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Unnecessary Roughness: Reconciling Hart and Keller with a Fair Use Standard Befitting the Right of Publicity Note

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Note

UNNECESSARY ROUGHNESS: RECONCILING *HART* AND *KELLER* WITH A FAIR USE STANDARD BEFITTING THE RIGHT OF PUBLICITY

MICHAEL “BUBBA” SCHOENEGER

Two lawsuits have created a stir in the sports law community threatening to derail the NCAA’s monopoly on licensing the images of both present and former student-athletes. In both Keller v. Electronic Arts, Inc. and Hart v. Electronic Arts, Inc., former collegiate quarterbacks attack the NCAA, the CLC, and Electronic Arts for the unauthorized use of their likeness in the popular video game franchise NCAA Football. Recent scholarship has focused on the viability of the NCAA and how these cases may tear down any semblance of amateurism left in college sports.

This Note, however, focuses on how these two cases have the potential to inform the relationship between the First Amendment and the right of publicity. Courts have struggled to devise a test that accurately represents this relationship, which has spawned myriad tests. What makes Keller and Hart the perfect test cases is that the cases deal with the exact same issue, yet come to the opposite conclusion. This Note traces the history and policy justifications of the right of publicity to derive a fair use standard befitting the right of publicity. The new fair use factors are then applied to Keller and Hart’s factual scenarios to show why the outcomes differ and what appellate courts should do in the future.

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STANDARD BEFITTING THE RIGHT OF PUBLICITY

MICHAEL “BUBBA” SCHOENEBERGER*

I. INTRODUCTION

A rewarding aspect of playing quarterback for Arizona State was the joy Sam Keller felt whenever he played *NCAA Football*, the popular video game from Electronic Arts (“EA”).¹ Although his name did not appear in the game, there was little doubt that Keller inspired the virtual quarterback leading the Sun Devils’ offense in the 2005 edition.² Keller and his virtual counterpart were nearly identical, sharing the same jersey number, height, weight, skin color, hair color, and hometown.³ Like many other gamers, Keller found the realism of *NCAA Football* appealing and vital to his overall gaming experience.⁴ Since his days on the gridiron, however, Keller has come to view the video game as an exploitation of his right of publicity.⁵

In 2009, three lawsuits threatened to derail the National Collegiate Athletic Association’s (“NCAA”) restrictions on student-athlete compensation.⁶ Keller filed a class-action suit against EA and the NCAA alleging a violation of his right of publicity.⁷ Ed O’Bannon, former UCLA basketball star, filed suit against the NCAA, the Collegiate Licensing Company (“CLC”), and EA alleging a conspiracy to require student-athletes to forgo their publicity rights in perpetuity in violation of the Sherman Act.⁸ On the east coast, former Rutgers quarterback Ryan Hart

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¹ Katie Thomas, *College Stars See Themselves in Video Games, and Pause to Sue*, N.Y. TIMES, July 4, 2009, at A1.

² *Id.*

³ *Id.*

⁴ *Id.*

⁵ *Id.*

⁶ Gina Reif Ilardi, *First Amendment v. the Right of Publicity: The Game Is On!*, METROPOLITAN CORP. COUNS., Sept. 2012, at 17.

⁷ *Id.*

⁸ *Money & March Madness: The NCAA Lawsuit*, PBS FRONTLINE, <http://www.pbs.org/wgbh/pages/frontline/money-and-march-madness/ncaa-lawsuit/> (last updated Oct.

filed a putative class action suit against EA alleging the misappropriation of student-athletes' likenesses in connection with several editions of *NCAA Football*.⁹

Scholarly reaction has fixated on the possible downfall of the NCAA.¹⁰ A legal victory by any of these former athletes would threaten the status quo, potentially forcing the NCAA to share its estimated four billion dollar market for licensed merchandise with former—and possibly current—student-athletes.¹¹ One scholar claimed that “[i]f Keller is compensated even a modest amount, the damage to the NCAA (and EA) could foreseeably be enormous,” giving every athlete ever depicted in *NCAA Football* or *NCAA March Madness* strong precedent for future lawsuits.¹² Moreover, the NCAA would be required to pay treble damages under federal antitrust law.¹³

Sports columnist Dan Wetzel described one of the plaintiffs as a “sort-of Curt Flood of college sports,”¹⁴ referencing the potential to revolutionize the relationship between the NCAA and collegiate athletes.¹⁵ It is quite possible that Sam Keller and Ryan Hart will become the proverbial Curt Floods of this generation; however, when all is said and done, their legacies may more closely resemble that of Hugo Zacchini, the “human cannonball.”¹⁶ Zacchini's landmark case legitimized the right of publicity and attempted to define the relationship between such a right and the First

4, 2011). The O'Bannon and Keller lawsuits have been consolidated in the Northern District of California under the name *In Re: NCAA Student-Athlete Name & Likeness Licensing Litigation*. *Id.* However, the court granted Keller a stay to appeal the district court decision to the Ninth Circuit, which will be the focus of this Note. Ilardi, *supra* note 6.

⁹ Michael McCann, *Ryan Hart's Federal Lawsuit Against Electronic Arts Dismissed*, SPORTS L. BLOG (Sept. 12, 2011, 2:42 PM), <http://sports-law.blogspot.com/2011/09/ryan-harts-federal-lawsuit-against.html>.

¹⁰ See, e.g., Christian Dennie, *Changing the Game: The Litigation that May Be the Catalyst for Change in Intercollegiate Athletics*, 62 SYRACUSE L. REV. 15, 49–50 (2012) (predicting the creation of a new “modified amateurs” class distinct from student-athletes that will allow certain players to receive compensation while under the purview of the NCAA).

¹¹ Dan Wetzel, *Making NCAA Pay?*, YAHOO! SPORTS RIVALS (July 21, 2009), <http://rivals.yahoo.com/ncaa/basketball/news?slug=dw-ncaasuit072109>.

¹² Bill Cross, Comment, *The NCAA as Publicity Enemy Number One*, 58 U. KAN. L. REV. 1221, 1244 (2010).

¹³ Andrew B. Carrabis, *Strange Bedfellows: How the NCAA and EA Sports May Have Violated Antitrust and Right of Publicity Laws to Make a Profit at the Exploitation of Intercollegiate Amateurism*, 15 BARRY L. REV. 17, 39 (2010).

¹⁴ Wetzel, *supra* note 11.

¹⁵ Curt Flood, a former baseball player, courageously challenged the legality of the reserve clause, which provided that upon the expiration of a player's contract, the rights to that player were retained by his previous team. The Supreme Court refused to strike down the reserve clause, but Marvin Miller used this case to leverage bargaining power against Major League Baseball in negotiating what we now call (unrestricted) free agency. Nick Acocella, *Sportscenry Biography: Flood of Free Agency*, ESPN CLASSIC, http://espn.go.com/classic/biography/s/flood_curt.html (last visited Mar. 7, 2013).

¹⁶ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 563 (1977).

Amendment.¹⁷ Today, *Zacchini v. Scripps-Howard Broadcasting Co.*¹⁸ is still the only right of publicity case ever considered by the Supreme Court.¹⁹ However, the right of publicity is ripe for review, especially considering the litany of different tests that each circuit has employed to resolve the right of publicity—First Amendment tension.²⁰

Ironically, the publicity that *Hart v. Electronic Arts, Inc.*²¹ and *Keller v. Electronic Arts, Inc.*²² have received from scholars may help force the Supreme Court's hand. These two cases provide the perfect storm for tackling the right of publicity; we have two district courts considering the identical issue within the same video game, and yet, the opinions could not differ more. *Keller* and *Hart*'s inconsistency is just a microcosm of the current state of this jurisprudence, which is begging for the highest court's review.²³

This Note proposes a test akin to copyright fair use and the transformative use test applied in both *Keller* and *Hart*. These decisions will illustrate the deficiencies of the current framework and provide an example of the efficacy of this Note's proposed test by reconciling the two opinions. Part II will briefly discuss the background of the right of publicity chronicling its evolution from an element of the right of privacy into a distinct property right. Part III will examine the policy justifications underlying both the right of publicity and the First Amendment. Part IV will outline the various tests courts have used to balance the right of publicity against the First Amendment. Part V will focus on the *Keller* and *Hart* decisions, emphasizing the transformative use analysis. Finally, Part VI will introduce a new test incorporating the copyright fair use doctrine with new elements designed to advance right of publicity considerations.

II. MORNING WALK-THROUGH: A BRIEF HISTORY OF THE RIGHT OF PUBLICITY

A. *The All-Encompassing Right of Privacy*

In 1890, Samuel Warren and Louis Brandeis wrote one of the most influential law review articles in history, *The Right to Privacy*.²⁴ The gradual expansion of the right to life justified creation of a "right to enjoy

¹⁷ *Id.* at 565.

¹⁸ *Id.* at 562.

¹⁹ *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 775 (D.N.J. 2011).

²⁰ *See infra* Part IV.

²¹ *Hart*, 808 F. Supp. 2d at 757.

²² No. C 09–1967 CW, 2010 WL 530108 (N.D. Cal. Feb. 8, 2010).

²³ Katie Thomas, *Image Rights vs. Free Speech in Video Game Suit*, N.Y. TIMES, Nov. 16, 2010, at A1 ("I think it's an area that is crying out for Supreme Court review in the right case." (quoting David L. Hudson, Jr.)).

²⁴ Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

life,—the right to be let alone.”²⁵ The initial purpose of this right was to prevent the press from “overstepping in every direction the obvious bounds of propriety and of decency.”²⁶ The article had a great impact on American jurisprudence and did “nothing less than add a chapter to our law.”²⁷

In the wake of the article, courts struggled to accept a new common law right of privacy and in determining its scope and limitations.²⁸ In 1902, the New York Court of Appeals rejected the adoption of a common law right to privacy;²⁹ however, the New York legislature responded swiftly, creating a statute establishing both criminal and civil liability for the unauthorized use of a person’s “name, portrait or picture” for “advertising purposes, or for the purposes of trade.”³⁰ Three years later, the Georgia Supreme Court held that the misappropriation of an artist’s photograph in an advertisement violated his common law right to privacy.³¹ Subsequent opinions³² incorporated the exclusive right to one’s identity within the right of privacy.³³

The aforementioned cases fit comfortably within a “right to be let alone” since these plaintiffs were exposed to widespread, unwanted publicity with the potential to cause distress and embarrassment.³⁴ However, when celebrities, athletes, and entertainers claimed emotional injury for the unauthorized use of their image by advertisers or merchandisers—creating additional publicity—it raised some eyebrows.³⁵

²⁵ *Id.* at 93; *see also* *Olmstead v. United States*, 277 U.S. 438, 478 (1928) (Brandeis, J., dissenting) (“[The founders] sought to protect Americans in their beliefs, their thoughts, their emotions and their sensations. They conferred, as against the Government, the right to be let alone—the most comprehensive of rights and the right most valued by civilized men.”).

²⁶ Warren & Brandeis, *supra* note 24, at 196.

²⁷ ALPHEUS THOMAS MASON, *BRANDEIS: A FREE MAN’S LIFE* 70 (1946) (quoting Letter from Roscoe Pound to William Chilton (1916)).

²⁸ J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:15 (2d ed. 2012).

²⁹ *Roberson v. Rochester Folding Box Co.*, 171 N.Y. 538, 556 (1902), *superseded by statute*, N.Y. Civ. Rights Law §§ 50, 51 (Consol. 2001 & Supp. 2005).

³⁰ N.Y. CIV. RIGHTS LAW §§ 50, 51 (Consol. 2001 & Supp. 2005).

³¹ *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68, 80–81 (Ga. 1905).

³² *See, e.g., Flake v. Greensboro News Co.*, 195 S.E. 55, 63–64 (N.C. 1938) (holding that individuals had a right “not only against the scandalous portraiture and display of one’s features and person, but against the display and use thereof for another’s commercial purposes or gain”); *Foster-Milburn Co. v. Chinn*, 120 S.W. 364, 366 (Ky. 1909) (finding a right against “the publication of the picture of a person without his consent”); *see also* Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 168 (1993) (citing *Kunz v. Allen*, 172 P. 532, 533 (Kan. 1918) (holding that a right to privacy is “derived from natural law”)).

³³ Madow, *supra* note 32, at 168.

³⁴ *Id.*

³⁵ *See id.* at 168–69 (“After all, how could a movie star or professional athlete, who had deliberately and energetically sought the limelight, complain of embarrassment or hurt feelings when an advertiser or merchandiser simply gave his face some *additional* publicity? How could someone like Babe Ruth, who had performed before thousands, posed for photographs, granted interviews, made paid public appearances, and endorsed products, complain of distress or humiliation when his picture was used without his consent on a baseball card or in a cereal advertisement?” (footnote omitted)).

This type of action did not fit well within the right to privacy since it did not allege an emotional harm, but rather an economic harm causing diminished income.³⁶

Understandably, courts were unsympathetic to these celebrity plaintiffs in the 1920s and 1930s. Many courts held that celebrities “waived their rights of privacy . . . by assuming positions of prominence and visibility.”³⁷ In *O’Brien v. Pabst Sales Co.*,³⁸ the Fifth Circuit held that Davey O’Brien, an All-American college football player, had relinquished his privacy right by consenting to national media exposure of his on-field prowess and “repeatedly pos[ing] for photographs for use in publicizing himself and [his] team.”³⁹ O’Brien alleged that a beer company used his photograph on a football calendar without his consent.⁴⁰ Judge Hutcheson had little sympathy for the star athlete, noting that “the publicity he got was only that which he had been constantly seeking and receiving.”⁴¹

B. *Propertizing the Right of Publicity*

Widespread reluctance to enforce the commercial misappropriation tort under the right to privacy umbrella led some lower courts to recognize a distinct property right in the value of one’s image and likeness.⁴² However, the Fifth Circuit rejected this notion in *Hanna Manufacturing Co. v. Hillerich & Bradsby Co.*⁴³ In this case, Hillerich contracted with professional baseball players for the “exclusive right” to use their names, autographs, and photographs in connection with the sale and advertising of baseball bats.⁴⁴ Hanna, a competing bat manufacturer, had no agreements with these players, but nevertheless manufactured bats with similar styles and name imprints.⁴⁵ Hillerich sued to enjoin Hanna from selling the bats, alleging an exclusive property right to use those names on baseball bats.⁴⁶

³⁶ James M. Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV. 637, 641 (1973).

³⁷ Madow, *supra* note 32, at 169.

³⁸ 124 F.2d 167 (5th Cir. 1941), *cert. denied*, 315 U.S. 823 (1942).

³⁹ *Id.* at 169.

⁴⁰ *Id.* at 168–69.

⁴¹ *Id.* at 170.

⁴² See, e.g., *Munden v. Harris*, 134 S.W. 1076, 1078 (Mo. 1911) (“If there is value in [one’s appearance], sufficient to excite the cupidity of another, why is it not the property of him who gives it the value and from whom the value springs?”); *Edison v. Edison Polyform & Mfg. Co.*, 67 A. 392, 394 (N.J. Ch. 1907) (“If a man’s name be his own property, as no less an authority than the United States Supreme Court says, it is difficult to understand why the peculiar cast of one’s features is not also one’s property, and why its pecuniary value, if it has one, does not belong to its owner rather than to the person seeking to make an unauthorized use of it.” (citation omitted)).

⁴³ 78 F.2d 763 (5th Cir. 1935), *cert. denied*, 296 U.S. 645 (1935).

⁴⁴ *Id.* at 764.

⁴⁵ *Id.*

⁴⁶ Hillerich sued on two grounds, the second alleging that Hanna’s use of the names falsely implied an endorsement and thereby constituted unfair competition. *Id.* at 768. The Fifth Circuit did

The Fifth Circuit held that Hillerich's contracts with the players merely prevented the players from objecting to the use of their names, and that trademark and unfair competition law governed Hillerich's rights against third parties.⁴⁷ The court reasoned that characterizing the players' right to prevent unauthorized use of their names as a "personal" or "property" right was inconsequential since it was "not vendible in gross so as to pass from purchaser to purchaser unconnected with any trade or business."⁴⁸ More importantly, the court added, "Fame is not merchandise. It would help neither sportsmanship nor business to uphold the sale of a famous name to the highest bidder as property."⁴⁹

Eighteen years later, a court finally recognized the economic value of fame "in addition to and independent of" a right of privacy.⁵⁰ In the landmark case *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,⁵¹ the Second Circuit held that baseball players have "a right in the publicity value of [their] photograph."⁵² Judge Jerome Frank famously wrote:

This right might be called a "right of publicity." For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, 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.⁵³

The opinion "essentially propertized the right by averring that it could be licensed or assigned and enforced against third parties by the licensee or assignee."⁵⁴

Haelan generated a number of different reactions. William Prosser, in

not overturn the district court's ruling in favor of Hillerich on this claim and ultimately granted an injunction that would allow Hanna to continue to print the players' names on the bats under certain conditions. *Id.*

⁴⁷ *Id.*

⁴⁸ *Id.* at 766.

⁴⁹ *Id.*

⁵⁰ *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953).

⁵¹ *Id.* at 866.

⁵² *Id.* at 868.

⁵³ *Id.*

⁵⁴ Gloria Franke, Note, *The Right of Publicity vs. the First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CAL. L. REV. 945, 952 (2006) (citing *Haelan Laboratories, Inc.*, 202 F.2d at 868).

his immensely influential law review article, *Privacy*, viewed the phrase “right of publicity” narrowly, merely signifying a licensee’s exclusive right to use one’s name and likeness.⁵⁵ On the other hand, Joseph Grodin—who later became a justice of the California Supreme Court—recognized the broader implications of the decision: “[T]he *Haelan* case gave protection to persons’ commercial interest in their personality independent of their privacy interest. . . . If courts wish to protect both interests to at least some extent, they should do so under separate doctrines, so that limitations appropriate to each interest may be imposed.”⁵⁶

This confusion all but vanished when Melville Nimmer exposed the failure of traditional areas of law to protect the commercial interest in a person’s identity.⁵⁷ While the “concept of privacy which Brandeis and Warren evolved fulfilled the demands of Beacon Street in 1890,” Nimmer questioned its application to “the needs of Broadway and Hollywood in 1954.”⁵⁸ Their concern was the preservation of privacy against a press “overstepping in every direction the obvious bounds of propriety and of decency.”⁵⁹ “With the tremendous strides in communications, advertising, and entertainment techniques, [celebrity] likeness [took] on a pecuniary value undreamed of at the turn of the century.”⁶⁰ These cultural and technological forces necessitated the creation of a right of publicity, an agenda born by *Haelan* and subsequently endorsed by Nimmer.⁶¹

Courts were initially reluctant to embrace this new right,⁶² but ultimately the right of publicity gradually gained widespread judicial and

⁵⁵ MCCARTHY, *supra* note 28, § 1:26; William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 406 (1960). Prosser’s article divided the tort of invasion of privacy into four separate and distinct categories, the last of which being “appropriation privacy.” Prosser, *supra*, at 389. However, he did not accept the phrasing “right of publicity” because he viewed the tort as protecting both a commercial and personal dignity interest. *Id.* at 415. His failure to distinguish between “appropriation privacy” (injury to dignity and feelings) and commercial misappropriation of one’s identity has led to some confusion despite many courts referring to this fourth tort as the “right of publicity.” See *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983) (“Henceforth, we will refer to Prosser’s last, or fourth category, as the ‘right of publicity.’”); *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 220 (2d Cir. 1978) (“[Prosser’s fourth category] has in recent years acquired the label ‘right of publicity.’”).

⁵⁶ Joseph Grodin, Note, *The Right of Publicity: A Doctrinal Innovation*, 62 YALE L.J. 1123, 1127, 1130 (1953).

⁵⁷ See Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 204 (1954) (surveying the “inadequacy of privacy” as a foundation of a commercial market for “publicity values” because the law defined privacy as a personal, non-assignable right); *id.* at 210–12 (analyzing the inadequacy of unfair competition because “[p]ublicity values of a person or firm may be profitably appropriated and exploited without the necessity of any imputation that such person or firm is connected with the exploitation undertaken by the appropriator”).

⁵⁸ *Id.* at 203.

⁵⁹ *Id.* (quoting Warren & Brandeis, *supra* note 24, at 196).

⁶⁰ *Id.* at 204.

⁶¹ *Id.* at 222–23.

⁶² Madow, *supra* note 32, at 176.

scholarly acceptance.⁶³ It would, however, take another quarter century before the Supreme Court reviewed this newly established right of publicity.

III. FILM SESSION: POLICY CONSIDERATIONS UNDERLYING THE RIGHT OF PUBLICITY AND THE FIRST AMENDMENT

To formulate a workable test that balances the right of publicity and the First Amendment, it is appropriate to examine the theoretical underpinnings of both legal concepts. Scholars and courts have identified five primary policy justifications for the right of publicity: (1) allowing the famous to enjoy the fruits of their own labor; (2) preventing unjust enrichment; (3) providing incentives for creativity; (4) efficient allocation of property rights; and (5) personal autonomy.⁶⁴

A. *Right of Publicity*

1. *Lockean Labor Theory*

John Locke's theory asserts that the property right inherent in one's self justifies the "right to exclude others from possessing his body and controlling the output of his labor."⁶⁵ Furthermore, "[w]hen a person 'mixe[s]' his labor with a thing in its natural (that is unowned) state, he 'join[s]' to it something that is his own' and 'thereby makes it his property.'"⁶⁶

Arguably the most important contribution by Nimmer was grounding the right of publicity in the labor theory:

It is . . . unquestionably true that in most instances a person achieves publicity values of substantial pecuniary worth only after he has expended considerable time, effort, skill, and even money. It would seem to be a first principle of Anglo-

⁶³ See, e.g., *Cepeda v. Swift & Co.*, 415 F.2d 1205, 1207 (8th Cir. 1969) (recognizing that a professional baseball star could grant an exclusive right to use an imprint of his name to a baseball manufacturer); *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1281 (D. Minn. 1970) (holding that major league baseball players had a proprietary interest in their names, sporting activities and accomplishments sufficient to enjoin unauthorized use for commercial purposes).

⁶⁴ See Jennifer L. Carpenter, *Internet Publication: The Case for an Expanded Right of Publicity for Non-Celebrities*, 6 VA. J.L. & TECH. 3, at *11 (2001) (identifying four of the proffered justifications); Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 411, 417 (1999) (advocating the adoption of the personal autonomy justification for the right of publicity).

⁶⁵ Michael Decker, Note, *Goodbye, Norma Jean: Marilyn Monroe and the Right of Publicity's Transformation at Death*, 27 CARDOZO ARTS & ENT. L.J. 243, 257 (2009) (citing Madow, *supra* note 32, at 175 n.239).

⁶⁶ Madow, *supra* note 32, at 175 n.239 (alterations in original) (quoting JOHN LOCKE, THE SECOND TREATISE OF GOVERNMENT 17, 19 (Thomas P. Peardon ed., Bobbs-Merrill Co. 1952) (1690)).

American jurisprudence, an axiom of the most fundamental nature, that every person is entitled to the fruit of his labors unless there are important countervailing public policy considerations. . . . [P]ersons who have long and laboriously nurtured the fruit of publicity values may be deprived of them, unless judicial recognition is given to what is here referred to as the right of publicity. . . .⁶⁷

The Supreme Court echoed this sentiment in *Zacchini*, finding that “the [publicity] interest is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors.”⁶⁸

Legal scholar Michael Madow rejects this theory contending that numerous variables contribute to the creation of fame.⁶⁹ He asserts that “a celebrity’s public image is *always* the product of a complex *social*, if not fully democratic, process in which the ‘labor’ (time, money, effort) of the celebrity herself . . . is but one ingredient, and not always the main one.”⁷⁰ In fact, it is the public, rather than the star, that is responsible for the creation and molding of the celebrity’s image.⁷¹ Fame, therefore, is a “‘relational’ phenomenon” conferred by the audience and media who consequently deserve to share in the benefits of the celebrity’s image.⁷²

2. Unjust Enrichment

The Supreme Court articulated another moral rationale: the prevention of “unjust enrichment by the theft of good will.”⁷³ Professor Harry Kalven stated that “[n]o social purpose is served by having the defendant get for free some aspect of the plaintiff that would have market value and for which he would normally pay.”⁷⁴ Thus, some have characterized free-riding violators of publicity rights as thieves or hitchhikers.⁷⁵

⁶⁷ Nimmer, *supra* note 57, at 216.

⁶⁸ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977); *see also* Uhlaender v. Henricksen, 316 F. Supp. 1277, 1282 (D. Minn. 1970) (“A celebrity *must* be considered to have invested his years of practice and competition in a public personality which eventually may reach marketable status. That identity, embodied in his name, likeness, statistics and other personal characteristics, is the fruit of his labors and is a type of property.” (emphasis added)).

⁶⁹ Madow, *supra* note 32, at 183–96.

⁷⁰ *Id.* at 195.

⁷¹ Franke, *supra* note 54, at 954.

⁷² *Id.*; Madow, *supra* note 32, at 188.

⁷³ *Zacchini*, 433 U.S. at 576.

⁷⁴ Harry Kalven, Jr., *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966).

⁷⁵ Decker, *supra* note 65, at 260 n.130; *see also* Midler v. Ford Motor Co., 849 F.2d 460, 462 (9th Cir. 1988) (describing the defendant’s conduct as being that of “the average thief”); *Onassis v. Christian Dior-N.Y., Inc.*, 472 N.Y.S.2d 254, 261 (N.Y. Sup. Ct. 1984) (“The commercial hitchhiker

The problem with this theory, like the labor theory, is that the celebrities are often “reap[ing] what they have not sown” by building upon the creations of others before them.⁷⁶ Madow argues that “[c]ultural production is *always* . . . a matter of reworking, recombining, and redeploying already-existing symbolic forms, sounds, narratives, and images.”⁷⁷ Locke would counter by arguing that a laborer may justly claim rights in the value that the transformation added—through the mixing of his or her labor—to the original property.⁷⁸ However, it would seem unjust to allow a celebrity to monopolize the value of this creation since it only entitles the laborer to the proportionate value transforming the original.⁷⁹ It follows, then, that it is illogical to prevent use of the celebrity’s image by parties other than the celebrity (e.g., the media and the public) who play a role in the creation of his or her public image when the “unauthorized commercial appropriators oftentimes *add* something of their own—some humor, artistry, or wit—to whatever they ‘take,’ and their products may service markets different from those that the celebrity herself . . . chooses to service.”⁸⁰

3. *Incentivizing Creation*

The incentive justification, espoused in *Zacchini*, states that “protection [of publicity rights] provides an economic incentive for [the performer] to make an investment required to produce a performance of interest to the public.”⁸¹ Conversely, without protecting the value in one’s identity, there would be no incentive to “expend the time, effort, and resources necessary to develop talents and produce works that ultimately benefit society as a whole.”⁸² In reference to the corresponding policy in copyright, Chief Justice Bird wrote:

[P]roviding legal protection for the economic value in one’s identity against unauthorized commercial exploitation creates a powerful incentive for expending time and resources to develop the skills or achievements prerequisite to public recognition While the immediate beneficiaries are those who establish professions or identities which are commercially valuable, the products of their enterprise are

seeking to travel on the fame of another will have to learn to pay the fare or stand on his own two feet.”).

⁷⁶ Franke, *supra* note 54, at 955.

⁷⁷ Madow, *supra* note 32, at 196.

⁷⁸ Decker, *supra* note 65, at 258 (citing JOHN LOCKE, THE SECOND TREATISE OF GOVERNMENT 26 (Thomas P. Peardon ed., Bobbs-Merrill Co. 1952) (1690)).

⁷⁹ *Id.*

⁸⁰ Madow, *supra* note 32, at 204.

⁸¹ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

⁸² Madow, *supra* note 32, at 206.

often beneficial to society generally. Their performances, inventions, and endeavors enrich our society.⁸³

Critics of this rationale simply examine how and why one becomes famous, which reveals the futility of incentives. One of the more obvious criticisms is that fame existed long before the creation of this right, which suggests that incentives do not encourage the development of valuable personas. Madow observed that people could achieve fame in ways divorced from any investment on behalf of the celebrity including “through sheer luck, through involvement in public scandal, or through criminal or grossly immoral conduct.”⁸⁴ Some athletes and entertainers seek fame for non-economic purposes like, for example, earning the respect and admiration of the public.⁸⁵ Even so, the vast majority of these famous persons are “very handsomely compensated,” while the right of publicity merely generates a “*collateral* source of income.”⁸⁶ Even a prominent athlete like LeBron James who makes more than double his player salary in endorsements each year would consider this income ancillary.⁸⁷ Thus, absent a right of publicity, there would be incentives to become famous separate from collecting royalties from licensing one’s identity.

4. *Allocative Efficiency*

This theory—a modern tragedy of the commons—dictates that “in a free market economy, granting individuals exclusive rights to property is an effective way of allocating scarce resources.”⁸⁸ Specifically, conferring a property right to the celebrity will prevent the devaluation of the commercial value in his or her identity by preventing overexploitation by the general public.⁸⁹ Richard Posner argued that publicity rights assure that advertisers who place the highest value on this exclusive license will

⁸³ *Lugosi v. Universal Pictures*, 603 P.2d 425, 441 (Cal. 1979) (Bird, C.J., dissenting) (citation omitted).

⁸⁴ Madow, *supra* note 32, at 179; see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. c (1995) (“In [some] cases the commercial value acquired by a person’s identity is largely fortuitous or otherwise unrelated to any investment made by the individual . . .”).

⁸⁵ See Franke, *supra* note 54, at 956 n.80 (“These [non-economic] incentives include the desire for fame itself, the satisfaction of realizing and exercising one’s talents, the pleasure of winning people’s applause, inspiring their love and awe, earning their respect and gratitude, and the social and status rewards that are unique to the modern celebrity.” (citing Madow, *supra* note 32, at 214)).

⁸⁶ Madow, *supra* note 32, at 209.

⁸⁷ Cf. Decker, *supra* note 65, at 263 (using the example of Tiger Woods to illustrate this point (citing Madow, *supra* note 32, at 210)).

⁸⁸ MCCARTHY, *supra* note 28, § 2:7 (citing Douglas G. Baird, *Common Law Intellectual Property and the Legacy of International News Serv. v. Associated Press*, 50 U. CHI. L. REV. 411, 414 (1983)).

⁸⁹ Richard A. Posner, *The Right of Privacy*, 12 GA. L. REV. 393, 411 (1978).

purchase that right at market price.⁹⁰ Without legal recognition of a right of publicity, no market or market price exists; rather, the person's identity becomes communal property within the public domain.⁹¹ The Fifth Circuit adopted this logic:

[I]f a well-known public figure's picture could be used freely to endorse commercial products, the value of his likeness would disappear. Creating artificial scarcity preserves the value to him, to advertisers who contract for the use of his likeness, and in the end, to consumers, who receive information from the knowledge that he is being paid to endorse the product.⁹²

This theory rests on the presumption that the value of a celebrity's name or likeness diminishes through overuse.⁹³ This may be the case in advertising after a prolonged period of overuse; however, the opposite may also prove true where consumers value a product (e.g., a Madonna T-shirt) simply because "everybody's got one."⁹⁴ This phenomenon, the cultural network effect, suggests that "a consumer's utility associated with a good increases as others also purchase it."⁹⁵

Even assuming overuse negatively affects publicity rights, the celebrity bears those costs, not society at large.⁹⁶ Unlike the tragedy of the commons, this does not involve a non-renewable natural resource; the field of potential celebrities remains abundant despite others losing the commercial value in their identity.⁹⁷ "After all, there would be no 'tragedy' in the classic parable if the herdsmen, after depleting their common pasture, could simply move on to another one."⁹⁸

5. *Personal Autonomy*

Legal scholar Alice Haemmerli advocated for the restructuring of the right of publicity under a new philosophy: Immanuel Kant's theory on

⁹⁰ See *id.* ("There is a perfectly good economic reason for assigning the property right in a photograph used for advertising purposes to the photographed individual: this assignment assures that the advertiser to whom the photograph is most valuable will purchase it.").

⁹¹ MCCARTHY, *supra* note 28, § 2:7.

⁹² *Matthews v. Wozencraft*, 15 F.3d 432, 438 (5th Cir. 1994).

⁹³ See Decker, *supra* note 65, at 264 ("The allocative efficiency argument rests on the idea that celebrity can be depleted by overuse, but, in fact, fame tends to feed on itself." (citing Madow, *supra* note 32, at 188)).

⁹⁴ Madow, *supra* note 32, at 221–22.

⁹⁵ Maureen A. O'Rourke, *Toward a Doctrine of Fair Use in Patent Law*, 100 COLUM. L. REV. 1177, 1212 (2000).

⁹⁶ Madow, *supra* note 32, at 224.

⁹⁷ Decker, *supra* note 65, at 264.

⁹⁸ Madow, *supra* note 32, at 224.

personal autonomy.⁹⁹ Freedom is the “one sole and original right that belongs to every human being by virtue of his humanity,” and it comprises “the attribute of a human being’s being his own master.”¹⁰⁰ This notion of “control and self-determination” implies an individual’s right to control the use of his or her own persona, since interference causes an infringement of the innate right of freedom.¹⁰¹

In Kant’s view, “property is inseparably associated with one’s ‘personhood’ because property grows out of freedom and freedom is essential to personhood.”¹⁰² Property is an extension of freedom; therefore, the person should have the exclusive right to use his image and control the objectification of that image as his own property.¹⁰³ Haemmerli saw Kant’s philosophy as a means to reconcile the moral and economic characteristics of the right of publicity rather than “mak[ing] a dichotomous choice between a privacy right concerned with moral injury . . . or a purely pecuniary publicity right.”¹⁰⁴

This theory seems to “enhance[] the autonomy and personality interests of one person only by harming the interests of another.”¹⁰⁵ An expansive right of publicity will inevitably chill speech, particularly expression involving the most popular celebrities since they are “the easiest to evoke without resorting to obvious means such as name, likeness, or voice.”¹⁰⁶ The Kantian approach erroneously implies that a celebrity is morally entitled to deny the public the ability to express themselves by protecting his own reciprocal interest.¹⁰⁷ Furthermore, the personal autonomy justification fails to contemplate the transition from the tort-based right of privacy to the economic right of publicity.¹⁰⁸ Legal scholars Dogan and Lemley argued that courts and scholars abandoned the human dignity rationale in favor of labor-based moral rights to allocate revenue to the celebrity for his or her commercial exploitation.¹⁰⁹

⁹⁹ Haemmerli, *supra* note 64, at 414.

¹⁰⁰ *Id.* (quoting IMMANUEL KANT, *THE METAPHYSICAL ELEMENTS OF JUSTICE* 44 (John Ladd trans. & ed., Library of Liberal Arts 1965) (1797)).

¹⁰¹ *Id.* at 416.

¹⁰² *Id.* at 418.

¹⁰³ *Id.* at 418–21.

¹⁰⁴ *Id.* at 422.

¹⁰⁵ Steven Semeraro, *Property’s End: Why Competition Policy Should Limit the Right of Publicity*, 43 CONN. L. REV. 753, 780 (2011); *see also* *White v. Samsung Elec. Am., Inc.*, 989 F.2d 1512, 1521 (9th Cir. 1993) (Kozinski, J., dissenting) (“In the name of avoiding the ‘evisceration’ of a celebrity’s rights in her image, the majority diminishes the rights of copyright holders and the public at large. In the name of fostering creativity, the majority suppresses it.”).

¹⁰⁶ *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992), *cert denied*, 508 U.S. 951 (1993).

¹⁰⁷ Semeraro, *supra* note 105, at 780.

¹⁰⁸ Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1180–81 (2006).

¹⁰⁹ Semeraro, *supra* note 105, at 781; Dogan & Lemley, *supra* note 108, at 1182.

B. *The First Amendment*

The First Amendment safeguards freedom of speech and expression in our society. Two frequently cited justifications for the First Amendment are: (1) The fostering of a “free marketplace of ideas” essential to a democratic society; and (2) “fulfill[ing] the human need for self-expression”¹¹⁰

To achieve these goals, the Supreme Court has extended the constitutional protections of the First Amendment to entertainment.¹¹¹ Justice Reed explained, “The line between the informing and the entertaining is too elusive What is one man’s amusement, teaches another’s doctrine.”¹¹² With this quote, entertainment entered the proverbial free marketplace of ideas as another form of expression. The Court has also explicitly endorsed protecting various forms of self-expression, stating, “[t]he actor on stage or screen, the artist whose creation is in oil or clay or marble, the poet whose reading public may be practically nonexistent, the musician and his musical scores . . . are [all] beneficiaries of freedom of expression.”¹¹³

The right of publicity will inevitably conflict with both of these First Amendment purposes in certain circumstances. Madow soundly points out that individuals and groups use celebrity images in their everyday lives to produce “*meanings of their own making*.”¹¹⁴ Thus, it is essential that the public be able to use the celebrity’s persona freely and creatively without the risk of censorship, or more importantly, self-censorship.¹¹⁵ Their images are “widely used—far more than are institutionally anchored elites—to symbolize individual aspirations, group identities, and cultural values.”¹¹⁶ Giving celebrities absolute control over their identities would facilitate private censorship of popular culture, inhibiting both creative processes and freedom of expression.

The sphere of protected expression shrinks significantly in the context of commercial speech, or “speech that does ‘no more than propose a

¹¹⁰ Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 66 (1994) [hereinafter “Kwall I”]. A third justification—guarding against violent societal eruptions by providing meaningful vehicles of expression—is not particularly relevant to the right of publicity. *Id.*

¹¹¹ *Winters v. New York*, 333 U.S. 507, 510 (1948).

¹¹² *Id.*

¹¹³ Kwall I, *supra* note 110, at 67 (quoting *Poe v. Ullman*, 367 U.S. 497, 514 (1961) (Douglas, J., dissenting)).

¹¹⁴ Madow, *supra* note 32, at 143.

¹¹⁵ *Id.* at 146.

¹¹⁶ Franke, *supra* note 54, at 959 (quoting Madow, *supra* note 32, at 128).

commercial transaction.”¹¹⁷ For example, the Third Circuit held that the use of a thirteen-second audio of narrator John Facenda in a half-hour “Making of Madden NFL ‘06” video was commercial speech because its sole purpose was to promote EA’s *Madden NFL ‘06* video game.¹¹⁸ While the First Amendment affords a degree of protection to commercial speech, it is significantly less than that enjoyed by political and entertaining speech.¹¹⁹ Thus, the right of publicity will, in most instances, trump an advertiser’s right to use a celebrity’s image.

However, the line between expressive and commercial speech is far from clear.¹²⁰ This confusion arises because the First Amendment “is not limited to those who publish without charge and an expressive activity does not lose its constitutional protection merely because it is undertaken for a profit.”¹²¹ Thus, expressive speech that contains commercial elements presents a problem that has plagued the variety of balancing techniques employed to resolve the struggle between the right of publicity and the First Amendment.

These doctrinal justifications provide the groundwork for balancing the right of publicity against the First Amendment. Understanding these justifications can help create a proper mechanism to resolve the tension between these doctrines—a task that lower courts have struggled with due to the lack of guidance from one particular Supreme Court case.

IV. PRE-GAME WARM-UP: ESTABLISHED FIRST AMENDMENT BALANCING TESTS

A. *Zacchini & “The Entire Act” Standard*

Zacchini v. Scripps-Howard Broadcasting Co., the only Supreme Court case addressing the right of publicity,¹²² involved a local television station that recorded a human cannonball’s entire act without his

¹¹⁷ *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council*, 425 U.S. 748, 771–72 n.24 (1976) (quoting *Pittsburgh Press Co. v. Pittsburgh Comm’n Human Relations*, 413 U.S. 376, 385 (1973)).

¹¹⁸ *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1015–18 (3d Cir. 2008).

¹¹⁹ *Kwall I*, *supra* note 110, at 68. False or misleading commercial speech is afforded no protection. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of New York*, 447 U.S. 557, 563–64 (1980); *see also id.* at 561–62 (“Commercial expression not only serves the economic interest of the speaker, but also assists consumers and furthers the societal interest in the fullest possible dissemination of information.”).

¹²⁰ *See Franke*, *supra* note 54, at 960 (noting that “the fact that a lot of expressive speech contains commercial elements” creates a great deal of confusion).

¹²¹ *Id.* (citing *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 459 (Cal. 1979)); *see also Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307, 315 (Cal. Ct. App. 2001) (explaining that profit motive alone does not make speech “commercial”).

¹²² *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 775 (D.N.J. 2011).

permission and broadcast it on the evening news.¹²³ Zacchini claimed a misappropriation of his act while the television station claimed First Amendment protection for the news broadcast.¹²⁴ To begin, the Court explicitly recognized a right of publicity as a separate cause of action from the right of privacy.¹²⁵ The Court added:

The rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.¹²⁶

Although the Court recognized this right, it was seemingly at odds with free speech considerations. Even so, the Supreme Court held that Zacchini's interest in protecting the economic value of his "entire act" outweighed the television station's First Amendment prerogative to disseminate newsworthy information.¹²⁷ The Court attempted to apply a balancing test; however, the decision failed to provide guidance for lower courts to apply the test in the future.¹²⁸ The Court stated, "Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent."¹²⁹

Many courts have attempted to limit *Zacchini's* application to its facts; particularly where a defendant appropriates a performer's entire act, courts find a violation of the right of publicity without engaging in any balancing with the First Amendment.¹³⁰ Thus, while many have overanalyzed *Zacchini* over the years, no test has effectively resolved the conflict

¹²³ 433 U.S. 562, 563–64 (1977).

¹²⁴ *Id.* at 564.

¹²⁵ *Id.* at 573.

¹²⁶ *Id.* at 576 (alteration in original) (quoting Kalven, *supra* note 74, at 331).

¹²⁷ *Id.* at 575.

¹²⁸ Lower courts have analyzed *Zacchini* as employing a balancing test weighing the right of publicity and the First Amendment. See *C.B.C. Distrib. & Mktg. Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 823 (8th Cir. 2007) ("The Supreme Court [in *Zacchini*] has directed that state law rights of publicity must be balanced against first amendment considerations." (citing 433 U.S. at 562)).

¹²⁹ *Zacchini*, 433 U.S. at 574–75.

¹³⁰ *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 775 (D.N.J. 2011); see, e.g., *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 956 (6th Cir. 2003) ("*Zacchini* has been criticized as being very 'narrowly drawn' in that it involved the wholesale reproduction of a live 'entire act.'"). The decision may even suggest that *Zacchini* applies only to performances, rather than the misappropriation of one's identity. See *Zacchini*, 433 U.S. at 576 ("[T]his case . . . involv[es], not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.").

between the First Amendment and the right of publicity.¹³¹

Despite the lack of guidance from *Zacchini*, lower courts and scholars have attempted to devise tests to perfect the balance of these two rights.¹³² To date, there are at least five different approaches: (1) fair use; (2) the transformative use test; (3) the predominant use test; (4) the *Restatement* approach; and (5) general ad hoc balancing.

B. *The Fair Use Defense*

Several commentators have advocated the adoption of a modified version of copyright's "fair use" test to analyze First Amendment defenses in right of publicity cases.¹³³ Defendants in copyright suits often assert a "fair use"¹³⁴ of the copyrighted material, or "a privilege in others than the owner of a copyright to use the copyrighted material in a reasonable manner without his consent, notwithstanding the monopoly granted to the [owner of the copyright.]"¹³⁵

The fair use doctrine drew criticism as "the most troublesome in the whole law of copyright"¹³⁶ and "entirely equitable and . . . so flexible as virtually to defy definition."¹³⁷ Nonetheless, the doctrine has produced general agreement about which factors apply and how to weigh such factors.¹³⁸ Although fair use has posed issues in close cases, courts have little difficulty applying it in the majority of cases, and "there is sufficient consensus about the parameters of fair use to give rise to scholarly scoldings when courts on occasion misuse the doctrine."¹³⁹

¹³¹ Roberta Rosenthal Kwall, *A Perspective on Human Dignity, the First Amendment, and the Right of Publicity*, 50 B.C. L. REV. 1345, 1356–57 (2009) [hereinafter "Kwall II"]. Even Justice Powell, in dissent, recognized that the "entire act" standard had little precedential value for application to future publicity cases. *Zacchini*, 433 U.S. at 579 n.1 (Powell, J., dissenting).

¹³² Kwall II, *supra* note 131, at 1357.

¹³³ See, e.g., Haemmerli, *supra* note 64, at 466 (advocating that application of a fair use test to the right of publicity "is a sound idea" despite differences between copyright and publicity rights); Randall T.E. Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781, 815–20 (1988) (applying a modified fair use doctrine to right of publicity cases to promote the twin policies underlying that right: promoting creativity and preventing unjust enrichment); Pamela Samuelson, *Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 TUL. L. REV. 836, 915 (1983) (delineating a modified fair use standard applicable to right of publicity cases); Douglas G. Baird, Note, *Human Cannonballs and the First Amendment: Zacchini v. Scripps-Howard Broadcasting Co.*, 30 STAN. L. REV. 1185, 1206 (1978) ("Accommodation of the competing interests of the press and performers requires a tool of mediation analogous to fair use.").

¹³⁴ See 17 U.S.C. § 107 (2006).

¹³⁵ Samuelson, *supra* note 133, at 884 (alteration in original) (citing HORACE G. BALL, *THE LAW OF COPYRIGHT AND LITERARY PROPERTY* 260 (1944)).

¹³⁶ *Id.* at 885 (quoting *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661, 662 (2d Cir. 1939)).

¹³⁷ *Id.* (quoting *Time, Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 144 (S.D.N.Y. 1968)).

¹³⁸ *Id.*

¹³⁹ *Id.* Cf. Douglas J. Ellis, Comment, *The Right of Publicity and the First Amendment: A Comment on Why Celebrity Parodies Are Fair Game for Fair Use*, 64 U. CIN. L. REV. 575, 612 (1996)

Samuelson urged the application of a two-tiered fair use test based on a broad interpretation of *Zacchini*'s holding.¹⁴⁰ The first step assesses the "substantiality of the property interest" and the "degree of impairment . . . from the appropriation of the right."¹⁴¹ In doing so, the factors to consider would include:

1. The purpose and character of the appropriator's use of the publicity right, including whether such use is of a commercial nature or is for non-profit purposes;
2. The nature of the asserted publicity right;
3. The amount and substantiality of the appropriation of the publicity right by the defendant; and
4. The effect of the defendant's appropriation upon the potential market for or value of the publicity right.¹⁴²

If, upon application of these factors, fair use is not established, the presumption is that the First Amendment does not outweigh the "impingement on a substantial property right."¹⁴³ However, "this presumption could be overcome by proof that access to the protected matter was necessary to achieve the dissemination of information and public debate objectives which underlie the [F]irst [A]mendment."¹⁴⁴ Haemmerli reformulated this second step to ask whether "access is necessary as a matter of artistic expression to permit individuals and groups to 'play with' meaning and to come up with new ways of recoding cultural icons, or whether these needs can be satisfactorily fulfilled in alternative ways without invading conflicting property rights."¹⁴⁵ In other words, "Is the use necessary to achieve the public information, public discourse, or self-realization goals that underlie the First Amendment?"¹⁴⁶

Many disapproved of these proposals to adopt a modified fair use test. At the most basic level, the assumption that fair use internally accommodates copyright to the First Amendment may be erroneous.¹⁴⁷

("Despite a certain amount of ambiguity in its factors and the tendency of courts to misapply them, copyright's fair use doctrine provides a relatively stable and succinct method of analysis for parody defenses to the right of publicity.")

¹⁴⁰ Samuelson, *supra* note 133, at 858, 915–16.

¹⁴¹ *Id.* at 915.

¹⁴² *Id.*

¹⁴³ *Id.* at 916.

¹⁴⁴ *Id.*

¹⁴⁵ Haemmerli, *supra* note 64, at 471 (internal quotation marks omitted).

¹⁴⁶ Franke, *supra* note 54, at 969 (quoting Haemmerli, *supra* note 64, at 471).

¹⁴⁷ The Supreme Court has suggested that the idea/expression dichotomy actually balances copyright and free speech interests. *See, e.g., Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985) (noting that the idea/expression dichotomy "strike[s] a definitional balance

Additionally, the test, formulated for copyright law, fails to address an important rationale of the right of publicity grounded in trademark law, consumer protection.¹⁴⁸ No court has adopted this test, and one has even rejected a wholesale importation of fair use into the right of publicity.¹⁴⁹

C. *The Transformative Use Test*

Though many disfavored using a blanket copyright fair use test, courts have used the first fair use factor, “the purpose and character of the use,” in right of publicity cases.¹⁵⁰ The transformative use test weighs First Amendment protection for expression against a person’s right of publicity by determining “whether the [person’s] likeness is one of the ‘raw materials’ from which an original work is synthesized, or whether the depiction or imitation of the [person] is the very sum and substance of the work in question.”¹⁵¹

The Supreme Court of California first articulated the transformative use test in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*¹⁵² In this case, the plaintiff, owner of all rights associated with “The Three Stooges,” sought damages and injunctive relief for the reproduction of the comedians on charcoal drawings and lithographs.¹⁵³ In applying the test, the court reasoned that:

When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist. . . . [However], when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity.¹⁵⁴

The court concluded that the Three Stooges’ likenesses was not “one of the ‘raw materials’ from which [the] original work [was] synthesized,” but

between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author’s expression” (quoting 723 F.2d 195, 203 (2d Cir. 1983)).

¹⁴⁸ Kwall I, *supra* note 110, at 61.

¹⁴⁹ *See, e.g.,* *Cardtoons v. Major League Baseball Players Ass’n*, 95 F.3d 959, 964, 972 (10th Cir. 1996) (rejecting the district court’s use of the entire copyright fair use defense in favor of balancing the right of publicity against the First Amendment).

¹⁵⁰ *Comedy III Prods., Inc. v. Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001).

¹⁵¹ *Id.* at 809.

¹⁵² *Id.*

¹⁵³ *Id.* at 800.

¹⁵⁴ *Id.* at 808 (footnote omitted).

rather “the very sum and substance of the work,” in violation of their rights of publicity.¹⁵⁵

The Ninth Circuit observed that decisions applying the transformative use test represent a spectrum; on one end, *Comedy III* represents a blatant infringement, and on the other, *Winter v. DC Comics*¹⁵⁶ represents a substantial transformation.¹⁵⁷ In this case, the comic book “Jonah Hex” depicted well-known musicians, Johnny and Edgar Winter, as villainous half-worm, half-human offspring that bore their distinctive pale faces and long white hair.¹⁵⁸ After stating that the application of the test was “not difficult,”¹⁵⁹ the court concluded that the comic book characters were not “conventional depictions,” but contained “significant expressive content” beyond mere reproductions of the plaintiffs’ likenesses.¹⁶⁰

Somewhere in the middle of this spectrum falls *ETW Corp. v. Jireh Publishing, Inc.*¹⁶¹ In this case, Tiger Woods’s licensing agent sued artist Rick Rush for creating and selling a painting featuring Woods’s likeness celebrating victory at the 1997 Masters Tournament in Augusta, Georgia.¹⁶² The painting also included a panorama of golf legends, including Arnold Palmer and Jack Nicklaus, in the background observing Woods’s triumph.¹⁶³ The Sixth Circuit emphasized that the painting did not “capitalize solely on a literal depiction of Woods” because the artist added “a significant creative component of his own to Woods’s identity.”¹⁶⁴ The emphasis was not on the reproduction of Woods, but rather the transformative “message that Woods himself will someday join that revered group” of legendary golfers,¹⁶⁵ which entitled it to the full protection of the First Amendment.¹⁶⁶

Two cases applying the transformative use test to video games were particularly informative in the *Keller* and *Hart* decisions.¹⁶⁷ In *Kirby v. Sega of America, Inc.*,¹⁶⁸ the California Court of Appeals held that a video

¹⁵⁵ *Id.* at 809.

¹⁵⁶ 69 P.3d 473 (Cal. 2003).

¹⁵⁷ *Hilton v. Hallmark Cards*, 580 F.3d 874, 890 (9th Cir. 2009).

¹⁵⁸ *Winter*, 69 P.3d at 476.

¹⁵⁹ *Id.* at 479.

¹⁶⁰ *Id.* Cf. *Mine O’Mine, Inc. v. Calmese*, No. 2:10-CV-00043-KJD-PAL, 2011 U.S. Dist. LEXIS 75236, at *23 (D. Nev. July 12, 2011) (finding the character “Shaqtus”—a half-human, half-cactus cartoon of basketball star Shaquille O’Neal—to be just as sufficiently transformative as the cartoon images of the Winter brothers).

¹⁶¹ 332 F.3d 915 (6th Cir. 2003).

¹⁶² *Id.* at 918.

¹⁶³ *Id.*

¹⁶⁴ *Id.* at 938.

¹⁶⁵ *Id.* at 936.

¹⁶⁶ *Id.* at 938.

¹⁶⁷ See *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 782 (D.N.J. 2011) (asserting that *Kirby* and *No Doubt* are instructive in that both applied the transformative use test in the video game context).

¹⁶⁸ 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006).

game character fashioned after a celebrity singer's appearance and style was sufficiently transformative for full free speech protection.¹⁶⁹ Kirby was a 1990s singer known for the phrase "ooh la la," which also resembled the name of the alleged character imitation, "Ulala."¹⁷⁰ Also, like Kirby, the character wore platform shoes, had similar facial features and hair color, and wore attire like that worn by the singer.¹⁷¹ However, Ulala differed from Kirby in physique based, in part, on the use of the Japanese-style animation form of anime.¹⁷² The court also noted that the setting for the game, a twenty-fifth century space age, and her corresponding futuristic occupation as a space-reporter were unique; and altogether, it amounted to a sufficient transformation.¹⁷³

In the second case, the rock-band *No Doubt* sued the developer of the *Band Hero* video game for exceeding the bounds of the parties' licensing agreement.¹⁷⁴ *Band Hero* included avatars designed to resemble the band members' likenesses with great detail.¹⁷⁵ Ruling in favor of *No Doubt*, the court held that the game was not transformative, reasoning that:

[The developer] intentionally used . . . literal reproductions, so that players could choose to "be" the No Doubt rock stars. The game does not permit players to alter the No Doubt avatars in any respect; they remain at all times immutable images of the real celebrity musicians¹⁷⁶

The court further noted that these avatars are unlike the character in *Kirby* because the avatars were not "fanciful, creative characters."¹⁷⁷

The transformative use test has earned a fair amount of critics since its inception.¹⁷⁸ Eugene Volokh criticized *Comedy III's* varying definitions of transformation, which borrowed language from copyright law and fair

¹⁶⁹ *Id.* at 617.

¹⁷⁰ *Id.* at 609–10.

¹⁷¹ *Id.* at 610–11.

¹⁷² *Id.* at 616.

¹⁷³ *Id.* at 610; *see also id.* at 618 ("As in *Winter*, Ulala is a 'fanciful, creative character' who exists in the context of a unique and expressive video game. Similar facts distinguished *Winter* from *Comedy III*, and the same distinction applies here. [Respondents'] portrayal of Ulala is protected by the First Amendment." (quoting the trial court)).

¹⁷⁴ *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 401 (Cal. Ct. App. 2011).

¹⁷⁵ *Id.*

¹⁷⁶ *Id.* at 409–10.

¹⁷⁷ *Id.* at 410.

¹⁷⁸ *See, e.g.*, Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 493 (2003) (noting that the transformative use test has proven to be problematic); Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903, 914–25 (2003) (engaging in a detailed analysis of the problems with the transformative use test); Schuyler M. Moore, *Sex, Lies, and Videotape: The First Amendment vs. the Right of Publicity for Expressive Works*, 25 ENT. L. REP., Nov. 2003, at 8–10 (enumerating several arguments that prove the transformative use test unworkable).

use.¹⁷⁹ Even the *Comedy III* court called the distinction between protected and unprotected expression “subtle,” providing a vague standard with little predictive value.¹⁸⁰ Another critic, Schuyler Moore, even questioned the logic and First Amendment rationale behind justifying protection for “transformative” works, but not “non-transformative” works.¹⁸¹ Despite these criticisms, both district courts found this test appropriate to apply in *Keller* and *Hart*.

D. *The Predominant Use Test*

In *Doe v. TCI Cablevision*,¹⁸² the Supreme Court of Missouri rejected the transformative use test in favor of a “more balanced balancing test.”¹⁸³ The test states:

If a product is being sold that predominantly exploits the commercial value of an individual’s identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some “expressive” content in it that might qualify as “speech” in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.¹⁸⁴

A former hockey player, Anthony “Tony” Twist, sued Todd McFarlane, the creator of the *Spawn* comic series, for the improper use of his name and likeness.¹⁸⁵ McFarlane named a mafia don in his comic series “Anthony ‘Tony Twist’ Twistelli,” but the character bore no resemblance to the hockey player aside from the name and “reputation as a tough-guy enforcer.”¹⁸⁶ Despite these dissimilarities, the court held that “the use and identity of Twist’s name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression”¹⁸⁷

The problem with this test is evident; how does one distinguish between a predominantly commercial or expressive purpose “when the two go hand in hand?”¹⁸⁸ Mark Lee, the creator of the predominant use test,

¹⁷⁹ Volokh, *supra* note 177, at 916–17.

¹⁸⁰ *Comedy III Prods., Inc. v. Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001).

¹⁸¹ Moore, *supra* note 177, at 10.

¹⁸² 110 S.W.3d 363 (Mo. 2003) (en banc).

¹⁸³ *Id.* at 374.

¹⁸⁴ *Id.* (citing Lee, *supra* note 177, at 500).

¹⁸⁵ *Id.* at 365.

¹⁸⁶ *Id.* at 365–66.

¹⁸⁷ *Id.* at 374.

¹⁸⁸ Moore, *supra* note 177, at 13.

suggested that other judicial approaches like the “merchandise v. media” distinction,¹⁸⁹ the “alternative means” test,¹⁹⁰ the Restatement’s “unrelatedness” test,¹⁹¹ and the “transformative use” test¹⁹² could assist in determining whether the predominant purpose is exploitative or expressive.¹⁹³ However, even Lee concedes that these various approaches are “individually unsatisfying or incomplete,”¹⁹⁴ so it is questionable why they should guide the analysis of a more comprehensive approach.¹⁹⁵

Perhaps even more disconcerting is the test’s reliance on commercial success. Lee’s example reveals this defect: “If people buy a picture of Tiger Woods predominantly because they like Tiger Woods, rather than because they are attracted to the composition of the picture, that picture should be deemed to violate Tiger Woods’s right of publicity.”¹⁹⁶ The Tiger Woods example illustrates that “if [a] product receives commercial success *because of* the individual’s identity, that is the end of the analysis and the First Amendment is not available.”¹⁹⁷ Such a test would chill artistic endeavors and free speech, especially for works that include very famous celebrities or athletes that would garner commercial success regardless of the amount of expression.

E. *The Restatement Approach*

The *Third Restatement of Unfair Competition* provides that “if the name or likeness is used solely to attract attention to a work that is not related to the identified person, the user may be subject to liability for a use of the other’s identity in advertising.”¹⁹⁸ Also known as the “relatedness”

¹⁸⁹ See Lee, *supra* note 177, at 500 (“For example, the ‘merchandise v. media’ [distinction] can be a practical shortcut to quickly resolve the issue in many circumstances. While one could argue that a bumper sticker, swizzle stick, bobblehead doll, or poster includes some expressive content, most often they predominately are intended to capitalize on the commercial value of an individual’s identity . . .”).

¹⁹⁰ See *id.* at 500–01 (“The ‘alternative means’ test can also help a court assess whether publicity rights are being exploited by determining whether the taking of intellectual property could have been avoided in the first place. An unnecessary use is more likely to be an exploitive, and hence actionable, use of the publicity right.”).

¹⁹¹ See *id.* at 501 (“The Restatement’s ‘unrelatedness’ test can also help evaluate whether use of an individual’s identity in a work of expression is appropriate by helping to assess whether the use was intended to make a genuine comment about or merely to exploit the goodwill of the celebrity.”).

¹⁹² See *id.* (“[T]he California Supreme Court’s [transformative use] test can help to determine whether the use is primarily exploitative or communicative by encouraging judicial focus on the nature of the use.”).

¹⁹³ Franke, *supra* note 54, at 975 (citing Lee, *supra* note 177, at 500–01).

¹⁹⁴ Lee, *supra* note 177, at 500.

¹⁹⁵ See Franke, *supra* note 54, at 975–76 (noting the pitfalls of the “merchandise v. media” distinction, the “alternative means” test, and the *Restatement* approach).

¹⁹⁶ Lee, *supra* note 177, at 500.

¹⁹⁷ Franke, *supra* note 54, at 976.

¹⁹⁸ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (1995).

test, it essentially “protects the use of another person’s name or identity in a work that is ‘related to’ that person.”¹⁹⁹ The scope of “related uses” is broad, including:

[T]he use of a person’s name or likeness in news reporting . . . use in entertainment and other creative works, including both fiction and nonfiction . . . [use] as part of an article published in a fan magazine or in a feature story broadcast on an entertainment program . . . dissemination of an unauthorized print or broadcast biography . . . [and u]se of another’s identity in a novel, play or motion picture . . .²⁰⁰

This approach, while attempting to distinguish between expressive and commercial speech, fails to consider that many uses of a person’s identity are both expressive and commercial.²⁰¹ Though these tests purport to balance the right of publicity and First Amendment, the inquiry ends once the use is determined to be expressive.²⁰² For this reason, many courts have applied the transformative use or predominant use test as a better balancing mechanism.

F. *Ad Hoc Balancing*

The least structured approach involves a “case-by-case weighing of competing values and interests to determine whether ‘speech’ in a particular case is deserving of constitutional immunity from legal liability.”²⁰³ The Tenth Circuit was the first to employ such an analysis in *Cardtoons, L.C. v. Major League Baseball Players Association*.²⁰⁴ The court held that Cardtoons’ rights to produce and sell parody baseball trading cards outweighed the baseball players’ rights of publicity.²⁰⁵ Judge Tacha balanced these rights by weighing the “importance of Cardtoons’ right to free expression and the consequences of limiting that right” against “the effect of infringing on MLBPA’s right of publicity.”²⁰⁶

More recently, the Eighth Circuit applied the ad hoc balancing test in *C.B.C. Distribution & Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*²⁰⁷ C.B.C. sought declaratory judgment that it had a right to use the names and statistics of major league baseball players in its fantasy

¹⁹⁹ *Doe v. TCI Cablevision*, 110 S.W.3d 363, 373 (Mo. 2003) (en banc).

²⁰⁰ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (1995).

²⁰¹ *Doe*, 110 S.W.3d at 374.

²⁰² *Id.*

²⁰³ MCCARTHY, *supra* note 28, § 8.23.

²⁰⁴ 95 F.3d 959, 972 (10th Cir. 1996).

²⁰⁵ *Id.* at 976.

²⁰⁶ *Id.* at 972.

²⁰⁷ 505 F.3d 818 (8th Cir. 2007).

sports products.²⁰⁸ Advanced Media, a competing fantasy sports provider, filed a counterclaim arguing that this violated the players' rights of publicity, to which it had obtained a license.²⁰⁹ The court held that C.B.C.'s First Amendment rights in offering its fantasy baseball products superseded the players' right of publicity.²¹⁰

McCarthy pejoratively characterized this as an "I know it when I see it" approach.²¹¹ Furthermore, "there is no rule to be applied, there is only unrestrained and unpredictable judicial balancing of competing values."²¹² This approach has not secured widespread application despite its basic balancing of a commercial right to one's identity against freedom of expression.

The myriad tests fail to give courts a principled and consistent method of resolving the frequent interaction of the right of publicity and the First Amendment. The lack of uniformity creates difficulty in counseling clients, fails to provide predictable standards, and promotes forum shopping. Most troubling, however, are the inconsistent results exemplified by the *Keller* and *Hart* opinions.

V. THE PUBLICITY BOWL:
KELLER AND THE RIGHT OF PUBLICITY VERSUS
HART AND THE FIRST AMENDMENT

Keller and *Hart* demonstrate that the balancing of the right of the publicity and the First Amendment—even when considering the same medium—can produce contrary results. In both cases, former college football players sued the same video game manufacturer alleging nearly identical facts. These cases substantiate the need to create a uniform, unambiguous standard to protect the right of publicity while maintaining a robust public domain.

A. *Keller v. Electronic Arts, Inc.*

In 2010, Samuel Keller, a former quarterback for both Arizona State University and the University of Nebraska, filed a lawsuit against EA, the

²⁰⁸ *Id.* at 820.

²⁰⁹ *Id.*

²¹⁰ *Id.* at 824. The court relied on a number of factors including: (1) the information CBC used was already in the public domain; (2) courts have "recognized the public value of information about the game of baseball and its players"; and (3) the economic interests of the players was not nearly as strong since they already receive a great deal of compensation. *Kwall II*, *supra* note 131, at 1362 n.111 (citing *C.B.C. Distribution & Marketing*, 505 F.3d at 823–24).

²¹¹ MCCARTHY, *supra* note 28, § 8.23 (internal quotation marks omitted).

²¹² *Id.*

NCAA, and the CLC in the Northern District of California.²¹³ Sam Keller graduated from San Ramon High in 2003 as the ninth-best quarterback prospect in the nation.²¹⁴ After three years at Arizona State, Keller transferred to Nebraska where he set the school's single-season records for completion percentage (63.1%) and passing yards per game (269.1).²¹⁵ Like many before him,²¹⁶ Keller had a brief stint in the NFL; he was waived less than a month after signing with the Oakland Raiders.²¹⁷

EA develops interactive entertainment software including the *NCAA Football* series of video games.²¹⁸ *NCAA Football* allows consumers to simulate football games between more than 120 NCAA teams.²¹⁹ Keller alleged that, "to make the games realistic, EA designs the virtual football players to resemble real-life college football athletes, including himself."²²⁰ These virtual players share "the same jersey numbers," the "same home state," the same "physical characteristics" (including height and weight), and play the same positions as their real-life counterparts.²²¹ Although EA omits the athletes' names from the game, consumers may simply download team rosters and upload them into the game with ease.²²²

Keller alleged that EA and the NCAA violated his common law, California,²²³ and Indiana²²⁴ rights of publicity.²²⁵ He also alleged that the NCAA and CLC conspired to facilitate this unauthorized use of his likeness during a meeting with EA to negotiate agreements involving the

²¹³ Keller v. Elec. Arts, Inc., No. C 09-1967 CW, 2010 WL 530108, at *1-2 (N.D. Cal. Feb. 8, 2010).

²¹⁴ *Player Bio: Sam Keller*, HUSKERS.COM, http://www.huskers.com/ViewArticle.dbml?DB_OE_M_ID=100&ATCLID=866801 (last visited Mar. 13, 2013).

²¹⁵ *Id.*

²¹⁶ See *NFL Hopeful FAQs: How Long Do Most NFL Careers Last?*, NFL PLAYERS ASS'N., <https://www.nflplayers.com/About-us/FAQs/NFL-Hopeful-FAQs/> (last visited Mar. 13, 2013) ("The average length of an NFL career is about 3 and a half seasons. . . . Players leave the game because of injury, self-induced retirement, or being cut by the team.")

²¹⁷ ASSOCIATED PRESS, *Raiders Sign Rookie QB Keller, Waive QB Meyer*, NFL.COM (June 25, 2008, 7:45 PM), <http://www.nfl.com/news/story/09000d5d80902d4c/article/raiders-sign-rookie-qb-keller-waive-qb-meyer>; *Transactions: 2008-2009*, NFLHUSKERS.COM, <http://nflhuskers.com/transactions0809.html> (last visited Mar. 13, 2013).

²¹⁸ Keller v. Elec. Arts, Inc., No. C 09-1967 CW, 2010 WL 530108, at *1 (N.D. Cal. Feb. 8, 2010); see also Hart v. Elec. Arts, Inc., 808 F. Supp. 2d 757, 760 (D.N.J. 2011) (noting that there are over 100 college football teams in *NCAA Football*).

²¹⁹ *Id.*

²²⁰ *Id.*

²²¹ *Id.*; see also *id.* ("To enhance the accuracy of the player depictions, [Keller] alleges, EA sends questionnaires to team equipment managers of college football teams.")

²²² *Id.*

²²³ CAL. CIV. CODE § 3344(a) (West 2012).

²²⁴ IND. CODE § 32-36-1-8 (2012).

²²⁵ See *Keller*, 2010 WL 530108, at *1-2 (noting that EA is a Delaware corporation with its principal place of business in California and that NCAA's headquarters are located in Indiana).

NCAA Football video game.²²⁶

The court first listed the elements of a common law right of publicity claim: “(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.”²²⁷ Invoking the transformative use test, the court stated that a work is “protected by the First Amendment inasmuch as it contains significant transformative elements or that the value of the work does not derive primarily from the celebrity’s fame.”²²⁸

Relying heavily upon *Comedy III*, the court described the main inquiry as:

[W]hether the celebrity likeness is one of the “raw materials” from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness. And when we use the word “expression,” we mean expression of something other than the likeness of the celebrity.²²⁹

As discussed above,²³⁰ the court then recognized two California Supreme Court cases that “bookend the spectrum’ used to measure a work’s transformative nature.”²³¹ At one end, *Comedy III* provides an example of a non-transformative work, while *Winter* offers the opposite end finding a sufficient transformation.²³² Using these two cases as guideposts, the court used *Kirby* as a middling example of the transformative use test applied to a video game.²³³

Considering this precedent, the court held that the depiction of Keller was not sufficiently transformative to provide First Amendment protection.²³⁴ The court reasoned that Keller “is represented as what he was: the starting quarterback for Arizona State” with the “same jersey number, . . . the same height and weight and hail[ing] from the same

²²⁶ *Id.*

²²⁷ *Id.* at *3 (quoting *Hilton v. Hallmark Cards*, 580 F.3d 874, 889 (9th Cir. 2009) (internal quotation marks omitted)). “Although the statutory and common law rights are similar . . . to state a claim under section 3344, a plaintiff must prove knowing use in addition to satisfying the elements of a common law claim.” *Id.*

²²⁸ *Id.* (quoting *Hilton*, 580 F.3d at 889) (internal quotation marks omitted).

²²⁹ *Id.* at *4 (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001)).

²³⁰ See *supra* Part IV.C.

²³¹ *Keller*, 2010 WL 530108, at *4 (quoting *Hilton*, 580 F.3d at 890–91).

²³² *Id.*

²³³ *Id.*

²³⁴ *Id.* at *5.

state.”²³⁵ Furthermore, unlike in *Kirby*, “the game’s setting is identical to where the public found [Keller] during his collegiate career: on the football field.”²³⁶

Most importantly, the court rejected EA’s assertion “that the video game, taken as a whole, contains transformative elements.”²³⁷ Recognizing that precedent did not support this argument, the court added:

In *Winter*, the court focused on the depictions of the plaintiffs, not the content of the other portions of the comic book. The court in *Kirby* did the same: it compared Ulala with the plaintiff; its analysis did not extend beyond the game’s elements unrelated to Ulala. These cases show that this [c]ourt’s focus must be on the depiction of [Keller] in “NCAA Football,” not the game’s other elements.²³⁸

As of the writing of this Note, EA’s appeal to the Ninth Circuit is still pending.²³⁹

B. Hart v. Electronic Arts, Inc.

Alleging very similar facts, Ryan Hart, a former Rutgers University quarterback, brought a putative class action suit against EA in the District of New Jersey.²⁴⁰ Hart alleged unauthorized use of his likeness in *NCAA Football 2004*, *2005*, *2006*, and *2009*, in violation of his common law right of publicity.²⁴¹ With respect to *NCAA Football 2006*, Hart had identical allegations to Keller about the realistic portrayal of the virtual players.²⁴² However, Hart added that the virtual players had identical accessories, including a left wristband and helmet visor, and player ratings that reflected actual footage of him during his 2005 college season.²⁴³

EA filed a motion for summary judgment claiming that the First Amendment bars Hart’s right of publicity claim because the *NCAA Football* video games constitute protected expressive works.²⁴⁴ Hart disagreed, contending that the game signified speech made for commercial

²³⁵ *Id.*

²³⁶ *Id.*

²³⁷ *Id.*

²³⁸ *Id.*

²³⁹ See *Davis v. Elec. Arts, Inc.*, No. 10–03328 RS, 2012 WL 3860819, at *5 n.6 (N.D. Cal. Mar. 29, 2012) (stating that EA’s appeal was argued and submitted to the Ninth Circuit in February of 2011, but a decision has yet to come down).

²⁴⁰ *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 760 (D.N.J. 2011).

²⁴¹ *Id.* at 763.

²⁴² See *supra* Part V.A (stating that the virtual players had identical jersey numbers, home states, physical attributes, and positions, and that users could download player names and upload them into the game).

²⁴³ *Hart*, 808 F. Supp. 2d at 763.

²⁴⁴ *Id.* at 768.

purposes.²⁴⁵

The court began its First Amendment analysis by confirming that the NCAA Football video game was entitled to the same protections afforded to other expressive works.²⁴⁶ The next threshold question was whether NCAA Football constituted commercial speech under the Third Circuit's three-factor test from *Facenda*.²⁴⁷ The court concluded that, unlike the *Madden NFL '06* infomercial at issue in *Facenda*, Hart alleged that the expressive content of the game itself violated his right of publicity.²⁴⁸

The court then acknowledged that the Third Circuit had not adopted a particular test for balancing the right of publicity and First Amendment, but decided to analyze the case under the transformative use test.²⁴⁹ Judge Wolfson engaged in a lengthy discussion of the history and criticisms of copyright fair use from which the transformative use test derives.²⁵⁰

The court credited California state court decisions with developing the transformative use doctrine in right of publicity cases.²⁵¹ Thus, *Comedy III* informed the analysis of competing publicity and free speech interests.²⁵² However, unlike *Keller*, the court compared Hart's case to two particularly instructive decisions: *Kirby* and *No Doubt*.²⁵³ In contrast to the transformative Ulala in *Kirby*, the avatars in *No Doubt* were unalterable replicas of the band members.²⁵⁴ Moreover, unlike the immutable band members in *No Doubt*, a user may alter Hart's image in *NCAA Football* in

²⁴⁵ *Id.*

²⁴⁶ *Id.* at 771; *see also* *Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729, 2733 (2011) ("Like the protected books, plays and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices . . . and through features distinctive to the medium . . . [t]hat suffices to confer First Amendment protection.").

²⁴⁷ *Hart*, 808 F. Supp. 2d at 770 (citing *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1017–18 (3d Cir. 2008)).

²⁴⁸ *Id.*

²⁴⁹ *Id.* at 776–77. The court also considered applying the "Rogers test," an analysis devised by the Second Circuit in a trademark law case; however, Judge Wolfson clearly preferred the transformative use test as a "more refined" approach that "better balances the competing interests of the right of publicity and the First Amendment." *Id.* at 776, 787–88. Furthermore, he questioned "the wisdom of applying a trade-mark-based test to right of publicity claims without accounting for" the different concerns of the regimes. *Id.* at 791. Despite the issues with the *Rogers* test, the court felt no need to adopt either since EA's First Amendment defense prevailed under both tests. *Id.* at 777.

²⁵⁰ Judge Pierre N. Leval coined "transformative use" in 1990, arguing "the fair use doctrine is best effectuated if individuals are permitted to appropriate another's expression as 'raw material' that the individual then 'transform[s] in the creation of new information, new aesthetics, new insights and understandings.'" *Id.* at 778 (quoting Pierre N. Leval, Commentary, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990)). Just four years following the publishing of Judge Leval's article, the Supreme Court adopted the test in *Campbell v. Acuff-Rose Music, Inc.* *Id.*

²⁵¹ *Id.*

²⁵² *Id.* at 779.

²⁵³ *Id.* at 782.

²⁵⁴ *Id.* at 783.

many ways by editing his “personal characteristics,”²⁵⁵ “accessories,” “physical abilities,” “attributes and certain biographical details.”²⁵⁶

Despite the ability to alter his likeness, this case provided a “closer call than that in *Kirby* and *No Doubt*” since placing Hart into an *NCAA Football* game—the setting where the public recognizes him—“strongly suggests that the goal of the game is to capitalize upon the fame of those players.”²⁵⁷ In rejecting this argument, the court used language from the Supreme Court to recognize that “features distinctive to [video games]” include the player’s interaction with the virtual world by which it conveys ideas and social messages.²⁵⁸ Thus, the court held that under the transformative use test, EA was entitled to assert the First Amendment defense to Hart’s appropriation claim.²⁵⁹

Before moving on, Judge Wolfson addressed the California court’s conflicting decision. First, *Keller*’s substantive analysis declined to address the ability to alter the players’ image, which the New Jersey court found “significant because it suggests that the goal of the game is not for the user to ‘be’ the player.”²⁶⁰ Moreover, this ability to alter “is itself a noteworthy, expressive attribute of the game.”²⁶¹ Second, the court disagreed with *Keller*’s approach of focusing solely on the challenged image, rather than the work as a whole.²⁶²

Contrary to *Keller*’s reasoning, I read *Kirby* as looking at the video game in that case, as a whole. By focusing on the setting in which the *Ulala* character appeared, *Kirby* considered the entire game. Similarly, the *Winter* court considered that the purported images of the Winter brother musicians were “cartoon characters—half-human and half-worm—in a larger story, which itself is quite expressive.” While the *Winter* court did focus most of its attention on the fanciful worm-like characters, it also considered the larger story of which the characters were a part.²⁶³

Judge Wolfson’s principal disagreement with *Keller* is the scope of the

²⁵⁵ *Id.* at 785. *NCAA Football* permits the user to alter the virtual player’s “height, weight, hairstyle, face shape, body size, muscle size, and complexion.” *Id.* For example, a user may choose from eight different hairstyle options including variations on a fade, close crop, afro, and balding. *Id.*

²⁵⁶ *Id.* at 783. The court noted that *C.B.C.*’s holding that the use of player names, statistics, and biographical data is entitled to First Amendment protection as information within the public domain also applies to the public facts connected with Hart’s image. *Id.* at 785 n.28.

²⁵⁷ *Id.* at 783.

²⁵⁸ *Id.* at 785 (quoting *Brown v. Entm’t Merchs. Ass’n*, 131 S. Ct. 2729, 2733 (2011)).

²⁵⁹ *Id.* at 787.

²⁶⁰ *Id.*

²⁶¹ *Id.*

²⁶² *Id.*

²⁶³ *Id.* (citations omitted).

transformative use test: whether it considers only the transformation of the celebrity depiction, or the transformative nature of the depiction in light of its interaction with the overall work. This Note proposes a fair use standard that addresses this issue and improves upon the failures of established approaches.

VI. MONDAY MORNING QUARTERBACKING: A NEW FAIR USE STANDARD

The relationship between the right of publicity and copyright connotes that the fair use defense can provide a strong model to incorporate First Amendment limitations in right of publicity actions. Fair use is a judicially constructed “rule of reason” establishing a privilege to use copyrighted material in a reasonable manner without the owner’s consent.²⁶⁴ One commentator has stated that:

The fair use doctrine thus recognizes that the development of the arts and sciences may best be achieved by allowing for the free dissemination of certain information affecting areas of universal concern, such as history and biography. By providing a limited privilege . . . fair use . . . preserve[s] a marketplace of ideas.²⁶⁵

With Section 107 of the Copyright Act providing a model, a fair use defense can be fashioned for application in right of publicity cases. However, prior to modifying the factors, we must consider the differences between the two intellectual property regimes to avoid a wholesale importation of fair use that erroneously accommodates inapposite copyright policies.

A. *Comparing Copyright and the Right of Publicity*

In 1976 Congress enacted the Copyright Act,²⁶⁶ granting exclusive rights to original works of authorship.²⁶⁷ While copyright grants an exclusive right in creative works, the right of publicity grants an exclusive right over one’s personae.²⁶⁸ These monopolies run counter to the goals of the First Amendment by chilling free expression; therefore, the need for mechanisms to balance these private and public rights is necessary for both regimes. This mechanism is and should be fair use, which “serves as an

²⁶⁴ Coyne, *supra* note 133, at 815.

²⁶⁵ Stephen S. Morrill, Note, *Harper & Row, Publishers v. Nation Enterprises: Emasculating the Fair Use Accommodation of Competing Copyright and First Amendment Interests*, 79 NW. U. L. REV. 587, 611 (1984).

²⁶⁶ Copyright Act, Pub. L. 94-553, 90 Stat. 2541 (codified as amended in scattered sections of 17 U.S.C.).

²⁶⁷ 17 U.S.C. § 102 (2006).

²⁶⁸ Coyne, *supra* note 133, at 814.

accommodation of competing [exclusive rights] and [F]irst [A]mendment interests so as to preserve a marketplace of ideas.”²⁶⁹

The Supreme Court recognized that a state’s interest in protecting a right of publicity “is closely analogous to the goals of . . . copyright law.”²⁷⁰ Both copyright and the right of publicity “provide incentive[s] for creative endeavor” that benefit the public at large.²⁷¹ Copyright seeks the advancement of the public welfare through the encouragement of individual effort for monetary gain.²⁷² This copyright policy corresponds with the state’s interest in providing incentives to create valuable personas and, consequently, encouraging the development of those skills or achievements that foster public recognition. Similarly, these doctrines function to ensure that the individual will be able “to reap the reward of his endeavors.”²⁷³ The celebrity benefits from establishing commercially valuable identities while the public benefits from the products of their enterprise.²⁷⁴ These regimes are so alike that public policy requires preemption of certain publicity rights when free enterprise and free expression in non-copyrightable material trump those state interests.²⁷⁵

However, important differences require altering the fair use defense to bolster right of publicity policies. At the most rudimentary level, the right of publicity concerns a person, usually a celebrity, while copyright protects works fixed in a tangible medium of expression. The right of publicity protects ideas (e.g., a voice); conversely, the Supreme Court considered the idea/expression dichotomy an implicit balancing mechanism for copyright to accommodate the First Amendment.²⁷⁶ Likewise, some question whether the First Amendment should tolerate state interests that undermine free expression; copyright is deserving of such a balance since the

²⁶⁹ Morrill, *supra* note 265, at 611.

²⁷⁰ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

²⁷¹ Coyne, *supra* note 133, at 812; *see also* *Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663, 678 (7th Cir. 1986) (“The reason that state law protects individual pecuniary interests is to provide an incentive to performers to invest the time and resources required to develop such performances.”); *Zacchini*, 433 U.S. at 576 (“Ohio’s decision to protect petitioner’s right of publicity here rests on more than a desire to compensate the performer for the time and effort invested in his act; the protection provides an economic incentive for him to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright laws long enforced by this Court.”).

²⁷² *Baltimore Orioles*, 805 F.2d at 679.

²⁷³ *Zacchini*, 433 U.S. at 573.

²⁷⁴ *Lugosi v. Universal Pictures*, 603 P.2d 425, 441 (Cal. 1979) (Bird, J., dissenting).

²⁷⁵ *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 841 (6th Cir. 1983) (Kennedy, J., dissenting); *see also* *Laws v. Sony Music Entm’t*, 448 F.3d 1134, 1145 (9th Cir. 2006) (holding that the Copyright Act preempted a singer’s claim that a sound recording she licensed to the defendant violated her right of publicity through unauthorized use of her voice).

²⁷⁶ *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985).

Founders grounded it within the Constitution.²⁷⁷

Certain policies differ as well. At least one court has advanced the view that a violation of the right of publicity strikes at one's personhood more than an infringement of a copyrighted work.²⁷⁸ The fair use doctrine—and copyright in general—does not look to prevent consumer deception by ensuring that consumers receive accurate information about sponsorship and endorsement.²⁷⁹ Furthermore, legal scholar Roberta Rosenthal Kwall has argued that unjust enrichment is a principal rationale for the right of publicity, while the same interest in copyright has waned in recent years.²⁸⁰

B. *Altering the Factors*

With these key differences in mind, we must adjust the original section 107 factors to promote the policies of the right of publicity. The proposed factors for publicity rights include:

1. the nature of the speech, including the extent to which the use is transformative;
2. the nature of the asserted publicity right;
3. the scope of the misappropriation in relation to the purpose of the use;
4. the effect of the use upon the potential market for or value of the publicity right.²⁸¹

1. *The Nature of the Speech*

This factor will not require an analysis of whether the use is commercial in nature, since a *prima facie* case requires proof of commerciality. Initially, a court should consider whether the use falls within a preferred category of expression or within the sphere of commercial speech. The categories enumerated in § 107 have direct application to the right of publicity, including “criticism, comment, news

²⁷⁷ See, e.g., Volokh, *supra* note 177, at 913 (questioning whether the First Amendment can endure states barring citizens from being able to express themselves in particular fashions).

²⁷⁸ See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992) (ruling that the right of publicity is not preempted because this right is more personal than those protected by copyright).

²⁷⁹ *Kwall I*, *supra* note 110, at 61. But see *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 791 (D.N.J. 2011) (“I question the wisdom of applying a trademark-based test to right of publicity claims without accounting for [the] difference[s].”).

²⁸⁰ *Kwall I*, *supra* note 110, at 61–62; see also *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 352–56 (1991) (discrediting the “sweat of the brow” theory of copyright protection that underlies the unjust enrichment justification).

²⁸¹ See *Coyne*, *supra* note 133, at 817 (listing similar factors for a fair use test in the right of publicity context).

reporting, teaching . . . scholarship, [and] research.”²⁸² Additionally, the California Supreme Court has recognized that the right of publicity does not provide a shield from creativity in the form of “caricature, parody²⁸³ and satire.”²⁸⁴ In contrast, the commercial speech doctrine prescribes that wholly commercial uses should receive diminished protection.²⁸⁵ Moreover, this factor would provide no protection to falsified celebrity endorsement in accord with the First Amendment.²⁸⁶

For example, if someone wrote an unauthorized biography of Derek Jeter, would this be a violation of the shortstop’s right of publicity? Assuming that all the facts within the biography are true,²⁸⁷ or at least mostly true,²⁸⁸ the right of publicity would yield to “the free dissemination of thoughts, ideas, newsworthy events, and matters of public interest.”²⁸⁹ In this scenario, the unauthorized biography falls within the “newsworthy” category of protected activity, and would usually result in a finding of fair use. By incorporating First Amendment principles directly into the first factor, this fair use standard protects preferred speech categories while providing diminished protection for commercial speech. These categories, though not dispositive, will instruct the fair use ruling absent strong countervailing policies present in the other factors.

However, unsurprisingly, most cases do not fall within these preferred or non-preferred categories. In between fall those misappropriations that challenge the court to sift through both expressive and commercial elements. Here, courts will apply the transformative use test derived from *Comedy III*.²⁹⁰ However, the test will be different in one respect; no longer will transformation be a question of sufficiency, but rather of degree. Since transformative use will no longer be dispositive, it provides an opportunity to place this inquiry on a sliding scale. The new test will ask the degree to which the “celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized, or . . . the very sum and

²⁸² 17 U.S.C. § 107 (2012).

²⁸³ See *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 968–76 (1996) (using parody in the context of the right of publicity as a factor to balance the First Amendment).

²⁸⁴ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 803 (Cal. 2001). It should be noted that copyright law disfavors satire in the fair use analysis since it uses an original work to criticize something else. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580–81 (1994).

²⁸⁵ *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771 n.24 (1976).

²⁸⁶ *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 563–64 (1980).

²⁸⁷ MCCARTHY, *supra* note 28, § 8:65.

²⁸⁸ *Time, Inc. v. Hill*, 385 U.S. 374, 389 (1967) (creating some breathing room for First Amendment freedoms so that a few mistakes of factual accuracy do not become actionable).

²⁸⁹ *Rosemont Enters., Inc. v. Random House, Inc.*, 294 N.Y.S.2d 122, 129 (Sup. Ct. 1968), *aff’d*, 301 N.Y.S.2d 948 (N.Y. App. Div. 1st Dep’t 1969).

²⁹⁰ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001).

substance of the work in question.”²⁹¹

Though a subtle change, placing transformation on a spectrum makes a rigid standard much more flexible. *Comedy III* and *Winter* still bookend the spectrum from a purely commercial, non-transformative use to a substantial transformation.²⁹² *ETW* provides the middling example and shows the benefits of this flexible factor. The literal depiction of Tiger Woods denotes little to no transformation within the lithograph; however, the panorama of golf legends adds a slight transformation in the form of an objectively discernible message.²⁹³ In such a scenario, neither party should benefit from this factor; therefore, the court must consider the other factors to make a ruling.

The new construction of this factor incorporates the predominant use test and the *Restatement* approach, but capitalizes on their flaws by creating a sliding scale that removes the sufficiency determination. Furthermore, it refines the transformative use inquiry to allow for judicial discretion and consideration of other factors.

2. *The Nature of the Publicity Right*

This factor acts as a limiting principle on those instances of fame that do not comport with the twin policies of unjust enrichment and incentive creation. In other words, when the celebrity’s “persona is entirely of his own creation, his publicity rights deserve more protection.”²⁹⁴ Admittedly, this factor has little to do with its copyright counterpart, which considers distinctions like fiction v. non-fiction²⁹⁵ and published v. unpublished²⁹⁶ works. Instead, it incorporates both right of publicity and First Amendment policies by limiting the scope of a celebrity’s right in favor of the public domain that is responsible for his or her fame.

In fashioning his own fair use standard, Randall Coyne developed a similar explanation for this factor. He proposed, “to the extent that plaintiff’s acquisition of fame is unrelated to his creative or intellectual efforts, his assertion of publicity rights is undermined.”²⁹⁷ This provides a cogent response to Madow’s qualms with the incentive creation and unjust enrichment justifications. First, affording more protection to those celebrities who create their own valuable personas through their own labor incentivizes such behavior.²⁹⁸ Second, it is unjust for a celebrity to obtain

²⁹¹ *Id.*

²⁹² See *supra* Part IV.C and accompanying notes.

²⁹³ *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 936–38 (6th Cir. 2003).

²⁹⁴ Coyne, *supra* note 133, at 819.

²⁹⁵ *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 564 (1985).

²⁹⁶ Fair Use Amendment of 1992, Pub. L. 102-492, 106 Stat. 3145 (1992) (codified at 17 U.S.C. § 107 (2006)).

²⁹⁷ Coyne, *supra* note 133, at 819.

²⁹⁸ Madow, *supra* note 32, at 179.

an exclusive monopoly over a right that the public is largely responsible for creating.²⁹⁹ This factor will allow the public to enjoy the benefits of creating a valuable persona by enlarging the public domain and First Amendment protections.

The question is how do we differentiate between these two publicity rights? How do we classify those personas created by both the celebrity's labor and the public at large? The first classification, *active publicity*, will comprise the personas of celebrities who have expended "time, effort, skills, and . . . money"³⁰⁰ to acquire such fame. In contrast, *passive publicity* encompasses those commercial identities created solely by the public and media. For example, those who attain notoriety "through sheer luck . . . public scandal, or . . . grossly immoral conduct"³⁰¹ should not receive the same publicity rights that athletes and entertainers enjoy. A combination of both creates—as Justice Antonin Scalia would say—a *tertium quid*,³⁰² which, for purposes of this factor, will have the effect of *passive publicity* in favor of a larger public domain.³⁰³

In hindsight, this factor should have played a defining role in an important Ninth Circuit case. In *Hilton v. Hallmark Cards*, celebrity Paris Hilton sued Hallmark Cards for selling a birthday card reading "Paris's First Day as a Waitress."³⁰⁴ Inside the card was Paris's face superimposed on a cartoon waitress body saying her catch phrase "That's hot."³⁰⁵ The Ninth Circuit held that Hallmark's "transformative" defense was insufficient to grant the Anti-SLAPP motion to dismiss because the card depicted Paris in her natural setting as "born to privilege, working as a waitress."³⁰⁶

In such a close case, looking at the nature of the publicity right may have provided a more fitting decision. At the outset, the court described Paris as a "controversial celebrity known for her lifestyle as a flamboyant heiress [or in other words] 'famous for being famous.'"³⁰⁷ The court even acknowledged that Hallmark attempted to parody Paris's reality television

²⁹⁹ *Id.* at 196.

³⁰⁰ Nimmer, *supra* note 57, at 215–16.

³⁰¹ Madow, *supra* note 32, at 179.

³⁰² Black's Law Dictionary defines a "*tertium quid*" as a "third thing that has qualities distinct from the prior two components." BLACK'S LAW DICTIONARY (9th ed. 2009); *see also* Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 215 (2000) (describing a *tertium quid* as a combination of product packaging and product design under the *trade dress* doctrine).

³⁰³ *Cf. Wal-Mart Stores*, 529 U.S. at 215 ("To the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning.").

³⁰⁴ 599 F.3d 894, 899 (9th Cir. 2010).

³⁰⁵ *Id.*

³⁰⁶ *Id.* at 911. It should be noted that the court refused to label the card as a "parody," which may have been sufficient to deem it transformative solely on that basis. *Id.* at 910 n.13.

³⁰⁷ *Id.* at 899.

show “The Simple Life,” where in one episode she worked as a waitress at a fast food restaurant.³⁰⁸ Paris Hilton fits comfortably within the definition of *passive publicity*; her fame is a product of a complex social process involving both the public and the media molding and constructing her image. According to the Ninth Circuit, while Paris exploits this fame through reality television shows, a self-titled pop album, and various commercial products, the public domain—which is responsible for her success—must yield to her publicity right. Although a birthday card may qualify as commercial speech, the apparent parody and ample expression combined with a *passive publicity* classification should have resulted in a dismissal of the case.

3. *The Extent of the Misappropriation*

This factor has obvious application within the right of publicity context. Simply put, the court evaluates the extent of the misappropriation. In reference to the transformative test, the Supreme Court of California stated, “[t]he inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements *predominate in the work*.”³⁰⁹

This statement is significant for two reasons. First, unlike copyright, the application of this factor to the right of publicity will stress quantity rather than the quality of the expression. Second, and more importantly, the use of the word “work,” as opposed to identity or persona, suggests that the inquiry should consider the entire work as a whole. Later, the court reiterated this point by asking whether the “*product containing [the] celebrity’s likeness* is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.”³¹⁰

The California Supreme Court reiterated this rule in *Winter*, stating that the comic book characters were “in a larger story, which is itself quite expressive.”³¹¹ In *Kirby*, the court did not consider the depiction of the celebrity in isolation. Rather, it found that Ulala was a “fanciful, creative character’ who exist[ed] in the context of a unique and expressive video game.”³¹² In *ETW*, the Sixth Circuit considered the literal depiction of Tiger Woods within the context of the entire painting, including the background of golf legends, which formed the transformative message.³¹³ Thus, the inquiry goes beyond merely looking at the depiction of the

³⁰⁸ *Id.*

³⁰⁹ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001) (emphasis added).

³¹⁰ *Id.* (emphasis added). *Keller* misstates this test by solely emphasizing the transformation of the celebrity depiction itself. *Keller v. Elec. Arts, Inc.*, No. C 09–1967 CW, 2010 WL 530108, at *5 (N.D. Cal. Feb. 8, 2010).

³¹¹ *Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003).

³¹² *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 618 (Cal. Ct. App. 2006).

³¹³ *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 936 (6th Cir. 2003).

celebrity.

The underlying medium containing the celebrity depiction will dictate the extent of the misappropriation. For example, in *Comedy III*, the lithograph comprised a literal depiction of the Three Stooges; therefore, the court need not consider anything beyond the portrayal of the performers.³¹⁴ On the other hand, in *ETW*, the court had to consider Tiger Woods's depiction and its interaction with the golf legends in the background.³¹⁵ The Supreme Court agreed with this conception of misappropriation stating that “[v]ideo games . . . [l]ike the protected books, plays, and movies . . . communicate ideas . . . through familiar literary devices and through *features distinctive to the medium*.”³¹⁶ Thus, the First Amendment protects not only the transformation of the celebrity depiction, but also the transformative nature of the depiction's interaction with its underlying medium.

Kirby and *No Doubt* determined the appropriation in this manner as well. In *Kirby*, the California court considered not only the depiction of Kirby as “Ulala,” but also the twenty-fifth century space age setting in which the character existed.³¹⁷ The court took a holistic approach in evaluating the character's manifestation within a transformative setting that gave rise to sufficient expression to afford First Amendment protection. Conversely, the depiction of the rock band *No Doubt* within *Band Hero* was not sufficiently transformative.³¹⁸ However, it is important to note that the court considered whether the band's image was “immutable” and that the avatars could not be altered.³¹⁹ While the court failed to consider the setting in which these avatars interacted and placed undue emphasis on the celebrity depiction, it did consider a feature—user alteration—distinctive to video games in general. *Kirby* and *No Doubt* set the stage for *Keller* and *Hart*, which is why this factor will play an important role in remedying the contradictory opinions.

4. *The Effect of the Use on the Potential Market*

This factor is nearly identical to its copyright counterpart, asking whether the misappropriation affects the celebrity's use on the present or potential licensing market. The Supreme Court, in reference to copyright, described this factor by stating that “a use that has no demonstrable effect upon the potential market for, or the value of, the copyrighted work need not be prohibited in order to protect the author's incentive to create.”³²⁰

³¹⁴ *Comedy III*, 21 P.3d at 808.

³¹⁵ *ETW Corp.*, 332 F.3d at 936–38.

³¹⁶ *Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729, 2733 (2011) (emphasis added).

³¹⁷ *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 610 (Cal. Ct. App. 2006).

³¹⁸ *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 401 (Cal. Ct. App. 2011).

³¹⁹ *Id.*

³²⁰ *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 450 (1984).

This reference to incentive creation and the effect upon the potential market has direct application to the right of publicity.

The *Restatement* defines the contours of this factor.³²¹ Courts should analyze the market effect “in light of the informational or creative content of the defendant’s use.”³²² In the case of an imitation, the public interest in fostering competition and creating an expansive public domain will often outweigh the adverse effects on the celebrity’s market.³²³ However, literal reproductions create a greater likelihood of harm to an individual’s right of publicity.

The scope of commercial injury is vast. At the most basic level, the right of publicity protects against the unauthorized exploitation of the goodwill and reputation linked to one’s name or likeness to his or her commercial detriment.³²⁴ The protection extends to appropriations of a work product linked with the plaintiff’s identity. An example of this would be Zacchini’s “human cannonball” performance. The commercial harm would not only include the loss of a licensing opportunity, but also the amount the infringer benefitted from using the name or likeness. For example, Zacchini should have recovered for the lost profits in his “human cannonball” performance and lost licensing opportunities to the video of his performance. However, he should also recover the value that he brought to the news broadcast, or the value of the number of viewers that he attracted to the Scripps-Howard broadcast as opposed to its regular viewing audience.

Finally, the right of publicity even protects against the dilution of the commercial value of one’s identity through excessive or harmful uses.³²⁵ *Zacchini*’s “entire act” standard fits nicely within this factor protecting against severe infringements that affect a person’s ability to earn a livelihood. The broadcasting of his entire “human cannonball” act “pose[d] a substantial threat to the economic value of that performance.”³²⁶ The Sixth Circuit applied the *Restatement*’s conception of this factor as well. In *ETW*, the court reasoned that “[Tiger] Woods . . . engages in an activity, professional golf, that in itself generates a significant amount of income which is unrelated to his right of publicity. [Absent this right], he would still be able to reap substantial financial rewards from authorized appearances and endorsements.”³²⁷ The court held that the use of Woods’s likeness in the prints did not reduce the commercial value of his

³²¹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. d (1995).

³²² *Id.*

³²³ *Id.*

³²⁴ *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1198 (S.D.N.Y. 1983).

³²⁵ *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 138 (Wis. 1979).

³²⁶ *Zacchini v. Scripps-Howard Broad., Co.*, 433 U.S. 562, 575 (1977).

³²⁷ *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 938 (6th Cir. 2003).

likeness.³²⁸

C. *Application to Hart and Keller*

This new fair use test provides the mechanism for reconciling the conflicting decisions of *Keller and Hart*. Regarding the first factor, it is evident that the quarterbacks' likenesses do not fall within the preferred or commercial speech categories. Therefore, we must consider the degree of transformation in light of the "features distinctive to the medium."³²⁹ This will include the ability to alter characteristics, play in different modes including the "Road to Glory," and the interaction of the player with the virtual stadium and fans. As Judge Wolfson contended, "it is logically inconsistent to consider the setting in which the character sits, which *Keller* does in its analysis, yet ignore the remainder of the game."³³⁰ Despite being near literal depictions of the quarterbacks, *NCAA Football's* total transformation within the distinctive features of a video game weighs this factor slightly in favor of Electronic Arts.

Most collegiate athletes fall within the *active publicity* classification. Through their hard work and effort, these athletes attain a degree of fame, albeit some more than others, to exploit during their collegiate careers. Athletes will usually benefit from this factor because of how easily their publicity rights comport with the Lockean labor justification.

The third factor presents a great amount of overlap with the first. We cannot simply consider the depiction of Keller and Hart, but rather we must evaluate the extent of the appropriation with respect to the entire work. The scope of the inquiry is precisely what caused the contradictory decisions. The Northern District of California merely considered the depiction of Keller, while the District of New Jersey looked at the depiction of Hart within *NCAA Football* as a whole. The *Hart* decision was correct in ruling that the misappropriation was negligible in light of the "creative elements [that] predominate in the work."³³¹

Finally, the fourth factor will weigh against a finding of infringement. Disregarding whether the former student-athletes or the NCAA own the right to license their likenesses,³³² the imitation of Keller and Hart in *NCAA Football* has little to no demonstrable effect on the potential licensing market. Unlike Zacchini, the student-athletes are not in danger of losing their ability to earn a livelihood. Therefore, the interests of the public domain trump their publicity rights.

³²⁸ *Id.*

³²⁹ *Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729, 2733 (2011).

³³⁰ *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 787 (D.N.J. 2011).

³³¹ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001) (emphasis added).

³³² Drew Lipsky, *Should NCAA Athletes Be Paid After Leaving School: Analyzing O'Bannon v. NCAA, YAHOO!* (Dec. 30, 2011), <http://rivals.yahoo.com/ncaa/football/news?slug=yen-10770405>.

This new fair use test clearly delineates the necessary considerations to incorporate the First Amendment into the right of publicity. After applying this test to *Keller and Hart*, it is clear where the California court went wrong, and that Judge Wolfson was correct in ruling in favor of Electronic Arts.

There are three primary benefits in adopting this Note's proposed fair use standard. First, and most obvious, is the creation of uniformity among the lower courts. As previously discussed, no test has garnered as much widespread recognition as the foremost test to balance the right of publicity and the First Amendment. Implementing this Note's proposed fair use standard could provide outcomes that are more predictable and prevent forum shopping.

Second, the proposed fair use standard attempts to remedy the flaws of the established balancing tests. For example, the first factor changes the transformative inquiry from a black and white, yes or no inquiry into one with much more flexibility. The traditional transformative use test required a dispositive decision that caused inconsistencies like the *Keller* and *Hart* opinions.

Third, and most importantly, this standard will combat the gradual expansion of the right of publicity beyond that which Prosser or Nimmer could imagine. Under the proposed fair use standard, the First Amendment right of the video game publisher trumps the collegiate athletes' right of publicity. As the right of publicity grows to protect even the evocation of a celebrity's likeness,³³³ an expansive fair use standard is necessary to maintain a rich public domain. As Judge Kozinski stated, "Overprotecting intellectual property is as harmful as underprotecting it. . . . [and, in fact,] stifles the very creative forces it's supposed to nurture."³³⁴

The remaining ambit of the right of publicity will protect against unauthorized advertisements and endorsements. In other words, commercial speech will encompass most of the infringements of publicity rights. Of course, this fair use standard still provides breathing room for some infringements beyond commercial speech and some fair uses that constitute commercial speech.

VII. CONCLUSION

Balancing the First Amendment against the right of publicity has proved frustrating ever since *Zacchini*. This Note's proposed test provides the uniformity that scholars and courts have sought for over thirty-five

³³³ See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399, 1401 n.3 (9th Cir. 1992) (holding that Samsung's advertisement using a robot resembling Vanna White on a Wheel of Fortune game show set was a violation of her right of publicity).

³³⁴ *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting).

years.³³⁵ The conflicting *Keller* and *Hart* opinions represent the state of the entire area of law—muddled in a variety of tests with no predictive value. The lack of a clear standard is chilling the First Amendment guarantee of free expression and deterring creative endeavors. This district split—and potential circuit split—provides an opportunity for the Supreme Court, or Congress, to clarify this chaotic area of law with a fair use standard that specially pertains to the right of publicity.

³³⁵ See, e.g., Kevin L. Vick & Jean-Paul Jassy, *Why a Federal Right of Publicity Statute Is Necessary*, 28 COMM. LAW. 14, 19 (2011) (proposing a federal right of publicity statute that incorporates a fair use doctrine because “(1) there is no uniformity of laws, and (2) that lack of uniformity is a serious threat to the First Amendment”).