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Reinterpreting Jurisprudence: The Right of Publicity and Hoffman v. Capital Cities/ABC, Inc.

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REINTERPRETING JURISPRUDENCE: THE RIGHT OF PUBLICITY AND *HOFFMAN V. CAPITAL CITIES/ABC, INC.*[1]

I. INTRODUCTION

In *Hoffman v. Capital Cities/ABC, Inc.*,[2] the Ninth Circuit Court of Appeals held that the First Amendment of the United States Constitution protected the use of actor Dustin Hoffman's image in an article featured in *Los Angeles Magazine* (LAM).[3] In so holding, the court created questionable case precedent, which has led to inconsistent jurisprudence.

In its March 1997 "Fabulous Hollywood Issue!," LAM featured the *Grand Illusions* article which "used computer technology to alter famous film stills to make it appear that the actors were wearing Spring 1997 fashions."[4] The films and actors featured in the article included, among others, John Travolta in *Saturday Night Fever*, Marilyn Monroe in *The Seven Year Itch*, Cary Grant in *North by Northwest*, and Dustin Hoffman in *Tootsie*.[5]

Dustin Hoffman, who "has scrupulously guided and guarded the manner in which he has been shown to the public," never consented to LAM's use of his image.[6] Nevertheless, LAM featured the altered *Tootsie* photograph, which appeared much like the original, except "Hoffman's body and his long-sleeved red sequined dress were replaced by the body of a male model in the same pose . . . in a . . . gown by Richard Tyler and Ralph Lauren heels."[7] As a result,

1. 255 F.3d 1180 (9th Cir. 2001).
2. *Id.*
3. *Id.* at 1189.
4. *Id.* at 1183.
5. *Id.*
6. Hoffman v. Capital Cities/ABC, Inc., 33 F. Supp. 2d 867, 870–71 (C.D. Cal. 1999).
7. *Hoffman*, 255 F.3d at 1183.

Hoffman sued LAM alleging a violation of his right of publicity in his name, image, and likeness.[8]

This case Comment begins by providing a brief legal background of the relevant law regarding the right of publicity and the First Amendment. Next, this Comment summarizes and critically analyzes the Ninth's Circuit's decision in *Hoffman v. Capital Cities/ABC, Inc.* Finally, this Comment concludes that the Ninth Circuit's conclusion was unsound, its reasoning unpersuasive, and, as a result, subsequent courts face the difficulty of distinguishing or reinterpreting the court's decision.

II. BACKGROUND

A. Right of Publicity as a Property Right

"The right of publicity is the inherent right of every human being to control the commercial use of his or her identity."[9] The right of publicity protects the commercial interests that private citizens and celebrities have in their identities.[10] A celebrity's identity can be valuable in promoting products and therefore, celebrities have an interest in preventing unauthorized commercial exploitation of their identities.[11] Therefore, the right of publicity has "some social utility" in that it serves to protect those, primarily celebrities, who expended "considerable money, time and energy" in developing their own "skill, reputation, notoriety or virtues . . . to permit an economic return through some medium of commercial promotion."[12]

8. *See id.* Hoffman sued LAM for violations of his common law and California's statutory right of publicity, and also alleged a violation of the California unfair competition statute and the Federal Lanham Act. *Id.*

9. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:01 (4th ed. 2003).

10. *See* White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1398 (9th Cir. 1992).

11. *See id.*

12. Comedy III Prods. v. Gary Saderup, Inc., 21 P.3d 797, 804–05 (Cal. 2001) (quoting Lugosi v. Universal Pictures, 25 Cal. 3d 813, 834–35 (1979) (Bird, C. J., dissenting)).

The right of publicity emerged from the laws of unfair competition, misappropriation, fraud, and privacy.[13] However, that right was first independently recognized in 1953 by the Court of Appeals for the Second Circuit.[14] In *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,[15] the Second Circuit held that baseball players had the right to stop the unauthorized commercial use of their likenesses and playing statistics on baseball cards.[16] The court further expressed that individuals possess a property right in their identities, which allows them to grant exclusive use of their identities to one company in a specific market.[17]

Following the landmark decision in *Haelan*, many states began recognizing the right of publicity as a distinct intellectual property right.[18] Today, the right of publicity is widely recognized throughout the country on both common law and statutory grounds.[19] Under California state law, courts consider the right of publicity an intellectual property right, the infringement of which is considered a commercial tort of unfair competition.[20]

California also provides a statutory remedy for the infringement of the right of publicity and provides that:

> Any person who knowingly uses another's name, . . . photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent . . . shall be liable for any damages sustained by the person . . . injured as a result thereof.[21]

The California statute is consistent with the underlying principle that an individual's personality right or right of publicity is a

13. *See* J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY §§ 1:3–4 (2d ed. 2003).
14. *See* Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953).
15. *Id.*
16. *Id.* at 869.
17. *Id.* at 868–69.
18. *See* MCCARTHY, *supra* note 13, § 1:4.
19. *See id.* §§ 1:3–4.
20. *See id.* § 1:3.
21. CAL. CIV. CODE § 3344 (West 2003).

property right that deserves protection.[22] In particular, celebrities by virtue of their time, effort, and labor invested a great deal to create their famous and commercially valuable identities.[23] Accordingly, the courts justifiably protect these rights because it prevents unjust infringement by those who participate in deceptive trade practices and false advertising to benefit from the marketability of identities that they did not create.[24]

B. The Right of Publicity and the First Amendment

The right of publicity allows individuals and celebrities to maintain exclusive control over their names and images.[25] Thus, they may exclude others from using their names and images without prior consent.[26] A tension therefore exists between the right of publicity and the First Amendment. The First Amendment protects freedom of speech.[27] The government's grant of the exclusive property right to individuals in their identities often restrains, and thus conflicts, with the public's arguable First Amendment right to use the individual's name or image as part of their own expressive messages.[28] Defendants often argue that the right of publicity violates their constitutional right to free speech by "inhibit[ing] public debate and censor[ing] creative expressions."[29] Courts often resolve this conflict between the right of publicity and free speech by invoking the commercial speech doctrine.[30]

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22. *See id.*

23. *See* White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1399 (9th Cir. 1992) (holding that White's identity is so famous that it carries commercial value capable of marketing to advertisers); *see also* Winter v. DC Comics, 69 P.3d 473, 478 (Cal. 2003) ("[T]he right of publicity holder possesses . . . a right to prevent others from misappropriating the economic value generated by the celebrity's fame . . . ").

24. Chia Heng Ho, Note, *Hoffman v. Capital Cities/ABC, Inc.*, 17 BERKELEY TECH. L.J. 527, 530–31 (2002).

25. *See White*, 971 F.2d at 1399.

26. *See id.* at 1397 (Plaintiff alleged that defendant used her image in violation of her exclusive property right in her own identity).

27. U.S. CONST. amend. I.

28. *See White*, 971 F.2d at 1401 n.3.

29. Chia Heng Ho, *supra* note 24, at 532.

30. *See* Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 564–65 (1977).

Commercial speech is generally defined as speech that "does no more than propose a commercial transaction."[31] Commercial speech is entitled to lesser First Amendment protection than noncommercial speech.[32] Nonetheless, commercial speech is entitled to some protection as it "is necessary to insure that the flow of truthful and legitimate commercial information is unimpaired."[33] In order to restrain speech in the context of right of publicity cases, if the speech is classified as commercial, "a public figure plaintiff does not have to show that the speaker [or defendant] acted with actual malice."[34]

Accordingly, commercial speech is not entitled to absolute First Amendment protection.[35] The rationale justifying a lower threshold of protection for artistic expression that depicts or imitates a celebrity for commercial gain is based on the idea that such expression both "directly trespass[es] on the right of publicity without adding significant expression beyond that trespass, [and compromises] the state law interest in protecting the fruits of artistic labor [which] outweighs the expressive interests of the imitative artist.[36]

While courts grant commercial speech little First Amendment protection, in contrast, "work[s] [that] contain significant transformative elements . . . [are] especially worthy of . . . protection [as they are] . . . less likely to interfere with the economic interest protected by the right of publicity."[37] This other class of speech, "noncommercial speech," is often described as "communicative" or "expressive."[38] Examples of expressive activities include movies, books, magazine articles, political activities and the like.[39] Thus, an expressive transaction may be capable of receiving economic

31. *Hoffman*, 255 F.3d at 1184 (quoting Bolger v. Youngs Drug Prods. Corp., 463 U.S. 60, 66 (1983)).
32. *Id.*
33. Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc., 425 U.S. 748, 772 n.24 (1976).
34. *Hoffman*, 255 F.3d at 1185.
35. *See id.*
36. Comedy III Prods. v. Gary Saderup, Inc., 21 P.3d 797, 808 (Cal. 2001) (citing Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 575–76).
37. *Id.*
38. *See id.* at 803.
39. *See id.* at 804.

benefits even though courts will not necessarily consider the activity commercial speech.[40]

In addition to engaging in non-commercial speech, another way to receive broad First Amendment protection is if the publication or work is of "public interest" and does not "contain knowing or reckless falsehood."[41] "[T]he definition of 'public interest' sweeps up any publication regarding public figures and celebrities, as well as publications regarding private citizens who become associated with some issue that has caught the public eye."[42] The idea that the media has a right to report on matters of legitimate public concern and interest, regardless of an individual's right of publicity, was confirmed in *Zacchini v. Scripps-Howard Broadcasting Co.*[43] However, the right to report is not absolute. The Court noted that the right to report on issues of public interest must be balanced between the individual's personal interest and the state's interest in providing the publicity cause of action, on the one hand, and First Amendment interests, on the other.[44] Accordingly, although it is important to prevent unjust enrichment and to promote and encourage creativity, these interests must be balanced against the idea of chilling free speech.[45]

III. PROCEDURAL AND SUBSTANTIVE FACTS

In *Hoffman v. Capital Cities/ABC, Inc.*,[46] the plaintiff Dustin Hoffman sued the defendant ABC, Inc., which owns LAM.[47] Dustin Hoffman is a successful motion picture actor who has a "strict policy of not endorsing commercial products for fear that he will be perceived in a negative light . . . suggesting that his career is in decline and that he no longer has the business opportunities or the

40. *See* New York Times v. Sullivan, 376 U.S. 254, 266 (1964).

41. Schuyler M. Moore, *Putting the Brakes on the Right of Publicity*, 9 UCLA ENT. L. REV. 45, 49 (2001).

42. *Id.* at 49–50 (citing *Sullivan*, 376 U.S. at 254).

43. 433 U.S. 562 (1977).

44. *Id.* at 578.

45. *See* Alison P. Howard, *A Fistful of Lawsuits: The Press, the First Amendment, and Section 43(a) of the Lanham Act*, 88 CAL. L. REV. 127, 161–63 (2000).

46. 33 F. Supp. 2d 867 (C.D. Cal. 1999).

47. *Id.*

box office draw as before."[48] In its March 1997 issue, LAM published an article entitled *Grand Illusions*, which employed computer technology to manipulate photographs of famous actors and actresses to make it appear that they were wearing Spring 1997 designer fashions.[49]

The *Grand Illusions* article contained a photograph of Hoffman as he appeared in the 1982 movie *Tootsie*.[50] The original movie still depicted Hoffman in a red-sequined gown standing in front of the American flag.[51] The computer-generated photograph in the LAM article incorporated only Hoffman's head and the American flag, but replaced Hoffman's body with a male model's body dressed in a gown by Richard Tyler and shoes by Ralph Lauren.[52] LAM neither sought nor obtained Hoffman's permission to publish the digitally altered photograph in the magazine.[53]

Hoffman sued ABC, the parent company of LAM, in California state court alleging common law and statutory violations of the right of publicity, violation of the state unfair competition statute, and the Federal Lanham Act.[54] "ABC removed the case to federal court" and "Hoffman added LAM as a defendant."[55]

A. District Court Decision

Hoffman succeeded at the district court level on all of his claims.[56] The court found LAM's First Amendment defense unavailing, explaining that LAM's use of Hoffman's name and likeness was a commercial use, which enjoyed lower First Amendment protection.[57] This commercial use met the elements required to establish a right of publicity claim because it was

48. *Id.* at 870.
49. *Id.*
50. *Id.*
51. *Id.*
52. *Id.*
53. *Id.* at 871.
54. *Hoffman*, 255 F.3d at 1183; *see also* CAL. CIV. CODE § 3344 (West 2003) (California right to publicity statute), CAL. BUS. & PROF. CODE § 17200 (West 2003) (California unfair competition statute), Lanham Act, 15 U.S.C. § 1125(a) (2000).
55. *Hoffman*, 255 F.3d at 1183.
56. *Hoffman*, 33 F. Supp. 2d at 873–74.
57. *Id.* at 874–75.

knowingly false, hence not protected by the First Amendment.[58] Furthermore, the district court determined that the "public interest" defense did not apply because the case did not involve a "bona fide and traditional news or public affairs report."[59]

B. Summary of Ninth Circuit Decision

LAM appealed the district court's decision in favor of Hoffman.[60] The Ninth Circuit reversed the ruling, holding that LAM's publication of the *Grand Illusions* article, which contained the *Tootsie* photograph, was not commercial speech.[61] The court determined the photograph consisted of a combination of "fashion photography, humor, and visual and verbal editorial comment on classic files and famous actors."[62] Thus, the photograph was within the purview of public interest and worthy of broad First Amendment protection.[63] Furthermore, the court concluded that the magazine's alteration of Hoffman's image did not constitute a knowing falsehood because readers would know that the picture was digitally altered.[64]

The Ninth Circuit's decision in *Hoffman* has led to much controversy because it has resulted in—and it will continue to result in—many inconsistent rulings.[65] The court did not clearly articulate a standard for "public interest," nor did it outline a test for determining what constitutes "commercial speech."[66] As such, the Ninth Circuit erred when it held that the First Amendment protected the digitally altered photograph.[67] The remainder of this Comment will address the ill-reasoned analysis of the Ninth Circuit, as well as the implications of this erroneous decision.

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58. *Id.* at 875.
59. *Id.*
60. *Hoffman*, 255 F.3d at 1183.
61. *Id.* at 1186.
62. *Id.* at 1185.
63. *See id.* at 1186.
64. *See id.* at 1187–88.
65. *See generally* Downing v. Abercrombie & Fitch, 265 F.3d 994 (9th Cir. 2001) (concluding that retailer's use of appellant's photograph was not entitled to First Amendment protection).
66. *See Hoffman*, 255 F.3d at 1180 (explaining the court's reasoning); *see also* Moore, *supra* note 41, at 50 n.21.
67. *Hoffman*, 255 F.3d at 1189.

IV. ANALYSIS

A. Public Interest & Noncommercial Use

The court determined that LAM was "entitled to full First Amendment protection awarded noncommercial speech."[68] This holding is flawed in three important respects: (1) the article was summarily classified as one of public interest; (2) the court determined the digital alteration "was not a knowing falsehood because reasonable readers would know from the context of the article that the magazine had [created the alterations] by computer;"[69] and (3) the court considered the article noncommercial speech.

"The Supreme Court has held that the First Amendment provides an absolute defense to publication-based tort actions for publications on matters of public interest, unless the publications contain knowing or reckless falsehood."[70] While magazine articles, books, and movies are often entitled to this protection, advertisements are not.[71] The Ninth Circuit in *Hoffman* qualified the *Grand Illusions* article in LAM as one of public interest, but it did not explain why.[72] The extent of the court's reasoning was that "the article as a whole is a combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors."[73]

Some may argue that fashion, in and of itself, is a matter of public interest. Others may argue that celebrities or entertainers are subjects of public interest as "[w]e monitor their comings and goings, their missteps and heartbreaks . . . copy their mannerisms, their styles, their modes of conversation and of consumption."[74]

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68. *Id.*

69. Moore, *supra* note 41, at 50; *see also Hoffman*, 255 F.3d at 1184–88 (stating that the totality of the presentation of the article and the *Tootsie* photograph did not convince the court that LAM's editors intended to falsely suggest to readers that they were seeing Hoffman's body).

70. Moore, *supra* note 41, at 49.

71. *See Hoffman*, 255 F.3d at 1184–86 (deciding LAM's alteration of the *Tootsie* photograph is entitled to First Amendment protection).

72. *See id.* at 1180.

73. *Id.* at 1185.

74. Comedy III Prods. v. Gary Saderup, Inc., 21 P.3d 797, 803 (Cal. 2001).

In addition, often times the celebrity and fashion are combined in one medium, and the bright-line distinction between matters of public interest and pure advertisement becomes blurred. The photographic depiction of Hoffman in the Richard Tyler evening gown and Ralph Lauren shoes arguably contains some elements of public interest, i.e. fashion and celebrity.[75] However, the photograph also mirrors as an advertisement for Spring 1997 fashions as the manufacturer, price, and availability of the items were described in text immediately adjacent to the photograph.[76] Thus, an important issue arises because courts are forced to draw an arbitrary line between what constitutes a per se advertisement and what is merely an "editorial comment" on high fashion deserving of First Amendment protection.

Assuming, arguendo, that an article depicting Dustin Hoffman in high fashion is considered to be a matter of public interest, the Ninth Circuit's decision not to find the article knowingly or recklessly false is questionable.[77] The digitally altered image was knowingly false as it contained Hoffman's face, head, and the American flag from the original movie still, but replaced Hoffman's body with one of a male model dressed in designer fashions.[78] Defendant LAM knew that Hoffman never wore the clothes that the image depicted him as wearing, and that they used someone else's body in the picture.[79] Moreover, the magazine "admitted that it intended to create the false impression in the minds of the public 'that they were seeing Mr. Hoffman's body.'"[80]

The Ninth Circuit reasoned that the *Grand Illusions* article was not knowingly false because the title page disclaimed that it digitally altered the photographs.[81] The court also pointed to the Contributors page, which indicated that LAM used the "latest in computer software to give old movie stars makeovers for 'Grand Illusions.'"[82] The court justified its decision by stating that, considering most of

75. *See Hoffman*, 33 F. Supp. 2d at 870.
76. *See Hoffman*, 255 F.3d at 1185.
77. *See id.* at 1188.
78. *See Hoffman*, 33 F. Supp. 2d at 870.
79. *Id.* at 875.
80. *Id.*
81. *See Hoffman*, 255 F.3d at 1188.
82. *Id.*

the actors featured in the article were deceased, it would be clear that "models' bodies were digitally substituted for the actors bodies."[83]

Nevertheless, this reasoning is flawed because it suggests that if a disclaimer appears on a false news report or in an inaccurate portrayal in a book or magazine, it is still considered worthy of First Amendment protection so long as it pertains to a matter of public interest.

Additionally, some legal scholars have raised concerns about legally classifying celebrities as subjects of public interest.[84] If a celebrity's photograph is considered to be a matter of public interest, his image could be exploited without his consent. This exploitation raises other First Amendment issues because it may chill the creation of intellectual property, which is often comprised of speech.[85] Celebrities would be reluctant to pose for promotional products, such as movie stills, for fear that their images may be altered and immune from attack. Furthermore, while a celebrity, such as Dustin Hoffman, may wish to refrain from exploiting his image to maintain the integrity of his craft, other third parties may exploit his image under the guise of public interest and become unjustly enriched thereby.[86]

Another troubling aspect of this decision was the Ninth Circuit's conclusion that the digitally altered photograph of Dustin Hoffman constituted noncommercial speech.[87] In an attempt to justify its decision, the court pointed to other right of publicity cases where the challenged use involved the appropriation of the celebrity's persona in the context of an advertisement.[88] The court distinguished those cases from Hoffman's because the *Tootsie* photograph was not

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83. *Id.*

84. *See id.*

85. *See* 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, 479–80 (2003).

86. *See Hoffman*, 255 F.3d at 1180.

87. *See Id.* at 1186.

88. *See id.* at 1185 (citing Newcombe v. Adolph Coors Co., 157 F.3d 686, 691 (9th Cir. 1998); Abdul-Jabbar v. Gen. Motors Corp., 85 F.3d 407, 409 (9th Cir. 1996); White v. Samsung Elecs. Am. Inc., 971 F.2d 1395, 1396 (9th Cir. 1992)).

blatantly directed to the sole purpose of selling designer fashions or issues of *LAM*.[89]

Additionally, the *Grand Illusions* article was featured on the cover of the magazine and in the table of contents to draw public attention and promote the sale of the magazine.[90] The court reasoned that "LAM did not use Hoffman's image in a traditional advertisement printed merely for the purpose of selling a particular product."[91] "Viewed in context, [the court found that] the article as a whole is a combination of fashion photograph, humor, and visual and verbal editorial comment on classic films and famous actors."[92] Thus, the court concluded that LAM's use of the image was not commercial.[93]

Despite the court's decision to find the use noncommercial, the *Grand Illusions* article and the *Tootsie* photograph appear to have been featured in LAM primarily for the commercial purpose of advertising. Of significance is the fact that the "shopping guide" located towards the back of the magazine referenced the *Grand Illusions* article and provided price and store information for the clothing used in the *Tootsie* photograph.[94] Thus, the clothing depicted in the *Tootsie* photograph was tied directly to commercial advertising.

If, in fact, the article was meant to provide editorial comment, LAM should not have felt compelled to provide readers with information about where to buy the clothing.[95] Moreover, it appears that LAM sought not only to generate revenues through sales, but also through the sale of advertisements. By featuring their clothing in the article, LAM endorsed the related designers and attempted to sell advertisements to these designers.[96] Accordingly, the *Grand Illusions* article may be perceived as an "under-the-table arrangement with actual or potential advertisers which would convert an apparent news story into a paid advertisement."[97]

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89. *See id.*
90. *See id.*
91. *Id.*
92. *Id.*
93. *Id.* at 1186.
94. *See Hoffman*, 33 F. Supp. 2d at 870.
95. *See Hoffman*, 255 F.3d at 1188.
96. *See Hoffman*, 33 F. Supp. 2d at 870–71.
97. *See* Grant v. Esquire, Inc., 367 F. Supp. 876, 883 (S.D.N.Y. 1973).

The *Hoffman* case is similar to *Grant v. Esquire, Inc.*,[98] where *Esquire* magazine used Cary Grant's modified image in its magazine article without his consent.[99] However, the court in *Grant* found that the magazine used the celebrity's image to attract attention to its article and thus infringed on Grant's right of publicity.[100] Similarly, the Ninth Circuit should have followed the precedent of the *Grant* court and upheld the district court's ruling because LAM did not ask for Hoffman's authorization before using his image in its article.[101] Similar to *Esquire* magazine, LAM sought to exploit the images of the celebrities featured in the *Grand Illusions* article without paying "the going rate for such benefit."[102]

In a subsequent Ninth Circuit decision, the court conceded that LAM's use had some commercial purpose.[103] Other aspects of the Ninth Circuit's decision in *Hoffman* are similarly problematic. Assuming the *Grand Illusions* article and the *Tootsie* photograph constitute a matter of public interest, the digitally altered photograph was clearly a concerted false representation, which apparently was remedied by placing disclaimers in the magazine.[104] Taken together, these factors should have been enough to support a decision not to grant LAM "full First Amendment protection awarded [to] noncommercial speech."[105] If the Ninth Circuit was adamant about protecting LAM's use of the celebrity images within the *Grand Illusions* article, the court should have supported its decision on different grounds.

B. Transformative/Fair Use

In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,[106] the California Supreme Court acknowledged that some commentators

98. *Id.*
99. *See id.* at 881.
100. *See id.* at 880–81.
101. *See Hoffman*, 33 F. Supp. 2d at 871.
102. *Grant*, 367 F. Supp. at 883; *see also Hoffman*, 33 F. Supp. 2d at 872 (stating that defendant should have known that celebrities would demand payment for the use of their names and likenesses).
103. *See* Downing v. Abercrombie & Fitch, 265 F.3d 994, 1002–03 n.2 (9th Cir. 2001) (finding that "Abercrombie's use was much more commercial in nature" than LAM's use).
104. *See Hoffman*, 255 F.3d at 1187–88.
105. *Id.* at 1189.
106. 21 P.3d 797 (Cal. 2001).

have proposed using the "fair use" defense from copyright law as an affirmative defense in the right of publicity context.[107] The fair use defense involves a balancing of four factors: "(1) the purpose and character of the [copyrighted] use . . . ; (2) the nature of the copyrighted work; (3) the . . . substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work."[108]

The California Supreme Court determined it inappropriate to incorporate the entire fair use doctrine into right of publicity law.[109] The court indicated that two of the factors of the fair use defense, "the nature of the copyrighted work" and "the amount and substantiality of the portion used" would not be especially pertinent to the determination of whether the "depiction of a celebrity likeness is protected by the First Amendment."[110]

However, the California Supreme Court did indicate that the first factor of the fair use defense, "the purpose and character of the use," would be particularly useful in reconciling First Amendment interests with the right of publicity.[111] This first factor asks whether the use is "transformative" by adding a different character, expression, or message to the original creation.[112]

Like copyright law, right of publicity law seeks both to encourage "free expression and creativity" and to protect the "creative fruits of intellectual and artistic labor."[113] When the expression literally depicts the image of the celebrity, the state has an interest in protecting the celebrity rather than the imitative artist.[114] However, if the work is transformative, it has significant expressive elements and is more deserving of First Amendment protection as it is also "less likely to interfere with the economic interest protected by the right of publicity."[115]

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107. *See id.* at 807.
108. 17 U.S.C. § 107 (2000).
109. *See Comedy III Prods.*, 21 P.3d at 807.
110. *See id.* at 807–08 (citing 17 U.S.C. § 107(2) & (3)).
111. *See id.* at 808.
112. *See id.*
113. *Id.*
114. *See id.*
115. *Id.*

The purpose and character factor is inextricably entwined with the factor which considers the amount and substantiality of the use of the celebrity's likeness.[116] If the work is transformative, then usually the "product containing [the] celebrity's likeness [will be considered] so transformed that it . . . become[s] primarily the defendant's own expression rather than the celebrity's likeness."[117] If the challenged work is a literal depiction of the celebrity, it likely derives economic value primarily from the celebrity depicted. Thus, it would be considered an actionable right of publicity as the marketability and economic value of the celebrity has been affected.[118] However, if "the value of the work comes . . . from the creativity, skill, and reputation of the artist . . . it may be presumed that sufficient transformative elements are present to warrant First Amendment protection."[119]

Accordingly, when "faced with a right of publicity challenge to his or her work . . . [a defendant] may raise as an affirmative defense that the 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."[120] However, in *Hoffman*, the Ninth Circuit did not even apply the fair use defense when deciding to grant LAM First Amendment protection.[121] Yet the court did allude to the transformative nature of the work in one subtle footnote.[122]

The court in *Hoffman* distinguished *Comedy III* on the ground that the former contained "significant transformative elements" since "Hoffman's body was eliminated and a new, differently clothed body was substituted in its place."[123] However, the court's reasoning is flawed because the alterations in the *Tootsie* photograph are not significant. Although a male model's body was used, the frame of the body is nearly identical to Hoffman's body as photographed in the original movie still.[124] Moreover, the average reasonable reader

116. *See id.* at 809.
117. *See id.*
118. *See id.* at 810.
119. *Id.*
120. *Id.* at 797.
121. *See Hoffman*, 255 F.3d at 1184–89.
122. *Id.* at 1184 n.2.
123. *See id.*
124. *See id.* at 1187–88.

would not notice that LAM replaced Hoffman's body with that of another. Also, although Hoffman is in different clothing, a mere change of dress is not enough to constitute a significant transformative element.[125]

Hence, it is the opinion of this author that LAM did not have a valid defense for its unauthorized use of Dustin Hoffman's image, celebrity, and likeness. For these reasons, the Ninth Circuit erred in granting LAM First Amendment protection. Moreover, the Ninth Circuit failed to clearly articulate the reasons for its holding. As a result, subsequent courts have rendered inconsistent rulings and have attempted to reinterpret the case in ways which are not justified by the Ninth Circuit's decision.[126]

V. IMPLICATIONS OF DECISION

The Ninth Circuit rendered a flawed decision in *Hoffman v. Capital Cities*,[127] thus creating a burden for subsequent courts attempting to either distinguish the case or follow its precedent. The problematic nature of the *Hoffman* decision was first evidenced in another Ninth Circuit decision, *Downing v. Abercrombie & Fitch*.[128]

In *Downing*, surfers sued Abercrombie & Fitch, a clothing company, for publishing photographs of them and disclosing their names without their authorization in Abercrombie's catalogue.[129] Unlike the *Hoffman* decision, the *Downing* court used the correct analysis and came to the exact opposite conclusion.[130]

In *Downing*, the Ninth Circuit concluded that the photographs placed in the catalog did not "contribute significantly to a matter of the public interest and that Abercrombie [could not] avail itself of the First Amendment defense."[131] Furthermore, the court deemed

125. *See id.* at 1184 n.2.

126. *See* Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894 (2002) (referencing the *Hoffman* decision in the context of the parody defense); *see also* Downing v. Abercrombie & Fitch, 265 F.3d 994 (2001) (interpreting the *Hoffman* decision).

127. 255 F.3d 1180 (9th Cir. 2001).

128. *See Downing*, 265 F.3d at 1002 n.2.

129. *See id.* at 999–1000.

130. *See id.* at 1001–10 (holding that illustrative use of the surfers' photographs did not contribute significantly to a matter of public interest and was not entitled to First Amendment protection).

131. *Id.* at 1002.

Abercrombie's use commercial in nature, and, therefore, it was not entitled to full First Amendment protection.[132] As in *Downing*, the Ninth Circuit should have held in *Hoffman* that LAM's use of Hoffman's image constituted a mere "window-dressing to advance the [magazine's] theme" of famous motion picture actors in designer clothing.[133] Thus, the court should have held that LAM's use of Hoffman's image in its "Fabulous Hollywood Issue!" was not entitled to the First Amendment protection since it did not contribute significantly to public interest, but, rather, primarily advanced magazine revenues.

The court distinguished the two cases on the grounds that "Abercrombie, itself, used [the] images in its catalog to promote its clothing, [while] L.A. Magazine was unconnected to and received no consideration from the designer for the gown depicted in the article."[134] Although the Ninth Circuit made a valiant effort in attempting to distinguish *Hoffman*, it failed to do so as LAM, itself, used Hoffman's image in its magazine to draw the attention of the public and designers so they could sell both magazines and advertising space. *Downing* is but one example of the inconsistent rulings that have resulted and that will continue to result as long as *Hoffman* is considered good law.

Another consequence of the weak arguments set forth in *Hoffman* is that courts will attempt to distinguish the case on any basis they can conceptualize, even if such arguments are not supported by the facts in the original case. Indeed, the Ninth Circuit has even implicitly recognized the weaknesses of the logic in the *Hoffman* case by later reinterpreting the decision to be based on the parody defense, even though parody was never mentioned in the original decision.[135]

The danger of this "reinterpreting" is evidenced in *Mattel, Inc. v. MCA Records, Inc.*,[136] where the Ninth Circuit decided an action brought by toy manufacturer Mattel against music company MCA for trademark infringement and dilution associated with the song

132. *See id.* at 1002–03 n.2.
133. *Id.* at 1002; *see also Hoffman*, 33 F. Supp. 2d at 872.
134. *Downing*, 265 F.3d at 1002 n.2.
135. *See* Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894 (9th Cir. 2002).
136. *Id.*

"Barbie Girl" by the band Aqua.[137] The Ninth Circuit held that "Barbie Girl is not purely commercial speech, and is therefore fully protected . . . [as] . . . the song lampoons the Barbie image and comments humorously on the cultural values Aqua claims she represents."[138] The court supported its decision by citing *Hoffman* and conceded that the use of Hoffman's image "clearly served a commercial purpose: 'to draw attention to the for-profit magazine in which it appear[ed]' and to sell more copies."[139]

Although the *Mattel* case was correctly decided, the Ninth Circuit erred in citing *Hoffman* as precedent for granting MCA First Amendment protection based on the parody defense.[140] LAM never raised the parody defense, nor did the court discuss or allude to the issue of parody. The fact that the same court reinterpreted its decision, only one year later, speaks volumes about the flawed *Hoffman* holding.

VI. CONCLUSION

Dustin Hoffman is a highly successful and recognizable actor. To preserve his professional integrity, Dustin Hoffman has always maintained that he will not commercialize his identity.[141] LAM's unauthorized use of Hoffman's image violated the actor's professional ideal. LAM could have contracted other actors or entertainers who have demonstrated their willingness to authorize the use of their images instead of using the *Tootsie* photograph without Hoffman's permission and without adequate compensation for the photograph's benefits.

"There is no doubt that entertainment, as well as news, enjoys First Amendment protection. It is also true that entertainment itself can be important news." [142] However, the Ninth Circuit erred in finding that *Los Angeles Magazine* was entitled to broad First Amendment protection because although Dustin Hoffman and fashion may be considered matters of public interest, the digitally altered photograph of the actor was false and misleading. Moreover,

137. *See id.* at 899.
138. *Id.* at 906–07.
139. *Id.* at 906.
140. *See id.*
141. *See id.* at 870.
142. Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 578 (1977).

the magazine article constituted commercial speech, which should be granted only limited First Amendment protection because the article did not contain significant transformative elements. The Ninth Circuit's erroneous decision has resulted in—and will continue to result in—inconsistent jurisprudence unless and until the court explicitly recognizes its flawed reasoning and inaccurate decision.

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