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## COMIC BOOKS, THE FIRST AMENDMENT, AND THE “BEST TEST” FOR RIGHT OF PUBLICITY ISSUES

*Rachel Silverstein\**

### I. INTRODUCTION

California Supreme Court Chief Justice Bird has stated that, “The right of publicity derived from public prominence does not confer a shield to ward off caricature, parody and satire. Rather, prominence invites creative comment.”<sup>1</sup> This “creative comment” is what ignites heated lawsuits between a person of interest (“POI”) (i.e., celebrities) and the public over the POI’s public image. A POI’s public image may be appropriated in many ways, such as by unauthorized use in fine arts,<sup>2</sup> use in video games,<sup>3</sup> and even use in comic books.<sup>4</sup> Comic books in particular have been scrutinized under the First Amendment for decades due to their inherent combination of artistic and literary features.<sup>5</sup> A POI’s public image may be appropriated in comic books by way of artistic inclusion in the comic book storyline.<sup>6</sup> In order to determine whether appropriation occurred, courts consider various “right of publicity tests.”<sup>7</sup> However, courts have struggled with determining an all-encompassing test to address right of publicity issues.<sup>8</sup>

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<sup>1</sup> *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 460 (1979) (Bird, J., concurring).

<sup>2</sup> *See, e.g., ETW Corp. v. Jireh Publ’n, Inc.*, 332 F.3d 915 (6th Cir. 2003).

<sup>3</sup> *See, e.g., Keller v. Elec. Arts Inc. (In re NCAA Student–Athlete Name & Likeness Licensing Litig.)*, 724 F.3d 1268 (9th Cir. 2013).

<sup>4</sup> *See infra* section VI.

<sup>5</sup> *See infra* section V.

<sup>6</sup> *See, e.g., infra* section VI.

<sup>7</sup> *See infra* section IV.

<sup>8</sup> *See infra* section IV.

This Note addresses the issue of whether comic book creators who draw the likeness of a POI into their comic books are protected by the First Amendment when the POI argues right of publicity violations. Specifically, this Note considers which right of publicity test best applies to comic books and other media. Section II discusses what the right of publicity is and how it is defined. Section III discusses the intersection of the First Amendment and Right of Publicity. Section IV delves into the tests for right of publicity based on case law. Section V discusses how comic books relate to the First Amendment. Section VI discusses the intersection of comic books and right of publicity. Section VII applies the right of publicity tests to the comic book cases. Section VIII compares right of publicity to the First Amendment in other media. Section IX discusses the intersection of comic books, right of publicity, and the First Amendment. Finally, Section X considers the most effective test, the “Best Test,” for a POI’s right of publicity protection.

## II. WHAT IS THE RIGHT OF PUBLICITY?

Right of publicity is a derivative of privacy law when there is unauthorized use of a person’s likeness for financial gain.<sup>9</sup> The first ever right of publicity claim, and coining of the term “right of publicity,” stems from *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>10</sup> In *Haelan Laboratories*, the Second Circuit found that a baseball player had the exclusive right over his photograph when reproduced without his permission.<sup>11</sup> According to the Sixth Circuit in *ETW Corp. v. Jireh Publishing, Inc.*,<sup>12</sup> “right of publicity is an intellectual property right . . . defined as the inherent right of every human being to control the commercial use of his or her identity.”<sup>13</sup> Similarly, the New Jersey District Court in *Presley’s Estate v. Russen*,<sup>14</sup> defined right of publicity as the “right . . . to control the commercial value and exploitation of [one’s] name . . . or likeness and to prevent others from unfairly appropriating this value for their commercial benefit.”<sup>15</sup>

<sup>9</sup> See *Current Audio, Inc. v. RCA Corp.*, 337 N.Y.S.2d 949, 954 (Sup. Ct. 1972).

<sup>10</sup> 202 F.2d 866 (2d Cir. 1953).

<sup>11</sup> *Id.* at 868.

<sup>12</sup> 332 F.3d 915 (6th Cir. 2003).

<sup>13</sup> *Id.* at 928.

<sup>14</sup> 513 F. Supp. 1339 (D.N.J. 1981).

<sup>15</sup> *Id.* at 1353.

Violating a person's right of publicity is actionable in some states. For example, the State of Florida's "unauthorized publication of name or likeness" statute states, in part: "No person shall publish, print, display or otherwise publicly use for purposes of trade or for any commercial or advertising purpose the name, portrait, photograph, or other likeness of any natural person without the express written or oral consent to such use."<sup>16</sup> Similarly, Indiana's "limitations regarding use of an individual's identity" statute states that, "[a] person may not use an individual's identity for commercial purposes during the individual's lifetime without having obtained previous written consent."<sup>17</sup> These statutes have a commonality—no commercial use of a person's identity without consent. When a POI alleges his or her right of publicity is violated, defendants typically counter with the argument that they are expressing their First Amendment rights.<sup>18</sup>

### III. THE FIRST AMENDMENT AND RIGHT OF PUBLICITY

Right of publicity and the First Amendment are often intertwined. According to the Supreme Court of California, "[t]he right of publicity is often invoked in the context of commercial speech when the appropriation of a celebrity likeness creates a false and misleading impression that the celebrity is endorsing a product."<sup>19</sup> False and misleading speech is not protected by the First Amendment, and therefore, "the right of publicity may often trump the right of advertisers to make use of celebrity figures."<sup>20</sup> The Supreme Court of California held that "some, although not all, uses of celebrity likenesses are entitled to First Amendment protection."<sup>21</sup> The court also concluded that "depictions of celebrities amounting to little more than the appropriation of the celebrity's economic value are not protected expression under the First Amendment."<sup>22</sup> In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*<sup>23</sup> ("Comedy III"), the court recognized that "[o]nce the celebrity thrusts himself . . . into the limelight, the First Amendment dictates that

<sup>16</sup> FLA. STAT. ANN. § 540.08 (2020).

<sup>17</sup> 765 Ill. Comp. Stat. Ann. 1075/30.

<sup>18</sup> See *infra* section III.a.

<sup>19</sup> *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 802 (Cal. 2001).

<sup>20</sup> *Id.* at 802.

<sup>21</sup> *Winter v. DC Comics*, 69 P.3d 473, 477 (Cal. 2003).

<sup>22</sup> *Comedy III Prods.*, 21 P.3d at 805.

<sup>23</sup> 21 P.3d 797(Cal. 2001).

the right to . . . make [] expressive uses of the celebrity image must be [] broad.”<sup>24</sup> However, in the view of the Sixth Circuit:

There is an inherent tension between the right of publicity and the right of freedom of expression under the First Amendment. This tension becomes particularly acute when the person seeking to enforce the right is a famous actor, athlete, politician, or otherwise famous person whose exploits, activities, accomplishments, and personal life are subject to constant scrutiny and comment in the public media.<sup>25</sup>

Courts’ views of a POI’s right of publicity violation will differ based on First Amendment rights.

#### A. Cases Where Right of Publicity was Violated

In *Zacchini v. Scripps-Howard Broadcasting, Co.*,<sup>26</sup> plaintiff Zacchini was an entertainer who performed the “human cannonball” act in front of an audience for a fee.<sup>27</sup> Zacchini asked a reporter not to record his act, but the next day the reporter recorded it anyway.<sup>28</sup> The reporter recorded the entire act and sent it to Scripps-Howard Broadcasting, which aired the fifteen-second performance on their daily newscast.<sup>29</sup> Zacchini sued for damages alleging a violation of his right of publicity because defendants commercialized from the recording without his consent.<sup>30</sup> The trial court granted defendants summary judgment, and the Court of Appeals of Ohio reversed because Zacchini’s right of publicity was, indeed, violated.<sup>31</sup> The Supreme Court granted certiorari to consider “whether the First and Fourteenth Amendments immunized respondent from damages for its alleged infringement of petitioner’s state-law ‘right of publicity.’”<sup>32</sup> The Supreme Court reversed the Ohio Court of Appeals decision because

<sup>24</sup> *Id.* at 807.

<sup>25</sup> *ETW Corp. v. Jireh Publ’n, Inc.*, 332 F.3d 915, 931 (6th Cir. 2003).

<sup>26</sup> 433 U.S. 562 (1977).

<sup>27</sup> *Id.* at 563.

<sup>28</sup> *Id.* at 564.

<sup>29</sup> *Id.*

<sup>30</sup> *Id.*

<sup>31</sup> *Id.* at 564.

<sup>32</sup> *Id.* at 565.

“neither the public nor respondent will be deprived of the benefit of petitioner's performance as long as his commercial stake in his act is appropriately recognized.”<sup>33</sup> Essentially, the damages Zacchini sought were simply to be remunerated for his performance, and the First Amendment did not extend to the televised use of his entire performance without consent.<sup>34</sup> The Supreme Court did not reconcile the issue of whether a mere excerpt of the performance would violate Zacchini's right of publicity, and many have criticized the opinion for this lack of clarity.<sup>35</sup> Justice Powell's dissent discussed how the majority opinion was not “appropriately sensitive to the First Amendment.”<sup>36</sup> Justice Powell stated:

Hereafter, whenever a television news editor is unsure whether certain film footage received from a camera crew might be held to portray an “entire act,” he may decline coverage even of clearly newsworthy events or confine the broadcast to watered-down verbal reporting, perhaps with an occasional still picture. The public is then the loser. This is hardly the kind of news reportage that the First Amendment is meant to foster.<sup>37</sup>

The *Zacchini* decision implies that if the POI gives consent before televising something that is “news,” even “entertainment news,” the First Amendment will not be violated.

In *Comedy III*, plaintiff Comedy III Productions, Inc. was the registered owner of all rights to The Three Stooges, all whom are deceased.<sup>38</sup> Defendant Gary Saderup is an artist who made charcoal drawings of celebrities and turned them into lithographic prints and t-shirts.<sup>39</sup> Even though the art did not constitute an ad, endorsement, or sponsorship of any Three Stooges products, defendant sold his art bearing the likeness of the Three Stooges without consent.<sup>40</sup> The statute on which the plaintiff based its claim provided that any person who used a deceased person's likeness in any manner, or for purposes of

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<sup>33</sup> *Id.* at 578.

<sup>34</sup> *See id.*

<sup>35</sup> *See, e.g.,* Phyllis Glass, *State “Copyright” Protection for Performers: The First Amendment Question*, 27 *Duke L. J.* 5, 1199 (1978).

<sup>36</sup> 433 U.S. 562, 580 (1977) (Powell, J., dissenting).

<sup>37</sup> *Id.* at 580-81 (Powell, J., dissenting).

<sup>38</sup> *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 800 (Cal. 2001).

<sup>39</sup> *Id.*

<sup>40</sup> *Id.*

selling or advertising, without consent, shall be liable for damages, which include any profits earned and attorney fees and costs.<sup>41</sup> The court stated that:

The right of publicity is often invoked in the context of commercial speech when the appropriation of a celebrity likeness creates a false and misleading impression that the celebrity is endorsing a product. Because the First Amendment does not protect false and misleading commercial speech . . . the right of publicity may often trump the right of advertisers to make use of celebrity figures.<sup>42</sup>

The issue before the court was “whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.”<sup>43</sup> To consider this issue, the court described how an artist may argue that the First Amendment protects the work because it contains “significant transformative elements or that the value of the work does not derive primarily from the celebrity’s fame.”<sup>44</sup> The court found that there was “no significant or creative contribution,” and therefore the work was not sufficiently transformed because Saderup clearly intended to benefit monetarily from the Three Stooges’ fame.<sup>45</sup> The *Comedy III* case implies that a significant transformative “alteration” or creative contribution to a work without benefitting from the POI’s fame supersedes a POI’s First Amendment claim.<sup>46</sup>

### B. Cases Where Right of Publicity was Not Violated

In *Hoffman v. Capital Cities/ABC, Inc.*,<sup>47</sup> actor Dustin Hoffman sued Los Angeles Magazine for altering a still image of him from a movie and posting it in a magazine article without his permission.<sup>48</sup> The Ninth Circuit considered two factors when determining whether

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<sup>41</sup> *Id.* at 801.

<sup>42</sup> *Id.* at 802 (citations omitted).

<sup>43</sup> *Id.* at 809.

<sup>44</sup> *Id.* at 810.

<sup>45</sup> *Id.* at 811.

<sup>46</sup> The transformative use aspect of the *Comedy III* decision is derived from the copyright Fair Use test, discussed *infra* section IV.

<sup>47</sup> 255 F.3d 1180 (9th Cir. 2001).

<sup>48</sup> *Id.* at 1183.



Los Angeles Magazine was saved by a First Amendment claim: actual malice and whether the “free speech” was commercial or non-commercial use.<sup>49</sup> Hoffman argued that the inclusion of advertisements in the magazine meant the defendant intended to benefit monetarily from Hoffman’s image.<sup>50</sup> However, the court found that the image did not “advance a commercial message.”<sup>51</sup> Commercial speech, which is protected by a less stringent standard,<sup>52</sup> is distinguished from non-commercial speech, which receives full First Amendment protection; commercial speech merely requires a commercial transaction.<sup>53</sup> The court held that defendant magazine company was entitled to First Amendment protection because non-commercial speech could only be trumped by a showing of actual malice, which Hoffman failed to prove.<sup>54</sup> Defendant’s use of the image constituted non-commercial speech because the commercial aspects of the use were so intertwined with the expressive elements of the magazine that they could not be considered separate.<sup>55</sup> In *Cardtoons, L.C. v. Major League Baseball Players Ass’n*,<sup>56</sup> the Tenth Circuit relied on parody, a creature of copyright law, to determine whether plaintiff Cardtoons’ parodic use of baseball players’ likenesses in their baseball cards was protected by the First Amendment.<sup>57</sup> The court stated that, “Cardtoons’ expression requires use of player identities because, in addition to parodying the institution of baseball, the cards also lampoon individual players.”<sup>58</sup> In its conclusion, the court held, “The cards, on the other hand, are an important form of entertainment and social commentary that deserve First Amendment protection.”<sup>59</sup> The *Cardtoons* and *Hoffman* cases are important because they emphasize the protection of free speech. The First Amendment permits satirical and comedic speech directed at a POI and ensures that non-commercial speech which cannot be separated from commercial speech is afforded protection. *Cardtoons* and *Hoffman* reflect these concepts and are clear examples of when a POI

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<sup>49</sup> *Id.* at 1189.

<sup>50</sup> *Id.* at 1185.

<sup>51</sup> *Id.*

<sup>52</sup> *See id.* at 1184.

<sup>53</sup> *Id.* at 1184.

<sup>54</sup> *Id.* at 1186.

<sup>55</sup> *See id.*

<sup>56</sup> 95 F.3d 959 (10th Cir. 1996).

<sup>57</sup> *See generally Cardtoons*, 95 F.3d 959.

<sup>58</sup> *Id.* at 971.

<sup>59</sup> *Id.* at 976.



may not always receive First Amendment protection for the use of their likenesses.

#### IV. TESTS FOR RIGHT OF PUBLICITY

In an attempt to define a POI's right of publicity, courts have adopted various tests based on the areas of right of publicity, copyright law, trademark law, the First Amendment, and common laws. These tests include the transformative use test, the Fair Use test, the significant commercial value test, the Restatement relatedness test, and the predominant use test.

##### A. Comedy III Transformative Use Test

In *Comedy III*, the Supreme Court of California devised the Transformative Use test to determine whether the defendant appropriated the celebrity's economic value and whether that appropriation was sufficiently transformed in a way that allowed for First Amendment protection.<sup>60</sup> The test asks "whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness."<sup>61</sup> The word "expression" means "expression of something other than the likeness of the celebrity."<sup>62</sup> In *Hilton v. Hallmark Cards*,<sup>63</sup> the Ninth Circuit used the Transformative Use test to discuss the defendant's use of Paris Hilton's likeness and famous phrase "That's Hot" on a greeting card. The greeting card showed a Paris Hilton look-alike and a hot plate of food, but the court found it was not sufficiently transformative.<sup>64</sup> The court reasoned that although the girl on the card was a generic woman who appeared in merely a similar setting as Paris Hilton in an episode of "The Simple Life," there was still a clear connection between the card and Paris Hilton.<sup>65</sup> The court spoke of how a defendant "is only entitled to the [transformative use] defense as a matter of law if no trier of fact could reasonably conclude that the card was not transformative."<sup>66</sup>

<sup>60</sup> See *Winter v. D.C. Comics*, 69 P.3d 473, 477 (Cal. 2003) (discussing the Transformative Use Test).

<sup>61</sup> *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001).

<sup>62</sup> *Id.*

<sup>63</sup> 599 F.3d 894 (9th Cir. 2010).

<sup>64</sup> *Id.* at 911.

<sup>65</sup> *Id.*

<sup>66</sup> *Id.* at 910.

Ultimately, the Ninth Circuit dismissed “the appeal of denial of Hallmark's motion to dismiss the misappropriation of publicity claim.”<sup>67</sup>

Additionally, the Third Circuit in *Hart v. Electronic Arts, Inc.*<sup>68</sup> compared multiple tests, but adopted the Transformative Use test.<sup>69</sup> In *Hart*, former college football player Ryan Hart sued video game developer Electronic Arts, Inc. (“EA”) for allegedly violating his right of publicity when EA misappropriated his likeness in the video game series *NCAA Football*.<sup>70</sup> The Third Circuit held that the video games did not sufficiently transform the players’ likenesses because the games did not contain “highly creative elements in great abundance.”<sup>71</sup> The court decided the Transformative Use test was superior to the predominant use and Restatement relatedness test for three reasons: First, “the Transformative Use Test maintains a singular focus on whether the work sufficiently transforms the celebrity's identity or likeness, thereby allowing courts to account for the fact that misappropriation can occur in any market segment, including those related to the celebrity.”<sup>72</sup> Second, the test “recognizes that if First Amendment protections are to mean anything in right of publicity claims, courts must *begin* by considering the extent to which a work is the creator's own expression.”<sup>73</sup> Third, the test “effectively restricts right of publicity claims to a very narrow universe of expressive works.”<sup>74</sup>

### B. Fair Use Test

In *Comedy III* and in *Cardtoons*, the courts considered using the Fair Use test, which typically goes hand-in-hand with copyright infringement claims. The Fair Use doctrine includes the following factors:

- (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;

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<sup>67</sup> *Id.* at 912-13.

<sup>68</sup> 717 F.3d 141 (3d Cir. 2013).

<sup>69</sup> *Id.* at 153.

<sup>70</sup> *Id.* at 145.

<sup>71</sup> *Id.* at 169.

<sup>72</sup> *Id.* at 163.

<sup>73</sup> *Id.*

<sup>74</sup> *Id.*

- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and  
 (4) the effect of the use upon the potential market for or value of the copyrighted work.<sup>75</sup>

The doctrine also pertains to how copyrighted works may be commented on or criticized, which includes the right to create a parody of a work.<sup>76</sup> The court in *Cardtoons* considered how parody relates to First Amendment protection and the right of publicity.<sup>77</sup> The court concluded that the Fair Use test was proper because the use of the players' likenesses on the cards was a lampoon or parody of the players, therefore protecting the card company. Conversely, the court in *Comedy III* found that use of the Fair Use doctrine was a poor test in determining right of publicity violations.<sup>78</sup> The court reasoned that the first factor *could* pertain to the right of publicity because it deals with whether a work is transformative, but that this relates back to the Transformative Use Test.<sup>79</sup> There are differences between the first Fair Use factor and the Transformative Use Test. The Supreme Court stated in *Campbell v. Acuff-Rose Music, Inc.*<sup>80</sup> that, regarding the first Fair Use factor, "the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use."<sup>81</sup> However, in the context of the right of publicity Transformative Use Test, it is important to keep in mind that the Transformative Use Test relates only to a POI. Although both the Transformative Use Test and first factor of the Fair Use Test deal with use that is transformative, right of publicity issues do not necessarily overlap with copyright law.

The court in *Comedy III* found that the second and third Fair Use factors do not particularly relate to findings of right of publicity violations, but rather only relate to copyright infringement claims.<sup>82</sup> The court reasoned that applying works of authorship in a fixed,

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<sup>75</sup> 17 U.S.C. § 107.

<sup>76</sup> See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir.1996).

<sup>77</sup> See *supra* Section III.b.

<sup>78</sup> *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807-08 (Cal. 2001).

<sup>79</sup> *Id.*

<sup>80</sup> 510 U.S. 569 (1994).

<sup>81</sup> *Id.* at 579.

<sup>82</sup> *Comedy III Prods.*, 21 P.3d at 807-08.

tangible, medium of expression<sup>83</sup> does not relate to “whether the depiction of a celebrity likeness is protected by the First Amendment.”<sup>84</sup> The *Comedy III* court discussed the fourth Fair Use factor in a footnote, stating: “If it is determined that a work is worthy of First Amendment protection because added creative elements significantly transform the celebrity depiction, then independent inquiry into whether or not that work is cutting into the market for the celebrity's images . . . appears to be irrelevant.”<sup>85</sup> The court concluded that the Transformative Use test “protect[s] the right-of-publicity holder's core interest in monopolizing the merchandising of celebrity images without unnecessarily impinging on the artists' right of free expression.”<sup>86</sup> The Fair Use test should remain a creature of copyright law; a defendant arguing she created a work of parody or of commercial nature when using a POI's likeness essentially asks the court to consider whether the work was transformative. Arguing parody or commercialization alone is not sufficient to warrant Fair Use protection, but rather the court must consider all the Fair Use factors in conjunction with one another. The Transformative Use test only considers significant transformation, and therefore it is a better, narrower test than Fair Use.

### C. Significant Commercial Value Test

The court in *Cheatham v. Paisano Publications, Inc.*<sup>87</sup> discussed how a “remedy available in right of publicity claims belongs to those whose identity has commercial value.”<sup>88</sup> The plaintiff claimed that her likeness was used in a photograph that was subsequently printed on t-shirts and sold for value.<sup>89</sup> There, commercial value may be proven by establishing, “(1) the distinctiveness of the identity and by (2) the degree of recognition of the person among those receiving the publicity.”<sup>90</sup> The court also concluded that, “[i]n order to succeed in [a] claim, Plaintiff must have a notoriety which is strong enough to have commercial value within an identifiable group.”<sup>91</sup> The court held

<sup>83</sup> See 17 U.S.C. § 102.

<sup>84</sup> *Comedy III Prods.*, 21 P.3d at 808.

<sup>85</sup> *Id.* at 808 n.10.

<sup>86</sup> *Id.*

<sup>87</sup> 891 F. Supp. 381 (W.D. Ky. 1995).

<sup>88</sup> *Id.* at 386.

<sup>89</sup> *Id.*

<sup>90</sup> *Id.*

<sup>91</sup> *Id.*

that plaintiff's "friends and customers recognize her designs and that these unique designs have commercial value [which] overcomes Defendants' motions to dismiss."<sup>92</sup> The *Cheatham* court noted that First Amendment protections were afforded to the defendant because the photograph fell within the newsworthiness doctrine.<sup>93</sup> The Significant Commercial Value test was also used in *Landham v. Lewis Galoob Toys, Inc.*,<sup>94</sup> where the Sixth Circuit stated that to succeed in a claim the "[plaintiff] must show that a merchant would gain significant commercial value by associating an article of commerce with him."<sup>95</sup> The court in *Landham* held that the plaintiff's likeness was not used in an action figure distributed by defendant because plaintiff's persona was distinct from his likeness.<sup>96</sup>

#### D. Restatement Relatedness Test

The Restatement relatedness test, as described in *Doe v. TCI Cablevision*,<sup>97</sup> stems from the Restatement (Third) of Unfair Competition. The test "protects the use of another person's name or identity in a work that is 'related to' that person."<sup>98</sup> The Restatement states:

The name, likeness, and other indicia of a person's identity are used "for purposes of trade" . . . if they are used in advertising the user's goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user. However, use "for purposes of trade" does not ordinarily include the use of a person's identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.<sup>99</sup>

A comment to the Restatement states, "[I]f the name or likeness is used solely to attract attention to a work that is not related to the identified person, the user may be subject to liability for a use of the other's

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<sup>92</sup> *Id.* at 387.

<sup>93</sup> *Id.* at 386 n.5.

<sup>94</sup> 227 F.3d 619 (6th Cir. 2000).

<sup>95</sup> *Id.* at 624.

<sup>96</sup> *Id.* at 626.

<sup>97</sup> 110 S.W.3d 363 (Mo. 2003).

<sup>98</sup> *Id.* at 373.

<sup>99</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (AM. LAW INST. 1995).

identity in advertising.”<sup>100</sup> The *Doe v. TCI Cablevision* court reasoned that, “In a right of publicity action, the plaintiff must prove the same elements as in a misappropriation suit, with the minor exception that the plaintiff must prove that the defendant used the name to obtain a commercial advantage.”<sup>101</sup> In *Rogers v. Grimaldi*,<sup>102</sup> the Second Circuit considered whether the Restatement Relatedness test was the best test for determining whether POI Ginger Rogers and Fred Astaire’s likenesses were misappropriated when the defendant made a fictional movie titled “Ginger and Fred.”<sup>103</sup> The court adopted a two-pronged test stemming from trademark law that asks, 1) whether the use of the POI’s likeness was “wholly unrelated” to the sale of the goods or services, or 2) whether the use was “simply a disguised commercial advertisement for the sale of goods or services.”<sup>104</sup> The court found that when applying Oregon’s common law for right of publicity, the Rogers and Astaire’s likenesses were not misappropriated because the title “Ginger and Fred” merely “related to content of the movie” and not the famous actors.<sup>105</sup> Essentially, the goal of this test is to provide a means to separate commercial speech from expressive speech, and courts must look at the elements of misappropriation first before considering a right of publicity violation.<sup>106</sup>

### E. Predominant Use Test

The Supreme Court of Missouri in *TCI Cablevision* proposed a new right of publicity test, the “Predominant Use” test, to address both expressive and commercial components.<sup>107</sup> The Predominant Use test states:

If a product is being sold that predominantly exploits the commercial value of an individual's identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some “expressive” content in it that might qualify as “speech” in other circumstances. If, on the other

<sup>100</sup> *Id.* at cmt C.

<sup>101</sup> *TCI Cablevision*, 110 S.W.3d at 369.

<sup>102</sup> 875 F.2d 994 (2d Cir. 1989).

<sup>103</sup> *Id.* at 996.

<sup>104</sup> *Id.* at 1004.

<sup>105</sup> *Id.* at 1004-05.

<sup>106</sup> *TCI Cablevision*, 110 S.W.3d at 373.

<sup>107</sup> *Id.* at 374.

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.<sup>108</sup>

The Predominant Use test was also considered in *Hart v. Electronic Arts, Inc.*<sup>109</sup> There, the Third Circuit rejected the test because it “is subjective at best, arbitrary at worst, and in either case calls upon judges to act as both impartial jurists and discerning art critics.”<sup>110</sup> The theory behind the test is that 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.”<sup>111</sup>

## V. COMIC BOOKS AND THE FIRST AMENDMENT

Comic books are comprised of words and art; does this mean that comics are protected by the First Amendment? There are two issues here: first, the issue of free speech must be addressed – whether the contents within comic books are considered free speech, and therefore, are entitled to First Amendment protection. Second, the issue of applicable exceptions must be addressed. If words and art within comic books are protected as free speech, is there ever a time when they are not entitled to First Amendment protection?

### A. Free Speech

The First Amendment of the U.S. Constitution states, “Congress shall make no law. . . prohibiting the free exercise thereof; or abridging the freedom of speech.”<sup>112</sup> Today, the definition of “freedom of speech” pursuant to the First Amendment has been expanded to include pictures, films, paintings, drawings, and engravings.<sup>113</sup> In *Bery v. City of New York*,<sup>114</sup> the Second Circuit stated, “Visual art is as

<sup>108</sup> *Id.* (citing Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 500 (2003)).

<sup>109</sup> 717 F.3d 141 (3d Cir. 2013).

<sup>110</sup> *Id.* at 154.

<sup>111</sup> Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 500 (2003).

<sup>112</sup> U.S. CONST. AMEND. I.

<sup>113</sup> *Kaplan v. California*, 413 U.S. 115, 119 (1973).

<sup>114</sup> 97 F.3d 689, 695 (2d Cir. 1996).



wide ranging in its depiction of ideas, concepts and emotions as any book . . . or other writing, and is similarly entitled to full First Amendment protection.”<sup>115</sup> However, when it comes to certain pornographic comic books, the Supreme Court considers these forms of words coupled with art “legally obscene” and outside the purview of the First Amendment.<sup>116</sup>

### B. Obscenity as an Exception

“I know it when I see it,” the infamous words written by Justice Potter regarding obscenity and free speech, tell it all: defining obscenity is difficult.<sup>117</sup> The Supreme Court has made many attempts to define obscenity,<sup>118</sup> but the most recent test is decades old.<sup>119</sup> Obscenity issues are particularly prominent when it comes to comic book shop owners and employees.<sup>120</sup> There are numerous cases involving comic shop owners and employees who have been arrested for selling “legally obscene” comic books.<sup>121</sup> Each of the defendants in these cases has argued First Amendment protection to no avail,<sup>122</sup> the defendants were all convicted under their respective state obscenity statutes for selling legally obscene comic books.<sup>123</sup> Comic book artists and writers are aware of the overbroad obscenity statutes and common law that may adversely affect them;<sup>124</sup> this is shown in a comedic way, for

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<sup>115</sup> *Id.*

<sup>116</sup> *See Kaplan*, 413 U.S. at 119-20.

<sup>117</sup> *Jacobellis v. State of Ohio*, 378 U.S. 184, 197 (1964) (Potter, J., concurring).

<sup>118</sup> *See Roth v. U.S.*, 354 U.S. 476 (1957); *Memoirs v. Massachusetts*, 383 U.S. 413 (1966); *Miller v. California*, 413 U.S. 15 (1973).

<sup>119</sup> *Miller v. California*, 413 U.S. 15, 24 (1973) (“The basic guidelines for the trier of fact must be: (a) whether ‘the average person, applying contemporary community standards’ would find that the work, taken as a whole, appeals to the prurient interest; (b) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (c) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.”(citation omitted)).

<sup>120</sup> *See Rachel Silverstein, The Law of Obscenity in Comic Books*, 35 *TOURO L. REV.* 1315 (2020).

<sup>121</sup> *See, e.g., Kingsley Books, Inc. v. Brown*, 354 U.S. 436 (1957); *People v. Kirkpatrick*, 316 N.Y.S.2d 37 (N.Y. Crim. Ct. 1970); *Castillo v. State*, 79 S.W.3d 817 (Tex. App. 2002).

<sup>122</sup> *See supra* note 121.

<sup>123</sup> *See supra* note 121.

<sup>124</sup> *See History of Comics Censorship*, Part 4, CBLDF, <http://cblfd.org/resources/history-of-comics-censorship/history-of-comics-censorship-part-4/> (last visited August 29, 2019).

example, in the 1970s pornographic comic book *Harold Hedd*.<sup>125</sup> The short comic pokes fun at obscenity laws, where the main character, Harold, states, “[Y]’know, maybe that’s it! Maybe obscenity—like beauty—is in the eye of the beholder . . . kinda depends on what yer lookin [sic] for.”<sup>126</sup> Additionally, comic book artists and writers, specifically, have had legal difficulty with First Amendment rights and their relationship to right of publicity.<sup>127</sup>

## VI. COMIC BOOKS AND RIGHT OF PUBLICITY

There is overlap between comic books and right of publicity – comic book artists may draw a POI into their comic books without the POI’s permission. This scenario occurred in the cases of *Winter v. DC Comics*<sup>128</sup> and *Doe v. TCI Cablevision*, where comic creators drew the likenesses of Johnny and Edgar Winter and Tony Twist, respectively, in their comic books. The Winter brothers and Twist all argued that their right of publicity was violated when their likenesses were depicted as super villainous.

### A. Winter v. DC Comics

In *Winter v. DC Comics*, DC Comics published a five-volume comic book called “Jonah Hex” during the 1990s.<sup>129</sup> The fourth volume of the series introduced two new characters, “The Autumn Brothers,” aptly named Jonny and Edgar Autumn.<sup>130</sup> The “Autumn Brothers” are depicted as having “pale faces and long white hair . . . [o]ne brother wears a stovepipe hat and red sunglasses and holds a rifle. The second has red eyes and holds a pistol.”<sup>131</sup> The brothers are “depicted as half-worm, half-human,” and are shot and killed by Jonah Hex in the fifth volume.<sup>132</sup>

Johnny and Edgar Winter are well-known musicians.<sup>133</sup> The Winter brothers sued DC Comics for appropriation of their names and

<sup>125</sup> RAND H. HOLMES, *HAROLD HEDD* NO. 2, 1 (1973).

<sup>126</sup> *Id.*

<sup>127</sup> See *infra* section VI.

<sup>128</sup> 69 P.3d 473 (Cal. 2003).

<sup>129</sup> *Id.* at 476.

<sup>130</sup> *Id.*

<sup>131</sup> *Id.*

<sup>132</sup> *Id.*

<sup>133</sup> *Id.*

likenesses under California Civil Code section 3344.<sup>134</sup> The plaintiffs alleged the following:

[T]hat the defendants selected the names Johnny and Edgar Autumn to signal readers the Winter brothers were being portrayed; that the Autumn brothers were drawn with long white hair and albino features similar to plaintiffs'; that the Johnny Autumn character was depicted as wearing a tall black top hat similar to the one Johnny Winter often wore; and that the title of volume 4, *Autumns of Our Discontent*, refers to the famous Shakespearian phrase, "the winter of our discontent." They also alleged that the comics falsely portrayed them as "vile, depraved, stupid, cowardly, subhuman individuals who engage in wanton acts of violence, murder and bestiality for pleasure and who should be killed."<sup>135</sup>

The trial court granted defendants' motion for summary judgment.<sup>136</sup> The Supreme Court of California remanded the case to the Court of Appeal following the court's decision in *Comedy III*.<sup>137</sup> The second time around, the Court of Appeal affirmed summary judgment for all actions except the misappropriation of likeness action.<sup>138</sup> Finally, the Supreme Court of California "granted defendants' petition for review to decide whether the comic books are protected under the *Comedy III* transformative test."<sup>139</sup> The Supreme Court compared *Winter* to *Comedy III* and concluded that "in contrast to a drawing of The Three Stooges, the comic books do contain significant creative elements that transform them into something more than mere celebrity likenesses. Accordingly, the comic books are entitled to First Amendment protection."<sup>140</sup> The court held that, in comparison to *Comedy III*, "defendants essentially sold, and the buyers purchased, DC Comics depicting fanciful, creative characters, not pictures of the Winter brothers. This makes all the difference."<sup>141</sup> Essentially, the difference in the *Winter*

<sup>134</sup> *Id.*

<sup>135</sup> *Id.*

<sup>136</sup> *Id.*

<sup>137</sup> *Id.*

<sup>138</sup> *Id.*

<sup>139</sup> *Id.*

<sup>140</sup> *Id.*

<sup>141</sup> *Id.* at 480.

case is that the comic book drawings significantly transformed the Winter brothers look-a-likes, whereas in *Comedy III*, The Three Stooges were not transformed at all.

### B. Doe v. TCI Cablevision

In *Doe v. TCI Cablevision*, former professional National Hockey League player Tony Twist brought suit against Todd McFarlane, the creator of Image Comic Inc.'s *Spawn* comics, and associated companies, for injunction, damages, misappropriation of his name and defamation.<sup>142</sup> In *Spawn* issue number six a new villain named “Anthony ‘Tony Twist’ Twistelli” appeared.<sup>143</sup> The new villain was part of the mafia and partook in heinous activities such as “multiple murders, abduction of children and sex with prostitutes.”<sup>144</sup> McFarlane stated in a magazine article that he often used the names of real people when naming his characters.<sup>145</sup> Twist became aware of the comic book when fans started bringing him copies to be signed by him.<sup>146</sup>

McFarlane and the companies associated with the *Spawn* comic book (collectively, “defendants”) filed for summary judgment on the ground of First Amendment protection, but to no avail.<sup>147</sup> Defendants argued that although the name Tony Twist was used in the comic book, there was no association with the real “Tony Twist” and that they did not intend to benefit from the use of the name.<sup>148</sup> However, Twist’s evidence that defendants did intend to benefit from his name was revealed upon production of *Spawn*-licensed hockey memorabilia.<sup>149</sup> In regard to Twist’s defamation claim, there was evidence that a sponsor of Twist “withdrew a \$100,000 offer to Twist” after seeing his name in a comic book associated with the Mafia.<sup>150</sup> However, the misappropriation claim is not relevant here. The court considered multiple right of publicity tests, discussed in Section VII.b. The court concluded that a right of publicity claim must have the following elements: “(1) That defendant used plaintiff’s name as a symbol of his identity (2) without

<sup>142</sup> *Doe v. TCI Cablevision*, 110 S.W.3d 365, 365 (Mo. 2003).

<sup>143</sup> *Id.* at 366-67.

<sup>144</sup> *Id.* at 366.

<sup>145</sup> *Id.* at 366-67.

<sup>146</sup> *Id.* at 367.

<sup>147</sup> *Id.*

<sup>148</sup> *Id.*

<sup>149</sup> *Id.*

<sup>150</sup> *Id.*

consent (3) and with the intent to obtain a commercial advantage.”<sup>151</sup> Ultimately, the court held that:

[T]he use and identity of Twist's name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity.<sup>152</sup>

Additionally, the court found that all of the elements for Twist's right of publicity claim were met, and therefore there was sufficient evidence to prove that defendants used his name for commercial advantage.<sup>153</sup> This test, the Restatement relatedness test, has received broad support since the *TCI Cablevision* case was decided.<sup>154</sup>

## VII. RIGHT OF PUBLICITY TESTS AS APPLIED TO COMIC BOOKS

In both *Winter v. DC Comics* and *Doe v. TCI Cablevision*, the courts applied various tests to determine whether the POIs' rights of publicity were violated. Although there are five tests,<sup>155</sup> the courts in *Winter* and *TCI Cablevision* relied on the Transformative Use test and Restatement relatedness test.

### A. Winter v. DC Comics

The main issue in *Winter v. DC Comics* was whether the Court of Appeal properly considered the comic books under the *Comedy III* Transformative Use Test.<sup>156</sup> When applied to the *Comedy III* Transformative Use Test, the California Supreme Court found that “depictions of plaintiffs . . . contain significant expressive content other than plaintiffs' mere likenesses.”<sup>157</sup> The court reasoned that:

Although the fictional characters Johnny and Edgar Autumn are less-than-subtle evocations of Johnny and Edgar Winter, the books do not depict plaintiffs literally. Instead, plaintiffs are merely part of the raw materials from which the comic books were synthesized. To the

<sup>151</sup> *Id.* at 369.

<sup>152</sup> *Id.* at 374.

<sup>153</sup> *Id.* at 371-72.

<sup>154</sup> See *supra* section IV. A.

<sup>155</sup> See *supra* section IV.

<sup>156</sup> *Winter v. DC Comics*, 69 P.3d 473, 476 (Cal. 2003).

<sup>157</sup> *Id.* at 479.

extent the drawings of the Autumn brothers resemble plaintiffs at all, they are distorted for purposes of lampoon, parody, or caricature. And the Autumn brothers are but cartoon characters—half-human and half-worm—in a larger story, which is itself quite expressive.<sup>158</sup>

The court concluded that the comic book art did not violate the Winter brothers' rights of publicity because there was sufficient transformation.<sup>159</sup> Additionally, the Fair Use test was found to be irrelevant because “[i]t does not matter what precise literary category the work falls into. What matters is whether the work is transformative, not whether it is parody.”<sup>160</sup> Under copyright law, this statement is partly accurate; Transformative Use under the Fair Use doctrine should only relate to the transformation itself. However, parody is not the only factor relevant to the first Fair Use factor, or even to the Fair Use doctrine as a whole. Had the court considered the “Best Test,”<sup>161</sup> it is likely that a reasonable trier of fact would find that the defendants' comic book portraying the Winter brothers' personas was not for commercial gain, and their alleged “likeness” was substantially transformed as a whole, rather than as minimal elements. The Winter brothers' alleged likenesses were greatly transformed in the sense that that the Autumn brothers in the comic book were not human and were clearly cartoon character human-worms rather than the actual Winter brothers.

### B. Doe v. TCI Cablevision

In *Doe v. TCI Cablevision*, the court addressed two tests: the *Comedy III* Transformative Use test and the Restatement relatedness test. The court was reluctant to apply either test because neither considered that “many uses of a person's name and identity have both expressive and commercial components.”<sup>162</sup> The tests “operate to preclude a cause of action whenever the use of the name and identity is in

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<sup>158</sup> *Id.*

<sup>159</sup> *See id.*

<sup>160</sup> *Id.*

<sup>161</sup> *See infra* Section X.

<sup>162</sup> *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003).

any way expressive, regardless of its commercial exploitation.”<sup>163</sup> When applying the Predominant Use test, the court found that although Tony Twist’s likeness was used for commercial advantage, the use still contained an expressive aspect.<sup>164</sup> However, there was little commercial value in the “metaphorical reference to Twist.”<sup>165</sup> Ultimately, the court held that “the use and identity of Twist’s name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression.”<sup>166</sup> Defendant’s arguments would have likely failed the “Best Test”<sup>167</sup> due to the defendant’s inherent desire for monetary gain from the plaintiff’s likeness. Fans of the real Tony Twist bringing him the comic book to be signed is evidence that there was no transformation of the character in the comic book, and therefore the defendant could not have prevailed in the lawsuit.

### VIII. RIGHT OF PUBLICITY AND THE FIRST AMENDMENT IN OTHER MEDIA

Comic books are not alone when it comes to arguing First Amendment protection for right of publicity claims. For example, likeness of a POI used in video games and fine art<sup>168</sup> is not protected by the First Amendment when there is no significant transformation of the POI.<sup>169</sup>

#### A. Video Games

Video games are afforded First Amendment protection in and of themselves. The U.S. Supreme Court, in *Brown v. Entertainment Merchants Ass’n*,<sup>170</sup> stated:

Like the protected books, plays, and movies that preceded them, video games communicate ideas—and

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<sup>163</sup> *Id.* at 374.

<sup>164</sup> *Id.*

<sup>165</sup> *Id.* at 374.

<sup>166</sup> *Id.*

<sup>167</sup> See *infra* Section X.

<sup>168</sup> As used in this Note, “fine art” is any art that is not found in a comic book.

<sup>169</sup> See, e.g., *Keller v. Elec. Arts Inc. (In re NCAA Student–Athlete Name & Likeness Licensing Litig.)*, 724 F.3d 1268 (9th Cir. 2013); *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915 (6th Cir. 2003).

<sup>170</sup> 564 U.S. 786 (2011).



even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player's interaction with the virtual world). That suffices to confer First Amendment protection.<sup>171</sup>

However, as with comic books, the right of publicity in video games must be balanced against First Amendment claims.<sup>172</sup> For example, in *Keller v. Electronic Arts Inc. (In re NCAA Student–Athlete Name & Likeness Licensing Litigation)*,<sup>173</sup> the Ninth Circuit held that video game developer Electronic Arts had no First Amendment protection for using the likeness of college football player Samuel Keller in its *NCAA Football* video game.<sup>174</sup> The Ninth Circuit looked to *Comedy III's* Transformative Use test to determine whether the video game version of Keller was sufficiently transformed to be considered more than a celebrity likeness.<sup>175</sup> The court found a lack of a significant transformation of Keller's likeness to bear First Amendment protection.<sup>176</sup>

Additionally, in *No Doubt v. Activision Publishing, Inc.*,<sup>177</sup> the band No Doubt licensed its likeness to be used in the video game *Rock Band*;<sup>178</sup> however, No Doubt brought suit against Activision for violations of their right of publicity.<sup>179</sup> The California Court of Appeal found that literal recreations of the band members were used, therefore barring a First Amendment claim.<sup>180</sup> Similar to the court's analysis in *No Doubt*, the Third Circuit in *Hart v. Electronic Arts, Inc.*, applied the Transformative Use test and found that defendant's use of college football player Ryan Hart's likeness in its video game was not transformative because “[t]he digital Ryan Hart does what the actual Ryan Hart did while at Rutgers: he plays college football, in digital recreations of college football stadiums, filled with all the trappings of a college football game.”<sup>181</sup> The court concluded that “the various digitized

<sup>171</sup> *Id.* at 790.

<sup>172</sup> *Keller*, 724 F.3d at 1271.

<sup>173</sup> 724 F.3d 1268 (9th Cir. 2013).

<sup>174</sup> *Id.* at 1271.

<sup>175</sup> *Id.* at 1273.

<sup>176</sup> *Id.* at 1276.

<sup>177</sup> 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011).

<sup>178</sup> *Id.* at 400.

<sup>179</sup> *Id.*

<sup>180</sup> *Id.* at 411.

<sup>181</sup> *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 166 (3d Cir. 2013).

sights and sounds in the video game do not alter or transform the Appellant's identity in a significant way.”<sup>182</sup>

Comic books and video games are similar in that they both contain artistic visuals that could depict POIs. There is another similar theme surrounding the inclusion of POI likenesses in video games or comic books and First Amendment issues – the use of the Transformative Use test. The courts in the video games cases, *In re NCAA, No Doubt*, and *Hart*, all applied the Transformative Use test, as did the court in the comic book case *Winter v. DC Comics*. These courts recognized that if the POI likeness was sufficiently transformed in the artistic work, then the creators would be protected. The difference between the video game cases and the comic book case of *Winter* is that in the video games, each character was doing what the POI does in the real world; for example, No Doubt sings, and the basketball and football players play their respective sports. However, in *Winter*, the Winter brothers did not sing in the comic book as they do in the real world; they were transformed into villains. This can be contrasted with *Doe v. TCI Cablevision*, where Tony Twist's likeness was used for commercial gain in connection with hockey memorabilia in which real life Tony Twist is a famous hockey player. Right of publicity has also led to the barring of First Amendment claims in the field of art, where artists draw the likeness of celebrities in fine art.

## B. Fine Art

Just like art in comic books, fine art is afforded First Amendment protection. In *ETW Corp. v. Jireh Publishing, Inc.*, the licensing agent of Tiger Woods sued the publisher of an artist who painted a picture of Woods for right of publicity violation.<sup>183</sup> The Sixth Circuit considered two tests – the Fair Use test and the Transformative Use test. Regarding fair use, the court briefly analyzed only the third and fourth factors.<sup>184</sup> The court stated, “the substantiality and market effect of the use of the celebrity's image is analyzed in light of the informational and creative content of the defendant's use,” and concluded that, “Rush's work has substantial informational and creative content which outweighs any adverse effect on ETW's market and that Rush's work

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<sup>182</sup> *Id.*

<sup>183</sup> *ETW Corp. v. Jireh Publ'n, Inc.*, 332 F.3d 915, 918-19 (6th Cir. 2003).

<sup>184</sup> *Id.* at 937.

does not violate Woods's right of publicity."<sup>185</sup> The court compared *ETW Corp.* to *Cardtoons*, agreeing that “[due to a POI’s] pervasive presence in the media [and] sports[,] entertainment celebrities have come to symbolize certain ideas and values in our society and have become a valuable means of expression in our culture.”<sup>186</sup> Regarding the Transformative Use test, the court found that:

[A]pplying the transformative effects test adopted . . . in *Comedy III*, we find that Rush's work does contain significant transformative elements which make it especially worthy of First Amendment protection and also less likely to interfere with the economic interest protected by Woods' right of publicity. Unlike the unadorned, nearly photographic reproduction of the faces of The Three Stooges in *Comedy III*, Rush's work does not capitalize solely on a literal depiction of Woods. Rather, Rush's work consists of a collage of images in addition to Woods's image which are combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods's achievement in that event.<sup>187</sup>

Based on consideration of both tests, the court held that Rush’s work was entitled to First Amendment protection.<sup>188</sup> Both comic books and fine art consist nearly entirely of artistic elements.<sup>189</sup> The *ETW Corp.* case can be compared to *Winter v. DC Comics*. In both cases, the courts considered the Transformative Use test to determine that the POI’s right of publicity was not violated because there were significant transformative elements in the artistic works.

#### **IX. THE INTERSECTION BETWEEN COMIC BOOKS, RIGHT OF PUBLICITY, AND THE FIRST AMENDMENT**

There is a nexus among comic books, right of publicity and the First Amendment: when a POI’s identity is used to sell comic books,

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<sup>185</sup> *Id.*

<sup>186</sup> *Id.* at 937-938.

<sup>187</sup> *Id.* at 938.

<sup>188</sup> *Id.*

<sup>189</sup> The exception is that comic books consist of mostly art but also contain dialogue.

“free speech must give way to the right of publicity.”<sup>190</sup> This poses two issues: 1) whether the First Amendment protects comic book creators who draw a POI and 2) whether the First Amendment protects the POI when comic book creators draw his or her likeness in comic books.

#### A. When Are Comic Book Creators Protected?

According to *Comedy III*'s Transformative Use test, significant creative contributions to an artist's work are what protect creators, as long as the creator is not specifically using the POI's likeness for monetary gain.<sup>191</sup> The *Comedy III* court decided that:

[W]hen an artist is faced with a right of publicity challenge to his or her work, he or she may raise as affirmative defense that the work is protected by the First Amendment inasmuch as it contains significant transformative elements or that the value of the work does not derive primarily from the celebrity's fame.<sup>192</sup>

The Supreme Court of California in *Winter v. DC Comics* held that “the comic books do contain significant creative elements that transform them into something more than mere celebrity likenesses. Accordingly, the comic books are entitled to First Amendment protection.”<sup>193</sup> Thus, comic book creators may be protected by the First Amendment from right of publicity claims, based on the Transformative Use test, when their works sufficiently alter celebrity likeness. Of course, drawing a character to the exact appearance of a POI would result in the POI prevailing in a right of publicity lawsuit. However, comic books are inherently transformative based on their varying use of words and artwork, and therefore it is likely that a comic book creator will prevail as long as the words and artwork are even *somewhat* transformative.

<sup>190</sup> *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003).

<sup>191</sup> *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001).

<sup>192</sup> *Id.* at 810.

<sup>193</sup> *Winter v. DC Comics*, 69 P.3d 473, 476 (Cal. 2003).

### B. When Are Persons of Interest Protected?

A POI is protected when the contents of the artist's work are outside the protection of the First Amendment.<sup>194</sup> The Transformative Use test states that "a literal depiction of a celebrity, even if accomplished with great skill, may still be subject to a right of publicity challenge . . . [when] the literal and imitative or the creative elements predominate in the work."<sup>195</sup> This means that, as long as the elements of a POI depiction are not sufficiently transformed in the comic book, the POI is afforded right of publicity protection. Additionally, courts look to whether there was commercial value in the work that was sold. Comic books have commercial value because they are sold on the internet and at comic book stores. Therefore, a POI may argue that the comic book creator's work was not transformative and that the comic book creator benefitted monetarily from the POI's likeness.

### X. THE BEST TEST

Based on comic book and other media cases, the Transformative Use test is the best test when considering right of publicity and First Amendment issues. However, the test must be more stringent and less vague; therefore, a new test should be considered. On its face, the Transformative Use test only compares the defendants' expression of their work to literal depictions of the POI in question. The Ninth Circuit used a reasonableness test for right of publicity claims that allows a defendant to use the Transformative Use test as a defense if "no trier of fact could reasonably conclude that the [defendant's work] was not transformative."<sup>196</sup> A reasonableness test should be combined with the Transformative Use test because it adds an extra layer of right of publicity protection for the plaintiff. A POI should have more protection when the First Amendment is implicated because the added protection ensures that the POI's likeness will only be used in a manner that is not for commercial gain without the POI's permission. Additionally, although an entire Fair Use analysis is not necessary when considering right of publicity claims,<sup>197</sup> courts may benefit from including the "amount and substantiality of the portion used" factor. Commentators

<sup>194</sup> *Comedy III Prods.*, 21 P.3d at 809.

<sup>195</sup> *Id.*

<sup>196</sup> *Hilton v. Hallmark Cards*, 599 F.3d 894, 910 (9th Cir. 2010).

<sup>197</sup> *See supra* section IV.

have pointed out that, rather than considering the amount and substantiality of a POI's *work* used in a defendant's work in general, as in a copyright analysis, courts should consider the amount and substantiality of a POI's *persona* used in defendant's work.<sup>198</sup> Along with a "persona taken" analysis, courts should also consider a *de minimis* analysis in their consideration of whether a POI's right of publicity was violated. The *de minimis* test is another creature of copyright law; it means that "an infraction of the law may be so insubstantial that, although technically a right may have been violated, the violation or the effect of that violation is trivial enough for the court to ignore the infraction altogether."<sup>199</sup> The *de minimis* test should be taken into account because a defendant's use of a POI's likeness may be so miniscule that no reasonable trier of fact would find that there was any substantial portion of a persona taken, and therefore no right of publicity infringement. In sum, courts should use the "Best Test," a combination of the Transformative Use, reasonableness, Fair Use, and *de minimis* tests to conclude whether a POI's right of publicity was violated. Courts should consider whether a reasonable trier of fact would find that the defendant's work portraying a POI's persona for commercial value was substantially transformed as a whole, rather than as minimal elements.

## XI. CONCLUSION

Likeness of persons of interest in comic books should be afforded First Amendment protection. This should depend on whether a work was sufficiently transformed. Cases outside the scope of comic books have shown that First Amendment claims against the use of likeness in media may prevail when no substantial commercial value is shown. However, most comic books are sold for commercial gain, making that element tough to bypass for a comic book creator. Courts should consider amending the Transformative Use test to make it more all-encompassing by including reasonableness, Fair Use, and *de minimis* tests; by doing so, courts would have a more exacting definition of what it means to violate a person of interest's right of publicity.

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<sup>198</sup> See Matthew D. Bunker & Emily Erickson, *Transformative Variations: The Uses and Abuses of the Transformative Use Doctrine in Right of Publicity Law*, 14 WASH. J.L. TECH. & ARTS 138, 155 (2019).

<sup>199</sup> Julie D. Cromer, *Harry Potter and the Three-Second Crime: Are We Vanishing the De Minimis Defense from Copyright Law?*, 36 N.M. L. REV. 261, 262 (2006).