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Transformative Use Test Cannot Keep Pace with Evolving Arts

**TRANSFORMATIVE USE TEST CANNOT KEEP PACE
WITH EVOLVING ARTS**

*The Failings of the Third and Ninth Circuit “Transformative Use”
Tests at the Intersection of the Right of Publicity and the First
Amendment*

Geoffrey F. Palachuk*

I. FIRST DOWN: Introductions

A. The Virtual World at Risk

Today, human beings choose to escape reality in diverse, entertaining, and visually stunning ways. Films, music, and television have been immersive vehicles for reality-escaping experiences for decades.¹ In addition to these forms of media, video games have grown from a relatively niche market into a household staple. The video game market has grown into a multi-billion dollar indus-

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¹ See, e.g., *Schad v. Borough of Mount Ephraim*, 452 U.S. 61, 65 (1981) (citing *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495 (1952)); *Southeastern Promotions, Ltd. v. Conrad* 420 U.S. 546, 547-48 (1975); *Erznoznik v. City of Jacksonville*, 422 U.S. 205, 206 (1975); *Doran v. Salem Inn, Inc.*, 422 U.S. 922 (1975); *Jenkins v. Georgia*, 418 U.S. 153, 161 (1974); *Schacht v. United States*, 398 U.S. 58, 63 (1970).

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try, exceeding twenty-one billion in revenue in 2013.² Fifty-nine percent of American households play video games,³ and the average game-player is thirty-one years old and has been playing video games for approximately thirteen years.⁴ The top video game companies include the likes of Sega (Sonic), Nintendo (Mario), Ubisoft (Assassin's Creed), Konami (Dance Dance Revolution), Square Enix (Final Fantasy), Electronic Arts (Madden Football), Blizzard (Warcraft), and Microsoft (Halo).⁵ To be sure, video games are no longer “child’s play,” with enormous industry shares at stake, and companies with massive intellectual property portfolios.

Just as in films, music, and television, video games allow users to experience alternate realities and temporarily exist in other worlds. Intuitively, all those mediums constitute expressions protected by the First Amendment.⁶ The Supreme Court has held that video games are entitled to the full protections of the First

² Malathi Nayak, *FACTBOX - A Look at the \$66 Billion Video-games Industry*, REUTERS, (June 10, 2013), available at <http://in.reuters.com/article/2013/06/10/gameshow-e-idINDEE9590DW20130610>.

³ ENTMT SOFTWARE ASS'N, *INDUSTRY FACTS* (2013), available at <http://www.theesa.com/about-esa/industry-facts/>.

⁴ *Id.*

⁵ Dan Wilson, *The World's Most Successful Video Game Companies*, THERICHEST.COM, (December 10, 2013), available at <http://www.therichest.com/business/the-worlds-most-successful-video-game-companies/>.

⁶ U.S. CONST. amend. I; The First Amendment states: “Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.” *Id.*; see also *Winters v. New York*, 333 U.S. 507, 510 (1948). In *Winters*, the Supreme Court held that so long as entertainment media is capable of expression, then it is protected under the First Amendment of the United States. In that case, the Court also ruled that no clear line exists between information and entertainment (“The line between the informing and the entertaining is too elusive for the protection of that basic right . . . Though we can see nothing of any possible value to society in [these forms of media], they are as much entitled to the protection of free speech as the best of literature.”). *Id.*

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Amendment.⁷ Those rights are not absolute, and states may recognize the right of publicity to a degree consistent with the First Amendment.⁸ The right of publicity, in short, is one's right to protect his or her identity, "image and likeness," and representations in a commercial setting.⁹ (That definition is an obvious oversimplification, and will be discussed in more detail below.)

It is plain to see, then, iconic role-playing fantasy games like *The Elder Scrolls V: Skyrim* do not implicate right of publicity issues, but games such as the worldwide hits *Guitar Hero* and *Rock Band*, which have arguably attempted to imitate real bands or musicians, might create a cause of action for certain band's rights of publicity. Similarly, Cloud Strife from the legendary *Final Fantasy VII* may not run afoul of the right of publicity, where games based on actual college or university athletes might. The looming policy questions remains: whether slightly fanciful depictions of real people, or *intentionally* realistic depictions of real people, should receive protection from the First Amendment at all. Conversely, should the First Amendment trump a person's right of publicity? When, and under what circumstances?

Recent Third and Ninth Circuit jurisprudence¹⁰ has muddied the waters in extremely nuanced ways for those trying to determine where, in First Amendment defenses that implicate the right of publicity, the "line between informing and entertaining is too elusive."¹¹ The recent case law further complicates the question whether First Amendment protection should or should not be

⁷ *Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729, 2733, 180 L. Ed. 2d 708 (2011) ("Like protected books, plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player's interaction with the virtual world."); see U.S. CONST., amend. I.

⁸ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 574-75 (1977).

⁹ For a thorough explanation of the "right of publicity," see Section II.A.1, *infra*.

¹⁰ See *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 762 (D.N.J. 2011), *rev'd*, 717 F.3d 141 (3d Cir. 2013); *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013) [Hereinafter "*In re NCAA*"].

¹¹ *Winters*, 333 U.S. at 510.

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afforded to a particular artistic medium in a particular instance.¹² The decisions render a myriad of possible outcomes for future cases in determining what test courts should apply for right of publicity claims, and how those tests will be applied.¹³

One issue raised above exists at the intersection of the First Amendment and the right of publicity tort. The right of publicity affords an economic right in one's name and likeness, so that one may "profit from the full commercial value of their identit[y]."¹⁴ Some commentators question the validity of the justifications for a "right of publicity" altogether.¹⁵ Nevertheless, right of publicity

¹² In *In re NCAA*, *supra* note 10, Judge Sidney Thomas acknowledged the balance broken by the majority in the opinion. He argued "the right to compensation for the misappropriation for commercial use of one's image or celebrity is far from absolute. In every jurisdiction, *any right of publicity must be balanced against the Constitutional protection afforded by the First Amendment.*" *Id.* at 1284 (Sidney, J., dissenting) (emphasis added). He also argued that the majority failed to examine the "transformative and creative elements in the video game as a whole . . . [which] contradicts the holistic analysis required by the transformative use test." *Id.* at 1284-85 (citations omitted).

¹³ On July 31, 2013, the Ninth Circuit issued two different decisions rendered by the same panel. In one, a former college football player filed putative class action lawsuit against a video game manufacturer, which allowed users to control avatars representing college football and basketball players as those avatars participated in simulated games, alleging violations of class members' rights of publicity. The court held that the First Amendment did not protect the video game developer's use of the likenesses of college athletes in its video games. *In re NCAA*, *supra* note 10. In the other case, a former professional football player sued video game manufacturer, alleging, *inter alia*, that the manufacturer violated Lanham Act by using his likeness in series of football video games. The court affirmed the lower court in dismissing the action, and applied a different test to the Lanham Act claim. *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013). For further discussion, see Section II.B and C, *infra*.

¹⁴ *Cardtoons L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 968 (10th Cir. 1996).

¹⁵ See, e.g., Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1188 (2006); Michael Madow, *Private Ownership of Public Image: Popular Culture & Publicity Rights*, 81 CAL. L. REV. 127, 238 (1993); Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903, 911 (2003).

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lawsuits have proliferated in recent decades. Musicians, filmmakers, authors, artists, and video game manufacturers have all been subjects of right of publicity actions for depicting celebrities in their respective mediums.¹⁶ Courts have struggled to reconcile the right of publicity with the protections afforded by the First Amendment.¹⁷

The right of publicity, by its own terms, implicates video games among other forms of media. But to what extent do video games require the protections afforded by the First Amendment? The current lawsuits “ha[ve] the potential to reform collegiate athletics and the relationship between the NCAA and student-athletes for better or worse.”¹⁸ Indeed, applications of the “transformative use” test in First Amendment defenses of right of publicity claims has fractured a delicate balance between expression and exploitation.

Note, however, that the current NCAA lawsuits simply serve as red herrings to the larger issue at the intersection of First

¹⁶ See, e.g., *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003) (OutKast song lyrics); *Valentine v. C.B.S., Inc.*, 698 F.2d 430 (11th Cir. 1983) (Bob Dylan song lyrics); *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996) (feature movie and book about the Black Panther Party); *Ruffin-Steinback v. dePasse*, 82 F. Supp. 2d 723 (E.D. Mich. 2000), *aff'd*, 267 F.3d 457 (6th Cir. 2001) (television miniseries about the Temptations); *Tyne v. Time Warner Entm't Co., L.P.*, 901 So. 2d 802 (Fla. 2005) (movie about a shipwreck); *Matthews v. Wozencraft*, 15 F.3d 432 (5th Cir. 1994) (fictionalized, but accurate, book about a police officer); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001) (magazine using image of Dustin Hoffman); *Hilton v. Hallmark Cards*, 599 F.3d 894 (9th Cir. 2010) (Paris Hilton image in greeting card); *Kirby v. Sega of Am., Inc.*, 144 Cal. App. 4th 47 (2006) (video game); *No Doubt v. Activision Publ'g, Inc.*, 192 Cal. App. 4th 1018 (2011) (video game); *Martin Luther King, Jr. Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., Inc.*, 296 S.E.2d 697 (Ga. 1982) (bust of Martin Luther King, Jr.); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003) (painting of Tiger Woods); *John Broder, Schwarzenegger Files Suit Against Bobblehead Maker*, N.Y. TIMES (May 18, 2004), available at <http://www.nytimes.com/2004/05/18/national/18arnold.html>.

¹⁷ See, e.g., *supra* note 16 and cases cited therein.

¹⁸ *Tristan Griffin, Note, Payment of College Student-Athletes at Center of Legal Battles*, 75 TEX. B. J. 850, 851 (2012).

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Amendment protection and right of publicity claims. Consider the portrayal of Mark Zuckerberg's "image and likeness" in the recent film *The Social Network*, or the portrayal of real World War II veterans in the HBO miniseries *Band of Brothers*. Can film, documentaries, and artistic works depicting real people be subject to the "transformative use" test described by the Ninth and Third Circuits? The issue has been considered in brief, and future outcomes are unpredictable. Thus, the issue appears ripe for Supreme Court clarification.

This Note will briefly examine the *Hart* and *Keller* decisions, not only because those cases may soon provide Supreme Court guidance in balancing First Amendment defenses in right of publicity actions, but also because those cases will affect the future of colleges and universities as sports franchises. If the Supreme Court takes up the right of publicity issue decided by the Third¹⁹ and Ninth²⁰ Circuits, the Court will probably reverse the holdings enumerated by those courts, and will refuse to apply the "transformative use" test. The Supreme Court would likely reason that the First Amendment defenses raised by the NCAA shield it from liability for rights of publicity claims raised by college and university student-athletes, and that strong public policy considerations and NCAA self-governance controls should not permit the NCAA to compensate former college and university student-athletes. The claims involving the Sherman Act and possible antitrust violations, and the plaintiffs' unjust enrichment arguments will not be addressed in this Note.

The chief concern of this Note will be to (1) analyze the Third and Ninth Circuit decisions that could render college and university student-athletes compensable for their image and likeness in video games, (2) evaluate the tests for First Amendment defenses in right of publicity claims, and (3) determine the best test for evaluating right of publicity claims in a diverse, rapidly-evolving technological world. The transformative use test (dis-

¹⁹ *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013).

²⁰ *In re NCAA*, *supra* note 10.

cussed in Section III.C, *infra*), as fashioned by the Third and Ninth Circuits, is not the correct test. That test will result in incoherent and inconsistent application, and chill First Amendment protections granted by the United States Constitution. This Note stands for the proposition that the *Rogers*²¹ test (discussed in Section III.A, *infra*) is the best way for the courts to backstop state right of publicity claims with First Amendment protection, and provide a bright-line rule that can be applied coherently and predictably.

Throughout the next two subsections, I will provide a brief background of the “players” involved in the NCAA litigation, as well as the EA Sports video game franchise. My analysis of the cases above begins at Section II. Each of the relevant tests fashioned by the courts will be examined in Section III. Finally, Section IV will conclude this Note.

B. The Players: EA Sports No Longer “In The Game”

Any male with a pulse and a penchant for study-breaks or lazy days off should be able to explain the basics of the Electronic Arts’ (“EA”) *NCAA Football* video game. As the game system powers on, the famous EA Sports tagline rings out: “EA Sports... It’s in the game.” But, is it? Not in this lawsuit. Not anymore.

On September 26, 2013, EA Sports and Collegiate Licensing Company (“CLC”) settled with a class of athletes ranging from two hundred thousand to three hundred thousand for forty million dollars.²² Further, EA Sports announced that it would not publish its *NCAA Football* video game in 2014.²³ While speculation exists as to whether EA Sports had a preference to escape litigation by

²¹ *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir.1989).

²² Patrick Rishe, *E.A. Sports & C.L.C. Settle With College Athletes... Will NCAA Follow Suit?*, FORBES.COM (Sept. 27, 2013) available at www.forbes.com/sites/prishe/2013/09/27/ea-sports-clc-settle-with-college-athletes-will-ncaa-follow-suit.

²³ *Id.* The game would have been titled “NCAA Football 2015” because “NCAA Football 2014” was released for the 2013-14 NCAA college football season.

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paying a sum of forty million dollars (which amounts to about one hundred-fifty, per plaintiff, before fees), one fact appears certain: the NCAA has no intention to settle.²⁴ The NCAA now faces a class action lawsuit from a growing class (certified in the late winter of 2013) for, *inter alia*, right of publicity, antitrust, and unjust enrichment claims. The NCAA filed to intervene on behalf of EA, and may take up the right of publicity litigation (and others), if the Supreme Court grants certiorari.

Two Circuit Court decisions, *Hart* and *Keller*, (discussed in Section II, *infra*) are on petition for writ of certiorari to the Supreme Court. The settlement by EA Sports would seemingly leave the right of publicity petitions for certiorari moot, but the NCAA may litigate the issue should the Supreme Court take the petition. At the date of this Note, the District Court for the Northern District of California has denied the motion to dismiss the class action lawsuit, permitted the class certification, and set a trial date for early 2014. The Supreme Court has not ruled on either petition for certiorari.

C. The NCAA Football Video Game Franchise

EA's enormously popular *NCAA Football* video game series, first unveiled in 1993, artistically creates a fictional interactive college football gaming experience.²⁵ In each annual edition of *NCAA Football*, users can play individual games or entire seasons, selecting from among thousands of unnamed virtual players and over one hundred virtual college teams.²⁶ The virtual football games occur in virtual stadiums filled with virtual fans, coaches, cheerleaders, mascots, and referees, all meticulously crafted by EA's video game designers.²⁷

²⁴ Steve Eder, *E.A. Sports Settles Lawsuit With College Athletes*, NYTIMES.COM (Sept. 26, 2013), available at www.nytimes.com/2013/09/27/sports/ncaafootball/ea-sports-wont-make-college-video-game-in-2014.html?_r=0.

²⁵ *Hart*, *supra* note 19 at 146.

²⁶ *Id.*

²⁷ *Id.*

The virtual players (“avatars”) are clothed in their teams’ uniforms and logos. The unnamed avatars are identified only by position and jersey number (e.g., QB #7) but are meant to evoke real players.²⁸ Thus, for example, an avatar may have an appearance (e.g., height, weight, skin-tone, and throwing arm) and biographical information (e.g., class year) that match those of a real player.²⁹ “In no small part, the *NCAA Football* franchise’s success owes to its focus on realism and detail—from realistic sounds, to game mechanics, to team mascots. This focus on realism also ensures . . . [all the] teams in the game are populated by digital avatars that resemble their real-life counterparts and share their vital and biographical information.”³⁰

Moreover, while users can change the digital avatar’s appearance and most of the vital statistics (height, weight, throwing distance, etc.), certain details remain immutable: the player’s home state, home town, team, and class year.³¹ The *NCAA Football* games do not include athlete names to abide by the NCAA Bylaws and maintain student-athlete amateurism.³²

In the *Hart* case (discussed in Section II.B, *infra*), a former student-athlete claimed that two aspects of the game violated his right of publicity. First, the game included an animated avatar of a quarterback wearing a Rutgers uniform with Hart’s physical and biographical attributes and career statistics, though not his name or photographic image.³³ Second, in the 2009 *NCAA Football* game, a photograph of Hart appeared in a montage when users selected Rutgers as their team.³⁴ Similarly, in *Keller* (Section II.C, *infra*), a former student-athlete sued the NCAA, EA, and CLC under, *inter*

²⁸ *Id.*

²⁹ *See id.*

³⁰ *Id.* (quotation marks omitted).

³¹ *Id.*

³² For the general principles regarding student-athlete amateurism, see NCAA Bylaw 12.01.

³³ *Hart*, *supra* note 19.

³⁴ *Id.*

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alia, federal Lanham Act claims, the right of publicity tort, and the Sherman Act.

II. SECOND DOWN: *Keller and Hart*

Two nearly identical lawsuits have been filed and appealed to the Supreme Court: *Hart*,³⁵ out of the Third Circuit, and *Keller*,³⁶ out of the Ninth Circuit. Both circuit courts applied the “transformative use” test (analyzed in Section III), and created a foundation for legal analyses in video games that lacks coherence and reliability. In this Section, I will explain the claims brought by the plaintiffs in the cases, as well as the facts and holdings of each case. In Section III, I will discuss the legal tests available for the courts and how each test has been applied, analyzing the strengths and weaknesses of each test. Section IV will conclude this Note, and discuss the best test for courts to apply in future cases where the First Amendment and right of publicity intersect.

A. The Legal Claims of the Student-Athletes

1. The Right of Publicity

The right of publicity is a state common law doctrine, even though it is often supported by legislation.³⁷ The doctrine is closely associated with the right to privacy because it extends the privacy right that people have in protecting their identity and controlling its use in a commercial setting. Specifically, the right of publicity protects individual rights, especially those associated with public figures or celebrities, to control the commercial value and exploitation of their name or likeness and prevent others from unfairly

³⁵ *Hart*, *supra* note 19 at 147.

³⁶ *In re NCAA*, *supra* note 10.

³⁷ See, e.g., Matzkin, M.G., *Gettin' Played: How the Video Game Industry Violates College Athletes' Rights of Publicity by Not Paying for Their Likeness*, 21 LOY. L.A. ENT. L. REV. 227 (2001).

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appropriating this commercial value.³⁸ The right was first recognized in 1953:

[I]n addition to and independent of [the] right of publicity. . . a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture . . . This right might be called a ‘right of publicity.’ For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likeness, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses [sic], trains and subways. 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.³⁹

Haelan Labs “essentially propertized the right” by stating that the right of publicity could be “licensed or assigned and enforced against third parties by the licensee or assignee,” thus enumerating a limited grant of commercial rights.⁴⁰ That same year, Joseph Grodin, a future California Supreme Court Justice, recognized the broader implications of the decision.⁴¹ He noted, “where

³⁸ Beth A. Cianfrone & Thomas A. Baker III, *The Use of Student-Athlete Likenesses in Sport Video Games: An Application of the Right of Publicity*, 20 J. LEGAL ASPECTS SPORT 35, 38 (2010) (citing *McFarland v. Miller*, 14 F.3d 912 (3d Cir. 1994)).

³⁹ *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

⁴⁰ *See id.*; see also Gloria Franke, Note, *The Right of Publicity vs. the First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CAL. L. REV. 945, 952 (2006) (citing *Healan Labs.*, 202 F.2d at 868).

⁴¹ Joseph Grodin, Note, *The Right of Publicity: A Doctrinal Innovation*, 62 YALE L. J. 1123, 1127-30 (1953).

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courts have sometimes held that plaintiff's privacy interest was out-weighted by the public's interest in news or information, the balance may now swing in plaintiff's favor if both his privacy and publicity interests are considered."⁴²

At first, courts appeared reluctant to embrace the right of publicity.⁴³ Gradually, however, the right of publicity "gained widespread judicial and scholarly acceptance."⁴⁴ The Supreme Court recognized the right of publicity in 1977, and finally codified the right of publicity tort in *Zacchini v. Scripps-Howard Broad. Co.*⁴⁵

The right of publicity, as applied, is "fundamentally constrained by the public and constitutional interests in freedom of expression."⁴⁶ Accordingly, the First Amendment should provide a broad defense against a right of publicity claim unless someone's name or likeness "is used solely to attract attention to a work that is not related to the identified person."⁴⁷ Specifically, the First Amendment should shield artistic works from liability unless a celebrity or athlete's (e.g.) image or likeness is used in a commercially exploitative manner.⁴⁸

Nevertheless, the intersection of the First Amendment and the right of publicity remains the subject of much debate and litiga-

⁴² *Id.* at 1128-29.

⁴³ See Madow, *supra* note 15 at 176.

⁴⁴ Michael "Bubba" Schoeneberger, Note, *Unnecessary Roughness: Reconciling Hart and Keller with a Fair Use Standard Befitting the Right of Publicity*, 45 CONN. L. REV. 1875, 1883-84 (2013) (citing *Cepeda v. Swift & Co.*, 415 F.2d 1205, 1207 (8th Cir. 1969)) (recognizing that a professional baseball star could grant an exclusive right to use an imprint of his name to a baseball manufacturer); *Uhlaender v. Henricksen* 316 F. Supp. 1277, 1281 (D. Minn. 1970) (holding that major league baseball players had a proprietary interest in their names, sporting activities, and accomplishments sufficient to enjoin unauthorized use for commercial purposes)).

⁴⁵ *Zacchini* 433 U.S. at 565-66.

⁴⁶ RESTATEMENT (THIRD) OF UNFAIR COMPETITION, § 47, cmt. C (1995).

⁴⁷ *Id.*

⁴⁸ For example, if a consumer would be confused whether that celebrity or athlete (e.g.) had endorsed a specific product or service.

tion. A Supreme Court ruling would hopefully provide guidance on balancing the competing interests of free expression and the protection against exploitation of a limited commercial right.

2. The Lanham Act

Another claim brought by the college and university student-athletes falls within the purview of the Lanham Act.⁴⁹ The Lanham Act § 43(a)⁵⁰ indicates that any person using a false or misleading designation or representation that uses another's goods, services, image, or likeness can be held liable.⁵¹ For the purposes of this Note, the Lanham Act claims will be separated from the right of publicity tort claims for purposes of analyzing the Third and Ninth Circuit's treatment of the claims in their respective legal determinations.

3. Other Claims

The Sherman Antitrust Act⁵² makes illegal any contract, conspiracy, or combination in restraint of trade.⁵³ The Sherman

⁴⁹ 15 U.S.C. § 1051, *et seq.* (1984).

⁵⁰ 15 U.S.C. § 1125 (1984) states:

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, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which – (A) 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, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

⁵¹ *Id.*

⁵² 15 U.S.C. § 1 (1890) states: "Every contract, combination . . . or conspiracy, in restraint of trade or commerce . . . is declared to be illegal."

⁵³ *Id.*

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Act also prohibits monopolization or attempts to monopolize.⁵⁴ The antitrust claims in this case are moving forward in a class action lawsuit against the NCAA. The antitrust implications of the *Hart* and *Keller* cases will not be addressed in this Note as they are still being resolved in the Northern District of California. The unjust

B. The *Hart* Case

Ryan Hart played quarterback for Rutgers University from 2002 to 2005.⁵⁵ In June 2009, Hart filed a putative class action lawsuit against Electronic Arts (“EA”) in New Jersey state court, alleging a violation of the right of publicity and other claims.⁵⁶ He sought hundreds of millions of dollars in damages on behalf of the putative class, and an injunction prohibiting the use of players’ identities in the future and mandating the destruction of all copies of *NCAA Football* in EA’s possession.⁵⁷ Hart based his right of publicity claim on the alleged use of his biographical information and likeness in the 2004, 2005, 2006, and 2009 editions of *NCAA Football*.⁵⁸ Specifically, he claimed that two aspects of the game were tortious: first, the game included an animated avatar of a quarterback wearing a Rutgers uniform with Hart’s physical and biographical attributes and career statistics, though not his name or photographic image.⁵⁹ Second, in the 2009 edition, a photograph of Hart appeared in a montage when users selected Rutgers as their team.⁶⁰

In September 2011, the District Court granted summary judgment for Electronic Arts, holding that the First Amendment barred Hart’s right of publicity claim.⁶¹ In May 2013, the Third

⁵⁴ See 15 U.S.C. § 2 (1890).

⁵⁵ *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 762 (D.N.J. 2011), *rev’d*, 717 F.3d 141, 145 (3d Cir. 2013).

⁵⁶ *Id.*

⁵⁷ *Id.*

⁵⁸ *Id.*

⁵⁹ *Id.* at 763.

⁶⁰ *Id.*

⁶¹ *Id.* at 787.

Circuit reversed and remanded.⁶² Nevertheless, the court rejected Petitioner’s First Amendment defense.⁶³ The Third Circuit surveyed the myriad legal standards that courts have applied in different jurisdictions to determine whether the First Amendment bars a right of publicity claim. The Third Circuit rejected other possible tests in favor of the “transformative use” test.⁶⁴ Applying this test, the Third Circuit held that the First Amendment did not protect *NCAA Football* against Hart’s right of publicity claim because the game did not sufficiently “transform” his likeness.⁶⁵

The court noted that the avatar matched Hart “in terms of hair color, hair style, and skin tone,” and that the avatar’s “accessories mimic those worn by [Hart] during his time as a Rutgers player.”⁶⁶ The court also emphasized the biographical information associated with the avatar, which “accurately tracks [Hart’s] vital and biographical details.”⁶⁷ The court summarized: “The digital Ryan Hart does what the actual Ryan Hart did while at Rutgers: he plays college football, in digital recreations of college football stadiums, filled with all the trappings of a college football game.”

⁶² At the same time, the court concluded that the First Amendment *did protect* the use of an actual photo of Hart as part of a montage within the video game because the image appeared fleetingly and because the context of the photograph imbued the image with additional meaning beyond simply being a representation of the player. *Hart*, 717 F.3d at 168. On June 25, 2013, the Third Circuit denied EA’s petition for rehearing and rehearing *en banc*, with two judges dissenting. The petition for writ of certiorari was filed on September 23, 2013. For further analysis on the majority and dissenting opinions, see the petition for a writ of certiorari. *Elec. Arts Inc. v. Hart*, 2013 WL 5324719 at *6-12 (2013).

⁶³ See *Hart*, 717 F.3d at 172 (Ambro, J., dissenting) (warning that the majority-fashioned test could be misapplied or inconsistent in case-by-case determinations, and should not have been applied based on the specific facts of the case at bar); See also *Hart*, 2013 WL 5324719, at *11. Judge Ambro issued a forceful dissent, arguing that the majority misapplied the transformative use test.

⁶⁴ *Hart*, 717 F.3d at 165-66. The court specifically rejected the *Rogers* and “predominant use” tests in favor of the “transformative use” test. See *infra* Section III for explanation of these tests.

⁶⁵ *Id.* at 168.

⁶⁶ *Id.* at 166.

⁶⁷ *Id.*

⁶⁸ The court went on, “This is not transformative; the various digitized sights and sounds in the video game do not alter or transform [Hart’s] identity in a significant way.”⁶⁹

C. The Keller Case

Samuel Keller played quarterback for Arizona State University in 2005, after which he transferred to the University of Nebraska, where he played football during the 2007 season.⁷⁰ In May 2009, Keller filed a putative class action lawsuit in the District Court for the Northern District of California against EA, the NCAA, and CLC.⁷¹ Keller alleged that the defendants had violated his California statutory and common law right of publicity, *inter alia*, and sought damages on behalf of the putative class, as well as an injunction prohibiting the use of players’ identities in the future and mandating the seizure and destruction of all copies of *NCAA Football* in Electronic Arts’ possession.⁷² The district court granted motions to consolidate Keller’s case with those of eight other college athletes.⁷³

Keller’s right of publicity claim was based on the alleged use of his biographical information and likeness in the 2005 and 2008 editions of *NCAA Football*.⁷⁴ He claimed the game included an animated avatar of a quarterback wearing Arizona State University and University of Nebraska uniforms with his physical and biographical attributes and career statistics, though not his name or photographic image.⁷⁵ The Ninth Circuit rejected the other possible tests, and reasoned that the tests developed to accommodate

⁶⁸ *Id.*

⁶⁹ *Id.*

⁷⁰ *In re NCAA*, *supra* note 10 at 1271.

⁷¹ *Id.* at 1272.

⁷² *See id.*

⁷³ *See id.*

⁷⁴ *Id.* at 1272.

⁷⁵ *Id.*

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First Amendment interests in the context of trademark law, focused on the risk of consumer confusion, should not apply.⁷⁶

The Ninth Circuit concluded that EA had no First Amendment defense to Keller's right of publicity claim.⁷⁷ In reaching that conclusion, the Ninth Circuit adopted a version of the "transformative use" test, derived from the California Supreme Court decision *Comedy III*.⁷⁸ Again, that test will be analyzed in Section III.C, *infra*.

The test the Ninth Circuit adopted is essentially identical to the one adopted by the Third Circuit in *Hart*.⁷⁹ Here, similarly, the Ninth Circuit held EA's alleged use of Keller's likeness "[did] not qualify for First Amendment protection as a matter of law because it literally recreate[d] Keller in the very setting in which he has achieved renown."⁸⁰

Notably, the same Ninth Circuit panel, in an opinion ("*Brown*") released the same day as *Keller*, held that the First Amendment provided EA with a defense to a Lanham Act claim brought by a former National Football League ("NFL") player in connection with another of its video games, *Madden NFL Foot-*

⁷⁶ *See id.* at 1280.

⁷⁷ *Id.* at 1274. Judge Thomas forcefully dissented, warning that the Court had engaged in a "potentially dangerous and out-of-context interpretation of the transformative use test." *Id.* at 1284 (Thomas, J. dissenting). The majority rejected Judge Thomas' warning that its opinion jeopardized a broad range of valuable expression on the theory that later courts could examine the "primary motivation" of those who were likely to *purchase* (rather than create) the work. The majority asserted that First Amendment protection would turn on whether the primary motivation of the buyer was to acquire the "expressive work of [an] artist" or to acquire a "reproduction of the celebrity." *Id.* at 1274.

⁷⁸ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001).

⁷⁹ *In re NCAA*, 724 F.3d at 1271 (holding that the video game did not sufficiently transform Keller's likeness because it portrayed Keller as what he was: the starting quarterback for Arizona State and Nebraska, and the game's setting was identical to where the public found Keller during his collegiate career: on the football field.) (quotation marks and alteration omitted).

⁸⁰ *Id.* at 1271.

ball.⁸¹ In *Brown*, rather than applying the “transformative use” test, the same panel applied the so-called *Rogers* test,⁸² and concluded that the video game was “entitled to the same First Amendment protection as great literature, plays, or books.”⁸³ The *Brown* court went on, “in this case, the public interest in free expression outweighs the public interest in avoiding consumer confusion.”⁸⁴ The *Keller* court cited the decision in *Brown*,⁸⁵ and acknowledged that the Keller class would have been “hard-pressed” to succeed on its right of publicity claim if the court had applied the same test to that claim.⁸⁶ Note that only two Ninth Circuit judges voted in the *Keller* case, and they split on the result. A Senior District Judge from the Western District of Michigan, sitting by designation, cast the deciding vote in *Keller*.⁸⁷

III. THIRD DOWN: Various Tests Applied in Right of Publicity Claims

A. The *Rogers* Test

*Rogers v. Grimaldi*⁸⁸ is a landmark Second Circuit case that balanced First Amendment protections against claims of misappropriation and exploitation. Ginger Rogers brought a state right of publicity claim and a federal Lanham Act claim against the makers of a Federico Fellini film entitled “Ginger and Fred.”⁸⁹ The film was not about Ginger Rogers and Fred Astaire, but about a fictional Italian duo that imitated them and become known in Italy as “Ginger and Fred.”⁹⁰

⁸¹ See *Brown v. Elec. Arts Inc.*, 724 F.3d 1235 (9th Cir. 2013).

⁸² Analyzed in Section III.A, *infra*.

⁸³ *Brown*, 724 F.3d at 1248.

⁸⁴ *Id.*

⁸⁵ *In re NCAA*, 724 F.3d at 1281.

⁸⁶ See *id.*

⁸⁷ See *In re NCAA*, 724 F.3d 1270.

⁸⁸ *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

⁸⁹ *Id.* at 996-97.

⁹⁰ *Id.*

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The *Rogers* court recognized that “[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection,” but that “[t]he purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product.”⁹¹ The *Rogers* court determined that titles of artistic or literary works were less likely to be misleading than “the names of ordinary commercial products,” and that Lanham Act protections applied with less rigor when considering titles of artistic or literary works than when considering ordinary products.⁹² The court concluded, “[i]n general the [Lanham] Act should be construed to apply to artistic works *only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.*”⁹³ Accordingly, the *Rogers* court held:

In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the [Lanham] Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title *explicitly misleads as to the source or the content of the work.*⁹⁴

Under the *Rogers* test, an expressive work enjoys First Amendment protection against a right of publicity claim unless the use of the individual’s likeness is unrelated to the work, or merely serves to create a false impression that the individual has “endorsed” a product or expressive work.⁹⁵ The two prongs of the *Rogers* test include: (1) the use an individual’s image or likeness, and (2) an intent to mislead, or explicitly misleading a consumer as to the source or content of the work.⁹⁶ Thus, the artistic work cannot merely “confuse” a consumer—trademarks, for example, should not be captured by the *Rogers* test—but must actually

⁹¹ *In re NCAA*, 724 F.3d at 1279 (citing *Rogers*, 875 F.2d at 997).

⁹² *Id.* (citing *Rogers*, 875 F.2d at 999-1000).

⁹³ *Rogers*, 875 F.2d at 999 (emphasis added).

⁹⁴ *Id.* (emphasis added).

⁹⁵ *Id.* at 1003-04.

⁹⁶ *See id.* at 1004.

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mislead a consumer as to the individual's endorsement. Some examples might include falsely claiming a celebrity endorsement, including a celebrity image gratuitously, or attracting commercial attention through the individual's image or likeness. As the *Rogers* court stated, "[c]onsumers of artistic works have a dual interest: they have an interest in not being misled and they also have an interest in enjoying the results of the author's freedom of expression."⁹⁷

The *Rogers* court explained that the First Amendment protects the use of a person's name in a film title from a Lanham Act claim unless the use was "wholly unrelated to the movie or was simply a disguised commercial advertisement for the sale of goods or services."⁹⁸ In applying its newly developed framework, the court found that the title was artistically relevant to the film because the nicknames "Ginger" and "Fred" were not arbitrarily chosen to exploit the publicity of the real-life Ginger Rogers and Fred Astaire, but rather because of a genuine relevance to the story and message of the film.⁹⁹ The court also found that the title was not explicitly misleading because "Ginger and Fred" contained no overt indication that Ginger Rogers "endorsed the film or had a role in producing it."¹⁰⁰ Further, the court held that any risk of misunderstanding by the public as to Ginger Rogers's involvement with the film was "outweighed by the interests [of] artistic expression."¹⁰¹ Accordingly, the First Amendment precluded liability under the Lanham Act.¹⁰²

In subsequent decisions, and in other circuits, the *Rogers* test gained acceptance beyond the mere "title" of an expressive work. Starting the analysis with the Ninth Circuit, and moving through the Fifth, Sixth, and Eleventh Circuits, many courts have

⁹⁷ *Id.* at 998.

⁹⁸ *Id.* at 1004 (internal quotation marks omitted).

⁹⁹ *Id.* at 1001.

¹⁰⁰ *Id.*

¹⁰¹ *Id.*

¹⁰² *Id.*

applied the *Rogers* test to image and likeness misappropriation or exploitation claims.

The Ninth Circuit first endorsed the *Rogers* test for Lanham Act claims involving artistic or expressive works in *Mattel v. MCA*.¹⁰³ The Ninth Circuit adopted the *Rogers* standard when it found that, in the context of artistic and literary titles, “[c]onsumers expect a title to communicate a message about the book or movie, but they do not expect it to identify the publisher or producer.”¹⁰⁴

Six years later, the Ninth Circuit held that Rock Star’s use of a logo and “trade dress” found protection under the First Amendment, and that it therefore could not be held liable under the Lanham Act.¹⁰⁵ In that case, a strip club owner claimed that the video game manufacturer “Rock Star” incorporated its strip club logo into the *Grand Theft Auto* series video game’s virtual depiction of Los Angeles, thus violating the club’s trademark right to that logo.¹⁰⁶ There, the court extended the *Rogers* test slightly, noting that “[a]lthough this test traditionally applies to uses . . . in the *title* of an artistic work, *there is no principled reason why it ought not also apply . . . in the body of the work.*”¹⁰⁷ Here, again, the analysis turned on the commercial and exploitative aspects of the expressive work. Namely, whether a consumer would be misled about an individual’s endorsement of a particular work.¹⁰⁸

In *Keller*, EA argued that the Keller court should extend the test to apply to right of publicity claims because the test is less prone to misinterpretation and more protective of free expression than the transformative use defense.¹⁰⁹ The Ninth Circuit dismissed that argument, and followed the jurisprudence of the Third

¹⁰³ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

¹⁰⁴ *In re NCAA*, 724 F.3d at 1280 (citing *Mattel*, 296 F.3d at 902).

¹⁰⁵ *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1096–98 (9th Cir. 2008).

¹⁰⁶ *Id.* at 1099-1101.

¹⁰⁷ *Id.* at 1099 (emphasis added).

¹⁰⁸ *See id.* at 1099-01.

¹⁰⁹ *In re NCAA*, *supra* note 10 at 1280.

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Circuit *Hart* decision.¹¹⁰ The court reasoned that the right of publicity is not intended to protect consumer confusion.¹¹¹ “As the history and development of the *Rogers* test makes clear, it was designed to protect consumers from the risk of consumer confusion—the hallmark element of a Lanham Act claim.”¹¹²

The *Keller* court declined to use the *Rogers*, or any other commercial-based test. The *Keller* court stated “[t]he right of publicity protects the *celebrity*,¹¹³ not the *consumer*. Keller’s publicity claim is not founded on an allegation that consumers are being illegally misled into believing that he is endorsing EA or its products.”¹¹⁴

State-law right of publicity claims reach commercial uses for movies and video games, but a backstop must exist where the court can say that a State has overstepped its right of publicity protection. That backstop is First Amendment protection. Many other courts have applied the *Rogers* test, or a similar standard, to delineate First Amendment limits in right of publicity claims.¹¹⁵ Among these are the Fifth,¹¹⁶ Sixth,¹¹⁷ and Eleventh¹¹⁸ Circuits, along with the Supreme Courts of Florida¹¹⁹ and Kentucky.¹²⁰

¹¹⁰ *Id.*

¹¹¹ *Id.*

¹¹² *Id.*

¹¹³ *Id.* at 1281. While the issue of “celebrity status” of college or university student athletes could be worthwhile legal question, that issue will not be addressed in this Note.

¹¹⁴ *Id.* (emphasis in original).

¹¹⁵ See, e.g., *Matthews v. Wozencraft*, 15 F.3d 432, 440 (5th Cir. 1994); *Parks v. LaFace Records*, 329 F.3d 437, 461 (6th Cir. 2003); *Valentine v. C.B.S., Inc.* 698 F.2d 430, 430 (11th Cir. 1983); *Montgomery v. Montgomery*, 60 S.W.3d 524, 529 (Ky. 2001); *Tyne v. Time Warner Entm’t Co. L.P.*, 901 So. 2d 802, 810 (Fla. 2005).

¹¹⁶ In *Wozencraft*, *supra*, the Fifth Circuit cited *Rogers*, and concluded that the First amendment barred a right of publicity claim based on a fictionalized, but accurate, account of an undercover police officer’s experiences.

¹¹⁷ In *Parks*, *supra*, the Sixth Circuit adopted the *Rogers* test and remanded to determine whether the use of plaintiff’s name in the musical group OutKast’s

The Fifth Circuit applied a test similar to *Rogers*, and concluded that the First Amendment barred a right of publicity claim based on a novel's (and future movie's) fictionalized, but accurate, account of an undercover police officer's experiences.¹²¹ The Fifth Circuit cited Posner, and reasoned that "[t]he tort of misappropriation of name or likeness . . . creates property rights only where the failure to do so would result in the *excessive exploitation of its value*."¹²² Thus, the exploitation of commercial value was the central feature of Posner's analysis. Public misperceptions of commercial exploitation leave little room for subjective judgments. Similarly, questions of celebrity endorsement would require little subjective analysis.

Randall Coyne reached a parallel inference, proposing that "to the extent [the] plaintiff's acquisition of fame is unrelated to his creative or intellectual efforts, his assertion of publicity rights is undermined."¹²³ Thus, the courts can incentivize celebrities to create and protect their "image" while also disallowing celebrity monopolies over rights that the public is largely responsible for creating.¹²⁴

"Rosa Parks" song title was "disguised commercial advertisement" that would remove it from First Amendment protection.

¹¹⁸ In *Valentine*, *supra*, the Eleventh Circuit construed the Florida right of publicity statute to allow the use of a person's name except to directly promote a product or service.

¹¹⁹ The Florida Supreme Court in *Tyne*, *supra*, stated that, in light of First Amendment Constraints, the state's right of publicity does not bar the use of a name or likeness except to "directly promote a product or service."

¹²⁰ In *Montgomery*, *supra*, the Kentucky Supreme Court held that a right of publicity claim may only proceed if the use of a person's name or likeness is not sufficiently related to the underlying work, or if the work is simply disguised as a commercial advertisement for the sale of goods or services.

¹²¹ *Wozencraft*, *supra* note 115.

¹²² *Id.* at 438.

¹²³ See Randall T.E. Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781, 819 (1988).

¹²⁴ See Schoeneberger, *supra* note 44, at 1911-12 (citing Randall Coyne, *supra* note 125 at 819; Madow, *supra* note 15, at 179, 196).

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The public could, in effect, “enjoy the benefits of [celebrity status] by enlarging the public domain and First Amendment protections.”¹²⁵ News media, advertisers, and artists should not feel a chilling of First Amendment protection because of a broad right of publicity, when a publicly-created the celebrity status is made into a fictionalized, but accurate account (through documentary, painting, or advertisement). “Unlike the goodwill associated with one’s name or likeness, the facts of an individual’s life possess no intrinsic value that will deteriorate with repeated use.”¹²⁶ Notwithstanding the juxtaposition of advertising (commercial use) and newspaper (informational use), the Fifth Circuit was reserved whether to engage in a qualitative analysis; to distinguish mediums where the court would have to determine the degree of commercial value or the sufficiency of the “artistic” quality of a particular work.¹²⁷ This application of the *Rogers* test stands in direct opposition to the transformative use test, as will be discussed in Subsection C.

The Sixth Circuit also implemented the *Rogers* test in order to determine whether the rap duo OutKast’s song “Rosa Parks” misappropriated Parks’ name, image, or likeness.¹²⁸ The court remanded the case based on the *Rogers* analysis.¹²⁹ There, the court observed:

The *Rogers* court made an important point . . . ‘[p]oetic license is not without limits. The purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product.’ The same is also true regarding the content of a song. The purchaser of a song titled *Rosa Parks* has a right not to be misled regarding the content of that song. . . . ‘A misleading title with no artistic relevance cannot be sufficiently justified by a free

¹²⁵ *Id.*

¹²⁶ *Wozencraft*, *supra* note 115 at 438-39.

¹²⁷ *See id.*

¹²⁸ *Parks*, *supra* note 115.

¹²⁹ *Id.* at 463.

expression interest,' and the use of such a title, as in the present case, could be found to constitute a violation of the Lanham Act. Including the phrase 'move to the back of the bus' in the lyrics of this song, in our opinion, does not justify, as a matter of law, the appropriation of Rosa Parks' name for the title to the song, and the fact that the phrase is repeated ten times or fifty times does not affect the question of the relevancy of the title to the lyrics.¹³⁰

The court continued, "The same is no less true today and applies with equal force to musical compositions [W]e, as judges, do not presume to determine the artistic quality of the [work] in question . . ." ¹³¹ Where subjective analysis stands at the center of the transformative use test, commercial exploitation stands at the center of the *Rogers* test. Broad freedom of expression should be granted unless the public would be confused about a celebrity's possible endorsement of a particular product or service. Where no confusion exists, the First Amendment should prevail.

The Sixth Circuit went on to cite Justice Holmes: "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."¹³² Again, subjective judgments should not stand at the center of artistic valuations, especially when balancing the right of publicity against the freedom of expression. Mirroring the Fifth Circuit, the Sixth Circuit was reticent to engage in qualitative valuations of an artistic work, or to engage in determinations of an individual's enigmatic "value" and the degree of possible exploitation of that value. Where the Third and Ninth Circuits adopted a test based on purely qualitative valuations and enigmatic "degrees," the *Rogers* test leaves a bright-line standard where a work either falls into a category of First Amendment protection, or not.

¹³⁰ *Id.* at 453 (quoting *Rogers*, *supra* note 88 at 997, 999).

¹³¹ *See id.*

¹³² *Id.* at 463 (quoting *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903)).

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The common theme in *Rogers*-based tests is the legal standard that the “First Amendment protects the depiction of an individual within an expressive work, unless the depiction amounts to an unauthorized commercial endorsement or is *unrelated to any other expression . . .*”¹³³ Many courts have engaged in balancing tests that weigh First Amendment protections against the economic interests protected by the right of publicity, without considering the “transformation” of an image or likeness.¹³⁴ Indeed, the right of publicity must be “narrowly tailored to support a right that protects the pecuniary value of a celebrity’s identity, encourages the growth of that value to protect the individuals who hold it, and protects the consuming population, *but does not overstep the boundaries of free speech.*”¹³⁵

¹³³ See, e.g., *Elec. Arts Inc. v. Hart*, 2013 WL 5324719 at *16 (2013); *Elec. Arts Inc. v. Keller*, 2013 WL 5324721 at *17 (2013) (emphasis added).

¹³⁴ See, e.g., *C.B.C. Distrib. & Mktg, Inc. v. Major League Baseball Advanced Media, LP*, 505 F.3d 818 (8th Cir. 2007) (holding that the First Amendment protected fantasy baseball products that used the names of real players, biographical data, and performance statistics); *Cardtoons*, *supra* note 14 at 968-70 (holding that the creator of parody baseball cards featuring recognizable caricatures of real baseball players were expressive speech “subject to full First Amendment protection.”). The “predominant use” test, analyzed in Section III.B, below, also serves as a balancing test that examines the “predominant exploitation” of the “commercial value of an individual’s identity.” See *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003).

¹³⁵ Susannah M. Rooney, Note, *Just Another Brow-Eyed Girl: Toward a Limited Federal Right of Publicity Under the Lanham Act in a Digital Age of Celebrity Dominance*, 86 S. CAL. L. REV. 921, 928-29 (2013) (emphasis added); see also Schoeneberger, *supra* note 44 at 1900 (“The myriad tests fail to give courts a principled and consistent method of resolving the frequent interaction of the right of publicity and the First Amendment . . . [furthering] the need to create a uniform, unambiguous standard to protect the right of publicity while maintaining a robust public domain.”); but see Neil G. Hood, Note, *The First Amendment and New Media: Video Games as Protected Speech and the Implications of the Right of Publicity*, 52 B.C. L. REV. 617, 649 (2011) (“Prescribing categorical protection to an overly broad definition of video games inappropriately forces right of publicity claims involving all games into the balancing test meant to weigh constitutionally protected expression against an individual’s ability to control his own identity”).

After an examination of the various tests created by our Circuit courts, it appears that the Rogers test applies the most robust First Amendment protection of any test fashioned to date. The *Rogers* test should be applied, not just in cases involving the Lanham Act, but in cases involving the right of publicity as well. Unless and until the Supreme Court fashions a test more fitting to balance the delicate rights afforded by the First Amendment for free expression against the growing abuse of “image and likeness” claims in all artistic mediums, the *Rogers* test is also the most predictable. Further, the *Rogers* test is advantageous to courts because “image and likeness” claims would automatically fall into the category of *Rogers* scrutiny, followed by the two prong analysis: (1) *whether the individual’s image and likeness is actually used*; and (2) *whether the artistic work intentionally or explicitly misleads* a consumer as to the source of the work. As we will see, without such a bright-line rule, courts will not only have to engage in qualitative analyses of artistic works, but would also have to determine whether the works, if “sufficiently transformative” *should* get First Amendment protection.

A broadly applied *Rogers* test would protect artistic works such as documentaries, music, and certain television programming, social commentary, advertisements, and video games, without qualitative valuations into the artistic sufficiency of the works. Such a consistent, bright-line test is the best way for courts to evaluate the intersection of the right of publicity with the First Amendment.

The next subsections will evaluate the other commonly applied tests in right of publicity and Lanham Act § 43(a) claims. First, I will explain the “predominant use” test origins and applications in Subsection B. The transformative use test will be explained in Subsection C. Finally, in Subsection D, I will address the application of the transformative use test, paying special attention to the gaps, redundancies, and inconsistencies in the test.

B. The Predominant Use Test

In 2003, the Missouri Supreme Court established the “predominant use” test, which balances whether a product being sold “predominantly” exploits the commercial value of an individual’s identity.

The test was first explained in *TCI Cablevision*.¹³⁶ In *TCI Cablevision*, Anthony “Tony” Twist, a former professional hockey player, sued Todd McFarlane, the creator of the Spawn comic series, for the improper use of his name and likeness for a character in the comic named “Tony Twist.”¹³⁷ During Twist’s hockey career, he garnered fame for his aggressive play, and was known as the league’s preeminent “enforcer” (a player whose chief responsibility is to protect teammates from physical assaults by opponents).¹³⁸ Todd McFarlane, a well-known hockey fan, used the moniker “Anthony ‘Tony Twist’ Twisteli” to a New York mafia boss in his comic series.¹³⁹

The Missouri Supreme Court recognized that the real and fictional Tony Twists bore no physical resemblance to each other.¹⁴⁰ The court also determined that, aside from the common nickname, the two “Tonys” were similar only insofar as each could be characterized as having an enforcer or tough guy persona.¹⁴¹ Notwithstanding the lack of similarities, the court held for the plaintiff, stating “the use and identity of Twist’s name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression . . . [thus,] free speech must give way to the right of publicity.”¹⁴²

Ultimately, the court determined that speech received First Amendment protection against a right of publicity claim only if its

¹³⁶ *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003).

¹³⁷ *Id.* at 365

¹³⁸ *See id.* at 366.

¹³⁹ *Id.*

¹⁴⁰ *Id.*

¹⁴¹ *See id.*

¹⁴² *Id.* at 374.

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predominant purpose was to make an expressive comment on, or about, a celebrity.¹⁴³ If, on the other hand, the speech “predominantly exploit[ed] the commercial value of an individual’s identity,” the expressive work would be subject to liability under the right of publicity, “even if there [wa]s some expressive content in it.”¹⁴⁴ In devising its test, the Missouri Supreme Court specifically rejected the transformative use test.¹⁴⁵

Some have argued that the “predominant use” test may be the only avenue to overcome over-inclusive, categorical video game protection.¹⁴⁶ “As opposed to the other tests, the predominant use test gives greater weight to the fact that ‘many uses of a person’s name and identity have both expressive and commercial components.’”¹⁴⁷ Notwithstanding the inherent failing in deter-

¹⁴³ See *id.* (emphasis added); see also Hood, *supra* note 135 at 648.

¹⁴⁴ *TCI Cablevision*, *supra* note 136 at 374 (quotation marks omitted).

¹⁴⁵ *Id.*

¹⁴⁶ Hood, *supra* note 135 at 648. Hood evaluates the various tests applied by the courts in his Note, and determines that over-inclusive, categorical protection for video games would “inappropriately force[] right of publicity claims involving all games into the balancing test meant to weigh constitutionally protected expression against an individual’s ability to control his own identity . . . extend[ing] the constitutional protection too far.” *Id.* at 649. With that point, I agree. Hood goes on to conclude that the predominant use test best weighs the person’s identity in light of “both expressive and commercial components.” *Id.* In this Note, I refute his conclusion, because the *Rogers* test should apply broadly to categories of misappropriation that include both Lanham Act § 43(a) and right of publicity claims in order to provide robust First Amendment protection while not chilling rights achieved by “celebrities” and others looking to protect their publicity rights. I also conclude that the predominant use test, if applied to facts and issues that arise in *Keller* and *Hart* would run roughshod over the NCAA regulations that promote amateurism and prohibit NCAA student-athletes from obtaining compensation while in college. See NCAA Bylaws § 12.01. Further, if Hood’s test were applied in the *Hart* and *Keller* cases, the courts would be faced with the task of balancing “commercial exploitation” in the virtual (indeed, artificial) world of video games on a case-by-case, fact-specific basis. The test would essentially work upside-down, through a fact specific inquiry into the degree of exploitation versus the degree of artistry – a test that would inundate the courts and chill the broad expressive protections granted by the First Amendment.

¹⁴⁷ *Id.* at 641 (quoting *TCI Cablevision*, *supra* note 136 at 374).

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mining what “predominantly exploits” might mean in a given instance or with a specific artistic medium, the analysis itself would also have to determine the “commercial value” of an individual’s identity. Such an analysis would likely expose litigants to unsafe and unpredictable judicial scrutiny. For example, if the court determined that amateur athletes in the *NCAA Football* video games have a commercial value of zero, would that determination stand for all college and university student-athletes? Would the analysis under trademark or unfair competition claims differ, as it does in many courts today?¹⁴⁸ The same Ninth Circuit panel, on the same day, concluded that an athlete *could not receive compensation* for his image and likeness in a video game under Lanham Act § 43(a), but that another former student-athlete *might be able to receive compensation* for his image and likeness in a video game under the state-law right of publicity. Surely, the distinction cannot be so clear. Application of the predominant use test in either example might create even more opaque results.

Simply put, the predominant use test cannot sufficiently protect the First Amendment rights of artists. The test would inefficiently impose a duty on the courts to determine “commercial value,” “predominant exploitation,” and “sufficiency” of expressive content, much the same way the transformative use test tries to determine the “significance of transformative elements.” As will be seen, the two tests are in many ways mirror images. Both tests require top-down, fact-specific inquiries in order to determine

¹⁴⁸ Further, intellectual property rights are designed to encourage creativity through financial incentives, as opposed to inherent natural or moral rights. Compare Amy M. Adler, *Against Moral Rights*, 97 CAL. L. REV. 263, 266-71 (2009) (discussing the theory of moral rights, and the United States’ general rejection of moral rights), with Rooney, *supra* note 135 at 955 (2013) (arguing that a requirement of a trademark-based distinctiveness test, including secondary meaning and a showing of commercial value, and implementing the consumer confusion test to further protect free speech and allow for creativity, comment, and parody, would allow the right of publicity to maintain its integrity and protect the “brands” built by celebrities’ unique assets). A person’s commercial value could theoretically cede to the limited monopoly offered by the intellectual property right if the courts reached the conclusion described above. Thus, some balancing test appears to be the only solution.

qualitative valuations (e.g. “transformative elements,” or “commercial value”). The next Subsection discusses the origins and applications of the transformative use test.

C. The Transformative Use Test

Under the “transformative use” test developed by the California Supreme Court, a defendant’s use of a plaintiff’s likeness does not qualify for First Amendment protection as a matter of law if it literally “recreates [the plaintiff] in the very setting in which he has achieved renown.”¹⁴⁹ At its core, the test relies on qualitative judgments as to the “sufficiency” of transformative elements, in order to determine if the work departs “far enough” from a plaintiff’s image and likeness to render the work protectable under the First Amendment.

The defense is a “balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.”¹⁵⁰ When a work “contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it also less likely to interfere with the economic interest protected by the right of publicity.”¹⁵¹ Thus, the legal question turns on the “significance” of the “transformative” elements. As will become clear, this test results in incoherent and unpredictable results that

¹⁴⁹ *Comedy III*, *supra* note 78 at 799. In *Comedy III*, the plaintiff owned the rights associated with the comedy act known as “The Three Stooges,” and sought damages and injunctive relief for the reproduction and sale of charcoal drawings and lithographs using a likeness of The Three Stooges. *Id.* at 800. There, the court fashioned a test that applied a portion of “fair use” doctrine from copyright law to determine whether the First Amendment protected the drawings and lithographs. *Id.* at 807-08. The court avoided a “wholesale importation of the fair use doctrine,” because it stated at least two of the factors employed in the fair use test were not especially helpful in resolving the question presented, although it recognized that some aspects of the fair use defense are “particularly pertinent” to the test. *Id.* at 808.

¹⁵⁰ *Comedy III*, *supra* note 78 at 799.

¹⁵¹ *Id.* at 808.

favor a broad right of publicity over broad First Amendment protection for free expression.

The failings of this test include: (1) subjective judgments regarding artistic expression,¹⁵² (2) unpredictability due to those subjective judgments, (3) incoherence in judicial application of the standard due to the subjectivity of the analysis, and (4) substantial favoritism for individual privacy rights over the promotion of the useful arts¹⁵³ and the freedom of expression,¹⁵⁴ both of which are Constitutional guarantees.

1. Origins of “Transformative-ness”

The Supreme Court of California established the transformative use test in *Comedy III*.¹⁵⁵ That case concerned an artist’s production and sale of t-shirts and prints bearing a charcoal drawing of the Three Stooges.¹⁵⁶ The California court determined that

¹⁵² See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (Holmes, J.) (“It would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”). Judge Learned Hand famously expressed his views on subjective judgments in the copyright context: “[t]he test for infringement of a copyright is of necessity vague. . . . Obviously, no principle can be stated as to *when an imitator has gone beyond copying the idea, and has borrowed its expression*. Decisions must therefore inevitably be ad hoc.” *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960) (emphasis added). This view, shared by Hand, Holmes, and Cardozo has been viewed as critique against imposing subjective judgments into expressive works, which is precisely the *foundation* of the transformative use test.

¹⁵³ U.S. CONST., art. 1, § 8, cl. 8. The Constitution empowers Congress “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” *Id.*

¹⁵⁴ U.S. CONST., amend. I.

¹⁵⁵ *Comedy III*, *supra* note 78 at 799. Applying this test, the court concluded that the works violated the plaintiffs’ rights of publicity, and held that the court could “discern no significant transformative or creative contribution . . . the marketability and economic value of [the work] derives primarily from the fame of the celebrities depicted.” *Id.* at 810.

¹⁵⁶ *Id.*

while “[t]he right of publicity is often invoked in the context of commercial speech,” it could also apply in instances where the speech is merely expressive, but also noted that, when addressing expressive speech, “the very importance of celebrities in society means that the right of publicity has the potential of censoring significant expression by suppressing alternative versions of celebrity images that are iconoclastic, irreverent or otherwise attempt to redefine the celebrity’s meaning.”¹⁵⁷ Thus, while the “the right of publicity cannot, consistent with the First Amendment, be a right to control the celebrity’s image by censoring disagreeable portrayals,” the right, like copyright, nonetheless offers protection to a form of intellectual property that society deems to have social utility.¹⁵⁸

After briefly considering whether to import the “fair use” analysis from copyright law, the *Comedy III* court decided that only the first fair use factor, “the purpose and character of the use,” was appropriate.¹⁵⁹ Specifically, the *Comedy III* court found persuasive a Supreme Court holding¹⁶⁰ as to “whether and to what extent the new work is ‘transformative.’”¹⁶¹

The *Comedy III* court also explained that works containing “significant transformative elements” are less likely to interfere with the economic interests implicated by the right of publicity.¹⁶² The court was also careful to emphasize that “[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.”¹⁶³ The court ultimately held that the balancing test between the right of publicity and First Amendment turned on whether the celebrity likeness was “one of the raw materials from which an original work is synthesized, or whether the depiction or imitation of the

¹⁵⁷ Hart, *supra* note 19 at 159 (citing *Comedy III*, *supra* note 78 at 802-03).

¹⁵⁸ *Id.* (citing *Comedy III*, *supra* note 78 at 804).

¹⁵⁹ *Id.* (citing *Comedy III*, *supra* note 78 at 808).

¹⁶⁰ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

¹⁶¹ *Comedy III*, *supra* note 78 at 808 (citing *Campbell*, *supra* (emphasis added)).

¹⁶² *Id.*

¹⁶³ *Id.* at 809.

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celebrity is the very sum and substance of the work in question.”¹⁶⁴ In other words, “whether the 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.”¹⁶⁵

Few courts have applied the transformative use test and, consequently, there is not a significant body of case law related to its application. For example, in *Winter v. DC Comics*,¹⁶⁶ the Supreme Court of California revisited the transformative use test when two musicians, Johnny and Edgar Winter, who both possessed long white hair and albino features, brought suit against a comic book company over images of two villainous half-man, half-worm creatures, both with long white hair and albino features, named Johnny and Edgar Autumn.¹⁶⁷ As the brothers’ right of publicity claims necessarily implicated DC Comics’ First Amendment rights, the *Winter* court looked to the transformative use test.¹⁶⁸

In summarizing the test, the court explained that “[a]n artist depicting a celebrity must contribute something more than a merely trivial variation, [but must create] something recognizably his own, in order to qualify for legal protection.”¹⁶⁹ Thus, in applying the test, the *Winter* court held that, notwithstanding the apparent portrayals of Johnny and Edgar Winters, the books did not depict the brothers literally.¹⁷⁰ Instead, the plaintiffs were merely part of the “raw materials from which the comic books were synthesized. To the extent the drawings of the Autumn brothers resemble plaintiffs at all, they are distorted for purposes of lampoon, parody, or caricature half-human and half-worm [characters] in a

¹⁶⁴ *Id.* (internal quotation marks omitted).

¹⁶⁵ *Id.*

¹⁶⁶ *Winter v. DC Comics*, 69 P.3d 473, 476 (Cal. 2003).

¹⁶⁷ *Id.*

¹⁶⁸ *Id.* at 478.

¹⁶⁹ *Id.* (alteration in original) (quotation marks omitted).

¹⁷⁰ *Id.* at 479.

larger story, which is itself quite expressive.”¹⁷¹ Ultimately, the court rejected the brothers’ right of publicity claims.

Also in 2003, the Sixth Circuit decided *ETW*, a case focusing on a painting of Tiger Woods set among a collage of other, golf-related images.¹⁷² Rick Rush created paintings of famous figures in sports and famous sports events. A few examples included Michael Jordan, Mark McGuire, Coach Paul “Bear” Bryant, the Pebble Beach Golf Tournament, and the America’s Cup Yacht Race.¹⁷³ The defendant produced and successfully marketed limited edition art prints made from Rush’s paintings. The painting at issue, *Masters of Augusta*, included three views of Tiger Woods in different poses at the Masters Tournament in Augusta, Georgia, in 1997 (where Woods became the youngest player to win the Masters Tournament).¹⁷⁴ The painting included Woods’s caddy to the left, and his final round partner’s caddy to the right, as well as the Augusta National Clubhouse in the background and images of golfers Arnold Palmer, Sam Snead, Ben Hogan, Walter Hagen, Bobby Jones, and Jack Nicklaus.¹⁷⁵

The prints distributed by the defendant consisted of an image of Rush’s painting, which included Rush’s signature at the bottom right hand corner, as well as the title “Masters of Augusta.”¹⁷⁶ Beneath the title, in block letters of equal height, the defendant included the artist’s name, “Rick Rush,” as well as a legend, “Painting America Through Sports.”¹⁷⁷

When the defendant sold his prints, he enclosed a white envelope with literature including a large photograph of Rush, a description of his art, and a narrative description of the subject painting.¹⁷⁸ On the front of the envelope, Rush’s name appeared in

¹⁷¹ *Id.*

¹⁷² *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 918 (6th Cir. 2003).

¹⁷³ *Id.*

¹⁷⁴ *Id.*

¹⁷⁵ *Id.*

¹⁷⁶ *Id.*

¹⁷⁷ *Id.*

¹⁷⁸ *Id.*

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block letters inside a rectangle, which included the legend “Painting America Through Sports,” as well as a large reproduction of Rush's signature.¹⁷⁹ The back of the envelope included the words “Masters of Augusta,” and “Tiger Woods.”¹⁸⁰ Woods's name appeared in the narrative description of the painting twice in twenty-eight lines of text.¹⁸¹ The defendant published and marketed two hundred and fifty serigraphs and five thousand lithographs of *The Masters of Augusta* at an issuing price of \$700 for the serigraphs and \$100 for the lithographs.¹⁸²

The plaintiff filed suit in the United States District Court for the Northern District of Ohio, alleging myriad trademark infringement and unfair competition claims, as well as a right of publicity claim for Woods (under Ohio common law).¹⁸³ The defendant counterclaimed, seeking a declaratory judgment that the First Amendment protected Rush's art prints. The district court granted the defendant's motion for summary judgment and dismissed the case, and the Sixth Circuit affirmed.¹⁸⁴

The Sixth Circuit applied a combination of an ad-hoc approach and the transformative use test.¹⁸⁵ In holding that the collage “contain[ed] significant transformative elements,” the court compared it to the Three Stooges portraits from *Comedy III*, and noted that the collage “does not capitalize solely on a *literal depiction* of Woods.”¹⁸⁶ Instead, the “work consist[ed] 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.”¹⁸⁷ Thus, *ETW* fell somewhere within the transform-

¹⁷⁹ *Id.* at 918-19.

¹⁸⁰ *Id.* at 919.

¹⁸¹ *Id.*

¹⁸² *Id.*

¹⁸³ *Id.*

¹⁸⁴ *Id.*

¹⁸⁵ *See id.* at 920-38.

¹⁸⁶ *Id.* at 938 (emphasis added).

¹⁸⁷ *Id.*

ative use test, where the collage of painted images with added transformative aspects may or may not have “altered” the celebrity’s actual likeness.

As a result of the relative uncertainty surrounding the “sufficiency” of “transformative” elements, commentators have argued that the litany of different tests that each circuit has employed to resolve the right of publicity-First Amendment tension makes the issue ripe for Supreme Court review.¹⁸⁸ That conclusion appears undeniable when viewed in light of the multitude of possible results in any artistic medium (documentaries, for example) depicting an actual person, and the relevant inconsistency in determining whether a particular artistic work contains “sufficient transformative elements” to earn First Amendment protection.

The sufficiency of artistic transformative-ness is a qualitative valuation that is unfit for judicial scrutiny. The only result will be incoherence and inconsistency, resulting in a wide misapplication of the test.

2. The [Mis]Application of the Transformative Use Test

As stated earlier, a relative dearth of case law exists where the courts have chosen to use the transformative use test. In those cases, the determination usually turns first (implicitly) on the artistic medium being evaluated, evaluating the whole artistic work in question. The “transformative elements” portion of the test has varied from a difference in appearance and movement¹⁸⁹ to difference in setting and context.¹⁹⁰ No exhaustive list of factors or elements of “transformativeness” exists.

¹⁸⁸ See, e.g., Schoeneberger, *supra* note 44 at 1879 (citing Katie Thomas, *Image Rights v. Free Speech in Video Games Suit*, N.Y. TIMES, Nov. 16, 2010, at A1).

¹⁸⁹ See, e.g., Kirby, *infra*.

¹⁹⁰ See, e.g., No Doubt v. Activision Publ’g, Inc., 122 Cal. Rptr. 3d. 397 (Cal. Ct. App. 2011).

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In 2006, the California Court of Appeal decided *Kirby*,¹⁹¹ which addressed a musician's right of publicity claim against a video game company; the musician (Kirby) claimed that Sega misappropriated her likeness and signature phrases for purposes of creating a futuristic reporter.¹⁹² The court found similarities in appearance between Kirby and the futuristic reporter based on hairstyle, common phraseology, and clothing choice.¹⁹³ At the same time, the court held that differences between the two did exist—both in appearance and movement—and that the video game character was not a mere digital recreation of by.¹⁹⁴ Thus, the court concluded that the video game character passed the transformative use test.¹⁹⁵

Again, in 2011, the California courts confronted the right of publicity in a video game setting. *No Doubt*¹⁹⁶ centered on *Band Hero*, a game that allowed players to simulate performing popular songs within a rock band in time by selecting digital avatars to represent the player in an in-game band.¹⁹⁷ Some of the avatars were digital recreations of real-life musicians, including members of the band No Doubt.¹⁹⁸ After a contract dispute broke off relations between the band and the company, No Doubt sued, claiming a violation of their right of publicity; the California Court of Appeal applied the transformative use test.¹⁹⁹

The *No Doubt* court noted that “in stark contrast to the fanciful creative characters in *Winter* and *Kirby*,” the No Doubt (band) avatars could not be altered by players and thus remained

¹⁹¹Kirby, 144 Cal. Rptr at 607.

¹⁹² *Id.* at 608.

¹⁹³ *Id.* at 613.

¹⁹⁴ *Id.*

¹⁹⁵ *Id.* at 616-17.

¹⁹⁶ No Doubt v. Activision Publ'g, Inc., 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011).

¹⁹⁷ Hart v. Elec. Arts, Inc., 717 F.3d 141, 162 (3d Cir. 2013) (citing No Doubt, 122 Cal. Rptr. 3d. at 401).

¹⁹⁸ *Id.*

¹⁹⁹ *Id.*

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“at all times immutable images of the real celebrity musicians.”²⁰⁰ Yet, “even literal reproductions of celebrities can be ‘transformed’ into expressive works based on the context into which the celebrity image is placed.”²⁰¹ Looking to the setting and context of the *Band Hero* game, the court explained:

[T]he avatars perform [rock] songs as literal recreations of the band members. That the avatars can be manipulated to perform at fanciful venues including outer space or to sing songs the real band would object to singing, or that the avatars appear in the context of a videogame that contains many other creative elements, does not transform the avatars into anything other than the exact depictions of No Doubt’s members doing exactly what they do as celebrities.²⁰²

The court also noted that Activision’s use of highly realistic digital depictions of No Doubt was *motivated by a desire to capitalize on the band’s fan base*, “because it encourage[d fans] to purchase the game so as to perform as, or alongside, the members of No Doubt.”²⁰³ Thus, the court concluded that the video game’s use of No Doubt’s likenesses infringed the band’s right of publicity.²⁰⁴ Notice that the *No Doubt* court discussed the motivation or intent to capitalize on the source or endorsement of the image and likeness of the plaintiffs. That intersection falls squarely within the *Rogers* analysis.

In its application of the transformative use test, the *Keller* court outlined at least five factors found in *Comedy III* to be considered when determining whether a work is sufficiently trans-

²⁰⁰ See *No Doubt*, *supra* note 196 at 410.

²⁰¹ *Id.* (citing *Comedy III*, *supra* note 78 at 811).

²⁰² *Id.* at 411.

²⁰³ *Id.* (emphasis added).

²⁰⁴ *Id.* at 411-12.

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formative so as to obtain First Amendment protection.²⁰⁵ First if the “celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized,” it is more likely to be transformative than if “the depiction or imitation of the celebrity is the very sum and substance of the work in question.”²⁰⁶ Second, the work is protected if it is “primarily the defendant’s own expression,” as long as that expression is “something other than the likeness of the celebrity.”²⁰⁷ Third, “to avoid making judgments concerning the quality of the artistic contribution, a court should conduct an inquiry more quantitative than qualitative and ask whether the literal and imitative or creative elements predominate in the work.”²⁰⁸ Fourth, a subsidiary inquiry should be used in close cases: whether the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted.²⁰⁹ Lastly, when an artist’s skill and talent is subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the work is not transformative.²¹⁰ Again, the motivation or intent to capitalize on the source or endorsement of the image and likeness of the plaintiff falls squarely within the *Rogers* analysis as well, but with more coherent and consistent application.

²⁰⁵ See *In re NCAA*, 724 F.3d at 1270; J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 8:72 (2d ed. 2012); but see *In re NCAA*, 724 F.3d at 1285 (“Although these considerations are often distilled as analytical factors, Justice Mosk was careful in *Comedy III* not to label them as such. Indeed, the focus of *Comedy III* is a more holistic examination of whether the transformative and creative elements of a particular work *predominate over commercially based literal or imitative depictions*. The distinction is critical, because excessive deconstruction of *Comedy III* can lead to misapplication of the test. And it is at this juncture that I must respectfully part ways with my colleagues in the majority.”) (Sidney, J., dissenting) (emphasis added).

²⁰⁶ *Comedy III*, *supra* note 78 at 809.

²⁰⁷ *Id.* The Ninth Circuit recently stated that this factor asks whether a likely purchaser’s primary motivation is to buy a reproduction of the celebrity, or to buy the expressive work of the artist. *In re NCAA*, *supra* note 10 at 1274 (citing McCarthy, *supra* note 205).

²⁰⁸ *In re NCAA*, 724 F.3d at 1274 (citing *Comedy III*, 21 P.3d at 809) (internal quotation marks omitted).

²⁰⁹ *Id.*

²¹⁰ *Comedy III*, *supra* note 78 at 810.

Like the “predominant use” and *Rogers* tests, the transformative use test aims to balance the interest protected by the right of publicity against those interests preserved by the First Amendment.²¹¹ In *Hart*, the Ninth Circuit found that the transformative use test struck the best balance for analysis of right of publicity claims involving video games.²¹² The court declared that the test served as a “flexible,” yet “uniformly applicable analytical framework.”²¹³ The *Hart* court further reasoned that the test “excel[led] precisely where the other two tests falter[ed],” and stated that the “singular focus” on “whether the work sufficiently transforms the celebrity’s image or likeness” would allow the courts to “account for the fact that misappropriation can occur in any market segment, including those related to the celebrity.”²¹⁴

That evaluation seems misplaced, in light of the precedent. It is unclear what counts as “significant” under the transformative use test, it is unclear what satisfactorily “transforms” an image or likeness, and it is unclear whether artistic mediums categorically fall outside the bounds of right of publicity and into Lanham Act § 43. The *lack* of a singular focus, and *inconsistent* applicability of the “transformative” framework make this test effectively unpredictable. If a right of publicity claim does not sufficiently overcome the First Amendment right to free expression, then a Constitutional guarantee is chilled by common law tort. The Third and Ninth Circuits clearly cannot have intended to accept such a position. Yet, the analysis interpreted by those circuits has, in effect, affirmed that position.

The *Hart* court acknowledged the inquiry focuses on the “specific aspects of a work that speak to whether it was merely created to exploit a celebrity’s likeness.” If the court had used this conclusion as the basis for its analysis (the point where “court must *begin*”²¹⁵), then the court would have assuredly reached the same

²¹¹ *Hart*, *supra* note 19 at 163.

²¹² *See id.*

²¹³ *Id.*

²¹⁴ *Id.*

²¹⁵ *See id.* (emphasis added).

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conclusion as in *Rogers* – that the protections afforded by the First Amendment outweigh the claims to personal right of publicity.

The *Rogers* conclusion does not necessarily negate the claim that “where no additional transformative elements are present—i.e., the work contains ‘merely a copy or imitation of the celebrity’s identity—then there can be no First Amendment impediment to a right of publicity claim.”²¹⁶ It does, however, achieve more than the simple lip service paid by the court to the, *inter alia*, video game industry.²¹⁷ In light of video games, documentaries, musical works, and all artistic mediums, the *Rogers* test achieves more robust First Amendment protection without sacrificing the right of publicity, and better serves as a coherent and stable test for the courts.

The negative inference from the Third and Ninth Circuit formulations is that a documentary or docudrama, for example, cannot find First Amendment protection *unless* the work contains sufficient expressive content or significant transformative elements. That conclusion would almost certainly not stand in those circuits. The court would essentially have to carve away at its video game analysis using a transformative use test that does not accurately define the scope of “sufficiency,” or what counts as “expressive content,” and provides over-flexibility to the right of publicity over First Amendment guarantees.

The court may not have initially realized that it was inviting a wide variety of results, yet future cases will inevitably show a lack of coherency. Applied most broadly, the transformative use test is volatile, inconsistent, and unpredictable. In applying this test, courts must place themselves in the role of critics, and make

²¹⁶ *Id.* at 164.

²¹⁷ *Id.* at 165. The *Hart* court quoted the dissenting opinion and noted that “adopting the [Transformative Use] Test ensures that already-existing First Amendment protections in right of publicity cases apply to video games *with the same force as to biographies, documentaries, docudramas, and other expressive works depicting real-life figures.*” *Id.* (quotation marks and citation omitted) (emphasis added).

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subjective judgments into artistic matter, which is a foreseeably “dangerous undertaking.”²¹⁸

Ultimately, courts have balanced First Amendment protection with the right of publicity by recognizing that “when artistic expression takes the form of a literal depiction . . . for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond the trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.”²¹⁹ Further, when a work contains “significant transformative elements” it *should* be both protected by the First Amendment and fall outside the realm of protection under right of publicity.²²⁰ Yet, the question remains which right should yield when “the line between informing and entertaining is too elusive”²²¹

The only clear answer is that the same test should apply to Lanham Act § 43(a) misappropriation and right of publicity torts. The bright line rule developed in *Rogers* may be the proper analysis for the courts, because it provides robust First Amendment protection while granting celebrities broad rights to establish and create their own expressive works for the limited monopoly over their image and likeness. Nevertheless, it seems clear the transformative use test is the incorrect test evaluating right of publicity claims in light of First Amendment protections moving forward.

²¹⁸ Compare *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (“It would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits”), and *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir.1989) (where the film’s title was protected unless “wholly unrelated to the movie or . . . simply a disguised commercial advertisement for the sale of goods or services”), with *Comedy III*, 21 P.3d at 881 (where an Andy Warhol portrait of Marilyn Monroe presented “a form of ironic social comment on the dehumanization of celebrity itself.”).

²¹⁹ *Hart*, *supra* note 19 at 807-08.

²²⁰ *See id.*

²²¹ *See Winters v. New York*, 333 U.S. 507, 510 (1948).

IV. FOURTH DOWN: Conclusion

On the one hand, the fact that both the Third Circuit and the Ninth Circuit reached the same result in applying the transformative use test, and used almost the same reasoning, significantly decreases the likelihood that the U.S. Supreme Court will grant review. On the other hand, the Fifth, Sixth, Eighth, and Eleventh Circuits have all used tests besides the transformative use test in order to determine the reach of First Amendment protection in right of publicity claims. If taken literally, the transformative use test would allow states to subject biographers, filmmakers, singers, photographers, and other artists to tort liability if their realistic images of, or references to, famous people are not “sufficiently transformative.” Either a new test should be fashioned by the Supreme Court, or the *Rogers* test should be applied to all misappropriation claims involving an individual’s image and likeness. That test grants broad First Amendment protection without chilling the right of publicity. The *Rogers* test also serves as a bright-line rule by which the courts do not have to engage in the factual or aesthetic analyses of the “artistic elements” or the sufficiency of expression in any artistic work.

The *Rogers* test would protect artistic works such as documentaries, music, and certain television, social commentary, certain advertisements,²²² and video games, *without qualitative*

²²² *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir.1989). Some might argue that the *Rogers* test would not operate effectively at the margins where an advertisement implicitly, or seemingly, incorporates someone’s image or likeness. *See, e.g.*, *Mannion v. Coors Brewing Company*, 377 F. Supp. 2d 444 (S.D.N.Y. 2006) (where plaintiff’s copyrighted image of Kevin Garnett was altered by defendant to be used in an “urban” advertisement; the court held that the work did not infringe the copyright-holder’s right to produce derivative works because the two works were not substantially similar). In similar cases, a Lanham Act action would effectively mirror a right of publicity action for the use of a celebrity’s image and likeness. The question would turn on consumer confusion (i.e. whether the ordinary consumer would think that the celebrity endorsed the product or service). The distinction is not stark, but the *Rogers* test simply imposes a more stringent, consistent, and predictable set of rules than the trans-

valuations into the artistic sufficiency of the works. Conversely, where other advertisements, endorsements, certain video games, or commercially exploitative artistic works might still violate the right of publicity without First Amendment protection, the *Rogers* test would serve as a bright-line test at the intersection of the right of publicity and the First Amendment. Such a bright-line rule is sorely needed where Constitutional guarantees meet rapidly evolving arts.

The *Rogers* test is the best way for courts to guarantee First Amendment rights while also providing a safety net for commercially exploitative uses of an individual's likeness. On certiorari, the Supreme Court should do away with the unpredictable, qualitative transformative use test and adopt the bright-line *Rogers* test, because, as exhibited by the disparity between the *Brown* and *Keller* opinions, the transformative use test cannot keep pace with today's evolving technology.

We return now, lastly, to the implications of a Supreme Court judgment on the NCAA as a highly profitable sports franchise. Strong arguments can be made that the NCAA exploits its student-athletes in order to bring in hundreds of millions of dollars in advertisements, endorsements, and donations. Those arguments are not misplaced. But the answer is not to simply pay student-athletes, nor to provide a royalty payment after graduation. The exploitation of student-athletes is unavoidable: the market is extremely profitable, and college and university sports are amateur sporting endeavors. The athletes compete for a limited time, while enrolled at a college or university. The NCAA will also likely continue its stranglehold on television licensing agreements. It appears that if the plaintiffs have any hope in this litigation, that hope may exist in the antitrust portion of the litigation.

Although the outcome of this pending case will rectify the circuit split at the intersection of First Amendment protection in right of publicity claims, it will also likely anger many student-

formative use test, with less subjective judgments on artistry and more concern for progressive arts and free expression.

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athletes. While the world of arts and technology will continue to rapidly evolve, it seems the world of NCAA student-athletics will not.