

# The IP Law Book Review

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# The IP Law Book Review

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**Vol. 9 No. 1 (February 2019) pp. 1-5**

**PATENT POLITICS: LIFE FORMS, MARKETS, AND THE PUBLIC INTEREST IN THE UNITED STATES AND EUROPE** by **Shobita**

**Parthasarathy**. The University of Chicago Press, 2017, 304 pp., Hardcover, \$25.00

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At first blush, Shobita Parthasarathy's PATENT POLITICS appears to be an historical and geographic journey documenting the expanding scope of patentable subject matter to cover a growing number of life-forms and biotechnological discoveries. Parthasarathy comprehensively details the history of expanding subject matter eligibility and its effect on access to medicines, traditional farming practices, and long-standing academic research norms. Parthasarathy highlights how representatives from each of these groups as well as civil liberties organizations have struggled to voice their grievances before an audience of legislators, patent offices, and courts, and how the U.S. and Europe have taken divergent paths towards addressing such public interest concerns. In that sense, one may view Parthasarathy's intervention as a comparative case study in public interest mechanisms between the U.S. and European patent systems, along with their relative successes and failures.

However, PATENT POLITICS touches on something far more fundamental. The book provides a sophisticated case study in the boundary work exercised by key patent stakeholders, resulting in a Kafka-esque expertise barrier separating the patent system from the public it is meant to serve. Many of us have encountered the work of boundary agents in one context or another, along with attempts to reinforce domains of expertise, distinguish their craft and knowledge from that of others and reserve protected spaces for themselves. Yet few have previously engaged in the level of rigorous analysis surrounding the extent and depth of boundary work in the patent system as Parthasarathy has in PATENT POLITICS.

Parthasarathy begins her analysis by tracing historical concerns surrounding the expanding scope of patentable subject matter in the U.S. Some of the earliest debates regarding patenting and pharmaceutical products, such as the Oldfield Hearings of the early 20<sup>th</sup> century, raised relatively modest suggestions that patents could, in some circumstances, stifle innovation and hurt the availability of

health products (p. 31). The response from industry was swift and vigorous, summarily dismissing any such concerns as being extraneous to the workings of the patent system. Parthasarathy points out that the vast majority of the witnesses to testify before Congress during the Oldfield Hearings were patent lawyers, thereby “establish[ing] industrialists and their legal representatives as the appropriate experts because they brought direct experience with the patent system” (p. 31). As such, from the days of these early debates, an ‘expertise’ wall began to form dividing the patent system between an *inside* and an *outside*.

This trend not only continued over the course of the 20<sup>th</sup> century, but also increased in intensity. In one hearing after another, public interest groups were continuously disregarded. According to Parthasarathy, patent insiders, such as patent attorneys and patent bureaucrats, have long employed rhetorical resources to shut out any such public interest concerns. These rhetorical mechanisms are the antithesis of debate, as patent insiders refuse to even acknowledge interest group perspectives, perspectives which the insiders proclaim do not belong within the patent system.

Even economists, law professors and senior scientists could all be dismissed and disregarded with little effort as *outsiders* without any real *direct experience* of the patent system (pp. 36-37, 133, 71, 31). If these individuals, with their extensive credentials and many years of research experience could easily be disregarded, then civil society groups attempting to introduce moral and ethical considerations into the patent system would not stand a chance (pp. 113-114). To the patent insiders, only those with experience in the art of patent practice can truly understand the realities of this system (pp. 36-37). Only those who have been directly involved in the drafting, prosecution, or litigation of patents are qualified to participate in the patent discourse, and all other issues, including the ethics of patenting in the life sciences, are entirely extraneous to this discourse. As Parthasarathy points out, rather than receiving and adapting to public feedback, over the course of these 20<sup>th</sup> century public interest conflicts, “the definition of the patent evolved, in other words, to gain the acceptance of system stakeholders,” those stakeholders being the large corporate patent filers, patent bureaucrats, and patent lawyers (pp. 27-28).

Apart from the legislative context, the USPTO and the courts provided little additional recourse for public interest concerns, given that rules regarding public interest standing “[asserted] certain legal boundaries that restricted who could participate in the patent system” (p. 90). Jeremy Rifkin’s battle against *Diamond v. Chakrabarty*’s “anything under the sun that is made by man” crashed and burned. Public interest groups were denied standing to challenge the patentability of the Oncomouse (p. 90). While the “chimera” test cases did “stimulate new organizational forms within the PTO” such as the Sensitive Application Warning System (SAWS) program designed to flag patent applications that might generate public interest concerns (p. 95), such programs “never really had a chance because both the patent-system institutions and their organized interests held so tightly to the idea that patents, and therefore patent governance, was techno-legal

and therefore amoral” (p. 97). Even with respect to recent successes such as *Myriad*, public interest groups “had to thread the eye of a narrow legal needle that could address their immediate concerns only indirectly” (p. 171).

Some may ask how this differs from any other political domain. Is it not the case that in many socioeconomic areas, interest groups dominate political discourse, capture legislators and regulators, and twist their political will away from that of the greater public good towards special interests? How is the patent system more of an exercise of “boundary work” than any other discourse? In the typical collision of political interests, the voices of public interest are often drowned out by powerful and well-resourced special interests. However, as Parthasarathy demonstrates, in the case of the patent system’s expertise barrier, public interest voices are disqualified from participation altogether, thus making the patent system’s disconnect from the public quite drastic compared to other issues (pp. 36-37).

The effects of boundary work and the expertise barrier in the patent system are of a different and more pronounced nature than typical interest group dynamics and the nature of boundary work within the patent system is unique amongst disciplines. This exceptionalism traces its roots back to the earliest days of the Industrial Revolution. As historical sociologist Dirk Van Zyl Smit has pointed out, patent office practice itself has historically been unique amongst professions. Many professions are born and develop as agents of certain dominant classes, developing their own professional identity and interests through this representational symbiosis. However, the early English patent agents of the Industrial Revolution era created and deployed their own “ideological resources,” authoring their own patent discourse “through their conceptive work in the legal sphere.”<sup>1</sup> As they authored “sophisticated ideological justifications” for the patent system, they also authored the discourse of their own professional identity alongside developing the institutions of the patent system itself. Thus the disconnect between the public and the patent system is in many ways inherent in the origins of our modern patent institutions.

According to Parthasarathy, the ideological aim of patent institutions has thus become the narrow goal of certifying inventions (p. 78), and to many of the insiders, procedural objectivity, efficiency, and inventors’ interests are sufficient to guarantee satisfaction of the public’s interest (pp. 17, 61). Any alternative understandings of the roles and responsibilities of our patent institutions, regardless of how modest, are swiftly rejected by patent insiders (p. 35). This disconnect between the patent system and the public has created dual patent insider/outsider narratives which have drastically diverged over time, generating social myths that may not accurately reflect the realities of the patent system. This disconnect between public perception of what the patent system is and what actually happens in reality may be far more stark and pronounced than most, if not all, other areas of law.<sup>2</sup> Given the many social perceptions that have, over time, developed regarding what the patent system is and should be, we should be

apprehensive about wholeheartedly accepting that a more democratic patent system is necessarily a *better* patent system.

As an excellent example of these potentially confused social myths, one can look to those who spoke on behalf of the independent inventors' community during passage of the AIA and their fight against transitioning to a "first-to-file" system. Their argument was that a first-to-file system would prejudice independent inventors and small-to-medium enterprises who would see their hard, inventive work stolen by well-resourced, foreign multi-nationals who are better equipped to play the "first-to-file" game. This assertion of independent inventors being robbed by large corporations is tenuous at best,<sup>3</sup> and likely based on long-standing social myths surrounding the plight of "heroic inventors".<sup>4</sup>

Accordingly, democratizing the patent system may not necessarily lead to a *better* patent system if the system only becomes a reflection of these pervasive social myths. Furthermore, democratizing the patent system should not be taken to mean that the practitioners and experts who have worked in this system for many years do not possess valuable insights regarding best practices which the public may lack.

Parthasarathy is careful to avoid jumping to such normative conclusions. Here she points to the EPO's nuanced approach to the democratization of the patent system in the face of growing public interest concerns. The EPO has recognized that "whether or not the patenting system is at fault... is immaterial. Blame is laid at the door of the IP system by many forces in society" (p. 184). As Parthasarathy puts it, "it [doesn't matter] whether or not the patent system had these distributional effects. The public believed it did, and therefore the patent system and the EPO believed it and had to act accordingly" (p. 184). Recognizing this disconnect, the EPO has taken steps - some more successful than others - to slowly develop institutional initiatives directed to facilitating greater public interest participation within the patent system dialogue (p. 196).

The foregoing highlights the key issues at play in this scenario. How has this expertise barrier become so pronounced, preventing effective dialogue between those *insiders* within the system and those outside of it? How and why have such inaccurate understandings, on both sides of the insider/outsider divide, developed regarding the functioning of the patent system along with its socioeconomic effects? How do we build new systems to support effective communication across this barrier? Regardless of who is 'right' or 'wrong' in any of these public interest debates, this lack of dialogue across the patent expertise barrier threatens the public legitimacy of the patent system.<sup>5</sup>

Parthasarathy provides some conclusions on how to promote dialogue across the expertise barrier between the inventive community and the patent experts, such as developing new innovation governance frameworks incorporating broader representation (p. 197) and robust patent office public interest participation mechanisms (p. 196). However, Parthasarathy acknowledges that her work in this

regard is not yet complete (p. 197). The hope is that this book will spark a much needed conversation on how to begin chipping away at the wall that separates the patent system and the public, and Parthasarathy has put forth an impressive effort at getting the ball rolling through her brilliant case study on the fight for democratic legitimacy within the context of patenting in the life sciences.

PATENT POLITICS is a brilliant account of how the patent system's "expertise barrier" has created an institutional rift between the patent system and the public it is meant to serve. Viewed in this light, Parthasarathy's book is truly a unique contribution to patent scholarship. Patent scholars continue to rehash age old debates within standard philosophical frameworks while continuing to overlook the *sociology* of patenting.<sup>6</sup> While patent scholarship's regulatory turn hit full stride several years ago<sup>7</sup>, perhaps what patent law scholarship needs now is a *sociological turn*. PATENT POLITICS may go a long way to ushering in this much-needed new sociological patent law perspective.

## ENDNOTES

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<sup>1</sup> Dirk Van Zyl Smit, "Professional' Patent Agents and the Development of the English Patent System 13 International Journal of the Sociology of Law 79, 101 (1985).

<sup>2</sup> Mark D. Janis, Timothy R. Holbrook, Patent Law's Audience, 97 Minn. L. Rev. 72, at 122-3 (2012).

<sup>3</sup> See Mark A. Lemley, Colleen V. Chien, Are the U.S. Patent Priority Rules Really Necessary, 54 Hastings L.J. 1299 (2002)

<sup>4</sup> See Mark D. Janis, Patent Abolitionism, 17 Berkeley Tech. L.J. 899, at 904-922 for an excellent discussion of the impact of the myth of the "heroic inventor" on patent reform (2002).

<sup>5</sup> See David Vaver, Does the Public Understand Intellectual Property Law? Do Lawyers?, Working Paper No 23/2006 University of Oxford Faculty of Law Legal Studies Research Paper Series (2006), online: [https://digitalcommons.osgoode.yorku.ca/all\\_papers/37](https://digitalcommons.osgoode.yorku.ca/all_papers/37).

<sup>6</sup> Dan L Burk, On the Sociology of Patenting, 101 Minn L Rev 421 (2016).

<sup>7</sup> See for example Mark A. Lemley, Taking the Regulatory Nature of IP Seriously, 92 Tex. L. Rev. See Also 107 (2013); Jonathan S. Masur, Regulating Patents, 2010 Sup. Ct. Rev. 275 (2010); Mark A. Lemley, The Regulatory Turn in IP, 36 Harv. J.L. & Pub. Pol'y 109 (2013).

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# The IP Law Book Review

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**THE RIGHT OF PUBLICITY: PRIVACY REIMAGINED FOR A PUBLIC WORLD** by Jennifer E. Rothman. Harvard University Press, 2018. 256 pp., Hardcover, \$39.95.

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The right of publicity is the unruly adolescent of the intellectual property world. Or is it the tort world? (Um, why is it any of *your business*?! You wouldn't even *understand*!!) The right of publicity is moody and unpredictable, headstrong and heedless. Between you and me—and I hate to say this—it's still figuring out how to move its newly lengthened limbs without breaking things. (Not too long ago it knocked over a stack of comic books<sup>1</sup> and almost destroyed a whole collection of DVDs.<sup>2</sup>) Like other teenagers, the right of publicity talks too loudly, thinks everything it says is interesting, and—as you'll know if you've read recent cases—spends far too much of its time on video games.<sup>3</sup> (Remember when it was obsessed with baseball cards?<sup>4</sup> It felt like those days would go on forever ... ). What will the right of publicity do to become a productive member of society? Will it economically incentivize creative activity? Will it protect individual autonomy? Whatever you do, don't ask the right of publicity. It will just scowl at you. The right of publicity is still figuring out what it wants to do for a job. If it even *wants* a job.

Most of all, the right of publicity won't take advice. But it should. It really should. All we can do is keep talking and hope that something gets through.

Well, the right of publicity couldn't ask for a much better guardian than Jennifer E. Rothman, whose new book is **THE RIGHT OF PUBLICITY**. Rothman, a professor at Loyola Law School in Los Angeles, has genuine love and affection for the right of publicity, but she's clearheaded about the need for discipline. She's also knowledgeable. Rothman has taught herself everything there is to know about the right of publicity's upbringing, including every embarrassing story from the right of publicity's childhood. If you want to hear those stories, put the right of publicity in the spare room with the latest *Grand Theft Auto*,<sup>5</sup> close the door, and open Rothman's book. She'll tell you how it all started and where it all went wrong.

The right of publicity lost its way, Rothman tells us, when it started to wander from its roots in the right of privacy. Actually, check that. The right of privacy, back in the beginning, *was* the right of publicity. “[A]t the origin of the right to privacy,” Rothman explains, “privacy was primarily about the right to control ‘publicity’—when and how one’s image and name could be used by others in public” (p. 11). This is a key contention for Rothman, and she backs it up with a thorough and entertaining history.

Rothman begins deep in the culture and technology of the late 1800s, showing us how the common-law right of privacy was a legal response to photographers and print shops gaining the technical means to do as they would like with other people’s faces. Rothman then follows the law through the first half of the 1900s: In these decades, the right of privacy/publicity succeeded in allowing celebrities and noncelebrities alike to keep control over their names and likenesses. They could get damages for emotional distress, economic harms, and reputational injuries. Persons’ agency over themselves was upheld with an increasingly cogent and well-accepted common law right. The right of privacy was in a good place. It was working.

But in this era were the first stirrings of trouble. Some rogue courts and loose dicta suggested—against the weight of authority, Rothman tells us—that the right to privacy wouldn’t protect celebrities (p. 44). Why? The right to privacy was, these bad influences said, about compensating the hurt feelings of private people who wanted to stay private, while celebrities, by their very nature, had shown they didn’t want to stay private. This line of thinking raised the specter that celebrities needed something different from the law prevailing at the time. Even though, Rothman insists, they didn’t.

But the right of publicity didn’t start to go off the rails until mid-century, when the Second Circuit handed down the granddaddy of all right-of-publicity cases, *Haelan Laboratories v. Topps Chewing Gum*.<sup>6</sup> The dispute involved one baseball card company suing another over alleged exclusive rights to various players, and the Second Circuit opinion that resulted from the case became the stuff of legend. In the years since, *Haelan Labs* has become widely known to be the instant of the birth of the right of publicity and the moment of the coining of the term “right of publicity.” Widely known, yes—but wildly wrong. Rothman demonstrates that the case originated neither of these things (p. 45). In fact, according to the litigants, the litigation was not about the right of privacy, the right of publicity, or anything of that ilk. Instead, it was about tortious interference with contract (p. 51). So how did it end up as the most influential right-of-publicity case of all time?

To chart that metamorphosis, Rothman does meticulous research. She dives into archives, bringing us, for instance, pictures of packaging used as litigation exhibits and the trial testimony of New York Giants catcher—and face for both Topps and Bowman—Wes Westrum (pp. 52 & 54). We get the snide characterization by the Topps attorney of ballplayers being “child-like” in their

propensity to sign away rights without legal representation or even bothering to read what's on the page (p. 54). In fact, the blizzard of haphazardly signed papers isn't just color, it's a plot point. Rothman surmises that the seed for a right-of-publicity solution to the case was sown when the district court judge faced the prospect of having to read hundreds of contracts to untangle competing claims of priority (pp. 57-58). The juiciest part, however, is where Rothman gets a hold of the internal memoranda among the judges on the Second Circuit panel (pp. 60-61). Here we get startling new insight into why the panel gravitated toward a right-of-publicity basis for upholding claims of exclusive rights.

Judge Charles Edward Clark, Rothman suggests, was encouraged to look at things from a right-of-publicity angle because of a book review he had recently read in the *Yale Law Journal*. The review, written by Herman Finkelstein, an attorney for music-publisher rights society ASCAP, concerned Samuel Spring's *Risks and Rights in Publishing, Television, Radio, Motion Pictures, Advertising, and the Theater*. Judge Clark was apparently convinced on the basis of just the review's criticism of the book—since Clark admitted in his memo to Judge Jerome Frank that he hadn't read the book itself—that New York's privacy statute would not permit a claim for unauthorized use of celebrity images, only for unauthorized uses of images of people who wanted to stay out of the public eye.

Of course, more than a half century later, Rothman has done the reading Judge Clark didn't have time for. She tells us Spring's book got it right, and Finkelstein's book review got it wrong: New York cases had already held that the state's privacy statute protected celebrities against unauthorized exploitation of their images (p. 61). Thus, *Haelan Labs* didn't need to forge a new path.

Let us pause here to consider a collateral lesson that comes out of Rothman's research: A hasty book review can do enormous damage to the law. Gulp! (I now feel obligated to encourage future judges to avoid relying on my review of Rothman's work and instead to go ahead and read her book. And I hereby disclaim all damage done to the spacetime continuum by judges who don't).

The marvelous way in which Rothman finds connections makes the reader think she must have a large corkboard in her basement—like the ones you see on TV—pinned with pictures and scraps of paper linked by strings of yarn. As one example: Rothman even figures out why Judge Clark must have seen Finkelstein's book review—because it followed Clark's own book review of a procedure casebook in the same issue of the *Yale Law Journal*!

Problematic though *Haelan Labs* was, Rothman contends that the case did not, itself, represent the transmogrification from the well-functioning right of privacy/publicity we had before into the troublesome doctrine we have today. Instead, it was a host of others who “took this ball from *Haelan* and ran with it” (p. 64). Thus Rothman proceeds to the second part of her story, where the right of publicity bloats and grows out of control.

One group Rothman pins blame on is law students, for writing impulsive, poorly researched comments in law reviews that she finds to have had surprising influence (pp. 47-50, 68). What cannot be surprising, of course, is that so many students wrote law-review notes about the right of publicity. It turns out the law students of yesteryear flocked to sports- and entertainment-related cases for note topics just as they do today. (Not that us IP scholars can be too judgy. One thing I found looking over the photographs in the book is that Rothman and I have collected the exact same Wes Westrum baseball cards. Um, you know, for science).

Another influencer and target of Rothman's criticism is Melville Nimmer, best known as the original Nimmer of *Nimmer on Copyright*. Before his treatise-writing days, Melville Nimmer gained early prominence with his extremely influential 1954 article, "The Right of Publicity."<sup>7</sup> Rothman questions Nimmer's motivations for writing that piece, which she says took positions that benefitted his then-employer Paramount Pictures and oversold the idea of a revolutionary change in the common law in a way that would help him land a law professor job (pp. 68-71). It's a critique that is wince-inducing, but productive. Legal scholars, as a profession, should probably be talking much more about how real-world, beyond-the-fourth-wall influences end up shaping scholarship and, ultimately, affecting the path of the law.

Rothman's treatment of that other most famous right-of-publicity case, *Zacchini v. Scripps-Howard Broadcasting*<sup>8</sup> (pp. 139-143), is another engrossing part of the book. This is the case in which circus performer Hugo Zacchini sued a local television station for airing footage of his human cannonball act performed at a county fair. To scrutinize this case, Rothman does more first-rate historical digging. She not only reads the clerks' memos, she even inspects the underlining on Justice Lewis F. Powell Jr.'s copies. For those scholars, like me, who've puzzled for years over why the Court granted certiorari in the case, Rothman gives us new insight: The underlining of the phrases "fun-to-work-on" and "a lot of fun" provides, when you think about it, a depressingly plausible explanation.

All of Rothman's toiling in the archives and connecting of disparate threads helps deliver her convincing story of how the right of publicity shifted away from its original, beneficial right-of-privacy paradigm and toward its noxious, current form as a transferrable, intellectual-property-type right. Morphed as it has been, the right of publicity is no longer principally concerned with protecting people's dignity and their ability to control how they are presented to the world. Instead, as Rothman's book tells it, the right of publicity has become a tool to undermine those interests, allowing corporate actors—such as managers, record labels, social media platforms, and others—to grab people's names and likenesses and use them for corporate interests, dignity be damned.

The *Haelan Labs* case, the student law-review notes, Melville's article, and the *Zacchini* case all played a role, in addition to other influences that Rothman catalogs. But what were the underlying motivations behind the big change? What

motivated the characters in this drama? In part, it was a power grab by corporate interests that stood to benefit from being able to separate people from the legal rights to their own names and images. That's unfortunate, of course, although it is hardly an unusual storyline. Much more troubling is the extent to which, according to Rothman's account, the law was unwittingly redirected by the self-indulgence and intellectual laziness of judges and commentators who reached out for something glittery to work on—but then didn't do the research or hard thinking needed to do a good job with it. That heartbreaking realization—made possible by Rothman's indefatigable historical work—is one of the book's signature contributions.

The highest achievement of Rothman's work, however, is that it gives us a thoroughly documented, unified picture of the right of publicity, allowing us to see great cohesiveness in it. Early on in her book Rothman confesses, "The right of publicity ... rather than a single, uniform right, is in reality many different laws. This variability makes these laws difficult to navigate and even to talk about in a coherent fashion" (p. 3). Too true. I recently made my own attempt to provide coherence to the right of publicity.<sup>9</sup> I'll break the fourth wall to tell you that writing that article frequently made me want to pull out my hair. Right-of-publicity cases show a chronic disregard for procedural and doctrinal structure, and they are filled with inconsistently used terms and bits of glossy nonsense that patch over omitted analytical steps. Trying to unsnarl them can be maddening. Thus, my experience intensifies my admiration for what Rothman has been able to pull off in her book, putting the history, the rhetoric, the holdings, and the personalities into a single, coherent narrative that tells a convincing story of how the right of publicity went wrong, where it's at now, and how we should start fixing it.

If there is one weak point in the substance of Rothman's book, in my view, it is the chapter on copyright preemption. Like the rest of the book, this part is clearly written and extremely well-researched. And I agree with Rothman's sense that copyright-preemption doctrine is troubled in the right-of-publicity context. But her suggestions for righting the various problems in this area strike me as unconvincing. Unexpectedly, Rothman does not leverage her privacy-centered view of the right of publicity as a means for solving its copyright preemption woes.<sup>10</sup> On the basis of the preceding chapters, however, she has convinced me that doing so is fully plausible. I would be very glad to see Rothman marrying her privacy-centered view with copyright-preemption analysis in a future work.

Another place for constructive criticism is the book's cover. I realize it's probably eccentric to bring jacket design into an academic book review, but I think there's an interesting point to be made here. Designed by Jill Breitbarth, the cover seems thematically disconnected from the book's substance. It features the book's title and the author's name arranged in blue semi-transparent bands across a black-and-white photo of a city's pedestrian mall on a sunny day, shot from above—perhaps from an unseen building or by a drone. Silhouetted people mill about with their shadows on the bright surface. Two of the people in the plaza are

windowboxed within one of the blue bands. We get the idea they are being spied upon. The graphic elements in combination with the book's subtitle, *Privacy Reimagined for a Public World*, delivers the message that this book is about how we are all surreptitiously watched as we go about our daily lives: tracked by Fitbits, surveilled by the Five Eyes, and all that. Yet Rothman's book isn't about any of that.

What would have been a fitting jacket design? I've come up with a few good ones, myself. But I'll spare you. You didn't pick up this review to hear a law professor pitch graphic design ideas. I'll just tell you that the ideas I have all involve recognizable faces—which, after all, is what the right of publicity is all about.

I don't know how the book's cover was made, but in an experiment I found that when I searched stock-photography website iStock using only the words "public" and "plaza," the first page of results included photos of the same city scene from the same photographer. (It's the Zeil in Frankfurt, credited to a photographer named Meinzahn.) When you get to the particular photo used on the cover, you find a little gem that, as it turns out, is very much connected to Rothman's book and the legal problems she is tackling. Along with the offer to license the photo is this selling point: "Every file licensed comes with a \$10,000 legal guarantee – that's our promise that when you use our content within the terms of our license agreement, it won't infringe on any copyright, moral right, trademark or other intellectual property right or violate any right of privacy or publicity. You can also purchase an Extended Legal Guarantee to increase that coverage to \$250,000."

And so it is that an out-of-control right of publicity, with the unpredictable capacity to sidestep the First Amendment, seems to have tied the hands of one who might venture to put a more fitting cover on the book that decries it.

So don't judge this book by its cover. (Unless you are willing to engage with the cover in a well-researched meta-analysis that reveals its deeper meanings.) But do read it.

THE RIGHT OF PUBLICITY: PRIVACY REIMAGINED FOR A PUBLIC WORLD is an unquestionably important book. Masterfully researched and deftly crafted, it is probably the best single source for gaining a deep understanding of the doctrine's history, context, and politics. I also am not aware of a more effective introduction to the principal cases and current controversies. The ultimate importance of the book comes more than anything from its careful, nuanced, and well-ordered thinking about an area of law that has stayed defiantly abstruse. The cogency of Rothman's argument will win many converts, but the clarity of her analysis will help even those who disagree with her. It deserves a place among the must-reads of American right of publicity law.

## END NOTES

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<sup>1</sup> See *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003) (upholding a right-of-publicity claim by a hockey player nicknamed “Tony Twist” against the creator of a villainous character nicknamed “Tony Twist” in the *Spawn* comic-book series).

<sup>2</sup> See *Dryer v. National Football League*, 814 F. 3d 938 (8th Cir. 2016) (denying right-of-publicity claim by former NFL players against the NFL for selling documentary films using old game footage in which the players appear).

<sup>3</sup> See, e.g., *Hart v. Electronic Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013); *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268 (9th Cir. 2013); *No Doubt v. Activision Publishing, Inc.*, 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011).

<sup>4</sup> See *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir. 1996).

<sup>5</sup> See *Lohan v. Take-Two Interactive Software, Inc.*, 31 N.Y.3d 111 (2018) (right-of-publicity claim by actress Lindsay Lohan for alleged portrayal in video game *Grand Theft Auto V*).

<sup>6</sup> 202 F.2d 866.

<sup>7</sup> Melville B. Nimmer, *The Right of Publicity*, 19 *Law & Contemp. Probs.* 203 (1954).

<sup>8</sup> *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977).

<sup>9</sup> Eric E. Johnson, *Disentangling the Right of Publicity*, 111 *Nw. U. L. Rev.* 891 (2017).

<sup>10</sup> Rothman does mention in the epilogue, in passing, that reuniting the right of publicity conceptually with the right of privacy will help to limit clashes between the right of publicity and copyright, but she does not develop this idea.

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**EXHAUSTING INTELLECTUAL PROPERTY RIGHTS, by Shubha Ghosh and Irene Calboli.** Cambridge University Press, 2018. 218 pp., Hardcover, \$120.00.

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The exhaustion doctrine refers to a principle that once an intellectual property owner sells or authorizes the sale of a protected product, the IP rights in that product are “exhausted.” The IP owner may not thereafter chase the article down the stream of commerce and use IP law to collect additional royalties or place further restrictions on the use or resale of the product. This simplified articulation of the doctrine fails to account for all of the variations on exhaustion rules in different countries and for different types of intellectual property; and fails to capture the myriad ways in which IP exhaustion intersects with complicated policy calculations, legal and economic theory, international trade, and areas of law beyond IP, such as contracts, antitrust, and the regulation of pharmaceuticals (to name a few). It takes a book to plumb the depths of exhaustion in all of its variations and implications, and that book is Shubha Ghosh and Irene Calboli’s new treatment, *EXHAUSTING INTELLECTUAL PROPERTY RIGHTS*. The book is a comprehensive guide to exhaustion, detailing the exhaustion regimes of many countries around the world across the various forms of intellectual property protection and against the backdrop of a clear and succinct explanation of the policy and legal theory behind IP exhaustion. To borrow the pun most readily at hand, this book exhausts the topic of IP exhaustion on many different levels.

First and foremost, the book is aggressively comparative in its scope. There has been a flurry of legal scholarship attending several major decisions by the U.S. Supreme Court in recent years that revitalized copyright and patent exhaustion in this country.<sup>1</sup> By this author’s count, there are approximately 450 law review articles discussing just one of those decisions, *Quanta Computer v. LG Electronics*. Professors Ghosh and Calboli’s book reminds the myopic U.S. scholar that all of this sound and fury is just about one small corner of the exhaustion world – U.S. patent law. The book does this through an exhaustive (apologies) survey of the IP exhaustion regimes of the European Union, the United States, Canada, Mexico, Australia, New Zealand, India, China, and member countries of ASEAN (Brunei Darussalam, Cambodia, Indonesia, Laos,

Malaysia, Myanmar, the Philippines, Singapore, Thailand, and Vietnam). Granted, the book does not discuss the exhaustion law of every country on earth (the authors offer express regrets that “there is no discussion of Switzerland, except in a short footnote in Chapter 5” (p. 2)). To correct this injustice, I will state here that Switzerland observes regional exhaustion of patent rights (except with respect to pharmaceuticals), but international exhaustion of trademarks and copyrights (except with respect to performance rights) (p. 103, n. 48)). But the authors assure us that “future editions may expand the set of representative jurisdictions” (p. 2). And the existing survey is more than sufficient to provide the reader with a framework for understanding the possible contours of the exhaustion doctrine in different jurisdictions.

Of primary importance in the comparative discussion are the different rules various countries observe with respect to whether foreign sales trigger exhaustion and with respect to the ability to write contracts that evade exhaustion. On the first issue, the Agreement on Trade-Related Aspects of Intellectual Property (the TRIPS Agreement) allows signatory nations to determine for themselves whether exhaustion of IP rights is triggered by a foreign sale, or only by a domestic sale. This has led to a fascinating laboratory of exhaustion regimes in which some countries observe national exhaustion (only a domestic sale triggers exhaustion), some countries observe international exhaustion (foreign and domestic sales trigger exhaustion), and some countries observe regional exhaustion (for example, the European Union Countries, in which the sale of a patented product anywhere in the European Union exhausts patent rights in the European Union, but not elsewhere).

On the issue of writing contracts to evade exhaustion, the authors offer the important insight that civil law countries tend to view the exhaustion of IP rights as arising from an implied license a purchaser has to use and resell the purchased item; these countries are more likely to allow for contracting around exhaustion because the implied license can be expressly revoked. On the other hand, common law countries tend to view exhaustion as arising out of the common law policy against restraints on alienability of personal property; these regimes are less likely to enforce contracts that purport to evade exhaustion because such behavior would violate this policy against servitudes.

A second way in which this book is exhaustive is that it surveys exhaustion across all of the relevant IP regimes. There are separate chapters devoted to trademark exhaustion, patent exhaustion, and copyright exhaustion. Exhaustion in each of these areas implicates different policy considerations. Moreover, exhaustion of these different types of IP rights interplays and often conflicts with other IP doctrines and areas of law, such as trade secret law and moral rights (aka “droit de suite”), topics that are explored in detail. The situation becomes even more complicated when one considers products that are subject to overlapping IP regimes. For example, a particular country may observe international exhaustion of trademark rights, meaning that a product lawfully sold overseas may be

imported without running afoul of the trademark laws. But what happens when the IP owner also claims *copyright* protection in the product labels in a situation where, under the law of the country in question, those rights are not exhausted by a sale overseas? A product that should be in the public domain under the policy of the country's trademark law nonetheless carries servitudes and restrictions under the copyright law. An entire chapter is dedicated to these thorny problems resulting from overlapping IP regimes.

A separate chapter is also devoted to the topic of digital technology and exhaustion. Digital technology complicates the picture because technological barriers can be imposed to prevent the reuse, copying, or resale of products even after the IP rights are exhausted. Moreover, copyright exhaustion can be foiled in situations where reuse violates reproduction rights as a technical matter. On the other hand, digital technology facilitates the instant dissemination of various products across borders in ways that can defeat IP rights.

And of course, as if comparative law were not enough, an entire chapter is devoted to the ways in which exhaustion law interacts with international trade law.

Finally, the book offers a rigorous discussion of the policy and legal theory behind IP exhaustion. This discussion is remarkably clear in light of the complexities involved, and the thesis appears to be that the complexities are fundamentally important. For example, some scholars have argued that international exhaustion benefits consumers in high-priced markets (by allowing for competition from imports), but hurts consumers in low-priced markets (by dissuading IP rights holders from engaging in useful price discrimination). Professors Ghosh and Calboli refute this argument by drawing attention to the many factors and variables this argument disregards. Whether and to what extent the prices in the two countries tend to equalize depends on consumer demand in the two countries, importation costs, regulatory costs, tourist and immigrant consumption, and other factors. It could be that national exhaustion permits IP holders to engage in predatory low pricing in the "low-priced" country in order to eliminate competition in that country and raise prices thereafter. How is the situation different for durable versus non-durable goods? What of companies that use technology or product differentiation to achieve the effects of national exhaustion in an international exhaustion regime? Maybe wealth maximization or redistribution are not the only legitimate goals of an exhaustion regime. Shouldn't one also take into account the policies of free trade, competition, and incentives to innovate? The book even offers speculation as to what John Locke, Georg Hegel, and John Rawls would have had to say about IP exhaustion, if anyone had bothered to ask.

In the end this book does not offer pat answers to the myriad policy questions surrounding exhaustion except to point out that these questions are very complicated. The authors tell us that the goal of the book is "to show the

economic, political, social, and legal choices” that are available to countries in formulating exhaustion doctrine (p. 207). The authors then undertake to explain how the exhaustion regime a country chooses “has implications for international trade, for secondhand markets, for consumer rights, and for distribution channels” (p. 207). The book achieves these ambitious goals in spectacular fashion.

#### ENDNOTES

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<sup>1</sup> See *Impression Prods. v. Lexmark Intern., Inc.*, 137 S.Ct. 1523 (2017); *Kirtsaeng v. John Wiley & Sons*, 568 U.S. 519 (2013); *Quanta Computer v. LG Elecs., Inc.*, 553 U.S. 617 (2008).

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