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Is Nominal Use an Answer to the Free Speech and Right of Publicity Quandary?: Lessons from America's National Pastime

Raymond Shih Ray Ku^{*}

INTRODUCTION

From its inception, the right of publicity has existed in an uneasy state of tension with the First Amendment. By prohibiting the use of an individual's name or likeness, the right of publicity—like other categories of intellectual property law, including copyright and trademark—creates a property right in information that may be asserted by its owner to restrict the expression of others.¹ By definition, laws that limit expression implicate the First Amendment's prohibition against the abridgment of speech, even if this does not mean that all such limitations are unconstitutional. As the Supreme Court has noted, some restrictions upon speech imposed by intellectual property law promote freedom of expression.² Not surprisingly, this tension between free speech and intellectual property laws in general, and the right of publicity in particular, has been a source of continuing consternation for courts³ and commentators alike.⁴

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¹ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995) ("One who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability . . .").

² See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985) ("In our haste to disseminate news, it should not be forgotten that the Framers intended copyright itself to be the engine of free expression.")

³ See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003); *Cardtoons, L.C., v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001); *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905); *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003) (en banc).

⁴ See, e.g., Pamela Samuelson, *Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 *TUL. L. REV.* 836 (1983); Roberta Rosenthal Kwall, *Fame*, 73 *IND. L.J.* 1 (1997); Diane Leinheer Zimmerman, *Fitting Publicity Rights into Intellectual Property and Free Speech Theory: Sam, You Made the Pants Too Long!*, 10 *DEPAUL-LCA J. ART & ENT. L.* 283 (2000); Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 *HOUS. L. REV.* 903 (2004); F. Jay Dougherty, *All the World's Not a Stooge: The "Transformativeness" Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 *COLUM. J.L. & ARTS* 1 (2003); Shubha Gosh, *On Bobbling Heads, Paparazzi, and Justice Hugo Black*, 45 *SANTA CLARA L. REV.* 617 (2005); David S. Welkowitz & Tyler T. Ochoa, *The Terminator as Eraser: How Arnold Schwarzenegger Used the Right of Publicity to Terminate Non-Defamatory Political*

One factor that complicates this tension is that, as it has evolved, the right of publicity does not respond to a single interest, but instead responds to a cluster of related though distinct interests, each raising different First Amendment questions. The least controversial of these interests is when the courts prevent unauthorized use of an individual's name or likeness in a manner that falsely signals endorsement or sponsorship.⁵ False speech is generally not constitutionally protected speech.⁶ A little more controversial is protecting individuals from being unwillingly thrust into the public eye for commercial purposes.⁷ In these types of cases, an individual's interest in liberty and dignity may be said to outweigh the speech interests at stake,⁸ though the Supreme Court has generally been skeptical of restrictions upon the dissemination of truthful information.⁹ Lastly, the right of publicity protects the economic interests of an individual from having her name or likeness exploited even when there is no confusion regarding the individual's relationship with the use.¹⁰

This essay explores three approaches developed by courts to alleviate the tension between free speech and the right of publicity. It focuses upon the last set of interests—non-misleading, for-profit uses of a celebrity's name or likeness. Perhaps by coincidence—or, perhaps because it is this nation's pastime—professional baseball is fertile ground for these controversies. Not only does the modern right of publicity begin with a dispute over baseball cards, its future should be defined by fantasy baseball. In *C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*, the Eighth Circuit held that the use of players' names and statistics for online fantasy baseball did not violate the right of publicity.¹¹ The court used an approach that not only reconciled the speech interests at stake in that case, but also adopted an essential First Amendment safeguard present in trademark law—nominal use—that has yet to be explicitly recognized in the right of publicity context.

I. PLAY BALL! OR NOT

From the beginning, courts have recognized the inherent tension between one person's right not to be spoken about and another's constitutional guarantee of freedom of expression. After tracing the origins of the right of publicity, this part discusses how courts have attempted to balance these

Speech, 45 SANTA CLARA L. REV. 651 (2005).

⁵ See, e.g., *Pavesich*, 50 S.E. 68.

⁶ See, e.g., *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964).

⁷ See, e.g., *Pavesich*, 50 S.E. 68.

⁸ *Id.*; see also Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

⁹ See, e.g., *Bartnicki v. Vopper*, 532 U.S. 514 (2001).

¹⁰ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (1995) ("The name, likeness, and other indicia of a person's identity are used 'for purposes of trade' . . . if they are used in advertising the user's goods or services, or placed on merchandise marketed by the user, or are used in connection with services rendered by the user.").

¹¹ 505 F.3d 818 (8th Cir. 2007).

competing interests. Through the lens of the three cases involving the right of publicity and baseball, it demonstrates the limits and promise of these efforts.

The right of publicity originates from Samuel Warren and Louis Brandeis' seminal article, *The Right to Privacy*.¹² Responding to what they perceived to be the abuses of "modern" media, the authors argued that the common law recognized a "right to be let alone."¹³ Drawing from common copyright, which recognized a property right in one's unpublished papers, including letters and manuscripts, *The Right to Privacy* argued that the law protects the "[t]houghts, emotions, and sensations" that make up one's personality.¹⁴ As such, the law should provide "to each individual the right of determining, ordinarily, to what extent his thoughts, sentiments, and emotions shall be communicated to others[,]" regardless of how these aspects of one's personality are expressed.¹⁵

To do this, *The Right to Privacy* de-linked the protected attributes of personality from the physical pieces of property protected by the common law that provided evidence of that personality.¹⁶ According to the authors:

The circumstance that a thought or emotion has been recorded in a permanent form renders its identification easier, and hence may be important from the point of view of evidence, but it has no significance as a matter of substantive right. If, then, the decisions indicate a general right to privacy for thoughts, emotions, and sensations, these should receive the same protection, whether expressed in writing, or in conduct, in conversation, in attitudes, or in facial expression.¹⁷

However, even Warren and Brandeis recognized that the right of privacy is not absolute and would not prohibit, among other things, "any publication of matter which is of public or general interest[,]"¹⁸ or apply to facts published by the individual or with her consent.¹⁹ The authors, therefore, emphasized that "[i]t is the unwarranted invasion of individual privacy which is reprehended, and to be, so far as possible, prevented."²⁰

Warren and Brandeis's original conception of the right of privacy is illustrated by *Pavesich v. New England Life Insurance Co.*,²¹ one of the earliest decisions recognizing the right. In *Pavesich*, the plaintiff complained that the unauthorized use of his photograph in conjunction with an advertisement for life insurance violated his right to privacy.²² The advertise-

¹² Warren & Brandeis, *supra* note 8.

¹³ *Id.*

¹⁴ *Id.* at 195, 206–07.

¹⁵ *Id.* at 198.

¹⁶ See Robert C. Post, *Rereading Warren and Brandeis: Privacy, Property, and Appropriation*, 41 CASE W. RES. L. REV. 647 (1991).

¹⁷ Warren & Brandeis, *supra* note 8, at 206.

¹⁸ *Id.* at 214.

¹⁹ *Id.* at 218.

²⁰ *Id.* at 215.

²¹ 50 S.E. 68 (Ga. 1905).

²² *Id.* at 68–69.

ment used the plaintiff's image alongside a picture of an ill-looking individual in conjunction with statements supposedly from those pictured about the value of buying insurance while in good health.²³ In rejecting the defendant's free speech claim, the Supreme Court of Georgia concluded that, "[t]here is in the publication of one's picture for advertising purposes not the slightest semblance of an expression of an idea, a thought, or an opinion, within the meaning of the constitutional provision which guaranties to a person the right to publish his sentiments on any subject."²⁴ Instead, it was a serious assault on individual liberty. According to the court, the unauthorized use of one's image in advertising is the equivalent of slavery:

The knowledge that one's features and form are being used for such a purpose, and displayed in such places as such advertisements are often liable to be found, brings . . . even the individual of ordinary sensibility, to a realization that his liberty has been taken away from him; . . . that he is for the time being under the control of another, that he is no longer free, and that he is in reality a slave . . .²⁵

As such, the court established a rule that "the publication of one's picture without his consent by another as an advertisement, for the mere purpose of increasing the profits and gains of the advertiser, is an invasion of [the right of privacy] . . ."²⁶ Because the plaintiff never consented to the public use of his image, *Pavesich* is a rather straightforward application of Warren and Brandeis's right of privacy.

Given the scope of the right of privacy, how did it develop into the right of publicity, or what William Prosser described as "[a]ppropriation, for the defendant's advantage, of the plaintiff's name or likeness"?²⁷ In other words, how did a right to prevent the disclosure of one's personal thoughts and emotions become a right to control the use of one's public image? As we will see, the ceiling established by the right of privacy becomes the floor for the right of publicity. What develops out of the conclusion that the right of privacy is constrained by expression involving matters of public concern—subsequently described as newsworthy—is the corollary that when the expression is not newsworthy it is not privileged. As Diane Zimmerman notes:

If a use of a celebrity's identity occurs in a "newsworthy" setting, the use does not, all concede, violate any property right. But matters quickly go awry because the flip-side assumption seems to be that if a use is not newsworthy, it must perforce be commercial. And if it is commercial, then it does not have a First Amendment dimension and is fair game for regulation.²⁸

To illustrate this point, consider the following decisions involving the

²³ *Id.*

²⁴ *Id.* at 80.

²⁵ *Id.*

²⁶ *Id.* at 81.

²⁷ William J. Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960) (identifying four different categories of privacy-related torts, including misappropriation).

²⁸ Zimmerman, *supra* note 4, at 295 (citations omitted).

right of publicity claims of baseball players.

The first case, *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, established the modern right of publicity.²⁹ *Haelan* involved the consensual use of photographs of baseball players by competing chewing gum manufacturers in connection with the sale of gum.³⁰ The plaintiff, Haelan, alleged that, not only had the ball players consented to the use of their photographs for such purposes; they also agreed not to grant similar rights to any other gum manufacturer.³¹ In response, the defendant, Topps, argued that the right of privacy was a personal right and could not be assigned to plaintiff and, as such, the players' agreements represented nothing more than a release of liability under New York's statutory right of privacy and did not create a separately enforceable interest.³² Because Topps also obtained the players' consent, the players had no grounds for complaint.³³ In deciding for the plaintiff, Judge Jerome Frank concluded that, "in addition to and independent of that right of privacy . . . a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture"³⁴ According to Judge Frank:

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.³⁵

Chief Judge Swan concurred on the basis that the case should be remanded on the claim that Topps intentionally induced the players to breach their contracts with Haelan.³⁶

While *Haelan* is important for its recognition and defense of the right of publicity, for this discussion the decision is more important for what it does not address. Consider the fact that the majority's discussion regarding the right of publicity is arguably dicta. As Chief Judge Swan concluded, the case could have been resolved under basic contract principles, and did not require the establishment of an independent property right.³⁷ Furthermore, Judge Frank's concern that, without the right of publicity, ball players would make no money from advertising,³⁸ is not only unsupported by

29 202 F.2d 866 (2d Cir. 1953).

30 *Id.* at 867.

31 *Id.*

32 *Id.*

33 There was some suggestion that Topps may not have obtained the consent of one player, although this fact did not impact the court's analysis. *Id.* at 868.

34 *Id.*

35 *Id.*

36 *Id.* at 869 (Swan, J., concurring).

37 *See id.*

38 *Id.* at 868 (majority opinion).

the facts of the case, it is far from inevitable. Topps did not argue that the right of privacy did not entitle the players to control the use of their photographs, either because: (1) they were public personalities; or (2) because they already consented to the publication of similar photographs by Haelan. As such, there was no threat to the players' ability to obtain compensation for the use of their photographs in advertising. The right of privacy guaranteed them that opportunity (at least to the extent that Topps valued the players' cooperation in posing for their photographs). Instead, the problem was that the players, presumably in exchange for additional compensation, consented to competing uses of their photographs, despite an earlier promise to Haelan.³⁹

Moreover, while the baseball cards were distributed in connection with the sale of chewing gum, the players' photographs were not used specifically to advertise gum. Yet, there is no discussion whether the differences between baseball cards and advertising require a separate First Amendment analysis (perhaps because the defendant was a competing chewing gum manufacturer rather than a member of the press). Even if one agrees with *Pavesich* that unauthorized uses of one's likeness in advertising is akin to slavery,⁴⁰ that does not mean that the use of the players' photographs on baseball cards is the same. Lastly, while one might ultimately conclude that, for First Amendment purposes, promotional uses that encourage the sale of an unrelated product are equivalent to advertising, the question does not even arise in *Haelan*. Instead, in response to competing commercial uses, the court almost reflexively recognizes a property interest in the player's image disconnected from the dignitary harms associated with the right of publicity and in opposition to the players' own actions.⁴¹ The court does this without any consideration of the First Amendment interests at stake.⁴² In *Haelan*, freedom of speech, literally, is not an issue.

The next decision in the baseball trilogy, *Cardtoons, L.C. v. Major League Baseball Players' Ass'n*,⁴³ illustrates how courts have responded to First Amendment concerns after *Haelan*. Under this approach, defendants must justify their use of celebrity images and demonstrate that the use is sufficiently important to society to outweigh the right of publicity.⁴⁴ In *Cardtoons*, the defendant produced humorous trading cards that featured caricatures of major league baseball players, including Barry Bonds, who was called "Treasury Bonds."⁴⁵ The cards ridiculed the players for, among

³⁹ See *id.* at 867.

⁴⁰ *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68, 80 (Ga. 1905).

⁴¹ See *Haelan*, 202 F.2d at 868.

⁴² See *id.*

⁴³ 95 F.3d 959 (10th Cir. 1996).

⁴⁴ *Id.* at 972. This approach follows the Supreme Court's treatment of the subject in *Zacchini v. Scripps-Howard Broad. Co.*, in which the Court held that the First Amendment did not preclude a right of publicity when the news media broadcasted the plaintiffs' entire performance. 433 U.S. 562 (1977).

⁴⁵ *Cardtoons*, 95 F.3d at 962.

other things, their compensation, egos, and physical characteristics.⁴⁶ The Major League Baseball Players Association (MLBPA), the exclusive collective bargaining agent for all active major league baseball players, claimed that the cards violated the players' rights against false representation under the Lanham Act and the right of publicity.⁴⁷ Because the cards did not fall within the statutory exception for news, *Cardtoons'* use of the players' likenesses would be prohibited by Oklahoma's right of publicity statute, unless it could successfully assert a First Amendment defense.⁴⁸

If a newsworthy use of celebrity images is one talismanic category of protected speech, *Cardtoons* establishes parody as another. According to the court, the trading cards implicate "some of the core concerns of the First Amendment."⁴⁹ In explaining the value of parody, the court noted:

A parodist can, with deft and wit, readily expose the foolish and absurd in society. Parody is also a valuable form of self-expression that allows artists to shed light on earlier works and, at the same time, create new ones. Thus, parody, both as social criticism and a means of self-expression, is a vital commodity in the marketplace of ideas.⁵⁰

Because of their significance in society, celebrities are both appropriate targets and vehicles for such social criticism.⁵¹ And, in the absence of First Amendment protection, celebrities are not likely to license or consent to such uses, thus depriving the public of important, if not core, First Amendment expression.⁵²

Correspondingly, the court concluded that recognizing a First Amendment privilege for celebrity parodies did little to harm the interests protected by the right of publicity.⁵³ The court reasoned:

The right is thought to further economic goals such as stimulating athletic and artistic achievement, promoting the efficient allocation of resources, and protecting consumers. In addition, the right of publicity is said to protect various non-economic interests, such as safeguarding natural rights, securing the fruits of celebrity labors, preventing unjust enrichment, and averting emotional harm.⁵⁴

The court concluded that, given the importance of parody as social commentary and criticism, none of these interests were of sufficient weight to justify restricting the parody baseball cards.⁵⁵

With regard to the economic justifications, the court concluded that the parodies are unlikely to change the incentives for people to become

⁴⁶ *Id.* at 963.

⁴⁷ *Id.* at 966.

⁴⁸ *Id.* at 968.

⁴⁹ *Id.* at 972.

⁵⁰ *Id.*

⁵¹ *See id.*

⁵² *Id.* ("Indeed, the director of licensing for MLBPA testified that MLBPA would never license a parody which poked fun at the players.")

⁵³ *Id.* at 976.

⁵⁴ *Id.* at 973.

⁵⁵ *Id.* at 976.

baseball players.⁵⁶ In the words of the court, "it is unlikely that little leaguers will stop dreaming of the big leagues or major leaguers will start 'dogging it' to first base if MLBPA is denied the right to control the use of its members' identities in parody."⁵⁷ Likewise, non-advertising uses of celebrity images were not likely to reduce the value of that likeness, and arguably, may increase that value.⁵⁸ As such, the right of publicity would not be used to maximize value, but, instead, to suppress criticism and "permanently remove a valuable source of information about their identity from the marketplace."⁵⁹ Lastly, the baseball cards were not likely to confuse or deceive consumers.⁶⁰

With regard to the non-economic justifications, the court rejected the natural rights argument out of hand as nothing more than a "blind appeal[] to first principles"⁶¹ In response to the claim that celebrities are entitled to the fruits of their labor, it noted that celebrities "are often not fully responsible for their fame."⁶² Moreover, with regard to parody, this was an untenable argument that celebrities should "enjoy the fruits of socially undesirable behavior."⁶³ Lastly, the court rejected the argument that the right of publicity may be used to prevent emotional injuries because, unlike the right of privacy, publicity rights focus upon the loss of financial gain.⁶⁴ According to the court, "fame is a double-edged sword—the law cannot allow those who enjoy the public limelight to so easily avoid the ridicule and criticism that sometimes accompany public prominence."⁶⁵ One may disagree with the court's balancing or conclude that the court's analysis was driven by its perception of the importance of parody as a form of social criticism. Nonetheless, *Cardtoons* is illustrative of efforts to resolve First Amendment concerns in right of publicity cases by determining whether the unauthorized use as speech is valuable speech or, as Warren and Brandeis put it, "in the public interest."⁶⁶

The final dispute in the baseball trilogy arose out of the operation of fantasy baseball leagues. The defendant, C.B.C. Distribution and Marketing ("CBC") sold fantasy baseball products through the Internet that included the names, performance, and biographical data of actual major league baseball players.⁶⁷ These products allowed individuals to become

⁵⁶ *Id.* at 973- 74.

⁵⁷ *Id.* at 974.

⁵⁸ *Id.* at 975.

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² *Id.*

⁶³ *Id.* at 975- 76.

⁶⁴ *Id.* at 976.

⁶⁵ *Id.*

⁶⁶ See Warren & Brandeis, *supra* note 8, at 214 and accompanying text. The California Supreme Court subsequently relied upon *Cardtoons* and followed this balancing analysis when it concluded that "transformative" expression outweighs a celebrity's interest in the control of her name or likeness. See *Comedy III Prods. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001).

⁶⁷ *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d

fantasy “owners” of a baseball franchise by creating their own teams and competing against the teams of other “owners” based upon the actual performance statistics of the ball players.⁶⁸ The participants in these leagues paid fees to play and additional fees to trade players.⁶⁹ Initially, C.B.C. licensed the use of the players’ names and information.⁷⁰ However, when that licensing agreement expired, MLBPA licensed the exclusive right to use that information to Major League Baseball, which began offering its own fantasy baseball products and services through its website, *MLB.com*.⁷¹ In response, C.B.C. filed a declaratory judgment action to determine the legality of continuing to operate its fantasy games.⁷²

While both the district court and the court of appeals ultimately followed the balancing approach illustrated by *Cardtoons*, concluding that there is a substantial public interest in discussing our Nation’s pastime,⁷³ the case raises the tantalizing possibility of avoiding balancing altogether. Fundamental to the district court’s analysis, and central to the court of appeals’ analysis, is the point that C.B.C. used the identities of the baseball players as facts and facts are not subject to intellectual property rights.⁷⁴ For example, the district court concludes that C.B.C. used the players’ names as facts rather than “as symbol[s] of their identit[ies],” as required by Missouri law.⁷⁵ And, as facts, the players’ names and performance statistics were part of information already in the public domain.⁷⁶ Similarly, the court of appeals concluded that, “the ‘recitation and discussion of factual data concerning the athletic performance of [players] command a substantial public interest, and, therefore, is a form of expression due substantial constitutional protection.’”⁷⁷ Moreover, “the facts in this case barely, if at all, implicate the interests that states typically intend to vindicate by providing rights of publicity to individuals.”⁷⁸

C.B.C. is intriguing for several reasons. First, it hints at an alternative approach for resolving the tension between free speech and the right of publicity by distinguishing between factual uses of names versus publicity uses, for lack of a better term. Unfortunately, the opinions do not readily explain how so-called factual uses of names differ from other uses typically controlled by the right of publicity.⁷⁹ The court of appeals appeared con-

818, 820 (8th Cir. 2007).

⁶⁸ *Id.* at 820-21.

⁶⁹ *Id.* at 821.

⁷⁰ *Id.*

⁷¹ *Id.*

⁷² *Id.*

⁷³ *Id.* at 823; 443 F. Supp. 2d 1077, 1096 (E.D. Mo. 2006).

⁷⁴ 505 F.3d at 823; 443 F. Supp. 2d at 1101.

⁷⁵ *C.B.C.*, 443 F. Supp. 2d at 1089.

⁷⁶ *Id.* at 1095.

⁷⁷ *C.B.C.*, 505 F.3d at 823-24 (quoting *Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307, 315 (Ct. App. 2001) (brackets in original)). Ironically, *Gionfriddo* concluded that Major League Baseball’s promotional use of ball-players’ names and likenesses did not violate their publicity rights.

⁷⁸ *Id.* at 824.

⁷⁹ See *infra* Part II.

fused on this very point when it criticized the district court, stating:

We think that by reasoning that "identity," rather than "mere use of a name," "is a critical element of the right of publicity," the district court did not understand that when a name alone is sufficient to establish identity, the defendant's use of that name satisfies the plaintiff's burden to show that a name was used as a symbol of identity.⁸⁰

Apparently, the court of appeals missed the point. As discussed in Part II, this distinction makes sense because the district court did not claim that a name cannot be used to identify an individual, but that C.B.C. was using the names and statistics descriptively.⁸¹ In other words, C.B.C. identified the players, but did not exploit their legally protected identities.

Second, the appellate court's reference to the public's interest in baseball does little to address the fact that C.B.C. was not using celebrity images to report the news or as social commentary. Under a *Cardtoons* balancing approach, the focus would be on how the information was used in expression (i.e., news, parody, or social criticism) rather than the topic of that expression (i.e., politics, sports, or entertainment). In *C.B.C.*, the players' names and information were used to make C.B.C.'s game more appealing to customers.⁸² C.B.C. could have provided a game using fictional names and statistics, but it preferred to use actual names and statistics.⁸³ As such, MLBPA's argument that C.B.C. used the players' names and performances to enhance the value of C.B.C.'s fantasy baseball products and services, and that it would be unfair to allow C.B.C. to profit from that value without compensating the players, is not so easily dismissed by labeling C.B.C.'s use as factual. However, for the reasons discussed in Part II, the approach taken in *C.B.C.* is analogous to the nominal use defense in trademark law and represents a valuable development for the right of publicity.

II. NOMINAL USE FOR THE RIGHT OF PUBLICITY

The tension between freedom of speech and intellectual property is not unique to the right of publicity. The conflict between laws that regulate expression, and a constitutional guarantee of freedom of expression, exists in trademark and copyright law as well.⁸⁴ And, while both trademark and copyright law recognize fair use as a defense, they also protect freedom of expression through "definitional balancing."⁸⁵ In other words, these laws

⁸⁰ *C.B.C.*, 505 F.3d at 822.

⁸¹ See *infra* Part II.

⁸² See *C.B.C.*, 505 F.3d at 822–23.

⁸³ See *id.* at 822.

⁸⁴ See Raymond Shih Ray Ku, *F(r)ee Expression?: Reconciling Copyright and the First Amendment*, 58 CASE W. RES. L. REV. (forthcoming 2008) (discussing copyright's internal mechanism for balancing copyright and free speech); Rebecca Tushnet, *Trademark Law as Commercial Speech Regulation*, 58 S.C. L. REV. 737 (2007) (discussing the ways in which trademark law and the First Amendment differ in approach); see generally Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1999).

⁸⁵ See Ku, *supra* note 84 (discussing the origins and limits of definitional balancing); see also Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and*

seek to reduce the tension between free speech and intellectual property rights, not only by making an exception for unauthorized expression that is valuable, but by concluding that certain expression is not part of the property right to begin with. In copyright law, this can be found in the idea/expression dichotomy, which limits copyright protection to how an author expresses ideas and not the ideas themselves.⁸⁶ In trademark law, definitional balancing is found in the requirement of trademark use, which limits liability to circumstances in which a defendant uses the trademark as a trademark. As the following argues, *C.B.C.* represents an effort to bring definitional balancing to the right of publicity and is analogous to the nominative use of trademarks as established by the Ninth Circuit's decision in *New Kids on the Block v. News America Publishing, Inc.*⁸⁷

New Kids involved a right of publicity claim brought by the musical act, New Kids on the Block, against two newspapers that conducted reader polls.⁸⁸ These polls asked readers to call 900-numbers to answer: "Which one of the New Kids is the most popular?"⁸⁹ and "Now which kid is the sexiest?"⁹⁰ Readers who called in were charged "50 cents" and "95 cents per minute," respectively.⁹¹ The New Kids sold "posters, T-shirts, badges, coffee mugs and the like" and also offered 900-numbers for fans to call and listen to the New Kids themselves and other fans as a means of generating income in addition to their musical act.⁹² They claimed that the newspapers' use of the New Kids violated their trademark rights protected under the Lanham Act, or, essentially, that the papers were "free-riding" on the New Kids' mark.⁹³ As the court noted, this "free-riding" is considered unfair because it represents something akin to fraud, and also because, "by using a rival's mark, the infringer capitalizes on the investment of time, money and resources of his competitor"⁹⁴ The newspapers claimed that the First Amendment protected their use as a form of newsgathering.⁹⁵

Instead of reaching the First Amendment issue, the court chose instead to resolve the matter on non-constitutional, trademark law grounds.⁹⁶ Initially, the court emphasized both the importance of trademark law in preventing unfair competition and, at the same time, the concern that trade-

Press?, 17 UCLA L. REV. 1180, 1189-93 (1970) (discussing the importance of definitional balancing); Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CAL. L. REV. 283, 293-99 (1979) (discussing the importance of fair use in definitional balancing).

⁸⁶ See Nimmer, *supra* note 85, at 1189-93 (discussing the importance of definitional balancing through the idea/expression dichotomy).

⁸⁷ 971 F.2d 302 (9th Cir. 1992).

⁸⁸ *Id.* at 304.

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² See *id.*

⁹³ *Id.* at 304-05.

⁹⁴ *Id.* at 305.

⁹⁵ *Id.*

⁹⁶ *Id.*

mark law not unduly deplete the English language of words, phrases, or symbols.⁹⁷ According to the court, trademark law expressly addresses the latter concern in two ways. First, trademark law denies protection to marks that are, or become, generic. As the court describes, “[w]hen a trademark comes to describe a class of goods rather than an individual product, the courts will hold as a matter of law that use of that mark does not imply sponsorship or endorsement”⁹⁸ Second, “when a trademark also describes a person, a place or an attribute of a product[.]” the law denies protection where the “mark is used only ‘to describe the goods or . . . services’”⁹⁹ The newspapers’ use of *New Kids*, however, did not squarely fit either category. The *New Kids* were not generic, nor did the papers use their trademark to describe the papers’ own product.¹⁰⁰

Nonetheless, the court concluded that it should recognize a related defense for nominative uses of a mark.¹⁰¹ According to the court:

[S]ometimes there is no descriptive substitute [for a mark], and a problem closely related to genericity and descriptiveness is presented when many goods and services are effectively identifiable only by their trademarks. For example, one might refer to “the two-time world champions” or “the professional basketball team from Chicago,” but it’s far simpler (and more likely to be understood) to refer to the Chicago Bulls.¹⁰²

Use of a trademark under these circumstances is “best understood as involving a non-trademark use of a mark—a use to which the infringement laws simply do not apply”¹⁰³ To accommodate these nominative uses, the court established a three-part test. Under this test, a commercial user would be entitled to use another’s trademark without authorization if: (1) “[T]he product or service in question . . . [is] one not readily identifiable without use of the trademark;”¹⁰⁴ (2) “only so much of the mark or marks is used as is reasonably necessary to identify the product or service;”¹⁰⁵ and (3) “the user does nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.”¹⁰⁶

In *New Kids*, the newspapers’ use of the band’s trademark satisfied all three elements.¹⁰⁷ The court reached this conclusion despite the fact that the newspapers were also making money separately from their newsgathering function, arguably in direct competition with 900-numbers offered by the band.¹⁰⁸ According to the court, because the newspapers did not use the

97 *Id.* at 305–06.

98 *Id.* at 306.

99 *Id.* (quoting 15 U.S.C. § 1115(b)(4)).

100 *Id.* at 308.

101 *Id.* at 309.

102 *Id.* at 306.

103 *Id.* at 307.

104 *Id.* at 308.

105 *Id.*

106 *Id.*

107 *Id.*

108 *Id.* at 309.

band's trademark in a manner that implied sponsorship or endorsement, "trademark laws do not give the New Kids the right to channel their fans' enthusiasm (and dollars) only into items licensed or authorized by them."¹⁰⁹ As recently suggested by Stacey Dogan and Mark Lemley, the right of publicity could learn a great deal from trademark law.¹¹⁰

Initially, the parallels between the right of publicity and trademark law should be readily apparent. Both grant individuals control over certain uses of words, images, and symbols, and both are justified, at least in part, on the basis of preventing consumer confusion and unjust enrichment.¹¹¹ Similarly, the parallels between *C.B.C.* and *New Kids* should also be apparent. In both cases, the unauthorized users were profiting from using the protected mark and names at issue, and yet both were found to be non-infringing.¹¹² In *C.B.C.*, the court focused upon the factual nature of the use of ball player names, while *New Kids* recognized an exception for nominative uses of trademarks. As discussed earlier, it was not immediately apparent why the factual nature of the use should matter. *New Kids*, however, sheds some light on *C.B.C.* if one considers it an attempt at definitional balancing akin to nominative use in trademark law.

As discussed in Part II, the district court originally concluded that MLBPA could not raise a right of publicity claim because *C.B.C.* used the players' names as facts rather than "as symbols of their identities."¹¹³ Under those circumstances, *C.B.C.*'s use of ball player names and statistics can be equated with the nominative use at issue in *New Kids*. *C.B.C.* used the ball player names to describe the individuals who took part in Major League Baseball and how they performed. They were not being put to "publicity use" (i.e., "lending" their hard earned credibility and reputation to the promotion of *C.B.C.*'s fantasy baseball products and services). In other words, the factual nature of ball players' names is not decisive. Ball player names (and trademarks) are facts and would remain facts even if used as part of false advertising, but few would suggest that the factual nature of such names and symbols should preclude liability when used in the context of false endorsement. Rather, *C.B.C.*'s use was decisive, even if some of the value of their products and services could be attributed to the use of real rather than fictional names and statistics. *C.B.C.*, like the newspapers in *New Kids*, put the names to nominative use. As in *New Kids*, it can be said that, under these circumstances, the right of publicity does not give celebrities the right to channel their fans' enthusiasm (and dollars) into only licensed or authorized products and services.

¹⁰⁹ *Id.*

¹¹⁰ Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161 (2006).

¹¹¹ *Id.* at 1164-65 (drawing the parallels between the right of publicity and trademark law and suggesting, among other things, that the right of publicity adopt a form of trademark use).

¹¹² *Compare* *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007) with *New Kids*, 971 F.2d 302.

¹¹³ 443 F. Supp. 2d 1077, 1089 (E.D. Mo. 2006).

Additionally, the three-part test of *New Kids* described above would be useful in right of publicity cases as well. Courts would permit the use of a celebrity's name without authorization if: (1) the celebrity in question is not readily identifiable without use of the person's name or likeness; (2) only so much of the celebrity's name or likeness is used as is reasonably necessary to identify the celebrity; and (3) the user does nothing that would, in conjunction with the celebrity's name or likeness, suggest sponsorship or endorsement by the celebrity.

Consider how it would apply to the facts of *C.B.C.* First, *C.B.C.* used the ball players' names to describe the actual players themselves; and, while there could be alternative ways to describe them, the players are not readily identifiable without resorting to their actual names. Second, *C.B.C.* used only the names and statistics of the players, which was, arguably, no more than was reasonably necessary to identify them. Third, *C.B.C.* did not use the players' names in any manner that suggested sponsorship or endorsement. As such, the *New Kids* test could become a valuable tool for evaluating unauthorized uses of celebrity names and likenesses. Moreover, as a movement towards definitional balancing in right of publicity cases, recognizing the privileged status of nominative uses of celebrity names and likenesses represents an important effort to alleviate the tension between free speech and the right of publicity.

CONCLUSION

As the baseball cases illustrate, courts have developed three approaches to the free speech and right of publicity conundrum. Traditionally, freedom of speech was literally not an issue and, subsequently, only an issue when the speech in question is sufficiently valuable to outweigh a celebrity's right to control the use of her name or likeness. The first position is clearly untenable; the second, undesirable. Freedom of speech is clearly at stake when the law limits a speaker's ability to engage in expression and having First Amendment protection hang on whether judges believe that the speech is "valuable," while an improvement, is itself, problematic. However, as this essay suggests, there is another way. Applying definitional balancing to the right of publicity and privileging nominative uses of celebrity names and likenesses is not only a step towards harmonizing publicity rights with both copyright and trademark law; it reduces the tension between free speech and the right of publicity. When one considers that the Supreme Court recently upheld copyright's restrictions upon speech, in large part because copyright protects free speech through definitional balancing *and* fair use (or interest balancing),¹¹⁴ this approach for the right of publicity may not only be prudent, but constitutionally required.

¹¹⁴ *Eldred v. Ashcroft*, 537 U.S. 186, 218-19 (2003) (rejecting the need to subject copyright to heightened scrutiny because copyright has "its own speech-protective purposes and safeguards.").