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**GINGER ROGERS, Plaintiff, v. ALBERTO GRIMALDI and MGM/UA  
ENTERTAINMENT CO., Defendants; GINGER ROGERS, Plaintiff, v. PEA  
PRODUZIONI EUROPEE ASSOCIATE, S.R.L., Defendant**

Nos. 86 Civ. 1851 (RWS), 86 Civ. 7481 (RWS)

**UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW  
YORK**

**695 F. Supp. 112; 1988 U.S. Dist. LEXIS 8694; 8 U.S.P.Q.2D (BNA) 1562; 15 Media L. Rep.  
2097**

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**LexisNexis(R) Headnotes**

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Pryor, Cashman, Sherman & Flynn, Esqs., By: Stephen F. Huff, Esq., Tom J. Ferber, Esq., Charles B. McKenna, Esq., of counsel, New York, New York, Attorneys for Defendants.

**JUDGES:**

Robert W. Sweet, United States District Judge.

**OPINIONBY:**

SWEET

**OPINION:**

[\*113] ROBERT W. SWEET, UNITED STATES DISTRICT JUDGE

Defendants Alberto Grimaldi ("Grimaldi"), MGM/UA Entertainment Co. ("MGM") and PEA Produzioni Europee Associate, s.r.l. ("PEA") (collectively, "Defendants") have moved pursuant to Fed.R.Civ.P. 56 for summary judgment dismissing the complaints of plaintiff Ginger Rogers ("Rogers") in their entirety. Upon the findings and conclusions set forth below, the motion is granted.

What must be determined here is the boundary between commercial and artistic speech and the extent of the protection given under the First Amendment to the expression of an idea in a commercial film "Federico Fellini's 'Ginger and Fred'" (the "Film"), as opposed to the protection of a famous actress' name, Ginger Rogers,

under the Lanham Act and the common law. The conflict is direct and significant and was presented with skill and strength by able advocates. In this contest artistic expression [\*\*2] has prevailed, indeed, at least in part as a consequence of the symbolic fame of Ginger Rogers.

**Facts**

Ginger Rogers is well-known, a celebrity who enjoys a world-wide reputation. She has been performing in one entertainment medium or another for over 50 years, most prominently in motion pictures, having played major roles in some 73 films over a 35 year period and having won an Academy Award for her performance of the title role in "Kitty Foyle" in 1940. Rogers' greatest impact as far as this fact-finder is concerned, however, is attributable to the ten musical films in which she co-starred with Fred Astaire. These films, beginning with "Flying Down to Rio" in 1933 and concluding with "The Barkleys of Broadway" in 1949, established Fred Astaire and Ginger Rogers as the icons of elegant ballroom dancing during Hollywood's Golden Age. This famous pair became so well known that the term "Fred and Ginger" has come to be a metaphorical symbol for fine ballroom dancers and is frequently used in the press as a shorthand term for elegant dancers and dancing. n1

n1 The following are excerpts from some of the newspaper and magazine articles submitted by Defendants in which dancers are referred to as "Fred and Ginger" and dance numbers as "Fred and Ginger" routines:

(a) "Sashaying into Ballroom Dancing," by Dorothy MacKinnon. *The Washington Post*, August 27, 1982. Reference: "For the real aficionados, dancing becomes a way of life. Washington's serious Freds and Gingers do most of their dancing

at the social dances held by area studios."

(b) "Music and Dance Star in Film Maker's Short," by Jennifer Dunning. *The New York Times*, August 30, 1983. Reference: ". . . the film's dance styles range from disco and 1920's jazz to a final 'Fred and Ginger' filmed on the esplanade . . ."

(c) "And Now For The Samurai Flamenco, By A Japanese Isadora," by Barbara Rowes. *People*, June 14, 1982. Reference: "She began working with Miguel in 1967, and they became the Fred and Ginger of flamenco."

(d) "Foxtrotting Without Fear," by Faye Rice. *Fortune*, March 17, 1986. Reference: "Other aspiring Freds and Gingers remain more footloose."

(e) "Affairs of the Hearts," by Jamie Gold. *The Washington Post*, December 2, 1981. Reference: "This Valentine's Day it's easy to become entangled in an affair. For instance, Georgetown Park is having a free one Sunday, with a big-band jazz 1 to 3 and a professional ballroom dance couple offering instruction in dancing a la Fred and Ginger."

[\*\*3]

[\*114] During her career, Rogers has maintained a high standard of taste, avoiding that which she considers seedy, ugly, or profane. During her lifetime, while she has lent her name to certain enterprises, such as J.C. Penney, Rogers has been highly selective with respect to such endorsements.

The subject of this action is "Federico Fellini's 'Ginger and Fred,'" a motion picture that began a relatively brief U.S. theatrical distribution in March 1986. MGM distributed the Film in the U.S. All the advertising and posters for the Film entitled it as it is in the defined term. PEA produced the Film, and Grimaldi acted as its individual producer. Federico Fellini ("Fellini"), who conceived, co-wrote and directed the Film, is widely regarded as one of the world's greatest film-makers. Over the last 34 years he has brought 17 full length films to the motion picture screen, four of which — "La Strada," "The Nights of Cabiria," "8 1/2" and "Amarcord" — have garnered the Academy Award for Best Foreign Film.

The Film, which was advertised in promotional posters as "the movie that looks at television through the eyes of Fellini," is a fictional work that depicts the bitter-sweet reunion of two retired [\*\*4] dancers. Decades earlier, as the Film's story goes, these two dancers had made a living in Italian cabarets imitating Fred Astaire and Ginger Rogers, thus earning the nickname "Ginger and Fred." The Film satirizes the world of television by presenting the central characters' reunion against the background of an Italian television special for which they are called upon

to reprise the routine that they have not performed in 30 years. Marcello Mastroianni and Giulietta Masina play the roles of Pippo and Amelia, the aging Italian "hoofers" who try to defy time by reviving their imitation of two legendary dancers of a bygone era. n2

n2 Although the Film received mixed reviews in the United States, the following excerpts evince the reviewers' recognition of the Film's characters as imitators of Rogers and Astaire and of the tribute that the Film intended to make: (a) "Last Waltz in Roma," by Jack Kroll. *Newsweek*, March 31, 1986:

. . . Fellini's film is an act of homage to [Astaire and Rogers]. By casting Giulietta Masina and Marcello Mastroianni as two retired old hoofers who used to bill themselves as Ginger and Fred, Fellini acknowledges the mythic status of the great American dance team.

(b) "Film: Lost Souls and Soulful Strangers," by Julie Salamon. *The Wall Street Journal*, April 3, 1986:

The press materials for Federico Fellini's new movie, 'Ginger and Fred,' firmly state that the movie has nothing to do with Fred Astaire and Ginger Rogers. This is more or less true . . . . All references to the real Fred and Ginger are entirely respectful and almost beside the point, since the purpose of the picture seems to be to satirize television, and more obliquely, life itself.

(c) "Roman Holiday" by Stanley Kauffman. *The New Republic*, April 14, 1986:

[The Film's couple] was professionally known as Ginger and Fred. Played by [Masina and Mastroianni], they haven't the slightest resemblance to their namesakes; but they did wear similar clothes, tried to dance like the famous pair, used the same tunes, and cashed in, as they imitatively could — in music halls, not in films — on the Italian passion for Hollywood.

[\*\*5]

In an affidavit submitted in support of Defendants' motion, Fellini, who is not a party but who took part in writing both the story treatment and the actual screenplay for the Film, explained his reasons for utilizing Astaire and Rogers as the subject of the Film's imitation:

My reason for using this nickname for my characters is that Fred Astaire and Ginger Rogers were a glamorous and care-free symbol of what American cinema represented during the harsh times [\*115] which Italy experienced in the 1930's and 1940's. It comforted us to know that a different kind of life existed. In those grey and difficult times, the films of Ginger Rogers, Clark Gable, Fred Astaire and Greta Garbo consoled us with thoughts of a better world. That is why in my film I have created central characters who, the story goes, had become popular in Italy by performing their "Ginger and Fred" routine.

With respect to the Film's central characters, Fellini stated:

The characters of Amelia and Pippo in [the Film] do not in any way resemble Fred Astaire and Ginger Rogers, nor were they ever intended to portray them. Rather, Amelia and Pippo are two aging and retired dancers who were Italian cabaret performers, [\*\*6] whose "act" consisted of an imitation of the American legends whose name they borrowed for their routines.

As opposed to portraying Rogers and Astaire in any representative form, Fellini claims that he invoked Rogers and Astaire "only as a reference in the film based on their well-deserved reputation as paragons of style and excellence in dancing."

Rogers commenced this action in March 1986, at or about the time the Film began its theatrical distribution in the U.S. She seeks permanent injunctive relief and money damages "arising from defendants' impermissible and unlawful misappropriation and infringement of Ginger Rogers' public personality." (Compl. para. 1). Rogers' first claim for relief is premised on the common law right of publicity. Her second claim alleges that the Film constitutes a false light invasion of privacy because it allegedly "depicts the Film's dance team, Fred and Ginger, as having been lovers and depicts them in a seedy manner." (Compl. para. 18). Her third claim is based upon Section 43(a) of the Lanham Act and alleges that the Film creates

the false impression that Rogers endorsed or was involved in it. (Compl. para. 23).

After two years of discovery, Defendants [\*\*7] moved for summary judgment dismissing the complaint. In opposition to the motion, Rogers has submitted a market research survey dated July 1986 which reports that based on approximately 200 interviews in Boston and New York (Staten Island) 43% of those exposed to the Film's title only connected the Film with Rogers and that 27% of those exposed to the Film's advertisement connected the Film with Rogers. Rogers also learned during discovery that MGM had devised several promotional ideas for marketing the Film on the strength of the public's familiarity with Ginger Rogers and Fred Astaire. These ideas included using still photographs of Ginger Rogers and Fred Astaire, requesting that guests invited to the New York premiere of the Film "Dress: Ginger or Fred," and using a "Ginger and Fred" dance cane, an item associated with Fred Astaire, despite the fact that the male lead in the Film does not use a cane during dance routines. Only the latter suggestion was ultimately implemented.

Oral argument on Defendants' motion for summary judgment was held on April 22, 1988.

#### *Summary Judgment*

Fed.R.Civ.P. 56 provides that "a court shall grant a motion for summary judgment if it determines that [\*\*8] 'there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.'" *Knight v. U.S. Fire Ins. Co.*, 804 F.2d 9, 11 (2d Cir. 1986), cert. denied, 480 U.S. 932, 107 S. Ct. 1570, 94 L. Ed. 2d 762 (1987). If the evidence is such that a reasonable finder of fact could return a verdict for the non-moving party, summary judgment should not be granted. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986). After adequate time for discovery, if the non-moving party fails to make a showing sufficient to establish the existence of an element essential to its case, and on which it will bear the burden of proof at trial, summary judgment is appropriate. In such a situation, there can be no "genuine issue as to any material fact," since a failure of proof on an essential element of the case of the non-moving party "necessarily renders all other facts [\*116] immaterial." *Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 91 L. Ed. 2d 265, 106 S. Ct. 2548 (1986).

Here, Defendants contend that Rogers' claims are precluded by the protections afforded Defendants pursuant to the First Amendment. The Defendants argue that the references to Rogers are entirely permissible and are part and parcel of Fellini's [\*\*9] film, which is protected artistic expression. Rogers contends that the protections

695 F. Supp. 112, \*116; 1988 U.S. Dist. LEXIS 8694, \*\*9;  
8 U.S.P.Q.2D (BNA) 1562; 15 Media L. Rep. 2097

afforded by the First Amendment are not absolute and do not shield the Defendants' unauthorized appropriation, use and commercial exploitation of her name. Invoking the limited First Amendment protection that is afforded to "commercial speech," Rogers argues that her proprietary rights and the right of the public to be free from deception outweigh the Defendants' free speech claim because there were alternate ways for Defendants to communicate the message they claim the Film conveys.

*Motion Pictures Are Protected By The First Amendment's Guarantees of Freedom of Speech and of the Press*

The proposition "that motion pictures are a form of expression protected by the First Amendment," *Natco Theatres, Inc. v. Ratner*, 463 F. Supp. 1124, 1128 (S.D.N.Y. 1979), has been settled for more than three decades, since the Supreme Court's decision in *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 96 L. Ed. 1098, 72 S. Ct. 777 (1952). In *Burstyn*, the Court addressed the constitutionality of a New York statute that gave the New York State Board of Regents licensing authority over the exhibition of motion pictures, and which permitted [\*\*10] the banning of films on the grounds that they were "sacrilegious." *Burstyn*, 343 U.S. at 497. Following a determination that a film by Roberto Rossellini entitled "The Miracle" was sacrilegious, the Board of Regents had rescinded the license for its exhibition. The New York Court of Appeals rejected constitutional challenges to the licensing statute, but the Supreme Court reversed on appeal. The Court stated:

It cannot be doubted that motion pictures are a significant medium for the communication of ideas. They may affect public attitudes and behavior in a variety of ways, ranging from direct espousal of a political or social doctrine to the subtle shaping of thought which characterizes all artistic expression. The importance of motion pictures as an organ of public opinion is not lessened by the fact that they are designed to entertain as well as to inform.

*Id.*, at 501 (footnote omitted). Thus, the Court concluded that "expression by means of motion pictures is included within the free speech and free press guaranty of the First and Fourteenth Amendments." *Id.* at 502. The Court reaffirmed this principle with respect to all works of entertainment in *Schad v. Borough of Mount Ephraim*, 452 U.S. 61, 68 L. Ed. 2d 671, 101 S. Ct. 2176 (1981):

Entertainment, as well as political and ideological speech, is protected; motion pic-

tures, programs broadcast by radio and television and live entertainment, such as musical and dramatic works fall within the First Amendment guarantee.

*Schad*, 452 U.S. at 65 (citations omitted).

The New York courts, mindful of the importance of the First Amendment's protections and of the potential danger of levying civil sanctions which might inhibit artistic expression, have carefully guarded against imposing liability in connection with motion pictures. Thus, in the leading New York case of *University of Notre Dame Du Lac v. Twentieth Century-Fox Corp.*, 22 A.D.2d 452, 256 N.Y.S.2d 301 (1st Dep't), *aff'd*, 15 N.Y.2d 940, 259 N.Y.S.2d 832, 207 N.E.2d 508 (1965), the Court stated:

It is at once apparent, when we deal with the content of a book or motion picture, that we deal with no ordinary subject of commerce. Motion pictures, as well as books, are "a significant medium for the communication of ideas"; their importance "as an organ of public opinion is not lessened by the fact that they are designed to entertain as well as to inform", and like books, they [\*\*12] are a constitutionally [\*117] protected form of expression notwithstanding that "their production, distribution, and exhibition is a large-scale business conducted for private profit" (*Joseph Burstyn v. Wilson*, 343 U.S. 495 [96 L. Ed. 1098, 72 S. Ct. 777] . . . ; *Jacobellis v. State of Ohio*, 378 U.S. 184, [12 L. Ed. 2d 793, 84 S. Ct. 1676 (1964)] . . .).

*Notre Dame*, 256 N.Y.S.2d at 306. Accordingly, the courts in New York are cautious not to construe the First Amendment's scope too narrowly and have recognized its applicability to all legitimate forms of entertainment. As the court stated in *Paulsen v. Personality Posters, Inc.*, 59 Misc. 2d 444, 299 N.Y.S.2d 501 (N.Y. Co. 1968):

The scope of the subject matter which may be considered of "public interest" or "newsworthy" has been defined in most liberal and far reaching terms. The privilege of enlightening the public is by no means limited to dissemination of news in the sense of current events but extends far beyond to include all types of factual, educational and historical data, or even entertainment and amusement, concerning interesting phases of human activity in general.

695 F. Supp. 112, \*117; 1988 U.S. Dist. LEXIS 8694, \*\*12;  
8 U.S.P.Q.2D (BNA) 1562; 15 Media L. Rep. 2097

*Paulsen*, 299 N.Y.S.2d at 506. The courts of this Circuit have been equally vigilant in recognizing the protection [\*\*13] afforded artistic expression. See, e.g., *United States v. A Motion Picture Film Entitled "I Am Curious — Yellow"*, 404 F.2d 196, 199 (2d Cir. 1968); *Natco Theatres v. Ratner*, 463 F. Supp. at 1128; *Man v. Warner Bros. Inc.* 317 F. Supp. 50, 52 (S.D.N.Y. 1970); but cf. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 467 F. Supp. 366 (S.D.N.Y.), *aff'd*, 604 F.2d 200 (2d Cir. 1979).

Rogers maintains that there are countervailing legal and policy reasons why Defendants' unauthorized use of her name should not receive First Amendment protection. First, she contends that such use violates Section 43(a) of the Lanham Act. Second, Rogers contends that such use violates her rights to publicity and constitutes an invasion of privacy. Rogers contends that the First Amendment does not bar either claim because Defendants had alternate ways to convey the Film's message.

#### *The Lanham Act Claim*

Section 43(a) of the Lanham Act imposes civil liability on "any person who shall . . . use in connection with any goods or services . . . a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe [\*\*14] or represent same, and shall cause such goods to enter into commerce . . ." 15 U.S.C. § 1125(a). In support of her claim that Defendants' unauthorized use of her name in the screen play and title of the film constitutes a false designation of origin, Rogers relies on *Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985) and *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 467 F. Supp. 366 (S.D.N.Y.), *aff'd*, 604 F.2d 200 (2d Cir. 1979).

*Allen* involved an advertisement for a video rental chain that used a picture of a Woody Allen double. Discussing the applicability of the Lanham Act to acts that confuse the public with respect to a celebrity's endorsement of, or involvement with, goods or services, the court stated:

A celebrity has a . . . commercial investment in the "drawing power" of his or her name and face in endorsing products and in marketing a career. The celebrity's investment depends upon the good will of the public, and infringement of the celebrity's rights also implicates the public's interests in being free from deception when it relies on a public figure's endorsement in an advertisement. The underlying purposes of the Lanham Act

[\*\*15] therefore [are] implicated in cases of misrepresentations regarding the endorsement of goods and services.

*Allen*, 610 F. Supp. at 625-26. In *Allen*, however, there was no dispute that the advertisement at issue was purely commercial speech, *Allen* 610 F. Supp. at 618, 622, and, therefore, was entitled to less protection than other constitutionally safeguarded forms of speech. See *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 77 L. Ed. 2d 469, 103 S. Ct. 2875 (1983); *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 56 L. Ed. 2d 444, 98 S. Ct. 1912 (1978). Because the defendant's sole purpose in using a [\*118] Woody Allen look alike in its advertising was to capitalize on Allen's familiar name, face and "reputation for artistic integrity" in order to boost sales of its movie rentals, the court found that such use violated the Lanham Act's prohibition against misleading advertising.

*Dallas Cowboys*, which involved the pornographic film "Debbie Does Dallas," in which the central character participates in sexual escapades wearing some but not always all the distinctive trademarked costume of the Dallas Cowboy Cheerleaders, presents a closer question concerning the unauthorized use of a celebrity's notoriety. On plaintiff's motion for [\*\*16] a preliminary injunction, the court was asked to decide whether the film "Debbie Does Dallas," its promotion, and its advertising violated Section 43(a). In addition to finding that the movie depicted the film's lead, Debbie, engaging in sexually explicit conduct wearing a uniform resembling the Dallas Cowboy Cheerleaders uniform, the court found that the defendants had advertised the film with a large marquee containing a picture of Debbie wearing the uniform and that print advertisements for the film falsely represented that the woman playing the role of Debbie was an ex-Dallas Cowboy Cheerleader. Stating that "it would appear obvious that Section 43(a) of the Lanham Act applies to a motion picture," *Dallas Cowboys*, 467 F. Supp. at 375, the court next considered whether the First Amendment afforded any protection to the defendants.

The film's promoter argued that the film was a parody or satire on female cheerleaders. Addressing this argument, the court stated:

It has been long settled in our jurisprudence that the rights of free expression, embodied in the First Amendment and other legal doctrines are subject to rights under the copyright and trademark laws. In the copyright [\*\*17] area, one means of accommodation between the conflicting interests is the "fair use" doctrine, which permits certain use of copyrighted material to be made for

695 F. Supp. 112, \*118; 1988 U.S. Dist. LEXIS 8694, \*\*17;  
8 U.S.P.Q.2D (BNA) 1562; 15 Media L. Rep. 2097

purposes such as news reporting, criticism, scholarship — and parody and satire.

*Id.* (citing Second Circuit copyright "fair use" cases). After discussing the meaning of the terms parody and satire, the court strongly rejected the defendant's claim that "Debbie Does Dallas" fell within that definition:

In the present case, there is no content, by way of story line or otherwise, which could conceivably place the movie *Debbie Does Dallas* within any definition of parody and satire. The purpose of the movie has nothing to do with humor; it has nothing to do with a commentary, either by ridicule or otherwise, upon the Dallas Cowboys Cheerleaders. There is basically nothing to the movie *Debbie Does Dallas*, except a series of depictions of sex acts.

*Dallas Cowboys*, 467 F. Supp. at 376. The court concluded that the plaintiff's service marks and trademarks had been misappropriated for commercial purposes:

The use of the associations with the Dallas Cheerleaders both in the film and in the advertising, all have the *single* [\*18] *purpose* of exploiting the Dallas Cheerleaders' popularity in order to attract customers to view the sex acts in the movie.

*Id.* (emphasis added).

Affirming the district court's issuance of a preliminary injunction against the film's distribution and exhibition, the Second Circuit did not reach the question whether the "fair use" doctrine is applicable to trademark infringements, although it agreed with the district court that the film's use of the Dallas Cheerleaders' uniform "hardly qualifies as parody or any other form of fair use." *Dallas Cowboys*, 604 F.2d at 206. n3 Instead, the Court of Appeals appears to have rejected the defendants' claim of First Amendment protection on other grounds:

[\*119] That defendants' movie may convey a barely discernible message does not entitle them to appropriate plaintiff's trademark in the process of conveying that message. . . . Plaintiff's trademark is in the nature of a property right, . . . , and as such it need not "yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist." *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567, [33 L. Ed. 2d 131, 92 S. Ct. 2219] . . . (1972).

Because there are numerous ways in which defendants [\*19] may comment on "sexuality in athletics" without infringing plaintiff's trademark, the district court did not encroach upon their first amendment rights in granting a preliminary injunction.

*Id.* The Circuit's decision in *Dallas Cowboys* thus permitted the Lanham Act to override First Amendment concerns, noting that the defendant had alternate ways of communicating his message without infringing upon the protected mark.

n3 The Second Circuit stated that it was "unlikely that the fair use doctrine is applicable to trademark infringements," noting in a footnote that since "the primary purpose of the trademark laws is to protect the public from confusion, . . . , it would be somewhat anomalous to hold that the confusing use of another's trademark is 'fair use.'" *Dallas Cowboys*, 604 F.2d at 206 & n.9.

Construed narrowly, in light of the district court's express finding that the sole purpose of defendants' appropriation of the mark was "simply to use the attracting power and fame of the Dallas Cowboy Cheerleaders to draw customers for the sexual 'performances' in the film," *Dallas Cowboys*, 467 F. Supp. at 376, the Second Circuit's opinion is consistent with Supreme Court [\*20] decisions holding that the "Constitution . . . accords a lesser protection to commercial speech than to other constitutionally guaranteed expression." *Central Hudson Gas & Elec. Corp. v. Public Service Comm'n of New York*, 447 U.S. 557, 563, 65 L. Ed. 2d 341, 100 S. Ct. 2343 (1980) (citing *Ohrlik v. Ohio State Bar Ass'n*, 436 U.S. at 456, 457). Among the reasons why commercial speech receives limited First Amendment protection is the legitimate public interest in suppressing "commercial messages that do not accurately inform the public about lawful activity." *Id.* n4

n4 In *Central Hudson Gas & Elec. Corp.*, the Supreme Court also suggested that a restriction on non-misleading commercial speech may be justified if the government's interest in the restriction is substantial and if the restriction directly advances the government's asserted interest and is no more extensive than necessary to serve the interest. *Central Hudson Gas & Elec.*, 447 U.S. at 566. In *San Francisco Arts & Athletics, Inc. [SFAA] v. United States Olympic Committee [USOC]*, 483 U.S. 522, 107 S. Ct. 2971, 97 L. Ed. 2d 427 (1987), the Court recently relied on the government's assertion of a strong interest in promoting, through the

USOC's activities, the participation of amateur athletes from the United States in the Olympic Games to uphold against a First Amendment challenge a statute that granted the USOC the exclusive use of the word "Olympic." There, the Court found that the USOC's use of trademark remedies to prohibit the SFAA's use of the word to promote the "Gay Olympic Games" was not barred by the First Amendment even though the SFAA claimed to have used the word for both commercial and political purposes. *SFAA v. USOC*, 107 S. Ct. at 2983. The Court based its holding, in part, on a finding that the SFAA's use of the word could not be divorced from the commercial value the USOC's efforts had given to it and was "a clear attempt to exploit the imagery and goodwill created by the USOC." *Id.* & n.19.

[\*\*21]

In addition, the Supreme Court has held that where a company "enjoy[s] the full panoply of First Amendment protections for [its] direct comments on public issues, there is no reason for providing similar constitutional protection when such statements are made only in the context of commercial transactions." *Id.* 447 U.S. at 563 n.5. Therefore, "advertising which 'links a product to a current public debate' is not thereby entitled to the constitutional protection afforded noncommercial speech." *Bolger v. Youngs Drug Prod.*, 463 U.S. [60] at 68, 103 S. Ct. 2875, 77 L. Ed. 2d 469 (quoting *Central Hudson Gas & Elec.*, 447 U.S. 557, 563 n.5, 65 L. Ed. 2d 341, 100 S. Ct. 2343 (1980)). Although the language of the opinions of both the district court and the Court of Appeals in *Dallas Cowboys* do not contain any express limitation of the Lanham Act's override of the First Amendment to cases involving speech that is primarily commercial, such a narrowing is implicit in subsequent decisions of the Second Circuit in which the Court has held that "misleading commercial speech" regulated by the Lanham Act "is beyond the protective reach of the First Amendment." *Vidal Sassoon, Inc. v. Bristol-Myers Co.*, [\*120] 661 F.2d 272, 276 n.8 (2d Cir. 1981); see also *Consumers* [\*\*22] *Union of United States, Inc. v. General Signal Corp.*, 724 F.2d 1044, 1052 (2d Cir. 1983).

How to identify the line between commercial and artistic speech, however, constitutes the difficulty presented in the instant case. In an era where artistic expression is often intertwined with the use of well-known symbols, which because of their familiarity may have commercial value, to read *Dallas Cowboys* as Rogers suggests to require courts to decide whether an artistic message could have been conveyed in some other manner would have a chilling effect on the free expression of

creative ideas.

As the late Andy Warhol is reported to have stated, "Being good in business is the most fascinating kind of art." With annual sales in the international auction market exceeding one billion dollars, see Kernan, "The Great Debate Over Artists' Rights," *The Washington Post*, May 22, 1988, at F1, it is hardly surprising that for some artists, like Warhol, the distinction between art and commerce has blurred beyond recognition. The staggering box office receipts of smash hit movies and the burgeoning video rental market may have a similar effect on the hearts and minds of those in the film industry. [\*\*23] More than three decades ago, however, the Supreme Court rejected the contention that simply because the "production, distribution, and exhibition [of motion pictures] is a large-scale business conducted for private profit," expression by means of films should not be protected by the First Amendment. *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. at 501-02. Therefore, before expression through film can be curtailed by the Lanham Act, the party seeking relief bears the heavy burden of establishing that the challenged speech is intended primarily to serve a commercial function.

In the instant case, Defendants contend that the use of Rogers' first name in the title and screenplay of the Film constitutes an exercise of artistic expression rather than commercial speech. On the basis of viewing the Film and the undisputed facts in the record, it is so found.

In the commercial speech cases discussed above, the defendants' use of the plaintiffs' celebrated image or symbol was intended primarily to persuade the public to consume something that either had no connection to the plaintiff, *Allen*, or to convey the false impression that plaintiff was somehow involved with or had endorsed the product, [\*\*24] *Dallas Cowboys*. Here, by contrast, the relevance of "Ginger" in both the Film's title and screenplay is apparent at two levels. First, the title accurately refers to the fictionalized nicknames of the Film's two central characters. Second, the screenplay establishes the reference to Rogers and Astaire as the basis for the Film's characters' livelihood and thereby recognizes the Rogers and Astaire phenomenon as a known element of modern culture.

In addition, the record here establishes that the Film's satirical vision of television entertainment in the 1980's rests in part on the contrast provided by the old hoofers' imitation of Hollywood entertainment in a bygone era. The director's affidavit evinces Fellini's intent to evoke an American cultural symbol the existence of which Rogers concedes in her complaint. There is nothing in the record to suggest that Fellini intended to use Rogers' name to deceive the public into flocking to his movie under the mistaken belief that the Film was about the true

695 F. Supp. 112, \*120; 1988 U.S. Dist. LEXIS 8694, \*\*24;  
8 U.S.P.Q.2D (BNA) 1562; 15 Media L. Rep. 2097

Rogers and Astaire. Moreover, the critics' reviews uniformly acknowledge the Film's artistic tribute to Rogers and Astaire. Against the overwhelming evidence squarely placing the Film's [\*\*25] title and screenplay within the realm of artistic expression, the fact that the Film's distributors may have conceived of and even executed a few schemes to exploit commercially the public's familiarity with Rogers' name does not turn either the film or its title into commercial speech. See *Bolger v. Young Drug Prod.*, 463 U.S. at 67.

Having determined that the speech in question is artistic expression, whether there were alternate avenues open to Fellini to convey his film's message is not subject to examination by this court. Because [\*121] the speech at issue here is not primarily intended to serve a commercial purpose, the prohibitions of the Lanham Act do not apply, and the Film is entitled to the full scope of protection under the First Amendment.

#### *The State Law Claims*

Rogers' right of publicity claim rests on allegations of Defendants' unauthorized use of her name and public personality for advertising purposes or purposes of trade. See, e.g., *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1353 (D.N.J. 1981); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 728-29 (S.D.N.Y. 1978). Defendants contend that this claim and Rogers' false light invasion of privacy claim are [\*\*26] precluded by overriding constitutional concerns raised by the First Amendment's protection of artistic speech. n5

n5 Since, as discussed below, broad constitutional concerns, not narrow distinctions based on different states' laws, require dismissal of Rogers' claims, her attempt to raise a choice of law issue by arguing that the law of Oregon, her state of residence, rather than that of New York or California, governs her state law claims need not be addressed.

Courts have been consistently unwilling to recognize the right of publicity cause of action where the plaintiff's name or picture was used in connection with a matter of public interest, be it news or entertainment. In *Paulsen v. Personality Posters, Inc.*, 59 Misc. 2d 444, 299 N.Y.S.2d 501 (N.Y. Co. 1968), the court denied comedian Pat Paulsen's motion for a preliminary injunction preventing the defendant from marketing posters bearing his photograph and the words "For President," in connection with Paulsen's mock run for the White House in 1968. The court noted that matters of public interest — from newspapers to motion pictures — are not to be considered as distributed for purposes of trade, "notwithstanding that

[\*\*27] they are also carried on for a profit." *Paulsen*, 299 N.Y.S.2d at 506. The court observed that Paulsen, like Rogers in the present case, "is concededly a well-known public personality by professional choice" and "indeed, as an entertainer he actively seeks to promote and stimulate such public attention to enhance his professional standing." *Id.* at 507. The court rejected Paulsen's claim, concluding:

Even where the "right of publicity" is recognized, it does not invest a prominent person with the right to exploit financially every public use of his name or picture. What is made actionable is the unauthorized use for advertising purposes in connection with the sale of a commodity. . . . The "right of publicity," therefore, like that of "privacy" is at best a limited one, within the context of an advertising use, and would be held to have no application where the use of name or picture, as is here the case, as [sic] in connection with a matter of public interest.

*Id.* at 508-09 (citations omitted).

The court in *Frosch v. Grosset & Dunlap, Inc.*, 75 A.D.2d 768, 427 N.Y.S.2d 828 (1st Dep't 1980), used a similar analysis in affirming summary judgment against the plaintiff, [\*\*28] the executor of Marilyn Monroe's estate, who had brought suit on a book entitled "Marilyn." While noting that the New York courts did not recognize a descendible right of publicity, the court held:

Special Term held that the book here involved is what it purports to be, a biography, and as such did not give rise to a cause of action in favor of the estate for violation of a right to publicity. Plaintiff disputes the characterization of the book as a biography. We think it does not matter whether the book is properly described as a biography, a fictional biography, or any other kind of literary work. It is not for a court to pass on literary categories, or literary judgment. It is enough that the book is a literary work and not simply a disguised commercial advertisement for the sale of goods or services.

*Frosch*, 427 N.Y.S.2d at 829. In *Ann-Margret v. High Society Magazine, Inc.*, 498 F. Supp. 401 (S.D.N.Y. 1980), in which the plaintiff-actress brought right of privacy and publicity claims against a "soft-porn" magazine that had published several photographs of her from a film in which she had appeared partially nude, the Honorable Gerard

L. Goettel also weighed the protections [\*\*29] of the First Amendment against a public figure's right to publicity. Discussing the limitations that the First Amendment [\*122] imposes on New York's statutory right to publicity, the court stated:

This provision, which, if read literally, would provide an extremely broad cause of action applicable to virtually all uses of a person's name or picture, including the use of the new media, has been narrowly construed by the courts, especially in the context of persons denominated "public figures," so as "to avoid any conflict with the free dissemination of thoughts, ideas, newsworthy events, and matters of public interest" guaranteed by the First Amendment. . . . Thus, as has been noted by the New York courts, "freedom of speech and the press under the First Amendment transcends the right to privacy." *Namath v. Sports Illustrated*, 80 Misc. 2d 531, 535, 363 N.Y.S.2d 276, 280 (N.Y. Co. 1975), *aff'd*, 48 A.D.2d 487, 371 N.Y.S.2d 10 (1st Dep't 1975), *aff'd mem.*, 39 N.Y.2d 897, 352 N.E.2d 584, 386 N.Y.S.2d 397 (1976).

*Ann-Margret*, 498 F. Supp. at 404 (other citations omitted). The court also noted "there is little doubt that the plaintiff, who has starred in numerous movies and television [\*\*30] programs . . . is, as the term has come to be understood, a 'public figure.'" *Id.* Accordingly, the court granted summary judgment dismissing the complaint, stating:

Plaintiff's claim fares no better when considered as one for violation of the common law "right to publicity." As has been noted, . . . [the right to publicity] "does not invest a prominent person with the right to exploit financially every public use of name or picture." . . . It is only when such use is made "for advertising purposes, or for the purposes of trade," . . . that a cause of action arises. And it is well settled that simple use in a magazine that is published and sold for profit does not constitute a use for advertising or trade sufficient to make out an actionable claim, even if its "manner of use and placement was designed to sell the article so that it might be paid for and read." *Oma v. Hillman Periodicals, Inc.*, 281 A.D. 240, 244, 118 N.Y.S.2d 720, 724 (1st Dep't 1953).

*Ann-Margret*, 498 F. Supp. at 406 (other citations omit-

ted).

In *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978), the Honorable Lawrence W. Pierce addressed another factual situation similar to that presented [\*\*31] here. Plaintiffs, the heir and assignees of the late mystery writer Agatha Christie, sued regarding the distribution of a movie and book entitled "Agatha," a fictional work about what might have transpired during an actual eleven day disappearance by Ms. Christie during her life. The court noted that Ms. Christie had been "one of the best-known mystery writers in modern times" and that she had cultivated her name "in such a way as to make it almost synonymous with mystery novels." *Hicks*, 464 F. Supp. at 428. The plaintiffs sought to enjoin distribution of the film and book, alleging unfair competition and infringement of the right of publicity, and the defendants moved to dismiss the complaint on First Amendment grounds. In considering the First Amendment's applicability, the court stated:

. . . more so than posters, bubble gum cards, or some other "merchandise," books and movies are vehicles through which ideas and opinions are disseminated and, as such, have enjoyed certain constitutional protections, not generally accorded "merchandise."

*Id.* at 430. After concluding that "there are no countervailing legal or policy grounds against" extending First Amendment protection [\*\*32] to the book and film, the court dismissed the right of publicity claim. *Id.* at 431. Like the film and book "Agatha," "Federico Fellini's 'Ginger and Fred'" is not a piece of "merchandise" like a perfume or line of apparel, whose name would likely bear no relation to the product. To the contrary, the Film is a protected work of artistic expression, the product of one of the world's great cinematic artists, clearly labeled as such in every poster and advertisement.

In addition to the cases discussed above, perhaps the most compelling opinion counselling that Rogers' claims are precluded as a matter of law by the First Amendment is that of the alternate majority of the California Supreme Court in *Guglielmi v. Spelling-Goldberg Productions*, 25 Cal. 3d 860, 160 Cal. Rptr. 352, 603 P.2d 454 (1979) [\*123] (Bird, C.J., concurring). n6 *Guglielmi* concerned an unauthorized and fictionalized television film entitled "Legend of Valentino: A Romantic Fiction" on the life of actor Rudolph Valentino. Like Rogers here, the plaintiff (as putative assignee of Valentino's rights) complained that the defendants "used Valentino's name, likeness and personality in a fictionalized film which did not accurately portray [\*\*33] his life." *Guglielmi*, 160 Cal. Rptr. at 354. Observing that "this is not a case in which a celebrity's

name is used to promote or endorse a collateral commercial product or is otherwise associated with a product or service in an advertisement," *Guglielmi*, 160 Cal. Rptr. at 355 n.6, the opinion discussed the important role played by fictional works as a form of social commentary:

It is clear that works of fiction are constitutionally protected in the same manner as political treatises and topical news stories. Using fiction as a vehicle, commentaries on our values, habits, customs, laws prejudices, justice, heritage and future are frequently expressed. What may be difficult to communicate or understand when factually reported may be poignant and powerful if offered in satire, science fiction or parable.

*Id.* at 357. The majority rejected the plaintiff's claim that the use of Valentino's name and likeness in the film was impermissible and unnecessary and that it was done solely to increase the film's value, stating:

If this analysis were used to determine whether an expression is entitled to constitutional protection, grave harm would result. Courts would be required not [\*\*34] merely to determine whether there is some minimal relationship between the expression and the celebrity . . . but to compel the author to justify the use of the celebrity's identity. . . . Such a course would inevitably chill the exercise of free speech — limiting not only the manner and form of expression but the interchange of ideas as well.

Contemporary events, symbols and people are regularly used in fictional works. Fiction writers may be able to more persuasively, more accurately express themselves by weaving into the tale persons or events familiar to their readers. The choice is theirs. No author should be forced into creating mythological worlds or characters wholly divorced from reality. The right of publicity derived from public prominence does not confer a shield to ward off caricature, parody and satire. Rather, prominence invites creative comment.

*Id.* 160 Cal. Rptr. at 358. As the court concluded with respect to Valentino, since Rogers and Astaire are similarly "part of the cultural history of an era," their fame is an equally "apt topic" for Fellini's fictional work. *See id.*

n6 The holding in *Guglielmi* is set forth in a

brief *per curiam* opinion stating that in accordance with *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 160 Cal. Rptr. 323, 603 P.2d 425 (1979), decided the same day, since California did not recognize a descendible right of publicity, the complaint was properly dismissed. Chief Justice Bird addressed the First Amendment concerns raised by the plaintiffs' claims in the concurring opinion, discussed below, which she authored for an alternate majority of the court.

[\*\*35]

Finally, Chief Justice Bird's opinion explained why the use of Valentino's name in advertising the film was equally protected and permissible:

A similar result is compelled for the use of Valentino's name and likeness in advertisements for the film. That use was merely an adjunct to the exhibition of the film. It was not alleged that the advertisements promoted anything but the film. Having established that any interest in financial gain in producing the film did not affect the constitutional stature of respondents' undertaking, it is of no moment that the advertising may have increased the profitability of the film. It would be illogical to allow respondents to exhibit the film but effectively preclude any advance discussion or promotion of their lawful enterprise. Since the use of Valentino's name and likeness in the film was not actionable infringement of Valentino's right of publicity, the use of his identity in advertisements for the film is similarly not actionable.

[\*124] *Id.* at 360. This rationale applies with equal force to Rogers' claims concerning promotion of the Film in the United States. Since Fellini's right to use Rogers and Astaire as a cultural reference point in this [\*\*36] film is protected, the related advertising cannot be actionable.

The cases on which Rogers primarily relies to support her right of publicity claim can be distinguished from the instant case. In *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 53 L. Ed. 2d 965, 97 S. Ct. 2849 (1977), the plaintiff performed a "human cannonball" act which the defendant broadcast on a news program. In a narrowly drawn opinion effectively limited to its facts, the Supreme Court held that the First Amendment did not bar the plaintiff's claim because Zacchini's "entire act" had been appropriated by the broadcast on television without his permission, thereby seriously interfering with the public's desire to pay to see him and destroying the economic

695 F. Supp. 112, \*124; 1988 U.S. Dist. LEXIS 8694, \*\*36;  
8 U.S.P.Q.2D (BNA) 1562; 15 Media L. Rep. 2097

viability of plaintiff's act. *Zacchini*, 433 U.S. at 575. By contrast, here the Film does not interfere with Rogers' economic viability, there having been no showing that her reputation has suffered in any way from the Film. Indeed, one might assume that the reverse may be true, given the critical acclaim achieved by the Film and the resulting enhancement of Astaire and Rogers' fame. In *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981), which involved a concert [\*\*37] featuring an Elvis Presley imitator, the court concluded that the imitator's concert was not protected since it "serves primarily to commercially exploit the likeness of Elvis Presley without contributing anything of substantial value to society" and that it "does not really have its own creative component and does not have a significant value as pure entertainment." *Estate of Presley*, 513 F. Supp. at 1359. Here, Rogers does not contend that the Film does not have its own creative component and, as discussed above, the Film's use of Rogers' name is not primarily for a commercial purpose.

#### *Conclusion*

Under the authorities discussed above, Rogers' claims, which are all premised on the same subject matter, fail as a matter of law because the Film is a work of protected artistic expression. It is not an "ordinary subject of commerce," a simple "commodity" or a piece of "merchandise." Under the cited authorities, the Film does not meet the requirements for "trade or advertising" or an "advertisement in disguise" for a "collateral commercial product." Thus, the Film enjoys the full protection of the First Amendment. Fellini was entitled to create a satire of modern television built [\*\*38] around the bittersweet reunion of two somewhat tattered, retired hoofers who once earned the nicknames "Ginger and Fred" by imitating America's dancing legends, one of whom is the plaintiff here. Equally protected is the title of the Film, an integral part of the work's artistic expression, which is a reference to its central characters.

Upon the findings and conclusions set forth above, the motion for summary judgment dismissing the complaint with costs is granted. Enter judgment on notice.

It is so ordered.

LEXSEE 875 F2D 994

**GINGER ROGERS, Plaintiff-Appellant, v. ALBERTO GRIMALDI, MGM/UA  
ENTERTAINMENT CO., and PEA PRODUZIONI EUROPEE ASSOCIATE, S.R.L.,  
Defendants-Appellees**

No. 88-7826, 88-7828

**UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT**

875 F.2d 994; 1989 U.S. App. LEXIS 6443; 10 U.S.P.Q.2D (BNA) 1825; 16 Media L. Rep.  
1648

December 22, 1988, Argued  
May 5, 1989, Decided

**PRIOR HISTORY:** [\*\*1] Appeal from a judgment of the District Court for the Southern District of New York (Robert W. Sweet, Judge) dismissing on summary judgment claims of plaintiff Ginger Rogers that the movie title "Ginger and Fred" violated her rights under the Lanham Act, 15 U.S.C. § 1125(a)(1982), and infringed her common law rights of publicity and privacy. 695 F. Supp. 112 (S.D.N.Y. 1988). Judge Griesa concurs in the result with a separate opinion.

**DISPOSITION:** Affirmed.

**LexisNexis(R) Headnotes**

**COUNSEL:**

Barry G. Saretsky, New York, New York, (Steven J. Ahmuty, Alan G. Katz, Debra J. Guzov, Bower & Gardner, New York, New York, on the brief), for Plaintiff-Appellant.

Stephen F. Huff, New York, New York (Tom J. Feber, Charles B. McKenna, Pryor, Cashman, Sherman & Flynn, New York, New York, on the brief), for Defendants-Appellees.

**JUDGES:**

Newman and Altamari, Circuit Judges, and Griesa, District Judge. \*Griesa, District Judge, concurring in the result.

\* The Honorable Thomas P. Griesa of the United States District Court for the Southern District of New York, sitting by designation.

**OPINIONBY:**

NEWMAN

**OPINION:**

[\*996] NEWMAN Circuit Judge

Appellant Ginger Rogers and the late Fred Astaire are among the most famous duos in show business history. Through their incomparable performances in Hollywood musicals, Ginger Rogers [\*\*2] and Fred Astaire established themselves as paragons of style, elegance, and grace. A testament to their international recognition, and a key circumstance in this case, is the fact that Rogers and Astaire are among that small elite of the entertainment world whose identities are readily called to mind by just their first names, particularly the pairing "Ginger and Fred." This appeal presents a conflict between Rogers' right to protect her celebrated name and the right of others to express themselves freely in their own artistic work. Specifically, we must decide whether Rogers can prevent the use of the title "Ginger and Fred" for a fictional movie that only obliquely relates to Rogers and Astaire.

Rogers appeals from an order of the District Court for the Southern District of New York (Robert W. Sweet, Judge) dismissing on summary judgment her claims that defendants-appellees Alberto Grimaldi, MGM/UA Entertainment Co., and PEA Produzioni Europee Associate, S.R.L., producers and distributors of the motion picture "Ginger and Fred," violated the Lanham Act, 15 U.S.C. § 1125(a) (1982), and infringed her common law rights of publicity and privacy. *Rogers v. Grimaldi*, 695 F. Supp. 112 [\*\*3] (S.D.N.Y. 1988). Although we disagree with some of the reasoning of the District Court, we affirm.

**Background**

Appellant Rogers has been an international celebrity for more than fifty years. In 1940, she won an Academy Award for her performance in the motion picture "Kitty Foyle." Her principal fame was established in a series of

875 F.2d 994, \*996; 1989 U.S. App. LEXIS 6443, \*\*3;  
10 U.S.P.Q.2D (BNA) 1825; 16 Media L. Rep. 1648

motion pictures in which she co-starred with Fred Astaire in the 1930s and 1940s, including "Top Hat" and "The Barkleys of Broadway."

There can be no dispute that Rogers' name has enormous drawing power in the entertainment world. Rogers has also used her name once for a commercial enterprise other than her show business career. In the mid-1970s, she licensed J.C. Penney, Inc. to produce a line of GINGER ROGERS lingerie. Rogers is also writing her autobiography, which she hopes to publish and possibly sell for adaptation as a movie.

In March 1986, appellees produced and distributed in the United States and Europe a film entitled "Ginger and Fred," n1 created and directed by famed Italian filmmaker Federico Fellini. The film tells the story of two fictional Italian cabaret performers, Pippo and Amelia, who, in their heyday, [\*997] imitated Rogers and Astaire and [\*4] became known in Italy as "Ginger and Fred." The film focuses on a televised reunion of Pippo and Amelia, many years after their retirement. Appellees describe the film as the bittersweet story of these two fictional dancers and as a satire of contemporary television variety shows.

n1 Rogers contends that the title is "Ginger and Fred," while appellees contend that it is "Federico Fellini's 'Ginger and Fred.'" Without deciding the issue, we accept Rogers' contention for purposes of this appeal.

The film received mixed reviews and played only briefly in its first run in the United States. Shortly after distribution of the film began, Rogers brought this suit, seeking permanent injunctive relief and money damages. Her complaint alleged that the defendants (1) violated section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1982), by creating the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film, (2) violated her common law right of publicity, and (3) defamed her and violated her right to privacy by depicting her in a false light.

After two years of discovery, the defendants moved for summary judgment. In opposition to [\*5] the motion, Rogers submitted a market research survey purporting to establish that the title "Ginger and Fred" misled potential movie viewers as to Rogers' connection with the film. Rogers also provided anecdotal evidence of confusion, including the fact that when MGM/UA publicists first heard the film's title (and before they saw the movie), they began gathering old photographs of Rogers and Astaire for possible use in an advertising campaign.

The District Court granted summary judgment to the

defendants. Judge Sweet found that defendants' use of Rogers' first name in the title and screenplay of the film was an exercise of artistic expression rather than commercial speech. 695 F. Supp. at 120. He then held that "because the speech at issue here is not primarily intended to serve a commercial purpose, the prohibitions of the Lanham Act do not apply, and the Film is entitled to the full scope of protection under the First Amendment." *Id.* at 120-21. The District Judge also held that First Amendment concerns barred Rogers' state law right of publicity claim. *Id.* at 124. He also rejected Rogers' "false light" claim without elaboration.

#### Discussion

##### I. Lanham Act

Section 43(a) [\*\*6] of the Lanham Act creates civil liability for

Any person who shall affix, apply, or annex, or use in connection with any goods or services . . . a false designation of origin, or any false description or representation . . . and shall cause such goods or services to enter into commerce. . . .

15 U.S.C. § 1125(a) (1982).

The District Court ruled that because of First Amendment concerns, the Lanham Act cannot apply to the title of a motion picture where the title is "within the realm of artistic expression," 695 F. Supp. at 120, and is not "primarily intended to serve a commercial purpose," *id.* at 121. Use of the title "Ginger and Fred" did not violate the Act, the Court concluded, because of the undisputed artistic relevance of the title to the content of the film. *Id.* at 120. In effect, the District Court's ruling would create a nearly absolute privilege for movie titles, insulating them from Lanham Act claims as long as the film itself is an artistic work, and the title is relevant to the film's content. We think that approach unduly narrows the scope of the Act.

Movies, plays, books, and songs are all indisputably works of artistic expression and deserve protection. [\*\*7] Nonetheless, they are also sold in the commercial marketplace like other more utilitarian products, making the danger of consumer deception a legitimate concern that warrants some government regulation. *See Central Hudson Gas & Electric v. Public Service Commission*, 447 U.S. 557, 563, 65 L. Ed. 2d 341, 100 S. Ct. 2343 (1980) ("The government may ban forms of communication more likely to deceive the public than inform it . . ."); *Vidal Sassoon, Inc. v. Bristol-Myers Co.*, 661 F.2d 272, 276 n. 8 (2d

875 F.2d 994, \*997; 1989 U.S. App. LEXIS 6443, \*\*7;  
10 U.S.P.Q.2D (BNA) 1825; 16 Media L. Rep. 1648

Cir. 1981). Poetic license is not without limits. The purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product. [\*998] Thus, it is well established that where the title of a movie or a book has acquired secondary meaning — that is, where the title is sufficiently well known that consumers associate it with a particular author's work — the holder of the rights to that title may prevent the use of the same or confusingly similar titles by other authors. See, e.g., *Warner Bros. Pictures, Inc. v. Majestic Pictures Corp.*, 70 F.2d 310 (2d Cir. 1934); *Orion Pictures Co. v. Dell Publishing Co.*, 471 F. Supp. 392 (S.D.N.Y. 1979); *Dawn Associates v. Links*, 4 Media L. [\*8] Rep. (BNA) 1642, 1645–46 (N.D.Ill. 1978). Indeed, it would be ironic if, in the name of the First Amendment, courts did not recognize the right of authors to protect titles of their creative work against infringement by other authors. Cf. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 556–60, 85 L. Ed. 2d 588, 105 S. Ct. 2218 (1985) (noting that copyright law fosters free expression by protecting the right of authors to receive compensation for their work).

Though First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims, such concerns must nonetheless inform our consideration of the scope of the Act as applied to claims involving such titles. n2 Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker's expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined. Film-makers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works. Furthermore, their interest in freedom of artistic expression [\*9] is shared by their audience. The subtleties of a title can enrich a reader's or a viewer's understanding of a work. Consumers of artistic works thus have a dual interest: They have an interest in not being misled and they also have an interest in enjoying the results of the author's freedom of expression. For all these reasons, the expressive element of titles requires more protection than the labeling of ordinary commercial products. n3

n2 Several law review articles in recent years have explored the issue of First Amendment limits on trademark protection. See Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 Wis.L.Rev. 158 (1982); Dorsen, *Satiric Appropriation and the Law of Libel, Trademark, and Copyright: Remedies Without*

*Wrongs*, 65 B.U.L.Rev. 923, 949–52 (1985); Note, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 Va.L.Rev. 1079 (1986); Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 69 B.U.L.Rev. 131 (1989).

n3 In other respects, trademark law has also accorded greater leeway for the use of titles than for names of ordinary commercial products, thus allowing breathing space for free expression. A confusingly similar title will not be deemed infringing unless the title alleged to be infringed, even if arbitrary or fanciful, has acquired secondary meaning. See 1 J. McCarthy, *Trademarks and Unfair Competition* § 10.2 (1984).

[\*\*10]

Because overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict. See *Silverman v. CBS*, 870 F.2d 40 (2d Cir. 1989); *Stop The Olympic Prison v. United States Olympic Committee*, 489 F. Supp. 1112 (S.D.N.Y. 1980); cf. *Edward J. DeBartolo Corp. v. Florida Gulf Coast Building & Trades Council*, 485 U.S. 568, 108 S. Ct. 1392, 1397, 99 L. Ed. 2d 645 (1988) ("The Court will construe [a] statute to avoid [serious constitutional problems] unless such construction is plainly contrary to the intent of Congress.").

Rogers contends that First Amendment concerns are implicated only where a title is so intimately related to the subject matter of a work that the author has no alternative means of expressing what the work is about. This "no alternative avenues of communication" standard derives from *Lloyd Corp. v. Tanner*, 407 U.S. 551, 566–67, 33 L. Ed. 2d 131; 92 S. Ct. 2219 (1972), and has been applied by several courts in the trademark context. See, e.g., *Mutual of Omaha Insurance Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987), cert. [\*999] denied, 488 U.S. 933, 109 S. Ct. 326, 102 L. Ed. 2d 344 (1988); *Reddy Communications, Inc. v. Environmental Action* [\*11] *Foundation*, 3 Media L. Rep. 1547, 199 U.S.P.Q. (BNA) 630, 634 (D.D.C. 1977) ("We do not see how defendant's First Amendment rights will be severely hampered if this one arrow is removed from its quiver.").

In the context of titles, this "no alternative" standard provides insufficient leeway for literary expression. In *Lloyd*, the issue was whether the First Amendment provided war protesters with the right to distribute leaflets on a shopping center owner's property. The Supreme Court held that it did not. But a restriction on the location of a speech is different from a restriction on the words the

875 F.2d 994, \*999; 1989 U.S. App. LEXIS 6443, \*\*11;  
10 U.S.P.Q.2D (BNA) 1825; 16 Media L. Rep. 1648

speaker may use. See *Denicola, supra*, at 197. As the Supreme Court has noted, albeit in a different context, "We cannot indulge the facile assumption that one can forbid particular words without running a substantial risk of suppressing ideas in the process." *Cohen v. California*, 403 U.S. 15, 26, 29 L. Ed. 2d 284, 91 S. Ct. 1780 (1971).  
n4

n4 This Circuit employed the "no alternative avenues of communication" standard in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979). As we stated in *Silverman*, however, that case involved a pornographic movie with blatantly false advertising. F.2d at . Advertisements for the movie were explicitly misleadingly, stating that the principal actress in the movie was a former Dallas Cowboys' cheerleader. We do not read *Dallas Cowboys Cheerleaders* as generally precluding all consideration of First Amendment concerns whenever an allegedly infringing author has "alternative avenues of communication."

[\*\*12]

Thus, the "no alternative avenues" test does not sufficiently accommodate the public's interest in free expression, while the District Court's rule — that the Lanham Act is inapplicable to all titles that can be considered artistic expression — does not sufficiently protect the public against flagrant deception. We believe that in general the Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression. In the context of allegedly misleading titles using a celebrity's name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work. n5

N5 This limiting construction would not apply to misleading titles that are confusingly similar to other titles. The public interest in sparing consumers this type of confusion outweighs the slight public interest in permitting authors to use such titles.

The reasons for striking the balance in this manner require some explanation. A misleading title with [\*\*13] no artistic relevance cannot be sufficiently justified by a free expression interest. For example, if a film-maker placed the title "Ginger and Fred" on a film to which it had no artistic relevance at all, the arguably misleading

suggestions as to source or content implicitly conveyed by the title could be found to violate the Lanham Act as to such a film.

Even where a title surpassed the appropriately low threshold of minimal artistic relevance but was explicitly misleading as to source or content, a violation could be found. To illustrate, some titles — such as "Nimmer on Copyright" and "Jane Fonda's Workout Book" — explicitly state the author of the work or at least the name of the person the publisher is entitled to associate with the preparation of the work. Other titles contain words explicitly signifying endorsement, such as the phrase in a subtitle "an authorized biography." If such explicit references were used in a title and were false as applied to the underlying work, the consumer's interest in avoiding deception would warrant application of the Lanham Act, even if the title had some relevance to the work.

Many titles, however, include a well-known name without any overt [\*\*14] indication of authorship or endorsement — for example, the hit song "Bette Davis Eyes," and the recent film "Come Back to the Five and Dime, Jimmy Dean, Jimmy Dean." To some people, these titles might implicitly suggest that the named celebrity had endorsed [\*1000] the work or had a role in producing it. Even if that suggestion is false, the title is artistically relevant to the work. In these circumstances, the slight risk that such use of a celebrity's name might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression, and the Lanham Act is not applicable. Cf. *Estate of Hemingway v. Random House, Inc.*, 23 N.Y.2d 341, 350, 296 N.Y.S.2d 771, 780, 244 N.E.2d 250 (1968) (holding that estate of Ernest Hemingway had no cause of action for "palming off" or "unfair competition" against author of biographical memoir entitled "Papa Hemingway.").

Similarly, titles with at least minimal artistic relevance to the work may include explicit statements about the *content* of the work that are seriously misleading. For example, if the characters in the film in this case had published their memoirs under the title "The True Life Story of Ginger and Fred," [\*\*15] and if the film-maker had then used that fictitious book title as the title of the film, the Lanham Act could be applicable to such an explicitly misleading description of content. n6 But many titles with a celebrity's name make no explicit statement that the work is about that person in any direct sense; the relevance of the title may be oblique and may become clear only after viewing or reading the work. As to such titles, the consumer interest in avoiding deception is too slight to warrant application of the Lanham Act. Though consumers frequently look to the title of a work to determine what it is about, they do not regard titles of artistic works

875 F.2d 994, \*1000; 1989 U.S. App. LEXIS 6443, \*\*15;  
10 U.S.P.Q.2D (BNA) 1825; 16 Media L. Rep. 1648

in the same way as the names of ordinary commercial products. Since consumers expect an ordinary product to be what the name says it is, we apply the Lanham Act with some rigor to prohibit names that misdescribe such goods. *See Johnson & Johnson v. GAC International, Inc.*, 862 F.2d 975 (2d Cir. 1988). But most consumers are well aware that they cannot judge a book solely by its title any more than by its cover. We therefore need not interpret the Act to require that authors select titles that unambiguously describe what the work [\*\*16] is about nor to preclude them from using titles that are only suggestive of some topics that the work is not about. Where a title with at least some artistic relevance to the work is not explicitly misleading as to the content of the work, it is not false advertising under the Lanham Act.

n6 In offering this example and others in this opinion, we intend only to indicate instances where Lanham Act coverage might be available; whether in such instances a violation is established would depend on the fact-finder's conclusions in light of all the relevant facts and circumstances.

This construction of the Lanham Act accommodates consumer and artistic interests. It insulates from restriction titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading but leaves vulnerable to claims of deception titles that are explicitly misleading as to source or content, or that have no artistic relevance at all. n7

n7 We need not consider whether Congress could constitutionally bar the use of all literary titles that are to any extent misleading. *Cf. San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522, 97 L. Ed. 2d 427, 107 S. Ct. 2971 (1987) (holding that the First Amendment does not bar a statute granting the United States Olympic Committee the right to enjoin even non-commercial uses of the word "Olympic").

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With this approach in mind, we now consider Rogers' Lanham Act claim to determine whether appellees are entitled to summary judgment. A federal court may not grant summary judgment "if the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986). "The inquiry . . . is . . . whether . . . there are any genuine factual issues that properly can be resolved only by a finder of fact because they may reasonably be resolved in favor of either party." *Id.* at 250.

Rogers essentially claims that the title "Ginger and Fred" is false advertising. [\*1001] Relying on her survey data, anecdotal evidence, and the title itself, she claims there is a likelihood of confusion that (1) Rogers produced, endorsed, sponsored, or approved the film, and/or (2) the film is about Rogers and Astaire, and that these contentions present triable issues of fact. In assessing the sufficiency of these claims, we accept Judge Sweet's conclusion, which is not subject to dispute, that the title "Ginger and Fred" surpasses the minimum threshold of artistic relevance to the film's content. The central characters in the film are nicknamed [\*\*18] "Ginger" and "Fred," and these names are not arbitrarily chosen just to exploit the publicity value of their real life counterparts but instead have genuine relevance to the film's story. We consider separately the claims of confusion as to sponsorship and content.

The title "Ginger and Fred" contains no explicit indication that Rogers endorsed the film or had a role in producing it. The survey evidence, even if its validity is assumed, n8 indicates at most that some members of the public would draw the incorrect inference that Rogers had some involvement with the film. But that risk of misunderstanding, not engendered by any overt claim in the title, is so outweighed by the interests in artistic expression as to preclude application of the Lanham Act. We therefore hold that the sponsorship and endorsement aspects of Rogers' Lanham Act claim raise no "genuine" issue that requires submission to a jury.

n8 The survey sampled 201 people who said they were likely to go to a movie in the next six months. Half of those surveyed were shown a card with the title "Ginger and Fred" on it; the other half were shown an actual advertisement for the movie. Of these 201, 38 percent responded "yes" to the question: "Do you think that the actress, Ginger Rogers, had anything to do with this film, or not?" Of these respondents, a third answered yes to the question: "Do you think Ginger Rogers was involved in any way with making this film or not?" In other words, about 14 percent of the total 201 surveyed found that the title suggested that Rogers was involved in making the film.

Appellees contend that the survey used "leading" questions, making the survey results invalid. Without resolving this issue, we will assume for the purposes of this appeal that the survey was valid.

[\*\*19]

Rogers' claim that the title misleads consumers into thinking that the film is *about* her and Astaire also fails.

875 F.2d 994, \*1001; 1989 U.S. App. LEXIS 6443, \*\*19;  
10 U.S.P.Q.2D (BNA) 1825; 16 Media L. Rep. 1648

Indeed, this case well illustrates the need for caution in applying the Lanham Act to titles alleged to mislead as to content. As both the survey and the evidence of the actual confusion among the movie's publicists show, there is no doubt a risk that some people looking at the title "Ginger and Fred" might think the film was about Rogers and Astaire in a direct, biographical sense. For those gaining that impression, the title is misleading. At the same time, the title is entirely truthful as to its content in referring to the film's fictional protagonists who are known to their Italian audience as "Ginger and Fred." Moreover, the title has an ironic meaning that is relevant to the film's content. As Fellini explains in an affidavit, Rogers and Astaire are to him "a glamorous and care-free symbol of what American cinema represented during the harsh times which Italy experienced in the 1930s and 1940s." In the film, he contrasts this elegance and class to the gaudiness and banality of contemporary television, which he satirizes. In this sense, the title is not misleading; [\*\*20] on the contrary, it is an integral element of the film and the film-maker's artistic expressions. n9

n9 Appellees also contend that advertisements for the film included a disclaimer that the film is fictional and does not depict any real person, living or dead. In light of our resolution of the case, we need not decide whether such a disclaimer would be sufficient to cure an otherwise deceptive title.

This mixture of meanings, with the possibly misleading meaning not the result of explicit misstatement, precludes a Lanham Act claim for false description of content in this case. To the extent that there is a risk that the title will mislead some consumers as to what the work is about, that risk is outweighed by the danger that suppressing an artistically relevant though ambiguous title will unduly restrict expression.

For these reasons, we hold that appellees are entitled to summary judgment on Rogers' [\*1002] claim that the title gives the false impression that the film is about Rogers and Astaire.

## II. State Law Claims

### A. Right of Publicity

Because the District Judge decided Rogers' state law claims on the ground of broad First Amendment protection, he did not decide which state's law [\*\*21] applies to those claims. 695 F. Supp. at 121 n. 5. Although we reach the same result as the District Court, we think the correct approach is to decide the choice of law issue first and then to determine if Rogers has a triable claim under the applicable substantive law, before reaching constitutional

issues.

A federal court sitting in diversity or adjudicating state law claims that are pendent to a federal claim must apply the choice of law rules of the forum state. *Klaxon Co. v. Stentor Electric Manufacturing Co.*, 313 U.S. 487, 496, 85 L. Ed. 1477, 61 S. Ct. 1020 (1941); *Colgate Palmolive Co. v. S/S Dart Canada*, 724 F.2d 313, 316 (2d Cir. 1983), cert. denied, 466 U.S. 963, 80 L. Ed. 2d 562, 104 S. Ct. 2181 (1984). The New York Court of Appeals has clearly stated that "right of publicity" claims are governed by the substantive law of the plaintiff's domicile because rights of publicity constitute personalty. *Southeast Bank, N.A. v. Lawrence*, 66 N.Y.2d 910, 498 N.Y.S.2d 775, 489 N.E.2d 744 (1985). Rogers is an Oregon domiciliary, and thus Oregon law governs this claim.

Oregon courts, however, have not determined the scope of the common law right of publicity in that state. The Supreme Court of Oregon discussed the "right to publicity" in dictum in [\*\*22] *Anderson v. Fisher Broadcasting Cos.*, 300 Ore. 452, 712 P.2d 803, 812 (1986) (in banc), a case involving a right of privacy claim, but there are no reported decisions of any Oregon court on a right of publicity claim. We are therefore obliged to engage in the uncertain task of predicting what the New York courts would predict the Oregon courts would rule as to the contours of a right of publicity under Oregon law. n10

n10 This two-step process of divining the law of the foreign state to which the forum state's conflicts rules direct us appears to be a consequence both of *Klaxon* and of the fundamental tenet of diversity jurisdiction, equally applicable to the exercise of pendent jurisdiction over state law claims, that the federal court is "only another court of the State." *Guaranty Trust Co. v. York*, 326 U.S. 99, 108, 89 L. Ed. 2079, 65 S. Ct. 1464 (1945); see also *Bernhardt v. Polygraphic Co. of America*, 350 U.S. 198, 203, 100 L. Ed. 199, 76 S. Ct. 273 (1956); *Commissioner v. Estate of Bosch*, 387 U.S. 456, 465, 18 L. Ed. 2d 886, 87 S. Ct. 1776 (1967) (state law issue in federal question case). The two-step process was given its well-known formulation when Judge Friendly stated that our Court's task is "to determine what the New York courts would think the California courts would think on an issue about which neither had thought." *Nolan v. Transocean Air Lines*, 276 F.2d 280, 281 (2d Cir. 1960), remanded, 365 U.S. 293, 5 L. Ed. 2d 571, 81 S. Ct. 555 (1961), adhered to, 290 F.2d 904 (2d Cir.), cert. denied, 368 U.S. 901, 82 S. Ct. 177, 7 L. Ed. 2d 96 (1961); see also *Allstate Insurance Co. v. Employers Liability Assurance Corp.*, 445 F.2d 1278, 1278 (5th Cir.

1971).

On some occasions, however, we appear to have used a one-step process, making our own determination as to the content of the law of the foreign jurisdiction, without pausing to inquire what the forum state's courts would say the foreign state's courts would say. *See, e.g., Metz v. United Technologies Corp.*, 754 F.2d 63, 66-67 (2d Cir. 1985) (New York forum; Louisiana substantive law); *Entron, Inc. v. Affiliated FM Insurance Co.*, 749 F.2d 127, 131-32 (2d Cir. 1984) (New York forum; New Jersey substantive law); *Perlman v. Feldmann*, 219 F.2d 173, 175-78 (2d Cir.) (Connecticut forum; Indiana substantive law), *cert. denied*, 349 U.S. 952, 75 S. Ct. 880, 99 L. Ed. 1277 (1955). The truncated approach also appears to have been used in *Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 456 U.S. 927, 72 L. Ed. 2d 442, 102 S. Ct. 1973 (1982), where we accepted the Sixth Circuit's view of Tennessee law, without inquiring whether New York, the forum state, would have given similar deference to the circuit in which the pertinent foreign state was located. *See also id.* at 284 (Mansfield, J., dissenting) (declining to defer to Sixth Circuit view of Tennessee law but also not inquiring what New York courts would do).

Perhaps the one-step cases reflect an implicit assumption that the forum state would consult the same materials surveyed by the federal court and make the same prediction as to the content of the foreign state's law, though, as we discuss below, that assumption is not always warranted, especially where New York is the forum state. *But see Essex Universal Corp. v. Yates*, 305 F.2d 572, 580 (2d Cir. 1962) (Friendly, J., concurring) (citing *Perlman v. Feldmann*, *supra*, as an example of a federal court having the "freedom" to make its own determination of foreign (Indiana) law, a freedom used "to good effect").

[\*\*23]

[\*1003] At one time the New York courts, confronting an issue arising under the law of another state and having no clear indication of the foreign law, applied a presumption that "the common law of a sister state . . . is the same as our own." *International Text-Book Co. v. Connelly*, 206 N.Y. 188, 200-01, 99 N.E. 722 (1912); *see also Zwirn v. Galento*, 288 N.Y. 428, 432, 43 N.E.2d 474 (1942). However, that presumption arose from a rule of evidence, the state's rule prohibiting a court from taking judicial notice of the law of another state. In 1943,

New York by statute accorded its courts discretion to take judicial notice of foreign law, *see Pfeuger v. Pfeuger*, 304 N.Y. 148, 106 N.E.2d 495 (1952), and in 1963 required such judicial notice. N.Y.Civ.Prac.L. & R. 4511(a) (McKinney 1963). Though New York courts usually now recognize their obligation to take judicial notice of the law of another state, *see, e.g., Monko v. Cicoria*, 46 Misc. 2d 565, 260 N.Y.S.2d 70 (Sup.Ct. 1965), some New York courts still appear to be applying the pre-1963 law, even citing *International Text-Book* for the proposition that foreign law may or even must be presumed to be the same as New York's in the absence of proof to the contrary [\*\*24] in the record. *See, e.g., Knieriemen v. Bache Halsey Stuart Shields Inc.*, 74 A.D.2d 290, 427 N.Y.S.2d 10, 15 (1st Dep't), *appeal dismissed*, 51 N.Y.2d 970, 435 N.Y.S.2d 720, 416 N.E.2d 1055 (1980); *Banco Do Brasil, S.A. v. Calhoon*, 50 Misc. 2d 512, 270 N.Y.S.2d 691, 696 (Sup.Ct. 1966).

There thus remains some ambiguity in the New York cases as to whether that state's courts, encountering an issue that turns on unsettled law of another state, will apply a presumption of similarity with New York law because of the remaining influence of the pre-1943 evidentiary cases that barred judicial notice of foreign law or will predict, as a matter of substantive interpretation, that the foreign state will adopt a rule similar to New York's. The distinction can have significance for a diversity court because it is not bound by a state's judicial notice rules, *see Simmons v. Continental Casualty Co.*, 410 F.2d 881, 884 (8th Cir. 1969); *Zell v. American Seating Co.*, 138 F.2d 641, 643 n. 6 (2d Cir. 1943), *rev'd on other grounds*, 322 U.S. 709, 88 L. Ed. 1552, 64 S. Ct. 1053 (1944); 1A Pt. 2 *Moore's Federal Practice* para. 0.316[4] (1987), but is obliged to apply whatever substantive standards the forum state uses in predicting the content [\*\*25] of foreign law.

Indeed, our own cases have not taken a consistent approach to New York's presumption of similarity of foreign law in diversity cases in which New York is the forum state. On occasion, we have applied the presumption, apparently viewing it as a substantive rule of interpretation; in other cases, we have ignored it and made our own determination of what we think will emerge as the law of a foreign state. *Compare Sagamore Corp. v. Diamond West Energy Corp.*, 806 F.2d 373, 377 (2d Cir. 1986), and *Colgate Palmolive Co. v. S/S Dart Canada*, 724 F.2d at 317, with *Plummer v. Lederle Laboratories*, 819 F.2d 349, 355 (2d Cir.), *cert. denied*, 484 U.S. 897, 108 S. Ct. 232, 98 L. Ed. 2d 191 (1987), and *Metz v. United Technologies Corp.*, 754 F.2d 63, 66 (2d Cir. 1985). We believe that New York courts would, as a matter of substantive interpretation, presume that the unsettled law of another state would resemble New York's but that they would examine the law of the other jurisdiction and that of other states,

875 F.2d 994, \*1003; 1989 U.S. App. LEXIS 6443, \*\*25;  
10 U.S.P.Q.2D (BNA) 1825; 16 Media L. Rep. 1648

as well as their own, in making an ultimate determination as to the likely future content of the other jurisdiction's law. See *In re Estate of Havemeyer*, 17 N.Y.2d 216, 270 N.Y.S.2d 197, [\*26] 217 N.E.2d 26 (1966); *Strain v. Seven Hills Associates*, 75 A.D.2d 360, 429 N.Y.S.2d 424, 430 (1st Dep't 1980). That is the task we now undertake.

The common law right of publicity, where it has been recognized, grants celebrities an exclusive right to control the commercial value of their names and to prevent [\*1004] others from exploiting them without permission. See *Bi-Rite Enterprises v. Button Master*, 555 F. Supp. 1188, 1198-99 (S.D.N.Y. 1983). Because the right of publicity, unlike the Lanham Act, has no likelihood of confusion requirement, it is potentially more expansive than the Lanham Act. See Denicola, *supra*, at 160-66. Perhaps for that reason, courts delineating the right of publicity, more frequently than in applying the Lanham Act, have recognized the need to limit the right to accommodate First Amendment concerns. *Id.* at 198 & n. 171 (citing cases).

In particular, three courts, citing their concern for free expression, have refused to extend the right of publicity to bar the use of a celebrity's name in the title and text of a fictional or semi-fictional book or movie. See *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978); *Frosch v. Grosset & Dunlap, Inc.*, 75 A.D.2d 768, [\*27] 427 N.Y.S.2d 828 (1st Dep't 1980); *Guglielmi v. Spelling-Goldberg Productions*, 25 Cal. 3d 860, 603 P.2d 454, 455, 160 Cal. Rptr. 352 (1979) (Bird, C.J., concurring). n11

n11 Commentators have also advocated limits on the right of publicity to accommodate First Amendment concerns. See, e.g., Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 Tex.L.Rev. 637 (1973).

*Guglielmi* involved a suit by a nephew of the late film star Rudolph Valentino to bar a television broadcast entitled "Legend of Valentino: A Romantic Fiction" as a violation of Valentino's right of publicity. The Court dismissed the action for failure to state a claim. In a concurrence joined by three members of the Court, Chief Justice Bird stated: "Prominence invites creative comment. Surely, the range of free expression would be meaningfully reduced if prominent persons in the present and recent past were forbidden topics for the imaginations of authors of fiction." 603 P.2d at 460. n12

n12 The majority of the in banc court did not discuss the First Amendment issues, rejecting the claim instead on the ground that the right of publicity expires on the death of the person protected.

603 P.2d at 455.

[\*\*28]

Chief Justice Bird noted that a cause of action might have existed had the defendant, for example, published "Rudolph Valentino's Cookbook," and neither the recipes nor the menus described were in any fashion related to Valentino. *Id.* at 457 n. 6. But she said that as long as the use of a celebrity's name was not "wholly unrelated" to the individual nor used to promote or endorse a collateral commercial product, the right of publicity did not apply. *Id.* Similarly, New York's Appellate Division said in *Frosch* that the right of publicity did not bar the use of a celebrity's name in a title so long as the item was a literary work and not "simply a disguised commercial advertisement for the sale of goods or services." 427 N.Y.S.2d at 829.

We think New York would recognize similar limits in Oregon law on the right of publicity. We note, for example, that the Oregon Supreme Court has on occasion interpreted the free speech clause of the Oregon Constitution as providing broader protection for free expression than that mandated by the federal Constitution. Compare *Wheeler v. Green*, 286 Ore. 99, 593 P.2d 777, 788-89 (1979) (holding that Article I, § 8 of the Oregon Constitution prohibits [\*29] punitive damages in defamation cases), with *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 41 L. Ed. 2d 789, 94 S. Ct. 2997 (1974) (holding that states may impose punitive damages for defamation where the plaintiff proves knowing falsity or reckless disregard for the truth). In light of the Oregon Court's concern for the protection of free expression, New York would not expect Oregon to permit the right of publicity to bar the use of a celebrity's name in a movie title unless the title was "wholly unrelated" to the movie or was "simply a disguised commercial advertisement for the sale of goods or services."

Here, as explained above, the title "Ginger and Fred" is clearly related to the content of the movie and is not a disguised advertisement for the sale of goods or services [\*1005] or a collateral commercial product. We therefore hold that under Oregon law the right of publicity does not provide relief for Rogers' claim. n13

n13 As in our ruling on the Lanham Act claim, we need not, and do not, reach the issue of whether the First Amendment would preclude a state from giving broader application to the right of publicity. The Supreme Court explored the First Amendment limits on the right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 53 L. Ed. 2d 965, 97 S. Ct. 2849 (1977), holding that the First Amendment does not preclude an

award of damages to a performer for violation of the right of publicity where a television news program broadcasts a performer's entire act. But the Court explicitly recognized each state's authority to define the right more narrowly. *Id.* at 578-79.

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#### B. False-Light Defamation

Rogers claims that the film portrays her in a false light by depicting the dance pair in the film in a tawdry and "seedy" manner. Complaint, para. 18. We need not dwell long on this claim, nor need we decide which state's law governs it. The film is manifestly not about Rogers. It is about a pair of fictional characters who are like Rogers and Astaire only in their imagination and in the sentimental eyes of their fictional audience. We know of no state law that provides relief for false-light defamation against a work that clearly does not portray the plaintiff at all.

#### Conclusion

In sum, we hold that section 43(a) of the Lanham Act does not bar a minimally relevant use of a celebrity's name in the title of an artistic work where the title does not explicitly denote authorship, sponsorship, or endorsement by the celebrity or explicitly mislead as to content. Similarly, we conclude that Oregon law on the right of publicity, as interpreted by New York, would not bar the use of a celebrity's name in a movie title unless the title was "wholly unrelated" to the movie or was "simply a disguised commercial advertisement for the sale of goods or services." Under these [\*\*31] standards, summary judgment was properly entered on the undisputed facts of this case, rejecting the Lanham Act and right of publicity claims, as well as the claim for false-light defamation.

We therefore affirm the judgment of the District Court.

#### CONCURBY:

GRIESA

#### CONCUR:

GRIESA, District Judge, concurring in the result:

I concur with the result reached in the majority opinion, but have substantial disagreement with the opinion otherwise.

At the outset, a brief word about the development of the issues is in order.

The original claim of Rogers, as stated in the complaint, did not have any separate allegation about the title of the film as such. The complaint was directed against "the Film." The first cause of action, claiming violation of

Rogers' right of publicity, was directed against the production and distribution of the Film. The second alleged that the Film depicted Rogers in a false light. The third cause of action, under the Lanham Act, was directed against the Film and its advertising. In her submissions on the summary judgment motion, Rogers focused mainly on the alleged wrongdoing of defendants in entitling the Film and in promoting and advertising the Film.

Judge Sweet's opinion treated [\*\*32] the issue as relating to "the Film's title and screenplay." He discussed promotion and advertising, but not as a significant separate claim. His holding was that the Film (including the title and the screenplay) is entitled to First Amendment protection and does not violate the Lanham Act or state law rules.

On appeal, the only issues raised by Rogers relate to the title and to the advertising and promotion. No claim is made regarding the screenplay. The only issue dealt with in the majority opinion is that relating to the title. I have no objection to this feature of the majority opinion. My objection is to how the issue is handled.

#### Lanham Act

According to the majority, Judge Sweet's Lanham Act ruling creates a broad immunity [\*1006] which would prevent a remedy in instances of "flagrant deception." To deal with this problem, the majority attempts to set out more precise standards by which lawful titles are to be differentiated from unlawful ones. It is said that the Lanham Act

. . . should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.

To implement this vague and fluid test, the [\*\*33] majority goes on to articulate two specific rules. *First*, titles which are artistically relevant to an underlying work but are "explicitly misleading" violate the Lanham Act. *Second*, titles which are artistically relevant but "ambiguous or only implicitly misleading" do not violate the Lanham Act.

I do not believe that anything in Judge Sweet's opinion, sensibly read, would interfere with the protection of the public against "flagrant deception." But whatever may be the problem with Judge Sweet's opinion, the cure offered by the majority is far worse than the ailment.

Judge Sweet's reasoning can be briefly summarized as follows. Since the two main characters of the Film, Pippo and Amelia, are depicted as having made their living by imitating Ginger Rogers and Fred Astaire, there is, in a

unique but entirely lawful manner, a reference to Ginger Rogers in the Film. The name "Ginger" is relevant to both the Film's screenplay and its title. The screenplay and title are within the realm of artistic expression, and are thus entitled to an appropriately broad measure of protection under the First Amendment, a level of protection greater than would be accorded if this were commercial [\*\*34] speech. The possibility that alternate avenues of expression might have been used does not create a valid Lanham Act claim. The judge noted that there is nothing in the record to suggest an intention to use Ginger Rogers' name to deceive the public into coming to the movie under the mistaken belief that it was about the true Rogers and Astaire. 695 F. Supp. at 113, 120-21.

The essential points of Judge Sweet's rationale are echoed in the majority opinion, which states that the title "is an integral element of the film and the film-maker's artistic expression," and that "the expressive element of titles requires more protection than the labeling of ordinary commercial products." However, the majority opinion expresses the concern that the district court's ruling would create "a nearly absolute privilege for movie titles," because of what are thought to be broad statements about the First Amendment protection accorded to artistic speech as distinct from commercial speech.

In my view, this concern is unfounded. Judge Sweet's discussion of First Amendment protection for artistic expression was his basis for deciding *this case*. He did not purport to write a treatise or attempt to say how [\*\*35] various other cases with different facts should be treated. This is not to say that the ruling would not, justifiably, have some general precedential effect. It is undoubtedly true that most titles which are artistically relevant to the underlying work would be protected under the First Amendment from Lanham Act claims. However, Judge Sweet did not purport to write the law covering all possible situations.

The problem of an overly expansive ruling really lies with the majority opinion and its unfortunate attempt to establish a rule based on the asserted difference between explicitly misleading titles and those which are ambiguous or only implicitly misleading.

All the judges involved here agree that the title "Ginger and Fred" does not violate the Lanham Act. Although the title may mean different things to different people, the artistic relationship between the title and the Film protects both from the strictures of the statute.

However, this unique case would seem to be an inappropriate vehicle for fashioning a general rule of the kind announced by the majority. The unusual circumstances here do not provide a valid illustration of the general

proposition (which I regard as dubious [\*\*36] indeed) that there is a legal boundary between implicitly misleading titles and explicitly [\*\*1007] misleading ones. The majority opinion does not use the facts of this case to define the asserted distinction, but seeks to give substance to the announced rule through the use of certain hypothetical examples.

The majority attempts to give illustrations of titles which would be artistically relevant but explicitly misleading. It is said that if the titles "Nimmer on Copyright" and "Jane Fonda's Workout Book" were used in a manner which was "false as applied to the underlying work" there would be liability under the Lanham Act. But these examples really go nowhere. It is not specified what the underlying works would be where such titles would be false but "artistically relevant." The simple fact is that if either of these titles was used in connection with some bogus work, it would be a simple case of the copying of a legally protected title. See *Warner Bros. Pictures, Inc. v. Majestic Pictures Corp.*, 70 F.2d 310 (2d Cir. 1934); *Orion Pictures Co. v. Dell Publishing Co.*, 471 F. Supp. 392 (S.D.N.Y. 1979). Thus the illustrations have nothing whatever to do with the kind of problem under [\*\*37] discussion here.

The majority opinion states that, in the present case, the title would have been explicitly misleading if it had been "The True Life Story of Ginger and Fred." Of course, this awkward assemblage could hardly be expected to come under the consideration of a director such as Fellini. If, by some strange circumstance, it had been used, and if the majority opinion's legal doctrine were applied to it, lawyers might debate extensively about whether it was indeed misleading, and if so, whether it fell into the explicit or the implicit category. But the fact is that the example does not pose a realistic legal problem.

Coming to the other branch of the rule created by the majority, the opinion attempts to give illustrations of titles which would be artistically relevant and implicitly misleading — *i.e.*, which "impliedly suggest that the named celebrity had endorsed the work or had a role in producing it." The examples given are the song "Bette Davis Eyes" and the film "Come Back to the Five and Dime, Jimmy Dean, Jimmy Dean." But these examples in no way illustrate the majority's proposition. No one can seriously think that these titles imply or suggest that Bette Davis or James [\*\*38] Dean endorsed or had a role in producing the song or the film.

In my view, the rule of the majority opinion, involving the two purported categories, is not well founded. It should be left to future courts, dealing with real cases, to determine if there are to be exceptions to the First Amendment protection which would seem to be gener-

875 F.2d 994, \*1007; 1989 U.S. App. LEXIS 6443, \*\*38;  
10 U.S.P.Q.2D (BNA) 1825; 16 Media L. Rep. 1648

ally afforded to artistically relevant titles. To say the least, the hypotheticals in the majority opinion are a poor basis for arriving at serious legal propositions. When and if an actual case arises, it may not fit within either of the categories posited by the majority. Also, it is most likely that the distinction between explicitly and implicitly misleading titles will prove to be unsound and unworkable.

State Law Claims

A respectable common sense approach to choice of law problems is simply to avoid them when it is clear that

the law of the various jurisdictions under consideration is the same. There is a sufficient discussion of the law dealing with the right to publicity in *Anderson v. Fisher Broadcasting*, 300 Ore. 452, 712 P.2d 803, 812 (1986), to indicate that the law of Oregon on this subject is basically no different from that expressed in the [\*\*39] New York, California and federal decisions relied on by Judge Sweet and in the majority opinion. Judge Sweet sensibly avoided a lengthy excursion into the subject of choice of law.