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# ARTICLES

## AGENTS OF CHAOS: JUDICIAL CONFUSION IN DEFINING THE RIGHT OF PUBLICITY-FREE SPEECH INTERFACE

*Mark S. Lee\**

### I. INTRODUCTION

Speech is free, but the resources needed to create it cost money. A constitutional “speaker” may not have that money. Can the speaker take or use others’ property to enable speech? If so, when?

The answer to these questions may seem obvious in many contexts. Few would argue that a filmmaker could rob a bank to get the money needed to make a movie. Few would argue that a screenwriter could steal word processing equipment to write a screenplay. And few would argue that an artist could walk into a supply store and help herself to the pigments and oils needed to create a painting.<sup>1</sup> Although flag burning has been recognized as constitutionally-protected “speech,”<sup>2</sup> it seems unlikely that the First Amendment would permit one to take Old Glory and burn it, or even slightly damage it, to enable such speech, because this would infringe on another’s property rights. In other words, these “constitutional” speakers’ First Amendment rights end where another’s property rights begin.

For reasons often not clearly articulated, these questions have proven more difficult to answer when the property taken is intellectual property. Constitutional “speakers” often wish to use others’ intellectual property to communicate their “message.” An artist might wish to duplicate a

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1. *See Grant v. Esquire, Inc.*, 367 F. Supp. 876, 883 (S.D.N.Y. 1973) (“[N]obody would seriously contend that artistic need would authorize a painter to walk into a supply store and help himself to whatever he might require.”).

2. *United States v. Eichman*, 496 U.S. 310, 318–19 (1990).

copyrighted photograph to create a new artistic work. A musician might wish to use someone else's copyrighted poem or samples of earlier music as the lyrics to or accompaniment for a song. A screenwriter might want to use a book as the basis for a screenplay. A producer might wish to use a copyrighted musical composition in the soundtrack of a motion picture or television commercial, or a trademark or celebrity image in the substance of that same motion picture or television commercial.

Courts have struggled to accommodate these competing interests in the intellectual property context.<sup>3</sup> Copyright and trademark law have developed approaches that operate with varying degrees of success. However, courts have largely failed to fashion clearly-articulable standards in what is arguably the newest form of intellectual property recognized in the United States—the right of publicity.<sup>4</sup> Despite two United States Supreme Court decisions and decades of caselaw, the current legal landscape is a confusing morass of inconsistent, sometimes non-existent, or mutually exclusive approaches, tests, standards, and guidelines, with the confusion only increased by several recent rulings.<sup>5</sup>

This Article discusses the various approaches courts have followed to adjudicate First Amendment defenses to right of publicity claims, evaluates the strengths and weaknesses of these approaches, and suggests standards that, in the author's view, may help reconcile the competing property and expressive interests in the context of the right of publicity.

## II. PROPERTY AND SPEECH

### *A. Background Regarding Property*

While a clear definition can be elusive, "property" has been described as "everything which one person can own and transfer to another."<sup>6</sup> It is "that dominion or indefinite right of user and disposition which one may lawfully exercise over particular things or objects."<sup>7</sup> It may be characterized as that which has economic value and the law permits to be bought and sold.

There are two basic types of property, namely, real property

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3. See discussion *infra* Part IV.A–B.

4. See discussion *infra* Part IV.C.

5. See discussion *infra* Part IV.C.

6. *Yuba River Power Co. v. Nevada Irrigation Dist.*, 279 P. 128, 129 (Cal. 1929); see also CAL. CIV. CODE § 654 (West 1982).

7. *Texas Co. v. Hauptman*, 91 F.2d 449, 451 (9th Cir. 1937).

(involving land and similar real estate) and personal property. "Every kind of property that is not real is personal."<sup>8</sup> As such, intellectual property is generally characterized as intangible personal property.<sup>9</sup>

Further, the ability to acquire and protect property is one of the foundations of Anglo-Saxon jurisprudence, and is the bedrock of our economy. It is impossible to have efficient commerce without a clear understanding of what property there is to buy and sell, and what may be done with it.<sup>10</sup> Property is protected by the constitutions of the United States and the states for this reason. Within narrow substantive restrictions,<sup>11</sup> the United States Constitution leaves it to the states to define what property is,<sup>12</sup> but several provisions of the Constitution recognize and protect private property rights once that property has been defined. For example, the Fourth Amendment prohibits unreasonable searches and seizures of private property.<sup>13</sup> The Fifth and Fourteenth Amendments prohibit the taking of property without due process of law.<sup>14</sup> In addition,

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8. CAL. CIV. CODE § 663 (West 1982).

9. For example, trade secrets have been called "property." *Continental Car-Na-Var Corp. v. Moseley*, 48 P.2d 9, 12 (Cal. 1944) ("[E]quity will to the fullest extent protect the property rights of employers in their trade secrets . . ."); *Pillsbury, Madison & Sutro v. Schectman*, 64 Cal. Rptr. 2d 698, 704 (Ct. App. 1997) ("trade secrets . . . [are] a form of intellectual property . . ."); *ITT Telecom Prods. Corp. v. Dooley*, 262 Cal. Rptr. 773, 780 (Ct. App. 1989) ("[T]rade secrets have been recognized as a constitutionally protected intangible property interest."). Trademarks are described as personal property. *Italian Swiss Colony v. Italian Vineyard Co.*, 110 P. 913, 915 (Cal. 1910) ("[R]elief is granted . . . because a right of property—i.e., plaintiff's exclusive right to the use of his trademark—has been invaded."); *Hall v. Holstrom*, 289 P. 668, 671 (Cal. 1930) ("A trademark or design . . . is property, and is therefore susceptible to private ownership."); CAL. CIV. CODE § 655 (West 1982) (stating that trademarks are property because they may be owned). Common law copyrights are "property." See *Desny v. Wilder*, 299 P.2d 257, 271 (Cal. 1956) (noting that "common law protects . . . a property right . . ."); *Weitzenkorn v. Lesser*, 256 P.2d 947, 956 (Cal. 1953) ("California now accepts the traditional theory of protectible property under common law copyright.").

10. See, e.g., Mark A. Lemley, *The Law and Economics of Internet Norms*, 73 CHI.-KENT L. REV. 1257, 1259 (1998) (discussing the need for initial distribution of property rights as a prerequisite to Internet commerce); see also Julia E. Cohen, *Lochner in Cyberspace: The New Economic Orthodoxy of "Rights Management,"* 97 MICH. L. REV. 462, 492–95 (1998).

11. In rare circumstances, substantive constitutional limitations, such as the First Amendment, equal protection guarantees, and the concept of substantive due process, will restrict the ability of either state or federal governments to limit rights in property. See *Shelley v. Kraemer*, 334 U.S. 1, 23 (1948) (concluding that the government could not define or enforce rights in real property as contingent on the property's not being granted to racial minorities).

12. The U.S. Constitution contains no definition of "property," with most Supreme Court authority focusing on when government entitlements create "property" interests. See, e.g., *Bd. of Regents v. Roth*, 408 U.S. 564, 578 (1972).

13. U.S. CONST. amend. IV.

14. *Id.* amends. V, XV.

state constitutions routinely articulate specific property rights.<sup>15</sup>

This does not mean that private property is legally sacrosanct. A taking of private property by the state is permitted, for example, upon a showing of probable cause that the property may evidence a crime.<sup>16</sup> Eminent domain proceedings also permit the taking of private property so long as proper compensation is paid.<sup>17</sup> Further, use of private property can be restricted in certain circumstances by zoning or other laws without qualifying as a “taking” under the Constitution.<sup>18</sup>

However, all of these restrictions on private property are only exercisable by the state, after appropriate administrative, legislative, or judicial procedures.<sup>19</sup> No statute or constitutional provision permits a private party to take another’s property, even when the party justifies the taking to exercise a perceived right. To the contrary, elaborate mechanisms have been created to prevent such conduct, by punishing the perpetrators and compensating the victims.<sup>20</sup> In particular, theft, robbery, burglary, embezzlement, larceny, and extortion, which involve the unauthorized private taking of others’ property, are crimes. Additionally, their civil equivalents—trespass, conversion, negligence, fraud, and other torts—permit an individual whose property has been damaged, interfered with, or misappropriated to obtain equitable relief to stop the interference and/or recover damages. Thus, the state can, in certain circumstances, take one’s property through proceedings that comply with due process, while a private party cannot, except through successful litigation.

### *B. Background Regarding “Free Speech”*

The right to speak is embodied in the First Amendment.<sup>21</sup> Although two centuries of jurisprudence have recognized that speech is a cornerstone of a vibrant democracy,<sup>22</sup> there is sometimes confusion about what it is. Some have advocated relatively strict definitions of speech that would limit First Amendment protection to political speech and artistic expression.<sup>23</sup>

15. *See, e.g.*, CAL. CONST. art. I (recognizing that all persons have the inalienable right to acquire, possess, and protect property).

16. *Zurcher v. Stanford Daily*, 436 U.S. 547, 571–74 (1978).

17. *Contributors to Pa. Hosp. v. City of Philadelphia*, 245 U.S. 20, 23–24 (1917); *see also* discussion *supra* note 9.

18. *See Penn Cent. Transp. Co. v. New York City*, 438 U.S. 104, 125 (1978).

19. U.S. CONST. amend. V.

20. *See, e.g.*, CAL. PENAL CODE §§ 461, 505, 530.7, 13848 (West 1997).

21. U.S. CONST. amend. I.

22. *See N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 270 (1964).

23. *See, e.g.*, Robert H. Bork, *Neutral Principles and Some First Amendment Problems*, 47

However, courts have accepted that broad categories of information and conduct can qualify as “speech” for First Amendment purposes.<sup>24</sup>

Although speech is “free,” engaging in it sometimes has a legal cost. Many crimes or torts traditionally have not been deemed to be protected by the First Amendment, even if they embody “speech.”<sup>25</sup> There is no constitutional right to make fraudulent misrepresentations, even though such misrepresentations are usually made through “speech.”<sup>26</sup> There is no constitutional right to solicit murder or offer a bribe to a public official, even though these crimes are “speech.”<sup>27</sup> There is no constitutional right to tell someone how to build a bomb<sup>28</sup> or violate tax laws.<sup>29</sup> While burning one’s own flag can be “speech,” as described above, burning someone else’s property to “communicate” unhappiness with the property owner would not be protected by the First Amendment’s free speech provisions.<sup>30</sup>

Traditional First Amendment jurisprudence generally evaluates the nature of the speech or the nature of the restriction on the speech to determine whether the speech can properly be deemed illegal.<sup>31</sup> “Pure” speech generally receives the highest degree of First Amendment protection. It can be inhibited only if there is a compelling state interest and the state does so by the least restrictive means available.<sup>32</sup> This is sometimes called the “strict scrutiny” test.<sup>33</sup>

IND. L.J. 1, 20 (1971) (stating that First Amendment protection should be limited to political speech); Marci A. Hamilton, *Art Speech*, 49 VAND. L. REV. 73, 77 (1996) (asserting that the First Amendment should apply to artistic expression).

24. See *Miller v. California*, 413 U.S. 15, 34 (1973) (“The First Amendment protects works which, taken as a whole, have serious literary, artistic, political or scientific value . . . .”); *Roth v. United States*, 354 U.S. 476, 484 (1957) (The First Amendment applies to “[a]ll ideas having even slightest redeeming social importance” including “the advancement of truth, science, morality and arts in general . . . .”) (citation omitted).

25. See, e.g., *N.Y. Times*, 376 U.S. at 287–88; *Levi Strauss & Co. v. Shilon*, 121 F.3d 1309, 1312–13 (9th Cir. 1997) (citing *Nordyke v. Santa Clara County*, 110 F.3d 707, 710 (9th Cir. 1997)).

26. See *N.Y. Times*, 376 U.S. at 287–88.

27. *Levi Strauss*, 121 F.3d at 1312–13 (The First Amendment does not protect verbal offers to sell counterfeit merchandise because “the underlying transaction is illegal.”).

28. *United States v. Featherston*, 461 F.2d 1119, 1122–23 (5th Cir. 1972).

29. *United States v. Raymond*, 228 F.3d 804, 815 (7th Cir. 2000); *United States v. Dahlstrom*, 713 F.2d 1423, 1428 (9th Cir. 1983).

30. See *United States v. Eichman*, 496 U.S. 310, 322 (1990) (Stevens, J., dissenting) (“[T]he communicative value of a well-placed bomb in the Capitol does not entitle it to the protection of the First Amendment.”).

31. *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989).

32. *Sable Communications of Cal., Inc. v. FCC*, 492 U.S. 115, 126 (1989).

33. *Kasky v. Nike, Inc.*, 45 P.3d 243, 251 (Cal. 2002) (“For noncommercial speech entitled to full First Amendment protection, a content-based regulation is valid under the First Amendment only if it can withstand strict scrutiny, which requires that the regulation be narrowly

However, even pure speech can be regulated without “strict scrutiny” review if the restriction is “content neutral.”<sup>34</sup> “Content neutral” restrictions receive an intermediate level of review.<sup>35</sup> “A regulation that serves purposes unrelated to the content of expression is deemed neutral, even if it has an incidental effect on some speakers or messages but not others.”<sup>36</sup> Content-neutral regulation of speech is acceptable “if the incidental restriction on alleged First Amendment freedoms is no greater than is essential to the furtherance of that [governmental] interest.”<sup>37</sup> “[S]o long as the . . . regulation promotes a substantial government interest that would be achieved less effectively absent the regulation,” content-neutral restriction on speech is permissible, though the regulation may not “burden substantially more speech than is necessary to further the government’s legitimate interests.”<sup>38</sup>

Restrictions on “commercial speech” also receive lessened judicial scrutiny.<sup>39</sup> “Commercial speech” is generally defined as truthful, non-misleading speech that predominantly “propose[s] a commercial transaction.”<sup>40</sup> The government can regulate commercial speech if the regulation is intended to advance a substantial government interest and does not unnecessarily burden the ability to communicate the commercial message.<sup>41</sup>

### *C. Free Speech and Use of Others’ Property*

Although they have not always discussed the issue in these terms, U.S. Supreme Court decisions addressing the free speech-private property interface have generally ruled that the First Amendment does not permit the use of another’s property to engage in speech against the property owner’s will.<sup>42</sup> *Lloyd Corp. v. Tanner*<sup>43</sup> held that political leafleters had no federal free speech rights in a privately-owned shopping mall, stating “[i]t would

tailored (that is, the least restrictive means) to promote a compelling government interest.”).

34. *Ward*, 491 U.S. at 798.

35. *Id.* at 798–800. “So long as the means chosen are not substantially broader than necessary to achieve the government’s interest . . . the regulation will not be invalid.” *Id.* at 800.

36. *Id.* at 791; *see also* *Hill v. Colorado*, 530 U.S. 703, 707–08, 725–26 (2000) (upholding a statute with police guidelines restricting access to healthcare centers by demonstrators).

37. *United States v. O’Brien*, 391 U.S. 367, 377 (1968).

38. *Ward*, 491 U.S. at 799 (quoting *United States v. Albertini*, 472 U.S. 675, 689 (1985)).

39. *See Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 65 (1983).

40. *Id.* at 66 (quoting *Va. Pharmacy Bd. v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976)).

41. *Id.* at 68–69.

42. *See infra* notes 54–61 and accompanying text.

43. 407 U.S. 551 (1972).

be an unwarranted infringement of property rights to require them to yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.”<sup>44</sup> *Hudgens v. National Labor Relations Board*<sup>45</sup> expanded on *Lloyd Corp.* and held that the First Amendment did not require a privately-owned shopping center to permit picketing on its premises because the right to own private property encompassed the right to prohibit unwanted speech.<sup>46</sup> The only circumstance in which real property can be used to promote speech under the U.S. Constitution is when the private property has been granted rights so extensive that it, in effect, serves a governmental function and operates as a public forum.<sup>47</sup> In that event, it can be subject to the same constitutional restrictions as a government-owned public forum.<sup>48</sup> However, state statutes or constitutional provisions, consistent with states’ general ability to define property, may nevertheless afford additional access to property to effectuate speech under the states’ police power.<sup>49</sup>

The Supreme Court has also been respectful of intellectual property rights in the face of First Amendment defenses. For example, it held that a magazine article’s use of 300 to 400 words from a 200,000-word book violated the copyright in the book and rejected an argument that the newsworthy value of the article gave it constitutional protection under the First Amendment.<sup>50</sup> It held that a television station which broadcast a human cannonball’s act during the evening news violated the performer’s right of publicity, rejecting a First Amendment argument in the process.<sup>51</sup>

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44. *Id.* at 567.

45. 424 U.S. 507 (1976).

46. *Id.* at 520–21.

47. *See* *Marsh v. Alabama*, 326 U.S. 501, 506–09 (1946) (holding that a “company town” with no formal ties to any state agency or authority could not prohibit religious leafletting in privately owned business district sidewalks because the business district served a “public function”).

48. *Id.*

49. *See* *Pruneyard Shopping Ctr. v. Robins*, 447 U.S. 74, 81 (1980) (holding that the United States Supreme Court’s decision in *Lloyd* did not preclude the State of California from requiring owners of a shopping center to permit peaceful leafletting on shopping center property pursuant to the state constitution’s free speech provisions). The California Supreme Court later clarified that, even under California law, private property may be used to effectuate speech only where there is both state action and the property has become a public forum. *See* *Golden Gateway Ctr. v. Golden Gateway Tenants Ass’n*, 29 P.3d 797, 810 (Cal. 2001) (holding that the Tenants Association did not have free speech rights to distribute newsletters in a privately-owned residential apartment complex that was not open to the public under California’s Constitution because the actions of the owners were not state actions and the apartment building’s hallway was not a “public forum”).

50. *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 569 (1985).

51. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 574–75 (1977).



It affirmed the U.S. Olympic Committee's exclusive statutory right to the "Olympic" mark, rejecting a political speech argument in doing so.<sup>52</sup> How the Supreme Court arrived at those results will be discussed below.

### III. BACKGROUND REGARDING THE RIGHT OF PUBLICITY

Though it has important antecedents in unfair competition, misappropriation, and fraud, and is historically linked to privacy, the "right of publicity" was first recognized in 1953 in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,<sup>53</sup> when the Court of Appeals for the Second Circuit held that baseball players had a right to stop the unauthorized commercial appropriation of their likenesses and playing statistics on baseball cards.<sup>54</sup> *Haelan* was the start of a judicial and legislative movement recognizing an economic right in one's identity separate and apart from the right of privacy or other analogous tort.<sup>55</sup> The right of publicity recognizes that, in the culture of celebrity, an individual's name and likeness can have significant commercial value that will be harmed by the unauthorized and uncontrolled commercial exploitation of others.<sup>56</sup> It has been described as "property" in both statute and caselaw.<sup>57</sup>

A creature of state law, the right of publicity is now widely

52. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 535 (1987).

53. 202 F.2d 866 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953).

54. *Id.* at 869.

55. Interestingly, the baseball cards' inclusion of playing statistics undoubtedly served an "expressive" purpose within the First Amendment. The *Haelan* court nevertheless did not rule that the First Amendment protected such expression; if it had, the right of publicity might never have developed. The expressive content of baseball cards apparently found unimportant in *Haelan* was later found more important to other courts. See *Cartoons v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996); *Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307 (Ct. App. 2001).

56. See, e.g., *McFarland v. Miller*, 14 F.3d 912, 919 (3d Cir. 1994) ("A famous individual's name, likeness, and endorsement carry value, and an unauthorized use harms the person both by diluting the value of the name and depriving that individual of compensation."); *Matthews v. Wozencraft*, 15 F.3d 432, 438 n.2 (5th Cir. 1994) (holding that the right of publicity allows a person to prevent dilution of the goodwill that has been created in his or her image.); RICHARD A. POSNER, *ECONOMIC ANALYSIS OF LAW* § 3.3 (4th ed. 1992) (stating that "the value of associating the celebrity's name with a particular product will be diminished if others are permitted to use the name in association with their products").

57. See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992) ("Waits' voice misappropriation claim is one for invasion of a *personal property* right: his right of publicity to control the use of his identity as embodied in his voice") (emphasis added); *Michaels v. Internet Entm't Group*, 5 F. Supp. 2d 823, 838 (C.D. Cal. 1998) ("[A] celebrity's *property* interest in his name and likeness is unique . . .") (emphasis added); *Am. Econ. Ins. Co. v. Reeboans*, 852 F. Supp. 875, 879-80 (N.D. Cal. 1994) (stating that dilution and right of publicity claims involve property rights); CAL. CIV. CODE § 3344.1(b) (West 1997) ("[T]he rights recognized under this section are property rights, freely transferable, in whole or in part . . .").

recognized throughout the United States, and the trend is to recognize such a right on common law or statutory grounds.<sup>58</sup> About thirty-six states recognize some variant of the right, and nineteen have applied it posthumously; in contrast, no state has refused to apply the right to living individuals, and only two states arguably refuse to apply it posthumously.<sup>59</sup> Forty years of judicial and legislative effort have produced a nationally-recognized, reasonably-defined right of publicity that protects the economic value of identity.<sup>60</sup>

#### IV. INTELLECTUAL PROPERTY AND THE FIRST AMENDMENT

There has always been a tension between the expressive rights embodied in the First Amendment and the property rights embodied in intellectual property laws. All persons who create works can argue that any inhibition on their free taking of others' intellectual property chills speech by increasing the cost of creating works.<sup>61</sup> However, granting free use of others' intellectual property to communicate a message also chills speech, since it chills the creation of intellectual property in the first instance and

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58. See, e.g., J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 9.5 (2d. ed. 2002) (noting that the trend and majority rule is recognizing that the right of publicity does last after death and has a post-mortem duration of some period); *RESTATEMENT (THIRD) OF UNFAIR COMPETITION* § 46 cmt. h (1993) ("Of those jurisdictions that have determined the issue through legislation or common law adjudication, the majority recognize the [publicity] right as descendible . . .").

59. See MCCARTHY, *supra* note 58, § 9.5[A]; *Smith v. Long Island Jewish-Hillside Med. Ctr.*, 499 N.Y.S.2d 167, 168 (App. Div. 1986); *Hagen v. Dahmer*, 24 Med. L. Rptr. 1311, 1314 (C.D. Wis. 1995). Two other states with earlier reported decisions that could be construed to deny a right of publicity, Ohio and Illinois, recently enacted legislation to create statutory posthumous publicity rights. See *Illinois Right of Publicity Act*, 765 ILL. COMP. STAT. 1075/20 (1993); see also S.54, 123rd Gen. Assem. (Ohio 1999). Washington state and Pennsylvania recently enacted right of publicity statutes as well. See 1998 Wash. Legis. Serv. 274 (West); 42 PA. CONS. STAT. § 8312 (1978).

60. In response to the judicial and legislative trend of recognizing the right of publicity, a few commentators have attacked the fundamental tenets of the right. These attacks appear to stem from a discomfort with the economic value our culture places on celebrity, as well as the broader "critical studies" movement, which commentators argue has unjustifiably developed legal concepts designed to protect the middle class. See Sheldon W. Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L.J. 853, 869-71 (1995).

61. Indeed, one commentator has argued that the right of publicity should not exist because it "suppresses" creative works by requiring authors to obtain permission to use others' identities in such works. See, e.g., Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 134 (1993). Identical arguments could be made about copyrights, trademarks, patents, and all other intellectual property rights, since all similarly "suppress" derivative works. Indeed, identical arguments could be made about *all* property rights, since all theoretically "suppress" speech by requiring speakers to obtain the property owner's permission to use that property in speech.

intellectual property itself often consists of speech.<sup>62</sup> Allowing uncompensated third-party use also devalues the property and allows unjust enrichment in violation of the owner's property rights.<sup>63</sup> Thus, courts have had to determine how to accommodate these competing constitutional interests.

One court noted that "the[F]irst [A]mendment is not a license to trammel on legally recognized rights in intellectual property,"<sup>64</sup> since otherwise, one could always utilize another's intellectual property on free speech grounds without liability for infringement, and virtually wipe out copyright, trademark, right of publicity, and other intellectual property laws.<sup>65</sup> Similarly, the U.S. Supreme Court and every other court to consider the issue have rejected the argument that a free speech claim automatically immunizes conduct that infringes intellectual property rights.<sup>66</sup>

Recognizing that there cannot be absolute free speech immunity for taking others' intellectual property, courts have developed different approaches to reconcile the expressive and property interests at issue.<sup>67</sup> Approaches utilized in copyright and trademark law are summarized below to give context.

62. 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, 162–63 (2000).

63. See *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 837 (6th Cir. 1983).

64. *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1188 (5th Cir. 1979) (affirming a preliminary injunction barring trademark and copyright infringement despite a First Amendment parody defense).

65. See Howard, *supra* note 62, at 159–60, 162.

66. 433 U.S. 562, 577 n.13 (1977) (holding that the First Amendment did not insulate defendants from liability for violating plaintiff's right of publicity in newscast any more than it would for copyright infringement); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1401 n.3 (9th Cir. 1992) (holding that the First Amendment parody defense did not bar a right of publicity claim: "unless the first amendment bars all right of publicity actions—and it does not . . . then it does not bar this case"); *Anheuser-Busch, Inc. v. Balducci Publ'ns, Inc.*, 28 F.3d 769, 775 (8th Cir. 1994) ("Balducci argues it has an absolute First Amendment right to use plaintiff's trademarks in its parody. No such absolute right exists."); *Silverman v. CBS, Inc.*, 870 F.2d 40, 49 (2d Cir. 1989), *cert. denied*, 492 U.S. 907 (1989) (holding that "[t]rademark protection is not lost simply because the allegedly infringing use is in connection with a work of artistic expression"). A leading authority on the right of publicity has stated:

When a defendant is making a confusing use of another's trademark on a product like a coffee mug, a claim of First Amendment immunity for conveying a "message"—whether it be criticism of the trademarked product, condemnation of some social evil, or just parody—rings hollow. A coffee mug is not the normal or traditional medium for "speech" on public issues.

MCCARTHY, *supra* note 58, § 31:152.

67. See *supra* note 66 and accompanying text.

### A. Copyright Law

The Supreme Court recently affirmed that there is no First Amendment right to copy others' copyrighted works.<sup>68</sup> Copyright law accommodates expressive interests through its "idea/expression dichotomy" and a "fair use" analysis.<sup>69</sup> It protects only the particular expression of facts or ideas, not the facts or ideas themselves.<sup>70</sup> Thus, the ability to speak on, with, or about the ideas in expressive works is honored.

Initially developed by caselaw,<sup>71</sup> the fair use doctrine is now codified in the Copyright Act.<sup>72</sup> It generally holds that certain uses of copyrighted works, such as educational uses, criticism, news reporting, etc. should be deemed "fair" and not a violation of copyright law. To determine whether the taking of some or all of another's copyrighted work is a "fair use," courts are required to evaluate:

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the affect of the use upon the potential market for or value of the copyrighted work.<sup>73</sup>

These statutory factors are something of an empty suit because courts are told to "weigh" them without guidance on how to do so. Caselaw has attempted to fill these statutory gaps with uneven success.<sup>74</sup> The fair use doctrine, nevertheless, is the most clearly articulated approach to

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68. *Eldred v. Ashcroft*, 123 S. Ct. 769, 789 (2003) ("The First Amendment securely protects the freedom to make—or decline to make—one's own speech; it bears less heavily when speakers assert the right to make other people's speeches.").

69. 17 U.S.C. § 102 (2000); *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985); *Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65, 74 (2d Cir. 1999) (noting that "[w]e have repeatedly rejected First Amendment challenges to injunctions from copyright infringement on the ground that First Amendment concerns are protected by and coextensive with the fair use doctrine"); *L.A. News Serv. v. Tullo*, 973 F.2d 791, 795 (9th Cir. 1992) ("First Amendment concerns are also addressed in the copyright field through the 'fair use' doctrine;" idea/expression dichotomy "strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression.") "No author may copyright his ideas or the facts he narrates." *Harper & Row Publishers, Inc.*, 471 U.S. at 556.

70. See 17 U.S.C. § 102.

71. See, e.g., *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (Ct. Cl. 1973).

72. 17 U.S.C. § 107 (2000).

73. *Id.*

74. See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (holding that a parody's commercial nature is only one element to be weighed).

reconciling property and speech interests in the intellectual property field.<sup>75</sup>

That does not mean it is popular or its application is predictable. It has been widely criticized for decades. Characterized by one court as “so flexible as virtually to defy definition,”<sup>76</sup> an appellate judge famously described copyright’s fair use doctrine as “the most troublesome in the whole law of copyright,”<sup>77</sup> while a leading copyright commentator characterized fair use as a “most obscure doctrine.”<sup>78</sup> This uncertainty has made the fair use doctrine a heavily litigated aspect of copyright law.

### B. Trademark Law

Copyright’s fair use doctrine may be “troublesome,” but it is a model of unified clarity compared to the approaches utilized in trademark infringement and unfair competition actions. Courts have applied a number of inconsistent methods to competing trademark and free speech claims, splintering both among and within federal circuits in the approach they follow.

#### 1. The “Alternative Means” Test

Early panels of the Second, Eighth, and Ninth Circuits adopted an “alternative means of communication” test, pursuant to which non-commercial speech is held infringing if there is another way to convey the message without infringing intellectual property rights.<sup>79</sup> Those courts

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75. *See id.*

76. *Time, Inc. v. Bernard Geiss Assoc.*, 293 F. Supp. 130, 144 (S.D.N.Y. 1968).

77. *See Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661, 662 (2d Cir. 1939).

78. 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05 (1963). Nimmer elsewhere cites a cartoon depicting a young lawyer who climbs to the top of a mountain to ask a guru the ultimate unanswerable question: It is not, “What is the meaning of life?”, but rather, “What is ‘fair use’?” *See* MELVILLE B. NIMMER, CASES AND MATERIALS ON COPYRIGHT AND OTHER ASPECTS OF ENTERTAINMENT LITIGATION 367 (3d ed. 1985).

79. *See, e.g., Int’l Olympic Comm. v. S.F. Arts & Athletics*, 781 F.2d 733, 737 (9th Cir. 1986), *aff’d* 483 U.S. 522 (1987) (holding “political speech” defense to statutory “Olympic” trademark infringement claim lacked merit because defendants had other ways to communicate their message); *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (holding t-shirt with phrase “Mutant of Omaha” printed on it infringed trademarks, and rejecting First Amendment defense under the “alternative means of communication” test); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (rejecting First Amendment argument and holding that use of Dallas Cowboys Cheerleaders uniforms in film constituted trademark infringement under “alternative means” standard); *Dr. Seuss Enter., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1571–73 (S.D. Cal. 1996), *aff’d on other grounds*, 109 F.3d 1394 (9th Cir. 1997) (holding that potentially confusing use of trademarks in a book not protected by First Amendment because “[w]here alternative means of achieving the satiric or parodic ends exist that would not entail confusion, the First Amendment will not protect the

adopted this approach because they believed it best comports with U.S. Supreme Court authority discussing incidental “time, place and manner” restrictions on speech in analogous property settings.<sup>80</sup>

The Supreme Court appeared to support this approach in a ruling that affirmed one of the panel decisions. *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*<sup>81</sup> involved an organization (“SFAA”) that sponsored and promoted an event called the “Gay Olympic Games.”<sup>82</sup> The SFAA used the word “Olympic” in the title of its event, in advertising for the event, and on ancillary merchandise such as t-shirts, buttons, and bumper stickers it sold to fund the event.<sup>83</sup> The United States Olympic Committee (“USOC”) sued the SFAA on the grounds that it owned an exclusive statutory right to prohibit certain commercial and promotional use of the word “Olympic,” regardless of whether the work was used in a confusing manner.<sup>84</sup>

The SFAA sought to defend its conduct on the grounds that, *inter alia*, its use of “Olympic” was “political speech” protected by the First Amendment.<sup>85</sup> Both the trial court and the Ninth Circuit Court of Appeals rejected the First Amendment argument,<sup>86</sup> with the Ninth Circuit relying on *Zacchini v. Scripps-Howard Broadcasting Co.* to hold that there was no First Amendment defense “[b]ecause SFAA had satisfactory alternative means for expressing its opposition to the Olympics . . . .”<sup>87</sup>

The Supreme Court granted certiorari, but rejected the “political speech” argument.<sup>88</sup> In language echoing the “alternative means” standard utilized by the Ninth Circuit and articulated in the Supreme Court’s own earlier *Lloyd Corp. v. Tanner* decision, it stated:

By prohibiting the use of one word for particular purposes, neither Congress nor the USOC has prohibited the SFAA from conveying its message . . . . Section 110 restricts only the

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parodist from being held to infringe”).

80. See *Lloyd Corp. v. Tanner*, 407 U.S. 551, 566–67 (1972) (noting that “[i]t would be an unwarranted infringement of property rights to require them to yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist”); *United States v. O’Brien*, 391 U.S. 367, 376–77 (1968) (discussing time, place, and manner restrictions on speech).

81. 483 U.S. 522 (1987).

82. *Id.* at 525.

83. *Id.*

84. *Id.* at 526 (citing 36 U.S.C. § 308).

85. *Id.* at 535.

86. *Int’l Olympic Comm.*, 781 F.2d at 737.

87. *Id.* (relying on *Zacchini*).

88. See *S.F. Arts & Athletics*, 483 U.S. at 535–36.

manner in which the SFAA may convey its message. The restrictions on expressive speech properly are characterized as incidental to the primary Congressional purpose of encouraging and rewarding the USOC's activities. The appropriate inquiry is thus whether the incidental restrictions on First Amendment freedoms are greater than necessary to further a substantial governmental interest . . . .

The SFAA's expressive use of the word [Olympic] cannot be divorced from the value the USOC's efforts have given to it. The mere fact that the SFAA claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to "appropriat[e] to itself the harvest of those who have sown . . . ." The USOC's right to prohibit use of the word "Olympic" in the promotion of athletic events is at the core of its legitimate property right.<sup>89</sup>

Thus, the Supreme Court implicitly found that restrictions on expressive uses of trademarks were "content neutral" regulations,<sup>90</sup> which received only an intermediate level of review. Although the Court was less clear in articulating precisely what type of intermediate review was appropriate,<sup>91</sup> by establishing an intermediate level of review and affirming the Ninth Circuit's "alternative means" approach, the Court implied acceptance of such an approach to reconciling intellectual property and free speech rights.<sup>92</sup>

One might have thought that these decisions would have resolved the issue. However, despite the appellate and Supreme Court decisions cited above, no appellate court has applied the "alternative means" approach since 1987, the year of the *SFAA* decision.<sup>93</sup> Instead, subsequent courts have applied other approaches, as described below.

## 2. Balancing

In 1989, a panel of the Second Circuit in *Rogers v. Grimaldi* was again faced with the trademark-free speech issue when Ginger Rogers sued

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89. *Id.* at 536–37, 541 (citations and footnotes omitted).

90. *Id.* at 561 (Brennan, J., dissenting).

91. The Supreme Court cited with approval the "time, place and manner restrictions" test applied in *United States v. O'Brien*, 391 U.S. 367, 377 (1968), while at the same time borrowing language from commercial speech cases. See *S.F. Arts & Athletics*, 483 U.S. at 535–37. Footnote 16 goes so far as to state that the application of either test to the facts before it was "substantially similar," and thus discussed them together. *Id.* at 537 n.16.

92. *Id.* at 548.

93. See, e.g., *Rogers v. Grimaldi*, 875 F.2d 994, 998–99 (2d Cir. 1989).

over a movie about two Italian dancers entitled *Ginger and Fred*.<sup>94</sup> Disposing of the above authority with a short observation that the “no alternative avenues” test was insufficiently protective of expressive interests,<sup>95</sup> the court announced an ad hoc balancing test in which one is to weigh competing expressive and property interests according to unspecified criteria.<sup>96</sup> The *Rogers* court concluded that the expressive interests outweighed Ms. Rogers’ property interest because, although the film was not about Fred Astaire or Ginger Rogers, the title had an “artistic relevance” to its subject matter.<sup>97</sup>

Perhaps because balancing implies fairness and describes in the broadest sense what a court in this area must do, the “balancing” approach has recently proven popular with appellate courts. The two most recent appellate decisions addressing these issues in the trademark setting have followed it.<sup>98</sup> However, the approach presents several problems.

First, the “balancing” test is arguably inconsistent with Supreme Court authority as described above.<sup>99</sup> Some courts have recognized that inconsistency.<sup>100</sup>

Second, the “balancing” approach is ultimately unsupported by authority. *Rogers* cites no authority to support the approach it develops; to the contrary, it acknowledged the Supreme Court’s *Lloyd Corp.* decision and its “no alternative avenues” test, but declined to follow it, and barely mentions and does not follow the *San Francisco Arts & Athletics* decision issued only two years before.<sup>101</sup>

Third, the approach is not limited by any meaningful evaluative guidelines or criteria, and amounts to little more than a Rorschach test for a particular judge’s philosophical predilections. It has been criticized by

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94. *Id.* at 996–97.

95. *Id.* at 999 (“[T]his ‘no alternative’ standard provides insufficient leeway for literary expression . . . [T]he ‘no alternative avenues’ test does not sufficiently accommodate the public’s interest in free expression . . .”). The *Rogers* court noted that it “need not consider whether Congress could constitutionally bar the use of all literary titles that are to any extent misleading.” *Id.* at 1000 n.7. Therefore, the court felt it was unnecessary to consider the Supreme Court’s decision in *San Francisco Arts & Athletics*. *Id.*

96. *Id.* at 999.

97. *Id.* at 1001.

98. *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664 (5th Cir. 2000); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

99. See *supra* notes 95–97 and accompanying text.

100. See, e.g., *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1571–72 (S.D. Cal. 1996), *aff’d on other grounds*, 109 F.3d 1394 (9th Cir. 1997) (stating that *Rogers*’ “balancing” test is “sui generis” as applied to noncommercial speech, given that the Supreme Court has only applied a lower standard of protection to commercial speech).

101. *Rogers*, 875 F.2d at 998–1000 & n.7; see *supra* note 95 and accompanying text.



leading commentators in the copyright and trademark fields for these reasons.<sup>102</sup> Judicial application confirms the propriety of these criticisms. Courts “balancing” intellectual property rights have either applied criteria that are not amenable to case-by-case determination or have arrived at inconsistent results.<sup>103</sup>

Finally, ad hoc “balancing” itself can chill speech by creating legal uncertainty as to whether the speech is or is not permitted. As the California Supreme Court noted:

[A]nalysis focusing on relevance allows courts and juries to decide most cases . . . without balanc[ing] interests in an ad hoc fashion in each case. The articulation of standards that do not require ad hoc resolution of the competing interest in each . . . case . . . is favored in areas affecting First Amendment rights, because the relative predictability of results reached under such standards minimizes the inadvertent chilling of protected speech, and because standards that can be applied objectively provide a stronger shield against the unconstitutional punishment of unpopular speech.<sup>104</sup>

### 3. The “Likelihood of Confusion” Standard

After *Rogers*, panels of the Fifth and Ninth Circuits in the late 1990s applied traditional “likelihood of confusion” analysis to First Amendment defenses to Lanham Act claims.<sup>105</sup> Citing neither the “alternative means” nor “balancing” authority described above, those decisions apparently premised their analysis on the proposition that there is no constitutional right to engage in misleading speech.<sup>106</sup> They evaluated potentially

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102. See MELVILLE B. NIMMER, NIMMER ON FREEDOM OF SPEECH: A TREATISE ON THE THEORY OF THE FIRST AMENDMENT § 2.02 (1984).

103. See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970–72 (10th Cir. 1996) (balancing free speech rights with property rights); *Rogers*, 875 F.2d at 996–1001 (holding that under the “balancing” approach, use of Ginger Rogers’ name and title of film about Italian dancers protected free expression because title artistically related to subject of films); *American Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 734–35 (D. Minn. 1998) (holding that the use of the “Dairy Queen” trademark in title of film about Minnesota beauty pageant contestants was not protected free expression because title was not artistically related to subject of film).

104. *Shuman v. Group W Prods., Inc.*, 955 P.2d 469, 486 (Cal. 1998) (citations and internal quotations omitted).

105. See, e.g., *Dr. Seuss v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1404 (9th Cir. 1997); see also *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 200–01 (5th Cir. 1998).

106. *Id.*; see also *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 563–64, 566 (1980) (holding no First Amendment protection for misleading commercial speech).

confusing uses of a mark under “likelihood of confusion” factors regardless of the “media” used, whether traditionally “expressive” media such as books, or traditionally “commercial” media such as advertisements.<sup>107</sup>

This approach has the advantage of being intuitive, straightforward, and easy to apply. Under it, confusing speech is unprotected speech.<sup>108</sup> In many circumstances, this is consistent with “commercial speech” doctrine, since trademarks are most often used in advertising or other traditional commercial speech settings.<sup>109</sup> Indeed, one could argue that any speech that misleads as to commercial source or origin is “commercial speech.”<sup>110</sup> It also appears consistent with analogous caselaw prohibiting fraudulent, deceptive, or otherwise harmful speech.<sup>111</sup> However, some courts have found it insufficiently protective of First Amendment interests, as described above and below.

#### 4. Constitutional “Malice”

A California appellate court and two panels from the Ninth Circuit Court of Appeals have applied defamation’s “actual malice” test to actions that included unfair competition claims.<sup>112</sup> Defamation or related claims were also asserted in the *Eastwood* decisions, and both held that the standard was satisfied.<sup>113</sup> Those courts’ use of the “malice” standard to the unfair competition claims might be viewed as coincidental to their

107. See, e.g., *Dr. Seuss Enters.*, 109 F.3d at 1405–06 (affirming a preliminary injunction against potentially confusing use of marks in a book and rejecting First Amendment “parody” defense).

108. See *id.* at 1403 n.11.

109. See generally *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 859, 900 (9th Cir. 2002) (“A trademark is a word, phrase or symbol that is used to identify a manufacturer or sponsor of a good or the provider of a service.”).

110. See generally *Edenfield v. Fane*, 507 U.S. 761, 767 (1993) (“[T]he speaker and the audience, not the government, assess the value of the information presented . . . even a communication that does no more than propose a commercial transaction is entitled to the coverage of the First Amendment.”)

111. See *supra* notes 26–30 and accompanying text.

112. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1186–87 (9th Cir. 2001) (reversing judgment for Dustin Hoffman on unfair competition and right of publicity claims arising out of use of a photograph in a magazine because insufficient evidence of “malice”); see generally *Eastwood v. Nat’l Enquirer*, 123 F.3d 1249 (9th Cir. 1997) (granting judgment for Clint Eastwood, affirmed on defamation, false association, right of privacy, and right of publicity claims because defendants knew statements were false when they made them; First Amendment defense rejected); *Eastwood v. Superior Ct.*, 198 Cal. Rptr. 342, 351–52 (Ct. App. 1983) (applying the actual malice test to defamation and right of publicity for commercial purposes).

113. *Nat’l Enquirer*, 123 F.3d at 1250, 1256; *Eastwood v. Superior Ct.*, 198 Cal. Rptr. at 351–52 (holding that while *Eastwood* failed to include claim that the article was published with reckless disregard for falsity, such defect was capable of being cured by amending his pleading).

judicially-mandated application of “malice” to defamation claims. However, one Ninth Circuit panel has applied the “actual malice” standard in an unfair competition action that lacked a defamation claim.<sup>114</sup> It did so without distinguishing, or even mentioning, earlier caselaw from the same circuit that applied other standards in similar unfair competition actions.<sup>115</sup>

### C. Right of Publicity Law

In the right of publicity setting, trademark law’s unsatisfying splintering of analytic methodologies has only intensified. Lacking even the grounding of trademark law’s “likelihood of confusion” requirements, courts faced with right of publicity-free speech issues have borrowed or invented varying methodologies to address them.

#### 1. The “Merchandise v. Media” Result

Although difficult to logically support as a “test” or “approach,” historically, most courts rejected First Amendment defenses to right of publicity claims involving traditional “merchandise,” i.e., items such as t-shirts, posters, games, buttons, or bumper stickers,<sup>116</sup> while they accepted it when an image was used in traditional “media.”

There often is little articulation of the policies underlying this rejection in those decisions, but the courts, which do explain their reasoning, state that merchandise is not a meaningful expression of ideas.<sup>117</sup>

114. *Hoffman*, 255 F.3d at 1186–87.

115. *Id.* (applying malice test to unfair competition claim arising out of use of image in magazine article). *Cf. Dr. Seuss Enters.*, 109 F.3d at 1404 (applying likelihood of confusion analysis to unfair competition claim arising out of use of trademarked images in book).

116. Such rejection arguably is proper even if the merchandise might have some expressive value. “[I]t is possible to find some kernel of expression in almost every activity a person undertakes . . . but such a kernel is not sufficient to bring the activity within the protection of the First Amendment.” *Dallas v. Stanglin*, 490 U.S. 19, 25 (1989) (holding that ballroom dancing is not protected by the First Amendment).

117. For example, *Guglielmi v. Spelling-Goldberg Productions*, 603 P.2d 454, 462–64 (Cal. 1979), held that use of a celebrity’s name and likeness in a fictionalized biography of the celebrity did not infringe the plaintiff’s right of publicity because the television program was a form of expression protected by the First Amendment. However, the concurring opinion distinguished *Guglielmi* from a companion case, *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979) as follows:

*Lugosi* involved the use of Bella Lugosi’s likeness in connection with the sale of such commercial products as plastic toy pencil sharpeners, soap products, target games, candy dispensers and beverage stirring rods . . . . These objects, unlike motion pictures, are not vehicles through which ideas and opinions are regularly disseminated . . . . This case involves the use of a celebrity’s identity in a constitutionally protected medium of expression, a work of fiction on film.

*Guglielmi*, 603 P.2d at 463–64 (citations omitted). Yet the dissenting opinion in *Lugosi* noted

For these courts, the medium really is the message. Use in a recognized “medium of expression” is apparently thought to have an exclusively, or at least predominantly, expressive meaning deserving First Amendment protection, while use in “merchandise” is thought to exclusively or predominantly exploit the commercial value of the celebrity.<sup>118</sup> To synthesize a formulation not expressed in any of these decisions, products which predominantly sell a *celebrity* are seemingly deemed unprotectable merchandise; products which predominantly sell *comment about* a celebrity are arguably deemed protected speech.<sup>119</sup>

Courts adopting this approach have ruled that sales of merchandise by non-news organizations that infringe publicity rights are not protected by the First Amendment, even if the merchandise “commemorates” an event, and even if some “expressive” information is contained on or in the products which exploit the celebrity, because the dominant purpose of the merchandise is to commercially exploit the goodwill of, rather than make an expressive comment about the celebrity.<sup>120</sup>

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that “this unauthorized exploitation of plaintiffs proprietary interest in these commercial merchandising products is no more insulated from suit by the Constitutional guarantees of freedom of expression than Universal’s refusal to pay Lugosi for his services in portraying Count Dracula in *Dracula* would be.” *Lugosi*, 603 P.2d at 434, 449 (Bird, C.J., dissenting).

118. A few courts have gone even further and have found uses of a celebrity’s persona in potentially “expressive” media infringing where the primary purpose of the use was to commercially exploit, rather than to communicate information about the celebrity. *See, e.g.*, *Factors Etc., Inc. v. Pro Arts, Inc.*, 444 F. Supp. 288 (S.D.N.Y. 1977), *aff’d*, 579 F.2d 215, 222 (2d Cir. 1978) (The sale of a “memorial poster” of Elvis Presley with the words “In Memory, 1935–77” was not protected by the First Amendment—“no constitutional protection for selling posters of Elvis Presley as Elvis Presley”); *Groucho Marx Prod., Inc. v. Day & Night Co.*, 523 F. Supp. 485, 493 (S.D.N.Y. 1981), *rev’d on other grounds*, 689 F.2d 317 (2d Cir. 1982) (rejecting defendant’s argument that a play featuring impersonators of the Marx Brothers was a protected parody under the First Amendment because “the play does not present a parody on their parody, but instead successfully reproduced the Marx Brothers’ own style of humor”); *Estate of Elvis Presley v. Russen*, 513 F. Supp. 1339, 1359 (D.N.J. 1981) (holding that a live theatrical presentation of concert designed to imitate a performance of the late Elvis Presley infringed publicity rights and was not protected under the First Amendment); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 729 (S.D.N.Y. 1978) (holding that an unauthorized drawing of a nude man in magazine recognizable as Mohammed Ali violated right of publicity and not protected free speech).

119. *Hoffman*, 255 F.3d at 1186–87.

120. *See, e.g.*, *Titan Sports, Inc. v. Comics World Corp.*, 870 F.2d 85, 85–86, 88 (2d Cir. 1989) (holding that a non-advertising poster inside a magazine is a commercial product that can trigger right of publicity liability despite “newsworthy” information on the poster); *NFL Props. v. Playoff Corp.*, 808 F. Supp. 1288, 1294 (N.D. Tex. 1992) (“Purchasers, while buying a Sports Illustrated primarily for newsworthy information, would be likely to buy Defendants’ [products] for possible appreciation value and for their ability to trade . . . . Defendants’ First Amendment defense does not mitigate against a finding of likelihood of success on the merits . . . .”); *Brockum v. Blalock*, 725 F. Supp. 438, 444–46 (E.D. PA 1990) (holding that “event” t-shirts that were allegedly intended to “commemorate” a musical tour violated publicity rights and not

This approach achieves a certain rough justice in many circumstances, which may explain its historical popularity. However, its obvious conceptual shortcomings have rendered it vulnerable to First Amendment attack. The fact is, the First Amendment does not limit its protections to speech in "recognized media." Many courts have sought a more logically-supportable approach with which to reconcile competing right of publicity and First Amendment interests for this reason.

## 2. The *Zacchini* Decision

The United States Supreme Court issued a ruling in a decision involving the right of publicity-free speech interface in *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>121</sup> *Zacchini* involved a local television station that recorded a human cannonball's act without his permission and broadcast it on the evening news.<sup>122</sup> He alleged violation of his right of publicity, and the television station claimed its news broadcast was protected speech.<sup>123</sup> The Supreme Court of Ohio affirmed the decision for the television station,<sup>124</sup> but the United States Supreme Court reversed, holding that the plaintiff's interest in protecting the economic value of his

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protected speech); *Beverly v. Choices Women's Med. Ctr.*, 532 N.Y.S.2d 400, 400 (1988) (ruling that a calendar that included unauthorized photograph of plaintiff violated right of publicity even if the photograph also served an educational or informative purpose); *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1188, 1201 (S.D.N.Y. 1983) (deciding that posters, buttons, patches, bumper stickers, and other novelty items bearing images of rock musicians infringed their rights of publicity); *Winterland Concessions Co. v. Sileo*, 528 F. Supp. 1201, 1214 (N.D. Ill. 1981) (holding that t-shirts which infringe trademark and publicity rights are not protected by First Amendment); *Brinkley v. Casablancas*, 438 N.Y.S.2d 1004 (App. Div. 1981) (holding that an unauthorized poster of model Christie Brinkley violated her right of publicity; summary judgment granted); *Rosemont Enters., Inc. v. Choppy Prods., Inc.*, 347 N.Y.S.2d 83, 83 (Sup. Ct. 1972) (rejecting argument that sale of merchandise bearing the name and image of Howard Hughes protected by the First Amendment and granting summary judgment on right of publicity claim); *Rosemont Enters., Inc. v. Urban Sys., Inc.*, 340 N.Y.S.2d 144 (1973), *modified and aff'd*, 345 N.Y.S.2d 17 (App. Div. 1973) (rejecting argument that board game with name and likeness of Howard Hughes was a "medium of free speech" and granting summary judgment on right of publicity theory); *Uhlaender v. Hendricksen*, 316 F. Supp. 1277 (D. Minn. 1970) (rejecting First Amendment argument and holding that board game that used the names and statistics of hundreds of baseball players violated their rights of publicity); *Palmer v. Schonhorn Enters., Inc.*, 232 A.2d 458 (N.J. Super. Ct. Ch. Div. 1967) (holding that a board game that utilized the names and images of Arnold Palmer, Jack Nicklaus, and other golfers was not a protected form of free expression and that defendants were liable for violating plaintiffs rights of publicity).

121. 433 U.S. 562 (1977).

122. *Id.* at 563-64.

123. *Id.* at 564 (holding that despite television station's general privilege to report matters of legitimate public interest petitioner nevertheless alleged a violation of right of publicity).

124. *Id.* at 565.

“entire act” outweighed the television’s First Amendment rights.<sup>125</sup> It stated: “The Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner . . . .”<sup>126</sup>

Although *Zacchini* demonstrates that the right of publicity can outweigh First Amendment interests,<sup>127</sup> its unusual factual setting has created uncertainty as to how it applies in typical right of publicity actions. Some portions of the *Zacchini* decision carefully distinguish between the economic or property interests which underlie the right of publicity with the reputation or privacy interests involved in defamation and false light invasion of privacy claims.<sup>128</sup> Generally, such distinctions apply to every right of publicity claim, as all seek to protect an individual’s economic interest in the commercial value of his or her identity and reputation. However, *Zacchini* also emphasized that the action before it involved “what may be the strongest case for a ‘right of publicity’—involving, 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.”<sup>129</sup> Yet, the *Zacchini* court emphasized that nothing in its ruling would have prevented the television station defendant from broadcasting a news story that merely named the plaintiff and described the act.<sup>130</sup> This uncertainty has encouraged some lower courts to virtually ignore *Zacchini* when evaluating First Amendment defenses to right of publicity claims as described below.

### 3. Fair Use

A few courts have attempted to apply copyright law’s “fair use” doctrine to the posthumous right of publicity.<sup>131</sup> They may have been

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125. *Id.* at 574–75.

126. *Id.* at 575.

127. *Zacchini*, 433 U.S. at 574–75, 578–79.

128. *See id.* at 571–73 (stating “[t]he interest protected’ in permitting recovery for placing the plaintiff in a false light ‘is clearly that of reputation, with the same overtones of mental distress as in defamation.’ By contrast the State’s interest in permitting a ‘right of publicity’ is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment.”) (citations omitted).

129. *Id.* at 576.

130. *Id.* at 574 (stating that “[i]t is evident, and there is no claim here to the contrary, that petitioner’s state-law right of publicity would not serve to prevent respondent from reporting the newsworthy facts about petitioner’s act”).

131. *See, e.g.,* *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 868 F. Supp. 1266,

encouraged to follow this approach by the statement in *Zacchini*, quoted above, that the First Amendment did not permit the right of publicity or the copyright violation.

These efforts could probably best be characterized as noble failures, as the factors used in copyright analysis do not readily lend themselves to right of publicity claims. For example, one of the copyright fair use factors, “the nature of the copyrighted work,” would generally not be helpful in right of publicity analysis because the identity rights involved would usually be of the same “nature.”<sup>132</sup> Another factor, “the amount and substantiality of the portion used in relation to the copyrighted work as a whole,”<sup>133</sup> also would not generally be meaningful, since by definition there must be a taking of an individual’s identity before right of publicity liability attaches.<sup>134</sup> A third factor, “the effect of the use upon the potential market for or value of the copyrighted work,”<sup>135</sup> would routinely favor a finding of infringement, as Supreme Court authority establishes that an uncompensated taking will generally have an adverse effect on the market for commercial exploitation of the celebrity’s image.<sup>136</sup> For these reasons, commentators have advised against adoption of a “fair use” approach in right of publicity cases.<sup>137</sup>

Nevertheless, in *Comedy III Productions, Inc. v. Saderup*,<sup>138</sup> the California Supreme Court recently adopted one of the four fair use factors as its test to evaluate a First Amendment defense to a right of publicity claim.<sup>139</sup> The court affirmed a right of publicity judgment in favor of the owners of rights in the Three Stooges against an artist who sold an artistic rendering of the Three Stooges on t-shirts and posters.<sup>140</sup> The California Supreme Court described its approach as follows:

When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing

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1271–72 (N.D. Okla. 1994), *aff’d on other grounds*, 95 F.3d 959, 971 (10th Cir. 1996) (recognizing that the *Campbell v. Acuff-Rose* decision applied copyright’s fair use criteria to right of publicity claim to determine no right of publicity liability); *Estate of Presley*, 513 F. Supp. at 1358 n.18, 1359 n.21 (holding that “fair use” analysis used to determine that Elvis Presley impersonator’s attempt to duplicate a live performance of Elvis Presley violated the right of publicity and was not protected “speech” under the First Amendment).

132. 17 U.S.C. § 107 (2000).

133. *Id.*

134. *Id.*

135. *Id.*

136. *See, e.g., S.F. Arts & Athletics*, 483 U.S. at 535.

137. *See, e.g., MCCARTHY*, *supra* note 58, § 8.38.

138. 21 P.3d 797 (Cal. 2001).

139. *Id.* at 808.

140. *Id.* at 811.

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.

On the other hand, 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 . . . . Accordingly, First Amendment protection of such works outweighs whatever interest the state may have in enforcing the right of publicity.<sup>141</sup>

This “transformativeness” test has apparently already proven problematic. The California Supreme Court has accepted for review the first lower court decision to apply the “transformativeness” test,<sup>142</sup> implying at least discomfort with the consequences of its formulation. In an earlier decision, the appellate court in *Winter v. D.C. Comics*<sup>143</sup> ruled that it could not be determined, as a matter of law, whether defendants’ use of the images and partial names of Johnny and Edgar Winter in a cowboy science fiction comic book series was sufficiently “transformative” to defeat a right of publicity claim.<sup>144</sup> Defendants’ successful petition for review to the California Supreme Court<sup>145</sup> essentially argued that the lower court misinterpreted *Comedy III* because use of a celebrity identity in “expressive works of fiction” almost invariably “are entitled to first amendment protection as a matter of law,”<sup>146</sup> an argument harking back to the “media versus merchandise” rulings described above.

#### 4. Malice

The U.S. Supreme Court has both implied and stated that the “malice” test does not apply in right of publicity actions.<sup>147</sup> For example, in *Zacchini v. Scripps-Howard Broadcasting Co.*, the Court rejected a First Amendment defense as described above, and while the intended breadth of its ruling is uncertain in many respects, it is clear that the *Zacchini* Court

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141. *Id.* at 808 (citations omitted).

142. *See Winter v. D.C. Comics*, 54 P.3d 262 (Cal. 2002) (granting review en banc).

143. 121 Cal. Rptr. 2d 431 (Ct. App. 2002).

144. *Id.* at 441–42.

145. Appellant D.C. Comics’ Petition for Review, *Winter v. D.C. Comics*, 54 P.3d 262 (Cal. 2002) (No. 5108751).

146. *Id.* at 13.

147. *See Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 52 (1988).



did not engage in a “malice” analysis.<sup>148</sup> *Zacchini* even explained at some length why “malice” was not appropriate in right of publicity cases by distinguishing between the reputational interests involved in false light invasion of privacy and economic interests at stake in right of publicity actions as follows:

[The false light claim in] *Time, Inc. v. Hill* . . . involved an entirely different tort from the “right of publicity” . . . . The Court was aware that it was adjudicating a “false light” privacy case involving a matter of public interest, not a case involving . . . “appropriation” of a name or likeness for the purposes of trade . . . . It is also abundantly clear that *Time, Inc. v. Hill* did not involve a performer, a person with a name having commercial value, or any claim to a “right of publicity” . . . .

The differences between these two torts are important.<sup>149</sup>

The privacy versus property distinction articulated in *Zacchini* is present in every right of publicity action, as described above, implying that the “malice” analysis is never appropriate for such claims.<sup>150</sup> The Supreme Court itself subsequently confirmed that interpretation of *Zacchini* when it stated that “the ‘actual malice’ standard does not apply to the tort of appropriation of a right of publicity.”<sup>151</sup>

This distinction between privacy and defamation claims on the one hand and right of publicity claims on the other is logical. Defamation and certain privacy claims involve an individual’s reputational interests. Such interests are not transferable, end upon an individual’s death, and therefore do not rise to the level of property.<sup>152</sup> The right of publicity, on the other hand, protects an individual’s commercial value in his or her identity. It is property, and thus is entitled to all of the protections the Constitution affords to property.<sup>153</sup> The “malice” standard applied in defamation actions may be an appropriate way to protect expressive interests when no property is taken; however, another mode of analysis is needed to protect property interests when they are at risk.

Three recent Ninth Circuit Court of Appeals decisions, two of which included false light invasion of privacy claims, nevertheless applied the “malice” test to right of publicity claims.<sup>154</sup> *Eastwood v. National*

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148. See discussion *supra* Part IV.C.2.

149. *Zacchini*, 433 U.S. at 571–73.

150. *Id.*

151. *Hustler*, 485 U.S. at 52.

152. See MCCARTHY, *supra* note 58, §§ 9:1, 10:2–10:3.

153. See *id.*

154. See *Eastwood v. Nat’l Enquirer*, 123 F.3d 1249 (9th Cir. 1997); *Hoffman v. Capital*

*Enquirer, Inc.*, involved a newspaper article that Clint Eastwood alleged placed him in a false light and violated his right of publicity.<sup>155</sup> Applying the “malice” standard to that action is understandable because, as described above, the court was obliged to undertake a “malice” analysis on the false light claim, and the Ninth Circuit’s determination that the “malice” requirement was satisfied necessarily affirmed the constitutional viability of the remaining claims.<sup>156</sup>

Nevertheless, *Hoffman v. Capital Cities/ABC, Inc.*, involved a direct confrontation between publicity and expressive rights.<sup>157</sup> In that action, a magazine published a “feature” in which photographs of a variety of celebrities were altered by a computer to make it appear that they were wearing Spring 1997 fashions.<sup>158</sup> The manufacturer, price, and availability were described in text immediately adjacent to the photographs.<sup>159</sup> At least some of the products depicted were produced by advertisers in the magazine. One of the altered photographs depicted Dustin Hoffman from the motion picture *Tootsie*, and he filed suit alleging unfair competition and violation of his right of publicity.<sup>160</sup> He was successful in the trial court, where the court ruled that he had been “violated by technology” and awarded him \$3 million in damages.<sup>161</sup>

The Ninth Circuit reversed in a decision that spent surprisingly little time discussing how it should evaluate the magazine’s conduct.<sup>162</sup> It simply evaluated whether the above-described use was “commercial speech,” concluded that it was not, and stated that “a public figure such as Hoffman can recover damages for non-commercial speech from a media organization . . . only by proving ‘actual malice’ . . . .”<sup>163</sup> It ruled that Hoffman had not presented “clear and convincing” evidence of actual malice and reversed.<sup>164</sup> The Ninth Circuit’s *Hoffman* ruling did not discuss or even mention the above-described Supreme Court authority, even

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Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001); *Solano v. Playgirl*, 292 F.3d 1078 (9th Cir. 2002).

155. *Nat’l Enquirer*, 123 F.3d at 1250.

156. *Solano*, 292 F.3d 1078 (reversing summary judgment for defendant because of factual dispute on whether defendant acted with malice in using plaintiff’s photograph on cover of magazine in a way that implied he posed nude inside magazine).

157. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1183–84 (9th Cir. 2001).

158. *Id.* at 1183.

159. *Id.* at 1185.

160. *Id.* at 1183.

161. *Hoffman v. Capital Cities/ABC, Inc.*, 33 F. Supp. 2d 867 (C.D. Cal. 1999), *rev’d*, 255 F.3d 1180 (9th Cir. 2001).

162. *See Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1183 (9th Cir. 2001).

163. *Id.* at 1186.

164. *Id.* at 1189.

though it was cited to the court.<sup>165</sup>

Additionally, a Missouri appellate court has applied the “malice” test to a right of publicity action notwithstanding this Supreme Court authority, with the appellate court essentially holding that the Supreme Court did not really mean what it said.<sup>166</sup> *Doe v. TCI Cablevision*<sup>167</sup> held that a professional hockey player could not recover from a magazine and toy manufacturer for alleged misappropriation of his name, which was used for a comic book character and spinoff action figure.<sup>168</sup> The Missouri appellate court discussed the *Zacchini* decision at length, ruling that it was limited to cases involving an individual’s “own performance.”<sup>169</sup> The court concluded that the Supreme Court’s statement in *Hustler* that “the ‘actual malice’ standard does not apply to the tort of appropriation of right of publicity,” was intended to apply only to *Zacchini*-type right of publicity claims.<sup>170</sup> It then proceeded to apply the malice test to the action before it.

### 5. Balancing

Two courts, including *Rogers v. Grimaldi* discussed above, have adopted the ad hoc “balancing” test to right of publicity claims.<sup>171</sup> “Balancing” has the same difficulties in the right of publicity setting that are present in the trademark setting described above. Indeed, the only post-*Rogers* court to adopt the test in the right of publicity setting implicitly acknowledged the lack of authority for the approach it borrowed, relying on dissents to support the “balancing” it advocated.<sup>172</sup>

### 6. The “Relatedness” Test

The *Restatement of Unfair Competition*<sup>173</sup> advocates a “relatedness” test, pursuant to which the use of others’ publicity rights in expressive

165. *See id.* at 1188.

166. *See generally* N.Y. Times v. United States, 403 U.S. 713 (1971) (stating that malice deals with the importance of public debate in free society, not property interests).

167. No. ED78785, 2002 Mo. App. LEXIS 1577, at \*1 (Mo. Ct. App. July 23, 2002).

168. *See id.* at \*46–\*49.

169. *Id.* at \*27–\*31.

170. *Id.* at \*45 n.16.

171. *See Rogers*, 875 F.2d at 999; *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 972 (10th Cir. 1996).

172. *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 971 (10th Cir. 1996) (citing *Rogers*, 875 F.2d at 999; *Mutual of Omaha Ins. Co.*, 836 F.2d at 405–06 (Heany, J., dissenting); *S.F. Arts & Athletics*, 483 U.S. at 569–70 (Brennan, J., dissenting)).

173. RESTATEMENT (THIRD) OF UNFAIR COMPETITION (1993).

works is permitted if the rights “relate” to the work, but not otherwise.<sup>174</sup> “Use of a [deceased personality’s] identity in advertising, magazine or newspaper articles, biographies, films, or similar works relating to the identified individual is not an infringement of the right of publicity”<sup>175</sup> while, “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 the use of the other’s identity in advertising.”<sup>176</sup> Several courts have applied this “relatedness” test where the First Amendment defenses to right of publicity claims involved expressive works.<sup>177</sup>

Most recently, the Kentucky Supreme Court applied a “relatedness” test to rule that there is no right of publicity violation from the use of a deceased musical performer’s name and likeness in a music video for a song that was a tribute to the deceased musical performer.<sup>178</sup> This decision is unusual because it addressed a First Amendment issue that had not been raised by any of the parties.<sup>179</sup> Perhaps for this reason, the Kentucky Supreme Court’s discussion does not discuss, refer to, or mention any of the authorities applying different tests as described herein.

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174. *Id.* § 47, Reporter’s Note & cmts. a, c.

175. *Id.* § 47, Reporter’s Note cmt. a.

176. *Id.* § 47, Reporter’s Note cmt. c.

177. *See, e.g.*, *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996) (holding a docudrama depicting the Black Panther party and Bobby Seale’s participation in the group as protected by the First Amendment under the *Restatement’s* “relatedness” test because no alternative means to discuss the matters raised); *Lerman v. Flynt Distrib. Co.*, 745 F.2d 123, 131–32 (2d Cir. 1984) (holding that First Amendment privilege is lost if the use of a name or likeness “has no real relationship to the discussion, and thus is an advertisement in disguise”); *Delan by Delan v. CBS, Inc.*, 458 N.Y.S.2d 608, 613 (App. Div. 1983) (“Of course, there must have existed a legitimate connection between the use of plaintiff’s name and picture and the matter of public interest sought to be portrayed . . . .”); *Barrows v. Rozansky*, 489 N.Y.S.2d 481, 485 (App. Div. 1985) (“to be privileged such use must be legitimately related to the informational value of the publication and may not be a mere disguised commercialization of a person’s personality;” nude photos of socialite arrested for running prostitution ring not legitimately related to news story); *see also Gugliemi v. Spelling-Goldberg Prod.*, 603 P.2d 454, 457 n.6 (Cal. 1979) (concluding media use of Rudolph Valentino to be appropriate because “this is not a case in which the use [of the deceased celebrity] is wholly unrelated to the individual. A different result may follow if, for example, respondents had published Rudolph Valentino’s cookbook and neither the recipes nor the menus described in the book were in any fashion related to Rudolph Valentino.”).

178. *Montgomery v. Montgomery*, 60 S.W.3d 524, 529 (Ky. 2001).

179. *See id.* at 527.

## 7. The “Alternative Means” Test

The “alternative means” test has been discussed in connection with right of publicity claims,<sup>180</sup> but has not yet been adopted. However, the Ninth Circuit and the U.S. Supreme Court arguably applied this approach to a right that is directly analogous to the right of publicity, namely, statutory rights in the “Olympic” mark in *San Francisco Arts & Athletics*, as described above.<sup>181</sup>

This statutory “Olympic” trademark is directly analogous to the right of publicity because both establish liability for particular words without requiring a likelihood of confusion.<sup>182</sup> Indeed, the Supreme Court’s discussion of the policies underlying the “Olympic” mark in *San Francisco Arts & Athletics* quoted from its earlier *Zacchini* decision in which it recognized the right of publicity, implied that the Supreme Court believed the policies underlying the statutory “Olympic” mark and the right of publicity are at least analogous.<sup>183</sup>

## V. OBSERVATIONS AND SUGGESTIONS

Aside from an unfortunate lack of judicial consistency, what can be learned from the above survey of this confusing area of law? Several principles can be gleaned from extant authority.

First, broad-brush arguments concerning the expansiveness of “speech” address only half of the issue. The right of publicity-free speech interface involves not merely the constitutional right to “speak,” but also the right to control one’s property.<sup>184</sup> An argument can be made that Constitutional “speakers” should not be able to “take” and use intellectual property to enable speech any more than they can take real or tangible personal property to do so. Intellectual property obviously has more expressive value than a building or field, but all can be used to communicate a message.<sup>185</sup> For this reason, all deserve the legal

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180. The Tenth Circuit in *Cardtoons* rejected the “adequate alternative avenues” approach in favor of ad hoc balancing, but nevertheless applied it to its decision. See *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 971–72 (10th Cir. 1996).

181. See *Int’l Olympic Comm. v. S.F. Arts & Athletics, Inc.*, 781 F.2d 733 (9th Cir. 1986); *S.F. Arts & Athletics*, 483 U.S. at 522.

182. See 36 U.S.C. § 380 (2000); CAL. CIV. CODE § 3344 (West 1997).

183. See *S.F. Arts & Athletics*, 483 U.S. at 533 (quoting *Zacchini*, 433 U.S. at 575).

184. See *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 971 (10th Cir. 1996).

185. Some courts have distinguished intellectual property from other types of property on the grounds that intellectual property’s symbolic value makes it a more important component of

protections that the Constitution affords.

Second, although the caselaw generally does not express itself in these terms, the right of publicity should be viewed as, at most, creating a “content neutral” restriction on speech. It promotes a “substantial government interest” in recognizing and protecting an individual’s commercial value in his or her identity.<sup>186</sup> Right of publicity law often protects the substantial government interest in circumstances which do not involve speech. The right of publicity would be much less effective if any claim to expressive use exempted it from liability. The right of publicity fits the classic definition of “content neutral” regulations when publicity rights are being used in a creative work.<sup>187</sup>

Third, most courts grappling with this issue have already applied some variant of intermediate review, although the precise approach varies according to the case. The Supreme Court’s *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>188</sup> decision, “merchandise v. media” caselaw, the *Restatement’s* “unrelatedness” approach, the “alternative means” approach, and the *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*<sup>189</sup> decision all involve judicial attempts to protect the commercial value of identity while permitting, where appropriate, the identity to be used for predominantly expressive purposes.<sup>190</sup>

Fourth, the “malice” and ad hoc “balancing” approaches utilized by

speech. See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 971 (10th Cir. 1996). However, some artists consider real property a necessary symbolic component of their art. For example, prominent artist Christo is well-known for creating artistic works that require acres of real property. His works include wrapping the Reichstag in a million square feet of polypropylene fabric in 1995, planting hundreds of umbrellas along the hillsides of California in 1991, surrounding the Pont Neuf of Paris in 1985 and the island of Biscayne Bay in 1983 with colored fabric, and his creation of a 24-mile nylon fabric “running fence” in California in 1976. See Steven R. Weisman, *Wrapping the Reichstag*, N.Y. TIMES, July 3, 1995, at 20; L.A. TIMES, June 25, 1995, at A12. Other artists commonly create large murals on the sides of high-rise office buildings. Thus, an argument that “pure speech” allows the use of another’s property would mean that any artist would have an absolute First Amendment right to trespass on and use that property to create “art.” Courts have rejected such arguments for decades. See, e.g., *Galella v. Onassis*, 487 F.2d 986, 995 (2d Cir. 1973) (holding that “crimes and torts committed in newsgathering are not protected [by the First Amendment]”); *Miller v. NBC*, 232 Cal. Rptr. 668, 681 (Ct. App. 1986) (holding that news organizations that trespassed into a home to photograph medical procedures was not protected).

186. See ALLAN IDES & CHRISTOPHER MAY, *CONSTITUTIONAL LAW: INDIVIDUAL RIGHTS* 307 (2d ed. 2001).

187. See *supra* Part II.B and accompanying notes.

188. 433 U.S. 562 (1977).

189. 483 U.S. 522 (1987).

190. See also *Dale v. Boy Scouts of Am.*, 734 A.2d 1196, 1223 (N.J. 1999) (showing court protection of the expressive idea of the Boy Scouts of America, even though a commercial entity).

some courts should be rejected. “Malice” does not recognize the property interests at stake, and has been rejected by the Supreme Court in the right of publicity setting.<sup>191</sup> “Balancing” lacks substantive content and encourages uncertainties, which may chill speech by themselves.<sup>192</sup>

Fifth, the fairest way to approach these issues when publicity rights are being used in a creative work, as well as the approach that best comports with applicable authority, may be to answer a simple question—What is being exploited? 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. Such an approach does justice to both the expressive and property interests. It protects intellectual property that is being exploited by others, but permits and encourages creative expression that makes meaningful comment on, about, or with the intellectual property. It gives deference to the heightened symbolic content of intellectual property by allowing such property to be used without compensation in many more circumstances than is possible with real or tangible personal property.

Such an approach would not be meaningful absent substantive analytic methodologies to help evaluate a particular use, but such methodologies are presently available, and have already been used by many courts. The better judicially developed approaches discussed herein, while individually unsatisfying or incomplete as described above, can provide helpful tools for determining whether the publicity right is being exploited or the individual is being commented on. For example, the “merchandise v. media” approach 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 predominantly are intended to capitalize on the commercial value of an individual’s identity by permitting the public to purchase a symbolic representation of that identity. 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’ right of publicity. The “alternative

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191. *See* N.Y. Times v. United States, 403 U.S. 713 (1971) (stating that malice has to do with the importance of public debate in free society, not property interests).

192. IDES & MAY, *supra* note 186, at 320 (stating that uncertainties could “impose a dangerous chill” on speech).

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. 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.<sup>193</sup> Even the California Supreme Court’s “formativeness” test can help to determine whether the use is primarily exploitive or communicative by encouraging judicial focus on the nature of the use.<sup>194</sup>

The above-described approach would, doubtless, be difficult to apply in many circumstances. However, in contrast to the present approaches it at least addresses the ultimate question in such cases, and provides mechanisms by which that question may be answered. It would also be better than the present judicial confusion that surrounds the issue. On one hand, continued judicial uncertainty and inconsistency will on the one hand cause more individuals and companies to exploit other publicity rights in legally dubious ways. On the other hand, it will chill speech and impoverish discourse as others avoid potentially harmless references to individuals. In addition, it will encourage additional litigation as individuals seek to protect rights of uncertain legal dimensions to prevent the devaluation of public goodwill that results from widened use of the intellectual property by third parties. Coherent legal guidelines are needed to protect individual rights and encourage speech.

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193. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. b (1995).

194. See *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001).



