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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

Jay Dougherty, *Loyola Law School - Los Angeles*



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**ALL THE WORLD'S NOT A STOOGES: THE "TRANSFORMATIVENESS" TEST FOR
ANALYZING A FIRST AMENDMENT DEFENSE TO A RIGHT OF PUBLICITY
CLAIM AGAINST DISTRIBUTION OF A WORK OF ART**

By F. Jay Dougherty

What is a picture? It is one of the ways of representing a person or thing. It attempts imitation, rather than description. Pictures antedated letters, and their use was probably one of the earliest methods of communicating thought and perpetuating events. Pantomime and pictures are intelligible to all people, while the same cannot be said of written or even spoken language...They impart information to those who cannot or will not read, and many times more rapidly and effectually than written description would do to those who can and will....When it can be used, the picture is a much more satisfactory method than the use of the alphabet alone, of conveying an understanding of material objects, animate and inanimate.¹

I. INTRODUCTION

It is V.J. Day in Times Square. A photographer sees a sailor running down the street, kissing every girl in sight. He snaps a photograph of the sailor kissing a nurse.² An essayist observes the same scene. He asks the sailor his name and writes a short description of the scene, including a highly detailed description of the sailor. An artist also observes the scene and, inspired by the events of the day, makes a simple, but extremely realistic, charcoal sketch of the sailor kissing the nurse. A popular magazine of the day publishes both the photograph and the essay. Decades later, the photographer offers to sell prints of the by now famous photograph to the public for more than a thousand dollars each. The essayist includes copies of his essay in a collection of post-war vignettes, which becomes a best seller. The artist, noting the growing interest in the era, sells thousands of lithographic prints of his sketch. The sailor sues all three of them for violating his right to control the commercial uses of his name and likeness, that is, his right of publicity.

¹ Atkinson v. John E. Doherty & Co., 80 N.W. 285, 288 (Mich. 1899).

² See *Alfred Eisenstaedt: Photojournalist of the Century*, THE DIGITAL JOURNALIST, Dec. 1999, at <http://digitaljournalist.org/issue9911/icon01.htm>.

The court would very likely dismiss the claim against the publisher of the essay, but the claims against the photographer and artist would probably not be dismissed and may ultimately be successful.³ All three works depict an individual without his consent and are exploited for the financial gain of the creator of the work. The law fairly clearly protects the essay as speech. By contrast, some courts would view the prints of the photograph and the lithographs of the sketch as commercial merchandise unprotected by the First Amendment. After a recent California Supreme Court decision, the prints and lithographs might be viewed as protected speech, if the photograph and the sketch are viewed as sufficiently “transformative.”⁴ This Article argues that all three works⁵ should be fully protected speech, insulated from claims by the person portrayed that the works violate his right of publicity.

The right of publicity is an exclusive right to control and derive revenue from the commercial use of one’s name, likeness, or other aspects of persona.⁶ The right was initially recognized as a type of privacy right—later called commercial appropriation privacy—infringed when a person’s likeness was used in advertising or on the packaging of a product otherwise unrelated to the person.⁷ In its early development it also reflected a concern with preventing consumer deception.⁸ Viewed in this way, the right was not very effective at providing a cause of action to celebrities when their persona was used without falsely suggesting an endorsement. This is because courts were skeptical of a famous person’s violation of privacy claims, since they lose much of that privacy by becoming famous.⁹ Furthermore, privacy rights were not descendible, so there was no claim with respect to image works of deceased individuals. Such limitations permitted courts to decide cases involving claims against image copies without reaching free speech issues.

³ See *Mendonsa v. Time, Inc.*, 678 F. Supp. 967 (D.R.I. 1988).

⁴ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001).

⁵ For purposes of this article, non-advertising works consisting of a visual image of a person will be called “image works” and copies of those works will be referred to as “image copies.” Products, other than copies of a visual image of a person that incorporate an element of persona will be referred to as “image merchandise.” Non-advertising literary, musical, and audiovisual works incorporating elements of persona will be referred to as “media works,” and copies of those works will be referred to as “media copies.”

⁶ See 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1.3 (2d ed. 2000). In this article, the term “persona” or “identity” will be used to designate those elements of identity protected by the right of publicity.

Exactly what those elements are is a matter of continued development by statute and case law. See *id.* §§ 4.9- 4.15.

⁷ *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905); see Melville Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 203 (1954).

⁸ See James M. Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV. 637, 647 (1973).

⁹ See Nimmer, *supra* note 7, at 204.

Yet association of a product with a celebrity can be valuable, even without a clear endorsement.¹⁰ In the 1950's a federal court acknowledged that, and gave a new label to the right to reflect that associative value as a form of property—the right of publicity.¹¹ Rather than viewing unauthorized use of persona as a violation of a person's privacy harmful to feelings or dignity, such a use was characterized as unjustly enriching the user,¹² who was characterized as a free rider¹³ who misappropriated the property of the persona claimant.¹⁴

As courts and legislatures recognized a right of publicity, privacy right limitations were no longer available to courts addressing claims against expressive works. Unlike the right of privacy, public figures retain publicity rights. The right of publicity, being considered a property right protecting commercial value of persona, can survive death. Hence, courts could not avoid free speech issues by applying those prior limitations. Because many uses of persona are in connection with the creation and dissemination of expressive works, the emerging view of the right of publicity as a property right exacerbated potential conflict between the right of publicity and freedom of speech.

Early cases advocating the commercial appropriation privacy right recognized a risk of conflict with freedom of expression.¹⁵ Those early decisions did not articulate approaches to analyzing that conflict, perhaps because many of the early cases involved an unauthorized use of persona in advertising, and because at that time advertising was not regarded as speech with much if any constitutional protection.¹⁶ Instead, they simply concluded that an advertisement contained no valuable speech and the right of privacy prevailed.¹⁷ For example, in *Pavesich*, the Georgia Supreme Court acknowledged the potential conflict between the right of privacy and liberty of speech. But because the challenged use was an advertisement, in which the court said

¹⁰ See Sheldon W. Halpern, *The Right of Publicity: Commercial Exploitation of the Associative Value of Personality*, 39 VAND. L. REV. 1199, 1246 (1986).

¹¹ *Haelen Labs., Inc. v. Topps Chewing Gum*, 202 F.2d 866 (2d Cir. 1953).

¹² *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

¹³ *Onassis v. Christian Dior-N.Y., Inc.*, 472 N.Y.S.2d 254, 261 (Sup. Ct. 1984), *aff'd without opinion*, 110 A.D.2d 1095 (App. Div. 1985).

¹⁴ Modern writers recognize the fuzziness of these distinctions and that a right of publicity claim may under some circumstances include damages for misappropriation of property value and for emotional harm. See, e.g., Roberta Rosenthal Kwall, *The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 69-74 (1994); 1 MCCARTHY, *supra* note 6, § 1:39, at 1-68.

¹⁵ See 2 MCCARTHY, *supra* note 6, § 8:45, at 8-66.

¹⁶ 2 RODNEY A. SMOLLA, SMOLLA AND NIMMER ON FREEDOM OF SPEECH § 20:1, at 20-22 (3d ed.1996). See generally Alex Kozinski & Stuart Banner, *The Anti-History and Pre-History of Commercial Speech*, 71 TEX. L. REV. 747 (1993).

there was “not the slightest semblance of an expression of an idea, a thought, or an opinion, within the meaning of the constitutional provision which guaranties to a person the right to publish his sentiments on any subject,”¹⁸ the privacy claim prevailed. Of course, since that time it has been recognized that advertising is protected speech,¹⁹ but it is worth observing that the first court to strongly speak out in favor of recognizing the right was seriously concerned with its potential to interfere with the expression of “sentiments.” It addressed that problem by categorically excluding advertising from protected speech.

The first statute recognizing the commercial appropriation privacy tort prohibited unauthorized use of a person’s name, portrait or picture for advertising use or for purposes of trade.²⁰ Many of the earliest cases in the United States asserting a right of commercial appropriation privacy involved unauthorized use of a person’s likeness in advertising for a product or service.²¹ Because news and entertainment media, art, photographs and other image copies are often disseminated for payment, one might take the position that they are within the prohibited “purpose of trade” uses. But early cases involving non-advertising uses by news and entertainment media defendants developed another categorical approach that had the effect of protecting First Amendment interests. Under that approach, if a use was newsworthy, that is, a use in connection with a matter of legitimate public interest, the court would consider it not to be

¹⁷ See, e.g., *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905).

¹⁸ *Id.* at 80.

¹⁹ *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748 (1976); see Alex Kozinski & Stuart Banner, *Who’s Afraid of Commercial Speech?*, 76 VA. L. REV. 627, 629 (1990).

²⁰ Act of Apr. 6, 1903, ch. 132, §§ 1-2, 1903 N.Y. Laws 308 (codified at N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 2002)). Other statutes prohibit use of persona on or in goods or products, CAL. CIV. CODE § 3344 (2002), or prohibit commercial uses. See, e.g., NEV. REV. STAT. § 597.770 (2002). The Nevada statute further defines “commercial use” to mean a use on or in products, merchandise, or goods, or a use for advertising, soliciting, or selling products, merchandise, goods, or services. *Id.*

²¹ 1 MCCARTHY, *supra* note 6, § 1:23, at 1-32; see e.g., *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905); *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442 (N.Y. 1902). There were a few early cases involving non-advertising uses. For example, *Manola v. Stevens* was an unreported 1890 case the *Pavesich* court described as the first U.S. case invoking the right of privacy as the basis for relief. The case involved an unauthorized photo of an actress, and it is not clear what was the intended use of the photograph that was enjoined. *Pavesich*, 50 S.E. at 74; see also *Schuyler v. Curtis*, 42 N.E. 22 (N.Y. 1895). The lower court decision in *Schuyler* was described by the *Pavesich* court as the first reported case expressly recognizing the right of privacy. A New York volunteer organization intended to create a sculpture of a deceased philanthropist and exhibit it at The Columbian Exposition of 1893. The lower court granted an injunction, but the New York Court of Appeals reversed, reasoning that whatever right of privacy Mrs. Schuyler had was terminated by her death. The court suggested that if she had been alive, she might have had a claim. *Id.* at 28. In *Corliss v. E.W. Walker Co.*, 64 F. 280 (C.C.D. Mass. 1894), the widow of one of the first American inventors attempted to enjoin the use of a photograph of Mr. Corliss in a biographical book. The court dissolved the injunction issued by the lower court. Although the decision suggests that a person has both a privacy right and a property right in his portrait, a “public man” such as Corliss surrenders

a use for purposes of trade. Subsequent state statutes often expressly exempt a use of persona “in connection with any news, public affairs, or sports broadcast or account, or any political campaign.”²²

Initially, newsworthiness was defined rather narrowly. The defense would apply where the use was wholly factual,²³ but not where the use was dramatized or fictionalized.²⁴ Thus a newsreel, newspaper article, or magazine using images of a person in connection with a story of legitimate public interest would ordinarily not be considered a use “for purposes of trade,” but a dramatized retelling of a factual story—what today would be called a “docudrama”—might be considered a use for purposes of trade, violating commercial appropriation privacy.²⁵

that right to the public. *Id.* at 282. Thus, at the time of those decisions, the right of publicity was subject to certain limitations that made it less necessary to directly consider potential conflict with freedom of expression.

²² CAL. CIV. CODE § 3344(d). Of the eighteen states that have passed commercial appropriation privacy/right of publicity statutes, eleven include an express statutory news media exception. *See* 1 MCCARTHY, *supra* note 6, § 6:8, at 6-18 (chart of state statutes).

²³ *Humiston v. Universal Film Mfg. Co.*, 178 N.Y.S. 752 (App. Div. 1919). A few early cases, however, found a violation for the use in a motion picture or book of a performance or likeness, even without fictionalization. *See, e.g., Hogan v. A.S. Barnes & Co.*, 114 U.S.P.Q. 314 (Pa. Com. Pl. 1957) (unauthorized use of name and photographs of professional golfer on cover and in body of book did not violate right of privacy but did constitute unfair competition and violate right of publicity, described as an “application” of unfair competition); *Redmond v. Columbia Pictures Corp.*, 14 N.E.2d 636 (N.Y. 1938) (unauthorized use and exhibition of motion picture footage of professional golfer’s “trick shots” violated New York right of privacy statute); *Blumenthal v. Picture Classics, Inc.*, 257 N.Y.S. 800 (App. Div. 1932) (short New York City travelogue using actors that included brief footage of street vendor violated street vendor’s rights under New York Civil Rights Law §§ 50-51), *aff’d* 185 N.E. 713 (N.Y. 1933).

²⁴ An early New York case found a motion picture company violated the New York right of privacy law when it produced an early docudrama, that is, a dramatic film based on factual events. *Binns v. Vitagraph Co. of Am.*, 103 N.E. 1108 (N.Y. 1913). The film dramatized the first use of then new telegraph technology to save the passengers on a sinking ship. It featured the name of the telegraph operator and an actor who portrayed him. The court stated that use of Binn’s photograph or actual film of him would not be actionable, but the dramatized portrayal was actionable. Note that this case was decided at a time when motion pictures were viewed as commercial products and not protected speech. *Compare Mut. Film Corp. v. Indus. Comm’n of Ohio*, 236 U.S. 230 (1915) (motion picture exhibition is a business conducted for profit, not protected speech), *with Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495 (1952) (rejecting *Mutual Film* and holding that motion pictures are “a significant medium for the communication of ideas,” protected by the First Amendment). *Id.* at 501. Modern courts routinely reject similar claims. *See, e.g., Ruffin-Steinback v. De Passe*, 17 F. Supp 2d 699 (E.D. Mich. 1998) (denying preliminary injunction by daughter of member of “The Temptations” against docudrama because it would constitute an unconstitutional prior restraint), final decision at 82 F. Supp. 2d 723 (E.D. Mich., 2000) (granting summary judgment to defendants); *Polydoros v. Twentieth Century Fox Film Corp.*, 79 Cal. Rptr. 2d 207 (Ct. App. 1997), *appeal dismissed*, 965 P.2d 724 (Cal. 1998); *Taylor v. Nat’l Broad. Co.*, 22 Media L. Rep. 2433 (Cal. Super. 1994) (denying preliminary injunction by Elizabeth Taylor against docudrama because it would constitute an unconstitutional prior restraint). An early California case suggested that a dramatized motion picture about public events would not violate the right of privacy, although the use of a rehabilitated prostitute’s real maiden name violated her right of privacy under the California constitution. *Melvin v. Reid*, 297 P. 91 (Cal. Ct. App. 1931). Under current law, the publication of such an embarrassing fact might not be actionable. *See, Florida Star v. B.J.F.*, 491 U.S. 524 (1989) (state statute imposing damages against newspaper for publishing name of rape victim violated First Amendment).

²⁵ *Donahue v. Warner Bros. Pictures, Inc.*, 194 F.2d 6 (10th Cir. 1952). *Compare Binns v. Vitagraph Co. of Am.*, 103 N.E. 1108 (N.Y. 1913), *with Lahiri v. Daily Mirror, Inc.*, 295 N.Y.S. 382 (Sup. Ct. 1937) (newspaper); *Sidis v. F-R Pub. Corp.*, 113 F.2d 806 (2d Cir. 1940) (magazine); *Oma v. Hillman Periodicals, Inc.*, 118 N.Y.S.2d 720 (App.

Although the earliest cases only protected as speech actual news media uses, later cases have both applied an expansive definition to what constitutes informational newsworthiness²⁶ and have recognized that non-informational entertainment media works are also speech privileged against appropriation privacy and publicity claims without requiring a showing of newsworthiness.²⁷ Thus, modern decisions generally find such media portrayals do not violate privacy²⁸ or publicity rights, even when they are fictionalized,²⁹ so long as they are not false and held out as truth.³⁰ For example, a film, whether a documentary, a docudrama, or a work of fiction, is presumed to be within the protection of the First Amendment.³¹

Courts have not followed a parallel path with respect to purely visual works. Until recently, most decisions continued to apply the categorical newsworthiness analysis in claims by a persona claimant against disseminators of unauthorized image copies. But, like motion pictures, visual art has come to be recognized as protected speech. In recent cases, courts have been asked to extend that recognition to artistic works depicting celebrities. Part II of this Article will briefly review the historical approach and then will describe the California Supreme Court's attempt to develop a new solution to the conflict. In its decision in *Saderup*, that court proposed a new categorical test under which a work of visual art will be considered speech protected from right of publicity claims only if it is transformative.

Div. 1953) (magazine); *Chaplin v. NBC*, 15 F.R.D. 134 (S.D.N.Y. 1953) (radio broadcast); *Dallesandro v. Henry Holt & Co.*, 166 N.Y.S.2d 805 (App. Div. 1957) (book). California courts have been more permissive towards fictionalized versions of real stories, at least where the subject can be considered a public figure. See *Melvin v. Reid*, 297 P. 91 (Cal. Ct. App. 1931); *Stryker v. Republic Pictures Corp.*, 238 P.2d 670 (Cal. Ct. App. 1951) (fictionalized story of WWII battles using real soldier's name did not violate right of privacy).

²⁶ See *New Kids on the Block v. News Am. Publ'g Inc.*, 971 F.2d 302 (9th Cir. 1992).

²⁷ See, e.g., *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454 (Cal. 1979); *Polydors v. Twentieth Century Fox Film Corp.*, 79 Cal. Rptr. 2d 207 (Ct. App. 1997), *appeal dismissed*, 965 P.2d 724 (Cal. 1998); *Taylor v. NBC*, 22 Media L. Rep. 2433 (Cal. Super. 1994); *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978); *Rosemont Enters., Inc. v. McGraw-Hill Book Co.*, 380 N.Y.S.2d 839 (Sup. Ct. 1975); *Ruffin-Steinback v. De Passe*, 82 F. Supp. 2d 723 (E.D. Mich. 2000); *Matthews v. Wozencraft*, 15 F.3d 432 (5th Cir. 1994); *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996).

²⁸ Compare *Blumenthal v. Picture Classics, Inc.*, 257 N.Y.S. 800 (App. Div. 1932) (film including images of street vendor actionable under New York Civil Rights Law §§ 50-51), with *Gaeta v. Home Box Office*, 645 N.Y.S.2d 707 (Civ. Ct. 1996) (television program including images of bystander not actionable).

²⁹ See, e.g., *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 455 (Cal. 1979) (Bird, C.J., concurring) (fictionalized biographical film portraying Rudolph Valentino).

³⁰ *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (Ct. App. 1983); *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978); *Spahn v. Julian Messner, Inc.*, 221 N.E.2d 543 (N.Y. 1966), *vacated and remanded by* 387 U.S. 239 (1967), *aff'd*, 233 N.E.2d 840 (N.Y. 1967), *appeal dismissed*, 393 U.S. 1046 (1969) (willfully and substantially fictional biography held out as truthful violated New York right of privacy law); see *Rosemont Enters., Inc. v. McGraw-Hill Book Co.*, 380 N.Y.S.2d 839 (Sup. Ct. 1975) (refusing to enforce injunction to stop publication of a "fictionalized autobiography" of Howard Hughes, so long as it is made clear that it was fictional).

³¹ *Guglielmi*, 603 P.2d at 455 (Bird, C.J., concurring).

This Article criticizes the transformativeness test in several ways. Part III criticizes the transformativeness test with reference to its roots in copyright law. An important element of the delicate social balance embodied in copyright's fair use defense, transformativeness has been unpredictable and has been inappropriately elevated into a categorical rule by judges in copyright cases. Moreover, the right of publicity lacks other mechanisms found in copyright law that protect First Amendment values. Therefore, to rely on transformativeness in right of publicity cases inadequately protects speech.

Part IV assesses the transformativeness test from the point of view of contemporary First Amendment jurisprudence. While various categorical approaches are still used by courts with respect to certain limited types of expression, in the latter part of the Twentieth Century, the Supreme Court developed a more elaborate form of analysis to address most conflicts between freedom of speech and laws that may limit that freedom. That analysis starts with a categorical assessment of the challenged law's impact on the content of speech and follows with a weighted balancing of the state's interest in the regulation against its impact on speech. Part IV reviews arguments for and against balancing and categorical approaches in First Amendment literature. It then considers the transformativeness test under each approach. Under the more typical weighted balancing approach, it argues that the transformativeness test should be considered a content-based regulation of speech and should fail the balancing test applied to such regulations. As a categorical approach, the transformativeness test should be rejected in favor of an approach that would not require judges to make aesthetic judgments as to what visual art qualifies as protected speech. Part V concludes with suggestions for approaches that would provide a more appropriate level of protection for visual art as speech.

II. CONFLICT BETWEEN RIGHT OF PUBLICITY CLAIMS AND FIRST AMENDMENT PROTECTION OF IMAGE COPIES

A. *Denial of First Amendment Protection to Image Copies and Image Products That Are Not Newsworthy*

As courts began to recognize the property interest protected by the right of publicity distinct from the personal interests protected by the right of privacy, the purveyors of image

copies lost a defense that had previously been available to them; namely, that a public figure's privacy rights are truncated. Hence, starting in the 1960's, celebrities renewed their efforts to stop the unauthorized distribution of image copies and image products by bringing claims against unauthorized uses of persona in various kinds of memorabilia, such as posters, buttons, and T-shirts incorporating a name or likeness.³² Defendants in these cases sometimes raised First Amendment defenses.³³ Courts characterized merchandise as wrongful because it is "a commodity, a commercial product."³⁴ News media such as newspapers and magazines are generally produced and distributed in order to make a profit, like merchandise products, yet courts do not consider those media products to be mere non-speech commercial products. Hence commercial, in this sense, does not mean distributed for a profit. Essentially, it is a conclusory term, reflecting the court's view that a work looks more like a non-expressive product than like speech.³⁵

Without engaging in any substantial discussion of the extent of permissible government regulation of speech, courts in these cases generally utilized a categorical approach similar to that developed in the media cases, interpreting the operative language of the relevant privacy or publicity statute in an attempt to avoid direct constitutional conflicts.³⁶ That categorical approach distinguished non-actionable uses of persona in connection with news or accounts of public interest from actionable uses in mere merchandise. Only rarely has a court found an image copy to be protected expression under this approach.

The earliest reported case involving the unauthorized sale of a non-advertising poster comprised of a photograph of a celebrity is *Paulsen v. Personality Posters, Inc.*,³⁷ one of the rare cases in which a claim for violation of the right of publicity was denied. In that case, comedian Pat Paulsen created a comedy routine involving his candidacy for president in 1968. The routine received substantial publicity through its performance on the popular Smothers Brothers Show. Personality Posters issued a mock "For President" poster, and Paulsen sued for violation of the

³² See, e.g., *Rosemont Enters., Inc. v. Urban Sys., Inc.*, 340 N.Y.S.2d 144 (Sup. Ct. 1973) (Howard Hughes adult educational career game); *Rosemont Enters., Inc. v. Choppy Prods., Inc.*, 347 N.Y.S.2d 83 (Sup. Ct. 1972); *Paulsen v. Personality Posters, Inc.*, 299 N.Y.S.2d 501 (Sup. Ct. 1968).

³³ See, e.g., *Rosemont Enters., Inc. v. Choppy Prods., Inc.*, 347 N.Y.S.2d 83 (Sup. Ct. 1972) (buttons, T-shirts, and sweatshirts making comical or satirical use of Howard Hughes' name and likeness violated New York Civil Rights Law §§ 50-51).

³⁴ *Rosemont Enters., Inc.*, 340 N.Y.S.2d at 146.

³⁵ See *Id.* at 146-147.

³⁶ See 2 MCCARTHY, *supra* note 6, § 8:45, at 8-67.

³⁷ 299 N.Y.S.2d 501 (Sup. Ct. 1968).

New York commercial appropriation statute. A New York trial court denied relief. Noting that “troublesome confrontations with constitutionally protected areas of speech and press have...caused our courts to engraft exceptions and restrictions onto the statute to avoid any conflict with the free dissemination of thoughts, ideas, newsworthy events, and matters of public interest,”³⁸ the court observed that the “public interest” and “newsworthy” exceptions have been interpreted broadly to include “even entertainment and amusement, concerning interesting phases of human activity in general.”³⁹ The court correctly noted that a prominent person does not have the right to exploit financially every public use of name or picture and that a use in connection with a matter of public interest is constitutionally protected. The court’s conclusion suggested broad First Amendment protection for posters:

[W]hether the poster involved be considered as a significant satirical commentary upon the current presidential contest, or merely as a humorous presentation of a well-known entertainer’s publicity gambit, or in any other light, be it social criticism or pure entertainment, it is sufficiently relevant to a matter of public interest to be a form of expression which is constitutionally protected and “deserving of substantial freedom.”⁴⁰

But subsequent courts have defined newsworthiness narrowly with respect to photographic posters. *Factors Etc., Inc. v. Pro Arts, Inc.*⁴¹ dealt with unauthorized posters issued shortly after Elvis Presley’s death consisting of a photograph of Presley and the words “In Memory—1935-1977. Sale of the posters was preliminarily enjoined. Although it seems clear that the death of Elvis Presley was a newsworthy matter of public concern, the court rejected the newsworthiness defense with little analysis, stating simply, “We cannot accept Pro Arts contention that the legend ‘IN MEMORY...’ placed its poster in the same category as one picturing a presidential candidate, albeit a mock candidate.”⁴² The poster was treated as memorabilia, and there was no discussion of First Amendment protection of the photograph as art or expression, over and above any newsworthiness.⁴³

³⁸ *Id.* at 505.

³⁹ *Id.* at 506.

⁴⁰ *Id.* at 508 (citing *Univ. of Notre Dame v. Twentieth Century-Fox Film Corp.*, 256 N.Y.S.2d 301 (App. Div. 1965).

⁴¹ 579 F.2d 215 (2d Cir. 1978).

⁴² *Id.* at 222.

⁴³ Several later cases have followed the approach of *Pro Arts*. For example, in *Brinkley v. Casablancas*, 438 N.Y.S.2d 1004 (App. Div. 1981), model Christie Brinkley was successful in a claim against a company that issued an unauthorized poster consisting of her photograph. The court simply stated that “the sale of the poster was a use

No sculptures have been found to be newsworthy, although one decision recognized potential protection of a sculpture as artistic speech.⁴⁴ For example, in *Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. Am. Heritage Prods, Inc.*, the defendant sold plastic busts of Martin Luther King together with a booklet about Dr. King.⁴⁵ As in its first decision recognizing a right of privacy in 1905,⁴⁶ the Georgia Supreme Court recognized a potential conflict between that right and freedom of speech, but found no speech protection for advertisements. Similarly, in this right of publicity case the court saw no violation of freedom of speech in enjoining the distribution of the busts.⁴⁷

Justice Weltner, in a special concurring opinion, objected to the majority's recognition of the proprietary right of publicity, stating that it "created an open-ended and ill-defined force which jeopardizes a right of unquestioned authenticity—free speech."⁴⁸ Justice Weltner criticized the majority for denying that the sculpture was speech.⁴⁹ Indeed, his opinion presents a passionate recognition of free speech protection for works of art generally:

When our constitution declares that anyone may 'speak write and publish his sentiments, on all subjects' it does not confine that freedom exclusively to verbal expression. Human intercourse is such that oftentimes the most powerful of expression involve no words at all, e.g., Jesus before Pilate; Thoreau in the Concord jail; King on the bridge at Selma.⁵⁰

of plaintiff's photograph for trade purposes." *Id.* at 1008. There was no analysis of First Amendment protection for the photograph as such. The defendants focused instead on an argument that Brinkley's claim was for proprietary injury and that New York didn't recognize a proprietary right of publicity. The court rejected that argument, finding that right to be subsumed under New York's appropriation privacy statute.

⁴⁴ Perhaps the earliest sculpture case is *Schuyler v. Curtis*, 42 N.E. 22 (N.Y. 1895). In that case, the relatives of a deceased public figure objected to the erection of a bust portraying her, alleging that she would not have wanted to be associated with Susan B. Anthony, whose bust was also to be displayed at the same exhibit. The court rejected the claim on the basis that, even if a right of privacy existed, it did not survive her death. *Id.* at 28-29. A 1941 New York decision dealt with a model's claim against a manikin manufacturer and distributor. *Young v. Greneker Studios, Inc.*, 26 N.Y.S.2d 357 (Sup. Ct. 1941). The court refused to dismiss the claim, rejecting the defendant's argument that a three-dimensional sculpture was not a "portrait or picture" for purposes of New York Civil Rights Law § 51. The question, whether the manikin was a use for purposes of trade or was a work of art, was apparently not raised. In one of the first of the modern cases, *Memphis Dev. Found. v. Factors, Etc., Inc.*, 441 F. Supp. 1323 (W.D. Tenn. 1977), a non-profit corporation intended to finance the erection of a bronze statue of Elvis Presley in his home town, by offering to give eight-inch pewter replicas of the statue to contributors of at least \$25. The court made no reference to free speech concerns, describing the reproductions as merely "commercially exploitive souvenir merchandise." *Id.* at 1327. There was no discussion of whether the bronze statue itself violated Presley's rights.

⁴⁵ *Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. Am. Heritage Prods, Inc.*, 296 S.E.2d 697 (Ga. 1982).

⁴⁶ *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905).

⁴⁷ *Martin Luther King, Jr., Ctr. for Soc. Change, Inc.*, 296 S.E.2d at 700.

⁴⁸ *Id.* at 708 (Welter, J., concurring).

⁴⁹ *Id.*

⁵⁰ *Id.*

He pointed to statues of confederate soldiers, busts of former chief justices, and the portrait of Dr. King hanging in the Georgia capitol building as examples of such non-verbal expression of sentiment. He noted that limiting the right of publicity to cases of financial gain would not protect freedom of speech, since “It is rare, indeed, that any expression of sentiment beyond casual conversation is not somehow connected, directly or indirectly, to ‘financial gain.’”⁵¹ Justice Weltner concurred in the majority result, however, because the particular use in this case was “irresponsible to the interest of the community—to the extent of being *unconscionable*—that such conduct go unrestrained.”⁵² Unlike the majority, he suggested that the doctrine of unjust enrichment could achieve that result, without the need to recognize a new right of publicity.

Unfortunately, Justice Weltner did not explain exactly what it was about that case that made the defendant’s use unconscionable. Most likely, he was offended by the defendant’s rather brazen marketing methods. The defendant, after unsuccessfully negotiating with the plaintiff for its endorsement, took out ads in major national publications offering the bust as “an exclusive memorial” and “an opportunity to support the Martin Luther King, Jr., Center for Social Change.” An advertising brochure used photographs of Dr. King and excerpts from his speeches. The ads also indicated that “a contribution” from each order would go to the Center, and promised buyers a “Certificate of Appreciation” confirming that a contribution had been made. Apparently a small contribution was to be deposited into a trust fund for the Center, but the trust documents were never executed. It would seem that such marketing techniques implied an endorsement by the Center and its participation in the product; however, the Center chose to bring a claim for violation of the right of publicity. Because the busts were used to solicit donations, this case could be viewed more as an advertising case than one against the simple sale of an image copy. Therefore, although Justice Weltner’s opinion is remarkable for its emphasis on freedom of expression, his approach gives little guide to determining when the exploitation of expressive works portraying a celebrity should be considered actionable, unless false endorsement concepts should apply.

⁵¹ *Id.*

⁵² *Id.* at 709.

In *Simeonov v. Tiegs*,⁵³ the only reported sculpture case other than the ones discussed above, a New York trial court stated that, “An artist may make a work of art that includes a recognizable likeness of a person without her or his written consent and sell at least a limited number of copies thereof without violating Civil Rights Law sections 50 and 51.”⁵⁴ This decision did not apply the news/merchandise categorical approach, but instead held that art is protected speech. The plaintiff, an internationally known sculptor, had created a plaster casting of model Cheryl Tiegs’ head. While the casting was in Tiegs’ possession, some workers destroyed it, and the sculptor sued, claiming that he not only intended to display a sculpture made from the casting, but also to sell a limited edition of ten bronze copies of it for \$20,000 each. He sought damages of \$200,000, and Tiegs defended by asserting that he had no right to make or sell the sculpture, so she could have no liability.

The sculptor asserted that if Sections 50 and 51 covered his sculpture and reproductions, they would be unconstitutional. The court distinguished *Young v. Grenaker Studios, Inc.*,⁵⁵ where a manikin distributor was found to be acting for the purposes of trade. Because the Tiegs sculpture is an artist’s creative expression even the sale of copies was not for purposes of trade. Echoing Justice Weltner’s view of the value of nonverbal expression, the court said, “The dissemination for profit is not the sole determinant of what constitutes trade under these statutes. It is the content that counts....Works of art, including sculptures, convey ideas, just as do literature, movies or theater.”⁵⁶ The court found that Tiegs’ right of privacy was outweighed by freedom of speech.

If art might be protected speech or might be merchandise that violates the right of publicity, how do courts distinguish the two?⁵⁷ Courts in New York have suggested that whether

⁵³ *Simeonov v. Tiegs*, 602 N.Y.S.2d 1014 (Civ. Ct. 1993).

⁵⁴ *Id.* at 1018.

⁵⁵ 26 N.Y.S.2d 357 (Sup. Ct. 1941)

⁵⁶ *Simeonov*, 602 N.Y.S.2d at 1018 (citations omitted).

⁵⁷ The broader question of how to analyze the constitutional status of speech that is a mix of commercial and non-commercial speech is unsettled and beyond the scope of this Article. The Supreme Court has said that, “[W]e do not believe that the speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech.” *Riley v. Nat’l Fed’n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988). In a later case, the Court found that non-commercial speech could be disentwined from commercial speech in upholding a state college prohibition of campus “tupperware parties.” *Bd. of Trs. of the State Univ. of N.Y. v. Fox*, 492 U.S. 469 (1989). In that decision, Justice Scalia, who had dissented in *Riley*, wrote for the majority, “no law of man or of nature makes it impossible to sell housewares without teaching home economics.” *Id.* at 474. The California Supreme Court recently developed a broad test for commercial speech in the context of commercial deception cases, and followed *Fox* in holding that commercial and noncommercial speech are not inextricably intertwined “unless there is some legal or practical compulsion to combine them.” *Kasky v. Nike, Inc.*, 45 P.3d 243, 260 (Cal. 2002); *see also Kraft*

or not a sale of posters or limited edition prints of a photograph constitutes a newsworthy use protected by the First Amendment is a question of fact, focusing on the primary purpose of the distribution.

In *Mendonsa v. Time, Inc.*,⁵⁸ the court found that the plaintiff, who claimed to be the sailor in the famous Alfred Eisenstadt photograph of a sailor kissing a woman in Times Square on V-J Day, stated a claim under Rhode Island's commercial appropriation statute against Life Magazine, which had offered to sell to the public limited edition prints of the photograph for \$1,600 each. Although the court noted that Life Magazine's initial publication of the photograph would be newsworthy and not for purposes of trade, it concluded that the defendant "clearly had a commercial purpose apart from the dissemination of news,"⁵⁹ and suggested that the trier of fact would have to consider whether the sale of the photograph "functioned primarily as a means of commercial exploitation or served some other protected public interest."⁶⁰

In *Titan Sports, Inc. v. Comics World Corporation*,⁶¹ the district court dismissed a claim on behalf of professional wrestlers that magazines that included large-size photographs or "magazine posters" of the wrestlers violated the New York appropriation statute. Although the magazines' titles suggested their purpose was primarily to distribute posters,⁶² they also included some news articles and resembled traditional newsstand publications. The district court concluded that they were fully protected by the First Amendment and not used for purposes of trade. The Second Circuit reversed, stating that "photographs marketed as posters are used for purposes of trade."⁶³ It instructed the trial court to consider the primary purpose of the use and

Foods Holdings, Inc., v. Helm, 205 F. Supp. 2d 942, 954-55 (N.D. Ill. 2002). In the right of publicity context, the Ninth Circuit recently found that expressive and commercial elements were inextricably intertwined in a magazine article using a digitally altered photograph of Dustin Hoffman as Tootsie, but in a modern gown. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185-86 (9th Cir. 2001). Because "common sense" told the court that the article, which had very little editorial content, was still "not a simple advertisement," the court treated the article as a whole as noncommercial speech. *Id.* On the other hand, the Ninth Circuit found that a photo of some classic surfers that was used in a catalogue that included substantial editorial content was not inextricably intertwined with that content. *Downing v. Abercrombi & Fitch*, 265 F.3d 994 (9th Cir. 2001). The Supreme Court of Colorado used a "primary character of the publication" approach in a case where a detective agency used a photograph of a person who had been convicted of a crime after being investigated by the agency in the agency's promotional newsletter. *Joe Dickerson & Assocs. v. Dittmar*, 34 P.3d 995, 1003-04 (Colo. 2001) (en banc). In that case, the court discounted the defendant's profit motive and emphasized the legitimate public concern in the plaintiff's crime. *Id.* at 1004-05. Hence, it focused on the content of the publication rather than the predominate purpose of the publisher.

⁵⁸ 678 F. Supp. 967 (D.R.I. 1988).

⁵⁹ *Id.* at 972.

⁶⁰ *Id.*

⁶¹ 690 F. Supp. 1315 (S.D.N.Y. 1988), *rev'd and remanded by* 870 F.2d 85 (2d Cir. 1989).

⁶² The magazines were entitled "Wrestling All-Stars Poster Magazine" and "Wrestling All-Stars Giant Pin-Ups."

⁶³ *Titan Sports*, 870 F.2d at 88.

whether the public interest aspect of the use is “merely incidental” to a commercial purpose. Moreover, it suggested facts to be considered, including “the nature of the item, the extent of its relationship to the traditional content of a magazine, the ease with which it may be detached from the magazine, whether it is suitable for use as a separate product once detached, and how the publisher markets the item.”⁶⁴

Where the object of the promotion is clearly a news work, however, the sale of posters has been found to be subject to First Amendment protection. For example, a California decision was much more solicitous of a newspaper’s sale of posters including news photos of Joe Montana celebrating the 49’ers 1990 Super Bowl victory.⁶⁵ Affirming the lower court’s summary judgment for the defendant, the court noted that there could be no doubt that the newspaper accounts in connection with which the photograph was first published was a publication of a matter in the public interest entitled to First Amendment protection. It concluded, “the relatively contemporaneous reproduction of these pages, in poster form for resale, is similarly entitled to First Amendment protection.”⁶⁶ Even if the posters were sold to promote sales of the newspaper, such a use is itself constitutionally protected.⁶⁷

B. Protecting Only Newsworthy Art Inadequately Protects Speech

⁶⁴ *Id.* at 89. A more recent case applied those factors and found that the use of a photograph of an “art car” designer in a news magazine centerfold as part of a pictorial article on extravagantly designed cars was not a use for purposes of trade. *Psyhoyos v. Nat’l Exam’r*, 1998 WL 336655 (S.D.N.Y. 1998). Unlike *Titan*, the news magazine did not feature the availability of the poster on its cover, and there was no other evidence that it tried to use the photo to increase sales. The centerfold was not printed on poster-type oversized paper, and although it could be removed and used as a poster, the court noted that its “low quality” made it unlikely to serve as a poster. Finally, the magazines at issue in *Titan* were aimed specifically at wrestling fans, while this news magazine did not cater to art car fans. The court concluded that there was not even an issue of fact as to whether the use was for purposes of trade.

⁶⁵ *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639 (Ct. App. 1995).

⁶⁶ *Id.* at 641. The decision did not cite the *Titan Sports* opinion, saying that it was unable to locate any cases on point. *Id.*

⁶⁷ *Id.* at 642–43. It is difficult to reconcile *Montana* and *Titan Sports*. In both cases, a poster was sold to promote the sale of a magazine. One might distinguish them, since there was arguably a close connection between the poster in *Montana* and the recent newsworthy football team victory. By contrast, there may not have been any particular newsworthy event associated with the wrestling photographs other than the general notoriety of the wrestlers. On the other hand, the *Montana* posters would probably fail the factual test suggested by the *Titan Sports* court: The item was clearly a poster, it was already detached from the newspaper, it was suitable—indeed, intended—for use as a separate product, and was marketed as a poster. Under *Titan Sports* it would seem that any poster or visual image marketed as such, separate from a news publication, would be treated as a use for purposes of trade rather than as a newsworthy use protected by the First Amendment. But none of these cases considered potential First Amendment protection for a photograph as an expressive work per se, focusing instead on the photograph’s newsworthiness or

The foregoing discussion and review of the cases demonstrates several points. In general, courts have treated the sale of multiple copies of an image of a person as a sale of a product or a use for purposes of trade, no different from the attachment of an image to an article of merchandise such as a cup or a T-shirt. Other than in the *Tiegs* case, the courts have not considered the free expression rights of the artist or photographer who created the image. Rather, they have resolved potential First Amendment issues by categorizing the image as either newsworthy or merchandise. If the use of the image was found to be primarily in connection with reporting newsworthy events, the use was protected by freedom of speech and not actionable. Otherwise, the exploitation of image was found to be commercial or for purposes of trade, violating the right of publicity. This was true even if the image was marketed as a work of art or as part of a news publication, if the court could characterize its “primary purpose” as a commercial one. In some cases, even images or sculptures that related to events of public concern, such as the death of Elvis Presley or the continuing legacy of Martin Luther King, were treated as commercial merchandise the sale of copies of which violated the right of publicity.

This traditional categorical approach to determining appropriate First Amendment limitations on the right of publicity in this context is inadequate.⁶⁸ First, courts can manipulate outcomes by improper characterization of a particular use. Surely, a memorial poster published three days after the death of Elvis Presley was as newsworthy as Pat Paulsen’s so-called presidential candidacy or Joe Montana’s football victory.⁶⁹ Yet the court in *Factors Etc., Inc. v. Creative Card Co.*⁷⁰ hardly discussed the possibility, simply stating that Paulsen should be limited to its unique facts and “[t]here is no constitutional protection for selling posters of Elvis Presley as Elvis Presley.”⁷¹ The Joe Montana poster was Joe Montana as Joe Montana, yet was found to be newsworthy. This ability to manipulate outcomes by conclusory categorizations is inadequate to protect freedom of speech.

its relationship to other newsworthy material. As will be discussed in the following sections, that approach gives inadequate protection to speech.

⁶⁸ See James Barr Haines, *First Amendment II: Developments in the Right of Publicity*, 1989 ANN. SURV. AM. L. 211 (1990).

⁶⁹ See Pamela Samuelson, *Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 TUL. L. REV. 836, 860 (1983).

⁷⁰ 444 F. Supp. 279 (S.D.N.Y. 1977)

⁷¹ *Id.* at 285.

Second, focusing only on newsworthiness ignores other important interests protected by freedom of speech.⁷² Various theories have been identified to justify freedom of speech, including its importance in society's search for truth through a marketplace of ideas, its important role in democratic self-governance and as a safety-valve for conflicting beliefs and its necessity to human dignity and self-fulfillment.⁷³ Focusing solely on newsworthiness inadequately recognizes the many roles of visual media. Photographs and illustrations concerning matters of public importance are a vivid contribution to the marketplace of ideas, and can play a role as an important safety-valve and source of opinion vital to a modern democracy. But visual expression is more important than that. It clearly serves as a fundamental mode of self-fulfillment.

Moreover, even non-informational art may serve an important role in nurturing the search for truth and the maintenance of democratic self-governance. While courts expanded the scope of the right of publicity in the second half of the Twentieth Century, so too courts expanded freedom of expression and articulated an interest-balancing approach to assessing the constitutionality of laws impacting speech. The U.S. Supreme Court has recognized that expression other than news or information is protected speech.⁷⁴ It has noted that "a narrow, succinctly articulable message is not a condition of constitutional protection."⁷⁵ It has found entertainment,⁷⁶ motion pictures,⁷⁷ theater⁷⁸ and music⁷⁹ to be protected. The Court has stated that, like entertainment, art is protected speech.⁸⁰ Other courts have expressly recognized this

⁷² In *Reviving Zacchini*, Professor Samuelson criticized the newsworthiness approach as conclusory, and also for not adequately considering impairment of the right of publicity plaintiff's property interests. Samuelson, *supra* note 69, at 863-64. That argument may make sense in the context of *Zacchini*'s facts, where a performer's entire act was filmed without permission and broadcast; however, in the context of pure image works rather than performances, the plaintiff's property interests are weak.

⁷³ See, e.g., THOMAS I. EMERSON, *THE SYSTEM OF FREEDOM OF EXPRESSION* 6-7 (1970) (discussing premises for recognizing freedom of expression). See generally 1 SMOLLA, *supra* note 16, §§ 2:3-2:6.

⁷⁴ See *Spence v. Washington*, 418 U.S. 405, 411 (1974) (per curiam) (a particularized message is not required for speech to be protected); *Hurley v. Irish-Am. Gay, Lesbian & Bisexual Group of Boston*, 515 U.S. 557 (1995) (parade is protected speech).

⁷⁵ *Hurley*, 515 U.S. at 569.

⁷⁶ *Schad v. Borough of Mt. Ephraim*, 452 U.S. 61 (1981); *Winters v. New York*, 333 U.S. 507 (1948).

⁷⁷ *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495 (1952).

⁷⁸ *Southeastern Promotions, Ltd. v. Conrad*, 420 U.S. 546 (1975).

⁷⁹ *Ward v. Rock Against Racism*, 491 U.S. 781 (1989).

⁸⁰ In *Hurley v. Irish-American Gay, Lesbian & Bisexual Group of Boston*, 515 U.S. 557 (1995), the Court referred to "the unquestionably shielded painting of Jackson Pollock, music of Arnold Schoenberg, or Jabberwocky verse of Lewis Carroll." *Id.* at 569.

fact.⁸¹ Speech may be protected from regulation even when it is disseminated for commercial gain⁸² and on unconventional media such as T-shirts.⁸³

In an insightful article, Professor Marci Hamilton analyzed art's important role in a representative democracy, the "liberty value of art."⁸⁴ This value goes beyond its potential as a mode for explicit comment on political or social issues, as in political cartoons for example. Indeed, Professor Hamilton argues that

art cannot receive its due as long as attempts to justify its place in the pantheon of first amendment freedoms are focused only upon the protection of ideas or information. Art can carry ideas and information, but it also goes beyond logical, rational, and discursive communication. It provides a risk-free opportunity to live in other worlds, enlarging individual perspective and strengthening individual judgment.⁸⁵

Because of the important role art plays, government regulation of artworks should be presumptively unconstitutional, rebuttable

only if its regulation passes the strict scrutiny now applied to political speech. In other words, any regulation of art should be unconstitutional unless the government can prove a compelling interest in such regulation and it can show the regulation directly advances such an interest.⁸⁶

Courts approaching right of publicity claims against photographs, paintings, sculpture and other art solely in terms of whether or not the use is newsworthy exemplifies the overly

⁸¹ See, e.g., *Bery v. City of New York*, 97 F.3d 689 (2d Cir. 1996).

⁸² *Riley v. Nat'l Fed'n of the Blind of N.C., Inc.*, 487 U.S. 781, 801 (1988).

⁸³ *Ayres v. City of Chicago*, 125 F.3d 1010 (7th Cir. 1997); see also *Cohen v. California*, 403 U.S. 15 (1971) (jacket with "Fuck the Draft" printed on it was protected speech).

⁸⁴ Marci A. Hamilton, *Art Speech*, 49 VAND. L. REV. 73, 75 (1996); see also Amy Adler, *The Thirty-Ninth Annual Edward G. Donley Memorial Lectures: The Art of Censorship*, 103 W. VA. L. REV. 205 (2000). Professor Adler argues that the classic rationale for protecting speech – to protect the marketplace of ideas – gives greater protection to verbal, rather than visual, communication. She criticizes such a constricted approach, positing that the classic rationale gives inadequate protection to art, which often finds its power in emotional, rather than rational, ideas. *Id.* at 210. That visual images can be "more powerful and less controllable than verbal speech" has been recognized by the Supreme Court in its cases dealing with the American flag, and Professor Adler suggests that we should rethink "the cramped First Amendment model that we currently insist on." *Id.* at 217.

⁸⁵ Hamilton, *supra* note 85, at 77.

⁸⁶ *Id.* at 102 (footnote omitted).

narrow view of the importance of art and the inappropriate focus on only the discursive value of art that Professor Hamilton criticized in her article.⁸⁷

*C. Direct Conflict Between Right of Publicity Claims and First Amendment Protection of Image
Work Creators – Comedy III v. Saderup*

1. Background

The defendants in the cases discussed above were generally distributors rather than the artist or photographer who created the image involved in the case. They asserted a general freedom of the press defense and not an argument based on their protected expression as artists.⁸⁸

In two recent cases, courts have been directly confronted with a First Amendment defense based on the argument that an image used in a mass-distributed item was protected expressive speech. Unlike most previous cases, the defendants in these cases specifically asserted that the allegedly infringing work was art, a form of speech protected by the federal and state constitutions. For the first time, the court was asked to consider the constitutionality of the application of a right of publicity law to an artist's depiction of a celebrity.

In cases challenging the constitutionality of state regulation impacting the dissemination of expression such as art, the Supreme Court has applied varying degrees of scrutiny, depending on whether it views the particular regulation as content-based or content-neutral, and, if content-neutral, on the impact of the challenged law on communication of messages.⁸⁹ Often this results in fairly strict scrutiny and the rejection of the state law.⁹⁰ That is not the approach used in those recent cases.

In *ETW Corp. v. Jireh Publishing, Inc.*,⁹¹ a federal district court was confronted with the question of whether copies of a work of art were protected against a right of publicity claim by

⁸⁷ “The marketplace of ideas paradigm, which permeates the speech cases, tends to undervalue art by only recognizing its political, rational, discursive potential.” *Id.* at 106.

⁸⁸ The only exception, prior to *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001) and *ETW Corp. v. Jireh Publishing, Inc.*, 99 F. Supp. 2d 829 (N.D. Ohio 2000), both discussed *infra* Part IV, was a sculpture case discussed *supra* Part III.B.2.b., *Simeonov v. Tiegs*, 602 N.Y.S.2d 1014 (Civ. Ct. 1993).

⁸⁹ Geoffrey R. Stone, *Content-Neutral Restrictions*, 54 U. CHI. L. REV. 46, 71 (1987); *see Montefusco v. Nassau County*, 39 F. Supp. 2d 231, 241-42 (E.D.N.Y. 1999).

⁹⁰ *See, e.g., Bery v. City of New York*, 97 F.3d 689 (2d Cir. 1996) (suggesting that law regulating street vending of art was content-based, subject to strict scrutiny, but finding it unconstitutional under intermediate scrutiny).

⁹¹ *ETW Corp. v. Jireh Publishing, Inc.*, 99 F. Supp. 2d 829 (N.D. Ohio 2000).

the First Amendment. In that case, Rick Rush, an artist who specializes in “sports art,” had created a print entitled “The Masters of Augusta,” which featured well-known golfer Tiger Woods. Unlike *Saderup*, the case that will be more fully discussed below, Rush’s print was not distributed on T-shirts. Rather, copies were sold in the form of a “limited edition,” signed by Rush. ETW Corp., Tiger Woods’ exclusive licensing agent, brought an action alleging several trademark and unfair competition claims, as well as a claim that the prints violated Woods’ right of publicity under Ohio common law. Although the district court’s decision primarily addressed the former claim, it took an approach similar to *Tiegs* as to the right of publicity claim, stating that, “[P]aintings and drawings are protected by the First Amendment.”⁹² At least where the work is “an artistic creation seeking to express a message,”⁹³ the fact that copies are sold is irrelevant to its First Amendment protection.⁹⁴ This case is currently on appeal.

The other case is *Comedy III Productions, Inc. v. Gary Saderup, Inc.*⁹⁵ Saderup is an artist who creates charcoal sketches of celebrities. He created a sketch of the Three Stooges, and used it to create lithographs⁹⁶ and t-shirts. He sold 1,415 lithograph posters and 2,265 t-shirts embodying the image.⁹⁷ Comedy III Productions, Inc., the registered owner of the rights of publicity of the Three Stooges,⁹⁸ sued, alleging a violation of California’s statutory right of publicity applicable to deceased celebrities.⁹⁹ After a trial on stipulated facts, the court awarded the plaintiff \$75,000 in damages, \$150,000 in attorneys fees and a broad injunction. The appellate court affirmed the damages but struck the injunctive relief, and the case was appealed to the California Supreme Court. The court elaborated a different approach to resolving conflicts between the right of publicity and the First Amendment, which will result in some works of art being treated as protected speech and others being treated as merchandise.

In his appeal to the California Supreme Court, Saderup first argued that his artwork was speech that is fully protected under the First Amendment and the California constitution. He

⁹² *Id.* at 835.

⁹³ *Id.* at 836.

⁹⁴ *Id.*

⁹⁵ 21 P.3d 797 (Cal. 2001)

⁹⁶ Lithography is a process for art reproduction developed at the end of the Eighteenth Century. Nineteenth Century master artists refined the process as a means of creating reproductions of fine art. Many successful fine artists, e.g., Cezanne, Picasso, and Matisse have utilized lithography. 1 RALPH E. LERNER & JUDITH BRESLER, ART LAW 367-68 (2d ed. 1998).

⁹⁷ Opposing Party’s Brief on the Merits at 10, *Comedy III Prods, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001) (No. S076061).

⁹⁸ Initially, Shaquille O’Neal was also a plaintiff. The defendant settled with O’Neal before trial.

⁹⁹ Cal.Civ.Code §990. In 1998, that statute was amended and renumbered Cal. Civ.Code §3344.1.

argued that §990 as applied by the Appellate Court was a content-based regulation that must satisfy strict scrutiny, requiring a showing by the plaintiff that there is a compelling state interest and the regulation is narrowly drawn to serve that interest.¹⁰⁰ That showing was not made. Second, Saderup argued that the artwork constitutes speech about a public figure and, therefore, falls within the statutory public interest exception. Finally, Saderup made public policy arguments, that government should not act as a censor of art, that celebrities are “necessary components of our common culture” and that courts should not have the power to decide what an artwork means.¹⁰¹

In its reply, Comedy III argued that celebrities have a property interest in their images that is also expressly protected under the California constitution. It emphasized the labor rationale for recognizing the right as a form of intellectual property similar to other forms of intellectual property, and offered vehement rebuttals to the scholarly critics of the right, suggesting that critiques reflect the “extreme left of center political philosophy”¹⁰² of the critics. As to Saderup’s First Amendment argument, Comedy III pointed to decisions finding that the First Amendment does not always trump intellectual property claims, and particularly the decision in *Zachini v. Scripps-Howard Broadcasting*.¹⁰³ It argued that the express limitations in §990 protect speech interests, and that balancing of speech and publicity right interests is accomplished by a categorical, “communicative” versus “primarily commercial” use distinction, with the latter not requiring First Amendment protection. Even if Saderup’s drawing constitutes “art”, the statute expressly excludes “single original works of fine art;” therefore, Saderup’s reproductions are not excluded from coverage. Next, Comedy III argued that the public interest exception did not apply, because it covers newsworthy material, not newsworthy celebrities. Saderup’s T-shirts and posters “depict no newsworthy events and contain no political or satirical messages.”¹⁰⁴ Comedy III not only argued that the damages judgment should be affirmed, but also that the injunction should be reinstated.

¹⁰⁰ Appellant’s Opening Brief at 20, *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001) (No. S076061).

¹⁰¹ Saderup also argued that, to preserve the constitutionality of §990, courts have limited its coverage to commercial speech, namely use in advertising and solicitation. He repeated his argument below that the statutory reference to use “on or in products” means using the persona to sell a product other than the persona itself.

¹⁰² Appellee’s Reply Brief at 20, *Saderup* (No. S076061).

¹⁰³ 433 U.S. 562 (1977).

¹⁰⁴ *Id.* at 36. As to Saderup’s argument that §990 is limited to advertising uses, Comedy III argued that the statute prohibition of use on or in “products” covers uses in merchandise and the legislative history and some case law confirms the intent to preclude such uses.

There were also numerous amicus briefs filed in the case. Many of the arguments amici made were directed at the Supreme Court's First Amendment jurisprudence approach discussed below. For example, the Screen Actors Guild argued, among other things, that §990 is content-neutral because "it in no way discriminates permissible usage based on the substantive message Saderup seeks to convey,"¹⁰⁵ seemingly confusing content neutrality with viewpoint neutrality. The Screen Actors Guild and a group of other *amici* that license celebrity images argued that §990 is aimed at the noncommunicative impact of Saderup's conduct and does not unduly restrict the flow of ideas. Hence, they argued that §990 should be subject only to the Supreme Court's *O'Brien* intermediate scrutiny test for regulation of expressive conduct, which it should survive because the right of publicity furthers "an important or substantial governmental interest" that is unrelated to the suppression of free expression and is no greater than essential to the furtherance of the governmental interest.¹⁰⁶ Wayne Enterprises, Inc. and a group of other entities and individuals that own and license celebrity images argued that the court should look to the Supreme Court cases that rejected First Amendment challenges to "invasions of private property." Finally, the Wayne Enterprises brief articulated several of the policy rationales supporting the right of publicity as evidence of substantial government interests unrelated to the suppression of expression. Although the California Supreme Court did not endorse these arguments, because they arise under the more typical First Amendment jurisprudence used by the Supreme Court they will be addressed in the discussion below.¹⁰⁷

¹⁰⁵ Brief of Amici Curiae Screen Actor's Guild at 19, *Saderup* (No. S076061). Wayne Enterprises and a group of other celebrity image licensors made a similar argument. See Brief of Amici Wayne Enterprise, Inc., at al. at 12, *Saderup* (No. S076061)

¹⁰⁶ Brief of Amici Curiae Screen Actor's Guild at 24, *Saderup* (No. S076061).

¹⁰⁷ An amicus brief filed on behalf of some other celebrity image licensing organizations, most notably ETW Corp., plaintiff in the case pending in the Sixth Circuit, made some similar arguments to those in some of the other briefs and advocated a two-step approach combining the merchandise vs. media and "alternative means of expression" tests. First, does the use primarily exploit celebrity goodwill or is it a "media use that significantly comments on a" celebrity? If the former, it is not protected by the first amendment. If the latter, it is not protected by the first amendment unless there are no "alternative means to communicate the message that do not involve the taking of others' intellectual property."

Brief of Amici Curiae Gene Autry at 30, *Saderup* (No. S076061). This suggested approach would decimate expressive uses of celebrity personalities that have been found constitutionally protected, such as an unauthorized docudrama or other biography telling the life story of a celebrity, unless it "significantly comments" on the celebrity. Indeed, the proposed test suffers from many problems. It would require courts to decide when expression is "significant," and is therefore, content-based and violative of the esthetic non-discrimination principle. Because the scope of the right of publicity continues to expand, it is difficult to predict when a message can be conveyed without "taking others'" protected persona. Finally, the alternative means of expression approach is completely unworkable. In addition to the other critiques of that approach discussed in this Article, there is a fatal logical flaw in the approach as envisioned by the author of this brief. A visual artist such as Saderup would always have an alternative means, since he could write a book or a song or publish a newspaper. Therefore, even if there is significant comment

An amicus brief submitted by the American Intellectual Property Lawyers Association may have been more influential on the California Supreme Court's analysis. That brief advocated the application of an approach analogous to copyright's fair use analysis¹⁰⁸ to balance right of publicity and First Amendment interests.¹⁰⁹ The brief argued that cases such as *Lugosi* and *Zachini* acknowledge the similarity between the right of publicity and copyright. In turn, fair use analysis provides a "limited privilege" to use copyrighted works for some purposes and is "an important, if not exclusive, tool for balancing" the conflicting interests." Moreover, the brief argues that guidance from copyright fair use cases will provide certainty in right of publicity cases. Finally, the brief proposed how the fair use factors should be applied in the context of right of publicity.¹¹⁰

It seems clear that a fair use analysis as described in the AIPLA brief would result in no First Amendment protection for most works of art portraying a person's likeness. All of the four

on the celebrity, it violates the right of publicity under this test. But the same thing would apply to each of the other potential works. That is, if he wrote a book containing significant commentary, it would not be protected by the First Amendment because he could have written a song. Hence, because there are numerous potential ways in which one might present expression about a celebrity, there are always "alternative means" of doing so and *none of them* is protected by the First Amendment. The California Supreme Court did not even discuss this proposal and certainly didn't accept the invitation to protect celebrity interests to this extent.

¹⁰⁸ See 17 U.S.C. §107 (listing four non-exclusive factors to be considered by courts: the purpose and character of the use, the nature of the work used, the amount and substantiality of the material used, and the effect of the use upon the potential market for or value of the work used).

¹⁰⁹ The AIPLA brief primarily argued that Saderup's portrait contained no protected speech because it did not comment on the celebrity. That characterization of the portrait also infected its application of the fair use factors to Saderup's use.

¹¹⁰ As to the purpose and character of the use factor, the AIPLA focused on two aspects: the commerciality of the use and the question of whether the use is transformative. It argues that Saderup's portrait is not transformative because he didn't comment substantively upon the subjects of his portraits. As authority for the necessity of such commentary, the brief refers to the *Acuff-Rose* case, which noted that in the context of a parody defense, the work used in the parody must be the target of the parody in order to justify using it. Regarding the nature of the property used, the brief argued that courts should consider "how necessary it is to use the protected right in the ordinary course of exercising one's First Amendment rights." Such use would be necessary in a parody, but not in Saderup's case. This is because there was no speech other than the likeness itself, so it was not necessary to use the likeness to effectuate speech. The circularity of this approach is obvious. If the speech is the likeness itself, then it is necessary to use it express that speech. Hence, AIPLA's focus in regard to this factor is really as to the purpose and character of the use, not the property used. Concerning the third fair use factor, the amount of the work used, the AIPLA argued that one should "evaluate whether the use of the protected property is incidental to the Petitioner's speech or instead whether the property so dominates the speech that it can fairly be said that the Petitioner has completely appropriated the right." The brief argues that Saderup's use is like the taking of an "entire act," found unprotected by the First Amendment in *Zachini*. Thus, the AIPLA seems to look to what portion of the defendant's work consists of the plaintiff's likeness. Generally, copyright fair use analysis looks to how much of the plaintiff's work is taken, not how much of the defendant's work consists of the plaintiff's material. However, courts sometimes turn this inquiry around, arguing that if the defendant's work consists largely of the plaintiff's material it shows the qualitative importance of the plaintiff's work taken. See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985). Finally, as to the effect on potential markets, the AIPLA argued that this is often the most important

factors would favor the plaintiff's rights and disfavor the free speech interests, unless the work could be viewed as commenting substantively on the subject. In other words, a parody might be protected speech, but virtually no other use would be, because any portrait or photograph would be commercially exploited, would depict the entire likeness of the person portrayed and would be in competition with present or future uses by the plaintiff. Indeed, it is difficult to see how this approach would protect other media uses of a celebrity persona that are clearly protected by the First Amendment, such as a non-critical biography, docudrama or song.¹¹¹ However, the California Supreme Court was persuaded of the importance of transformativeness under the first fair use factor, while rejecting the application of the other factors.

2. California Supreme Court Decision – The Transformativeness Test

The California Supreme Court rejected some, but accepted many, of the arguments made by Saderup. Ultimately, however, it affirmed the Appellate Court's judgment. First the court rejected Saderup's argument that §990 covers only advertising uses, finding that T-shirts and lithographs were "products, merchandise or goods" covered by the statute.

Most of the decision focuses on the First Amendment issues. The court agreed that Saderup's work was not commercial speech, but rather was an expressive work, which is protected even if exploited for financial gain. Justice Mosk recognized two commonly acknowledged purposes of the First Amendment, preserving an uninhibited marketplace of ideas and fostering a "fundamental respect for individual development and self-realization".¹¹² He noted that not only may an appropriation of celebrity likeness play a role in public debate, but such appropriation also "can be an important avenue of individual expression," because

factor and that, in this regard, one should consider whether the use is in competition with the owner's present or potential uses.

¹¹¹ Indeed, one of the other amici for the plaintiff in this case argued that fair use analysis should not apply in right of publicity cases, because it would promote confusion, would be unpredictable and most of the factors would favor infringement. Brief of Amici Curiae Gene Autry at 34-35, *Saderup* (No. S076061). Notably, that brief did not mention the purpose and character of the use factor. One wonders why parties who represent celebrities would criticize a test on the basis that it would usually favor a finding of infringement. It seems more likely that those parties were concerned that a fair use analysis would tend to favor defendants more than the two-step test proposed in the Autry brief, presumably because an inquiry into the purpose and character of the use might favor expressive uses and might not consider the availability of alternative means of expression as proposed in that two-step test.

¹¹² *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 803 (Cal. 2001) (citing Justice Bird's concurrence in *Guglielmi v. Spelling-Goldberg Prod.*, 603 P.2d 454, 458 (Cal. 1979)).

“celebrities take on personal meanings to many individuals in society.”¹¹³ The Justice cited Professor Madow’s and Professor Coombs’ observations that the right of publicity has the potential to censor expression, particularly critical expression such as caricature, parody or satire. He noted the heightened First Amendment protection given to speech concerning public figures in defamation cases and observed that too broad a right of publicity could limit “unflattering commentary that cannot be constitutionally accomplished through defamation actions.”¹¹⁴

Further, Justice Mosk correctly observed that Saderup’s art receives constitutional protection even though it is entertainment rather than information, is a nonverbal, visual representation, conveys “no discernable message” and appears primarily on T-shirts, a “less conventional avenue of communications.” Those parts of the decision’s analysis reflect strong respect for full First Amendment protection for visual art in all forms.

On the other hand, the court also found that not all expression receives full First Amendment protection. Justice Mosk discussed some interests furthered by the right of publicity. First, he described the right of publicity as “a form of intellectual property that society deems to have some social utility,” in that it protects the investment of considerable money, time and energy as well as creative labor, concluding that whether viewed as a natural property right or an incentive for encouraging creative work, it reflects a “legitimate protectable interest”. Thus, “the Legislature has a rational basis for permitting celebrities and their heirs to control the commercial exploitation of the celebrity’s likeness.”¹¹⁵

The decision proceeds to address the conflict between these two sets of interests. Justice Mosk discussed with approval *Zachini*, *Guglielmi v. Spelling-Goldberg Productions*, and *Russen*,¹¹⁶ describing them as cases applying balancing tests to distinguish appropriations that constitute protected speech from those that are unprotected by the constitution, “concluding that depictions of celebrities amounting to little more than the appropriation of the celebrity’s

¹¹³ *Id.*

¹¹⁴ *Id.* at 804.

¹¹⁵ *Id.* at 805.

¹¹⁶ *Zachini*, which will be discussed in more detail below, held that the First Amendment does not preclude a right of publicity claim against a newscaster that filmed and broadcast a “human cannonball’s” entire act. *Guglielmi* found that a fictionalized film about a deceased celebrity did not violate his right of publicity. Although the majority decision in that case based its conclusion on the non-descendibility of the common-law right, Justice Bird in her concurrence articulated a vigorous First Amendment defense of such uses of persona, which Justice Mosk cited with approval in *Saderup*. *Russen* found that an Elvis Presley impersonator show violated the right of publicity and other rights of Elvis Presley’s estate.

economic value are not protected expression under the First Amendment.”¹¹⁷ On the other hand, Justice Mosk criticized the district court decision in *Groucho Marx Productions, Inc. v. Day & Night Co.*¹¹⁸ for not giving “due consideration to forms of creative expression protected by the First Amendment that cannot be categorized as ideas or information.” Moreover, he criticized that decision for seemingly limiting the First Amendment defense to parody and not recognizing that a non-parodic use in a new theatrical work “to advance various creative objectives” would be protected by the First Amendment.

Justice Mosk then attempted to develop a test to distinguish protected from unprotected expression in right of publicity cases. First, he noted that the right of publicity cannot be used to “censor disagreeable portrayals.” Rather than a tool for censorship, the right of publicity is “a right to prevent others from misappropriating the economic value generated by the celebrity’s fame through the merchandising” of the elements of persona covered under the statute.

Next, the court considered importing the fair use defense from copyright law to distinguish protected from unprotected speech. Justice Mosk noted the “advantage of employing an established doctrine developed from a related area of the law,” but also noted criticism of that approach, namely the “murkiness of the fair use doctrine” and the fact that the idea/expression dichotomy is the primary method for reconciling copyright with First Amendment rights.¹¹⁹

Accordingly, the court concluded that “a wholesale importation of the fair use doctrine into right of publicity law would not be advisable.” Justice Mosk noted that two fair use factors, “the nature of the copyrighted work”¹²⁰ and “the amount and substantiality of the portion used,”¹²¹ were not particularly useful in the context of right of publicity claims. Moreover, he indicated that another factor, “the effect of the use upon the potential market for or value of the copyrighted work” seemed “irrelevant,”¹²² and potentially circular (meaning that if a defendant

¹¹⁷ *Id.*

¹¹⁸ 523 F. Supp. 485 (SDNY, 1981), *rev’d*, 689 F.2d 317 (2d Cir., 1982). This case involved a right of publicity claim by a company that owned Marx Brothers’ persona rights against a live stage production. The district court found that the play violated their rights of publicity under New York law and was not a parody protected by the First Amendment. On appeal, the Second Circuit reversed, based on its application of California law, under which the common law right of publicity was not descendible. The appellate court did not have to reach the First Amendment issue, but suggested that the First Amendment defense was strong. 689 F.2d, at 319 n. 2.

¹¹⁹ *Id.* at 807.

¹²⁰ 17 U.S.C. § 107.

¹²¹ *Id.*

¹²² *Saderup*, 21 P.3d at 809, n.10.

succeeds in creating a market for her work, it would also inevitably be a potential market for the celebrity and the factor would weigh against fair use).

Instead, the court focused on the first fair use factor, “the purpose and character of the use,” and in particular considered “whether the new work merely ‘supersede[s] the objects’ of the original creation...or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.”¹²³ Thus, the inquiry focuses on whether the new work is “transformative,” which Justice Mosk characterized as “necessarily at the heart of any judicial attempt to square the right of publicity with the First Amendment.” Indeed, because the common goal of the First Amendment, copyright and the right of publicity is to protect

the creative fruits of intellectual and artistic labor...When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.¹²⁴

By contrast, when a work “contains significant transformative elements” it is “especially worthy of First Amendment protection” and “less likely to interfere with the economic interest protected by the right of publicity.”¹²⁵ For example, parodies or “other distortions of the celebrity figure” are not likely to be good substitutes for authorized celebrity memorabilia, so the First Amendment outweighs the state protected right of publicity interest as to such a portrayal.

The court discussed *Cardtoons v. Major League Baseball Players Assn*¹²⁶ as an example of appropriate balancing in the context of a parodic use of celebrity persona, but emphasized that constitutionally protected “transformative elements or creative contributions” are not limited to parody and can include a range of forms, from “factual reporting”¹²⁷ to “fictionalized

¹²³ *Id.* at 808 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (citations omitted in original)).

¹²⁴ *Id.*

¹²⁵ *Id.*

¹²⁶ 95 F.3d 959 (10th Cir., 1996). *Cardtoons* was a declaratory judgment action by the producer of parody sports trading cards seeking a judgment that the cards did not infringe the players’ right of publicity. The lower court’s judgment in favor of *Cardtoons* was affirmed on First Amendment grounds.

¹²⁷ *Id.* at 809 (citing *Rosemont Enters., Inc. v. Random House, Inc.*, 294 N.Y.S.2d 122, 129 (Sup. Ct. 1969)).

portrayal”¹²⁸ and “heavy-handed lampooning”¹²⁹ to “subtle social criticism.”¹³⁰ Attempting to restate the transformativeness test, Justice Mosk further described it as:

Whether the celebrity likeness is one of the “raw materials” from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question...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...expression of something other than the likeness of the celebrity.¹³¹

Justice Mosk instructed courts not to concern themselves with the quality of an artist’s contribution, which might be protected even if vulgar but might be actionable if a “literal depiction...even if accomplished with great skill.” He went on to describe the test as “more quantitative than qualitative...whether the literal and imitative or the creative elements predominate in the work.”¹³²

Further elaborating a “subsidiary inquiry”¹³³ for “close cases,”¹³⁴ Justice Mosk directed consideration of whether “the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted”¹³⁵ or whether the value instead derives from “the creativity, skill and reputation of the artist.”¹³⁶ If the latter, sufficient transformative elements may be presumed.¹³⁷ If the former, though, the work may still be protected if it is otherwise transformative.¹³⁸ Justice Mosk described the transformativeness test as an affirmative defense that defendant artists may raise.¹³⁹

¹²⁸ *Id.* (citing *Guglielmi v. Spelling-Goldberg Prod.*, 603 P.2d 454, 461 (Cal. 1979) and *Parks v. LaFace Records*, 76 F. Supp. 775, 779-782 (E.D. Mich. 1999)).

¹²⁹ *Id.* (citing *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988)).

¹³⁰ *Id.* (referring to Andy Warhol’s portraits).

¹³¹ *Id.*

¹³² *Id.* Justice Mosk did not indicate how one may quantify “imitative” or “creative” elements. With reference to this elaboration of the transformativeness test, the court referred to the district court decision in *ETW Corp. v. Jireh Publishing, Inc.*, 99 F. Supp. 2d 829, 835-36 (N.D. Ohio 2000), and stated that it disagrees with that decision if it means that any work of art is categorically shielded from liability by the First Amendment. *Saderup*, 21 P.3d at 809, n.11.

¹³³ *Saderup*, 21 P.3d at 810.

¹³⁴ *Id.*

¹³⁵ *Id.*

¹³⁶ *Id.*

¹³⁷ *Id.*

¹³⁸ *Id.*

¹³⁹ *Id.*

The court proceeded to consider how this approach would apply to Saderup's reproduction of his sketch of the Three Stooges. Justice Mosk first criticized the lower courts' apparent holding that reproductions of celebrity images are per se outside First Amendment protection, saying that such a holding "has no basis in logic or authority."¹⁴⁰ Much as a published book does not receive reduced First Amendment protection because it is reproduced in multiple copies, reproductions of celebrity images are entitled to as much First Amendment protection as the original, if the work "contains significant creative elements."¹⁴¹

Next, the court rejected Saderup's argument that all portraits involve creative decisions and are entitled to First Amendment protection, stating 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, then the artist's right of free expression is outweighed by the right of publicity." Shifting to another copyright law analogy, to be protected, an artist must contribute "more than a 'merely trivial' variation...something recognizably 'his own'."¹⁴² The court described silk-screens of Andy Warhol's celebrity portraits as examples of art reproductions that would satisfy the proposed test. Warhol's "distortion" and "careful manipulation of context" conveyed "a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself."¹⁴³

The court acknowledged that the proposed distinction will sometimes be subtle, but no more so than other First Amendment distinctions, such as whether a purportedly obscene work lacks serious artistic value.

Finally, the court applied the transformativeness test to Saderup's portrait of the Three Stooges. In two brief paragraphs, the court concluded that the portrait had "no significant transformative or creative contribution."¹⁴⁴ Although the court recognized that Saderup was skilled, his overall goal was to create "literal, conventional depictions...so as to exploit" the Three Stooges' fame. To accord First Amendment protection for such a depiction would leave

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

¹⁴² *Id.* at 810-11 (citing *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976)). In copyright law, this is a test for whether a work based on another work is protectable as a derivative work. It is an extremely low threshold, and there is no doubt that Saderup's portrait would qualify for copyright protection under this standard.

¹⁴³ *Id.* at 811 (citing a work by an art critic and a novelist's fictional account of how a character was impacted by Warhol's Mao Tse Tung portrait).

¹⁴⁴ *Id.*

nothing to the right of publicity but claims for false endorsement. In addition, the court said, “the marketability and economic value of Saderup’s work derives primarily from the fame of the celebrities depicted.”¹⁴⁵ As to Saderup’s argument that the First Amendment should not protect parodic depictions while leaving reverential portraits unprotected, the court said that the transformativeness test “does not express a value judgment or preference for one type of depiction over another. Rather, it reflects a recognition...that certain forms of expressive activity fall outside” the boundaries of celebrities’ property right in their images. Justice Mosk claimed not to be concerned with whether “conventional” images would be produced, but rather with “who appropriates the value from their production.”¹⁴⁶ Thus, Saderup would need Comedy III’s consent to continue to depict the Three Stooges.

Summarizing the decision, the court’s reference to the “rational basis” for the right of publicity might suggest that it applied a balancing test applying minimal scrutiny to a challenged law. Where a government regulation is aimed at the noncommunicative impact of activity, courts engage in ad hoc balancing, and the regulation survives scrutiny so long as it does not “unduly constrict the flow of information and ideas.”¹⁴⁷ “Although the court’s language suggested that it applied a balancing test typically used is assessing the constitutionality of laws with no communicative impact, it actually created and applied a categorical test, namely, the transformativeness test. Under that test, if a court concludes that an artistic work either (i) contains significant creative elements or advances creative objectives such as parody or caricature and is not merely a literal, albeit highly skilled, depiction of a celebrity, or (ii) would be valued principally because of the creativity, skill or reputation of the artist rather than from the fame of the celebrity depicted, then the work would be considered transformative. If the work is transformative, the sale of reproductions of that work is fully protected by the First Amendment and does not violate the right of publicity.

Given the recognized stature of art as speech and the protected status of commercial dissemination of speech, the California court was in a difficult position in *Saderup*. If it were to find Saderup’s exploitation of his art protected by the First Amendment, it is possible that other celebrity merchandise embodying an image of the celebrity would also be protected as speech and an enormous source of celebrity wealth recognized for decades would be lost. Yet to deny

¹⁴⁵ *Id.*

¹⁴⁶ *Id.*

¹⁴⁷ *TRIBE, AMERICAN CONSTITUTIONAL LAW* § 12-2, 791-92.

absolutely constitutional protection for the creation and distribution of an artistic rendering would be inconsistent with substantial Supreme Court precedent. Therefore, the California Supreme court attempted to develop a middle ground—a categorical test under which some art would be fully protected speech under the First Amendment, but other art would be treated as mere merchandise. The court took that test from the fair use defense in copyright law. Rather than importing that defense wholesale into right of publicity law, it selected a single aspect of the defense that asks whether or not the challenged work is “transformative,” that is, does it merely serve the same purpose as the original or does it instead add something “new, with a further purpose or different character, altering the first with new expression, meaning, or message.” The court determined that Saderup’s sketch was not transformative because it was merely an artistically rendered realistic image of the Stooges. Hence, under this analytical approach, the sketch was treated not as art, but as mere merchandise, so the Stooges’ publicity rights outweighed the expressive value of the sketch.

III. CRITIQUES OF THE TRANSFORMATIVENESS TEST

The California Supreme Court decision included some holdings that are of great value to creators and disseminators of expressive works; namely its recognition that art can be protected speech without a discernable message and its endorsement of Justice Bird’s concurrence in *Guglielmi*. But the test that it requires in a conflict between right of publicity owners and artists is unworkable, unwise and inadequate to satisfy constitutional requirements under current First Amendment jurisprudence.

A. The Transformativeness Test is Unworkable

The test is unworkable for several reasons. First, fair use doctrine in copyright law is murky and unpredictable. Second, because it is difficult and unpredictable, courts tend to focus on one or another of a non-exclusive set of factors described in the copyright statute, converting it into a categorical test, and manipulating the category du jour to achieve what they perceive to be a fair result. The category du jour in copyright fair use analysis is transformativeness, and it has not done a good job prescriptively or normatively in copyright. It is reasonable to expect

that courts applying the *Saderup* test will fare similarly. A brief review of the development and current state of fair use analysis illustrates both of these points.

1. Fair Use is Unpredictable in Copyright Law

Judges developed fair use in the 19th century¹⁴⁸ to address the problem that most if not all works of authorship are not novel, but rather use existing expression.¹⁴⁹ To further the fundamental goal of copyright, which is to encourage the production of works of authorship for the benefit of the public,¹⁵⁰ copyright required limiting doctrines that would permit others to use existing works in some ways without infringing.¹⁵¹ The current fair use doctrine, which is codified in the Copyright Act of 1976, is often traced back to Justice Story's decision in an 1841 case, *Folsom v. Marsh*.¹⁵² In that decision, Justice Story articulated several considerations, now among the factors expressly described in §107 of the Copyright Act: the purpose and character of the use, the nature of the plaintiff's work, the amount and substantiality of the portion used and the effect on the potential market and value of the work used.¹⁵³ These factors are not necessarily exclusive, although as a practical matter, judges rarely explicitly raise other factors in copyright cases.¹⁵⁴ Balancing these factors is no easy task and in most cases the outcome is unpredictable. Indeed, the legislative history of the 1976 Copyright Act acknowledged this in stating, "no generally applicable definition is possible, and each case raising the question must be decided on its own facts,"¹⁵⁵ and "the endless variety of situations and combinations of

¹⁴⁸ William F. Patry & Shira Perlmutter, *Fair Use Misconstrued: Profit Presumptions, and Parody*, 11 CARDOZO ARTS & ENT. L.J. 667, 668 (1993).

¹⁴⁹ Pierre N. Leval, *Nimmer Lecture: Fair Use Rescued*, 44 UCLA L. REV. 1449, 1450 (1997). See generally Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965 (1990) (examines the public domain by looking at the gulf between what authors really do and the way the law perceives them).

¹⁵⁰ *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975); see *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 349 (1991) (primary objective of copyright is not to reward labor of authors but to promote progress of knowledge by permitting authors to build on others' work).

¹⁵¹ Lloyd L. Weinreb, *Fair Use and How it Got That Way: The 1998 Donald C. Brace Memorial Lecture Delivered at Fordham University School of Law on November 12, 1998*, 45 J. COPYRIGHT SOC'Y U.S.A. 634, 635-36 (1998).

¹⁵² *Id.* at 634.

¹⁵³ 17 U.S.C. § 107.

¹⁵⁴ But see WILLIAM PATRY, *THE FAIR USE PRIVILEGE IN COPYRIGHT LAW* 415 (2d ed. 1995) (suggesting some additional factors that courts have considered). At least some of these additional factors could also be viewed as considerations respecting the listed § 107 factors. See Patry & Perlmutter, *supra* note 159, at 685.

¹⁵⁵ H.R. Rep. 94-1476, 65.

circumstances that can arise in particular cases precludes the formulation of exact rules in the statute.”¹⁵⁶

The Supreme Court issues relatively few copyright decisions, yet there are three Supreme Court decisions addressing the fair use defense since 1978, the effective date of the 1976 Copyright Act.¹⁵⁷ This illustrates the difficulty and controversiality of fair use cases. Each of those decisions reversed an appellate decision that in turn had reversed a district court decision. Until the third of those cases, the Court itself was divided. Obviously, reasonable minds can differ substantially in the application of the fair use factors to a particular set of facts.

2. Courts Try to Simplify Fair Use Analysis By Emphasizing Single Definitional Elements

Courts struggle with fair use analysis, sometimes emphasizing a particular element of the defense that seems more easily weighed than a combination of sometime countervailing factors.¹⁵⁸ This is also illustrated by the Supreme Court’s fair use decisions. In the first of the Supreme Court decisions after the 1976 Copyright Act, the Court suggested that a commercial use would be presumptively unfair, both as an aspect of the purpose and character of the use and the effect on potential markets for the work used.¹⁵⁹ Predictably, fair use cases decided after that emphasized the commerciality of the defendant’s use.¹⁶⁰

The second of those Supreme Court decisions focused on the unpublished nature of the work used. It considered that a key factor, along with the commerciality presumption from *Sony* and the effect on potential markets for the plaintiff’s work, which it described as “undoubtedly the single most important element of fair use.”¹⁶¹ For a time, lower courts emphasized commerciality or, where applicable, that the plaintiff’s work was unpublished.¹⁶² Indeed, the emphasis on the plaintiff’s work’s publication status after that case led Congress to amend §107 to expressly state that that is not a determinative factor.¹⁶³

¹⁵⁶ S. Rep. 94-473, 62.

¹⁵⁷ See *Sony Corp. of Am. v. Universal Studios, Inc.*, 464 U.S. 417 (1984); *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

¹⁵⁸ See Patry & Perlmutter, *supra* note 159, at 667-71.

¹⁵⁹ *Sony*, 464 U.S. at 429.

¹⁶⁰ Patry & Perlmutter, *supra* note 159, at 670-71.

¹⁶¹ *Harper & Row*, 471 U.S. at 566.

¹⁶² See PATRY, *supra* note 165, at 544-47.

3. The Supreme Court Criticized Single-Factor Fair Use Approaches, But Emphasized Transformativeness

The third of those Supreme Court cases, *Campbell v. Acuff-Rose Music*, is particularly important for three reasons. First, the decision reminded courts that fair use is “not to be simplified with bright-line rules,” but instead requires case-by-case analysis, with a consideration of all the factors, which are to be “weighed together, in light of the purposes of copyright.” Second, the Court criticized the emphasis on commerciality of the use derived from *Sony*. Indeed, the Court found that the appellate court had erred by giving “virtually dispositive weight” to the commerciality factor. Third, the Court directed attention to whether or not the defendant’s work is “transformative.” Thus, in considering the fair use defense, courts should determine whether the defendant’s work “merely supercede[s] the objects” of the plaintiff’s work or whether it instead “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.”¹⁶⁴

Ironically, lower courts facing fair use defenses after *Campbell* have placed substantial, if not determinative, emphasis on whether or not the defendant’s work is transformative. Scholars have noted this and criticized the excessive focus on transformativeness, which “seems to have merely pumped more silt into already muddy waters.”¹⁶⁵ Moreover, a finding of non-transformativeness is also often used to create a presumption of likely harm to a potential market. This creates a similar “double whammy” to the *Sony* commerciality approach as applied by lower courts, where both the nature and purpose of the use factor and the effect on the market factor were virtually determined by the commerciality of the use.¹⁶⁶ That is the very approach rejected by the Court in *Campbell*.

4. Single-Factor Definitional Balancing is Not a Good Approach

¹⁶³ Act of October 24, 1992, Pub. L. No. 102-492, 102d Cong., 2d Sess., 106 Stat. 3145.

¹⁶⁴ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

¹⁶⁵ Diane Leenheer Zimmerman, *The More Things Change, the Less They Seem “Transformed”: Some Reflections on Fair Use*, 46 J. COPYRIGHT SOC’Y USA 251 (1998); see also Matthew D. Bunker, *Eroding Fair Use: The “Transformative” Use Doctrine After Campbell*, 7 COMM. L. & POL’Y 1 (2002).

¹⁶⁶ See Laura Lape, *Transforming Fair Use: The Productive Use Factor in Fair Use Doctrine*, 58 ALB. L. REV. 677 (1995). Even Judge Leval, who was a primary advocate of the transformative use concept, noted this. See Pierre

One may conclude from this that fair use analysis presents a dilemma. On the one hand, where fair use involves consideration of numerous factors on a case-by-case basis and its delicate and nuanced weighing of those factors, it reflects an important concern with balancing the social interests embodied in copyright law.¹⁶⁷ But that balancing leads to unpredictable and murky results. On the other hand, focusing determinative weight on a particular factor simplifies the analysis for judges and gives an impression of greater predictability, but gives undue emphasis to isolated aspects of the delicate social balance.¹⁶⁸ Indeed, in some cases focusing on a particular factor permits courts to manipulate the definition of that factor to achieve what they view is a fair result, but without discussion of other important considerations.¹⁶⁹ One writer has described post-*Acuff-Rose* decisions as “a strategy that tends to overprotect copyright owners at the expense of the free flow of information.”¹⁷⁰

Saderup exemplifies this dilemma. Faced with a challenge to a type of speech entitled to strong First Amendment protection for the sake of a relatively new subspecies of intellectual property, the court looked for relief to the fair use doctrine. Noting problems with that doctrine, partly in its murkiness and partly the lack of a good fit between the factors developed to assess a different conflict—that between two works of authorship—from the one at issue, the court chose one particular factor out of the fair use bundle: transformativeness. But transformativeness has been unpredictable in copyright cases and is not likely to fare much better in the new context of publicity rights versus artistic expression. It is a slender, effervescent wall to protect freedom of expression.

Moreover, a focus on transformativeness makes even less sense in right of publicity cases than it does in copyright cases. This is because requiring the defendant’s work to incorporate new expression in order to avoid liability for copyright infringement furthers the core purpose of copyright law itself, which is to encourage the production of new expressive works. Indeed, that aspect of copyright law combined with copyright’s idea/expression dichotomy supports viewing copyright as the “engine of free expression,”¹⁷¹ consistent with First Amendment goals. If the transformativeness concept were limited to the context of conflicts between celebrities or

Leval, *Copyright in the Twenty-First Century: Campbell v. Acuff-Rose: Justice Souter’s Rescue of Fair Use*, 13 CARDOZO ARTS & ENT. L. J. 19 (1994); see also Bunker, *supra* note 176, at 1.

¹⁶⁷ Patry & Perlmutter, *supra* note 159, at 719.

¹⁶⁸ Lloyd L. Weinreb, *Fair’s Fair: A Comment on the Fair Use Doctrine*, 103 HARV. L. REV. 1137, 1160-61 (1990).

¹⁶⁹ Bunker, *supra* note 176, at 24.

¹⁷⁰ *Id.* at 1.

performers, it might arguably further the goal of encouraging creativity in the creation of personae or performance works. Indeed, it was just such cases that the *Saderup* court used to support the transformativeness test.¹⁷²

But when transplanted to right of publicity cases involving a conflict between a persona claimant and a visual artist, transformativeness does not affect that goal. Instead, it could limit the creation of new expressive works of visual art by prohibiting the reproduction and sale of copies of artworks unless they are clearly transformative in the right of publicity sense. *Saderup*'s drawing of the Three Stooges would clearly merit copyright protection—there was no evidence that his drawing did not reflect original creation. But because it was a realistic depiction of the Stooges, selling reproductions was held to be unlawful. Hence, unlike in the case of using transformativeness as a factor in a copyright fair use analysis, requiring transformativeness to protect visual art as speech may protect celebrity economic interests, but it does not further originality in the creation of new personae or in the creation of expressive works of authorship.

B. Important Additional Copyright Law Mechanisms Protecting First Amendment Interests That Are Absent From Right of Publicity

The transformativeness test is unwise for another reason. Copyright law includes several other important mechanisms in addition to fair use that protect First Amendment interests, but those mechanisms are unavailable in right of publicity cases.

The fair use defense does have the effect in some copyright cases of protecting First Amendment interests. The use of quotations in critical reviews or use of material in a work parodying another work are examples of the kinds of works where copyright without the fair use doctrine would frustrate freedom of expression. But there are at least two other important mechanisms internal to copyright law that protect that freedom: the exclusion of “ideas” and

¹⁷¹ *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985).

¹⁷² The cases discussed by the *Saderup* court in support of the proposition that the First Amendment does not preclude right of publicity claims were *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977), *Guglielmi v. Spelling-Goldberg Prod.*, 603 P.2d 454, 461 (Cal. 1979), *Estate of Elvis Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981), and *Groucho Marx Prods., Inc. v. Day & Night Co.*, 523 F. Supp. 485 (S.D.N.Y. 1981). *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 805-07 (Cal. 2001). *Zachini* involved the literal taking of a performance, and the other cases involved claims against theatrical imitations.

“facts” from copyright protection (“idea/fact-expression dichotomy”) and the requirement of originality for copyright protection.¹⁷³

1. Idea/Expression Definitional Balancing in Copyright Law

For at least the last thirty years, the most important doctrine protecting free speech interests in copyright law has been thought to be the idea/fact-expression dichotomy.¹⁷⁴ That means that copyright protects an author’s expression but not the underlying ideas or facts.

The leading commentator on copyright law, Mel Nimmer, recognized the First Amendment role of the idea/fact-expression dichotomy in a 1970 law review article.¹⁷⁵ In that article, and in his formative treatise, Prof. Nimmer noted the potential for conflict between copyright and the First Amendment, and criticized the then-current approach of addressing first amendment conflicts in other fields by ad hoc balancing of the free speech and non-speech interests in a particular case. His critique was that ad hoc balancing leads to unpredictability and a consequent chilling of potential speech because of uncertainty about the weight that a court will accord to particular speech when it is judicially tested. Instead, drawing on the Supreme Court’s approach in obscenity, privacy and defamation cases, Nimmer advocated a form of “definitional” balancing. In definitional balancing, the court creates a category to distinguish speech that is protected from that which is not. Applying that approach to copyright, Professor Nimmer found such a category in the idea/fact-expression dichotomy. The right of the copyright owner does not extend to the “ideas” or “facts” embodied in a work, but only to the particular “expression” of those ideas or facts.¹⁷⁶ Of course, the protection of expression extends beyond

¹⁷³ Durational limits that place expression in the public domain after a limited time might also function to protect First Amendment interests. The increased duration of copyright has limited the value of that mechanism. In its recent decision in *Eldred v. Ashcroft*, 2003 WL 118221 (2003), the Supreme Court de-emphasized the importance of durational limits as a mechanism protecting the First Amendment and emphasized the other mechanisms discussed here. *Id.* at *57-*61. Current durational limits on the right of publicity do little to protect access to personae for expressive uses. Many states permit the right to survive death. Some states even greatly exceed the copyright term, protecting the right for 100 years after death, IND. CODE (2002); OKLA. STAT. tit. 12, § 1448(G) (2002), for an unspecified period of time, NEB. REV. STAT. § 20-208 (2002), or even forever, so long as the right continues to be exploited, TENN. CODE ANN. (2002). Professor Roberta Kwall, who has written in defense of the right of publicity, has recognized the descensible right of publicity’s potential negative impact on freedom of speech. KWALL, PROPERTY/LIABILITY RULE 83-85. She has suggested that a period of twenty years after death is reasonable.

¹⁷⁴ See, 2003 WL 118221 at *58.

¹⁷⁵ Melville Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and the Press?*, 17 UCLA L. REV. 1180 (1970).

¹⁷⁶ 17 U.S.C. § 102.

absolute literal identity to permit the copyright owner to prevent non-literal copying if it is close enough to the copyright owner's expression. Thus the uncertainty inherent in an ad hoc balancing approach is replaced with uncertainty in determining where the idea ends and its expression begins, creating potential chilling effects.¹⁷⁷ Still, the idea/expression distinction serves to protect free speech interests over and above the fair use defense and courts have looked to this definitional balancing as an explanation for why copyright laws do not per se violate the First Amendment.¹⁷⁸

By contrast, there is no similar mechanism to protect freedom of expression in right of publicity law.¹⁷⁹ Indeed, courts in right of publicity cases have extended the subject matter protected by the right to include anything that reminds the viewer of the right of publicity claimant.¹⁸⁰ Although that trend has been criticized, the right of publicity tends to protect not just the specific details of a celebrity's persona, but a general embodiment of the celebrity's persona, his or her "idea."¹⁸¹

2. Originality as a Mechanism Protecting First Amendment Interests

A second internal mechanism protecting free speech interests in copyright law is the requirement of originality.¹⁸² Only original works of authorship are subject to copyright protection.¹⁸³ Originality does not mean novelty or a high degree of creativity, but only that a

¹⁷⁷ See Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's "Total Concept and Feel,"* 38 EMORY L. J. 393 (1989). Recently, scholars have increasingly criticized Professor Nimmer's position that the idea/expression definitional balancing approach adequately addresses conflicts between copyright law and freedom of speech. See, e.g., Neil W. Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1 (2001) (enumerating the fundamental changes in copyright and First Amendment doctrine that transpired since 1970 and that rendered much of Nimmer's argument out of date).

¹⁷⁸ See, e.g., cases cited in 2 SMOLLA, *supra* note 16, at § 21:5, 21-13 n.22.

¹⁷⁹ Perhaps anticipating this argument, the Screen Actors Guild in its Amicus brief argued that "the personhood of an actor" is an expression, not an idea, and that Saderup could employ other means to express his message, if any, without using a likeness or image protected by §990. This is seemingly contradicted by its recognition that §990 restricts use of "certain icons." Brief of Amici Curiae Screen Actor's Guild at ___, *Saderup* (No. S076061).

¹⁸⁰ See, e.g., *White v. Samsung*, 971 F.2d 1395 (C.D. Cal. 1992) (holding that robot was not celebrity's "likeness" 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).

¹⁸¹ The *Saderup* decision itself has been criticized for coming "perilously close" to granting celebrities property rights in their ideas. 2 SMOLLA, *supra* note 16, at § 21:5, 21-8.1.

¹⁸² Yen, *supra* note 187, at 435. See also Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 1020 (1970).

¹⁸³ 17 U.S.C. § 102.

work has not been copied from another and shows a minimal degree of human creative effort.¹⁸⁴ However, courts reject copyright protection for works on the basis of lack of originality. Although this mechanism may not be as significant as the idea/fact-expression dichotomy, it does help to preserve the public domain, thus serving the interests of freedom of expression.

There is no such requirement in right of publicity law. One might argue that every face is original, so there is no need for a concept like originality to maintain a public domain and to encourage creation of new expression, as in copyright law. First, that argument does not rebut the proposition that right of publicity laws lack internal mechanisms to protect free speech found in copyright law. Second, the proposition that every face is original is not true, at least in the context of right of publicity. Cases enjoining “celebrity look-alikes” demonstrate that.¹⁸⁵ Moreover, in the context of a proprietary right of publicity, it is as much the persona as the face per se that is protected.¹⁸⁶ One might not recognize Madonna shopping on a street in Los Angeles, out of makeup, out of her persona. The Madonna more likely to be protected by the right of publicity is a persona, somewhat like an audiovisual character. The right of publicity accords rights to her with respect to that persona without any requirement that it be original. For example, it may well be that Madonna’s early persona was derivative of Marilyn Monroe or Jane Mansfield, platinum blond sex kittens of a prior generation. Yet there is no reported case rejecting a right of publicity claim on the basis that the claimant’s persona was unoriginal, that is, lacking minimal creativity and copied or derived from someone else. Thus, the right of publicity lacks originality as a mechanism to protect freedom of expression.

Because the right of publicity lacks these additional internal mechanisms to protect freedom of expression, it is more important to recognize external first amendment limitations on the right of publicity than it is in copyright. It is unlikely that a single isolated category derived from the fair use defense will be adequate to the task.

IV. FIRST AMENDMENT ASSESSMENT OF THE TRANSFORMATIVENESS TEST

¹⁸⁴ See *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340 (1991).

¹⁸⁵ See *Onassis v. Christian Dior*; *Allen v. National Video, Inc.*, 601 F. Supp. 612 (S.D.N.Y. 1985); *Fat Boys*. In *Carson v. Here’s Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983), the use of a common unoriginal name “Johnny” was found to violate Johnny Carson’s right of publicity, at least in the context of the phrase “Here’s Johnny,” associated with Carson.

If the transformativeness test is subjected to the Supreme Court's modern approach to assessing the constitutionality of state laws regulating speech, it should be found unconstitutional.

A. *First Amendment Assessment of Laws Regulating Speech*

It is a gross understatement to say that First Amendment jurisprudence is extremely complex and is constantly changing.¹⁸⁷ This brief overview is an oversimplification, but will serve to provide a framework for addressing the conflict between freedom of expression and the right of publicity in the context of the distribution of image copies, and a critique of the transformativeness test articulated by the California Supreme Court.

Since at least the 1970's, the Supreme Court generally applies a complex combination of categorical and balancing tests to determining the constitutionality of state laws restricting speech.¹⁸⁸ First, it is determined whether the law abridges speech enough to be subject to first amendment scrutiny. Some laws have such an incidental impact on expressive speech that they are not subject to further scrutiny.¹⁸⁹

Second, if the law is subject to scrutiny, the Court looks to see if the law is content-based or content-neutral.¹⁹⁰ Content-based laws are those that place different burdens on speech depending on its subject matter, communicative impact or viewpoint.¹⁹¹ If it is content-based, the law will be subject to heightened scrutiny, essentially a balancing test heavily weighted against the law.¹⁹² Although there are various types of heightened scrutiny, the default approach is the strict scrutiny approach: a content-based regulation is unconstitutional unless it furthers a compelling government interest and is narrowly tailored to protect that interest.¹⁹³

¹⁸⁶ After all, if, as stated by the Supreme Court in *Zachini*, the rationale for the right of publicity is to provide incentives for activities resulting in celebrity, one does not require an incentive to have a face.

¹⁸⁷ See 1 SMOLLA, *supra* note 16, at § 2:64, 2-65.

¹⁸⁸ See Netanel, *supra* note 187, at 31-32.

¹⁸⁹ See *id.* at 45-46 (listing, for example, regulation of securities filings, warranties in consumer contracts and blackmail).

¹⁹⁰ See Geoffrey R. Stone, *Content Regulation and the First Amendment*, 25 WM. & MARY L. REV. 189 (1983); Erwin Chemerinsky, *Content Neutrality as a Central Problem of Freedom of Speech: Problems in the Supreme Court's Application*, 74 S. CAL. L. REV. 49 (2000).

¹⁹¹ Chemerinsky, *supra* note 206, at 51.

¹⁹² 1 SMOLLA, *supra* note 16, at § 2:66, 2-66; Stone, *supra* note 99, at 47-48.

¹⁹³ See *id.* §§ 4:1-4:2, at 4-2 to 4-2.1.

However, a few categories of content (and speech occurring within certain settings) are either excluded from protection as speech¹⁹⁴ or, when regulated, are subject to specialized analyses or less rigorous balancing analyses.¹⁹⁵ Examples of those categories of content include obscene speech, factually false speech, speech inciting immanent unlawful conduct, “fighting words” and commercial speech.¹⁹⁶

Content-neutral laws regulate expression without considering its viewpoint, subject matter or the communicative impact of its content.¹⁹⁷ Put another way, “[g]overnment regulation of expressive activity is content neutral so long as it is ‘justified without reference to the content of the regulated speech.’”¹⁹⁸

If the law is determined to be content-neutral, then the Court applies one or another of several types of balancing tests, some of which are quite deferential to the law and others of which come very close to strict scrutiny.¹⁹⁹ *United States v. O’Brien*,²⁰⁰ the case in which this approach was first articulated, dealt with the constitutionality of a statute forbidding conduct, the destruction of draft cards, as applied to an individual who burned his draft card as “symbolic speech,” namely, a protest against the Vietnam War. In the context of a law addressed at conduct which incidentally might have speech elements, the Court upheld the law because it “furthers an important or substantial governmental interest...unrelated to the suppression of free expression; and...the incidental restriction on alleged First Amendment freedoms is no greater than is essential to the furtherance of that interest.”²⁰¹

This means-end scrutiny has been applied beyond regulations of conduct with incidental impact on speech to content-neutral restrictions on fully-protected expression and even to content-based regulation of commercial speech, a category of speech viewed as requiring less than heightened scrutiny.²⁰² For example, in *Ward v. Rock Against Racism*,²⁰³ the Court upheld a

¹⁹⁴ E.g. obscenity. See *Miller v. California*, 413 U.S. 497 (1987). See 1 SMOLLA, *supra* note 16, at § 2:69, 2-27.

¹⁹⁵ SMOLLA, *supra* note 16, at §§ 2-71-2:72.

¹⁹⁶ *Simon & Schuster v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 124, 127 (1991) (Kennedy, J., concurring in result, naming categories of speech regulation of which is not presumptively invalid). See Stone, *supra* note 206, at 194-95.

¹⁹⁷ Stone, *supra* note 99, at 48.

¹⁹⁸ *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989) (citing *Clark v. Cmty. for Creative Non-Violence*, 468 U.S. 288, 293 (1984)).

¹⁹⁹ Stone, *supra* note 99, at 48-49.

²⁰⁰ 391 U.S. 367 (1968).

²⁰¹ *Id.* at 377.

²⁰² Keith Werhan, *The O’Briening of Free Speech Methodology*, 19 ARIZ. ST. L.J. 635, 637 (1987).

²⁰³ 491 U.S. 781 (1989).

content-neutral city regulation requiring the use of certain sound-amplification equipment and operators in a bandshell in New York's Central Park. The Court viewed the regulation as a reasonable restriction on the time, place or manner of protected speech. It was justified without reference to the content of the regulated speech, was narrowly tailored to serve a significant government interest and left open "ample alternative channels for communication of the information,"²⁰⁴ a key requirement for valid time, place or manner restrictions.²⁰⁵ Note that the means chosen to regulate need not be the least restrictive means available,²⁰⁶ but only if the regulation is a truly content-neutral regulation of time, place or manner, i.e., not justified by reference to the content of the regulated speech.²⁰⁷

A similar intermediate scrutiny, means-end balancing methodology has been applied in considering regulation of commercial speech. Because proponents of the right of publicity have argued that commercial speech analysis should apply in claims against image copies,²⁰⁸ a brief discussion of commercial speech doctrine is appropriate here. Regulations of commercial speech per se are content-based, yet the Court has been slow to grant the same level of protection as that required of most other content-based regulation. Still, recent cases suggest that even commercial speech regulations will be subject to a rigorous form of scrutiny, approaching strict scrutiny.

The commercial speech doctrine, that is, the idea that commercial speech would receive less First Amendment protection than other speech, originated in *Valentine v. Chrestensen*.²⁰⁹ In *Valentine*, the Court upheld a New York law forbidding the distribution of advertising leaflets in the streets, stating without citing any authority that "the Constitution imposes no...restraint on government as respects purely commercial advertising."²¹⁰ Thus, for a time, commercial advertising was treated as a category of speech without any First Amendment protection. In the mid-1970's this approach was questioned and finally rejected in *Bigelow v. Virginia*²¹¹ and

²⁰⁴ *Id.* at 791.

²⁰⁵ *Clark v. Cmty. for Creative Non-Violence*, 468 U.S. 288, 293 (1984); *Schad v. Borough of Mount Ephraim*, 452 U.S. 61 (1981). See 1 SMOLLA, *supra* note 16, at § 8:42, 8-62.3.

²⁰⁶ *Ward*, 491 U.S. at 798.

²⁰⁷ See 1 SMOLLA, *supra* note 16, at § 8:41, 8-62.2.

²⁰⁸ See, e.g., Opposing Party's Brief on the Merits at 20, *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001) (No. S076061).

²⁰⁹ 316 U.S. 52 (1942).

²¹⁰ *Id.* at 54; see Kozinski & Banner, *supra* note 20, at 628. See generally Kozinski & Banner, *supra* note 16, at 747 (discussing possible historical roots of the commercial speech doctrine in the development of substantive due process jurisprudence at the time of *Valentine*).

²¹¹ 421 U.S. 809 (1975).

Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council.²¹² Then, in *Central Hudson Gas & Electric Corp. v. Public Service Commission*,²¹³ the Court developed a standard for review of commercial speech regulations. Under that standard, if advertising concerns lawful activity and is not misleading it may be regulated only where there is a substantial government interest. In addition, the regulation must “directly advance[] the governmental interest asserted” and may not be “more extensive than is necessary to serve that interest.”²¹⁴

In *Board of Trustees of State University of New York v. Fox*,²¹⁵ the Court held that the *Central Hudson* test does not require that the regulation use the “least restrictive means” to accomplish its substantial interest. Instead, a rigorous level of intermediate scrutiny is called for.²¹⁶ There must be a reasonable “‘fit’ between the legislature’s ends and the means chosen to accomplish those ends,” a fit that must be “carefully calculated”, “narrowly tailored to achieve the desired objective.”²¹⁷

In more recent cases the Court has moved substantially toward requiring the same level of strict scrutiny for commercial speech as it requires for other content-based regulation of speech.²¹⁸ After these decisions, regulation of non-misleading commercial speech is highly suspect and likely to be measured under strict scrutiny.²¹⁹ Commercial speech that is actually or inherently false or misleading, however, receives no First Amendment protection and “‘may be banned entirely’.”²²⁰

Hence, the Court’s approach to determining the constitutionality of commercial speech has changed in the last sixty years from a categorical approach in which it was treated as non-speech receiving no First Amendment protection to something close to parity with non-commercial speech, subject to strict scrutiny balancing with a heavy presumption against regulation.

²¹² 425 U.S. 748 (1976).

²¹³ 447 U.S. 557 (1980).

²¹⁴ *Id.* at 566.

²¹⁵ 492 U.S. 469 (1989).

²¹⁶ See 1 SMOLLA, *supra* note 16, at § 20:7, 20-121.

²¹⁷ Bd. of Trs. Of State Univ. of N.Y. v. Fox, 492 U.S. 469, 480 (citing *Posadas de Puerto Rico Assoc. v. Tourism Co. of Puerto Rico*, 478 U.S. 328, 341 (1986) and *In re R.M.J.*, 455 U.S. 191, 203 (1982)).

²¹⁸ 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484 (1996); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525 (2001); see 1 SMOLLA, *supra* note 16, at § 20:9, 20-18 – 20-27.

²¹⁹ 1 SMOLLA, *supra* note 16, at § 20:9, 20-25.

²²⁰ *Kasky v. Nike, Inc.*, 45 P.3d 243, 306-07 (Cal. 2002), *cert. granted*, 71 U.S.L.W. 3319 (U.S. Jan 10, 2003) (No. 02-575) (citing *in re R.M.J.*, 455 U.S. 191, 203 (1982)).

The core application of the right of publicity is in claims against unauthorized use of persona in advertising of goods or services, uses which generally fall within the category commercial speech; that is, “speech which does no more than propose a commercial transaction.”²²¹ The trend towards more heightened scrutiny in non-misleading commercial speech cases makes the distinction between commercial and non-commercial speech less important than in the past, and, if anything, suggests that even right of publicity laws limiting the use of persona in advertising should be subject to fairly rigorous scrutiny. Although the meaning of the term commercial speech is somewhat ambiguous at the margins,²²² it is worth noting for purposes of this analysis that neither an image work itself nor the sale of image copies is commercial speech.²²³ An economic motivation by itself does not turn speech into commercial speech.²²⁴ Of course, if it did, most speech works—books, newspapers, films, music—would be commercial speech. Clearly, that is not the case. As the *Saderup* court acknowledged, “[t]he First Amendment is not limited to those who publish without charge...[An expressive activity] does not lose its constitutional protection because it is undertaken for profit.”²²⁵

Generally, the more severe the possible interference with opportunities for free expression, the more strict will be the scrutiny applied.²²⁶ For example, in *Bartnicki v. Vopper*²²⁷ the Court found that federal and state anti-wiretapping statutes were content-neutral because they did “not distinguish based on the content of the intercepted conversations, nor [were they] justified by reference to the content of those conversations.”²²⁸ Although the government’s

²²¹ See *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66 (1983) (describing that definition as “the core notion of commercial speech,” citing *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) and *Pittsburgh Press Co. v. Human Relations Comm’n*, 413 U.S. 376, 385 (1973)). Of course, not all advertising would be commercial speech, since some advertising conveys a message “unconnected to a product or service or commercial transaction.” *Kasky*, 45 P.3d at 254 (citing *Bolger v. Youngs Drug Prods. Corporation.*, 463 U.S. 60 (1983) and *New York Times Co. v. Sullivan*, 376 U.S. 254, 256-66 (1964)).

²²² *Kasky*, 45 P.3d at 255.

²²³ The Supreme Court has said that a combination of three factors—advertising format, product references, and commercial motivation—may support characterization of speech as commercial speech. *Bolger*, 463 U.S. at 67. Generally, an image copy will not be in advertising format and will not contain product references. Posters may sometimes be used for advertising, but they are also a format in which the public can obtain inexpensive reproductions of photographs and works of art. Hence, a non-advertising poster should not ordinarily be viewed as an advertising format. The *Saderup* decision acknowledged this: “[T]he present case does not concern commercial speech.” *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 802 (Cal. 2001).

²²⁴ *Bolger*, 463 U.S. at 67.

²²⁵ *Saderup* 21 P.3d at 802 (quoting *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 459 (1979) (Bird, C.J., concurring)).

²²⁶ Stone, *supra* note 99, at 58.

²²⁷ 532 U.S. 514 (2001).

²²⁸ *Id.* at 26.

interest in protecting privacy in communications was an important one, the Court found that interest outweighed by “the interest in publishing matters of public importance,”²²⁹ and noted that, [a]s a general matter, ‘state action to punish the publication of truthful information seldom can satisfy constitutional standards.’”²³⁰

B. Balancing vs. Special Categorical Tests

As noted above, the principal approach applied to assess the constitutionality of laws regulating speech is a means-end balancing test weighted by reference to the categorical distinction between content-based and content-neutral regulations.²³¹ In addition, the Court utilizes special types of tests for certain types of speech regulations. Generally, these are categorical tests used for content-based laws as an alternative to strict scrutiny.

For example, the Court uses a test to define the category of speech that may be considered an incitement to unlawful behavior under which such speech may be punished, but only if it is intended to produce immanent unlawful conduct and is likely to produce such conduct.²³² Another approach is illustrated by the way the Court treats factually false speech, that is, defamation and false light invasion of privacy. Factually false speech may be considered of lower social value than other speech, but in order to avoid chilling speech, the Court requires a level of scienter determined by the category of the person—public official, public figure, private figure—referred to in the speech.²³³ In the case of one category of speech, obscenity, if the speech satisfies a definitional test, it receives no protection under the First Amendment.²³⁴

²²⁹ *Id.* at 534.

²³⁰ *Id.* at 527 (citing *Smith v. Daily Mail Publ’g Co.*, 443 U.S. 97, 102 (1979)).

²³¹ See 1 SMOLLA, *supra* note 16, at § 2:11, 2-6-2-10. Professor Smolla uses the term “heightened scrutiny” to refer to the weighted balancing approach and also to the various other specialized tests used with respect to some content and settings, all of which he views as being more protective of speech than an “ad hoc balancing” approach would be. *Id.*

²³² *Brandenburg v. Ohio*, 395 U.S. 444 (1969).

²³³ See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974).

²³⁴ *Miller v. California*, 413 U.S. 15 (1978). Sexually obscene speech may be banned not because of potential harmful audience behavior, but rather because it is highly offensive. *American Amusement Machine Ass’n v. Kendrick*, 244 F.3d 572, 574-75 (7th Cir. 2001). Laws punishing speech because it is simply offensive pose perhaps the greatest risk to First Amendment freedom of expression. See generally, F. Jay Dougherty et al., *A Panel Discussion: Potential Liability Arising From the Dissemination of Violent Music*, 22 LOY. L.A. ENT. L. REV. 237, 256-61 (2002). Courts have been reluctant to extend this treatment to other types of speech. See, e.g., *Eclipse Enters., Inc. v. Gulotta*, 134 F.3d 63, 66 (2d Cir., 1997) (declining to extend to depictions of violence). In what this author views as a dangerous precedent, at least one court found that certain violent videogames were not a protected form of speech. *Interactive Digital Software Ass’n v. St. Louis City*, 200 F. Supp. 2d 1126 (E.D. Mo. 2002), *claim*

Note that in each of those instances, the category of speech in question—incitement to unlawful acts, factual falsehood, obscenity—is relatively “low value.”²³⁵ Outside of the low-value speech arena, a categorical approach has also been applied with respect to the conflict between copyright law and freedom of expression. First advocated in a 1970 article by Professor Nimmer,²³⁶ that approach was cited with approval by the Supreme Court in its only right of publicity case²³⁷ and has subsequently become the primary judicial approach to resolving copyright/free speech conflicts.²³⁸ As discussed above, that approach involves what Professor Nimmer referred to as “definitional balancing,” distinguishing a work’s unprotected “idea” from its protected “expression.” Recently, Professor Netanel advocated abandoning that approach in favor of the more customary weighted balancing approach.²³⁹ Professor Netanel’s argument will be considered more fully below. A similar argument was recently rejected by the Supreme Court in upholding the constitutionality of the Copyright Term Extension Act,²⁴⁰ but, as will be discussed below, the Court’s rationale in that copyright case is less persuasive applied to the right of publicity.

Academics have long debated which approach—categorical or balancing—is normatively preferable.²⁴¹ Balancing approaches may be further broken down as either ad hoc balancing or definitional balancing. The ad hoc balancing approach “weights, in each particular case, the

dismissed, 2002 WL 1770524 (June 14, 2002). *But see, Kendrick*, 244 F.3d at 574; *Sanders v. Acclaim Entm’t, Inc.*, 188 F. Supp. 2d 1264, 1279 (D. Co. 2002) (videogames are entitled to full First Amendment protection). The precedent is dangerous because much protected speech is offensive to someone, and if legislatures may outlaw speech merely for offending, little would be left of First Amendment protection for speech. We do not need the First Amendment to protect completely inoffensive speech. *See SMOLLA*, *supra* note 16, at § 4:7, 4-4 to 4-5, and cases cited therein.

²³⁵ Netanel, *supra* note 187, at 32-33.

²³⁶ Nimmer, *supra* note 185, at 1180.

²³⁷ *Zachini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 577 n.13 (1977).

²³⁸ *See* Netanel, *supra* note 187, at 11-12. In recent years, the “definitional balancing” idea/expression approach advocated by Professor Nimmer has come under academic criticism, such as in Professor Netanel’s thorough and insightful article. The Supreme Court recently emphasized the idea/expression dichotomy as a mechanism protecting speech interests in copyright law. *Eldred v. Ashcroft*, 2003 WL 118221 (2003).

²³⁹ Netanel, *supra* note 187.

²⁴⁰ *Eldred v. Ashcroft*, 2003 WL 118221 (2003).

²⁴¹ T. Alexander Aleinikoff, *Constitutional Law in the Age of Balancing*, 96 YALE L.J. 943, 944 (1987). A full discussion of this debate is beyond the scope of this article. For some articles considering these issues, see, e.g., Laurent B. Frantz, *The First Amendment in the Balance*, 71 YALE L.J. 1424 (1962); Louis Henkin, *Infallibility Under Law: Constitutional Balancing*, 78 COL. L. REV. 1022 (1978); T. M. Scanlon, *Freedom of Expression and Categories of Expression*, 40 U. PITT. L. REV. 519 (1979); Pierre Schlag, *An Attack on Categorical Approaches to Freedom of Speech*, 30 UCLA L. Rev. 671 (1983); Eugene Volokh, *Freedom of Speech, Permissible Tailoring and Transcending Strict Scrutiny*, 144 U. PEA. L. REV. 2417 (1996). The accurate description of the approaches themselves can be debated. For example, what I refer to as weighted balancing, Professor Netanel refers to as

interests served by the speech against the asserted state interest in prohibition or regulation.”²⁴² By contrast, “Definitional balancing weights the values served by a particular class of speech against the state interest asserted in the particular case.”²⁴³ A categorical approach is one in which First Amendment protection is assessed “by reliance on broad and abstract classifications of protected or unprotected speech.”²⁴⁴ A categorical approach resembles a definitional balancing approach. Those approaches have been distinguished on the basis that definitional balancing expressly involves balancing of interests but categorical approaches do not.²⁴⁵

Advantages of the explicit ad hoc balancing approach are that it is less formalistic and mechanical than a categorical approach.²⁴⁶ Ad hoc balancing permits judges to identify relevant competing interests and to “give them the weight that history, tradition, and current society attribute[s] to them.”²⁴⁷ Critiques of ad hoc balancing include that it leads to a conservative bias,²⁴⁸ excessively weighted in favor of legislative judgments,²⁴⁹ and that courts don’t have information necessary to balance,²⁵⁰ don’t really consider all the relevant interests, do not consider the interests of non-parties, and have no way of objectively evaluating or comparing the relevant interests.²⁵¹ Moreover, it has been argued that ad hoc balancing with respect to laws regulating speech could lead to no constitutionally protected speech at all, and by extension could eliminate other constitutional rights as well.²⁵² This is because the balancing approach views constitutional rights as “interests” that may be outweighed by other non-constitutional interests or limited by government conduct that is merely reasonable.²⁵³ Such an approach “does not accord with common understanding of the meaning of a ‘right’.”²⁵⁴ Finally, it is difficult to

categorical. What I refer to as a categorical test in copyright—the idea/expression approach—Professor Nimmer referred to as “definitional balancing.”

²⁴² Schlag, *supra* note 257, at 673.

²⁴³ *Id.*

²⁴⁴ *Id.* at 672.

²⁴⁵ *Id.* at 673.

²⁴⁶ Aleinikoff, *supra* note 257, at 955-56.

²⁴⁷ *Id.* at 963.

²⁴⁸ *Id.* at 971, n.187.

²⁴⁹ 1 SMOLLA, *supra* note 16, at § 2:60, 2-59–2-62.

²⁵⁰ Aleinikoff, *supra* note 257, at 971, n.187.

²⁵¹ *Id.* at 972-78.

²⁵² Frantz, *supra* note 257, at 1444-45.

²⁵³ Aleinikoff, *supra* note 257, at 987.

²⁵⁴ *Id.*

predict the outcome of ad hoc balancing and that uncertainty is particularly dangerous with respect to speech regulation because it may discourage speakers, chilling speech.²⁵⁵

A categorical approach may have the advantage of more certainty and predictability, at least to the extent that the applicable category is capable of a clear definition. “The application of categorical principles can be entrusted to a judiciary with reasonable expectation of some consistency, and subject to effective guidance by the Supreme Court; ad hoc balancing, on the other hand, gives great power to the individual judge and smacks loudly of ‘wisemanship.’”²⁵⁶

Categorical approaches have their potential disadvantages as well. A category may be misinterpreted in a particular application.²⁵⁷ Regulating one category of speech might lead to inappropriate extension to other categories, or the category itself may be overbroad.²⁵⁸ Unthoughtful reliance on categories might reach unsupportable results and give only the illusion of analysis. As one critic of categorical approaches said, “The danger of categorical approaches is that to some extent they present the courts with prepackaged justifications for particular outcomes....If categorical theories pretend to compel decisions in concrete cases, but in fact do not, then the court’s exercise in classification becomes simply a cover for attaching certain consequences (protection or non-protection) to certain activities on the basis of concerns never articulated and, therefore, never judged.”²⁵⁹ A category may also be not broad enough. For example, as argued above, protecting only newsworthy speech from right of publicity claims inadequately protects expressive visual art.

Definitional balancing may appear to provide more certainty than ad hoc balancing²⁶⁰ and, by applying balancing as a way to define what categories of expression should be considered fully-protected speech rather than to weigh the interests of the parties in a particular case, it might insulate judges from public antipathy towards a particular speaker or expression.²⁶¹ Essentially, though, definitional balancing either requires re-balancing to reflect new interests and weights in a particular case, thus becoming ad hoc balancing, or it suffers from the disadvantages of other categorical approaches.²⁶² As one critic said, “Balances are ‘definitional’

²⁵⁵ 1 SMOLLA, *supra* note 16, at § 2:59, 2-25-2-59.

²⁵⁶ Henkin, *supra* note 257, at 1048.

²⁵⁷ Scanlon, *supra* note 257, at 539.

²⁵⁸ *Id.* at 540.

²⁵⁹ Schlag, *supra* note 257, at 733-34.

²⁶⁰ Aleinikoff, *supra* note 257, at 979.

²⁶¹ 1 NIMMER AND NIMMER ON COPYRIGHT § 1.10[A], at 1-67–1-68 (1994).

²⁶² Aleinikoff, *supra* note 257, at 980-81.

only if the Court wants to stop thinking about the question.”²⁶³ Indeed, in the most recent version of his treatise initially co-authored with Professor Melville Nimmer, a primary advocate of definitional balancing, Professor Smolla has largely abandoned the term “definitional balancing,” describing it instead as a form of heightened scrutiny.²⁶⁴

As mentioned above, in its only right of publicity case, the Supreme Court referred to Professor Nimmer’s definitional balancing in adopting a categorical approach to resolving a dispute between a performer’s right of publicity claim against a news broadcaster which had videotaped and transmitted the performer’s act.²⁶⁵ Under that approach, the First Amendment does not insulate a broadcaster from a right of publicity claim if the broadcaster appropriates the performer’s “entire act.” The parties in that case did not advocate a balancing approach in their briefs, but instead focused on the categorical jurisprudence that was current at that time with respect to defamation and false light invasion of privacy claims.²⁶⁶ Drawing on that approach, the Ohio Supreme Court had held that a newsworthy use would be protected by the First Amendment unless the news organization actually intended “to appropriate the performance for some other private use, or if the actual intent was to injure the performer.”²⁶⁷ Rejecting that holding, the Court stated that the right of publicity is “an entirely different tort.”²⁶⁸ Rather, in the context of a claim respecting the appropriation of a performance, the Court analogized the right of publicity to patent and copyright laws.²⁶⁹ The right of publicity protects the performer’s investment of “time, effort, and expense”²⁷⁰ in creating the performance that had been appropriated, preventing “unjust enrichment.”²⁷¹ The Court held that where the entire act is taken, newsworthiness does not automatically trump the right of publicity.

Because Zachini’s claim was against a news broadcast, seemingly at the heart of first amendment protection, the Court’s finding that the First Amendment did not protect against the taking of an entire performance could suggest that the right of publicity should categorically outweigh freedom of expression in other contexts, such as claims against artistic portrayals. The

²⁶³ *Id.* at 981.

²⁶⁴ 1 SMOLLA, *supra* note 16, at § 2:61, 2-62 n.1.

²⁶⁵ *Zachini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

²⁶⁶ *See* Brief for Petitioner and Respondent, *Zachini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

²⁶⁷ *Zachini v. Scripps-Howard Broad. Co.*, 51 N.E.2d 454, 461 (Ohio 1976).

²⁶⁸ *Zachini*, 433 U.S. at 571.

²⁶⁹ *Id.* at 576.

²⁷⁰ *Id.* at 575.

²⁷¹ *Id.* at 576.

case has been cited in decisions to support that outcome.²⁷² But commentators have argued that it should be limited to the rather unusual facts of the case; namely, instances where a creative performer's "act" has been recorded and exploited without his consent.²⁷³ The *Zachini* decision itself recognized the distinction between that type of performance appropriation and more typical right of publicity claims.²⁷⁴ *Zaschini* involved an atypical right of publicity claim.²⁷⁵ Thus, it gives little guidance with respect to how the Court would address a conflict between a persona claimant and an artist selling image copies.²⁷⁶ It is difficult to see such a case as one involving the appropriation of an "entire act."²⁷⁷ The rationale developed by the Court is not as persuasive when applied to a case other than the appropriation of a professional performer's performance, something very close to the subject matter of common law copyright²⁷⁸ or what many non-United States legal systems classify as "performers' rights" or "neighboring rights."²⁷⁹ The *Saderup* court recognized the distinction and did not purport to apply the categorical "entire act" test in the context of the sale of image copies. But it cited *Zachini* for two propositions: that state law may protect "the fruits of a performing artist's labor,"²⁸⁰ and the state's interest in that regard "is not automatically trumped by the interest in free expression or dissemination of information."²⁸¹

Professor McCarthy, author of the primary treatise on the right of publicity, advocates an ad hoc balancing approach.²⁸² A Tenth Circuit decision rejecting a right of publicity claim against parody sports trading cards also applied an ad hoc balancing approach.²⁸³ The Supreme

²⁷² See *Tellado v. Time-Life Books*, 643 F. Supp 904, 914 (D.N.J. 1986). Indeed, the *Saderup* decision commenced its First Amendment analysis with a discussion of *Zachini*.

²⁷³ See 2 MCCARTHY, *supra* note 6, § 8:27, at 8-37.

²⁷⁴ *Zachini*, 433 U.S. at 576.

²⁷⁵ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 805-06 (Cal. 2001). See 2 MCCARTHY, *supra* note 6, § 8:27, at 8-37–8-39.

²⁷⁶ See 2 MCCARTHY, *supra* note 6, § 8:27, at 8-38 (2002).

²⁷⁷ Perhaps a photograph of a professional model whose only "act" is his visual appearance might be analogous. But arguably that act is generally valuable as a way of advertising and promoting other products, such as clothing designs. If so, the sale of image copies of a professional model that is not used for such advertising or promotion would not constitute appropriation of the model's act.

²⁷⁸ NIMMER, *supra* note 277, at § 8E.02, 8E-11.

²⁷⁹ See F. Jay Dougherty, *Not a Spike Lee Joint? Issues in the Authorship of Motion Pictures Under U.S. Copyright Law*, 49 UCLA L. Rev. 225, 300-06 (2001). See generally S. STEWART, INTERNATIONAL COPYRIGHT AND NEIGHBORING RIGHTS (1989); RICHARD ARNOLD, PERFORMERS' RIGHTS (1997).

²⁸⁰ *Saderup*, 21 P.3d at 805-06.

²⁸¹ *Id.*

²⁸² 2 MCCARTHY, *supra* note 6, § 8:39, at 8-62.

²⁸³ *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10 Cir. 1996), *cert. denied*, 531 U.S. 873 (2000).

Court has not yet addressed the conflict outside of the unique context of unauthorized recording of an entire performance.

Because it is uncertain whether the Supreme Court, if faced with a case between a persona claimant and an artist, would apply its broader content-based/content-neutral weighted balancing test or would instead adopt the California Supreme Court's transformativeness test or develop a different categorical test, the next section of this Article will consider each of those potential approaches.

C. The Transformativeness Test Fails Under a Balancing Test

State right of publicity laws qualify as regulation of speech subject to First Amendment scrutiny. Those laws do not simply regulate conduct with only incidental expressive significance. When right of publicity law is applied to prohibit unauthorized use of persona in an advertisement, it regulates "commercial speech," which the Court has held to receive some First Amendment protection. When it is applied to prohibit the dissemination of expressive works not used as advertisements, it clearly regulates speech with full First Amendment protection. In this section of this Article, I argue that right of publicity laws and particularly an interpretation of right of publicity law that excludes only transformative art from liability are content-based and should be subject to strict scrutiny. Even if they were to be viewed as content-neutral, they should be subject to rigorous intermediate scrutiny. In either event, such laws as applied to image copies should fail the required scrutiny. Finally, if the right of publicity is to be analyzed under a special categorical test rather than a balancing approach, a test based on the medium of distribution would be preferable to the California Supreme Court's transformativeness test, which requires judges to decide what works of visual art qualify as First Amendment-protected speech.

1. What Level of Scrutiny Should Be Applied to the Right of Publicity and the Transformativeness Test?

Are right of publicity laws content-based or content-neutral? Certainly liability depends on the content of the defendant's expression. If the content of the challenged use includes

elements of persona covered by the applicable law, there may be liability. The right of publicity cannot be justified without reference to content. The law is aimed specifically at content—the persona of celebrities and other persons. This suggests that right of publicity laws are content-based. Like “Son of Sam” laws,²⁸⁴ right of publicity laws are content-based speech restrictions because they “single[] out income derived from expressive activity...and [are] directed only at works with a specified content.”²⁸⁵ Such laws are suspect and presumptively invalid even if there is no legislative intent to suppress certain ideas²⁸⁶ and even if they primarily impact a publisher rather than the creator of the expression.²⁸⁷ Arguably, they are more dangerous to free speech than Son of Sam laws are, because they not only provide for financial disincentives, but also permit injunctive relief,²⁸⁸ sometimes including preliminary injunctions.²⁸⁹

Several scholars have argued that right of publicity laws are content-based.²⁹⁰ A few commentators have argued that right of publicity laws are content-neutral.²⁹¹ Of course, right of publicity advocates have also made the content-neutrality argument.²⁹² To the extent that they argue that right of publicity is content neutral because it does not favor a particular viewpoint,

²⁸⁴ “Son of Sam” was the nickname of a serial killer in New York. After it appeared that he could make substantial sums of money from selling his “life story” rights, New York passed a law requiring entities that contract with someone convicted of a crime for the reenactment of the crime in certain expressive works to pay the sums due under the contract to a crime victims board. Numerous states enacted similar statutes. See *in re* Opinion of the Justices to the Senate, 764 N.E.2d 343, 346-47 (Mass. 2002). The Supreme Court invalidated the New York statute for overbreadth. *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105 (1991). States have subsequently tried and failed to craft constitutional versions of such a statute. *Keenan v. Sup. Ct. of L.A. County*, 40 P.3d 718 (Cal. 2002); *Opinion of the Justices to the Senate*, 764 N.E.2d at 346-47.

²⁸⁵ *Simon & Schuster*, 502 U.S. at 116.

²⁸⁶ *Id.* at 117.

²⁸⁷ *Id.*

²⁸⁸ See generally 2 MCCARTHY, *supra* note 6, § 11:22.

²⁸⁹ See, e.g., *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 222 (2d Cir. 1978) (affirming preliminary injunction of an Elvis Presley poster). See generally 2 MCCARTHY, *supra* note 6, § 11:23. Preliminary injunctions of speech may be presumptively unconstitutional “prior restraints.” See *id.* § 11:24. See, e.g., *Taylor v. Nat’l Broad. Co.*, 22 Media L. Rep. 2433 (Cal. Super. 1994) (refusing to enjoin docudrama because to do so would be a prior restraint of speech). Preliminary injunctions are routinely granted in copyright and trademark cases where there is a likelihood of success on the merits. Professor Mark Lemley and Professor Eugene Volokh have insightfully criticized this aspect of intellectual property jurisprudence. Mark Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147 (1997).

²⁹⁰ See, e.g., Diane Leenheer Zimmerman, *Fitting Publicity Rights Into Intellectual Property and Free Speech Theory: Sam, You made the Pant too Long!*, 10 DEPAUL-LCA J. ART & ENT. L. & POL’Y 283, 293 (2000); Volokh, *supra* note 257 at 2459.

²⁹¹ See Rebecca Kwok, *Comment: Cartoons v. Major League Baseball Player Association: Fair Use or Foul Play?*, 5 UCLA ENT. L. REV. 315 (1998).

²⁹² See, e.g., Comedy Brief of Amici Curiae Screen Actor’s Guild at 19, *Saderup* (No. S076061); Brief of Amici Curiae Wayne Enterprises, Inc. et al. at 12, *Saderup* (No. S076061).

these arguments are misplaced. Viewpoint-based laws are perhaps the most suspect form of content-based regulation, but a law can be content-based even though it is viewpoint-neutral.²⁹³

Even if the right of publicity applied to expressive uses generally is subject to only a reduced level of scrutiny, the transformativeness test is not only content-based but also viewpoint-based and should be subject to the strictest scrutiny. This is because it protects speech based on its view of the celebrity portrayed—if the viewpoint is parodic or critical it would be protected speech under the transformativeness test as described by the *Saderup* court.²⁹⁴ By contrast, if the viewpoint is simply informational or reverential, it is highly unlikely to be protected speech under the *Saderup* rule and would violate the right of publicity.²⁹⁵ Viewpoint-based restrictions on speech are highly suspect, subject to strict scrutiny, and virtually never survive such scrutiny.²⁹⁶

Perhaps it is less important to protect non-critical speech than parodies or other critical portrayals. After all, it is more likely that a rational person would license a favorable portrayal than a caricature. Thus, parodies and other critical commentary are more likely to be the subject of market failures.²⁹⁷ This reasoning may justify extra First Amendment protection for critical depictions such as parodies, but it does not justify an absence of protection for other depictions. For example, if the First Amendment protected solely those depictions which the subject would be unlikely to license, newspapers would have to buy licenses from the subjects of their articles. Surely, although it may play a role in market efficiency, the First Amendment is not merely a tool for wealth maximization.

²⁹³ For example, Son of Sam laws, discussed above, are not viewpoint-based, but have been held to be content-based. *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 116 (1991); *Keenan v. Sup. Ct. of L.A. County*, 40 P.3d 718, 729 (Cal. 2002); *in re Opinion of the Justices to the Senate*, 764 N.E.2d 343, 348 (Mass. 2002).

²⁹⁴ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001).

²⁹⁵ *Id.* at 811 (rejecting First Amendment protection for Saderup's sketch because it is merely a "literal, conventional depiction"). The California Supreme Court said that a work may be transformative even if not parodic. *Id.* at 809. It identified some other forms of expression that might be transformative. Two of the forms listed by the court are also critical—"heavy-handed lampooning" and "subtle social criticism." *Id.* The other two—"factual reporting" and "fictionalized portrayal"—are not necessarily critical. But it is hard to see why the distinction between a conventional sketch and factual reporting should be considered rational. True, celebrities do make money from licensing conventional visual depictions. But if the law refused to accord First Amendment protection to factual reporting or fictionalized literary, audiovisual or musical portrayals, celebrities could also make money from licensing them. That kind of market rationale is questionable circular reasoning. In any event, carving out critical portrayals—parodies, lampooning or social criticism—for special treatment seems clearly viewpoint-based.

²⁹⁶ *SMOLLA*, *supra* note 16, at § 4:8, 4-5, and cases cited therein.

²⁹⁷ See generally Wendy Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and its Predecessors*, 82 COLUM. L. REV.1600 (1982).

Aside from economics, a person might deny such a license not to control criticism but simply because she wants total privacy.²⁹⁸ That desire may be understandable,²⁹⁹ but social norms do not recognize the right to privacy as such an absolute, at least vis-à-vis the conduct of other individuals rather than the government,³⁰⁰ absent some other harm resulting from the invasion of privacy.³⁰¹

Another implication of the transformativeness test that suggests requiring strict scrutiny is that the transformativeness test can turn on who the speaker is. As articulated by the California Supreme Court, a realistic, non-parodic painting of a celebrity could be protected speech if created and sold by a famous artist, where the same painting would not be protected and would violate the right of publicity if created and sold by a relatively unknown artist such as Saderup.³⁰² The court's intention in suggesting that aspect of its test was to distinguish situations where the motive for a purchase might be the value of the artist's reputation rather than the fame of the celebrity portrayed from those where the artist benefits from the celebrity.³⁰³ One problem with this aspect of the test is that, aside from extreme cases, it is difficult to measure an artist's fame and weigh it against that of the subject. Under this test, presumably Andy Warhol could sell copies of literal depictions of anyone, except perhaps someone more famous than he is—but who would that include?³⁰⁴ Or put more generally, an artist could sell copies of depictions of anyone less well-known than the artist but not of celebrities who are better-known. Clearly, such a rule severely impacts the subject matter of speech. Moreover, fame and reputation are not static, but rather can change during and after a person's life. Relying on such a mercurial calculus hardly seems appropriate as a mechanism defining what images should be considered speech within the protection of the First Amendment. In addition, speaker-based restrictions on

²⁹⁸ See Alfred Yen, *When Authors Won't Sell: Parody, Fair Use, and Efficiency in Copyright Law*, 62 U. COLO. L. REV. 79, 107 (1991).

²⁹⁹ See Samuel Warren & Louis Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 215-16 (1890).

³⁰⁰ See 1 MCCARTHY, *supra* note 6, § 5:54, at 5-95 (contrasting constitutional privacy against acts by the government with tort law privacy).

³⁰¹ Each of Prosser's four types of privacy tort involves some showing of offensiveness or harm. Even the "intrusion" form of privacy tort, which does not ordinarily involve publication and thus does not potentially implicate First Amendment rights, typically requires that the intrusion is "highly offensive to a reasonable person." See *id.* § 5:87, at 5-177 to 5-189. One who truly desires absolute privacy has the option of securing total solitude, perhaps by moving to a cave in the Himalayas.

³⁰² *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001).

³⁰³ *Id.*

³⁰⁴ See *id.* at 809 (suggesting that Warhol's celebrity portraits would be considered transformative).

speech have the potential to discriminate against viewpoints.³⁰⁵ They are particularly dangerous when the non-favored speakers do not have alternative channels of communication, as is the case with visual artists' portrayal of real people. This is an additional reason to apply heightened scrutiny. It is also a characteristic of the test that should cause it to fail such scrutiny.

As suggested in the Introduction to this Article, after *Saderup*, the status of the speech can turn on the medium used. A simple short factual biography of a celebrity³⁰⁶ or a poem or song lyrics referring to the celebrity or events in her life would be considered protected speech without consideration of whether or not it added new meaning or expression.³⁰⁷ Yet under the *Saderup* rule, a simple realistic drawing of the same celebrity would be subject to the transformativeness test because it is visual art, and would be considered protected speech only if the artist can prove that she has added new meaning or expression.³⁰⁸ If a picture is worth a thousand words, surely such a distinction would fail to satisfy even a rational basis test for constitutionality. Arguably, such a substantial ban on a particular means of expression should be reviewed under rigorous scrutiny, because of its potential to restrict free expression.³⁰⁹

One might argue that the right of publicity should be viewed as subject-matter based rather than content-based. A subject-matter restriction is “directed, not at particular ideas, viewpoints, or items of information, but at entire subjects of expression.”³¹⁰ Professor Stone has observed that such restrictions have “baffled the Court,” because they share some of the characteristics of viewpoint-based and content-neutral restrictions.³¹¹ Professor Stone suggested treating different types of subject-matter restrictions differently, based upon their implication on various free-speech concerns.³¹² Because right of publicity laws as applied to expressive works, and the transformativeness rule in particular, implicate the serious concerns discussed above, those regulations should be subject to strict scrutiny, requiring a compelling government interest and narrow tailoring to achieve that interest. As will be discussed below, the transformativeness rule satisfies neither of those requirements.

³⁰⁵ Stone, *supra* note 206, at 249.

³⁰⁶ See, e.g., *Sidis v. F-R Publ. Corporation*, 113 F.2d 806 (2d Cir. 1940) (brief biographical sketch); *Rosemont Enters., Inc. v. Random House, Inc.*, 294 N.Y.S.2d 122 (Sup. Ct. 1968) (unauthorized biography).

³⁰⁷ See *Parks v. LaFace Records*, 76 F. Supp. 2d 775 (E.D. Mich. 1999) (song).

³⁰⁸ *Saderup*, 21 P.3d at 809 (artist may raise transformativeness defense as an affirmative defense).

³⁰⁹ See Stone, *supra* note 99, at 65.

³¹⁰ Stone, *supra* note 206, at 239.

³¹¹ *Id.* at 240-41.

³¹² *Id.* at 242. See also, Geoffrey Stone, *Restrictions of Speech Because of its Content: The Peculiar Case of Subject-Matter Restrictions*, 46 U. CHI. L. REV. 81 (1978).

2. Right of Publicity Rules Should Be Subject to Stricter Scrutiny than Copyright Rules

As discussed above, in its only case addressing the right of publicity, the Supreme Court did not apply the content-based/content-neutral approach, but rather analogized the right of publicity to copyright law, at least in the context of a performer's entire act. In considering the level of scrutiny that should be applied to right of publicity rules, it may be useful to consider the argument that copyright laws are content-neutral and the corollary argument as to the appropriate level of scrutiny for copyright laws.

Some scholars have characterized copyright law as content-based.³¹³ Like the right of publicity, liability turns on the content of the defendant's work. But a recent article by Professor Netanel thoroughly discussing the question whether copyright law is content-based argued that context "sensitivity," such as that reflected in copyright law, does not necessarily mean that a law is content-based for first amendment purposes.³¹⁴ Should similar reasoning be applied to the right of publicity?

Professor Netanel argued that copyright law should be considered content-neutral for several reasons. First, copyright's purpose is to provide incentives for the production and dissemination of works of authorship, not to limit viewpoints or communicative impact.³¹⁵ Second, copyright law derives from an express constitutional grant of power to Congress that describes copyright as a means to promote knowledge.³¹⁶ Third, the Court has applied content-neutral scrutiny to certain federal statutes according copyright-like protection to certain material.³¹⁷ Like the statutes in those cases, copyright restricts the manner in which an idea may be expressed but not the message. Although he concluded that copyright law is content-neutral, Netanel posited that copyright should be subject to a rigorous form of intermediate scrutiny, because it "directly and systematically" restricts protected expressive activity.³¹⁸

³¹³ See Netanel, *supra* note 187, at 47-48 (citing scholars who have argued copyright law is content-based).

³¹⁴ *Id.* at 48.

³¹⁵ *Id.* at 48-50.

³¹⁶ *Id.* at 50.

³¹⁷ *Id.* at 51-54. One of the statutes prohibited publication of photographs of U.S. currency. The other prohibited use of the word "Olympic" for certain commercial purposes. The Court applied less than rigorous scrutiny in upholding both statutes. *Id.*

³¹⁸ *Id.* at 54.

Although courts have compared the right of publicity to copyright in some respects, the rationales proffered by Professor Netanel are less persuasive with respect to the right of publicity. The first rationale—that copyright should be viewed as content-neutral because copyright law provides an important incentive to the creation of speech³¹⁹—might at first glance seem applicable to the right of publicity. Courts, including the Supreme Court, have described the purpose of the right of publicity to be the protection of incentives to engage in certain types of activity.³²⁰ That rationale seems most persuasive in the context of *Zachini*, where the right is used to protect against unauthorized recording and broadcast of an entire entertainment performance. Arguably, it would not be economically feasible to invest in developing an entertainment act such as Mr. Zachini’s if anyone could record it and exploit that recording without his permission.

But it is not at all persuasive in many other potential right of publicity contexts, particularly with respect to an attempt to prohibit dissemination of an image copy that does not appropriate an entire entertainment performance. The right of publicity may provide incentives to conduct leading to celebrity, but its incentives are not aimed at the creation of works of expression, at least outside of its application to particular entertainment performances. Hence it cannot be characterized as an “engine of free expression.” Moreover, the incentive rationale falls apart when applied to private or infamous individuals. Even private individuals have a right of publicity, with no particular productive activity. Infamous people have a right of publicity. Certainly, the law should not provide incentives to the Son of Sam.

Indeed, other courts and commentators have questioned the incentive rationale as a basis for the right of publicity.³²¹ One scholar, attempting to rebut challenges to the incentive rationale, argued that permitting celebrities to control uses of their personae reduces disincentives to achieving celebrity and compensates for such celebrity disadvantages as the constitutional actual malice requirement in defamation and right of privacy claims.³²² Perhaps celebrity comes with costs, such as Oprah Winfrey’s inability to enjoy an Art Expo once

³¹⁹ Indeed, because of this function, the Court has described copyright as “the engine of free expression.” *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558. The Court recently again relied on this function of copyright law in rejecting the argument that the Copyright Term Extension Act should be subject to rigorous scrutiny. *Eldred v. Ashcroft*, 2003 WL 118221 (2003).

³²⁰ See *Zachini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

³²¹ See Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 206-15 (1993); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir. 1996).

³²² Roberta Rosenthal Kwall, *Fame*, 73 IND. L.J. 1, 35-38 (1997).

discovered there by her fans.³²³ This hardly seems sufficient reason to justify restrictions on speech portraying a celebrity.

Often, the most forcefully advocated rationale supporting the right is not its incentive function, but a fundamental belief that it is unjust for someone else to profit in any way from one's persona.³²⁴ That rationale has also been criticized.³²⁵ For purposes of assessing content-neutrality, it suffices to note that a legislative purpose of promoting a vague sense of fairness is more suspect than the utilitarian incentive rationale in that such a highly subjective rationale could be used to disguise a purpose of limiting the communicative content or viewpoint of speech. Hence, the right of publicity is more suspect than copyright, at least outside of the *Zachini* context.

The second rationale for treating copyright law as content-neutral—that copyright derives from an express constitutional grant of power to the legislature—has little purchase applied to the right of publicity. The Supreme Court recently pointed to the fact that the Constitutional copyright clause and the First Amendment “were adopted close in time” as a rationale for limited scrutiny of copyright laws.³²⁶ There is no express constitutional grant of power to enact right of publicity laws. The right is a product of twentieth-century commerce and media developments,³²⁷ and was unknown to the Founding Fathers. Hence, unlike copyright, there can be no argument that the drafters of the First Amendment considered the right of publicity to be consistent with freedom of speech. Indeed, the law of England, which was so influential in the constructing of U.S. copyright law, did not recognize anything like the right of publicity and still does not recognize a similar right.³²⁸

As to Netanel's third rationale—that the Supreme Court has analyzed federal statutes limiting images of U.S. currency and uses of the word “Olympic” like content-neutral restrictions—Professor Netanel's argument is that these laws were treated as mere time, place or manner regulations and that, by virtue of the idea/expression dichotomy in copyright, it too may be viewed as more of a limitation on the manner of expression than on its content. Yet, as

³²³ *Id.* at 35.

³²⁴ 1 MCCARTHY, *supra* note 6, § 2:2, at 2-4-2-5.

³²⁵ Madow, *supra* note 337, at 196-205.

³²⁶ *Eldred v. Ashcroft*, 2003 WL 118221 (2003).

³²⁷ See Madow, *supra* note 337, at 147-67; Kwall, *supra* note 338, at 4-13.

³²⁸ See Hayley Stallard, *The Right of Publicity in the United Kingdom*, 18 LOY. L.A. ENT. L. REV. 565 (1998). See generally HUW BEVERLEY-SMITH, *THE COMMERCIAL APPROPRIATION OF PERSONALITY* (2002); SIMON SMITH, *SPECIAL REPORT: IMAGE, PERSONA AND THE LAW* (2001).

discussed above, the right of publicity lacks an idea/expression dichotomy. Moreover, unlike the laws regarding currency images and the word “Olympic”, the right of publicity applied to image copies limits an enormous category of potential subject matter for expression. Hence, an analogy between those very narrow laws and a broad government endorsement of some but not all uses of persona would be questionable. Moreover, at least the “Olympic” case has been criticized as unduly restricting speech by many commentators.³²⁹

Thus, the copyright analogy does not provide persuasive reasons to treat the right of publicity as content-neutral.³³⁰

3. Other Arguments for Reduced First Amendment Protecting in the Context of Right of Publicity Claims

If art is speech and a law restricting the subject matter of speech is content-based, then right of publicity laws, at least as applied to non-advertising uses of persona, would be subject to strict scrutiny and, as will be discussed below, should be found unconstitutional. However, right of publicity advocates sometimes look to some other lines of constitutional argument to support minimal, or at least a non-rigorous intermediate, scrutiny. First, some decisions have held that one does not have the right to engage in speech on private real property. If one has property rights in her persona, should courts be similarly deferential to a right of publicity rule that prohibits use of that property for expressive purposes?³³¹ Second, the creation and sale of image

³²⁹ See, e.g., Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 398 (1990).

³³⁰ Professor Netanel argued that although copyright is content-neutral, it should be subject to extremely rigorous intermediate scrutiny. He analogized copyright laws to “must-carry” rules respecting cable television companies that were subjected to such rigorous scrutiny in *Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622 (1994). This is because copyright is a form of government speech entitlement allocation, and such allocations “raise a concern about improper government motive: that government has doled out speech entitlements to favored interest groups without adequately accounting for the speech burdens thus imposed on other speakers and the public at large.” Netanel, *supra* note 187, at 59. Certainly, the right of publicity is a similar government allocated speech entitlement, with concomitant risks of celebrity rent-seeking. For example, a recent amendment to California’s right of publicity law was entitled the “Astaire Celebrity Image Protection Act.” S.B. 209, 1999, ch.998. Fred Astaire’s widow, angry at losing a case asserting a right of publicity claim, initiated the bill and was a “moving force” behind it. See 1 MCCARTHY, *supra* note 6, § 6:34, at 6-68. As such, right of publicity regulation should be subject to rigorous scrutiny. The Supreme Court recently rejected the argument that the Copyright Term Extension Act should be subject to rigorous scrutiny under *Turner*, primarily because of copyright’s “built-in free speech safeguards.” *Eldred v. Ashcroft*, 2003 WL 118221 (2003). As discussed above, the right of publicity lacks these safeguards.

³³¹ In its Amicus Curiae brief, the Screen Actors Guild argued that property and privacy are, like freedom of speech, expressly protected under the California constitution, and celebrity images are the result of labor. Hence images are

copies might be characterized as conduct. Where a law is aimed at non-communicative conduct with only an incidental impact on speech, the Court has applied a less demanding level of scrutiny than would be required on other types of regulation. Should right of publicity claims against the sale of image copies be viewed as regulating commercial conduct—misappropriation of property—with only an incidental impact on speech? Third, where a content-based law is addressed to the secondary effects of a particular form of speech and not to its communicative impact, the Court has applied a deferential level of scrutiny.³³² Should applying the right of publicity to prohibit unauthorized image copies be viewed as regulating misappropriation or theft of property, characterized as a secondary effect of such a use, and not the image copies’ communicative impact? The following sections of this Article will review and criticize those arguments.

a. Speech that uses another’s property

The Court has permitted the prohibition of otherwise protected speech when it intrudes on private real property, under a lower level of scrutiny that considers the availability of alternative means of communicating the message. For example, in *Lloyd Corp. v. Tanner*,³³³ the Court supported the right of the owner of a shopping center to prohibit leafleting, saying, “[T]his Court has never held that a trespasser or an uninvited guest may exercise general rights of free speech on property privately owned and used nondiscriminatorily for private purposes only.”³³⁴ Because the Court found that there were ample alternative avenues for the leafletters’ expression, it found no violation of their First Amendment rights.³³⁵

Some decisions have applied *Tanner* to one form of intellectual property, rejecting a First Amendment defense to a trademark infringement action.³³⁶ One of the amici in the *Saderup* case

property and an unauthorized user is unjustly enriched. Brief of Amici Curiae Screen Actor’s Guild at ____, *Saderup* (No. S076061).

³³² *City of Renton v. Playtime Theatres, Inc.*, 475 U.S. 41 (1986) (zoning ordinance prohibiting adult theatres within 1,000 feet of residential areas, churches, parks or schools was aimed at protecting property values, among other things, and not to suppress expression).

³³³ 407 U.S. 551 (1972).

³³⁴ *Id.* at 568.

³³⁵ *Id.* at 567.

³³⁶ *Dallas Cowboys Cheerleaders v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979); *Mutual of Omaha Ins. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987). The Supreme Court has rejected a First Amendment defense to an infringement claim, although without referring to the *Tanner* line of cases. *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 554-60 (1985). The Court recently addressed the application of the First Amendment to a

analogized the case to *Tanner*, and argued that the artist's acts should be viewed as an "invasion[] of real property" unprotected by the First Amendment.³³⁷ The plaintiffs in *Saderup* advocated following the Supreme Court's *Zachini* decision and viewing the right of publicity as a form of property the taking of which would not violate the First Amendment.³³⁸

In *Zachini*, Justice White described the right of publicity as a form of intellectual property, at least as applied to protect an entertainer's performance.³³⁹ Describing this particular type of right of publicity claim as the "strongest case" of a legitimate state right of publicity interest and noting that the plaintiff only sought damages, not to enjoin the broadcast, the Court concluded that judgment for *Zachini* would not violate the First Amendment.³⁴⁰

It may be that in the limited context of *Zachini*, that is, the unauthorized recording and distribution of a performer's entire performance, the right of publicity most resembles a form of intellectual property. Professor McCarthy recognized the limited application of *Zachini*, but approves of the private property analogy in balancing free speech rights and the right of publicity, because he believes that the implicated publicity rights are best viewed as protecting proprietary interests, rather than protecting feelings or reputation.³⁴¹ Approving the property analogy, he argues that in a close case between informational or expressive use and advertising use, "If the property right inherent in plaintiff's identity is merely used as a *vehicle* to attract attention to the defendant's news or entertainment 'message,' then the property right of the right of publicity should clearly outweigh the claim to free speech."³⁴²

There are several problems with this analogy and with Professor McCarthy's suggested analysis, particularly applied outside the narrow context of *Zachini*. First, a person's "property"

statutory extension of the term in existing works in *Eldred v. Ashcroft*. Petitioner in that case argued that copyright law should not be categorically exempt from First Amendment scrutiny. The Court recognized explicitly that copyrights are not "categorically immune from challenges under the First Amendment" *Eldred v. Ashcroft*, 2003 WL 118221 (2003) (quoting and rejecting appellate decision on this point). But it rejected the First Amendment challenge to the term extension, because of "copyright's built-in safeguards," and because the term extension did not "alter[] the traditional contours of copyright protection." *Id.*

³³⁷ Brief of Amici Curiae Wayne Enterprises, Inc. et al. at 7-9, *Saderup* (No. S076061). *See also*, *Cardtoons v. Major League Baseball Players Ass'n*, 95 F.3d 959, 971-972 (10th Cir. 1996) (addressing MLBP's assertion that *Tanner* should apply to a right of publicity claim).

³³⁸ Opposing Party's Brief on the Merits at 21-24, *Saderup* (No. S076061).

³³⁹ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

³⁴⁰ *Id.* at 576.

³⁴¹ 2 MCCARTHY, *supra* note 6, § 8:32, at 8-48-49.

³⁴² *Id.*, § 8:32, at 8-48.

interest in uses of copies of his persona is different from one's ownership of real property.³⁴³ The subject matter of the right of publicity lacks the specificity that characterizes real property.³⁴⁴ In addition, like a work of authorship and unlike real property, a persona has the characteristic of a "public good."³⁴⁵ Because use of persona by an artist does not limit potential use by another artist or by the celebrity herself, the right of publicity, at least in the context of image works, involves potential "nonrivalrous consumption." An artist's use of a person's likeness does not interfere with the likeness in the way that demonstrators' or picketers' physical occupation of real property or a graffiti artist's defacement of a building impacts the owner's rights.³⁴⁶ Hence, the analogy to real property is not apt.

Second, the *Tanner* case involved the right of a property owner to prohibit speakers whose speech did not relate to the property³⁴⁷ and there were adequate alternative avenues of communication for the speech.³⁴⁸ By contrast, the subject of the speech embodied in an image copy is usually the person depicted. Although that in itself might not justify trespass on real property—that is, one may not have a First Amendment right to enter real property simply because one desires to comment about the real property—it should still weigh in favor of permitting the non-rivalrous use of intangible property in the form of a persona.³⁴⁹ Perhaps more

³⁴³ See Timothy Terrell & Jane Smith, *Publicity, Liberty, and Intellectual Property: A Conceptual and Economic Analysis of the Inheritability Issue*, 34 EMORY L.J. 1, 5-6 (1985) (argument that the right of publicity is a "liberty" interest, not a "property" interest).

³⁴⁴ *Id.* One's actual name and face are fairly "specific." But the same is not true of all the possible images and texts depicting a person. This lack of specificity has been exacerbated by the extension of the subject matter of the right of publicity—the elements of persona in which one may claim exclusive rights—to ephemera of fame. See, e.g., *White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395 (9th Cir. 1992) (finding protection for evocations of identity that do not use name, likeness or voice).

³⁴⁵ See RICHARD WATT, *COPYRIGHT AND ECONOMIC THEORY* 3 (2000) (describing intellectual property as a public good); ROBERT COOTER & THOMAS ULEN, *LAW & ECONOMICS* 42 (3d Ed., 2000) (describing characteristics of a public good).

³⁴⁶ But see Wendy Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1548 (1993). Professor Gordon points out that unauthorized copying can economically harm the creator of the work copied. Still, the nature of the harm is different from that caused by one physically occupying real property. Ultimately, Professor Gordon's article demonstrates that the Lockean property theory, if properly applied to intellectual property, does not justify limiting free speech. *Id.* at 1535.

³⁴⁷ *Lloyd Corp., Ltd. v. Tanner*, 407 U.S. 552 (1972). The Court appears to have essentially overruled *Amalgamated Food Employees Union Local 590 v. Logan Valley Plaza, Inc.*, 391 U.S. 308 (1968), the decision that had protected the right of speakers to use property for speech related to the property. See *Hudgens v. NLRB*, 424 U.S. 507 (1976). But that was in a case where the speech did not directly relate to the property. *Id.* at 525 (White, J., concurring).

³⁴⁸ *Hudgens*, 407 U.S. at 563-64.

³⁴⁹ A corollary proposition would be that permitting an artist to depict a person forces that person to allow his "property" to be used as a vehicle for someone else's message. See 2 MCCARTHY, *supra* note 6, § 8:33. The Supreme Court rejected this argument in *Pruneyard Shopping Center v. Robins*, 447 U.S. 74 (1980), because the public would not necessarily believe that ideas expressed in a place open to the public would be identified with the owner. A full discussion of this proposition is beyond the scope of this Article. It may be preliminarily observed,

importantly, there is no alternative avenue of communication for the artist, as will be discussed below.³⁵⁰ The trademark cases that have followed *Tanner* have emphasized the availability of alternative avenues of communication for the defendant's message.³⁵¹

Ultimately, to say that a persona is property and therefore a particular use of it unlawfully appropriates that property simply states a conclusion. Characterizing the right as property begs the question and constitutes circular reasoning.³⁵² A person's rights in his persona are property to the extent the law circumscribes others' use of it. The question under consideration is to what extent the law should circumscribe an artist's ability to depict a real person in her art and disseminate that depiction. Because such depictions are a form of speech, this is a substantial question going to the basic nature of the bundle of rights comprising the right of publicity. It should not be assumed out of existence by simply characterizing the right of publicity as a property right.³⁵³

Moreover, because the right of freedom of expression is so fundamental in our society, the "property" analogy should not be used to shift the burden of persuasion to the artist, requiring her to justify using a depiction of a real person in her image works. Where such a fundamental right is at stake, the burden should be on the persona claimant to show why his right to prevent the use of his likeness to sell unrelated products should extend to preventing an artist from

however, that this seems to be a different issue than cases requiring someone to make statements that she does not agree with—the more usual "forced speech" case. See generally 1 SMOLLA, *supra* note 16, at § 4:26. This is because limiting the right of publicity does not force the persona owner to make any particular statement. It is also worth noting that the more that the law requires one's permission for depictions, the more the public will be likely to believe that permission was obtained and that, therefore, the ideas suggested by that depiction are endorsed by the person depicted. First Amendment interests would be better served by rules that limit the contexts in which permission is required. Like with respect to the shopping center in *Pruneyard*, the public will not then increasingly assume that messages utilizing a persona imply endorsements by the persona owner.

³⁵⁰ See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 971 (10th Cir. 1996).

³⁵¹ See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir., 1979) ("there are numerous ways in which defendants may comment on 'sexuality in athletics' without infringing plaintiff's trademark"); *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) ("[o]ther avenues for Novak to express his views exist and are unrestricted by the injunction").

³⁵² See Jane M. Gaines, *The Absurdity of Property in the Person*, 10 YALE J.L. & HUMAN. 537, 541 (1998): "The law creates the right, the right creates the value, the value creates the right, the right preexists in the property, which is recognized by law, which is none other than the right itself. The circularity of rights discourse can verge on nonsense."

³⁵³ See Amicus Curiae Brief of 73 Law Professors in Support of Defendant/Appellee Jireh Publishing, Inc. For Affirmance, *reprinted in* 22 WHITTIER L. REV. 391, 413-16 (2000). The author of this Article was one of the 73 Law Professors.

disseminating her art.³⁵⁴ Professor McCarthy correctly observes that the right of publicity protects in part proprietary, pecuniary interests, but it does not follow—and he does not argue—that one should have a near absolute right to exclude others from expressive uses of persona. However, to say, as does Professor McCarthy, that the right of publicity should “clearly outweigh” freedom of speech when a persona is used as a vehicle to attract attention to a message reposes too much power in an extremely subjective characterization.³⁵⁵ Particularly where the image itself is an important part of the message, how is a judge to determine when the persona is a mere “vehicle”? Arguably, most expressive uses of name or likeness do so in part to attract attention. One reads a biography in substantial part because one is interested in the life of the subject of the biography. If use to attract attention were enough to convert an protected expressive use into a prohibited use for purposes of trade, there would be little left of First Amendment protection for expressive depictions of real people.

b. Laws regulating conduct with only incidental impact on speech

Some right of publicity advocates argue that the right of publicity applied against the dissemination of image copies is a content-neutral regulation of conduct with only an incidental impact on speech that should be subject only to a reduced level of scrutiny pursuant to cases like *United States v. O'Brien*.³⁵⁶ *O'Brien* upheld the constitutionality of a statute prohibiting the destruction or mutilation of draft cards as applied to the defendant, who had burned his draft card to express his criticism of the Vietnam War. The Court noted that under some circumstances “a sufficiently important governmental interest in regulating the nonspeech element [of conduct] can justify incidental limitations on First Amendment freedoms.”³⁵⁷ To satisfy the First Amendment in such circumstances, the regulation must further an “important or substantial

³⁵⁴ See Burt Neuborne, *Notes for a Theory of Constrained Balancing in First Amendment Cases: An Essay in Honor of Tom Emerson*, 38 CASE W. RES. L. REV. 576, 585 (1988) (arguing that the censor should have the burden of persuasion as to constitutionality).

³⁵⁵ 2 MCCARTHY, *supra* note 6, § 8:32, at 8-48. The case cited by Professor McCarthy in support of his proposed test involved the use of a likeness in a magazine article. The court denied summary judgment for the defendant in order to permit proof on whether or not there were “clandestine arrangements which would convert an apparent news story into an advertisement.” *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 885 (S.D.N.Y. 1973). Thus, it is actually an advertising use case, not one in which an editorial use was found not to be protected by the First Amendment merely because the celebrity likeness was a vehicle to attract attention to an article.

³⁵⁶ 391 U.S. 367 (1968); see Amicus Curiae Brief of Wayne Enterprises, Inc. et al. at 10, *Saderup* (No. S076061); Amicus Curiae Brief of the Screen Actors Guild, Inc. at 24, *Saderup* (No. S076061).

³⁵⁷ *O'Brien*, 391 U.S. at 376.

governmental interest...unrelated to the suppression of free expression” and any “incidental restriction on First Amendment freedoms” must be “no greater than essential to the furtherance of that interest.”³⁵⁸ The Court found a substantial government interest in assuring the effective functioning of the draft system and held that the regulation in question “precisely and narrowly” furthered that interest by regulating a “noncommunicative aspect” of the defendant’s conduct.³⁵⁹ The Court distinguished the circumstances “where the alleged governmental interest in regulating conduct arises in some measure because the communication allegedly integral to the conduct is itself thought to be harmful,” such as a law punishing people for using the flag to express opposition to organized government.³⁶⁰ Thus, to qualify for the reduced scrutiny of *O’Brien*, the challenged regulation must regulate conduct unrelated to expression.³⁶¹

The right of publicity does not regulate nonspeech conduct with only an incidental effect on speech. By prohibiting a particular class of content, it is directly aimed at expression. True, certain activity that could be characterized as conduct is also regulated—for example, the selling of copies of a work depicting a person. But if the act of disseminating speech constitutes the kind of conduct unrelated to expression that is subject to *O’Brien* scrutiny, then the distinction at the heart of the case becomes meaningless.

One cannot justify applying the *O’Brien* test to the right of publicity on the basis that the right of publicity only regulates conduct with an incidental impact on speech. But something less than strict scrutiny is applied to other types of content-neutral speech regulation.³⁶² So although the argument that *O’Brien* scrutiny should be applied because the right of publicity falls within the type of regulation discussed by *O’Brien* is misplaced, what of the broader argument, that the right of publicity should be viewed as a content-neutral speech regulation, subject to reduced scrutiny?

That argument should be rejected. First, as discussed above, the right of publicity is content-based. Second, the transformativeness rule itself is content-based. At least when applied to expressive uses other than advertising, those rules should be subject to heightened scrutiny. Third, even content-neutral rules are sometimes subject to heightened scrutiny—it is inaccurate

³⁵⁸ *Id.* at 377. In addition to these three requirements, the *O’Brien* test also requires that the challenged regulation be within the constitutional power of the government. *Id.*

³⁵⁹ *Id.* at 381-82.

³⁶⁰ *Id.* at 382 (citing *Stromberg v. California*, 283 U.S. 359 (1931)).

³⁶¹ See 1 SMOLLA, *supra* note 16, § 11:7.

³⁶² See Stone, *supra* note 99, at 48-54; Werhan, *supra* note 218, at 637-38.

to say that content-neutral rules receive only minimal *O'Brien* scrutiny.³⁶³ Professor Stone articulated at least three concerns affecting the rigor of First Amendment review of a regulation: distortion of public debate, improper motivation, and communicative impact.³⁶⁴ He further identified a central concern of content-neutral rule assessment: their potential to “significantly impair the ability of individuals to communicate their views to others,”³⁶⁵ including potential to “frustrate individual self-fulfillment.”³⁶⁶ The level of scrutiny applied to a content-neutral law depends on the severity of its interference with communication of ideas and self-fulfillment—the more severe the interference, the more rigorous the scrutiny.³⁶⁷ To Professor Stone, the “pivotal inquiry [is] the extent to which the challenged restriction actually diminishes the opportunities for free expression.”³⁶⁸

When applied to prohibit the dissemination of expressive works depicting a person, the right of publicity, even if content-neutral, has the potential to severely diminish opportunities for free expression and significantly frustrate an artist’s or author’s individual self-fulfillment. Therefore, the right of publicity as applied to nonadvertising uses of persona should be subject at least to rigorous intermediate scrutiny, under which “the government must prove that its use of a less restrictive alternative would seriously undermine substantial governmental interests.”³⁶⁹ *O'Brien*’s deferential review is insufficient to protect such an important class of communicative acts.

c. Content-based laws aimed at secondary effects of speech

In *City of Renton v. Playtime Theatres, Inc.*,³⁷⁰ the Court applied highly deferential scrutiny to a zoning regulation that prohibited locating adult theatres within a thousand feet of residences, churches, parks or schools. Because the regulation was based exclusively on the content of the films shown by such theatres, it would seem to be content-based and subject to

³⁶³ Stone, *supra* note 99, at 54.

³⁶⁴ *Id.*

³⁶⁵ *Id.* at 57.

³⁶⁶ *Id.*

³⁶⁷ *Id.* at 58.

³⁶⁸ *Id.* at 59.

³⁶⁹ *Id.* at 53.

³⁷⁰ 475 U.S. 41 (1986).

strict scrutiny.³⁷¹ But the Court viewed it as a content-neutral time, place, and manner regulation, upheld because it served a substantial governmental interest and did not unreasonably limit alternative avenues of communication.³⁷² The district court had found that the city's predominate concern was not with the content, but rather was with "secondary effects" of the theatres on the surrounding community, such as preventing crime, protecting retail trade, preserving the quality of the city's neighborhoods, and maintaining property values.³⁷³ The Ninth Circuit had reversed summary judgment for the city in part because, if it could be shown that restricting speech was a motivating factor in passing the regulation, the statute would be unconstitutional.³⁷⁴ The Court rejected that approach. According to Justice Rehnquist, courts should not consider illicit government motives,³⁷⁵ and if the city's "predominate" motive was to address the non-speech secondary concerns, the regulation should be treated as content-neutral.³⁷⁶

One might make an analogous argument as to a right of publicity law's prohibiting use of persona in an image copy. Under that argument, the intent of the law is not to suppress speech, but rather is to address secondary effects; namely, protecting the property value of exclusive rights in a persona. So long as the regulation of the secondary effect "serve[s] a substantial government interest,"³⁷⁷ is "'narrowly tailored' to affect only that category of [material] shown to produce the unwanted secondary effects,"³⁷⁸ and there are reasonable alternative avenues of communication,³⁷⁹ the law would survive constitutional scrutiny.

The *Renton* approach has been strongly criticized. Professor Stone argued that extending that approach to other areas would "threaten[] to undermine the very foundation of the content-based/content-neutral distinction"³⁸⁰ and "erode the coherence and predictability of first amendment doctrine."³⁸¹ Professor Smolla also criticizes the secondary effects test as a "potentially portentous departure from existing First Amendment jurisprudence,"³⁸² and suggests

³⁷¹ *Id.* at 55 (Brennan, J., dissenting).

³⁷² *Id.* at 46-48.

³⁷³ *Id.* at 48.

³⁷⁴ *Id.* at 47.

³⁷⁵ *Id.* at 48 (quoting *United States v. O'Brien*, 391 U.S. 367, 382-86 (1968)).

³⁷⁶ *Id.*

³⁷⁷ *Id.* at 50.

³⁷⁸ *Id.* at 52.

³⁷⁹ *Id.* at 50.

³⁸⁰ Stone, *supra* note 99, at 116.

³⁸¹ *Id.*

³⁸² 1 SMOLLA, *supra* note 16, § 9:19, at 9-30.

that it may be limited to regulation of sexually oriented expression.³⁸³ The Supreme Court rejected a secondary effects argument in support of the Communications Decency Act, because the law was aimed at offensive speech and was not a time, place and manner regulation aimed at secondary effects from such speech.³⁸⁴

Even if one follows *Renton*, the doctrine should not apply to the right of publicity. The statute upheld in *Renton* was not aimed at direct consequences of the regulated speech, but at potential secondary effects, such as crime. It did not prohibit adult motion picture theatres altogether, but only their location in proximity to residences, churches, parks and schools. Hence, it was characterized as a “place” regulation, not an absolute prohibition.³⁸⁵ Unlike the ordinance upheld in *Renton*, right of publicity laws prohibiting artists from selling image copies should not be viewed as a content-neutral time, place and manner restrictions, and there is no reasonable alternative avenue for communication available to such artists.

4. Neither the Right of Publicity as Applied to Expressive Works Nor the Transformativeness Test Should Survive Heightened Scrutiny

As discussed above, the right of publicity applied to expressive works, such as the sale of image copies, should not be subject to reduced scrutiny on the basis of a real property analogy, as a regulation of conduct with only incidental speech impact or as a regulation aimed at secondary effects unrelated to the suppression of expression. Instead, the right of publicity so applied, and particularly the transformativeness rule articulated by the California Supreme Court, should be subject to heightened scrutiny. It should only survive if the regulation is necessary to serve a compelling state interest and is narrowly tailored to protect that interest.³⁸⁶

Applied to prohibit expressive works,³⁸⁷ neither the right of publicity generally nor the transformativeness rule would survive heightened scrutiny. Neither the state’s interest in providing incentives to the development of celebrity nor the other rationales that have been

³⁸³ *Id.* § 9:20, at 9-30.2.

³⁸⁴ *Reno v. ACLU*, 521 U.S. 844 (1997).

³⁸⁵ *City of Renton v. Playtime Theatres, Inc.*, 475 U.S. 41, 46 (1986).

³⁸⁶ *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 118 (1991).

³⁸⁷ To the extent the right of publicity protects against the unauthorized use of persona in advertising, it regulates commercial speech, which, as discussed above, may be subject to a slightly reduced level of scrutiny. It is beyond the scope of this Article to specifically address the balancing that might be involved with respect to advertising uses, although it seems more likely that such a limited application of the right might survive such scrutiny.

offered as support for the right of publicity are compelling in the application of that right to challenge the dissemination of copies of works embodying expressive uses of persona. Moreover, the transformativeness test is not narrowly tailored to achieve that interest and does not leave open any, let alone ample, alternative channel for communication.

- a. The state lacks a compelling governmental interest in permitting the prohibition of sale or image copies

To determine the state's interest in permitting the prohibition of sale of image copies, one must look to the rationales for recognition of the right of publicity, as applied to such a use of persona.³⁸⁸ The primary rationale, which was recognized by the Supreme Court in the context of protection of a performer's entire act, is to provide an incentive to the performer's development of the act.³⁸⁹ Similar to the primary rationale for copyright law, this is a utilitarian approach focusing on the ultimate benefit to society of the production of entertaining performances. Courts and commentators have described additional rationales. Although the Court has said that the basis for the right of publicity is strong in the context of protecting a performer's entire act, these rationales are weak applied to the sale of image copies. In that context, they do not comprise a compelling state interest.

(i) Right of publicity rationales are weak applied to image copies

The fundamental interest protected by the right of publicity is against unauthorized use in advertising or placement on merchandise.³⁹⁰ A use in news reporting or commentary or in fiction or non-fiction entertainment, or in advertising for such a use, will generally not be considered commercial.³⁹¹ Should use in a work of art or a photograph per se, apart from use in advertising for a separate product or service or use on an item of merchandise, be considered a violation of the right? On the one hand, one might argue that such a use is clearly a commercial exploitation. The "product" is purely the image of the person portrayed. If a person has a

³⁸⁸ See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 973-76 (10th Cir. 1996) (assessing justifications offered for the right of publicity as part of a balancing analysis).

³⁸⁹ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

³⁹⁰ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (2002) (use "for purposes of trade").

property right in her image, it would seem that exploiting that image per se violates that right. Indeed, it might seem at first blush that the sale or display of image works is at the core of the property interest protected by the right of publicity. On the other hand, to the extent that the right of publicity protects against appropriation of the associative value of one's persona—the enhanced value to another product or service—then it should not be considered violated by the sale of an image itself.

Although courts have sometimes assumed that the right of publicity should prevent sale of copies of a person's image, most of the rationales that have been proffered to support recognition of the right provide only weak support for the application of the right to such a use. There are two types of rationales for the right of publicity: natural rights theories and economic theories.³⁹² Natural rights rationales include labor theory, personality theories, and unjust enrichment. Economic rationales include utilitarian/incentive theory, consumer protection theory and allocative economic efficiency.

(ii) Natural rights rationales

(1) labor theory

There has been much discussion of the application of the labor theory of property to intellectual property generally³⁹³ and some discussion of the application of that theory to the right of publicity.³⁹⁴ Put in simplest terms, the theory is that if a person exerts labor to transform something owned by all to transform it into something more valuable, he is entitled to own the results, at least so long as there is “enough and as good” remaining in the commons for everyone else. This rationale would seem most applicable to celebrities who labor in socially valuable ways to create their fame, and of little or no application to non-celebrities and to the infamous.³⁹⁵

³⁹¹ *Id.*

³⁹² See F. Jay Dougherty, *Foreword, The Right of Publicity: Towards a Comparative and International Perspective*, 18 LOY. L.A. ENT. L.J. 421, 440-46 (1998).

³⁹³ See, e.g., Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 296-329 (1988); Gordon, *supra* note 361, at 1538; Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 OHIO ST. L.J. 517 (1990).

³⁹⁴ See, e.g., Kwall, *supra* note 338, at 39-40; Madow, *supra* note 337, at 181-96; Nimmer, *supra* note 7, at 216.

³⁹⁵ See Hughes, *supra* note 408, at 340. (“The persona is the one type of potential intellectual property which is generally thought of as *not* being a result of labor.”); cf. *Maritote v. Desilu Prods., Inc.*, 345 F.2d 418 (7th Cir. 1965),

Even as to such celebrities, this rationale for the right of publicity has been criticized, for not recognizing that fame is often the result of the efforts of many people and events other than the celebrity.³⁹⁶ Others have attempted to rebut that critique.³⁹⁷

Regardless of the efficacy of that rationale in justifying the right of publicity generally, it seems weaker as a justification for permitting control over third party creation and sale of image copies. First, the labor theory depends on the “enough and as good” proviso.³⁹⁸ If the right of publicity permits everyone to prevent artists from painting their portrait or from taking their photograph, it clearly reduces the subject matter available to artists and photographers. This depletion of artistic subject matter harms the public in the way that permitting an author to exclude material from the public domain harms the public.³⁹⁹ In her insightful article concerning the labor theory of intellectual property, Wendy Gordon derived not from an extrinsic First Amendment theory but from labor theory itself the proposition that “when the public’s claims conflict with a laborer’s, the public claims should prevail.”⁴⁰⁰

Second, when an artist labors to create an artistic rendition of a person, labor theory itself would seem to support the artist’s right to own and exploit the results of that labor.⁴⁰¹ If celebrities often borrow material from predecessors to build their image, it is difficult to see how their claims against an artist would be morally superior.⁴⁰² Because the labor theory supports both opposing claims it does little to determine which of the claims should prevail. And because prohibiting dissemination of portraits without permission would remove substantial material

cert. denied, 382 U.S. 883 (1965) (administratrix of Al Capone estate brought claim against television series, “The Untouchables,” portraying Capone).

³⁹⁶ Madow, *supra* note 337, at 184-96.

³⁹⁷ Kwall, *supra* note 338, at 41-46.

³⁹⁸ See Gordon, *supra* note 361, at 1562.

³⁹⁹ See David Lange, *Recognizing the Public Domain*, 44 LAW & CONTEMP. PROBS. 147, 150 (1981). See generally Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354 (1999); Litman, *supra* note 160, at 965.

⁴⁰⁰ Gordon, *supra* note 361, at 1538. The idea/expression dichotomy serves to protect free speech interests in copyright law and reflects the Lockean “enough and as good” proviso. At this time, however, the right of publicity has not recognized an equivalent dichotomy. In fact, recent expansion of the right of publicity to prohibit the use of images that merely remind the viewer of a celebrity suggests that the idea of a celebrity is within the subject matter of the right. See, e.g., *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992).

⁴⁰¹ Cf. Marc J. Apfelbaum, Note, *Copyright and the Right of Publicity: One Pea in Two Pods?*, 71 GEO. L.J. 1567, 1577 (1983) (characterizing a decision enjoining the unauthorized distribution of Elvis Presley poster as effectively transferring title in the poster from the author to the Presley estate); Ralph S. Brown, *Copyright and Its Upstart Cousins: Privacy, Publicity, Unfair Competition: The Sixteenth Donald C. Brace Memorial Lecture*, 33 J. COPYRIGHT SOC’Y U.S.A. 301, 305 (1986) (“Exclusive rights that go beyond the copyright boundaries become especially troublesome when they extend to creations that possess their own elements of authorship. Examples are photographs, paintings or statues, impersonations and satires.”).

⁴⁰² See Madow, *supra* note 337, at 196-99.

from the artistic commons, this rationale does not support use of the right of publicity to prevent such dissemination.

(2) personality theory

Another type of natural right theory of intellectual property derives from the philosophical argument “that property provides a unique or especially suitable mechanism for self-actualization, for personal expression, and for dignity and recognition as an individual person.”⁴⁰³ In other words, “private property...is an extension of human personality, and therefore, ...essential to human dignity.”⁴⁰⁴ Justin Hughes identified this rationale as one particularly apt for the right of publicity: “[T]he persona is the ideal property for the personality justification. No intermediary concepts such as ‘expression’ or ‘manifestation’ are needed: the persona is the reaction of society and a personality.”⁴⁰⁵

Professor Alice Haemmerli thoroughly explored Kantian personality theory as a basis for the right of publicity in a recent insightful article.⁴⁰⁶ In that article, she argued that “a reorientation of the right of publicity along Kantian lines is not only possible but desirable...because it permits recognition of the right’s moral, as well as economic, facet, and...because the Kantian emphasis on inherent human value resonates strongly with our political culture.”⁴⁰⁷

One might think that the personality theory creates the strongest case for legal recognition of a person’s right to prevent the creation and sale of images portraying that person. Yet having advocated the rationale, Professor Haemmerli proposes in her article “full First Amendment protection for even the most blatantly ‘commercial’ non-advertising uses of identity.”⁴⁰⁸ She explicitly recognizes that the creation of works of art and the sale of the

⁴⁰³ Hughes, *supra* note 408, at 330.

⁴⁰⁴ Kwall, *supra* note 338, at 39. Although Professor Kwall identifies this as a rationale for the right of publicity, her article focuses more on the Lockean labor justification.

⁴⁰⁵ Hughes, *supra* note 408, at 340.

⁴⁰⁶ Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383 (1999). For a comparative discussion of Hegelian and Kantian personality theories as a justification for the right of publicity, see *id.* at 423-28.

⁴⁰⁷ *Id.* at 390.

⁴⁰⁸ *Id.* at 391. Although Professor Haemmerli proposes “full” First Amendment protection, she does not mean “absolute” protection. *Id.* at 447. Rather she advocates a nuanced balancing of an autonomy-based right of publicity against competing free speech interests. Aside from her view that the right of publicity is not only an

original or of at least a limited number of reproductions should not be considered a commercial use prohibited by the right of publicity.⁴⁰⁹ Further, she states that, even with respect to celebrity merchandise, “in case of doubt, it is preferable to err on the side of expression, extending First Amendment protection to objects that make ‘iconic’ use of celebrity identities...”⁴¹⁰

Personality theories for right of publicity must also recognize the importance of art in permitting and nourishing human freedom and autonomy. As Justin Hughes said, “Poems, stories, novels, and musical works are clearly receptacles for personality. The same can be said for sculpture, paintings, and prints.”⁴¹¹ Professor Haemmerli’s advocacy of strong First Amendment protection for expressive uses of persona reflects that recognition. Therefore, personality theories do not weigh heavily in favor of persona rights against the freedom of expression of artists.

It might be argued that preventing the sale of reproductions of a person’s image protects reputational and other non-economic or “moral” interests.⁴¹² Generally, these harms result from a false statement or implication of endorsement or association with a product.⁴¹³ But the law provides other means to protect important personal interests of those portrayed in a work of art or photograph.⁴¹⁴ Even if such works may be created, reproduced and sold without violating the right of publicity, the person portrayed retains the core right of publicity to prevent their use to advertise other products or as part of an unrelated product. Moreover, if an image were harmful to reputation or feelings, the subject can assert defamation and other right of privacy claims, subject to the limitations courts have developed in those causes of action to protect freedom of expression. Thus, the “moral” interests of the subject would continue to find protection under the law. This rationale does not weigh heavily against the dissemination of image copies.

(3) unjust enrichment

economically justified right, but instead is morally based in human autonomy, it is difficult to see how her First Amendment analysis is informed by personality theory.

⁴⁰⁹ *Id.* at 391 n.24, 434. Professor Haemmerli does recognize the difficulty or even futility of attempting to determine what is “art.” *Id.* at 434 n.209, 443.

⁴¹⁰ *Id.* at 446.

⁴¹¹ Hughes, *supra* note 408, at 340.

⁴¹² See Kwall, *supra* note 14, at 69-74.

⁴¹³ See *id.* at 72-73.

⁴¹⁴ See 1 MCCARTHY, *supra* note 6, § 2:8, 2-22 to 2-24 (discussing the falsity justification for the right of publicity); *id.* § 5:22, at 5-41 to 5-42 (introducing numerous other types of causes of action available for use of identity without permission).

In many cases, the language of unjust enrichment is used in support of the right of publicity.⁴¹⁵ This rationale is related to the natural rights theories discussed above. If one's persona is one's property, then for someone else to use it without permission or payment looks like misappropriation or theft, in other words, unjust enrichment. Beyond the various theories for why the law recognizes "property" in an intangible, however, this rationale is based on "the intuitive and natural human feeling that everyone should have control of the commercial use of their identity."⁴¹⁶ It has been said that this rationale may be "the most common judicial theory in favor of the right of publicity."⁴¹⁷

Critics of this approach, such as Professor Madow, challenge the underlying theory supporting the characterization of a person's persona as property.⁴¹⁸ Professor Madow goes on to point out that celebrities often borrow elements of their persona from others: "Cultural production is always (and necessarily) a matter of reworking, recombining, and redeploying already-existing symbolic forms, sounds, narratives, and images."⁴¹⁹ Hence, it is hypocritical for a celebrity, having taken a "free ride" in that respect, to challenge others who borrow from her.

Moreover, our social baseline favors "free appropriability of intangibles."⁴²⁰ Even Professor McCarthy, a strong advocate for recognition of the right of publicity recognized that: "In fact, it is probably true that free and legal copying is the rule, and exclusive property rights the exception, in United States law."⁴²¹ Notwithstanding that observation, Professor McCarthy goes on to say that "one should have to articulate some important social purpose which negates everyone's natural impulse to conclude that the law *should* require defendant to pay."⁴²² Of course although the person portrayed in an image work may have that impulse, not everyone would agree, certainly not the artist who created the work. Professor Madow's final observation with respect to the unjust enrichment rationale is that "unauthorized commercial appropriators oftentimes add something of their own"⁴²³ and hence do not simply reap what another has sown.

⁴¹⁵ See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

⁴¹⁶ 1 MCCARTHY, *supra* note 6, § 2:2, at 2-5.

⁴¹⁷ *Id.* (quoting Mark F. Grady, *A Positive Economic Theory of the Right of Publicity*, 1 UCLA ENT. L. REV. 97, 109 (1994)).

⁴¹⁸ See, e.g., Madow, *supra* note 337, at 182-96 (challenging the labor theory of property as applied to celebrities).

⁴¹⁹ *Id.* at 196.

⁴²⁰ *Id.* at 201.

⁴²¹ 1 MCCARTHY, *supra* note 6, § 2:2, at 2-3 (citing his own treatise on Trademarks and Unfair Competition).

⁴²² *Id.* at 2-3 to 2-4.

⁴²³ Madow, *supra* note 337, at 204.

It is difficult to rebut a bare appeal to basic concepts of fairness, other than by noting that a person's view of what is fair often derives from economic interests and that one person's view of fairness, another may view as unfair. The debate on this rationale seems to boil down to who has the burden of proof—those in favor of a particular application of the right of publicity or those opposed.⁴²⁴ Ultimately, unjust enrichment arguments beg the question.⁴²⁵ Whether the benefit to an unauthorized user is “unjust” depends on whether it is “fair,” which depends on what rights the public should have with respect to the use of others' images. Moreover, in the context of the type of use considered in this Article, there are indeed important countervailing social purposes to that of the right of publicity—maintaining a rich and diverse subject matter for works of visual art, by permitting artists to portray real people in their art and to make a living by selling reproductions.

(iii) Economic rationales

(1) utilitarian theory

As has been discussed above, perhaps the primary theory offered to justify intellectual property rights in United States jurisprudence is that recognizing exclusive rights in the product of intellectual effort provides an incentive to creation of such products, benefiting society. Courts and scholars have also applied that rationale to the right of publicity.⁴²⁶ As with the other rationales, critics have argued that rejecting a right of publicity would not significantly reduce incentives for the type of socially valuable activity that can generate fame.⁴²⁷ Supporters of the right of publicity rebut those critiques, primarily on the basis that incentives are needed to encourage potential celebrities to endure the personal costs of fame.⁴²⁸

Of course, this theory has no force supporting the right of publicity as it applies to non-celebrities and the infamous, who by definition are not engaged in activity for which the right of

⁴²⁴ See Dougherty, *supra* note 407, at 440-41.

⁴²⁵ Cf. Brown, *supra* note 416, at 305 (“There is an ethical belief that the imitator is guilty of unjust enrichment – what an empty phrase that is!”).

⁴²⁶ See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (“right of publicity ‘provides an economic incentive for [a performer] to make the investment required to produce a performance of interest to the public.’”); Kwall, *supra* note 338, at 35-38.

⁴²⁷ Madow, *supra* note 337, at 206-16.

⁴²⁸ Kwall, *supra* note 338, at 36-38.

publicity should constitute an incentive.⁴²⁹ As to celebrities, although they would clearly potentially lose some income if image copies can be exploited without obtaining consent and paying license fees,⁴³⁰ there is no reason to believe that the creation and exploitation of unauthorized non-advertising image copies would have significant disincentive effects on their fame-creating activity.

Professor Kwall's rebuttal of the critique of the incentive rationale focuses on the marginal additional power that the right of publicity provides to a celebrity to protect his reputational interests, in view of the limitations on defamation and intentional infliction of emotional distress actions as applied to celebrities.⁴³¹ Of course, this assumes that celebrities should have a right that permits the circumvention of those limitations that protect other important social values (for example, the actual malice requirement). Even if one accepts that assumption, it seems unlikely that most artistic or photographic renderings of celebrities would have a significant negative impact on their reputational, moral interests. The critique of the incentive rationale seems stronger than the rebuttal with respect to artistic non-advertising image copy uses.

(2) consumer protection theory

A second economic rationale for right of publicity is that it may be used to prevent consumer confusion as to a person's association with, or approval or endorsement of, products or services.⁴³² Because other causes of action are available to protect that interest,⁴³³ this rationale is weak with respect to even advertising and merchandise uses, and has virtually no relevance to an artistic use of persona.

(3) allocative economic efficiency theory

⁴²⁹ 1 MCCARTHY, *supra* note 6, § 2:6, at 2-19.

⁴³⁰ *But see* *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 973 (10th Cir. 1996) ("Thus, while publicity rights may provide some incentive for creativity and entertainment, the magnitude and importance of that incentive has been exaggerated.").

⁴³¹ Kwall, *supra* note 338, at 35-38.

⁴³² Treece, *supra* note 8, at 647.

⁴³³ 1 MCCARTHY, *supra* note 6, § 2:8, at 2-23-24.

Another economic rationale sometimes used to support the right of publicity is that the law, by enforcing private property rights in persona permits market forces to preserve the value of those rights by limiting overuse and to allocate persona to the most valuable uses.⁴³⁴ This theory has been used to explain private property generally and other forms of intellectual property, such as copyright.⁴³⁵ Under this approach, unless the law provides for exclusive ownership, a celebrity's persona would have the characteristics of a "public good,"⁴³⁶ which could be used up, its value dissipated by numerous uses of relatively little value until it becomes valueless.⁴³⁷ Sometimes this risk is called the "tragedy of the commons."⁴³⁸

There are criticisms of this theory on many levels. Some criticize the simplistic assumptions upon which achievement of efficient allocation is based, such as the absence of transaction costs.⁴³⁹ Professor Madow goes on to question the analogy to scarce, nonrenewable resources such as land, since our society is constantly creating new celebrities.⁴⁴⁰ He also points out that this approach has found little or no support in courts.⁴⁴¹ Finally, Professor Madow argues that economic analysis cannot help determine what the normatively best rule would be: "[A] purely economic analysis has nothing to offer when it comes to evaluating the central place that celebrity has come to occupy on our culture. It cannot help us decide whether to embrace this development warmly or resist it steadfastly."⁴⁴²

Putting such critiques aside, it is not clear that an allocative efficiency rationale would lead to the conclusion that persons should have the right to prevent or charge for their portrayal by artists. Economic scholarship suggests that, under the assumptions supporting the rationale, it would not matter whether the right is allocated to the persona claimant or to the artist.⁴⁴³ If the right is allocated to the persona claimant, artists will pay to acquire the right if it is more valuable to them. If it is allocated to the artist, persons will pay the artist not to portray them, if such

⁴³⁴ See 1 MCCARTHY, *supra* note 6, § 2:7; Grady, *supra* note 432; Vincent M. de Grandpre, *Understanding the Market for Celebrity: An Economic Analysis of the Right of Publicity*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 73 (2001).

⁴³⁵ See Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283, 306-21 (1996).

⁴³⁶ De Grandpre, *supra* note 449, at 103 n.128.

⁴³⁷ See *Matthews v. Wozencraft*, 15 F.3d 432, 437-38 (5th Cir. 1994) (discussing this rationale with approval).

⁴³⁸ See Madow, *supra* note 337, at 220.

⁴³⁹ See *id.* at 223-24. Professor de Grandpre advocates an economic approach to the right of publicity, but also highlights potential high transaction costs and the difficulty in passing those costs on to consumers. De Grandpre, *supra* note 449, at 109-12.

⁴⁴⁰ Madow, *supra* note 337, at 224.

⁴⁴¹ *Id.* at 225.

⁴⁴² *Id.* at 228.

privacy is more valuable to the person. In either event, the right will go to the highest valued user. Taking into account transactions costs and other market failures, the economic approach might counsel dividing rights in identity and allocating the components initially to the likely most valued user.⁴⁴⁴

An intuitive cost-benefit analysis suggests that society would be better off if the right to create and sell image copies is allocated to artists. Generally, it seems likely that it would be primarily celebrities rather than non-celebrities who would object to the unauthorized sale of image copies, assuming they are not defamatory or otherwise invasive of privacy.⁴⁴⁵ Allocating the right to celebrities would burden artists and cause immeasurable loss to society of potential artworks and artistic photographs. Arguably, the loss to artists and society would outweigh the benefit to celebrities of such an allocation. Hence, the most efficient allocation might well be that artists should have the right to create portrayals of people without their consent, and to sell copies of those portrayals.⁴⁴⁶ Of course, it is probably impossible to quantify and weigh the costs. Given that uncertainty, allocative efficiency theory does not seem to qualify as a compelling, or even substantial, government interest supporting a prohibition on the dissemination of image copies.

- b. The transformativeness test is not narrowly tailored to achieve the state's interest and fails to leave open alternative channels for communication

The weakness of the rationales generally proffered for the right of publicity undermines the argument that there is a compelling or substantial government interest to limit dissemination of image copies. The interests most likely to be identified by courts is that accepted by the *Saderup* court—"that a celebrity's heirs and assigns have a legitimate protectible interest in exploiting the value to be obtained from merchandising the celebrity's image, whether that interest be conceived as a kind of natural property right or as an incentive for encouraging

⁴⁴³ See COOTER & ULEN, *supra* note 360, at 85.

⁴⁴⁴ De Grandpre, *supra* note 449, at 112; see Ian Ayres & Eric Talley, *Solomonic Bargaining: Dividing a Legal Entitlement to Facilitate Coasean Trade*, 104 YALE L.J. 1027 (1995); see also Dougherty, *supra* note 295, at 320-25 (discussing and applying these concepts in the context of contributions to a motion picture).

⁴⁴⁵ If an image work harms reputation or feelings, the person depicted would have causes of action other than the right of publicity, such as defamation and non-appropriation forms of invasion of privacy.

creative work.”⁴⁴⁷ Even if one accepts that as a sufficiently important government interest, the transformativeness test does not satisfy the additional requirement that a speech regulation be narrowly tailored to achieve the state’s interest and leave open ample alternative channels for communication.

The transformativeness rule is not narrowly tailored to protect celebrities’ interest in exploiting merchandising value. Under the transformativeness rule, a work of art would not be considered protected speech at all regardless of whether copies are sold. Yet, if a court makes the aesthetic judgment that a particular work of art is transformative, then presumably it can be attached to any unrelated product and sold.⁴⁴⁸ Rather than regulating sale of image merchandise otherwise unassociated with the person depicted, it prevents the dissemination of copies of pictorial works assessed by a judge to be insufficiently creative and is likely to chill the creation of pictorial works portraying real people. Such a rule will surely interfere with more speech than is necessary to protect the interest identified by the *Saderup* court.

The transformativeness test does not leave open ample alternative channels for the communication of expression found in an image work. In copyright law that alternative channel is found in the idea/fact-expression dichotomy. Although one cannot use substantial portions of another’s expression, one can communicate the ideas and facts embodied in that expression by putting them in one’s own words. As discussed above, there is no such dichotomy in the right of publicity. There is no way to express an opinion or an emotion or convey information about a celebrity without identifying that celebrity. If doing so violates the right of publicity, there is no alternative channel. Outside of copyright cases, courts have generally rejected alternative channel of communication arguments with respect to intellectual property. As a Tenth Circuit

⁴⁴⁶ Of course, the person portrayed would retain the right to prevent advertising uses, uses to enhance the value of products separate from the portrayal, and to prevent portrayals that were defamatory, or otherwise invasive of privacy.

⁴⁴⁷ *Comedy III Prods., Inc., v. Gary Saderup, Inc.*, 21 P.3d 797, 805 (Cal. 2001). Note that the decision characterized this as a “rational basis” for permitting control of commercial exploitation of likeness. *Id.* If, as I argue in this Article, the right of publicity as applied to prohibit dissemination of image copies should be considered under more than a minimal level of scrutiny, then a “rational basis” is not sufficient justification for the regulation. The “rational basis” test derives from equal protection jurisprudence and is applied to laws that do not involve suspect classifications or fundamental rights. See Allan Ides & Christopher N. May, *CONSTITUTIONAL LAW: INDIVIDUAL RIGHTS: EXAMPLES & EXPLANATIONS* 199 (2001). It is extremely deferential to the lawmaker and has been described as “toothless.” *Id.* It is similar to the most deferential level of review of content-neutral speech restrictions, requiring only that the law be “reasonable.” Stone, *supra* note 99, at 49-50. It is far more deferential than even the O’Brien and the “time, place and manner” tests. *Id.* Given the concerns regarding prohibition of the dissemination of image copies discussed in this Article, a rational basis test is excessively deferential.

⁴⁴⁸ See *Hoepker v. Kruger*, 200 F. Supp. 2d 340, 347-350 (S.D.N.Y. 2002).

court said, “Intellectual property, unlike real estate, includes the words, images, and sounds that we use to communicate, and ‘we cannot indulge in the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process...Restrictions on words or images that may be used by a speaker, therefore, are quite different than restrictions on the time, place, or manner of speech.”⁴⁴⁹

With respect to visual art, it would be disingenuous to say that an artist has alternative channels because she could write a literary work or create a documentary film about the same celebrity, that is, prepare expressive works other than a work of visual art, as to which courts have been more protective. The absurdity of that proposition is evident if one imagines it applying to written, sung or filmed works identifying a celebrity. It cannot be plausibly argued that it would be constitutional to prohibit such uses because the author, songwriter or filmmaker could paint a painting of the person portrayed in their work.

As more fully discussed above, because there is no reasonable alternative avenue for communication, the right of publicity as applied to image copies should not be viewed as a “time, place and manner” regulation requiring only that the government interest “would be achieved less effectively absent the regulation.”⁴⁵⁰ Instead, as will be argued below, there is a less restrictive alternative means of achieving the government’s interest in protecting the incentives of celebrities—permitting the sale of image copies but prohibiting sale of image merchandise.

D. Preferable Categorical Rules

If a court elects not to apply the usual content based-content neutral weighted balancing, but instead to use a categorical approach, in addition to the criticisms discussed above, transformativeness is not a good categorical approach because it requires courts to make aesthetic judgments. Although not perfect, a rule protecting the dissemination of copies of any work of visual art regardless of judicial assessments of its aesthetic value would be preferable.

⁴⁴⁹ *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 971 (10th Cir. 1996) (citations omitted); see also *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir.1989). Compare *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 734-35 (D. Minn. 1998) (enjoining use of title “Dairy Queens” for a motion picture, finding alternative avenues for expressing the idea where there was no relationship between the motion picture and the Dairy Queen company). The Dairy Queen court suggested that there would be no alternative avenue where the use of a celebrity name expressed and evoked the celebrity. *Id.*

At a minimum, if the transformativeness test is retained, it should be interpreted narrowly and with procedural safeguards for free speech.

It goes without saying that a work's protected status as speech should not depend upon the perceived quality of the work. Justice Holmes articulated this idea in a different context,⁴⁵¹ saying

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke...At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value,---it would be bold to say that they have not an aesthetic and educational value,--and the taste of any public is not to be treated with contempt.⁴⁵²

Later courts have recognized this concept, sometimes referred to as “aesthetic non-discrimination.”⁴⁵³ In 1954, Justice Reed said, “Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art.”⁴⁵⁴ To permit judges to deny First Amendment protection to works of art because the art is not good enough arguably would be equivalent to permitting viewpoint-based restrictions on speech, perhaps the most suspect type of restriction in First Amendment jurisprudence.⁴⁵⁵ “Courts should not be asked to draw arbitrary lines between what may be art and what may be prosaic as the touchstone of First Amendment protection.”⁴⁵⁶

⁴⁵⁰ Ward v. Rock Against Racism, 491 U.S. 781, 799 (1989).

⁴⁵¹ The Court was interpreting an old copyright statute according copyright protection to “works connected with the fine arts.” It found that a poster advertising a circus would qualify. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). Copyright law requires very minimal creativity and originality in order for a work to receive protection. See generally NIMMER & NIMMER, *supra* note 277, § 2.01[B], 2-12 to 2-17.

⁴⁵² *Bleistein*, 188 U.S. at 251 (“Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art.”); *Mazer v. Stein*, 347 U.S. 201, 214 (1954).

⁴⁵³ Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of “Authorship,”* 1991 DUKE L.J. 455, 466 (1991) (referring to the principle as “shopworn”).

⁴⁵⁴ *Mazer*, 347 U.S. at 214.

⁴⁵⁵ See 1 SMOLLA, *supra* note 16, § 3.11, at 3-17; cf. Stone, *supra* note 206, at 225 (noting that permitting courts to distinguish different levels of viewpoint-based restrictions creates a danger that they may be influenced by “conscious or unconscious biases”).

⁴⁵⁶ See *Hoepker v. Kruger*, 200 F. Supp. 2d 340, 352 (S.D.N.Y. 2002).

Even Judge Leval, who argued for making transformativeness the key principle in copyright fair use analysis, noted this problem. In deciding a trademark parody case, he said, “First Amendment protections do not apply only to those who speak clearly, whose jokes are funny and whose parodies succeed.”⁴⁵⁷ In the Supreme Court decision that followed Judge Leval’s recommendation and emphasized transformativeness as a key element of copyright fair use analysis, Justice Souter cited Justice Holmes’ aesthetic non-discrimination statement with approval, noting that the Court, having found a work to be a parody, “will not take the further step of evaluating its quality.”⁴⁵⁸ As Professor David Lange observed in connection with what he characterized as society’s loss resulting from a case enjoining on right of publicity grounds a play parodying Marx Brothers movies: “But the decision whether society’s loss should be borne in a given case should not turn on the unlettered opinion of a trial judge about the merits of a defendant’s work. Trial judges’ opinions in matters of this sort are notoriously apt to be foolish or bourgeois or both or worse.”⁴⁵⁹

A better test that would be less vague and would be more effective in protecting valuable First Amendment interests would be to permit the sale of image copies—that is, any artwork or photograph portraying an individual in the form of prints, posters, lithographs or other mere reproductions—without regard to its artistic quality, while prohibiting sale of unrelated image merchandise, such as T-shirts, buttons or cups, that embody such a work. In other words, it would be better for judges to determine what is unrelated merchandise than to determine whether a given image work is good enough to qualify as speech.

First Amendment advocates may object to this approach, because generally speech is protected regardless of the medium in which it is embodied. Indeed, it is difficult to articulate a principled distinction between a poster of a portrait and a cup with a portrait on it. However, such a rule is at least more workable and less vague than the transformativeness test, and would avoid involving judges and juries in determination of what art is worthy of First Amendment protection. In addition, regulating unrelated image merchandise but not the sale of image copies is more like a time, place or manner restriction, in that the artist at least has her fundamental avenue of expression—the dissemination of copies of her work—open to her.

⁴⁵⁷ *Yankee Publ’g, Inc. v. News Am. Publ’g, Inc.*, 809 F. Supp.267, 280 (S.D.N.Y. 1992).

⁴⁵⁸ *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 582-83 (1994).

⁴⁵⁹ Lange, *supra* note 414, at 164.

Right of publicity advocates would object to this proposal because they view copies of artworks and photographs as merchandise, which they believe the person portrayed should have the right to control and to derive an economic benefit. But under the *Saderup* rule a work, if deemed transformative, could be distributed on any type of merchandise, not limited to copies of the work itself in some form.⁴⁶⁰ Thus, the proposed rule, although it reduces control over what portrayals may be distributed, might be no less harmful economically to the person portrayed.

A further advantage of this proposal is that it might reduce conflict with copyright law, reducing the likelihood of federal preemption. A full discussion of the extent of preemption of right of publicity laws by federal copyright law and the Supremacy Clause of the Constitution is beyond the scope of this Article. The case law is inconsistent.⁴⁶¹ But some cases have found preemption to the extent that right of publicity law was asserted merely to enjoin distribution of copies of a work of authorship depicting a person that was created with the person's consent, while granting relief with respect to advertising use of the work.⁴⁶² Although copyright law would normally be implicated regardless of whether the copy was independent of an article of merchandise or affixed to an article of merchandise, perhaps courts could view the requirement of affixation to such an article as an "extra element," reducing conflict with copyright law.

A variation on that proposal would be to permit limited editions of any artwork, regardless of its transformativeness. One might argue that such a rule would have to be arbitrary. What would constitute a limited edition? How many copies could be sold before the edition would be deemed unlimited? There is precedent, albeit constitutionally untested, for treating a work as "art" if it is reproduced in no more than a specified number of copies or possibly separately signed and numbered by the artist. That precedent is found in copyright law's definition of works of visual art that are accorded moral rights protection,⁴⁶³ and also in some

⁴⁶⁰ See *Hoepker v. Kruger*, 200 F. Supp. 2d 340 (S.D.N.Y. 2002) (finding a collage using a photograph to be transformative, and granting summary judgment against the plaintiff including with respect to museum gift shop items).

⁴⁶¹ Compare *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n.*, 805 F.2d 663 (7th Cir. 1986) (right of publicity claims preempted), with *Brown v. Ames*, 201 F.3d 654 (5th Cir. 2000), and *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 809-10 (9th Cir. 1997) (right of publicity claims not preempted).

⁴⁶² *Michaels v. Internet Entm't Group, Inc.*, 5 F. Supp. 2d 823 (C.D. Cal. 1998). The court enjoined distribution of a sex video, but on copyright and right of privacy grounds, noting that a state law right of publicity claim would be preempted where "the conduct alleged to violate the right consists only of copying the work in which the plaintiff claims a copyright." *Id.* at 837 (citing *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645 (Ct. App. 1996)); accord *Glovarama, Inc. v. Maljack Prods., Inc.*, 1998 WL 102742 (N.D. Ill. Feb. 26, 1998); see F. Jay Dougherty, *Recent Developments in the Right of Publicity*, 46 J. COPYRIGHT SOC'Y U.S.A. 467, 483-487 (1999).

⁴⁶³ 17 U.S.C. § 101 (definition "work of visual art").

states' laws that grant moral rights protection to limited editions.⁴⁶⁴ By contrast, California's right of publicity statute with respect to deceased celebrities, and the right of publicity laws of several other states, expressly exempt only "single, original works of art."⁴⁶⁵ The decision in *ETW v. Jireh* is consistent with that approach, because the defendant in that case only sold his painting in such a form, rather than the unlimited lithographs and T-shirts sold by Sadlerup.

To the extent that courts elect to apply the transformativeness test, breathing room for freedom of expression should outweigh pecuniary interests of a relatively small group of celebrities, and courts should interpret the test accordingly.⁴⁶⁶

Particularly in view of the aesthetic non-discrimination principle discussed above, courts should err on the side of finding a work of art to be transformative if it contains minimal new expression, meaning or purpose and should not require some greater showing. Indeed, the risk of judicial bias is one reason for strict scrutiny of content-based regulations,⁴⁶⁷ and that risk is high in this context, regardless of whether the transformativeness test is viewed as content-based or content-neutral. The same may be said concerning inquiries as to whether the principal value of the contested work derives from the "creativity, skill, and reputation of the artist."⁴⁶⁸ On this basis, for example, *ETW v. Jireh* should be affirmed by the Sixth Circuit, even if it elects to

⁴⁶⁴ LA. REV. STAT. ANN. § 51:2152 (West 2002) (300 copies); ME. REV. STAT. ANN. tit. 27, § 303 (West 2002) (300 copies); N.J. STAT. ANN. § 2A:24A-3 (West 2002) (300 copies); N.Y. ARTS & CULT. AFF. LAW § 14.03 (McKinney 2002) (300 copies); R.I. GEN. LAWS § 5-62-2 (2002) (300 copies). Two states accord moral rights protection to art of "recognized quality." MASS. GEN. LAWS ch. 231, § 85S (2002); 73 PA. CONS. STAT. § 2102 (2002). Potential constitutional challenges to these statutes based on First Amendment concerns and preemption by copyright law is beyond the scope of this Article.

⁴⁶⁵ California's express exemption from right of publicity claims against single, original works of fine art is only found in its statute recognizing publicity rights of deceased personalities. CAL. CIV. CODE § 3344.1 (West 2002). There is no such express exception in the statute recognizing publicity rights for living persons. *See id.* § 3344. A handful of other states exclude from right of publicity claims single, original works of fine art. *See* 765 ILL. COMP. STAT. 1075/35 (2002); IND. CODE § 32-36-1-1(c)(1)(C) (2002); NEV. REV. STAT. 597.790(2)(e) (2002); OKLA. STAT. tit. 12, § 1448(N)(3) (2002); TEX. REV. CIV. STAT. ANN. art. 4, § 26.012(a)(4) (Vernon 2002). Ohio's statute excludes "original works of fine art" without express limitation to a single copy. OHIO REV. CODE ANN. § 2741.09 (West 2002). Washington's statute excludes single, original works of fine art, but also extends to "photographic, graphic, and sculptural works of art that are not published in more than five copies." WASH. REV. CODE § 63.60.070(2)(a) (West 2002). Note that California's exception for single original works of art was found to be unconstitutional in *Wayne Enterprises v. The Upstairs Gallery, Inc.*, No. C627183 (L.A. Super. Ct. 1988). However, the parties settled after the superior court's judgment, so there is no reported opinion of the case. *See* J. Stephen Bingman, Comment, *A Descendible Right of Publicity: Has the Time Finally Come for a National Standard?*, 17 PEPP. L. REV. 933, 965-66 (1990); Katherine F. Rowe, *Visual Art and the First Amendment; Moral Rights; Resale Royalties*, 312 PLI/PAT 307, 336 (1991).

⁴⁶⁶ *See* Lange, *supra* note 414, at 150; Haemmerli, *supra* note 421, at 445-46.

⁴⁶⁷ *See* Stone, *supra* note 99, at 73.

⁴⁶⁸ *Comedy III Prods., Inc., v. Gary Sadlerup, Inc.*, 21 P.3d 797, 810 (Cal. 2001).

reject the broad protection for art endorsed by the district court in favor of a transformativeness approach.

Second, any commentary or editorial content should be deemed sufficient to satisfy the test. The California Supreme Court recognized that transformative elements are not limited to parody, but also can include factual reporting, fictionalization or subtle social criticism.⁴⁶⁹

Courts applying the *Saderup* test to date have generally followed this approach. For example, in *Hoffman v. Capital Cities, Inc.*,⁴⁷⁰ the court found that a photograph of Dustin Hoffman in the character “Tootsie” that was digitally altered to put the character in a modern dress contained significant transformative elements, satisfying the *Saderup* test.⁴⁷¹ In *Hoepker v. Kruger*,⁴⁷² the defendant artist cropped and enlarged the plaintiff’s photograph, and embodied in a silkscreen together with a short line of text. The resulting collage was exhibited in art museums, reproduced in various gift items and in a book, and used as five-story high “billboard art” in several locations to advertise the exhibit. Although the court criticized the *Saderup* decision for requiring courts to engage in arbitrary line-drawing, it found that Kruger’s collage was sufficiently transformative to satisfy the test.⁴⁷³

By contrast, one decision relying on *Saderup* found that attributing some magazine editorials to the plaintiff was not a transformative use of name.⁴⁷⁴ This case involved solely use of a name and is distinguishable from the *Saderup* facts.

Finally, courts should limit the chilling effect of such a vague test by procedural approaches, such as favoring summary judgment on the issue, at least where no reasonable juror could find a work to be non-transformative, and by placing the burden of proof on the plaintiff to show non-transformativeness. This is supportable because it is reasonable to presume that any

⁴⁶⁹ *Id.* at 809.

⁴⁷⁰ *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001).

⁴⁷¹ *Id.* at 1184, n.2. Although *Hoffman* mentioned the *Saderup* test, it focused on a different and complex approach to assessing conflicts between the right of publicity and the First Amendment, in which a use assertedly excluded from right of publicity claims because it is newsworthy is alleged to lose that defense on the basis of falsity. In that context, some courts require not only falsity, but also a degree of fault derived from defamation and right of privacy cases. In this case, because Mr. Hoffman is a public figure, “actual malice” was required. Mr. Hoffman lost the appeal because he failed to meet his burden of proving the requisite intent. *Id.* at 1189.

⁴⁷² *Hoepker v. Kruger*, 200 F. Supp. 2d 340 (S.D.N.Y. 2002).

⁴⁷³ *Id.* at 349-50. This decision followed the *Simeonov* and *Titan Sports* cases discussed above, and found that even use on the museum gift items was protected by the First Amendment. *Id.* at 353-54. Thus, it exceeded this Article’s proposed categorical test, at least as to the modest quantities and prices involved in museum merchandise.

⁴⁷⁴ *Ackerman v. Ferry*, 2002 WL 31506931 (Cal. Ct. App. Nov. 12, 2002) (not officially published).

copyrightable work of authorship contains sufficient new expression to satisfy the transformativeness test.

One pending California case illustrates the problem that could be avoided by implementing the procedural suggestion made above. In that case, two rock musicians, Johnny and Edgar Winter, sued a comic book when it used in some stories two characters called the Johnny and Edgar Autumn, who were inspired by the Winter Brothers.⁴⁷⁵ The court affirmed denial of a summary judgment as to a right of publicity claim because it concluded that there are triable issues of fact as to whether the use qualifies as transformative.⁴⁷⁶ The California Supreme Court accepted an appeal of the decision. The decision is troublesome for several reasons. For one thing, it applies the transformativeness test to a visual-literary work, not the type of work at issue in *Saderup*, and one which precedent would suggest should be categorically protected by the First Amendment, without a showing of transformativeness. Thus, it threatens to extend the transformativeness test far beyond the boundaries of *Saderup*'s sale of image copies, and place judges in the position of making aesthetic determinations about whether or not works that should be clearly protected by the First Amendment qualify as speech. This is a dangerous precedent for all kinds of expressive works. For purposes of this Article, it also should be considered erroneous because the magazines clearly incorporated substantial creative, expressive material in addition to any indicia of the Winter brothers' identities, and summary judgment should have been available in such a case to avoid chilling expressive speech.⁴⁷⁷

V. CONCLUSION

In its decision in *Saderup*, the California Supreme Court made a valiant attempt to resolve the very difficult problem of the conflict between property rights in persona and the free

⁴⁷⁵ Winter v. DC Comics, 121 Cal. Rptr. 2d 431 (Ct. App. 2002), *review granted*, 54 P.3d 262 (Cal. 2002).

⁴⁷⁶ *Id.* at 442.

⁴⁷⁷ In another recent decision, the Kentucky Supreme Court affirmed summary judgment for the defendant in a right of publicity claim by a stepmother against her stepson who had used video footage of his father in a music video. *Montgomery v. Montgomery*, 60 S.W.3d 524 (Ky. 2001). Citing *Parks v. LaFace Records*, 76 F. Supp. 2d 775 (E.D. Mich.1999), the majority held that the right of publicity was inapplicable as a matter of law and that the use was protected by the First Amendment because there was a "genuine connection" between the use of the father's name and likeness and the content of the music video, which was a "tribute" to the defendant's father. This decision reflects a procedural approach protective of the First Amendment such as that advocated above. Two dissenting justices, however, argued that the court should have applied the *Saderup* test and that the case should have been remanded for trial to balance evidence as to transformativeness. *Id.* at 536 (Keller, J., dissenting).

speech rights of visual artists who depict real people. Unfortunately, the test the court chose inadequately protected freedom of speech. It should be limited to its facts, interpreted liberally, and supplemented with procedural safeguards to limit its chilling effect on speech, until such time as it is ultimately rejected for failing the Supreme Court's requirements for content-based, or at least expression-limiting, laws.

With protections such as those described above, the threat of the right of publicity to freedom of speech in non-advertising cases can be limited. If, ultimately, non-advertising uses of expressive works depicting real people are not categorically protected from right of publicity claims, then at a minimum, visual artists should be protected from such claims when they sell copies of their works not incorporated in unrelated merchandise.▼

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