A New First Amendment Goal line Defense – It’s Time to Stop the Right of Publicity Offensive

Mark A. Conrad
Imagine the conclusion of an iconic sporting event. Exultant fans celebrate their team’s championship victory. Sports writers pen their odes of joy, sacrifice and drama surrounding the season. The team’s quest captures the imagination of millions – and entices authors, filmmakers, artists to capture it the way they deem fit. An author decides to write a week-by-week account of the season leading to the championship. The book’s cover even has a photograph of a group of readily identifiable players who are holding up the championship trophy, including its most valuable player of the team. Throughout the book, player names, descriptions of their styles of play, their actions, their feelings are described. The non-fiction book gives fans a chance to relive that glorious season. It becomes a best seller and the author and publisher make healthy amounts of money.

Now it’s time for the cinematic treatment. The successful author negotiates film rights with one of Hollywood’s leading directors. The film is made and it is a commercial success. Actors play the athletes, but their portrayals are so realistic than many moviegoers think that the real players perform in the film. The film grosses tens of millions of dollars.

Commercial artists sense an opportunity to produce great pieces of visual art. After photographs of the team captain hoisting the championship trophy are captured in broadcasts, newspapers and social media from all over the world, a famous painter creates a canvas representing the thrilling moment of victory, with depictions of readily recognizable players in it. It sells for $1 million at auction. The painter also negotiates licensing rights to reproduce it in lithographs, posters, coffee mugs and other merchandise – for millions more.

A game manufacturer wishes to issue a video game featuring the team and its quest for the championship. The two final teams are represented in the game and by agreement with the team and the respective league. Also, the distributor secured the use of trademark rights to the teams’ names and logos through an appropriate licensing agreement with the respective league and/or team. In this game, no player names are used, but the depictions of the players (or their avatars) bear a fair resemblance to the actual players. The avatars’ striking similarities with the actual players – including height, build, hair color, hair style, skin tone and particular distinctive features such as visors and bandanas – are noticeable, but because no names are used, and the avatars can be changed by the player, there is no literal identification between the actual players and the avatars in the game. Consequently, many fans could deduce that the avatar doubles as the actual player, based on the number, position and general features.
Looking at these hypothetical scenarios, there is little question that the depictions of the players – with their actual names – in the book would be protected speech under the First Amendment. Same with the film. Most likely, the painting as well. However, the video game’s avatars would likely be treated differently, as many argue that the use of the “player” in the avatar images of the game, even without of the use of the player names, would be restricted because of a recent and unwarranted trend of more and more courts to expand the commercial rights of individuals – known as the “Right of Publicity” – at the expense of creative license and free speech.

What began as a novel subset of traditional privacy rights has led courts and legislatures to create a property-based right of publicity jurisprudence that has gone beyond its original goals and now crept into the traditional First Amendment domain of protection of artistic and creative rights. In the last two decades, courts have applied the “right of publicity” doctrine in various artistic contexts – from comic books, baseball cards, t-shirts, fantasy games and action-based videogames, resulting in confusion and inconsistency. Various tests devised by the courts to balance the competing interests of free speech and commercial rights to one’s identity and image have produced a panoply of rulings, exacerbated by a lack of federal law and consistent standards over the issue. The result has been an active, but confusing jurisprudence. Call it personal image protection on steroids.

Debate about the precise balance between free speech rights and the right of publicity is not new and has been discussed by eminent legal scholars reflecting different points of view. However, no adequate resolution seems to be imminent, as the issue has taken on a new urgency in the videogame era with avatars masquerading as real or supposedly real people. Claims by groups of former athletes seeking damages for alleged use of their likenesses in videogames and names in fantasy sports games have been the new frontier in this conflict. Although the facts in two recent cases merit sympathy for former college players’ claims against a Goliath of the National Collegiate Athletic Association (“NCAA”) and gaming companies, the courts are making a big mistake in extending publicity rights to these plaintiffs. As this article seeks to show, it is a case of sympathetic parties making bad law.

Traditional literary license (or, in a more recent twist, “avatar license”) has increasingly been threatened with an unwarranted expansion of the right of publicity. The fault lines are drawn in two cases that have made their slow march in the courts: Hart v. Electronic Arts and In re NCAA Student-Athlete Name & Likeness Licensing Litigation (formally known as Keller v.

---

Electronic Arts and referred in this article as Keller/NCAA). A third case, O’Bannon v. NCAA, while a potentially significant case in other respects, is not applicable and won’t receive discussion, as its central claims are antitrust-based. Hart and Keller/NCAA, on the other hand, involve claims for former NCAA student-athletes who seek compensation by a major videogame company for allegedly misappropriating their images for commercial gain. These cases are still in the motion stage, but have produced four decisions including the two recent Federal appeals court rulings: one by the Third Circuit in Hart (overruling a district court opinion) and a few months later, one by the Ninth in Keller/NCAA (affirming it).

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

Yet, Hart, Keller/NCAA and a series of other cases result in various tests and assumptions that point to the heart of the problem -- the definitional parameters of the right of publicity action and exactly when does this right end First Amendment protection begin. The demarcation point is not easily found, but when dealing with a fundamental constitutional right, there has to be a consistent way to mark the line between property protection and speech protection. This article will propose a new standard.

Essentially, producers of depictions of real people or their images, sounds or other aspects of their persona would create a constitutional privilege for such speech unless it would be “deemed” commercial speech, which or for a commercial purpose. Only if a court determines that the depiction is “commercial speech” would it be subject to a lesser degree of First Amendment protection than political or artistic speech and the person whose name, likeness, sound or other

---

5 See supra note 2.
6 See Central Hudson Gas & Elec. v. Public Serv. Comm’n, 447 U.S. 557 (1980) (The court noted that the
indicia of identity would prevail. The standard would draw on the positive aspects of standards utilized by certain court, with a stronger constitutional imprimatur.

To get to this proposed solution, we have go transverse the rocky landscape of right of publicity doctrine, which this article will do. It will address: (1) the origins, common law and statutory bases of the right of publicity and the various balancing tests used to determine protection; (2) the background, disposition and criticism of the Hart and Keller/NCAA cases; (3) recent cases that may give hints on the précises balance between right of publicity and the First Amendment; and (4) the dawn of a new qualified privilege, replacing the myriad of balancing tests with a general qualified privilege in favor of First Amendment protection.

I. The Right of Publicity

So much literature has been penned regarding the history and application of the right of publicity that we can dispense from a long recitation. The doctrine of right of publicity derived from the tort of commercial misappropriation, which, as the name suggests, steeped in commerce. Centering on the right to protect and exploit one’s name, likeness, voice or persona, it is now considered a form of intellectual property protection, which, unlike copyright and trademark law, is not federalized, but rather a patchwork of different standards and levels of protection, depending on the particular state. As of this writing, about 20 states have statutory protection, while another 30 use court-made common law as its basis.

___

7 See, e.g., 1-1 Nimmer on Copyright § 1.01 (2002) (discussing the intersection of federal copyright law and the right of publicity).
8 One commentator has called it a doctrine with its genus in “unfair competition, intellectual property and tort law. See 1 J. Thomas McCarthy, The Rights of Publicity & Privacy § 1:7 (2d ed. 2008). Scholars and some courts have been drawn to the trademark law similarities of this right. See, id at 1.8; see also, Prosser, Privacy, 48 Calif. L. Rev. 383, 406 (1960) (“The interest protected is not so much a mental as a proprietary one, in the exclusive use of the plaintiff's name and likeness as an aspect of his identity.”). See Lugosi v. Universal Pictures, 25 Cal.3d 813 (1979) (the court discussed “secondary meaning” in determining whether the right continued after the death of the person).
9 See, e.g., CAL. CIVIL CODE § 3344-3344.1 (West 2009); FLA. STAT. ANN. § 540.08 (West 2009); 765 ILL. COMP. STAT. ANN. 1075 §§ 1-10 (West 2009); IND. CODE ANN. § 32-36-1-7 (West 2009); KY. REV. STAT. ANN. § 391.170 (West 2009); MASS. GEN. LAWS ANN. CH. 214, § 3A (WEST 2009); NEB. REV. STAT. § 20-202 (WEST 2009); NEV. REV. STAT. §§ 597.770-597-810 (WEST 2009); N.Y. CIVIL RIGHTS LAW §§ 50-51 (WEST 2009); OHIO REV. CODE ANN. § 2741.06 (WEST 2009); OKLA. STAT. tit. 12 §§ 1448, 1449 (WEST 2009); Pa. CONS. STAT. § 8316 (WEST 2009); R.I. GEN. LAWS §§ 9-1-28, 9-1-28.1(a)(2) (WEST 2009); TENN. CODE ANN. §§ 47-25-1102 to -1107 (WEST 2009); TEX. PROP. CODE ANN. § 26.010 (WEST 2009); UTAH CODE ANN. § 45-3-3 (WEST 2009); VA. CODE ANN. § 8.01-40 (WEST 2009); WASH. REV. CODE § 63.60.010 (WEST 2009); WIS. STAT. § 995.50 (WEST 2009).
10 New Jersey, for example, lacks a statute and relies on common law as a basis for its right of publicity rules. See Faber v. Condecor, Inc., 477 A.2d 1289 (1984) (family photo used to sell pictures frames constituted misappropriation); Georgia does, as well. See Martin Luther King, Jr. Center for Social Change v. American Heritage Products, 250 Ga. 135; 296 S.E.2d 697 (1982) (right of publicity applicable to sale of busts of Dr. King).
Although derived from the tort-based right of privacy which has its genesis back well over a century, the right of publicity came from one of four branches of privacy enunciated by Dean Prosser and adopted by just about every court. Yet, it differs from a privacy tort concept in one crucial way: the privacy torts seek damages for the unreasonable intrusion of someone’s privacy by advertising their name or identity, the publicity right stems from the commercial value of identity. Some states were sensitive to the issue of commercial misappropriation of one’s name early on. New York passed its version of a protection against such misappropriation in 1903, while a few others followed with statutory enactments or common-law rulings.

11 See Louis Brandeis & Samuel Warren, The Right to Privacy, 4 Harv. L. Rev. 193 (1890) (“The right of property in its widest sense, including all possession, including all rights and privileges, and hence embracing the right to an inviolate personality, affords alone that broad basis upon which the protection which the individual demands can be rested.”).
12 See Prosser, 48 Calif. L. Rev. at 403. The branches are trespass, intrusion, false light and what was then known as commercial misappropriation, but later called right of publicity. Portions of the tort have been constitutionalized to balance the rights with First Amendment speech rights. One example is “false light” privacy, which differs from defamation in that it involves a truthful depiction of an event, but casts a person in a false light.
13 See Nimmer, The Right of Publicity, 19 Law & Contemp. Probs. 203 (1954) (Nimmer notes that courts have recognized that the right of publicity exists independently of the right of privacy.).
14 See N.Y. Civil Rights Law §§ 50-51 (McKinney 2010). This statute was the first to recognize a right of privacy for one’s name and identity. It was enacted to reverse the effect of a prior New York Court of Appeals ruling that denied that such a right existed under New York Law. See Roberson v. Rochester Folding-Box Co., 64 N.E. 442 (N.Y. 1902). An early and significant court ruling creating such a right under common law was Pavesich v. New England Life Insurance Co., 50 S.E. 68 (Ga. 1905). For more information, see J. Gordon Hylton, Baseball Cards and the Birth of the Right of Publicity: The Curious Case of Haelan Laboratories v. Topps Chewing Gum, 12 Marq. Sports L. Rev. 272 (2001).
15 New Jersey’s standard has been based on the Restatement definition, although there is no statutory provision. However, courts have applied the definition. See Palmer v. Schonhorn Enterprises, Inc., 232 A. 2d 458 (N.J. Super. 1967) (court upheld privacy-based common law claim, as names of internationally known professional golfer used in biographical information); See Faber v. Condecor, 195 N.J. Super. 81 (1984) (use of family photo in advertisement gave right to a cause of action). Florida’s law is statutory and protects one’s name, portrait and likeness from trade, commercial or advertising purposes. See Fla. Stat. Ann. § 540.08 (West 2009). See also, Loft v. Fuller, 408 So. 2d 619 (Fla. Dist. Ct. App. 1981) (book about air crash does not give victim’s relatives a cause of action under the privacy claims); Illinois’ statute, protects an individual’s identity, in a somewhat more expansive way. Identity includes “any attribute of an individual that serves to identify that individual to an ordinary, reasonable viewer or listener, including but not limited to (i) name, (ii) signature, (iii) photograph, (iv) image, (v) likeness, or (vi) voice.” However, its scope is also commercially based, as the Act protects against unauthorized commercial use of one’s identity, which includes, (i) offering the sale of products, services, etc. (ii) advertising or promoting products, services, etc.; or (iii) fundraising. See Illinois Right of Publicity Act, 765 IILCS 1075.

California has utilized both statutory and common law bases for right of publicity. California's statute, § 3344(a) of the Civil Code, protects against uses of a person's likeness for advertising purposes. Specifically, the statute is intent-based, as it prohibits “knowing” use of a person’s name/likeness/etc., on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent. See Cal. Civ. Code § 3344(a) (West 2009). Subsection (e) provides that it is a question of fact to determine whether the use provides a “direct connection” between the use of that person’s name or likeness with the commercial sponsorship or with the paid advertising. The state’s courts impose a three-step test to determine whether: (1) there was a “knowing” use of the plaintiff’s protected identity; (2) the use was for advertising purposes; and (3) there was a direct connection between the use and the commercial purpose. See, e.g.,
What became known as the right of publicity was born just over six decades ago in a federal appeals ruling in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*\(^6\) where the Second Circuit court first concluded that the more limited tortious right should be expanded into a property-oriented one, and one, in effect, with intellectual property roots. Concomitantly, Dean Prosser and professor Nimmer also advocated that right, and urged its acceptance, but such acceptance came very slowly.\(^7\) And, ironically, the independent right of publicity advocated by Judge Frank in *Haelen Labs*, was overruled as applying to New York, in 1990.\(^8\)

Yet, in the last two decades, *Haelan Labs* spawned a vibrant right of publicity expansion, which most states have adopted as either a common law tort or a statutory provision. About 20 states, including California and Tennessee, follow a copyright law model and recognize the right of publicity to deceased persons.\(^9\)

Not surprisingly, the expansion of the publicity right has led to active litigation – especially involving athletes or former athletes. For example, courts have had to grapple with cases

---


\(^8\) See *Pirone v. MacMillan*, 894 F.2d 579 (2d Cir. 1990) (holding that the use of photographs which did not indicate origin or represent sponsorship did not amount to unfair competition and that New York civil right's law right of privacy protection was clearly limited to living persons).

\(^9\) See Cal Civil Code § 3344.14(g) (privacy right lasts for 70 years after the death of the individual); see also, Tenn. Code Ann. §47-25-1104 (privacy right last for 10 years after death).
involving parody baseball cards, artwork depicting athletes and their specific achievements, comic book images using altered names, and the use of names in fantasy sports games resulting in a doctrine without clear parameters in part due to the varied definitions of what constitutes a right of publicity and, more particularly, in not crafting an adequate balancing approach between the right and free speech.

A. The Boundaries, the Definition

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

More importantly, this factually unique case did not create a workable standard to judge the limits of the right of publicity. As one commentator noted, the court “dodged the question” as to when a media report would be constitutionally protected and when it misappropriates one’s creation. The majority opinion generalized approach haunted the evolution of this area of law because it allowed lower courts to fashion their own balancing tests and, consequently, their own standards. Coming at a time when the court fashioned a more aggressive first Amendment

---

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

21 See ETW v. Jireh Publishing, 332 F.3d 915 (2003), discussed infra at note 33 (court concluded that lithograph depicting golfer’s victory at the Masters’ Tournament was a “transformative” work and not subject to claims by Tiger Woods).

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

23 See C.B.C. v. MLBAM, 505 F.3d 818 (8th Cir. 2007) (use of professional baseball players’ names and statistics protected under the First Amendment), discussed infra at notes 169-173.


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

protection in defamation and, just years before doing the same in the area of commercial speech, this definitional gap is all the more puzzling.\textsuperscript{27} Also, the failure to “federalize” the rules – something it could have done by making a federal baseline like in defamation, was even more problematic, and led to the helter-skelter system we have now. Also worth noting is that the dissenting opinions in \textit{Zacchini} did not give any such guidelines, either.\textsuperscript{28}

Although the opinion looked to copyright law for its rationale, the failure to define its scope, along with the fact that the right of publicity is state-based, means that unlike its intellectual law cousins copyright, patent and trademark, there is no universal, standard definition for right of publicity.\textsuperscript{29} It is true that statutes and courts have crafted standards to determine the right of publicity, differences, albeit minor, in their definitions, but more significant variance in the scope and application of the right.

Let’s start with the Restatement standards, or rather, the virtually identical provisions found in the Restatement of Torts (3d) and the Restatement of Unfair Competition (3d). It states: “[o]ne who appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for the purposes of trade is subject to liability.”\textsuperscript{30} “Purposes of trade” is defined as the use of the identity in advertising of goods or services, or placed on merchandise marketed by the user, or are used in connection with services rendered by the user.”\textsuperscript{31} To preclude the potential of constitutional overbreath, the section limits the scope of both Restatements’ “purposes of trade” basis as communications that “does not ordinarily include the use of a person’s identity in news reporting, commentary, entertainment,


\textsuperscript{28} See \textit{Zacchini}, \textit{supra} note 24 at 579. There was three dissenting justice on the merits of the case – Powell, Brennan and Marshall, who concluded that the First Amendment protects the station from a "right of publicity" or "appropriation" suit, absent a strong showing by the plaintiff that the news broadcast was a subterfuge or cover for private or commercial exploitation. Id. More significantly, these three dissenters would have created a First Amendment privilege for such “newsworthy” broadcasters, unless it can be shown that the appropriation was “subterfuge or cover for private or commercial exploitation.” Id. at 581. This approach echoes the conclusion of the Ohio Supreme Court, which ruled in favor of the television station. \textit{See} 47 Ohio St. 2d 224, 351 N.E. 2d 454, 455 (1976).

\textsuperscript{29} Copyrights, patents and trademarks have statutory definitions. A copyright is an ownership right in “original works of authorship fixed in any tangible medium of expression, now known or later developed. See 17 USC sec. 102(a). The copyright grants monopoly status to the owner, who has the right to use, license or assign. A trademark is “any word, name, symbol, or design, or any combination thereof, used in commerce to identify and distinguish the goods of one manufacturer or seller from those of another and to indicate the source of the goods.” See 15 U.S.C. § 1127. A patent give ownership status to one who “invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101.

\textsuperscript{30} \textit{See} Restatement of Torts (3d) § 46 (1995); Restatement of Unfair Competition (3d) § 46 (1995).

\textsuperscript{31} \textit{See} Restatement of Unfair Competition (3d) § 47.
works of fiction or non-fiction, or in advertising that is incidental to such uses.” This may is the most limited and most commercially-based right of publicity definitions found.

The comments in the Restatement of Unfair Competition point to an inherently limited doctrine – something overlooked in many decisions, including the cases discussed in this article. Comment c to § 47, takes pains to note that “The right of publicity as recognized by statute and common law is fundamentally constrained by the public and constitutional interest in freedom of expression.” In the same comment, the authors state that “[t]he use of a person's identity primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation of the person's right of publicity.”

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

---

32 Id.
33 See Restatement (3d) of Unfair Competition, § 47, cmt. c. One court noted that this “limitation on the right is not confined to news reporting but extends to use in ‘entertainment and other creative works, including both fiction and non-fiction.’” The commentators list examples of protected uses of a celebrity's identity, likeness or image, including unauthorized print or broadcast biographies and novels, plays or motion pictures. See ETW v. Jireh Publishing, 332 F. 3d 915, 930 (6th Cir. 2003). The court in this case added that According to the Restatement, such uses are not protected, however, if the name or likeness is used solely (emphasis added) attract attention to a work that is not related to the identified person, and the privilege may be lost if the work contains substantial falsifications.” Id.
34 Washington, D.C. has adopted the more traditional tort bases of misappropriation under Restatement (2d) Torts, § 652. See Vassiliades v. Garfinckel’s et al, 492 A.2d 580 (1985); Missouri adopted a modified version of the Restatement of Unfair Competition standard in Doe v. TCI Cablevision, 110 S.W. 2d at 370. For more examples, see note 15, supra.
35 See Fla. Stat. § 540.08 (West 2009), which states, in part: “No person shall publish, print, display or otherwise publicly use for purposes of trade or for any commercial or advertising purpose the name, portrait, photograph, or other likeness of any natural person without the express written or oral consent to such use given by: (a) Such person; or (b) Any other person, firm or corporation authorized in writing by such person to license the commercial use of her or his name or likeness; or (c) If such person is deceased, any person, firm or corporation authorized in writing to license the commercial use of her or his name or likeness, or if no person, firm or corporation is so authorized, then by any one from among a class composed of her or his surviving spouse and surviving children. 540.08(1). Like the Restatements, it creates a defense if the publication is “part of any bona fide news report or presentation having a current and legitimate public interest and where such name or likeness is not used for advertising purposes.” Id. at § 3.
36 See Tenn. Code Ann. § 47-25-1104. Although the statute focuses more on the duration of the rights to ten years after the death of the individual, it applies to “Commercial exploitation of the property right by any executor, assignee, heir, or devisee if the individual is deceased” and the termination of that “right to commercial exploitation being terminated by “non-use” for two years subsequent to the death of the individual. Id. At secs. (b) 1 and (b) 2.
37 See 42 Pa.C.S.A 8316(a).
California’s right of publicity statute, however, seems to slightly expand the Restatement standard, applying the right to the knowing use of one’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, as well as for purposes of advertising, selling, or soliciting purchases of, products, merchandise, goods or services and outlines the scope of the actual damages. Its language has permitted courts to extend such protection to the image that may be evocative, but where the public can draw the reference to the created image and the actual person. Another key difference in the scope of right of publicity is that some states have a right of descendability, while others do not.

Except for the descendibility issue, as noted earlier, the statutory and Restatement definitions vary little from the state to state. My concern is the application and interpretation of the scope of the doctrine and the increasing application of the right trumping the First Amendment. Each of the tests that have been employed by various courts over the last two decades has a fundamental flaw: each seems to treat the personal right and the constitutional right on an equal balancing plane. Even content-neutral constitutional standards give more weight to the fundamental right under the so-called “intermediate scrutiny” test. To illustrate, a comparison with the tort of defamation is apt. States have applied defamation differently but the overriding bedrock standard in New York Times and its progeny create a constitutional baseline to prevent that claim from overriding free speech.

39 See Cal. Civil Code § 3344 (West 2009). The complete provision states; “(a) Any person who knowingly uses another’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof. In addition, in any action brought under this section, the person who violated the section shall be liable to the injured party or parties in an amount equal to the greater of seven hundred fifty dollars ($750) or the actual damages suffered by him or her as a result of the unauthorized use, and any profits from the unauthorized use that are attributable to the use and are not taken into account in computing the actual damages. In establishing such profits, the injured party or parties are required to present proof only of the gross revenue attributable to such use, and the person who violated this section is required to prove his or her deductible expenses. Punitive damages may also be awarded to the injured party or parties. The prevailing party in any action under this section shall also be entitled to attorney's fees and costs.

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

41 See note 18 supra. New York does not recognize any common law right of publicity, and its statutory publicity rights, New York Civil Rights Law §§ 50, 51, applies only to living persons, whether famous or unknown. New York does not recognize a postmortem right of publicity or descendability.

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

Notably, there is no requirement of intent or even negligence in any definition of the right of publicity. The notion has not come up with any frequency in the major cases involving this doctrine and while there is no definitive answer as to whether or how much tort-based culpability is required, at one major commentator has assumed that there is no requirement to show intent, despite language in *Haelan* that may be interpreted that way. With that in mind, a short examination – and critique – of each of the myriad follows.

**B. The tests**

1. **The Restatement and the “Relatedness Test”**

By its definition, the Restatement provisions protect the use of another person's name, likeness or other indicia of identity for purposes of trade. A few jurisdictions have inferred that the use must relate to the commercial use, thought, as we will see, more courts have increased the scope of protections for those seeking publicity rights.

So, the Restatement standard keeps the right of publicity on a fairly tight commercial lid. It focuses right of publicity where it should be, primarily applying to situations involving “purposes of trade” which I take to be commercial or advertising use. To bolster this point, a

---

See *Zacchini*, 433 U.S. 562 (1977). See also, *White v. Samsung Electronics*, 971 F.2d 1395 (9th Cir. 1988) (The court held that a robot depicting game show celebrity Vanna White’s “likeness” was actionable within meaning of California Civil Code provision authorizing award of damages against person who knowingly uses another’s likeness for purposes of advertising without consent.); *Doe v. TCI Cablevision*, 110 S.W. 3d 363 (Mo. 2003) (The court held that appellant hockey player “Tony Twist” presented sufficient evidence to establish that respondents used his name for a commercial advantage in a comic book.).

See Restatement (3d) of Unfair Competition, §§ 46 and 47. The name, likeness, and other indicia of a person's identity are used “for purposes of trade” under the rule stated in § 46 if they are used in advertising the user's goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user.
section of the commentary notes that right of publicity “may” extend beyond pure advertising or commercial purposes (in a nod to the Supreme Court’s opinion in Zacchini), but it categorically notes that this is an exception to the rule.\textsuperscript{48} That comment notes that uses that are newsworthy or used in “creative works (fiction or non-fiction) such as an unauthorized biography or a motion picture depiction” are excluded from the scope of the misappropriation,\textsuperscript{49} but a proviso in that comment notes that “if the name or likeness is used solely to attract attention to a work that is not related to the identified person, the user may be subject to liability for a use of the other's identity in advertising.”\textsuperscript{50} Hence, that is why some have coined the Restatement standard as the “relatedness test.”\textsuperscript{51}

The Restatement takes pains to distinguish the right of publicity from the more well-settled, but still difficult to apply standard of fair use in copyright law or issues involving trademark or false advertising.\textsuperscript{52} This is key, because it impacts on the level of the First Amendment protection in any balancing test. For example, false advertising is not entitled to any First Amendment right,\textsuperscript{53} while trademark and copyright law are implicitly subject to a balancing test.\textsuperscript{54}

In my view, there is much to like with the Restatement approach, because it focuses on commercial use. However, it is not ideal because neither the provisions nor the commentary

\textsuperscript{48} Id. at § 47. Comment d. notes “Broader restrictions on the use of another's identity in entertainment, news, or other creative works threaten significant public and constitutional interests.”

\textsuperscript{49} Such uses include “the use of a person's name or likeness in news reporting, whether in newspapers, magazines, or broadcast news . . . use in entertainment and other creative works, including both fiction and nonfiction . . . use as part of an article published in a fan magazine or in a feature story broadcast on an entertainment program . . . dissemination of an unauthorized print or broadcast biography, [and use] of another's identity in a novel, play, or motion picture . . . .” Restatement (Third) of Unfair Competition, sec. 47, cmt. C at 549.

\textsuperscript{50} Id.


\textsuperscript{52} See 17 U.S.C. § 107, which states: “the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work. This concept has drawn considerable consternation by the courts. See Consumers Union v, General Signal Corp., 730 F. 2d 47 (2d Cir. 1984) (Oakes, J., dissenting) (“fair use is one of, if not the most, difficult areas of copyright law”); Regarding trademarks and false advertising, see Restatement § 46, comment d, which notes: “if trademark issues exist in a given case, then these issues should be decided under relevant trademark law, rather than the use of the right of publicity.”


\textsuperscript{54} See Stewart v. Abend, 495 U. S., 207, 230 (“Th[e] evolution of the duration of copyright protection tellingly illustrates the difficulties Congress faces . . . . [I]t is not our role to alter the delicate balance Congress has labored to achieve.”); See also, Harper & Row v. Nation Enterprises, 471 U.S. 539, 556 (1985) (this “idea/expression dichotomy strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author’s expression.”)
point of a definitive balancing test favoring the First Amendment to address free expression concerns. While the comments exempt certain areas from the right and express sympathy to parody and other creative expression, they fail to craft the kind of precise standard or immunity to aid courts in addressing these issues.

Another problem involves the appropriate level of commercial and expressive values in the given work. As one commentator aptly stated what I consider to be a key defect. “If a product is being sold that predominantly exploits the commercial value of an individual's identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some "expressive" content in it that might qualify as "speech" in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.” However, one court opined that under the relatedness test, use of a person's name and identity is actionable only when the use is solely commercial and is otherwise unrelated to that person. In other words, how far does “related to purposes of trade” go?

The problem of relation comes to play in cases where newsworthy depictions are then used for advertising purposes. As noted earlier, the Restatement provisions generally frown from applying publicity rights to such a situation, but do not completely exclude the possibility. An example of this dilemma involves the case of former New York Jets quarterback Joe Namath, who graced the cover of Sports Illustrated when he led his team to victory in Super Bowl III. A replica of that cover was used in subway and other billboards around New York to sell copies of the magazine. If the relatedness test would have been used (which it was not), then a court could note that there were “expressive” elements, but that the commercial right to sell the magazine could result in a right of publicity claim. Although the Restatement provision does exempt "the

---

55 Restatement (3d) of Unfair Competition, § 46, cmt. d, which states. “In cases of imitation, the public interest in competition and in avoiding the monopolization of successful styles, together with the interest in the production of new works including parody and satire, will ordinarily outweigh any adverse effect on the plaintiff's market. When the defendant's appropriation consists, not of an imitation, but of an unauthorized broadcast or other reproduction of an actual performance by the plaintiff, the greater likelihood of commercial injury to the plaintiff and the reduced public interest in permitting the use may justify relief in exceptional circumstances (emphasis added).


57 See Doe v. TCI Cablevision, 110 S.W. 3d 363 (Mo. 2003).

58 See Restatement (Third) Unfair Competition, § 47, which notes that “[t]he name, likeness, and other indicia of a person's identity are used “for purposes of trade” under the rule stated in § 46 if they are used in advertising the user's goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user. However, use “for purposes of trade” does not ordinarily include the use of a person's identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.

use of a person's name or likeness in news reporting,” 60 it does not precisely address this kind of situation, which was predominantly an attempt to sell copies of that journal to Jets fans. Given the expansion of publicity rights in recent years, it is theoretically possible that the Restatement test may not exempt this kind of particularized semi-commercial use.

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

This standard, with trademark law roots, was first utilized in the Second Circuit’s ruling in Rogers v. Grimaldi.61 In Rogers, The court rejected the claim that the title “Ginger and Fred” violated the famed dancer Ginger Rogers’s publicity rights and constituted false advertising under the Lanham Act, and in doing so, it noted that the title had minimal artistic relevance to the film.62 The Second Circuit, in overruling a prior test,63 held that the Lanham Act “should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” 64 The test, based on the issue of confusion of the purpose of the use, was adopted in several other jurisdictions.65 As to the right of publicity claims, the court also granted summary judgment, concluding that the use of a celebrity's name in a movie title did not violate publicity rights unless the title was “wholly

republication of plaintiff’s picture was ‘in motivation, sheer advertising and solicitation.’ [However, t]his alone is not determinative of the question so long as the law accords an exempt status to incidental advertising of the news medium itself.” 371 N.Y.S. 2d at 12. See also, Montana v. San Jose Mercury News, 40 Cal. Rptr. 2d 639 (1995), which held that the poster-sized reproduction of actual newspaper pages, with artistic renditions of the NFL quarterback’s likeness and the sale of such posters were protected by the First Amendment, in part, relying on Namath. The case was also decided before California adopted the transformative test, discussed, infra.

60 See Restatement (3d) of Unfair Competition § 46.

61 875 F.2d 994 (2d Cir. 1989). The well-known dancer Ginger Rogers sued the producers and distributors of a motion picture called “Ginger and Fred” alleging that the use of her name in the film’s title violated her publicity rights and rights under the Lanham Act. Rogers became known as a part of dance team with her co-partner Fred Astaire, making many films together. The film in question depicted an pair of Italian cabaret dancers who “only obliquely relates” to the dancing of Rogers and Astaire. Id. at 994.

62 Id. at 1006.

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

64 Id. at 999. For a analytical, detailed treatment of the case, see David M. Kelly and Lynn M. Jordan, Twenty Years Of Rogers V. Grimaldi: Balancing The Lanham Act With The First Amendment Rights Of Creators Of Artistic Works, 99 TMR 1360.

65 See Parks v. LaFace Records, 328 F. 3d 437 (6th Cir. 2003) (concluding that the use of the Civil Rights icon’s name in a song by the rap group Outkast was justifiably creative and referring to competitor groups being inferior to them and going “to the back of the bus.” Id. at 460. See also, Mattel v. MCA Records, 296 F.3d 984 (9th Cir. 2002). Curiously, the 9th Circuit adopted the test for Lanham Act cases, even though the California State courts adopted the transformative test.
unrelated” to the movie or was “simply a disguised commercial advertisement for the sale of goods or services.”

On the positive side, the Rogers test presumes First Amendment protection more than other standards, barring the confusion, and by extension, it protects literary license. It infers a strong commercial requirement of the speech, since under trademark law “use in commerce” is a key component. However, the problem with the Rogers test is that it is a trademark infringement test based on confusion and false endorsement under the Lanham Act that is awkwardly extended to right of publicity because lumping publicity claims as a mirror image of Lanham Act is inserting a round peg in the square hole.

Central to the Lanham Act/false endorsement claims is the question of falsity, and there is no such requirement (or even issue) in the right of publicity. Doctrinally, that is the problem in cherry-picking aspects of one doctrine to another, which has similarities, but significant differences as well. Right of publicity is a property right, but is not the same as a trademark, as the former is a protection of the misappropriation of one’s identity while the latter involves the use of a false endorsement to “attract attention” to the product advertised by use of the person’s image.

3. “Predominant Purpose” Test

This test, created by the Supreme Court of Missouri in its 2003, requires that plaintiff’s name and likeness are used with the intent to obtain a commercial advantage and is intended to balance the respective interests of the individual based on the “purpose” of the use. The case involved the creation and depiction of a mob type character in a comic book that had a similar name, but not similar illustrative attributes, to a professional hockey player. The player sued on

---

66 See Rogers, 875 F.2d at 1005.
67 Based on its interpretation of the Lanham Act provision, the court concluded that the appellees were entitled to summary judgment, thereby rejecting the argument that the title gave the false impression that the film is about Rogers and Astaire. 875 F. 2d at 1001-02.
68 See Lanham Act, Sec. 43(a), which imposes civil liability to “[a]ny person who shall affix, apply, or annex, or use in connection with any goods or services ... a false designation of origin, or any false description or representation ... and shall cause such goods or services to enter into commerce....15 U.S.C. § 1125(a).
71 See Doe 110 S.W. 3d at 369.
72 The character, named “Tony Twistelli” is a particularly vile individual, who orders child abductions and murders. The hockey player who brought the action was named Tony Twist and was regarded as one of the toughest
defamation and misappropriation claims, and the lower courts dismissed on First Amendment grounds. The Missouri Court of Appeals, which affirmed the trial court's dismissal, concluded that because the Twistelli character was not “a depiction” of “Twist the hockey player” and because McFarlane (the creator) never used Twist's identity to propose a commercial transaction, the First Amendment barred Twist's claims. This is what the Supreme Court should have concluded as well. Taken from the Restatement definition, it puts the publicity claim right where it should be legally. However, the state’s Supreme Court thought otherwise.

However, the Missouri Supreme Court reversed on the ground that the “predominant purpose” of the work was commercial rather than expressive in nature, meaning that the character was more of a vehicle to sell comic books banking on the alteration of the hockey player’s name than in the expressive creation. While the court gives lip service to First Amendment protections, it notes that the First Amendment does not “always trump” commercial rights.

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

I would argue that this is not a publicity case at all; rather, it’s a defamation case “of and concerning” Twist and should have been solely considered as such. The opinion in Doe makes an end-run to place it as a right of publicity case that presumptively denies First Amendment protection to a work that may be partly, but not predominately expressive. The court shows its bias by saying that the publicity claim should be “more durable” and less subject to First Amendment considerations than a defamation claim. And, if the use of Twist’s “name” in the comic was simply a method to sell comic books, if such evidence can be determined, that it could be deemed “malice” or “pure commercial speech” areas of jurisprudence that lessen First Amendment protections.

For a good summary of the case, see Recent Cases: First Amendment - Right of Publicity - Missouri Supreme Court Creates “Predominant Purpose” Test for First Amendment Defenses to Publicity Right Claims, 117 HArv. L. Rev. 1275, 1277.

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


See Doe, 110 S.W.3rd at 372-73.
Amendment protection. Very few courts have adopted this test and it has been the subject of much criticism.  

4. The “Transformative” Test

If any of the balancing tests could be considered the “darling” of the courts these days, it is this one. A number of commentators have extolled the virtues of this test, first adopted by the California Supreme Court in the 2001 case of Comedy III v. Gary Sandrup, and refined two years later in Winters v. DC Comics. The transformative test takes a literal depiction versus a creative or literary license approach in that the court must determine whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness. The test has its antecedent on the earlier “Vanna White” case, where a “lookalike” to the celebrity was held to be in violation of her publicity rights under California law. Like the other tests, it focuses on a balance between the

---

78 See Hart, 717 F.3d 141, 154 (2013) (“By our reading, the Predominant Use Test is subjective at best, arbitrary at worst, and in either case calls upon judges to act as both impartial jurists and discerning art critics. These two roles cannot co-exist.”); see also, Kirby v. Sega of America, Inc. 144 Cal. App. 4th 47, 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006) (where the court rejected the predominant use test in favor of the transformative test); and C.B.C. v. MLBAM 443 F.Supp.2d 1077 (ED. Mo. 2006). (The court reasoned that the predominant use test was not applicable in the case at bar, thus rejecting it.) For further discussion see Mark S. Lee, Agents of Chaos: Judicial Confusion in Defining the Right of Publicity - Free Speech Interface, 23 Loy. L.A. ENT. L. REV. 471, 500 (2003); and Jason K. Levine, Can the Right of Publicity Afford Free Speech?: A New Right of Publicity Test for First Amendment Cases, 27 HASTINGS COMM. & ENT. L. J. 171, 220-21 (2004).

79 Some have criticized aspects of the test and proposed slight modifications on the burden of proof. See Marc Edelman, Protecting College Athletes’ Publicity Rights in Commercial Videogames, 65 U. of Fl. L. Rev. 554, (2013) (author argues that plaintiff has the initial burden of showing a prima facie case of breach of his publicity rights, once this burden is met, the burden could still shift to the defendant to argue in favor of First Amendment preemption. However, under a revised test, the burden to shift back to the plaintiff to argue that the transformative element represents a partial, rather than full, transformation of the plaintiff’s identity.)


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

82 30 Cal. 4th 881, 69 P. 3d 473 (Cal. 2003). The case involved two musicians, Johnny and Edgar Winter, who both possessed long white hair and albino features, who brought suit against a comic book company over images of two villainous half-man, half-worm creatures, both with long white hair and albino features, named Johnny and Edgar Autumn. The court concluded it was a transformative use since the work did not contain literal depictions, but “merely part of the raw materials from which the comic books were synthesized.” Therefore, the characters were sufficiently transformed so as to entitle the comic book to First Amendment protection. Id at 479

83 See Comedy III, 106 Cal. Rptr. 2d at 140 (“when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity.”).

84 See White v. Samsung Electronics, 971 F.2d 1395 (9th Cir. 1988) The court held that an ad depicting a robot “dressed in a wig, gown, and jewelry” violated Vanna White’s right of publicity. In a questionable application of the property rights of the White, the majority court applied the right of publicity to attributes or symbols that may
commercial use and first amendment protections.\textsuperscript{85} However, it is more intricate and potentially broader as the Comedy III court adopted a multiple-based rationale, whereby courts would look into such factors as the primacy of the celebrity likeness in the nature of the work, the motivation of the creator in crafting the depiction, the economic value of the celebrity likeness and the level of creativity used in the work.\textsuperscript{86}

In adopting the transformative test, the California courts (as well as the third circuit in Hart), were sensitive – even more than in the Rogers test – to the balancing of expressive and non-expressive elements. However, it suffers from the same problem as the other standards – it cannot come up with a good way to demarcate the boundaries to acknowledge First Amendment rights.

Compounding the problem is that it forces courts to be judges of artistic expression in a very direct way.\textsuperscript{87} A case in point is ETW v. Jireh Publishing,\textsuperscript{88} which in effect adopted a version of trigger the celebrity’s identity, as long as they are used for commercial gain. So, simply using a blond wig and a “wheel” that looks like the spinning wheel in the “Wheel of Fortune” game constituted a misappropriation of White’s property rights. The court dismissed any parody defense under the First Amendment as “subservient” to the commercial claims, without making a formally balancing. \textit{Id.} at 1401. In one sense, this is Missouri’s “Predominant Use” test run amok. It is noteworthy that the opinion produced critical dissents from two Judges and a fair amount of scholarly criticism. \textit{See}, e.g., Arlen W. Langvardt, \textit{The Troubling Implications of a Right of Publicity “Wheel” Spun Out of Control}, 45 KAN. L. REV. 329, 330 (1997) (claiming that the Ninth Circuit decision in White “handed celebrities a new property right with greatly expanded boundaries”); David S. Welkowitz, \textit{Catching Smoke, Nailing JELL-O to a Wall: The Vanna White Case and the Limits of Celebrity Rights}, 3 J. INTELL. PROP. L. 67, 76–85 (1995); Linda J. Stack, Note, \textit{White v. Samsung Electronics America, Inc.’s Expansion of Publicity: Enriching Celebrities at the Expense of Free Speech}, 89 NW. U. L. REV. 1189, 1202–26 (1995) (arguing that the White court “expanded the right of publicity in a manner inconsistent with precedent, the Constitution, and societal concerns”)


\textsuperscript{86} See J. Thomas McCarthy, \textit{The Rights of Publicity and Privacy} § 8:72 (2d ed. 2012) as cited in In re NCAA, --- F.3d ----, at 3 (2013). The full list of factors is as follows: first, if “the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized,” it is more likely to be transformative than if “the depiction or imitation of the celebrity is the very sum and substance of the work in question.” [internal citations omitted] Second, the work is protected if it is “primarily the defendant’s own expression”—as long as that expression is “something other than the likeness of the celebrity.” [internal citations omitted] This factor requires an examination of whether a likely purchaser’s primary motivation is to buy a reproduction of the celebrity, or to buy the expressive work of that artist. [internal citations omitted] Third, to avoid making judgments concerning “the quality of the artistic contribution,” a court should conduct an inquiry “more quantitative than qualitative” and ask “whether the literal and imitative or the creative elements predominate in the work.” [internal citations omitted]. Fourth, . . . “a subsidiary inquiry” would be useful in close cases: whether “the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted.” [internal citations omitted] Lastly, the court indicated that “when an artist’s skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame,” the work is not transformative.

\textsuperscript{87} This pointed was well-stated in an amicus brief in Hart: “With no original work to measure against the defendant’s work, the only metric of “transformation” comes from what the court thinks is artistic, or not, about the
the transformative test to a depiction by a commercial artist of Tiger Woods’ winning his first Masters golf tournament. The painting, copies of which were sold for about $800 each, showed a mirror view of two images of a very realistic-looking Woods looking at the hole, with his caddy nearby. The only “imaginative” portion was the ghost-like faces of past Master’s winners in back of the scoreboard and the club house. In rejecting Woods’ claim, the majority of the appeals court considered the work more than a literal depiction; it was “expressive”, according to the court, because it was transformative. Additionally, the opinion noted that Woods was making a lucrative living from golf and the many commercial endorsements he had, while the artist did not have such economic advantages.

But the illustration is clearly Woods. It is a virtual portrait of Woods in a depiction of a real event, albeit with certain fictionalization. So how “transformative” is it? Some may say yes, but others no. It can be a very subjective question and one that can be especially problematic when applying it to videogame depictions of athletes. These games have both elements – realistic depictions, but also the ability to creative different competitive scenarios for these athletes.

The above series of tests – along with prior case law that does not espouse a specific test – has resulted in a various potpourri of cases involving athletes attempting to claim publicity rights in various unauthorized depictions disseminated to the public. For example, there are cases, which


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

Id. at 918 (“In the foreground of Rush’s painting are three views of Woods in different poses. In the center, he is completing the swing of a golf club, and on each side he is crouching, lining up and/or observing the progress of a putt. To the left of Woods is his caddy, Mike “Fluff” Cowan, and to his right is his final round partner’s caddy. Behind these figures is the Augusta National Clubhouse. In a blue background behind the clubhouse are likenesses of famous golfers of the past looking down on Woods. These include Arnold Palmer, Sam Snead, Ben Hogan, Walter Hagen, Bobby Jones, and Jack Nicklaus. Behind them is the Masters leader board.”).

Id. at 938 (“applying the transformative effects test adopted by the Supreme Court of California in Comedy III, we find that Rush’s work does contain significant transformative elements which make it especially worthy of First Amendment protection and also less likely to interfere with the economic interest protected by Woods’ right of publicity).

Id. at 938 (“Even in the absence of his right of publicity, he would still be able to reap substantial financial rewards from authorized appearances and endorsements. It is not at all clear that the appearance of Wood’s likeness in artwork prints which display one of his major achievements will reduce the commercial value of his likeness.”).
reject such claims for the use of reproduction of magazine pages on billboards. Some conclude that the simple retelling of statistical information about a player in an advertisement gave rise to a cognizable claim, while others concluded otherwise. Some cases weighted on a commercial speech-oriented theory in making the determination. In one, the Tenth Circuit concluded that baseball cards that had caricatures of players were “fully” protected speech because they were not commercial in nature (ironic, since the very case that created the right of publicity involved baseball playing cards). The transformative test takes too many factors into account, is too subjective, and it gives a court the opportunity to apply it inconsistently and far too broadly to be constitutionally consistent.

In sum, with the exception of the Restatement test, the other tests strive to deal with the situation of speech utilizing one’s name or likeness that has both expressive and commercial elements. In doing so, each of the tests engages in a judicial form of nit-picking by either determining the predominant purpose of the speech, or how creative it is (through the transformative test). In my view, this becomes a torturous case-by-case jumble through several different tests espoused in different jurisdictions to laws that may vary from state to state. And most significantly, none of these tests give the First Amendment its due.

II. The Hart and Keller litigation

A. Hart

---


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

94 See C.B.C. Distribution v. MLBAM, 505 F.3d 818 (8th Cir. 2007) (use of name and player statistics in a online fantasy sports game protected under the First Amendment), discussed infra. Compare with Palmer v. Schonhorn Enterprises, Inc., 232 A.2d 458 (1967), which involved the use of illustrations of Arnold Palmer and other golfers in a board game affected their potential licensing income. Also, compare with ETW v. Jireh, where the court basically said that Woods made enough income so that damages in this case would be minimal. Supra. At n. XX

95 See Cardtoons v. Major League Baseball Players’ Assn., 95 F.3d 959 (10th Cir. 1996) (where court upheld First Amendment rights or parody baseball cards). Compare with Comedy III, 106 Cal. Rptr. 2d 126, which upheld publicity claims due to the “literal” depiction of The Three Stooges on T-shirts).

96 See HaeLEN Labs v. Topps, 202 F.2d 866 (1953).
Ryan Hart played quarterback on the Rutgers University football team from 2002-05. As a National Collegiate Athletic Association (“NCAA”) “student-athlete,” he was required to forego any commercial opportunities that result from his athletic pursuits, as required by the “amateurism” rule of the organization. In particular, he was barred from accepting any compensation for or even permitting the use of his or her name or picture to advertise, recommend or promote directly the sale or use of a commercial product or service of any kind. Hart achieved considerable success in his years at Rutgers.

Although the NCAA prohibited Hart from entering any agreements exploiting his name and image, the organization had no second thoughts about making such agreements with Electronic Arts, and secured agreements to create an electronic game called “NCAA Football” first marketed in 1993. As constituted, the game involves potentially thousands of college players. While the players are avatars in that their specific names are not used, the creators of the game have created the images to bear a strong resemblance by the use of the same numbers, and characteristics. Specifically, the game shows a player’s actual jersey number and “virtually identical” height, weight, build, skin tone, hair color, and home state. However, there are fictionalized aspects as well. EA omits the players’ names on their jerseys and assigns each player a hometown that is different from the actual player’s hometown.

97 See 2011-12 NCAA Division I Manual § 12.01.1 (2011) (“Only an amateur student-athlete is eligible for inter-collegiate athletics participation in a particular sport.”), cited in Hart v. EA, 717 F.3d 141 (3d Cir. 2013). More specifically, the rules state that a collegiate athlete loses his or her amateur status if the athlete “[u]ses his or her athletics skill (directly or indirectly) for pay in any form in that sport.” Id. § 12.1.2.

98 Id. at § 12.5.2.1. It is important to understand the precise nature of the agreement that student-athletes are currently held to when they first transfer their rights of publicity. The Letter of Intent and Statement of Financial Aid, which contains the conditions and amount of the scholarship (if any), provide the basis for the contractual relationship between the university and the student-athlete. The school promises to pay for the educational fees and expenses incurred by the student-athlete assuming the student-athlete receives an athletic scholarship, and the student-athlete promises to participate in the school’s athletic program and adhere to the NCAA’s rules. See NCAA MANUAL, supra note 29, art. 12.5.2.1 (a student-athlete may not “[a]ccept[] any remuneration for or permit[] the use of his . . . name or picture to advertise, recommend or promote directly the sale or use of a commercial product or service of any kind; or . . . [r]eceive[] remuneration for endorsing a commercial product or service through . . . [his] use of such product or service).  

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

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

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

102 See In re NCAA Student-Athlete Name & Likeness Licensing Litigation, --- F.3d ---- (2013) (9th Cir. July 31, 2013) at 1. Additionally, EA creates realistic virtual versions of actual stadiums; populates them with the virtual athletes, coaches, cheerleaders, and fans realistically rendered by EA’s graphic artists; and incorporates realistic sounds such as the crunch of the players’ pads and the roar of the crowd. Id.
EA filed motion to dismiss, claiming that Hart’s claims on First Amendment grounds. The District Court granted the motion, first noting that for the sake of this motion, the court accepted the existence of a prima facie right of publicity in New Jersey. The district then addressed the scope of the First Amendment claims directly, concluding, after a lengthy discussion, that the constitutional rights trump any right of publicity under New Jersey law, thereby dismissing the case. First, the opinion discussed the nature of the First Amendment application to videogames, citing the then-recently decided Brown v. Entertainment Merchants Association ruling that applied content-based First Amendment standards for a statute prohibiting sales or rentals of “violent videogames” to minors. In so doing, the district court rejected that argument that like Brown, strict scrutiny applied in this case, thereby applying the less onerous intermediate scrutiny test for non-content restrictions on speech. However, in a blow to the plaintiff, it also rejected the argument that the games were “commercial” in nature, thereby dismissing the argument that commercial speech doctrine (and its lesser standard of First Amendment protection) should apply.

According to the district court, intermediate scrutiny implies a balancing test and the court proceeded to apply one of several tests mentioned earlier to this case. Noting that New Jersey adopted a right of publicity as a property right, rather than the more traditional misappropriation tort, the court had to craft or apply one of the existing balancing tests, which the circuit or

---

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

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

106 131 S.Ct. 2729, 180 L. Ed. 2d 708 (2011). The statute also required warning labels on such games and imposed civil fines for violators.

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

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

109 See McFarland v. Miller, 14 F.3d 912, 917 (3d Cir. 1994) (“In New Jersey, the right of publicity is a property right.”). See also, Palmer v. v. Schonhorn Enterprises, Inc., 232 A.2d 458 (1967), which concluded that the use of a famous golfer’s name constituted misappropriation.)
New Jersey state courts had not done beforehand. The court narrowed its focus, considering two of the tests, the “Rogers test” and the “transformative test.” Although it preferred the transformative test as the “more refined” standard than the Rogers test, the court concluded that under either test, Hart’s claim would fail.

Viewing the test as a mirror image of the copyright fair use standard, the court applied intellectual property principles from copyright law and from the California Supreme Court’s adoption of the transformative test in Comedy III. In so doing, the court found that despite what seemed to be the game’s goal of capitalizing upon the fame of those players, the court nevertheless found that elements of the game created a transformative depiction of the game, including the use of virtual coaches, alteration of the player avatars and the use of fans and sound effects. In other words, the interactivity of the game is what makes it transformative, rather than looking at how much alteration there is from the literal image of Hart and other players.

The court took pains to distinguish Hart from the Keller v. Electronic Arts district court ruling, which reached the opposite result. The opinion also discussed the Rodgers test (as the alternative to the transformative test, which it applied) and why that test is not ideal for

110 See Hart v. EA, 808 F. Supp. 2d at 775. See Comedy III, 106 Cal. Rptr. 2d 126 (2001); ETW Corp. v. Jireh Publishing, Inc., 332 F.3d 915, 935 (6th Cir. 2003) (transformative test); Doe v. TCI Cablevision, 110 S.W.3d 363 (2003) (predominant use factor test); Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989) (relatedness test). The lower court in Hart also noted that the U.S. Supreme Court in Zacchini, but stating that subsequent lower courts have limited the scope of this ruling.

111 See note 61, supra.

112 See note 21, supra.

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

114 See Comedy III Productions, Inc. v. Gary Saderup, Inc., 25 Cal. 4th 387, 106 Cal. Rptr. 2d 126, 21 P.3d 797 (2001). The court noted: “Viewing the right of publicity as akin to an intellectual property right, designed to protect the “considerable money, time, and energy . . . needed to develop one's prominence in a particular field,” id. at 399 (quoting Lugosi v. Universal Pictures, 25 Cal.3d 813, 160 Cal. Rptr. 323, 603 P.2d 425 (1979)), the Court concluded that a test incorporating elements of the copyright fair use doctrine most appropriately balanced the competing First Amendment and right of publicity interests. Id. at 404. See Hart, 808 F. Supp. 2d at 778-79.

115 Id. at 783. The opinion added, “[e]ven focusing on Hart’s virtual image alone, it is clear that the game is transformative. It is true that the virtual player bears resemblance to Hart and was designed with Hart’s physical attributes, sports statistics, and biographical information in mind. However, as noted, the game permits users to alter Hart's virtual player, control the player's throw distance and accuracy, change the team of which the player is a part by downloading varying team names and rosters, or engage in “Dynasty” mode, in which the user incorporates players from historical teams into the gameplay. Id.

116 Id. at 787. See Keller v. Electronic Arts, 2010 U.S. Dist. LEXIS 10719; 94 U.S.P.Q.2D (BNA) 1130; 38 Media L. Rep. 1353 (N.D. Ca., 2010). The Hart district court opinion criticized the holding in Keller, as misapplying the transformative test because it focused solely on the image, rather than the game itself.
determination this kind of right of publicity case.\textsuperscript{117} In so deciding, it noted that plaintiff’s image was not “wholly unrelated” to the game, nor a “disguised commercial advertisement” deriving primarily from trademark and unfair competition law, rather than the property-based right of publicity.\textsuperscript{118}

Significantly, the court discussed whether the expression embodied in the EA game constitutes commercial speech, thereby qualified for lesser First Amendment protection. In rejecting this argument, the court applied a definitional test employed in the Third Circuit ruling in \textit{Facenda v. NFL Films},\textsuperscript{119} and concluded that it was not an advertisement and did not refer to another specific product, noting that the depiction of Hart was used directly as part of the game, and not in any independent advertisements or marketing promotions.\textsuperscript{120}

Hart appealed to the Third Circuit and in a 2-1 opinion, that appeals court majority reversed the conclusions of the district court, resulting in a decision more in line with the \textit{Keller} ruling. The majority opinion was tighter and more direct than the lower court’s ruling and it framed the issue quite directly: whether the right to freedom of expression overpowers the right of publicity.\textsuperscript{121} After noting that New Jersey has adopted a common law right of publicity, with privacy antecedents dating back to 1907,\textsuperscript{122} the majority admitted that this is a case of first impression because “neither the New Jersey courts nor our own circuit have set out a definitive methodology for balancing the tension between the First Amendment and the right of publicity.”\textsuperscript{123}

After discussing the various balancing tests that courts used following the Supreme Court’s ruling in \textit{Zacchini}, the majority (and dissenting judge as well) agreed that the transformative test should be the standard adopted in this circuit, following its use in the Ninth and Sixth Circuits.\textsuperscript{124}

\textsuperscript{117} \textit{Hart}, 808 F. Supp. 2d at 787-793.
\textsuperscript{118} \textit{Id.} at 791. (“courts have noted that right of publicity claims do not embody the same likelihood-of-confusion concerns that the \textit{Rogers} Lanham Act test is designed to protect. [citations omitted] . . . For this reason, I question the wisdom of applying a trademark-based test to right of publicity claims without accounting for this difference.”) \textsuperscript{119} 542 F.3d 1007, 1016 (3d Cir. 2008).
\textsuperscript{120} In distinguishing \textit{Hart} from \textit{Facenda}, the court noted: “The speech at issue in \textit{Facenda} was a video that the court characterized as a ‘late-night, half-hour-long ’infomercial’ [for the \textit{Madden Football} video game, that was] only broadcast eight times in a three-day span immediately before the release of the video game to retail stores – much like an advertisement for an upcoming film.” \textit{Facenda}, 542 F.3d 1017. The “infomercial” referred specifically, and solely, to the \textit{Madden Football} video game. . . .In short, the video “aim[ed] to promote another creative work, the video game.” \textit{Id.} at 1018. Here, by contrast, the speech \textit{is} the video game that is being sold. It is not a separate instance of speech that promotes the purchase of another work. \textit{See} \textit{Hart}, 808 F. Supp. 2d at 770.
\textsuperscript{121} \textit{See} \textit{Hart v. Electronic Arts}, 717 F.3d 141, 150 (3rd Cir. 2013).
\textsuperscript{122} \textit{See} \textit{Edison v. Edison Polyform Mfg. Co.}, 73 N.J. Eq. 136, 67 A. 392, 394 (N.J. Ch. 1907) (enjoining a company from using the name or likeness of Thomas Edison to promote its products).
\textsuperscript{123} \textit{Id.}
In doing so, the majority concluded that other balancing approaches were less effective in determining the proper balance. The “predominant use” test, advocated by appellant and discussed earlier in this article, was deemed “subjective at best, arbitrary at worst, and in either case calls upon judges to act as both impartial jurists and discerning art critics.” Adopting it would have serious First Amendment consequences, because if the predominant purpose of the work is commercial, yet it still has expressive elements, and under the predominant use standard, it would lose its First Amendment standing.

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

The court then applied the transformative test, despite its recent vintage and relative lack of venerable case law utilizing it, and gave examples of salient cases that were literal depictions of a celebrity likeness, cases involving a significant transformation and a case that involved more than a “trivial” change in the likeness, but one significant enough to “alter the meaning” of the likeness. The majority then discussed case law that applied this test to videogames,

126 Id. In criticizing this test, the majority noted “[t]he game would have the exact same level of First Amendment expressiveness if [Appellee] didn't appropriate Mr. Hart's likeness, . . .Such reasoning, however, leads down a dangerous and rightly-shunned road: adopting Appellant's suggested analysis would be tantamount to admitting that it is proper for courts to analyze select elements of a work to determine how much they contribute to the entire work's expressiveness. Moreover, as a necessary (and insidious) consequence, the Appellant's approach would suppose that there exists a broad range of seemingly expressive speech that has no First Amendment value.”
127 Id. at 157. (“Appellee argues that Appellant should be unable to assert a claim for appropriating his likeness as a football player precisely because his likeness was used for a game about football. Adopting this line of reasoning threatens to turn the right of publicity on its head.”).
128 See Comedy III, 106 Cal. Rptr. 2d 126 (2001) (charcoal portraits of the Three Stooges did violate the Stooges’ rights of publicity, as the court could “discern no significant transformative or creative contribution” and that “the marketability and economic value of [the work] derives primarily from the fame of the celebrities depicted.” Id. at 811, cited in Hart at 159.
129 See Winter v. DC Comics, 30 Cal. 4th 881, 134 Cal. Rptr. 2d 634, 69 P.3d 473, 476 (Cal. 2003) n. 76.
130 See ETW v. Jireh Publishing, 332 F.3d 915 (2003). As the appellate court in stated: “ETW presents an archetypical example of a case falling somewhere in the middle of Transformative Use Test jurisprudence, given that it focuses on the use of photographs (literal depictions of celebrities), but adds a transformative aspect to the work, thereby altering the meaning behind the use of the celebrity's likeness. Id. At 16.
131 See Kirby v. Sega of America, Inc., 144 Cal. App. 4th 47, 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006) (applying the transformative test to a videogame which allegedly depicted the likeness and signature phrases of a musician. The court rejected the right of publicity claim against a video game company. Specifically, the musician (Kerin
before finally concluding that this test is best suited for adoption in this case and in the Circuit at large. Stating “the Transformative Use Test effectively restricts right of publicity claims to a very narrow universe of expressive works,” the majority found that it is the most consistent with other courts' ad hoc approaches to right of publicity cases. In applying the test, the judges concluded that there was more of a literal depiction of Hart with minimal alteration. More specifically, the majority rejected the idea that the user’s ability to alter the image of the avatar player precludes a right of publicity. In applying this point to the case at hand, the opinion concluded that the realistic image of the player was default and the ability to alter that image was ancillary. “To hold otherwise would have deleterious consequences for the state of the law,” it noted. In ruling that the use does not pass the transformative test and does not have a de facto First Amendment privilege, the court reversed the lower court’s summary judgment determination.

In dissent, Judge Ambro agreed that the transformative test should be applied, but in doing so, he sided with Electronic Arts. He looked at NCAA Football in a broad context, not in terms of the identity of a player, but in terms of the entire product, which he found sufficiently creative and expressive to be “transformative.” In criticizing the majority’s approach, the court cited ETW v. Jireh Publishing (the “Tiger Woods” reproduction case) for the proposition that the transformative use should be in the context of the entire work, not just Woods’ image, which was quite realistic.
Football game, Judge Ambro, considered the videogame gives the user significant control and power to “direct the play” by creating rosters, even with fictitious players.\(^{139}\) He therefore concluded that the majority misapplied the test by failing to consider the expressive content of the game as a whole. EA made a motion for an en banc hearing in front of the entire court, but it was denied.\(^{140}\) However, two judges dissented, one of whom was Judge Ambro.

B. Keller/NCAA

**Keller v. Electronic Arts, since renamed *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*,**\(^{141}\) the second of the cases, involve similar facts and resulted in a short, district court decision that echoes many of the conclusions found by the Third Circuit majority in *Hart*. Keller and a number of other former NCAA student-athletes\(^{142}\) brought an action against Electronic Arts, the NCAA and the Collegiate Licensing Company, claiming right of publicity, among other grounds, the allegedly improper use of athlete images in college football and basketball games.\(^{143}\) After discussing the right of publicity laws in Indiana\(^{144}\) (where the NCAA is headquartered) and California (EA’s residence),\(^{145}\) the court addressed EA’s motion to dismiss.

\(^{139}\) *Id.* The court noted: “*NCAA Football* involves myriad original graphics, videos, sound effects, and game scenarios. These artistic aspects permit a user to direct the play of a college football team whose players may be based on a current roster, a past roster, or an entirely imaginary roster comprised of made-up players. Users are not reenacting real games, but rather are directing the avatars in invented games and seasons. Further, the ‘Campus Legend’ and ‘Dynasty Mode’ features permit users to control virtual players and teams for multiple seasons, creating the means by which they can generate their own narratives. Such modes of interactive play are, I submit, imaginative transformations of the games played by real players.”

\(^{140}\) See [too recent – need to get citation]


\(^{142}\) There were nine named plaintiffs, all former NCAA football or basketball players: Keller, Edward O’Bannon, Jr. (UCLA), Byron Bishop (University of North Carolina), Michael Anderson (University of Memphis), Danny Wimprine (University of Memphis), Ishmael Thrower (Arizona State University), Craig Newsome (Arizona State University), Damien Rhodes (Syracuse University), and Samuel Jacobson (University of Minnesota). See footnote 2.

\(^{143}\) Specifically, seven causes of action were brought: (1) violation of Indiana right of publicity, against EA; (2) violation of California statutory right of publicity, against EA; (3) violation of California common law right of publicity, against EA; (4) civil conspiracy, against EA, NCAA and CLC; (5) violation of California Business & Professions Code § 17200 et. seq., against EA; (6) breach of contract, against NCAA; and (7) unjust enrichment, against EA and CLC. Only the right of publicity claims concerns us.

\(^{144}\) See IND. CODE ANN. § 32-36-1-7 (West 2009), which states, in part, “A person may not use an aspect of a personality's right of publicity for a commercial purpose during the personality's lifetime or for one hundred (100) years after the date of the personality's death without having obtained previous written consent from a person . . .”

\(^{145}\) See CAL. CIV. CODE § 3344(a) (West 2009), which states: “Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.”
The court denied the motion, concluding, after citing Winter, Comedy III and Kirby v. Sega of America, that the transformative test applies and that the depiction s of the players were not expressive enough to protect the apparent misappropriation of their images. In essence, it rejected First Amendment immunity. EA also sought dismissal under California’s “anti-SLAPP” statute. The court denied the motion, concluding that a case was made under the transformative test. Since that ruling, the case was subsequently consolidated with a number of other claims, as part of the general antitrust claims and appealed to the Ninth Circuit.

The Ninth Circuit issued a similar 2-1 ruling as did the Third Circuit in Hart. Affirming the lower court’s conclusion precluding a First Amendment defense, the majority, in an opinion penned by Judge Bybee, writing for the majority concluded that the images did not contain “significant transformative elements” to warranty a constitutional defense as a matter of law under the state’s Anti-SLAPP statute. Looking at past “transformative” cases, the majority applied past cases from the California courts and from the Circuit applying the standard.

In its analysis of how “realistic” or “literal” the uses were, the court analogized this case with No Doubt v. Activision Publishing, which also involved an avatar situation involving plaintiff rock band which were as “realistically portrayed” as Keller was in the EA’s NCAA football game. The majority added that the “context” of the activities in both No Doubt and Keller are also “similarly realistic—real venues in Band Hero and realistic depictions of actual football stadiums in NCAA Football.” The court therefore distinguished Keller/NCAA and No Doubt from the other “California” cases, which involved “fanciful, creative character(s).” It so concluded

---

146 See Keller, supra at 5.
147 Id. at 20. The anti-SLAPP statute, as found in the California Code of Civil Procedure, states that if a cause of action arises from the defendant's conduct “in furtherance of the person's right of petition or free speech under the United States or California Constitution in connection with a public issue[, it] shall be subject to a special motion to strike, unless” the plaintiff demonstrates a probability that he or she will prevail on the cause of action. Id. See also, Timothy J. Bucher, Game On: Sports-Related Games and the Contentious Interplay Between the Right of Publicity and the First Amendment, 14 Tex. Rev. Ent. & Sports L. 1. The court rejected this argument, concluding that EA was not able to show that Keller would not likely prevail on his claim based on the pleadings submitted. Id. at 22.
149 Id.
150 The cited cases were Comedy III, Winters, Kirby v. Sega of America, 50 Cal. Rptr. 3d 607, 609–10 (Ct. App. 2006), No Doubt v. Activision Publishing, Inc., 122 Cal. Rptr. 3d 397, 400 (Ct. App. 2011), and Hilton v. Hallmark Cards, 599 F.3d 894 (9th Cir. 2009).
151 122 Cal. Rptr 3d 397, 400.
153 Id.
154 Id. at 6. The court stated: “Though No Doubt certainly mentioned the immutability of the avatars, we do not read the California Court of Appeal’s decision as turning on the inability of users to alter the avatars. The key contrast with Winter and Kirby was that in those games the public figures were transformed into “fanciful, creative characters” or “portrayed as . . . entirely new character[s].” No Doubt, 122 Cal. Rptr. 3d at 410. On this front, our
Despite that the fact that in No Doubt the avatars could not be altered, while in Keller/NCAA, they could. The court also ignored the fact that EA’s game had many participants and many avenues of alteration, which was not the case in No Doubt.

Not surprisingly, the majority approvingly cited Hart to justify its conclusion that the identity of the player (Keller) was not sufficiently transformed to grant EA constitutional protection, pointing out that the Hart court’s view that “the ability to modify the avatar counts for little where the appeal of the game lies in users’ ability to play as, or alongside[,] their preferred players or team.”

It took a swipe at Judge Ambro’s dissenting opinion in Hart, arguing that it failed to consider the effect of the No Doubt because it was not decided by California’s highest court, but rather by an appellate level court. The majority noted that even though that was the case, it felt that No Doubt was “persuasive” authority and does not conflict with the standard set in Comedy III. But there is a certain judicial gamesmanship here. Hart involves New Jersey law, not California’s (which has both statutory and common law bases for the right of publicity) while New Jersey is a strict common law state, relying on determinations based on law created by the judiciary in that state. There certainly is no obligation for any judge of that court to cite a California intermediate appellate court to justify its position. And to give some credence to the dissenting judge in Hart, there are legitimate differences between this case and Hart with No Doubt, this majority could and should have distinguished it, rather than rely on it.

The court rejected EA’s claim that the Rogers test should be applied. Outlining the criticisms of the test stated earlier in this article, it noted that it is an inapplicable extension of a trademark law standard to right of publicity cases. It noted that the Rogers test was designed to protect consumers from the risk of confusion, while the right of publicity “does not implicate the potential for consumer confusion.” It followed that only the Restatement and one Federal circuit fully extended this standard to right of publicity cases, while others rejected that approach. Ironically, on the very same day as Keller/NCAA was decided, this same court case is clearly aligned with No Doubt, not with Winter and Kirby. We believe No Doubt offers a persuasive precedent that cannot be materially distinguished from Keller’s case."

---

155 See Hart, 717 F.3d 141 (3rd Cir. 2013).
157 Id. at 8, citing Cairns v. Franklin Mint Co., 292 F.3d1139, 1149 (9th Cir. 2002) and Hart, 717 F.3d at 158 (“[T]he right of publicity does not implicate the potential for consumer confusion . . . .”).
158 Id. at 10. See Parks v. LaFace Records, 329 F.3d 437, 461 (6th Cir. 2003) (Sixth Circuit indicated that the Rogers test was appropriate for right-of-publicity claims, noting that the Restatement (Third) of Unfair Competition had endorsed use of the test in that context.). The Tenth Circuit in Cardtoons, L.C. v. Major League Baseball Players Association, 95 F.3d 959 (10th Cir. 1996), and the Eighth Circuit in C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media, L.P., 505 F.3d 818 (8th Cir. 2007), rejected the Rogers test in favor of a flexible case-by-case approach that takes into account the celebrity’s interest in retaining his or her publicity and the public’s interest in free expression.
applied the Rogers test in a lawsuit by a former NFL player against EA and concluded that the athlete’s claim of consumer confusion was subordinate to the First Amendment right of expression.\(^{159}\)

In dissent, Judge Thomas also applied the transformative test, but concluded that EA’s game was sufficiently transformative to warrant First Amendment protection. In certain respects, Judge Thomas’s dissent displays similarities to Judge Ambro’s dissent in Hart because they both were trying to make the correct call under the rubric of a flawed standard.

Judge Thomas examined the standard in Comedy III, in a more “holistic” sense than a literal one to avoid “misapplication” of the test.\(^{160}\) In so doing, he took EA’s product, “as a whole” rather than as the use or alteration of one player’s image. Calling the EA game a “creation of historic fiction” and notes that the image is part of a scenario of audition, engaging in game competition, and alteration of the appearance and quality of players.\(^{161}\) Judge Thomas looked at the work “considered as a whole, is primarily one of EA’s own expression” and the game is not a conventional portrait of a celebrity, but a work consisting of many creative and transformative elements.”\(^{162}\) He added that the celebrity element of Keller and the other plaintiffs was relatively

\(^{159}\) See Brown v. Electronic Arts, No. 09–5667 (9th Cir., July 31, 2013). In Brown, the former NFL Hall of Fame player Jim Brown sued, claiming violation of § 43(a) of the Lanham Act. Concluding that the EA game ‘Madden Football’ was an expressive work, the court applied the Rogers test, concluding that the “[a]s expressive works, the Madden NFL video games are entitled to the same First Amendment protection as great literature, plays, or books. Brown's Lanham Act claim is thus subject to the Rogers test, and we agree with the district court that Brown has failed to allege sufficient facts to make out a plausible claim that survives that test. Brown's likeness is artistically relevant to the games and there are no alleged facts to support the claim that EA explicitly misled consumers as to Brown's involvement with the games. The Rogers test tells us that, in this case, the public interest in free expression outweighs the public interest in avoiding consumer confusion. Id. at 3.

\(^{160}\) In re NCAA, 2013 WL 3928293 at 13 (C.A.9) (July 31, 2013). As the dissent stated: “Indeed, the focus of Comedy III is a more holistic examination of whether the transformative and creative elements of a particular work predominate over commercially based literal or imitative depictions. The distinction is critical, because excessive deconstruction of Comedy III can lead to misapplication of the test.”

\(^{161}\) Id. at 14. “The gamers can also change their abilities, appearances, and physical characteristics at will. Keller’s impressive physical likeness can be morphed by the gamer into an overweight and slow virtual athlete, with anemic passing ability. And the gamer can create new virtual players out of whole cloth. Players can change teams. The gamer could pit Sam Keller against himself, or a stronger or weaker version of himself, on a different team. Or the gamer could play the game endlessly without ever encountering Keller’s avatar. In the simulated games, the gamer controls not only the conduct of the game, but the weather, crowd noise, mascots, and other environmental factors.”

\(^{162}\) Id. The dissent applied Keller/NCAA to Winter, noting that the EA game is similar to that in Winter, 69 P.3d 473, 476 (Cal. 2003), where the two fabled guitarists Johnny and Edgar Winter were easily identifiable, but depicted as chimeras. It distinguished the EA game from No Doubt v. Activision Publishing, Inc., 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011), as the images in that case would not be transformed “in any way” and the bandmembers posed for motion-capture photography to allow reproduction of their likenesses, id. at 402, and the video game did not “permit players to alter the No Doubt avatars in any respect” Id. at 410. Unlike the avatars in No Doubt, the virtual players in NCAA Football are completely mutable and changeable at the whim of the gamer.
minimal, and to exaggerate their importance and focus on their images, is a “potentially dangerous and out-of-context interpretation of the transformative use test.”

III. Toward a Uniform and Constitutional Standard

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

On the surface, similarities between aspects of trademark law and right of publicity seem evident. Both deal with the use of a name for certain commercial purposes – or at least as a vehicle to brand someone as a vehicle to sell products. However, the similarities end because of definition and application. While this confluence is criticized earlier in the article when discussing the *Rogers* test, a broader critique is warranted. The mention of this right under the *Restatement of Unfair Competition* might suggest more than a passing connection with the Lanham Act, but the framers of the provisions in question took pains to note the differences and to construe the right in a limited manner. Comment c of § 46 of the Restatement makes it clear that “[t]he rationales underlying recognition of a right of publicity are generally less compelling than those that justify rights in trademarks or trade secrets” and notes that those engaged in entertainment and sports repeat other substantial awards (which I take to be meaning significant compensation) and their publicity rights “may only have marginal significance.”

Also significant is the Restatement’s view that publicity is “fundamentally constrained by the public and constitutional interest in freedom of expression,” although it creates an exception when the use of the person’s name or likeness “is used solely to attract attention to a work that is not related to the identified person.”

Copyright poses a different issues because the commercial aspect is not as central. A copyright involves a “work” in a fixed tangible medium, which grants the owners a monopoly to use or not

---

163 *Id.* at 17.
164 See Part II, *supra*.
165 See *ETW v. Jireh*, 332 F. 3d at 931.
166 See *Restatement (Third) of Unfair Competition*, § 46, cmt. c. That section also notes “In other cases the commercial value acquired by a person’s identity is largely fortuitous or otherwise unrelated to any investment made by the individual, thus diminishing the weight of the property and unjust enrichment rationales for protection. In addition, the public interest in avoiding false suggestions of endorsement or sponsorship can be pursued through the cause of action for deceptive marketing. Thus, courts may be properly reluctant to adopt a broad construction of the publicity right. For more discussion, see *ETW v. Jireh*, at 930.
167 See *Restatement (Third) of Unfair Competition*, § 47 cmt. c, as noted in notes 33 and 48.
168 *Id.*
to use.\textsuperscript{169} The relatively few cases pitting copyright rights against the First Amendment have given the property right a more solid level of protection than found in other kinds of speech cases. A case in point is \textit{Harper & Row v. Nation Enterprises},\textsuperscript{170} where the Supreme Court concluded that unauthorized use of a few hundred words from a upcoming book of 200,000 words was not constitutionally protected and thereby a violation of the book publisher’s copyright. The fact that the subject was “newsworthy” did not provide a defense.\textsuperscript{171} This is not dissimilar to the approach the court took in \textit{Zacchini}, even though \textit{Zacchini} was not a copyright case.

The major defense against a copyright infringement is fair use, a longstanding concept found in the Copyright Act.\textsuperscript{172} It permits some limited use of a copyrighted work without permission, but despite a four-part definition, courts have shown great difficulty in coming up with a consistent standard. In fact, one court called fair use “obscure” while another called it “the most troublesome in the whole law of copyright.”\textsuperscript{173} Nevertheless, fair use remains at least conceptually, a bulwark defense to this day.\textsuperscript{174}

Yet, compared with other intellectual property areas, copyright fair use is a model of unified clarity compared to the approaches utilized in trademark infringement and unfair competition actions.”\textsuperscript{175} This may be in part because the “fair use” exception in trademark is not statutory, so the courts lack the definitional foundation (albeit less than ideal) as found in copyright. An example of a trademark right upheld over free speech considerations involved the use of the five-ringed Olympic trademark, a design given specific protection under provisions of the Ted Stevens Amateur Sports Act.\textsuperscript{176} The Supreme Court upheld such protection in a challenge to the use of the term “Gay Olympic Games” by an organization with no connection to the U.S.

\begin{flushright}
\textsuperscript{170} 471 U.S. 539 (1985).
\textsuperscript{171} Id. at 557.
\textsuperscript{172} 17 U.S.C. § 107.
\textsuperscript{174} See Eldred v. Ashcroft, 537 US 186 (2003) (court rejected constitutional challenge to the Copyright Extension Act, noting that First Amendment considerations were duly protected due to fair use and other exceptions). See also \textit{Harper}, 471 U.S. at 589, 603 (The court opined that judges must resist the urge to reject a fair use defense based on traditional notions of labor. The court went on to note, “[b]oth the purpose of the use and the nature of the copyrighted work strongly favor the fair use defense here.”).
\textsuperscript{175} See Lee 23 LOY. L.A. ENT. L. REV. at 482.
\end{flushright}
Olympic Committee. The group advertised the event by utilizing and distributing printed materials using the term. In concluding that there were other ways to publicize a sports event, without using the trademarked term “Olympic”, the court concluded that free speech limitations were “incidental” and subservient to the property interests involved.177

Significantly, the court in San Francisco Arts & Athletics embraced a balancing standard – one that, surprisingly, has not seen much traction from subsequent courts on the trademark or the right of publicity side. Essentially an intermediate scrutiny test found in non-content regulations, the court stated “The appropriate inquiry is thus whether the incidental restrictions on First Amendment freedoms are greater than necessary to further a substantial governmental interest . . .”.178 Subsequent cases followed either the more standard “likelihood of confusion” standard179 or requiring a showing of “malice” like that found in defamation cases.180

While I find the very last option a viable aspect of a new standard for the right of publicity, the lack of consistency and the lack of statutory guidance (in copyright, even though under the Fair Use standards) and especially in trademark mitigate against applying these rules to right of publicity. In other words, the right of publicity standards are varied enough, so what good is it to take confusing standards from other areas of law?

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

Unlike the sole foray into right of publicity in the Zacchini case, the Supreme Court has addressed the scope and protection of commercial speech often in the last three and a half decades181 and has created a jurisprudence that concludes that it is more subject to governmental

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

The most frequently utilized definition is “speech that does not more than propose a commercial transaction,” which is similar to the Restatement’s requirement of “commercial purpose” for the right of publicity. Although issues occur regarding speech that has both commercial and non-commercial elements, such cases have been relatively rare, and it is safe to say that most commercial speech cases are devoted to commercial advertising.

---


182 See, e.g. Central Hudson Gas, 447 U.S. 557 (1980), which created a four-part test that approximates an intermediate scrutiny standard.


184 This definition was first utilized in Pittsburgh Press Co. v. Pittsburgh Commission on Human Relations, 413 U.S. 376 (1973).

185 See Restatement (Third) of Unfair Competition, § 46.

186 See Nike, Inc. v. Kasky, 27 Cal. 4th 949, 45 P. 3d 243 (2002), cert. granted, 537 U.S. 1099 (2003), cert. dismissed, 539 U.S. 654 (2003). The case involved paid advertising by the company to refute claims against the firm about its alleged use of child labor, poor working conditions and wages and safety concerns in its Asian factories. These allegations received considerable press coverage and resulting negative publicity for the company in the 1990s. Kasky instituted a private right of action under California’s Unfair Competition and false advertising laws. In a sharply divided 4-3 vote, the California Supreme Court considered the speech sufficiently commercial as to apply the statutes and remanded the case back for consideration. In doing so, the majority, noting the discomfort over the standard definition of commercial, constructed a new definition which requires: (1) the speaker to be engaged in commerce; (2) the intended audience is likely to be actual or potential buyers or customers of the speakers’ goods or services or persons acting for actual or potential buyers or customers; and (3) the facts represented are of a commercial nature. Kasky v. Nike, 27 Cal. 4th 963, 45 P.3d 248. If the test (called the “limited-purpose test”) was met, then the Unfair Competition and false advertising law would apply. The court found on the side of greater First Amendment protection. In doing so, they applied strict scrutiny. The U.S. Supreme Court at first granted certiorari, even heard oral arguments, but then then decided that it improvidently granted based on several procedural issues, including the fact that the California judgment was not “final.” Ultimately, the parties settled the case. The California’s court’s proposed standard has not generated much judicial traction since.
Like its counterpart defamation, commercial speech’s constitutionalization is of fairly recent vintage. Beforehand, courts easily justified the regulation of advertising based on health and safety pursuant to state police powers. It received its entry into the First Amendment club in 1976, and since 1980, it is subject to a categorical test to balance the expressive interests of the commercial speaker and the governmental interest to regulate such speech. Unlike right of publicity cases, the test to determine the constitutionality of government restriction on such speech has been settled law, although it has been criticized as too protective or not protective enough by some scholars and judges. The standard has variously been called an intermediate

187 See, e.g., Valentine v. Chrestensen, 316 U.S. 52 (1942) (upheld a city ordinance that barred distribution of commercial handbills). Valentine represented the culmination of three prior decades of jurisprudence treating restrictions on such speech as a justifiable health and safety regulation. During that time, courts dismissed challenges to various commercial speech regulations, including (a) laws limiting all billboard advertising. See e.g. See Thomas Cusack Co. v. City of Chicago, 242 U.S. 526 (1917), (the court held that the ordinance requiring consent by residents to permit billboard advertising in residential areas was within the scope of the power conferred on the city by the legislature). See also, St. Louis Poster Advertising Co. v. St Louis, 249 U.S. 269 (1919), (involving a challenge by plaintiff billboard company to a city ordinance that restricted the height and size of billboards on 14th Amendment liberty grounds, where the court upheld the city’s power to issue such in the interest of the safety, morality, health, and decency of the community.); (b) restrictions on vehicular advertising. See, e.g., Fifth Ave. Coach Co. v. New York, 221 U.S. 467 (1911) (the court rejected a constitutional challenge, and concluded that the ordinance was not an arbitrary exercise of the city’s police power to regulate the business conducted in its streets); (c) prohibitions of tobacco advertising. See Packer Corporation v. Utah, 285 U.S. 105 (1932) (court upheld a Utah statute prohibiting tobacco advertising on billboards, street car signs, and placards, rejecting an argument that the law was discriminatory because it exempted ads in newspapers and other periodicals. The court, however justified the difference, because unlike advertisements in newspapers and magazines, billboard advertisements were “constantly before the eyes of observers on the streets and “thrust upon” the public, while ads in newspapers, magazines and radio must be “sought” and “read.”); (d) restrictions on advertisements using the U.S. flag. See Halter v. Nebraska, 205 U.S. 34 (1907). The court upheld such a ban as preventing “indignation” or “offense” from those who revere the flag. Id. at 45. For an excellent discussion of early commercial speech cases, see Alex Kozinski & Stuart Banner, The Anti-History and Pre-History of Commercial Speech , 71 TEXAS L. REV. 747 (1993).

188 See Virginia Pharmacy, 425 U.S. 748 (1976). In that case, the court struck down advertising ban by pharmacies, concluding “[S]ociety . . . may have a strong interest in the free flow of commercial information. Even an individual advertisement, though entirely “commercial,” may be of general public interest . . . So long as we preserve a predominantly free enterprise economy, the allocation of our resources in large measure will be made through numerous private economic decisions. It is a matter of public interest that those decisions, in the aggregate, be intelligent and well informed. To this end, the free flow of commercial information is indispensable [internal citations omitted]. . . Therefore, even if the First Amendment were thought to be primarily an instrument to enlighten public decision making in a democracy, we could not say that the free flow of information does not serve that goal.” 425 US at 765.

189 See C. Edwin Baker, The First Amendment and Commercial Speech, 84 IND. L. REV. 981, 998 (that the libertarian tradition makes a fundamental mistake when it tries to connect its emphasis on autonomy and liberty to claims about market freedom.”). See also, Eugene Volokh, Freedom of Speech and the Right of Publicity, 40 HOUSTON L. REV. 905, 930 (author concludes that if right of publicity should exist, it should have a commercial speech basis).

However, others have criticized the standard has difficult to define and not protective enough. See, e.g., Laurence H. Tribe, American Constitutional Law, section 12-15, at 896 (2d ed. 1988) (stating that the distinction between
scrutiny or, but with a decided tilt toward more First Amendment protection in recent years\(^{190}\) and is based on an intricate, policy-driven four-part standard, known as the *Central Hudson* test.\(^{191}\) Taking a cue from the court in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council*, the case that formally constitutionalized commercial speech, but also noted that commercial speech may not be as protected as non-commercial speech,\(^{192}\) The *Central Hudson* test differs from the standard imposed for content-related political speech, known as “strict scrutiny,” which grants a higher level of First Amendment protection,\(^{193}\) except in certain areas of speech such as defamation\(^{194}\) and broadcasting.\(^{195}\)

Traditional intermediate scrutiny requires that the restriction is justified if the government can show that there is a substantial governmental interest and that the restriction is “not more

commercial speech and noncommercial speech “has not provided reliable guidance for resolution of individual cases”); Alex Kozinski & Stuart Banner, *Who's Afraid of Commercial Speech?*, 76 VA. L. REV. 627, 649 (1990) (stating that “we have a distinction then, with no basis in the Constitution, with no justification in the real world, and that must often be arbitrarily applied in any but the easiest cases”); Steven Shiffrin, *The First Amendment and Economic Regulation: Away from a General Theory of the First Amendment*, 78 NW U. L. REV. 1212, 1216 (1983) (stating that the Court’s “doctrinal treatment of commercial speech has been inadequate”).

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

\(^{190}\) See, e.g. Mitchell N. Berman, “Commercial Speech and the Unconstitutional Conditions Doctrine: A Second Look at “The Greater Includes the Lesser,” ” 58 VAND. L. REV. 693, 777 (“Justice Thomas argued that the advertising restrictions should be subject to strict scrutiny, not to the intermediate review of *Central Hudson*”). See also, 44 Liquormart, 517 U.S. 484 (1996).

\(^{191}\) The test is named after *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557 (1980).

\(^{192}\) 425 U.S. 748, 771-73 (1976). Specifically, the court noted that some commercial speech may not receive or may receive less constitutional protection than other speech: false or misleading commercial speech; Commercial speech about illegal transactions receives no protection; Advertising through radio and television may receive lower protection; Disclosure and warning requirements, as well as regulation of the form of advertising, may be more permissible in the commercial speech arena than elsewhere; and, the prior restraint doctrine may not apply to commercial speech regulations. See also, Ashutosh Bhaghwat: *A Brief History of the Commercial Speech Doctrine (With Some Implications for Tobacco Regulation)*, 2 HASTINGS SCI. & TECH. L.J. 103, 106 (2010).

\(^{193}\) Strict scrutiny requires that, in order for the state to limit content-related speech it must show that there is a compelling governmental interest for the restriction and that the restrictions was a narrowly-tailored as possible to accomplish this result. See Simon & Schuster v. New York State Crime Victims Board, 502 U.S. 104 (1991).


\(^{195}\) See NBC v. United States, 319 U.S. 190 (1943). (Justifying the scarcity of the broadcast spectrum as a basis for treating regulating broadcasters more heavily the print media); see also, Red Lion Broadcasting v. FCC, 305 U.S. 167 (1969) (upholding the right to reply requirements under the Fairness Doctrine, where a radio station was required to furnish reply time to an individual after a personal attack).
restrictive than necessary” to accomplish this result. Central Hudson calibrates the test to cater to commercial speech by creating a multi-part requirement: assuming that the speech is not false or deceptive (if it is then there is no protection), then the government must demonstrate that there was a substantial governmental interest, the restriction “directly advances” that interest and that the restriction is not “more restrictive than necessary” to accomplish the result. It is less onerous than the more difficult, almost Sisyphean strict scrutiny test.

More complex than the traditional two-part intermediate scrutiny standard used in non-content-based speech regulations, Central Hudson, requires that, assuming the speech is not false or deceptive: (a) the government must possess a “substantial” interest to regulate the speech, (b) which ‘directly relates’ to the governmental objective, and (c) is not ‘broader than necessary’ to accomplish that result.” If the speech is untrue, then it has no protection.

Commercial speech cases have involved varying regulations affecting a myriad of products and services. In the post-Virginia Pharmacy/Central Hudson era, the only kind of commercial speech with no protection are those advertisements deemed “false and deceptive” often under the purview of the Federal Trade Act and regulations of the Federal Trade Commission (“FTC”) or similar state laws. While the state interest of punishing purveyors of political or artistic speech for being “false or deceptive ” (excluding private rights of action defamatory speech), there is a legitimate state interest to prevent consumers from purchasing goods based on those claims. Despite its importance, this issue is not central to our inquiry.

Right of publicity cases (at least traditionally) dovetailed this kind of speech as they involved uses of one’s name, likeness or other indicia of identity in a commercial setting resulting in direct commercial exploitation. And attempts to expand this were generally rebuffed. The
Restatement demonstrates the strong connection by its very definition of commercial speech; between commercial speech and right of privacy. True, these cases appeared in traditional advertising vehicles, but there is something consistent in this kind of bedrock standard. A few courts have addressed the issue of whether the speech has intertwined “commercial” and “non-commercial” elements and have concluded that a strong presumption of non-commercial status exists in such situations. A recent opinion demonstrates that, at least to one California appellate court, a special paid advertising section of a magazine with both editorial and advertisements could not be considered “commercial” for First Amendment purposes. However this notion has not been a prevalent aspect of the jurisprudence.

In the realm of newer media that may have commercial and expressive elements, the problem of whether speech is commercial or not may be more acute. For example, what standard applies to a comic book, given away free as a promotion with a parody image that looks nothing like the hockey player who sued and who received a substantial settlement? Or, whether a the “transformative” aspect of the work makes it inherently non-commercial? Or determining constituted a cause of action for misappropriation and infringement of trade name); Abdul-Jabbar v. General Motors Corp., 85 F. 3d 407 (9th Cir. 1996) (use of star basketball player’s former name as “most valuable player” in past NCAA men’s basketball tournaments constituted a cause of action under both statutory and common law right of publicity under California law).


See Hoffman v. Capital Cities, 255 F.3d 1180; 2001 (9th Cir. 2001) discussed infra (altered image of actor with identified designer wear not deemed commercial); see also, Gaudiya Vaishnava Soc'y v. City & County of San Francisco, 952 F.2d 1059, 1064 (9th Cir. 1991) (as amended) (selling merchandise in connection with a charitable purpose is fully protected speech); Riley v. National Federation of the Blind, 487 U.S. 781 1988 (“we do not believe that the speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech”); Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc., 425 U.S. 748, 771 n.24, 48 L. Ed. 2d 346, 96 S. Ct. 1817 (1976) (“There are commonsense differences between speech that does no more than propose a commercial transaction and other varieties.”), all cited in Hoffman, at 1185-86).

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

See Doe v. TCI Cablevision, 110 S.W. 3d 363 (2003). Twist was originally awarded $24.5 million. That award was overturned by the court and after a second trial, he was awarded $15 million. However, Twist has settled for $5 million. The settlement between Twist and insurance companies for Todd McFarlane Productions Inc. was approved in bankruptcy court in Arizona in 2007. See “Twist Case Settled,” http://www.icv2.com/articles/news/10104.html (retrieved July 10, 2013)

whether a depiction of an athlete in a video game with different applications and imaginative elements can render its creators subject to a commercial speech standard because the game is being sold to the public.

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

This is a key point that many of the more recent decisions have shied away from and the weakness of the transformative test. While the majority in Hart concluded that it was not sufficiently transformative, that misses the point. The depictions are not commercial in nature they do not propose a commercial transactions and full First Amendment rights should apply. And full First Amendment rights means a form of strict scrutiny test. To consider such uses “commercial” would mean that every product sold to the public with a person’s name or image would be subject to a commercial speech designation.

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

Despite the gradually expansive protection of non-commercial speech through the 20th century, until 1964, libelous and slanderous communications were also not part of the First

---


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

Id. at 970.

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

See Cardtoons, 95 F. 3d at 970.

Amendment lexicon. However, *New York Times v. Sullivan*,\(^{212}\) swept away hundreds of years of common law defamation and concluded that communications (that would traditionally be libelous or slanderous) would have a degree of First Amendment protection – a qualified immunity if the defendant was a “public official,”\(^{213}\) later expanded to “public figures.”\(^{214}\) However, before addressing the central issue, the court determined that the material in question was not “commercial speech” but rather political speech that was protected under the First Amendment.\(^{215}\) For those in the public eye, the court ended strict liability in tort for defamation, requiring instead that not only does the communication have to be false and harmful to reputation, but it also must be shown to have been made with “malice or reckless disregard for its truth.”\(^{216}\) The standard was later refined to include standards for non-public figures.\(^{217}\)

The *New York Times* standard was applied to a privacy cause of action known as “false light” – a type of hybrid that is close, but not quite false, but does create an inaccurate portrayal.\(^{218}\)

---

\(^{212}\) 376 U.S. 254 (1964).

\(^{213}\) *Id.* The facts in *New York Times* are well-known. Sullivan claimed had been libeled by statements in a full-page advertisement signed by 64 individuals from public affairs, religion, trade unions, and the performing arts that was carried in the *New York Times* on March 29, 1960. It sought to raise funds to support “the struggle for the right-to-vote,” and the legal defense of Dr. Martin Luther King, Jr. against a perjury indictment then pending in Montgomery, Alabama. Entitled “Heed Their Rising Voices,” the advertisement charged that “in their efforts to uphold these guarantees, civil rights protesters were being met by an unprecedented wave of terror by those who would deny and negate that document which the whole world looks upon as setting the pattern for modern freedom . . .” Succeeding paragraphs purported to illustrate the “wave of terror” by describing certain alleged events. Some of the statements were inaccurate and respondent alleged that some or all of the statements as referring to him in his capacity as Commissioner.  


\(^{215}\) This was particularly significant because at the time of the case, commercial speech had no First Amendment protection. One of respondent’s arguments was that the First Amendment freedoms did not apply in this case precisely because the material constituted commercial speech. 376 U.S. at 266. However, the court concluded that despite the fee paid for the space and the appeal for contributions, the speech was political. The majority stated: “The publication here was not “commercial. . . . [I]t communicated information, expressed opinion, recited grievances, protested claimed abuses, and sought financial support on behalf of a movement whose existence and objectives are matters of the highest public interest and concern. [internal citations omitted] That the Times was paid for publishing the advertisement is as immaterial in this connection as is the fact that newspapers and books are sold.” *Id.*

\(^{216}\) *New York Times*, at 279. The court concluded: “The constitutional guarantees require, we think, a federal rule that prohibits a public official from recovering damages for a defamatory falsehood relating to his official conduct unless he proves that the statement was made with “actual malice” – that is, with knowledge that it was false or with reckless disregard of whether it was false or not.” *Id.*

\(^{217}\) *Gertz v. Robert Welch*, 418 U.S. 323 (1974) (the court refined the definition of a public figure to include on those who voluntarily thrust themselves into the public domain. It also ended the common law strict liability standard for defamation and directed the states to impose, at a minimum, a requirement of negligence as part of a cause of action. *Id.* at 347.

D. The Cases to Watch

While the expansion of right of publicity has been chronicled by showing many of the cases cited in the article, there may be the inkling on the part of a number of courts that this property right has run amok. Certain recent decisions – possibly too little too late – have put a break on its expansion and have left tantalizing morsels that may result in a new standard.

1. Fantasy Sports – The MLBAM case

We may have come to the last frontier of right of publicity cases when courts began to consider whether the use of an athlete’s name and statistical information as part of a fantasy sports game. *C.B.C. Distribution v. MLBAM*, 605 F.3d 818 (8th Cir. 2007) is not the first case to decide this question, but probably is the most important. Using publicly available information, a firm marketed a baseball fantasy sports game. There were no team designs, logos or reproductions of a likeness or avatar of the player. It was, to put it in the parlance of a famous cop television show of a bygone era, “just the facts.” C.B.C. Distributing, the firm that created and disseminated the particular fantasy game, sought a declaratory judgment from the district court that the game did not violate any publicity rights of MLBAM and no license was needed to utilize the names and statistical information. MLBAM and the Major League Baseball Players’ Association counterclaimed, arguing C.B.C. violated the players’ right of publicity based on C.B.C.’s exploiting the rights of players “including their names, nicknames, likenesses, signatures, jersey numbers, pictures, playing records and biographical data” with respect to fantasy baseball games. There was also a breach

---

219 S05 F.3d 818 (8th Cir. 2007).
221 See Dragnet, when officer says to a potential witness, “Just the facts, ma’am.”
222 See C.B.C. Distribution and Marketing, Inc., v. Major League Baseball Advanced Media, 443. F. Supp. 2d 1077 (E.D. Mo. 2006). The federal magistrate noted that C.B.C. distributed and sold fantasy sports products, via telephone, mail, e-mail, and the Internet. At the time of the filing, it offered eleven fantasy baseball games, two mid-season fantasy baseball games, and one fantasy baseball playoff game. C.B.C. provided lists of Major League baseball players and their respective statistical information for selection by participants in its games. Game participants pay fees to C.B.C. to play its games and pay additional amounts to trade players. Prior to the start of the professional baseball season participants form their teams by “drafting” players from various Major League baseball teams. Participants or “owners” compete against other fantasy owners who have drafted their own teams. The success of one's fantasy team over the course of the baseball season is dependent on one's chosen players’ actual performances on their respective actual teams. *Id.* at 1080. The statistical information includes information, which according to the court, “is typically found in box scores in newspapers such as players' batting averages, at bats, hits, runs, doubles, triples, home runs, etc.” *Id.*
223 *Id.*

41
of contract claim alleged because at one time C.B.C. had a licensing agreement with MLBAM to produce a fantasy game.\textsuperscript{224}

The magistrate, pointing to Missouri’s Restatement-based right of publicity standard utilized in \textit{Doe v. TCI Cablevision},\textsuperscript{225} concluded that the First Amendment superseded any publicity claims, as the use was not “commercially-based” and in fact pre-empted the state law applying to this case.\textsuperscript{226} Noting that the use does not hurt baseball players from earning an income, the court failed to see any commercial application – a correct conclusion in my judgment. In granting the summary judgment motion in favor of C.B.C., the only thing missing from the opinion was a more precise balancing standard.

The Eighth Circuit, in a 2-1 vote,\textsuperscript{227} delivered an unusually short opinion that justifiably agreed with the conclusion of the lower court, but resulted in more ambiguity. While noting that Missouri has a strong commercial element in its standard for right of publicity,\textsuperscript{228} Relying on the Restatement standard, the majority admitted that this case of “does not fit neatly into the more traditional categories of commercial advantage,”\textsuperscript{229} but then drew upon an expanded view of that commercial element when it focused on C.B.C.’s “intent” to use the ballplayers’ identities for profit, and that was “sufficient to make out a prima facie case for a right of publicity claim.\textsuperscript{230}

The majority then balanced that claim with First Amendment consideration, in so doing, affirmed the lower court. Without discussing specific contours, the conclusion was that such information constituted protected speech and that there is a strong public interest in the dissemination of such statistical information for the millions of fans who follow Major League Baseball and its players.\textsuperscript{231} That point, coupled with the fact that baseball players do not have a strong economic interest in proceeds from the use of their names and statistics for fantasy games,

\textsuperscript{224} See 808 F.3d at 821. From 1995 through the end of 2004, C.B.C. licensed its use of the names of and information about major league players from the Players Association pursuant to license agreements that it entered into with the association in 1995 and 2002. In 2005, after the 2002 agreement expired, the Players Association licensed those rights to MLBAM “for exploitation via all interactive media.” After note being offered an extension, CBS decided to market its own game.

\textsuperscript{225} See \textit{Doe}, 110 S.W.3d at 369.


\textsuperscript{227} The dissenting opinion of Judge Colloton concurred in the majority’s conclusions about the right of publicity and First Amendment. He dissented on grounds involving the prior licensing agreement, which is not the subject of our discussion. See 808 F. 2d at 826 (Colloton, J., dissenting).

\textsuperscript{228} See \textit{Doe}, 110 S.W. 3d at 369.

\textsuperscript{229} See \textit{C.B.C.}, 505 F.3d at 822. Citing comment a of Restatement (Third) of Unfair Competition, § 47, the majority stated that there was doubt that the use of the baseball players’ names in the fantasy game is not a traditional use of the names for advertising and merchandising purposes in a way that states or intimates that the individuals are endorsing a product.

\textsuperscript{230} Id. at 822-23.

\textsuperscript{231} Id. at 824.
given that they are “rewarded, and handsomely, too, for their participation in games and can earn additional large sums from endorsements and sponsorship arrangements,” demonstrate that their property rights are subsumed by the First Amendment considerations.\(^\text{232}\)

This is not the first time a court has stressed the economic earning ability of professional athletes. The courts in ETW and other cases also discussed this point.\(^\text{233}\) Some scholars also noted that it should be a factor in determining a right of publicity. I think it should not be relevant (except for calculation of damages if indeed the right of violated), because it is constitutionally irrelevant. The \textit{Hart} and \textit{Keller} cases demonstrate the pitfalls of this because if this point would possibly favor Hart and Keller, since they never received compensation for their services while playing college sports (unless one considers the scholarship received as compensation) and contracted away their rights to obtain this kind of income. As noted earlier, sympathetic plaintiffs should not result in bad law.

Had the Third Circuit in \textit{Hart} adopted the lower court’s approach, essentially created a First Amendment immunity for right of publicity claims, it would have brought clarity – at least in that circuit. However, we leave this case looking to a solution to the problem – a categorical approach, which immunizes all claims that not directly commercially based -- a paradigm for a new standard.

\textbf{2. \textit{Brown v. Entertainment Merchants Association} – The Supreme Court Finds Strong First Amendment in Videogames}

Another “high-tech” case that buttresses the First Amendment rights of EA and other such manufacturers is the Supreme Court’s decision in \textit{Brown v. Entertainment Merchants Association},\(^\text{234}\) which addressed the state of California’s attempt to restrict access of certain violent videogames to minors and imposed civil penalties for violators.\(^\text{235}\) At first glance, this case does not seem to have any relation with the right of publicity of celebrities or athletes, but the court’s strong affirmation of First Amendment rights, does show a continued sympathy for

---

\(^{232}\) \textit{Id.}

\(^{233}\) \textit{See} ETW v. Woods, 332 F.3d 915, 935.


\(^{235}\) The provision, CAL. CIV. CODE §§1746 - 1746.5 (West 2006) (prohibited the sale or rental of “violent video games” to minors, and required their packaging to be labeled “18.” The Act covered games “in which the range of options available to a player includes killing, maiming, dismembering, or sexually assaulting an image of a human being, if those acts are depicted” in a manner that “[a] reasonable person, considering the game as a whole, would find appeals to a deviant or morbid interest of minors,” that is “patently offensive to prevailing standards in the community as to what is suitable for minors,” and that “causes the game, as a whole, to lack serious literary, artistic, political, or scientific value for minors.” §1746(d)(1)(A). Violation of the Act is punishable by a civil fine of up to $1,000. §1746.3. \textit{See Brown}, 556 U.S. at 950.
the expression rights of private enterprises.\(^{236}\) The court held first that video games remain on 
the same constitutional plateau as more traditional media, such as books, plays, and movies and 
therefore refused to presume that because it is a “new category” of speech, it would be 
unprotected based on its violent content that appeals to children. It therefore applied the strict 
scrutiny test, concluding that the regulation was constitutionally defective as both 
“underinclusive” and “overinclusive.”\(^{237}\)

The ruling in *Brown* presumes that new technologies are a part of the same First Amendment 
club as traditional ones and strengthens the view that content-based regulations, even though 
with the best of intentions, are subject to severe constitutional constraints. Coming at the time of 
the *Hart* and *Keller* cases, it creates a stronger basis that a test involving content-based speech, 
even for indirect commercial gain (sale of the games) is not subject to a lesser standard of 
review.\(^{238}\) It implies (along with the Restatement exception) that unless direct commercial speech 
can be determined, the speech is subject to the highest level of protection.

### 3. The “Malice” Cases

As will be discussed later, a standard of actual malice is one that has been included in a libel or 
slander or false light privacy cause of action involving plaintiffs who are “public figures.”\(^{239}\) A 
few appellate cases discussed the possibility of applying this standard to certain factual 
circumstances in right of publicity cases. Although the idea did not gain traction by other courts

\(^{236}\) As Justice Scalia, writing for the majority, stated: “Like the protected books, plays, and movies that preceded 
them, video games communicate ideas—and even social messages—through many familiar literary devices (such as 
characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player’s 
interaction with the virtual world). *Id.* at 2733. This case follows on recent decisions, such as U.S. v. Stevens, 559 
U.S. 460, 130 S.Ct. 1577 (2010) (Statute criminalizing commercial creation, sale, or possession of certain depictions 
of animal cruelty held unconstitutional); U.S. v. Playboy Entertainment Group, 529 U.S. 803 (2000) (court ruled 
unconstitutional as overbroad statute requiring cable television operators providing channels “primarily dedicated to 
sexually-oriented programming” either to “fully scramble or otherwise fully block” those channels or to limit their 
transmission to hours when children are unlikely to be viewing, set by administrative regulation as between 10 p.m. 
and 6 a.m.).

\(^{237}\) *Id.* at 2740 - 41. The Court concluded the regulation “underinclusive,” as it singles out video games 
for disparate treatment, noting that more traditional media also displayed violent content aimed at children (such as 
Saturday morning cartoons). It held it was “overinclusive,” as it forbids the purchasing of violent video games by 
the children of many parents who do not disapprove of them doing so.

\(^{238}\) Note that *Stevens*, 559 U.S. 460, involved a statute that banned selling materials “depicting” the killing of 
animals for commercial gain and yet, the court also applied a strict scrutiny test. As the court stated: “The First 
Amendment’s guarantee of free speech does not extend only to categories of speech that survive an ad hoc balancing 
of relative social costs and benefits. The First Amendment itself reflects a judgment by the American people that the 
benefits of its restrictions on the Government outweigh the costs. Our Constitution forecloses any attempt to revise 
that judgment simply on the basis that some speech is not worth it.” *See* 130 S. Ct. at 445.

\(^{239}\) *See* New York Times v. Sullivan, 376 U.S. 254, 279 (1964); *See also*, AP v. Walker, 389 U.S. 28 (1967); *and* 
and was since rejected by that very court, it is worth discussing, since it will be a major portion of the test advocated in this article.

The primary case that considered applying a malice test for a right of publicity claim were Eastwood v. Superior Court (also known as “Eastwood I”){240} In Eastwood I, the Enquirer published an article alleging that Eastwood was romantically involved with two female celebrities. The headline and a photograph of Eastwood were then used in television advertising as a way to entice the public to buy that issue of the magazine. {241} Despite the conclusion that the piece was not defamatory, the court did find that a right of publicity claim was made, since the Enquirer commercially exploited his name, photograph, and likeness under both the common law and statutory law. {242}

Furthermore, in making this conclusion, the court rejected the statutory “news and public affairs” defense found in California’s right of publicity law. {243} Although the use of a “newsworthy” photograph in an advertisement is similar to the Namath case, noted earlier, {244} the California court rejected the “news or public affairs” defense because the interview was a fabrication and while not defamatory in a literal sense, it was, in a sense, a fraud or a “subterfuge” to sell more newspapers.

4. Malice and Commercial Speech Doctrine

Since Eastwood, the Ninth Circuit has become a focal point for discussion as to the relationship of right of publicity, commercial speech and the applicability of malice as a counterweight to a First Amendment defense. This was first, and most famously, explored in Comedy III v. Saderup, {245} the Three Stooges t-shirt case. The court went one step further than the state court in

---


{241} Eastwood v. Superior Court, (“Eastwood I”), 198 Calif. Rptr. at 344-45. The story run by the Enquirer entitled “Clint Eastwood in Love Triangle With Tanya Tucker,” alleged that the actor was romantically involved with both Tonya Tucker and Sondra Locke. The story was accompanied by a photograph of Mr. Eastwood. The headline and the photograph were also used in television advertising for the tabloid. See 198 Calif. Rptr. at 352 (“Accordingly, we do not believe that the Legislature intended to provide an exemption from liability for a knowing or reckless falsehood under the canopy of ‘news.’ We therefore hold that Civil Code section 3344, subdivision (d), as it pertains to news, does not provide an exemption for a knowing or reckless falsehood”).

{242} Id. at 349.

{243} See CAL. CIVIL LAW, § 3344(d), which provides that “[f]or purposes of this section, a use of a name, photograph or likeness in connection with any news ... shall not constitute a use for purposes of advertising or solicitation.” Id. The defense is similar to that of the Restatement (Third) of Unfair Competition, § 47 (“use ‘for purposes of trade’ does not ordinarily include the use of a person’s identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.”)


{245} See supra, note 76.
Eastwood, when it noted that, despite finding a viable claim in the case, “[g]iving broad scope to the right of publicity has the potential of allowing a celebrity to accomplish through the vigorous exercise of that right the censorship of unflattering commentary that cannot be constitutionally accomplished through defamation actions.”246

The idea of an interplay between malice, the First Amendment and the right of publicity came, was reiterated in two other case of note, one being Hoffman v. Capital Cities/ABC247 and the other a more recent case, Stewart v. Rolling Stone.248 In Hoffman, a local magazine, published an issue which used computer technology to alter famous film portraits. Among others, was a still from a film where actor Hoffman portrayed a woman, but altered the clothing to show an outfit by to show a different outfit with the text “Dustin Hoffman isn't a drag in a butter-colored silk gown by Richard Tyler and Ralph Lauren heels.”249 Needless to say, the magazine did not ask Hoffman, nor from the copyright holder, Columbia Pictures, for permission to publish the altered photograph and Hoffman commenced the action, alleging violation of the right of publicity as well as Lanham Act violations.

The Ninth Circuit rejected Hoffman’s claim, concluding that since the speech in question was not commercial speech, even if had some commercial elements, and therefore, it was entitled to a high standard of First Amendment protection.250 The circuit court also addressed whether the altered image was “falsified” so that actual malice was determined. Applying defamation law standard, it concluded that there was no clear and convincing evidence that the publication

246 Id. at 398.
247 255 F.3d 1180 (9th Cir. 2001).
248 181 Cal.App.4th 664 (Ct. App., 2010).
249 255 F. 3d at 1188. Los Angeles Magazine (“LAM”) published what it called the “Fabulous Hollywood Issue!” An article from this issue entitled “Grand Illusions” used computer technology to alter famous film stills to make it appear that the actors were wearing Spring 1997 fashions. The sixteen familiar scenes also included movies and actors such as “North by Northwest” (Cary Grant), “Saturday Night Fever” (John Travolta), “Rear Window” (Grace Kelly and Jimmy Stewart), “Gone with the Wind” (Vivian Leigh and Hattie McDaniel), “Jailhouse Rock” (Elvis Presley), “The Seven Year Itch” (Marilyn Monroe), “Thelma and Louise” (Susan Sarandon and Geena Davis), and even “The Creature from the Black Lagoon” (with the Creature in Nike shoes). The final shot was the “Tootsie” still.
250 The decision noted: that the magazine “did not use Hoffman's image in a traditional advertisement printed merely for the purpose of selling a particular product . . . did not receive any consideration from the designers for featuring their clothing in the fashion article, containing the altered movie stills . . . Nor did the article simply advance a commercial message . . . Viewed in context, the article as a whole is a combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors. Any commercial aspects are “inextricably entwined” with expressive elements, and so they cannot be separated out “from the fully protected whole.” Id. at 1185-86. In so ruling, the panel reversed the lower court, which, rather inexplicably, concluded that since the speech was commercial, it was not protected (for right of publicity purposes) under the First Amendment. Id. at 1184.
altered the image with actual malice. Recently, a California state appellate court echoed this view.

IV. The New Test

A. Commercially based

As it stands now, the right of publicity is full of complexity – an increasingly overbroad doctrine pushing property rights on a collision course with the First Amendment. Hard to apply, with varying tests and applications, the result has been decisions of dubious constitutional reasoning. Right of publicity doctrine has applied to a gambit of activities, far afield from a traditional advertisement-based tort (later property) right. The author had hoped that Hart and Keller, would reach the opposite result, which would have increased the likelihood of a Supreme Court review, but even though the rulings are substantially similar, one day the high court will have to put its imprimatur into this hodgepodge of cases, statutes and standards. In my view, the sooner the better.

The Supreme Court (or lower courts, for that matter), must bite the bullet, and side with free speech, even brushing aside the compelling fairness argument for the college athletes. Borrowing heavily from the Restatement, Commercial Speech doctrine and a vigorous First Amendment jurisprudence, the author proposes to formally constitutionalize the doctrine, just as the court did for defamation and false light privacy a half century ago and, more recently, certain emotional distress claims, utilize a commercial speech standard and create a limited exception for a bad faith-based subset for “hybrid” commercial and non-commercial speech issues. Specifically, courts should presume that a work which incorporates one’s name, image, likeness, sound or other unique characteristics be constitutionally protected, whether it be a literacy depiction, film, artwork or computer game.

However, the aforementioned items are used to exploit the person’s property interests in a strictly commercial setting (let’s call it “direct commercial use”), as proposing a commercial transaction, such as consumer purchase, then the person would have a viable claim for violation of the right of publicity. To make this determination, the courts would look to definitions of commercial speech under Bolger v. Youngs Drugs Products – speech proposing a commercial transaction, 252 and Central Hudson - expression related solely to the economic interests of the

251 Id. at 1188.
252 See 460 U.S. 60 (1975). In Bolger, the court defined commercial speech as speech “proposing a commercial transaction.” Virginia Pharmacy cited this definition. It’s interesting to note that the court has not addressed the question of expanding this definition. The California Supreme Court made an attempt to do so in Nike v. Kasky, supra, when it applied commercial speech to speech by one “engaged in commerce,” to an “intended audience” of
speaker and its audience. While there are subtle differences between these two definitions, courts have cited the Bolger definition and it seems to have developed more legal traction.

A court could look to several factors to make a determination of “direct commercial use.” Is the depiction found on a product of mass-market production? Does the depiction aid in sales of the product? Is there any written statement by the person in question, which advocates buying the product? Is the product a widget, real estate or a service likely to be bought or sold? Is the image used in an advertisement for the product, in effect creating an invitation to negotiate? How literal is the image – is it recognizable to the public? Looking into these factors, it is worth keeping in mind a comment by the court in *Friedman v. Rogers*: “by definition, commercial speech is linked inextricably to commercial activity.”

Note that the last factor is not to be confused with the transformative test adopted by Hart, Keller and other courts. Even if the image on the product is stylized, but potentially recognizable, a prima facie case would be made and the question would go the jury as a question of fact and a question of damages.

Applying this standard to the cases before us, if Hart’s and Keller’s images were used without their permission on a box of Wheaties, there would be no doubt it was direct commercial use. Wheaties is a mass-market breakfast cereal and their images are used to help sell and the cereal as the “breakfast of champions.” However, if their depictions were used in a painting by an artist showing the grittiness of college athletes, neither would have a cause of action, because the speech was not primarily commercial. It is a work of art, even if sold as an investment. It does not matter if there is a literal depiction of not. If a photograph of either of their faces were used to show the elation of winning a championship game and that image later is used as a promo for ESPN to watch college sports, the use would still not constitute direct commercial use.

Continuing this line of thought, if their images and numbers were used as one of many players on a computer depiction of a game of avatars would be also protected. And, even if the videogame

---

255 440 U.S. 1, 10 (1979).
contains a literal depiction of them with little method of alteration, the conclusion would remain the same—no cause of action.

Despite the newer technology of video gaming, older traditions should remain. When you take the gloss off the bells and whistles of the EA games, they are digital docudramas—taking true events, with true characters and creating an environment based on a computer version of literary license. It’s a form of “based on a true story” in the digital era. So, if there is a direct advertisement/sales usage of the person’s image, then the plaintiff can have a cause of action for direct commercial use; the balance favors that person and trumps any First Amendment rights. However, the defendant may have some methods to counter that presumption.

Unless there is a direct commercial use demonstrated, the presumption should be against right of publicity claims by individuals, since the right of publicity is not a fundamental constitutional right; freedom of expression is. A case that aptly describes the correct parameter is Guglielmi v. Spelling-Goldberg Productions.256 A right of publicity action was brought by a relative of the great silent film actor Rudolf Valentino for an alleged depiction in a TV film.257 It was a docudrama, in the classic sense, but analogous to the products found in Hart and Keller.

In a pre-transformative, pre-Rogers, even pre-Restatement era, the court soundly rejected the publicity claims, under both California law and Federal Constitutional law. Whether the film was “fictional” or “factual” had no basis in the court’s determination—it was expression, for entertainment purposes, which is entitled to just as much protection as a factual documentary. Applying this point to Hart and Keller, the ability to alter their images as avatars does not diminish the protection in any way. In terms of the argument of utilizing the names and images to advertise or publicize the film, the court did not consider that commercial and using the Valentino name to “enhance the value” of the film was simply not a relevant point.258

Using the images of Hart and Keller to enhance the authenticity of the EA games is the same as utilizing Valentino’s name in the above example. In fact, it’s an even of an issue here, because the connection between the avatars and the real people is more tenuous since the images and numbers are used, but not their names. And unlike a replica of a specific event, like a football

257 The case involved a “fictionalized version” of Valentino's life, in a television film, without consent from his legal heir. On November 23, 1975, the film was broadcast on ABC. The film, entitled “Legend of Valentino: A Romantic Fiction,” which was, according to the appellant, ‘a work of fiction about the life and loves of an Italian actor who became Hollywood's first romantic screen star and who died at the height of his fame.’ Hence, the film is a “fictionalized version of Rudolph Valentino's life.” Appellant also alleged that respondents used Valentino's name, likeness and personality in advertising the film “to solicit and to sell commercial sponsorship . . . and to solicit viewers for the exhibition of [the] film.” Id. at 862.
258 Id. at 869.
game (or a human cannonball in the case of Zacchini), the game is an interactive, somewhat or potentially fictionalized account of the players’ activities. The “performance” is not lifted from an actual, live event.

Those who may argue for Hart and Keller may say that goal or “predominant purpose” is to take the images to sell the game. I say, so what? Of course, they were used as a basis. But the predominant purpose of making the Valentino movie (or many creations in our capitalist system) is to make a buck. The First Amendment does not limit this – right of publicity should not either.

B. The First Amendment Immunity for Non-Commercial Speech

The above discussion leads to the creation of a First Amendment immunity for non-commercial speech that may involve one’s name and image. Like the immunity for defamation and the more recent immunity granted to Internet Service Providers (“ISPs”) under section 230 of the 1998 Communications Decency Act,259 does not prevent a party from suing if the depiction cast the person in a “false light” or the depiction was outright defamatory. Although “false light” cases tend to be infrequent and difficult to prove,260 non-public figures could have valid causes of action. So, say that the images of Keller and Hart (based on team and number) were depicted as thugs, cheap-shot artists or incompetent fools or buffoons, they remain rights to sue in tort. Additionally, causes of action remain for the tort of inflection of emotional distress.

Despite the certainty of the standard, there is the question whether the day may come when Central Hudson is overruled and the court decides to treat commercial speech regulation with the same or similar strict scrutiny of political and expressive speech. If that day will come, this standard may still be viable, if a court wishes to carve out a “commercial” exception in a similar way as a “malice” exception applies in defamation.

259 See 47 U.S.C. § 230 (Section (c)(1) provides that neither a provider nor a servicer of an interactive computer service shall be treated as a publisher or speaker of content provided by a third party. With regard to content, including that which may be considered obscene, lewd, lascivious, filthy, excessively violent, harassing, or otherwise objectionable, section (c)(2) confers upon the provide or user of an interactive computer service immunity from liability as distributors.).

260 See Time, Inc. v. Hill, 385 U.S. 374 (1967). (The court held that the constitutional protections for speech and press precluded the application of a New York statute that provided redress for false reports where the reports involved “matters of public interest in the absence of proof that the defendant published the report with knowledge of its falsity or in reckless disregard of the truth.”).
A word on a malice-based standard that some courts have advocated and discussed. Although an attractive approach, I don’t think that an actual malice test should be applied. As defined in *New York Times*, actual malice means (in defamation cases) to require a defendant to have knowledge of falsity or a reckless disregard for the truth. In a right of publicity case, that would be easy to show. If a company wishes to utilize a person’s name, likeness or identity for commercial purposes, it is not difficult to infer the company’s knowledge and intent that that it will be used for that purpose. In fact, that is precisely why the image would be created. Not only would it be far less burdensome than showing malice in a defamation or false light claim, it would be fairly easy to show, by the facts and circumstances of these cases.

It is true that a commercial speech-based standard will exempt the situation where the expression contains commercial and non-commercial elements – arguably the situation in *Hart* and Keller. However, a “bad faith” corollary of the direct commercial speech test would come into play.

C. The “Bad Faith” Corollary

Advocates for an expanded right of publicity standard correctly point out that under the direct commercial speech standard, one could theoretically intent to use an image for a commercial purpose, through a patina of a non-commercial use. Let’s take this example: what if Wheaties decides to commission a computer graphics artist to create an avatar that has strong identifying features of a particular athlete. The creation would be a part of a new campaign to “digitize” the athlete used on the box. The reason, in part is to avoid paying rights fees to use the actual athlete’s name and likeness on the box.

At this point, under the “direct commercial use” test, a case for publicity rights by the actual athlete could be made – assuming that the avatar had enough similarities to the actual athlete. However, what if General Mills also decided to use or license the avatar as a character in a children’s comic book (shades of *Doe v. TCI Cable*) or in a videogame. What if the firm decided to sell posters of the avatar (like in *ETW v. Jireh*)? Non-commercial or artistic use can be shown. If the athlete brought a cause of action claiming violation of his/her publicity rights, such a case would present both commercial and non-commercial use. Normally, under the “direct commercial use” test, the First Amendment rights of General Mills would prevail. However, taking a cue from the *Central Hudson* test, I would create an exception that if the aggrieved party can demonstrate that the defendant intended to use the image for commercial purposes, but also

---

261 See *New York Times* v. Sullivan, 376 U.S. 254, 279 (1964) (defining “actual malice” as knowledge that the speech was false or “with reckless disregard of whether it was false or not.”). See also, *Eastwood I* and *Eastwood II*, and Hoffman v. Capita Cities/ABC, Inc., 255 F. 3d 1180 (9th Cir. 2001).

262 See *New York Times*, 376 U.S. at 279.
created a non-commercial use with the intent to circumvent the rights of the athlete, then a court could determine that the firm engaged in “bad faith” and a cause of action would ensue.

This is roughly analogous to the first prong of the Central Hudson test, which denies constitutional protection for commercial speech that is “likely to deceive” the reader. One could also argue that it has some relationship with the malice standard used to rebut the qualified immunity protecting media defendants from defamation lawsuits involving public figures found in New York Times cases and its progeny. Although the Central Hudson court was focusing on illegal or misleading advertising, this notion can be applied to attempts by a firm to improperly exploit the commercial image of one name, likeness or image by creating the artistic version as a subterfuge to avoid liability. In a sense, this is “misleading” conduct by the defendant. Additionally, one can argue that this could be a “reckless disregard” for the truth found in New York Times, since the defendant is intentionally creating liability avoidance by crafting a non-commercial use.

The standard of proof for the bad faith corollary would be difficult and could result in an expensive discovery phase, to be sure. However, like the knowledge/reckless disregard elements required to show malice in a defamation claim, it is a difficult standard, but not an impossible feat. Determining “bad faith” in a case where the use has both commercial and non-commercial elements would be similar: tough, but not impossible. In my mind, this corollary would not apply in Hart and Keller, since there was no evidence that these depictions are directly commercial or that there were any commercial elements to their use. I doubt that bad faith would be demonstrated as well.

V. Conclusion

As one commentator put it, “In right of publicity cases, “there are many quasi-commercial uses that fall somewhere in-between the non-commercial and commercial ends of the commercial advantage spectrum, like video games, trading cards, and fantasy leagues.” He adds, “[I]t is unfair and not good policy to allow the producer to reap the full commercial value of the celebrity's identity.” That may be true and in the ideal world, the parties would negotiate licensing agreements to detail the use and the compensation. However, the expansion of the publicity right to “quasi-commercial” uses through the myriad of tests noted in this article produced conflicting decisions, inconsistent application of the right of publicity doctrine and a

263 See Central Hudson 447 U.S. 557, 563 (1980) (“The government may ban forms of communication more likely to deceive the public than to inform it.”).
gradual, but persistent shortchanging of creative First Amendment rights. The best solution to the problem is to put constitutionally protected expressive rights over property rights. A commercial use limitation on right of publicity is the best way to achieve that goal.

*Director, Sports Business Concentration, Associate Professor, Law and Ethics, Gabelli Schools of Business, Fordham University. BA – City College of New York; JD – New York Law School; MS – Columbia University, Graduate School of Journalism. I would like to thank Ms. Veronica N. Dunlap, JD/MBA Candidate, Fordham University, for her assistance in the preparation of this article.