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## *Collateral Damage: Why the Transformative Use Test Confounds Publicity Rights Law*

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## ABSTRACT

Over the last half-century, the “right of publicity” has bedeviled courts and commentators who have largely overlooked the right of publicity’s relevant legal interests and colorably failed to construct a jurisprudential framework that properly balances the right of publicity’s property interests with the First Amendment’s free speech values. The increasing adoption of *Comedy III*’s “transformative use” test only further confounds publicity rights’ already confusing legal landscape. Courts should reject and abandon *Comedy III*’s “transformative use” test and turn back to the prevailing judicial frameworks utilized in other intellectual property cases—namely, the Secondary Effects doctrine and copyright law’s internal means-ends balancing test. Only then will courts produce fair, clear, and consistent outcomes that fairly reflect the underlying interests and overarching policies of the two conflicting rights.

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## I. INTRODUCTION

Despite decades of case law and a Supreme Court decision,<sup>1</sup> the right of publicity over the last thirty-eight years—while surging in importance<sup>2</sup>—has plunged into confusion.<sup>3</sup> In addition to, or perhaps because of, the elusive theoretical justifications underlying this relatively modern “right,”<sup>4</sup> courts and commentators have equally struggled to find a legal framework that properly balances publicity rights-based proprietary interests with First Amendment free speech values.<sup>5</sup> Among the many attempts to reconcile this entrenched legal conflict, several state courts—most notably California—

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<sup>1</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

<sup>2</sup> See Jana M. Moser, *Tupac Lives! What Hologram Authors Should Know About Intellectual Property*, BUSINESS LAW TODAY, Sept. 2012, available at <http://apps.americanbar.org/buslaw/blt/content/2012/09/article-02-moser.shtml> (discussing the expansive right of publicity implications of holographic performances); see also Mark P. McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 225, 227 (2005) (commenting on the “growth of the right of publicity”).

<sup>3</sup> 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, 472 (2003) (stating that publicity rights law is a “confusing morass of inconsistent, sometimes non-existent, or mutually exclusive approaches, tests, standards, and guidelines, with the confusion only increased by several recent rulings”).

<sup>4</sup> See Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1162 (2006) (bemoaning the “absence of any clear theoretical foundation for the right of publicity”); see also McKenna, *supra* note 2, at 231 (stating that “the right of publicity, in its current form, stands on shaky ground”).

<sup>5</sup> See, e.g., Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 47 (1994) (stressing that “courts lack a principled and consistent method of resolving the conflict between the right of publicity and the First Amendment”).

have recently strewn together a First Amendment balancing test<sup>6</sup> by borrowing elements from copyright law's already much-maligned fair use doctrine.<sup>7</sup> This "transformative use" test has unfortunately, but rather predictably, produced a series of inconsistent and arguably counterintuitive results.<sup>8</sup> These highly criticized outcomes, however, merely reflect the initial unsound judicial approach—an approach that readily ignores and often directly undermines the right of publicity's underlying purpose and overarching policy. Only by clearly defining and properly applying the fundamental principles underpinning the right of publicity and the First Amendment will courts strike a sensible balance between these embattled legal claims. This Article seeks to reestablish the proper relationship between the right of publicity and the First Amendment and restructure California's "transformative use"

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<sup>6</sup> See, e.g., *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003); *Hart v. Elec. Arts, Inc.*, 740 F. Supp. 2d 658 (D.N.J. 2010); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001).

<sup>7</sup> See Alex Kozinski & Christopher Newman, *What's So Fair About Fair Use?*, 46 J. COPYRIGHT SOC'Y 513, 514 (1999) (pointing out that "when you're applying a multi-factor test in which the factors are not clearly defined or weighted, it's very difficult to be clearly wrong" (emphasis in original)); Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903, 916–25 (2003) (criticizing *Comedy III*'s transformative use test and calling it "indefinite," "vague," and "hardly worth recommendation").

<sup>8</sup> See Kwall, *supra* note 5, at 58 (stating in 1994 that "the incorporation of a copyright law doctrine as the springboard for analysis in the First Amendment/right of publicity dilemma will result in the adoption of an imprecise analytical framework and potentially inappropriate outcomes"). Compare *No Doubt v. Activision Publ'g Inc.*, 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011), and *Keller v. Elec. Arts, Inc.*, No. C09-1967CW, 2010 WL 530108, at \*1, \*16 (N.D. Cal. Feb. 8, 2010), with *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006), and *Hart*, 740 F. Supp. 2d at 658.

test to more clearly reflect the precise legal interests in tension so as to provide a more consistent and intuitive path for judicial decisions going forward.

Part II of this Article discusses the birth and development of publicity rights law in the United States and most notably its intimate connection to, and eventual independence from, the right of privacy. Part III uses the history of publicity rights law in California as a case study to illustrate how the right of publicity's interaction with the First Amendment has, over time, been increasingly misunderstood, misinterpreted, and mishandled. Part IV sets forth a more comprehensive right of publicity model and Part V offers a coherent and consistent First Amendment balancing test. The Article concludes in Part VI by reiterating the need for predictability in the law and stressing the marked unpredictability of the rapidly expanding "transformative use" test.

## II. THE ORIGIN AND DEVELOPMENT OF THE RIGHT OF PUBLICITY IN THE UNITED STATES

The modern right of publicity is a state-based common law and statutory claim that allows an individual to safeguard the commercial value of his or her name and likeness and to prevent others from exploiting it without permission.<sup>9</sup> Conventionally, this right has been understood as the "step-child" of privacy law,<sup>10</sup> in that it owes its genesis to, and is a

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<sup>9</sup> Roberta Rosenthal Kwall, *Is Independence Day Dawning for the Right of Publicity?*, 17 U.C. DAVIS L. REV. 191, 191 (1983).

<sup>10</sup> See Evie K. Rubin, *The Right of Publicity Survives in California: California Civil Code Section 990*, 12 W. ST. U. L. REV. 299 (1984).

direct offshoot of, the “right of privacy.”<sup>11</sup> Although early privacy decisions relied upon “property-like” legal protection theories,<sup>12</sup> over time, the right of privacy was viewed as an intangible, personal claim of redress for injury to one’s feelings<sup>13</sup> with inherent limitations on celebrity, alienability, and decendibility.<sup>14</sup> Indeed, it was privacy law’s theoretical drift towards a more feeling-centered injury rationale that ultimately compelled the recognition of a separate, property-centered legal claim—a claim framed as an assignable property right to the economic value of an individual’s name or likeness that was fully amenable to a celebrity claimant’s public status.<sup>15</sup>

### A. The Right of Privacy and Early Privacy Cases

The “right of privacy” as a legally enforceable right is largely a twentieth century development.<sup>16</sup> Although privacy law’s roots are embedded in a cluster of constitutional and

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<sup>11</sup> See Kwall, *supra* note 9, at 191–92; Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 125, 167 (1993) (noting that the first cases invoking a “right of privacy” primarily involved the unauthorized advertising use of a private person’s name and likeness).

<sup>12</sup> See Dorothy J. Glancy, *Privacy and the Other Miss M*, 10 N. ILL. U. L. REV. 401, 402 (1990).

<sup>13</sup> See J. THOMAS MCCARTHY, 1 THE RIGHTS OF PUBLICITY AND PRIVACY § 5:65 (2d ed. 2014).

<sup>14</sup> See Robert T. Thompson, III, *Image as Personal Property: How Privacy Law Has Influenced the Right of Publicity*, 16 UCLA ENT. L. REV. 155, 157 (2009).

<sup>15</sup> See *id.* at 165; Madow, *supra* note 11, at 167 (“The right of publicity was created not so much from the right of privacy as from frustration with it.”).

<sup>16</sup> See DONALD E. BEIDERMAN ET AL., LAW & BUSINESS OF THE ENTERTAINMENT INDUSTRIES 185 (5th ed. 2006).



common law precedents,<sup>17</sup> the enunciation of privacy as an integrated legal theory is generally traced back to the publication of Samuel Warren and Louis Brandeis' landmark 1890 Harvard Law Review article,<sup>18</sup> "The Right to Privacy."<sup>19</sup> The conventional understanding of this article is that Warren and Brandeis, in response to the growing encroachment of media and technology, argued for the creation (or recognition) of a common law cause of action that they believed was necessary to protect an individual's privacy from a press that was "overstepping in every direction the obvious bounds of propriety and of decency."<sup>20</sup> Advocating for a fundamental "right to be let alone," Warren and Brandeis argued that individuals should be free from the "blighting influence" of gossip and instantaneous photography.<sup>21</sup> Such invasions of privacy, the authors asserted, were immeasurably damaging to the feelings of the person whose private life was invaded.<sup>22</sup> Because the existing cause of action at the time (libel) protected only damage to one's reputation with others in the community, Warren and Brandeis argued for the recognition and enforcement of a new common law tort that provided a remedy for the direct damage to the feelings of the

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<sup>17</sup> See *id.*; Benjamin E. Bratman, *Brandeis and Warren's The Right of Privacy and the Birth of the Right to Privacy*, 69 TENN. L. REV. 623, 627 (2002).

<sup>18</sup> Gloria Franke, *The Right of Publicity vs. the First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CAL. L. REV. 945, 949 (2006).

<sup>19</sup> Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 194 (1890).

<sup>20</sup> See Franke, *supra* note 18, at 949 (quoting Warren & Brandeis, *supra* note 19, at 195–96).

<sup>21</sup> *Id.*

<sup>22</sup> Bratman, *supra* note 17, at 630.

persons aggrieved by such privacy invasions.<sup>23</sup> And thus the “right to privacy” was first injected into the legal dialogue.

After some initial reluctance,<sup>24</sup> courts eventually recognized Warren and Brandeis’ newly crystalized “right to privacy.”<sup>25</sup> In the seminal 1905 case, *Pavesich v. New England*

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<sup>23</sup> *Id.* at 632 (citing Warren & Brandeis, *supra* note 19, at 194). It is important to note that Warren and Brandeis modeled the legal framework for their newly minted “right to privacy” on property-like legal protection of an individual’s identity and attendant exposure. *See* Glancy, *supra* note 12, at 402 (explaining how, in their landmark article, Warren and Brandeis addressed current cases involving the circulation of surreptitiously snapped pictures of vaudeville performers and stating that such invasions of privacy “involved enforcement of a proprietary right to a person’s identity”). Unfortunately, “the article’s more revolutionary suggestion that the right to privacy provides a legal basis for vindicating feelings and providing redress for emotional injuries has, over the past hundred years, overshadowed this proprietary aspect of the original concept of the right to privacy.” *Id.* at 408; *see also* Warren & Brandeis, *supra* note 19, at 211 (“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, afford alone that broad basis upon which the protection which the individual demands can be rested.”).

<sup>24</sup> *See* Bratman, *supra* note 17, at 633–34; *see also* *Atkinson v. John E. Doherty & Co.*, 80 N.W. 285, 286 (Mich. 1899); *Chapman v. W. Union Tel. Co.*, 15 S.E. 901 (Ga. 1882). The watershed case for the right of privacy was the 1902 New York Court of Appeals case, *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442 (N.Y. 1902). There, the court rejected a legally enforceable “right to privacy” and held that the unauthorized use of a private individual’s picture on flyers promoting the sale of flour boxes did not violate any cognizable legal right. *Id.* at 447. The public and academic outcry that followed the Court of Appeal’s decision compelled the New York legislature to swiftly reverse the *Roberson* court with a statute establishing both criminal and civil liability for the unauthorized use of “the name, portrait or picture of any living person” for “advertising purposes, or for the purposes of trade.” *See* 40 N.Y. CIV. RIGHTS LAW §§ 50, 51 (Consol. 2001).

<sup>25</sup> *See* Bratman, *supra* note 17, at 642–43.

*Life Insurance Co.*,<sup>26</sup> the Georgia Supreme Court held that a company's unauthorized use of a person's photograph in a testimonial advertisement was actionable as an "invasion of privacy."<sup>27</sup> The *Pavesich* court found that such conduct was a

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<sup>26</sup> 50 S.E. 68 (Ga. 1905). Although *Pavesich* was not the first published opinion to recognize a legally cognizable right of privacy, see, e.g., *Corliss v. E.W. Walker Co.*, 64 F. 280, 282 (D. Mass. 1894); *Marks v. Jaffa*, 26 N.Y.S. 908 (N.Y. Sup. Ct. 1893); *Schuyler v. Curtis*, 15 N.Y.S. 787 (N.Y. Sup. Ct. 1891), *Pavesich* was by far the most influential of the earliest cases.

<sup>27</sup> *Pavesich*, 50 S.E. at 70. Writing for the majority, Judge Cobb explicitly rejected the *Roberson* opinion and favorably cited Warren and Brandeis's article for the proposition that the right of privacy was a legal right found in natural law. *Id.* Interestingly, while the *Pavesich* court certainly relied upon "natural law," it centered its analysis on the "right to liberty"—not the "right to life" as did Warren and Brandeis. See Warren & Brandeis, *supra* note 19, at 193 ("[N]ow the right to life has come to mean the right to enjoy life[]—the right to be let alone; the right to liberty secures the exercise of extensive civil privileges; and the term 'property' has grown to comprise every form of possession—intangible, as well as tangible."). This distinction has not received the scholarly attention it deserves. Whereas Warren and Brandeis' "right to privacy" is a subset of personal security stemming from an individual's inherent "right to life," the Georgia Supreme Court's "right to privacy" is a subset of individual autonomy and a person's inherent "right to liberty." See *Pasevich*, 50 S.E. at 70 ("Each is entitled to a liberty of choice as to his manner of life, and neither an individual nor the public has a right to arbitrarily take away from his liberty."). It also noted that "[t]he right of one to exhibit himself to the public at all proper times, in all proper places, and in a proper manner is embraced within the right of personal liberty." *Id.* (emphasis added). Connected to this "liberty" theme (and also frequently overlooked by courts and commentators) is the fact that the *Pavesich* court left open ample room in its analysis for celebrities to seek redress for unwanted and unwarranted publicity. See *id.* ("One may desire to live a life of seclusion; another may desire to live a life of publicity; still another may wish to live a life of privacy as to certain matters, and of publicity as to others. . . . One who desires to live a life of partial seclusion has a right to choose the times, places, and manner in which . . . he will submit himself to the public gaze." (emphasis added)). In

“serious invasion” and could cause “damages to flow which are irreparable in their nature.”<sup>28</sup> The court also recognized, however, that this right of privacy, “like every other right that rests in the individual, may [only] be waived by him . . . .”<sup>29</sup> In the years following *Pavesich*, “more through judicial decision than legislation,”<sup>30</sup> protection from the unauthorized commercial use of one’s name and likeness became a widely recognized legal right.<sup>31</sup>

## B. The Birth of the Right of Publicity

In its infancy, *private* individuals invoked the “right to privacy.”<sup>32</sup> Eventually, however, public figures and celebrities

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fact, the *Pavesich* court suggested that the “right of privacy” was complimentary to the “right of publicity.” *See id.* (“Publicity in one instance, and privacy in the other, are each guarant[e]d. If personal liberty embraces the right of publicity, it no less embraces the correlative right of privacy . . . .”).

<sup>28</sup> 50 S.E. at 80. The fact that the early “right of privacy” cases involved the unauthorized use of an individual’s likeness in advertisements partially explains why the right of privacy and the right of publicity are so closely linked and so often confused.

<sup>29</sup> *Id.* at 72.

<sup>30</sup> *See* Madow, *supra* note 11, at 168.

<sup>31</sup> *See* Bratman, *supra* note 17, at 642–43. Again, these “right to privacy” cases involved the right of an individual to exclude others from using her visage in a public or commercial setting. Although the defendants in these cases certainly had the right to take a picture of the plaintiff and also the right in the physical picture itself, they nevertheless did not have the right to publish or disseminate the particular “private” image within the picture for advertising or commercial purposes. Hence, to some extent, the plaintiff had a copyright-like property right in his face and identity for the purpose of protecting her anonymity and privacy.

<sup>32</sup> *See* Madow, *supra* note 11, at 168; *see also* Robert C. Denicola, *Institutional Publicity Rights: An Analysis of the Merchandising of Famous Trade Symbols*, 62 N.C. L. REV. 603, 621 (1984).

began objecting to the commercial appropriation of their identities by profit-peddling merchandisers and rapidly expanding advertising firms. As Professor Madow explained, these claims presented a unique challenge to the privacy law paradigm:

The plaintiffs in [cases like] *Roberson* [*v. Folding Box Co.*] and *Pavesich* asserted claims that fit comfortably within the basic conception of privacy as a “right to be let alone.” . . . [T]he plaintiffs . . . [were private individuals who were] rudely exposed to widespread and unwanted publicity. They could plausibly claim keen embarrassment or distress at having their faces spread before all the world. . . . [When it came to celebrities, however,] [c]laims of such emotional injury were not nearly as convincing . . . . After all . . . [what] movie star or professional athlete, who had deliberately and energetically sought the limelight, [could then] complain of embarrassment or hurt feelings when an advertiser or merchandiser simply gave his face some *additional* publicity? . . . [Thus,] when celebrity plaintiffs first came to the courts in the 1920s and 1930s seeking relief from unauthorized commercial appropriation on privacy grounds, the reception was generally cool or uncomprehending. . . . [C]ourts held simply that celebrities had waived their rights of privacy, not only as to news coverage and comment but as to commercial appropriation as

well, by assuming positions of prominence and visibility.<sup>33</sup>

The courts were accordingly slow to recognize this nonprivacy “property” claim.<sup>34</sup> But by the 1930s, the inadequacy of privacy-based remedies against unauthorized commercial uses of celebrity identities was apparent:<sup>35</sup> the right to privacy, as a purely “personal right,” simply did not allow celebrities to enjoy<sup>36</sup> a “fully functioning market” in their commercially valuable personas.<sup>37</sup> Furthermore, many started believing that the harm connected to the unauthorized use of a celebrity’s name or likeness was not unwanted exposure but rather uncompensated publicity.<sup>38</sup> Such claims,

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<sup>33</sup> Madow, *supra* note 11, at 168–69 (emphasis in original) (footnotes omitted). Although there certainly were some early exceptions to courts’ rejection of an economic property-based claim to unauthorized commercial use of names and likenesses, *see, e.g.*, *Edison v. Edison Polyform Mfg. Co.*, 67 A. 392 (N.J. Ch. 1907) (enjoining a third party from using the name or likeness of inventor Thomas Edison to promote its own products), the majority of courts addressed and rejected only privacy-based arguments. *See, e.g.*, *O’Brien v. Pabst Sales Co.*, 124 F.2d 167 (5th Cir. 1941), *cert. denied*, 315 U.S. 823 (1941) (affirming a directed verdict against a famous football player seeking damages for the alleged use of his photograph by a beer company without his permission because O’Brien, as a celebrity, could not establish direct injury to his personal feelings).

<sup>34</sup> *See* Marla E. Levine, *The Right of Publicity as a Means of Protecting Performers’ Style*, 14 LOY. L.A. L. REV. 129, 135–38 (1980).

<sup>35</sup> *See* Madow, *supra* note 11, at 170.

<sup>36</sup> *Id.*

<sup>37</sup> *Id.*

<sup>38</sup> *See, e.g.*, *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953). This belief was a gross overgeneralization. True, celebrities in some cases were primarily concerned with the economic implications of their names and likeness being used or overused in a commercial context (something that today could easily be addressed under the current Lanham Act); however, other celebrities *were* concerned with

legal commentators and courts asserted, had no relation to an individual's right of privacy.<sup>39</sup>

The 1935 case, *Hanna Manufacturing Co. v. Hillerich & Bradsby Co.*,<sup>40</sup> was the watershed case for the right of publicity. In *Hanna*, the Fifth Circuit held that a bat manufacturer could not enforce its exclusive right to baseball players' names against a rival bat maker because the right was "not vendible in gross so as to pass from purchaser to purchaser unconnected with any trade or business."<sup>41</sup> More so than previous court decisions that rejected personality rights for famous individuals, the *Hanna* decision was met with a cold and critical reception.<sup>42</sup> The older understanding, on which Judge Sibley's opinion in *Hanna* rested, was that fame—like reputation—was considered to be something that one cannot buy or own.<sup>43</sup> But over time, most likely influenced by trademark law,<sup>44</sup> people began to conceive fame as a business

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and injured by "overexposure." See *Fisher v. Murray M. Rosenberg, Inc.*, 23 N.Y.S.2d 677, 679 (N.Y. Sup. Ct. 1940) (recognizing that a famous dancer "suffered humiliation and distress of mind" because of defendant's unauthorized use of the dancer's likeness in an advertisement).

<sup>39</sup> See Madow, *supra* note 11, at 170.

<sup>40</sup> 78 F.2d 763 (5th Cir. 1935).

<sup>41</sup> *Id.* at 766.

<sup>42</sup> See Madow, *supra* note 11, at 171–72.

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

<sup>44</sup> Prior to 1953, trademark law long grappled with the perils of free-floating misappropriation claims. See Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 583 (2005) (explaining that "the goodwill-as-property theory had problems, and these problems became increasingly troubling to jurists over the first half of the twentieth century"). In 1917, the Second Circuit, in *Aunt Jemima Mills Co. v. Rigney & Co.*, 247 F. 407 (2d Cir. 1917), opened wide the door for trademark protection beyond traditional same-good confusion. See *Rosenberg Bros. & Co. v. Elliott*, 7 F.2d 962, 965–66 (3d Cir. 1925)

asset like “good will”—a commodity to be produced and exchanged like any other.<sup>45</sup> As this legal conception gained traction, Judge Sibley's “market-inalienability” conception of fame increasingly came to be seen as naive, romantic, and obstructionist.<sup>46</sup> The jurisprudential breakthrough for the novel economic conception of fame came in the 1953 case, *Haelan*

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(observing that the *Aunt Jemima* decision “revived a controversy of long standing as to what is the proper basis on which equity will grant relief for trade[]mark infringement, whether on a property right in the trade[]mark, . . . a tort to property, . . . deceit practiced against the owner or against the public, or . . . the right of a vendor to have his mark or his trade protected from irreparable damage”). Then in 1928, the Second Circuit again set watershed precedent in *Yale Elec. Corp. v. Robertson*, 26 F.2d 972 (2d Cir. 1928), wherein, by the pen of Judge Learned Hand, the court broadly stated that if another uses a merchant's mark, “he borrows the owner's reputation, whose quality no longer lies within his own control . . . . This is an injury, even though the borrower does not tarnish it, or divert any sales by its use . . . .” 26 F.2d at 974. After *Yale Elec.*, labor-desert theories justifying the misappropriation of goodwill quickly emerged. *See, e.g.*, FRANK S. MOORE, LEGAL PROTECTION OF GOODWILL: TRADE-MARKS, TRADE EMBLEMS, ADVERTISING, UNFAIR COMPETITION 52 (1936) (arguing that companies are entitled to the “goodwill” or “consumer demand” engendered by its advertising efforts). Nevertheless, several courts were weary to grant “property-like” rights in intangible symbols. *See, e.g.*, *Premier-Pabst Corp. v. Elm City Brewing Co.*, 9 F. Supp. 754, 757 (D. Conn. 1935) (recognizing that “some have vaguely suggested that a right to a name may be part of one's ‘good will’ which is a subject-matter of property from which all others may be excluded” but stating that “such an assertion gets us nowhere” because “good will so construed certainly is not property in any technical sense; for no man can have either by prescription or contract, such a proprietary right to the favorable regard of the public that he may exclude others therefrom”). As functionalist legal philosophy gained traction in the second quarter of the twentieth century, however, the formalist paradigms of the late nineteenth and early twentieth centuries were increasingly questioned, rejected, and replaced. *See Bone, supra*, at 585.

<sup>45</sup> *See* Madow, *supra* note 11, at 171–72.

<sup>46</sup> *Id.*



*Laboratories, Inc. v. Topps Chewing Gum*<sup>47</sup>—a case with facts almost identical to those in *Hanna*.<sup>48</sup>

In the groundbreaking *Haelan* case, the Second Circuit—by the pen of Judge Jerome Frank—declared that an individual has, independent of the right of privacy, a “right in the publicity” value of his photograph.<sup>49</sup> This “right of publicity” could be licensed or assigned, and the licensee or assignee could enforce it against third parties.<sup>50</sup> In what are now widely quoted words in publicity rights law, the Second Circuit rejected Topps’ argument that the players had “no legal interests” in the publication of their pictures beyond their right of privacy, stating:

We think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in

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<sup>47</sup> 202 F.2d 866 (2d Cir. 1953).

<sup>48</sup> See Madow, *supra* note 11, at 171.

<sup>49</sup> *Haelan*, 202 F.2d at 868. In *Haelan*, a famous baseball player signed an exclusive baseball card contract with one company (*Haelan*) but then a rival company (*Topps*) printed cards with pictures of the same player. *Id.* at 867. The main issue before the court was whether *Haelan*, as the assignee, could bring suit against *Topps*. *Id.* The photographs at issue depicted baseball players, individuals with obvious celebrity status. Roberta Rosenthal Kwall, *A Perspective on Human Dignity, the First Amendment, and the Right of Publicity*, 50 B.C. L. REV. 1345, 1351 (2009) (citing *Haelan*, 202 F.2d at 867). *Topps*, consistent with the *Hanna* decision, asserted that under New York law, the player had “no legal interest in the publication of his picture other than . . . a personal and nonassignable right not to have his feelings hurt by such a publication.” *Haelan*, 202 F.2d at 868. Consequently, *Topps* argued that *Haelan* had “no ‘property’ right or other legal interest which defendant’s conduct invaded.” *Id.* at 867.

<sup>50</sup> J. Thomas McCarthy, *Melville B. Nimmer Symposium: A Tribute*, 34 UCLA L. REV. 1703, 1708 (1987) (citing Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 216 (1954)).

the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture . . . [and] far from having [his] feelings bruised through public exposure of [his] likenesses, [he] would feel sorely deprived if [he] no longer received money for authorizing advertisements, popularizing [his] countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield [him] no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using [his] pictures.<sup>51</sup>

While clearly rejecting a “privacy” justification, the Second Circuit did not make readily apparent its underlying theoretical justification for why the value of a famous name and likeness demanded legal protection.<sup>52</sup> Since, as the *Haelen* court openly admitted, exclusivity of use was the real source of a persona’s marketable value,<sup>53</sup> the *Haelen* court’s “right of publicity” lacked an explicit justification why such exclusivity

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<sup>51</sup> *Haelan*, 202 F.2d at 868. Judge Frank impatiently dismissed as “immaterial” whether this “right of publicity” should be labeled a property right: “Here, as often elsewhere, the tag ‘property’ simply symbolizes the fact that courts enforce a claim which has pecuniary worth.” See Madow, *supra* note 11, at 173 (citing *Haelan*, 202 F.2d at 868).

<sup>52</sup> See Madow, *supra* note 11, at 173–74.

<sup>53</sup> *Haelan*, 202 F.2d at 868 (“This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.”); see also *Matthews v. Wozencraft*, 15 F.3d 432, 437–38 (5th Cir. 1994) (recognizing that without the artificial scarcity created by publicity rights, identities would be commercially exploited until the marginal value of each use is zero).

should be legally enforced.<sup>54</sup> Furthermore, absent privacy concerns, the use of a name and likeness—even in a commercial context—still commands some, albeit limited, First Amendment protection.<sup>55</sup> Before this newly formed “right of publicity” could find a legitimate legal niche, therefore, it needed a clear and compelling theoretical foundation.

A year after the *Haelan* decision, well-revered intellectual property authority Melville Nimmer attempted to provide that foundation.<sup>56</sup> In his seminal article, “The Right of Publicity,” Nimmer asserted that it was “an unquestioned fact that the use of a prominent person’s name, photograph or likeness (i.e., his publicity values) in advertising a product or in

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<sup>54</sup> See *Haelan*, 202 F.2d at 868. The *Haelan* court’s faulty reasoning mirrors the fallacies found in early trademark misappropriation claims. See Felix Cohen, *Transcendental Nonsense and the Functional Approach*, 35 COLUM. L. REV. 809, 815 (1935): (“The current legal argument runs: One who by the ingenuity of his advertising or the quality of his product has induced consumer responsiveness to a particular name, symbol, form of packaging, etc., has thereby created a thing of value; a thing of value is property; the creator of property is entitled to protection against third parties who seek to deprive him of his property. . . . The vicious circle inherent in this reasoning is plain. It purports to base legal protection upon economic value, when, as a matter of actual fact, the economic value of a sales device depends upon the extent to which it will be legally protected.”)

<sup>55</sup> See *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 761 (1976) (stating that “[i]t is clear . . . that speech does not lose its First Amendment protection because money is spent to project it, as in a paid advertisement of one form or another”); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184–85 (9th Cir. 2001) (same); Alex Kozinski & Stuart Banner, *Who’s Afraid of Commercial Speech?*, 76 VA. L. REV. 627, 628–29 (1990) (recognizing and in fact arguing against the distinction between commercial and noncommercial speech).

<sup>56</sup> See Madow, *supra* note 11, at 174 (“A year after *Haelan Laboratories*, the nascent ‘right of publicity’ received its first systematic exposition in a seminal article by Melville Nimmer.”).

attracting an audience is of great pecuniary value.”<sup>57</sup> He then posited that it was also “unquestionably true that in most instances a person achieves publicity values of substantial pecuniary worth only after he has expended considerable time, effort, skill, and even money.”<sup>58</sup> Recognizing the deep-rooted, Anglo-American ethos that “every person is entitled to the fruit of his labors unless there are important countervailing public policy considerations,” Nimmer argued for the universal judicial recognition of the right of each person to control and profit from the publicity values which he has created or purchased.<sup>59</sup> Indeed, Nimmer viewed this labor-desert justification as a “first principle of Anglo[]American jurisprudence” and “axiom of the most fundamental nature.”<sup>60</sup>

Nimmer’s Lockean-inspired “labor-desert” theory, however, is simply insufficient to justify property-like legal exclusion for intangible concepts like words, symbols, or other types of expression. As Justice Brandeis pointed out in his dissent in *International News Service v. Associated Press*,<sup>61</sup> “the fact that a product of the mind has cost its producer money and labor, and has a value for which others are willing to pay, is not sufficient to ensure to it th[e] legal attribute of

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<sup>57</sup> Nimmer, *supra* note 50, at 215.

<sup>58</sup> *Id.* at 216.

<sup>59</sup> *See id.* at 212, 216 (“Advertisements, almost regardless of their nature, will increase their reader appeal by including the name and portrait of a prominent personality or a well-known enterprise, although there is no ‘passing off’ that such personality or enterprise produces or endorses the product being advertised.”); *see also* MCCARTHY, *supra* note 13, at § 2.2.

<sup>60</sup> Steven J. Hoffman, *Limitations on the Right of Publicity*, 28 BULL. COPYRIGHT SOC’Y U.S.A. 111 (1980) (stating that Nimmer’s 1954 article “did for the right of publicity what Warren and Brandeis did sixty-four years earlier for the right of privacy”).

<sup>61</sup> 248 U.S. 215, 248 (1918) (Brandeis, J., dissenting).

property.”<sup>62</sup> Specifically, Brandeis explained that such intellectual material, upon voluntary communication, is by default as “free as the air to common use.”<sup>63</sup> Accordingly, free exchange in the marketplace of ideas is thereafter limited “only in certain classes of cases where public policy has seemed to demand it.”<sup>64</sup> In other words, because intangible property embracing speech and expression is necessarily “affected with a public interest,” the “right of exclusion is qualified” and such a right must be justified on important policy grounds—policy grounds outside of and in addition to the inadequate “labor-desert” theory.<sup>65</sup> Since personas, like most other forms of

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<sup>62</sup> *Id.* at 250; *see also* *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001) (citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 160 (1989) (emphasizing that “copying is not always discouraged or disfavored by the laws which preserve our competitive economy”)).

<sup>63</sup> *Int’l News Serv.*, 248 U.S. at 250 (Brandeis, J., dissenting); *see also* Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 975 (1993) (“The point is that any doctrine that gives people property rights in words, symbols, and images that have worked their way into our popular culture must carefully consider the communicative functions those marks serve. . . . Words and images do not worm their way into our discourse by accident; they’re generally thrust there by well-orchestrated campaigns intended to burn them into our collective consciousness. Having embarked on that endeavor, the originator of the symbol necessarily—and justly—must give up some measure of control.” (footnotes omitted)).

<sup>64</sup> *Int’l News Serv.*, 248 U.S. at 250 (Brandeis, J., dissenting); *ATC Distribution Grp., Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 710 (6th Cir. 2005) (quoting *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 349) (“The primary objective of copyright is not to reward the labor of authors, but ‘to promote the Progress of Science and useful Arts.’” (internal citations omitted))).

<sup>65</sup> *Int’l News Serv.*, 248 U.S. at 250 (Brandeis, J., dissenting). Even when sufficient policy grounds exist, moreover, “[c]ourts are ill-equipped to make the investigations which should precede a determination of the limitations which should be set upon any property right.” *Id.* at 267.

intangible property, have informational value and expressive utility, any “extension of property rights” over such necessarily entails a “corresponding curtailment of the free use of knowledge and of ideas.”<sup>66</sup> This curtailment requires adequate policy justifications, and, when such policy justifications are lacking—despite the labor expended or the value created—free “appropriation” is not only proper but preferred.<sup>67</sup> This point was reiterated by the Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*,<sup>68</sup> wherein the Court directly rejected a “sweat of the brow” justification for copyright law because such a theory “distorts basic copyright principles in that it creates a monopoly in public domain materials without the *necessary justification* of protecting and encouraging the creation of ‘writings’ by ‘authors.’”<sup>69</sup> Neither Nimmer’s “labor-desert” theory, nor Judge Frank’s “value-property” theory, therefore, provides a sufficient policy justification for protecting an intangible concept infused with expressive value.

Notwithstanding these flaws, Nimmer’s article gave the right of publicity at least an arguable theoretical underpinning and certainly much-needed authoritative support.<sup>70</sup> After

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<sup>66</sup> *Id.* at 263; *see also* *E.I. du Pont de Nemours Powder Co. v. Masland*, 244 U.S. 100, 102 (1917) (“The word property as applied to trademarks and trade secrets is an un[-]analyzed expression of certain secondary consequences of the primary fact that the law makes some rudimentary requirements of good faith.”).

<sup>67</sup> *Int’l News Serv.*, 248 U.S. at 252 (Brandeis, J., dissenting) (citing *Dr. Miles Medical Co v. Park & Sons Co.*, 220 U.S. 373, 402 (1911)) (“Anyone may use it who fairly, by analysis and experiment, discovers it. But the complainant is entitled to be protected against invasion of its right in the process by fraud or by breach of trust or contract”); *see also id.* at 257–58, 262–63.

<sup>68</sup> 499 U.S. at 340.

<sup>69</sup> *Id.* at 354 (emphasis added).

<sup>70</sup> *See* Madow, *supra* note 11, at 174.

Nimmer's endorsement, the right of publicity began to win some judicial recognition and acceptance.<sup>71</sup> But it was not until the Supreme Court endorsed the infant right did it win widespread judicial and scholarly approval.<sup>72</sup>

### C. Supreme Court Support for the Right of Publicity

Twenty years after *Halean*, in an anomalous right of publicity case involving the unauthorized broadcast of an actual performance,<sup>73</sup> the U.S. Supreme Court crafted a copyright-like "incentive-public benefit" justification for the right of publicity. While, to this day, *Zacchini v. Scripps-Howard Broadcasting Co.* is the only Supreme Court decision to directly address the right of publicity, as discussed below,<sup>74</sup> the Supreme Court in 1987 also gave implicit support for publicity right-like legal protection in *San Francisco Arts & Athletics v. United States Olympic Committee*.<sup>75</sup>

#### i. Supreme Court Approval of Performance-Based Publicity Rights

In *Zacchini*,<sup>76</sup> the performer of a human cannonball act sued a television station for videotaping and broadcasting his

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<sup>71</sup> *See id.*

<sup>72</sup> *See id.* at 177. For instance, Dean Prosser included the "appropriation, for the defendant's advantage, of the plaintiff's name or likeness" claim as one of the four "privacy" torts. *See* William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960).

<sup>73</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

<sup>74</sup> *See infra* Part II.C.i.

<sup>75</sup> 483 U.S. 522 (1987).

<sup>76</sup> *Zacchini*, 433 U.S. at 562.

daredevil cannonball performance without his consent.<sup>77</sup> The film clip, about fifteen seconds in length, was shown on the eleven o'clock news program with favorable commentary about the uniqueness of Zacchini's spectacular performance.<sup>78</sup> Like the trial court below, the Ohio Supreme Court ultimately held that the press, when reporting on matters of public concern, "must be held privileged when an individual seeks to publicly exploit his talents while keeping the benefits private."<sup>79</sup>

Reversing the Ohio Supreme Court and ruling in favor of Zacchini, the U.S. Supreme Court held that the television station violated Zacchini's right of publicity by filming and broadcasting the performer's cannonball act without his authorization.<sup>80</sup> The Court reasoned that the broadcast of Zacchini's entire act posed a substantial threat to the economic value of that performance—and by extension Zacchini's ability to earn a living as an entertainer—because if the public could

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<sup>77</sup> *Id.* at 564. In his act at the county fair, Zacchini was shot from a cannon into a net some 200 feet away. *Id.* at 563. Every performance lasted fifteen seconds. *Id.* Members of the public attending the fair were not charged a separate admission fee to observe the Zacchini act, although he performed in a fenced area, surrounded by the grandstands at the fairgrounds. *Id.* A freelance reporter for Scripps-Howard Broadcasting Company, intending to record Zacchini's act, attended the Geauga County Fair carrying a small camera. *Id.* Zacchini noticed the reporter and asked him not to film the performance. *Id.* at 564. Per the instructions of his producer, however, the reporter returned to the fair on the next day and videotaped Zacchini's entire act. *Id.*

<sup>78</sup> *Id.* at 563.

<sup>79</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 351 N.E.2d 454, 461 (Ohio 1976). Notably, the Ohio Supreme Court relied upon *N.Y. Times Co. v. Sullivan*, 376 U.S. 254 (1964) for its privilege of the press concept. *Zacchini*, 433 U.S. at 562.

<sup>80</sup> *Zacchini*, 433 U.S. at 579.



view the act free on television, they would be disinclined to pay to see the act at the fair.<sup>81</sup> The Court reasoned that “the State’s interest in permitting a ‘right of publicity’ is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment”<sup>82</sup> and that the rationale for protecting it is “the straightforward one of preventing unjust enrichment by the theft of good will.”<sup>83</sup> “No social purpose is served,” the Court maintained, “by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.”<sup>84</sup> The Court rejected the notion that federal copyright or patent law preempted this type of state law protection of intellectual property: “[Copyright and patent] laws perhaps regard the ‘reward to the owner [as] a secondary consideration,’ but they were ‘intended definitely to grant valuable, enforceable rights’ in order to afford greater encouragement to the production of works of benefit to the public. The Constitution does not prevent Ohio from making a similar choice here in deciding to protect the entertainer’s incentive in order to encourage the production of this type of work.”<sup>85</sup> The *Zacchini* Court went beyond both Judge Franks and Professor Nimmer in recognizing (or providing) a persuasive justification for the right of publicity: while Judge Franks focused on value and Professor Nimmer relied upon labor, the *Zacchini* Court stressed Zacchini’s performance and the seemingly necessary

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<sup>81</sup> *Id.* at 576. The Court in fact observed that “the State’s interest is closely analogous to the goals of patent and copyright law.” *Id.* at 573.

<sup>82</sup> *Id.*

<sup>83</sup> *Id.* at 576. Similar to Nimmer’s argument, the Court found that Zacchini’s act “is the product of [Zacchini’s] own talents and energy, the end result of much time, effort, and expense.” *Id.* at 575.

<sup>84</sup> *Id.* at 576.

<sup>85</sup> *Id.* at 577 (citations omitted).

incentive for the creation thereof as the underlying public policy that publicity rights law purportedly promoted and protected.<sup>86</sup>

Additionally, the *Zacchini* Court held that the First Amendment did not shield the television news organization.<sup>87</sup> In rejecting the contention that the First and Fourteenth Amendments immunized news media from violation of *Zacchini*'s state-law right of publicity, the Court noted that the state's interest in permitting a "right of publicity" is closely analogous to the goals of patent and copyright laws and should be similarly protected.<sup>88</sup>

It must be pointed out, however, that the Court in *Zacchini* emphasized that "the broadcast of [*Zacchini*'s] entire performance, *unlike the unauthorized use of another's name for purposes of trade . . .*, goes to the heart of [*Zacchini*'s] ability to earn a living as an entertainer."<sup>89</sup> The Court cited *Ettore v. Philco Television Broadcasting Corp.*<sup>90</sup> to distinguish *Halaen* from other kinds of "right of publicity" claims, which

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<sup>86</sup> *Id.* at 576 ("[The] decision to protect petitioner's right of publicity here rests on *more than a desire to compensate the performer for the time and effort invested in his act*; the protection provides an economic *incentive* for him to make the investment required to produce a performance of *interest to the public*. This same consideration underlies the patent and copyright laws long enforced by this Court." (emphasis added)).

<sup>87</sup> *Id.* at 578–79 ("We conclude that although the State of Ohio may as a matter of its own law privilege the press in the circumstances of this case, the First and Fourteenth Amendments do not require it to do so.").

<sup>88</sup> *Id.* at 573, 575 ("The Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner.").

<sup>89</sup> *Id.* at 576 (emphasis added).

<sup>90</sup> 229 F.2d 481 (3d Cir. 1955).

the Court implied merited less protection.<sup>91</sup> In fact, the *Zacchini* Court explicitly stated that the “[p]etitioner does not *merely* assert that some general use, such as advertising, was made of his name or likeness; he relies on the *much narrower claim* that respondent televised an entire act that he ordinarily gets paid to perform.”<sup>92</sup> The dissent highlighted the narrow nature of the majority’s holding when it stated, “[d]isclaiming any attempt to do more than decide the narrow case before us, the Court reverses the decision of the Supreme Court of Ohio based on repeated incantation of a single formula: ‘a performer’s entire act.’”<sup>93</sup> Indeed, the appropriation of *Zacchini’s performance* seemed absolutely crucial to the Court’s analysis.

As much as *Zacchini* endorsed a performance-based “right of publicity” claim, therefore, it seemed to just as

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<sup>91</sup> *Id.* at 486 (“[T]here are, speaking very generally, two polar types of cases. One arises when some accidental occurrence rends the veil of obscurity surrounding an average person and makes him, arguably, newsworthy. The other type involves the appropriation of the performance or production of a professional performer or entrepreneur. Between the two extremes are many gradations, most involving strictly commercial exploitation of some aspect of an individual’s personality, such as his name or picture.”).

<sup>92</sup> *Zacchini*, 433 U.S. at 574 n.10 (emphasis added) (“It should be noted, however, that the case before us is *more limited* than the broad category of lawsuits that may arise under the heading of ‘appropriation.’” (emphasis added)); *see also* Volokh, *supra* note 7, at 906 (“*Zacchini* focused only on the unusual right of publicity scenario where a defendant broadcasts the plaintiff’s entire act . . . . The Court twice stressed that it was *not* deciding the broader question of when a plaintiff may sue the defendant for using plaintiff’s name, likeness, or other attributes of identity—the standard right of publicity claim.” (emphasis in original)).

<sup>93</sup> *Zacchini*, 433 U.S. at 579 (Powell, J., dissenting).

equally disparage an identity-based “right of publicity” claim.<sup>94</sup> Moreover, the Court’s intellectual property incentive framework—which worked well for individuals like Zacchini whose livelihood as a performer directly relied upon the commercial control of his performances—was far more dubious when applied to the commercial appropriation of mere personas.<sup>95</sup> Whereas performance-based publicity rights protection followed the patent and copyright “incentive-public benefit” framework endorsed by the Intellectual Property Clause of the Constitution,<sup>96</sup> persona-based protection seemed to fall back on Nimmer’s labor-desert theory or Frank’s value-ownership theory.<sup>97</sup> Nevertheless, lower courts subsequently imported *Zacchini*’s incentive-based rationale to justify protecting the “weaker” right of publicity claim or “the unauthorized commercial appropriation of an individual’s name or likeness.”<sup>98</sup>

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<sup>94</sup> *See id.* at 576 (“[I]n this case, Ohio has recognized what may be the strongest case for a ‘right of publicity’ involving, not the appropriation of an entertainer’s reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.”).

<sup>95</sup> *See id.* The Court again cited *Ettore v. Philco Television Broad. Corp.*, 229 F.2d 481 (3d Cir. 1955), explaining, that “[t]he fact is that, if a performer performs for hire, a curtailment, without consideration, of his right to control his performance is a wrong to him [as] [s]uch a wrong vitally affects his livelihood, precisely as a trade libel, for example, affects the earnings of a corporation.” *Id.* at 575 n.9 (quoting *Ettore*, 229 F.2d at 490).

<sup>96</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>97</sup> *See Madow, supra* note 11, at 182–205.

<sup>98</sup> *Id.* at 208 n.395 (“[C]ourts and commentators . . . have repeatedly cited the Supreme Court’s opinion in *Zacchini* as authority for the assertion that the right of publicity, like copyright, is justified as an economic incentive to creation and achievement.”).

## ii. Supreme Court Support for Symbol-Based Publicity Rights

A decade after *Zachinni*, the U.S. Supreme Court finally provided some implicit precedential support for nonperformance right of publicity claims in *San Francisco Arts & Athletics v. United States Olympic Committee*.<sup>99</sup> In this case, the Supreme Court addressed a Congressional statute that gave publicity rights-like protection to the United States Olympic Committee (USOC) to prohibit certain commercial and promotional uses of the word “Olympic.”<sup>100</sup> In upholding the constitutionality of the statute and dismissing the challenger’s First Amendment argument, the Court found that the statute served a “significant governmental interest” and was “well within constitutional bounds.”<sup>101</sup> The Court’s analysis is instructive.

First, the *San Francisco Arts* Court found that Congress’s grant to the USOC of the exclusive rights to the commercial exploitation of the word “Olympic” served an important governmental interest. Initially pointing out that the “commercial and promotional value of the word ‘Olympic’ was the product of the USOC’s ‘own talents and energy, the end

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<sup>99</sup> 483 U.S. 522 (1987).

<sup>100</sup> *Id.* at 525. The Congressional statute at issue bears a striking resemblance to several “right of publicity” statutes, in that it “did not require the use to be confusing” and instead invoked the “right of publicity” language “for the purpose of trade.” *Id.* at 530. Furthermore, because the “language and legislative history” of the statute “indicate[d] clearly that Congress intended to grant the USOC exclusive use of the word ‘Olympic’ without regard to whether use of the word tends to cause confusion,” the SFAA could not rely on the “defenses available under the Lanham Act.” *Id.*

<sup>101</sup> *Id.* at 532.

result of much time, effort, and expense,”<sup>102</sup> the Court emphasized also that the USOC’s efforts achieved the “broader public interest” of “promot[ing] the development of those physical and moral qualities which are the basis of sport,” “educat[ing] young people through sport in a spirit of better understanding between each other and of friendship, thereby helping to build a better and more peaceful world,” and “spread[ing] the Olympic principles throughout the world, thereby creating international goodwill.”<sup>103</sup> The Court found that the statute “directly advance[d]” these important governmental interests “by supplying the USOC with the means to raise money to support the Olympics and encourages the USOC’s activities by ensuring that it will receive the benefits of its efforts.”<sup>104</sup> San Francisco Arts & Athletics’ (SFAA) unauthorized use of the word, the Court maintained, “undercut the USOC’s efforts to use, and sell the right to use, the word in the future, since much of the word’s value comes from its limited use.”<sup>105</sup>

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<sup>102</sup> *Id.* at 532–33 (quoting *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575 (1977)).

<sup>103</sup> *Id.* at 537 (quoting United States Olympic Committee (USOC), Olympic Charter, Rule 24(B)). The connection of labor to other important public policy benefits distinguishes *Zachinni’s* and *San Francisco Art’s* reasoning from *Nimmer’s* naked “labor-desert” argument.

<sup>104</sup> *Id.* at 538–39. It can be argued that unlike normal publicity rights, the protection of the word “Olympic” directly served a unanimous public interest (the Olympics) and was vital to achieving that interest (raising money for the United States Olympic team).

<sup>105</sup> *Id.* at 539 (citing Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 825 (1927) (“[O]ne injury to a trademark owner may be ‘the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name’ by nonconfusing uses.”)). In fact, the Court specifically stated that such unauthorized commercial exploitation had “adverse effect[s] on the USOC’s activities” and was

Second, the *San Francisco Arts* Court found that congressional protection of the word “Olympic” did not violate the First Amendment. Addressing the challenger’s First Amendment defense, the Court found that the statute’s restrictions on expressive speech were merely “incidental to the primary Congressional purpose of encouraging and rewarding the USOC’s activities,” and that there was no “realistic danger that the statute itself [would] significantly compromise recognized First Amendment protections of parties not before the Court.”<sup>106</sup> “By prohibiting the use of one word for particular purposes,” the Court maintained, “neither Congress nor the USOC ha[d] prohibited the SFAA from conveying its message.”<sup>107</sup> Although the Court recognized that words are “not always fungible” and that the suppression of particular words “run[s] a substantial risk of suppressing ideas in the process,” the Court maintained that this fact “always has been balanced against the principle that when a word acquires value ‘as the result of organization and the expenditure of labor, skill, and money’ by an entity, that entity constitutionally may obtain a *limited* property right in the word.”<sup>108</sup> The Court reasoned

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“directly contrary to Congress’ interest.” *Id.* Interestingly, even though the SFAA was a nonprofit organization and its athletic event was not organized for the primary purpose of commercial gain, the Court held that its use of the word “Olympic” was nevertheless commercial because the appropriate question was “not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the [protected] material without paying the customary price.” *Id.* at 541 n.19 (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985)). In other words, in determining commerciality, the Court focused on the economic gain in using the word (akin to copyright law) instead of merely the context in which it was used (akin to trademark law).

<sup>106</sup> *Id.* at 537 n.15.

<sup>107</sup> *Id.* at 536.

<sup>108</sup> *Id.* at 532 (emphasis added) (citing *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 239 (1918)).

that “[t]he image the SFAA sought to invoke was exactly the image carefully cultivated by the USOC” and that “[t]he SFAA’s expressive use of the word cannot be divorced from the value the USOC’s efforts have given to it.”<sup>109</sup> The “mere fact that the SFAA claimed an expressive, as opposed to a purely commercial, purpose [did] not give it a First Amendment right to ‘appropriat[e] to itself the harvest of those who have sown.’”<sup>110</sup> Lastly, the Court found that the statute’s speech restrictions were “not broader than Congress reasonably could have determined to be necessary to further [the governmental] interests” and therefore did not violate the First Amendment.<sup>111</sup>

### iii. The Supreme Court’s First Amendment Doctrine for Intellectual Property

Implicit in the Supreme Court’s First Amendment analyses in both *Zacchini* and *San Francisco Arts* (as well as intellectual property cases in general) is the Court’s Secondary Effects doctrine.<sup>112</sup> This First Amendment framework holds

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<sup>109</sup> *Id.* at 540–41.

<sup>110</sup> *Id.* at 541 (quoting *Int’l News*, 248 U.S. at 239–40).

<sup>111</sup> *Id.* at 539.

<sup>112</sup> See Eugene Volokh, *Content Discrimination and the First Amendment (Including the “Secondary Effects” Doctrine)*, THE VOLOKH CONSPIRACY (June 21, 2010, 12:36 PM), <http://www.volokh.com/2010/06/21/content-discrimination-and-the-first-amendment-including-the-secondary-effects-doctrine>. The “Secondary Effects” doctrine is one of four jurisprudential approaches the Supreme Court has taken in scrutinizing content-neutral (such as time, place, manner) speech regulations. *Id.* In analyzing intangible property, the Court—although never explicitly—has used an amalgamation of these four doctrines. This makes perfect sense because intangible property-based speech regulations are not adopted by legislatures “because of disagreement with the message [such speech] conveys,” see, e.g., *Hill v. Colorado*, 530



that when a law regulates the content-neutral “secondary effects” of speech, that law will survive constitutional scrutiny if it is “narrowly tailored to serve the government’s legitimate, content-neutral interests”<sup>113</sup> and it “leave[s] open ample

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U.S. 703, 719 (2000), but are designed to protect against the speech’s “non-communicative impact” on individuals’ private property, *see, e.g.*, *Texas v. Johnson*, 491 U.S. 397, 411 (1989), and are “applicable to all speech irrespective of content.” *Consol. Edison Co. v. Pub. Serv. Comm’n*, 447 U.S. 530, 536 (1980); *see City of Renton v. Playtime Theatres, Inc.*, 475 U.S. 41, 46–47 (1986) (upholding zoning ordinance prohibiting adult theatres from locating within 1,000 feet from certain residential-zoned areas); *Heffron v. Int’l Soc’y for Krishna Consciousness, Inc.*, 452 U.S. 640 (1981) (upholding a state fair restriction on selling or distributing merchandise without a license); *Police Dep’t v. Mosley*, 408 U.S. 92, 98 (1972) (pointing out that the Supreme Court has “continually recognized that reasonable ‘time, place and manner’ regulations of picketing may be necessary to further significant governmental interests”); *Tinker v. Des Moines Indep. Sch. Dist.*, 393 U.S. 503 (1969) (explaining that while the First Amendment protected the wearing of black armbands in school to symbolically protest the Vietnam war, it would not protect such dress if it caused a substantial disruption); *Adderley v. Florida*, 385 U.S. 39, 46–48 (1966) (same); *Cox v. Louisiana*, 379 U.S. 559 (1965) (same); *Poulos v. New Hampshire*, 345 U.S. 395, 398 (1953) (same).

Restrictions on “commercial speech” rely on a similar doctrine wherein such restrictions must serve a “substantial government interest,” must “be designed carefully to achieve the State’s goal,” and implicitly must leave open all noncommercial channels of communication. *Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 564 (1980); *see also San Francisco Arts*, 483 U.S. at 535 (1987) (“Both [the *Central Hudson*] test and the test for a time, place, or manner restriction . . . require a balance between the governmental interest and the magnitude of the speech restriction.”).

<sup>113</sup> *Ward v. Rock Against Racism*, 491 U.S. 781, 797 (1989). The Court has many times held that the protection of private property is an important content-neutral government interest that only “incidentally” restricts free expression and the free flow of information. *See, e.g., San Francisco Arts*, 483 U.S. at 539. This makes perfect sense because while spray-painting tear

alternative channels for communication of the information.”<sup>114</sup>  
The particular regulation, however, “need not be the least restrictive or least intrusive means of doing so.”<sup>115</sup>

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drops on the Statue of Liberty may be the most effective way of expressing one’s thoughts or opinion on the state of liberty in the United States, an individual cannot simply hide behind the First Amendment to avoid punishment for the desecration or destruction of public (or private) property. Nor can a violinist steal another person’s Stradivarius violin simply because playing the unique instrument will better help him express his message. Indeed, courts have consistently recognized that the First Amendment is not a license to trample over the property rights of others. *See id.* at 537 (citing *Int’l News*, 248 U.S. at 239–40 (“The mere fact that the SFAA claimed an expressive, as opposed to a purely commercial, purpose [did] not give it a First Amendment right to appropriat[e] to itself the harvest of those who have sown.”)); *Anheuser-Busch, Inc. v. Balducci Publ’ns, Inc.*, 28 F.3d 769, 775 (8th Cir. 1994) (“Balducci argues it has an absolute First Amendment right to use plaintiff’s trademarks in its parody. No such absolute right exists.”); *Silverman v. CBS, Inc.*, 870 F.2d 40, 49 (2d Cir. 1989), *cert. denied*, 492 U.S. 907 (1989) (holding that “[t]rademark protection is not lost simply because the allegedly infringing use is in connection with a work of artistic expression”); *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1188 (5th Cir. 1978) (“The [F]irst [A]mendment is not a license to trammel on legally recognized rights in intellectual property.”).

<sup>114</sup> *Ward*, 491 U.S. at 791 (quoting *Clark v. Cmty. for Creative Non-Violence*, 468 U.S. 288, 293 (1984)); *see also Renton*, 475 U.S. at 47 (applying the much less demanding “do not unreasonably limit alternative avenues of communication” standard).

<sup>115</sup> *Ward*, 491 U.S. at 781, 789–90, 798, 800 (holding that the lower court “erred in requiring the city to prove that its regulation was the least intrusive means of furthering its legitimate governmental interests” because all that is required is that “the means chosen are not substantially broader than necessary to achieve the government’s interest”). Nevertheless, the “[g]overnment may not regulate expression in such a manner that a substantial portion of the burden on speech does not serve to advance its goals.” *Id.* at 790 (citation omitted). “So long as the means chosen are not substantially broader than necessary to achieve the government’s interest,

Quite fittingly, most cases utilizing the Secondary Effects doctrine involve the balancing of private property rights against First Amendment claims. In these cases, the Court has recognized the important government interest of protecting an individual's right to use and enjoy her private property<sup>116</sup> and has ultimately upheld countless laws incidentally restricting others' expression.<sup>117</sup> In the context and to the degree that the law treats intellectual property as "property,"<sup>118</sup> the Court's

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however, the regulation will not be invalid simply because a court concludes that the government's interest could be adequately served by some less-speech-restrictive alternative." *Id.* at 800.

<sup>116</sup> See *Frisby v. Schultz*, 487 U.S. 474 (1988) (upholding ordinance prohibiting picketing "before or about" any residence or dwelling); *Hudgens v. NLRB*, 424 U.S. 507 (1976) (holding that the First Amendment did not require a privately owned shopping center to permit picketing on its premises because the right to own private property encompassed the right to prohibit unwanted speech); *Grayned v. City of Rockford*, 408 U.S. 104 (1972) (sustaining ordinance prohibiting noisemaking adjacent to school if that noise disturbs or threatens to disturb the operation of the school); *Brown v. Louisiana*, 383 U.S. 131 (1966) (explaining that silent vigils in public libraries are protected by the First Amendment while noisy and disruptive demonstrations would not be); *Kovacs v. Cooper*, 336 U.S. 77 (1949) (sustaining state law forbidding sound trucks in residential neighborhoods); *Cox v. New Hampshire*, 312 U.S. 569, 575-76 (1941) (same); Mark Cordes, *Property and the First Amendment*, 31 U. RICH. L. REV. 1, 4-5 (1997) ("The Court has also recognized that, apart from the right to exclude, property owners have the right to be free from unreasonable speech intrusions that interfere with the quiet enjoyment of property.").

<sup>117</sup> See, e.g., *Harper & Row Publishers v. Nation Enters.*, 471 U.S. 539 (1985); *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir.1978); *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 361 (9th Cir. 1947); *Steinberg v. Columbia Pictures Indus., Inc.*, 663 F. Supp. 706 (S.D.N.Y. 1987).

<sup>118</sup> Because the Intellectual Property Clause gives to individuals "exclusive rights" to achieve a particular objective, and because the right to exclude is the most fundamental right of property, see, e.g., *Loretta v. Teleprompter*

First Amendment analysis has implicitly followed the same reasoning: It permits the reasonable protection of the property interest at stake while incidentally inhibiting others' expression but leaves open ample channels of expression.<sup>119</sup> The one important difference between ordinary property and intellectual property is that the protection of ordinary property under the Constitution is inherently justified<sup>120</sup> whereas the protection of intellectual property is justified only insofar as it achieves an important public purpose.<sup>121</sup> In protecting both corporeal and

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Manhattan CATV Corp., 458 U.S. 419, 433 (1982) (recognizing right to exclude others as one of the most essential sticks in bundle of property rights); ROGER A. CUNNINGHAM ET AL., *THE LAW OF PROPERTY* § 7.1 (1984) (“[T]he right physically to exclude others is the most nearly absolute of the many property rights that flow from the ownership . . . of land.”), intellectual material is only “property” insofar as it achieves that particular policy objective). See Justin Hughes, *The Philosophy of Intellectual Property*, 77 *GEO. L.J.* 287, 295–96 (1988) (pointing out that even “the most extraordinary ideas or discoveries are . . . beyond the ken of legal protection: the calculus, the Pythagorean theorem, the idea of a fictional two-person romance, the cylindrical architectural column, or a simple algorithm”).

<sup>119</sup> See *Walt Disney Prods. v. Air Pirates*, 345 F. Supp. 108, 115 (N.D. Cal. 1972) (stating that, in the context of limiting speech to protect a copyright, “[i]t can scarcely be maintained that there is *no* other means available to defendants to convey the message” (emphasis in original)).

<sup>120</sup> See *Chicago, Burlington & Quincy R.R. Co. v. City of Chicago*, 166 U.S. 226, 235–36 (1897) (“Due protection of the rights of property has been regarded as a vital principle of republican institutions.”); *Appeal of Ervine*, 16 Pa. 256, 264 (1851) (“The great principle is, that a man’s property is his own, and that he shall enjoy it according to his pleasure (injuring no other man) until it is proved in a due process of law that it is not his, but belongs to another.”); Norman Karlin, *Back to the Future: From Nollan to Lochner*, 17 *SW. U. L. REV.* 627, 638 (1988) (discussing the preconstitutional importance of private property).

<sup>121</sup> See Corey Brettschneider, *Public Justification and the Right to Private Property: Welfare Rights as Compensation for Exclusion*, 6 *LAW & ETHICS HUM. RTS.* 120, 128 (2012) (recognizing that “private property, and in

intellectual property, however, the law's restrictions on speech must be narrowly tailored to serve an important government interests<sup>122</sup> and leave open ample alternative channels for the

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particular the right to exclude, requires public justification"). In the context of intellectual property, restrictions on speech serve the important, content-neutral interests of advancing knowledge, *see, e.g.*, *Golan v. Holder*, 132 S. Ct. 873, 888 (2012) (explaining that the "Progress of Science" broadly refers to "the creation and spread of knowledge and learning" (citation omitted) (internal quotation marks omitted)); *CCC Info. Servs. v. MacLean Hunter Mkt. Reports*, 44 F.3d 61, 65 (2d Cir. 1994) ("The fundamental principle of copyright, as expressed in the Copyright Clause of the Constitution, is to promote the advance of knowledge . . ."); furthering innovation, *see, e.g.*, *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 481 (1974) ("When a patent is granted and the information contained in it is circulated to the general public and those especially skilled in the trade, such additions to the general store of knowledge are of such importance to the public weal that the Federal Government is willing to pay the high price of 17 years of exclusive use for its disclosure, which disclosure, it is assumed, will stimulate ideas and the eventual development of further significant advances in the art."); protecting consumers and maintaining the quality of goods and services, *see Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995) ("In principle, trademark law, by preventing others from copying a source-identifying mark, 'reduce[s] the customer's costs of shopping and making purchasing decisions . . . [and] encourage[s] the production of quality products.'" (citation omitted)); and, promoting commercial fairness and encouraging research and development, *see, e.g., Kewanee Oil Co.*, 416 U.S. at 482 (recognizing the goals of trade secret law as the "maintenance of standards of commercial ethics and the encouragement of invention" and "increas[ing] economic efficiency within large companies through the dispersion of responsibilities for creative developments").

<sup>122</sup> Copyright protection, for example, is narrowly tailored because it grants to the author only the exclusive right to his or her *original contribution*. *See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 340 (1991) ("To qualify for copyright protection, a work must be original to the author."). Moreover, copyright protection only lasts for a limited time. *See U.S. CONST. art. I, § 8, cl. 8* (authorizing Congress to "secure for limited Times

communication of information.<sup>123</sup> Under this First Amendment doctrine, therefore, others' expression will be necessarily but *constitutionally* limited by legal restrictions pertaining to the commercial exploitation of others' original works of authorship, patented designs, confusingly similar trademarks or service marks, and other names, likenesses, or personas.<sup>124</sup>

Not coincidentally, the Supreme Court's First Amendment discussion in both *Zacchini* and *San Francisco Arts* very clearly center on the Secondary Effects doctrine.<sup>125</sup>

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to Authors . . . the exclusive Right to their respective Writings"); 17 U.S.C. § 101 (2012).

<sup>123</sup> For example, copyright law protects only against others' commercial exploitation of the copyright work—all noncommercial exploitive uses are permitted. For this reason, copyright law's fair use law recognizes such noncommercially exploitive uses, like research. *See* 17 U.S.C. § 107. Lastly, copyright law leaves open ample alternative channels of communication for that information. Through copyright law's limitation of an author's exclusive right to only the "commercial exploitation" of his or her original contribution, all noncommercially exploitive uses remain open.

<sup>124</sup> *See, e.g., Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003) ("Protection of [an author's original expression from unrestricted exploitation] does not raise the free speech concerns present when the government compels or burdens the communication of particular facts or ideas."); Cordes, *supra* note 116, at 64 (1997) (recognizing that through the Court's jurisprudence "a private property owner's right to exclude limits most First Amendment activity"); Richard A. Epstein, *Liberty Versus Property? Cracks in the Foundations of Copyright Law*, 42 SAN DIEGO L. REV. 1, 23 (2005) (recognizing that "the clear conflict between copyright and freedom of speech, . . . in its essential form, is analogous to the conflict between liberty of movement and the trespass laws").

<sup>125</sup> *See San Francisco Arts & Athletics v. U.S. Olympic Comm.*, 483 U.S. 522, 537 n.16 (1987) ("A restriction on nonmisleading commercial speech may be justified if the government's interest in the restriction is substantial, directly advances the government's asserted interest, and is no more extensive than necessary to serve the interest.") (citing *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 566 (1980)).

In *Zacchini*, the Court found that, although the television station's speech was restricted, protection against the appropriation of Zacchini's cannonball performance served the important content-neutral government interest of preserving a "valuable, enforceable right[] in order to afford greater encouragement to the production of works of benefit to the public."<sup>126</sup> Furthermore, the Court implicitly found, by citing to several copyright cases, that such a restriction was narrowly tailored to serve the above-described government interests<sup>127</sup> and left open ample alternative channels for the communication of the information.<sup>128</sup>

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<sup>126</sup> *Zacchini v. Scripps Howard Broad. Co.*, 433 U.S. 562, 576 (citation omitted) ("[The] decision to protect petitioner's right of publicity here rests on *more than a desire to compensate the performer for the time and effort invested in his act*; the protection provides an economic incentive for him to make the investment required to produce a performance of *interest to the public*. This same consideration underlies the patent and copyright laws long enforced by this Court." (emphasis added)). "The Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner." *Id.* at 575.

<sup>127</sup> The Court pointed out that the Ohio statute's protection of Zacchini's performance was narrowly tailored to protect only against commercial exploitation. *See id.* at 578 ("But it is important to note that neither the public nor respondent will be deprived of the benefit of petitioner's performance as long as his commercial stake in his act is appropriately recognized."). "The fact, is that, if a performer performs for hire, a curtailment, without consideration, of his right to control his performance is a wrong to him . . . [s]uch a wrong vitally affects his livelihood." *Id.* at 572 n.9.

<sup>128</sup> *See id.* at 577 n.13 (citing *Walt Disney Prods. v. Air Pirates*, 345 F. Supp. 108, 115 (N.D. Cal. 1972) ("[I]t can scarcely be maintained that there is *no* other means available to defendants to convey the message . . . ." (emphasis in original))).

Likewise, in *San Francisco Arts*, the Supreme Court found that although the nonprofit appellant's speech was certainly restricted to some extent by Congress's publicity rights-like statute,<sup>129</sup> such legislation served the important content-neutral government interests of "promot[ing] the development of those physical and moral qualities which are the basis of sport," "educat[ing] young people through sport in a spirit of better understanding between each other and of friendship, thereby helping to build a better and more peaceful world," and "spread[ing] the Olympic principles throughout the world, thereby creating international goodwill."<sup>130</sup> The Court also found that the statute was narrowly tailored to serve the government's legitimate, content-neutral interests, because it "directly advance[d]" those interests "by supplying the USOC with the means to raise money to support the Olympics" and "by ensuring that it will receive the benefits of its efforts."<sup>131</sup> Lastly, the Court found that the statute left open ample alternative channels of communication, explaining that "[b]y prohibiting the use of one word for *particular purposes*, neither

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<sup>129</sup> *San Francisco Arts*, 483 U.S. at 537 (recognizing that words are "not always fungible," and that the suppression of particular words "run[s] a substantial risk of suppressing ideas in the process"); *cf.* *Hustler Magazine v. Falwell*, 485 U.S. 46, 50 (1988) ("At the heart of the First Amendment is the recognition of the fundamental importance of the free flow of ideas and opinions on matters of public interest and concern.").

<sup>130</sup> *San Francisco Arts*, 483 U.S. at 538.

<sup>131</sup> *Id.* at 538–39. The application of the Act to th[e] commercial speech [was] not broader than necessary to protect the legitimate congressional interest." *Id.* at 540. The Court's characterization of *San Francisco Arts*' speech as "commercial speech" would most likely not hold up under the Court's modern "commercial speech" doctrine; nevertheless, if by "commercial speech" the Court meant expression that exploited the commercial value of the word "Olympic," then the Secondary Effects doctrine would demand such an analysis.



Congress nor the USOC ha[d] prohibited the SFAA from conveying its message.”<sup>132</sup>

In both *Zacchini* and *San Francisco Arts*, therefore, the Supreme Court found that the law at issue forwarded an important, content-neutral government interest, that the statute’s restrictions on speech were narrowly tailored, and that those restrictions left open ample alternative channels of communication of information. Consequently, after *Zacchini* and *San Francisco Arts*, protection against unauthorized commercial appropriation of a name or likeness—not just a performance—had at least implicit Supreme Court support. Furthermore, these two cases gave lower courts some much-needed (albeit poorly applied) guidance on how to apply the First Amendment to the right of publicity.

### III. *COMEDY III* AND CALIFORNIA CASE LAW

After the Supreme Court’s *Zachinni* decision not only recognized the right of publicity, but also provided explicit precedent for the doctrine’s incentive justification, the nascent intellectual property right gained widespread judicial recognition.<sup>133</sup> Several courts, California courts in particular, readily adopted *Zachinni*’s copyright-like incentive-based rationale.<sup>134</sup> In fact, the California Supreme Court ultimately

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<sup>132</sup> *Id.* at 536 (emphasis added). In fact, the *San Francisco Arts* Court specifically relied upon the time, plane, manner doctrine set forth in *United States v. O’Brien*, 391 U.S. 367 (1968). *See id.* at 536–37 (citing *O’Brien*, 391 U.S. at 377). The Court also blended into its discussion of time, place, and manner restrictions with the theory that “commercial speech” merits less First Amendment protection. *Id.*

<sup>133</sup> *See* Madow, *supra* note 11, at 177.

<sup>134</sup> *See, e.g.*, *Bi-Rite Enters, Inc. v. Bruce Miner Co.*, 757 F.2d 440, 444–45 (1st Cir. 1985); *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d

utilized this copyright analogy in building a publicity rights First Amendment balancing test around copyright law's fair use doctrine.<sup>135</sup> While the roots of this copyright-inspired First Amendment balancing test can be found in earlier California cases, such as *Lugosi v. Universal Pictures*<sup>136</sup> and *Guglielmi v. Spelling-Goldberg Productions*.<sup>137</sup> *Comedy III Productions v. Saderup*<sup>138</sup> is the seminal case explicitly outlining the comprehensive "transformative use" test.

### A. The Birth of the "Transformative Use" Test

*Comedy III* involved a right of publicity claim brought by the registered owner of the rights to the comedy act known as the "Three Stooges" against defendant artist Gary Sanderud for his sale of lithographic prints and t-shirts featuring charcoal drawings of the Three Stooges characters.<sup>139</sup> While acknowledging that publicity rights may often trump the right of advertisers in the contexts of misleading commercial speech<sup>140</sup> and nonmisleading commercial speech,<sup>141</sup> the California Supreme Court was not so easily sold in the context of "expressive works."<sup>142</sup> The Court consequently explored the

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831, 837 (6th Cir. 1983); *Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d 278, 287 (2d Cir. 1981) (Mansfield, J., dissenting); *Lugosi v. Universal Pictures*, 603 P.2d 425, 441 (Cal. 1979) (Bird, C.J., dissenting).

<sup>135</sup> See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807–09 (Cal. 2001).

<sup>136</sup> 603 P.2d at 448 (Bird, C.J., dissenting).

<sup>137</sup> 603 P.2d 454, 461 (Cal. 1979) (Bird, C.J., concurring).

<sup>138</sup> See *Comedy III*, 21 P.3d at 807–11.

<sup>139</sup> *Id.* at 800–01.

<sup>140</sup> *Id.* at 802 (citing *Cent. Hudson Gas & Elec. v. Pub. Serv. Comm'n*, 447 U.S. 557, 563–64 (1980)).

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

<sup>142</sup> *Id.* at 803.

tension between the right of publicity and the First Amendment, highlighting along the way the value of celebrities as cultural symbols,<sup>143</sup> the importance of art and entertainment as channels of self-expression,<sup>144</sup> as well as the “social utility” of publicity rights as a form of intellectual property.<sup>145</sup> While noting that the state’s interest in preventing the misappropriation of intellectual property is not automatically trumped by free expression,<sup>146</sup> the Court nevertheless stressed that such interests must be balanced according to the relative importance of the interests at stake.<sup>147</sup> Synthesizing a number of previous cases grappling with this seemingly unresolvable legal tension,<sup>148</sup> the Court drew a line

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<sup>143</sup> *Id.* at 802–03.

<sup>144</sup> *Id.* at 803.

<sup>145</sup> *Id.* at 804–05.

<sup>146</sup> *Id.* at 806 (“[T]he state’s interest in preventing the outright misappropriation of such intellectual property by others is not automatically trumped by the interest in free expression or dissemination of information . . .”).

<sup>147</sup> *Id.* (stating that “as in the case of defamation, the state law interest and the interest in free expression must be balanced, according to the relative importance of the interests at stake”). In its First Amendment analysis, the California Supreme Court inexplicably analogized to defamation law, even though the U.S. Supreme Court in *Zacchini* directly rejected this analogy. *See Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 572 (1977). (stressing that “[i]t is also abundantly clear that *Time, Inc. v. Hill* did not involve . . . any claim to a ‘right of publicity’” and stating that the differences between defamation and the right of publicity are “important” (internal citation omitted)). While defamation claims center upon the communicative impact of the speech as issue, right of publicity claims—like other intellectual property claims—focus on the noncommunicative impact of the speech. Thus, while the right of publicity triggers a form of intermediate judicial scrutiny in the form of the Secondary Effects doctrine, defamation claims must survive strict scrutiny.

<sup>148</sup> *See Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981); *Groucho Marx Prods., Inc. v. Day & Night Co.*, 523 F. Supp. 485 (S.D.N.Y.

of demarcation between “conventional, more or less fungible images”<sup>149</sup> of celebrities and expressive uses that “comment on, parody, lampoon, and make other expressive uses of the celebrity image.”<sup>150</sup>

In drawing this line, the California Supreme Court borrowed from copyright law’s fair use doctrine.<sup>151</sup> Specifically, the California Supreme Court cited the U.S. Supreme Court’s language in *Campbell v. Acuff-Rose Music, Inc.*,<sup>152</sup> which emphasized the importance of “whether and to what extent [a] work is ‘transformative.’”<sup>153</sup> As a result, the

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1981) (reversed on other grounds); *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 461 (Cal. 1979).

<sup>149</sup> *Comedy III*, 21 P.3d at 808.

<sup>150</sup> *Id.* at 807. Notice how the California Supreme Court subtly sneaks in the phrase “other expressive uses” to its list of “fair uses.” *Id.* The *Comedy III* court implies that it is importing this exemption from copyright law, but copyright law does not simply permit secondary artists to use an otherwise protected original work of authorship simply because their use is “expressive.” See *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 753 (9th Cir. 1978); *Bridgeman Art Library v. Corel Corp.*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999); *Grand Upright Music, Ltd v. Warner Bros. Records Inc.*, 780 F. Supp. 182 (S.D.N.Y. 1991). It should be pointed out, however, that the California Constitution recognizes greater First Amendment rights than does the United States Constitution. See *New Kids on the Block v. News Am. Publ’g, Inc.*, 745 F. Supp. 1540, 1545 n.7 (C.D. Cal. 1990) (“[T]he California Supreme Court has interpreted the California Constitution as providing greater protection to speech than does the First Amendment.”).

<sup>151</sup> *Comedy III*, 21 P.3d at 807–08. This factor seeks to analyze the “purpose and character of the use.” 17 U.S.C. § 107(1) (2012).

<sup>152</sup> 510 U.S. 569, 579 (1994).

<sup>153</sup> *Comedy III*, 21 P.3d at 808 (citing *Campbell*, 510 U.S. at 579 (stating that “[t]he central purpose of this investigation into this fair use factor is to see, in Justice Story’s words, whether the new work merely ‘supersede[s] the objects’ of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the

Court struck the balance as follows: “When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.” However, “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.”<sup>154</sup>

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new work is ‘transformative’” (citations omitted)). The court found that the “inquiry into whether a work is ‘transformative’ appears to us to be necessarily at the heart of any judicial attempt to square the right of publicity with the First Amendment.” *Id.* at 808. Because the right of publicity allegedly shares the same goal of “encouraging free expression and creativity” as copyright laws, the California Supreme Court concluded that the “‘transformative’ test . . . protect[ed] the right-of-publicity holder’s core interest in monopolizing the merchandising of celebrity images without unnecessarily impinging on the artists’ right of free expression.” *Id.* at 808 n.10. The court explained that “[w]hen the value of the work comes principally from some source other than the fame of the celebrity—from the creativity, skill, and reputation of the artist—it may be presumed that sufficient transformative elements are present to warrant First Amendment protection.” *Id.* at 810. Thus, the inquiry is “whether the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.” *Id.* at 809. Put another way, the focus of *Comedy III’s* “transformative use” test centers on “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.” *Id.* Consequently, “[t]he inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.” *Id.*

<sup>154</sup> *Id.* at 808. The *Comedy III* court’s claim that the more original expression an artist contributes to an otherwise protected work, the more the new work is worthy of First Amendment protection, is simply an incorrect interpretation of copyright-First Amendment law. Among the many faulty

Ultimately, the California Supreme Court held that Saderup's work lacked a "significant[ly] transformative or creative contribution" and therefore violated the Three Stooges'

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assumptions upon which this claim rests, the two most striking are: (1) different amounts of expression are entitled to different levels of First Amendment protection; and (2) adding original expression to otherwise protected intellectual property magically extinguishes the original intellectual property right. Both of these assumptions are clearly false. As the *Comedy III* court itself pointed out, "the United States Supreme Court has made it clear that a work of art is protected by the First Amendment even if it conveys no discernable message: '[A] narrow, succinctly articulable message is not a condition of constitutional protection, which if confined to expressions conveying a particularized message, would never reach the unquestionably shielded painting of Jackson Pollock, music of Arnold Schoenberg, or Jaberwocky verse of Lewis Carroll.'" *Id.* at 804 (quoting *Hurley v. Irish-Am. Gay, Lesbian and Bisexual Grp. of Bos., Inc.*, 515 U.S. 557, 569 (1995)). A lithographic drawing of an individual or individuals, therefore, is protected by the First Amendment just as much as a complex collage that merely includes that drawing among additional creative contributions. What the First Amendment does not protect is the piracy of another's property under the guise of free expression. *See Silverman v. CBS, Inc.*, 870 F.2d 40, 49 (2d Cir. 1989), *cert. denied*, 492 U.S. 907 (1989) (holding that "[t]rademark protection is not lost simply because the allegedly infringing use is in connection with a work of artistic expression"). Therefore, whenever a name or likeness is commercially exploited, the right of publicity's property right is triggered and the First Amendment does not offer safe harbor. This means that others cannot merely add their own original expression into or around the protected persona like a net in order to snatch up the otherwise protected and valuable property interest. Copyright law has made this point abundantly clear. *See, e.g., Peter Letterese & Assocs. v. World Inst. of Scientology Enters.*, 533 F.3d 1287, 1311 (11th Cir. 2008) (holding that a 1979 musical production of *Scarlett Fever*, though *certainly creative*, failed to reshape the instructional purpose or character of the work, but rather served to fulfill the same "overall function," and thus failed to qualify as transformative).

(Comedy III's) right of publicity.<sup>155</sup> Saderup's "undeniable skill [was] manifestly subordinated to the overall goal of

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<sup>155</sup> *Comedy III*, 21 P.3d at 811. The *Comedy III* court assumes also, incorrectly, that the addition of enough original creative expression will "transform" the original work (the persona) and that such a transformation will magically resolve the matter in full. *Id.* at 808 n.10 ("If it is determined that a work is worthy of First Amendment protection because added creative elements significantly transform the celebrity depiction, then independent inquiry into whether or not that work is cutting into the market for the celebrity's images . . . appears to be irrelevant."). This again is simply not true. As explained above, copyright law does not accommodate merely "additional original expression," even if it is substantial. Rather, copyright law accommodates additional original expression that "transforms" the *character* and *purpose* of the original work. In *Campbell*, 2 Live Crew's playful rap song was entirely different than the rock n' roll song, "Pretty Woman." The equivalent of this "transformative use" in publicity rights law would be if Gary Saderup used the Three Stooges' façades, added feathered cavalier hats, goatees, and other Spanish-like facial features in order to make the trio look exactly like the Three Musketeers (and not just the Three Stooges dressed as the Three Musketeers). This use would be "transformative" because the work no longer uses the personas for their identities or fame but rather uses them for an altogether different purpose—as a template for the Three Musketeers expression. But as long as an artist uses an individual's name or likeness for the purpose of expressing its inherent identity or commercially valuable persona, that use cannot be said to be "transformative." Only when the new use transforms the original work (or persona) into a different character, using it for a different purpose, does the independent inquiry into the effect of new use on the original's potential market or value become less relevant. That is because new uses that are different in character do not supplant the original's market. In contrast, new uses that merely commercially exploit the protected intellectual property in another way, or worse, in the same way, *do* supplant the market for the original persona, and the effect on the market inquiry is not only vitally important but is usually dispositive. Thus, if an artist appropriates a persona (the protected intellectual property) and commercially exploits the actual identity or commercial persona, the commercial inquiry is crucial.

creating literal, conventional depictions of The Three Stooges so as to exploit their fame.”<sup>156</sup>

### **B. Application of the “Transformative Use” Test**

Upon *Comedy III*'s shaky foundation, several states have built their right of publicity First Amendment balancing test. As the following case law from California and other jurisdictions will illustrate, the “transformative use” test lacks any semblance of a well-reasoned and reliable judicial analysis. Instead of promoting fairness and predictability, it nurtures preconceived policy preferences and promotes wild contradiction.

As noted above, the California Supreme Court in *Comedy III* rejected First Amendment protection for a marginally expressive, “non-transformative” celebrity depiction that directly violated the Three Stooges’ right of publicity.<sup>157</sup> After *Comedy III*, the crucial question was “what kind expression, and how much expression, was required to ‘transform’ a celebrity’s likeness?”<sup>158</sup> The next case to directly

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<sup>156</sup> *Id.* at 811.

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

<sup>158</sup> In a rather puzzling passage, the California Supreme Court attempted to distinguish the artwork of painter Andy Warhol: “[W]e do not hold that all reproductions of celebrity portraits are unprotected by the First Amendment. The silkscreens of Andy Warhol, for example, have as their subjects the images of such celebrities as Marilyn Monroe, Elizabeth Taylor, and Elvis Presley. Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself.” *Id.* at 811. How such First Amendment-protected “subtlety distorted” images could be



address<sup>159</sup> and deliberately apply California's "transformative use" test, *Winter v. DC Comics*,<sup>160</sup> attempted to answer this question. In *Winter*, an artist published a series of comic books featuring two characters who were quite obviously based on the musician brothers Edgar and Johnny Winter.<sup>161</sup> The comic

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distinguished from the kind of infringing depictions featured in Saderup's t-shirts was never explained.

<sup>159</sup> In *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1183 (9th Cir. 2001), the Ninth Circuit—applying California law—found that the unauthorized use of actor Dustin Hoffman's face on a computer-generated male body wearing a silk gown and high heels in a fashion magazine did not violate Hoffman's right of publicity. Even though "there was testimony that the Hollywood issue and the use of celebrities was intended in part to 'rev up' the magazine's profile," and although the magazine contained a "Shopper's Guide" in the back of the magazine that provided stores and prices for the shoes and gown, the Ninth Circuit nonetheless found that "the article as a whole [was] a combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors." *Id.* at 1185–86. Any commercial aspects, the court maintained, were "inextricably entwined" with expressive elements" to the extent that they could not be separated out "from the fully protected whole." *Id.* at 1185 (citing *Gaudiya Vaishnava Soc'y v. City & Cnty. of San Francisco*, 952 F.2d 1059, 1064 (9th Cir. 1990)). The Ninth Circuit further found that based on the *Comedy III* decision, "there is no question that LAM's publication of the 'Tootsie' photograph contained 'significant transformative elements.'" *Id.* at 1189 n.2 (emphasis added). Lastly, the Ninth Circuit maintained that the use of Hoffman's persona was transformative because "Hoffman's body was eliminated and a new, differently clothed body was substituted in its place." *Id.* Despite its seemingly sure-handed assertions, however, the Ninth Circuit later disavowed *Hoffman's* precedential authority in regard to California's transformative test. See *Hilton v. Hallmark*, 599 F.3d 894, 913 n.15 (9th Cir. 2010). Additionally, in *Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307, 315–16 (Cal. Ct. App. 2001), the court quickly glossed over the then recent *Comedy III* decision and instead relied heavily upon *Hoffman*.

<sup>160</sup> 69 P.3d 473 (Cal. 2003).

<sup>161</sup> *Id.* at 476.

book duo, called the “Autumn brothers” were villainous half-worm, half-human offspring who were “vile, depraved, stupid, cowardly, subhuman individuals [that] engage[d] in wanton acts of violence, murder and bestiality for pleasure.”<sup>162</sup> The court affirmed summary judgment in favor of the defendant, holding that the images were sufficiently transformative.<sup>163</sup> The *Winter* court stated that although the fictional characters Johnny and Edgar Autumn were “less-than-subtle evocations of Johnny and Edgar Winter” (they shared their same long white hair and albino features and one wore a similar hat), the plaintiffs were “merely part of the raw materials from which the comic books were synthesized . . . [into] a larger story, which is itself quite expressive.”<sup>164</sup>

Interestingly, the court seemed to emphasize the creative embellishments woven around the celebrity portrayals more than the portrayals themselves.<sup>165</sup> Although the court did find that the comic books depicted the Winter brothers as “fanciful, creative characters”<sup>166</sup> and that the characters were “distorted for purposes of lampoon, parody, or caricature,”<sup>167</sup> the court did not elaborate beyond these naked conclusions. Moreover, the court repeatedly emphasized the “larger story” around the characters, which the court described as “quite

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<sup>162</sup> *Id.* (internal quotation marks omitted).

<sup>163</sup> *Id.* at 479–80.

<sup>164</sup> *Id.* at 479.

<sup>165</sup> *See id.* (“We can readily ascertain that they are not just conventional depictions of plaintiffs but contain significant expressive content *other* than plaintiffs’ mere likenesses . . . [T]he Autumn brothers are but cartoon characters—half-human and half-worm—in a larger story, which is itself quite expressive.” (emphasis added)).

<sup>166</sup> *Id.* at 480.

<sup>167</sup> *Id.* at 479.

expressive.”<sup>168</sup> The *Winter* court also was correct in addressing the commercial market for plaintiffs’ personas; however, it did so in an incorrect manner, stating that “[t]he characters and their portrayals do not greatly threaten plaintiffs’ right of publicity . . . [as] [p]laintiffs’ fans who want to purchase pictures of them would find the drawings of the Autumn brothers unsatisfactory as a substitute for conventional depictions.”<sup>169</sup> While the *Winter* court failed to take into consideration the fact that nonliteral depictions still can directly undermine the market value for a particular personality,<sup>170</sup> the court at least considered the persona’s potential commercial market.

After *Winter*, California precedent seemed to suggest that commercial uses of a celebrity’s likeness were permissible if the appropriator added some creative expression into and around a conventional depiction.<sup>171</sup> Nevertheless, the exact quantity of additional expression required to “transform” an otherwise infringing celebrity depiction was still unclear. Seven years later, *Hilton v. Hallmark Cards*<sup>172</sup> provided some much-needed guidance. In *Hilton*, greeting card company Hallmark used the visage of Hilton hotel heiress and realty show celebrity Paris Hilton in a birthday card.<sup>173</sup> The card featured Hilton’s facial likeness superimposed, in an oversized manner, on a generic cartoon female body.<sup>174</sup> She was donned in a uniform reminiscent of an episode from her popular reality

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<sup>168</sup> *Id.*

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

<sup>170</sup> This fallacious line of reasoning was taken to the extreme in *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003).

<sup>171</sup> See *Winter*, 69 P.3d 479.

<sup>172</sup> See *Hilton v. Hallmark Cards*, 599 F.3d 894 (9th Cir. 2010).

<sup>173</sup> *Id.* at 899.

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

show *The Simple Life*, in which she was tasked with working as a waitress at a drive-thru fast food restaurant.<sup>175</sup> The card, in addition, prominently displayed Hilton's well-known catchphrase, "That's hot."<sup>176</sup>

The court, while noting the broad nature of the transformative use defense, nevertheless held that Hallmark's portrayal of Hilton violated her publicity rights.<sup>177</sup> Relying on the Supreme Court's statement in *Campbell v. Acuff-Rose Music, Inc.*<sup>178</sup> that parody is not presumptively a fair use, the court found that Hallmark's use of Hilton's likeness in its alleged "parody" was not sufficiently transformative to merit First Amendment protection.<sup>179</sup> Though there were some distinguishing characteristics between the card's portrayal and the episode—including Hilton's outfit, the type of restaurant at which she worked, and the "literal" use of the catchphrase to refer to a plate of hot food—the court concluded that these were not enough to transform the depiction of Hilton into a work primarily conveying Hallmark's own expression.<sup>180</sup> Ultimately, the court held that, despite Hallmark's added expression, the card (1) failed to transform the use of Hilton's likeness, (2) merely ripped off Hilton's reality show, and (3) simply "merchandis[ed] [Hilton's] image."<sup>181</sup> Indeed, the *Hilton* court's opinion seemed to suggest that the addition of merely generic expression, along with expression that merely "ripped off" the notoriety and achievements of the celebrity,

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

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

<sup>177</sup> *Id.* at 910

<sup>178</sup> 510 U.S. 569, 581 (1994).

<sup>179</sup> *Hilton*, 599 F.3d at 910 n.13.

<sup>180</sup> *Id.* at 911.

<sup>181</sup> *Id.* at 910–11.

was not sufficiently transformative to warrant First Amendment protection.<sup>182</sup> The Sixth Circuit's decision four years earlier in *ETW Corp. v. Jireh Publishing, Inc.*,<sup>183</sup> however, suggested otherwise.

In *ETW*, professional golfer Eldrick “Tiger” Woods brought suit against artist Rick Rush for selling the golfer's likeness without authorization in limited edition art prints made from the artist's original painting.<sup>184</sup> The painting, entitled *The Masters of Augusta*, featured three literal likenesses of Woods in different poses in the foreground, with the Augusta National Clubhouse behind him and the likenesses of other famous golfing champions looking down on him.<sup>185</sup> Despite the fact that the painting featured three entirely literal and lifelike depictions of the star golfer, and that the expression added by the artists consisted entirely of golf-related images, the Sixth Circuit nevertheless held that Rush's work contained “substantial transformative elements” and was “entitled to the full protection of the First Amendment.”<sup>186</sup> Distinguishing its decision from *Comedy III*, the Sixth Circuit stated that “[u]nlike the unadorned, nearly photographic reproduction of the faces of The Three Stooges in *Comedy III*, Rush's work does not capitalize solely on a literal depiction of Woods.”<sup>187</sup>

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<sup>182</sup> *Id.* at 911–12.

<sup>183</sup> 332 F.3d 915 (6th Cir. 2003).

<sup>184</sup> *Id.* at 918–19.

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

<sup>186</sup> *Id.* at 918, 938. In deciding where to draw the line between Wood's intellectual property rights and the First Amendment, the *ETW* court explicitly adopted the “transformative test” from *Comedy III*. *See id.* at 936. Applying the test, the court stated that, “Woods's right of publicity must yield to the First Amendment.” *Id.* at 938.

<sup>187</sup> *Id.* The court emphasized that “Rush has added a significant creative component of his own to Woods' identity . . . [p]ermitting Woods' right of

Rush's work, the Sixth Circuit maintained, "consists of a collage of images in addition to Woods's image which are combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods's achievement in that event."<sup>188</sup> After weighing the "societal and personal interests embodied in the First Amendment against Woods's property rights," the court concluded that "the effect of limiting Woods's right of publicity in this case is negligible and significantly outweighed by society's interest in freedom of artistic expression."<sup>189</sup> In contrast to *Hilton*, the *ETW* court relied heavily upon the artists' added expression—even though that expression consisted mainly of further highlighting Woods' status and achievements as a golfer. As long as a product or artistic work does not consist entirely of the celebrity's likeness, the Sixth Circuit seemed to suggest, the First Amendment would trump the right of publicity.<sup>190</sup> This questionable approach, however,

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publicity to trump Rush's right of freedom of expression would extinguish Rush's right to profit from his creative enterprise." *Id.* at 938. The court also found that the transformative nature of the painting made it "less likely to interfere with the economic interest protected by Woods' right of publicity." *Id.*

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

<sup>189</sup> *Id.*

<sup>190</sup> *Id.* The Sixth Circuit's disapproval of the right of publicity as a form of intellectual property flows throughout the *ETW* decision. *Id.* at 932–33, 937–38 (stating, among other things, that "[Tiger] Woods, like most sports and entertainment celebrities with commercially valuable identities, engages in an activity, professional golf, that in itself generates a significant amount of income which is unrelated to his right of publicity [and that] [e]ven in the absence of his right of publicity, he would still be able to reap substantial financial rewards from authorized appearances and endorsements"). The Sixth Circuit is not the first court to question the utility of the right of publicity. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n.*, 95 F.3d 959, 970 (10th Cir. 1996). But when such policy skepticism leaks into

was seemingly rejected eight years later by the California appellate court in *No Doubt v. Activision Publishing*.<sup>191</sup>

In *No Doubt*, the members from the alternative rock band “No Doubt” agreed to appear in the video game “Band Hero” and license three songs to accompany them, subject to the band’s approval.<sup>192</sup> The musicians also agreed to have their physical attributes and mannerisms scanned by a motion-capture device so that the band members’ Band Hero avatars would “accurately reflect their appearances, movements, and sounds.”<sup>193</sup> Unbeknownst to the band, however, Band Hero included an “unlocking” feature that allowed users to use the No Doubt avatars to perform any songs included in the game—uses to which No Doubt did not consent and for which they were not compensated.<sup>194</sup> The California Appellate Court held that the videogame company violated the band members’ rights of publicity.<sup>195</sup> In rejecting Activision’s “transformative use” defense, the court found that Activision’s use of lifelike depictions of No Doubt performing songs was “motivated by the commercial interest in using the band’s fame to market Band Hero, because it encourage[d] the band’s sizeable fan base to purchase the game so as to perform as, or alongside, the members of No Doubt.”<sup>196</sup> The graphics and other background content of the game, the court maintained, were “secondary,

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the court’s judicial analysis, the court seems to invade the province of the legislature.

<sup>191</sup> 122 Cal. Rptr. 3d 397, 400–01 (Cal. Ct. App. 2011).

<sup>192</sup> *Id.* at 402.

<sup>193</sup> *Id.*

<sup>194</sup> *Id.* For example, lead singer Gwen Stefani’s avatar also could be made to sing in a male voice.

<sup>195</sup> *Id.* at 411–12.

<sup>196</sup> *Id.* at 411. Activision openly admitted to hiring actors to impersonate No Doubt in order to create these extra performances. *Id.* at 402.

and the expressive elements of the game remain ‘manifestly subordinated to the overall goal of creating a conventional portrait of [No Doubt] so as to commercially exploit [its] fame.’”<sup>197</sup> Thus, although the defendant’s work did not consist entirely of the plaintiffs’ likenesses, and even though the celebrity avatars could be altered in strange and creative ways, the *No Doubt* court nevertheless found that these embellishments were merely creative ways to commercially exploit the band’s fame.<sup>198</sup> The *No Doubt* case, therefore, seems to stand for the principle that added expression—even fanciful expression<sup>199</sup>—would not immunize a work from publicity rights violations if that expression merely subordinated the exploitation of the celebrity’s fame. This principle, however, directly conflicted with the holding of another California appellate court five year earlier in *Kirby v. Sega of America, Inc.*<sup>200</sup>

In *Kirby*, the lead singer of the musical group “Deee-Lite”—Lady Kier (“Kirby”)—brought suit against video game maker Sega for violation of her publicity rights based on Sega’s creation of a video game character that was clearly “reminiscent” of Kirby’s public persona.<sup>201</sup> The video game character shared Kirby’s facial features, lip color, brightly colored pink hair, formfitting clothing, short skirt, 1960’s retro style platform shoes, and even her common (yet quite

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<sup>197</sup> *Id.* at 411 (citation omitted). This reasoning is equally applicable to the *ETW* case.

<sup>198</sup> *Id.*

<sup>199</sup> *Id.* at 402 (explaining how No Doubt’s female lead singer could be altered to sound like a guy).

<sup>200</sup> 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006).

<sup>201</sup> *Id.* at 608. Sega at one point even reached out to Lady Kier to seek her endorsement of the game, a fact potentially telling of not only its intent to merchandise her likeness, but also its success in doing so. *Id.* at 613.



distinctive) catchphrases such as “groove,” “meow,” “deedish,” and “I won’t give up.”<sup>202</sup> Despite these less than subtle evocations of Lady Kier’s image, the *Kirby* court nevertheless held that the game’s additional creative elements were enough to transform the character into a creative expression not violative of Lady Kier’s publicity rights.<sup>203</sup> The court first highlighted the differences between Kirby’s image and the video game character, including their physiques, typical hairstyles, costumes, and dance moves.<sup>204</sup> More important to the court’s decision, however, was the fact that the game depicted Ulala (the Kirby-like character) as a space-age reporter in a futuristic, twenty-fifth century setting.<sup>205</sup> Pointing out that this portrayal was “unlike any public depiction of Kirby,” the court determined that these embellishments were sufficient enough to conclude that Ulala was more of a “fanciful, creative character” than an “imitative character.”<sup>206</sup> Although the music video for Kirby’s best known song, “Grove to the Heart,” featured the singer clad in “funky retro outfits, vivid graphics, groovy dance moves, and a futuristic setting,”<sup>207</sup> and although the main purpose of the video game was to mimic the dance moves of other characters,<sup>208</sup> the court nevertheless found that the character’s

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<sup>202</sup> *Id.*. Evidence in the case also established that the video game deliberately designed the main character to “appeal to girls.” *Id.* at 609.

<sup>203</sup> *Id.* at 617–18.

<sup>204</sup> *Id.* at 613.

<sup>205</sup> *Id.* at 610.

<sup>206</sup> *Id.* at 616–17.

<sup>207</sup> *Id.* at 609.

<sup>208</sup> *Id.* at 610. The player moves to higher levels of more difficult play until he or she reaches a final level and a surprise ending to Ulala’s story: one character at the final level is known as “Space Michael” was created to resemble the celebrity Michael Jackson and even performed the character’s voice and received credit in the game. *Id.*

“lack of stasis in appearance and visual style” was “inconsistent with a claim of appropriation.”<sup>209</sup> The *Kirby* decision seemed to suggest that as long as a work’s setting is creative and fanciful, and the appropriated celebrity image slightly differs or changes, then the work would be considered sufficiently transformative so as to permit others to exploit a celebrity’s commercial appeal. This line of reasoning would be pushed to the extreme five years later in the District Court of New Jersey’s decision in *Hart v. Electronic Arts, Inc.*<sup>210</sup>

In *Hart*, defendant videogame company EA Sports appropriated the images of college football players, including the plaintiff, to use in a realistic college football video game.<sup>211</sup> The district court granted defendant’s motion for summary judgment dismissing the plaintiff’s right of publicity claims, holding that the defendant’s First Amendment right to free expression outweighed the plaintiff’s right of publicity.<sup>212</sup> While noting that the college football teams were identifiable by name, uniform designs, and logos, and that the virtual players were readily identifiable by jersey number, position, physical attributes, sports statistics, and biographical information, the court nevertheless maintained that when “[v]iewed as a whole, there are sufficient elements of EA’s own expression found in the game that justify the conclusion

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<sup>209</sup> *Id.* at 613. In particular, the court highlighted the fact that Ulala was “continually moving,” and was “not the type of artist that wants to do the same thing every time.” *Id.* (internal quotation marks omitted).

<sup>210</sup> 808 F. Supp. 2d 757 (D.N.J. 2011). The *Hart* court explicitly adopted the California Supreme Court’s transformative use test. *See id.* at 776–77. Although this decision was overturned by *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 145 (3d Cir. 2013), the district court’s decision is revealing.

<sup>211</sup> *Id.* at 761. The plaintiff was Rutgers University quarterback Ryan Hart and the game was *NCAA Football 2006*. *Id.* at 760–61.

<sup>212</sup> *Id.* at 760.

that its use of Hart's image is transformative and, therefore, entitled to First Amendment protection."<sup>213</sup> The court stressed the fact that each virtual player's unique attributes, including personal characteristics (height, weight, athletic ability), accessories (helmet visor, wristband), physical abilities (speed and agility, throwing arm, passing accuracy), and biographical details (place of origin) could be edited by the user.<sup>214</sup> While acknowledging that "video game consumers enjoy and, as a result, purchase more EA-produced video games as a result of the heightened realism associated with actual players,"<sup>215</sup> and that the video game developer was walking a "fine line between using reality as a building block for the developer's own creative work and exploiting the hard-earned reputations of college players for its own profit,"<sup>216</sup> the *Hart* court nevertheless quoted *Winter* for the proposition that "[i]f it is determined that a work is worthy of First Amendment protection because added creative elements significantly transform the celebrity depiction, then independent inquiry into whether or not that work is cutting into the market for the celebrity's images . . . appears to be irrelevant."<sup>217</sup>

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<sup>213</sup> *Id.* at 784.

<sup>214</sup> *Id.* at 783–85.

<sup>215</sup> *Id.* at 783 (citation omitted) (internal quotation marks omitted).

<sup>216</sup> *Id.* at 783.

<sup>217</sup> *Id.* (quoting *Winter v. DC Comics*, 69 P.3d 473, 478 (Cal. 2003)). It is interesting to note that the video game company licensed the publicity rights from certain NFL players for its equivalent realistic NFL video game, and that the defendant also entered into licensing agreements with the leading collegiate trademark licensing and marketing company for use of team trademarks, uniforms, and logos in the game at issue. *See id.* at 784. The *Hart* decision effectively extinguished this royalty revenue because EA has no reason to pay for that which the court permits it to use for free.

Downplaying the significance of a photographic montage of the plaintiff throwing a pass that can be seen when a game user selects Rutgers,<sup>218</sup> the court stated that the photograph was “but a fleeting component part of the montage and the video game as a whole.”<sup>219</sup> More importantly, the court held that the fact that the user is able to change the image’s features, statistics, and teammates distinguishes *NCAA Football* from the game at issue in *No Doubt*, where the characters were immutable, and from the greeting card in *Hilton*, where Paris Hilton’s photograph was used in a single static setting.<sup>220</sup> The *Hart* decision seemed to suggest that if a game user has the mere *ability* to change various characteristics of a lifelike and literally depicted famous persona who operates in the exact context for which he has earned his fame, the likeness is sufficiently “transformed” so as to preclude right of publicity claims in the name of First Amendment rights. Less than a year prior to *Hart*, however, the Northern District of California ruled in favor of a similarly situated college football player in *Keller v. Electronic Arts, Inc.*<sup>221</sup>—a case involving the same video game company and nearly the exact same set of facts.

In *Keller*, a video game company depicted college football players in their respective roles in a simulated college football game.<sup>222</sup> The virtual player of the plaintiff wore the same jersey number, was the same height and weight, and

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<sup>218</sup> *Id.* at 786.

<sup>219</sup> *Id.*

<sup>220</sup> *Id.* at 785. The court even went so far as stating, “[i]n my view, the creation of these varied potential formulations of each virtual player alone makes the game a transformative use of Hart’s image.” *Id.*

<sup>221</sup> No. C09-1967CW, 2010 U.S. Dist. LEXIS 10719, at \*1 (N.D. Cal. Feb. 8, 2010).

<sup>222</sup> *Id.* at \*6.

hailed from the same state as the real-life plaintiff.<sup>223</sup> The Northern District of California, in denying the video game company's motion to dismiss, stated that the literal depiction of the plaintiff was not "transformative" because the player was represented as exactly what he was—the starting quarterback for Arizona State University—and the game's setting—a football field—was "identical to where the public found [the] [p]laintiff during his collegiate career."<sup>224</sup>

#### IV. THE UNSUITABILITY OF THE TRANSFORMATIVE USE TEST

The California and other case law discussed above exemplify the perils of using the "transformative use" test to resolve conflicts between publicity rights and the First Amendment.<sup>225</sup> Rather than producing predictability or fairness

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<sup>223</sup> *Id.* at \*16.

<sup>224</sup> *Id.* The *Hart* court rejected the substantive analysis set forth in *Keller*, noting that the *Keller* court "fail[ed] to address that the virtual image may be altered and that the EA artists created the various formulations of each player." *Hart*, 808 F. Supp. 2d at 787. "The malleability of the player's image in *NCAA Football* suggests, instead, that the image serves as an art-imitating-life starting point for the game playing experience." *Id.* "[W]hile the player image may not be fanciful, like the worm-like characters in *Winter*," the *Hart* court maintained, "it is one of the 'raw materials' from which an original work is synthesized, [and] the depiction or imitation of the celebrity is [not] the very sum and substance of the work in question." *Id.* (citation omitted).

<sup>225</sup> See David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment*, 2 HARV. J. SPORTS & ENT. L. 1, 25–26 (2011) (noting the inefficacy of the transformative use test in recent California decisions). As can be gleaned from the above cases, *Comedy III*'s "transformative use" test turns every judge into an art critic, directly violating the long-standing Supreme Court rule. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 582 (1994) ("As Justice Holmes explained, 'it would be a dangerous

in the law, the California Supreme Court's test has engendered immense uncertainty and widespread criticism. The central flaw in *Comedy III*'s "transformative use" test is precisely what the California Supreme Court purported to be its biggest strength—namely, the so-called "advantage" of employing an "established doctrine developed from a related area of law."<sup>226</sup> What the California Supreme Court failed to grasp was the fact that the right of publicity and copyright—while similar—are not the same: The fair use test predominately balances copyright's goal of advancing knowledge with the means by which that goal is achieved, not its external relationship with the First Amendment, and though long established, the fair use test is widely criticized and notoriously imprecise. Rather than adopting a legal test designed to balance copyright doctrine, courts should, in addition to acknowledging the right of publicity's First Amendment justification under the Secondary Effects doctrine, adopt a test that balances the ends and means of the right of publicity. This Part examines copyright law's proper First Amendment test—the Secondary Effects doctrine—and how it relates to the right of publicity. This Part then explores the purpose behind copyright law's fair use doctrine and explores how such principles can be used to balance the internal ends and means of the right of publicity.

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undertaking for persons trained only to the law to constitute themselves final judges of the worth of [a work], outside of the narrowest and most obvious limits." (citation omitted)); *Hoepker v. Kruger*, 200 F. Supp. 2d 340, 352 (S.D.N.Y. 2002) ("Courts should not be asked to draw arbitrary lines between what may be art and what may be prosaic as the touchstone of First Amendment protection.").

<sup>226</sup> See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807–08 (Cal. 2001).

## A. Copyright Law, the First Amendment, & Fair Use

In constructing the “transformative use” test, the *Comedy III* court turned to copyright law’s fair use doctrine, believing it to be copyright law’s long-established mechanism for balancing copyright protection with First Amendment rights.<sup>227</sup> The problem with this assertion—and its attendant analogy—is that it misrepresents and oversimplifies copyright law’s approach to the First Amendment. As discussed above, copyrights, like other forms of intangible property, operate within the Supreme Court’s Secondary Effects doctrine. This First Amendment test tolerates laws that incidentally restrict expression if they forward an important content-neutral government interest, are narrowly tailored and leave open ample alternative channels of communication of information.<sup>228</sup> Copyright law’s important government interest, “advancing knowledge,”<sup>229</sup> is defined by the Constitution’s Intellectual Property Clause and ensured by copyright law’s “originality” and “fixed tangible medium of expression” requirements.<sup>230</sup> That governmental interest in turn is directly

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<sup>227</sup> *See id.*

<sup>228</sup> *See* San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm., 483 U.S. 539 (1987)

<sup>229</sup> *See* PRIMARY SOURCES OF COPYRIGHT (1450–1900) 133 (Lionel Bently & Martin Kretschmer eds., 2008), available at [http://copy.law.cam.ac.uk/record/us\\_1783a](http://copy.law.cam.ac.uk/record/us_1783a). Prior to the adoption of the Copyright Clause in the U.S. Constitution, many individual states passed copyright laws for the purpose of “the improvement of knowledge,” “the progress of civilisation,” and “the advancement of human happiness.” *Id.*

<sup>230</sup> *See* 17 U.S.C. § 101 (2012). This originality requirement ensures that copyright protection forwards the important government interest of “advancing knowledge.” Since protecting facts and ideas do not advance knowledge, courts have long identified the idea/expression dichotomy, as opposed to the fair use doctrine, as copyright’s main mechanism for accommodating First Amendment interests. *See* Harper & Row Publishers,

furthered by laws, narrowly tailored, which grant to the author only the exclusive right to the *commercial exploitation* of his or her *original contribution*<sup>231</sup> for a *limited time*.<sup>232</sup> This narrow tailoring is also ensured by copyright law's idea/expression dichotomy and, to some extent, by copyright law's fair use doctrine.<sup>233</sup> Lastly, copyright law leaves open ample alternative channels of communication for that information: By limiting authors' rights to the "commercial exploitation" of his or her original contribution, the law leaves open all noncommercially exploitive uses.<sup>234</sup>

Thus, while the fair use doctrine plays a role in copyright law's First Amendment analysis, it is a small, supporting role.<sup>235</sup> Fair use plays the *lead* role in copyright

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Inc. v. Nation Enters., 471 U.S. 539, 556 (1985) (citing the lower court's decision, Harper & Row Publishers, Inc. v. Nation Enters., 723 F.2d 195, 203 (2d Cir. 1983) (stressing that "copyright's idea/expression dichotomy '[strikes] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression'")).

<sup>231</sup> Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991) ("To qualify for copyright protection, a work must be original to the author.").

<sup>232</sup> See 17 U.S.C. § 101.

<sup>233</sup> The fair use doctrine's accommodation for "criticism" and "commentary" ensures that copyright law is not abused in a way that indirectly promotes subject matter and opinion censorship i.e., speech that merits the highest First Amendment protection.

<sup>234</sup> It should be pointed out that noncommercial works or noncommercial uses (such as nonprofit uses) may still be commercially exploitive. That is why the Supreme Court has stressed that "[it] is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price." *Harper*, 471 U.S. at 562 (citations omitted).

<sup>235</sup> Along with the idea/expression dichotomy, the fair use test ensures that copyright protection permits adequate alternative channels of expression by



law's internal balancing test, that is, where copyright law balances its end goal (advancing knowledge through the creation and dissemination of original works of authorship fixed in a tangible medium of expression) with the means by which that goal is achieved (the granting of exclusive rights to the commercial exploitation of those contributions).<sup>236</sup> As discussed above, the Secondary Effects doctrine holds that as long as another's unlicensed appropriation of an original work of authorship threatens that work's commercial market beyond a *de minimis* degree, the First Amendment permits copyright protection—no matter how creative that use is.<sup>237</sup> But

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refusing copyright protection against others' noncommercially exploitative uses of original works of authorship. For example, in most circumstances, using an original work (or part of a work) in a criticism will not threaten the original work's market niche—it is essentially a noncommercial use. But where the fair use test does most of its heavy lifting is in balancing those uses that *are* commercially exploitative but perhaps only marginally and/or incidentally.

<sup>236</sup> See *Harper*, 471 U.S. at 558 (“By establishing a marketable right to the use of one’s expression, copyright supplies the economic incentive to create and disseminate ideas.”); *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (“The immediate effect of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the ultimate aim is, by this incentive, to stimulate [the creation of useful works] for the general public good.”).

<sup>237</sup> To most, this fact may be a little jarring. For newspapers and news channels operate for profit and use copyrighted works in quasi-commercial contexts, so do they violate the copyright owner’s copyright when they do so? The answer to this question is “yes” when that use is sufficiently commercial. That is why Gerald Ford’s memoirs were protected in *Harper*, and why Zacchini’s performance was protected in *Zacchini*. See *Harper*, 471 U.S. at 562 (citing *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984) (“[Every] commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright” (citation omitted) (internal quotation marks omitted))). Newspapers and news

stations are not automatically exempt from intellectual property laws. *See* N.Y. Times Co. v. United States, 403 U.S. 713, 731 n.1 (1971) (White, J., concurring) (pointing out that the Constitution permits a form of prior restraint as “Article I, § 8, of the Constitution authorizes Congress to secure the ‘exclusive right’ of authors to their writings, and no one denies that a newspaper can properly be enjoined from publishing the copyrighted works of another”). The legal community, and the general public for that matter, has come to expect that newspapers and news organizations will be exempt from copyright laws because they usually use otherwise protected works in a way that only slightly and incidentally impinges on the original work’s market niche. Those uses, moreover, usually advance knowledge by creating new knowledge. In other words, news-based uses are usually fair uses and are accordingly permitted under copyright law’s fair use doctrine. But they are not automatically exempt from copyright laws. *See* Cohen v. Cowles Media Co., 501 U.S. 663, 668–72 (1991) (stating that the publisher of a newspaper “has no special privilege to invade the rights and liberties of others”); *Wainwright Sec., Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91, 93 (2d Cir. 1977) (enjoining a newspaper’s publishing of abstracts of plaintiff’s copyrighted research reports); *Roy Export Co. Establishment v. Columbia Broad. Sys., Inc.*, 503 F. Supp. 1137, 1144 (S.D.N.Y. 1980) (“The fair use doctrine is not a license for corporate theft, empowering a court to ignore a copyright whenever it determines the underlying work contains material of possible public importance.” (citation omitted) (internal quotation marks omitted)); *Macmillan Co. v. King*, 223 F. 862 (D. Mass. 1914) (finding that a teacher infringed book publisher’s copyrighted textbooks by handing out memoranda and outlines of the copyrighted textbook to his students). The First Amendment, moreover, does not mandate this type of permission as long as the news-based use is commercially exploitive. *See* *Brandreth v. Lance*, 8 Paige Ch. 24, 26 (N.Y. Ch. 1839) (recognizing the power of the court to enjoin publications based on the “principle of protecting the rights of property”); *see also* *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1972) (“No social purpose is served by having the defendant [in a right of publicity case] get free some aspect of the plaintiff that would have market value and for which he would normally pay.” (citation omitted) (internal quotation marks omitted)); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 955 (6th Cir. 2003) (“[W]hile we want a free marketplace of ideas and expression, we wish to insure that any commercial value gained from that expression is not unjustly obtained through another’s labors.” (citation omitted)). The only possible exception

*constitutional* policy does not equate to effective *copyright* policy and when a second author can use an original work of authorship (or part of it) in a way that expresses something new (advances knowledge) while not unduly impinging on the original work's market niche, then good copyright policy suggests that such a use should be permitted.<sup>238</sup> In contrast, when another author uses that same original work of authorship (or part of it) in a way that does not or only arguably expresses something new while substantially threatening the original work's market niche, good copyright policy suggests that such a use should be prohibited. The fair use factors, originally developed by the common law and ultimately codified in the Copyright Act of 1976, simply aid the judge in weighing this "new knowledge-original market niche" balance.<sup>239</sup> Judge

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to this commercial exploitation rule involves criticisms and commentaries that invoke the First Amendment's highest interests—the liberty of subject matter and opinion—and only incidentally, indirectly, and slightly impinge on the original work's market niche. This exception may be constitutionally required to give the First Amendment "breathing room."

<sup>238</sup> The utility of intellectual property differs importantly from real property in that "the possibility of multiple utilizations of the item, without exhaustion of its physical properties, allows for a realization of gain if the term is cut short." Epstein, *supra* note 124, at 25. This is why the Constitution requires a limited duration for copyrights and patents and why fair use exists in copyright law.

<sup>239</sup> Factor two (the "nature of the copyrighted work") works in concert with factor three (the "amount and substantiality of the portion used") to approximate the harm to the original work's commercial market. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586 (1994) (stating that "the second statutory factor, 'the nature of the copyrighted work,' § 107(2), draws on Justice Story's expression, 'the value of the materials used'" (citing *Folsom v. Marsh*, 9 F. Cas. 342, 348 (D. Mass. 1841))); *Harper*, 471 U.S. at 565 (maintaining that "the fact that a substantial portion of the infringing work was copied verbatim *is evidence of the qualitative value of the copied material*, both to the originator and to the plagiarist who seeks to profit from marketing someone else's copyrighted expression" (emphasis

Leval recognized this dual-interest framework in his widely cited law review article, *Toward a Fair Use Standard*,<sup>240</sup> and the Supreme Court applied this framework when it adopted the “transformative use” principle in *Campbell*.<sup>241</sup>

### i. The *Campbell* Transformative Use Doctrine

In *Campbell*, the owner of the rock and roll ballad “Oh, Pretty Woman”<sup>242</sup> sued rap group 2 Live Crew for its rap “parody” of the famous song.<sup>243</sup> Acuff-Rose argued that the rap group’s rendition infringed on its copyrighted composition and that the song’s excessive borrowing and commercial nature rendered the appropriation presumptively—if not *per se*—infringing.<sup>244</sup> The rap group, in turn, argued that its song was a parody and that it used comical lyrics to satire the original work.<sup>245</sup> In reversing the Sixth Circuit’s grant of summary judgment to Acuff-Rose, the Court stressed that the fair use doctrine “permits and requires courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the

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added)). This dual framework alone explains cases like *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605 (2d Cir. 2006) and *Perfect 10, Inc. v. Amazon.com, Inc.*, 487 F.3d 701 (9th Cir. 2007), where the defendant appropriated an entire “creative” work yet did so fairly.

<sup>240</sup> See Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1109 (1990) (“Briefly stated, the use must be of a character that serves the copyright objective of stimulating productive thought and public instruction without excessively diminishing the incentives for creativity.”).

<sup>241</sup> *Campbell*, 510 U.S. at 569.

<sup>242</sup> The song was originally written by Roy Orbison and William Dees in 1964. *Id.* at 572.

<sup>243</sup> *Id.* at 573.

<sup>244</sup> *Id.* at 572.

<sup>245</sup> *Id.*

very creativity which that law is designed to foster.”<sup>246</sup> In particular, the Court reasoned that a parody’s commercial character, which tended to weigh against a finding of fair use, was only one element that should be weighed in a fair use inquiry.<sup>247</sup> Explicitly citing and noticeably influenced by Leval’s article,<sup>248</sup> the *Campbell* Court stated that “the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works”<sup>249</sup> and that such works “lie at the heart of the fair use doctrine’s guarantee of breathing space *within the confines of copyright* . . . .”<sup>250</sup> Moreover, the Court stated that “[t]he more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.”<sup>251</sup>

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<sup>246</sup> *Id.* at 577 (quoting *Stewart v. Abend*, 495 U.S. 207, 236 (1990) (internal quotation marks omitted)). In other words, when correctly construed, the means of a statute or constitutional provision should not actively work against or defeat its purported end.

<sup>247</sup> *Id.* at 569.

<sup>248</sup> See Leval, *supra* note 240, at 1105.

<sup>249</sup> *Campbell*, 510 U.S. at 579.

<sup>250</sup> *Id.* (emphasis added). The California Supreme Court in *Comedy III* in fact explicitly acknowledged the copyright-specific purpose of the fair use/transformative use test set forth in *Campbell*. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001) “Although such transformative use is not absolutely necessary for a finding of fair use, *the goal of copyright*, to promote science and the arts, is generally furthered by the creation of transformative works.” *Id.* (emphasis added) (quoting *Campbell*, 510 U.S. at 579).

<sup>251</sup> *Campbell*, 510 U.S. at 569. Elaborating on the “transformative use” test’s “new knowledge-original market niche” dynamic, the Court stated the following:

If a parody whose wide dissemination in the market runs the risk of serving as a substitute for the original or licensed derivatives . . . , it is more

The critical inquiry under the “transformative use” test mirrors the central inquiry of the “new knowledge-original market niche” framework: it asks whether the original work is used or altered in such a way that the second work contributes new knowledge while not unduly impinging on the original work’s market niche.<sup>252</sup> Here, the term “market niche” is used to underscore the fact that an original work of authorship by definition expresses knowledge, and that such “knowledge” bears a particular character.<sup>253</sup> It is this knowledge, and the particular character of it, to which an author is granted an exclusive right. Thus, when another person merely translates a

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incumbent on one claiming fair use to establish the extent of transformation and the parody’s critical relationship to the original. By contrast, when there is little or no risk of market substitution, whether because of the large extent of transformation of the earlier work, the new work’s minimal distribution in the market, the small extent to which it borrows from an original, or other factors, taking parodic aim at an original is a less critical factor in the analysis, and looser forms of parody may be found to be fair use, as may satire with lesser justification for the borrowing than would otherwise be required. *Id.* at 580 n.14; *see also* *MCA, Inc. v. Wilson*, 677 F.2d 180, 183 (2d Cir. 1981) (“The less adverse effect that an alleged infringing use has on the copyright owner’s expectation of gain, the less public benefit need be shown to justify the use.”).

<sup>252</sup> *See Matthew Sag, The Pre-History of Fair Use*, 76 *BROOK. L. REV.* 1371, 1393 (2011) (demonstrating that the question of market substitution and the “degree of labor and authorial skill injected by the defendant” were “central in premodern copyright cases”).

<sup>253</sup> *See Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1377 (2d Cir. 1993) (emphasizing that “the author of ‘Twin Peaks’ cannot preserve for itself the entire field of publishable works that wish to cash in on the ‘Twin Peaks’ phenomenon”); *see also* *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132, 145 n.11 (2d Cir. 1998) (“[B]y developing or licensing a market for parody, news reporting, educational or other transformative uses of its own creative work, a copyright owner plainly cannot prevent others from entering those fair use markets.”).

copyrighted work into another medium,<sup>254</sup> immaterially tweaks the work,<sup>255</sup> or uses parts of the work (or the entire work) in the same character and for the same purpose as the original expression,<sup>256</sup> no new knowledge is expressed and copyright law's goal is not advanced. The public can go to the original for that knowledge.

On the other hand, when another person adds her original expression to a copyrighted work in a way that transforms the very character of the original work, new knowledge is born—the character to which the original author has no right or claim. As Judge Posner explains, “in economic terminology that has become orthodox in fair[]use case law, we may say that copying that is complementary to the copyrighted work (in the sense that nails are complements of hammers) is fair use, but copying that is a substitute for the copyrighted work (in the sense that nails are substitutes for pegs or screws), or for derivative works from the copyrighted work, is not fair use.”<sup>257</sup> In other words, it is not the amount of new expression,

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<sup>254</sup> See 17 U.S.C. § 101 (2012) (defining a derivative work as, among other things, a work that is “based upon one or more preexisting works, such as a translation”).

<sup>255</sup> See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (“It is of course essential to any protection of literary property, whether at common-law or under the statute, that the right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations.”).

<sup>256</sup> See, e.g., *Balsley v. LFP, Inc.*, 691 F.3d 747 (6th Cir. 2012) (rejecting defendant's news-based fair use defense and holding that defendant used plaintiff's photograph on its website in the same nature and for the same purposes as the plaintiff's original use—to shock, arouse, and amuse).

<sup>257</sup> *Ty, Inc. v. Publ'ns Int'l Ltd.*, 292 F.3d 512, 517 (citation omitted); see *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 591 (1994) (“[W]hen a commercial use amounts to mere duplication of the entirety of the original, it clearly ‘supersede[s] the objects’ of the original and serves as a market replacement for it, making it likely that cognizable market harm to the

even original expression, that makes a new work “transformative;” rather, it is the addition of new knowledge.

The first part of this “transformative use” inquiry, therefore, focuses on just what kinds of uses transform an original work in a way that adds new knowledge.<sup>258</sup> The easiest cases involve “self-referential” works. Commentaries and criticisms by definition must *refer* to a copyrighted work in order to comment on or criticize it. And, also by definition, a “commentary” or “criticism” adds an independent opinion, or “new knowledge.” In fact, a commentary can add new knowledge to a previous commentary of a previous commentary of a previous commentary *ad infinitum*.<sup>259</sup>

News reporting can be, but is not always, self-referential. When a news organization uses a copyrighted work for the purpose of reporting on that work, then such “reporting”

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original will occur.” (citation omitted)); *Hofheinz v. A&E Television Networks*, 146 F. Supp. 2d 442, 446–47 (S.D.N.Y. 2001) (finding that defendant’s use of twenty seconds of film footage in a biography of actor “was not shown to recreate the creative expression reposing in plaintiff’s film, it was for the transformative purpose of enabling the viewer to understand the actor’s modest beginnings in the film business” and that AMC documentary’s employment of brief clips from plaintiff’s films were “‘too few, too short, and too small in relation to the whole’ to undercut the market for plaintiff’s copyrighted works” (footnote omitted) (citation omitted)).

<sup>258</sup> See RICHARD GODSON, A PRACTICAL TREATISE ON THE LAW OF PATENTS FOR INVENTIONS AND OF COPYRIGHT 215–16 (1823) (“A man may fairly adopt part of the work of another; he may so make use of another’s labours for the promotion of science, and the benefit of the public . . .”).

<sup>259</sup> Because self-referential works inherently add new knowledge, courts have long been generous in allowing the authors of such works to borrow from other copyrighted works. See *Folsom v. Marsh*, 9 F. Cas. 342, 343 (D. Mass. 1841) (maintaining that a review that cites “largely from the original work” is fair and should be permitted).



essentially functions as a commentary. However, when the news organization uses a copyrighted work for the purpose of explaining or illustrating something besides that work, then such a use does not inherently *add* new knowledge. Nevertheless, centuries of common law have found that such reporting—like research, teaching, library archiving, and scholarship—substantially advance knowledge by more effectively spreading existing knowledge without materially undermining the original work’s market niche.<sup>260</sup> This is why

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<sup>260</sup> See *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132, 145 n.11 (2d Cir. 1998) (“[B]y developing or licensing a market for parody, news reporting, educational or other transformative uses of its own creative work, a copyright owner plainly cannot prevent others from entering those fair use markets.”); see also *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 819 (9th Cir. 2003) (finding defendant’s use of plaintiff’s copyrighted images in a thumbnail search engine was “fair use” because it “improve[d] access to information on the [I]nternet”); *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1523 (9th Cir. 1992) (recognizing the fair use value in the “growth in creative expression, based on the dissemination of other creative works and the unprotected ideas contained in those works, that the Copyright Act was intended to promote”); *Berlin v. E. C. Publ’ns, Inc.*, 329 F.2d 541, 543–44 (2d Cir. 1964) (“[C]opyright protection is designed ‘[t]o promote the Progress of Science and useful Arts,’ and the financial reward guaranteed to the copyright holder is but an incident of this general objective, rather than an end in itself. As a result, courts in passing upon particular claims of infringement must occasionally subordinate the copyright holder’s interest in a maximum financial return to the greater public interest in the development of art, science and industry.” (citation omitted)); Hannibal Travis, *Google Book Search and Fair Use: iTunes for Authors, or Napster for Books?*, 61 U. MIAMI L. REV. 87, 126 (2006) (recognizing that Google book previews are fair uses because they “utilize[e] information about the books in a genuinely new fact-disseminating and transformative way by making entire libraries of books searchable in an online index, and facilitating book previews and purchases with an online, enhanced, hyperlinked catalog”).

these uses are expressly listed in the copyright fair use statute as examples of presumptively “fair uses.”<sup>261</sup>

By far, the most difficult “transformative use” inquiry involves “transformative” creative uses, where authors use an otherwise protected work (or a part thereof) in a different character and for a different purpose than the original copyrighted work. Unlike the use of a work for criticism and commentary (which *per se* creates new knowledge), or the use of a work for reporting, research, teaching, library archiving, and scholarship (which presumptively substantially advances knowledge), the use of a copyrighted work to create another “creative” work may or may not create new knowledge.<sup>262</sup> For such “creative uses,” courts must determine to what extent the new work is transformative and to what extent the new work impinges on the original copyrighted work’s commercial market. And as explained earlier, the first inquiry is inversely related to the second inquiry: The more a work is definitively “transformative,” the less will be the importance of the “effect on the original work’s market” inquiry. This emphatically does not mean that the market effect is less important; it simply

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<sup>261</sup> 17 U.S.C. § 107 (2012) (listing purposes “such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research”); *see also* Hughes, *supra* note 119, at 295 (“Fair use focuses on personal use or use which is *not* directly for profit.” (emphasis in original) (internal quotation marks omitted)).

<sup>262</sup> *Compare Castle Rock*, 150 F.3d at 132 (finding that defendant’s “Seinfeld” trivia game, though creative, constituted copyright infringement), *with* *Suntrust v. Houghton Mifflin Co.*, 268 F.3d 1257 (11th Cir. 2001) (finding that defendant’s fictional novel appropriating characters and story lines from the fictional novel “Gone with the Wind” was a sufficiently transformative parody), *and* *L.A. News Serv. v. CBS Broad., Inc.*, 305 F.3d 924, 941–42 (9th Cir. 2002) (inclusion of a clip in video montage was transformative).

means the inquiry is less necessary because definitively transformative works inherently do not undermine an original work's commercial niche. Likewise, when a secondary work is only questionably "transformative," the inquiry into its effect on the original work's commercial market is crucial.

The second prong of the "transformative use" inquiry (like the second part of the "new knowledge-original market niche" test) asks whether the second work unduly impinges on the original work's market niche. As explained above, the second inquiry is helpful in resolving the first because, as the Court pointed out in *Campbell*, the clearer the second work uses the copyrighted work to add new knowledge, the less likely the second work will impinge on the copyright work's market niche.<sup>263</sup> The consumer, for example, is not going to purchase a criticism or parody of a song instead of purchasing the original song, especially if that parody assumes a completely different style and character.<sup>264</sup> In other instances,

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<sup>263</sup> *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 591 ("[W]hen a commercial use amounts to mere duplication of the entirety of the original, it clearly supersedes the object of the original and serves as a market replacement for it, making it likely that cognizable market harm to the original will occur."); *id.* (citing *Leval*, *supra* note 240, at 1125 ("[A]s to parody pure and simple, it is more likely that the new work will not affect the market for the original in a way cognizable under this factor, that is, by acting as a substitute for it ('superseding [its] objects')"); *Roworth v. Wilkes*, (1807) 170 Eng. Rep. 889, 890 (K.B.) (reducing the *question of* infringement to whether the defendant's publication would serve as a substitute for the original and stating that the determinative factor in this substitution inquiry was whether the later work communicates the same knowledge as the original).

<sup>264</sup> Indeed, a criticism can arguably appropriate an entire work, such as a book or poem, if it criticizes it line by line (assuming that the copyrighted work is imbedded within that criticism and not simply attached independent of and or addition to that criticism). Consumers simply will not go to the

the use of a copyrighted work, though not really adding new knowledge, nevertheless more efficiently disseminates existing knowledge while only *marginally* impinging on the original work's market niche.<sup>265</sup> Because these uses substantially fulfill copyright law's ultimate objective of advancing knowledge without unduly threatening the means by which that objective is achieved (preserving the original work's market niche), they are deemed sufficiently "transformative" or "fair."<sup>266</sup> But this is not *always* the case. Even when others use a copyrighted work in such a way that adds new knowledge, if that use substantially impinges on the original work's market niche, courts will not permit it.<sup>267</sup> Likewise, when the second work negligently impinges on the original work's market niche, such uses will generally be permitted and evidence of new knowledge does not have to be particularly strong.<sup>268</sup>

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criticism for the original work and thus the commercial market for the original work will remain largely intact.

<sup>265</sup> Such uses include preserving knowledge, improving access to knowledge, and teaching knowledge.

<sup>266</sup> These uses include reporting, researching, teaching, library archiving, scholarship, and search engines. *See* 17 U.S.C. § 106.

<sup>267</sup> *See* Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 561 (1985) (stating that "[t]he issue is not what constitutes 'news,' but whether a claim of news reporting is a valid fair use defense to an infringement of *copyrightable expression*" and finding that the defendant "went beyond simply reporting uncopyrightable information and actively sought to exploit the headline value of its infringement" (citation omitted) (internal quotation marks omitted)). The California Supreme Court in *Comedy III* got this part of the analysis wrong, at least in its application to the right of publicity. *See* Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 809 (Cal. 2001) ("The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.").

<sup>268</sup> *See* *Campbell*, 510 U.S. at 580 n.14.

## **B. The Application of the Transformative Use Test to Publicity Rights Law**

The forgoing copyright discussion illuminates two important points for the right of publicity: (1) the First Amendment's Secondary Effects doctrine governs claims involving intellectual property law, and (2) the "transformative use" test balances copyright's means and ends. When these principles are applied to publicity rights law, *Comedy III's* test, and the reasoning undergirding it, appears completely off-key.

### **i. The Secondary Effects Doctrine and the Right of Publicity**

As demonstrated above, copyright law implicitly relies upon the Supreme Court's Secondary Effects doctrine, wherein a law may incidentally restrict speech if it forwards an important government interest, is narrowly tailored to achieve that important government interest, and leaves open ample alternative channels of communication of information. The right of publicity passes this test:<sup>269</sup> the right only incidentally

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<sup>269</sup> Although celebrity personas, like copyrighted works, have expressive meaning, and although forcing artists to pay (or worry about lawsuits demanding payment) to use an individual's name or persona certainly deters to some extent artistic expression and achievement, this is an inevitable consequence of the basic intellectual property bargain. *See Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33 (2003) (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150–51 (1989)) (emphasizing that the "rights of a . . . copyright holder are part of a 'carefully crafted bargain'"); Samuel Johnson, *Considerations on the Case of Dr. T[rapp]'s Sermons, Abridged by Mr. Cave*, 1739, 57 GENTLEMAN'S MAG. (1787), reprinted in ARTHUR MURPHY, *THE WORKS OF SAMUEL JOHNSON* 548 ¶ 22 (1st ed. 1837) (stating that "[t]o abridge a book, therefore, is no violation of the right of the proprietor, because to be subject to the hazard of an abridgement was an original condition of the property").

restricts speech,<sup>270</sup> advances public achievement, is narrowly tailored to only protect against the commercial exploitation of a living or once-living individual's identity or persona for a limited time, and leaves open ample alternative channels of communication by permitting, like copyright law, all noncommercial and "fair" uses.

(a) Incidental Speech Restrictions

As the Court pointed out in *San Francisco Arts*, the restrictions on speech flowing from the protection of a word (like a name or persona) are merely "incidental to the primary Congressional purpose of encouraging and rewarding the plaintiff's activities," and there is no "realistic danger that the statute itself will significantly compromise recognized First Amendment protections . . . ." <sup>271</sup> Indeed, publicity rights protections and the limitations on speech that they entail are not adopted by legislatures "because of disagreement with the message [such speech] conveys" <sup>272</sup> but are designed to protect against the speech's noncommunicative impact on individuals' "private property." <sup>273</sup>

(b) Important Government Interest

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<sup>270</sup> *Comedy III*, 21 P.3d at 807 ("[T]he right of publicity is essentially an economic right. What the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity's fame . . .").

<sup>271</sup> *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 536 n.15 (1987) (quoting *City Council of L.A. v. Taxpayers for Vincent*, 466 U.S. 789, 801 (1984)).

<sup>272</sup> *Hill v. Colorado*, 530 U.S. 703, 719 (2000) (quoting *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989)).

<sup>273</sup> *Texas v. Johnson*, 491 U.S. 397, 411 (1989).

Contrary to modern legal convention, the right of publicity is best understood as an umbrella right encompassing four related but independent legal injuries.<sup>274</sup> Specifically, these claims include (1) the personal injury of unwanted and unwarranted public exposure;<sup>275</sup> (2) the personal, noncommercial, injury of compelled speech and false association;<sup>276</sup> (3) the unfair competition claim of false endorsement or false connection;<sup>277</sup> and (4) the unauthorized commercial misappropriation of an individual's name, identity, or persona.<sup>278</sup>

First, although privacy law early on precluded celebrities from bringing claims involving unwanted and unwarranted public exposure, this was by no means an

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<sup>274</sup> See generally *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 953 (6th Cir. 2003) (quoting J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:7 (2d ed. 2000)) (“Although the right of publicity grew out of the right of privacy, the right of publicity has within it characteristics of other rights such that it has been described as a *sui generis* mixture of personal rights, property rights, and rights under unfair competition.” (internal citations and quotations omitted)).

<sup>275</sup> See *Galella v. Onassis*, 353 F. Supp. 196, 232 (S.D.N.Y. 1972), *aff'd in part, rev'd in part*, 487 F.2d 986 (2d Cir. 1973) (recognizing that even celebrities are entitled to a right to privacy, which includes “a general ‘right to be left alone,’ and to define one’s circle of intimacy; to shield intimate and personal characters and activities from public gaze; to have moments of freedom from the unremitted assault of the world and unfettered will of others in order to achieve some measure of tranquility for contemplation or other purposes, without which life loses its sweetness”).

<sup>276</sup> See *Kwall*, *supra* note 49, at 1353, 1365 (analyzing various cases where the plaintiff’s injury was not economic harm but rather “compelled or forced speech”).

<sup>277</sup> See *Madow*, *supra* note 11, at 167, 228.

<sup>278</sup> *Id.* at 206.

inevitable or prudent development.<sup>279</sup> In fact, the first major court decision upholding a “right to privacy” recognized that the right to privacy is not an all-or-nothing right and that celebrities do not automatically surrender their “right to repose” simply because they seek publicity in other contexts.<sup>280</sup> Rather, the *Pavesich* court suggested that *all* persons have the inherent right to privacy and repose, that the default legal position should be the protection of this right, and that such a right can only be pierced when overwhelming public necessity requires it.<sup>281</sup> Absent such public need, the law should protect individuals from unwanted public exposure. This is surely the

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<sup>279</sup> See McKenna, *supra* note 2, at 229 (“[C]ourts’ refusal to allow celebrities’ privacy claims was based upon an unwarranted conclusion that the only type of compensable ‘hurt feelings’ were those that resulted from publicity generally. Courts dismissed, to the extent they considered, the possibility that one might suffer hurt feelings from particular forms of publicity, even if she accepted publicity in other forms.”).

<sup>280</sup> See *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68, 70 (Ga. 1905) (“One may desire to live a life of seclusion; another may desire to live a life of publicity; *still another may wish to lead a life of privacy as to certain matters, and of publicity as to others.*” (emphasis added)). “One who desires to live a life of partial seclusion has a right to choose the times, places, and manner in which he will submit himself to the public gaze.” *Id.*; see also *United States v. Jones*, 132 S. Ct. 945, 957 (2012) (Sotomayor, J., concurring) (“[I]t may be necessary to reconsider the premise that an individual has no reasonable expectation of privacy in information voluntarily disclosed to third parties. . . . I would not assume that all information voluntarily disclosed to some member of the public for a limited purpose is, for that reason alone, disentitled to Fourth Amendment protection.”).

<sup>281</sup> *Pavesich*, 50 S.E. at 70 (“The right to withdraw from the public gaze at such times as a person may see fit, when his presence in public is *not demanded by any rule of law* is also embraced within the right of personal liberty.” (emphasis added)).



better argument.<sup>282</sup> Those who endure the saturating and oftentimes suffocating publicity born out of news reporting, criticism, commentary, and other media directly serving the public interest should not also have to suffer through widespread commercial exploitation for the purpose of another's personal gain. Most reasonable persons would deem it intolerable to have to see their name on every lunchbox, shampoo bottle, cleaning product, or billboard advertisement and would think it insufferable to have their face associated with sex toys, cigarettes, condoms, pharmaceuticals, and other businesses or brands with negative and controversial reputations simply because they have some notoriety born out of their accomplishments. And what about those individuals who simply have greatness "thrust upon 'em?"<sup>283</sup> Do they, through no choice of their own, completely lose their right to privacy? Modern law all too often says "yes" but the correct answer should clearly be "no." This injury of "undue exposure" is real and it often times sneaks into the courts' consideration of the supposedly purely "economic" right of publicity claim. Making this injury explicit would better focus the court's analysis on the claim at hand.<sup>284</sup>

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<sup>282</sup> See *Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. Am. Heritage Prods.*, 296 S.E.2d 697, 700 (Ga. 1982) ("[The *Pavesich* court] noted that the commentators on ancient law recognized the right of personal liberty, including the right to exhibit oneself before the public at proper times and places and in a proper manner.").

<sup>283</sup> WILLIAM SHAKESPEARE, *TWELFTH NIGHT* act 2, sc. 5.

<sup>284</sup> See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1103 (9th Cir. 1992) ("The defendants argue that in right of publicity actions, only damages to compensate for economic injury are available. We disagree. Although the injury stemming from violation of the right of publicity may be largely, or even wholly, of an economic or material nature, we have recognized that it is quite possible that the appropriation of the identity of a celebrity may

Second, as the *Pavesich* court pointed out, “[I]berty of speech and of writing is secured by the Constitution, and incident thereto is the correlative liberty of silence, not less important nor less sacred.”<sup>285</sup> Likewise, the right to association encompasses also the choice not to associate. Therefore, when others—without authorization—vicariously exercise another person’s freedom to speak or liberty to associate, they effectively usurp that individual’s fundamental and self-defining constitutional right.<sup>286</sup> This is a grave and tangible

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induce humiliation, embarrassment, and mental distress.” (citation omitted) (internal quotations omitted)).

<sup>285</sup> *Pavesich*, 50 S.E. at 70–71 (quoting *Wallace v. Ry. Co.*, 94 Ga. 732 (1894)); see also Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, so Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM.–VLA J.L. & ARTS 123, 127 (1996) (“In a way, the right of publicity can also be seen as an adjunct to the First Amendment—specifically, to the dimension giving individuals the right not to speak.”); see also *Riley v. Nat’l Fed’n of the Blind, Inc.*, 487 U.S. 781, 796–97 (1988) (“There is certainly some difference between compelled speech and compelled silence, but in the context of protected speech, the difference is without constitutional significance, for the First Amendment guarantees ‘freedom of speech,’ a term necessarily comprising the decision of both what to say and what *not* to say.” (emphasis in original)); *Pac. Gas & Elec. Co. v. Pub. Utils. Comm’n*, 475 U.S. 1, 11 (1986) (plurality opinion) (“[A]ll speech inherently involves choices of what to say and what to leave unsaid.” (emphasis in original)); *Wooley v. Maynard*, 430 U.S. 705 (1977) (striking down on First Amendment grounds a New Hampshire statute compelling motorist to leave visible on their license plates the motto “Live Free or Die”); *W.Va. State Bd. of Educ. v. Barnette*, 319 U.S. 624 (1943) (holding that a state may not compel children to recite the pledge of allegiance).

<sup>286</sup> See *Turner Broad. Sys. v. FCC*, 512 U.S. 622, 641 (1994) (“At the heart of the First Amendment lies the principle that each person should decide for himself or herself the ideas and beliefs deserving of expression, consideration, and adherence. Our political system and cultural life rest upon this ideal.”); see also *Pac. Gas*, 475 U.S. at 12 (“*PruneYard* . . . does not undercut the proposition that forced associations that burden protected

injury of constitutional dimensions, one which cannot be defended on First Amendment grounds.<sup>287</sup> This “false approbation” claim must certainly be addressed and effectively resolved in any publicity rights analysis.

Third, when others use an individual’s name or likeness in conjunction with the sales of goods and services, such placement almost always falsely suggests that individual’s approval of or connection to those goods or services.<sup>288</sup> Such

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speech are impermissible.”); *Mason v. Jews for Jesus*, No. 06Civ.6433(RMB), 2006 WL 3230279, at \*1 (S.D.N.Y. Nov. 8, 2006) (involving a pamphlet promoting the organization “Jews for Jesus” where a Jewish Rabbi was centered on the cover impliedly endorsing the cause and joining the efforts though he made no such endorsement and had no such involvement); McKenna, *supra* note 2, at 284 (recognizing an individual’s interest in autonomous self-definition and control over “the particular contexts in which his identity would be used might create associations”).

<sup>287</sup> The First Amendment safeguards persons’ right to talk *about* others and *to* others, not *for* others. In many nations, moral rights, and the legal protections thereof, addresses this cause of action. In the United States, however, moral rights are little protected. See Robert C. Bird, *Moral Rights: Diagnosis and Rehabilitation*, 46 AM. BUS. L.J. 407, 409 (2009) (stating that the U.S. has “weak moral rights protection”). Some courts, nonetheless, have tried to shoehorn this injury into the modern “economic” right of publicity claim. See *Hogan v. A.S. Barnes & Co.*, No. 8645, 1957 WL 7316 (Pa. Com. Pl. Jun. 19, 1957) (enjoining defendant’s use of golfer Ben Hogan’s name and picture on the jacket of a book in a manner that implied Hogan’s authorship of the book).

<sup>288</sup> See *Maker’s Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 419 (6th Cir. 2012) (quoting *Ameritech, Inc. v. Am. Info. Techs. Corp.*, 811 F.2d 960, 964 (6th Cir. 1987)) (explaining that confusion of sponsorship or false association occurs when “the similarity of the trademarks erroneously suggests a connection between the sources”); *Boston Prof’l Hockey Ass’n, Inc. v. Dallas Cap & Emblem Mfg.*, 510 F.2d 1004 (5th Cir. 1975) (upholding injunction against embroidered emblems that substantially duplicated a professional hockey team’s logo and therefore falsely suggested a connection to or sponsorship by the hockey team); *Allen v.*

an action constitutes a fraud upon the public and embodies the prototypical unfair competition claim.<sup>289</sup> This legal injury is well established under the Lanham Act<sup>290</sup> and often goes hand-in-hand with right of publicity claims.<sup>291</sup>

Fourth, when others commercially exploit, in a nonconfusing manner, an individual's name or likeness, they arguably pirate or "free-ride" off that individual's private property. This *Vanna White*-like<sup>292</sup> "commercial misappropriation" claim is by far the most controversial of the four claims. Because "free-riding" denotes economic value and this value is primarily created through market exclusivity or "property-like" legal protection, the question remains: Why should the law create and enforce property-like exclusivity? As

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Men's World Outlet, Inc., 679 F. Supp. 360, 367–68 (S.D.N.Y. 1988) (holding that a celebrity states a claim under § 43(a) by showing that advertisement featuring photograph of a lookalike falsely represented that advertised products were associated with him).

<sup>289</sup> See 15 U.S.C. § 1125(a) (2012); *Jurin v. Google Inc.*, 768 F. Supp. 2d 1064, 1070 (E.D. Cal. 2011) ("15 U.S.C. § 1125(a), then, provides two distinct grounds on which to base a cause of action alleging unfair competition. 15 U.S.C. § 1125(a)(1)(A) protects against false association and 15 U.S.C. § 1125(a)(1)(B) protects against false advertising.").

<sup>290</sup> See 15 U.S.C. § 1125(a) (providing a civil action against any person who "on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device [that is] likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person").

<sup>291</sup> See Dreyfuss, *supra* note 285, at 126–27.

<sup>292</sup> *White v. Samsung Elecs. Am.*, 971 F.2d 1395 (9th Cir. 1992) (finding that a television advertisement featuring a robot resembling "Wheel of Fortune" hostess Vanna White, though it did not invoke any connection to or sponsorship by Ms. White, nonetheless violated the celebrity's right of publicity).

discussed above, Judge Frank’s “value-ownership theory and Nimmer’s labor-desert theory do not sufficiently answer this criticism. But what about *Zacchini*’s intellectual property-based “public good-incentive” theory? While the *Zachinni* Court many times emphasized—and several commentators have since stressed—that the unauthorized appropriation of a performance is readily and importantly distinguishable from the unauthorized commercial appropriation of a name or likeness, the question remains: Can the “weaker” publicity rights claim still rely upon the “stronger” claim’s “intellectual property” justification? This Article suggests that it can—albeit in a slightly more attenuated way.<sup>293</sup>

Copyright law provides a clear example of how the intellectual property-based “public good-incentive” framework operates.<sup>294</sup> The Copyright Clause grants to individuals the

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<sup>293</sup> While copyright law directly and exclusively protects knowledge (original works of expression fixed in a tangible medium of expression), nonperformance publicity rights only protect the secondary benefits of public achievement—commercially valuable personas—not public achievement itself. Although the commercial speech doctrine’s requirement that the law at issue “directly advance” the important government interest is stricter than the time, place, and manner doctrine’s requirement that the law at issue is “narrowly tailored,” Supreme Court precedent suggests that the right of publicity meets either standard. *See San Francisco Arts & Athletics v. U.S. Olympic Comm.*, 483 U.S. 522, 538–39 (1987) (finding that the publicity rights-like statute, which protected the secondary benefit of the Olympic organization’s publicly beneficial activities (the commercial value of the word “Olympic”), “directly advances th[e] important government interest”).

<sup>294</sup> In fact, the right of publicity could almost be protected under copyright law. It looks surprisingly similar to the copyright protection granted in *CCC Info. Servs. v. MacLean Hunter Mkt. Reports*, 44 F.3d 61 (2d Cir. 1994). There, the plaintiff corporation sued the defendant for appropriating its copyrighted car valuations. *Id.* at 63. The court found that the car valuations were copyrightable because the value, though a single number, was infused

exclusive right to their original works of authorship in order to incentivize the creation and dissemination of works that benefit the public.<sup>295</sup> The incentive is threefold. The grant of exclusive rights (1) incentivizes the time, investment, and effort necessary to *create* such works; (2) incentivizes the *public diffusion* of such works as opposed to their limited distribution through private contract-by-contract sales;<sup>296</sup> and (3)

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with both facts and personal judgment. *Id.* at 73; *see also Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984) (granting protection to identification of “premium” baseball cards because of personal subjectivity of the selection). Likewise, although a name or likeness is a single symbol, it is infused with the creative decisions and personal judgments of the individuals exercising their free will in making career and publicity decisions—the ultimate form of self-authorship. *See Epstein, supra* note 124, at 21 (explaining how every author can be “deconstructed into a vessel through which countless forms of influences are poured” but noting that the Constitution “gives the entire claim to the one person who has contributed the lion’s share to the finished product, with the precise intention of slighting the indirect contributions of other individuals to this product”). The right of publicity also nearly approaches copyright protection for fictional characters. *See Rich v. Fox Broad. Co.*, 330 F.3d 1170, 1175 (9th Cir. 2003) (recognizing that copyright law protects fictional characters that “have displayed consistent, widely, identifiable traits”); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 755 (9th Cir. 1978) (explaining that “a comic book character, which has physical as well as conceptual qualities, is more likely to contain some unique elements of expression” than mere literary characters).

<sup>295</sup> The “stronger” right of publicity claim follows the same formula: it grants to persons the exclusive right to their performances in order to incentivize the creation and dissemination of such performances for the purpose of advancing public achievement.

<sup>296</sup> *See Golan v. Holder*, 132 S. Ct. 873, 888 (2012) (“Evidence from the founding, moreover, suggests that inducing *dissemination*—as opposed to creation—was viewed as an appropriate means to promote science.” (emphasis in original)). “The provision of incentives for the creation of new works is surely an essential means to advance the spread of knowledge and

encourages the publication and dissemination of already created but otherwise personally sensitive works, such as letters and diaries.<sup>297</sup> The “weaker” right of publicity claim operates under the same three-part incentive model. The right of publicity (1) incentivizes the investment, time and effort necessary for individuals to do that which creates commercially valuable personas<sup>298</sup>—which, more often times than not,

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learning. *Id.* “We hold, however, that it is not the sole means Congress may use ‘[t]o promote the Progress of Science.’” *Id.* (citation omitted).

<sup>297</sup> *Folsom v. Marsh*, 9 F. Cas. 342 (D. Mass. 1841) (involving the publication of the private letters of President George Washington). This three-part incentive has unfortunately been lost in modern copyright doctrine. Today, federal copyright law applies to original works of authorship whether or not they are published or disseminated. In fact, contemporary copyright doctrine primarily (if not exclusively) focuses on creation while dissemination has taken a backseat. But it was not always so. For over a hundred years, publication was a prerequisite for federal copyright protection. This makes sense because like patents, original works of authorship require disclosure and dissemination in order to directly achieve copyright’s end goal of advancing knowledge. Today, however, publication is not a prerequisite for copyright protection. Thus, it could be argued that much of federal modern copyright law, like publicity rights law, does not *directly* achieve the important government interest of advancing knowledge.

<sup>298</sup> This “publicity rights” incentive is somewhat more attenuated than its copyright law equivalent. Copyright law incentivizes the creation of works that inherently fulfill copyright law’s end goal of advancing knowledge through the granting of an exclusive right to those actual works. But the right of publicity incentivizes those activities that benefit the public not by granting an exclusive right to those actual activities (that would be the “strong,” performance-based right of publicity), but by granting an exclusive right to an individual’s name or identity—a secondary commercial byproduct of those activities. This indirect connection between the grant of exclusive rights and the objective-promoting incentive is why many courts and commentators remain skeptical about the efficacy of the right of publicity. *See* Volokh, *supra* note 7, at 910 (“Copyright law can at least be justified . . . by the concern that without the financial incentive

entails some form of public achievement;<sup>299</sup> (2) incentivizes people who do publicly achieve to continue achieving by rewarding such efforts through the promise of a fully functional market for their personas and by ensuring that such achievement will not be thwarted by unwanted and unwarranted commercial exploitation;<sup>300</sup> and (3) incentivizes

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secured by copyright law, many fewer works (especially expensive works) would be created. But . . . it's hard to believe that people would stop wanting to become political leaders, actors, or athletes if they were told that they would get less income from sales of T-shirts or prints. Virtually all such uses depict people who are already famous, and who have likely already earned a lot of money from the activity that made them famous.” (footnotes omitted)); *see also* *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 973–74 (10th Cir. 1996) (rejecting the economic arguments in favor of the right of publicity); Madow, *supra* note 11, at 137, 184 (criticizing the economic arguments in support of the right of publicity). This attenuation argument is certainly a valid legislative criticism, but it should not affect the judicial analysis. So long as the granting of the exclusive right to a name or likeness advances public achievement more so than without it, that is all that is necessary to sustain judicial scrutiny. *Ward v. Rock Against Racism*, 491 U.S. 781, 792, 800 (1989).

<sup>299</sup> “Public achievement” broadly refers to an individual’s attributes, actions, and accomplishments that benefit the public.

<sup>300</sup> *See* Andrew Koo, *Right of Publicity: The Right of Publicity Fair Use Doctrine—Adopting a Better Standard*, 4 BUFF. INTELL. PROP. L.J. 1, 22 (2006) (“[I]n right of publicity cases involving celebrities and athletes, unauthorized exploitations of their identities in a negative or false light could greatly cost them lucrative endorsements and sponsorships opportunities.”). This incentive is similar to trademark law’s protection against dilution. *See* 15 U.S.C. § 1125(c)(2)(B)(i) (2012) (“[D]ilution by blurring’ is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”); *id.* § 1125(c)(2)(C) (“[D]ilution by tarnishment’ is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”). A celebrity’s persona is an important commercial and career asset, one which can be quickly



those sensitive individuals who would otherwise not enter the public stage by guaranteeing to them the protection from and security against unnecessary exploitative exposure.<sup>301</sup>

Undue exposure, false approbation, false endorsement, and commercial misappropriation, therefore, are the four basic injuries that courts should perch under the “right of publicity” umbrella. Two are unalienable personal rights, and the remaining two are alienable economic rights. All four claims should be independently addressed and resolved in any publicity rights case. But because the California Supreme Court—like most other courts—focuses mostly on the last claim (the commercial misappropriation claim), this Article uses the term “right of publicity” to denote the “commercial misappropriation” claim and will hereafter focus solely on that specific economic injury.

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diluted by others’ unauthorized commercial exploitation of it. *See Franke, supra* note 18, at 957 (quoting Richard A. Posner, *The Right to Privacy*, 12 GA. L. REV. 393, 411 (1978) (“[B]y giving celebrities property rights in their identities, they will seek to maximize their value and prevent the devaluation that may come with overexploitation.”)); *see also* *Matthews v. Wozencraft*, 15 F.3d 432, 438 n.2 (5th Cir. 1994) (“If the appropriation of an individual’s goodwill were left untrammelled, it soon would be overused, as each user will not consider the externality effect his use will have on others. Each use of the celebrity’s name or face will reduce the value that other users can derive from it. The use of a name or face, therefore, is analogous to the overuse of a public highway: In deciding whether to use the road, each user does not consider the increased congestion that his use will inflict on others.” (citation omitted)) While a celebrity, like a business, cannot prevent others from commenting on or criticizing them, they can protect against the commercial blurring or tarnishing of an otherwise distinct and self-chosen commercial identity.

<sup>301</sup> Admittedly, this last incentive could perhaps be addressed under a reworked privacy law, as set forth in the above proposed “undue exposure” claim.

(c) Narrowly Tailored & Directly Advances

The more difficult question is determining, to the extent it needs to be determined, whether the right of publicity's protection (which to some extent limits the free flow of information) directly forwards the government's important interest, i.e., advancing public achievement.<sup>302</sup> Although legislative judgments deserve deference from the judicial branch, as a fundamental right, free speech restrictions warrant a more scrutinizing inspection. Intermediate scrutiny, while not requiring a law to most directly achieve its purported important government interest, nevertheless will not tolerate tenuous chains of causation.<sup>303</sup> Such regulations must be "narrowly tailored to serve the government's legitimate, content-neutral interests."<sup>304</sup> Nonetheless, such laws "need not be the least-restrictive or least-intrusive means of doing so."<sup>305</sup> Rather, the content-neutral regulation must "promote[] a substantial governmental interest that would be achieved less effectively absent the regulation."<sup>306</sup> The question thus turns to whether legal protection against the commercial appropriation of an individual's identity and persona advance public achievement

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<sup>302</sup> See *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490, 502–03 (1981) ("A court may not escape the task of assessing the First Amendment interest at stake and weighing it against the public interest allegedly served by the regulation." (citations omitted) (internal quotation marks omitted)).

<sup>303</sup> See *Cent. Hudson Gas & Elec. v. Pub. Serv. Comm'n*, 447 U.S. 557, 564 (1980) (stating, in the context of commercial speech regulations, that "the regulation may not be sustained if it provides only ineffective or remote support for the government's purpose").

<sup>304</sup> *Ward v. Rock Against Racism*, 491 U.S. 781, 792 (1989).

<sup>305</sup> *Id.* at 800 (stating that all that is required is that "the means chosen are not substantially broader than necessary to achieve the government's interest . . . .")

<sup>306</sup> *Id.* (quoting *United States v. Albertini*, 472 U.S. 675, 689 (1985)); see also *Mastrovincenzo v. New York*, 435 F.3d 78 (2d. Cir. 2005).

more so than absent such protection. The above “important government interests” discussion demonstrates that it does.

(d) Ample Alternative Channels of Expression

First, the right of publicity does not prohibit noncommercially exploitive uses of an individual’s name or likeness. Thus, anyone can freely use a persona for their own personal expression, such as in personal projects, correspondences, and noncommercial social media postings. Second, those “fair uses” that only incidentally commercially exploit a persona are permitted as well: the right of publicity does not shield individuals from others’ commentary and criticism. These exemptions in themselves provide ample alternative channels of expression. But even when protected, publicity rights law permit others’ use of an individual’s name or likeness as long as they “pay[] the customary price” for such use.<sup>307</sup>

Because the right of publicity furthers an important government interest, because it does so by sufficiently restrictive and direct means, and because it leaves open ample alternative channels, legal protection against the unauthorized, non-*de minimis* commercial use of an individual’s name or likeness passes First Amendment muster. Like copyright law, however, constitutional propriety does not necessarily equate to prudent policy. Artistic expression is a form of public achievement, one which the right of publicity should encourage and protect. Thus, prohibiting all non-*de minimis* commercial uses of personas—though within constitutional bounds—is not prudent publicity rights policy. Accordingly, a legal framework

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<sup>307</sup> Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 562 (1985).

that balances the right of publicity's ultimate objective (advancing public achievement) with the means by which that objective is furthered (the grant of an exclusive right to an individual's name or likeness) is essential.

## V. THE COMMERCIAL EXPLOITATION TEST

As explained above, copyright's fair use test (and the "transformative use" test therein) does not primarily address or resolve legal conflicts between copyright law and the First Amendment. Rather, the fair use test is an internal test—one that balances copyright law's ultimate objective with the means by which that objective is achieved. Indeed, it is the Court's Secondary Effects doctrine that primarily balances copyright law with the First Amendment.<sup>308</sup> For publicity rights cases, therefore, courts ought to rely on the Secondary Effects framework—not the fair use framework—to resolve conflicts

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<sup>308</sup> Sometimes, the secondary author may want to use a copyrighted work ("work X") in his own original work. But the secondary author's access to work X, and the very existence of work X, is the product of the copyright system. This system, the secondary author must realize, relies upon the granting of exclusive rights to authors for their original works in order to incentivize the creation and dissemination of such works. If such exclusive rights were not protected, there would not be work X to appropriate. That is, if others were allowed to freely copy and use an author's work, there would be virtually no market for that work, which would discourage authors to publicly disseminate their works, and would prevent authors from initially taking the time or investment to create such works. Simply put, the entire system collapses. Thus, when using a copyright work, the secondary author must pay the customary price. He cannot receive the benefit of the copyright law bargain (access to the work) but then renege on his end of the bargain (respecting the original author's commercial market).

between the right of publicity and the First Amendment.<sup>309</sup> As explained in Part III, the right of publicity passes First Amendment judicial scrutiny. The real issue at stake in California’s “transformative use” test, therefore, is not the First Amendment. Rather, the central question really addressed in these decisions (though cloaked under a “First Amendment” inquiry) is when can (or should) others be able to use an otherwise protected personality for their own commercially exploitative purposes?<sup>310</sup> In this respect, *Comedy III*’s “transformative use” test fails pretty spectacularly.<sup>311</sup> Contrary to *Comedy III*’s claim, adding new expression to otherwise protected material guarantees nothing. In copyright law, for instance, other artists cannot simply use a copyrighted work because they add new expression to it—even a substantial amount of expression.<sup>312</sup> The new expression, no matter how

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<sup>309</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 581 (1977) (Powell, J., dissenting) (stating that the First Amendment does not provide “a subterfuge or cover for private or commercial exploitation”).

<sup>310</sup> The California Supreme Court erroneously frames this issue as a balancing analysis between the right of publicity and the First Amendment. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 806 (Cal. 2001) (stating that “as in the case of defamation, the state law interest and the interest in free expression must be balanced, according to the relative importance of the interests at stake”).

<sup>311</sup> Indeed, the *Comedy III* test largely usurps legislatively granted rights and does so in a markedly arbitrary and unpredictable manner. When a sovereign people, acting through their state legislature, choose to recognize a “right of publicity,” courts should not thereafter circuitously veto that legislative act. Neither should judges indulge the facile and often self-serving assumption that the First Amendment compels them to do so. As thoroughly discussed above, the right of publicity follows the same First Amendment framework that copyright law has followed for over 200 years—a scheme permitted under and endorsed by the Constitution itself.

<sup>312</sup> See *Harper*, 471 U.S. at 565 (quoting *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d. Cir. 1936) (“[N]o plagiarist can excuse the wrong by showing how much of his work he did not pirate.”)).

creative or how substantial, must fulfill copyright law's ultimate objective (advancing knowledge) *while not materially undermining* the means by which that end goal is achieved (grant of exclusive rights to the commercial exploitation of the original contribution).<sup>313</sup>

While at first blush it would seem somewhat inconsistent for publicity rights law to permit the free use of an otherwise protected right when copyright law clearly does not permit such blatant misappropriation, the analogy is a little more complicated. While one can argue that the creative use of an otherwise protected work only achieves copyright law's ultimate objective (advancing knowledge) when it is used in

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<sup>313</sup> The Supreme Court in *Zacchini* made clear that the "First and Fourteenth Amendment do not immunize the media" from intellectual property claims. *Zacchini*, 433 U.S. at 575. While news organizations engaging in reporting and commentary generally do not threaten intellectual property rights, when such uses "pose[] a substantial threat to the economic value of [those rights]," these organizations are liable to the rights owners. *Id.* The *Comedy III* Court gave short shift to the fourth fair use factor, the factor the Supreme Court has called the "single most important element of fair use." *Harper*, 471 U.S. at 568. But it also found that "the 'potential market' test has been criticized for circularity" and that "it could be argued that if a defendant has capitalized in any way on a celebrity's image, he or she has found a potential market and therefore could be liable for such work." See *Comedy III*, 21 P.3d at 808 n.10 (citing MELVILLE B. NIMMER & DAVID NIMMER, 4-13 NIMMER ON COPYRIGHT § 13.05[A][4]). While this is undoubtedly true, it undoubtedly misses the point. The commercial market for, or value of, a copyrighted work primarily rests on direct consumption, such as when people buy a book to read the book, download a song to listen to the song, or buy a poster to hang up the poster. This "direct" and "intrinsic" consumption is what copyright law jealousy guards, the threat to which extinguishes the author's incentive to create and disseminate his work. Indirect consumption, such as one's use of a work for archiving or research, normally does not unduly threaten the author's incentive and usually leaves the author's direct-consumption market intact.

such a way that creates *new* knowledge (i.e., a “transformative” use), *all* creative uses of a persona seemingly fulfill publicity rights law’s ultimate objective of advancing public achievement. From the Three Stooges t-shirts in *Comedy III* to the painting in *ETW*, there is undoubtedly public utility and public benefit in an artist’s creation. Courts, furthermore, are in no position to judge which creative use is more creative than the next.<sup>314</sup> So long as the use is marginally creative, then that use should be held to fulfill the ultimate objective of publicity rights law.<sup>315</sup> The real question is, therefore, at what price should that creative use be permitted? Copyright law, for example, does not permit the use of a copyrighted work—even if that use is accompanied by substantial creativity—if that use materially threatens the means which that copyright author and all other copyright authors originally relied upon in creating and disseminating their works (i.e., the protected commercial market of the original work). Publicity rights law should follow the same instruction.

Publicity rights law should not automatically permit a “creative use” of an otherwise protected personality simply because such creativity to some extent fulfills the right of publicity’s ultimate objective. When any use materially undermines the right of publicity’s means (i.e., an individual’s commercial market in her name, identity, and persona), it

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<sup>314</sup> *Ettore v. Philco Television Broad. Corp.*, 229 F.2d 481, 490 (3d Cir. 1955) (“If the artistry of the performance be used as a criterion, every judge perforce must turn himself into a literary, theatrical or sports critic.”).

<sup>315</sup> In *Feist Publ’ns*, the Supreme Court took a similarly minimalist approach to what kind of expression is protected under copyright law. 499 U.S. 340, 345 (1991) (stating that “the requisite level of creativity is extremely low; even a slight amount will suffice”).

should be prohibited.<sup>316</sup> Creative uses of personalities should only be permitted when such uses do not materially threaten the commercial market for those personalities. The correct internal balancing test for the right of publicity, therefore, must focus on determining whether, and to what extent, a creative use of a personality undermines the commercial market of that personality.

### A. The “Commercial Exploitation Test”

The inquiry into whether and to what extent a creative use of a personality undermines the commercial market of that personality reveals five basic kinds of uses: (1) advertising uses;<sup>317</sup> (2) merchandizing uses;<sup>318</sup> (3) creative uses; (4) fair uses; and (5) noncommercial uses. On one extreme, noncommercial uses by definition do not threaten the commercial market for a particular personality. Such a use should therefore be *per se* permitted. Next, the enumerated “fair uses” in copyright law (criticism, commentary, reporting, teaching, archiving) ordinarily do not materially undermine the

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<sup>316</sup> Permitting the free use of personalities directly undermines the market for them—which is the very means by which the right of publicity purportedly encourages the advancement of public achievement.

<sup>317</sup> See *Doe v. TCI Cablevision*, 110 S.W.3d 363, 373 (Mo. 2003) (stating that “the use of a person’s identity for purely commercial purposes, like advertising goods or services or the use of a person’s name or likeness on merchandise, is rarely protected”).

<sup>318</sup> See *Lugosi v. Universal Pictures*, 603 P.2d 425, 434–35 (Cal. 1979) (finding that the likeness of Bela Lugosi as Count Dracula was not permissible on items such as plastic toy pencil sharpeners, plastic model figures, T-shirts and sweat shirts, soap and detergent products, picture puzzles, candy dispensers, masks, kites, belts and belt buckles, and beverage stirring rods—in other word, items with underlying utility).



commercial market for a personality.<sup>319</sup> Such uses, therefore, should be presumptively permitted, with the burden on the plaintiff to prove a material market injury or threat of injury. In the other extreme, however, advertising uses (as defined by the Supreme Court's "commercial speech" doctrine) always undermine a personality's commercial market.<sup>320</sup> Accordingly, these uses should be *per se* prohibited. Next, merchandising uses ordinarily undermine the commercial market of a personality.<sup>321</sup> Such uses, therefore, should be presumptively

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<sup>319</sup> Copyright law's well-established fair uses do not impinge on the kind of direct consumption that defines a persona's commercial market. These utilitarian uses only incidentally, collaterally, and minimally impinge on a persona's potential market or commercial value. This presumption, however, can be overturned. *See* *Messenger ex rel. Messenger v. Gruner & Jahr Printing & Publ'g, Inc.*, 727 N.E.2d 549, 555 (N.Y. 2000) (stating that "invented biographies" may be "so infected with fiction, dramatization or embellishment that [they] cannot be said to fulfill the purpose of the newsworthiness exception" to liability under New York law).

<sup>320</sup> *See* *Nimmer, supra* note 50, at 212 ("Advertisements, almost regardless of their nature, will increase their reader appeal by including the name and portrait of a prominent personality or a well-known enterprise, although there is no 'passing off' that such personality or enterprise produces or endorses the product being advertised."); *see also* *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407 (9th Cir. 1996) (holding the use of a basketball player's name in historical quiz featured in a television commercial violated the player's right of publicity); *Titan Sports v. Comics World Corp.*, 870 F.2d 85 (2d Cir. 1989) (determining that poster-sized photographs of wrestlers inserted into their periodicals by sports promotion company violated plaintiff's right of publicity); *Tellado v. TimeLife Books, Inc.*, 643 F. Supp. 904, 909-10 (D.N.J. 1986) (holding that use of photograph of former Vietnam veteran in letter advertising nonfiction Vietnam book violated veteran's right to publicity).

<sup>321</sup> Determining what is and what is not a "merchandising use" considers two factors: (1) the amount of additional creativity added to and around the personality, and (2) the underlying utility of the product on which the personality is affixed or otherwise connected to. When an unadorned personality is featured on an item with independent utility, consumers

prohibited, with the burden on the defendant to prove that such a use does not materially undermine the commercial market for the personality.<sup>322</sup>

The last kind of use, a “creative use” (or an “art/entertainment use”), demands a closer examination. As in most intellectual property balancing tests, multiple factors aid the trier of fact in determining whether or not a particular creative use materially impinges on the personality’s commercial market. Those factors include (1) the number of works or products produced; (2) the placement and prominence of the personality in the work or product; and (3) the extent to which the work or product exploits the personality’s unique qualities, reputation, or accomplishments. These three factors signal to courts whether or not a defendant’s use of a personality is unduly commercially exploitive. But like any multifactor test, the particular weight of each factor and the

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normally assume that the item is endorsed by or is otherwise associated with the personality—in direct violation of § 43(a) of the Lanham Act. For example, the defendant’s use of an unadorned image of the Three Stooges comedy trio on a t-shirt in *Comedy III* was a prototypical merchandising use. The defendant added no material amount of creativity into or around the generic image of the three personalities and the underlying product (a t-shirt) had utility independent of the image. *See People v. Saul, 776 N.Y.S.2d 189,193 (N.Y. Crim. Ct. 2004)* (“Collectibles are readily distinguishable from art and, as mere merchandise, would not be entitled to constitutional protection.”).

<sup>322</sup> The purpose of the advertising and merchandising presumptions, as well as the noncommercial and fair use presumptions, is to provide clear notice for both parties in a variety of instances, and to promote predictability in the law and resolution in litigation. Although some legal and judicial resources will inevitably be diverted from the cases’ actual merits to establishing the correct “category” under which the product or work ought to be analyzed, the tradeoff of predictability and the existence of such legal safe harbors are well worth these formulistic concerns.

interaction between them must be thoroughly articulated, lest such factors become mere tools of subjective, outcome-oriented judicial assessments.<sup>323</sup>

### **i. Number of Works**

First, the greater the number of works or products sold or circulated that incorporate the persona, the higher the probability that use will impinge on the persona's market value by drying up the commercial market.<sup>324</sup> For right of publicity claims, this is the most important factor. While one item, such as a painting, should normally be permitted to be sold,<sup>325</sup> and

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<sup>323</sup> See Kozinski & Newman, *supra* note 7, at 514 (pointing out that “when you’re applying a multi-factor test in which the factors are not clearly defined or weighted, it’s very difficult to be clearly wrong”).

<sup>324</sup> See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 n.14 (1994) (identifying as an example of when there is “little or no risk of market substitution” when “the new work’s minimal distribution in the market”); see also WILLIAM F. PATRY, 6 PATRY ON COPYRIGHT § 22:105 (“The public’s interest in particular subjects is frequently short-lived, leading content providers and distributors alike to all rush in at the same time, resulting in mutually assured market saturation. Similarly, it is in the nature of some works (and most celebrities) that overexposure leads to a greatly diminished appeal and therefore a diminished market. . . . Where . . . copyright owners carefully husband their marketing only to have a third party rush in by placing an infringing work before the public, the copyright owner is very likely to suffer future harm.”).

<sup>325</sup> Drawing from copyright law’s fair use doctrine, the market effects factor must consider not just the single case at issue, but it must also embrace the effect of such activity in the aggregate. See *Campbell*, 510 U.S. at 590 (“[The fourth factor] requires courts to consider not only the extent of market harm caused by the particular actions of the alleged infringer, but also ‘whether unrestricted and widespread conduct of the sort engaged in by the defendant . . . would result in a substantially adverse impact on the potential market’ for the original.” (citation omitted)).

while a handful of items should usually be excused,<sup>326</sup> when an item is vended or mass-manufactured, such activity requires further justifications from the other factors—if it can be justified at all.<sup>327</sup>

## ii. Placement and Prominence

Second, courts should recognize the commercial importance of the placement and prominence of the persona in the work or product at issue. The more a personality is featured in a work or product, the more that use is commercially exploitive. On the other hand, the rest of the work can so engulf a persona that such unauthorized use nonetheless constitutes a *de minimis* use.<sup>328</sup> For example, the use of a

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<sup>326</sup> See *Simeonov v. Tiegs*, 602 N.Y.S.2d 1014, 1018 (N.Y. Civ. Ct. 1993) (stating that “[a]n artist may make a work of art that includes a recognizable likeness of a person without her or his written consent and sell at least a limited number of copies thereof”). Individual manufacture also minimizes the extent of commercial exploitation. See *Saul*, 776 N.Y.S.2d at 193 (“Individuated manufacture is one way to distinguish ‘art’ from, say, the decoration on the back of playing cards.”).

<sup>327</sup> See *Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. Am. Heritage Prods.*, 296 S.E.2d 697, 700 (Ga. 1982) (recognizing the unlawful commercial exploitation of an artist’s bust of Dr. King as massively sold through \$29.95 plastic busts). The Visual Rights Acts provides a useful and objective (even if somewhat arbitrary) maximum number, above which would constitute infringement (barring *de minimis* use). See 17 U.S.C. § 101 (2012) (defining a “work of visual art” as a “painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer” (emphasis added)).

<sup>328</sup> BLACK’S LAW DICTIONARY 443 (9th ed. 2009) (“The law does not concern itself with trifles.”); see also *Sandoval v. New Line Cinema*, 147 F.3d 215, 218 (2d Cir. 1998) (finding photograph’s fleeting appearance in film constituted *de minimis* use); *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70, 77 (2d Cir. 1997) (holding that a television show’s use of copyright painting in the background, obscured most of the time, was *de*

persona in massive collage of pictures shown in the distance in the background of a movie scene should not trigger a legal cause of action. Although any use beyond a *de minimis* one is material, when the copies number less than a handful, minor uses of a personality should be permitted. Likewise, when the copies are numerous and the personality's role is major, such uses should be prohibited.<sup>329</sup>

### iii. Exploitation of Unique Qualities, Reputation, or Accomplishments

Third, the more a work capitalizes off of an individual's identity, reputation, talents or accomplishments, the more that use is commercially exploitive. While the use of a personality in an unidentifiable way does constitute an actionable offense, and while the use of a persona in a completely contrasting or ironic manner borders on parody, the ordinary use of an individual's identity constitutes straightforward infringement and the use of an individual's unique reputation, talents, and accomplishments is exceedingly difficult to justify. When the first two factors are closely balanced, this third factor should decide the case.<sup>330</sup>

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*minimis*); *Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255, 267 (5th Cir. 1988) (holding that thirty characters copied out of fifty pages of source code was *de minimis*).

<sup>329</sup> In other words, the quantity of works permitted is inversely related to the placement and prominence of the persona in the work. As a rule of thumb, quantities of less than 200, less than 50, and less than 10 works should respectively permit minor, major, and feature uses of a persona.

<sup>330</sup> When the quantity is small and the placement is prominent, or when the quantity is large and the placement is nearly *de minimis*, the third factor should tip the scales in favor or against a finding of infringement.

## B. Application of the “Commercial Exploitation Test”

The “commercial exploitation” test produces sensible, intuitive, and predictable results. Although the test does not “guarantee some perfect allocation”<sup>331</sup> of value and desert, it does “identify at low cost clear owners of labor so as to assure the security of investment and exchange that promotes long-term productive wealth.”<sup>332</sup>

First, persons using an individual’s persona in advertisements are given clear notice that such uses will not be permitted. The *Vanna White* case clearly illustrates this principle.<sup>333</sup> There, the Ninth Circuit found that the defendant’s use of a Vanna White robot in an advertisement constituted a violation of her right of publicity.<sup>334</sup> Second, when people use an unadorned persona on or in connection with a product with underlying utility, they will know they face a high hurdle to overcome a claim of infringement. *Comedy III* exemplifies this kind of case. The entire work consisted of an unadorned depiction of the three famous comedians and the underlying product (a t-shirt) had utility independent of the depiction. The defendant’s clear merchandizing use would trigger a presumption of infringement—a presumption Saderup would not overcome.

On the other hand, an individual’s posting of a picture of Lady Gaga on her personal social media account would constitute a noncommercial use and would be *per se*

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<sup>331</sup> Epstein, *supra* note 124, at 9.

<sup>332</sup> *Id.* at 9–10.

<sup>333</sup> See *White v. Samsung Elecs. Am.*, 971 F.2d 1395 (9th Cir. 1992).

<sup>334</sup> *Id.* at 1399 (stressing that “[a]dvertisers use celebrities to promote their products” and implicitly suggesting that advertisements inherently commercially exploit the celebrities they use).

permitted.<sup>335</sup> Additionally, when individuals use an individual's name or likeness to comment on or criticize that personality, they know the fair use presumption will give them safe harbor. *Cardtoons, L.C. v. Major League Baseball Players Ass'n*<sup>336</sup> exemplifies such a "fair use." In *Cardtoons*, the defendant company sold parody trading cards featuring caricatures of major league baseball players.<sup>337</sup> Under the Commercial Exploitation test, the parodying, self-referential use of the personalities at issue in *Cardtoons* would have created a presumption of permissible use—a presumption the plaintiffs would not have overturned. In contrast, the defendant's use of two personalities in *Winter v. DC Comics*<sup>338</sup> was not a "fair use." In *Winter*, the defendant obviously used the Winter brothers as the basis for the comic book's "Autumn brothers" characters. While the defendant claimed he used the plaintiffs' personas to lampoon and criticize, the only "commentary" apparent was general satire.<sup>339</sup> The Supreme Court has made clear, however, that general satire is not the same as self-referential parody.<sup>340</sup> The former is less necessary and more directly commercially exploitive than the latter. The

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<sup>335</sup> Admittedly, some use social media accounts to promote and to advertise; but, in such cases, the use of celebrity personas would in fact be commercial.

<sup>336</sup> 95 F.3d 959 (10th Cir. 1996).

<sup>337</sup> *Id.* at 962.

<sup>338</sup> *Winter v. DC Comics*, 69 P.3d 473 (Cal. Ct. App. 2003).

<sup>339</sup> *Id.* at 479.

<sup>340</sup> *See Campbell v. Acuff-Rose Music*, 510 U.S. 569, 580–81 (1994) ("Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim's (or collective victims') imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.").

“Autumn brothers” are not self-referential parodies.<sup>341</sup> The comic book used the name and likeness of two famous musicians simply in a creative and strange<sup>342</sup> but nevertheless commercially exploitive way.<sup>343</sup> No commentary, criticism, or parody was reasonably apparent.<sup>344</sup> Accordingly, the defendants in *Winter* would not have received the benefit of the fair use presumption. Under the commercial exploitation’s three-factor balancing test, moreover, the court would have found that the Autumn brothers comic books infringed on the Winter brothers’ right of publicity. The comic books were widely circulated and sold and the “Autumn brothers” were featured on the cover of the comic books and embodied its main characters. Rather than “paying the customary price” to

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<sup>341</sup> The California Court of Appeals in fact admitted that the comic books do not technically qualify as parody of plaintiffs. *Winter*, 69 P.3d at 479.

<sup>342</sup> If the comic book used the Everly brothers instead of the Winter brothers, the strangeness of the depiction might be more significant. The Winter brothers, however, are known for their eccentric look and unconventional style. Indeed, between the two, their biggest hit is the song entitled, “Frankenstein.” It is not implausible that Winter brothers fans would both appreciate and purchase the comic book at issue due to the musicians’ commercial magnetism.

<sup>343</sup> See *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1404–06 (9th Cir. 1997) (rejecting a parody defense and stating that the appropriating author did not refer to the original work but merely used the original work’s style and material to get commercial attention); *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (finding that a fictional comic book character “Tony Twist” violated plaintiff hockey player’s right of publicity).

<sup>344</sup> See *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1268 (11th Cir. 2001) (stating that a work’s parodic character must be “reasonably be perceived”).



license the personas, the defendant simply used them for his own creative but commercial purposes.<sup>345</sup>

The *Hilton* case exemplifies a “creative use” and so the court would have analyzed this use under the three-part balancing test. Although the defendant’s contribution consisted entirely of Paris Hilton’s persona, the underlying product (the greeting card) really did not have utility independent of the defendant’s contribution—without which there would be just a blank card. Nevertheless, this “near” merchandising use is easily resolved under the balancing test. The defendant mass-produced the card; the card prominently featured Paris Hilton’s persona in its product (a greeting card); and, the card directly exploited and capitalized off Hilton’s unique qualities, reputation, and accomplishments. Under the commercial exploitation test, such a use would have been plainly prohibited. Similarly, the defendant’s use of college football players’ identities in *Keller* and *Hart* was clearly a “creative use” and as such would have been analyzed under the three-part balancing test. Applying the three factors, the court would have certainly prohibited EA’s particular use. First, the video game was mass-manufactured and widely sold.<sup>346</sup> Second, the college players’ personas were featured prominently throughout the video game. In fact, the players were placed front and center on not only the video game cover, but also in

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<sup>345</sup> See *Groucho Marx Prods., Inc. v. Day & Night Co.*, 523 F. Supp. 485, 492 (S.D.N.Y. 1981), *rev’d on other grounds*, 689 F.2d 317 (2d Cir. 1982) (finding that a creative musical nonetheless infringed on the plaintiffs’ right of publicity because the performers appropriated the unique appearances, style, and mannerisms of the Marx brothers).

<sup>346</sup> See *NCAA Football 12 Kicks Off to Record Start at Retail*, EA (July 26, 2011), <http://investor.ea.com/releasedetail.cfm?releaseid=594113> (touting record sales of 700,000 units after two weeks of selling NCAA Football ’12).

every part of the user play. Last, the game exploited exactly what the players were famous for—playing college football. The first two factors alone would conclude infringement. Such mass-market commercial exploitation, which very nearly approaches a merchandising use, directly impinges on the commercial markets of the personalities.<sup>347</sup>

While *Hilton*, *Keller*, and *Hart* illustrate infringing “creative uses,” *ETW* illustrates a permissible creative use. First, because the painting at issue was sold for profit, it was not a “non-commercial” use. Neither did the painting fall within the enumerated “fair uses.”<sup>348</sup> And clearly the single painting was not an advertising or merchandising use. Because the defendant’s use of Tiger Woods’ persona was a creative one, therefore, the three-factor balancing test would apply. Regarding the single painting, the use of Woods’ visage should be permitted. Although the painting featured Woods front and center and exploited his accomplishments and fame as a golfer, the quantity (just one) would have outweighed the other two factors. Permitting the sale of the painting allows the painter to create a work of art (a form of public achievement) while not unduly undermining the commercial market for Woods’ personality (the protection of which incentivizes Woods’ public achievement).<sup>349</sup>

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<sup>347</sup> The *Kirby* and *No Doubt* cases would follow the same line of reasoning and produce the same outcome.

<sup>348</sup> The court found that the painting was neither a commentary nor a criticism.

<sup>349</sup> The prints, however, are a different story. The defendant sold more than just a handful and they, exactly like the painting, featured Woods front and center and exploited his accomplishments and fame as a golfer. Such material commercial exploitation of Woods’ persona is, under the Commercial Exploitation test, prohibited. See *Memphis Dev. Found. v.*

The above test is but one suggestion for how to resolve the antagonistic balance between publicity rights and the First Amendment. Many others tests have certainly been put forth.<sup>350</sup> The purpose of such tests, however, should all be the same: produce clear and consistent outcomes that fairly reflect the underlying interests and overarching policies between the two rights. The “transformative use” test, used predominately in California and increasingly adopted elsewhere, does not produce clear and consistent results. And it certainly does not fairly reflect the important legal interests at stake. Not surprisingly, the resulting application of the “transformative

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Factors Etc., Inc., 441 F. Supp. 1323, 1330–31 (W.D. Tenn. 1977), *rev'd*, 616 F.2d 956 (6th Cir. 1980), *cert. denied*, 449 U.S. 953 (1980) (permitting a large bronze statue of Elvis Presley erected in downtown Memphis but enjoining the promotional sale of several replica statuettes); *see also* Factors Etc., Inc. v. Pro Arts, Inc., 579 F.2d 215, 222 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979) (finding a poster “commemorating” the death of Elvis Presley infringed the singer’s right of publicity).

<sup>350</sup> *See* Rogers v. Grimaldi, 875 F.2d 994, 1004–05 (2d Cir. 1989) (applying the two-part “Rogers” test); *see also* Cardtoons, L.C. v. Major League Baseball Players Ass’n, 95 F.3d 959 (10th Cir. 1996) (applying a general balancing test); Doe v. TCI Cablevision, 110 S.W.3d 363 (Mo. 2003) (applying a “predominate use” test); Stephen R. Barnett, *First Amendment Limits on the Right of Publicity*, 30 TORT & INS. L. J. 635 (1995); F. Jay Dougherty, *All the World’s Not a Stooge: The “Transformativeness” Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 COLUM. J.L. & ARTS 1 (2003); Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577 (1979); Kwall, *supra* note 49, at 1347 (“Much ink has been spilled over the intersection between the right of publicity and the First Amendment.”); Volokh, *supra* note 7; Diane Leenheer Zimmerman, *Fitting Publicity Rights into Intellectual Property and Free Speech Theory: Sam, You Made the Pants Too Long!*, 10 DEPAUL-LCA J. ART & ENT. L. 283 (2000); Diane Leenheer Zimmerman, *Money as a Thumb on the Constitutional Scale: Weighing Speech Against Publicity Rights*, 50 B.C. L. REV. 1503 (2009).

use” test, has produced a series of highly criticized and inconsistent decisions.<sup>351</sup> This test should swiftly be discarded. Courts should instead refocus their analysis on the relevant ends, means, and mechanisms underlying the right of publicity and the First Amendment. Then, and only then, can they faithfully address and adequately resolve these two competing interests.

## VI. CONCLUSION

The commercial and noncommercial exploitation of a person’s name and likeness spawns various emotional, reputational, and economic injuries—many of which continue to go unrecognized and exceedingly unresolved. The modern right of publicity is an imperfect solution to these real and rapidly expanding problems, as it addresses only the economic injury of such public exploitation. Over the last half-century, moreover, this singular approach has bedeviled courts and commentators, who have largely overlooked the right of publicity’s relevant legal harm and colorably failed to construct a legal framework that appropriately accommodates First Amendment interests. Courts’ increasing adoption of the *Comedy III* “transformative use” test only further confounds publicity rights’ already confusing legal landscape. Among the many wrong turns the right of publicity has taken since its extrication from the right of privacy, this is one that can and

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<sup>351</sup> See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249–51 (1903) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside the narrowest and most obvious limits.”); *Hoepker v. Kruger*, 200 F. Supp. 2d 340, 352 (S.D.N.Y. 2002) (“Courts should not be asked to draw arbitrary lines between what may be art and what may be prosaic as the touchstone of First Amendment protection.”).

should be avoided. Courts should reject and abandon *Comedy III*'s "transformative use" test and turn back to the prevailing judicial frameworks utilized in other intellectual property cases—namely, the Secondary Effects doctrine and copyright law's internal means-ends balancing test. States certainly do not have to enact a right of publicity law, and state legislatures are free to exempt uses of personalities not required by the First Amendment.<sup>352</sup> But when a state does enact a right of publicity statute, and when the statute provides only limited exceptions, courts have the duty to duly respect and properly analyze this modern form of intellectual property.

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<sup>352</sup> See, e.g., Illinois Right to Publicity Act, 765 ILCS § 1075/5 (exempting from the Illinois right of publicity statute "works of Fine Art," which it defines as including paintings, drawings, sculptures, mosaics, videotapes, photographs, works of calligraphy, etchings, lithographs, serigraphs, offset prints, clays, textiles, fibers, woods, metals, plastics, glasses; collages, and assemblages).