away some of the debris that has accumulated around patent-eligibility, however, and probably failed to make things any worse. It got rid of the inane ''useful, concrete, and tangible'' test. Moreover, *Bilski* seems to have put an end to the Federal Circuit's running warfare against the Supreme Court's patent-eligibility opinions and seemingly tried to follow rather than evade them. But it left a great deal for future litigation to clarify and its analysis is frequently baffling. In particular, the opinion completely avoids the technology and business method issues that Mayer J.'s dissent and Dyk J.'s concurrence attempt to address—issues that remain highly controversial and in need of authoritative resolution both in the United States and Europe.[27]

Ana Ramalho

Silent Ethics in the Mobile Phone Sector? The Case of the ''por qué no te callas?'' Ringtone

LT Character merchandising; King; Mobile telephony; Publicity; Spain

Introduction

November 10, 2007, Ibero-American Summit, Santiago, Chile. Before the constant interruptions performed by the President of Venezuela Hugo Chávez to the speech of the Spanish Prime Minister Zapatero, the King of Spain uttered the soon-to-be famous sentence ''why don't you shut up?'' (''*por qué no te callas?*''). Be it because of the King of Spain's usual phlegm or due to ongoing controversies between Spain and its former colonies, the rebuke gained both a political and commercial significance.

As a matter of fact, apart from the expected throng of political commentators dissecting the King's attitude and its respective implications, those blessed with some commercial awareness readily started profiting from the incident: according to the BBC,[1] more than half a million people downloaded a ringtone[2] which reproduced the King's tirade, generating an estimated income of $2 million.

The episode raises questions appertaining to a number of long-standing controversies. Undoubtedly, ringtones represent a new market and consequently a new licencing opportunity in the copyright realm. In the United States, for instance, a Memorandum Opinion from the Register of Copyrights, delivered on October 16, 2006,[3] gave off the view that ringtones are phonorecords and are therefore covered by the compulsory licence proviso laid down in copyright law.

However, copyright law is not at issue here. Instead, the query involves the use of someone's personal indicia for commercial purposes without that person's consent. Hence, the ''*por qué no te callas*'' ringtone concerns the so-called right of publicity, an area of law deemed to be either neighbouring or even part of intellectual property, but which holds contours and brings about considerations of its own. Amongst the former, one can definitely underline the ethical rationale presiding to most of the national laws that chose to approach the matter.

Therefore, by gauging the legal implications of the abovementioned incident, the main goal of this article is to draw some conclusions as to how ethics can and should play a role in preventing acts of encroaching upon someone else's personality rights in the mobile phone industry in general and in the ringtones business in particular.

For that purpose, we will start by analysing the right of publicity from an international perspective (section II). We then follow to examine how ethics can influence that area of law (section III). Finally, we will consider the case of the ''*por qué no te callas*'' ringtone, while taking into account the right of publicity from an ethical perspective.

Cuique suum tribuere: an overview of the right of publicity

It has long been acknowledged that fame is a commodity. Be it through endorsement, merchandising or media coverage, notoriety sells. Consequently, the right of publicity started to be perceived as the right to use someone's personality features, such as name, picture or voice, for commercial purposes. We can thus put forth that the right of publicity is the right to commercialise someone's identity.

Nevertheless, it is noteworthy that this right is not harmonised at an international level. In the United States, the right of publicity was expressly recognised in *Haelan Laboratories Inc v Topps Chewing Gum Inc.*[4] It was also given a particular emphasis by the US Supreme Court in *Zacchini v Scripps-Howard Broadcasting Co*,[5] where a difference between the tort of privacy and the tort of publicity was established.

Be it because of an ethical approach or just due to the tendency to worship celebrities, the US system forcefully protects the right of publicity[6]—for instance, even the commonly used ''freedom of speech'' defence cannot

27 For a discussion of the issues raised by the Mayer and Dyk opinions, see Richard H. Stern, *Being Within the Useful Arts as a Further Constitutional Requirement for US Patent Eligibility* [2009] E.I.P. R. 6.

1 News is available at *http://news.bbc.co.uk/1/hi/world/europe/7101386.stm* [Accessed January 20, 2009].

2 A ringtone is a digital sound file played by a mobile phone to indicate an incoming phone call or message.

3 The Memorandum Opinion from the Register of Copyrights document is available at *http://www.copyright.gov/docs/ringtone-decision.pdf* [Accessed January 20, 2009].

4 *Haelan Laboratories Inc v Topps Chewing Gum Inc* (2d Cir) 202 F.2d 866 (1953).

5 *Zacchini v Scripps-Howard Broadcasting Co* 97 S. Ct. 2849 (1977).

6 See S. Barnett, '''The Right to One's Own Image': Publicity and Privacy Rights in the United States and Spain'' [1999] *American Journal of Comparative Law* 47, 555. It is interesting to note, however, that the author concludes that, when compared to Spain and in certain cases, the US do not have such an extended scope of protection as one might think at first (see Barnett, '''The Right to One's Own Image': Publicity and Privacy Rights in the United States and Spain'' [1999] *American Journal of Comparative Law* 47, 581).

generally hold against a commercial use of someone else's personality aspects without consent.[7]

Conversely, other legislatures have deviated, to a lesser or greater extent, from this line of thought. Under German law, for instance, one finds a general personality right coexisting with specific ones (e.g. right to one's name or image). Personality rights are unitary in that they protect economic and non-economic interests.[8] Consequently, the possibility of licencing personality rights remains an ongoing discussion.[9]

On the other side of the spectrum, the United Kingdom does not admit such personality rights as the right to one's image or name. This will leave the prospective plaintiff with the sole option of seeking injunctive relief through established torts like passing off or defamation—which in turn have their own specific requisites of application.[10]

This mosaic normative landscape concerning the right of publicity is, of course, intrinsically linked to the cultural, social and legal traditions of the various countries. Because this right touches upon personality features as something inherent to a given person, opinions on whether such right should be alienable or even recognised are thoroughgoing and vary greatly.

It is our opinion that, independently of the legal system at stake, some general conclusions can be outlined and subsequently applied to the case presented. In furtherance of that goal, we follow to discuss the rationale of the right of publicity, while adopting an ethical approach to the matter.

Right of publicity revised: bringing ethics into play

The first problem one faces when dealing with the right of publicity is its rationale. Modern markets tend to reinforce the idea of property,[11] and from that standpoint one could extend such proprietary trend to the domain of personality rights. Still, property rights in general, just as any other rights, need justification. One possible view is to consider that morality underlies most of the rights bestowed upon individuals.[12] However, other type of considerations, e.g. economic ones, ought to be seen as valuable justifications as well.[13]

In what concerns copyright or patents, for example, the grant of an exclusive right is based mainly on an incentive rationale—if no protection is afforded, the works or inventions will be under-produced, that is, production will remain at a sub-optimal level. Conversely, inasmuch as the allocation of property rights allows for a recoupment of the creator's investment, the creation flow will arguably have the tendency to rise should a proprietary right be granted.[14]

In the case of the right of publicity, it has been correctly pointed out that its justification does not amount to fame per se.[15] In fact, there is a multitude of reasons for people to become famous, some of them not being fair, justified, ethical or moral. Justification for such right must then be found beneath the notoriety it rests upon.

A promising approach would be to retrieve the Lockean view of granting a proprietary right to one's own person, thus naturally including the right one has to one's personal indicia. It can be argued, however, that this grant is not ethical, for human features should not be disposable at all. This would lead to the conclusion that the right of publicity could represent an attempt on the general principles of human dignity.

We do not share the abovementioned view, though. One has to perform a balancing exercise of the various rights and principles involved. Human dignity, just as any other principle or right, must be seen *cum grano salis*, i.e. it must be weighed against the other rights or principles deserving to be considered in a given case. Moreover, human dignity is an abstract notion bearing different levels of prohibition. For instance, whereas disposition of one's own life blatantly goes against it, the exploitation of one's identity can be considered a borderline case.

One can also resort to a fairness argument. It must be underlined that fairness has both a legal and an ethical dimension. Therefore, a probable intertwinement would be: in order to be fair, a legal system has to behold and respect certain fundamental rights[16]—such as some personality rights, we add. Yet, there is a clear distinction between the recognition of a personality right and the further step of granting a right to commercially exploit it. We should thus examine whether the notion of justice can extend to the latter.

We call to mind the ancient notion of distributive justice put forth by Aristotle: one's wealth ought to be proportionate to one's merit. Similarly, if one is merely appropriating someone else's personality features to profit from that person's recognition on the market,

7 See, for example, *Abdul-Jabbar v General Motors Corp* 85 F. 3d 407, 9th Circ. 1996, or *White v Samsung Electronics America* Inc 971F.2d 1395, 9th Circ., 1992.

8 See judgment of December 1, 1999, German Federal Supreme Court, BGHZ 143, 214.

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9 In the framework of • judgements delivered by the German Federal Supreme Court, one finds some cases approaching this subject: for example, judgment of October 14, 1986, GRUR 1987, 128 and judgment of October 26, 2006, GRUR 2007, 137.

10 For a thorough explanation on the torts of passing off and defamation, see respectively A. Firth, G. Lea and P. Cornford, *Trade Marks Law and Practice*, 2nd edn (Bristol: Jordans, 2005), pp.41 ff. and L. McNamara, *Reputation and Defamation* (New York: Oxford University Press, 2007), pp.81 ff.

11 See P. Himanen, *La Ética del Hacker y el Espíritu de la Era de la Información* (Barcelona: Ediciones Destino, 2004), p.65.

12 Discussing this view, see B. Almond, "Los Derechos" in P. Singer (ed.), *Compendio de Ética*, (Madrid: Alianza Editorial, 1995), pp.368 ff.

13 For a critique to the opinion defending morality as the sole rationale for the existence of rights, see J. Ascensão, *O Direito: Introdução e Teoria Geral*, 7th edn, (Coimbra: Almedina, 1993), pp.90 ff.

14 For a thorough analysis of the economic rationale of copyright, see W. Landes and R. Posner, "An Economic Analysis of Copyright Law" [1989] *The Journal of Legal Studies* 18(2), 326 ff.; referring to the incentive rationale regarding patents, see Federal Trade Commission. *To Promote Innovation: the Proper Balance of Competition and Patent Law and Policy*. 2003, pp. 4 ff., available at *http://www.ftc.gov/os/2003/10/innovationrpt.pdf* [Accessed January 20, 2009].

15 M. Madow, "Private Ownership of Public Image: Popular Culture and Publicity Rights" [1993] *California Law Review* 81, 179.

16 See E. Fernández, "Estudios de Ética Jurídica" (Madrid, Editorial Debate, 1990), pp.106 ff.

there is no merit-based wealth. However, as stressed earlier, the notoriety of a given person can be far from being justified from an ethical or moral point of view, which will lead us to the same conclusion (i.e. the notorious person also lacks merit).

Hence, regarding the commercialisation of personality features, the fairness argument should be thoughtfully reformulated. The idea of a third party profiting from someone else's personality traits is somehow repulsive to most of us. This is so because we tend to think of personality rights as something which is inherently ours, on the one hand, and due to the effortless enrichment of that third party, on the other hand.

These commonsense avowals give us a start-off basis towards the recognition of a right of publicity. As mentioned earlier, justification should not lie on fame itself. Instead, one must dig underneath it. As a result, the right to commercialise one's personal indicia should be prima facie acknowledged as an exclusive right of everyone—celebrities and anonymous citizens—notwithstanding the fact that the market value of personality features is directly proportional to one's fame or notoriety. That is, fame is the cause for the willingness to profit from certain personal traits, but it should not certainly be a mandatory requisite for affording protection.

Recalling Kant's philosophy about the autonomy of the human being, we set forth that the reason for the recognition of one more exclusive right in the already oversized domain of proprietary rights is ultimately self-determination. Because personality features are so closely connected to the person they relate to, the grant of an exclusive right to commercialise them is no more than a natural consequence of the general right to self-determination, widely settled in most legal systems.

Nevertheless, another different problem arises before the possibility of licencing or assigning the right of publicity. Again, ethical reflections should be called upon, forasmuch as they highlight the two faces of the same coin. The right of publicity should be descried as an exclusive, subjective right owing to its intrinsic link to the persona; and it should not be licensable or assignable exactly because of that. Self-determination must have its limits and one of its boundaries should definitely be the moral and ethical dimension of the human being as a socially integrated creature. Notably, this right should have a sufficient scope to withhold third parties from using one's personality features for commercial purposes. But it can not go as far as to empower its proprietor to licence or assign it, relinquishing the moral or ethical reasons which supported the bestowal of that same right in the first place.[17] A diverse solution would be equivalent to a denaturation not only of the right of publicity but also of the personality rights themselves.[18]

Still, one should differentiate assignment and licencing of the right of publicity—which should be prohibited in light of the above—and consent, which should be deemed possible. Awarding an absolute inalienable right to one's personality features would be unrealistic and noticeably against self-determination. This principium should prevent one from overcapitalising on one's personal indicia, but it should not thwart the possibility of its economically disinterested disposal.

Altogether, it is our view that ethics ought to play a homogeniser role in the field of the right of publicity. It should be used to emphasise the rationale behind such right, in order to posit a common general regime, regardless of the legal system concerned. By playing on the ethical indoctrinations, the right of publicity would be accepted as a right deriving from self-determination which, due to that dogmatic ballast, ought to be an exclusive, subjective right. It should not be the object of an assignment or licence, but its exercise could be consented on.

In the country of the blind, the one-eyed man is king

Generally speaking, the telecommunications sector has an economical dimension which cannot be overlooked. However, like ethics, economics cannot and should not stand alone. As in many other stratums, telecommunications are relevant in the political and social spheres.[19] It is exactly in the intersection of these domains that the present case takes place.

Taking into account the arguments drawn in the previous sections, and making use of the ethical dimension given to the right of publicity, it is apparent that no third party could simply record the King's intervention, convert it into a ringtone and commercialise it. That would be a clear-cut case of an unauthorised use of a personality feature (voice), and thus an infringement to the right of publicity as delineated under the model proposed heretofore.

However, in the case under analysis and according to the Canadian Broadcasting Company,[20] an actor was intentionally engaged to avoid legal problems. This fact raises the question of whether an evocation of the public figure is enough to trigger the qualification of a conduct as an illicit one. US case law has occasionally approached this issue, and it seems to provide the legal interpreter with an affirmative answer. In *Carson v Here's Johnny Portable Toilets*,[21] the use of a catchy phrase (''Here's Johnny'') was deemed to be an infringement

17 Discussing the drawbacks of treating the right of publicity as any other assets, see M. Jacoby and D. Zimmerman, ''Foreclosing on Fame: Exploring the Uncharted Boundaries of the Right of Publicity'' [2002] *New York University Law Review* 77, 1357.

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18 Nevertheless, • some courts around the globe have found licencing to be admissible, or at least left the door opened to such future decisions. Leaving aside the US, where the right of publicity finds a safe haven and thus assignment and licencing are widely accepted, improbable judicatures have made for a possibility of licencing of personality rights. One eloquent example is Germany, where the Federal Supreme Court recognised that there are economic interests in personality rights (judgments of October 14, 1986, GRUR 1987, 128 and December 1, 1999, BGHZ 143, 214).

19 Following this holistic approach, see J. Conill, ''Economía Ética de los Medios de Comunicación'' in J. Conill and V. Gozálvez (eds), *Ética de los Medios: una Apuesta por la Ciudadanía Audiovisual* (Barcelona: Editorial Gedisa, 2004), pp.137 ff.

20 News available at *http://www.cbc.ca/world/story/2007/11/19/spain-ringtone.html* [Accessed January 20, 2009].

21 *Carson v Here's Johnny Portable Toilets* 698 F.2d 831, 6th Cir., 1983.

to the right of publicity of Johnny Carson. In both *Midler v Ford Motor Co*[22] and *Waits v Frito Lay Inc*,[23] the plaintiffs won the suit for voice misappropriation where an actor's voice was intentionally used to mimic the one of a famous singer (respectively, Bette Midler and Tom Waits).[24] Nonetheless, some doctrine suggests prudence when drafting the boundaries of the right to evoke.[25]

Again, ethics must come into play in situations like the above. Ethical considerations ought to be the determinative factor to assess whether an evocation is licit. Evocation can take place through the imitation of a style, voice or mannerism. Whatever the means, it is our view that the ultimate test for infringement should be the closeness of the collage of the evocation to the original personality features which the public ascribes to a given person. The underlying reason for the adoption of such test has an ethical nature as well: the closer one gets to the inner personal sphere of someone else, the more likely one is to scratch that someone else's identity and right to self-determination.

Differently from the cases where one finds a commercial exploitation of the pure and real indicia of a person, here one must weigh the closeness of the evocation to the personality features against free market principles. The right to evoke should not be the motto for monopolistic strategies, forasmuch as the ethical argument would be lost. Therefore, the scope of the right to evoke cannot stymie free market values when that hindrance fails to be justified from an ethical point of view.

One must also take account of the fact that there are transformative evocations, usually consisting of a parody or satire. This type of situation will naturally be more supported by premises relating to freedom of speech, since the critique or the transformation, rather than the original personal indicia, are the central focus. As a consequence, the transformative use—and not the original aspects of someone's personality—is the main income generator.[26]

Importantly, in the case of the "*por qué no te callas*" ringtone, the King's voice is not the distinctive feature allowing for the identification of the person. The voice used to produce the ringtone is immaterial in the sense that the majority of the public could not recognise the King's voice anyway. Instead, the popularity of the ringtone is a consequence of the specific phrase uttered, enabling an association of the expression with the King of Spain.

That being clarified, could we still defend the granting of a right to evoke to the King? We do not think so. The King's tirade was nothing more than that: a tirade. It does not reflect his identity, it does not have a close link with his personality, it is not even a sentence which he says regularly. Indeed, the phrase became known as coming out of the King's mouth. But that was due to a combination of the special political context and the contradiction with the King's personality that the rebuke seems to represent.

Absent strong ethical constraints, monopolies of random sentences should not be granted *tout court*. As much as the idea of allowing the impunity of a commercial awareness of this kind might sound blameworthy, in the country of the blind the one-eyed man is indeed the real king.

Conclusion

The mobile phone industry has been one paradigmatic example of the rapid innovation pace which characterises the telecommunications sector. Apart from the obvious core product, the mobile itself, the industry has strongly relied on the popularity (and, consequently, profitability) of satellite businesses such as the ringtones one. Specifically concerning the latter, the mobile phone companies had to take into consideration legal guidelines flowing out from other branches of law, namely copyright.

As the development of technology (and of commercial awareness) encourages an intertwinement of the mobile industry and practice with a growing number of other fields, ethical principles are a primary tool in what concerns basic regulatory needs.

Notably, the use of someone's voice or catchy phrase in a ringtone can call upon the intervention of the right of publicity. However, just like in any other subjective right, the limits to one's right of publicity must be drawn, for it is not an absolute right. In fact, if on the one hand fairness and self-determination are powerful ethical arguments when regulating the use of personality features by the mobile phone industry, on the other hand the right to evoke has to be carefully curbed. Ethics should not be a motor for the creation of unjustified monopolies, insofar as it lacks argumentative strength to go further. When ethical concerns start becoming blurred, economic principles should step in. Definitely, ethics are not silent in the mobile phone industry, but they sure ought to listen to what economics has to say.

22 *Midler v Ford Motor Co* (1988) 849 F.2d 460.

23 *Waits v Frito Lay* 978 F. 2d 1093, 9th Cir., 1992.

24 It should be noted that there is a specific tort of voice misappropriation in California, though.

25 See S. Dogan, "An Exclusive Right to Evoke" [2003] *Boston College Law Review* 44, 319.

26 Standing for the adoption of a transformative test in this domain, see D. Sherman, "The Right of Publicity and the First Amendment Defense in California" [2004] *Intellectual Property Law Bulletin* 9(1), 45.

THOMSON

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