

Under the Shadows of Trademark: The Current State of Publicity Rights in the Philippines

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I. INTRODUCTION

In the landmark case of *Ayer Productions Pty. Ltd. v. Capulong*,¹ the Supreme Court of the Philippines, adopting the definition of Professors William Lloyd Prosser and Robert Keeton, defined a public figure as “a person who, by his [or her] accomplishments, fame, or mode of living, or by adopting a profession or calling which gives the public a legitimate interest in his [or her] doings, his [or her] affairs, and his [or her] character, has become ‘public personage.’”² The word is synonymous with a celebrity or one who has succeeded in attracting the public eye.³ This category includes anyone who has achieved at least some degree of reputation by appearing in front of the public, such as actors, professional sports players, and other entertainers.⁴ The category, however, can be expanded to include a lot more: public officers, famous inventors, explorers, war heroes, and soldiers, among others.⁵ And as a country where celebrity, melodrama, and national politics are deeply entangled,⁶ the Philippines is a hotbed of public figures.

The cause of this phenomenon is the long-marketable “celebrity factor” that is pervasive in the country.⁷ Fame, whether good or bad, whether trivial or groundbreaking, whether achieved by a celebrity through “rare ability, dumb luck, or a combination thereof[,]”⁸ easily catches the eyes and ears of the common Filipino. This susceptibility can be traced to Filipinos being heavily invested in different forms of media. According to the Philippine Statistics Authority, four in every five Filipinos watch television, which is the most popular form of mass media, with 65% of Filipinos 10 to 64 years old

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1. *Ayer Productions Pty. Ltd. v. Capulong* 160 SCRA 861 (1988).
2. *Id.* at 874 (citing William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 410 (1960)).
3. Prosser, *supra* note 2, at 410-11.
4. *Id.* at 411.
5. *Id.*
6. Anna Cristina Pertierra, In the Philippines, celebrity, melodrama and national politics are deeply entangled, *available at* <http://theconversation.com/in-the-philippines-celebrity-melodrama-and-national-politics-are-deeply-entangled-69656> (last accessed Feb. 1, 2019).
7. *See* Pertierra, *supra* note 6.
8. *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395, 1399 (1992) (U.S.).

watching television every day.⁹ For the younger generations, almost two in every three Filipinos are exposed to the internet: 67.8% surfing the internet for social media, and 65.3% surfing the internet for research work.¹⁰ With the exposure part of their work cut out for them, aspiring personas and celebrities need only develop unique or semi-unique attention-catching characteristics that appeal to the media and the public to grab a position in the country's growing roster of key personas and celebrities.

In politics, the success of former city mayor and congressman Rodrigo Roa Duterte's rise to presidency, for instance, can be partly traced to his cinematic invocation of the "macho-man."¹¹ This is reminiscent of the political formula of former president Ferdinand E. Marcos around the 1960s where like-a-film-star looks and flashy performances were used to generate popular appeal.¹² Politicians follow this format because melodramatic cinematic performances are of great interest to the common Filipino, as can be seen from the "overriding themes of revenge, betrayal, secret love, and complex family histories" that plague most plots of Philippine television shows.¹³ These shows' exploitation of these themes which strike Filipino traits and culture eventually lead them to develop a heavy following — lifting their casts and personas with their fame, likewise promoting a strong fan base for such personas. Personas and celebrities with strong fandoms are not exclusive to the political or entertainment arenas, however; such phenomenon also permeates the sports industry and the music industry,¹⁴ among others.

Given the rapid consumption of the common Filipino of the "celebrity factor," entrepreneurs and product owners were keen on investing into such potential market.¹⁵ Publicity endorsements by celebrities then became a

9. Philippine Statistics Authority, 2013 FLEMMS Functional Literacy, Education and Mass Media Survey Final Report at 41, *available at* <https://psa.gov.ph/sites/default/files/2013%20FLEMMS%20Final%20Report.pdf> (last accessed Feb. 1, 2019).

10. *Id.* at 42.

11. Pertierra, *supra* note 6.

12. *Id.*

13. *Id.*

14. CORNEL SANDVOSS, *FANS: THE MIRROR OF CONSUMPTION* 8 (2005).

15. See Michele Velete, *Riding with fame: stars on wheels*, PHIL. DAILY INQ., Dec. 21, 2016, at B5-1 & B5-2.

norm,¹⁶ with an ever-increasing demand.¹⁷ Product owners seek to channel the popularity of celebrities with major following for the benefit of their products. Some questions may arise in these arrangements, however: what happens if businesses exploit the name, image, or likeness of a celebrity or key persona for commercial purposes without obtaining his/her consent? Does the public figure have a remedy in the law although he/she is deemed to have waived her right to privacy¹⁸ for voluntarily attracting the public eye?¹⁹

This is precisely the issue in the Court of Appeals (CA) case of *Andres Sanchez v. Hon. Ramon Paul L. Hernando, Emmanuel Pacquiao, et al.*²⁰ Emmanuel Pacquiao (Pacquiao), the Philippine boxing icon and eight-time world champion, initiated a criminal suit for violation of the Intellectual Property Code²¹ against two entities after the latter's conveyance of his personal endorsement of the latter's products called the "Wow Magic Sing microphone."²² In a nutshell, Pacquiao was asserting his right of publicity.²³ Is such right recognized in Philippine law?

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16. See Carlo P. Mallo, The pros and cons of celebrity endorsements, available at https://www.entrepreneur.com.ph/business-ideas/the-pros-and-cons-of-celebrity-endorsements/page/1?ref=feed_1 (last accessed Feb. 1, 2019).
 17. See Roger Pe, *Need a celeb endorser? Look at your product*, PHIL. DAILY INQ., Nov. 8, 2013, available at <https://business.inquirer.net/151403/need-a-celeb-endorser-look-at-your-product> (last accessed Feb. 1, 2019); Meryl Ligunas, 10 Filipino celebrities who have more than ten endorsements, available at <https://www.gmanetwork.com/entertainment/celebritylife/news/7457/10-filipino-celebrities-who-have-more-than-ten-endorsements/photo/89924/maine-mendoza> (last accessed Feb. 1, 2019); & Rizal Raoul Reyes, *Celebrity endorsement still seen effective among millennials*, BUS. MIRROR, Jan. 28, 2017, available at <https://businessmirror.com.ph/celebrity-endorsement-still-seen-effective-among-millennials> (last accessed Feb. 1, 2019).
 18. Prosser, *supra* note 2, at 411.
 19. See Prosser, *supra* note 2, at 411.
 20. *Andres Sanchez v. Hon. Ramon Paul L. Hernando, Emmanuel Pacquiao, et al.*, G.R. S.P. No. 104070, July 7, 2009, available at <http://services.ca.judiciary.gov.ph> (The case may be downloaded from the Court of Appeals Case Status Inquiry System) (last accessed Feb. 1, 2019).
 21. An Act Prescribing the Intellectual Property Code and Establishing the Intellectual Property Office, providing for its Powers and Functions and for Other Purposes [INTELL. PROP. CODE], Republic Act 8293 (1997).
 22. *Sanchez*, G.R. S.P. No. 1040701, at 3.

To develop the context, the first part of this Article tackles the history of the right of publicity, from its roots in the right of privacy's individual-centric view up until its paradigm shift to being an alienable property right available to third persons. It seeks to answer whether the public figure's waiver of his or her privacy rights, as acknowledged by laws and jurisprudence resulting from such status, include the waiver of his or her rights against the commercial exploitation of his or her name and likeness. How different, exactly, is the right of privacy from the right of publicity?

The Article first examines the United States of America (U.S.) jurisdiction's working model of the right of publicity. In addition, it then analyzes the right of publicity in the Philippines, discussing the aforementioned case of *Sanchez*,²⁴ as well as, *Fredco Manufacturing Corporation v. President and Fellows of Harvard College (Harvard University)*.²⁵ Since these cases maintain a strong correlation between the right of publicity and other fields of Intellectual Property law, a comparative analysis follows on the right's rubric's similarities and differences with copyright laws and trademark laws. The Article concludes with a discussion of the right's current state in the national context and some recommendations to operationalize the right in Philippine laws.

II. THE RIGHT OF PUBLICITY IN THE UNITED STATES

A. Brief History of the Right to Privacy

Before the late 19th century, no right of publicity existed.²⁶ The nearest legal recourse that an individual had in cases where his or her identity was exploited without his or her consent for commercial or noncommercial use was either to file a case for libel or for trademark infringement.²⁷ These recourses, however, as will be proven below, did not provide adequate protection for such a peculiar right.

23. See *Sanchez*, G.R. S.P. No. 1040701, at 5.

24. *Sanchez*, G.R. S.P. No. 1040701.

25. *Fredco Manufacturing Corporation v. President and Fellows of Harvard College (Harvard University)*, 650 SCRA 232 (2011).

26. Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN L. REV. 1161, 1167 (2006).

27. *Id.* (citing *Borden Ice Cream Co., et al. v. Borden's Condensed Milk Co.*, 201 F. 510 (Il. Ct. App. 7th Cir. 1912) (U.S.) & Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 148-52 (1993)).

The roots of publicity-like rights can be traced all the way back to the late 1800s.²⁸ During such phase in the legal field, the courts recognized, for the first time, “the right of individuals to limit the use of their names or likenesses by commercial actors.”²⁹ This marked the birth of the right to privacy, which is essentially the predecessor of the right to publicity today, albeit in a different form, and on a different level. This right to privacy was treated much like a publicity right; it sought to prevent, initially, only false endorsements available to both key personalities and non-key personalities.³⁰ The right was later on expanded to include the right to prevent commercial use of one’s identity beyond endorsements, half a century later.³¹ There occurred a shift from protecting an individual’s identity to protecting the economic value of a celebrity as an economic right.³² This shift ushered the modern version of the right of publicity.

By the early 20th century, cases ruled by the courts already started to imply this shift.³³ Banking on the starting statutes on the right, most of the publicity (or privacy, then) cases involved the unauthorized use of personal names or photographs related to certain product advertisements³⁴ as well as false statements which would be actionable today under unfair competition laws.³⁵

Nevertheless, despite of the fact that the courts construed “the new privacy right in extremely broad terms, often suggesting a property-like interest of individuals in their personal image[,]”³⁶ as presented below, such constructions are far from sufficient to protect the whole of publicity rights.

28. Dogan & Lemley, *supra* note 28, at 1167 (citing Madow, *supra* note 29, at 167)

29. Dogan & Lemley, *supra* note 28, at 1167.

30. *Id.*

31. *Id.*

32. *Id.*

33. *Id.* at 1169 (citing Madow, *supra* note 29, at 167-69).

34. Dogan & Lemley, *supra* note 28, at 1169-70 (citing *Pavesich v. New England Life Insurance Co.*, 122 Ga. 190, 191 (1905) (U.S.); *Kunz v. Allen*, 172 P. 532 (1918) (U.S.); *Milburn Co. v. Chinn*, 120 S.W. 364, 366 (Ky. Ct. App. 1909) (U.S.); *Munden v. Harris* 153 Mo. App. 652, 659-60 (Mo. Ct. App. 1911) (U.S.); & *Edison v. Edison Polyform Mfg. Co.*, 67 A. 392, 394 (N.J. Ch. 1907) (U.S.)).

35. *Id.*

36. Dogan & Lemley, *supra* note 28, at 1170 (citing *Pavesich*, 122 Ga. at 218; *Munden*, 153 Mo. App. at 660; & *Edison*, 67 A. at 394).

B. The Shift to the Right of Publicity

The implications of the right of publicity being constrained merely to its privacy origins had several implications for public figures and celebrities:

- (1) [T]he mere publication of their photographs or images was typically not viewed by courts as an invasion of any privacy interest, because the celebrities had actively sought out their fame and could not be offended by its furtherance[;]
- (2) [W]hile a celebrity could sometimes prevail on a theory that the defendant had falsely suggested her endorsement of its product, courts generally held that the mere use of the celebrity's image, even in advertising, did not suggest such endorsement[;]
- (3) [E]ven when celebrities prevailed in privacy cases, their damages were limited to the personal injury that they suffered, rather than the economic value that the use brought to the advertiser[; and]
- (4) [S]ince the right of privacy was a personal right, it ran with the person and could not be transferred or survive the death of the celebrity.³⁷

These implications eventually led public figures to clamor for a broader breed of the right to privacy.³⁸ Subsequently, the more economically-oriented right of publicity emerged.³⁹

The case of *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*⁴⁰ in 1953 pioneered this new kind of right to privacy (now publicity).⁴¹ In this New

37. Dogan & Lemley, *supra* note 28, at 1171 (citing *O'Brien v. Pabst Sales Co.*, 124 F.2d 167, 170 (Ct. App. 5th Cir. 1941) (U.S.); *Smith v. Suratt*, 7 Alaska 416, 423 (D. Alaska 1926) (U.S.); *Corliss v. E.W. Walker Co.*, 64 F. 280, 282 (C.C. D. Mass. 1894) (U.S.); & *Lane v. F.W. Woolworth Co.*, 11 N.Y.S.2d 199, 200 (1939) (U.S.); *Hanna Mfg. Co. v. Hillerich & Bradsby Co.*, 78 F.2d 763, 767 (5th Cir. 1935) (U.S.); *Martin v. F.I.Y. Theatre Co.*, 1 Ohio. Supp. 19, 23 (Ohio C.P. 1938) (U.S.); *Pavesich*, 122 Ga. at 202; *Melvin v. Reid*, 297 P. 91, 93 (Cal. Ct. App. 1931) (U.S.); *Atkinson v. Doherty & Co.*, 80 N.W. 285, 372 & 383 (1899) (U.S.); & *Schuyler v. Curtis*, 42 N.E. 22, 25 (N.Y. 1895) (U.S.)).

38. Dogan & Lemley, *supra* note 28, at 1171 (citing Harvard Law Review Association, *Recent Cases: Unfair Competition – Rights under Contract Granting Exclusive Advertising Use of Famous Name*, 49 HARV. L. REV. 478, 496 (1936); Madow, *supra* note 29, at 17; & *O'Brien*, 124 F.2d at 171 (J. Holmes, dissenting opinion)).

39. *Id.*

40. *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953) (U.S.).

York case, Haelan had obtained exclusive licenses with different ballplayers for the use of their images in the former's chewing gum that used baseball trading cards as selling points.⁴² It sued the other party, Topps Chewing Gum, for the latter's selling of its own chewing gum with the same photographs, without the consent of Haelan.⁴³ Haelan's cause of action rested on its "exclusive rights" to the players' photographs.⁴⁴ The Second Circuit, in a sense, agreed with defendant Topps, as plaintiff Haelan cannot recover, as it is, under the provisions of the New York's statutory privacy law.⁴⁵ Nevertheless, the court eventually ruled in favor of plaintiff based on a new common law right — the right of publicity.⁴⁶ The court held —

[I]n addition to and independent of that right [to] privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made 'in gross,' i.e., without an accompanying transfer of a business or of anything else.⁴⁷

As justification for the new right, the court stated, albeit vaguely, that many prominent persons ... would feel sorely deprived if they no longer received money for authorizing advertisements [(ads)], popularizing their countenances, displayed in newspapers, magazines, busses, trains[,] and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant[,] which barred any other advertiser from using their pictures.⁴⁸

This is a landmark case, in the sense that it defined a new cause of action — a right of publicity, which is different from the right to privacy known before it.⁴⁹ Aside from the emphasis on the economic aspect of the right, it stressed on its alienability.⁵⁰ Third parties, such as profit-oriented assignees interested in maximizing their exploitations of their celebrities' fame, became

41. Dogan & Lemley, *supra* note 28, at 1172.

42. *Id.* (citing *Haelan*, 202 F.2d at 867).

43. Dogan & Lemley, *supra* note 28, at 1172 (citing *Haelan*, 202 F.2d at 868).

44. *Id.*

45. *Id.*

46. *Id.*

47. *Id.*

48. *Id.*

49. See Dogan & Lemley, *supra* note 28, at 1173.

50. Dogan & Lemley, *supra* note 28, at 1173.

the forefront subjects of the right,⁵¹ apart from the celebrities themselves. This shows the drastic shift from the previous personal integrity aspect centered on the rights of the persona involved, where the prior right to privacy was based on.⁵² This case likewise paved the way for key personas to seek damages in addition to injunctive relief, such as customary endorsement fees.⁵³

After *Haelan*, more than half of the states, either through common law or statute, adopted some form of the right of publicity.⁵⁴ Although varying between states, generally, the right of publicity “proscribe[d] any unauthorized use of an individual’s identity for commercial purposes or ‘for purposes of trade.’”⁵⁵ The right of publicity has been invoked in different respects since then.⁵⁶ It has covered look-alikes,⁵⁷ sound-alikes,⁵⁸ use of a celebrity’s nickname in a fictional work,⁵⁹ use of addresses,⁶⁰ statues,⁶¹ and a robot evoking the image of a celebrity.⁶²

51. *Id.*

52. See Dogan & Lemley, *supra* note 28, at 1173.

53. Dogan & Lemley, *supra* note 28, at 1173 (citing THE AMERICAN LAW INSTITUTE, RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 49 (1995)).

54. Dogan & Lemley, *supra* note 28, at 1174 (citing 1 THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 6:3 (2d ed. 2005)).

55. Dogan & Lemley, *supra* note 28, at 1174 (citing THE AMERICAN LAW INSTITUTE, *supra* note 55, § 46 & MCCARTHY *supra* note 56, § 3.2).

56. Dogan & Lemley, *supra* note 28, at 1174.

57. *Id.* (citing *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 624 (S.D.N.Y. 1985) (U.S.) & *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (U.S.)).

58. Dogan & Lemley, *supra* note 28, at 1174 (citing *Midler v. Ford Motor Co.*, 849 F.2d 460, 461 (9th Cir. 1988) (U.S.)).

59. Dogan & Lemley, *supra* note 28, at 1174 (citing *Doe v. TCI Cablevision*, 110 S.W.3d 363, 367 (2003) (U.S.)).

60. Dogan & Lemley, *supra* note 28, at 1174 (citing *Villalovos v. Sundance Assocs.*, No. 01 C 8468, WL 115243 (N.D. Ill. 2003) (U.S.)).

61. Dogan & Lemley, *supra* note 28, at 1174 (citing *Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., Inc.*, 296 S.E.2d 697, 703 (Ga. 1982) (U.S.)).

62. Dogan & Lemley, *supra* note 28, at 1174-75 (citing *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395, 1396 (9th Cir. 1992) (U.S.) & MCCARTHY *supra* note 56, §§ 4:45-4:87).

C. *The Common and Civil Law Forms of the Right of Publicity*

In expounding the different legal bases of the right of publicity, the 1992 case of *White v. Samsung Electronics America, Inc.*⁶³ is instructive. Plaintiff Vanna White (White), at the time, was the hostess of *Wheel of Fortune*, arguably one of the most popular game shows in television history.⁶⁴ Capitalizing on the popularity of the show, White marketed her identity to various advertisers.⁶⁵ The series of ads in issue was the ad prepared by David Deutsch Associates (Deutsch) for Samsung Electronics America, Inc.⁶⁶ The ad depicted a robot, dressed in a wig, gown, and jewelry, which Deutsch consciously intended to resemble White's hair and dress.⁶⁷ The robot was posed next to a game board that was easily recognizable as, and closely resembled, the *Wheel of Fortune* game show set.⁶⁸ The ad even had the caption: "Longest-running game show. 2012 A.D."⁶⁹ Since White neither consented to nor was she paid therefor, she filed a case for infringement of various intellectual property rights based on the California Civil Code, Section 3344; the California common law right of publicity; and Section 43 (a) of the Lanham Act.⁷⁰

First, the California Civil Code under Section 3344 states that "[a]ny person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner ... for purposes of advertising or selling ... without such person's prior consent ... shall be liable for any damages sustained by the person or persons injured as a result thereof."⁷¹ As can be gleaned, in order to qualify for damages under this provision, a person must use someone else's name, voice, signature, photograph, or at the very least, likeness. The Court held that since Samsung and Deutsch used a robot with mechanical features, and not a manikin molded to White's precise features, the case fell short of

63. *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395, 1396 (9th Cir. 1992) (U.S.).

64. *Id.* at 1396.

65. *Id.*

66. *Id.*

67. *Id.*

68. *Id.*

69. *White*, 971 F.2d at 1396.

70. *Id.*

71. *Id.* at 1397 (citing Civil Code of California [CAL. CIV. CODE], § 3344 (a) (2005) (U.S.)).

having the “likeness” element within the meaning of Section 3344.⁷² The robot was not of White’s “likeness.”⁷³

Second, the California common law right of publicity can be traced back to the case of *Eastwood v. Superior Court*⁷⁴ decided in 1983. In the case, the California Court of Appeals stated that the common law right of publicity cause of action can be pleaded by alleging:

- (1) the defendant’s use of the plaintiff’s identity;
- (2) the appropriation of plaintiff’s name or likeness to defendant’s advantage, commercially or otherwise;
- (3) lack of consent; and
- (4) resulting injury.⁷⁵

This cause of action was dismissed by the lower court for failure to meet *Eastwood*’s second prong, explaining with the same reasoning on the first cause of action that defendants did not appropriate White’s “name or likeness” with their robot ad.⁷⁶ However, the higher court herein clarified that the common law right of publicity should not be so defined with the element of name or likeness.⁷⁷ The source of this formulation is Professor Prosser, author and former Dean of UC Berkeley College of Law,⁷⁸ who noted that “it is not impossible that there might be appropriation of the plaintiff’s identity, as by impersonation, without the use of either his [or her] name or his [or her] likeness, and that this would be an invasion of his [or her] right of privacy.”⁷⁹ Furthermore, “the common law right of publicity reaches means of appropriation other than name or likeness, but that the specific means of appropriation are relevant only for determining whether the defendant has in fact appropriated the plaintiff’s identity.”⁸⁰ The court concluded that, viewed together, the elements of the ad left little doubt as to

72. *Id.* at 1397.

73. *Id.*

74. *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (3d Cir. 1983) (U.S.).

75. *White*, 971 F.2d at 1397 (citing *Eastwood*, 198 Cal. Rptr. at 417).

76. *Id.* at 1397.

77. *Id.*

78. Prosser, *supra* note 2, at 383.

79. *White*, 971 F.2d at 1397–98 (citing Prosser, *supra* note 2, at 401).

80. *White*, 971 F.2d at 1398.

the celebrity it meant to depict; hence, White had a valid cause for misappropriation of her identity.⁸¹

Third, Section 1125 (a) of the Lanham Act pertinently provides that “[a]ny person who shall ... use, in connection with any goods or services ... any false description or representation ... shall be liable to a civil action ... by any person who believes that he [or she] is or is likely to be damaged by the use of any such false description or designation.”⁸² To prevail under this claim, the plaintiff is required to show that the defendant’s acts resulted in a likelihood of confusion.⁸³ The court recognized the different multi-factor tests available to determine whether a likelihood of confusion exists.⁸⁴ The court turned to the eight-factor test in the case of *AMF, Inc. v. Sleekcraft Boats*⁸⁵ for guidance:

- (1) strength of the plaintiff’s mark;
- (2) relatedness of the goods;
- (3) similarity of the marks;
- (4) evidence of actual confusion;
- (5) marketing channels used;
- (6) likely degree of purchaser care;
- (7) defendant’s intent in selecting the mark; [and]
- (8) likelihood of expansion of the product lines.⁸⁶

The court measured White’s claims under each of the factors and concluded that, since White had raised a genuine issue of material fact concerning a likelihood of confusion as to her endorsement, the lower court erred in rejecting White’s Lanham Act claim at the summary judgment stage.⁸⁷

From this illustrative case, which is only one of the many publicity-related cases in US jurisprudence, several causes of action are available to a

81. *Id.* at 1399.

82. *Id.* (citing U.S. Trademark Act of 1946, 15 U.S.C. § 1125 (a) (1946) (U.S.)).

83. *Id.* at 1399.

84. *White*, 971 F.2d at 1400.

85. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979) (U.S.).

86. *White*, 971 F.2d at 1400 (citing *AMF, Inc.*, 599 F.2d at 348-49).

87. *Id.* at 1399.

plaintiff if his or her publicity rights are violated. Plaintiff can file for infringement of various intellectual property rights. In the U.S., at least, the legal action/s can be based on Section 3344 of the California Civil Code, the California common law right of publicity, or Section 43 (a) of the Lanham Act.

III. APPLICATION: THE RIGHT OF PUBLICITY IN THE PHILIPPINES

The territoriality characteristic of the law aside, most of the causes of actions available to US personas like White are not as straightforwardly available to the Philippine personas and for various reasons.

First, unlike the Civil Codes of some of the states in the U.S., the Philippine Civil Code⁸⁸ does not contain any express provision on the misappropriation of another's name, voice, signature, photograph, or likeness. Second, the Philippines is a mixed-law country, i.e., common laws and civil laws are intertwined in this jurisdiction.⁸⁹ Further buttressed by the fact of having relatively young intellectual property laws and jurisprudence,⁹⁰ no common law right of publicity exists in the Philippines. As for White's third cause of action, however, an analogy can be drawn with existing Philippine laws, as discussed below.

A. *Andres Sanchez v. Hon. Ramon Paul L. Hernando, Emmanuel Pacquiao, et al.*

To say that the right of publicity is absent merely because no express provision of law grants such right in our jurisdiction is *non sequitur*. In the

88. An Act to Ordain and Institute the Civil Code of the Philippines [CIVIL CODE], Republic Act No. 386 (1950).

89. Ryan McGonigle, *The Role of Precedents in Mixed Jurisdictions: A Comparative Analysis of Louisiana and the Philippines*, ELECTRONIC J. COMP. L., July 2002, at 16 (citing Cesar L. Villanueva, *A Comparative Study of the Judicial Role and its Effect on the Theory of Judicial Precedents in the Philippine Hybrid Legal Systems*, 65 PHIL. L.J. 42, 42 (1990); MELQUIADES J. GAMBOA, AN INTRODUCTION TO PHILIPPINE LAW (7th ed. 1969)); & ASEAN Law Association, Philippines: Sources of Law (Chapter 2 of 11 on the Philippine Legal System), available at https://www.aseanlawassociation.org/papers/phil_chp2.pdf (last accessed Feb. 1, 2019) (citing CIVIL CODE, art. 8).

90. See Ferdinand M. Negre & Jonathan Q. Perez, *The Philippines, in INTELLECTUAL PROPERTY IN ASIA: LAW, ECONOMICS, HISTORY AND POLITICS* 217 (Paul Goldstein, et al. eds., 2009).

illustrative CA case of *Sanchez*, the honorable Appellate Court upheld the right of publicity.⁹¹

In *Sanchez*, respondent Pacquiao was a Philippine boxing icon and eight-time world champion.⁹² He capitalized on his fame by accepting endorsements of select products and releasing song albums.⁹³ G2K Corporation (G2K), owned by petitioner Andres Sanchez, and In-A-Jiffy Enterprises (IAJ) were corporations that manufactured and marketed the product, “Wow Magic Sing microphone.”⁹⁴ G2K and IAJ supported Pacquiao in his highly publicized 2006 fight against Erik Morales, a Mexican professional boxer, by placing ads during the fight’s television coverage.⁹⁵

As part of their marketing plan to promote their microphone, G2K and IAJ purchased 3,125 copies of Pacquiao’s CD album.⁹⁶ They gave these albums for free to customers who would buy their “Wow Magic Sing” package.⁹⁷ Since these were done without the consent of Pacquiao, the boxing icon initiated a criminal suit and alleged that G2K and IAJ publicly misrepresented and unlawfully used Pacquiao’s name, image, and goodwill without obtaining his prior permission as to his personal endorsement of their product.⁹⁸

Pacquiao’s cause of action was for violation of Section 169.1 in relation to Section 170 of the Intellectual Property Code (I.P. Code),⁹⁹ to wit —

SECTION 169. *False Designations of Origin; False Description or Representation.* — 169.1. Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false

91. Augusto Bundang, *It’s a knockout! Publicity rights in the Philippines* (An Article Published Online by Sapalo Velez Bundang & Bulilan Law Offices), available at <https://www.sapalovelez.com/2014/09/05/its-a-knockout-publicity-rights-in-the-philippines> (last accessed Feb. 1, 2019) (citing *Sanchez*, G.R. S.P. No. 104070, at 5).

92. *Id.*

93. *Id.*

94. Bundang, *supra* note 93 (citing *Sanchez*, G.R. S.P. No. 104070, at 2).

95. *Id.*

96. *Id.*

97. Bundang, *supra* note 93 (citing *Sanchez*, G.R. S.P. No. 104070, at 2).

98. Bundang, *supra* note 93 (citing *Sanchez*, G.R. S.P. No. 104070, at 3).

99. *Id.* (citing INTELL. PROP. CODE, §§ 169.1 & 170).

designation of origin, false or misleading description of fact, or false or misleading representation of fact, which:

- (a) is likely to cause confusion, or to cause mistake or to deceive as to the affiliation, connection or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person[] ...

...

SECTION 170. *Penalties.* — Independent of the civil and administrative sanctions imposed by law, a criminal penalty of imprisonment from two (2) to five (5) years and a fine ranging from [f]ifty thousand pesos (₱50,000) to [t]wo hundred thousand pesos (₱200,000) [] shall be imposed on any person who is found guilty of committing any of the acts mentioned in Section 155, Section 168 and Subsection 169.1.¹⁰⁰

Sanchez filed a motion to quash.¹⁰¹ The trial court denied the motion and ruled that the “image rights” pertaining to a public figure such as the boxing icon Pacquiao were protected in Section 169.1 of the I.P. Code.¹⁰² The court explained their Decision using the statutory construction principle of “adopted statutes” and held that, since Section 169.1 of the I.P. Code mirrors the Lanham Act of the U.S.,¹⁰³ the latter’s construction in the U.S. can be applied here in the Philippines.¹⁰⁴ To reiterate, the right of publicity in the U.S. gives a person a ground for the issuance of an injunction and damages for the invasion of a person’s right to be let alone, in the use of that person’s name or likeness, without permission or consent, in order to advertise a commercial product.¹⁰⁵

In denying Sanchez’s motion for reconsideration, the trial court adopted the opinion of author, Vicente B. Amador, thus —

A party acquires a protectable interest in a name or equivalent designation under Section 123.1(a) [of the I.P. Code] where the name or designation is unmistakably associated with, and points uniquely to, that party’s

100. INTELL. PROP. CODE, §§ 169.1(a) & 170.

101. *Sanchez*, G.R. S.P. No. 104070, at 4.

102. Bundang, *supra* note 93 (citing *Sanchez*, G.R. S.P. No. 104070, at 5).

103. Bundang, *supra* note 93 (citing *Sanchez*, G.R. S.P. No. 104070, at 6 (citing 15 U.S.C. § 1125 (a) (1) (A-B))).

104. *Id.*

105. *Id.* (citing *Sanchez*, G.R. S.P. No. 104070, at 5).

personality or persona. A party's interest in a name or designation does not depend upon adoption and use as a technical trademark or trade name.¹⁰⁶

Sanchez appealed, alleging that the establishment of Pacquiao's image rights as a trademark was mandatory before the cause of action under the I.P. Code can prosper.¹⁰⁷ However, this was ultimately rejected by the Appellate Court, ruling that such registration was not necessary since Pacquiao was a high-profile celebrity.¹⁰⁸ For having his high-profile name at stake, he had a right to be protected from any unauthorized product endorsement that would falsely imply that he supported or endorsed a product, when in truth, he did not.¹⁰⁹

Clearly, this case suggests that even if a public figure has no registered trademark, he or she has the right to be protected from any unauthorized product endorsement.

B. Fredco Manufacturing Corporation v. President and Fellows of Harvard College (Harvard University)

The aforementioned *Sanchez* ruling in 2009 is not the only time that the Philippine judiciary upheld the right of publicity. In the June 2011 case of *Fredco*, the Supreme Court similarly recognized such right, albeit for a famous institution, not a persona.¹¹⁰

In *Fredco*, Fredco Manufacturing Corporation (Fredco) filed a petition for cancellation of trademark Registration No. 56561 issued to Harvard University (Harvard) in November 1993 "for the mark 'Harvard Veritas Shield Symbol' for decals, tote bags, serving trays, sweatshirts, t-shirts, hats[,] and flying discs."¹¹¹ Fredco alleged that the mark "Harvard" was first used in the Philippines in January 1982 by New York Garments Manufacturing & Export Co., Inc. (New York Garments), Fredco's predecessor-in-interest.¹¹² In January 1985, New York Garments filed for trademark registration of the mark "Harvard" and was granted a Certificate of Registration for such, with

106. *Id.* (citing *Sanchez*, G.R. S.P. No. 104070, at 7 (citing VICENTE B. AMADOR, INTELLECTUAL PROPERTY FUNDAMENTALS 28 (2007 ed.))).

107. *Id.* (citing *Sanchez*, G.R. S.P. No. 104070, at 8).

108. Bundang, *supra* note 93 (citing *Sanchez*, G.R. S.P. No. 104070, at 11).

109. *Id.*

110. *Fredco*, 650 SCRA at 255-56.

111. *Id.* at 235.

112. *Id.* at 236.

a 20-year term subject to renewal at the end of the term.¹¹³ Fredco claimed that, since then, it had “handled the manufacture, promotion[,] and marketing of ‘Harvard’ clothing articles.”¹¹⁴ Moreover, it averred that by the time Registration No. 56561 was issued to Harvard University, New York Garments had already registered the same.¹¹⁵

Harvard, on the other hand, alleged that

[t]he name and mark ‘Harvard’ was adopted in 1639 as the name of Harvard College of Cambridge, Massachusetts, U.S.A[;] [that] [t]he name and mark ‘Harvard’ was [already] used in commerce as early as 1872[;] [that] Harvard University is over 350 years old and is a highly regarded institution of higher learning in the United States and throughout the world[;] [and that] Harvard University promotes, uses, and advertises its name ‘Harvard’ through various publications, services, and products in foreign countries, including the Philippines.¹¹⁶

Harvard further claimed that it discovered in March 2002, through its international trademark watch program, the existence of Fredco’s website, www.harvard-usa.com.¹¹⁷ The website advertised and promoted the brand name “Harvard Jeans USA®” and showed a logo bearing the marks “Established 1936” and “Cambridge, Massachusetts.”¹¹⁸ In April 2004, through its valid and existing certifications of trademark registration in the Philippines, Harvard filed a complaint against Fredco before the Intellectual Property Office (IPO) for trademark infringement and/or unfair competition with damages.¹¹⁹

The Director General of the IPO ruled that Harvard’s Registration No. 56561 not only covers the word “Harvard,” but as well as the “logo, emblem, or symbol of Harvard University.”¹²⁰ The Director General also held that Fredco failed to explain how New York Garments, its predecessor, thought of the mark “Harvard,” and that no evidence was presented to

113. *Id.*

114. *Id.*

115. *Id.* at 236.

116. *Fredco*, 650 SCRA at 237.

117. *Id.* at 238.

118. *Id.*

119. *Id.*

120. *Id.* at 240.

prove that Fredco or New York Garments was “licensed or authorized by Harvard to use its name in commerce or any other use” for that matter.¹²¹

The Supreme Court affirmed the decision of the Director General¹²² and ruled for Harvard.¹²³ The Court held that although Section 2 of Republic Act No. 166 (the old trademark law) required that a trademark must have been actually used in commerce for no less than two months in the Philippines before it can be registered, and although Harvard did not have actual prior use in the Philippines before its application therein, the registration of Harvard should still be upheld — based on home registration allowed under Section 37 of the same law.¹²⁴ In other words, since the trademark sought to be registered had already been registered in a foreign country, which was a member of the Paris Convention,¹²⁵ the requirement of proof of use in commerce in the Philippines was not necessary.¹²⁶

Moreover, the Court decided that Fredco’s registration of the mark “Harvard” should not be allowed, because Section 4 (a) of Republic Act No. 166¹²⁷ prohibited the registration of a mark, “which may disparage or false suggest a connection with persons, ... institutions, [or] beliefs ... [,]”¹²⁸ to wit —

Section 4. *Registration of Trade-marks, Trade-names and Service-marks.* — The owner of a trade-mark, a trade-name[,], or service-mark used to distinguish his [or her] goods, business[,], or services from the goods, business[,], or services of others shall have the right to register the same on the principal register, unless it:

- (a) Consists of or comprises immoral, deceptive or scandalous manner, or matter which may disparage or falsely suggest a

121. *Id.*

122. *See Fredco*, 650 SCRA at 239-40.

123. *Fredco*, 650 SCRA at 256.

124. *Id.* at 243.

125. *See generally* Paris Convention for the Protection of Industrial Property, signed Mar. 20, 1883, 828 U.N.T.S. 305.

126. *Fredco*, 650 SCRA at 243.

127. *Id.* (citing An Act to Provide for the Registration and Protection of Trade-Marks, Trade-Names and Service-Marks, Defining Unfair Competition and False Marking and Providing Remedies Against the Same and for Other Purposes, Republic Act No. 166 (1947)).

128. *Fredco*, 650 SCRA at 243 (citing Republic Act No. 166, § 4 (a)) (emphasis omitted).

connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute[.]¹²⁹

Since Fredco or its predecessor-in-interest, New York Garments, did not have any affiliation or connection with Harvard University or even with Cambridge, Massachusetts, the Court held that it was obvious that Fredco only sought to relate its products with Harvard University to ride on its prestige and popularity, thus appropriating the goodwill of Harvard without its permission, which was prohibited by law.¹³⁰

Of greater significance to this Article is the following justification of the Court in ruling in favor of Harvard —

Section 4(a) of [Republic Act] No. 166 is identical to Section 2(a) of the Lanham Act, the trademark law of the United States. These provisions are intended to protect the right of publicity of famous individuals and institutions from commercial exploitation of their goodwill by others. What Fredco has done in using the mark 'Harvard' and the words 'Cambridge, Massachusetts,' 'USA' to evoke a 'desirable aura' to its products is precisely to exploit commercially the goodwill of Harvard University without the latter's consent. This is a clear violation of Section 4(a) of [Republic Act] No. 166. Under Section 17(c) of [Republic Act] No. 166, such violation is a ground for cancellation of Fredco's registration of the mark 'Harvard' because the registration was obtained in violation of Section 4 of [Republic Act] No. 166.¹³¹

It is evident that the Supreme Court in this case recognized rather expressly the right of publicity in the Philippines — again, by relating it to the Lanham Act of the U.S.¹³² Thus, to understand the underpinnings of the right of publicity in the Philippines then, an analogy with the Lanham Act has to be made.

129. *Id.* (emphasis omitted).

130. *Fredco*, 650 SCRA at 245-46.

131. *Id.* at 246 (citing ROGER E. SCHECHTER & JOHN R. THOMAS, INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS 603 & 263 (2003) & Republic Act No. 166, § 17 (c)).

132. *Fredco*, 650 SCRA at 246 (citing 15 U.S.C. § 1052 (a)).

IV. THE RIGHT OF PUBLICITY, COPYRIGHT, TRADEMARK, AND THE LANHAM ACT

In order to arrive at a logical and feasible framework to understand and to operationalize the right of publicity, it is imperative to consider its close link to the relevant provisions of the I.P. Code and related laws.

A. Copyright and the Right of Publicity

An analogy with copyright has long plagued U.S. jurisprudence relating to the right of publicity. However, some scholars believe that this analogy is wrong for various reasons:¹³³

- (1) Copyright law has a utilitarian purpose.¹³⁴ Copyrights are granted in order to promote the new arts and works of original authorship for the benefit of society.¹³⁵ This public good orientation purpose is distinctly absent in the right of publicity.¹³⁶ Society does not necessarily benefit from the influx of more celebrities or their endorsements.¹³⁷ Even if such were present, there is likewise no evidence to show that a property-like right, such as the previously discussed right of publicity, is the correct solution to such need.¹³⁸
- (2) The fair use doctrine of copyright involves a certain tradeoff “between the interests of original creators and those who want to make transformative uses of their creative works.”¹³⁹ If the latter’s works, although based on the original’s, have a new use, for a new purpose, for a new market, the copyright holder must give way, for the promotion of the arts.¹⁴⁰ Fair use therefore, balances private intellectual property rights with public good.

133. See Dogan & Lemley, *supra* note 28, at 1164.

134. *Id.*

135. *Id.*

136. *Id.*

137. *Id.*

138. *Id.*

139. Dogan & Lemley, *supra* note 28, at 1164

140. See Dogan & Lemley, *supra* note 28, at 1164.

No such similar tradeoff exists in the right of publicity,¹⁴¹ since the celebrity is not creating anything.

- (3) Notwithstanding the copyright's fair use doctrine as a tradeoff, this is also too incoherent and confusing to be a model for any other legal right to emulate.¹⁴² It is better that another set of more coherent and clear factors be established with regard to ascertaining the metes and bounds of the right of publicity.
- (4) Lastly, "the analogy to copyright can obscure important free speech interests at stake in right of publicity cases."¹⁴³ When it comes to the First Amendment, copyright has been getting a free ride,¹⁴⁴ all in the name of protecting the original works of authors and to encourage their creativity.¹⁴⁵ If the same analogy would be given to the right of publicity, the court's dockets would be filled with cases of violations of free speech, and other related interests.¹⁴⁶

Considering the above, the analogy of copyright to the right of publicity suffers from serious concerns on account of the latter's nature and purpose. Hence, to some scholars, an analogy to the right of publicity with the laws of trademark is more appropriate compared to copyright.

B. Trademark and the Right of Publicity

The right of publicity has more in common with trademark than with copyright.¹⁴⁷ To expound:

- (1) Both areas of law grant each of their respective rights-holders some degree of control or protection over their identities.¹⁴⁸ The right of publicity protects the rights of celebrities, key personas, or other persons in their name, image, and likeness, as

141. *Id.*

142. *Id.*

143. *Id.*

144. *Id.*

145. *Id.*

146. See Dogan & Lemley, *supra* note 28, at 1164.

147. *Id.*

148. *Id.*

much as trademark law protects the names and marks of businesses.¹⁴⁹

- (2) In the U.S., the Lanham Act accomplishes this protection of trademark by “preventing commercial uses of trademarks that are likely to confuse consumers regarding either the source of goods or the affiliation, endorsement, or sponsorship of those goods by the trademark owner.”¹⁵⁰ The right of publicity, on the other hand, also similarly aims to protect the use of celebrities’ names, images, or likenesses against unauthorized ads and promotions, which tend to falsely suggest their endorsement of the advertised product.¹⁵¹
- (3) Both forms of legal protection also promote the public’s interest, not just the right holder’s.¹⁵² Trademark registration and upholding the right of publicity can prevent the “deceptive appropriation of the meaning associated with their goodwill and identity, while consumers can buy products with confidence in the truth of assertions about who makes, sponsors, endorses, and stands behind those goods.”¹⁵³

In contrast with the analogy with copyright, the nature and purpose of the right of publicity coincide neatly with the nature and objectives of trademark. Both envelop a certain level of legal protection over the name, image, likeness, or mark of an individual or an institution from unauthorized use and exploitation by third persons. After developing this more appropriate form of correlation, the next step would be to analyze its application in the Philippine context.

C. Implications in the Philippine Context

This successful analogy of trademark law and the right of publicity has several implications for the latter’s construction. And this analogy and subsequent construction can be adopted in the Philippine context because of the “mirroring” of the Lanham Act of the U.S., particularly in Section 169.1

149. *Id.*

150. Dogan & Lemley, *supra* note 28, at 1164 (citing 15 U.S.C. §§ 1114 (1) & 1125 (a)).

151. Dogan & Lemley, *supra* note 28, at 1164.

152. *Id.*

153. *Id.*

of the I.P. Code,¹⁵⁴ which incidentally is under Part III of said Code on the Law on Trademarks, Service Marks and Trade Names, to wit —

SECTION 169. *False Designations of Origin; False Description or Representation.* — 169.1. Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which:

- (a) Is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person; or
- (b) In commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable to a civil action for damages and injunction provided in Sections 156 and 157 of this Act by any person who believes that he or she is or is likely to be damaged by such act.¹⁵⁵

As introduced in the previous Section, the reason for this close affiliation between right of publicity and trademark is the element of confusion and deception involved. Trademark registration seeks to protect the public from the deceptive practices of individuals or institutions who seek to profit from appropriating the goodwill of another, without having proper standing and resources to be the actual source of these goods or services.¹⁵⁶ The Intellectual Property Code mandates —

SECTION 168. *Unfair Competition, Rights, Regulation and Remedies.* — 168.1. A person who has identified in the mind of the public the goods he [or she] manufactures or deals in, his [or her] business or services from those of others, whether or not a registered mark is employed, has a property right in the *goodwill* of the said goods, business or services so identified, which will be protected in the same manner as other property rights.

168.2. Any person who shall employ deception or any other means contrary to good faith by which he [or she] shall pass off the goods

154. See *Sanchez*, G.R. S.P. No. 104070, at 6 (citing 15 U.S.C. § 1125 (a) (1) (A-B)).

155. INTELL. PROP. CODE, § 169.1 (a) & (b).

156. See INTELL. PROP. CODE, § 168.1-168.2.

manufactured by him [or her] or in which he [or she] deals, or his [or her] business, or services for those of the one having established such *goodwill*, or who shall commit any acts calculated to produce said result, shall be guilty of unfair competition, and shall be subject to an action therefor.¹⁵⁷

Similarly, the protection that the right of publicity vests on right holders and the public operates around the same goodwill preservation concept. The right of publicity essentially secures the “goodwill” of public figures from being appropriated by third persons for their benefit, such that the public will not be deceived that the goods are endorsed or backed by such public figures. Protecting the goodwill that a public figure has established with the public is the crux of the right to publicity.

In the realm of publicity rights therefore, public figures can be considered as “brands” in trademark in a way that they embody certain ideals and standards such that unauthorized use of their names or pictures can affect the way the public perceives goods, services, and themselves.

In other words, the analogy between the two forms of legal protection roots from the premise that right of publicity seeks to achieve the same level of equilibrium that trademark intends to achieve, where consumers can buy products with confidence about who makes, sponsors, endorses, and stands behind the goods or services they purchase.¹⁵⁸

The most significant benefit of this analogy is that it defines the right of publicity’s scope and limitations.¹⁵⁹ First, for scope, trademark law can be a framework, although not on all fours, for the different claims that can be filed under the presently-undeveloped right of publicity in the Philippines, since they operate on the same nature and purpose. Through the different unfair competition and false-origin-related claims in our trademark law, as applied in the goodwill preservation concept outlined above, it is possible to construe which uses of one’s person are actionable and which are not.

Second, and more importantly, the analogy between trademark law and the right of publicity offers logical ways of limiting the right.¹⁶⁰ The different tests and factors enunciated in jurisprudence on trademark infringement and dilution, designed to balance the interests of third parties against those of trademark owners and their assigns, can be very helpful in delineating the

157. INTELL. PROP. CODE, § 168 (emphases supplied).

158. Dogan & Lemley, *supra* note 28, at 1164.

159. *Id.* at 1165.

160. *Id.*

extent to which celebrities and personas can exercise their rights.¹⁶¹ In other words, the exercise of the right of publicity, as discussed to have similar objectives as trademark law, must likewise balance with the rights of the public in relation to their constitutional rights, particularly free speech.¹⁶²

V. CONCLUSION AND RECOMMENDATION

Given the direct recognition of our courts, through their constant correlation of the right of publicity to the laws and jurisprudence of the U.S. from which Philippine I.P. laws were adopted,¹⁶³ it is safe to conclude that the right of publicity exists in the country. In fact, it has already been invoked by select celebrities and institutions in the cases discussed above to protect their name, image, and likeness from commercial appropriation without their consent and permission.¹⁶⁴

The acknowledgment of the right, however, cannot be fully perfected unless there is a more express recognition in our laws. The California Civil Code, for instance, *expressly* mandates that “[a]ny person who knowingly uses another’s name, voice, signature, photograph, or likeness, in any manner ... for purposes of advertising or selling ... without such person’s prior consent ... shall be liable for any damages sustained by the person or persons injured as a result thereof.”¹⁶⁵ Similarly, the Philippine legal community can make use of an express derivative in the Civil Code for a more efficient judicial procedure regarding publicity rights.

Although the current state of the right of publicity in the Philippines remains in the shadows of trademark law, this actually offers a potential solution — the right of publicity can be recognized through an amendment of the I.P. Code through its nearest inference in Section 169.1, under the Laws of Trademark.¹⁶⁶ Given the right of publicity’s heavy correlation with intellectual property rights, as discussed above, trademark offers a good and suitable framework given the shared objectives. Furthermore, the limitations of trademark can be used by analogy to define the extent and scope of the right of publicity.

161. See Dogan & Lemley, *supra* note 28, at 1166.

162. *Id.*

163. See Sanchez, G.R. S.P. No. 104070, at 5–6 & *Fredco*, 650 SCRA at 246.

164. See Sanchez, G.R. S.P. No. 104070, at 5 & *Fredco*, 650 SCRA at 237–38.

165. CAL. CIV. CODE, § 3344 (a) (2005) (U.S.).

166. See Sanchez, G.R. S.P. No. 104070, at 6 (citing INTELL. PROP. CODE, § 169.1).

As technology progresses and social media continues to dictate the context and framework of communications and personal interaction, however, the environment for the full recognition of the right continues to narrow down. Social media, for instance, adds “an enormous layer of complexity” to the right of publicity.¹⁶⁷ Would “name” under the right of publicity’s rubric include a Twitter handle? Would “likeness” include someone’s Facebook profile picture?¹⁶⁸ The digital age continues to obscure the limitations of both legal rights already existing as well as rights yet to be fully recognized. Given that the private sphere of public figures continues to yield to public scrutiny, there is a need to re-examine the current legal regime in place. As public figures themselves, legislators must be mindful of the changing global environment particularly the increasing recognition of the right of publicity.

167. Lynne M. J. Boisineau, INTELLECTUAL PROPERTY LAW: The Right of Publicity and the Social Media Revolution, *available at* https://www.americanbar.org/groups/gpsolo/publications/gp_solo/2013/may_june/intellectual_property_law_right_publicity_and_social_media_revolution (last accessed Feb. 1, 2019).

168. *Id.*