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A New First Amendment Goal Line Defense – Stopping the Right of Publicity Offense

BY MARK CONRAD*

I. INTRODUCTION

An iconic sporting event concludes and exultant fans celebrate their college team's championship victory. Sports writers pen their odes of joy, sacrifice and drama surrounding the team, which captures the imagination of millions—and entices authors, filmmakers, and visual artists to portray the event with the hope of a substantial financial gain. A few months later, a noted author signs a contract with a major publisher to write a week-by-week account of the season leading to the championship. The book's cover even has a photograph of a group of readily identifiable players who are holding up the championship trophy, including the most valuable player of the team. Throughout the book, player names, descriptions of their styles of play, and their emotions, are described in great detail. The non-fiction book becomes a best seller and the author and publisher make healthy amounts of money. The successful author then negotiates film rights with one of Hollywood's leading film producers. Actors play the athletes, but their portrayals are so realistic that many moviegoers think the real players perform in the film. The film grosses tens of millions of dollars.

Commercial artists sense an opportunity to produce compelling pieces of visual art. After photographs of the team captain hoisting the championship trophy are disseminated in newspapers, websites and social media from all over the world, a famous painter creates a canvas representing the thrilling moment of victory, with depictions of readily recognizable players in it. The painter then negotiates licensing rights to reproduce it in lithographs, posters, coffee mugs, and other merchandise—for millions of dollars.

A game manufacturer wishes to create a video game featuring the college team and its quest for the championship. The victorious team and its rival in the championship finals are represented. The creator secured the use of trademark rights to the teams' names and logos through an appropriate licensing agreement with the respective collegiate conference and the

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National Collegiate Athletic Association (NCAA). In this game, no player names are used, but the depictions of the players (or their avatars) bear a strong resemblance to the actual players. The avatars' striking similarities with the actual players—including height, build, hair color, hair style, skin tone, and particular distinctive features such as visors and bandanas—are noticeable, despite the lack of literal identification of the actual players. Consequently, many fans could deduce that the avatar doubles as the actual player based on the number, position, and general features.

Looking at these hypothetical scenarios, there is little question that the depictions of the players—with their actual names—in the book would be protected speech under the First Amendment. The same result applies to the film and most likely, with the painting. However, the video game's avatars would likely be treated differently, as many argue that the use of the “player” in the avatar images of the game, even without the use of the player names, would be restricted because of the recent and unwarranted trend of more and more courts expanding the commercial rights of individuals under what is known as the “Right of Publicity,” at the expense of creative license and free speech.¹

What began as a novel subset of traditional privacy rights has led courts and legislatures to create a property-based right of publicity jurisprudence that goes beyond its original goals and encroaches on the traditional First Amendment domain of protection of artistic and creative rights.² In the last two decades, courts have applied the right of publicity doctrine in various artistic contexts—from comic books, baseball cards, and t-shirts to fantasy games and action-based videogames—resulting in confusion and inconsistency.³ The various tests devised by the courts to balance the competing interests of free speech and commercial rights to one's identity and image produced a potpourri of rulings, made all the more confusing by a lack of federal law.⁴ The result has been an active, but unwieldy jurisprudence. Call it personal image protection on steroids.

Debate about the precise balance between free speech rights and the right of publicity is not new and has been discussed by eminent legal scholars reflecting different points of view.⁵ However, no adequate

1. Andy Sellars, *The Right of Publicity and Free Speech: DMLP Joins Amicus Brief in Hart v. Electronic Arts*, DIGITAL MEDIA LAW PROJECT (March 31, 2012), <http://www.dmlp.org/blog/2012/right-publicity-and-free-speech-dmlp-joins-amicus-brief-hart-v-electronic-arts>.

2. See Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 904, 929 (2004).

3. Adam Liptak, *When It May Not Pay to Be Famous*, N.Y. TIMES, June 1 2013, available at http://www.nytimes.com/2013/06/02/sunday-review/between-the-first-amendment-and-right-of-publicity.html?_r=0.

4. *Id.*

5. See Volokh, *supra* note 2, at 904.

resolution appears imminent, as the issue now takes on a new urgency in this videogame era, where avatars masquerade as real or supposedly real people. Claims by groups of former athletes seeking damages for alleged use of their likenesses in videogames and names in fantasy sports games are the new frontier in this conflict.⁶ Although the facts in two recent cases merit sympathy for former college players' claims against the Goliaths, better known as the NCAA and gaming companies, the courts are making a big mistake in extending publicity rights to these plaintiffs.⁷ As this article seeks to show, this is a case of sympathetic parties making bad law.

Traditional literary license (or, in a more recent twist, maybe we can call it "avatar license"), increasingly faces threats of an unwarranted expansion of the right of publicity. The fault lines are drawn in two cases that slowly marched through the courts: *Hart v. Electronic Arts*⁸ and *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* (previously known as *Keller v. Electronic Arts* and referred in this article as *Keller/NCAA*).⁹ A third case, *O'Bannon v. NCAA*,¹⁰ while a potentially highly significant case in other respects, does not directly discuss the right of publicity issues. Therefore, it will merit minimal discussion because its central claims are antitrust-based.¹¹ *Hart* and *Keller/NCAA*, on the other hand, involve claims by former NCAA student-athletes who sought compensation from a major videogame company and the NCAA for allegedly misappropriating their

6. See *infra*, notes 427-28 and accompanying text.

7. See *infra*, notes 427-28 and accompanying text.

8. 717 F.3d 141 (3d Cir. 2013).

9. No. C 09-1967, 2010 U.S. Dist. LEXIS 10719 (N.D. Cal. Feb. 8, 2010), *aff'd sub nom.*, *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268 (9th Cir. 2013).

10. No. 09-CV-3329 (N.D. Cal. filed July 21, 2009) Nos. C 09-1967 CW, C 09-3329 CW, C 09-4882 CW, 2010 WL 445190, at *1 (N.D. Cal. Feb. 8, 2010). The case was ultimately consolidated with *Keller v. Electronic Arts*. Twenty-one of the twenty-five plaintiffs claimed that the agreements between the NCAA and "student-athletes" denying them compensation for the use of their names and images constituted a violation of section 1 of the Sherman Anti-Trust Law, 15 U.S.C. § 1; the other four plaintiffs alleged common law and statutory violations of their right of publicity. The complaint was amended in 2012 to include specific damages from television broadcasting rights and revenues from videogames for current NCAA student-athletes. *In re NCAA*, 724 F.3d 1268 (9th Cir. 2013). The court granted partial class action certification on the claim that NCAA rules prevent college athletes from entering into group licensing deals. However, the court denied class action status to claims for monetary damages for the use of the images of the players, citing the lack of commonality of the players' claims. See *id.* As of this writing, there has been no scheduled trial date for the consolidated case.

11. See *O'Bannon v. Nat'l Collegiate Athletic Ass'n*, 09-CV-3329, 2010 WL 445190. The trial judge concluded that the NCAA's rules prohibiting student-athletes from receiving any compensation for the use of their names, images, and likenesses restrain price competition among top-tier (FBS) football and Division I basketball schools as suppliers of the unique combination of educational and athletic opportunities that elite football and basketball recruits seek. It also permitted schools to utilize licensing revenue generated from the use of their student-athletes' names, images, and likenesses to fund stipends covering the cost of attendance for those student-athletes and permitted schools to hold limited and equal shares of that licensing revenue in trust for the student-athletes until they leave school. Right of publicity was only addressed tangentially. See *infra* notes 246-47 and accompanying text for more discussion.

images for commercial gain.¹² Although both EA Sports and the NCAA settled the publicity rights claims, the underlying definitional and constitutional questions remain.¹³ Before the settlements were announced, these cases were still in the motion stage and produced four decisions, including the two Federal appeals court rulings: one by the Third Circuit in *Hart*¹⁴ (overruling a district court opinion), and a few months later, one by the Ninth in *Keller/NCAA* (affirming its district court ruling).¹⁵

In *Hart*, the U.S. Court of Appeals for the Third Circuit concluded, in a 2-1 ruling, that the right of publicity claim against the videogame manufacturer may proceed; thus, overruling the lower court, which concluded that the First Amendment barred the claim.¹⁶ The U.S. Court of Appeals for the Ninth Circuit in *Keller/NCAA*, concluded in a similar 2-1 determination, that a right of publicity claim may go to trial; thus, rejecting a First Amendment defense, and in this case, affirming the conclusion of the trial court.

Yet, *Hart*, *Keller/NCAA*, and a series of other cases result in various tests and assumptions that demonstrate the inherent problem with the present standards—what are the definitional parameters of a right of publicity action and exactly when does this right end and First Amendment protection begin.¹⁷ The demarcation point is not easily found, but when dealing with a fundamental constitutional right, there must be a consistent way to mark the line between property protection and speech protection. This article will propose a new standard that, hopefully, will further that goal.

Essentially, a constitutional privilege would be granted for depictions of real people or their images, sounds, or other aspects of their persona, unless such speech is used for a “sole commercial purpose,” that is, speech exclusively for a commercial purpose. Only if a court determines that the speech in the depiction is solely commercial, is it subject to a lesser degree

12. See *Hart v. Electronic Arts, Inc.*, 717 F.3d at 147; see *Keller v. Electronic Arts, Inc.*, 2010 U.S. Dist. LEXIS 10719, at *7.

13. EA settled for \$40 million. See Cliff Edwards and Karen Gullo, *Electronic Arts Settles Athletes' Images Lawsuit for \$40 Million*, BLOOMBERG.COM (Sept. 27, 2013) available at <http://www.bloomberg.com/news/2013-09-27/electronic-arts-settles-athletes-images-lawsuit-for-40-million.html>. The NCAA settled for \$20 million. See *NCAA Reaches Settlement in EA Video Game Lawsuit*, NCAA PRESS RELEASE (June 9, 2014), available at <http://www.ncaa.org/about/resources/media-center/press-releases/ncaa-reaches-settlement-ea-video-game-lawsuit>.

14. See *Hart*, 717 F.3d 141.

15. See *Keller*, 2010 U.S. Dist. LEXIS 10719, at *11. Although subsumed in the antitrust case—a rather strange set of circumstances for a property-based claim of right of publicity—we are examining the right of publicity decisions in *Hart* and *Keller*, as the respective appellate court rulings remain good law.

16. *Hart*, 717 F.3d at 170.

17. See *Dillinger LLC v. Electronic Arts Inc.*, 795 F. Supp.2d 829, 835 (D. Ind. 2011).

of First Amendment protection than political or artistic speech;¹⁸ thus, the person whose name, likeness, sound, or other indicia of identity the depiction represents would prevail. If, however, the material does not fall into this category, then it receives First Amendment immunity and is not subject to a right of publicity claim, except for a limited situation when the defendant exercised “bad faith” by engaging in fraud or malice to evade a sole commercial purpose categorization.¹⁹

To arrive at this proposed solution, we must transverse the rocky landscape of right of publicity doctrine, which this article will do. This article will address: (1) the origins, common law, and statutory bases of the right of publicity and the various balancing tests used to determine protection;²⁰ (2) the background, disposition, and criticism of the *Hart* and *Keller/NCAA* cases;²¹ (3) recent cases that may provide hints concerning the precise balance between right of publicity and the First Amendment;²² and (4) the dawn of a new qualified privilege, replacing the myriad of balancing tests with a general qualified privilege in favor of First Amendment protection.²³

II. THE RIGHT OF PUBLICITY

A. Introduction

So much literature exists regarding the history and application of the right of publicity²⁴ that we can dispense from a long recitation. The doctrine of right of publicity derived from the tort of commercial misappropriation, which, as the name suggests, was steeped in commerce.²⁵ The right to protect and exploit one’s name, likeness, voice, or persona, is now considered a form of intellectual property protection, which, unlike copyright and trademark law, is not federalized, but rather exists as a

18. See *Central Hudson Gas & Elec. v. Public Serv. Comm’n*, 447 U.S. 557, 562 (1980) (The court noted that the Constitution accords a lesser protection to commercial speech than to other constitutionally protected expression.).

19. *Id.* at 598 (Rehnquist, J., dissenting).

20. See *infra* Part II.

21. See *infra* Part III.

22. See *infra* Part IV.

23. See *infra* Part V.

24. See, e.g., 1-1 Nimmer on Copyright § 1.01 (2002) (discussing the intersection of federal copyright law and the right of publicity).

25. One commentator has called it a doctrine with its genus in “unfair competition, intellectual property and tort law. See 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY & PRIVACY* § 1:7 (2d ed. 2008). Scholars and some courts have been drawn to the trademark law similarities of this right. See *id.* at 1:8; see also, W. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 406 (1960) (“The interest protected is not so much a mental as a proprietary one, in the exclusive use of the plaintiff’s name and likeness as an aspect of his identity.”). See *Lugosi v. Universal Pictures*, 25 Cal.3d 813, 818 (1979) (the court discussed “secondary meaning” in determining whether the right continued after the death of the person).

patchwork of different standards and levels of protection, depending on the particular state. As of this writing, about 20 states enacted statutes creating a right of publicity,²⁶ while another 30 utilize a court-made common law protection.²⁷

Although derived from the tort-based right of privacy, which traces its genesis back well over a century,²⁸ the right of publicity came from one of four branches of privacy enunciated by Dean Prosser.²⁹ Yet, it differs from a privacy tort concept in one crucial way: the privacy torts seek damages for the unreasonable intrusion of someone's privacy by advertising his or her name or identity, while the publicity right stems from the commercial value of that identity.³⁰ Some states demonstrated sensitivity to the issue of commercial misappropriation of one's name early on. New York passed its version of a protection against such misappropriation in 1903,³¹ while a few others followed with statutory enactments or common-law rulings.³²

26. See, e.g., CAL. CIVIL CODE § 3344-3344.1 (West 2009); FLA. STAT. ANN. § 540.08 (West 2009); 765 ILL. COMP. STAT. ANN. 1075 §§ 1-10 (West 2009); IND. CODE ANN. § 32-36-1-7 (West 2009); KY. REV. STAT. ANN. § 391.170 (West 2009); MASS. GEN. LAWS. ANN. ch. 214, § 3A (West 2009); NEB. REV. STAT. § 20-202 (West 2009); NEV. REV. STAT. §§ 597.770-597-810 (West 2009); N.Y. CIVIL RIGHTS LAW §§ 50-51 (West 2009); OHIO REV. CODE ANN. § 2741.06 (West 2009); OKLA. STAT. tit. 12 §§ 1448, 1449 (West 2009); 42 PA. CONS. STAT. § 8316 (West 2009); R.I. GEN. LAWS. §§ 9-1-28, 9-1-28.1(a)(2) (West 2009); TENN. CODE ANN. §§ 47-25-1102 to -1107 (West 2009); TEX. PROP. CODE ANN. § 26.010 (West 2009); UTAH CODE ANN. § 45-3-3 (West 2009); VA. CODE ANN. § 8.01-40 (West 2009); WASH. REV. CODE § 63.60.010 (West 2009); WIS. STAT. § 995.50 (West 2009).

27. New Jersey, for example, lacks a statute and relies on common law as a basis for its right of publicity rules. See *Faber v. Condecor, Inc.*, 477 A.2d 1289 (1984) (family photo used to sell picture frames constituted misappropriation); Georgia does, as well. See *Martin Luther King, Jr. Center for Social Change v. American Heritage Products*, 250 Ga. 135, 296 S.E.2d 697 (1982) (right of publicity applicable to sale of busts of Dr. King).

28. See Louis Brandeis & Samuel Warren, *The Right to Privacy*, 4 HARV. L. REV. 193, 211 (1890) ("The right of property in its widest sense, including all possession, including all rights and privileges, and hence embracing the right to an inviolate personality, affords alone that broad basis upon which the protection which the individual demands can be rested.")

29. See *Prosser, supra* note 25, at 403. The branches are trespass, intrusion, false light and what was then known as commercial misappropriation, but later called right of publicity. Portions of the tort have been constitutionalized to balance the rights with First Amendment speech rights. One example is "false light" privacy, which differs from defamation in that it involves a truthful depiction of an event, but casts a person in a false light.

30. See Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954) (Nimmer notes that courts have recognized that the right of publicity exists independently of the right of privacy.).

31. See N.Y. CIVIL RIGHTS LAW §§ 50-51 (McKinney 2010). This statute was the first to recognize a right of privacy for one's name and identity. It was enacted to reverse the effect of a prior New York Court of Appeals ruling that denied that such a right existed under New York Law. See *Roberson v. Rochester Folding-Box Co.*, 64 N.E. 442 (N.Y. 1902). An early and significant court ruling creating such a right under common law was *Pavesich v. New England Life Insurance Co.*, 50 S.E. 68 (Ga. 1905). For more information, see J. Gordon Hylton, *Baseball Cards and the Birth of the Right of Publicity: The Curious Case of Haelan Laboratories v. Topps Chewing Gum*, 12 MARQ. SPORTS L. REV. 272 (2001).

32. New Jersey's standard has been based on the Restatement definition, although there is no statutory provision. However, courts have applied the definition. See *Palmer v. Schonhorn Enterprises, Inc.*, 232 A.2d 458 (N.J. Super. 1967) (court upheld privacy-based common law claim, as names of internationally known professional golfers used in biographical information); see *Faber v. Condecor*, 195

What became known as the right of publicity was born just over six decades ago in a federal appeals ruling in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,³³ where the Second Circuit court concluded that the more limited tortious right should be expanded into a property-oriented one, with a strong intellectual property veneer.³⁴ Dean Prosser and Professor Nimmer also advocated that right and urged its acceptance, yet such acceptance came very slowly.³⁵ Ironically, in 1990, the same circuit

N.J. Super. 81 (1984) (use of family photo in advertisement gave right to a cause of action). Florida's law is statutory and protects one's name, portrait and likeness from trade, commercial or advertising purposes. See FLA. STAT. ANN. § 540.08 (West 2009). See also, *Loft v. Fuller*, 408 So. 2d 619 (Fla. Dist. Ct. App. 1981) (book about air crash does not give victim's relatives a cause of action under the privacy claims); Illinois' statute protects an individual's identity, in a somewhat more expansive way. Identity includes "any attribute of an individual that serves to identify that individual to an ordinary, reasonable viewer or listener, including but not limited to (i) name, (ii) signature, (iii) photograph, (iv) image, (v) likeness, or (vi) voice." However, its scope is also commercially based, as the Act protects against unauthorized commercial use of one's identity, which includes, (i) offering the sale of products, services, etc.; (ii) advertising or promoting products, services, etc.; or (iii) fundraising. See Illinois Right of Publicity Act, 765 ILCS 1075.

California has utilized both statutory and common law bases for right of publicity. California's statute, § 3344(a) of the Civil Code, protects against uses of a person's likeness for advertising purposes. Specifically, the statute is intent-based, as it prohibits "knowing" use of a person's name/likeness/etc., on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of products, merchandise, goods or services, without such person's prior consent. See CAL. CIV. CODE § 3344(a) (West 2009). Subsection (e) provides that it is a question of fact to determine whether the use provides a "direct connection" between the use of that person's name or likeness with the commercial sponsorship or with the paid advertising. The state's courts impose a three-step test to determine whether: (1) there was a "knowing" use of the plaintiff's protected identity; (2) the use was for advertising purposes; and (3) there was a direct connection between the use and the commercial purpose. See, e.g., *Newcombe v. Adolf Coors Co.*, 157 F.3d 686, 692 (9th Cir. 1998). For more information, see Digital Media Law Project, BERKMAN CENTER FOR INTERNET AND SOCIETY, <http://www.dmlp.org/legal-guide/california-right-publicity-law> (accessed July 1, 2013).

33. 202 F.2d 866 (2d Cir. 1953), *cert denied*, 346 U.S. 816 (1953). The dispute involved a tortious interference with contract claim by two baseball card manufacturers, whereby Haelan claimed that Topps improperly utilized images of baseball players for its cards that were under exclusive contract with Haelan. The lower court dismissed the privacy claims, because New York's Civil Rights law limited those claims to the players affected, not to third parties. See 112 F.Supp. 904 (1953). However, the Second Circuit, in a brief opinion by Judge Jerome Frank, reversed, concluding that even if there was no property right by Haelan over the players' images, Topps was still liable for inducing contract breaches by at least some of the players when they contracted with Topps. More significantly, however, he concluded:

We think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made 'in gross,' i.e., without an accompanying transfer of a business or of anything else. Whether it be labeled a 'property' right is immaterial; for here, as often elsewhere, the tag 'property' simply symbolizes the fact that courts enforce a claim which has pecuniary worth.

Haelan Lab., 202 F.2d at 868; see also *Hylton*, n.11, *supra* note 31, at 287.

34. See *Haelan Lab.*, 202 F.2d at 868.

35. See Prosser, *supra* note 25; see also Nimmer, *supra* note 30. By 1970, only five states—Pennsylvania, Georgia, New Jersey, Hawaii and Missouri—adopted the *Haelan* right of publicity

court held that the independent and fairly broad right of publicity advocated by Judge Frank in *Haelan Labs*, was inapplicable to the New York state's limited statutory requirements.³⁶

Yet, in the last two decades, *Haelan Labs* spawned a vibrant right of publicity expansion, which most states subsequently adopted through common law or via a statutory provision.³⁷ About 20 states, including California and Tennessee, have expanded the doctrine to recognize the right of publicity to deceased persons.³⁸

Not surprisingly, this expansion of the publicity right led to active litigation—especially involving athletes or former athletes.³⁹ For example, courts have had to grapple with cases involving parody baseball cards,⁴⁰ artwork depicting athletes and their specific achievements,⁴¹ comic book images using altered names,⁴² and the use of names in fantasy sports games,⁴³ resulting in a doctrine without clear parameters. This is, at least in part, due to the varied definitions of what constitutes a right of publicity and, more particularly, in the failure of the courts to craft an adequate balancing approach between the right and free speech.⁴⁴

standard by court ruling, and two states—Oklahoma and Florida—statutorily enacted it. *See also*, *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481 (3d Cir. 1956), *cert. denied*, 351 U.S. 926 (1956) (applying Pennsylvania law); *Hogan v. A.S. Barnes & Co.*, 114 U.S.P.Q. 314, 320 (Pa. Ct. Com. Pl. 1957); *Cabaniss v. Hipsley*, 151 S.E.2d 496 (Ga. Ct. App. 1966); *Palmer*, 232 A.2d 458 (1967); *Fergerstrom v. Hawaiian Ocean View Estates, Inc.*, 441 P.2d 141 (Haw. 1968); *Cepeda v. Swift and Co.*, 415 F.2d 1205 (8th Cir. 1969) (applying Missouri law).

36. *See Pirone v. MacMillan*, 894 F.2d 579 (2d Cir. 1990) (holding that the use of photographs which did not indicate origin or represent sponsorship did not amount to unfair competition and that New York Civil Rights law right of privacy protection was clearly limited to living persons).

37. *See* David W. Melville & Harvey S. Perlman, *Protection for Works of Authorship Through the Law of Unfair Competition: Right of Publicity and Common Law Copyright Reconsidered*, 42. ST. LOUIS L.J. 363, 390-92 (1998).

38. *See* CAL. CIVIL CODE § 3344.1(g) (privacy right lasts for 70 years after the death of the individual); *see also*, TENN. CODE ANN. § 47-25-1104 (privacy right lasts for 10 years after death).

39. *See* Melissa A. Reinckens & Matthew Ganas, *The Right of Publicity in College Sports*, 20 No. 16 WESTLAW JOURNAL INTELLECTUAL PROPERTY 2 (2013).

40. *See, e.g.*, *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 969 (10th Cir. 1996) (appeals court concluded that professional baseball player did not have a publicity cause of action for parody baseball cards, noting that First Amendment rights prevail since the speech was not “commercial” but rather part of a news exception under the Oklahoma right of publicity law).

41. *See* *ETW v. Jireh Publishing*, 332 F.3d 915 (2003) (concluding that lithograph depicting golfer's victory at the Masters' Tournament was a “transformative” work and not subject to claims by Tiger Woods).

42. *See* *Doe v. TCI Cablevision*, 110 S.W. 3d 363 (Mo. 2003), *cert. denied sub nom.*, *Twist v. McFarlane*, 124 S.Ct. 1058 (2004) discussed *infra* (court upheld publicity rights by hockey player against comic book distributor who created a fictional character based on the player's name and reputation).

43. *See* *C.B.C. v. MLBAM*, 505 F.3d 818 (8th Cir. 2007) (use of professional baseball players' names and statistics protected under the First Amendment), discussed *infra* at notes 169-73.

44. Melville & Perlman, *supra* note 37, at 390-98.

B. *The Boundaries, the Definition*

Although *Haelan* did not define the contours of the right, subsequent rulings, statutes, and scholars have tried.⁴⁵ Judicially, there is little guidance from the top.⁴⁶ The Supreme Court has only considered the scope of right of publicity once, and concluded that a television station's use of a complete 10-second human cannonball act was not constitutionally protected.⁴⁷ However, the case, *Zacchini v. Scripps-Howard Broadcasting*, does not fit the typical facts found in both prior and subsequent right of publicity cases. *Zacchini* involved a news report on a local television station, rather than a commercial exploitation of one's name and likeness.⁴⁸ It focused on the scope of the use and the economic loss to *Zacchini*, the performer.⁴⁹ The court viewed the potential "infringement" of *Zacchini's* ability to profit from his act as similar to a copyright case, rather than a commercially-based violation of his name and likeness.⁵⁰

More importantly, this factually unique case did not create a workable standard to judge the limits of the right of publicity.⁵¹ As one commentator noted, the court "dodged the question" as to when a media report is constitutionally protected and when it misappropriates one's creation.⁵² The majority opinion's generalized approach stunted the evolution of this area of law because it allowed lower courts to fashion their own balancing tests and, consequently, their own standards.⁵³ Coming at a time when the court fashioned a more aggressive First Amendment protection in the areas of defamation and commercial speech, this definitional gap is all the more puzzling.⁵⁴ Also, the failure to "federalize" the rules—something it could have done by setting a federal baseline similar to defamation, was even more problematic, and directly led to the helter-skelter system we have now. Also worth noting is that the dissenting opinions in *Zacchini* did not provide

45. *See id.* at 392-93.

46. *See Zacchini v. Scripps-Howard Broadcasting*, 433 U.S. 562 (1977).

47. *See id.*

48. *Id.*

49. *Id.* at 575-76.

50. *Id.* at 573 ("the State's interest is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation.")

51. Christina Smedley, *Commercial Speech and the Transformative Use Test: The Necessary Limits of A First Amendment Defense in Right of Publicity Cases*, 24 DEPAUL J. ART, TECH. & INTELL. PROP. L. 451, 462 (2014).

52. *See* Russell S. Jones, Jr., *The Flip Side Of Privacy: The Right Of Publicity, The First Amendment, And Constitutional Line Drawing - A Presumptive Approach*, 39 CREIGHTON L. REV. 939, 946.

53. *See* Smedley, *supra* note 51.

54. *See* *New York Times v. Sullivan*, 376 U.S. 254, 268 (1964); *see also*, *Central Hudson Gas*, 447 U.S. 557 (creating the four-part intermediate scrutiny balancing test for commercial speech).

any such guidelines, either.⁵⁵ Although the opinion looked to copyright law for its rationale, the failure to define its scope, along with the fact that the right of publicity is state-based, means that unlike its intellectual law cousins copyright, patent, and trademark, there is no universal or standard definition for right of publicity.⁵⁶

The scholarly approach centers on the standards found in the Restatement—or rather, the virtually identical provisions found in the Restatement of Torts (3d) and the Restatement of Unfair Competition (3d). They state: “[o]ne who appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade is subject to liability.”⁵⁷ “Purposes of trade” is defined as the use of the identity in advertising of goods or services, or “placed on merchandise marketed by the user, or are used in connection with services rendered by the user.”⁵⁸ To avoid constitutional overbreadth, the section limits the scope of both Restatements’ “purposes of trade” basis as communication, which “does not ordinarily include the use of a person’s identity in news reporting, commentary, entertainment, works of fiction or non-fiction, or in advertising that is incidental to such uses.”⁵⁹ This is the most limited and most commercially-based right of publicity definition in existence today.⁶⁰

The comments in the Restatement of Unfair Competition point to an inherently limited doctrine—something overlooked by many courts, including the *Hart* and *NCAA/Keller* cases featured in this article. Comment c of section 47, takes pains to note that “[t]he right of publicity as

55. See *Zacchini*, 433 U.S. at 579. There were three dissenting justices on the merits of the case—Justices Powell, Brennan and Marshall, who concluded that the First Amendment protects the station from a “right of publicity” or “appropriation” suit, absent a strong showing by the plaintiff that the news broadcast was a subterfuge or cover for private or commercial exploitation. *Id.* More significantly, these three dissenters would have created a First Amendment privilege for such “newsworthy” broadcasters, unless it can be shown that the appropriation was “subterfuge or cover for private or commercial exploitation.” *Id.* at 581. This approach echoes the conclusion of the Ohio Supreme Court, which ruled in favor of the television station. See *Zacchini v. Scripps-Howard Broadcasting*, 47 Ohio St. 2d 224, 351 N.E. 2d 454, 455 (1976).

56. Copyrights, patents, and trademarks have statutory definitions. A copyright is an ownership right in “original works of authorship fixed in any tangible medium of expression, now known or later developed. See 17 USC § 102(a). The copyright grants monopoly status to the owner, who has the right to use, license, or assign. A trademark is “any word, name, symbol, or design, or any combination thereof, used in commerce to identify and distinguish the goods of one manufacturer or seller from those of another and to indicate the source of the goods.” See 15 U.S.C. § 1127. A patent gives ownership status to one who “invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101.

57. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

58. *Id.* at § 47.

59. *Id.*

60. See generally Oliver R. Goodenough, *Go Fish: Evaluating the Restatement’s Formulation of the Law of Publicity*, 47 S.C. L. REV. 709 (1996) (explaining the Restatement’s definition of the right of publicity is limited in application and is too commercially-focused).

recognized by statute and common law is fundamentally constrained by the public and constitutional interest in freedom of expression.”⁶¹ In the same comment, the authors state that “[t]he use of a person’s identity primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation of the person’s right of publicity.”⁶²

Some, but not all, states have adopted this Restatement standard.⁶³ Florida’s statute applies this standard to photographs, or other likeness,⁶⁴ while Tennessee’s infers use of one/s name for “commercial purposes.”⁶⁵ Pennsylvania’s statute applies the right of publicity to persons whose name or likeness has *commercial value* and *is used for any commercial or advertising purpose*,⁶⁶ while Indiana’s law includes the use of a name or image as part of a fundraising campaign.⁶⁷

California’s right of publicity statute, also focuses on the *knowing* use of one’s name, voice, signature, photograph, or likeness, *in any manner, on or in products, merchandise, or goods*, as well as for purposes of advertising, selling, or soliciting purchases of, products, merchandise, goods or

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

62. *See id.* One court noted that this limitation on the right is not confined to news reporting but extends to use in “entertainment and other creative works, including both fiction and non-fiction.” The commentators list examples of protected uses of a celebrity’s identity, likeness or image, including unauthorized print or broadcast biographies and novels, plays or motion pictures. *See ETW*, 332 F. 3d 915, 930. The court in this case added that “According to the Restatement, such uses are not protected, however, if the name or likeness is used *solely* attract attention to a work that is not related to the identified person, and the privilege may be lost if the work contains substantial falsifications.” *Id.* (emphasis added).

63. Washington, D.C. has adopted the more traditional tort bases of misappropriation under RESTATEMENT (SECOND) OF TORTS § 652 (1977). *See Vassiliades v. Garfinckel’s et al*, 492 A.2d 580 (1985); Missouri adopted a modified version of the Restatement of Unfair Competition standard in *Doe*, 110 S.W. 2d at 370. For more examples, *see supra* note 26.

64. *See* FLA. STAT. § 540.08 (West 2009), which 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 given by: (a) Such person; or (b) Any other person, firm or corporation authorized in writing by such person to license the commercial use of her or his name or likeness; or (c) If such person is deceased, any person, firm or corporation authorized in writing to license the commercial use of her or his name or likeness, or if no person, firm or corporation is so authorized, then by any one from among a class composed of her or his surviving spouse and surviving children.

Id. Like the Restatements, it creates a defense if the publication is “part of any bona fide news report or presentation having a current and legitimate public interest and where such name or likeness is not used for advertising purposes.” *Id.* at § 3.

65. *See* TENN. CODE ANN. § 47-25-1104. Although the statute focuses more on the duration of the rights to ten years after the death of the individual, it applies to “Commercial exploitation of the property right by any executor, assignee, heir, or devisee if the individual is deceased” and the termination of that “right to commercial exploitation being terminated by “non-use” for two years subsequent to the death of the individual. *Id.* at §§ (b) 1 and (b) 2.

66. *See* 42 PA.C.S.A 8316(a) (emphasis added).

67. *See* IND. CODE ANN. § 32-36-1-1 (West 2009).

services,⁶⁸ and outlines the scope of the actual damages awarded for violations. Yet, it also recognizes a common law right of publicity that is broader.⁶⁹ Under this right, courts extended right of publicity protection to an image that may be evocative, but where the public can draw the reference to the created image and the actual person.⁷⁰ California, as noted earlier, has adopted a right of descendibility, while most other states have not.⁷¹

While differences exist between the various statutory and Restatement definitions of the right of publicity, a larger concern is whether the expansive application and interpretation of this right infringes on First Amendment speech guarantees.⁷² As we will see, the various tests employed by courts over the last two decades suffer from a fundamental flaw, as they treat the personal right and the constitutional right on, at best, an equal balancing plane.⁷³ Even content-neutral speech is afforded a heavier presumption of protection from governmental regulation, based on the so-called “intermediate scrutiny” test,⁷⁴ than the vague balancing test used in right of publicity cases. A comparison with the tort of defamation provides an apt illustration. States may apply certain aspects of defamation

68. See CAL. CIVIL CODE § 3344 (West 2009) (emphasis added). The complete provision states:

a) Any person who knowingly uses another’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person’s prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof. In addition, in any action brought under this section, the person who violated the section shall be liable to the injured party or parties in an amount equal to the greater of seven hundred fifty dollars (\$750) or the actual damages suffered by him or her as a result of the unauthorized use, and any profits from the unauthorized use that are attributable to the use and are not taken into account in computing the actual damages. In establishing such profits, the injured party or parties are required to present proof only of the gross revenue attributable to such use, and the person who violated this section is required to prove his or her deductible expenses. Punitive damages may also be awarded to the injured party or parties. The prevailing party in any action under this section shall also be entitled to attorney’s fees and costs.

Id.

69. See *supra* text accompanying note 68.

70. See *White v. Samsung Electronics*, 971 F.2d 1395 (9th Cir. 1992). (The court upheld publicity claims by a game show hostess who claimed that a robot with a blond wig used in defendant’s commercial was a “likeness” of White in a commercial context).

71. See *supra* note 38. New York does not recognize any common law right of publicity, and its statutory publicity rights, New York Civil Rights Law §§ 50, 51, applies only to living persons, whether famous or unknown. New York does not recognize a postmortem right of publicity or descendibility.

72. See Roberta Rosenthal Kwall, *The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 69 (1994).

73. *Id.* at 62-63.

74. See *United States v. O’Brien*, 391 U.S. 367 (1968) (for non-content restrictions on speech, the government has to show a sufficiently important or substantial interest that is unrelated to suppression of free expression).

involving non-public figures differently, but the bedrock standard from *New York Times* and its progeny⁷⁵ create a solid constitutional baseline to prevent that claim from overriding free speech.⁷⁶

Notably, there is no formal requirement of intent, or even negligence, in any definition of the right of publicity.⁷⁷ At least one major commentator stated that there is no requirement to show intent, despite language in *Haelan* that may be interpreted that way.⁷⁸

A short examination—and critique—of each of the principal judicially-created tests follows.

C. The tests

1. The Restatement and the “Relatedness Test”

As noted earlier, the Restatement provisions protect the use of another person’s name, likeness, or other indicia of identity for purposes of trade.⁷⁹ A few jurisdictions have inferred that such use must relate to commercial use, though as we will see, more courts have increased the scope of protections for those seeking publicity rights.⁸⁰

The Restatement standard keeps the right of publicity on a fairly tight commercial lid. It focuses the right of publicity where it should be,

75. See *New York Times*, 376 U.S. at 301-02 (limiting the scope of state libel and slander laws by constitutionalizing defamation and creating a qualified First Amendment privilege for certain defamatory communications involving public officials); *Curtis Publishing Co. v. Butts* and its companion, *Associated Press v. Walker*, 388 U.S. 130, 162 (1967) (extending the *New York Times* standard to “public figures” defined as nonpublic persons who ‘are nevertheless intimately involved in the resolution of important public questions or, by reason of their fame, shape events in areas of concern to society at large.’ See also, *Gertz v. Robert Welch*, 418 U.S. 323 (1974) (although state law can still govern defamation involving non-public figures, the court expanded the constitutional standard to mandate that for those individuals, a minimum standard of negligence must be determined, thereby ending a strict liability standard that existed in common law defamation).

76. See *New York Times*, 376 U.S. at 301-02.

77. See 1 J. THOMAS MCCARTHY, *supra* note 25, § 3:43 (Author’s comment opining no element of intent or knowledge is required in cases of infringement of the right to publicity).

78. See *id.* at 3:28. In *Haelan*, Judge Frank noted that “Plaintiff, in its capacity as sole grantee of a player’s ‘right of publicity’, has a valid claim against defendant if defendant used that player’s photograph during the term of plaintiff’s grant and with knowledge of it.” 202 F.2d 866, 869, as cited in McCarthy. McCarthy concludes that the “it” in the phrase deals with the exclusive license of plaintiff and finds it to be mere dictum. Subsequent cases have proven him right, as intent is not mentioned. However, McCarthy notes that the lack of intent or the user’s honest ignorance of the use of a plaintiff’s image or likeness can be a mitigation of damages. MCCARTHY, at 3:35. I find the lack of intent, malice, or negligence as a part of the standard troubling, especially when constitutional claims are involved and will address this point later in the article. See *infra* Part IV.

79. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46.

80. See *Zacchini*, 433 U.S. 562 (1977). See also, *White*, 971 F.2d 1395 (The court held that a robot depicting game show celebrity Vanna White’s “likeness” was actionable within meaning of California Civil Code provision authorizing award of damages against person who knowingly uses another’s likeness for purposes of advertising without consent.); *Doe*, 110 S.W. 3d 363 (The court held that appellant hockey player “Tony Twist” presented sufficient evidence to establish that respondents used his name for a commercial advantage in a comic book.).

primarily applying it to situations involving “purposes of trade” which I take to be commercial or advertising use.⁸¹ To bolster this point, a section of the commentary notes that right of publicity “may” extend beyond pure advertising or commercial purposes (in a nod to the Supreme Court’s opinion in *Zacchini*), but it categorically notes that this is an exception to the rule.⁸² That comment notes that uses that are newsworthy or used in “creative works (fiction or non-fiction) such as an unauthorized biography or a motion picture depiction” are excluded from the scope of the misappropriation,⁸³ but a proviso in that comment notes that “if the name or likeness is used *solely* to attract attention to a work that is *not related* to the identified person, the user may be subject to liability for a use of the other’s identity in advertising.”⁸⁴ Hence, that is why some have coined the Restatement standard as the “relatedness test.”⁸⁵

The Restatement takes pains to distinguish the right of publicity from the more well-settled standard of fair use in copyright law or issues involving trademark or false advertising.⁸⁶ This is wise, not only because

81. RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46 and 47. The name, likeness, and other indicia of a person’s identity are used “for purposes of trade” under the rule stated in § 46 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.

82. *Id.* at § 47. Comment d. notes “Broader restrictions on the use of another’s identity in entertainment, news, or other creative works threaten significant public and constitutional interests.”

83. Such uses include

the use of a person’s name or likeness in news reporting, whether in newspapers, magazines, or broadcast news . . . use in entertainment and other creative works, including both fiction and nonfiction . . . use as part of an article published in a fan magazine or in a feature story broadcast on an entertainment program . . . dissemination of an unauthorized print or broadcast biography, [and use] of another’s identity in a novel, play, or motion picture”

RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47, cmt. c. at 549.

84. *Id.*

85. See Roberta Rosenthal Kwall, *A Perspective On Human Dignity, The First Amendment, And The Right Of Publicity*, 50 B.C. L. Rev. 1345, 1360-61 (2009).

86. See 17 U.S.C. § 107, which states:

the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include: (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 effect of the use upon the potential market for or value of the copyrighted work. This concept has drawn considerable consternation by the courts.

See *Consumers Union v. General Signal Corp.*, 730 F.2d 47 (2d Cir. 1984) (Oakes, J., dissenting) (“fair use is one of, if not the most, difficult areas of copyright law”); regarding trademarks and false advertising, see Restatement § 46, cmt. d, which notes: “if trademark issues exist in a given case,

publicity rights are conceptually different, but also because fair use and false advertising have different First Amendment attributes. For example, false advertising does not receive First Amendment protection,⁸⁷ while trademark and copyright law are implicitly subject to a balancing test.⁸⁸

In my view, there is much to like with the Restatement approach, because it most directly focuses on commercial use. However, it is not ideal because neither the provisions nor the commentary point to a definitive standard factoring in First Amendment rights to address free expression concerns.⁸⁹ While the comments exempt certain uses and express sympathy to parody and other creative expression,⁹⁰ they fail to craft the kind of precise standard—be it a qualified immunity or a specific level of scrutiny—to aid courts in addressing these issues.⁹¹

Another problem involves the appropriate level of commercial and expressive values in the given work. As one commentator aptly stated what I consider to be a key defect:

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

then these issues should be decided under relevant trademark law, rather than the use of the right of publicity.”

87. See *Central Hudson Gas*, 447 U.S. 557.

88. See *Stewart v. Abend*, 495 U.S., 207, 230 (“Th[e] evolution of the duration of copyright protection tellingly illustrates the difficulties Congress faces . . . [I]t is not our role to alter the delicate balance Congress has labored to achieve.”); see also, *Harper & Row v. Nation Enterprises*, 471 U.S. 539, 556 (1985) (this “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.”)

89. See generally RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46.

90. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, cmt. d, which states:

In cases of imitation, the public interest in competition and in avoiding the monopolization of successful styles, together with the interest in the production of new works including parody and satire, will ordinarily outweigh any adverse effect on the plaintiff’s market. When the defendant’s appropriation consists, not of an imitation, but of an unauthorized broadcast or other reproduction of an actual performance by the plaintiff, the greater likelihood of commercial injury to the plaintiff and the reduced public interest in permitting the use may justify relief in *exceptional circumstances*.”

Id. (emphasis added).

91. See Kwall, *supra* note 72.

expressive comment on or about a celebrity, the expressive values could be given greater weight.⁹²

However, one court opined that under the relatedness test, use of a person's name and identity is actionable only when the use is solely commercial and is otherwise unrelated to that person.⁹³

The problem of relatedness is evident in cases where newsworthy depictions are subsequently used for advertising purposes.⁹⁴ As noted earlier, the Restatement provisions generally refrain from applying publicity rights to such a situation, but do not completely exclude the possibility.⁹⁵ An example of this dilemma involves the case of former New York Jets quarterback Joe Namath, who graced the cover of Sports Illustrated when he led his team to victory in Super Bowl III.⁹⁶ A replica of that Super Bowl photo appeared in an ad campaign to sell copies of the magazine.⁹⁷ If the relatedness test had been used (which it was not), then a court could note that there were "expressive" elements, but that the commercial right to sell the magazine could result in a right of publicity claim.⁹⁸ Although the Restatement provision does exempt "the use of a person's name or likeness in news reporting,"⁹⁹ it does not precisely address this kind of situation, which was an attempt to utilize a newsworthy photo to sell magazine subscriptions to Jets fans or, more generally, fans of Namath. Given the

92. See Mark S. Lee, *Agents Of Chaos: Judicial Confusion In Defining The Right Of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 500 (2003).

93. See *Doe*, 110 S.W. 3d 363.

94. See Jon M. Garon, *Playing in the Virtual Arena: Avatars, Publicity, and Identity Reconceptualized Through Virtual Worlds and Computer Games*, 11 CHAP. L. REV. 465, 489-97 (2008).

95. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47, which notes that,

[t]he name, likeness, and other indicia of a person's identity are used "for purposes of trade" under the rule stated in § 46 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.

96. See Randall T.E. Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781, 818 (1988).

97. See Alison P. Howard, *A Fistful of Lawsuits: The Press, the First Amendment, and Section 43(A) of the Lanham Act*, 88 CALIF. L. REV. 127, 168 (2000).

98. See *Namath v. Sports Illustrated*, 48 A.D.2d 487, 371 N.Y.S.2d 10 (1st Dept. 1975) (the court dismissed the case under New York's limited tort-based right of privacy law, noting that "[c]ertainly, defendants' subsequent republication of plaintiff's picture was 'in motivation, sheer advertising and solicitation.' [However, t]his alone is not determinative of the question so long as the law accords an exempt status to incidental advertising of the news medium itself." *Id.* at 12. See also, *Montana v. San Jose Mercury News*, 40 Cal. Rptr. 2d 639 (1995), which held that the poster-sized reproduction of actual newspaper pages, with artistic renditions of the NFL quarterback's likeness and the sale of such posters were protected by the First Amendment, in part, relying on *Namath*. The case was also decided before California adopted the transformative test.

99. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46.

expansion of publicity rights in recent years, it is theoretically possible that the Restatement test may not exempt this “incidental advertising” (as the court called it)¹⁰⁰ or, as I would put it, semi-commercial use.

2. *The Rogers Test (“Relatedness” slightly altered, based on Trademark Law)*

This standard, with trademark law roots, was first utilized in the Second Circuit’s ruling in *Rogers v. Grimaldi*.¹⁰¹ In *Rogers*, the court rejected the claim that the title “Ginger and Fred” violated the famed dancer Ginger Rogers’s publicity rights and constituted false advertising under the Lanham Act.¹⁰² In doing so, it noted that the title was not misleading and referred to the characters in the film, not to Rogers.¹⁰³ The court granted summary judgment in regard to the right of publicity claims, concluding that the use of a celebrity’s name in a movie title did not violate publicity rights unless the title was “wholly unrelated” to the movie or was “simply a disguised commercial advertisement for the sale of goods or services.”¹⁰⁴ In overruling a prior test,¹⁰⁵ the Second Circuit held that the Lanham Act “should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”¹⁰⁶ This test, based on the issue of confusion of the purpose of the use, was adopted in several other jurisdictions.¹⁰⁷

The *Rogers* test presumes First Amendment protection more than other standards, and by extension, it protects literary license.¹⁰⁸ It infers a strong commercial requirement of the speech, since under trademark law “use in

100. See *Namath*, 48 A.D.2d at 488.

101. 875 F.2d 994 (2d Cir. 1989). The well-known dancer Ginger Rogers sued the producers and distributors of a motion picture called “Ginger and Fred” alleging that the use of her name in the film’s title violated her publicity rights and rights under the Lanham Act. Rogers became known as part of a dance team with her co-partner Fred Astaire, making many films together. The film in question depicted an pair of Italian cabaret dancers who “only obliquely relates” to the dancing of Rogers and Astaire. *Id.* at 994.

102. See generally *id.*

103. *Id.* at 1005.

104. See *id.* at 1005.

105. That test was known as the “no alternative avenues” standard utilized in the use of the Dallas Cowboys cheerleaders in a pornographic film. See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (enjoining defendants from releasing pornographic film containing infringing trademarks because other avenues of expressing the message were available).

106. *Id.* at 999. For an analytical, detailed treatment of the case, see David M. Kelly & Lynn M. Jordan, *Twenty Years Of Rogers V. Grimaldi: Balancing The Lanham Act With The First Amendment Rights Of Creators Of Artistic Works*, 99 TRADEMARK REP. 1360.

107. See *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003) (concluding that the use of the Civil Rights icon’s name in a song by the rap group Outkast was justifiably creative and referring to competitor groups being inferior to them and going “to the back of the bus.” *Id.* at 460. See also, *Mattel v. MCA Records*, 296 F.3d 984 (9th Cir. 2002). Curiously, the 9th Circuit adopted the test for Lanham Act cases, even though the California State courts adopted the transformative test.

108. See *id.* at 999.

commerce” is a key component.¹⁰⁹ However, the problem with the *Rogers* test is that it is a trademark infringement test based on confusion and false endorsement under the Lanham Act,¹¹⁰ which is awkwardly extended to right of publicity. Lumping publicity claims as a mirror image of Lanham Act is akin to inserting a round peg in the square hole.

Central to the Lanham Act and false endorsement claims is the question of falsity, yet there is no such requirement in the right of publicity.¹¹¹ Doctrinally, this demonstrates the problem in cherry-picking aspects of separate doctrines, which have similarities, but significant differences as well. Right of publicity is a property right, but is not the same as a trademark: the former is a protection of the misappropriation of one’s identity, while the latter involves the use of a false endorsement to “attract attention” to the product advertised by use of the person’s image.¹¹²

3. “Predominant Purpose” Test

This test, created by the Supreme Court of Missouri in 2003,¹¹³ requires that a plaintiff’s name and likeness be used with the intent to obtain a commercial advantage,¹¹⁴ and is intended to balance the respective interests of the individual based on the “purpose” of the use.¹¹⁵ *Doe v. TCI Cablevision* involved the creation and depiction of a mob type “enforcer” character in a comic book that had a similar name, but not similar illustrative attributes, to a professional hockey player well-known in the St. Louis market as an on-ice “enforcer.”¹¹⁶ The player sued on both defamation and right of publicity grounds, and the lower courts dismissed on First Amendment grounds.¹¹⁷ The Missouri Court of Appeals affirmed the trial court’s dismissal and concluded that the comic-book character (named “Tony Twistelli”) was not “a depiction” of the hockey player

109. Based on its interpretation of the Lanham Act provision, the court concluded that the appellees were entitled to summary judgment, thereby rejecting the argument that the title gave the false impression that the film is about Rogers and Astaire. 875 F. 2d at 1001-02.

110. See Lanham (Trademark) Act, 15 U.S.C. § 1125(a), which imposes civil liability to “[a]ny person who shall affix, apply, or annex, or use in connection with any goods or services . . . a false designation of origin, or any false description or representation . . . and shall cause such goods or services to enter into commerce.”

111. See 1 J. THOMAS MCCARTHY, *supra* note 25, § 3:43.

112. See J. Thomas McCarthy and Paul M. Anderson, *Protection of the Athlete’s Identity: The Right of Publicity, Endorsements and Domain Names*, 11 MARQ. SPORTS L. REV. 195, 201 (2001).

113. See *Doe*, 110 S.W. 3d 363, *cert. denied sub nom., Twist v. McFarlane*, 124 S.Ct. 1058.

114. See *Doe*, 110 S.W. 3d at 369.

115. *Id.* at 370-72.

116. The character, named “Tony Twistelli” is a particularly vile individual, who orders child abductions and murders. The hockey player who brought the action was named Tony Twist and was regarded as one of the toughest “enforcers” in the National Hockey League while he played for the St. Louis Blues during the period when the comic book with that character was distributed. *Id.* at 366-67.

117. *Id.* at 365.

(named Tony Twist).¹¹⁸ Because McFarlane (the creator) never used Twist's identity to propose a commercial transaction, the court reasoned that the First Amendment barred Twist's claims.¹¹⁹ This is what the Missouri Supreme Court should have concluded. Taken from the Restatement definition, it puts the publicity claim right where it should be legally.

However, the Missouri Supreme Court reversed on the ground that the "predominant purpose" of the work was commercial rather than expressive in nature, meaning that the character was used as a vehicle to sell comic books specifically relying on the alteration of the hockey player's name.¹²⁰ While the court gave lip service to First Amendment protections, it noted that the First Amendment did not "always trump" commercial rights.¹²¹

Although categorized as a separate test, the predominant purpose test is a broader variant of the Restatement's "Relatedness" test.¹²² This standard is commercially-based, but its application by the court was unconstitutionally applied. It runs counter to a California ruling on a similar line of facts,¹²³ and, more fundamentally, makes the questionable conclusion that the right to one's name (or, in this case, alteration of one's name) presumptively wins in a "balancing test" over a fundamental constitutional right.

I would argue that *Doe v. TCI Cablevision* is not a publicity case at all; rather, it's a defamation case "of and concerning" Twist and therefore the right of publicity claim was inapplicable to the heart of the dispute. The opinion in *Doe* makes a judicial end-run to place it as a right of publicity case that presumptively denies First Amendment protection to a work that may be partly, but not predominately, expressive. The court tips its hand by saying that the publicity claim should be "more durable" and less subject to First Amendment considerations than a defamation claim.¹²⁴ If the use of Twist's "name" in the comic was conceived as a method to sell comic books by defaming Twist, it could be deemed "malice" under the New York Times standard, which would overcome the First Amendment immunity of

118. *Id.*

119. For a good summary of the case, see Recent Cases: *First Amendment - Right of Publicity - Missouri Supreme Court Creates "Predominant Purpose" Test for First Amendment Defenses to Publicity Right Claims*, 117 HARV. L. REV. 1275, 1277 (2004).

120. See *Doe*, 110 S.W. 3d at 374.

121. See *id.* at 372; see also Recent Cases, *supra* note 119, at 1278.

122. In fact, the *Doe* court recognized the Restatement test and effectively tweaked it to make it more directly purpose-oriented. See *Doe*, 110 S.W.3d at 368.

123. See *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 106 Cal.Rptr.2d 126, 25 Cal.4th 387, 21 P.3d 797 (2001) (where court concluded that literal depiction of T-shirts of the Three Stooges violated California's statutory right of publicity).

124. See *Doe*, 110 S.W.3d at 372-73.

defamation in the case of public figures. Very few courts have adopted the predominant purpose test and it has been the subject of much criticism.¹²⁵

4. The “Transformative” Test

If any of the balancing tests can be considered the darling of the courts, it is this one. A number of commentators have extolled the virtues of this test,¹²⁶ first adopted by the California Supreme Court¹²⁷ in the 2001 case of *Comedy III v. Gary Sandrup*,¹²⁸ and refined two years later in *Winter v. DC Comics*.¹²⁹ The transformative test frames the issue as a determination of whether the use is a literal depiction, versus a creative or literary license approach. In so doing, the court must determine 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.¹³⁰ Although of recent vintage, the roots of the test go back to the 1980s, where a federal appeals court in *White v. Samsung Electronics*, concluded that the use of a “lookalike” to the celebrity was held to be in

125. See *Hart*, 717 F.3d at 154 (“By our reading, the Predominant Use Test is subjective at best, arbitrary at worst, and in either case calls upon judges to act as both impartial jurists and discerning art critics. These two roles cannot co-exist.”); see also, *Kirby v. Sega of America, Inc.* 144 Cal. App. 4th 47, 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006) (where the court rejected the predominant use test in favor of the transformative test); and *C.B.C. v. MLBAM* 443 F.Supp.2d 1077 (E.D. Mo. 2006) (The court reasoned that the predominant use test was not applicable in the case at bar, thus rejecting it). For further discussion see Lee, *supra* note 92, at 500 (2003); Jason K. Levine, *Can the Right of Publicity Afford Free Speech?: A New Right of Publicity Test for First Amendment Cases*, 27 HASTINGS COMM. & ENT. L. J. 171, 220-21 (2004).

126. Some have criticized aspects of the test and proposed slight modifications on the burden of proof. See Marc Edelman, *Closing the “Free Speech” Loophole: The Case For Protecting College Athletes’ Publicity Rights in Commercial Videogames*, 65 U. FLA. L. REV. 553 (2013) (author argues that plaintiff has the initial burden of showing a prima facie case of breach of his publicity rights, once this burden is met, the burden could still shift to the defendant to argue in favor of First Amendment preemption. However, under a revised test, the burden to shift back to the plaintiff to argue that the transformative element represents a partial, rather than full, transformation of the plaintiff’s identity).

127. The test derived from a 1990 article penned by a federal judge discussing fair use in copyright. See Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990).

128. See 25 Cal. 4th 387, 106 Cal. Rptr. 2d 126, 21 P. 3d 797 (Cal, 2001) (The court concluded that the depictions of the Three Stooges were undeserving of First Amendment protection because the likenesses were insufficiently transformed).

129. 30 Cal. 4th 881, 69 P. 3d 473 (Cal. 2003). The case involved two musicians, Johnny and Edgar Winter, who both possessed long white hair and albino features, who brought suit against a comic book company over images of two villainous half-man, half-worm creatures, both with long white hair and albino features, named Johnny and Edgar Autumn. The court concluded it was a transformative use since the work did not contain literal depictions, but “merely part of the raw materials from which the comic books were synthesized.” Therefore, the characters were sufficiently transformed so as to entitle the comic book to First Amendment protection. *Id.* at 479

130. See *Comedy III*, 106 Cal. Rptr. 2d at 140 (“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.”).

violation of her publicity rights under California law.¹³¹ Like the other right of publicity tests, the transformative test focuses on a balance between commercial use and first amendment protection.¹³² However, it is more intricate and potentially broader in its application. In *Comedy III*, for example, the court adopted a multiple-based rationale, whereby courts look into such factors as the primacy of the celebrity likeness in the nature of the work, the motivation of the creator in crafting the depiction, the economic value of the celebrity likeness, and the level of creativity used in the work.¹³³

In adopting the transformative test, the California federal and state courts (as well as the Third Circuit in *Hart*), were sensitive—even more than in the *Rogers* test—to the balancing of expressive and non-expressive elements.¹³⁴ However, it suffers from the same problem as the other standards—it does not provide a practical way to demarcate the boundaries

131. See *White*, 971 F.2d 1395. The court held that an ad depicting a robot “dressed in a wig, gown, and jewelry” violated Vanna White’s right of publicity. In a questionable application of the property rights of the White, the majority court applied the right of publicity to attributes or symbols that may trigger the celebrity’s identity, as long as they are used for commercial gain. So, simply using a blond wig and a “wheel” that looks like the spinning wheel in the “Wheel of Fortune” game constituted a misappropriation of White’s property rights. The court dismissed any parody defense under the First Amendment as “subservient” to the commercial claims, without making a formally balancing. *Id.* at 1401. In one sense, this is Missouri’s “Predominant Use” test run amok. It is noteworthy that the opinion produced critical dissents from two Judges and a fair amount of scholarly criticism. See, e.g., Arlen W. Langvardt, *The Troubling Implications of a Right of Publicity “Wheel” Spun Out of Control*, 45 KAN. L. REV. 329, 330 (1997) (claiming that the Ninth Circuit decision in *White* “handed celebrities a new property right with greatly expanded boundaries”); David S. Welkowitz, *Catching Smoke, Nailing JELLO to a Wall: The Vanna White Case and the Limits of Celebrity Rights*, 3 J. INTELL. PROP. L. 67, 76–85 (1995); Linda J. Stack, Note, *White v. Samsung Electronics America, Inc.’s Expansion of Publicity: Enriching Celebrities at the Expense of Free Speech*, 89 NW. U. L. REV. 1189, 1202–26 (1995) (arguing that the *White* court “expanded the right of publicity in a manner inconsistent with precedent, the Constitution, and societal concerns”), found in Gloria Franke, *The Right of Publicity vs. The First Amendment: Will One Test Ever Capture the Starring Role*, 79 S. CAL. L. REV. 945, 977, n. 238 (2006).

132. See David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment*, 2 HARV. J. SPORTS & ENT. L. 1, 25 (2011).

133. See J. Thomas McCarthy, *The Rights of Publicity and Privacy* § 8:72 (2d ed. 2012) as cited in *In re NCAA*, 724 F.3d 1268. The full list of factors is as follows: first, if “the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized,” it is more likely to be transformative than if “the depiction or imitation of the celebrity is the very sum and substance of the work in question.” [internal citations omitted] Second, the work is protected if it is “primarily the defendant’s own expression”—as long as that expression is “something other than the likeness of the celebrity.” [internal citations omitted] This factor requires an examination of whether a likely purchaser’s primary motivation is to buy a reproduction of the celebrity, or to buy the expressive work of that artist. [internal citations omitted] Third, to avoid making judgments concerning “the quality of the artistic contribution,” a court should conduct an inquiry “more quantitative than qualitative” and ask “whether the literal and imitative or the creative elements predominate in the work.” [internal citations omitted]. Fourth, . . . “a subsidiary inquiry” would be useful in close cases: whether “the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted.” [internal citations omitted] Lastly, the court indicated that “when an artist’s skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame,” the work is not transformative.

134. See William K. Ford & Raizel Liebler, *Games are not Coffee Mugs: Games and the Right of Publicity*, 29 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1, 79 (2013).

between First Amendment and publicity rights. Additionally, the transformative test compounds the problem by forcing courts to judge artistic expression in a very direct way.¹³⁵ A case in point is *ETW v. Jireh Publishing*,¹³⁶ which applied the transformative test to a depiction by a commercial artist of Tiger Woods' winning his first Masters golf tournament.¹³⁷ The painting, copies of which were sold for about \$700 each, depicted two mirror images of a very realistic-looking Woods viewing the hole, with his caddy nearby.¹³⁸ The only "imaginative" portion was the ghost-like faces of past Masters' winners in back of the scoreboard and the club house.¹³⁹ In rejecting Woods' claim, the majority of the appeals court considered the work more than a literal depiction; it was "expressive," according to the court, because it was transformative.¹⁴⁰ Additionally, the opinion noted that the artist did not have the economic advantages that Woods has, as Woods made a lucrative living from both professional golf and his many commercial endorsements.¹⁴¹

135. This point was well-stated in an amicus brief in *Hart*: "With no original work to measure against the defendant's work, the only metric of 'transformation' comes from what the court thinks is artistic, or not, about the defendant's speech. . . . These kinds of judgments of worthiness are precisely what courts should avoid." See Brief for Organization for Transformative Works, International Documentary Ass'n, Digital Media Law Project and Law Professors as Amici Curiae Supporting Defendant-Appellee, *Hart v. Electronic Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013), 2012 WL 1985731, at 15-16.

136. 332 F.3d 915, 935-36 (6th Cir. 2003). The court also dismissed claims of trademark infringement due to the use of Woods' name in the marketing materials for the artwork, the panel concluded that even though the name "Tiger Woods" had a registered trademark, the use of the name was considered a "fair use." It also dismissed false endorsement claims under § 43(a) of the Lanham Act, concluding that trademark law's "likelihood of confusion" standard did not give sufficient weight to First Amendment considerations in a case where the reference was one of artistic expression, rather than commercial use. In so doing, the court cited *Rogers* and various Ninth Circuit cases to bolster their opinion. *Id.* at 927.

137. See generally *id.*

138. *Id.* at 918-19.

139. *Id.* at 918.

In the foreground of Rush's painting are three views of Woods in different poses. In the center, he is completing the swing of a golf club, and on each side he is crouching, lining up and/or observing the progress of a putt. To the left of Woods is his caddy, Mike "Fluff" Cowan, and to his right is his final round partner's caddy. Behind these figures is the Augusta National Clubhouse. In a blue background behind the clubhouse are likenesses of famous golfers of the past looking down on Woods. These include Arnold Palmer, Sam Snead, Ben Hogan, Walter Hagen, Bobby Jones, and Jack Nicklaus. Behind them is the Masters leader board.

Id.

140. *Id.* at 938 ("applying the transformative effects test adopted by the Supreme Court of California 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.").

141. *ETW*, 322 F.3d at 938.

The illustration is clearly Woods. The virtual portrait of Woods depicts a real event, albeit with certain fictionalization. So how “transformative” is it? Some may say yes, but others say no. It is a highly subjective question and one that can be especially problematic in application to videogame depictions of athletes. Like the painting in question in this case, these games contain both elements—realistic depictions, but also the ability to create different competitive scenarios for these athletes. In sum, the transformative test takes too many factors into account, is too subjective, and provides a court with the opportunity to apply it both inconsistently and far too broadly to be constitutionally justifiable.

The above series of tests—along with prior case law that does not espouse a specific test—have resulted in a potpourri of cases that involve athletes attempting to claim publicity rights to various unauthorized depictions disseminated to the public.¹⁴² For example, some rulings reject such claims for the use of reproduction of magazine pages on billboards.¹⁴³ Others conclude that the simple retelling of statistical information about a player in an advertisement gives rise to a cognizable claim,¹⁴⁴ while others arrive at a contrary conclusion.¹⁴⁵ A few cases looked to a commercial speech-oriented theory in determining a right of publicity claim. In one such case, the Tenth Circuit held that baseball cards depicting caricatures of players were “fully” protected speech because they were not commercial in

Even in the absence of his right of publicity, he would still be able to reap substantial financial rewards from authorized appearances and endorsements. It is not at all clear that the appearance of Woods’s likeness in artwork prints which display one of his major achievements will reduce the commercial value of his likeness.

Id.

142. See Timothy J. Bucher, *Game On: Sports-Related and the Contentious Interplay Between the Right of Publicity and the First Amendment*, 14 TEX. REV. ENT. & SPORTS L. 1, 20 (2012).

143. See *Namath*, 48 A.D.2d 487.

144. See *Abdul-Jabbar v. General Motors, Inc.*, 75 F. 3d 1391 (9th Cir. 1996) (court upheld claim of description of Lew Alcindor (Jabbar’s name at the time) collegiate basketball achievements in an ad for General Motors. The ad played as follows: A disembodied voice asks, “How ‘bout some trivia?” This question is followed by the appearance of a screen bearing the printed words, “You’re Talking to the Champ.” The voice then asks, “Who holds the record for being voted the most outstanding player of this tournament?” In the screen appear the printed words, “Lew Alcindor, UCLA, ‘67, ‘68, ‘69.” Next, the voice asks, “Has any car made the ‘Consumer Digest’s Best Buy’ list more than once? [and responds:] The Oldsmobile Eighty-Eight has.” A seven-second film clip of the automobile, with its price, follows. During the clip, the voice says, “In fact, it’s made that list three years in a row. And now you can get this Eighty-Eight special edition for just \$18,995.”) 75 F. 2d at 1393.

145. See *C.B.C.*, 505 F.3d 818 (8th Cir. 2007) (use of name and player statistics in an online fantasy sports game protected under the First Amendment). Compare with *Palmer*, 232 A.2d 458, which involved the use of illustrations of Arnold Palmer and other golfers in a board game affected their potential licensing income. Also, compare with *ETW v. Jireh*, where the court basically said that Woods made enough income that damages in this case would be minimal.

nature¹⁴⁶ (ironic, since this very case that created the right of publicity involved baseball playing cards).¹⁴⁷

The creation of these various tests, adopted by different jurisdictions, has resulted in a torturous case-by-case jumble. Most significantly, none of these tests give the First Amendment its due.

III. THE *HART* AND *KELLER* LITIGATION

A. *Hart*

Ryan Hart played quarterback on the Rutgers University football team from 2002-05.¹⁴⁸ As a NCAA “student-athlete,” he was required to forego any commercial opportunities that result from his athletic pursuits, as required by the organization’s “amateurism” rules.¹⁴⁹ In particular, he was barred from accepting any compensation for “the use of his . . . name or picture to advertise, recommend or promote directly the sale or use of a commercial product or service of any kind.”¹⁵⁰ While a student at Rutgers, Hart achieved considerable athletic success.¹⁵¹

Although the NCAA prohibited Hart from entering any agreements exploiting his name and image, the organization had no second thoughts about making agreements with Electronic Arts (“EA”) to create and distribute an electronic game called “NCAA Football,” first marketed in

146. See *Cartoons*, 95 F.3d 959 (where court upheld First Amendment rights of parody baseball cards). Compare with *Comedy III*, 106 Cal. Rptr. 2d 126, which upheld publicity claims due to the “literal” depiction of The Three Stooges on T-shirts).

147. See *Haelan Labs*, 202 F.2d 866.

148. SPORTS-REFERENCE/COLLEGE FOOTBALL, <http://www.sports-reference.com/cfb/players/ryan-hart-1.html> (last visited June 29, 2014).

149. See 2011-12 NCAA DIVISION I MANUAL § 12.01.1 (2011) (“Only an amateur student-athlete is eligible for inter-collegiate athletics participation in a particular sport.”), cited in *Hart*, 717 F.3d 141. More specifically, the rules state that a collegiate athlete loses his or her amateur status if the athlete “[u]ses his or her athletics skill (directly or indirectly) for pay in any form in that sport.” *Id.* § 12.1.2.

150. *Id.* at § 12.5.2.1. It is important to understand the precise nature of the agreement that student-athletes are currently held to when they first transfer their rights of publicity. The Letter of Intent and Statement of Financial Aid, which contains the conditions and amount of the scholarship (if any), provide the basis for the contractual relationship between the university and the student-athlete. The school promises to pay for the educational fees and expenses incurred by the student-athlete assuming the student-athlete receives an athletic scholarship, and the student-athlete promises to participate in the school’s athletic program and adhere to the NCAA’s rules. See *id.* at 12.5.2.1 (a student-athlete may not “[a]ccept[] any remuneration for or permit[] the use of his . . . name or picture to advertise, recommend or promote directly the sale or use of a commercial product or service of any kind; or . . . [r]eceive[] remuneration for endorsing a commercial product or service through . . . [his] use of such product or service.”).

151. Hart was a quarterback, player number 13, with the Rutgers University NCAA Men’s Division I Football team for the 2002 through 2005 seasons. As of 2013, Hart held the Scarlet Knights’ records for career attempts, completions, and interceptions. During his senior year the Knights were invited to the Insight Bowl, their first Bowl game since 1978. See *Hart*, 717 F.3d at 144.

1993.¹⁵² The EA sports games have involved actual college teams over the years. However, the featured players on those teams were avatars, as their specific names are not used. However, the creators of the game crafted images to show certain identifiable characteristics of actual players by using their numbers and particular features.¹⁵³ Specifically, the game showed a player's actual jersey number and "virtually identical" height, weight, build, skin tone, hair color, and home state.¹⁵⁴ However, there were fictionalized aspects as well. EA omitted the players' names on their jerseys and assigned each player a hometown that is different from that of the actual players.¹⁵⁵

Hart argued that the uses of his characteristics constituted a violation of his publicity rights. EA filed a motion to dismiss on First Amendment grounds,¹⁵⁶ which was granted by the District Court. The opinion was long and treatise-like. After first noting that, for the sake of this motion, the court accepted the existence of a prima facie right of publicity in New Jersey,¹⁵⁷ the court then addressed the scope of the First Amendment claims. After a lengthy discussion, it ultimately concluded that the constitutional free speech right trumps any right of publicity under New Jersey law.¹⁵⁸ The opinion discussed the nature of the First Amendment application to videogames, citing the then-recently decided *Brown v. Entertainment Merchants Association*, which applied content-based First Amendment standards for a statute prohibiting sales or rentals of "violent videogames" to minors.¹⁵⁹ In so doing, the district court rejected the argument that, like *Brown*, strict scrutiny applied in this case, thereby applying the less onerous

152. The first edition of the game was released in 1993 as *Bill Walsh College Football*. Two years later, it changed the name to *College Football USA*. In 1997, it adopted the current name, *NCAA Football*. *Id.* at 146.

153. Hart alleged that the avatar player wore the same number (13), was the same height (6'2"), weight (197 pounds), had the same left wrist band and helmet visor, and identified the school and graduating year as the same as his. *Id.*

154. *See In re NCAA*, 724 F.3d 1268 (9th Cir. 2013). Additionally, EA creates realistic virtual versions of actual stadiums; populates them with the virtual athletes, coaches, cheerleaders, and fans realistically rendered by EA's graphic artists; and incorporates realistic sounds such as the crunch of the players' pads and the roar of the crowd. *Id.*

155. *Id.*

156. Appellee filed a motion to dismiss under Federal Rule of Civil Procedure 12(b)(6), but the district court construed it as a motion for summary judgment pursuant to Federal Rule of Civil Procedure 56(c). *See Hart*, 717 F.3d at 147.

157. Specifically, the court stated "because of EA's decision not to challenge the sufficiency of Hart's right of publicity allegations for the purpose of this motion, the Court will focus solely upon EA's assertion of the First Amendment defense – rather than upon how a New Jersey court might construe the prima facie elements of the right of publicity." *See Hart v. Electronic Arts, Inc.*, 808 F. Supp. 2d 757, 768 (D.N.J. 2011).

158. *Id.* at 768-772.

159. 131 S.Ct. 2729, 180 L. Ed. 2d 708 (2011). The statute also required warning labels on such games and imposed civil fines for violators.

intermediate scrutiny test for non-content restrictions on speech.¹⁶⁰ However, in a blow to the plaintiff, the court also rejected the argument that the games were “commercial” in nature, thus dismissing the argument that commercial speech doctrine (and its lesser standard of First Amendment protection) should apply.¹⁶¹

According to the district court, intermediate scrutiny implies a balancing test and with that in mind, the court proceeded to apply one of several right of publicity tests mentioned earlier to this case.¹⁶² Noting that New Jersey adopted a right of publicity as a property right, rather than the more traditional tort bases found in misappropriation,¹⁶³ the court had to craft a new standard or apply one of the existing balancing tests, which the circuit or New Jersey state courts had not done beforehand.¹⁶⁴ The court narrowed its focus to two of the tests: the “*Rogers* test”¹⁶⁵ and the “transformative test.”¹⁶⁶ Although it preferred the transformative test as a “more refined” standard than the *Rogers* test, the court concluded that under either test, Hart’s claim would fail.¹⁶⁷

Viewing the transformative test as a mirror image of the copyright fair use standard (an aspect of the *Rogers* test), the court applied intellectual property principles from copyright law and from the California Supreme Court’s adoption of the transformative test in *Comedy III*.¹⁶⁸ In so doing, the

160. See *Hart*, 808 F. Supp. 2d at 768-69.

161. In so concluding, the court looked to *Facenda v. NFL Films, Inc.*, 542 F.3d 1007 (3d Cir. 2008), which concluded that for speech to be commercial: (1) the speech constitutes an advertisement; (2) the speech refers to a specific product or service; and (3) the speaker has an economic motivation for the speech. *Id.* at 1017. The district court concluded that the speech found in the EA games does not fit this standard. See *Hart*, 808 F. Supp. 2d at 770. The court also cited one of its district court rulings, *Tellado v. Time-Life*, 643 F. Supp. 904, 914 (D.N.J. 1986), which concluded that the First Amendment did not insulate the defendant from a right of publicity claim by a Vietnam veteran whose photograph was used in an advertisement for a book series the defendant produced about the Vietnam War. The court distinguished between use of the plaintiff’s photograph in an advertisement for a book and the hypothetical use of the photograph in the book itself, noting that in the latter case, “defendant’s use clearly would have been protected by the First Amendment, regardless of what type of profit defendant expected to make with its book series.” *Id.*

162. *Hart*, 808 F. Supp. 2d at 769.

163. See *McFarland v. Miller*, 14 F.3d 912, 917 (3d Cir. 1994) (“In New Jersey, the right of publicity is a property right.”). See also, *Palmer*, 232 A.2d 458, which concluded that the use of a famous golfer’s name constituted misappropriation).

164. See *Hart*, 808 F. Supp. 2d at 775. See *Comedy III*, 106 Cal. Rptr. 2d 126; *ETW*, 332 F.3d 915, 935 (transformative test); *Doe*, 110 S.W. 3d 363 (predominant use factor test); *Rogers*, 875 F.2d 994 (relatedness test). The lower court in *Hart* also noted that the U.S. Supreme Court in *Zacchini*, but stated that subsequent lower courts have limited the scope of this ruling.

165. See *supra* note 101.

166. See *supra* note 126.

167. See *Hart*, 808 F. Supp. at 777. The way the court came to its conclusion was indirect. Instead of citing the cases credited for creating and utilizing the test, *Comedy III* and *ETW*, it relied on an earlier district court opinion in *Estate of Presley v. Russen*, 513 F.Supp. 1339, 1356 (D.N.J. 1981) which involves an action against an Elvis Presley impersonator. Stating that *Russen* predated *Comedy III* or *ETW*, despite its narrow holding, it serves as an antecedent for that test.

168. See *Comedy III*, 106 Cal. Rptr. 2d 126. The court noted: “Viewing the right of publicity as

court found, despite what seemed to be the EA game's goal of capitalizing upon the fame of those players, the elements of the game created a transformative depiction, including the use of virtual coaches, alteration of the player avatars, and the use of fans and sound effects.¹⁶⁹ In other words, the game's interactivity was a major factor in making it transformative.

The *Hart* court took issue with the district court ruling in *Keller v. Electronic Arts*, which reached the opposite result.¹⁷⁰ The opinion also discussed the *Rodgers* test (as the alternative to the transformative test) and reasons why that test is not ideal for determining this kind of right of publicity case.¹⁷¹ In so deciding, it noted that plaintiff's image was not "wholly unrelated" to the game, nor a "disguised commercial advertisement" deriving primarily from trademark and unfair competition law, rather than the property-based right of publicity.¹⁷²

Significantly, the court discussed whether the expression embodied in the EA game constitutes commercial speech, thereby receiving less First Amendment protection. In rejecting this argument, the court applied a definitional test employed by the Third Circuit in *Facenda v. NFL Films*,¹⁷³ ultimately concluding this was not an advertisement and did not refer to another specific product because the depiction of Hart was used directly as part of the game, and not in any independent advertisements or marketing promotions.¹⁷⁴

akin to an intellectual property right, designed to protect the "considerable money, time, and energy . . . needed to develop one's prominence in a particular field." *Id.* at 399 (quoting *Lugosi*, 25 Cal.3d 813, 160 Cal. Rptr. 323, 603 P.2d 425). The Court concluded that a test incorporating elements of the copyright fair use doctrine most appropriately balanced the competing First Amendment and right of publicity interests. *Id.* at 404. See *Hart*, 808 F. Supp. 2d at 778-79.

169. *Id.* at 783. The opinion added,

[e]ven focusing on Hart's virtual image alone, it is clear that the game is transformative. It is true that the virtual player bears resemblance to Hart and was designed with Hart's physical attributes, sports statistics, and biographical information in mind. However, as noted, the game permits users to alter Hart's virtual player, control the player's throw distance and accuracy, change the team of which the player is a part by downloading varying team names and rosters, or engage in "Dynasty" mode, in which the user incorporates players from historical teams into the gameplay.

Id. at 784.

170. *Id.* at 787. See *Keller*, 2010 U.S. Dist. LEXIS 10719. The *Hart* district court opinion criticized the holding in *Keller*, as misapplying the transformative test because it focused solely on the image, rather than the game itself.

171. *Hart*, 808 F. Supp. 2d at 787-793.

172. *Id.* at 791. ("courts may have chosen to apply the right of publicity test because right of publicity claims do not embody the same likelihood-of-confusion concerns that the *Rogers* Lanham Act test is designed to protect. [citations omitted] . . . For this reason, I question the wisdom of applying a trademark-based test to right of publicity claims without accounting for this difference.")

173. 542 F.3d 1007, 1016 (3d Cir. 2008).

174. In distinguishing *Hart* from *Facenda*, the court noted: "The speech at issue in *Facenda* was a video that the court characterized as a "late-night, half-hour-long 'infomercial' [for the *Madden Football*

Hart appealed to the Third Circuit and in a 2-1 opinion, that appeals court majority reversed the conclusions of the district court, resulting in a decision more in line with the *Keller* ruling.¹⁷⁵ The majority opinion, tighter and more pointed than the lower court's ruling, framed the issue quite directly: whether the right to freedom of expression overpowers the right of publicity.¹⁷⁶ After noting that New Jersey adopted a common law right of publicity, with privacy antecedents dating back to 1907,¹⁷⁷ the majority found this to be a case of first impression because "neither the New Jersey courts nor our own circuit have set out a definitive methodology for balancing the tension between the First Amendment and the right of publicity."¹⁷⁸

After discussing the various balancing tests that courts used following the Supreme Court's ruling in *Zacchini*, the majority (and dissenting judge as well) adopted the transformative test, the standard already used by the Ninth and Sixth Circuits.¹⁷⁹ In doing so, the majority found the other approaches to be less effective in determining the proper balance.¹⁸⁰ The "predominant use" test, advocated by appellant and discussed earlier in this article, was deemed "subjective at best, arbitrary at worst, and in either case calls upon judges to act as both impartial jurists and discerning art critics."¹⁸¹ Adopting the predominant use standard, the majority opined, would lead to serious First Amendment consequences, because if the predominant purpose of the work is commercial, it would lose its First Amendment standing regardless of its expressive elements.¹⁸²

video game, that was] only broadcast eight times in a three-day span immediately before the release of the video game to retail stores – much like an advertisement for an upcoming film." *Hart*, 808 F. Supp. 2d at 770 (quoting *Facenda*, 542 F.3d 1017). The "infomercial" referred specifically, and solely, to the *Madden Football* video game. . . .In short, the video "aim[ed] to promote another creative work, the video game." *Id.* at 1018. Here, by contrast, the speech *is* the video game that is being sold. It is not a separate instance of speech that promotes the purchase of another work. *See Hart*, 808 F. Supp. 2d at 770.

175. *See Hart*, 717 F.3d at 145.

176. *See id.* at 150.

177. *See Edison v. Edison Polyform Mfg. Co.*, 73 N.J. Eq. 136, 67 A. 392, 394 (N.J. Ch. 1907) (enjoining a company from using the name or likeness of Thomas Edison to promote its products).

178. *Id.*

179. The Ninth Circuit adopted the test in *Comedy III*, 25 Cal.4th 387 (2001), and the Sixth Circuit in *ETW*, 332 F.3d 915.

180. *See Hart*, 717 F. 3d at 160.

181. *See id.* at 154.

182. *Id.* In criticizing this test, the majority noted

[t]he game would have the exact same level of First Amendment expressiveness if [Appellee] didn't appropriate Mr. Hart's likeness. . . .Such reasoning, however, leads down a dangerous and rightly-shunned road: adopting Appellant's suggested analysis would be tantamount to admitting that it is proper for courts to analyze select elements of a work to determine how much they contribute to the entire work's expressiveness. Moreover, as a necessary (and

A discussion of the *Rogers* test followed.¹⁸³ The majority rejected that test, advocated by appellee, as it focused too much on trademark and unfair competition issues.¹⁸⁴ Calling it a “blunt instrument, unfit for widespread application,” beyond a trademark context, the opinion stated that because the right of publicity is broader and, by extension, protects a greater swath of property interests, a trademark law-oriented test is too restrictive and protects the “consumer, rather than the “celebrity.”¹⁸⁵

The court then applied the transformative test, despite its recent vintage and relative lack of venerable case law, and gave examples of its applicability in salient cases that (1) were literal depictions of a celebrity likeness,¹⁸⁶ (2) involved a significant transformation¹⁸⁷ and, (3) involved more than a “trivial” change in the likeness, significant enough to “alter the meaning” of the likeness.¹⁸⁸ The majority next discussed case law that applied the transformative test to videogames,¹⁸⁹ before finally concluding that this test is best suited for both adoption in this case and in the Circuit at large. Stating “the Transformative Use test effectively restricts right of publicity claims to a very narrow universe of expressive works,”¹⁹⁰ the majority found that it is the most consistent with other courts’ ad hoc approaches to right of publicity cases.¹⁹¹ In applying the test, the judges concluded that there was more of a literal depiction of Hart with minimal alteration.¹⁹² More specifically, the majority rejected the idea that the user’s

insidious) consequence, the Appellant’s approach would suppose that there exists a broad range of seemingly expressive speech that has no First Amendment value.

Id.

183. *Id.* at 155.

184. *Id.* at 155-59.

185. *Hart*, 717 F. 3d at 157. (“Appellee argues that Appellant should be unable to assert a claim for appropriating his likeness as a football player precisely because his likeness was used for a game about football. Adopting this line of reasoning threatens to turn the right of publicity on its head.”)

186. See *Comedy III*, 106 Cal. Rptr. 2d 126 (charcoal portraits of the Three Stooges did violate the Stooges’ rights of publicity, as the court could “discern no significant transformative or creative contribution” and that “the marketability and economic value of [the work] derives primarily from the fame of the celebrities depicted.” *Id.* at 811; *Hart*, 717 F.3d at 159.

187. See *Winter*, 30 Cal. 4th 881, 134 Cal. Rptr. 2d 634, 69 P.3d 473, 476.

188. See *ETW*, 332 F.3d 915. As the *Hart* court stated: “*ETW* presents an archetypical example of a case falling somewhere in the middle of Transformative Use Test jurisprudence, given that it focuses on the use of photographs (literal depictions of celebrities), but adds a transformative aspect to the work, thereby altering the meaning behind the use of the celebrity’s likeness.” *Hart*, 717 F.3d at 16.

189. See *Kirby*, 144 Cal. App. 4th 47, 50 Cal. Rptr. 3d 607 (applying the transformative test to a videogame which allegedly depicted the likeness and signature phrases of a musician. The court rejected the right of publicity claim against a video game company. Specifically, the musician (Kierin Kirby) had claimed that Sega misappropriated her likeness and signature phrases but the court concluded that differences in appearance and movement were such that the test was passed).

190. See *Hart*, 717 F.3d at 163. The author respectfully disagrees with that contention, as will be explained.

191. *Id.* at 164.

192. *Id.* at 166. The opinion stated:

ability to alter the image of the avatar player precludes a right of publicity,¹⁹³ ultimately concluding that the realistic image of the player was the central point, while the ability to alter that image was ancillary.¹⁹⁴ “To hold otherwise would have deleterious consequences for the state of the law,” it noted.¹⁹⁵ In ruling that the use does not pass the transformative test and does not have a de facto First Amendment privilege, the court reversed the lower court’s summary judgment determination.¹⁹⁶

In dissent, Judge Ambro wrote that, while the transformative test should be applied, Electronic Arts should prevail.¹⁹⁷ He looked at EA’s NCAA Football videogame in a broad context, not in terms of the identity of a player, but in terms of the entire product, which he found sufficiently creative and expressive to be “transformative.”¹⁹⁸ Criticizing the majority’s approach, the dissent cited *ETW v. Jireh Publishing* (the “Tiger Woods” reproduction case) for the proposition that the transformative use should be applied to the entire work, not just Woods’ image, which was quite realistic.¹⁹⁹ Chastising his colleagues for underestimating the creative

The 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. This is not transformative; the various digitized sights and sounds in the video game do not alter or transform the Appellant’s identity in a significant way.

Id.

193. *Id.*

[W]e are wary of converting the ability to alter a digital avatar from mere feature to talisman, thereby opening the door to cynical abuse. If the mere presence of the feature were enough, video game companies could commit the most blatant acts of misappropriation only to absolve themselves by including a feature that allows users to modify the digital likenesses. We cannot accept that such an outcome would adequately balance the interests in right of publicity cases.

Id.

194. *Id.* at 166-69.

195. *See Hart*, 717 F.3d at 168.

196. *Id.* at 170.

197. *Id.* at 170-71.

198. *Id.* at 167 (citing *Winter*, 30 Cal. 4th at 134 Cal. Rptr. 2d at 669 P.3d at 479).

199. *Id.* (citing *ETW*, 332 F.3d at 938)

My colleagues do not – and, in my view, cannot – explain how the photographic images of Woods were transformed if they limit their analysis to “how the *celebrity’s identity* is used.” [internal citations omitted]. Instead, their discussion of *ETW* recognizes that the Sixth Circuit held that the artist’s use qualified for First Amendment protection under the Transformative Use Test because “*the collage ‘contain[ed] significant transformative elements,’ ‘combination of images’*” describe[d], in artistic form, a historic event in sports history [the 1997 Masters golf tournament] and . . . convey[ed] a message about the significance of Woods’ achievement in that event.

Id.

aspects of the NCAA Football game, Judge Ambro, considered important the fact that the videogame gives the user significant control and power to “direct the play” by creating rosters, even with fictitious players.²⁰⁰ Therefore, he concluded that the majority misapplied the test by failing to consider the expressive content of the game as a whole.²⁰¹ After this ruling, EA made a motion for an *en banc* hearing, but it was denied.²⁰² However, two judges dissented, one of whom was Judge Ambro.

B. *Keller/NCAA*

Keller v. Electronic Arts, since renamed *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*,²⁰³ the second of the cases noted above, involved similar facts and resulted in a brief district court decision that echoed many of the conclusions found by the Third Circuit majority in *Hart*.²⁰⁴ Keller and a number of other former NCAA student-athletes²⁰⁵ brought an action against Electronic Arts, the NCAA, and the Collegiate Licensing Company, claiming right of publicity, among other grounds, due to the allegedly improper use of athlete images in college football and basketball videogames.²⁰⁶ After discussing the right of publicity laws in

200. See *Hart*, 717 F.3d at 167. The court noted:

NCAA Football involves myriad original graphics, videos, sound effects, and game scenarios. These artistic aspects permit a user to direct the play of a college football team whose players may be based on a current roster, a past roster, or an entirely imaginary roster comprised of made-up players. Users are not reenacting real games, but rather are directing the avatars in invented games and seasons. Further, the ‘Campus Legend’ and ‘Dynasty Mode’ features permit users to control virtual players and teams for multiple seasons, creating the means by which they can generate their own narratives. Such modes of interactive play are, I submit, imaginative transformations of the games played by real players.

Id.

201. *Id.* at 173.

202. See Dale Campbell, *The Ninth Circuit Throws a Penalty Flag Against Electronic Arts*, THE IP LAW BLOG (Aug. 9, 2013), <http://www.theiplawblog.com/2013/08/articles/trademark-law/the-ninth-circuit-throws-a-penalty-flag-against-electronic-arts/>.

203. See *Keller*, 2010 U.S. Dist. LEXIS 10719.

204. *Id.*

205. There were nine named plaintiffs, all former NCAA football or basketball players: Keller, Edward O’Bannon, Jr. (UCLA), Byron Bishop (University of North Carolina), Michael Anderson (University of Memphis), Danny Wimprine (University of Memphis), Ishmael Thrower (Arizona State University), Craig Newsome (Arizona State University), Damien Rhodes (Syracuse University), and Samuel Jacobson (University of Minnesota).

206. Specifically, seven causes of action were brought: (1) violation of Indiana right of publicity, against EA; (2) violation of California statutory right of publicity, against EA; (3) violation of California common law right of publicity, against EA; (4) civil conspiracy, against EA, NCAA and CLC; (5) violation of California Business & Professions Code § 17200 et. seq., against EA; (6) breach of contract, against NCAA; and (7) unjust enrichment, against EA and CLC. Only the right of publicity claims concern us.

Indiana²⁰⁷ (where the NCAA is headquartered) and California (EA's residence),²⁰⁸ the court addressed EA's motion to dismiss.

The district court denied the motion, concluding, after citing *Winter, Comedy III*, and *Kirby v. Sega of America*, that the transformative test applies and that the depictions of the players were not expressive enough to protect the apparent misappropriation of their images.²⁰⁹ In essence, the court rejected First Amendment immunity. EA also sought dismissal under California's "anti-SLAPP" statute.²¹⁰ Following this ruling, the case was consolidated, with *O'Bannon v. NCAA*, which alleged that the exclusive licensing of the former athletes' likenesses monopolized and restrained trade in the market for the licensing of college athlete publicity rights.²¹¹ An appeal to the Ninth Circuit followed.

The Ninth Circuit affirmed, in a 2-1 ruling,²¹² and the majority and dissent echoed the Third Circuit's determination in *Hart*. Judge Bybee, writing for the majority, concluded that the images did not contain "significant transformative elements" to warrant a constitutional defense as a matter of law under the state's Anti-SLAPP statute.²¹³ Looking at past "transformative" cases, the majority applied those cases from the California courts and from the Ninth Circuit applying the standard.²¹⁴

207. See IND. CODE ANN. § 32-36-1-8 (West 2014), which states, in part, "A person may not use an aspect of a personality's right of publicity for a commercial purpose during the personality's lifetime or for one hundred (100) years after the date of the personality's death without having obtained previous written consent from a person"

208. See CAL. CIV. CODE § 3344(a) (West 2009), which states:

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

Id.

209. See *Keller*, 2010 U.S. Dist. LEXIS 10719, 5.

210. *Id.* at 20. The anti-SLAPP statute, as found in the California Code of Civil Procedure, states that if a cause of action arises from the defendant's conduct "in furtherance of the person's right of petition or free speech under the United States or California Constitution in connection with a public issue[, it] shall be subject to a special motion to strike, unless the plaintiff demonstrates a probability that he or she will prevail on the claim." *Id.* See also, Timothy J. Bucher, *Game On: Sports-Related Games and the Contentious Interplay Between the Right of Publicity and the First Amendment*, 14 TEX. REV. ENT. & SPORTS L. 1. The court rejected this argument, concluding that EA was not able to show that Keller would not likely prevail on his claim based on the pleadings submitted. *Id.* at 22.

211. See *In re NCAA*, 724 F.3d 1268.

212. *Id.*

213. *Id.* at 1276, 1279.

214. *Id.* The cited cases were *Comedy III, Winter, Kirby, No Doubt v. Activision Publishing, Inc.*, 122 Cal. Rptr. 3d 397, 400 (Ct. App. 2011), and *Hilton v. Hallmark Cards*, 599 F.3d 894 (9th Cir. 2009).

In its analysis of how “realistic” or “literal” the uses were, the court analogized this case to *No Doubt v. Activision Publishing*,²¹⁵ which involved an avatar of plaintiffs’ rock band which was as “realistically portrayed” in defendant’s video game “Band Hero” as Keller was in the EA’s NCAA football game.²¹⁶ The majority added that the “context” of the activities in both *No Doubt* and *Keller* were also “similarly realistic—real venues in *Band Hero* and realistic depictions of actual football stadiums in *NCAA Football*.”²¹⁷ The court, therefore, distinguished *Keller/NCAA* and *No Doubt* from the other California cases, which involved “fanciful, creative character(s).”²¹⁸ It so concluded, even though the *No Doubt* avatars could not be altered, while those in *Keller/NCAA*, could be.²¹⁹ The court also ignored the fact that EA’s game had many participants and many avenues of alteration, which was not the case in *No Doubt*.²²⁰

Not surprisingly, the majority in *Keller/NCAA* approvingly cited *Hart* to justify its conclusion that the identity of the player (Keller) was not sufficiently transformed to grant EA constitutional protection.²²¹ The majority further noted the *Hart* court’s view that “the ability to modify the avatar counts for little where the appeal of the game lies in users’ ability to play as, or alongside[,] their preferred players or team.”²²² Additionally, it took a swipe at Judge Ambro’s dissenting opinion in *Hart*, arguing that he failed to consider the effect of *No Doubt* because it was not decided by California’s highest court, but rather by an appellate level court.²²³ The majority noted that even though that was the case, it felt that *No Doubt* was “persuasive” authority and does not conflict with the standard established in *Comedy III*.²²⁴

There is a certain judicial gamesmanship in this argument. *Hart* involves New Jersey law, not California’s (which, as noted earlier, has both

215. 122 Cal. Rptr 3d 397, 400.

216. See *In re NCAA*, 724 F.3d at 1276.

217. *Id.*

218. *Id.* at 1277. The court stated:

Though *No Doubt* certainly mentioned the immutability of the avatars, we do not read the California Court of Appeal’s decision as turning on the inability of users to alter the avatars. The key contrast with *Winter* and *Kirby* was that in those games the public figures were transformed into ‘fanciful, creative characters’ or ‘portrayed as . . . entirely new character[s].’

Id. (quoting *No Doubt*, 122 Cal. Rptr. 3d at 410) (“On this front, our case is clearly aligned with *No Doubt*, not with *Winter* and *Kirby*. We believe *No Doubt* offers a persuasive precedent that cannot be materially distinguished from Keller’s case.”). *In re NCAA*, 724 F.3d at 1277.

219. *No Doubt*, 122 Cal. Rptr. 3d at 410.

220. *Id.*

221. *Id.* at 1278.

222. See *Hart*, 717 F.3d 141.

223. *In re NCAA*, 724 F.3d at 1278.

224. *Id.* at 1277.

statutory and common law bases for the right of publicity). New Jersey is a strict common law state, relying on determinations based on court-made precedent. As such, a New Jersey court has no obligation to cite a California intermediate appellate court to justify its position. To give some credence to Judge Ambro's dissenting opinion in *Hart*, there are, as noted, legitimate differences between this case and *Hart* as compared to *No Doubt*; thus, this majority could and should have distinguished it, rather than rely on it.

The majority rejected EA's claim that the *Rogers* test should be applied.²²⁵ Outlining the criticisms of the test stated earlier in this article, it noted that *Rogers* constitutes an inapplicable extension of a trademark law standard to right of publicity cases. The court further stated that the *Rogers* test was designed to protect consumers from the risk of confusion, while the right of publicity "does not implicate the potential for consumer confusion."²²⁶ The court followed by mentioning the limited popularity of the test, as only the Restatement and one Federal circuit fully extended this standard to right of publicity cases, while others rejected the approach altogether.²²⁷ Ironically, on the very same day as *Keller/NCAA* was decided, this same court applied the *Rogers* test in a lawsuit by a former NFL player against EA and concluded that the athlete's claim of consumer confusion was subordinate to the First Amendment right of expression.²²⁸

In dissent, Judge Thomas also applied the transformative test, but concluded that EA's game was sufficiently transformative to warrant First

225. *Id.* at 1280.

226. *Id.* (citing *Cairns v. Franklin Mint Co.*, 292 F.3d1139, 1149 (9th Cir. 2002) and *Hart*, 717 F.3d at 158) ("[T]he right of publicity does not implicate the potential for consumer confusion . . .").

227. *Id.* at 1281. See *Parks*, 329 F.3d 437, 461 (6th Cir. 2003) (Sixth Circuit indicated that the *Rogers* test was appropriate for right-of-publicity claims, noting that the Restatement (Third) of Unfair Competition had endorsed use of the test in that context.). The Tenth Circuit in *Cardtoons, L.C. v. Major League Baseball Players Association*, and the Eighth Circuit in *C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media*, rejected the *Rogers* test in favor of a flexible case-by-case approach that takes into account the celebrity's interest in retaining his or her publicity and the public's interest in free expression.

228. See *Brown v. Electronic Arts*, 724 F.3d 1235 (9th Cir. 2013). In *Brown*, the former NFL Hall of Fame player Jim Brown sued, claiming violation of § 43(a) of the Lanham Act. Concluding that the EA game "Madden Football" was an expressive work, the court applied the *Rogers* test, concluding that

[a]s expressive works, the Madden NFL video games are entitled to the same First Amendment protection as great literature, plays, or books. Brown's Lanham Act claim is thus subject to the *Rogers* test, and we agree with the district court that Brown has failed to allege sufficient facts to make out a plausible claim that survives that test. Brown's likeness is artistically relevant to the games and there are no alleged facts to support the claim that EA explicitly misled consumers as to Brown's involvement with the games. The *Rogers* test tells us that, in this case, the public interest in free expression outweighs the public interest in avoiding consumer confusion.

Id. at 3.

Amendment protection.²²⁹ In certain respects, Judge Thomas’s dissent displays similarities to Judge Ambro’s dissent in *Hart*, as they both tried to make the correct determination under the rubric of a flawed standard.

Judge Thomas examined *Comedy III* in a more “holistic” manner to avoid “misapplication” of the test.²³⁰ In so doing, he took EA’s product “as a whole,” rather than as the use or alteration of one player’s image.²³¹ Judge Thomas called the EA game a “creation of historic fiction” and noted that the image is part of a scenario that includes tryouts, engaging in game competition, and alteration of the appearance and quality of players.²³² Judge Thomas “considered [the work] as a whole, is primarily one of EA’s own expression” and the game is not a conventional portrait of a celebrity, but “a work consisting of many creative and transformative elements.”²³³ He added that the celebrity element of Keller and the other plaintiffs was relatively minimal, so to exaggerate their importance and focus on their images is a “potentially dangerous and out-of-context interpretation of the transformative use test.”²³⁴

C. The EA and NCAA Settlements

In the fall of 2013, shortly after the 9th Circuit’s ruling in *Keller/NCAA*, EA Sports and co-defendant Collegiate Licensing Company announced a settlement with the class of plaintiffs on the right of publicity claims. The

229. *In re NCAA*, 724 F.3d at 1285.

230. *Id.* As the dissent stated: “Indeed, the focus of *Comedy III* is a more holistic examination of whether the transformative and creative elements of a particular work predominate over commercially based literal or imitative depictions. The distinction is critical, because excessive deconstruction of *Comedy III* can lead to misapplication of the test.”

231. *Id.*

232. *Id.* at 1285-86.

The gamers can also change their abilities, appearances, and physical characteristics at will. Keller’s impressive physical likeness can be morphed by the gamer into an overweight and slow virtual athlete, with anemic passing ability. And the gamer can create new virtual players out of whole cloth. Players can change teams. The gamer could pit Sam Keller against himself, or a stronger or weaker version of himself, on a different team. Or the gamer could play the game endlessly without ever encountering Keller’s avatar. In the simulated games, the gamer controls not only the conduct of the game, but the weather, crowd noise, mascots, and other environmental factors.

Id.

233. *Id.* The dissent applied *Keller/NCAA* to *Winter*, noting that the EA game is similar to that in *Winter*, 69 P.3d at 476, where the two fabled guitarists Johnny and Edgar Winter were easily identifiable, but depicted as chimeras. It distinguished the EA game from *No Doubt v. Activision Publishing, Inc.*, 122 Cal. Rptr. 3d 397, as the images in that case would not be transformed “in any way” and the bandmembers posed for motion-capture photography to allow reproduction of their likenesses, *id.* at 402, and the video game did not “permit players to alter the No Doubt avatars in any respect” *Id.* at 410. Unlike the avatars in *No Doubt*, the virtual players in *NCAA Football* are completely mutable and changeable at the whim of the gamer.

234. *In re NCAA*, 724 F.3d at 1290.

terms included a \$40 million payment to a group of former players that number between 200,000 and 300,000.²³⁵ Other details include individual players receiving up to \$4,000 for their avatars' appearance in *NCAA Football* and other EA games. At the time of this settlement, the NCAA committed, at least publicly, to litigate this case because the organization feels that the core nature of amateur athletics is at stake.²³⁶ However, just before the antitrust trial in the consolidated case, the NCAA announced a settlement of an additional \$20 million with the plaintiffs on the right of publicity claims involving the EA games.²³⁷ Also, the NCAA eliminated the name-and-likeness release from the set of forms Division I athletes sign annually.²³⁸ At this time, the *O'Bannon* antitrust claims have been litigated in front of the trial judge and she concluded that the NCAA's restrictions on the sharing of revenue that the NCAA and its member schools earned from the sale of licenses to use the student-athletes' names, images, and likenesses in videogames, live game telecasts, and other footage was a violation of antitrust law.²³⁹ Rejecting the NCAA's claims that maintaining amateurism and competitive balance justify these restrictions, the court permitted a scheme whereby students could earn compensation from a trust fund established paying up to \$5,000 per year for each year of eligibility. The payment would begin after the student leaves school or ends

235. See *EA to Settle for \$40 Million*, ESPN.COM, http://espn.go.com/college-football/story/_/id/9731696/ea-sports-clc-settle-lawsuits-40-million-source (last visited January 10, 2014).

236. See Peter Hammer, *EA settles with college athletes for \$40 million, NCAA still in suit*, THOMSON REUTERS, <http://blog.thomsonreuters.com/index.php/ea-settles-suit-with-college-athletes-for-40-million-ncaa-still-in-suit/> (last visited January 10, 2014).

237. See Michael McCann, *NCAA Reaches Settlement with Keller Plaintiffs: What does it Mean?*, SPORTS ILLUSTRATED, <http://www.si.com/college-football/2014/06/09/ncaa-keller-lawsuit-settlement> (last visited July 7, 2014).

238. See Dan Wolken and Steve Berkowitz, *NCAA removes name-likeness release from student-athlete form*, USA TODAY (July 18, 2014), <http://www.usatoday.com/story/sports/college/2014/07/18/ncaa-name-and-likeness-release-student-athlete-statement-form/12840997/>.

239. See *O'Bannon v. NCAA*, No. C 09-3329 CW, 2014 WL 3899815, at *36, (N.D. Cal. Aug. 8, 2014) (The Court concludes that the NCAA's challenged rules unreasonably restrain trade in violation of § 1 of the Sherman Act. Specifically, the association's rules prohibiting student-athletes from receiving any compensation for the use of their names, images, and likenesses restrains price competition among FBS football and Division I basketball schools as suppliers of the unique combination of educational and athletic opportunities that elite football and basketball recruits seek. . . . The challenged rules do not promote competitive balance among FBS football and Division I basketball teams, let alone produce a level of competitive balance necessary to sustain existing consumer demand for the NCAA's FBS football and Division I basketball-related products. Nor do the rules serve to increase the NCAA's output of Division I schools, student-athletes, or football and basketball games. Although the rules do yield some limited procompetitive benefits by marginally increasing consumer demand for the NCAA's product and improving the educational services provided to student-athletes, Plaintiffs have identified less restrictive ways of achieving these benefits.).

eligibility.²⁴⁰ However, the ruling, which, ironically came one day after the NCAA Board of Governors voted to give the five largest athletic conferences—the Atlantic Coast Conference (“ACC”), the Big Ten, the Big-12, the Pac-12, and the Southeast Conference (“SEC”)—autonomy to permit certain compensation for student beyond their current scholarships to cover their “full costs” of attendance,²⁴¹ was not a complete victory for the plaintiffs, as the court did not conclude that antitrust rules bar the NCAA from any regulation of collegiate athlete payments—in fact, she capped the stipends at a somewhat arbitrary amount. Suffice it to say, the district court ruling will not be the final word on the issue. The NCAA plans an appeal, which, barring a settlement, likely will result in months, if not years of litigation.²⁴²

The *O’Bannon* trial and the district court’s decision followed an order partially granting class action certification in the antitrust case.²⁴³ The court found certification justified on their claims for injunctive relief, barring the NCAA from prohibiting current and former student-athletes from entering into group licensing deals for the use of their names, images, and likenesses in videogames and game broadcasts.²⁴⁴ However, the court declined to grant certification on the question of damages, concluding that the plaintiffs have not identified a feasible way to determine which members of the proposed class were actually harmed by the NCAA’s allegedly anticompetitive conduct.²⁴⁵

The *O’Bannon* ruling addressed the right of publicity issue, albeit in passing. It restated the conclusion of a prior order that rejected the NCAA’s argument that the First Amendment precludes a right of publicity for live broadcasts of games (a point not central to our discussion) and that such broadcasts do not constitute commercial speech.²⁴⁶ Then, the court added

240. *Id.* at. *37. Also, the NCAA can no longer prohibit schools from paying the full cost of attendance as a scholarship. *Id.* At *36.

241. See Marc Tracy, *NCAA votes to give richest conferences more autonomy*, NEW YORK TIMES (Aug. 7, 2014), available at http://www.nytimes.com/2014/08/08/sports/ncaafotball/ncaa-votes-to-give-greater-autonomy-to-richest-conferences.html?_r=0.

242. See Michael McCann, *O’Bannon settles with EA and CLC in class action, NCAA still remaining*, SPORTS ILLUSTRATED (Sep. 26, 2013), <http://sportsillustrated.cnn.com/college-football/news/20130926/mccann-obannon-ea-clc-settlement/>.

243. See Michael McCann, *Judge Partially Certifies Class Action Status in O’Bannon Suit*, SPORTS ILLUSTRATED (June 16, 2014), <http://www.si.com/college-basketball/2013/11/09/obannon-ncaa-class-action-lawsuit>.

244. See generally *In re NCAA*, 724 F.3d 1268.

245. *Id.*

246. See *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, No. C 09–1967 CW, 2014 WL 1410451 (N.D. Cal. April 11, 2014).

[It is] clear that the First Amendment does not create a right to broadcast an entire athletic performance without first obtaining a license or consent from all of the parties who hold valid ownership rights in that performance. [footnote omitted] Whether Division I student-athletes

that even if the First Amendment bars a right of publicity claim for the game broadcasts, the broadcaster “may have still sought to acquire these rights as a precautionary measure” since “[b]usinesses often negotiate licenses to acquire uncertain rights.”²⁴⁷

IV. TOWARD A UNIFORM AND CONSTITUTIONAL STANDARD

A. *Why Right of Publicity Should not Adopt Standards from Copyright and Trademark Law*

On the surface, similarities between trademark law and right of publicity seem evident. Both involve the use of a name for certain commercial purposes—or at least as a vehicle to brand a person or a product. However, the similarities should not mask the differences in definition and application. While the notion of a de facto similarity was criticized earlier in the article when discussing the *Rogers* test,²⁴⁸ a broader critique is warranted. The mention of the right of publicity under the *Restatement of Unfair Competition* might suggest more than a passing connection with the Lanham Act, but the framers of the Restatement provisions in question took pains to note the differences between trademark and the right of publicity and construe the latter right in a limited manner.²⁴⁹ Comment c of section 46 of the Restatement makes it clear that “[t]he rationales underlying recognition of a right of publicity are generally less compelling than those that justify rights in trademarks or trade secrets[,]” and notes that those engaged in entertainment and sports reap other substantial awards (which I take to be meaning significant compensation) and their publicity rights “may only have marginal significance.”²⁵⁰ Also significant is the Restatement’s view that

hold any ownership rights in their athletic performances does not depend on the scope of broadcasters' First Amendment rights but, rather, on whether the student-athletes themselves validly transferred their rights of publicity to another party. Because the current record does not demonstrate that all Division I student-athletes validly transferred all of these rights, the First Amendment does not preclude student-athletes from asserting rights of publicity in live broadcasts or re-broadcasts of entire games. Accordingly, the First Amendment does not preclude the existence of a market for group licenses to use student-athletes' names, images, and likenesses in those broadcasts.

Id. at *9. See also, *id.* at 43 (rejecting the commercial speech argument, citing *NCAA/Keller*).

247. *O'Bannon*, No. C 09–3329 CW, 2014 WL 3899815, at *25, (N.D. Cal. Aug. 8, 2014).

248. See *supra* Part III.

249. See *ETW*, 332 F. 3d at 931.

250. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, cmt. c. That section also notes

In other cases the commercial value acquired by a person’s identity is largely fortuitous or otherwise unrelated to any investment made by the individual, thus diminishing the weight of the property and unjust enrichment rationales for protection. In addition, the public interest in avoiding false suggestions of endorsement or sponsorship can be pursued through the cause of

the right of publicity is “fundamentally constrained by the public and constitutional interest in freedom of expression,”²⁵¹ unless the use of the person’s name or likeness “is used solely to attract attention to a work that is not related to the identified person.”²⁵²

Copyright poses a different issue because the commercial aspect is not as central. A copyright involves a “work” in a fixed tangible medium, which grants the owners a monopoly to use or not to use.²⁵³ The relatively few cases pitting copyright rights against the First Amendment give the property right a more solid level of protection than found in other kinds of speech cases.²⁵⁴ One example is the ruling in *Harper & Row v. Nation Enterprises*,²⁵⁵ where the Supreme Court concluded that unauthorized use of a few hundred words from an upcoming book of 200,000 words was not constitutionally protected and, thereby, constituted a violation of the book publisher’s copyright.²⁵⁶ The fact that the subject was “newsworthy” did not provide a defense.²⁵⁷ This is not dissimilar to the approach the court took in *Zacchini*.²⁵⁸

Copyright infringers have a First Amendment defense—fair use, a longstanding concept found in the Copyright Act.²⁵⁹ The fair use defense allows a limited, yet unpermitted use of a copyrighted work. Despite statutory guidance, courts have had a difficult time crafting a consistent standard.²⁶⁰ In fact, one court called fair use “obscure” while another called it “the most troublesome in the whole law of copyright.”²⁶¹ Nevertheless, fair use remains at least conceptually, an important defense.²⁶²

action for deceptive marketing. Thus, courts may be properly reluctant to adopt a broad construction of the publicity right.

Id. For more discussion, see *ETW*, 332 F. 3d at 930.

251. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c, as noted in notes 61 and 83.

252. *Id.*

253. See Copyright Act, 17 U.S.C. § 102 (1976).

254. See generally Tun-jen Chiang, *Rehabilitating the Property Theory of Copyright’s First Amendment Exemption*, 89 NOTRE DAME L. REV. 521 (2013).

255. 471 U.S. 539 (1985).

256. *Id.* at 542.

257. *Id.* at 557.

258. Compare *id.* at 590, with *Zacchini*, 433 U.S. at 580.

259. Limitations on exclusive rights: Fair Use, 17 U.S.C. § 107 (1976).

260. See Joseph P. Bauer, *Copyright and the First Amendment: Comrades, Combatants or Uneasy Allies?*, 67 WASH. & LEE L. REV. 831, 837 (2010).

261. *Id.* See also, *Campbell v. Acuff-Rose Music*, 510 U.S. 569 (1994) (court concluded that parody of rap group’s musical parody of Roy Orbison’s “Oh, Pretty Woman” may be fair use); *Time v. Bernard Geis Associates*, 293 F.Supp. 130 (S.D.N.Y., 1968) (use of pictures from the famed “Zapruder film” deemed a fair use). For more background, see Lee, *supra* note 92.

262. See *Eldred v. Ashcroft*, 537 US 186 (2003) (court rejected constitutional challenge to the Copyright Extension Act, noting that First Amendment considerations were duly protected due to fair use and other exceptions). See also *Harper*, 471 U.S. at 589, 603 (The court opined that judges must resist the urge to reject a fair use defense based on traditional notions of labor. The court went on to note,

However, copyright fair use is a model of clarity compared to the approaches utilized in trademark infringement and unfair competition actions.²⁶³ This may be in part because the fair use exception in trademark law is not statutory, so the courts lack the definitional foundation (albeit less than ideal) as found in copyright. An example of a trademark right upheld over free speech considerations involved the use of the five-ringed Olympic trademark, a design given specific protection under provisions of the Ted Stevens Amateur Sports Act.²⁶⁴ The Supreme Court upheld such protection in a challenge to the use of the term “Gay Olympic Games” by an organization with no connection to the U.S. Olympic Committee.²⁶⁵ In concluding that there were other ways to publicize a sports event without using the trademarked term “Olympic,” the court held that free speech limitations were “incidental” and subservient to the property interests involved.²⁶⁶

Significantly, the court in *San Francisco Arts & Athletics* embraced a balancing standard—one that, surprisingly, has not seen much traction from subsequent courts on the trademark or the right of publicity side.²⁶⁷ Essentially an intermediate scrutiny test, the court stated “[t]he appropriate inquiry is thus whether the incidental restrictions on First Amendment freedoms are greater than necessary to further a substantial governmental interest . . .”²⁶⁸ Subsequent cases followed either the more customary “likelihood of confusion” standard²⁶⁹ or required a showing of “malice,” like that found in defamation cases.²⁷⁰

“[b]oth the purpose of the use and the nature of the copyrighted work strongly favor the fair use defense here.”).

263. See *Lee*, *supra* note 92, at 482.

264. Ted Stevens Olympic and Amateur Sports Act, 36 U.S.C. § 220501 et seq. (1978) (at the time of the case, the act was named the “Amateur Sports Act of 1978”). See *San Francisco Arts & Athletics, Inc. (“SFAA”) v. United States Olympic Committee*, 483 U.S. 522 (1987). 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.

265. *SFAA*, 483 U.S. at 522-24.

266. *Id.* at 537-41.

267. *Id.* at 532.

268. *Id.* at 537-41.

269. See *Dr. Seuss v. Penguin Books USA*, 109 F. 3d 1394, 1404 (9th Cir. 1997) (“poetic account” of the O.J. Simpson double murder trial entitled *The Cat NOT in the Hat! A Parody by Dr. Juice*, presents a sufficient showing trademark infringement of the well-known *The Cat in the Hat* by Dr. Seuss under the likelihood of confusion balancing approach); *Elvis Presley Enterprises v. Capece*, 141 F3d 188 (9th Cir. 1998) (lower court erred in dismissing claim that defendants-appellees’ service mark, “The Velvet Elvis,” does not infringe or dilute its federal and common-law trademarks, rejecting a First Amendment defense of parody. “As an irrelevant factor, parody does not weigh against or in favor of a likelihood of confusion, and the district court erred in relying upon parody in its determination of the likelihood of confusion and does not violate its right of publicity in Elvis Presley’s name.” *Id.* at 200.

270. See *Hoffman v. Capital Cities/ABC, Inc.*, 255 F. 3d 1180 (9th Cir. 2001); *Eastwood v. National Enquirer*, 123 F. 3d 1249 (9th Cir. 1997) [hereinafter *Eastwood II*]; *Eastwood v. Superior Court*, 149 Cal.App.3d 409, 198 Cal. Rptr. 352 (Ct. App. 1983) [hereinafter *Eastwood I*]. *Eastwood I* and *Hoffman* are discussed later.

While I find the San Francisco Arts & Athletics approach a viable basis for a new standard for right of publicity claims (discussed later in the article), the lack of consistency (for the copyright fair use defense) and the lack of statutory guidance (in the case of trademark), mitigate against applying these rules for a new right of publicity standard. In other words, the right of publicity standards are varied enough, so what good is it to take confusing standards from other areas of law?

B. Why the Right of Publicity Should be Identified by a Commercial Speech Standard

Unlike the sole foray into right of publicity found in the *Zacchini* case, the Supreme Court has addressed the scope and protection of commercial speech often in the last three and a half decades²⁷¹ and created a jurisprudence that concludes that it is more subject to governmental regulation than non-commercial speech and artistic expression.²⁷² While much writing exists concerning right of publicity and the First Amendment generally,²⁷³ little discussion addresses the connection between commercial speech and the right of publicity.

The most frequently utilized definition for commercial speech is “speech that does no more than propose a commercial transaction,”²⁷⁴ which

271. The cases have covered a variety of restrictions on commercial speech. *See, e.g.*, *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council*, 425 U.S. 748 (1976) (ban on advertising of drug prices by pharmacists); *Bolger v. Young Drug Products Corp.*, 463 U.S. 60 (1983); *Central Hudson Gas*, 447 U.S. 557; (ban on advertising by utilities); *Posadas de Puerto Rico Associates v. Tourism Co. of Puerto Rico*, 478 U.S. 328 (1986) (challenge to ban on gambling advertising in Puerto Rico); *Board of Trustees of the State University of New York v. Fox*, 492 U.S. 469 (1989) (ban on advertising Tupperware parties); *City of Cincinnati v. Discovery Network*, 507 U.S. 410 (1993) (ban by the city on the distribution of commercial material through on-street news racks); *Rubin v. Coors Brewing Co.*, 514 U.S. 476 (1995); (prohibition of beer labels stating alcohol content); *44 Liquormart v. State of Rhode Island*, 517 U.S. 484 (1996) (state ban on the advertising of alcohol prices); *Greater New Orleans Broadcasting Association v. United States*, 527 U.S. 173 (1999); (federal prohibition on broadcast advertising of casino gambling as applied to broadcasters in states where such gambling is legal); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525 (2001) (advertising regulations related to smokeless tobacco and cigars).

272. *See, e.g. Central Hudson Gas*, 447 U.S. 557 (creating a four-part test that approximates an intermediate scrutiny standard).

273. *See* W. Mack Webner & Leigh Ann Lindquist, *Transformation: The Bright Line Between Commercial Publicity Rights and the First Amendment*, 37 AKRON L. REV. 171 (2004); Christian Dennie, *Tebow Drops Back to Pass: Videogames Have Crossed the Line, But Does the Right of Publicity Protect a Student-Athlete’s Likeness When Balanced Against the First Amendment?*, 62 ARK. L. REV. 645 (2009); Kwall, *supra* note 85; Rosina Zapparoni, *Propertising Identity: Understanding The United States Right Of Publicity And Its Implications—Some Lessons For Australia*, 28 MELB. U. L. REV. 690 (2004); Richard T. Karcher, *The Use of Players’ Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 PENN ST. L. REV. 557 (2007).

274. This definition was first utilized in *Pittsburgh Press Co. v. Pittsburgh Commission on Human Relations*, 413 U.S. 376 (1973). This definition is not universal. Other courts have categorized commercial speech as “expression related solely to the economic interest of the speaker and its audience.” *Central Hudson Gas*, 447 U.S. at 561. The limitation nature of what is commercial is also

is similar to the Restatement's requirement of "commercial purpose" for the right of publicity.²⁷⁵ Although categorical issues occur regarding speech that contains both commercial and non-commercial elements, cases where courts have discussed the boundaries of what is "commercial" and what is not have not been frequent,²⁷⁶ and, despite a recent federal court of appeals ruling involving former basketball great Michael Jordan (which coined a more expansive definition²⁷⁷ to include a congratulatory message from a store that did not tie Jordan to one of its products, but still "branded" him in connection with that store), it is safe to say that most commercial speech cases center on advertising whose commercial nature is clear.

Like its counterpart defamation, commercial speech's constitutionalization is of fairly recent vintage.²⁷⁸ Beforehand, courts easily justified the regulation of advertising based on health and safety pursuant to state police powers.²⁷⁹ Commercial speech received its entry into the First

incorporated in determining the "commercial advertising or promotion" element in the Lanham Act. *See* Fashion Boutique of Short Hills, Inc. v. Fendi USA, Inc., 314 F.3d 48, 56-58 (2d Cir. 2002).

275. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46.

276. *See* Nike, Inc. v. Kasky, 27 Cal. 4th 949, 45 P. 3d 243 (2002), *cert. granted*, 537 U.S. 1099 (2003), *cert. dismissed*, 539 U.S. 654 (2003). The case involved paid advertising by the company to refute claims against the firm about its alleged use of child labor, poor working conditions and wages and safety concerns in its Asian factories. These allegations received considerable press coverage and resulting negative publicity for the company in the 1990s. *Kasky* instituted a private right of action under California's Unfair Competition and false advertising laws. In a sharply divided 4-3 vote, the California Supreme Court considered the speech sufficiently commercial as to apply the statutes and remanded the case back for consideration. In doing so, the majority, noting the discomfort over the standard definition of commercial, constructed a new definition which requires: (1) the speaker to be engaged in commerce; (2) the intended audience is likely to be actual or potential buyers or customers of the speakers' goods or services or persons acting for actual or potential buyers or customers; and (3) the facts represented are of a commercial nature. If the test (called the "limited-purpose test") was met, then the Unfair Competition and false advertising law would apply. The court found on the side of greater First Amendment protection. In doing so, they applied strict scrutiny. The U.S. Supreme Court at first granted certiorari, even heard oral arguments, but then decided that it improvidently granted certiorari based on several procedural issues, including the fact that the California judgment was not "final." Ultimately, the parties settled the case. The California's court's proposed standard has not generated much judicial traction since. *See also*, Gaudiya Vaishnava Soc'y v. City of San Francisco, 952 F. 2d 1059 (9th Cir. 1990), *cert. denied*, 504 U.S. 914 (1992) (T-shirts and other items sold that carried political and religious messages were deemed "fully protected" speech; *Children of Rosary v. City of Phoenix*, 154 F. 3d 972 (9th Cir. 1998) (Advertising of products containing pro-life messages on city buses held to be noncommercial speech).

277. *See* *Jordan v. Jewel Food Stores*, 743 F.3d 509 (7th Cir. 2014); *see infra*, note 367.

278. *See* George A. Birrell & F.W.D. Schaefer, *Corporate and Commercial Free Speech: First Amendment Protection of Expression*, 42 Bus. Law. 279 (1986).

279. *See, e.g.*, *Valentine v. Chrestensen*, 316 U.S. 52 (1942) (upheld a city ordinance that barred distribution of commercial handbills). *Valentine* represented the culmination of three prior decades of jurisprudence treating restrictions on such speech as a justifiable health and safety regulation. During that time, courts dismissed challenges to various commercial speech regulations, including (a) laws limiting all billboard advertising. *See e.g.*, *Thomas Cusack Co. v. City of Chicago*, 242 U.S. 526 (1917), (the court held that the ordinance, requiring consent by residents to permit billboard advertising in residential areas, was within the scope of the power conferred on the city by the legislature). *See also*, *St. Louis Poster Advertising Co. v. St. Louis*, 249 U.S. 269 (1919) (involving a challenge by plaintiff billboard company to a city ordinance that restricted the height and size of billboards on 14th Amendment liberty

Amendment club in 1976,²⁸⁰ and since 1980, determining the level of constitutional protection for commercial speech has been subject to a content-neutral type balancing test weighing the freedom of the commercial speaker and the governmental interest to regulate such speech.²⁸¹ Unlike right of publicity cases, the test to determine the constitutionality of government restriction of such speech is settled law, although it has been criticized as too protective or not protective enough by some scholars and judges.²⁸² The standard has been considered intermediate scrutiny, but with

grounds, where the court upheld the city's power to issue such in the interest of the safety, morality, health, and decency of the community); (b) restrictions on vehicular advertising. *See, e.g.*, *Fifth Ave. Coach Co. v. New York*, 221 U.S. 467 (1911) (the court rejected a constitutional challenge, and concluded that the ordinance was not an arbitrary exercise of the city's police power to regulate the business conducted in its streets); (c) prohibitions of tobacco advertising. *See Packer Corporation v. Utah*, 285 U.S. 105 (1932) (court upheld a Utah statute prohibiting tobacco advertising on billboards, street car signs, and placards, rejecting an argument that the law was discriminatory because it exempted ads in newspapers and other periodicals. The court, however justified the difference, because unlike advertisements in newspapers and magazines, billboard advertisements were "constantly before the eyes of observers on the streets and "thrust upon" the public, while ads in newspapers, magazines and radio must be "sought" and "read."); (d) restrictions on advertisements using the U.S. flag. *See Halter v. Nebraska*, 205 U.S. 34 (1907). The court upheld such a ban as preventing "indignation" or "offense" from those who revere the flag. *Id.* at 45. For an excellent discussion of early commercial speech cases, *see Alex Kozinski & Stuart Banner, The Anti-History and Pre-History of Commercial Speech*, 71 TEX. L. REV. 747 (1993).

280. *See Virginia Pharmacy*, 425 U.S. 748 (1976). In that case, the court struck down advertising ban by pharmacies, concluding

[S]ociety . . . may have a strong interest in the free flow of commercial information. Even an individual advertisement, though entirely "commercial," may be of general public interest . . . So long as we preserve a predominantly free enterprise economy, the allocation of our resources in large measure will be made through numerous private economic decisions. It is a matter of public interest that those decisions, in the aggregate, be intelligent and well informed. To this end, the free flow of commercial information is indispensable [internal citations omitted]. . . Therefore, even if the First Amendment were thought to be primarily an instrument to enlighten public decision making in a democracy, we could not say that the free flow of information does not serve that goal.

Id. at 765.

281. *See Paul S. Zimmerman, Hanging Up On Commercial Speech: Moser v. FCC*, 71 WASH. L. REV. 571, 573-76 (1996).

282. *See C. Edwin Baker, The First Amendment and Commercial Speech*, 84 IND. L.J. 981, 998 (that the libertarian tradition makes a fundamental mistake when it tries to connect its emphasis on autonomy and liberty to claims about market freedom."). *See also, Volokh, supra* note 2, at 930 (author concludes that if right of publicity should exist, it should have a commercial speech basis).

However, others have criticized the standard as difficult to define and not protective enough. *See, e.g.*, LAURENCE H. TRIBE, *AMERICAN CONSTITUTIONAL LAW* 896 (2nd ed. 1988) (stating that the distinction between commercial speech and noncommercial speech "has not provided reliable guidance for resolution of individual cases"); Alex Kozinski & Stuart Banner, *Who's Afraid of Commercial Speech?*, 76 VA. L. REV. 627, 649 (1990) (stating that "we have a distinction then, with no basis in the Constitution, with no justification in the real world, and that must often be arbitrarily applied in any but the easiest cases"); Steven Shiffrin, *The First Amendment and Economic Regulation: Away from a General Theory of the First Amendment*, 78 NW. U. L. REV. 1212, 1216 (1983) (stating that the Court's "doctrinal treatment of commercial speech has been inadequate").

a decided tilt toward more First Amendment protection in recent years.²⁸³ It is based on an intricate, policy-driven four-part standard, known as the *Central Hudson* test.²⁸⁴ While the court in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council*, formally constitutionalized commercial speech, the opinion noted, in general terms, that commercial speech may not be as protected as non-commercial speech.²⁸⁵ *Central Hudson* created the specific test for determining the protection of commercial speech. Whether it is considered intermediate scrutiny or intermediate scrutiny “plus,” it clearly differs from the standard imposed for content-related political speech, known as “strict scrutiny,” which grants a higher level of First Amendment protection,²⁸⁶ except in certain areas of speech such as defamation²⁸⁷ and broadcasting.²⁸⁸

Traditional intermediate scrutiny requires that the government show a substantial governmental interest for the restriction and that the restriction is “not more restrictive than necessary” to accomplish this result.²⁸⁹ *Central Hudson* calibrates the test to commercial speech by creating a multi-part requirement—assuming that the speech is not false or deceptive (if it is then

At least one Supreme Court justice has sought its re-examination and possible repeal. Justice Thomas has been particularly vocal questioning the lower level of constitutional protection for commercial speech. *See, e.g., Greater New Orleans Broadcasting v. United States*, 527 U.S. 173, 197 (1999) (Thomas, J., concurring in the judgment) (rejecting the government’s interest as no more justifying a restriction on commercial speech than it would justify a restriction on noncommercial speech); *44 Liquormart v. Rhode Island*, 517 U.S. 484, 518–23 (1996) (Thomas, J., concurring in part and concurring in the judgment) (“I do not see a philosophical or historical basis for asserting that ‘commercial’ speech is of ‘lower value’ than ‘noncommercial’ speech.”). Justice Stevens has also been skeptical of the standard. For more, see Volokh, *supra* note 2, at 929.

283. *See, e.g., Mitchell N. Berman, “Commercial Speech and the Unconstitutional Conditions Doctrine: A Second Look at “The Greater Includes the Lesser”* 55 VAND. L. REV. 693, 777 (2002) (“Justice Thomas argued that the advertising restrictions should be subject to strict scrutiny, not to the intermediate review of *Central Hudson*”). *See also, 44 Liquormart*, 517 U.S. 484.

284. The test is named after *Central Hudson*, 447 U.S. 557.

285. 425 U.S. 748, 771-73 (1976). Specifically, the court noted that certain commercial speech may receive less constitutional protection than other speech, or even no protection at all. False or misleading commercial speech and commercial speech about illegal transactions receives no protection. Advertising through radio and television may receive lower protection. Disclosure and warning requirements, as well as regulation of the form of advertising, may be more permissible in the commercial speech arena than elsewhere, and, the prior restraint doctrine may not apply to commercial speech regulations. *See also, Ashutosh Bhagwat: A Brief History of the Commercial Speech Doctrine (With Some Implications for Tobacco Regulation)*, 2 HASTINGS SCI. & TECH. L.J. 103, 106 (2010).

286. Strict scrutiny requires that, in order for the state to limit content-related speech it must show that there is a compelling governmental interest for the restriction and that the restrictions was as narrowly-tailored as possible to accomplish this result. *See Simon & Schuster v. New York State Crime Victims Board*, 502 U.S. 104 (1991).

287. *See New York Times*, 376 U.S. at 268.

288. *See NBC v. United States*, 319 U.S. 190 (1943) (justifying the scarcity of the broadcast spectrum as a basis for regulating broadcasters more heavily than print media); *see also, Red Lion Broadcasting v. FCC*, 305 U.S. 167 (1969) (upholding the right to reply requirements under the Fairness Doctrine, where a radio station was required to furnish reply time to an individual after a personal attack).

289. *See O’Brien*, 391 U.S. 367.

there is no protection), then the government must demonstrate: (a) that there was a substantial governmental interest for the restriction; (b) that the restriction “directly advances” that interest; and (c) that the restriction is not “more restrictive than necessary” to accomplish the result.²⁹⁰

Commercial speech cases have involved varying regulations and affected a myriad of products and services.²⁹¹ In the post-*Virginia Pharmacy/Central Hudson* era, the only kind of commercial speech with no protection are those advertisements deemed “false and deceptive” often under the purview of the Federal Trade Act and regulations of the Federal Trade Commission (“FTC”) or similar state laws.²⁹² While the state interest of punishing purveyors of political or artistic speech for being “false or deceptive” (excluding private rights of action defamatory speech) is minimal, there is a legitimate state interest to prevent consumers from purchasing goods based on those claims.

Right of publicity cases (at least traditionally) dovetailed this kind of speech as they involved uses of one’s name, likeness, or other indicia of identity in a commercial setting, resulting in direct commercial exploitation.²⁹³ Until the 1990s, attempts to expand this were generally rebuffed.²⁹⁴ The Restatement demonstrates this strong connection by centering the right of publicity on commercial use.²⁹⁵ As noted earlier, only a few right of publicity cases have addressed the issue of whether the speech intertwined “commercial” and “non-commercial” elements and courts have

290. See *Central Hudson*, 447 U.S. at 566.

291. Examples have included challenges to regulations involving licensed professions, “sinful” products, drug prescription pricing, billboards, and government-mandated advertising. See *Central Hudson*, 447 U.S. at 154.

292. See Federal Trade Commission Act, 15 U.S.C. §§ 52-57. An ad is deceptive if it contains a statement or practice, or omits information, that is likely to mislead consumers acting reasonably under the circumstances; and is “material” that is, important to a consumer’s decision to buy or use the product. Practices that have been found misleading or deceptive in specific cases include false oral or written representations, misleading price claims, sales of hazardous or systematically defective products or services without adequate disclosures, failure to disclose information regarding pyramid sales, marketing and point-of-sales practices (i.e. use of bait and switch techniques), failure to perform promised services, and failure to meet warranty obligations. See FTC Policy Statement on Deception, 103 F.T.C. 110, 174 (1984).

293. See, e.g. *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (court upheld claim by television talk show host against firm for using his introductory signature line in an advertisement for toilets); *Motschenbacher v. R. J. Reynolds Tobacco Company*, 498 F.2d 821 (1974) (Race car driver may have cause of action for use of film of his car and his image in tobacco advertisement); *Hirsch v. S. C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 280 N.W. 2d 129 (1979) (use of football player’s nickname “Crazy Legs” for a women’s shaving gel constituted a cause of action for misappropriation and infringement of trade name); *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407 (9th Cir. 1996) (use of star basketball player’s former name as “most valuable player” in past NCAA men’s basketball tournaments constituted a cause of action under both statutory and common law right of publicity under California law).

294. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (exception for newsworthy items). See e.g., *Namath*, 48 A.D.2d 487, 371 N.Y.S.2d 10.

295. See *supra* Part II.C.1.

concluded that a strong presumption of non-commercial status exists in such situations.²⁹⁶ A recent opinion demonstrates that, at least to one California appellate court, a special paid advertising section of a magazine with both editorial and advertisements could not be considered “commercial” for First Amendment purposes.²⁹⁷

Although this intermingling of commercial and non-commercial use has not been a central consideration, the issue is one of considerable importance. For example, what standard applies to a comic book, given away free as a promotion with a parody image that looks nothing like the hockey player who sued and who received a substantial settlement?²⁹⁸ Or, whether the “transformative” aspect of the work makes it inherently non-commercial?²⁹⁹ Or determining whether a depiction of an athlete in a video game with different applications and imaginative elements can render its creators subject to a commercial speech standard because the game is being sold to the public?³⁰⁰ Because the right of publicity has been expanded—in my view unwarranted in cases like *Hart* and *Keller/NCAA* that, at the very least, stretch the notion of what is “commercial”—there will be a confusing application of constitutional protection as long as there is a dichotomy between commercial and non-commercial speech.

296. See *Hoffman*, 255 F.3d 1180 (altered image of actor with identified designer wear not deemed commercial); see also, *Gaudiya Vaishnava Soc’y v. City & County of San Francisco*, 952 F.2d 1059, 1064 (9th Cir. 1991) (as amended) (selling merchandise in connection with a charitable purpose is fully protected speech); *Riley v. National Federation of the Blind*, 487 U.S. 781 (1988) (“we do not believe that the speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech”); *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771 (1976) (“There are commonsense differences between speech that does no more than propose a commercial transaction and other varieties.”), all cited in *Hoffman*, 255 F.3d at 1185-86).

297. See *Stewart v. Rolling Stone, LLC*, 181 Cal.App.4th 664 (Ct. App., 2010), discussed later. The magazine published a special section titled “Indie Rock Universe” and the editorial portion discussed a number of “independent” rock bands. However, the rest of the section was composed of advertising material from a tobacco company, demonstrating its support of the genre and of independent record labels that espouse the genre. A number of performers from those bands mentioned filed a class action lawsuit against the magazine, claiming the use of the bands names’ without consent for advertising purposes. The magazine responded with a motion to dismiss under the state’s “Anti-SLAPP” law found in § 425.16, of the California Civil Code. The appellate court, in overturning the trial judge, concluded “there is no legal precedent for converting noncommercial speech into commercial speech merely based on its proximity to the latter. There is also no precedent for converting a noncommercial speaker into a commercial speaker in the absence of any direct interest in the product or service being sold.” *Id.* at 689.

298. See *Doe*, 110 S.W. 3d 363. Twist was originally awarded \$24.5 million. That award was overturned by the court and after a second trial, he was awarded \$15 million. However, Twist had settled for \$5 million. The settlement between Twist and insurance companies for Todd McFarlane Productions Inc. was approved in bankruptcy court in Arizona in 2007. See *Twist Case Settled*, ICV2, <http://www.icv2.com/articles/news/10104.html> (last visited July 10, 2013).

299. Compare *ETW*, 332 F.3d 915 (transformative painting of Woods winning) with *Comedy III*, 106 Cal.Rptr.2d 126, 25 Cal.4th 387, 21 P.3d 797 (literal depiction of Three Stooges on T-shirts).

300. See *Hart*, 717 F.3d 141; see also, *Keller v. Electronic Arts, et al.*, 724 F.3d 1268 (9th Cir. 2013).

Although no court has applied the *Central Hudson* standard to a right of publicity case, a few courts have given clues about how commercial speech doctrine applies to the right of publicity. In *Cardtoons v. Major League Baseball Players' Association*,³⁰¹ the Tenth Circuit addressed this issue, concluding that the Supreme Court's view is "best understood as speech that merely advertises a product or service for business purposes."³⁰² This dovetails earlier courts' definition of the term.³⁰³ Consistent with this standard, the court in *Cardtoons* concluded that the trading cards were not commercial speech, as they did not "merely advertise another unrelated product," despite the fact that they were "sold in the marketplace, they are not transformed into commercial speech merely because they are sold for profit."³⁰⁴

This is a key point, yet many recent decisions have shied away from this commercialism view and relied on the vagaries of the transformative test. While the majority in *Hart* concluded that the depiction of an avatar of the player was not sufficiently transformative, that missed the point. Because the depictions are not commercial in nature—they do not propose a commercial transaction—full First Amendment rights should apply. And full First Amendment rights mean a form of the strict scrutiny test for content-related restrictions on speech. To consider such uses "commercial" would mean that every product sold to the public with a person's name or image would be subject to a commercial speech designation. That proves constitutionally problematic and would serve to minimize protections for potential documentarians, filmmakers, and video producers.

C. Defamation's Qualified Privilege – Could there be a Link?

Despite the gradually expansive protection of non-commercial speech through the 20th century,³⁰⁵ until 1964, libelous and slanderous

301. 95 F. 3d 959 (10th Cir. 1996).

302. *Id.* at 970.

303. *Id.* The court in *Central Hudson* defined commercial speech as "expression related solely to the economic interests of the speaker and its audience," while the earlier *Virginia Board of Pharmacy* court defined the term as "[s]peech that does no more than propose a commercial transaction." See *Central Hudson*, 447 U.S. 557 (1980); see also, *Virginia Pharmacy*, 425 U.S. at 761.

304. See *Cardtoons*, 95 F. 3d at 970.

305. The modern era of free speech rights occurred in *Schenck v. United States*, 249 U.S. 47 (1919); *Frohwerk v. United States*, 249 U.S. 204 (1919); *Debs v. United States*, 249 U.S. 211 (1919); *Abrams v. United States*, 250 U.S. 616 (1919). Concurring in *Schenck* and dissenting in *Abrams*, Justices Holmes and Brandeis created what would become the "clear and present" danger doctrine. Other notable cases included *Gitlow v. New York*, 268 U.S. 652 (1925) and *Whitney v. California*, 274 U.S. 357 (1927). The modern protection for political speech was not formally crystallized until *Brandenburg v. Ohio*, 395 U.S. 444 (1969). The present legal definition of obscenity was crafted in *Miller v. California*, 413 U.S. 15 (1973), which, in effect, permitted sexually oriented speech, as long as it did not lack artistic, educational, or scientific value, based on community standards and did not appeal to the prurient interest.

communications were not part of the First Amendment canon. However, *New York Times v. Sullivan*³⁰⁶ swept away hundreds of years of common law defamation by concluding that communications traditionally considered libelous or slanderous receive First Amendment protection in the form of a qualified immunity if the defendant was a “public official.”³⁰⁷ Shortly afterwards, this immunity was expanded to a “public figure.”³⁰⁸ However, before addressing the central issue, the court in *New York Times* determined that the material in question—a paid advertisement criticizing Alabama officials for stifling civil rights efforts and seeking contributions to defend Dr. Martin Luther King—was not commercial speech (which at the time had no constitutional protection), but rather political speech protected under the First Amendment.³⁰⁹ For those in the public eye, the court ended strict liability in tort for defamation, requiring instead that “actual malice” be shown in addition to the communication’s falsity and harm to reputation.³¹⁰ Actual malice constituted a false statement made with “malice or reckless disregard for its truth.”³¹¹ The *New York Times* standard was later refined to

306. 376 U.S. 254 (1964).

307. *Id.* The facts in *New York Times* are well-known. Sullivan claimed had been libeled by statements in a full-page advertisement signed by 64 individuals from public affairs, religion, trade unions, and the performing arts that was carried in the *New York Times* on March 29, 1960. It sought to raise funds to support “the struggle for the right-to-vote,” and the legal defense of Dr. Martin Luther King, Jr. against a perjury indictment then pending in Montgomery, Alabama. Entitled “Heed Their Rising Voices,” the advertisement charged that “in their efforts to uphold these guarantees, civil rights protesters were being met by “an unprecedented wave of terror by those who would deny and negate that document which the whole world looks upon as setting the pattern for modern freedom . . .” Succeeding paragraphs purported to illustrate the “wave of terror” by describing certain alleged events. Some of the statements were inaccurate and respondent alleged that some or all of the statements as referring to him in his capacity as Commissioner.

308. See *Curtis Publishing Co.*, 388 U.S. 130 (*New York Times* standard applies to dwell-known college football coaches); *Associated Press v. Walker*, 389 U.S. 28 (1967) (retired general considered a public figure).

309. See *New York Times*, 376 U.S. at 300. This was particularly significant because at the time of the case, commercial speech had no First Amendment protection. One of respondent’s arguments was that the First Amendment freedoms did not apply in this case precisely because the material constituted commercial speech. *Id.* at 266. However, the court concluded that despite the fee paid for the space and the appeal for contributions, the speech was political. The majority stated:

The publication here was not ‘commercial. . . . [It] communicated information, expressed opinion, recited grievances, protested claimed abuses, and sought financial support on behalf of a movement whose existence and objectives are matters of the highest public interest and concern.’ [internal citations omitted] That the *Times* was paid for publishing the advertisement is as immaterial in this connection as is the fact that newspapers and books are sold.

Id. See also *supra* note 307 and accompanying text.

310. *Id.* at 279-81.

311. *New York Times*, 376 U.S. at 279. The court concluded:

The constitutional guarantees require, we think, a federal rule that prohibits a public official from recovering damages for a defamatory falsehood relating to his official conduct unless he

include standards for defamation for non-public figures.³¹² Additionally, the *New York Times* standard was applied to a privacy cause of action known as “false light”—a type of speech that is not quite false, but does create an inaccurate portrayal.³¹³

D. *The Cases to Watch*

While the expansion of right of publicity has been chronicled by in this article, some courts have attempted to rein in its scope. Two recent decisions have displayed more sensitivity to First Amendment concerns and may plant the seeds for a new standard review in cases pitting publicity rights with free speech rights.

1. *Fantasy Sports – The MLBAM case*

The creation of fantasy sports games have raised issues as to whether the use of an athlete’s name and statistical information as part of a fantasy sports game constitutes a violation of the athlete’s publicity rights. *C.B.C. Distribution v. MLBAM*,³¹⁴ is not the first case to decide this question, but probably is the most important.³¹⁵ Using publicly available information, a firm marketed a baseball fantasy sports game.³¹⁶ There were no team designs, logos, or reproductions of a likeness or avatar of the player. The game involved, to put it in the parlance of the famous “Dragnet” television show of a bygone era, “just the facts.”³¹⁷ *C.B.C. Distributing*, the firm that created and disseminated the particular fantasy game, sought a declaratory judgment from the district court that the game did not violate any publicity rights of MLBAM and no license was needed to utilize the names and statistical information.³¹⁸ *MLBAM and the Major League Baseball Players’*

proves that the statement was made with ‘actual malice’ – that is, with knowledge that it was false or with reckless disregard of whether it was false or not.

Id.

312. *Gertz v. Robert Welch*, 418 U.S. 323 (1974) (the court refined the definition of a public figure to include those who voluntarily thrust themselves into the public domain. It also ended the common law strict liability standard for defamation and directed the states to impose, at a minimum, a requirement of negligence as part of a cause of action. *Id.* at 347).

313. *See, e.g., Time, Inc. v. Hill*, 385 U.S. 374 (1967).

314. 505 F.3d 818 (8th Cir. 2007).

315. *See Gionfriddo v. Major League Baseball*, 94 Ca. App. 4th 400, (Cal. Ct. App. 2001) (court dismissed claims by former baseball players for the use of their statistical information in advertisements).

316. *See C.B.C.*, 505 F.3d at 820.

317. *See Dragnet* television show, when officer says to a potential witness, “Just the facts, ma’am.”

318. *See C.B.C.*, 443 F. Supp. 2d 1077. The federal magistrate noted that *C.B.C.* distributed and sold fantasy sports products, via telephone, mail, e-mail, and the Internet. At the time of the filing, it offered eleven fantasy baseball games, two mid-season fantasy baseball games, and one fantasy baseball

Association counterclaimed, arguing C.B.C. violated the players' right of publicity based on C.B.C.'s exploiting the rights of players "including their names, nicknames, likenesses, signatures, jersey numbers, pictures, playing records and biographical data," with respect to fantasy baseball games.³¹⁹ They also alleged a breach of contract claim because at one time C.B.C. had a licensing agreement with MLBAM to produce a fantasy game.³²⁰

The magistrate, pointing to Missouri's Restatement-based right of publicity standard utilized in *Doe v. TCI Cablevision*,³²¹ concluded that the First Amendment superseded any publicity claims, as the use was not "commercially-based," and in fact, pre-empted any relevant state law.³²² Noting that the use does not hurt baseball players from earning an income, the court failed to see any commercial application³²³—a correct conclusion in my judgment. The court granted summary judgment in favor of C.B.C., but did not articulate a more precise balancing standard.

The Eighth Circuit, in a 2-1 vote,³²⁴ delivered an unusually short opinion that agreed with the conclusion of the lower court, but resulted in more ambiguity.³²⁵ In noting that Missouri's standard for right of publicity contains a strong commercial element,³²⁶ the majority relied on the Restatement standard, but admitted that this case "does not fit neatly into the more traditional categories of commercial advantage."³²⁷ It then drew upon an expanded view of that commercial element when it focused on C.B.C.'s

playoff game. C.B.C. provided lists of Major League baseball players and their respective statistical information for selection by participants in its games. Game participants pay fees to C.B.C. to play its games and pay additional amounts to trade players. Prior to the start of the professional baseball season participants form their teams by "drafting" players from various Major League baseball teams. Participants or "owners" compete against other fantasy owners who have drafted their own teams. The success of one's fantasy team over the course of the baseball season is dependent on one's chosen players' actual performances on their respective actual teams. *Id.* at 1080. The statistical information includes information, which according to the court, "is typically found in box scores in newspapers such as players' batting averages, at bats, hits, runs, doubles, triples, home runs, etc." *Id.*

319. *Id.*

320. See 808 F.3d at 821. From 1995 through the end of 2004, C.B.C. licensed its use of the names of and information about major league players from the Players Association pursuant to license agreements that it entered into with the association in 1995 and 2002. In 2005, after the 2002 agreement expired, the Players Association licensed those rights to MLBAM "for exploitation via all interactive media." After not being offered an extension, CBS decided to market its own game.

321. See *Doe*, 110 S.W.3d at 369.

322. *C.B.C.*, 443 F. Supp. 2d 1077, 1106-07, 1091-1100.

323. *Id.* at 1091.

324. The dissenting opinion of Judge Colloton concurred in the majority's conclusions about the right of publicity and First Amendment. He dissented on grounds involving the prior licensing agreement, which is not the subject of our discussion. See 808 F. 2d at 826 (Colloton, J., dissenting).

325. See generally *C.B.C.*, 505 F.3d 818.

326. See *Doe*, 110 S.W. 3d at 369.

327. See *C.B.C.*, 505 F.3d at 822. Citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. a, the majority stated that there was doubt that the use of the baseball players' names in the fantasy game is not a traditional use of the names for advertising and merchandising purposes in a way that states or intimates that the individuals are endorsing a product.

“intent” to use the ballplayers’ identities for profit, which was “sufficient to make out a prima facie case for a right of publicity claim.”³²⁸

The majority then balanced that claim with First Amendment considerations, ultimately affirming the decision of the lower court.³²⁹ Without discussing a precise standard of review, the court concluded that such information constituted protected speech and that a strong public interest exists in the dissemination of such statistical information for the millions of fans who follow Major League Baseball and its players.³³⁰ That point, coupled with the fact that baseball players do not have a strong economic interest in proceeds from the use of their names and statistics for fantasy games, given that they are “rewarded, and handsomely, too, for their participation in games and can earn additional large sums from endorsements and sponsorship arrangements,” demonstrate that their property rights are subsumed by the First Amendment considerations.³³¹

This is not the first time a court stressed the economic earning ability of professional athletes. As noted earlier, for example, the court in *ETW v. Jireh* discussed this point.³³² Some scholars also noted that a plaintiff’s earnings should be a factor in determining a right of publicity.³³³ However, I think this should not be considered (except for calculation of damages if indeed the right of violated), because it is irrelevant when determining first amendment rights. If decreased earning potential is used as a requisite for proof of commerciality, the plaintiffs in *Hart* and *Keller* could use it as an advantage, since they never received compensation for their services while playing college sports (unless one considers the scholarship received as compensation) and contracted away their rights to obtain this kind of income.

However, the circuit court’s opinion in *C.B.C. v. MLBAM* lacks the kind of categorical approach, which immunizes all claims that not directly commercially based—a paradigm for a new, controlling standard for right of publicity cases.

328. *Id.* at 822-23.

329. *Id.* at 825.

330. *Id.* at 824.

331. *Id.*

332. See *ETW*, 332 F.3d 915, 935. See also *supra* note 141.

333. See Michael Sloan, *Too Famous for the Right of Publicity: ETW Corp. and the Trend Towards Diminished Protection for Top Celebrities*, 22 CARDOZO ARTS & ENT. L.J. 903, 923 (2005).

2. *Brown v. Entertainment Merchants Association – The Supreme Court Finds Strong First Amendment Protection for Videogames*

Another “high-tech” case that buttresses the First Amendment rights of EA and other such manufacturers is the Supreme Court’s decision in *Brown v. Entertainment Merchants Association*,³³⁴ which addressed the state of California’s attempt to restrict access of certain videogames to minors and imposed civil penalties for violators.³³⁵ This case does not involve a right of publicity issue, but rather a restriction on sales of videogames deemed too violent for children.³³⁶ However, the court’s strong affirmation of First Amendment rights does show a continued sympathy for the application of those rights to for-profit enterprises.³³⁷ The court held first that video games remain on the same constitutional plateau as more traditional media, such as books, plays, and movies, and therefore, refused to presume that because it is a “new category” of speech it would be unprotected based on its violent content that appeals to children.³³⁸ Thus, the court applied the strict scrutiny test, concluding that the regulation was constitutionally defective as both “underinclusive” and “overinclusive.”³³⁹

The ruling in *Brown* presumes that new technologies are a part of the same First Amendment club as traditional ones and strengthens the view that

334. 131 S. Ct. 2729 (2011).

335. The provision, CAL. CIV. CODE §§1746 - 1746.5 (West 2006) (prohibited the sale or rental of “violent video games” to minors, and required their packaging to be labeled “18.” The Act covered games “in which the range of options available to a player includes killing, maiming, dismembering, or sexually assaulting an image of a human being, if those acts are depicted” in a manner that “[a] reasonable person, considering the game as a whole, would find appeals to a deviant or morbid interest of minors,” that is “patently offensive to prevailing standards in the community as to what is suitable for minors,” and that “causes the game, as a whole, to lack serious literary, artistic, political, or scientific value for minors.” §1746(d)(1)(A). Violation of the Act is punishable by a civil fine of up to \$1,000. §1746.3. See *Brown*, 131 S. Ct. 2729.

336. See *Brown*, 131 S. Ct. at 2732.

337. As Justice Scalia, writing for the majority, stated: “Like the protected books, plays, and movies that preceded them, video games communicate ideas—and 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).” *Id.* at 2733. This case follows on recent decisions, such as *U.S. v. Stevens*, 559 U.S. 460, 130 S.Ct. 1577 (2010) (statute criminalizing commercial creation, sale, or possession of certain depictions of animal cruelty held unconstitutional); *U.S. v. Playboy Entertainment Group*, 529 U.S. 803 (2000) (court ruled unconstitutional as overbroad statute requiring cable television operators providing channels “primarily dedicated to sexually-oriented programming” either to “fully scramble or otherwise fully block” those channels or to limit their transmission to hours when children are unlikely to be viewing, set by administrative regulation as between 10 p.m. and 6 a.m.).

338. See *Brown*, 131 S. Ct. at 2731.

339. *Id.* at 2740 - 41. The Court concluded the regulation “underinclusive,” as it singles out video games for disparate treatment, noting that more traditional media also displayed violent content aimed at children (such as Saturday morning cartoons). It held it was “overinclusive,” as it forbids the purchasing of violent video games by the children of many parents who do not disapprove of them doing so.

content-based regulations, even though legislated with the best of intentions, are subject to severe constitutional constraints.³⁴⁰ Coming at the time of the *Hart* and *Keller* cases, it creates a stronger presumption that a test involving content-based speech, even for indirect commercial gain (sale of the games), is not subject to a lesser standard of review.³⁴¹ *Brown* implies that unless direct or sole commercial purpose can be determined, the speech is subject to the highest level of protection.³⁴²

3. Malice, Commercial Speech and Right of Publicity

As discussed above, a requirement of actual malice is now included in a libel, slander, or false light privacy cause of action involving plaintiffs who are “public figures.”³⁴³ A few appellate cases discussed the possibility of applying a malice-based approach in right of publicity cases.³⁴⁴ Although the idea did not gain traction by other courts and was since discarded by that very court (due in large part to a change in the state’s right of publicity statute), it is worth discussing as a possible basis for a constitutional standard for right of publicity.

The primary case that considered applying such a test was *Eastwood v. Superior Court* (also known as “Eastwood I”).³⁴⁵ In *Eastwood I*, the *Enquirer* published an article alleging that Eastwood was romantically involved with two female celebrities.³⁴⁶ The headline and a photograph of Eastwood were then used in television advertising as a way to entice the public to buy that issue of the magazine.³⁴⁷ Despite concluding that the

340. See generally *Brown*, 131 S. Ct. 2729.

341. Note that *Stevens*, involved a statute that banned selling materials “depicting” the killing of animals for commercial gain and yet, the court also applied a strict scrutiny test. As the court stated:

The First Amendment’s guarantee of free speech does not extend only to categories of speech that survive an ad hoc balancing of relative social costs and benefits. The First Amendment itself reflects a judgment by the American people that the benefits of its restrictions on the Government outweigh the costs. Our Constitution forecloses any attempt to revise that judgment simply on the basis that some speech is not worth it.

Stevens, 559 U.S. at 470.

342. See *Brown*, 131 S. Ct. at 2747.

343. See *New York Times*, 376 U.S. at 279; see also, *AP v. Walker*, 389 U.S. 28 (1967); and *Time*, 385 U.S. 374.

344. See, e.g., *Hoffman*, 255 F.3d 1180.

345. 149 Cal.App.3d 409, 198 Cal.Rptr. 342 (1983). *Eastwood II*, 123 F.3d 1249 (9th Cir. 1997).

346. See *Eastwood I*, 149 Cal.App.3d at 414.

347. *Id.* at 415. The story run by the *Enquirer* entitled “*Clint Eastwood in Love Triangle With Tanya Tucker*,” alleged that the actor was romantically involved with both Tonya Tucker and Sondra Locke. The story was accompanied by a photograph of Mr. Eastwood. The headline and the photograph were also used in television advertising for the tabloid. See *id.* at 425.

piece was not defamatory, the court did find an alleged right of publicity claim was made, since the Enquirer commercially exploited his name, photograph, and likeness under both the common law and statutory law.³⁴⁸

Furthermore, in making this conclusion, the court rejected the statutory “news and public affairs” defense found in California’s right of publicity law.³⁴⁹ Although the use of a “newsworthy” photograph in an advertisement is similar to the *Namath* case, noted earlier,³⁵⁰ the California court rejected that statutory defense because the interview was a fabrication and, while not defamatory in a literal sense, it was, in a sense, a fraud or a “subterfuge” to sell more newspapers. Eastwood’s precedential value has been diminished because California’s right of publicity statute was expanded after the ruling was decided.³⁵¹

Since *Eastwood*, the Ninth Circuit has become a focal point for discussion regarding the relationship of right of publicity, commercial speech, and the applicability of malice as a counterweight to a First Amendment defense.³⁵² This was first, and most famously, explored in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, the Three Stooges t-shirt case.³⁵³ There, the Ninth Circuit went one step further than the state court in *Eastwood*, when it noted that, despite finding a viable claim in the case, “[g]iving broad scope to the right of publicity has the potential of allowing a celebrity to accomplish through the vigorous exercise of that right the censorship of unflattering commentary that cannot be constitutionally accomplished through defamation actions.”³⁵⁴

Accordingly, we do not believe that the Legislature intended to provide an exemption from liability for a knowing or reckless falsehood under the canopy of ‘news.’ We therefore hold that Civil Code section 3344, subdivision (d), as it pertains to news, does not provide an exemption for a knowing or reckless falsehood.

Id.

348. *Id.* at 420.

349. See CAL. CIVIL LAW § 3344(d), which provides that “[for] purposes of this section, a use of a name, photograph or likeness in connection with any news . . . shall not constitute a use for purposes of advertising or solicitation.” *Id.* The defense is similar to that of the Restatement (Third) of Unfair Competition, § 47 (“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.”).

350. See *Namath*, 48 A.D.2d 487, 371 N.Y.S.2d 10 (1st Dept. 1975).

351. See CAL. CIVIL LAW § 3344 (amended in 1984), which expanded the scope from the name of and likeness in advertising to uses “on or in products.”

352. Presently, the *Eastwood I* case has been cited 965 times. See *Eastwood v. Superior Court*, WESTLAWNEXT, <https://a.next.westlaw.com/Search/Home.html?transitionType=Default&contextData=%28sc.Default%29> (last visited Sept. 2, 2014). For specific examples, see *infra* notes 353-356 and accompanying text.

353. See *Comedy III*, 25 Cal.4th 387.

354. *Id.* at 398.

The idea of an interplay between malice, the First Amendment, and the right of publicity was addressed in both *Hoffman v. Capital Cities/ABC*³⁵⁵ and *Stewart v. Rolling Stone*.³⁵⁶ In *Hoffman*, a local magazine published an issue which used computer technology to alter famous film portraits.³⁵⁷ Among others was a still from a film where actor Dustin Hoffman portrayed a woman, the magazine altered his attire to show a different outfit accompanied by the text: “Dustin Hoffman isn’t a drag in a butter-colored silk gown by Richard Tyler and Ralph Lauren heels.”³⁵⁸ Needless to say, the magazine did not ask Hoffman or the copyright holder, Columbia Pictures, for permission to publish the altered photograph. Thus, Hoffman commenced the action, alleging violation of the right of publicity and portions of the Lanham Act.

The Ninth Circuit rejected Hoffman’s claim, concluding that although the speech in question contained some commercial elements, it was not commercial speech and therefore entitled to a high standard of First Amendment protection.³⁵⁹ In addressing whether the altered image was “falsified,” so that actual malice could be determined, the court applied the defamation law standard and concluded that there was no clear and convincing evidence that the publication altered the image with actual malice.³⁶⁰ Recently, a California state appellate court echoed this view in *Stewart v. Rolling Stone*.³⁶¹ This case involved a right of publicity challenge to the use of the singer’s name for a special magazine section on

355. 255 F.3d 1180 (9th Cir. 2001).

356. 181 Cal.App.4th 664 (Ct. App., 2010).

357. See *Hoffman*, 255 F.3d at 1183.

358. *Id.* at 1188. Los Angeles Magazine (“LAM”) published what it called the “Fabulous Hollywood Issue!” An article from this issue entitled “Grand Illusions” used computer technology to alter famous film stills to make it appear that the actors were wearing Spring 1997 fashions. The sixteen familiar scenes also included movies and actors such as “North by Northwest” (Cary Grant), “Saturday Night Fever” (John Travolta), “Rear Window” (Grace Kelly and Jimmy Stewart), “Gone with the Wind” (Vivian Leigh and Hattie McDaniel), “Jailhouse Rock” (Elvis Presley), “The Seven Year Itch” (Marilyn Monroe), “Thelma and Louise” (Susan Sarandon and Geena Davis), and even “The Creature from the Black Lagoon” (with the Creature in Nike shoes). The final shot was the “Tootsie” still.

359. The decision noted: that the magazine

did not use Hoffman’s image in a traditional advertisement printed merely for the purpose of selling a particular product . . . did not receive any consideration from the designers for featuring their clothing in the fashion article, containing the altered movie stills . . . Nor did the article simply advance a commercial message . . . Viewed in context, the article as a whole is a combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors. Any commercial aspects are ‘inextricably entwined’ with expressive elements, and so they cannot be separated out “from the fully protected whole.

Id. at 1185-86. In so ruling, the panel reversed the lower court, which, rather inexplicably, concluded that since the speech was commercial, it was not protected (for right of publicity purposes) under the First Amendment. *Id.* at 1184.

360. *Id.* at 1188.

361. *Stewart*, 181 Cal.App.4th 664.

“independent music performers.”³⁶² A portion of the section contained advertising, while the rest displayed editorial content.³⁶³ Yet, the court concluded that the content was not commercial and should be protected under California’s anti-SLAPP statute, not under the statutory right of publicity law.³⁶⁴

Applying the malice standard without determining whether the use was commercial or not, puts the cart before the horse. Malice has a particularized meaning in defamation law that differs from the common-law definition of the term³⁶⁵ and has been criticized by some courts in defamation cases.³⁶⁶ Because of the practical difficulty in applying actual malice (in large part, because juries may have trouble understanding exactly what it entails), taking the term literally into a right of publicity standard would be a mistake. Also, it deflects from the core issue—whether the speech is commercial or not. As will be shown later, a form of malice (or, as I will name it, “bad faith”) could be utilized in a right of publicity test, but it would be only applied in limited circumstances.³⁶⁷

V. THE NEW RIGHT OF PUBLICITY TEST

A. *The Speech Must be Commercial*

As it stands now, the right of publicity based on the application of the transformative test in *Hart* and *Keller/NCAA* is both overbroad and subjective, and using it as a standard means that property rights based on a “realistic” use trample on the First Amendment. The other tests, noted

362. *Id.* at 671.

363. *Id.*

364. *Id.* at 677.

365. *See Cantrell v. Forest City Publ’g Co.*, 419 U.S. 245, 253 (1974). Actual malice

is quite different from the common-law standard of ‘malice’ generally required under state tort law to support an award of punitive damages [C]ommon-law malice—frequently expressed in terms of either personal ill will toward the plaintiff or reckless or wanton disregard of the plaintiff’s rights—would focus on the defendant’s attitude toward the plaintiff’s privacy, not toward the truth or falsity of the material published.

Id.; *see also* *Masson v. New Yorker Magazine, Inc.*, 501 U.S. 496, 510 (1991) (“Actual malice under the *New York Times* standard should not be confused with the concept of malice as an evil intent or a motive arising from spite or ill will.”), cited in n. 17 *Jesse L. Jenike-Godshalk*, “ACTUAL MALICE” IS NOTE ACTUALLY MALICE: CLARIFYING AND SOLVING ONE OF THE SUPREME COURT’S ENDURING PARADOXES, <http://www.dinsmore.com/files/Uploads/Documents/Actual%20Malice%20is%20not%20Actually%20Malice.pdf> (available at January 25, 2014).

366. *See Masson*, 501 U.S. at 511. *See also* *Harte-Hanks Communications, Inc. v. Connaughton*, 491 U.S. 657 (1989).

367. *See infra* Part V.B.

earlier, also contain pose weaknesses.³⁶⁸ The results of such right of publicity jurisprudence have reduced First Amendment rights. Right of publicity doctrine has applied to a gambit of activities, far afield from a traditional advertisement-based tort (later property) right. I hoped that *Hart* and *Keller* would reach the opposite result, thus increasing the likelihood of Supreme Court review. Even though the rulings are substantially similar, one day the high court will have to put its imprimatur into this hodgepodge of cases, statutes, and standards.

The Supreme Court (or a unified body of lower courts), should bite the bullet, and side with free speech, brushing aside the compelling fairness argument for the college athletes. Borrowing heavily from the Restatement, Commercial Speech doctrine and a vigorous First Amendment jurisprudence, I propose a more constitutionally-centered standard, just as the court did for defamation and false light privacy a half century ago. To do this, the court should utilize a commercial speech standard as a prerequisite for a right of publicity claim. In cases of hybrid” commercial and non-commercial speech issues, a limited exception based on proving “bad faith” should also be created.

In order to make a prime facie case for a right of publicity violation, a plaintiff must prove that the use must be for a “sole commercial purpose.” A succinct definition of what is commercial is found in the California Supreme Court’s opinion in *Kasky v. Nike*:

In typical commercial speech cases, the speaker is likely to be someone engaged in commerce—that is, generally, the production, distribution, or sale of goods or services—or someone acting on behalf of a person so engaged, and the intended audience is likely to be actual or potential buyers or customers of the speaker’s goods or services, or persons acting for actual or potential buyers or customers, . . .³⁶⁹

This echoes the language of comment c of the Restatement of Unfair Competition, as noted earlier, which, except for commercial purposes, “presume[s] that a work which incorporates one’s name, image, likeness, sound or other unique characteristics be constitutionally protected, whether it be a literacy depiction, film, artwork or computer game.”³⁷⁰ Court have used variants of this definition, such as in *Bolger v. Youngs Drugs Products* (speech proposing a commercial transaction),³⁷¹ and *Central Hudson*

368. See *supra* Part II.C.4.

369. 27 Cal. 4th 939, 960 (2002).

370. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. c.

371. See 463 U.S. 60 (1975). In *Bolger*, the court defined commercial speech as speech “proposing a commercial transaction.” *Virginia Pharmacy* cited this definition. It’s interesting to note

(expression related solely to the economic interests of the speaker and its audience).³⁷² While there are subtle differences in scope between these two definitions, and a unitary definition of commercial speech would be ideal, courts have frequently cited the *Bolger* definition and it seems to have developed more legal traction.³⁷³

So, if one's name, voice, and likeness, is used in a sole commercial setting, such as proposing a commercial transaction, then the person has a viable claim for violation of the right of publicity. A court could look to several factors to make a determination of "sole commercial purpose." Is the depiction found on a product of mass-market production? Does the depiction directly aid in sales of the product? Is there any written statement by the person in question, which advocates buying the product? How familiar is the person to the public or segments of the public that would likely buy the product? Is the product a widget, real estate or a service likely to be bought or sold? Is the image used in an advertisement for the product, in effect creating an invitation to negotiate? How literal is the image—is it recognizable to the public? Looking into these factors, it is worth keeping in mind a comment by the court in *Friedman v. Rogers*: "by definition, commercial speech is linked inextricably to commercial activity."³⁷⁴

In looking for a sole commercial purpose, the issue of how much "transformation" the image possesses is now less important. In fact, the transformative test is no longer needed. It is, instead, the intent of the purveyor that becomes paramount and not the artistry of the use. Even if the image on the product is stylized, it still can be commercial to determine a right of publicity claim. The key would be public recognition or confusion

that the court has not addressed the question of expanding this definition. The California Supreme Court made an attempt to do so in *Nike v. Kasky*, when it applied commercial speech to speech by one "engaged in commerce," to an "intended audience" of "potential . . . customers likely to influence actual or potential customers that conveys factual information about itself "likely to influence consumers in their commercial decisions." See 27 Cal. 4th at 960.

372. See 447 U.S. at 561.

373. See *U.S. v. United Foods, Inc.*, 533 U.S. 405, 409 (2001) ("Commercial speech, usually defined as speech that does no more than propose a commercial transaction . . ."); *Edenfield v. Fane*, 507 U.S. 761, 767 (1993) (Commercial speech . . . is "linked inextricably" with the commercial arrangement that it proposes (citing *Friedman v. Rogers*, 440 U.S. 1, 10, n. 9 (1979)); *Bd. of Trustees v. Fox*, 492 U.S. 469, 473–74 (1989) (rejecting the argument that "pure speech and commercial speech are 'inextricably intertwined,' and that the entirety must therefore be classified as noncommercial). See also, Thomas C. Goldstein, *Nike v. Kasky and the Definition of "Commercial Speech,"* CATO SUPREME COURT REVIEW 2003, <http://www.cato.org/pubs/scr2003/commercialspeech.pdf> (August 14, 2013). A recent Seventh Circuit ruling utilized a somewhat more expanded definition, to include speech that contains both commercial and noncommercial elements, noting that the "relevant considerations include 'whether: (1) the speech is an advertisement; (2) the speech refers to a specific product; and (3) the speaker has an economic motivation for the speech.'" See *Jordan*, 743 F.3d 509. The court noted that "*Bolger* strongly implied that all are not necessary." *Id.* at 517.

374. 440 U.S. 1, 10 (1979).

of the image and the person. In other words, a jury question rather than a legal question.

Applying this standard to the cases before us, if Hart's and Keller's images were used without their permission on a box of Wheaties, there would be no doubt it would constitute sole commercial purpose. Wheaties is a mass-market breakfast cereal and the images on the box are used to help sell the cereal as the "breakfast of champions." However, if the depictions were used in a painting by an artist showing the grittiness of college athletes, there would be no cause of action, because the speech is not solely commercial and may not be commercial at all. The painting is a work of art, even if sold as an investment. Thus, it does not matter if there is a literal depiction or not. If a photograph of either Hart or Keller were used to show the elation of winning a championship game, and that image was later used as a promo for ESPN to watch college sports, the use would still not constitute sole commercial purpose.

Continuing in this line of thought, Hart and Keller's images and numbers, if used as one of many players on a computer game with avatars, would be also protected. Even if the videogame contained a literal depiction of them with little method of alteration, the conclusion would remain the same—no cause of action.

Despite the newer technology of video gaming, older traditions should remain. When you take the gloss off the bells and whistles of the EA games, they are digital docudramas—taking true events, with true characters, and creating an environment based on a computer version of literary license. It is a form of "based on a true story" in the digital era. So, if there is a direct advertisement/sales usage of the person's image, then the plaintiff can have a right of publicity cause of action based on the sole commercial use; the balance favors that person and trumps First Amendment rights. Far from conflicting with right of publicity laws, this standard dovetails them. For example, California requires a plaintiff to show whether there was "knowing" use of the plaintiff's identity for advertising purposes and a direct connection between the use and the commercial purpose.³⁷⁵ New York's law, generally more restrictive, requires the use of a person's identity within New York State for advertising or trade purposes, and without written consent.³⁷⁶

The right of publicity is not a fundamental constitutional right, while freedom of expression is.³⁷⁷ A case that illustrates the point is *Guglielmi v. Spelling-Goldberg Productions*.³⁷⁸ A relative of the great silent film actor

375. See *Newcombe v. Adolf Coors Co.*, 157 F.3d 686, 692 (9th Cir. 1998).

376. See N.Y. CIV. RIGHTS LAW §§ 50-51 (West 2009).

377. See *Comedy III*, 25 Cal. 4th at 391.

378. 25 Cal.3d 860 (1979).

Rudolf Valentino brought a right of publicity action for an alleged depiction in a TV film.³⁷⁹ It was a docudrama, in the classic sense, but analogous to the products found in *Hart* and *Keller* because the film was a “fictionalized version of Rudolph Valentino’s life.”³⁸⁰

In a pre-transformative, pre-*Rogers*, even pre-*Restatement* era, the court soundly rejected the publicity claims, under both California law and Federal Constitutional law.³⁸¹ Whether the film was “fictional” or “factual” had no basis in the court’s determination—it was expression for entertainment purposes, which is entitled to just as much protection as a factual documentary.³⁸² Applying this to *Hart* and *Keller*, the ability to watch the avatars, call plays, and alter their images, does not diminish the protection in any way. Also, in *Guglielmi*, the utilization of Valentino’s name and image to advertise or publicize the film did not make the use commercially “enhance the value” of the film. It was simply not relevant.³⁸³

Using the images of Hart and Keller to enhance the authenticity of the EA games is the same as utilizing Valentino’s name in the above example. In fact, it is a less compelling issue here, because the film centered on the Valentino character; the EA games did not center on an individual player, but in constructing teams of avatars who had some connection with the real players.³⁸⁴ However, that connection is more tenuous because only the images, uniforms, team logos, and numbers are used, but not the names.³⁸⁵ And unlike a replica of a specific event, like a football game (or a human cannonball in *Zacchini*), the game is interactive, a somewhat fictionalized account of the players’ activities.³⁸⁶ The “performance” is not lifted from an actual, live event. It is a part of an imaginative experience that can be, in large part, constructed by the user. In other words, the players are conduits for the electronic game, rather than the other way around.

Those who argue in favor of Hart and Keller’s publicity rights may say the predominant purpose of the game is to utilize player images to sell the game. I say, so what? Of course, it is. But the predominant purpose of

379. The case involved a “fictionalized version” of Valentino’s life, in a television film, without consent from his legal heir. On November 23, 1975, the film was broadcast on ABC. The film, entitled “Legend of Valentino: A Romantic Fiction,” which was, according to the appellant, ‘a work of fiction about the life and loves of an Italian actor who became Hollywood’s first romantic screen star and who died at the height of his fame.’ Appellant also alleged that respondents used Valentino’s name, likeness and personality in advertising the film “to solicit and to sell commercial sponsorship . . . and to solicit viewers for the exhibition of [the] film.” *Id.* at 862.

380. *Guglielmi v. Spelling-Goldberg Productions*, 25 Cal.3d at 861 (1979).

381. *See generally id.* at 860.

382. *Id.*

383. *Id.* at 869.

384. *See supra* Part III.A.

385. *Guglielmi*, 25 Cal.3d at 869.

386. *Id.*

making the Valentino movie (or many creations in our capitalist system) is also to make a buck. There have been unauthorized biopics that were based on the lives of famous and not-so-famous people. *The Social Network*, which involved a fictionalized account of the rise of Facebook, did not seek or obtain permission from Mark Zuckerberg to use his name or image³⁸⁷ and this depiction is protected by the First Amendment. In *Ruffin-Steinback v. De Passe*,³⁸⁸ the court rejected a right of publicity challenge to a network television docudrama about the 1960s and 1970s vocal group “The Temptations,” citing the commercially-based requirements of the Restatement sections 46 and 47, and therefore, concluding that the case did not arise from an attempt to promote or endorse a product, *per se*, but from defendants’ [somewhat fictionalized] depiction of the life-stories of these people as part of the story of the Temptations.”³⁸⁹ The court ruled that “depicting one’s life-story without his or her permission, particularly where some of the events are fictionalized,” does not constitute a violation of the right of publicity under Michigan law.³⁹⁰ Pointedly, the court rejected plaintiffs’ argument that the promotion and marketing of the docudrama on television and videocassette does not constitute a cause of action for the right of publicity.³⁹¹ In *Seale v. Gramercy Pictures*,³⁹² the court came to a similar conclusion, dismissing the claim of a former member of the Black Panthers that defendants used his name and likeness (through an actor) without permission in a film, pictorial history book.³⁹³ However, it maintained a cause of action for use of his image on the cover of the musical CD/cassette.³⁹⁴ While it is true that these cases involved public figures, the court rightly focused on the question of whether the use was commercial.

387. The film, based on a book titled *Accidental Billionaires—The Founding of Facebook: A Tale of Sex, Money, Genius and Betrayal*, by Ben Mezrich, was not sanctioned by Zuckerberg. The scriptwriter, Aaron Sorkin, had no access to Zuckerberg and he admitted that certain parts of the film were fictionalized. See Mark A. Fischer and Franklin H. Levy, *Privacy Rights and Celebrities: Truth, Fiction and Biopics*, http://www.duanemorris.com/articles/privacy_rights_celebrities_truth_fiction_biopics_3921.html (last visited January 21, 2014).

388. 82 F. Supp. 2d 723 (E.D. Mich., 2001), *aff’d*, 267 F.3d 457 (6th Cir. 2001). The appeals court’s discussion on the right of publicity was more cursory.

389. *Ruffin-Steinback*, 82 F. Supp. 2d at 729-730.

390. *Id.* at 729.

391. *Id.* at 731.

392. 949 F. Supp. 331 (E.D. Pa. 1996).

393. *Id.* at 334.

394. *Seale*, 949 F. Supp. at 337-39. The opinion noted:

The Defendants’ use of the Plaintiff’s name and likeness was for the purpose of First Amendment expression: the creation, production, and promotion of a motion picture and history book which integrates fictitious people and events with the historical people and events surrounding the emergence of the Black Panther Party in the late 1960’s. The Defendants’ use of the Plaintiff’s name and likeness on the cover of the pictorial history book and on the cover for the home video are clearly related to the content of the book and the film,

Turning back to Hart and Keller, are their depictions really that different from those of more famous people in television biographies or docudramas? Rather, are they transported to a fictional world of interactive football and a part of a creative process where they may be familiar to viewers, yet not construed as commercial salesman for the product? And, given the California district court's recent *O'Bannon* ruling, which specifically rejected commercial speech status to actual game broadcasts, it would be a real stretch to consider a video game based on a college football teams and players, to be "solely commercial."³⁹⁵

The commercial v. non-commercial distinction leads to the constitutionalization of the right of publicity for any depiction of an individual that is not a sole commercial purpose. The rule centers around a red-line standard: If the speech is beyond the contours of restrictive standards of Restatement sections 46 and 47, there would be First Amendment immunity when one's name and likeness is used, and no cause of action for right of publicity could be pursued. This is not as harsh as it may sound. Like the conditional immunity for defamation and the more recent and broader immunity granted to Internet Service Providers ("ISPs") under section 230 of the 1998 Communications Decency Act,³⁹⁶ an immunity from publicity claims does not prevent a party from claiming privacy violations (based on intrusion, embarrassing private facts or "false light") or defamation (outside of the scope of section 230). Although "false light" cases tend to be infrequent and difficult to prove,³⁹⁷ non-public figures could have valid causes of action. So, if the images depicted Keller and Hart (based on team and number) as thugs, cheap-shot artists, incompetent fools, or buffoons, they retain rights to sue in tort. Additionally, this immunity would not prohibit a cause of action for the tort of infliction of emotional distress.

the subject matter of which deals with the Black Panther Party and the Plaintiff's role as co-founder of the Party. . . .

Id. at 337. However, Plaintiff has raised a genuine issue of material fact showing that the Defendants' use of the Plaintiff's name and likeness (use of an actor called Bobby Seale in the film) on the cover of the musical CD/cassette was "for the purposes of trade" or for a "commercial purpose" since the CD/cassette consists of various songs composed by different musicians.

395. See *supra* note 246 and accompanying text.

396. See Communications Decency Act, 47 U.S.C. § 230 (c)(1) (provides that neither a provider nor a servicer of an interactive computer service shall be treated as a publisher or speaker of content provided by a third party. With regard to content, including that which may be considered obscene, lewd, lascivious, filthy, excessively violent, harassing, or otherwise objectionable, section (c)(2) confers upon the provider or user of an interactive computer service immunity from liability as distributors.). See *Perfect 10 v. CCBill*, 488 F. 3d 1102 (9th Cir. 2007).

397. See *Time*, 385 U.S. 374. (The court held that the constitutional protections for speech and press precluded the application of a New York statute that provided redress for false reports where the reports involved "matters of public interest in the absence of proof that the defendant published the report with knowledge of its falsity or in reckless disregard of the truth.").

This immunity would avoid the need to determine whether the strict or intermediate scrutiny applies, as each employs a different standard of review.³⁹⁸ This is not an academic issue because *Central Hudson* is a form of intermediate scrutiny standard, and some justices have advocated invalidating the test and adopting a full strict scrutiny test for content-based commercial speech.³⁹⁹ The question has divided scholars, as some have argued that right of publicity cases should be subject to a strict scrutiny test in any event,⁴⁰⁰ while others have advocated a content-neutral standard.⁴⁰¹

Without this proposed constitutional immunity, consider the following scenario. If the Supreme Court invalidates *Central Hudson* and decides to treat commercial speech regulation with the same or similar strict scrutiny standard found in political and other expressive speech, it could force the question of whether right of publicity cases for sole commercial uses would be subject to strict scrutiny. If so, then the test would not be based on the intermediate *O'Brien* standard.⁴⁰² So, if the speech would be deemed content-based, then strict scrutiny would clearly make the plaintiff's burden far more difficult. It would be difficult to speculate as to the compelling nature of the property interest and if strict scrutiny becomes a standard for commercial speech, that would, admittedly, severely restrict the rights of plaintiffs. The proposed immunity avoids this kind of testing and simply creates the de facto protection for non-commercial use of a name or likeness.

Courts could carve out a doctrine where right of publicity would be based on the deference given to protected works under the copyright law. However, this is problematic since copyright is statutory based and has particularized exceptions built in for "fair use," which is an affirmative

398. See *supra* note 199.

399. See *Lorillard v. Reilly*, 533 U.S. 525 (2001) (Thomas, J., concurring).

I continue to believe that when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in question may be characterized as 'commercial.' I would subject all of the advertising restrictions to strict scrutiny and would hold that they violate the First Amendment.

Id. at 572.

400. See, e.g., F. Jay Dougherty, *All the World's Not a Stooge: The "Transformativeness" Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 COLUM. J.L. & ARTS 1 (2003); Eugene Volokh, *Freedom of Speech, Permissible Tailoring and Transcending Strict Scrutiny*, 144 U. PA. L. REV. 2417, 59 (1996); Diane Leenheer Zimmerman, *Fitting Publicity Rights Into Intellectual Property and Free Speech Theory: Sam, You Made the Pants Too Long!*, 10 DEPAUL-LCA J. ART & ENT. L. & POL'Y 283, 293 (2000).

401. See Rebecca Kwok, Comment, *Cardtoons v. Major League Baseball Player Association: Fair Use or Foul Play?*, 5 UCLA ENT. L. REV. 315 (1998).

402. See *O'Brien*, 391 U.S. 367 (for non-content restrictions on speech, the government has to show a sufficiently important or substantial interest that is not more restrictive than necessary to accomplish the result).

defense, rather than an immunity proposed here.⁴⁰³ Another potential solution would treat right of publicity like defamation, requiring a plaintiff to show “malice” as a part of the commercial use. However, as stated earlier, the definitional problems of *New York Times* constitutional malice versus common-law malice, could result in more confusion, not less.⁴⁰⁴ As defined in *New York Times*, actual malice (in defamation cases) requires the plaintiff to prove that a defendant make the false statement with knowledge of falsity or a reckless disregard for the truth.⁴⁰⁵ In a right of publicity case, that would be all too easy to show. If a company wishes to utilize a person’s name, likeness, or identity for commercial purposes, it is not difficult to infer the company’s knowledge and intent that it will be used for that purpose. In fact, that is precisely why the image would be created. Not only would it be far less burdensome than showing malice in a defamation or false light claim, it would be fairly easy to demonstrate considering the facts and circumstances of these cases. What may be a form of bad faith in defamation cases becomes a business plan in a right of publicity case. Yet, the idea of creating a presumptive protection for a certain category of speech has its appeal and the “sole commercial purpose” has a similar logic.

Although the immunity standard applying to speech not solely commercial exempts a cause of action where the expression is a hybrid situation—containing commercial and non-commercial elements—at best (from the point of view of plaintiffs) the situation in *Hart and Keller*—there is a need for a very limited exception to the immunity, based on “bad faith” actions by a defendant.

B. An Exception: Right of Publicity Claims Under a “Bad Faith” Corollary

Advocates for an expanded right of publicity standard would legitimately point out that under the sole commercial purpose standard, a party could craft a non-commercial use as a subterfuge to evade a right of publicity action. Consider the following two examples:

Wheaties licenses a work of art that is a computer-based avatar of someone with has features of Tiger Woods (recognizable, but not a literal depiction) created by a noted computer graphics artist. The use of the avatar would be a part of a new campaign to “modernize” the image of the cereal after a marketing consultant said that these new type of image would sell

403. See 17 U.S.C. § 107; *Eldrid v. Ashcroft*, 537 U.S. 186, 221 (2003) (discussing how fair use accommodates First Amendment principles). See generally, Bauer, *supra* note 260.

404. See *New York Times*, 376 U.S. at 279 (1964) (defining “actual malice” as knowledge that the speech was false or “with reckless disregard of whether it was false or not.”). See also, *Eastwood I* and *Eastwood II*, and *Hoffman*, 255 F. 3d 1180.

405. See *New York Times*, 376 U.S. at 279.

more of the product than the more traditional “realist” pictures of the athletes used for generations. The image of Woods is clearly more “abstract” than the realistic image of the golf star that was the focus of the *ETW* case. As part of the license agreement, the computer artist can sell or license the painting and lithographs to museums, galleries, or directly to collectors and fans in partnership with General Mills (which paid a considerable sum for the artist to produce the work). General Mills would only have exclusive rights to use the image in a commercial setting. Suffice it to say that in this hypothetical Woods did not grant any permission or license and had no knowledge of this depiction.

The compensation scheme in this agreement is also novel. Wheaties would not pay the artist a flat rate, but it would be based on a percentage of gross revenues from sales (similar to what athletes can earn from “signature lines” of clothing). The success of this image adds to sales of Wheaties and to lithographs of the work. The partnership then decides to license the Woods avatar as a character in a children’s comic book (shades of *Doe v. TCI Cable*) or in a videogame. It decides to create posters of the Woods avatar (like in *ETW v. Jireh*)?

Woods, not surprisingly, files suit, claiming right of publicity violations. Under the proposed commercial-based constitutional standard, a court would need to first determine that the depiction was in fact that of Woods. Assuming it is, then the question would center on whether the sole commercial purpose standard applies to the depiction. Based on these facts, it would not—there are too many non-commercial elements. Therefore, it would receive immunity and Woods’ action would be dismissed.

However, let us now change the facts. It is discovered that both the artist and General Mills addressed the possibility of Woods suing and crafted the deal to include non-commercial elements to evade the sole commercial use standard and a resulting right of publicity action. The licensing agreements for the comic books or lithographs call for minimal payments to the artist. Internal documents show that this is primarily a “cereal deal.”

This kind of case involves bad faith conduct by the General Mills and the computer artist and would call for an exception to the immunity. Since we do not want to get into the intricacies and problems of defining “malice,” let’s call this exception the “bad faith corollary.” If the aggrieved party can demonstrate that the defendant intended to use the image for a commercial purpose, but created a non-commercial use to circumvent the rights of the person claiming the misappropriation, a right of publicity claim could proceed. Despite the seeming non-commercial use, a court would not apply First Amendment immunity because the commercial use was masqueraded. The standard of proof would be clear and convincing evidence, similar to

the standard for public figures in defamation cases.⁴⁰⁶ And, just as in defamation, the bad faith corollary would involve state of mind evidence to determine the intent of the parties.⁴⁰⁷ If there was evidence of piggybacking the commercial aspect by inserting independent creative elements to evade a right of publicity claim, the test could be met and a right of publicity action can successfully accrue.

The standard of proof for the bad faith corollary would be challenging due to the high level of proof (a “clear and convincing” standard could be used, as in defamation) and difficulty of finding such evidence in the first place. If this test was adopted, it can be reasonably assumed that no “bad faith” can be demonstrated by EA in the cases of *Hart* and *Keller/NCAA*, since there was no evidence that these depictions are directly commercial to begin with and no evidence of bad faith existed in the creation or marketing of the game to create expressive elements for the purpose of avoiding a right of publicity claim.⁴⁰⁸

Adopting this “sole commercial purpose” standard, coupled with the limited “bad faith” exception, would lead to a consistent solution: the parties would be barred from successfully claiming a right of publicity violation due to First Amendment immunity unless commercial purpose or bad faith could be demonstrated. And the adoption cannot come too soon. The trend toward expansive right of publicity rights has, in the period after *Keller/NCAA* and *Hart*, spawned lawsuits by former Panamanian dictator Manuel Noriega against the manufacturer of the popular videogame “Call of Duty – Black Ops II,” under California’s right of publicity statute⁴⁰⁹ and actress/singer Lindsay Lohan against the manufacturer of “Grand Theft Auto” in an action filed in New York. Both allege the unpermitted use of images of the dictator and the actress.⁴¹⁰ As a former public official

406. See *Harte-Hanks*, 491 U.S. at 681 (“Difference of opinion as to the truth of a matter—even a difference of 11 to 1—does not alone constitute clear and convincing evidence that the defendant acted with a knowledge of falsity or with a ‘high degree of awareness of . . . probable falsity.’” (citing *Garrison v. Louisiana*, 379 U.S. 64, 74 (1964))).

407. See *Herbert v. Lando*, 441 U.S. 153, 160 (1979).

It is also untenable to conclude from our cases that, although proof of the necessary state of mind could be in the form of objective circumstances from which the ultimate fact could be inferred, plaintiffs may not inquire directly from the defendants whether they knew or had reason to suspect that their damaging publication was in error.

Id.

408. See *supra* Part III.

409. See *Noriega v. Activision Blizzard, Inc.*, Los Angeles County Superior Court, Filed July 15, 2014, case no. BC 551747. The suit alleges that the defendants used the name and likeness of Noriega in the game for commercial use.

410. *Id.* See also Tom Huddleson, *Lindsay Lohan back in court: Actress sues makers of Grand Theft Auto V*, FORTUNE MAGAZINE (July 17, 2014), <http://fortune.com/2014/07/02/lindsay-lohan-lawsuit-grand-theft-auto/>. The suit, filed in New York County Supreme Court, alleges that the video game’s

(Noriega being the strongman of Panama in the 1980s, later jailed for murder) and Lohan a well-known celebrity, such actions would fit squarely into the kind of actions that game manufacturers fear under a relaxed right of publicity standard.

V. CONCLUSION

As one commentator stated, “In right of publicity cases . . . there are many quasi-commercial uses that fall somewhere in-between the non-commercial and commercial ends of the commercial advantage spectrum, like video games, trading cards, and fantasy leagues.”⁴¹¹ He adds, “[I]t is unfair and not good policy to allow the producer to reap the full commercial value of the celebrity’s identity.”⁴¹² That may be true and in the ideal world, as noted in the *O’Bannon* ruling, the parties would negotiate licensing agreements to detail the use and the compensation even if a First Amendment privilege exists.⁴¹³ However, the expansion of the publicity right to indirect or “quasi-commercial” uses through the myriad of tests noted in this article produced an inconsistent and constitutionally defective application of the right of publicity doctrine which has shortchanged First Amendment rights. Yet, I am not advocating elimination of the right of publicity. Individuals should retain the right to pursue damage claims for exploitation of their property rights. However, to avoid a chilling effect on the First Amendment, it is time to create a new sense of balance that limits one’s property rights to the situation in which they were intended: sole commercial purpose. Ranking constitutionally protected expressive rights over property rights is consistent with protections given to other forms of protected speech and a sole commercial purpose limitation on the right of publicity is the best way to achieve that goal.

“Lacey Jonas” character—portrayed in the game as a famous young actress who is trying to avoid paparazzi—on Lohan’s voice and likeness without the actress’ permission. The game includes one scene where the Jonas character tries to evade paparazzi staked outside of a hotel based on the Chateau Marmont in West Hollywood, which famously banned Lohan in real life after the actress racked up thousands of dollars in unpaid bills. In the game, the Jonas character attempts to explain to another character who she is and why she needs to escape, exclaiming: “I’m really famous. I didn’t do anything!” *Id.*; Complaint at 26-32, *Lohan v. Take-Two Interactive Software*, (2014) (No. 156443) (original unavailable).

411. See Karcher, *supra* note 273, at 585.

412. *Id.*

413. See *supra* note 247 and accompanying text.