

ARTICLE

NO DOUBT ABOUT IT—YOU’VE GOT TO HAVE HART:

**SIMULATION VIDEO GAMES MAY REDEFINE THE
BALANCE BETWEEN AND AMONG THE RIGHT OF
PUBLICITY, THE FIRST AMENDMENT, AND COPYRIGHT
LAW**

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ABSTRACT

A few recent cases involving simulation video games have highlighted the difficulty of balancing the right of publicity with First Amendment rights. Courts have struggled to develop a definitive test because, among other things, there is significant variation in state right of publicity laws. Courts have experimented with different tests to try to balance the often-competing rights and interests. One of the most popular tests is the “transformative test,” which, fittingly, originates in the copyright doctrine of fair use—a doctrine that itself has a long history of conflict and coexistence with the First Amendment. I examine the history of the right of publicity, and I attempt to apply the various balancing tests in the context of simulation video games. I argue that courts must use a test that, first and foremost, places great weight on First Amendment expression. I also look at the future of efforts to balance competing interests between not only the right of publicity and the First Amendment, but also with copyright law.

INTRODUCTION

Several recent cases test the boundaries of, and the tensions among, several important rights, specifically, First Amendment freedoms of speech and press, the rights of privacy and publicity, and copyrights. The cases are similar—all involve simulation video games.¹ Two of the suits were brought by college

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¹ Simulation games have become a popular genre of computer and video games. Many started as simulation computer games but are probably more appropriately described today as simulation video games, as they are more frequently played on game consoles like Xbox 360 and PlayStation 3. Simulation football games, like Front Page Sports, were capable of simulating either the management of a team or the movement of the players. The latter has become more popular and games like Madden Football and NCAA Football dominate the

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football players. In separate actions, Sam Keller and Ryan Hart alleged that NCAA Football, a computer and video game made by Electronic Arts (“EA”), violated their respective rights of publicity.² In the other suit, the musical group “No Doubt” contended the use of its images and songs in Band Hero, a video game made by Activision, exceeded the scope of the license, thereby violating the rights of publicity of the individual band members.³ Courts rendered contradictory decisions in these actions, granting a motion for summary judgment for EA in the *Hart* case, but denying EA’s motion to dismiss in the *Keller* case and affirming denial of a motion to strike a right of publicity claim in the *No Doubt* case.⁴

As is often the case, technology drives the law. These cases present new twists for courts to navigate regarding the balances and tensions between and among these rights. They also present new questions that can be anticipated by further technological advancements in gaming. In Part I of this paper, I present three scenarios that introduce different factors that create tension between and among First Amendment rights, copyright law, and the rights of privacy and publicity. In Part II, I discuss these video game cases in greater detail and explore the history of these tensions. In Part III, I revisit the scenarios and discuss possible ramifications for the future.

PART I

A. *Scenario 1—History*

1. Example 1

A historian writes a book about the Revolutionary War. It recounts in great detail the contributions and actions by participants, such as George Washington, Nathanael Greene, and Henry Knox. The book contains a number of old drawings of these characters.

2. Example 2

A video game company creates a simulation game about the Civil War. It contains great historical detail and includes many images and photographs of Abraham Lincoln, Ulysses S. Grant, Robert E. Lee, and others. The characters

market today. Simulation music games, like Guitar Hero and Band Hero, permit users to simulate the playing of musical instruments in order to produce sound or movement similar to that of the original performer.

² *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 U.S. Dist. LEXIS 10719, at *7–8 (N.D. Cal. Feb. 8, 2010); *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 761 (D.N.J. 2011).

³ *No Doubt v. Activision Publ’g, Inc.*, 122 Cal. Rptr. 3d 397, 402 (Cal. App. 2011), *appeal denied*, No. S191787, 2011 LEXIS 6100 (Cal. June 8, 2011).

⁴ *Id.* at 411–12; *Hart*, 808 F. Supp. 2d at 794; *Keller*, 2010 U.S. Dist. LEXIS 10719, at *35.

look exactly like the deceased historical figures they represent.

3. Example 3

A video game company creates a simulation game about the recent wars in Iraq and Afghanistan. The game contains photographs and avatars that look precisely like Presidents George W. Bush and Barack Obama, as well as a number of other living participants.

B. Scenario 2—Sports

1. Example 1

A video game company creates a baseball simulation game containing players from the early part of the twentieth century, including Ty Cobb, Babe Ruth, and Honus Wagner. The game contains images and photographs of the players. Users of the game can choose to assume the persona of any of the available players and play the game from a first-person perspective of pitching, hitting, or fielding.

2. Example 2

A fantasy baseball company creates a game in which users can form leagues and draft current major league baseball players to their teams. Associated with the players are their names (and other biographical information, such as age and height), the names of the teams they currently play for, and a variety of statistics related to their performances from both the current and past seasons. There are neither images nor photographs of the players, nor are there any images or logos of the teams for which they play.

3. Example 3

A video game company creates a football simulation game that contains all Division I college football teams. The football players in the game do not have names associated with them, but they do have numbers and physical attributes similar to real-life college players who play that position. For example, the starting quarterback wears the same number that his real-life counterpart wore the previous season and resembles that person. Additionally, the performance and physical abilities of that player mimic that of the real-life counterpart.

C. Scenario 3—Music

1. Example 1

A video game company creates a music simulation game that contains performers and songs from before 1923. For example, users can select Al Jolson to perform “April Showers” and “You Made Me Love You,” or Enrico Caruso to perform “Over There” and “O Sole Mio.” Users can choose

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different backgrounds and venues for the performances and can adjust the volume of the songs.

2. Example 2

A video game company creates a music simulation game containing a number of popular songs that can be performed by avatars that precisely resemble the groups or individuals who made the songs famous. The users can manipulate game controllers to make the rendition of the performance better or worse. By achieving certain levels of success, the users can “unlock” some of the avatars to perform songs other than their own.

3. Example 3

A video game company creates a music simulation game that contains the top one hundred bands of all time, along with each band’s fifty most popular songs. Avatars for each band look exactly like the real-life members. Each of the hundred bands can perform every song included in the game in a style *unique* to that band. Furthermore, there is a “genius” mode that permits a user to enter anywhere from five to one hundred words and/or musical notes and the game will generate a song from those words and/or notes in the style and sound of any specified band. The performances can be saved and transferred to other forms of media.

PART II

It is almost axiomatic that the most interesting areas of the law are those attempting to balance “good,” but competing, rights. Several such areas of law are those that lie at the intersections of First Amendment rights, copyright law, and the rights of privacy and publicity. Unsurprisingly, there is a long history of cases and statutes that attempt to balance the sometimes-competing interests enunciated by the First Amendment and copyright law.⁵ The Bill of Rights

⁵ See, e.g., *Golan v. Holder*, 132 S. Ct. 873, 889–92 (2012); *Eldred v. Ashcroft*, 537 U.S. 186, 217–21 (2003); *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 555–59 (1985). In addition, *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1263–65 (11th Cir. 2001), provides an excellent history of Copyright Law and the First Amendment. The Court in *Eldred* stated that “[t]he Copyright Clause and First Amendment were adopted close in time. This proximity indicates that, in the Framers’ view, copyright’s limited monopolies are compatible with free speech principles. Indeed, copyright’s purpose is to promote the creation and publication of free expression.” *Eldred*, 537 U.S. at 219. *Suntrust* explained that “[t]he Copyright Clause and the First Amendment, while intuitively in conflict, were drafted to work together to prevent censorship; copyright laws were enacted in part to prevent private censorship and the First Amendment was enacted to prevent public censorship.”

Suntrust, 268 F.3d at 1263 (footnotes omitted) (quoting 1 NIMMER ON COPYRIGHT § 1.10(B)) (2001)). See generally Patrick Cronin, *The Historical Origins of the Conflict*

was ratified in 1789⁶ and Congress enacted the first copyright act in 1790.⁷ Over the years, a number of doctrines have emerged, with two in particular having great significance to the balance of First Amendment and copyright law. First and foremost, the fair use doctrine has often been described as providing the balance between the First Amendment and copyright law.⁸ Second, the idea/expression dichotomy provides additional balance between these two interests.⁹

Unlike First Amendment and copyright law, which both developed almost exclusively within the domain of federal law, the rights of privacy and publicity are primarily state law, and as such, vary greatly from state to state.¹⁰ The common law right of privacy was first recognized in Georgia in 1905.¹¹ A derivative right of publicity first emerged under New York law in 1953.¹² As is often the case, technology largely drove the evolution of these laws. Several cases in recent years, discussed below, have attempted to address the often-competing interests enunciated by these rights.

A. *The Recent Video Game Cases—An Introduction*

Video games are the backdrop for the most recent attempts to balance an individual's right of publicity with the First Amendment. Activision sold a video game called *Band Hero*, in which users can choose to be a guitarist, a

between Copyright and the First Amendment, 35 COLUM. J.L. & ARTS 221 (2012).

⁶ U.S. CONST. amends. I–X.

⁷ Copyright Act of 1790, 1 Stat. 124 (codified as amended at 17 U.S.C. §§101-1332 (2006)).

⁸ *Eldred* stated that “the ‘fair use’ defense . . . allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself for limited purposes.” *Eldred*, 537 U.S. at 190. In *Suntrust*, the court noted that the exceptions carved out for “purposes such as criticism, comment news reporting, teaching . . . , scholarship, or research” in the fair use statute of the Copyright Act “are at the heart of fair use’s protection of the First Amendment, as they allow later authors to use a previous author’s copyright to introduce new ideas or concepts to the public.” *Suntrust*, 268 F.3d at 1264 (internal quotations omitted). See also Pierre Laval, *Nimmer Lecture: Fair Use Rescued*, 44 UCLA L. REV. 1449, 1450–54 (1997).

⁹ *Eldred* explained how “copyright law contains built-in First Amendment accommodations,” that it distinguishes between ideas and expression and protects only the latter. *Eldred*, 537 U.S. at 219. The Court stated that because of the idea/expression dichotomy and the balance it strikes between the First Amendment and copyright law, “every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication.” *Id.* (citations omitted).

¹⁰ See *infra* notes 307–29 and accompanying text.

¹¹ *Pavesich v. New Eng. Life Ins. Co.*, 50 S.E. 68, 69, 80–81 (Ga. 1905); see *infra* notes 33–35 and accompanying text.

¹² *Haelan Lab., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953); see *infra* notes 37–39 and accompanying text.

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drummer, or a singer.¹³ Users can select to “perform” as a number of fictional or real-life characters, known as avatars.¹⁴ One of the groups included in Band Hero is No Doubt.¹⁵ No Doubt entered into a detailed licensing agreement with Activision, under which it granted Activision the rights to use No Doubt’s name, likenesses, logos, and trademarks in the game.¹⁶ It granted Activision the right to use up to three of No Doubt’s songs in the game. No Doubt also agreed to participate in a full-day motion capture photography session at Activision’s studio so that the appearances, movements, and sounds of the band members could be realistically reproduced in the game.¹⁷

Two weeks before the release of Band Hero, No Doubt learned that the game would contain a feature that would permit users to “unlock[.]” the band members’ avatars to perform songs other than the two No Doubt songs that Activision included in the game.¹⁸ Users would be able to make the No Doubt avatars sing other groups’ songs, in voices other than their own.¹⁹ No Doubt subsequently learned that Activision hired actors to impersonate the No Doubt band members in additional motion-capture photography sessions in order to re-create the appropriate movements for the performances of the non-No Doubt songs.²⁰ No Doubt demanded that Activision remove the “unlocking” feature that permitted players to use avatars of the band members to perform songs other than their own, but Activision refused.²¹ No Doubt sued Activision for six causes of action, including violation of statutory and common law right of publicity under California law.²²

Next, EA sells the very popular video game called NCAA Football.²³ In it, a user can choose to play with different college football teams, complete with rosters of players.²⁴ The players are identified by number and position, but not by name, although users can add names to the players so those names will then appear on the players’ uniforms.²⁵ Each player comes with a variety of pre-set attributes, like height, weight, speed, agility, passing ability, and hometown.²⁶ Some of these attributes can be edited (e.g., first name, last name, uniform

¹³ No Doubt v. Activision Publ’g, Inc., 122 Cal. Rptr. 3d 397, 401 (Cal. Ct. App. 2011).

¹⁴ *Id.*

¹⁵ *Id.* at 400–01

¹⁶ *Id.* at 402.

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ *Id.*

²⁰ *Id.*

²¹ *Id.*

²² *Id.* at 402–03.

²³ Hart v. Elec. Arts, Inc., 808 F. Supp. 2d 757, 760 (D.N.J. 2011).

²⁴ *Id.*

²⁵ *Id.* at 761.

²⁶ *Id.*

number) and some cannot be edited (e.g., hometown, home state, team, and year in school).²⁷ Additionally, users are able to download complete customized rosters of their favorite college football teams from EA, created by other users, that contain the attributes, including the names of all of the players on current or past teams.²⁸

Ryan Hart played quarterback for Rutgers University.²⁹ In four different versions of NCAA Football, the quarterback for Rutgers has attributes identical or similar to those of Hart.³⁰ For example, in the 2006 version of NCAA Football, the Rutgers quarterback is from Florida, wears number 13, is six foot two inches tall, weighs 197 pounds, wears a left-wristband—all like Hart—and has speed, agility, passing accuracy, and passing strength attributes that reflect Hart's 2005 performances on the field.³¹ Hart brought suit against EA, alleging that EA violated his right of publicity under New Jersey law by misappropriating and incorporating his identity and likeness for a commercial purpose.³²

Both of these cases involve the popular genre of simulation video games. In this genre of games, users take on the role of a sports player or manager, entertainer, or political or military leader. The characters and the attributes of the characters are usually based upon accurate data and information. As technology and graphics have improved, so has the realism of the game itself, both in the depiction and representation of the characters, and in the accuracy of the resulting simulated activity.

B. *The Right of Publicity*

The right of publicity descended from its elder cousin, the right of privacy. In fact, when Georgia became the first state to recognize the right to privacy in a civil case, it was for a claim that would later emerge as the prototypical right of publicity case.³³ In *Pavesich v. New England Life Insurance Co.*, the defendant used the plaintiff's photograph, without his consent, in an advertisement for the defendant's company.³⁴ The court held such use violated

²⁷ *Id.* at 761 n.3.

²⁸ *Id.*

²⁹ *Id.* at 763.

³⁰ *Id.*

³¹ *Id.*

³² *Id.* at 762–63; *see infra* notes 243–78 and accompanying text.

³³ *See Pavesich v. New Eng. Life Ins. Co.*, 50 S.E. 68 (Ga. 1905). The court used both natural law and constitutional protection against unreasonable searches and seizures to hold that the state and federal constitutions guaranteed the right to privacy. *Id.* at 69–71. Modern opinions in Georgia proudly recite the fact that the right to privacy “was birthed by this court.” *Cox Broad. Corp. v. Cohn*, 200 S.E.2d 127, 130 (Ga. 1973), *rev'd on other grounds*, 420 U.S. 469 (1975).

³⁴ *Pavesich*, 50 S.E. at 80–81.

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one's right of privacy and that neither of the freedoms of speech or press protected such use.³⁵

In a famous law journal article, Professor William Prosser gave form to four distinct invasion of privacy torts that are recognized by the vast majority of states today: (1) intrusion upon plaintiff's seclusion or solitude, or into his private affairs; (2) public disclosure of embarrassing private facts about the plaintiff; (3) publicity that places the plaintiff in a false light in the public eye; and (4) appropriation, for the defendant's advantage, of the plaintiff's name or likeness.³⁶ It is this fourth branch—appropriation of name or likeness—that *Pavesich* first recognized.

A similar situation also spawned the creation of a specific right of publicity. In *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, rival companies battled for the right to publish baseball cards with the pictures of professional baseball players.³⁷ At issue was whether the players had any protectable interest in marketing their images.³⁸ In finding such a right, the court used the term "right of publicity" for the first time, and held that "in addition to and independent of that right of privacy . . . a man has a right to grant the exclusive privilege of publishing his picture."³⁹ Today, over half the states recognize a right of publicity, either at common law or by statute.⁴⁰

1. California's Transformative Test in *Comedy III*

California recognizes both a common law and a statutory right of publicity.⁴¹ The California statute provides a right of publicity for a person's

³⁵ *Id.* at 71, 79.

³⁶ William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960); *see also* RESTATEMENT (SECOND) OF TORTS § 652 (1977). Every state but North Dakota and Wyoming recognizes these four torts. *See* Jordan M. Blanke, *Criminal Invasion of Privacy: A survey of Computer Crimes*, 41 JURIMETRICS J. 443, 445 (2001).

³⁷ *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 867 (2d Cir. 1953).

³⁸ *Id.*

³⁹ *Id.* at 868.

⁴⁰ 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 6:1 (2d ed. 2005). Eighteen states recognize a common law right of publicity: Arizona, Alabama, California, Connecticut, Florida, Georgia, Hawaii, Illinois, Kentucky, Michigan, Minnesota, Missouri, New Jersey, Ohio, Pennsylvania, Texas, Utah and Wisconsin. *Id.* at § 6:3. Eighteen states have a statutory right of publicity, nine of which also recognize the common law right: California, Florida, Illinois, Indiana, Kentucky, Massachusetts, Nebraska, Nevada, New York, Ohio, Pennsylvania, Rhode Island, Tennessee, Texas, Utah, Virginia, Washington and Wisconsin. *Id.* at § 6:3. Thus, a total of twenty-seven states recognize the right of publicity. For more information, *see generally* RIGHT OF PUBLICITY, <http://www.rightofpublicity.com> (last visited Dec. 11, 2012).

⁴¹ MCCARTHY, *supra* note 40, § 6:3.

name, voice, signature, photograph or likeness.⁴² One of the most important cases involving the right of publicity deals with this statute.⁴³ In *Comedy III Productions v. Gary Saderup, Inc.*, the California Supreme Court enunciated a test that attempts to balance the often-competing interests of the right of publicity and First Amendment expression rights.⁴⁴ The plaintiff owned the rights to the comedy team known as the Three Stooges.⁴⁵ The defendant was an individual artist who drew charcoal drawings of celebrities.⁴⁶ The corporate defendant made, reproduced, and sold lithographs and T-shirts containing the likeness of the Three Stooges.⁴⁷ The trial court found for the plaintiff, granting monetary damages and issuing an injunction.⁴⁸ The Court of Appeals affirmed

⁴² CAL. CIV. CODE § 3344 (West 2012) provides, in pertinent part:

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

(d) For purposes of this section, a use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required under subdivision (a).

(e) The use of a name, voice, signature, photograph, or likeness in a commercial medium shall not constitute a use for which consent is required under subdivision (a) solely because the material containing such use is commercially sponsored or contains paid advertising. Rather it shall be a question of fact whether or not the use of the person's name, voice, signature, photograph, or likeness was so directly connected with the commercial sponsorship or with the paid advertising as to constitute a use for which consent is required under subdivision (a).

California also has a parallel statute that provides similar rights for deceased personalities for up to 70 years after death. CAL. CIV. CODE § 3344.1 (West 2012). In addition to language similar to that stated above, the statute provides:

For purposes of this subdivision, a play, book, magazine, newspaper, musical composition, audiovisual work, radio or television program, single and original work of art, work of political or newsworthy value, or an advertisement or commercial announcement for any of these works, shall not be considered a product, article of merchandise, good, or service if it is fictional or nonfictional entertainment, or a dramatic, literary, or musical work.

Id. at (a)(2).

⁴³ As the court points out in its first footnote, the case was decided under the statute previously numbered § 990. After the court granted review of the case, the California legislature amended the statute and renumbered it. Its present designation is § 3344.1. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 799 n.1 (Cal. 2001).

⁴⁴ *Comedy III*, 21 P.3d 797.

⁴⁵ *Id.* at 800.

⁴⁶ *Id.*

⁴⁷ *Id.* at 800–01.

⁴⁸ *Id.* at 801.

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the judgment, but struck the injunction.⁴⁹ The California Supreme Court affirmed the judgment of Court of the Appeal.⁵⁰

The first issue addressed by the court was whether the statute covered the defendants' use of the Three Stooges's likeness.⁵¹ The defendants contended the statute only applied to the use of one's name or likeness for purposes of "advertising or selling."⁵² The court noted that when the legislature amended the statute in 1984, it inserted the language "on or in products, merchandise, or goods, *or*," thus providing language making one liable for the use, without consent, of a deceased personality's name or likeness "on or in products, merchandise, or goods, *or* for purposes of advertising or selling" those products, merchandise or goods.⁵³ The court gave effect to the plain meaning of the statute's language, holding that the statute applied to *either* the use of the person's name or likeness on or in a product *or* for purposes of advertising or selling that product.⁵⁴

The court then addressed the defendants' contention that their constitutional rights of free speech and expression would be violated by application of this statute.⁵⁵ First, the court discussed the line of cases holding generally that commercial speech is afforded less protection under the First Amendment than expressive speech, and that right of publicity may trump this type of speech.⁵⁶ The court cited the cases of *Waits v. Frito-Lay, Inc.* and *Midler v. Ford Motor Co.*, which both involved the use of sound-alike singers in advertisements to suggest or imply celebrity endorsement, and both found for the plaintiffs.⁵⁷ The *Comedy III* court held, however, that defendants' depiction of the Three Stooges was not an advertisement for, or endorsement of, a product, but rather an expressive work, worthy of heightened First Amendment protection.⁵⁸

The court then made a series of observations and holdings, most of which remain relevant and important for the simulation video game cases today: (1) that defendants' works do not lose their First Amendment protection because they are entertaining, rather than informing; (2) that the works retain their First Amendment protection, despite the fact that they take a nonverbal, visual form; (3) that a work of art is protected by the First Amendment even if it conveys no

⁴⁹ *Id.*

⁵⁰ *Id.* at 811.

⁵¹ *Id.* at 801–02.

⁵² *Id.* at 801.

⁵³ *Id.* (emphasis added).

⁵⁴ *Id.* at 802.

⁵⁵ *Id.* at 802–12.

⁵⁶ *Id.* at 802.

⁵⁷ *Id.* (citing *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988)); see *Waits*, 978 F.2d at 1096; *Midler*, 849 F.2d at 461.

⁵⁸ *Comedy III*, 21 P.3d at 802.

discernable message; and (4) that the works do not lose First Amendment protection simply for appearing on T-shirts.⁵⁹ The court stated that although the First Amendment gave substantial protection to noncommercial speech about celebrities, the First Amendment did not protect *all* speech about celebrities.⁶⁰ In an observation that foretells the balancing test the court later devised, the court compared the right of publicity to copyright law.⁶¹ The court later borrowed one of the primary devices used to balance the tension between copyright interests and the First Amendment—the doctrine of fair use.⁶²

The court also discussed *Zacchini v. Scripps-Howard Broadcasting Co.*, the only case in which the United States Supreme Court has addressed a right of publicity claim.⁶³ The plaintiff, Zacchini—the “Human Cannonball”—objected to a television station’s airing of his entire 15-second act.⁶⁴ The Supreme Court held that the First Amendment did not shield the station from liability for violating Zacchini’s right to publicity under Ohio law.⁶⁵ While the case has been narrowly interpreted, it stands for several important propositions: that federal copyright or patent law does not preempt a right of publicity, and that the First Amendment does not automatically trump a right of publicity.⁶⁶ Rather, the relative importance of the competing interests must be balanced.⁶⁷

The *Comedy III* court then examined a series of cases that used a variety of balancing tests.⁶⁸ In *Guglielmi v. Spelling-Goldberg Productions*, an heir of Rudolph Valentino objected to the making of a fictional film about Valentino.⁶⁹ The California Supreme Court rejected that claim and the Chief Judge, in a concurrence, proposed a balancing test to distinguish between the protected and unprotected appropriation of celebrity likeness: “an action for infringement of the right of publicity can be maintained only if the proprietary interests at issue clearly outweigh the value of free expression in this context.”⁷⁰ In *Estate of Presley v. Russen*, the District Court of New Jersey applied a similar balancing test in deciding a New Jersey common law right of publicity claim against a performer who had developed an Elvis impersonation

⁵⁹ *Id.* at 804.

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² *Id.* at 807–08.

⁶³ *Id.* at 805–06 (citing *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977)).

⁶⁴ *Zacchini*, 433 U.S. at 563–64.

⁶⁵ *Id.* at 578–79.

⁶⁶ *Comedy III*, 21 P.3d at 805.

⁶⁷ *Id.* at 806.

⁶⁸ *Id.* at 806–07.

⁶⁹ *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 455 (Cal. 1979), cited in *Comedy III*, 21 P.3d at 806.

⁷⁰ *Id.* at 461 (Bird, C.J., concurring).

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act.⁷¹ The court acknowledged that the defendant's act had some expressive content, but that its primary purpose was to appropriate the commercial value of the likeness of Elvis.⁷² The court stated that the strongest case for a right of publicity came from such a situation—where the appropriation is not of the celebrity's reputation, but rather “the appropriation of the very activity by which the entertainer acquired his reputation in the first place.”⁷³ This notion will surface again in the simulation video game cases. After comparing the balancing tests used by these different courts, the *Comedy III* court concluded that any test must recognize that a celebrity cannot control all uses of his or her image—that there will always be a right to comment on, parody, and make other expressive uses of that image.⁷⁴ A right of publicity is an economic right that does not provide a celebrity with a right of censorship, but rather a right to prevent the misappropriation of the value created by his or her fame.⁷⁵ This will also be an issue in the simulation video game cases.

The court then turned to the idea of importing a modified fair use test.⁷⁶ Fair use has long been recognized as the primarily tool used to balance the sometimes competing interests between copyright and the First Amendment.⁷⁷ The court focused on the first of the four fair use factors—the purpose and character of the use.⁷⁸ It quoted language from Justice Story that was itself quoted in *Campbell v. Acuff-Rose Music, Inc.*, the last word by the Supreme Court on fair use and transformative use.⁷⁹ The inquiry should be whether the work “adds something new, . . . altering the first with new expression, . . . [and] whether and to what extent the new work is ‘transformative.’”⁸⁰ The court noted that both copyright law and the First Amendment share the goal of encouraging free expression and creativity, because the right of publicity, like copyright law, attempts to protect “the creative fruits of intellectual and artistic

⁷¹ Estate of Presley v. Russen, 513 F. Supp. 1339, 1344 (D.N.J. 1981), cited in *Comedy III*, 21 P.3d at 806–07.

⁷² *Id.* at 1358–59.

⁷³ *Id.* at 1361.

⁷⁴ *Comedy III*, 21 P.3d at 807.

⁷⁵ *Id.*

⁷⁶ *Id.* at 807–08.

⁷⁷ See Randall T. E. Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781 (1988).

⁷⁸ *Comedy III*, 21 P.3d at 808.

⁷⁹ *Id.* (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994)). In *Campbell*, the Court held that Two Live Crew's version of Roy Orbison's rock classic *Pretty Woman* was transformative in nature, was not merely a substitute for the original, and was therefore not an infringement of copyright, but rather a work protected by the fair use doctrine. *Campbell*, 510 U.S. at 594.

⁸⁰ *Comedy III*, 21 P.3d at 808 (quoting *Campbell*, 510 U.S. at 579).

labor.”⁸¹ The thrust of the “transformative” test proposed by the court should focus on whether the new work contains significant transformative elements and is, therefore, “less likely to interfere with the economic interest protected by the right of publicity.”⁸² It is in these situations that First Amendment protection outweighs the right of publicity.⁸³

The court determined that the transformative test it used was consistent with prior holdings.⁸⁴ In *Cardtoons v. MLB Players Association*,⁸⁵ the Tenth Circuit found that First Amendment interests outweighed the interests of baseball players, who brought suit under an Oklahoma right of publicity statute. Cardtoons produced baseball cards that caricatured the likenesses of certain players and commented on or parodied them.⁸⁶ For example, one card depicted a caricature of Barry Bonds with the title “Treasury Bonds,” with armed guards transporting his money.⁸⁷ The *Comedy III* court agreed with that decision and concluded that its transformative test would, and should, yield the same result.⁸⁸

The court also noted that it would frequently be difficult to determine whether a work containing a literal depiction of a celebrity would be transformative.⁸⁹ The court considered the example of Andy Warhol taking an image of Marilyn Monroe and juxtaposing that likeness in varying colors and shades. It concluded that such use is transformative and protected by the First Amendment because Warhol’s activity surpassed mere commercial exploitation of Monroe’s image: his art became a “form of ironic social comment on the dehumanization of celebrity itself.”⁹⁰ Courts will often have difficulty determining whether a work is sufficiently transformative, but that is no different from other First Amendment tests, which often require difficult factual determinations.⁹¹ Another way of describing the required inquiry is “whether the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.”⁹² This will be one of the key questions facing the courts in the simulation video game

⁸¹ *Id.*

⁸² *Id.*

⁸³ *Id.*

⁸⁴ *Id.* at 809.

⁸⁵ *Cardtoons v. MLB Players Ass’n*, 95 F.3d 959 (10th Cir. 1996), *cited in Comedy III*, 21 P.3d at 809.

⁸⁶ *Id.* at 962.

⁸⁷ *Id.* at 962–63.

⁸⁸ *Comedy III*, 21 P.3d at 809.

⁸⁹ *Id.* at 811.

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² *Id.* at 809.

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cases.

The court discussed a case cited by the defendants, *ETW Corp. v. Jireh Publishing, Inc.*,⁹³ that held that a painting depicting several images of Tiger Woods was a work of art and therefore protected by the First Amendment.⁹⁴ The *Comedy III* court criticized that conclusion because it was based solely on the determination of whether a work was a “work of art”—a very difficult and subjective decision—but specifically declined to opine whether that work would be protected under its “transformative” test.⁹⁵

The *Comedy III* court suggested that another inquiry might be useful in close cases: whether the marketability and economic value of the work in question derived primarily from the fame of the celebrity depicted.⁹⁶ If the answer to that question is no, then the court suggested a right of publicity claim would generally not exist; if the answer is yes, there might be First Amendment protection for the work, depending on a more detailed examination of the transformative elements.⁹⁷ By the court’s logic, an artist could attempt to prove that his work should be protected by the First Amendment because it contains significant transformative elements and does not derive its value primarily from the fame of the celebrity.⁹⁸

In applying the test to the case at hand, the court found that Saderup’s work did not contain significant transformative or creative contribution, but rather was merely a conventional depiction of the Three Stooges, intended solely to exploit their fame.⁹⁹ To find otherwise would leave nothing to the right of publicity, except for false endorsement claims.¹⁰⁰ The court concluded that the marketability and economic value of the works derived primarily from Three Stooges’s fame, and that the defendants added no transformative elements sufficient to warrant First Amendment protection.¹⁰¹ One of the biggest questions this case and the “transformative” test raised is how one makes the qualitative distinction between depictions of celebrities that contain sufficient

⁹³ *Id.* at 809 n.11 (citing *ETW Corp. v. Jireh Publ’g, Inc.*, 99 F. Supp. 2d 829 (N.D. Ohio 2000)).

⁹⁴ *Id.*

⁹⁵ *Id.* Subsequently, the Sixth Circuit held that this painting was worthy of First Amendment protection because it contained significant transformative elements, conveyed a message about Tiger Woods’s achievement in the Masters’ Tournament, and would not likely interfere with the economic interests protected by Woods’s right of publicity. *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 938 (6th Cir. 2003).

⁹⁶ *Comedy III*, 21 P.3d at 810.

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ *Id.*

¹⁰⁰ *Id.*

¹⁰¹ *Id.*

transformative elements and those that do not.¹⁰² How does one distinguish between the manipulated images of Marilyn Monroe and the charcoal representations of the Three Stooges?¹⁰³

2. Applying the Transformative Test in *Winter*

The California Supreme Court revisited its “transformative” test just a couple of years later in *Winter v. DC Comics*.¹⁰⁴ The defendants published a comic book miniseries that depicted two brothers, Johnny and Edgar Autumn, with pale faces and long white hair.¹⁰⁵ The title of one of the comic books was the *Autumns of Our Discontent*.¹⁰⁶ Well-known rock musicians Johnny and Edgar Winter sued defendant for, among other things, misappropriation of their names and likenesses under the California right of publicity statute.¹⁰⁷ The Winter brothers had long white hair and albino features similar to the Autumn brothers in the comic, and Johnny Winter often wore a stovepipe hat similar to the characters in the comic.¹⁰⁸ After a number of appeals and remands, the Court of Appeals affirmed the trial court’s summary judgment on all of the causes of action except for misappropriation of likeness, finding that there was a triable issue of fact as to whether the comic books were entitled to First Amendment protection under the “transformative” test adopted in *Comedy III*.

The *Winter* court summarized its decision in *Comedy III*, stating that the “inquiry is whether the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.”¹⁰⁹ The question, then, is “whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.”¹¹⁰ The court reiterated that “[w]hat the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity’s fame through the merchandising of the ‘name, voice, signature, photograph, or likeness’ of the celebrity.”¹¹¹

¹⁰² *Id.*

¹⁰³ See William K. Ford & Raizel Liebler, *Games are not Coffee Mugs: Games and the Right of Publicity*, 29 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1 n.494 (2012).

¹⁰⁴ *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003).

¹⁰⁵ *Id.* at 476.

¹⁰⁶ This was allegedly a play on names with reference to the famous Shakespearian phrase “the winter of our discontent.” *Id.*

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

¹⁰⁹ *Id.* at 477.

¹¹⁰ *Id.*

¹¹¹ *Id.* at 478.

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The court found that the defendants' depictions contained significant expressive content.¹¹² While the Autumn brothers were clearly drawn from the Winter brothers, they were merely part of the raw material from which the comic books were synthesized.¹¹³ The characters in the comic book did not threaten the economic interests of the Winter brothers' rights of publicity—if their fans were looking for depictions of them, they would not find suitable substitutes in the defendants' works.¹¹⁴ The court held that a work does not have to be characterized as parody, satire, serious social commentary, or any other specific form of expression to be protected—it only need be transformative.¹¹⁵ It was irrelevant that the “defendants may have been trading on plaintiffs' likenesses and reputations to generate interest in the comic book series and increase sales,”¹¹⁶ as long as the work was constitutionally protected: “The question is whether the work is transformative, not how it is marketed.”¹¹⁷ The court concluded by distinguishing the facts of this case from those in *Comedy III*. The *Winter* court characterized the defendants' action in *Comedy III* as merely selling pictures of the Three Stooges, which were not transformed expressive content.¹¹⁸ In contrast, the *Winter* court found that the defendants here sold comic books depicting fanciful, creative characters, not simply pictures of the Winter brothers.¹¹⁹ In the court's judgment, the latter is entitled to First Amendment protection, while the former is not.¹²⁰ After this case, at least in California, the critical determination by a court is whether a work contains sufficient transformative elements.

3. Missouri Rejects the Transformative Test in *Tony Twist*

Less than two months after the *Winter* decision, the Supreme Court of Missouri decided *John Doe v. TCI Cablevision*, a case also involving a comic book, that the court characterized as having “a remarkably similar fact situation” to that of *Winter*.¹²¹ Plaintiff Tony Twist was a former NHL hockey player with a well-earned reputation as an “enforcer,” having gotten into many fights during his career. He was also a well-known figure in his community, having endorsed products, appeared on radio and television, and hosted his

¹¹² *Id.* at 479.

¹¹³ *Id.*

¹¹⁴ *Id.*

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ *Id.*

¹¹⁸ *Id.* at 480.

¹¹⁹ *Id.*

¹²⁰ *Id.*

¹²¹ *John Doe v. TCI Cablevision (Tony Twist)*, 110 S.W.3d 363, 373 (Mo. 2003).

own talk show for two years.¹²² The defendant, a huge hockey fan, created a comic book called *Spawn*. One of the villains in the comic was a fictional character named Tony Twist, a Mafia don who bore no physical resemblance to the plaintiff, but who shared an “enforcer,” tough guy, persona.¹²³ The defendant admitted that he borrowed the name of the character from the plaintiff.¹²⁴ The plaintiff brought suit against defendants for misappropriation of his name, and the jury found in favor of the plaintiff on the misappropriation claim, but an appellate court overturned the verdict, holding that plaintiff failed to make a submissible case.¹²⁵

The Supreme Court of Missouri explained that while the plaintiff brought an action for misappropriation of name, the facts more appropriately gave rise to an action for right of publicity, which the court specifically recognizes in this case.¹²⁶ After adopting the Restatement (Third) of Unfair Competition’s definition of a right to publicity action, requiring “(1)[t]hat defendant used plaintiff’s name as a symbol of identity (2) without consent (3) and with intent to obtain a commercial advantage,”¹²⁷ the court held that the first two elements were clearly established. Regarding the last element, the court held that while the plaintiff presented sufficient evidence to show that defendants used his name for a commercial advantage, the jury had not been instructed with regard to *intent* to obtain a commercial advantage, ultimately leading the jury verdict to be reversed and a new trial to be ordered.¹²⁸ The primary significance of this case, however, comes from the court’s discussion about whether the First Amendment prohibits the plaintiff’s right of publicity claim and the court’s development of a different balancing test.¹²⁹ The court discussed *Zacchini*, observing that its holding is very narrow and should only be applied in situations analogous to having one’s entire act appropriated.¹³⁰ The court stated, however, that there are two important lessons to be learned from *Zacchini*: (1) the First Amendment does not always trump the right of publicity; and (2) the actual malice standard does not apply to misappropriation and right of publicity claims.¹³¹

The Supreme Court of Missouri stated that most right of publicity cases focus on whether the use of one’s name or likeness is “expressive” and thus

¹²² *Id.* at 366.

¹²³ *Id.*

¹²⁴ *Id.* at 370.

¹²⁵ *Id.* at 368.

¹²⁶ *Id.* at 368–69.

¹²⁷ *Id.* at 369.

¹²⁸ *Id.*

¹²⁹ *Id.* at 372–74.

¹³⁰ *Id.* at 372–73.

¹³¹ *Id.*

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protected, or “commercial” and thus generally not protected.¹³² It then compared two tests used to distinguish between those two types of speech.¹³³ First, the court examined the “relatedness” test proposed by the Restatement (Third) of Unfair Competition.¹³⁴ Under that test, the use of another person’s name or likeness in a work would be protected as long as that work is related to that person; if the use of the name or likeness is not related to the person, it would probably not be protected.¹³⁵ Second, the court considered the “transformative” test adopted by California and noted the similarity of the facts between the case at hand and the *Winter* case.¹³⁶ It stated that since the characters in the *Winter* comic book contained significant expressive content, the court found the work fully protected by the First Amendment.¹³⁷

The court criticized both the “relatedness” test and the “transformative” test for giving too little consideration to the fact that many uses of one’s name or likeness may contain both “expressive” and “commercial” components.¹³⁸ The court stated that both tests precluded a right of publicity action if there was any expressive use at all, regardless of its commercial exploitation.¹³⁹ The court found fault with the tests’ inability to actually perform a balance, since “once the use is determined to be expressive, it is protected.”¹⁴⁰ The court then proposed its own “predominant use” test to be used when the challenged speech is both expressive and commercial:

If a product is being sold that predominantly exploits the commercial value of an individual’s identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some “expressive” content in it that might qualify as “speech” in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.¹⁴¹

If a work were entirely expressive or commercial, presumably the “predominant use” test would not apply. Applying the test, the court held that the plaintiff’s right of publicity outweighed the free speech interests.¹⁴² It found that the defendants’ use of plaintiff’s name in the comic book had

¹³² *Id.* at 373.

¹³³ *Id.*

¹³⁴ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. C (1995).

¹³⁵ *Tony Twist*, 110 S.W.3d at 373.

¹³⁶ *Id.*

¹³⁷ *Id.* at 373–74.

¹³⁸ *Id.* at 374.

¹³⁹ *Id.*

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

¹⁴² *Id.*

predominantly commercial value and very little expressive value.¹⁴³

4. Applying the Transformative Test in *Kirby*

The California Court of Appeals added further nuance to the transformative test in *Kirby v. Sega of America, Inc.*¹⁴⁴ In *Kirby*, a professional singer sued the distributors of a video game for violation of her right of publicity and appropriation of her likeness.¹⁴⁵ Kierin Kirby was the lead singer of a retro-funk-dance band popular in the 1990s.¹⁴⁶ She claimed that the defendants appropriated her “unique public identity” resulting from her “signature costumes and lyrical expressions,” which included platform shoes, brightly colored clothes, often with a numeral written on her chest, bare midriffs, a blue backpack, red/pink hair, pigtails, and a musical introduction with the words “ooh la la.”¹⁴⁷ The defendants distributed a video game called Space Channel 5.¹⁴⁸ The game originally featured a male main character, but developers later changed the protagonist to a female to attract girl gamers.¹⁴⁹ This character’s name was Ulala (which one of defendant’s employee’s testified was a more easily pronounced derivative of the Japanese name Urara).¹⁵⁰ The character’s dance moves were created by a Japanese dancer and choreographer, who claimed that she had never heard of the plaintiff.¹⁵¹ The game is set in outer space in the twenty-fifth century and the main character works for a news channel called Space Channel 5.¹⁵² In the game, Ulala is seen primarily with hot pink hair worn in pigtails, wearing an orange midriff-exposing top with a numeral “5” on it, with knee-high platform shoes, and a blue headset and jet pack.¹⁵³

The Court noted the broad scope of free expression protected by the First Amendment, and also noted that the California constitution provides even greater protection.¹⁵⁴ The court stated that these protections extend to “all forms of expression, including written and spoken words (fact or fiction), music, films, paintings, and entertainment, whether or not sold for a profit.”¹⁵⁵

¹⁴³ *Id.*

¹⁴⁴ *Kirby v. Sega of America, Inc.*, 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006).

¹⁴⁵ *Id.* at 608.

¹⁴⁶ *Id.* at 609.

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ *Id.*

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

¹⁵² *Id.* at 610.

¹⁵³ *Id.*

¹⁵⁴ *Id.* at 614.

¹⁵⁵ *Id.*

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The court further stated that “[v]ideo games are expressive works entitled to as much First Amendment protection as the most profound literature.”¹⁵⁶ The Court then reviewed the evolution of the transformative test and its application by the Supreme Court in *Comedy III* and *Winter*:

The “transformative” test protects the right of publicity. It continues to shield celebrities from literal depictions or imitations for commercial gain by works which do not add significant new expression. Moreover, a work which has been “transformed” is less likely to interfere with the economic interests protected by the right of publicity, because a distorted image of a celebrity is a poor substitute for more conventional forms of celebrity depictions, and thus less likely to threaten the market for celebrity memorabilia.¹⁵⁷

The court held that, despite certain similarities, the character Ulala was more than a mere literal depiction of plaintiff; she contained sufficient expressive content to satisfy the “transformative” test.¹⁵⁸

5. Applying the Transformative Test in *Hilton*

In *Hilton v. Hallmark Cards*, a case that dealt with a more literal depiction of a plaintiff, the Court of Appeals for the Ninth Circuit addressed, among other things, a claim for misappropriation of publicity under California common law.¹⁵⁹ Paris Hilton, a wealthy heiress, is “famous for being famous.”¹⁶⁰ She starred in a reality television show called “The Simple Life,” in which she and her co-star engaged in mundane activities, such as waitressing in a fast food restaurant.¹⁶¹ Hilton is also famous for her catchphrase, “that’s hot,” which she has registered as a federal trademark.¹⁶² The defendant published a greeting card with a photograph of Hilton’s face on a cartoon body, serving a cartoon man a plate of food, with dialog bubbles: “Don’t touch that, it’s hot.” “What’s hot?” and “That’s hot.” Beneath the image is the caption: “Paris’s First Day as a Waitress.”¹⁶³ The court noted that the transformative nature of defendant’s card was far more limited than the

¹⁵⁶ *Id.* at 615.

¹⁵⁷ *Id.*

¹⁵⁸ *Id.* The court also affirmed the trial court’s award of \$608,000 against Kirby. *Id.* at 619. Under the California right of publicity statute: “The prevailing party in any action under this section shall also be entitled to attorney’s fees and costs.” CAL. CIV. CODE § 3344(a) (West 2011).

¹⁵⁹ *Hilton v. Hallmark Cards*, 599 F.3d 894 (9th Cir. 2010).

¹⁶⁰ *Id.* at 899.

¹⁶¹ *Id.*

¹⁶² *Id.*

¹⁶³ *Id.*

transformation of *Winter's* comic book.¹⁶⁴ In particular, the court noted that the depiction of Hilton was almost *exactly* what she did in *The Simple Life*: serving food in a restaurant.¹⁶⁵ Accordingly, the court concluded that “there is enough doubt as to whether Hallmark’s card is transformative under our case law that we cannot say Hallmark is entitled to the defense as a matter of law.”¹⁶⁶

Interestingly, the *Hilton* court discussed *Hoffman v. Capital Cities/ABC, Inc.*, a Ninth Circuit case decided around the same time as *Comedy III*, but the *Hilton* court made a very unconvincing attempt to distinguish the cases on their facts.¹⁶⁷ In that case, Los Angeles Magazine (LAM) published an article about 1997 fashion that included sixteen computer-altered photographs from famous movie scenes with the actors and actresses wearing modern fashions.¹⁶⁸ One such image depicted actor Dustin Hoffman, famous for, among other things, his portrayal in the film *Tootsie* of a male character frequently dressed as a female.¹⁶⁹ The image contained a photograph of Hoffman’s head (dressed as a woman) superimposed onto the body of a male model wearing a spaghetti-strapped, cream-colored, silk evening dress and high-heeled sandals.¹⁷⁰ Hoffman sued LAM and other defendants for, among other things, violation of California’s common law and statutory rights of publicity.¹⁷¹ The trial court found for Hoffman, holding that the photograph was an exploitative commercial use not entitled to First Amendment protection, and awarded one and a half million dollars in compensatory damages and another one and a half million dollars in punitive damages and attorney fees.¹⁷²

The Ninth Circuit reversed *Hoffman’s* trial court decision and found for the defendants, holding that the use of the photograph was protected as noncommercial speech.¹⁷³ The court began its analysis with the prescient statement: “We evaluate this defense aware of ‘the careful balance that courts have gradually constructed between the right of publicity and the First Amendment and federal intellectual property laws.’”¹⁷⁴ This is one of the first times that a court recognizes a balancing between not only the right of

¹⁶⁴ *Id.* at 911.

¹⁶⁵ *Id.*

¹⁶⁶ *Id.*

¹⁶⁷ See *id.* at 911–12 (citing *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001)).

¹⁶⁸ *Hoffman*, 255 F.3d at 1183.

¹⁶⁹ *Id.* at 1182.

¹⁷⁰ *Id.* at 1183.

¹⁷¹ *Id.*

¹⁷² *Id.*

¹⁷³ *Id.* at 1186.

¹⁷⁴ *Id.* at 1183–84 (quoting *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000)).

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publicity and the First Amendment, but also with copyright law. In a footnote, the *Hoffman* court recognized that the California Supreme Court had just decided the *Comedy III* case, which held that there was no First Amendment defense for a California right of publicity case when “artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain,” but that an artist who added “significant transformative elements” could still invoke that defense.¹⁷⁵ The court stated that if it considered LAM as the artist and the altered photograph as the artistic expression, there would be no question that LAM’s publication of the photograph contained “significant transformative elements.”¹⁷⁶

The *Hilton* court refused to use the *Hoffman* case as precedent for a transformative use defense because the *Comedy III* case, which first established the defense, was handed down after oral arguments in the *Hoffman* case and that defense was not fully litigated by the parties.¹⁷⁷ It is precisely these difficult factual determinations that the court avoids in this case by distinguishing *Hoffman*. Factual determinations, however, remain at the heart of the controversy in the simulation video games—how much literal depiction of an individual is permissible, and what level of transformative use must be established in order to satisfy the defense.

C. *The Fantasy Sports Cases*

Several recent cases involving fantasy sports also addressed the tension between the right of publicity and the First Amendment. Fantasy sports leagues permit participants to create a roster of players, usually from a professional sports league, and compete against other participants by accumulating points calculated by the performances of the players that they chose.¹⁷⁸ The fantasy sports industry has grown tremendously in recent years, with estimated revenue reaching five billion dollars per year and with thirty-six million participants.¹⁷⁹

¹⁷⁵ *Id.* at 1184 n.2.

¹⁷⁶ *Id.*

¹⁷⁷ *Hilton*, 599 F.3d at 912 n.15.

¹⁷⁸ See Marc Edelman, *A Short Treatise on Fantasy Sports and the Law: How America Regulates Its New National Pasttime*, 3 HARV. J. SPORTS & ENT. L. 1, 4–11 (2012); Richard T. Karcher, *The Use of Players’ Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 PENN. ST. L. REV. 557, 561–62 (2007); David G. Roberts, Jr., Note, *The Right of Publicity and Fantasy Sports: Why the C.B.C. Distribution Court Got it Wrong*, 58 CASE W. RES. L. REV. 223, 224–25 (2007); Gabriel Grossman, Comment, *Switch Hitting: How C.B.C. v. MLB Advanced Media Redefined the Right of Publicity*, 14 UCLA ENT. L. REV. 285, 286–90 (2007).

¹⁷⁹ Edelman, *supra* note 178, at 11, 16–17; *Media Kit*, FSTA.ORG, <http://www.fsta.org/mk/MediaKit.pdf> (last visited Dec. 11, 2012); see also Karcher, *supra* note 178 at 561–63.

One recent case dealt with licensing of player information for fantasy baseball.¹⁸⁰ From 1995 through 2004, CBC Distribution and Marketing, Inc. (“CBC”), in connection with its fantasy sports business on the Web, licensed the use of the names and information of professional baseball players from the Major League Baseball Players’ Association (“MLBPA”).¹⁸¹ One of the contracts between the parties licensed to CBC “the names, nicknames, likenesses, signatures, pictures, playing records, and/or biographical data of each player.”¹⁸² Major League Baseball Advanced Media, L.P. (“Advanced Media”) operates the official websites for Major League Baseball (“MLB”).¹⁸³ By the time this agreement expired, the MLBPA had contracted with Advanced Media, granting it, with some exceptions, the exclusive right to use baseball players’ names and performance information in all interactive media.¹⁸⁴ Advanced Media began its own fantasy baseball games on MLB.com and refused to enter into a licensing agreement with CBC in which CBC would be able to offer its own fantasy baseball games.¹⁸⁵ CBC sued Advanced Media, seeking a declaratory judgment that Advanced Media could not use the right of publicity to claim exclusive ownership of the player statistics necessary to run a fantasy baseball league.¹⁸⁶

The District Court for the Eastern District of Missouri granted summary judgment for CBC.¹⁸⁷ It held that CBC did not violate any of the players’ claimed rights of publicity,¹⁸⁸ and that even if it had, CBC’s First Amendment right to freedom of expression would have outweighed such rights.¹⁸⁹ The court further held that federal copyright law did not preempt the players’ rights of publicity under state law.¹⁹⁰ The Eighth Circuit affirmed the district court’s grant of summary judgment to CBC.¹⁹¹ It held that the MLBPA had presented sufficient evidence to make out a cause of action for violation of the right of publicity under Missouri law,¹⁹² but that CBC’s First Amendment rights

¹⁸⁰ C.B.C. Distrib. & Mktg., Inc. v. MLB Adv. Media, L.P. (*Adv. Media II*), 505 F.3d 818 (8th Cir. 2007).

¹⁸¹ *Id.* at 821.

¹⁸² *Id.*

¹⁸³ C.B.C. Distrib. & Mktg., Inc. v. MLB Adv. Media, L.P. (*Adv. Media I*), 443 F. Supp. 2d 1077, 1080 (E.D. Mo. 2006).

¹⁸⁴ *Id.* at 1081.

¹⁸⁵ *Id.*

¹⁸⁶ *Id.* at 1081–82.

¹⁸⁷ *Id.* at 1107.

¹⁸⁸ *Id.* at 1091.

¹⁸⁹ *Id.* at 1100.

¹⁹⁰ *Id.* at 1103.

¹⁹¹ C.B.C. Distrib. & Mktg., Inc. v. MLB Adv. Media, L.P. (*Adv. Media II*), 505 F.3d 818, 825 (8th Cir. 2007).

¹⁹² *Id.* at 823. The court found that there was sufficient proof for all three elements

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superseded those rights.¹⁹³ The court held that as the information used by CBC in its fantasy games was already available in the public domain, its use is clearly protected by the First Amendment.¹⁹⁴

The court then discussed *Gionfriddo v. MLB*, a 2001 case that is more significant today because of the continued growth and expansion of fantasy sports and sports simulation video games.¹⁹⁵ In *Gionfriddo*, a group of former players sued MLB, alleging that it used their names, pictures, statistics, and written accounts and video depictions of their playing without their permission, and in violation of their rights of publicity.¹⁹⁶ Ironically, MLB argued a position completely contrary to what it later argued in the *Advanced Media* case—that the First Amendment fully protects the use of this information.¹⁹⁷ In holding that MLB did not violate any of the players’ rights of publicity, the court made a number of relevant and prescient observations. The court found that the factual data concerning the players and their performance statistics are an important part of the game, and that the First Amendment protects the reporting of this information.¹⁹⁸ This passion for baseball statistics and records is part of the appeal of baseball.¹⁹⁹ The court concluded with an observation that publishing for profit does not deprive one of First Amendment protection.²⁰⁰ Because the *CBC* court held that First Amendment rights outweighed the rights of publicity, the court did not address whether the federal copyright law preempted those rights of publicity under state law.²⁰¹ The United States Supreme Court denied a writ of certiorari, putting an end to this case, and changing the business of fantasy sports forever.²⁰²

In a similar case, prior to the 2008 National Football League season, CBS Interactive, Inc. (“CBS”), a major provider of football and other fantasy sports games, had entered into licensing agreements with the National Football

required for a right of publicity claim in Missouri: “(1) That defendant used plaintiff’s name as a symbol of his identity (2) without his consent (3) and with intent to obtain a commercial advantage.” *Id.* at 822–33 (citing *John Doe v. TCI Cablevision (Tony Twist)*, 110 S.W.3d 363, 373 (Mo. 2003)).

¹⁹³ *Id.* at 822–23.

¹⁹⁴ *Id.*

¹⁹⁵ See *id.* at 824–25 (citing *Gionfriddo v. MLB*, 114 Cal. Rptr. 2d 307 (Cal. Ct. App. 2001)).

¹⁹⁶ *Gionfriddo*, 114 Cal. Rptr. 2d at 311.

¹⁹⁷ *Id.* at 313–14.

¹⁹⁸ *Id.* at 314.

¹⁹⁹ *Id.* at 315.

²⁰⁰ *Id.*

²⁰¹ *C.B.C. Distrib. & Mktg., Inc. v. MLB Adv. Media, L.P. (Adv. Media II)*, 505 F.3d 818, 824 (8th Cir. 2007).

²⁰² See *MLB Adv. Media, L.P. v. C.B.C. Distrib. & Mktg., Inc.*, 553 U.S. 1090 (2008) (denying petition for writ of certiorari).

League Players Incorporated (“Players, Inc.”), a licensing entity affiliated with, and authorized by, the National Football League Players Association, Inc. (“NFLPA”).²⁰³ NFLPA is an organization representing the interests of most National Football League players. Under the licensing agreements, CBS gained permission to use “the names, likenesses (including without limitation, [jersey] numbers), pictures, photographs, voices, facsimile signatures and/or biographical information” of the member NFL players for fantasy football games.²⁰⁴ In February 2008, after the *CBC* fantasy baseball case had been decided, Players, Inc. approached CBS about continuing to pay for the use of the NFL players’ names and statistics in CBS’s fantasy football games.²⁰⁵ CBS brought suit against Players, Inc. and NFLPA seeking a declaratory judgment that would extend the Eighth Circuit’s ruling in the fantasy baseball case to the use of the names and statistics in fantasy football games as well.²⁰⁶ In *CBS Interactive Inc. v. NFL Players Association, Inc.*, the District Court for the District of Minnesota granted summary judgment motion in a decision that was even broader than *Advanced Media*.²⁰⁷ Not only did the court hold as a matter of law that CBS could use the names and statistics of the players, but that CBS could use the entire “package” of information about the players—including “names, player profiles, up-to-date statistics, injury reports, participant blogs, pictures, images, and biographical information.”²⁰⁸

These two decisions changed the entire nature of licensing of player information for the fantasy sports industry. No longer would fantasy sports providers have to license the use of player names and statistics from the sports leagues.²⁰⁹ There probably remains some question, however, as to what extent pictures and images may be used.

D. The Video Game Cases

1. *Keller v. Electronic Arts, Inc.*

Two of the three recently decided cases about computer simulation video involved EA, the producer and distributor of NCAA Football, among other video games.²¹⁰ In *Keller v. Electronic Arts, Inc.*, Sam Keller, a former

²⁰³ *CBS Interactive Inc. v. NFL Players Ass’n, Inc.*, 259 F.R.D. 398 (D. Minn. 2009).

²⁰⁴ *Id.* at 403.

²⁰⁵ *Id.* at 404.

²⁰⁶ *Id.*

²⁰⁷ *Id.* at 417-18.

²⁰⁸ *Id.* at 417.

²⁰⁹ Ford & Liebler, *supra* note 103, at 4, 36–39; Michele R. Hull, *Sports Leagues’ New Social Media Policies: Enforcement under Copyright Law and State Law*, 34 COLUM. J. L. & ARTS 457, 468–69 (2011).

²¹⁰ See *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 U.S. Dist. LEXIS 10719 (N.D. Cal. Feb. 8, 2010); *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757 (D.N.J. 2011).

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quarterback at both Arizona State University and University of Nebraska, along with several other former college and professional football players, brought suit in the Northern District of California against EA, the National Collegiate Athletic Association (“NCAA”), and Collegiate Licensing Company (“CLC”) with a variety of different claims.²¹¹ Of particular relevance here are the claims brought under California’s statutory and common law rights of publicity.²¹²

In the least in-depth analysis of the right of publicity in these three cases, the District Court for the Northern District of California reviewed the “transformative” test and its development and application in *Comedy III*, *Winter*, *Kirby*, and *Hilton*.²¹³ It noted that *Hilton* used the *Comedy III* and *Winter* cases to “bookend the spectrum,” with the former typifying a non-transformative work, and the latter a sufficiently transformative work.²¹⁴ The court explained that, using *Comedy III* and *Winter* as guideposts, *Kirby* applied the transformative test to video games and held that the video game character, Ulala, was “more than a mere likeness or literal depiction of Kirby,”²¹⁵ but rather, contained “sufficient expressive content to constitute a ‘transformative work’ under the test.”²¹⁶ Using these precedents, the court held that EA’s depiction of Keller was not sufficiently transformative to bar his right of publicity claim as a matter of law.²¹⁷ The avatar representing the Arizona State quarterback in the game shared many similarities with Keller, from physical attributes to the very nature of what he was—a quarterback on a football field.²¹⁸

EA contended the court should look at the transformative nature of the game as a whole, rather than solely at the depiction of the plaintiff.²¹⁹ The court rejected this approach, stating that *Winter* focused only on the depictions of the plaintiffs, rather than on other parts of the comic book, and that *Kirby* focused only on comparing Ulala to the plaintiff, rather than on other elements of the

²¹¹ *Keller*, 2010 U.S. Dist LEXIS 10719, at *7–8.

²¹² *Id.* at *11–25. The right of publicity claims are only the tip of the iceberg in this case. The plaintiffs sued the NCAA and CLC for a variety of claims under Indiana and California law pertaining to the fact that collegiate athletes cannot and do not receive any monetary compensation and that the NCAA and CLC are thereby unjustly enriched. For purposes of this Article, I focus only on the California rights of publicity claims.

²¹³ *Id.* at *11–18.

²¹⁴ *Id.* at *14–15.

²¹⁵ *Id.* at *15–16 (quoting *Kirby v. Sega of America, Inc.*, 50 Cal. Rptr. 3d 607, 616 (Cal. Ct. App. 2006)).

²¹⁶ *Id.*

²¹⁷ *Id.* at *16.

²¹⁸ *Id.*

²¹⁹ *Id.* at *18.

game.²²⁰ The court held that its focus was on Keller's depiction in NCAA Football and not on the game's other elements.²²¹

After rejecting the transformative use defense, the court proceeded to examine EA's public interest defense.²²² Citing the *Hilton* case, the court noted that under California law, the freedom of the press and the public's right to know protect publication of any matter of public interest.²²³ The court discussed the *Gionfriddo* case, stating that the public clearly had an interest in the historical team data and photographs of the former baseball players, and that the First Amendment protected the recitation and discussion of that data.²²⁴ The court also discussed *Montana v. San Jose Mercury News, Inc.*, in which Joe Montana, a famous football player, had objected to the sale of posters containing reproductions of newspaper pages recounting his victory in the 1990 Super Bowl.²²⁵ The *Montana* court had held that the posters were entitled to the same First Amendment protection as the original news stories.²²⁶ The *Keller* court contrasted NCAA Football to the situations in *Gionfriddo* and *Montana*, holding that the former did not merely report or publish players' statistics or abilities, but rather, it permitted users to assume the identities of the college players and compete in computer simulations.²²⁷ As a result, the court recognized that EA's products were worthy of constitutional protection, while also stating that the protections were not absolute.²²⁸

The court also distinguished the *CBC* fantasy baseball case, noting that NCAA Football does not depend upon updated statistics from the current football season, but rather, provides more than simply names and statistics—it permits users to manipulate a physical depiction of the player in a simulated game.²²⁹ The court held that EA's use of Keller's likeness went beyond the facts under the court's consideration in *CBC*, and rejected EA's use of the public interest defense.²³⁰

2. *No Doubt v. Activision Publishing, Inc.*

In the second video game case, *No Doubt v. Activision Publishing, Inc.*, the

²²⁰ *Id.*

²²¹ *Id.*

²²² *Id.* at *18-25.

²²³ *Id.* at *18.

²²⁴ *Id.* at *19.

²²⁵ *Id.* at *18-20 (citing *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639 (Cal. Ct. App. 1995)).

²²⁶ *Montana*, 40 Cal. Rptr. 2d at 643.

²²⁷ *Keller*, 2010 U.S. Dist LEXIS 10719, at *20-21.

²²⁸ *Id.* at *21.

²²⁹ *Id.* at *21-22.

²³⁰ *Id.* at *22. The *Keller* case is presently on appeal before the Ninth Circuit. *Keller*, 2010 U.S. Dist LEXIS 10719, *appeal docketed*, No. 10-15387 (9th Cir. Feb. 22, 2010).

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California Court of Appeals held that Activision's use of No Doubt's avatars was not "transformative" because the avatars were precise, computer-generated reproductions of the band members.²³¹ The court held that the creative elements of the video game did not transform the images of the band members "into anything more than literal, fungible reproductions of their likenesses" and that the First Amendment did not bar No Doubt's right of publicity claim.²³²

The court reviewed the previous cases decided in California, stating that the *Comedy III* "transformative" test is essentially a balancing test between the First Amendment and the right of publicity that focuses on whether the work in question adds any significant creative elements that transform it into something more than the original work.²³³ The *Comedy III* court found no significant transformative or creative contribution to the likeness of the Three Stooges.²³⁴ In contrast, the *Winter* court found significant expressive content and the court noted that because of the significant expressive content, other than the Winter brothers' likenesses, the right of publicity claim was barred by the First Amendment as a matter of law.²³⁵ Similarly, while there was a question of fact as to whether Sega had misappropriated Kirby's likeness in creating the Ulala character in *Kirby*, the First Amendment barred her claim as a matter of law because of the creative elements added to the game by Sega.²³⁶

The *No Doubt* court pointed out that the Band Hero game does not permit users to alter the No Doubt avatars in any manner, in contrast to the "fanciful, creative characters" in *Winter* and *Kirby*.²³⁷ It was specifically the differences between *Kirby* and this case, rather than the similarities, which were dispositive.²³⁸ Ulala was an entirely new character, portrayed in a new setting, as space-age news reporter.²³⁹ In contrast, in Band Hero, the No Doubt avatars performed exactly the same songs in exactly the same settings as their real-life counterparts—they do not transform "into anything other than exact depictions of No Doubt's members doing exactly what they do as celebrities."²⁴⁰ The court then compared the case to *Keller*, stating that the NCAA Football game's literal depiction of Keller had been held not transformative because the football player avatar looked like Keller and performed like Keller, as the quarterback

²³¹ No Doubt v. Activision Publ'g, Inc., 122 Cal. Rptr. 3d 397, 411 (Cal. App. 2011).

²³² *Id.* at 400–01.

²³³ *Id.* at 407 (quoting *Comedy III Prods. v. Gary Saderup, Inc.*, 21 P.3d 797, 799 (Cal. 2001)).

²³⁴ *Id.* at 408 (quoting *Comedy III*, 21 P.3d at 811).

²³⁵ *Id.*

²³⁶ *Id.* at 408–09.

²³⁷ *Id.* at 410.

²³⁸ *Id.* at 409.

²³⁹ *Id.*

²⁴⁰ *Id.* at 410–11.

of Arizona State University, on a football field.²⁴¹ Therefore, the court reached the same result as in *Keller*, concluding that Band Hero's depiction of No Doubt was not transformative.²⁴²

The *Keller* and *No Doubt* decisions are similar. Both courts focused on the literal depictions of the characters and the fact that those characters performed and were manipulated in environments that were identical to where one would expect to find them in real life—playing football on a football field or performing on a stage. Thus the consistent result is not surprising.

3. *Hart v. Electronic Arts, Inc.*

In stark contrast to these two decisions, in *Hart v. Electronic Arts, Inc.*, the third video game case and the other one involving a former college football player and EA, the District Court for the District of New Jersey granted summary judgment for EA on Hart's right of publicity claim.²⁴³ The court began its review by stating that EA conceded that Hart had stated a prima facie right to publicity claim under New Jersey law, and that the issue of whether the First Amendment would limit Hart's right of publicity was a question of law and one that was typically addressed at the summary judgment stage.²⁴⁴ The court started its First Amendment analysis by noting that the United States Supreme Court recently specifically held that video games are entitled to First Amendment protection.²⁴⁵ The court held that the NCAA Football game was expressive speech, not commercial speech, opening the door to the discussion of whether the First Amendment trumped the right of publicity in this case.²⁴⁶

It noted that the common law right of privacy, specifically the right to prevent the unauthorized, commercial appropriation of name or likeness, was first recognized in New Jersey in 1907, and that "[d]espite its early characterization as a privacy right, by 1967, New Jersey cases treated the tort as a property right."²⁴⁷ The court noted that New Jersey, unlike states such as California and New York, did not have a right of publicity statute, but rather has adopted the Restatement (Second) of Torts's definition into its common law.²⁴⁸ The *Hart* court considered, for the first time in both New Jersey and the Third Circuit, a test that reconciled First Amendment interests with the right of publicity.²⁴⁹ The court discussed that eight different tests have been

²⁴¹ *Id.* at 411.

²⁴² *Id.*

²⁴³ *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757 (D.N.J. 2011).

²⁴⁴ *Id.* at 764.

²⁴⁵ *Id.* at 768 (quoting *Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729 (2011)).

²⁴⁶ *Id.* at 771.

²⁴⁷ *Id.* at 772.

²⁴⁸ *Id.* at 773.

²⁴⁹ *Id.* at 775.

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adopted throughout the United States that attempt to balance those interests, but that the two most important ones were the “transformative” test and the *Rogers* test, discussed below.²⁵⁰ Prior to its discussion of these two tests, the court summarized why it believed the former a better test:

The transformative test’s incorporation of copyright’s fair use doctrine not only reflects the common underlying principles shared by the right of publicity and copyright doctrine, but properly takes into account the extent of a defendant’s use of a plaintiff’s image. In this way, the transformative test captures the intricacies involved in deciphering whether a challenged work is a “new” work entitled to First Amendment protection or merely a blanket attempt to profit from another’s property without due compensation. That said, I need not explicitly adopt either test because, for the reasons explained herein, EA’s First Amendment defense prevails under both tests.²⁵¹

The court began its discussion of the transformative test by examining the long-existing and recognized tension between copyright interests and the First Amendment. Because of the idea/expression dichotomy, “every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication.”²⁵² In addition, the fair use defense “allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances.”²⁵³

The court discussed how California decided to borrow the transformative test used to balance competing copyright and First Amendment interests, as enunciated by the United States Supreme Court in *Campbell v. Acuff-Rose Music, Inc.*, in order to similarly balance the competing interests of the right of publicity and the First Amendment.²⁵⁴ It compared the result of the test as applied in *Kirby*, which found that there were enough differences in the character and in the setting and in the dance movements to warrant a finding of transformation, to the result in *No Doubt*, which found that because the avatars could not be altered and remained at all times as rock stars, there was no transformation.²⁵⁵ The court stated that the use of Hart’s image in NCAA Football presented a closer call than in either *Kirby* or *No Doubt*.²⁵⁶ The Ulala character in *Kirby*, while resembling the real-life performer, was placed in an

²⁵⁰ *Id.*

²⁵¹ *Id.* at 776–77.

²⁵² *Id.* at 777.

²⁵³ *Id.*

²⁵⁴ *Id.* at 777–79 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994)). The court stated that “‘whether and to what extent the new work is ‘transformative’ should frame the court’s balancing test inquiry.” *Id.* at 779.

²⁵⁵ *Id.* at 782.

²⁵⁶ *Id.* at 783.

entirely different setting in the video game.²⁵⁷ Hart's avatar appears in the exact same setting—a football field.²⁵⁸ Unlike the transformative Ulala character, the No Doubt avatars are exact replicas of the band members and cannot be changed in any way.²⁵⁹ The appearance of Hart's avatar and its physical attributes can be altered in many ways.²⁶⁰

The court recognized that any time a game developer uses real-life players, it walks a fine line between using reality as a building block for its own creative work and exploiting the reputations of the players. "Viewed as a whole, there are sufficient elements of EA's own expression found in the game that justify the conclusion that its use of Hart's image is transformative and, therefore, entitled to First Amendment protection."²⁶¹ This is basically the same issue that *Comedy III* addressed when trying to distinguish between a mere depiction of the Three Stooges and a transformative depiction by Andy Warhol of Marilyn Monroe,²⁶² and the trouble *Hilton* had in determining whether there were sufficient transformative elements contained in the literal depictions of Dustin Hoffman and Paris Hilton.²⁶³

The *Hart* court held that even focusing on Hart's image alone, it was convinced that its use was transformative.²⁶⁴ Users can alter not only attributes like height, weight, speed and agility, but also the hairstyles worn by Hart's avatar.²⁶⁵ The court cited approvingly the *CBC* case, stating that just as a player's name, statistics and biographical data were entitled to First Amendment protection, so should be the public facts connected to his image.²⁶⁶ The court disagreed with *Keller's* approach of concentrating on the image alone, rather than on the work as a whole, noting the procedural posture in this case differed from *Keller*.²⁶⁷ The court noted that it had the benefit of considering a summary judgment motion here, giving the court additional opportunity to take into account the games themselves, as well as other declarations and materials, whereas the *Keller* court was somewhat limited, as its decision was made pursuant to a motion to dismiss.²⁶⁸ Delicately as the

²⁵⁷ *Id.*

²⁵⁸ *Id.*

²⁵⁹ *Id.*

²⁶⁰ *Id.* The court listed a variety of Hart's attributes that can be altered by the user, including height, weight, helmet visor, wristband, athletic ability, speed and agility, throwing arm, and passing accuracy. *Id.*

²⁶¹ *Id.* at 784.

²⁶² See *supra* notes 89–92 and accompanying text.

²⁶³ See *supra* notes 175–77 and accompanying text.

²⁶⁴ *Hart*, 808 F. Supp. 2d at 784–85.

²⁶⁵ *Id.* at 785.

²⁶⁶ *Id.* at 785 n.22.

²⁶⁷ *Id.* at 787.

²⁶⁸ *Id.*

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court attempted to distinguish its result from *Keller*'s, the bottom line is simply that the two decisions reach opposite conclusions on the identical issue.²⁶⁹

The court then focused on the *Rogers* test, developed by the Second Circuit in *Rogers v. Grimaldi*.²⁷⁰ In that case, Ginger Rogers, who starred in numerous popular films with Fred Astaire, brought a false endorsement claim under the Lanham Act, as well as a right of publicity claim against the creators of a film call *Ginger and Fred*.²⁷¹ Rogers claimed that the title implied an endorsement by her and that it violated her right of publicity.²⁷² The court stated that application of the *Rogers* test made sense “in the context of commercial speech when the appropriation of a celebrity likeness creates a false and misleading impression that the celebrity is endorsing a product” and can be used to balance competing interests between the right to free expression and intellectual property rights.²⁷³ *Rogers* created a “relevance test,” under which liability can be imposed only if the challenged work has no relevance to the underlying work, or if there is some relevance, that the public is misled regarding its content or source.²⁷⁴ The court held that the title of the film *Ginger and Fred* was protected by the First Amendment because it bore some relevance to the film's story and because the title contained no explicit indication that Ginger Rogers endorsed or had a role in developing the film.²⁷⁵

The *Hart* court was reluctant to apply the *Rogers* test because the Third Circuit had not adopted it in the context of either a Lanham Act claim or a right of publicity claim.²⁷⁶ Two other circuits and some district courts had, however, recently adopted the test.²⁷⁷ This court preferred the transformative

²⁶⁹ *Id.*; see James J. S. Holmes & Kanika D. Corley, *Practice Tips: Defining Liability for Likeness of Athlete Avatars in Video Games*, 34 LOS ANGELES LAW. 17 (May 2011).

²⁷⁰ *Hart*, 808 F. Supp. 2d at 787–93 (citing *Rogers v. Grimaldi*, 875 F.2d 994 (2nd Cir. 1989)).

²⁷¹ *Rogers*, 875 F.2d at 996.

²⁷² *Id.* at 997.

²⁷³ *Hart*, 808 F. Supp. 2d at 788 (quoting *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 956 (6th Cir. 2003)).

²⁷⁴ *Id.*

²⁷⁵ *Id.* The film, by Federico Fellini, was about two fictitious Italian cabaret performers, who imitated Fred Astaire and Ginger Rogers and became known in Italy as “Ginger and Fred.” *Rogers*, 875 F.2d at 996.

²⁷⁶ *Hart*, 808 F. Supp. 2d at 792.

²⁷⁷ *Id.* (citing *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 n.7 (5th Cir. 1999); *Brown v. Elec. Arts, Inc.*, No. 2:09-cv-01598-FMC-RZx, 2009 U.S. Dist. LEXIS 131387, at *14 (C.D. Cal. Sept. 23, 2009) (The court dismissed former NFL football player Jim Brown's Lanham Act claim. He had contended that the inclusion of his likeness in EA's Madden NFL video game—a companion product to NCAA Football—implied his endorsement of the game. The court disagreed, applied the *Rogers* test and held that EA's use of his likeness was protected by the First Amendment.); *Dillinger, LLC v. Elec. Arts, Inc.*, No. 1:09-cv-1236, 2011 WL

test because it believed it better balanced the First Amendment and right of publicity interests.²⁷⁸ Clearly, the *Hart* decision reflects the approach taken by the California courts in *Winter* and *Kirby*, emphasizing the totality of the whole, rather than focusing on the individual characters or elements of the game.

These three video game cases are only the beginning. They raise difficult questions that necessarily implicate a variety of rights that need to be balanced. As these games become more technically sophisticated and provide users with more options for customization of avatars—and even creation of content—additional issues will present themselves. The examples in Part III discuss some of these issues.

PART III

Part I of this Article presented three Scenarios, each with three examples, involving History, Sports, and Music. This Part discusses these examples in more detail.

A. Scenario 1—History

Example 1 clearly typifies a situation in which First Amendment freedoms would be most supreme. The book is a non-fictional account of events, whose facts are not copyrightable. The copyright interests in the old images and drawings in the book, assuming they were produced prior to 1923, would be long-since expired and those images and drawings would be in the public domain.²⁷⁹

Example 2 introduces some technological changes. While the computer video game is a new form for the expression, it is afforded full First Amendment protection.²⁸⁰ The facts contained in the game are not copyrightable.²⁸¹ The photographs, another new technological form for

2457678, at *23 (S.D. Ind. Jun. 16, 2011) (The court rejected a claim under the Lanham Act that EA's use of the term "Dillinger Tommy Gun" in its *Godfather* video games violated the plaintiff's trademark interest. The court applied the *Rogers* test and found for EA on its First Amendment defense.)).

²⁷⁸ *Id.* at 792–93. The *Hart* case is presently on appeal before the Third Circuit. See *Hart*, 808 F. Supp. 2d 757, *appeal docketed*, No. 11-3750 (3d Cir. Oct. 7, 2010).

²⁷⁹ Under the Sonny Bono Copyright Term Extension Act of 1998, copyrighted works created after January 1, 1923 were given an additional 20 years of protection. Pub. L. 105-298, 112 Stat. 2827 (amending 17 U.S.C. §§ 302, 304). Any copyrighted work created before 1923 fell into the public domain in 1997. See *Golan v. Holder*, 132 S. Ct. 873, 903–04 (2012) (Breyer, J., dissenting). Any drawing or image created during or after 1923 would probably still be subject to copyright protection.

²⁸⁰ See *Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729, 2733 (2011) (holding that video games are entitled to full First Amendment protection).

²⁸¹ See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344 (1991).

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copyrightable expression, also would have fallen into the public domain long ago.²⁸²

Example 3 introduces several new twists. The characters in the game are alive and may have different rights of publicity under a variety of state laws.²⁸³ Also, significantly, because most, if not all, of the activity of these characters is newsworthy or of public concern, and because some of these characters are public officials or public figures, First Amendment interests might outweigh their rights of publicity.²⁸⁴ This would likely be true for the graphic depictions of these characters in their avatars, too.²⁸⁵ However, there would almost certainly be copyright interests in the particular photographs included in the game, and their use would have to be licensed.²⁸⁶

B. Scenario 2—Sports

Example 1 is fairly straightforward. As the game includes only players from the early twentieth century, most of the copyrights have likely expired. There would, however, still be copyright interests in any image or photograph created on or after 1923.²⁸⁷ There may be a few states that provide for extended rights of publicity for deceased individuals, but in most states, such rights probably would have expired.²⁸⁸ Even in Tennessee, where the right is permanent, non-use of the name, likeness, or image of the person for commercial purposes for a period of two years can lead to termination of the right.²⁸⁹ In states where the right of publicity outlives the individual, use of that individual's name, likeness, and biographical and statistical data probably would be permissible, subject to the same restrictions as discussed in the next example.

Example 2 is a fairly accurate summary of the fantasy sports cases in *CBC* and *CBS*.²⁹⁰ As those cases clearly held, the First Amendment will trump the right of publicity as it pertains to the use of players' names, and biographical

²⁸² See *supra* note 279.

²⁸³ See *infra* notes 307–29 and accompanying text. Even if some of the characters are deceased, their rights of publicity may survive in some states. See, e.g., CAL. CIV. CODE § 3344.1 (2012) (providing for an action for a deceased personality for 70 years after death for any such person who has died within 70 years prior to January 1, 1985); OKLA. STAT. tit. 12 § 1448 (providing for an action for a deceased personality for 100 years after death for any such person who has died within 50 years prior to January 1, 1986). In Tennessee, these rights may extend forever. See TENN. CODE ANN. §§ 47-25-1101 to 1108 (2012); State ex rel. Elvis Presley Int'l Mem. Found. v. Crowell, 733 S.W.2d 89 (Tenn. Ct. App. 1987).

²⁸⁴ See 2 MCCARTHY, *supra* note 40, §§ 8:14, 8:46–8:52.

²⁸⁵ *Id.*; see also *supra* notes 201–06, 231–32 and accompanying text.

²⁸⁶ See 17 U.S.C. § 102 (2006).

²⁸⁷ See *supra* note 279.

²⁸⁸ See *supra* note 283.

²⁸⁹ TENN. CODE ANN. § 47-25-1104(b)(2) (2012).

²⁹⁰ See *supra* notes 180–208 and accompanying text.

and statistical information.²⁹¹ While this example states that there are no images or photographs of the players, the *CBS* case included “pictures” and “images” among the items that can freely be used.²⁹² An argument can be made under *CBS* that pictures or images—or likenesses—of these players can be included in these games, subject to specific copyright interests in particular photographs of the players. The example states there are no images or logos of the major league teams. While the cities and names of the teams for whom the players play would almost certainly be exempted as nominal use, any trademarked symbols or logos would require licensing from MLB.²⁹³

Example 3 is essentially the *Keller* and *Hart* cases, whose dispositions remain unresolved. While *Hart* was disposed of by summary judgment in favor of EA, the Third Circuit is presently reviewing the issue on appeal, and likewise, the Ninth Circuit is considering *Keller*.²⁹⁴ One of the ironies in this current state of affairs is that EA has been paying a great deal of money to the NFL and the NFLPA in order to license not only league and team logos but also the names and likenesses of the football players in Madden NFL (EA’s very similar and very successful series of professional football video games).²⁹⁵ An argument can be made that EA does not have to pay to license some of the player information for which it is presently paying.²⁹⁶ While a good deal of what EA is paying to the NFL and NFLPA (and to the NCAA for NCAA Football) is for the exclusivity of the license, EA just announced that as part of a class action settlement, it will allow its current licensing agreement with the NCAA lapse in 2014 and will not sign any exclusive deals with the NCAA for at least five years.²⁹⁷

²⁹¹ See *supra* notes 180–208 and accompanying text.

²⁹² See *CBS Interactive Inc. v. NFL Players Ass’n, Inc.*, 259 F.R.D. 398, 403, 417–18 (D. Minn. 2009).

²⁹³ See generally J. Gordon Hylton, *The Over-Protection of Intellectual Property Rights in Sport in the United States and Elsewhere*, 21 J. LEGAL ASPECTS SPORT 43 (2011); Joseph P. Liu, *Sports Merchandising, Publicity Rights, and the Missing Role of the Sports Fan*, 52 B.C. L. REV. 493 (2011); Ford & Liebler, *supra* note 103.

²⁹⁴ See *supra* notes 230 & 278.

²⁹⁵ See Owen Good, *EA Lawsuit Doesn’t Mean Madden’s Exclusive is a License to be Killed*, KOTAKU (Jan. 21, 2012, 5:00 PM), <http://kotaku.com/5878160/ea-lawsuit-doesnt-mean-maddens-exclusive-is-a-license-to-be-killed>.

²⁹⁶ See *supra* notes 180–209 and accompanying text.

²⁹⁷ Hagens Berman, *\$27 Million Settlement Announced in EA Madden Price-Fixing Lawsuit*, BUSINESS WIRE (July 20, 2012, 10:20 PM), <http://www.businesswire.com/news/home/20120720005998/en/Hagens-Berman-27-Million-Settlement-Announced-EA>. In yet another irony, EA is involved in a legal dispute with Textron, Inc., the maker of Bell helicopters. EA contends that it does not have to seek a license for using images of the helicopters in its Battlefield 3 video game. See *Elec. Arts, Inc. v. Textron, Inc.*, No. C 12-00118, 2012 U.S. Dist. LEXIS 59357, at *3, (N.D. Cal. Apr. 27, 2012). It is ironic because, while EA might benefit by arguing that same position regarding the Madden NFL series, its

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C. Scenario 3—Music

Example 1 is very simple. Because all the songs and performances are from before 1923, all copyright interests in those works have fallen into the public domain.²⁹⁸ The example is further constrained by the fact that users have very little ability to manipulate the performances. An argument might be made that a user's creative inputs may have contributed to a new protectable expression, but even that would not have implicated any copyright or right of publicity claims in the songs or performances or in the performers themselves.

Example 2 mirrors closely the situation in *No Doubt*.²⁹⁹ Unfortunately, there will be no further decision in that case as the parties agreed to settle their dispute.³⁰⁰ While all three of the recent video game cases went to great pains to compare and distinguish the significance of user-modifiable attributes for the avatars, one of the significant differences in the music case is that the output of the musical performances in real-life results in copyrightable expression.³⁰¹ That is not true in the sports games.³⁰² Whatever Sam Keller and Ryan Hart do on the football field—and it may be art in the eyes of some—it will not result in copyrightable expression. In *Band Hero*, the musical performances and the underlying works are certainly subject to copyright protection, and are and will need to be licensed for use by the game company.³⁰³

Example 3 pushes the envelope more. What happens when technology permits a user to use avatars to not only visually perform the song of another artist, but to use the distinctive voice or sound or style of that group to perform the other artist's work? For example, rather than have Gwen Stefani of *No Doubt*, in effect, lip sync The Rolling Stones's "Honky Tonk Women," complete with Mick Jagger's vocal performance, which is exactly what happens today in *Band Hero*, what if the game permitted the Stefani avatar to perform a rendition of the song using *her* voice and style? What if users could choose any of the one hundred bands included in Example 3's 'Band Hero on Steroids' to perform any of the 5,000 songs included in the game? What if a user could input a few (or many) words and/or melodies and request a

exclusive license from the NFL and the NFLPA have given it a virtual monopoly in the NFL video game market. See Good, *supra* note 295.

²⁹⁸ See *supra* note 279.

²⁹⁹ See *supra* notes 3–4, 13–22, 231–42 and accompanying text.

³⁰⁰ Randy Lewis, *No Doubt, Activision Settle "Band Hero" Beef*, LATIMES.COM (Oct. 3, 2012, 5:40 PM), <http://articles.latimes.com/2012/oct/03/entertainment/la-et-ct-no-doubt-activision-settle-20121003>.

³⁰¹ See 17 U.S.C. § 102 (2006).

³⁰² See Michele R. Hull, Article, *Sports Leagues' New Social Media Policies: Enforcement under Copyright Law and State Law*, 34 COLUM. J. L. & ARTS 457, 468–69 (2011).

³⁰³ See 17 U.S.C. § 102 (2006).

performance in the voice or style of The Beatles or The Beach Boys or Cage the Elephant? Technology will likely bring this to a gaming console or computer in the near future.

Copyright implications make this scenario more complicated than the *No Doubt* case. In *No Doubt*, the band's gripe with Activision was primarily one involving the right of publicity.³⁰⁴ The band licensed the use of the two *No Doubt* songs and performances included in the game.³⁰⁵ The *No Doubt* case dealt primarily with the tension between the right of publicity and the First Amendment.³⁰⁶ In the future, will performers and content holders be willing to license entire libraries of songs for inclusion in a game like 'Band Hero on Steroids?' What will be and who will own the copyright interests (if any) in the works and performances created by the game?

D. *Ramifications for the Future*

The tensions between copyright law and the First Amendment have existed for over two hundred years and will continue to evolve. The fair use doctrine and the idea/expression dichotomy work well to achieve an appropriate balance. Once we add right of publicity law to the mix, however, it becomes much more difficult, if only because the right of publicity is determined by state law, and, as we have seen, state laws vary greatly.

Among the most problematic variations of state right of publicity laws are: (1) the scope of the right; (2) the rights of the deceased; (3) the duration of the right; (4) the jurisdictional domiciliary requirements; and (5) whether or not the right is to be applied retroactively. In New York, for example, statutory law proscribes the use of a person's "name, portrait, picture or voice . . . for advertising purposes or for the purposes of trade without the written consent" of the person.³⁰⁷ California prohibits the use of a person's "name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent."³⁰⁸ Indiana includes within its definition of the right of publicity the use of a person's "name, voice, signature, photograph, image, likeness, distinctive appearance, gesture, or mannerisms."³⁰⁹ New York does not

³⁰⁴ *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 400 (Cal. App. 2011).

³⁰⁵ See *supra* note 13–22 and accompanying text.

³⁰⁶ See *supra* notes 231–42 and accompanying text.

³⁰⁷ N.Y. CIV. RIGHTS LAW § 51 (McKinney 2002).

³⁰⁸ CAL. CIV. CODE § 3344(a) (West 2012).

³⁰⁹ IND. CODE ANN. § 32-36-1-7 (West 2002). See Brittany A. Adkins, Comment, *Crying Out for Uniformity: Eliminating State Inconsistencies in Right of Publicity Protection Through a Uniform Right of Publicity Act*, 40 CUMB. L. REV. 499, 503–24 (2010) for a detailed comparison of the statutory law in New York, California, Tennessee, and Indiana.

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recognize a right of publicity that extends past a person's death.³¹⁰ However, California provides for a post-mortem right of publicity for seventy years, and Indiana and Oklahoma for 100 years.³¹¹ In Tennessee, the right can continue indefinitely.³¹²

A few recent cases highlighted the often-incongruous nature of right of publicity law. In 2007, in *Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*³¹³ and *Shaw Family Archives Ltd. V. CMG Worldwide, Inc.*,³¹⁴ courts in both California and New York came to the same conclusion regarding the lack of descendibility of the right of publicity of Marilyn Monroe. Both courts concluded that since no post-mortem right of publicity existed at the time of her death in 1962 in either state, she could not devise such a right.³¹⁵ There was some question as to of which state she was a domiciliary at the time of her death, but since neither state had a post-mortem right, this was immaterial.³¹⁶

In the aftermath of the *Milton H. Greene* decision, California amended its law to make it clear that the post-mortem right of publicity could be applied retroactively.³¹⁷ The California statute now provides that the right can be asserted for any person "who has died within seventy years prior to January 1, 1985".³¹⁸ The Oklahoma statute provides the right for anyone "who has died within fifty years prior to January 1, 1986."³¹⁹ Tennessee has applied the right of publicity retroactively, not by statute, but by case law. In *State ex rel. Elvis Presley International Memorial Foundation v. Crowell*, the court specifically held that the descendibility of Elvis Presley's right of publicity was not based upon Tennessee's statutory law, but rather upon the existence of a common law right of publicity at the time of his death.³²⁰

In *The Hebrew University of Jerusalem v. General Motors*, the District

³¹⁰ See *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 585 (2d Cir. 1990).

³¹¹ CAL. CIV. CODE § 3344.1(g) (West Supp. 2012); IND. CODE ANN. §§ 32-36-1-8 (West 2002); OKLA. STAT. ANN. tit. 12, ch. 25, § 1448(G) (West 2010).

³¹² TENN. CODE ANN. § 47-25-1104(b)(2) (2012). See *State ex rel. Elvis Presley Int'l Mem. Found. v. Crowell*, 733 S.W.2d 89, 92 (Tenn. Ct. App. 1987).

³¹³ *Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*, No. CV 05-2200, 2007 U.S. Dist. LEXIS 97275 (C.D. Cal. May 14, 2007).

³¹⁴ *Shaw Family Archives Ltd. V. CMG Worldwide, Inc.*, 486 F. Supp. 2d 309 (S.D.N.Y. 2007).

³¹⁵ *Milton H. Greene Archives*, 2007 U.S. Dist. LEXIS 97275, at *2-3; *Shaw Family Archives*, 486 F. Supp. 2d at 314.

³¹⁶ *Shaw Family Archives*, 486 F. Supp. 2d at 314-15.

³¹⁷ Act of Oct. 10, 2007, ch. 439, § 1, 2007 Cal. Stats. 3757, 3760 (amending CAL. CIV. CODE § 3344.1(h)).

³¹⁸ CAL. CIV. CODE § 3344.1(h) (West Supp. 2012).

³¹⁹ OKLA. STAT. ANN. tit. 12, ch. 25, § 1448(H) (West 2010).

³²⁰ *State ex rel. Elvis Presley Int'l Mem. Found. v. Crowell*, 733 S.W.2d 89, 99 (Tenn. Ct. App. 1987).

Court for the Central District of California found that there was a factual issue regarding whether Albert Einstein's right of publicity had been devised to the plaintiff.³²¹ Einstein was a domiciliary of New Jersey when he died.³²² The defendant argued that, as there was no right of publicity at the time of his death, he could not bequeath such interest.³²³ However, the court held that while New Jersey does not have a statutory post-mortem right and no New Jersey state court has recognized such right, a federal court in New Jersey, in the *Estate of Presley v. Russen*, had predicted that the state would recognize a post-mortem right of publicity.³²⁴ The court was very careful in distinguishing the Marilyn Monroe cases, in which the California courts created a statutory right of publicity after Monroe died.³²⁵ Only after the Monroe cases did the state amend the statute to make it retroactive.³²⁶ However, the court noted that in *Crowell*, on the other hand, that court recognized a common law right of publicity.³²⁷ The difference between the two was creation of a right and recognition of a pre-existing right.³²⁸ A created right, therefore, only existed prospectively, whereas a recognized right was retroactive.³²⁹

Even if there were not such extensive differences in state right to publicity laws, courts would be grappling with which test to use to balance competing First Amendment interests with rights of publicity, and how to apply the test to the facts. As we have seen above, some courts have tried the transformative test, some the *Rogers* test, and one the "predominant use" test. In cases involving similar factual situations, the *Winters* court, applying the transformative test came to a completely opposite conclusion than the *Tony Twist* court, applying the predominant use test.³³⁰ Even when courts apply the same test to the same facts, results are inconsistent. As discussed above, in the NCAA Football video game cases district courts in California and New Jersey applied the transformative test only to come to opposite conclusions, with the *Keller* court focusing on the *lack* of transformation with respect to the plaintiff's virtual player and the New Jersey court focusing on the many ways in which the plaintiff's player image *could* be transformed: a difference of actual and potential.³³¹

³²¹ The Hebrew Univ. of Jerusalem v. Gen. Motors, No. CV10-03790, 2012 U.S. Dist. LEXIS 36048, at *37-38 (C.D. Cal. Mar. 16, 2012).

³²² *Id.* at *15.

³²³ *Id.* at *30.

³²⁴ *Id.* at *16 (citing *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981)).

³²⁵ *Id.* at *31; see *supra* notes 313-18 and accompanying text.

³²⁶ *Hebrew Univ.*, 2012 U.S. Dist. LEXIS 36048, at *31.

³²⁷ *Id.* at *32; see *supra* note 320 and accompanying text.

³²⁸ *Hebrew Univ.*, 2012 U.S. Dist. LEXIS 36048, at *32.

³²⁹ *Id.* at *31-32.

³³⁰ See *supra* note 104-143 and accompanying text.

³³¹ See *supra* note 210-230, 243-278 and accompanying text.

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Some propose a federal right to publicity statute.³³² While there would be advantages to having one standard, the jurisdictional and political challenges would likely be impossible to meet. Similarly, a good argument exists for a uniform right of publicity act.³³³ That, too, even if somewhat successful, would take a long time to produce results, and even then the act would probably not resolve all the problems in conflicting state laws until every state adopted it.

A more likely solution is for a stronger rule to emerge from First Amendment or copyright preemption jurisprudence at a high court level. Such a rule would be applied across the board to the variety of state right of publicity laws. In an excellent article, Thomas F. Cotter and Irina Y. Dmitrieva, argue:

First Amendment and copyright preemption analysis tend to converge on two relatively simple principles: first, that publicity claims arising in the context of commercial speech usually should withstand both First Amendment and copyright preemption challenges; and second, that publicity claims arising in the context of noncommercial speech may proceed only when, among other things, the exercise of publicity rights plausibly can be justified as advancing a state interest in protecting personal privacy or individual autonomy, or (possibly) in preventing consumers from erroneously perceiving that the plaintiff endorses a product that she does not, in fact, endorse.³³⁴

Most of the right to publicity cases can be appropriately decided using a strict First Amendment standard. As Cotter and Dmitrieva suggest, the application of right of publicity claims arising in connection with commercial speech must satisfy intermediate scrutiny, while claims arising in connection with noncommercial speech must satisfy strict scrutiny.³³⁵ While there would

³³² See Eric J. Goodman, *A National Identity Crisis: The Need for a Federal Right of Publicity Statute*, 9 DEPAUL-LCA J. ART & ENT. L. 227 (1999); Blair Joseph Cash, Note, "Hasta La Vista, Funny Guys": Arnold Schwarzenegger's Fictional Voice Misappropriation Lawsuit Against Comedians Imitating his Voice and the Case for a Federal Right of Publicity Statute, 18 J. INTELL. PROP. L. 207 (2010); Jennifer Y. Choi, Comment, No Room for Cheers: Schizophrenic Application in the Realm of Right of Publicity Protection, 9 VILL. SPORTS & ENT. L.J. 121 (2002); Risa J. Weaver, *Online Fantasy Sports Litigation and the Need for a Federal Right of Publicity Statute*, 9 DUKE L. & TECH. REV. 1 (2010), available at <http://scholarship.law.duke.edu/dltr/vol9/iss1/1/>; Sean D. Whaley, "I'm a Highway Star": An Outline for a Federal Right of Publicity, 31 HASTINGS COMM. & ENT. L.J. 257 (2009). But see Krishan Thakker, *The Federalism Case Against a Federal Right to Publicity*, 10 U. DENV. SPORTS & ENT. L.J. 1 (2011).

³³³ Adkins, *supra* note 309.

³³⁴ Thomas F. Cotter & Irina Y. Dmitrieva, *Integrating the Right of Publicity with First Amendment and Copyright Preemptive Analysis*, 33 COLUM. J.L. & ARTS 165, 165 (2010).

³³⁵ *Id.* at 169, 189, 200–02.

still be room for different interpretations by different courts, there would at least be a stronger and more well-defined body of federal law from which to make the factual and legal determinations. Fair use provides one of the most important tools for protecting and balancing First Amendment freedoms and copyright law. It is fitting that the transformative test, borrowed from that jurisprudence, be used to similarly protect and balance First Amendment freedoms and the right of publicity.

CONCLUSION

Thirty years ago, in *Martin Luther King, Jr., Center for Social Change, Inc. v. American Heritage Products, Inc.*, the Georgia Supreme Court responded to four questions certified to it from the Circuit of Appeals for the Eleventh Circuit.³³⁶ The questions were: (1) is the right of publicity distinct from the right of privacy; (2) does the right to publicity survive the death of the owner such that it is inheritable and devisable; (3) must the owner have commercially exploited the right before it can survive his death; and (4) what is the guideline to follow in defining commercial exploitation.³³⁷ The case involved plastic replica busts of Dr. King marketed and sold by the defendant.³³⁸ The busts were advertised for sale with promises that a portion of the proceeds would go to the King Center for Social Change.³³⁹ The defendant also published brochures that contained photographs of Dr. King and excerpts from some of his copyrighted speeches.³⁴⁰ The defendant testified that he created a trust fund to donate earnings to the Center, but that the trust fund agreement was never executed.³⁴¹ He also testified that he attempted to tender some funds to the Center, but that they were refused.³⁴²

The majority of the court answered the first two questions in the affirmative, holding there was a right of publicity in Georgia and that it did survive the death of its owner and was inheritable and devisable.³⁴³ It answered the third question in the negative, holding that the owner did not have to commercially exploit the right before his death in order for it to survive him, and, therefore, the court did not answer the last question.³⁴⁴

³³⁶ *Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. Am. Heritage Products, Inc.*, 296 S.E.2d 697 (Ga. 1982).

³³⁷ *Id.* at 699.

³³⁸ *Id.* at 698.

³³⁹ *Id.*

³⁴⁰ *Id.*

³⁴¹ *Id.* at 698–99.

³⁴² *Id.* at 699.

³⁴³ *Id.* at 700–05.

³⁴⁴ *Id.* at 705–06. The court proudly recounted that Georgia had been the first state to recognize the right of privacy in the *Pavesich* case in 1905 and that it had recognized a right of publicity in *Cabaniss v. Hipsley* in 1966. *Id.* at 700, 702 (citing *Pavesich v. New Eng.*

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In his eloquent and powerful concurring opinion, Justice Weltner stated that “in proclaiming this new ‘right of publicity,’ we have created an open-ended and ill-defined force which jeopardizes a right of unquestioned authenticity—free speech.”³⁴⁵ His concerns presaged many of the issues we face today. Justice Weltner reviewed some of the history behind the First Amendment and a Georgia Constitutional provision that predated the First Amendment by fourteen years: “No law shall ever be passed to curtail, or restrain the liberty of speech, or of the press; any person may speak, write and publish his sentiments, on all subjects, being responsible for the abuse of that liberty.”³⁴⁶ He objected “vigorously” to the majority’s conclusion that the “fabrication and commercial distribution of a likeness of Dr. King is not ‘speech,’” thereby eliminating a First Amendment or Free Speech inquiry.³⁴⁷ He stated that freedom of speech should not be limited to verbal expression, that often the most powerful of expression involves no words at all.³⁴⁸ He objected to the majority’s conclusion that the new right of publicity would be violated only in cases involving “financial gain.”³⁴⁹ He did not believe that a “financial gain” standard would withstand scrutiny.³⁵⁰

Justice Weltner stated that the answers to where these dividing lines should be fixed should not depend on the presence or absence of “financial gain,” but rather should be grounded upon what in the community’s judgment is unconscionable.³⁵¹ In short, he believed that the right of publicity the majority described would inevitably create additional and unnecessary legal tension with First Amendment freedoms.³⁵² He believed that existing legal doctrines would be sufficient without having to create a new right grounded in a “financial gain” standard.³⁵³ Justice Weltner’s reservations about adopting a right of publicity grounded in a “financial gain” standard were ahead of his

Life Ins., Co., 50 S.E. 68 (Ga. 1905); *Cabaniss v. Hipsley*, 151 S.E.2d 496 (Ga. App. 1966)). The court reviewed many of the early right of publicity cases and concluded that “[r]ecognition of the right of publicity rewards and thereby encourages effort and creativity.” *Id.* at 705. The court continued, “[i]f the right of publicity dies with the celebrity, the economic value of the right of publicity during life would be diminished because the celebrity’s untimely death would seriously impair, if not destroy, the value of the right of continued commercial use.” *Id.*

³⁴⁵ *Id.* at 708 (Weltner, J. concurring).

³⁴⁶ *Id.* (quoting GA. CONST art. I, § I, para. IV, now GA. CONST art. I, § I, para. V).

³⁴⁷ *Id.*

³⁴⁸ *Id.*

³⁴⁹ *Id.* at 708–709.

³⁵⁰ *Id.*

³⁵¹ *Id.* at 709.

³⁵² *Id.*

³⁵³ In the case at hand, Justice Weltner believed that the doctrine of unjust enrichment would have more easily resolved the problem. *Id.*

time. Courts need to be just as vigilant today in recognizing and distinguishing between commercial and noncommercial speech. When primarily noncommercial speech is involved, courts need to protect First Amendment freedoms without regard to whether the situation may also involve some sort of “financial gain.”

In cases like *Hart* and *Keller*, where publicly available and non-copyrightable information is used to create expressive content, courts should find that First Amendment interests outweigh rights of publicity. In cases like *Winter*, *Kirby*, and *Tony Twist*, where significant transformative elements are added, courts should, similarly, give great weight to First Amendment expressive freedom and find that it generally outweighs the right of publicity. The toughest of these cases are the *Comedy III* and Andy Warhol situations, where courts will have to make largely subjective determinations as to whether an artist’s creative expression is significant enough to warrant First Amendment protection. These results will inevitably vary and be unpredictable. Courts will have to determine whether a work is merely a literal depiction of a person or whether it rises to a level sufficient to be deemed “art.”

Cases like *No Doubt* will involve not only a balance between First Amendment rights and the right of publicity, but will also implicate copyrights, inasmuch as the works performed are protected by copyright law. In addition, it will not be long before courts are asked again to respond to the push of technology and decide how to handle the expressive output of simulation video games like the hypothesized ‘Band Hero on Steroids’ which may itself be copyrightable expression.