shall be owned and enforceable by the following successors, heirs, or other transferees of living or deceased personalities:

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**Deleted:** "Photograph" means any photograph or photographic reproduction, still or moving, or any videotape, online or live television transmission, of any individual, so that the individual is readily identifiable.†

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(1) Except where the right was transferred before the deceased personality's death by means of a contract or trust instrument, the right shall be owned by the person entitled to the right under the deceased personality's last will and testament or, if none, then by the beneficiaries or heirs under the laws of intestate succession applicable to interests in intangible personal property generally of the personality's domicile;

or

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(2) If the deceased personality transferred an interest in the personality's right during his or her life by means of a contract or trust instrument, then the transferred interest shall be held as follows:

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(A) If the transferred interest was held in trust, in accordance with the terms of the trust;

(B) If the interest is subject to a cotenancy with survivorship provision or payable-on-death provision, in accordance with those provisions;

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(C) If the interest is subject to a contract, including without limitation a license,

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assignment, or a community property agreement, in accordance with the terms of the applicable contract;

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(b) A person to whom a personality's right of publicity has been transferred by contract or inter vivos transfer cannot bring an action or recover damages or other relief for the violation of a right under this chapter unless the transfer of the personality's right of publicity has been registered as provided in subsection (2), below.

**Deleted:** (D) If the interest has been transferred or assigned to a third person in a form that is not addressed in this section, by the individual or personality, or the successor, heir, or other transferee of the living or deceased individual or personality, then the interest may be transferred, assigned, or licensed by that third person, in whole or in part, by any otherwise permissible form of inter vivos or testamentary transfer or, if none is applicable, under the laws of intestate succession applicable to interests in intangible personal property of the third person's domicile, regardless of whether the law of the domicile of the deceased third party, at the time of death, or thereafter, recognizes a similar or identical property right.†

(1) A transferee of a personality's right of publicity may only recover damages or other relief for a violation of the right of publicity that commenced after, but not before, the date that the transferee registered the transfer under subsection (2), below. However, if neither the personality nor the transferee (nor any prior transferee) knew of the violation of the personality's right of publicity prior to the transfer, and the transferee acting in good faith registered the transfer within ninety days after the transfer, then the transferee may recover even though the violation commenced before the registration date.



(2) A transferee of a right of publicity may register the transfer with the secretary of state on a form prescribed by the secretary of state. The form shall include the name of the personality, the date of the transfer, the date of death and the personality's domicile or residence at the time of death if the personality is deceased, the name and address of the transferee, the method of transfer of the right, and the extent of the right of publicity transferred. The information provided on the form shall be verified by the transferee. The secretary of state may collect a fee for the registration that does not exceed the incremental costs of recording the documents and maintaining the registry.

(3) Upon receipt of the form and any related document for filing, the secretary of state shall post the form and document in a registry of interests in transferred rights of publicity on a website on the internet that is accessible to the public. The secretary of state may microfilm or reproduce by other means any of the forms or documents and destroy the original form or document. A reproduction of a record under this section that

is certified by the secretary of state shall be admissible in a court of law. The secretary of state is not required to retain a record or reproduction concerning a registration under this section more than seventy years after the date of the personality's death.

(4) A form or other document filed under this section is a public record.

(5) A person who registers a transfer under this section without a reasonable belief that the person is a transferee of the right of publicity is guilty of a misdemeanor punishable by imprisonment for not more than 90 days or a fine of not more than \$500.00, or both.

(c) A property right exists under this chapter whether or not the personality's right of publicity was commercially exploited by or under the authority of the personality or the personality's transferees during the personality's lifetime.

(d) Causes of action, and related damages, inter alia, relating to misappropriation of the right established by this chapter may only be enforced as of the effective date of this chapter.

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(e) No action may be brought under this chapter by reason of any use of a deceased personality's name, voice, signature, or likeness occurring after the expiration of seventy years after the date of the personality's death.

**§ -4 Right is exclusive for personalities.**

(a) Except to the extent that the personality may have assigned, licensed or otherwise transferred the right, the right protected in this chapter is exclusive to the personality, subject to the assignment, licensing or other transfer of the right during the personality's lifetime, and to the persons entitled to the right under section

-3 for a period of seventy years after the death of the personality, including to the extent that the persons entitled to the right under section -3 may have assigned, licensed or otherwise transferred the right to others.

(b) The right granted in this chapter may be exercised by a personal representative, attorney-in-fact, parent of a minor child, or guardian, or as authorized by a court of competent jurisdiction. The terms "personal representative," "attorney-in-fact," and "guardian" shall have the same meanings in this chapter as they have in chapter 560.

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- Deleted: (a) For individuals, except to the extent that the individual may have assigned or licensed the rights, the rights protected in this chapter are exclusive to the individual, subject to the assignment or licensing of the rights during the individual's lifetime, and are exclusive to the persons entitled to the rights under section -3 for a period of seventy years after the death of the individual, including to the extent that the persons entitled to the rights under section -3 may have assigned or licensed these rights to others.
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§ -5 Infringement of right; use without consent.

Any person who knowingly uses a living or deceased personality's name, voice, signature, or likeness, on or in goods, merchandise, or products, or for purposes of advertising products, merchandise, goods, or services, without written or oral, express or implied, consent of the personality or of a person to whom the personality's right of publicity has been transferred, has infringed the personality's right of publicity.

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§ -6 Infringement of right; circuit courts;

injunctions; liability for damages and profits; attorneys'

fees. (a) The circuit courts of this State may grant injunctions on reasonable terms to prevent or restrain the infringement of a personality's right of publicity.

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(b) Any person who infringes the right under this chapter shall be liable for the greater of \$10,000 or the actual damages, including any profits, sustained as a result of the infringement. To prove profits under this section, the injured party must submit proof of gross

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revenues attributable to the infringement, and the infringing party is required to prove his or her deductible expenses. For the purposes of computing statutory damages, the use of a name, voice, signature, or likeness in or related to one product, merchandise, good, or service, or

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for purposes of advertising the same, constitutes a single act of infringement regardless of the number of copies made or the number of times the name, voice, signature, or likeness is displayed.

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(c) The prevailing party may recover reasonable attorneys' fees, expenses, and court costs incurred in recovering any remedy or defending any claim brought under this chapter.

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Deleted: At any time while an action under this chapter is pending, the court may order the impounding, on reasonable terms, of all materials or any part thereof claimed to have been made or used in violation of the injured party's rights, and the court may enjoin the use of all plates, molds, matrices, masters, tapes, film negatives, master recordings, copies of recordings, optical disk stampers, or other articles by means of which these materials may be reproduced.

(d) This chapter establishes the exclusive rights and remedies for the violation of the right of publicity, superseding common law rights and remedies concerning the rights of publicity.

(d) As part of a final judgment or decree, the court may order the destruction or other reasonable disposition of all materials found to have been made or used in violation of the injured party's rights, and of all plates, molds, matrices, masters, tapes, film negatives, master recordings, copies of recordings, optical disk stampers, or other articles by means of which these materials may be reproduced.  
(e)

§ -7 Exemptions from use restrictions; when chapter does not apply.

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(a) This chapter does not apply to the use of a personality's name, voice, signature, or likeness, in any of the following:

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Deleted: The remedies provided for in this section are cumulative and are in addition to any others provided for by law.

- (1) A play, book, story, article, magazine, newspaper, newsletter, other periodical, graphic novel, musical composition, sound recording, documentary, photograph, motion picture or television program or other audio visual work, radio or other audio program, video game, original work of art, art reproduction, or other

Deleted: (a) For purposes of section -5, the use of a name, voice, signature, photograph, or likeness in connection with matters of cultural, historical, political, religious, educational, newsworthy, or public interest, including without limitation comment, criticism, satire, and parody relating thereto, shall not constitute a use.

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work derived from such work, work of political or newsworthy value, informational work, or any other editorial, artistic or other expressive work, regardless of length or format, or any advertisement, promotion or commercial announcement for any such work, in any medium now known or hereafter devised.

(2) An advertisement, promotion or commercial announcement, for the authorized sale, distribution, performance, broadcast, or display of a literary, musical, cinematographic, or other artistic work using the name, voice, signature, or likeness of the writer, author, composer, director, actor or artist who created or took part in the creation of the work, where the personality or a person to whom the personality's right of publicity has been transferred consented to the use of the personality's name, voice, signature, or likeness on or in connection with the initial sale, distribution, performance, broadcast, or display thereof.

(3) The advertisement or sale of a rare or fine product that incorporates the name or signature of the author.

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**Deleted:** (1) Single and original works of fine art, including but not limited to photographic, graphic, and sculptural works of art that are not published in more than five copies;f

(2) A literary work, theatrical work, musical composition, film, radio, online or television program, magazine article, news story, public affairs report, or sports broadcast or account, or with any political campaign when the use does not inaccurately claim or state an endorsement by the individual or personality;f

(3) An advertisement or commercial announcement for a use permitted by subsections (a) and (g) and paragraph (1) or (2);f

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(b) The use of a personality's name, voice, signature, or likeness in connection with matters of cultural, historical, political, religious, educational, newsworthy, or public interest, including without limitation comment, criticism, satire, and parody relating thereto, or any advertisement, promotion or commercial announcement for any such matters, shall not constitute a use for which consent is required under this chapter.

(c) It is no defense to an infringement action under this chapter that the use of a personality's name, voice, signature, or likeness includes more than one personality so identifiable. However, the personalities complaining of the use shall not bring their cause of action as a class action.

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(d) This chapter does not apply to the owners or employees of any medium used for advertising, including but not limited to newspapers, magazines, radio and television stations, online service providers, billboards, and transit ads, who, without prior notice that the use would be in violation of this chapter, have published, broadcast or disseminated any advertisement or solicitation in violation of this chapter, unless the advertisement or solicitation was intended to promote the medium itself.

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(e) This chapter does not apply to a use of a personality's name that is merely descriptive and used fairly and in good faith only to identify or describe something other than the personality, such as, without limitation, to describe or identify a place, a legacy, a style, a theory, an ownership interest, or a party to a transaction, or to accurately describe the goods or services of a party.

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(f) This chapter does not apply to a use of a personality's name, voice, signature, or likeness when the use is insignificant, de minimis, or incidental.

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(g) This chapter does not apply to the distribution, promotion or transfer of material containing a personality's name, voice, signature, or likeness to a third party for use in a manner which is lawful under this chapter, or to a third party for further distribution, promotion or transfer, for use in a manner which is lawful under this chapter."

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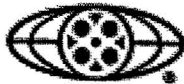
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SECTION 3. This Act shall take effect upon its approval.

INTRODUCED BY: \_\_\_\_\_



MOTION PICTURE ASSOCIATION OF AMERICA, INC.  
1600 EYE STREET, NORTHWEST  
WASHINGTON, D.C. 20006  
(202) 293-1966

### **Statement In Support of Amendments to SB 1005**

The Motion Picture Association of America, Inc. respectfully opposes SB 1005 and urges that the bill be amended in accordance with the suggested draft amendment attached.

SB 1005, in its current form, is an unconstitutional under the First Amendment. The bill is also vague, ambiguous and overbroad, and it is unnecessary since adequate remedies exist at common law for the misappropriation of one's likeness. MPAA's legal analysis is set forth in its Memorandum of Opposition to SB 1005.

MPAA and its member companies seek to protect the right to disseminate the stories of personalities. Movies from *Hoffa* to *Forrest Gump* could be subjected to legal challenges if SB 1005 becomes law. Filmmakers would be concerned that whenever they sought to depict a personality in a movie the filmmaker could be sued for failing to get consent of the heirs of personality or whomever is in possession of the transferable property right created by this legislation. In addition, contemporary programs, such as *The Daily Show* or *The Tonight Show with Jay Leno* which show public figures, actors, criminals and retired elected officials in satire or parody could be subject to liability under the legislation.

MPAA has proposed amendments which protect the rights of personalities against improper commercial use while protecting First Amendment rights of filmmakers and other creators. MPAA urges adoption of these amendments, which address the following issues:

- Clarify that only a personality, not any individual, has a property right in the commercial use of his/her name, voice, signature or likeness.
- Eliminate photograph from the attributes of a personality, since a

photograph is a visual work which should be exempt from this legislation.

- Establish that a living personality must be domiciled or reside in Hawaii and that a deceased personality must have been domiciled in or resided in Hawaii at the time of the personality's death.
- Create a comprehensive expressive works exemption that clearly, specifically and unambiguously sets forth that creative works may use the attributes of a personality as part of their creative expression, in the form of books, plays, stories, articles, motion pictures, television programs, etc. and any advertisements of such creative works.
- Modify the definition to exclude "distinctive appearance, gestures, or mannerisms from an individual" since those qualities are not part of the attributes of a personality.
- Establish a process of the transfer or assignment of the property right and the registration of the property right so that anyone who wants to obtain consent for use of a personality's attributes can do so.
- Eliminate the authority of a court to impound materials alleged to have been used in violation of the personality's rights and to order destruction of material used in violation of the party's rights. These remedies have a chilling effect on protected speech.
- Make the remedy available under this bill the exclusive remedy and not in addition to any other remedies that may exist.
- Clarify that the duration of right established is seventy years after the death of the personality.

These amendments narrow the legislation to its stated purpose – to protect Hawaiians' publicity rights and to ensure that they have the ability to authorize the use of their name, voice, signature, or likeness in goods, merchandise or products. The bill, if revised in accordance with the proposed amendments, should withstand scrutiny under the First Amendment and would properly accord a right of publicity without limiting the constitutionally protected right of free expression.

**From:** George E. Darby KRI [gdarby@kanikapilarecords.com]  
**Sent:** Monday, April 06, 2009 12:39 PM  
**To:** JUDtestimony  
**Subject:** TESTIMONY IN SUPPORT OF SENATE BILL No. 1005, SD2, HD1, House JUD Hearing:  
April 7, 2009, 2 p.m., Room 325 (Rep. Karamatsu)

## KANIKAPILA RECORDS, INC.

126 Queen, Rm 302

Honolulu, Hawaii 96813

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TESTIMONY IN SUPPORT OF **SENATE BILL No. 1005, SD2, HD1**

RELATING TO PUBLICITY RIGHTS

HOUSE OF REPRESENTATIVES

COMMITTEE ON JUDICIARY

Committee Hearing: April 7, 2009, 2 p.m., Room 325

Kanikapila Records, Inc., is based in Honolulu and is known for its releases of Peter Moon Band albums. **Kanikapila Records strongly supports SB1005, SD2, HD1** as a major step is putting the publicity rights of Hawaii's writers, composers, and recording artists on a par with such rights in other states that have significant music industries. A publicity rights statute requires that anyone wishing to use another person's name, signature, voice, or photograph *commercially* must have a license granted by the other person (directly or from the person's estate or assignee). If enacted, SB1005, SD2, HD1 (the "Bill") would provide much needed clarity about the "freely allowed uses" of other persons' names, signatures, voices, and photographs (i.e., the exemptions in Section 7 of the Bill), and those uses that require a license.

Using an author's or recording artist's name and photograph (and other likenesses, such as drawings or paintings depicting the author or recording artist) is critically important in the promotion and marketing of CDs, books, movies, and other forms of entertainment. If SB1005 SD2, HD1 were enacted, and using the music industry as an example, a license of publicity rights would be required for the commercial exploitation of a living or deceased recording artist's name, signature, voice, and photographs to market and promote (i.e., to publicize) sales of the recording. This is similar to a record label needing a license of a song's copyright before releasing a CD of a song. SB1005, SD2, HD1 addresses the *use* of sound recordings of an individual's or of a personality's voice; SB1005, SD2, HD1 does not create any new rights in sound recordings or conflict with federal copyright law. An "individual" is someone who has not established commercial value in their name, voice, signature, photograph, or likeness as of the time of his or her death; in contrast, a "personality" has established such commercial value as of the time of his or her death.

In the absence of a publicity rights statute, some record labels choose to exploit the names, signatures, voices, and photographs of artists in Hawaii without any compensation to artists or heirs, while some other labels offer token compensation, telling the artists or heirs the token compensation is “generous” since “none is owed”. Kanikapila Records refrains from such conduct, but would certainly welcome the level playing field provided by a publicity rights statute such as SB1005, SD2, HD1.

### “Contract Clause Issues”

House EBM/TCI Standing Committee Report No. 1181 noted “contract clause issues” for closer review by the House Judiciary Committee. Late testimony to EBM/TCI on behalf of two record labels discussed the lack of written contracts between recording artists in Hawaii and record labels in past decades, and argues that current owners of old recordings should be entitled to continue to use for free, forever, the name, likeness, voice, and signature of recording artists, alive or deceased, to distribute, market, and sell copies of such recordings. This conduct is one type of injury that SB1005, SD2, HD1 is expressly intended to remedy. The late testimony attempts to link copyright law and publicity rights law, but the two are entirely separate.

**Nothing in SB1005, SD2, HD1 would prevent owners of old recordings from continuing to distribute and sell copies of the recordings they own;** however, after enactment of the Bill, the owners could no longer use *without permission* the name, likeness, and/or signature of recording artists on the cover art (or otherwise) to promote and market the recordings. The argument that SB1005, SD2, HD1 would deny the public access to old recordings is inaccurate, if not specious, and there is certainly no constitutional issue; SB1005, SD2, HD1 does not impair any rights under copyright law, and a record label’s failure to obtain written contracts from authors and recording artists is not the basis for a constitutional challenge.

SB1005, SD2, HD1 would require that anyone who makes *commercial use* of the name, likeness, signature, or voice (as distinct from a vocal in the context of a recorded song) of a recording artist or author have a written license to do so or satisfy one of the exemptions listed in Section -7 of the Bill.

The Washington State publicity rights statute, RCW 63.60.010, *et seq.*, is the model on which the Bill is based, and that statute is widely respected as striking a clear and fair balance between rights owners and rights users. Based on our research, there have been no challenges, constitutional or otherwise, of the Washington State publicity rights statute. In adapting the Washington State publicity rights statute, the *50 year retroactivity* provided by that statute was not included in the draft Bill.

The record labels that submitted late testimony to EBM/TCI are asking the Legislature to create a special exemption to protect such labels’ continued exploitative use of an artist’s name, likeness, voice, and/or signature to sell copies of old recordings; they are asking the Legislature to endorse the practice of buying old recordings and selling copies without compensation to the artist or heirs for the use of the artist’s name, likeness, signature, and/or voice in promoting sales. Should the presumption of what a “flat fee” for a recording session 50 years ago covered be in favor the artist/heirs, or in favor of someone who came into possession of a recording decades later, and now repackages it as a CD or digital download, and sell copies using the name, likeness, voice, and signature of the recording artist? From conversations with artists who recorded under a flat fee arrangement decades ago, the general understanding of the artists was that the record label had the rights to a one release of one LP, and if the song was popular, to release of the song as a single (45 rpm); perpetual rights and future media were never discussed.

SB1005, SD2, HD1 makes it clear that **merely possessing a recording does not include the rights to commercial use of the name, likeness, voice, and signature of the recording artist.** The Legislature should not



condone the principle that “mere possession” of a recording includes publicity rights. If the proposed exemption were created, a recording asserted to date from before January 1, 1978, would automatically include publicity rights and invite abuse. How can recordings be dated? Should an author or artist bear the burden of dating a recording? Should the Legislature give anyone who acquires old recordings an unlimited, perpetual, royalty-free license to exploit the name, likeness, voice, and signature of the recording artist?

Based on our research, no other state that has a publicity rights statute has created an exemption that mere possession of, or otherwise acquiring, a recording includes publicity rights; there is no legal basis or rationale for such an exemption. The exemptions listed in Section -7 of SB1005, SD2, HD1 are sufficient. Statutes codify public policy, and Hawaii’s public policy should be to stop the ongoing, unauthorized exploitation of an author’s and recording artist’s name, likeness, voice, and signature to sell copies of recordings and other works.

As noted in Senate Judiciary Committee Report No. SSCR770, SB1005 SD2 “tempers the exploitation of the names, signatures, voices, and photographs of a deceased individual or personality without any compensation to their heirs.” The Washington State publicity rights statute is the basis for SB1005, SD2, HD1, and that statute is widely respected as striking a clear and fair balance between rights owners and rights users without the need to create an exception for old recordings.

The one area in which the Washington State publicity rights statute is unique compared with the statutes of other states is that it recognizes that a grant of publicity rights can be implied. Where facts support implied consent, Section -5 of the Bill should adequately address the concerns raised in the aforesaid late testimony.

Kanikapila Records, Inc., urges that the Committee to maintain SB1005, SD2, HD1, as drafted, but adopt an effective date of the Publicity Rights Act as August 1, 2009. Hawaii needs this law now, not in the distant future, to address current and ongoing abuse of publicity rights of authors, composers, and artists in Hawaii.

###

## **karamatsu3-Leanne**

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**From:** cordintl@aol.com  
**Sent:** Monday, April 06, 2009 3:19 PM  
**To:** JUDtestimony  
**Subject:** Testimony Re: SB 1005

Testimony of Michael Cord  
Cord International/ Hana Ola Records  
1874 Terrace Drive  
Ventura CA 93001

April 6, 2009

**Re: SB 1005, SD2, HD1 (The Publicity Rights Bill)**

**Hearing Date/Time: April 7, 2009 at 2:00 p.m.**

**Chair Jon Riki Karamatsu, Vice Chair Ken Ito,  
and Members of the Committee on Judiciary**

Dear Chair, Vice-Chair and Members:

### **Introduction**

My name is Michael Cord. I am a record producer, a music publisher, and owner of Cord International & Hana Ola Records. I am a member of the Hawaii Academy of Recording Arts, the National Academy of Recording Arts and Sciences, ASCAP, and BMI.

While I appreciate the fact that the proponents of SB 1005, SD2, HD1 intend to benefit Hawaii's recording artists, both living and deceased, the proposed legislation is unfortunately flawed and will, if it becomes law in its present form, have the unintended effect of stifling if not destroying the market for many Hawaiian music sound recordings especially older recordings and upsetting existing contractual relationships that have been in place for many years. The resulting confusion and potential litigation that would result from the passage of SB 1005, SD2, HD1 will have a profound "chilling effect" upon Hawaiian music, making it less attractive for use in performing arts products such as motion pictures, television shows and records (in all formats such as CDs and digital downloads). Furthermore, this sweeping legislation would create rights for individuals whose attributes do not have commercial value. Moreover, the bill is unnecessary and contrary to established law, would unconstitutionally regulate and restrict story-telling in sound recordings and audiovisual works, and would discourage motion picture<sup>20</sup>production, particularly in Hawaii.

### **SB 1005, SD2, HD1 Violates the First Amendment**

The First Amendment to the U.S. Constitution is designed to remove governmental restraints from public discussion and encourage the free flow of information and ideas. This includes comment, criticism and parody by filmmakers and other storytellers about public figures and personalities, the use of iconic public figures in debate about public issues, culture and values, in motion pictures and television shows,<sup>20</sup>and in other forms of expression. See Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495 (1952); Eronoznik v. City of Jacksonville, 422 U.S. 205 (1975); and Jenkins v. Georgia, 417 U.S. 153 (1974). The free flow of information and ideas is also protected from state and federal laws that would result in a chilling effect on speech, which includes motion pictures and television programs. The U.S. Supreme Court has ruled many times that laws that promote self-censorship because of the fear of legal consequences violate the First Amendment as much as laws that directly ban certain speech. See also Smith v. California, 361 U.S. 147, 154 (1959).

**The bill as currently drafted fails to protect expressive works clearly and unambiguously. The bill must be revised to provide a comprehensive and inclusive exemption for First Amendment protected activity, including all expressive works in any medium now known or hereafter devised. The failure to provide such an exemption will cause the bill to fail constitutional scrutiny.**

### **SB 1005, SD2, HD1 is Vague, Ambiguous and Overbroad**

SB 1005, SD2, HD1, as currently drafted, precludes the use of attributes of both “individuals” (all natural persons) and “personalities” (individuals whose attributes have commercial value). Application of this bill to all individuals whether or not there is any commercial value in the person’s name, signature, voice or likeness, renders the bill overbroad and vague. The right of publicity protects the commercial value in a person’s name, signature, voice, or likeness, thus the existence of commercial value is a fundamental requirement for such a right. Moreover, legislation that extends this right to all individuals would make it impossible for filmmakers to determine with any certainty as to whether their use of an individual’s name in telling a story could give rise to a lawsuit.

This bill also contains no limits as to who can receive its protection. Any person could come to Hawaii and assert a claim under this bill. There need be no nexus between Hawaii and the person who would make a claim. The bill makes no requirement regarding domicile, and thus a person need not establish or demonstrate any connection with Hawaii.

In addition, the bill, which contains provisions allowing for the transfer of a personality’s right of publicity, is confusing as to how to accomplish the transfer and how to put the public on notice that a right of publicity exists and has been transferred. Without a procedure for registering a transfer of a right of publicity, those who would like to obtain consent to use a personality’s attributes on or in goods, merchandise, or products would have no way of determining who is authorized to give consent for such use. The bill should have a registration requirement and procedure to give certainty to those who may seek consent to use a personality’s name, voice, signature, or likeness.

Further, SB 1005, SD2, HD1 fails to make clear that the right of publicity persists for a specified time period of seventy years following the death of a personality, and further fails to – but should – expressly state that no action may be brought for any use occurring after the expiration of seventy years after the date of the personality’s death. Without such clarification, this bill will cause an explosion of litigation as litigants seek to clarify confusing terms of this legislation.

In addition, the remedies provided by this bill are problematic. The availability of injunctive relief prior to publication runs afoul of the First Amendment. A court may grant a temporary restraining order prohibiting the dissemination of First Amendment-protected material, but only in very extraordinary circumstances, such as national security situations. In addition, the impounding of First Amendment-protected content prior to final judgment is on its face unconstitutional.

#### **This Bill is Unnecessary and Relief Can Be Sought at Common Law**

Most states do not have this kind of statute and are guided by common law in this arena. The misappropriation of another’s name or likeness is an invasion of privacy and actionable under common law. It is unnecessary to create a broad statute which infringes on the rights of creators in order to address the commercial use of a personality’s image or likeness. I also respectfully submit that this legislation would not be complementary to the economic development goals and objectives of the Hawaii Legislature to encourage and motivate an increase in local motion picture and television production. The likely result of this legislation is that motion picture producers would be discouraged from telling stories about public figures because of the threat of litigation under SB 1005, SD2, HD1.

#### **Background Regarding My Company**

Over the last twenty years my company has researched the legal and market status of numerous sound recordings of Hawaiian music many of which were originally released to the public prior to the effective date of the Copyright Act of 1976 (January 1, 1978). In cases where we have been able to establish a proper chain of title and clear the intellectual property rights involved (i.e. obtain a license or an assignment from the person or company that owns the rights (including copyright rights) in and to the sound recordings) we have, at significant cost, "cleaned up" (re-mastered) the sound recordings and made copies of 20 the same available for sale (such as in CD format) and/or license (for use in compilation albums and in motion picture and television shows). We always obtain all necessary mechanical licenses from the owners of the copyright in and to the underlying musical compositions and pay all royalties associated therewith. We also pay any artist or other royalties that may be required to be paid based upon prior contractual agreements. Often when no such royalties are required to be paid on a current basis (because the original contract required a lump sum payment or other arrangement for payment) we offer to pay an honorarium or royalty to the artist, if living, or to the heirs of the artist if the artist is deceased. We do so not because we have any obligation to do so but, rather, we do so out of principal as a token of respect to the artist. This is not a common practice in the industry and is pretty much unheard of on the mainland and elsewhere.

#### **Relevant Legal and Industry Background**

Sound recordings created prior to January 1, 1978 (the effective date of the current Copyright Act of 1976) which were paid for by a record company, record producer, or recording studio ("Record Label") were generally considered works "made-for-hire" under the 1909 Copyright Act. While the "work-for-hire" doctrine was not codified in the 1909 Act (the law prior to the Copyright Act of 1976), under the common law "work-for-hire" doctrine, the hiring party who paid for the creation of the work was deemed to be the "author" of the sound recording and therefore "owned" all rights to the sound recording. Along with the ownership of the rights in the sound recording, the "work-for-hire" author (the Record Label) obtained the right (usually a non-exclusive license) to identify the artist (i.e. attribute the recording to the performing artist). Thus, the record company had the right to release the album with the name and likeness (assuming appropriate use rights were obtained from the owner of the copyright to the photograph or artwork used in the "likeness") of the recording artist. This makes total sense as any other result would be absurd and render the recording commercially useless.

Artists who recorded under this industry practice were paid for their services as either "employees" or "independent contractors" for hire. Written contracts were not required by law and often never used. SB 1005, SD2, HD1 threatens to undermine those business arrangements and in the process deprive the public from access to these works.

The 1976 Copyright Act codified a modified version of the "work-for-hire" doctrine by setting up special rules depending upon whether a work was created by "employees" or "independent contractors." As a result of the passage of the 1976 Copyright Act (which among other things provided that copyrightable works created by independent contractors in connection with certain classes of works would be considered works "made-for-hire" under the law if a writing to that effect was signed by the persons who contributed copyrightable expression to the work) industry practice shifted and most if not all recording contracts soon contained an express acknowledgment that the work was to be deemed a work "made-for-hire" and/or if it was ever determined that the work would not qualify as a work "made-for-hire" that the hired party assigned his or her copyright rights in and to their contribution to the work to the hiring party. It also became a standard practice to include in all recording contracts a non-exclusive license which allows the artist's name, likeness and biographical information to be included in materials used in connection with the release of sound recordings by said artist such as liner notes and advertising materials.

### **Analysis**

Accordingly, any provision of law which would require, on a going forward basis, (let alone on a retroactive basis) that a record company must have a written agreement from the original artist, or the heirs of the artist, authorizing the record company to identify who appears as a performer on a particular sound recording would upset existing contractual arrangements and cast doubt over the right to use such information in connection with sound recordings where said rights were not previously reduced to writing.

This result would have a devastating impact upon my business and others in the recording industry particularly those companies that specialize in older sound recordings. Record Labels that followed the letter of the law, as it existed at the time, who properly acquired the legal right to reproduce and distribute such sound recordings would be unable to correctly and properly identify for the public the artists appearing on said recordings or said Record Labels would be required to go back to said artists (and if said artists are deceased to the heirs of said artists) to obtain such permission and no doubt would be required to pay additional monies in connection therewith. This would create a hornet's nest of doubt, confusion and ultimately litigation where the only winners would be the lawyers involved. More importantly, most Record Labels and motion picture and television production companies would simply choose other works for commercial exploitation to avoid the hassle and uncertainty created by this legislation.

### **Recording Industry Considerations and the Underlying Dispute**

The current legislation emanates from a dispute between the Estate of Genoa Keawe and my Company.

IN the mid 1990's, my Company obtained all right, title and interest in and to certain sound recordings owned by 49<sup>th</sup> State Records, including the Album "Among My Hawaiian Souvenirs" featuring Genoa Keawe. As is my practice, my Company re-mastered the sound recordings and prior to the re-release of the 20 Album in CD format offered the artist an "honorarium" to be paid in conjunction with the re-release of the Album. The "honorarium" was refused and Mr. Eric Keawe (son of Genoa Keawe) objected to the re-release of the Album. In this regard, it is important to note that Mr. Keawe and the estate of Genoa Keawe, do not assert ownership of the copyright rights in and to the subject sound recordings nor in the photograph of Genoa Keawe which was used in connection with the original release of the subject sound recordings and which I used in connection with my re-release of the subject sound recordings. Instead, it is Mr. Keawe's position that he, on behalf of his late mother, during her life, and now, on behalf of his late mother's estate, control Genoa Keawe's "right of publicity" (i.e. her name and likeness such as that which appears in the subject photograph) and that I'm not permitted to use his mother's name or likeness in connection with my marketing, distribution and sale of the subject sound recordings unless and until I have obtained a license from him to use the same and that to date, he has not agreed to provide such a license.

Nevertheless, even assuming Hawaii were to recognize a post-mortem right of publicity, the question presented by Mr. Keawe is whether, under Hawaii law, it is proper for me to use the name and likeness of a artist or performer to truthfully identify the



works created by that person. The general rule is that it is indeed permissible to use the name and likeness of an author or artist to correctly and truthfully identify works created by that person. This general rule is partially codified in the statutes of several states (other than Hawaii). Accordingly, record labels, CD retailers, art dealers etc. are permitted to use the identity of the creators of the articles that they deal in to sell or advertise their wares. In Hawaii, when there is no directly controlling precedent on a particular legal issue, the Hawaii courts often look to the Restatement of the Law for guidance in ruling upon a matter presented. In this regard, the Restatement Third, Unfair Competition, § 47, Comment a (1995) provides that:

**Use of a person's name or likeness for the purpose of identifying that person as the author or creator of the advertised goods is ordinarily permissible. Thus, a bookstore may include, in its advertising, the name and photograph of the author of an advertised book, and a movie theater may display the names and photographs of the actors appearing in the advertised motion picture.**

Similarly, other states follow this general rule that in the absence of a contract provision to the contrary, an author cannot validly object to the use of his or her name in connection with a work if the use merely consists of a truthful statement that the person is the author or featured performer of the work. I acknowledge that use outside the scope of this permitted use may be actionable as infringement of the right of publicity. In other words, if someone attempted to use Genoa Keawe's name and likeness in connection with the advertising and sale of products unrelated to the subject sound recordings (such as ukuleles, guitar strings, microphones, singing lessons etc.) in the absence of an agreement permitting such use, such use may be actionable as infringement of the right of publicity. Similarly, any false implications which suggest an endorsement of said products might be actionable as false advertising, but that is simply not the case here. Here, I only sought to use Genoa Keawe's name and likeness correctly and truthfully to identify her as the featured performer in the subject sound recordings. This, I'm able to do according to the general rule noted above.

States with a mature entertainment industry that have a "post-mortem" right of publicity such as California have statutory language that specifically exempts the usage of a person's name or likeness in various types of entertainment products from the prohibition against using a deceased person's name or a likeness without appropriate permission (see Cal. Civ. Code Section 3344.1(a)(2)). Furthermore, interpretation of the California "post-mortem" right of publicity statute is, in any event, subject to the general and widely accepted rule that it is permissible to use the name and likeness of an author or an artist to correctly and truthfully identify works created by that person. In Brown v. Ames, 201 F.3d 654 (5th Cir. 2000) the court surveyed the common law on this issue and concluded that the "common law on the right of publicity appears ordinarily to permit an authorized publisher or distributor to use name or likeness to identify truthfully the author or creator of the goods". 201 F.3d at 660. See also Zim v. Western Publishing Company, 573 F.2d 1318, 1327 (5th Cir. 1978) holding that authorization to publish author's work provided implicit authorization to use author's name to identify work. There is substantial additional authority to support this proposition.

While recent amendments to SB 1005 (set forth in SB 1005, SD2) adding the words "Beginning August 1, 2009" to the beginning of Section 3(a) and the deletion of Section 3(c) appear to be intended to avoid retroactivity and application of the law to these older recordings, these modifications do not go far enough and will not alleviate the complications I have set forth hereinabove.

## Conclusion

The best way to address this deficiency in the statute is to create a general exemption that provides that the use of a personality's name, voice, signature or likeness in various types of works such as plays, books, stories, magazines, newspapers, musical compositions, sound recordings, photographs, audiovisual works and other similar types of creative works **and advertisements for said works** be excluded from the law. Of course, if a Record Label is properly challenged by someone (with legal standing to do so) who alleges that the Record Label never acquired the necessary rights to duplicate and distribute a particular sound recording, that individual already has legal recourse as allowed by other applicable rules of law.

While I totally support an artist's (or the heirs of an artist's) right, to stop unauthorized use of the artist's name or likeness to endorse product sales such as ukuleles, muumuus, leis etc., the law as proposed goes way beyond such concerns and is therefore overly broad and unworkable.

I would be happy to work with you in crafting appropriate amendments to SB 1005 that serve the needs of Hawaii's artists while respecting past industry practice and existing contractual arrangements. In this regard, I respectfully submit that the attached draft amendment to SB 1005 be adopted. These amendments:

- Clarify that only a personality, not any individual, has a property right in the commercial use of his/her name, voice, signature or likeness.
- Eliminate photograph from the attributes of a personality, since a photograph is a visual work which should be exempt from this legislation.
- Establish that a living personality must be domiciled or reside in Hawaii and that a deceased personality must have been

domiciled in or resided in Hawaii at the time of the personality's death.

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- **Create a comprehensive expressive works exemption that clearly, specifically and unambiguously sets forth that creative works may use the attributes of a personality as part of their creative expression, in the form of books, plays, stories, articles, motion pictures, television programs, etc. and any advertisements of such creative works.**
- Modify the definition to exclude “distinctive appearance, gestures, or mannerisms from an individual” since those qualities are not part of the attributes of a personality.
- Establish a process of the transfer or assignment of the property right and the registration of the property right so that anyone who wants to obtain consent for use of a personality's attributes can do so.
- Eliminate the authority of a court to impound materials alleged to have been used in violation of the personality's rights and to order destruction of material used in violation of the party's rights. These remedies have a chilling effect on protected speech.
- Make the remedy available under this bill the exclusive remedy and not in addition to any other remedies that may exist.
- Clarify that the duration of right established is seventy years after the death of the personality (co-extensive with the term of copyright).

These amendments narrow the legislation to its stated purpose – to protect Hawaiians' publicity rights and to ensure that they have the ability to authorize the use of their name, voice, signature, or likeness in goods, merchandise or products. The bill, if revised in accordance with the proposed amendments, should withstand scrutiny under the First Amendment and would properly accord a right of publicity without limiting the constitutionally protected right of free expression.

Very truly yours,

Michael Cord

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**From:** Mark D. Bernstein [markdb@hawaii.rr.com]  
**Sent:** Monday, April 06, 2009 1:05 PM  
**To:** JUDtestimony  
**Subject:** S.B. No. 1005- hearing Date April 7, 2009 at 2:00 p.m.  
**Attachments:** Fergerstrom.pdf

***The following e-mail is the testimony of Mark D. Bernstein concerning Senate Bill 1005, relating to Publicity Rights which is scheduled for hearing before the Judiciary Committee on Tuesday, April 7, 2009 at 2:00 p.m. This testimony is not submitted on behalf of any organization or person, other than the author, Mark D. Bernstein.***

To the members of the Judiciary Committee,

I have concerns about SB 1005(the Bill). These concerns are not addressed at the intended purpose of the Bill. I believe that it is worthwhile to statutorily recognize the right of publicity, namely the right of all persons to control the use of their name, likeness and other commercially valuable attributes of their personalty, such as their voice and signature, whether they are recording artists, public figures, or simply a common everyday citizen. Simply stated, no one should be able to make commercial use of another's name, likeness or other commercially valuable attribute of their personalty without that person's permission. Indeed, this already appears to be the law of this state as the result of the case of *Fergerstrom v Hawaiian Ocean View Estates 50 Haw. 374, 441 P. 2d 141 (1968)*, where our Supreme Court recognized a right not to have one's name and picture used without their permission as a part of an advertising campaign. A copy of the decision is attached.

I also believe that it is appropriate and worthwhile to statutorily recognize that the right of publicity does not terminate at death. As the committee has no doubt discovered in its research concerning this right, the genesis of the right of publicity is in the law of privacy and historically, the right of privacy was a right that terminated at death. However, the right of publicity is one that does not from a practical matter terminate upon death, but in fact is often a right which is made more valuable by death. Moreover, any number of inventive exceptions have been created to get around this historically based anomaly, so it makes sense to address it head on.

My concerns are based upon my experience as a lawyer who over the past 28 years in Hawaii has provided services to, record companies, commercial users of music, advertisers, publishers, and organizations such as the Hawaii Academy of Recording Arts, where I was honored to have a seat on the initial Board of Governors. It is this experience that leads me to point out, the following concerns about the Bill.

My concerns start with section 1. This section makes it plain that it is intended to protect the music of Hawaii and all other works of authorship. No such limitation is necessary, nor is it appropriate. The right of publicity is not a right that should be limited to recording artists and authors. Is there a reason why I should be able to exploit Lex Brodie's right of publicity because he is not recording artist or author?

In addition, I am concerned over the Bill's attempt to give the "brush off" to existing copyright law. If a person and/or entity is the lawful owner of a valid copyright in a sound recording, that person or entity should be able to make any lawful use of the copyright they own. Moreover, they may very well be legally obligated to attribute the copyrighted work to its author regardless of whether there is a specific grant of the right to do so. Nonetheless, the bill provides that even if the author of the sound recording validly assigned his/her copyright in that sound recording to a third party, that third party has no right to put the author's name on that sound recording, unless there was contained in the assignment a specific grant of the right to use the author's name upon the author's sound recording.

I would strongly urge from committee to revise section 1 to eliminate any reference to copyright law, and instead to focus on the right in question, namely the right of publicity, a right which all of the people of the State of Hawaii ought

to enjoy, a right that enables all to control the commercial use of their name, likeness, and other commercially valuable attributes of their personality from unpermitted commercial exploitation.

My next concern is in the definitions. While well intended, the definition of deceased personality contains a hole. The definition of deceased personality is such that it implies that unless the decedent name, voice, signature, photograph or likeness had commercial value at the time of their death, there is no right of publicity. However, the tale of the artist who was unrecognized and had no commercial value during their life, only to become an iconic figure in death is not an unknown phenomenon. Such a person would have no right of publicity as a deceased personality. This is yet another reason to extend the right to all citizens.

My next concern is in section 2 which clearly implies that prior to August 1, 2009 the right of publicity did not exist. Given the existence of the *Fergerstrom Decision*, I am at a loss to understand why the Legislature wants to create the impression that this important right did not exist until August 1, 2009.

Section 4C addresses the issue of who may exercise the rights granted in the chapter. However, it does not state that it applies to rights that were, prior to the individual's death, validly assigned to others. Thus, it creates the implication that the rights are only exercisable by a personal representative, attorney-in-fact, parent of a minor child, guardian, or as authorized by a court of competent jurisdiction. . Another concern with respect to who may exercise the rights has to do with the fact that it may not be possible under Hawaii law for a personal representative to be appointed for an estate which has been closed for decades. This is of special concern to the rights of publicity for recording artists in Hawaii who have been deceased for 20 years or more.

Section 5 states what constitutes an infringement of the right of publicity. Therein, the Bill provides that any person who uses or authorizes the use of any one's name, voice signature, photograph or likeness on any goods entered into commerce in Hawaii, or who for the purpose of advertising products and goods or services (I have no idea how merchandise differs from products or goods) disseminates or publishes advertisements in this state that contain the name voice signature photograph or likeness of an individual without the express or implied consent of the rights holder has infringed the right of publicity. This is broad language, which would be fine, if subsequent provisions of the Bill didn't modify it in an entirely unworkable fashion.

The present language of the Bill covers the following statements:

1. Please visit our beautiful dining room where you may dine in a room adorned with the magnificent works of John M. Kelly;
2. Hear the same rolling surf calling to you that inspired Andy Cummings to write of Waikiki;
3. Appearing for night only Robert and Roland Cazimero;
4. In celebration of Kuhio Day, all Israel Kamakawiwo'ole recordings are half off the retail price.

Each of these uses infringes the right of publicity, unless the individuals in question signed a specific written agreement allowing their name to be used in these examples. While section 5 states "express or implied consent", the only consent mentioned in the exemption section of the Bill (7(b)) is a signed written agreement.

There is no exception for a verbal agreement or an agreement by implication in the exemption and accordingly, unless the Hawaii Theatre had a signed agreement from Robert and Roland Cazimero permitting it to use their names in connection with a Robert and Roland Cazimero performance, the Hawaii Theatre could not advertise the performance for which it was paying Robert and Roland Cazimero to appear. Does this make any sense?

Should a restaurant or hotel dining room that is adorned with the reproductions of famous local artists be enjoined from telling its customers what is on the wall? Should the Kahala Resort be forced to take down to the photographs of



persons who have stayed there because the resort does not have executed written permission to display those photographs. The same is true for the photographs of diners at various restaurants.

Simply stated, if a person has consented either verbally or by implication to the use of their likeness etc., that permission should be respected, whether it was given in writing or verbally, expressly or by implication. Does the diner who poses for a picture with Keo, beneath a wall of other famous diners posing with Keo not know what he/she is doing or what will become of the photo? I think not. This is especially true if the Bill is going to have retroactive application for it is one thing to require people to get a written agreement going forward. It is another thing entirely to tell them that the verbal permission they thought was valid 5 years ago is no longer valid.

In sum, I believe that the appropriate and well-intentioned aims of the supporters of this Bill can be more effectively addressed in a shorter and more focused piece of legislation. That legislation should not be aimed solely at protecting the rights of so-called celebrities. It should be aimed at protecting the rights of all Hawaii citizens from the unconsented exploitation of their name, likeness and any other commercially valuable attribute of their personalty.

The bottom-line is that the use of anyone's name, likeness voice or signature for another's commercial gain without permission is wrong. The key element is "without permission". Therefore, the statute ought to be focused at this wrong while containing the very effective and appropriate restraints and sanctions that are already embodied in the bill. A bill that protects the right of all citizens to control the commercial exploitation of their name, likeness and other valuable attributes of their personalty is a bill that all citizens should support.

In closing, I am not sure I understand the purpose of making this legislation effective in 103 years. If the concept is that this time period will flush out any uncertainties based on the past, it will accomplish this, for the most part. I certainly cannot tell if IZ or Aunty Genoa or Gabby will still pack the commercial punch that requires protection. However, if the law does not go into effect for over a century, then what is the benefit of its enactment today, especially one that does not recognize that the right already exists.

Thank you for the opportunity to provide my comments and concerns. As noted above, there are my own concerns and do not purport to represent the views of anyone else.

Very truly yours,

Mark Bernstein,

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C

Supreme Court of Hawai'i.  
 Betty Box FERGERSTROM and Joseph E.  
 Fergerstrom, Plaintiffs-Appellees,

v.


HAWAIIAN OCEAN VIEW ESTATES, a Nevada  
 corporation, Defendant-Appellant.  
 No. 4675.

May 14, 1968.

Plaintiffs, who purchased parcel of land from corporation, brought action against corporation for invasion of right of privacy. The Third Circuit Court, City and County of Hilo, A. M. Felix, J., denied corporation's motion for summary judgment, and corporation brought an interlocutory appeal. The Supreme Court, Levinson, J., held that purchasers of land had cause of action for invasion of right of privacy against defendant corporation when employees of corporation took pictures of one plaintiff and of house at various stages of construction and used the photographs and plaintiffs' name in sales brochures, in advertisement in publications and in television commercials.


Affirmed.

West Headnotes

[1] Action 13  2

13 Action  
131 Grounds and Conditions Precedent

13k2 k. Acts or Omissions Constituting Causes of Action in General. Most Cited Cases

**Torts 379  330**

379 Torts

3791V Privacy and Publicity

3791V(B) Privacy

3791V(B)1 Privacy in General

379k330 k. In General. Most Cited Cases

(Formerly 379k8.5(1), 379k8)

Fact that there had been no common law remedy for invasion of privacy and that legislature did not provide for one did not prevent court from allowing recovery in an appropriate case.

[2] Courts 106  89

106 Courts

1061I Establishment, Organization, and Procedure

1061I(G) Rules of Decision

106k88 Previous Decisions as Controlling or as

Precedents

106k89 k. In General. Most Cited Cases

**Torts 379  330**

379 Torts

3791V Privacy and Publicity

3791V(B) Privacy


3791V(B)1 Privacy in General

379k330 k. In General. Most Cited Cases

(Formerly 379k8.5(1), 379k8)

Lack of precedent in allowing plaintiff to recover under cause of action not previously granted is a feeble argument

where plaintiff has made out case for invasion of privacy.

**[3] Damages 115**  **57.10**

115 Damages

115III Grounds and Subjects of Compensatory Damages

115III(A) Direct or Remote, Contingent, or Prospective Consequences or Losses

115III(A)2 Mental Suffering and Emotional Distress

115k57.8 Nature of Injury or Threat in General

115k57.10 k. Physical Illness, Impact, or Injury; Zone of Danger. Most Cited Cases  
(Formerly 115k49.10, 115k48)

**Torts 379**  **330**

379 Torts

379IV Privacy and Publicity


379IV(B) Privacy

379IV(B)1 Privacy in General

379k330 k. In General. Most Cited Cases

(Formerly 379k8.5(1), 379k8)

Argument that injury is purely mental in character is not a bar to recovery for invasion of privacy.

**[4] Action 13**  **2**

13 Action

13I Grounds and Conditions Precedent

13k2 k. Acts or Omissions Constituting Causes of Action in General. Most Cited Cases


**Action 13**  **9**

13 Action

13I Grounds and Conditions Precedent

13k9 k. Unnecessary or Vexatious Actions. Most Cited Cases

Fact that creation of new cause of action will increase litigation is unpersuasive in determining whether or not that cause of action ought to be created, unless litigation largely will be spurious and harassing.


**[5] Action 13**  **9**

13 Action

13I Grounds and Conditions Precedent

13k9 k. Unnecessary or Vexatious Actions. Most Cited Cases

Possibility that new cause of action will be abused by some plaintiffs cannot obscure need to provide an appropriate remedy.


**[6] Action 13**  **9**

13 Action

13I Grounds and Conditions Precedent

13k9 k. Unnecessary or Vexatious Actions. Most Cited Cases

Only in unusual case where parties actually injured are likely to sue and where those likely to sue are not those whose interests are of primary concern can possibility of abuse be given substantial weight in determining whether to recognize a new cause of action.

**[7] Torts 379**  **334**

379 Torts

379IV Privacy and Publicity

379IV(B) Privacy  
379IV(B)1 Privacy in General  
379k334 k. Public Interest, Record, Figures.

Most Cited Cases

(Formerly 379k8.5(3), 379k8)

The difficulty of distinguishing whether or not plaintiff, in an action for invasion of privacy, is a public or a private figure is no bar to recognition of cause of action.

**[8] Torts 379 394**

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness; Right to Publicity

379k392 Matters of Public Interest or Public Record; Newsworthiness

379k394 k. Public Figures. Most Cited

Cases

(Formerly 379k8.5(6), 379k8)

**Trademarks 382T 1427**

382T Trademarks

382TVIII Violations of Rights

382TVIII(A) In General

382Tk1423 Particular Cases, Practices, or Conduct

382Tk1427 k. Advertising or Marketing.

Most Cited Cases

(Formerly 382k482.1, 382k482 Trade Regulation)

Where defendant appropriated plaintiffs' name and personality for its own benefit in advertising, without plaintiffs' permission, it was not relevant whether plaintiffs were public or private figures, and it would be no defense in action for invasion of privacy, even if plaintiffs were public figures.

**[9] Constitutional Law 92 1652**

92 Constitutional Law

92XVIII Freedom of Speech, Expression, and Press

92XVIII(E) Advertising and Signs

92XVIII(E)2 Advertising

92k1652 k. Right of Publicity; Misappropriation of Likeness, Name, or Celebrity Status.

Most Cited Cases

(Formerly 92k90.3, 92k90.1(1), 92k90)

Recognition of a right not to have one's name and picture used without his permission as part of an advertising campaign does not involve a restriction on free speech and press.

**[10] Torts 379 390(2)**

379 Torts

379IV Privacy and Publicity

379IV(C) Use of Name, Voice or Likeness; Right to Publicity

379k386 Conduct or Misappropriation Actionable in General

379k390 Picture, Photograph, or Likeness

379k390(2) k. Particular Cases. Most

Cited Cases

(Formerly 379k8.5(6), 379k8)

Plaintiffs, who purchased parcel of land from corporation, had cause of action for invasion of privacy when corporation's employees took pictures of one plaintiff and the house at various stages of construction, and used the photographs and plaintiffs' name in sales brochures, in advertisement in publications, and in television commercials.

**\*\*142 Syllabus by the Court**

The common law recognizes a cause of action for invasion

of a right of privacy where the defendant uses the plaintiff's name or picture without permission in advertising the defendant's product.

\*378 L. N. Nevels, Jr., Hilo (Nevels & Chang, Hilo, of counsel), for defendant-appellant.

E. D. Crumpacker, Kailua Kona, for plaintiffs-appellees.

\*374 Before RICHARDSON, C. J., and MIZUHA, MARUMOTO, ABE and LEVINSON, JJ.

LEVINSON, Justice.

This case comes to us on interlocutory appeal from an order denying the defendant's motion for summary judgment. The plaintiffs' complaint alleges that they, husband and wife, purchased a parcel of land from the defendant, a corporation, for the construction of a house. The defendant's employees took pictures of one of the plaintiffs and of the house at various stages of construction. The defendant used the photographs and the plaintiffs' name in sales brochures, in advertisements in publications, and in television commercials. The complaint alleged that the defendant's acts constituted an actionable invasion of their right of privacy. Count I alleged:

The use of said photographs and the names of the plaintiffs as aforesaid was without the prior knowledge and consent of plaintiffs and constitutes multiple continuing and multifarious violations of plaintiffs' right of privacy, by reason of which plaintiffs have been held up to public exposure and ridicule, their right of privacy has been invaded by a continuous stream of defendant's 'sales prospects' coming on to plaintiffs' property, using plaintiffs' facilities and generally bothering plaintiffs\*375 in their said home, causing humiliation, annoyance and embarrassment to plaintiffs to their damage in the sum of

\$25,000.

The second count alleged a cause of action for unjust enrichment. The final count requested \$25,000 punitive damages on the ground that the defendant has refused to discontinue using the plaintiffs' photographs and name. The defendant moved for summary judgment on the grounds that there is no common law action for invasion of privacy and that the legislature has not provided for such an action.

[1] The defendant contends that since the ancient common law did not afford a remedy for invasion of privacy, and there is no case in Hawaii recognizing such a right, only the legislature can provide for such a cause of action.[FN1] The magnitude of the error in the defendant's position approaches Brobdingnagian proportions. To \*\*143 accept it would constitute more than accepting a limited view of the essence of the common law. It would be no less than an absolute annihilation of the common law system. This spectre of judicial self-emasculation has pervaded one case in which the court accepted this line of argument. Brunson v. Ranks Army Store, 161 Neb. 519, 73 N.W.2d 803 (1955)[FN2].

FN1. We are disinclined to decide an important issue merely on the basis of the number of states adopting a given approach. But some weight must be accorded to the overwhelming recognition of a common law right of privacy by all but a few states. Between 1941 and 1964, the number of states recognizing a cause of action for invasion of privacy increased from 8 to 31. See Annot. 14 A.L.R.2d 750 (1950) and 2 Supp. 172 (1965). We are inclined to agree with Professor Kalven's observation that:

It takes a special form of foolhardiness to raise one's voice against the right of privacy at this

particular moment in its history \* \* \*. Its development is a bit of legal culture to be proud of: it shows that the 'eternal youth' of the common law is still green; it is a reflection of civilized sensitivity to subtle harms \* \* \*. Kalven, *Privacy in Tort Law-Were Warren and Brandeis Wrong?* 31 *Law & Cont. Prob.* 327 (1966).

FN2. The opinion has been roundly criticized, Perlman, *The Right to Privacy in Nebraska: A Re-examination*, 45 *Neb.L.Rev.* 728 (1966).

A case decided, 4 to 3, by the New York Court of Appeals best articulates the arguments against judicial recognition of an action for invasion of privacy, Roberson v. Rochester Folding Box Co., 171 N.Y. 538, 64 N.E. 442, 59 L.R.A. 478 (1902). The majority opinion presents five basic arguments. First, there was no precedent in the \*376 ancient English common law. Second, the injury was of a purely mental character. Third, a 'vast amount of litigation' would be encouraged. Fourth, the distinction which would have to be drawn between public and private characters could not be effectively drawn. Fifth, it might unduly restrict free speech and press. However persuasive these arguments may have been in 1902, they amount to little more than straws in the wind today.

[2] On the issue of lack of precedent, there is a substantial question whether the common law provided no basis for recognizing a right of privacy, Roberson v. Rochester Folding Box Co., *supra* at 565-566, 64 N.E. at 450-451 (gray, J. dissenting); Warren and Brandeis, *The Right to Privacy*, 4 *Harv.L.Rev.* 193 (1890). In any event, the absence of precedent is a feeble argument.[FN3] The common law system would have withered centuries ago had it lacked the ability to expand and adapt to the social, economic, and political changes inherent in a vibrant human society.

FN3. Justice Cardozo very appropriately described the situation which results from judges automatically deferring to precedent:

Judges march at times to pitiless conclusions under the prod of a remorseless logic which is supposed to leave them no alternative. They perform it, none sacrificial rite. They perform it, none the less, with averted gaze, convinced as they plunge the knife that they obey the bidding of their office. The victim is offered up to the gods of jurisprudence on the altar of regularity. Cardozo, *Growth of the Law* 66 (1924).

The defendant asks us to follow the same principle although applied inversely.

'(T)he genius of the common law, upon which our jurisprudence is based, is its capacity for orderly growth.' Lum v. Fullaway, 42 Haw. 500, 502 (1958). Indeed, tort law as we know it today bears little, if any, resemblance to tort law in its early development, when a writ held the key to entry into the room of justice.[FN4] This court recognized the relatively new tort of intentional infliction of emotional distress although there was no more precedent in the ancient common law for that tort than for the protection of the right of privacy, see Fraser v. Blue Cross Animal Hosp., 39 Haw. 370 (1952).

FN4. Although the law of trespass was reasonably well established in the common law by the thirteenth century, no private action was available for fraud. The absence of a precedent did not prevent the common law from recognizing that tort. Pollock and Maitland, *History of English Law* 534-35 (1899).

[3] As for the argument that the injury is purely mental in

\*377 character, even if it were true it would not be persuasive. In the Fraser case, the court recognized a tort which was defined in terms of infliction of solely mental injury.

[4][5][6] The argument that recognizing the tort will result in a vast amount of litigation has accompanied virtually every innovation in the law. Assuming that it is true, that fact is unpersuasive unless the litigation largely will be spurious and harassing. Undoubtedly, when a court recognizes a new cause of action, there will be many cases based on it. Many will be soundly based and the plaintiffs in those cases will have their rights vindicated. In \*\*144 other cases, plaintiffs will abuse the law for some unworthy end, but the possibility of abuse cannot obscure the need to provide an appropriate remedy.[FN5]

FN5. Only in the unusual case where parties actually injured are unlikely to sue and where those likely to sue are not those whose interests are of primary concern can the possibility of abuse be given substantial weight in determining whether to recognize a new cause of action, *Kalven, Privacy in Tort Law-Were Warren and Brandeis Wrong?* 31 Law & Cont. Prob. 326, 338-39 (1966).

[7][8] As to the need to distinguish between public and private figures, the difficulty of drawing a line is no bar to the recognition of a cause of action.[FN6] But such a distinction is irrelevant in this case since the defendant has appropriated the plaintiffs' name and personality for its own benefit in advertising. Even were the defendant able to establish at trial that the plaintiffs were public figures, that would not be a defense to this cause of action. Furthermore, distinguishing between private and public figures is not as difficult a task as the defendant suggests.[FN7]

FN6. The difficulty in discovering the line dividing conduct satisfying that required under the reasonable man standard and conduct failing to do so has not prevented development of a cause of action for negligence.

FN7. The United States Supreme Court has relied on precisely such distinctions in determining whether actions for defamation of character unconstitutionally infringe on First Amendment freedoms, *Curtis Pub. Co. v. Butts*, 388 U.S. 130, 87 S.Ct. 1975, 18 L.Ed.2d 1094 (1967).

[9] Finally, the recognition of a right not to have one's name and picture used without his permission as part of an advertising campaign does not involve a restriction on free speech and press. The only communications the defendant made in which it used the plaintiffs' name and pictures were for the purpose of selling its product. Whatever limitations on other aspects of the right of privacy may have to be recognized because of the need to protect the First Amendment freedoms we hold so precious, the infringement alleged in this case does not raise the issue.

[10] We hold that the plaintiffs' complaint states a cause of action for invasion of the right of privacy. We go no further than to indicate that protection is available for appropriation of name or picture for commercial purposes. We do not now decide whether other aspects commonly included under a general right of privacy will receive similar protection.[FN8] These issues remain to be decided in subsequent cases raising them, preferably after a trial on the merits.

FN8. See *Kalven*, supra note 5.

Affirmed.

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