

A Collision Course Between the Right of Publicity and the First Amendment: The Third and Ninth Circuit Find EA Sports’s *NCAA Football* Video Games Infringe Former Student-Athletes Right of Publicity

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I. INTRODUCTION

The National Collegiate Athletic Association (the “NCAA”) is a voluntary association that includes 1,066 colleges and universities,¹ in which more than 430,000 students participate in intercollegiate sports.² The NCAA has an enforcement program that imposes severe penalties on member schools and student-athletes for noncompliance with NCAA rules, which are reflected in its manual governing Division I sports.³ According to the manual, the primary purpose of the NCAA’s structure and governing rules “is to maintain intercollegiate athletics as an integral part of the educational program . . . [and] retain a clear line of demarcation between intercollegiate athletics and professional sports.”⁴ The NCAA achieves this desired demarcation by requiring “student-athletes to be amateurs in an intercollegiate sport, and their participation should be motivated primarily by education and the physical, mental and social benefits to be derived.”⁵ Student-athletes risk their amateur status, and thus, their eligibility to participate in intercollegiate athletics if they accept

¹ See *About the NCAA*, NAT’L COLLEGIATE ATHLETIC ASS’N, <http://ncaa.org/about/who-we-are-membership> (last visited Oct. 25, 2014).

² *Id.*

³ National Collegiate Athletic Association, 2014-15 NCAA DIVISION I MANUAL, § 2.8.1–2.8.3, at 4 (2013), *available at*, http://www.ncaapublications.com/product_downloads/D115.pdf [hereinafter NCAA Div. I Manual].

⁴ *Id.* § 1.3.1, at 1.

⁵ *Id.* § 2.9, at 4.

compensation for their athletic skill or performance.⁶ Consequently, the manual circumscribes all commercial opportunities available for current and former student-athletes.

The Collegiate Licensing Company (the “CLC”), which serves as the NCAA’s licensing agent,⁷ facilitates the licensing and marketing of NCAA products to third-party enterprises. Marketing and licensing NCAA products comprises a “\$4.6 billion retail market for collegiate licensed merchandise.”⁸ Electronic Arts, Inc. (“EA Sports”) entered into a six-year exclusive contract with CLC in 2005, which effectively gave EA Sports a monopoly for the development and distribution of NCAA video games.⁹ This contract provided EA Sports the exclusive right to replicate NCAA teams, stadiums, uniforms, and mascots within its NCAA video games.¹⁰ EA Sports derived significant commercial success from its NCAA video games because of its ability to portray realistic depictions of the various players and college teams providing a simulated experience similar to participating in a real college football game.¹¹ Because EA Sports, pursuant to its exclusive agreement with CLC, agreed to comply

⁶ See *id.* § 12.1.2, at 59–60 (explaining amateur rules ensure that student-athletes: (1) do not receive benefits that could be construed as remuneration for athletics participation, (2) do not trade on their public standing as a student-athletes, and (3) are not exploited by professional or commercial interests that would abridge their status as amateurs in their sport).

⁷ *About CLC*, COLLEGIATE LICENSING CO., <http://www.clc.com/About-CLC.aspx> (last visited Oct. 18, 2013).

⁸ *Id.*

⁹ Liron Offir, Article, *Monopolistic Sleeper: How the Video Game Industry Awoke to Realize that Electronic Arts was Already in Charge*, 8 DUQ. BUS. L. J. 91, 97 (2006); see also Chris Morris, *EA Secures College Football Rights*, CNN MONEY (Apr. 11, 2005, 9:42 AM), http://money.cnn.com/2005/04/11/technology/personaltech/ea_ncaa/.

¹⁰ *Id.*

¹¹ Third Consol. Am. Class Action Compl. at 131, *Keller v. Elec. Arts, Inc.*, No. 09–1967, 2010 U.S. Dist. LEXIS 1079 (N.D. Cal. May 5, 2009) [hereinafter Third Am. Compl.] (describing how EA Sports undertook significant efforts to model each digital avatar to mirror the respective student-athlete by matching: (1) the name of the real student-athlete; (2) his real-life jersey number; (3) his position played; (4) his hometown; (5) his year of eligibility; (6) his athletic abilities (e.g., speed, strength, agility, etc); (7) his physical characteristics; and (8) how he dressed for games in real life); see also Third Consol. Am. Class Action Compl. at 89 (discussing users’ ability to download player names: “In the most recent versions of its games for the Sony Play Station 3, EA intentionally made the process of obtaining actual player names even easier by allowing players to share rosters online using its ‘EA Locker’ feature. The EA Locker feature allows gamers to upload rosters from other gamers while in the game itself. Prior to the EA Locker, gamers had to download rosters from a computer, upload the files to the gaming console and then transfer the rosters to the game. Now the gamer can obtain full NCAA rosters in a matter of seconds without using a computer. Furthermore, numerous websites, such as www.freencaa09rosters.com, keep a list of players who offer free NCAA rosters utilizing the EA Locker feature.”).

with the NCAA's rules, EA Sports did not pay any current or former student-athlete for the use of his name, image, and likeness in its NCAA video games.¹²

While technological advancements foster the consistent commercial expansion of college sports by creating new markets,¹³ the NCAA refuses to amend its amateur rules precluding student-athletes from sharing in this commercial revolution.¹⁴ The failure by the NCAA to act has led some former student-athletes to take legal action.¹⁵ For instance, two former quarterbacks, Samuel Keller and Ryan Hart, asserted individual right of publicity claims against EA Sports, claiming that EA Sports misappropriated their identity and likeness without their consent to enhance the commercial value of its *NCAA Football* video game series.¹⁶ In both cases, EA Sports asserted First Amendment defenses, arguing that its video games were protected as expressive speech.¹⁷

Courts have recognized that the First Amendment affords protection to numerous forms of expressive speech, including written and spoken

¹² *Id.* at 129–30.

¹³ See Kendall K. Johnson, Article, *Enforceable Fair and Square: The Right of Publicity, Unconscionability, and NCAA Student-Athlete Contracts*, 19 Sports Law. J. 1, 3 (2012).

¹⁴ Jeffrey L. Seglin, *Should Colleges Pay Athletes to Play?*, THE RIGHT THING (June 30, 2013, 11:39 AM), <http://jeffreysglin.blogspot.com/2013/06/should-colleges-pay-athletes-to-play.html>. (quoting Mark Emmert, the president of the NCAA), (“As long as I’m president of the NCAA, we will not pay student-athletes to play sports. Compensation for students is just something I’m adamantly opposed to. We’re providing athletes with world class educations and world class opportunities. If they are one of the few that are going to move on to become a pro athlete, there’s no better place in the world to refine their skills as a student-athlete.”). But see Johnson, *supra* note 13, at 3 (criticizing the NCAA’s hypocrisy, which is based on “[t]he [NCAA’s] often-stated contention that it is protecting the players from ‘excessive commercialism’ is ludicrous; the only thing it’s protecting is everyone else’s revenue stream.”).

¹⁵ See Hart Second Am. Compl., Hart v. Elec. Arts, Inc., (Oct. 12, 2010), ECF No. 25.; Keller Compl., Keller v. Elec. Arts, Inc., (May 5, 2009), ECF No. 1.

¹⁶ Hart Second Am. Compl. 10–13; Keller Compl. 18.

¹⁷ See Hart v. Elec. Arts, Inc., 717 F.3d 141, 147 (3d Cir. 2013) (“[EA Sports] contends that the First Amendment shields it from liability for this violation because NCAA Football is a protected work.”); Keller v. Elec. Arts, Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig.), 724 F.3d 1268, 1272–73 (9th Cir. 2013) (“EA raises four affirmative defenses derived from the First Amendment: the ‘transformative use’ test, the Rogers test, the ‘public interest’ test, and the ‘public affairs’ exemption.”).

words (fact or fiction),¹⁸ biographies,¹⁹ documentaries,²⁰ docudramas,²¹ music,²² films,²³ paintings,²⁴ entertainment,²⁵ whether or not sold for profit,²⁶ and other expressive works depicting real-life figures. In 2011, the United States Supreme Court determined that video games are protected as expressive speech under its First Amendment jurisprudence.²⁷ Although the First Amendment's free speech principles protect these different forms and mediums of expression, such protections can be limited in situations where the right of free speech necessarily conflicts with other protected rights, such as the right of publicity.²⁸

In the only Supreme Court decision to address the tension between the right of publicity and the First Amendment, the Court held that when state law publicity rights conflict with First Amendment rights, courts must balance these competing interests.²⁹ Because the Supreme Court's decision in *Zacchini v. Scripps-Howard Broadcasting Co.* did not establish a specific test or legal standard for resolving this conflict between the right of publicity and the First Amendment,³⁰ the federal circuits have

¹⁸ See *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 397 (Cal. 2001) (quoting *Guglielmi v. Spelling-Goldberg Productions*, 25 Cal. 3d 860, 869 (Cal. 1979)) (Bird, C.J., concurring) ("The right of publicity derived from public prominence does not confer a shield to ward off caricature, parody and satire.").

¹⁹ *Matthews v. Wozencraft*, 15 F.3d 432, 439–40 (5th Cir. 1994).

²⁰ *Ruffin-Steinback v. DePasse*, 82 F. Supp. 2d 723, 730–31 (E.D. Mich. 2000), *aff'd*, 267 F.3d 457, 461–62 (6th Cir. 2001).

²¹ *Hicks v. Casablanca Records*, 464 F. Supp. 426, 433 (S.D.N.Y. 1978).

²² *Ward v. Rock Against Racism*, 491 U.S. 781, 790 (1989).

²³ *Joseph Burstyn v. Wilson*, 343 U.S. 495, 501 (1952).

²⁴ *Kaplan v. California*, 413 U.S. 115, 119–20 (1973).

²⁵ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) (human cannonball performance).

²⁶ *Guglielmi v. Spelling-Goldberg Prod.*, 25 Cal. 3d 860, 868 (1979) (Bird, C.J., concurring) (citing *Time, Inc. v. Hill*, 385 U.S. 374, 397 (1967)) ("The First Amendment is not limited to those who publish without charge. Whether the activity involves newspaper publication or motion picture production, it does not lose its constitutional protection because it is undertaken for profit.").

²⁷ See *Brown v. Entm't Merch. Ass'n.*, 131 S. Ct. 2729, 2733 (2011) ("[V]ideo games communicate ideas – and even social messages – through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player's interaction with the virtual world).").

²⁸ See *Zacchini*, 433 U.S. at 574–75 ("Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, [the Court] [is] quite sure that the First . . . Amendment[] do[es] not immunize the media when they broadcast a performer's entire act without his consent").

²⁹ See *id.* ("Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, [the Court] [is] quite sure that the First . . . Amendment[] do[es] not immunize the media when they broadcast a performer's entire act without his consent").

³⁰ *Id.*

adopted different balancing tests to resolve the tension. In balancing the tension between the right of publicity and the right to free speech, courts have adopted four distinct legal methodologies: (1) a case-by-case balancing approach; (2) the Predominant Use Test; (3) the *Rogers* Test; and (4) the Transformative Use Test.³¹

This Comment analyzes the four different balancing approaches and the Third and Ninth Circuit's most recent application in *Hart v. Elec. Arts Inc.*,³² and *Keller v. Elec. Arts, Inc.*³³ Specifically focusing on the video game context, this Comment concludes that the Transformative Use Test provides the most effective legal standard in resolving the tension underlying the right of publicity and the First Amendment. Part II examines the origins of the right of publicity and its interplay with the First Amendment.³⁴ Part III discusses the case law developing different standardized balancing tests that weigh the interests underlying the right to free expression against the interests in protecting the right of publicity.³⁵ Part IV describes why the Transformative Use Test is the proper legal framework in the context of video games, as well as providing the proper formulation and application of this balancing test.³⁶

II. BACKGROUND OF THE RIGHT OF PUBLICITY AND THE RISING TENSION BETWEEN THE RIGHT OF PUBLICITY AND THE FIRST AMENDMENT

"Every man has a property in his own person. This nobody has a right to, but himself."³⁷

Courts have increasingly recognized the evolution of the right of publicity as an intellectual property right that clashes with the First Amendment. Part II analyzes the historical development of the right of publicity, as well as the fundamental tensions between the interests underlying the right of publicity and the First Amendment. While Part II A examines the general application of the right of publicity and its historical origin, Part II B considers the conflicting interests underpinning

³¹ See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Assoc.*, 95 F.3d 959 (10th Cir. 1996) (applying ad-hoc balancing approach); *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003) (*en banc*) (formulating and applying the Predominant Use Test); *Rogers v. Grimaldi*, 875 F.2d 994 (2nd Cir. 1989) (formulating and applying the *Rogers* Test); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (Cal. 2001) (formulating and applying the Transformative Use Test).

³² 717 F.3d 141 (3d Cir. 2013).

³³ 724 F.3d 1268 (9th Cir. 2013).

³⁴ See *infra* Part II.

³⁵ See *infra* Part III.

³⁶ See *infra* Part IV.

³⁷ John Locke, SECOND TREATISE ON CIVIL GOVERNMENT (1690), available at, <http://www.gutenberg.org/files/7370/7370-h/7370-h.htm>.

the First Amendment against those underpinning the right of publicity. After discussing the interests underlying the tension between the right of publicity and the First Amendment, Part II B analyzes the Supreme Court decision in *Zacchini v. Scripps-Howard Broadcasting Co.*, which formally recognized that free speech can be constitutionally subordinated to certain intellectual property rights. In the wake of *Zacchini*, Part II C considers earlier case law that reconciled the tension between the right of publicity and the First Amendment from an ad-hoc perspective by weighing the competing interests based on the facts and circumstances of each case.

A. *Origins of the Right of Publicity*

As a general rule, the right of publicity is an intellectual property right created by state law that protects the commercial interest in an individual's cultivated identity.³⁸ The right of publicity grants individuals the exclusive right to control the commercial value of their name and likeness, as well as to prevent others from exploiting that value without their consent.³⁹ The right of publicity also recognizes the investment that individuals makes in developing a public image, and it prevents unjust enrichment by others who exploit the resulting goodwill.⁴⁰

The right of publicity evolved out of the common law right of privacy, which arose from the famous law review article written by

³⁸ Thomas J. McCarthy, *THE RIGHTS OF PUBLICITY AND PRIVACY*, § 1.3 (2d ed. 2012); see *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1138 (9th Cir. 2008) (citation omitted) (internal quotation marks omitted) (discussing the elements of California's common law right of publicity: "To sustain this action, [a plaintiff] must prove: (1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury.").

³⁹ For a discussion of what constitutes an individual's "likeness," see *Elvis Presley Enter. v. Capece*, 950 F. Supp. 783, 801 (S.D. Tex. 1996) ("To violate a plaintiff's right of publicity, . . . [] the defendant must employ an aspect of persona in a manner that symbolizes or identifies the plaintiff, such as the use of a name, nickname, voice, picture, achievements, performing style, distinctive characteristics or other indicia closely associated with a person."); see also McCarthy, *supra* note 38, § 1.3.

⁴⁰ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977); see *Gignilliat v. Gignilliat, Savitz & Bettis, L.L.P.*, 385 S.C. 452, 461 (2009) (citation omitted) ("Goodwill may be properly enough described to be the advantage or benefit which is acquired by an establishment beyond the mere value of the capital, stock, funds, or property employed therein, in consequence of the general public patronage and encouragement which it receives from constant or habitual customers, on account of its local position or common celebrity, or reputation for skill or affluence, or punctuality, or from other accidental circumstances or necessities, or even from ancient partialities or prejudices.").

Samuel Warren and Louis Brandeis in 1890.⁴¹ By preventing the press from disseminating truthful, but yet, intrusive and embarrassing information, Warren and Brandeis argued that people should have a legal right to their privacy.⁴² Warren and Brandeis were also concerned about famous people being able to control the commercial use of their photographs.⁴³ As such, people brought right of privacy actions because they wanted to enjoy their right to be left alone; thus, preventing others from invading their privacy, injuring their feelings, or assaulting their peace of mind.⁴⁴

During the middle of the twentieth century, courts began recognizing a distinction between the personal right to be left alone and the commercial right to control the use of one's identity.⁴⁵ Courts found that the commercial nature of a person's desire to control the use of their identity, not the right to be left alone was at issue.⁴⁶ As a result, the concept of a

⁴¹ See Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890), available at, <http://www.english.illinois.edu/-people-/faculty/debaron/582/582%20readings/right%20to%20privacy.pdf>.

⁴² *Id.* at 213–14.

⁴³ *Id.* at 195–96 n.7.

⁴⁴ McCarthy, *supra* note 38, § 1.7.

⁴⁵ See *Zacchini*, 433 U.S. at 573 (citations omitted) (internal quotation marks omitted) (discussing two key distinctions between the right of publicity and the right of privacy: “First, the State’s interests in providing a cause of action in each instance are different. The interest protected in permitting recovery for placing the plaintiff in a false light is clearly that of reputation, with the same overtones of mental distress as in defamation. By contrast, the State’s interest in permitting a right of publicity is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment Second, the two torts differ in the degree to which they intrude on dissemination of information to the public. In [the right of privacy] cases[,] the only way to protect the interests involved is to attempt to minimize publication of the damaging matter, while in right of publicity cases the only question is who gets to do the publishing. An entertainer such as [the plaintiff] usually has no objection to the widespread publication of his act as long as he gets the commercial benefit of such publication.”); *Cabaniss v. Hipsley*, 151 S.E.2d 496, 504 (Ga. Ct. App. 1966) (explaining there was a “fundamental distinction between causes of action involving injury to feelings, sensibilities or reputation . . . , and those involving an appropriation of rights in the nature of property rights for commercial exploitation.”). But see Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 Cal. L. Rev. 127, 167–78 (1993) (contending that expanded judicial and scholarly recognition protecting the right of publicity are not compelling).

⁴⁶ See *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1354 (D.N.J. 1981) (quoting *Palmer v. Schonhorn Enter., Inc.*, 232 A.2d 458, 462 (N.J. Super. Ct. Ch. Div. 1967)) (“[A]lthough the publication of biographical data of a well-known figure does not per se constitute an invasion of privacy, the use of that same data (as well as the name) for the purpose of capitalizing upon the name by using it in connection with a commercial project other than the dissemination of news or articles or biographies does.”).

property right in the commercial value of a person's identity was born.⁴⁷ No court explicitly recognized a distinct right of publicity until the Second Circuit's landmark case in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*⁴⁸ *Haelan* involved two rival chewing gum sellers that battled to obtain the rights from professional baseball players to use their pictures on chewing gum cards.⁴⁹ In resolving this dispute, the Second Circuit held that "in addition to and independent of that right of privacy . . . , a man has a right in the publicity value of his photograph . . . , [which is] called a 'right of publicity.'"⁵⁰ Even after Judge Frank's decision in *Haelan*, courts remained reluctant to afford legal protection to the "right of publicity."⁵¹ Even those courts that afforded legal protection to the right of publicity, they often preferred other traditional labels.⁵²

William Prosser's influential 1960 law review article addressed this tension between Judge Frank's recognition of the right of publicity and the subsequent case law reluctance to adopt the label and/or concept by dividing the invasion of privacy tort into four separate and discrete categories: (1) intrusion; (2) disclosure; (3) false light; and (4) appropriation.⁵³ Prosser specifically viewed the *Haelan* decision as

⁴⁷ See McCarthy, *supra* note 38, §§ 1.7, 10.9 (quoting Hoffman, *Limitations on the Right of Publicity*, 28 BULL. COPYRIGHT SOC'Y 111, 112 (1980)) ("It is more accurate to think of [the right of publicity] as a sui generis mixture of personal rights, property rights, and rights under unfair competition than to attempt, Procrustean-like, to fit it precisely into one of those categories.").

⁴⁸ *Haelan Lab., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953).

⁴⁹ *Id.* at 867.

⁵⁰ See *id.* at 868 (discussing the scope of the "right of publicity," Judge Frank stated: "For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways.").

⁵¹ See *Strickler v. Nat'l Broad. Co.*, 167 F. Supp. 68, 70 (S.D. Cal. 1958) (dismissing the right of publicity claims, Judge Westover stated, "[t]his Court does not feel it wishes to blaze the trail to establish in California a cause of action based upon the right of publicity.").

⁵² See *Ettore v. Philco Television Broad. Corp.*, 229 F.2d 481, 485 (3d Cir. 1956) ("The state of the law is still that of a haystack in a hurricane but certain words and phrases stick out. We read of the right of privacy, of invasion of property rights, of breach of contract, of equitable servitude, of unfair competition; and there are even suggestions of unjust enrichment."); see also *Hogan v. A. S. Barnes & Co., Inc.*, No. 8645, 1957 WL 7316, at *1 (Pa. Com. Pl. June 19, 1957) ("While we do not feel it necessary to place a label upon the property right which the court is protecting, if we must do so, we feel that 'right of publicity' is as apt a label as any other that might be suggested This . . . is not a separate cause of action, but rather is unfair competition under another label.").

⁵³ Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960). But see Bloustein, *Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U. L. REV. 962, 971 (1964) (arguing that the right of privacy protects "the individual's independence, dignity

invoking the right of publicity under the label “appropriation privacy,”⁵⁴ which he recognized as a “proprietary” right “in the exclusive use of the plaintiff’s name and likeness as an aspect of his identity.”⁵⁵ In light of Prosser’s article and the inconsistent development in the case law recognizing the right of publicity,⁵⁶ states begun codifying the right of publicity, starting with California in 1972.⁵⁷ Presently, more than half of the states in the United States have recognized the right of publicity by either statute or at common law.⁵⁸

Accordingly, the evolution and development of the right of publicity can no longer be ignored. Instead, the right of publicity is now widely recognized as a commercial tort that prevents the unauthorized commercial exploitation of people’s name, likeness, voice, and biographical data without their consent or due compensation.⁵⁹ This property right, however, may conflict with people’s right to freely express themselves under the First Amendment. When this scenario arises, courts must balance the competing interests and determine whether the right of publicity outweighs the First Amendment interest.⁶⁰ This Comment next considers the nature of the competing interests underlying the right of publicity and the First Amendment.

and integrity; it defines man’s essence as a unique and self-determining being.” In other words, “privacy” should not be viewed as “four torts,” but as a unified concept protecting a fundamental aspect of human rights: human dignity).

⁵⁴ Prosser, *supra* note 53, at 406.

⁵⁵ *Id.*; see also RESTATEMENT (SECOND) OF TORTS § 652C (1977) (adopting Prosser’s four-part division of privacy rights: “One who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of privacy”); RESTATEMENT (THIRD) OF THE LAW OF UNFAIR COMPETITION § 46, cmt b (1995) [hereinafter Restatement Unfair Competition] (discussing the privacy-based appropriation tort as encompassing “both personal and commercial interests caused by an unauthorized exploitation of the plaintiff’s identity.”).

⁵⁶ See *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1353 n.6 (D.N.J. 1981) (citations omitted) (“The right of a person, whether or not termed ‘right of publicity,’ to control the commercial value and exploitation of his or her name and likeness has received wide recognition by the courts.”).

⁵⁷ McCarthy, *supra* note 38, § 6.8; see also Restatement of Unfair Competition, § 46 (listing California, Florida, Kentucky, Massachusetts, Nebraska, Nevada, New York, Oklahoma, Rhode Island, Tennessee, Texas, Virginia, and Wisconsin as those states recognizing a statutory right of publicity).

⁵⁸ McCarthy, *supra* note 38, § 6.8.

⁵⁹ McCarthy, *supra* note, § 1.38.

⁶⁰ See *Zacchini*, 433 U.S. at 574–79.

B. The Supreme Court Recognizes the Competing Interests Underlying the Right of Publicity and the First Amendment

Before engaging with the different balancing tests addressing the conflict between the right of publicity and the First Amendment, it is paramount to understand the relevant interests at stake. On the one hand, the right of publicity is not a right of censorship, but rather a right to prevent others from misappropriating the economic value generated by an individual's fame through merchandising his or her name, image, or likeness.⁶¹ Justifications for the protecting the right of publicity fall into two categories; (1) economic and (2) non-economic.⁶²

The primary economic justification in protecting the right of publicity is that it presents a monetary incentive for creativity and achievement.⁶³ In effect, the economic goals are thought to "stimulate[]athletic and artistic achievement, promoting the efficient allocation of resources, and protecting consumers."⁶⁴ Failing to protect the economic value developed in a person's identity against commercial exploitation is contrary to the fundamental purpose of intellectual property laws, which seek to incentivize people to expend the time, effort, and resources necessary to develop talents that will ultimately benefit society due to its potential literary, artistic, political, scientific, or entertainment value.⁶⁵ Because the right of publicity is closely analogous to other

⁶¹ See *Comedy III*, 25 Cal. 4th at 408 ("[W]hen an artist's skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist's right of free expression is outweighed by the right of publicity."); *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 773 (D.N.J. 2011) (internal quotation marks omitted) ("Underlying this right is the theory that a celebrity has the right to capitalize on his persona, and the unauthorized use of that persona for commercial gain violates fundamental notions of fairness and deprives the celebrity of some economic value in his persona. Because celebrity status often translates to economic wealth, the unauthorized use of one's persona harms the person both by diluting the value of the name and depriving that individual of compensation."), *rev'd on other grounds*, 717 F.3d 141 (3d Cir. 2013).

⁶² *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 973 (10th Cir. 1996); see also *McCarthy*, *supra* note 38, § 2.1–2.7.

⁶³ *Cardtoons*, 95 F.3d at 973.

⁶⁴ *Id.*

⁶⁵ See *Zacchini*, 33 U.S. at 576 (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)) ("The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.' Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered."); *White v. Samsung Elec. Am., Inc.*, 989 F.2d 1512, 1513 (9th Cir. 1993) (denial of rehearing en banc) (Kozinski, J., dissenting) ("Intellectual property . . . provides an incentive for investment and innovation; it

intellectual property rights, including copyright and trademark law, society has an interest in affording the right of publicity similar protection.⁶⁶ In addition, when a defendant misappropriates the likeness of an individual, such conduct dilutes that individual's marketable identity, which has gained public recognition.⁶⁷ Thus, courts protecting one's right of publicity will prevent the devaluation of the commercial value in that person's identity by preventing inefficient exploitation of a scarce resource recognized by the economic value in one's likeness.⁶⁸

Furthermore, the right of publicity serves to protect various non-economic rights, including "safeguarding natural rights, securing the fruits of celebrity labors, preventing unjust enrichment, and averting emotional harm."⁶⁹ Protecting the right of publicity affords people the opportunity to protect their name, image, or likeness from misappropriation to the extent the individual expended "considerable money, time and energy" to develop his reputation in a particular field.⁷⁰ Because the skills, reputation, and virtues developed by these people often take years of labor

stimulates the flourishing of our culture; it protects the moral entitlements of people to the fruits of their labors.").

⁶⁶ See *Comedy III*, 25 Cal. 4th at 401 (citations omitted) (internal quotation marks omitted) (quoting *Zacchini*, 33 U.S. at 577) ("[Copyright and patent] laws perhaps regard the reward to the owner [as] a secondary consideration, . . . , but they were intended definitely to grant valuable, enforceable rights in order to afford greater encouragement to the production of works of benefit to the public.").

⁶⁷ See, e.g., *Matthews v. Wozencraft*, 15 F.3d 432, 437–38 (5th Cir. 1994) ("Without the artificial scarcity created by the protection of one's likeness, that likeness would be exploited commercially until the marginal value of its use is zero."); see also Richard A. Posner, *ECONOMIC ANALYSIS OF THE LAW*, § 3.3, at 57 (8th ed. 2011) ("It might seem that creating a property right in such uses would not lead to any socially worthwhile investment but would simply enrich already wealthy celebrities. However, whatever information value a celebrity's endorsement has to consumers will be lost if every advertiser can use the celebrity's name and picture The value of associating the celebrity's name with a particular product will be diminished if others are permitted to use the name in association with their products."); Restatement Unfair Competition, *supra* note 55, § 46 cmt. c ("The right to prohibit unauthorized commercial exploitation of one's identity allows a person to prevent harmful or excessive commercial use that may dilute the value of the identity.").

⁶⁸ Richard A. Posner, *The Right of Privacy*, 12 GA. L. REV. 393, 411 (1978).

⁶⁹ *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 973 (10th Cir. 1996).

⁷⁰ See *Comedy III*, 25 Cal. 4th at 399 (quoting *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 834–35 (1979)) (Bird, C. J., concurring) (citations omitted) (internal quotation marks omitted) ("The right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility. Often considerable money, time, and energy are needed to develop one's prominence in a particular field. Years of labor may be required before one's skill, reputation, notoriety, or virtues are sufficiently developed to permit an economic return through some medium of commercial promotion. For some, the investment may eventually create considerable commercial value in one's identity.").

to adequately develop and fine-tune,⁷¹ the right of publicity allows them to control and enjoy the use of their identities for commercial gain.⁷² Thus, the right of publicity prevents unjust enrichment when a defendant's primary purpose of using another's identity is to appropriate the commercial value of that person's identity.⁷³

On the other hand, when authors or creators use another individual's identity in a work, this use implicates that author's or creator's First Amendment rights. There are several theories and policies supporting First Amendment protections, which include fostering a marketplace of ideas, encouraging human dignity and self-fulfillment, and promoting democratic self-governance.⁷⁴ Specifically, protecting free speech under the First Amendment preserves an uninhibited marketplace of ideas that advances knowledge and the search for the truth. Such advanced knowledge is necessary to foster a democratic society.⁷⁵ First Amendment protection also encourages the fundamental respect for individual development and self-realization.⁷⁶ Because an individual's right to self-

⁷¹ *Id.*

⁷² *Id.*

⁷³ See *Zacchini*, 433 U.S. 562, 576 (“The rationale for [protecting the right of publicity] is the straight-forward one of preventing unjust enrichment by the theft of good will.”); see also Restatement Unfair Competition, *supra* note 55, § 46 cmt. c (“With its emphasis on commercial interests, the right of publicity [] secures for plaintiffs the commercial value of their fame and prevents the unjust enrichment of others seeking to appropriate that value for themselves.”). But see *Cardtoons*, 95 F.3d at 973–74 (criticizing the incentive justification “because most celebrities with valuable commercial identities are already handsomely compensated[,]” and thus, “the commercial value of their identities is merely a by-product of their performance values.”); *C.B.C. Distrib. & Mktg. v. Major League Baseball Advanced, L.P.*, 505 F.3d 818, 824 (8th Cir. 2007) (downplaying the unjust enrichment argument because “major league baseball players are rewarded, and handsomely, too, for their participation in games and can earn additional large sums from endorsements and sponsorship arrangements.”); Madow, *supra* note 45, at 209 (criticizing the attempt to analogize the right of publicity's incentive justification with other intellectual property protections because “abolition of the right of publicity would leave entirely unimpaired a celebrity's ability to earn a living from the activities that have generated his commercially marketable fame.”).

⁷⁴ See Rodney A. Smolla, 3 *SMOLLA & NIMMER ON FREEDOM OF SPEECH*, § 2:3 (2011); see also *McCarthy*, *supra* note 38, §§ 7:3, 8:16, 8:18.

⁷⁵ See *Red Lion Broad. Co. v. FCC*, 395 U.S. 367, 390 (1969) (“It is the purpose of the First Amendment to preserve an uninhibited marketplace of ideas in which truth will ultimately prevail, rather than to countenance monopolization of that market, whether it be by the Government itself or a private licensee.”).

⁷⁶ *Whitney v. California*, 274 U.S. 357, 376 (1927) (Brandeis, J., concurring); see also *Procunier v. Martinez* 416 U.S. 396, 427 (1974), *overruled on other grounds by Thornburgh v. Abbott*, 490 U.S. 401 (1989) (finding that the protection of free speech advances the needs “of the human spirit – a spirit that demands self-expression,” adding that “[s]uch expression is an integral part of the development of ideas and a sense of identity.”).

expression respects the individual dignity that is inherent in a democratic society, each speaker must be free of governmental restraint to express oneself.⁷⁷ While there are instances where competing interests may challenge the fundamental protections underlying the First Amendment,⁷⁸ safeguarding the integrity of the First Amendment weighs heavily in any balancing inquiry.⁷⁹ Because celebrities thrust themselves into the public domain and invite public scrutiny, “the appropriation of [a celebrity’s likeness] may have important uses in uninhibited debate on public issues,”⁸⁰ and “the creative appropriation of celebrity images can be an important avenue of individual expression.”⁸¹ Thus, the right of publicity has the potential for impairing one’s First Amendment right to freely express oneself.⁸²

The Supreme Court recognized these conflicting interests in *Zacchini v. Scripps-Howard Broadcasting Co.*, which is the Court’s only decision addressing the tension between the right of publicity and the First Amendment.⁸³ To resolve the tension between these two competing interests, the Court applied a balancing test to determine whether the interests protected by the right of publicity outweighed the already-

⁷⁷ *Whitney*, 274 U.S. at 376 (Brandeis, J., concurring); see also *Garrison v. Louisiana*, 379 U.S. 64, 74–75 (1964) (“Speech concerning public affairs is more than self-expression; it is the essence of self-government.”).

⁷⁸ See, e.g., *Brown v. Entm’t Merch. Ass’n*, 131 S. Ct. 2729, 2733 (2011) (citations omitted) (internal quotation marks omitted) (“[T]he First Amendment has permitted restrictions upon the content of speech in a few limited areas,” including “obscenity, incitement, and fighting words.”); *Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*, 472 U.S. 749, 757–61 (1985) (determining that a state may allow recovery of damages in certain defamation cases after balancing “the State’s interest in compensating private individuals for injury to their reputation against the First Amendment interest in protecting this type of expression”).

⁷⁹ See *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952) (“That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment.”).

⁸⁰ *Comedy III Prods., Inc. v. Saderup, Inc.*, 25 Cal. 4th 387, 397 (Cal. 2001).

⁸¹ *Id.*

⁸² *Keller v. Elec. Arts, Inc.*, petition for cert. filed, 2013 U.S. S. Ct. Briefs LEXIS 3988, at *11 (U.S. Sept. 23, 2013) (No. 10–15387) (explaining the real-world consequences caused by the uncertainty created by the different balancing tests in resolving the tension between the First Amendment and the right of publicity: “[W]ithout th[e] [Supreme] Court’s guidance, artists, musicians, and other content creators will be unsure what standards apply to their expression and, in particular, whether the realistic depiction of real individuals is tortious. If the realistic portrayal of a person in an expressive work can strip the work of First Amendment protection, then countless creative works are at risk of suit . . . The effect of this uncertainty is to chill protected expression, all in the name of a tort with questionable underlying purposes.”).

⁸³ See *Zacchini*, 433 U.S. at 574–75.

existing First Amendment protections.⁸⁴ In *Zacchini*, an Ohio television news program recorded and subsequently broadcast Zacchini's entire "human cannonball" act from a local fair without his consent, which Zacchini claimed violated his right of publicity as recognized by Ohio law.⁸⁵ Justice White, writing for the majority, held that the First Amendment did not protect the television station against Zacchini's state-law right of publicity claim.⁸⁶ After balancing the right of publicity against the First Amendment, the Court determined that Zacchini's economic interest in his performance clearly outweighed the television's First Amendment defense because the television station misappropriated Zacchini's entire act.⁸⁷ In support of its conclusion, the Court emphasized that the purpose of protecting the right of publicity is to prevent unjust enrichment by others who exploit the resulting goodwill at the public's expense.⁸⁸

Thus, *Zacchini* stands for two key principles: (1) the right of publicity is a state-law created intellectual property right that protects the fruits of one's labor⁸⁹ – that is, the ability for one to commercially exploit his or her identity, name, or likeness – and (2) the state's interest in protecting the unauthorized use of this intellectual property right is not *per se* outweighed by the interests underlying the First Amendment.⁹⁰ Nonetheless, scholars have criticized *Zacchini* as not being an "ordinary" right of publicity case because it involved the wholesale reproduction of a live "entire act," which is easily distinguishable from the unauthorized use of a person's identity.⁹¹ This is especially true when the unauthorized use is in the form of an artistic depiction of an individual.⁹²

⁸⁴ *Id.*

⁸⁵ *Id.* at 563–64.

⁸⁶ *Id.* at 578–79.

⁸⁷ *Id.* at 574–75.

⁸⁸ *See id.* at 576 ("[T]he rationale for protecting the right of publicity is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.").

⁸⁹ *Id.*

⁹⁰ *See Zacchini*, 433 U.S. at 574–75 ("Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, [the Court] [is] quite sure that the First . . . Amendment[] do[es] not immunize the media when they broadcast a performer's entire act without his consent.").

⁹¹ McCarthy, *supra* note 38, § 8:27 (recognizing that "while the *Zacchini* majority and dissenting opinions have been picked apart word by word by the commentators, no clear message emerges and no general rule is discernible by which to predict the result of conflicts between the right of publicity and the First Amendment.").

⁹² Keller v. Elec. Arts, Inc., *petition for cert. filed*, 2013 U.S. S. Ct. Briefs LEXIS 3988, at *11 (U.S. Sept. 23, 2013) (No. 10–15387) ("Zacchini offers little or no guidance in cases

Because *Zacchini* did not articulate a uniform balancing test for weighing the competing interests underlying the right of publicity against the interests underlying the First Amendment, the federal circuits were left to develop several balancing formulations to resolve this conflict.⁹³ Early cases used an ad-hoc perspective, which balanced the relevant interests based on the facts and surrounding circumstances on a case-by-case basis.

C. Post-Zacchini; Ad-Hoc Balancing Tests

Following *Zacchini*, but before courts began developing more systematized legal balancing tests, a few federal circuits applied an ad-hoc balancing approach to resolve cases where the right of publicity collided with the First Amendment.⁹⁴ Unlike trademark and copyright law, the right of publicity does not have a federal statutory rule to accommodate parody uses of a celebrity's identity.⁹⁵ Parody uses in the right of publicity context, therefore, must find their safe harbor in the free speech principles under the First Amendment.⁹⁶

In *White v. Elec. Am., Inc.*, the Ninth Circuit balanced Samsung Electronics's parodic use of Vanna White's likeness in the commercial speech context.⁹⁷ In that case, Vanna White, the letter-turner on the television game show "Wheel of Fortune," sued Samsung for violating her right of publicity because Samsung published an advertisement featuring a costumed robot that parodied White's persona.⁹⁸ Judge Goodwin, writing for the majority, reversed the grant of summary judgment for Samsung, holding that White had produced sufficient evidence that Samsung's advertisement appropriated her identity in violation of her right of publicity.⁹⁹ Judge Kozinski, writing the dissenting opinion after a

involving mere depictions of individuals, as opposed to appropriation of their actual performances in full.").

⁹³ See Marshall Leaffer, *The Right of Publicity: A Comparative Perspective*, 70 ALBANY L. REV. 1357, 1363 (2007) ("Most would acknowledge that the right of publicity needs to be reigned in when it burdens free expression, but no one convenient legal format has been found to set those limits.").

⁹⁴ See, e.g., *White v. Samsung Elec. America, Inc.*, 971 F.2d 1395 (9th Cir. 1992), *cert. denied*, 508 U.S. 951 (1993); *Cardtoons*, 95 F.3d at 959; *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007).

⁹⁵ See 15 U.S.C. § 1115 (2013) (describing the "fair use" doctrine under the Lanham Act); 17 U.S.C. § 107 (2013) (describing the "fair use" doctrine under the Copyright Act). For a discussion explaining the First Amendment value of parodies even though they may conflict with intellectual property rights, see *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 579–81 (1994).

⁹⁶ McCarthy, *supra* note 38, § 8.94.

⁹⁷ *White*, 971 F.2d at 1401.

⁹⁸ *Id.* at 1396.

⁹⁹ *Id.* at 1398–99.

suggestion for rehearing en banc failed,¹⁰⁰ strongly argued that the majority's decision set forth a dangerous precedent by overprotecting the right of publicity when balanced against the First Amendment.¹⁰¹

Contrary to *White*, the Tenth Circuit found the parodic use of another's identity or likeness was not commercial speech, but expressive speech entitled to full First Amendment protection.¹⁰² In *Cardtoons, L.C. v. Major League Baseball Players Assoc.*, the Tenth Circuit weighed the First Amendment rights of a company that produced trading cards caricaturing and parodying well-known major league baseball players against a claim brought under the Oklahoma right of publicity statute.¹⁰³ Specifically, the plaintiff contracted with a political cartoonist, a sports artist, and a sports author and journalist to design a set of trading cards that featured readily identifiable caricatures of major league baseball players with a humorous commentary about their careers on the back.¹⁰⁴ Finding the First Amendment outweighed the players' right of publicity claims, the Tenth Circuit reasoned that sports and entertainment celebrities, through their pervasive presence in the media, symbolized certain ideas and values in our society, which encompassed a valuable means of expression in our culture.¹⁰⁵ Under these circumstances, the *Cardtoons* court found that the card company's parodic use of the players' identities would not substantially affect their economic interests.¹⁰⁶ As a result, the court concluded that the cards parodying and caricaturing celebrities were protected under the First Amendment.¹⁰⁷

¹⁰⁰ *White v. Samsung Elec. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993) (denial of rehearing en banc) (Kozinski, J., dissenting).

¹⁰¹ *See id.* at 1513, 1516 (arguing that the majority erred because "[o]verprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain . . . Intellectual property rights aren't free: They're imposed at the expense of future creators and of the public at large . . . This is why intellectual property law is full of careful balances between what's set aside for the owner and what's left in the public domain for the rest of us[.]").

¹⁰² *Cardtoons, L.C. v. Major League Baseball Players Assoc.*, 95 F.3d 959, 970 (10th Cir. 1996) (distinguishing *White* because "the speech involved is not commercial, but rather speech subject to full First Amendment protection."). For a discussion examining the scope of commercial speech, *see* *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1017 (3d Cir. 2008) (citations omitted) ("[T]hree factors to consider in deciding whether speech is commercial: (1) is the speech an advertisement; (2) does the speech refer to a specific product or service; and (3) does the speaker have an economic motivation for the speech.").

¹⁰³ *Cardtoons*, 95 F.3d at 970–76.

¹⁰⁴ *Id.* at 962.

¹⁰⁵ *Id.* at 972.

¹⁰⁶ *See id.* at 973–74 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590–91 (1994)) ("Parody . . . rarely acts as a market substitute for the original").

¹⁰⁷ *Id.* at 973–76.

Furthermore, courts have found that interests underlying the First Amendment may outweigh interests underlying the right of publicity when the disputed expression is a matter of “public interest.”¹⁰⁸ In the fantasy sports context, the Eighth Circuit balanced the right of publicity of major league baseball players against the First Amendment rights to use the players’ identities in a pay-to-play Internet fantasy baseball game.¹⁰⁹ The plaintiff, a provider of fantasy baseball games, sought a declaratory judgment to establish its right to use, without a license, the baseball players’ names and statistics in connection with its fantasy baseball products.¹¹⁰ The issue before the court in *C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advance Media, L.P.*, was whether the owner of a fantasy baseball product had the right to use publicly available information without a license from the players.¹¹¹ In holding that the plaintiff’s First Amendment right trumped the players’ right of publicity, Judge Arnold, writing for the majority, reasoned that the “recitation and discussion of factual data concerning the athletic performance of [players on Major League Baseball’s website] command[ed] a substantial public interest.”¹¹² The Eighth Circuit also

¹⁰⁸ See, e.g., *C.B.C. Distrib. & Mktg.*, 505 F.3d 818 (8th Cir. 2007), (holding First Amendment outweighed the right of publicity, the Eighth Circuit reasoned that “the information used in CBC’s fantasy baseball games is all readily available in the public domain, and it would be strange law that a person would not have a first amendment right to use information that is available to everyone.”); *Matthews v. Wozencraft*, 15 F.3d 432, 440–41 (5th Cir. 1994) (finding that because “[the plaintiff] became a public figure through his activities[.]” and because “[t]he subject matter of his statements – narcotics officers using drugs, perjuring themselves, and making fraudulent charges – was a matter of public interest[.]” the defendant could use these activities); *Dora v. Frontline Video, Inc.*, 15 Cal. App. 4th 536, 543 (Cal. Ct. App. 1993) (holding that the surfing documentary was afforded protection under the First Amendment); *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790 (Cal. Ct. App. 1995) (finding that “[p]osters portraying the 49’ers’ victories are . . . a form of public interest presentation to which protection must be extended.”); *Gionfriddo v. Major League Baseball*, 94 Cal. App. 4th 400, 411 (Cal. Ct. App. 2001) (finding “[t]he recitation and discussion of factual data concerning the athletic performance of these plaintiffs command a substantial public interest, and, therefore, is a form of expression due substantial constitutional protection.”). But see *Keller v. Elec. Arts Inc.* (In re NCAA Student-Athlete Name & Likeness Licensing Litig.), 724 F.3d 1268, 1283 n.12 (9th Cir. 2013) (distinguishing *C.B.C.* because EA Sports not only uses publicly available information, but it also “uses virtual likenesses of actual college football players.”); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 165 n.37 (3d Cir. 2013) (finding “[t]he presence of a digital avatar that recreates [the celebrity] in a digital medium differentiates this matter from *C.B.C.*”).

¹⁰⁹ *C.B.C. Distrib. & Mktg.*, 505 F.3d at 820.

¹¹⁰ *Id.* at 820–21.

¹¹¹ *Id.* at 823.

¹¹² *Id.* at 823–24 (quoting *Gionfriddo v. Major League Baseball*, 94 Cal. App. 4th 400, 411 (Cal. Ct. App. 2001)).

noted that the major league baseball players' economic interests were not implicated because "players are rewarded, and handsomely, too, for their participation in games and can earn additional large sums from endorsements and sponsorship arrangements."¹¹³ Thus, the *C.B.C.* majority found the plaintiff enjoyed a First Amendment right to use the players' names and playing records.¹¹⁴

While these cases approached the tension between the right of publicity and the First Amendment based on the surrounding facts and circumstances of each case, other courts have attacked this issue through more methodological frameworks. Part III examines these more standardized balancing tests and seeks to determine whether any of them provide a more compelling legal framework in weighing the competing interests in the context of video games.

III. THE MODERN BALANCING TESTS; FEDERAL CIRCUIT COURT OF APPEALS APPLYING SYSTEMATIC ANALYTICAL FRAMEWORKS FOR RESOLVING CONFLICTS BETWEEN THE RIGHT OF PUBLICITY AND THE FIRST AMENDMENT

Zacchini set the stage for the development of more systematic balancing tests when determining whether the interest in safeguarding the right of publicity outweighs the interest in safeguarding the right to free expression.¹¹⁵ Specifically, there are three balancing tests that courts have applied in weighing the tension between the right of publicity and the First Amendment: (1) the Predominant Use Test; (2) the *Rogers* Test; and (3) the Transformative Use Test. Although most courts have declined to adopt the Predominant Use Test, commentators have weighed in on the test's usefulness and its appropriate application.¹¹⁶ Rather, most courts have

¹¹³ *Id.* at 824. *But see* *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 153 n.14 (3d Cir. 2013) ("We reject as inapplicable in this case the suggestion that those who play organized sports are not significantly damaged by appropriation of their likeness because 'players are rewarded, and handsomely, too, for their participation in games and can earn additional large sums from endorsement and sponsorship arrangements . . . ' If anything, the policy considerations in this case weigh in *favor* of [the college football players]. As we have already noted, intercollegiate athletes are forbidden from capitalizing on their fame while in school. Moreover, the NCAA most recently estimated that '[l]ess than one in 100, or 1.6 percent, of NCAA senior football players will get drafted by a National Football League (NFL) team.'") (citations omitted).

¹¹⁴ *Id.* at 824.

¹¹⁵ *See Hart*, 717 F.3d at 152–53 ("In the wake of *Zacchini*, courts began applying a balancing inquiry to resolve cases where a right of publicity claim collided with First Amendment protections.").

¹¹⁶ *See, e.g.,* William Liebler, *Games Are Not Coffee Mugs: Games and the Right of Publicity*, 29 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1 (2012); Andrew Beckerman-Rodau, *Toward a Limited Right of Publicity: An Argument for the Convergence of the Right*

adopted either the trademark-based *Rogers* Test or the copyright-based Transformative Use Test in resolving the conflict between the competing interests. While Part III A examines the application of the Predominant Use Test, Part III B analyzes the development and application of the *Rogers* Test. Part III C and C (i) discusses the Transformative Use Test and its application in the video game context. Finally, Part III C (ii) analyzes the Transformative Use Test's most recent application in suits brought by former college football players against EA Sports's *NCAA Football* video game series. After analyzing the different methodologies in balancing the right of publicity and the First Amendment, this Comment contends that the Transformative Use Test is the proper balancing framework that should be applied in the context of video games.

A. Predominant Use Test

The application of the Predominant Use Test has appeared only in *Doe v. TCI Cablevision*,¹¹⁷ where the Missouri Supreme Court considered a former professional hockey player's right of publicity claim against a comic book publishing company. Specifically, Anthony "Tony" Twist sued a number of individuals and entities involved in producing and publishing the *Spawn* comic book series after the introduction of a villainous character named Anthony "Tony Twist" Twistelli.¹¹⁸ The comic book creators asserted a First Amendment defense, arguing that the use of Twist's identity in their comic books constituted expressive speech protected under the First Amendment.¹¹⁹ In balancing Twist's property interests in his own name and identity against the First Amendment interests of the comic book creators, the *TCI* court rejected both the Transformative Use and *Rogers* tests, finding that the tests gave "too little consideration to the fact that many uses of a person's name and identity have both expressive and commercial components."¹²⁰ Furthermore, Judge Linbaugh, writing for a unanimous court, found that both tests were too rigid, emphasizing that they operated "to preclude a cause of action whenever the use of the name and identity is in any way expressive,

of Publicity, *Unfair Competition and Trademark Law*, 23 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 132 (2012); Joseph Gutmann, Note, *It's In the Game: Redefining the Transformative Use Test for the Video Game Arena*, 31 CARDOZO ARTS & ENT. L.J. 215 (2012).

¹¹⁷ *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003) (en banc).

¹¹⁸ *Id.* at 365.

¹¹⁹ *Id.* at 367.

¹²⁰ *Id.* at 374.

regardless of its commercial exploitation.”¹²¹ Instead, the *TCI* court applied a two-prong test, which it called “a sort of predominant use test”:

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.¹²²

After applying the Predominant Use Test, the court ruled for Twist, holding that the commercial value of using Twist’s identity trumped the literary value expressed in the comic book.¹²³ The Missouri Supreme Court found that the comic book creators used Twist’s name and identity “to attract attention to their product,” thus, attempting to obtain a commercial advantage for their comic book and related merchandise among hockey fans.¹²⁴

Because applying the Predominant Use Test in balancing the relevant interests underlying the right of publicity and the First Amendment may chill expressive speech,¹²⁵ the Missouri Supreme Court is the only court to adopt this balancing test.¹²⁶

B. *The Rogers Test*

Various courts and commentators have contended that claims asserting the right of publicity are akin to trademark claims under the Lanham Act because both claims require courts to balance the interest in protecting the relevant intellectual property rights against the interest in

¹²¹ *Id.*

¹²² *Id.* (quoting Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 500 (2003)).

¹²³ *Doe*, 110 S.W.3d at 374.

¹²⁴ *Id.* at 372; *see id.* at 374 (concluding “the use and identity of Twist’s name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity.”).

¹²⁵ *See, e.g., Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 154 (3d Cir. 2013) (“[A]s a necessary (and insidious) consequence, [Hart’s] approach would suppose that there exists a broad range of seemingly expressive speech that has no First Amendment value.”).

¹²⁶ *See* Jordan M. Blanke, *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*, 19 B.U. J. SCI. & TECH. L. 26, 63 (2013) (“[S]ome courts have tried the transformative test, some the *Rogers* test, and one the ‘predominant use’ test.”).

free expression.¹²⁷ Courts have determined that the application of the *Rogers* Test makes sense “in the context of commercial speech when the appropriation of a celebrity’s likeness creates a false and misleading impression that the celebrity is endorsing a product.”¹²⁸ The test arose in the Second Circuit decision in *Rogers v. Grimaldi*,¹²⁹ where Ginger Rogers sued the producers and distributors of the film entitled, “Ginger and Fred,” alleging that the title infringed Rogers’s right of publicity and confused consumers in violation of the Lanham Act.¹³⁰ In analyzing the right of publicity claim under Oregon law,¹³¹ the Second Circuit articulated the *Rogers* Test by holding that a celebrity’s name may be used in a movie title unless the title was (1) “wholly unrelated” to the movie or (2) the title was “simply a disguised commercial advertisement for sale of goods or services.”¹³² After applying the *Rogers* two-prong test, the Second Circuit denied Rogers’s right of publicity claim because the title was related to the content of the movie and was not a disguised advertisement for a commercial product.¹³³

Other federal circuits have expanded the application of the *Rogers* Test in the context of other expressive works under the Restatement (Third) of Unfair Competition.¹³⁴ Under the Restatement approach, the

¹²⁷ See, e.g., *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003) (citing Bruce P. Keller, *The Right of Publicity: Past, Present, and Future*, 1207 PLI Corp. Law & Prac. Handbook 159, 170 (2000)) (noting that “a Lanham Act false endorsement claim is the federal equivalent of the right of publicity”).

¹²⁸ *ETW*, 332 F.3d at 956 (Clay, J., dissenting) (quoting *Comedy III Prods., Inc. v. Saderup, Inc.*, 25 Cal. 4th 387, 396 (Cal. 2001)).

¹²⁹ *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

¹³⁰ *Id.* at 997.

¹³¹ See *id.* at 1002 (noting that because “right of publicity claims are governed by the substantive law of the plaintiff’s domicile[.]” and because “Rogers is an Oregon domiciliary,” the Second Circuit found “Oregon law governs [her] [right of publicity] claim.”).

¹³² *Id.* at 1004 (internal quotation marks omitted); see *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 790 (D.N.J. 2011) (citing *Parks v. LaFace Records*, 329 F.3d 437, 460 (6th Cir. 2003), *rev’d on other grounds*, 717 F.3d 141 (3d Cir. 2013) (“This ‘wholly unrelated’ and ‘disguised commercial advertisement’ language is strikingly similar to the Lanham Act relatedness test, but comes from a distinct body of law. Ultimately, it is not clear from [the Court’s] reading of [the] *Rogers*’ language whether it disposed of the right of publicity claim on state law, as opposed to federal constitutional grounds, but other courts have read *Rogers* as resting on federal constitutional grounds.”).

¹³³ *Id.* at 1004–05. But see *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008) (Ambro, J.) (discussing the scope of the *Rogers* Test, the Third Circuit, in dicta, expressed doubt over whether the *Rogers* Test could apply beyond the title of a work by emphasizing that only a few other courts had done so).

¹³⁴ See, e.g., *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003); *Matthews v. Wozencraft*, 15 F.3d 432 (5th Cir. 1994); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group*, 886 F.2d 490, 495 (2d Cir. 1989) (holding that the *Rogers* Test is not

use of a person's identity does not violate their right of publicity when the purpose of such use involves communicating information or expressing ideas, such as in news, entertainment, or creative works.¹³⁵ By contrast, the Restatement notes that the right of publicity trumps a First Amendment defense if the unauthorized use of the person's identity was "solely to attract attention to a work that is not related to the identified [person]."¹³⁶

The Fifth Circuit applied this broader application of the *Rogers* Test in *Matthews v. Wozencraft*,¹³⁷ which considered whether a fictional novel incorporating events from the life of an undercover narcotics officer violated the officer's right of publicity.¹³⁸ In articulating the legal standard for the right of publicity claim, the Fifth Circuit noted that it was irrelevant "whether [the book] [was] viewed as a[] historical or [] fictional work, so long as it [was] not simply a disguised commercial advertisement for the sale of goods or services."¹³⁹ Because the court found that the book was not a commercial advertisement, the Fifth Circuit held that the plaintiff had to show that the defendant acted with actual malice, which encompassed a "reckless disregard for the truth" to establish his right of publicity claim.¹⁴⁰ When applying this actual malice standard, the *Matthews* court ruled for the defendant because the plaintiff voluntarily interviewed with the media and the subject matter of his statements were a matter of public interest.¹⁴¹

The Sixth Circuit also applied the Restatement's extension of the *Rogers* Test in *Parks v. LaFace Records*,¹⁴² where it considered whether a rap song entitled "Rosa Parks" infringed the famous Civil Rights icon's

limited to literary titles but is generally applicable to Lanham Act claims against works of artistic expression."); accord *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 928 n.11 (6th Cir. 2003) (The *Rogers* Test is "generally applicable to all cases involving literary or artistic works where the defendant has articulated a colorable claim that the use of a celebrity's identity is protected by the First Amendment.").

¹³⁵ Restatement Unfair Competition, *supra* note 55, § 47; *see id.* § 47 cmt. c ("Use of another's identity in a novel, play, or motion picture is . . . not ordinarily an infringement [of the right of publicity] . . .").

¹³⁶ *Id.* § 47 cmt. c.

¹³⁷ 15 F.3d 432 (5th Cir. 1994).

¹³⁸ *Matthews*, 15 F.3d at 439–40.

¹³⁹ *Id.* at 440 (citations omitted) (internal quotation marks omitted).

¹⁴⁰ *Id.* *Contra* *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 156 & 156 n.20 (3d Cir. 2013) (citations omitted) (internal quotation marks omitted) (criticizing the Fifth Circuit's analysis in applying the actual malice standard because "[i]n *Hustler Magazine, Inc. v. Falwell*, the Supreme Court clarified its holding in *Zacchini v. Scripps-Howard Broadcasting Co.* . . . , as standing for the proposition that the actual malice standard does not apply to the tort of appropriation of a right of publicity.").

¹⁴¹ *Matthews*, 15 F.3d at 440–41.

¹⁴² *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003).

right of publicity.¹⁴³ Applying the expanded *Rogers* test, Judge Holschuh, writing for a unanimous court, concluded that there was an issue of material fact as to whether the title of the song was “wholly unrelated” to the lyrics because a reasonable finder of fact “could find the title to be a disguised commercial advertisement or adopted solely to attract attention to the work.”¹⁴⁴

Although some federal circuits have applied the *Rogers* Test in balancing the tension between the right of publicity and the First Amendment,¹⁴⁵ most federal circuits have relied on the Transformative Use Test.

C. The Transformative Use Test

The California Supreme Court constructed the Transformative Use Test after finding that elements of the copyright “fair use” doctrine most appropriately balanced the competing interests underlying the right of publicity and the First Amendment.¹⁴⁶ Generally, works containing “significant transformative elements” are less likely to interfere with the

¹⁴³ *Id.* at 441–42.

¹⁴⁴ *Id.* (internal quotation marks omitted). *But see*, *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 157 (3d Cir. 2013) (finding “*Parks* to be less than persuasive given that just over a month later another panel of the Sixth Circuit decided *ETW Corp. v. Jireh Publishing, Inc.*, a right of publicity case where the [Sixth] Circuit applied the Transformative Use Test.”) (citation omitted); *Keller v. Elec. Arts Inc.* (In re NCAA Student-Athlete Name & Likeness Licensing Litig.), 724 F.3d 1268, 1281 (9th Cir. 2013) (noting the Sixth Circuit in *Parks* is “only circuit court to import the *Rogers* test into the publicity arena, . . . [and] has done so inconsistently.”).

¹⁴⁵ *See* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002) (applying the *Rogers* Test, the Ninth Circuit concluded that the First Amendment outweighed any risk of confusion between Mattel and the song title); *Cliffs Notes, Inc. v. Bantam Doubleday Publ’g Group, Inc.*, 886 F.2d 490 (2d Cir. 1989).

¹⁴⁶ *See* *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 404–05 (Cal. 2001); *see also* *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (citing Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990)) (citation omitted) (internal quotation marks omitted) (“[W]hether the new work merely supersede[s] the objects’ of the original creation, [], or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is transformative.”). While the California Supreme Court rejected wholesale importation of the entire Copyright “fair use” defense, it did make key use of the transformative part of the fair use analysis, *see* *Hofheinz v. Discovery Commc’ns, Inc.*, No. 00-3802, 2001 WL 1111970, at *4 (S.D.N.Y. 2001) (“Although post-*Campbell*, courts have been neither consistent nor expositive in the interpretation and application of ‘transformative,’ it is now established that uses which merely copy, repackage, republish, substitute for, encapsulate or appropriate the essence of the copyrighted material are not transformative; whereas uses which ‘employ the quoted matter in a different manner or for a different purpose from the original’ are transformative.”).

economic interests implicated by the right of publicity.¹⁴⁷ The Ninth Circuit has noted that two California Supreme Court decisions “bookend the spectrum” of the Transformative Use Test.¹⁴⁸

At one end of the spectrum, the California Supreme Court discussed a clear example of a non-transformative use in *Comedy III Prods., Inc. v. Gary Saderup, Inc.*¹⁴⁹ *Comedy III* addressed whether the First Amendment protected an artist’s production and sale of t-shirts and prints bearing a charcoal drawing of the Three Stooges.¹⁵⁰ Judge Mosk, writing for a unanimous court, found that the first “fair use” factor from copyright law, “the purpose and character of the use,” properly balanced the competing interests between the right of publicity and the First Amendment.¹⁵¹

While articulating the Transformative Use Test, Judge Mosk held that the balance between the right of publicity and First Amendment interests turns on the following five factors, which includes whether:

(1) the celebrity likeness is one of the raw materials from which an original work is synthesized or the depiction or imitation of the celebrity is the very sum and substance of the work in question; (2) the work is primarily the defendant’s own expression, if the expression is something other than the likeness of the celebrity; (3) the literal and imitative or creative elements predominate in the work; (4) the marketability and economic value of the challenged work derives primarily from the fame of the celebrity depicted; and (5) an artist’s skill and talent has been manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit the celebrity’s fame.¹⁵²

The California Supreme Court carefully noted, however, that transformative or creative elements were not confined to parodic uses,¹⁵³ but may also include factual reporting and fictionalized portrayal, all ranging from heavy-handed lampooning to subtle social

¹⁴⁷ *Comedy III*, 25 Cal. 4th at 405 (citing *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 974 (10th Cir. 1996)) (explaining “works of parody or other distortions of the celebrity figure are not, from the celebrity fan’s viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect.”).

¹⁴⁸ See *Hilton v. Hallmark Cards*, 580 F.3d 874, 890 (9th Cir. 2009).

¹⁴⁹ See *Comedy III*, 25 Cal. 4th at 393.

¹⁵⁰ *Id.* at 393.

¹⁵¹ *Id.* at 404–05.

¹⁵² See *id.* at 406–08; see also McCarthy, *supra* note 38, § 8:72 (discussing the five-factor Transformative Use Test).

¹⁵³ *Comedy III*, 25 Cal. 4th at 406.

criticism.¹⁵⁴ Thus, a defendant may assert a First Amendment affirmative defense under the Transformative Use Test so long as the artistic visual depiction of the celebrity contains “significant transformative elements” or the economic value of the challenged work does not primarily derive from the fame of the celebrity depicted.¹⁵⁵ Applying the Transformative Use Test, Judge Mosk ruled that the artist’s charcoal portraits violated the Three Stooges’s right of publicity.¹⁵⁶ The Court found that the defendant’s creative contribution was subordinated to the overall goal of creating a literal image of the Three Stooges to commercially exploit their fame.¹⁵⁷

A few years later, the California Supreme Court revisited the Transformative Use Test in *Winter v. DC Comics*,¹⁵⁸ which illustrated a use that was highly transformative. Two musicians, Johnny and Edgar Winter, who both possessed long white hair and albino features, brought suit against DC Comics over images of two villainous half-man, half-worm creatures, both with long white hair and albino features, named Johnny and Edgar Autumn.¹⁵⁹ Applying the Transformative Use Test, Judge Chin, writing for a unanimous court, held that the Winter brothers’ claim were barred by the First Amendment as a matter of law.¹⁶⁰ In finding that the comic depictions at issue “depict[ed] fanciful, creative characters,”¹⁶¹ the California Supreme Court reasoned that the First Amendment protected these depictions because the characters were “distorted for purposes of lampoon, parody, or caricature.”¹⁶² Thus, the *Winter* court found that DC Comics’ work would not greatly threaten the commercial value of the Winter brothers’ likenesses because their fans “would find the drawings of the Autumn brothers [in the accused’s comic book] unsatisfactory as a substitute for conventional depictions.”¹⁶³

¹⁵⁴ See *id.* at 407 (citations omitted) (“The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.”).

¹⁵⁵ *Id.*

¹⁵⁶ *Id.* at 408–09.

¹⁵⁷ *Id.* at 409.

¹⁵⁸ 30 Cal. 4th 881 (Cal. 2003).

¹⁵⁹ *Id.* at 886.

¹⁶⁰ *Id.* at 890–92.

¹⁶¹ *Id.* at 892.

¹⁶² *Id.* at 891; see also *Ross v. Roberts*, 282 Cal. App. 4th 677, 687–88 (Cal. Ct. App. 2013) (holding that while “[the defendant] made music out of fictional tales of dealing drugs and other exploits – some of which related to [the] plaintiff[,] . . . [the defendant] created original artistic works” protected under the First Amendment).

¹⁶³ *Winter*, 30 Cal. 4th at 890–91; see *id.* at 891 (citations omitted) (internal citation omitted) (“The question is whether the work is transformative, not how it is marketed. If the work is sufficiently transformative to receive legal protection, it is of no moment that the advertisements may have increased the profitability of the [work]. If the challenged

Although *Comedy III* and *Winter* bookend the spectrum of cases applying the Transformative Use Test, most cases fall somewhere in the middle of the Transformative Use Test jurisprudence because they not only focus on the use of peoples' identities, but also add a transformative element to the work.¹⁶⁴ For instance, in *Hilton v. Hallmark Cards*,¹⁶⁵ the Ninth Circuit applied the Transformative Use Test to a Hallmark greeting card that depicted Paris Hilton in a manner reminiscent of an episode of Hilton's reality show, *The Simple Life*, and quoted her famous statement, "that's hot."¹⁶⁶ While comparing Hallmark's card to the video game in *Kirby v. Sega America, Inc.*,¹⁶⁷ the Ninth Circuit found the greeting card did not contain the degree of "significant transformative elements" added to the video game because the game transported a 1990s singer into the 25th century and transformed her into an entirely new character as space-age news reporter.¹⁶⁸ Accordingly, the *Hilton* court ruled that Hallmark's greeting card depicting Paris Hilton's head on a cartoon waitress accompanied by the line "that's hot" was not transformative and thus, infringed Hilton's right of publicity.¹⁶⁹

One month after the *Parks* decision,¹⁷⁰ the Sixth Circuit revisited the tension between the right of publicity and the right to free speech in *ETW Corp. v. Jireh Pub., Inc.*,¹⁷¹ which focused on a photograph of Tiger Woods set among a collage of other, golf-related photographs.¹⁷² Although *ETW* mentioned both *Parks* and its application of the *Rogers* Test under the Restatement (Third) of Unfair Competition,¹⁷³ the Sixth Circuit did not apply the *Rogers* Test to the Ohio right of publicity claim at issue. Instead, the balancing test the Sixth Circuit ultimately applied was a combination of an ad-hoc approach and the Transformative Use

work is transformative, the way it is advertised cannot somehow make it non-transformative.") (citations omitted)).

¹⁶⁴ See, e.g., *Hilton v. Hallmark Cards*, 599 F.3d 894 (9th Cir. 2009); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003).

¹⁶⁵ 599 F.3d 894 (9th Cir. 2009).

¹⁶⁶ *Id.* at 899.

¹⁶⁷ See *Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47 (Cal. Ct. App. 2006); see also *infra* notes 197–202.

¹⁶⁸ *Hilton*, 599 F.3d at 899.

¹⁶⁹ See *id.* at 911 ("While a work need not be phantasmagoric as in *Winter* or fanciful as in *Kirby* in order to be transformative, 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 . . .").

¹⁷⁰ See *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003).

¹⁷¹ 332 F.3d 915 (6th Cir. 2003).

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

¹⁷³ *Id.* at 936 n.17.

Test.¹⁷⁴ In analogizing the collage of Tiger Woods prints with the Three Stooges portraits from *Comedy III*, Judge Graham, writing for the majority, held that the collage was sufficiently transformative because it “d[id] not capitalize solely on a literal depiction of Woods.”¹⁷⁵ The majority afforded First Amendment protection based on the creative elements found in the “panorama” of Woods’s historic 1997 victory at the world-famous Masters Tournament.¹⁷⁶ The “panorama” conveyed a message about the significance of Woods’s achievement through images suggesting that Woods would eventually join the ranks of the world’s best golfers.¹⁷⁷ Thus, the defendant transformed Woods’s identity by adding significant creative elements that made it “less likely to interfere with the economic interest protected by [his] right of publicity.”¹⁷⁸

Judge Clay, in a dissenting opinion, criticized the *ETW* majority for its disjointed analysis in balancing Woods’s economic interest in his identity against the defendant’s First Amendment interest in the painting.¹⁷⁹ Although Judge Clay agreed that the Transformative Use Test was appropriate in this case, he disagreed with the majority’s application.¹⁸⁰ Applying the Transformative Use Test, the dissent found the defendant’s work did not contain significant transformative elements.¹⁸¹ Favoring Tiger Woods, Judge Clay found that the disputed images “gain[ed] their commercial value by exploiting the fame and celebrity status that Woods ha[d] worked to achieve.”¹⁸²

In sum, the Transformative Use Test jurisprudence includes a spectrum of works that transform the subject work at issue – turning on whether and how the celebrity’s identity is transformed.¹⁸³ At one end of the spectrum, the California Supreme Court found in *Comedy III* that the drawings of the Three Stooges were mere literal depictions of celebrities recreated in a different medium of expression.¹⁸⁴ At the other end of the

¹⁷⁴ See *id.* at 937–38 (illustrating the *ETW* majority’s two part analysis applying a balancing test from comment d in the Restatement analyzing “the substantiality and market effect of the use of the celebrity’s image . . . in light of the informational and creative content[.]” as well as the Transformative Use Test).

¹⁷⁵ *Id.* at 938.

¹⁷⁶ *Id.* at 936.

¹⁷⁷ *ETW*, 332 F.3d at 938.

¹⁷⁸ *Id.*; see also *Moore v. Weinstein Co., LLC*, 545 Fed. App’x. 405, 409 (6th Cir. 2013) (analogizing *ETW*, the Sixth Circuit held “the [m]ovie added significant expressive elements to any purported use of [the Plaintiff’s] identity.”).

¹⁷⁹ *ETW*, 332 F.3d at 951 (Clay, J., dissenting).

¹⁸⁰ *Id.* at 951–52.

¹⁸¹ *Id.* at 959–60.

¹⁸² *Id.* at 960.

¹⁸³ *McCarthy*, *supra* note 38, § 8:72.

¹⁸⁴ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 409 (Cal. 2001).

spectrum, the *Winter* court found significant creative elements when the publisher created fanciful characters in a fanciful setting in his comic book that drew inspiration from celebrities.¹⁸⁵ Most cases, however, fall somewhere in between the two California Supreme Court decisions, such as *Hilton* and *ETW*. Part III C (i) examines some of these other middle-ground cases applying the Transformative Use Test in the context of video games.

i. The Transformative Use Test and Video Games

Video games are expressive works entitled to as much First Amendment protection as the most profound literature and entertainment.¹⁸⁶ The California Court of Appeal decided two cases applying the Transformative Use Test to video games.¹⁸⁷ They are particularly instructive regarding the Third and Ninth Circuit's dispositions in resolving the former college football players' claims against EA Sports' First Amendment defenses. In *Kirby v. Sega of America, Inc.*,¹⁸⁸ the court applied the Transformative Use Test in a case involving the musician, Kierin Kirby, who claimed that Sega of America, Inc.'s ("Sega") video game misappropriated her likeness and signature phrases for purposes of creating the character of Ulala.¹⁸⁹ In applying the Transformative Use Test, the court noted that, on the one hand, not only did Kirby's signature phrases include "ooh la la,"¹⁹⁰ but that both she and Ulala would often use phrases like "groove," "meow," "dee-lish," and "I won't give up."¹⁹¹ On the other hand, the court noted that differences did exist between the two characters, such as Ulala's physique, primary hairstyle, costumes, and dance moves.¹⁹² After comparing and contrasting the two characters, the *Kirby* court ruled in Sega's favor, rejecting Kirby's argument that the differences between her and Ulala added no additional

¹⁸⁵ *Winter v. DC Comics*, 30 Cal. 4th 881, 891 (Cal. 2003).

¹⁸⁶ See *Brown v. Entm't Merch. Ass'n.*, 131 S. Ct. 2729, 2733 (2011) ("Like the protected books, plays, and movies that preceded them, video games communicate ideas – and even social messages – through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player's interaction with the virtual world). That suffices to confer First Amendment protection.").

¹⁸⁷ See e.g., *Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47 (Cal. Ct. App. 2006); *No Doubt v. Activision Publishing, Inc.*, 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011).

¹⁸⁸ 144 Cal. App. 4th 47 (Cal. Ct. App. 2006) (Bolan, J.).

¹⁸⁹ *Kirby*, 144 Cal. App. 4th at 52–53.

¹⁹⁰ *Id.* at 56.

¹⁹¹ *Id.*

¹⁹² *Id.*

meaning or message to the work because it was clear that that Ulala was not a mere digital recreation of Kirby.¹⁹³

Five years later, the California Court of Appeal in *No Doubt v. Activision Publishing, Inc.*, again addressed a right of publicity claim in the context of video games.¹⁹⁴ *No Doubt* revolved around the video game “Band Hero,” which allowed players to simulate performing in a rock band.¹⁹⁵ By choosing from a number of playable characters, known as “avatars,” players could be a guitarist, a singer, or a drummer.¹⁹⁶ Some of the avatars were digital recreations of real-life musicians, including members of the band No Doubt.¹⁹⁷ After a contract dispute broke off relations between the band and the company, No Doubt sued, claiming Activision violated their right of publicity.¹⁹⁸

Applying the Transformative Use Test, the California Court of Appeal held Activision’s use of No Doubt’s likeness was not sufficiently transformative because the avatars were precisely computer-generated reproductions of the band members that did not meld with the other elements of the game to become Activision’s own artistic expression.¹⁹⁹ Distinguishing *Kirby* and *Winter*, Judge Willhite, writing for the majority, noted that unlike the “fanciful creative characters” in the earlier cases, the No Doubt avatars could not be altered by players, and thus, remained “at all times immutable images of the real celebrity musicians.”²⁰⁰ This fact by itself, however, did not end the court’s application of the Transformative Use Test because “even literal reproductions of celebrities can be ‘transformed’ into expressive works based on the context into which the celebrity image is placed.”²⁰¹ While finding no additional transformative elements, the court emphasized that the No Doubt characters were performing the same activity, rock songs, in which the band attained and maintained its fame.²⁰² Even though the surrounding elements in the video game contained creative elements, Judge Willhite found that these creative elements failed to “transform the avatars into

¹⁹³ *Id.* at 59–60.

¹⁹⁴ 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011).

¹⁹⁵ *No Doubt*, 122 Cal. Rptr. 3d at 401.

¹⁹⁶ *Id.*

¹⁹⁷ *Id.* at 402.

¹⁹⁸ *Id.*

¹⁹⁹ *Id.* at 411–12.

²⁰⁰ *No Doubt*, 122 Cal. Rptr. 3d at 410.

²⁰¹ *See id.* (citing *Comedy III*, 25 Cal. 4th at 409) (noting, for example, the Andy Warhol silkscreens featuring celebrity portraits of Marilyn Monroe, Elizabeth Taylor, and Elvis Presley, through “careful manipulation of context,” convey an ironic message about the “dehumanization of celebrity” through reproductions of celebrity images).

²⁰² *Id.* at 410–11.

anything other than exact depictions of No Doubt's members doing exactly what they do as celebrities."²⁰³

In the wake of these two California Court of Appeal decisions, the Third and Ninth Circuit considered essentially two identical video game cases addressing whether the right of publicity of a former college football player outweighed the First Amendment right of a video game developer to use his likeness in its games.²⁰⁴

ii. The Transformative Use Test; EA Sports's *NCAA Football* Video Game Series

Hart v. Elec. Arts, Inc.,²⁰⁵ presented a case of first impression for the Third Circuit. Ryan Hart, a former Rutgers quarterback, filed suit against EA Sports alleging a violation of his right of publicity under the common law of New Jersey.²⁰⁶ Specifically, the crux of Hart's argument was that EA Sports allegedly misappropriated his identity, such as his likeness and biographical information, for commercial use in its *NCAA Football* video game series without his consent.²⁰⁷ After analyzing the Predominant Use Test, the *Rogers* Test, and the Transformative Use Test, the Third Circuit determined that the Transformative Use Test struck the proper balance in reconciling the tension underlying the interests protected by the right of publicity and afforded by the First Amendment in the video game context.²⁰⁸

In formulating the proper application of the Transformative Use Test, Judge Greenaway, writing for the majority, undertook a step-by-step

²⁰³ See *id.* at 411 (citation omitted) (internal quotation marks omitted) (finding "the graphics and other background content of the game are secondary, and the expressive elements of the game remain manifestly subordinated to the overall goal of creating a conventional portrait of [No Doubt] so as to commercially exploit [its] fame."); see also *Hilton v. Hallmark Cards*, 599 F.3d 894, 911 (9th Cir. 2010) (The Ninth Circuit considered a Hallmark card featuring Paris Hilton's head on a cartoon waitress's body was not a "transformative use" because the "basic setting" was the same as an episode of Hilton's television show in which she was depicted as "born to privilege, working as a waitress").

²⁰⁴ See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 149–52 (3d Cir. 2013); *Keller v. Elec. Arts Inc.*, 724 F.3d 1268 (9th Cir. 2013).

²⁰⁵ See *Hart*, 717 F.3d at 151–52 ("Since neither the New Jersey courts nor our own circuit have set out a definitive methodology for balancing the tension between the First Amendment and the right of publicity, we are presented with a case of first impression.").

²⁰⁶ *Id.* at 145.

²⁰⁷ *Id.* at 147 & n.8 ("[Hart] alleges that the physical attributes exhibited by the virtual avatar in *NCAA Football* are his own (i.e., he attended high school in Florida, measures 6'2" tall, weighs 197 pounds, wears number 13, and has the same left wrist band and helmet visor) and that the avatar's speed, agility, and passer rating reflected actual footage of [Hart] during his tenure at Rutgers.").

²⁰⁸ *Id.* at 165.

analysis in determining whether Hart's identity was sufficiently transformed in EA Sports's *NCAA Football* video game series:

(1) Whether [Hart]'s 'identity' [was] sufficiently transformed in *NCAA Football*; (2) how [Hart's] identity [was] incorporated into and transformed by *NCAA Football*; (3) whether the type and extent of interactivity permitted is sufficient to transform [Hart's] likeness into [EA Sports's] own expression.²⁰⁹

Applying this three-step formulation of the Transformative Use Test, the Third Circuit ruled in favor of Hart's right of publicity claim, holding that EA Sports's *NCAA Football* video game series did not sufficiently transform Hart's identity.²¹⁰ To the extent users were able to alter Hart's and other college football players's avatar appearances, Judge Greenaway found that this interactive feature alone could not satisfy the Transformative Use Test.²¹¹ Moreover, the *Hart* majority noted that the other creative elements featured in *NCAA Football*, including the feature that allowed users to alter the avatar's appearance, were deemed "wholly unrelated elements" under the Transformative Use Test because they did not affect how Hart's identity was used or altered when playing the game.²¹² Judge Greenaway reasoned that because the players' unaltered likenesses were an essential element to the user's game experience, the Third Circuit was disinclined to credit such a game feature as a transformative use.

Although agreeing with the *Hart* majority that the Transformative Use Test provided the proper balancing test for resolving the conflict between the right of publicity and First Amendment, Judge Ambro, in dissent, disagreed with the majority's formulation and application of the test.²¹³ First, Judge Ambro contended that the majority erroneously formulated the Transformative Use Test because it narrowly focused on

²⁰⁹ *Id.* at 165–67 (noting the term "identity" in the video game context includes the combination of Hart's likeness and biographical information).

²¹⁰ *Id.* at 169.

²¹¹ *See Hart*, 717 F.3d at 167 ("If the mere presence of the feature were enough, video game companies could commit the most blatant acts of misappropriation only to absolve themselves by including a feature that allows users to modify the digital likenesses."); *see also id.* at 168–69 (finding "[i]n the first instance, the relationship between these assets and the digital avatar is predicated on the users' desire to alter the avatar's appearance, which . . . is insufficient to satisfy the Test.").

²¹² *Id.* at 169 ("Decisions applying the Transformative Use Test invariably look to how the *celebrity's identity* is used in or is altered by other aspects of a work [T]his inquiry was aimed at determining whether this context acted upon the celebrity identity in a way that transformed it or imbued it with some added creativity beyond providing a 'merely trivial variation.'").

²¹³ *Id.* at 170–71 (Ambro, J., dissenting).

“Hart’s identity alone, disregarding other features of the work.”²¹⁴ Rather, Judge Ambro argued that the proper focus of the test examines “the context of the work in its entirety, rather than focusing only on the individual’s likeness.”²¹⁵ Second, the dissent argued that the majority misapplied the Transformative Use Test, finding EA Sports’s First Amendment right outweighed Hart’s right of publicity claim.²¹⁶ Specifically, Judge Ambro found that *NCAA Football*, in its totality, contained significant creative elements based on its “original graphics, videos, sound effects, and game scenarios[,]” which allowed users to direct how they want to play the game.²¹⁷ Furthermore, Judge Ambro emphasized that even if users select not to alter the characteristics of the players’ avatars, the combination of the other creative elements are still sufficiently transformative.²¹⁸ Accordingly, the dissent found that the video game contained “significant transformative elements” as a whole, thereby concluding that EA Sports’s First Amendment defense trumped Hart’s right of publicity claim.²¹⁹

Similarly, in *Keller v. Elec. Arts Inc.*, the issue before the Ninth Circuit was whether, for purposes of an anti-SLAPP motion under Cal. Code Civ. Proc. § 425.16(b)(1), EA Sports’s First Amendment defense outweighed Samuel Keller’s right of publicity claim.²²⁰ Keller, as part of a putative class-action complaint filed in the Northern District of California, asserted that EA Sports violated his right of publicity under California Civil Code § 3344 and California common law by using his likeness in its *NCAA Football* video game series.²²¹ Applying the

²¹⁴ *Id.* at 171–73 (explaining “a narrow focus on an individual’s likeness, rather than how that likeness is incorporated into and transformed by the work as a whole, is a flawed formulation of the transformative inquiry. The whole . . . is the better baseline for that inquiry.”).

²¹⁵ *Id.* at 171–72 (finding that the proper formulation of the Transformative Use Test “examine[s] the creative work in the aggregate to determine whether it satisfies the Transformative Use Test and merits First Amendment protection.”).

²¹⁶ *Id.* at 175

²¹⁷ *Hart*, 717 F.3d at 175 (Ambro, J., dissenting).

²¹⁸ *Id.*

²¹⁹ *Id.* (“Any attempt to separate these elements from the use of Hart’s likeness disregards *NCAA Football*’s many expressive features beyond an avatar having characteristics similar to Hart. His likeness is transformed by the artistry necessary to create a digitally rendered avatar within the imaginative and interactive world EA has placed that avatar.”).

²²⁰ 724 F.3d 1268, 1272–73 (9th Cir. 2013) (“California’s anti-strategic lawsuit against public participation (SLAPP) statute is designed to discourage suits that masquerade as ordinary lawsuits but are brought to deter common citizens from exercising their political or legal rights or to punish them for doing so.”).

²²¹ *Id.*

Transformative Use Test, the Ninth Circuit held that EA Sports's use of Keller's likeness in its video game did not sufficiently transform Keller's identity because "it literally recreate[d] Keller in the very setting in which he has achieved renown."²²² In reaching this conclusion, Judge Bybee, on behalf of the majority, agreed with Judge Greenaway's analysis in *Hart*,²²³ discounting the user's ability to alter the avatar's appearance.²²⁴

Judge Thomas, who agreed with Judge Ambro's dissenting opinion in *Hart*,²²⁵ also disagreed with the majority's formulation and application of the Transformative Use Test.²²⁶ According to Judge Thomas, the proper formulation examines "whether the transformative and creative elements of a particular work predominate over commercially based literal or imitative depictions."²²⁷ The dissent asserted that such an inquiry involves a two-step process, which first considers the creative work at issue, and then balances these creative elements against the publicity right at stake.²²⁸ In applying this two-step test, Judge Thomas found that the creative elements in EA Sports's video games were sufficiently transformative,²²⁹ "both from a quantitative and qualitative perspective."²³⁰ Thus, the dissent concluded that the First Amendment protected EA Sports's *NCAA Football* video game series.²³¹

²²² *Id.* at 1271; see also *Hilton v. Hallmark Cards*, 599 F.3d 894, 911(9th Cir. 2009) (applying anti-SLAPP statute to the transformative use test the court concluded "that the card falls far short of the level of new expression . . . [,] [in which] there is enough doubt as to whether Hallmark's card is transformative under [Ninth Circuit] case law that [the panel] cannot say Hallmark is entitled to the defense as a matter of law.").

²²³ *Id.* at 1278–79 ("Like the majority in *Hart*, [the Ninth Circuit] rel[ies] substantially on *No Doubt*, and believe[d] [it was] [] correct to do so.").

²²⁴ *Id.*

²²⁵ *Id.* at 724 F.3d 1268, 1285 n.2 (Thomas, J., dissenting).

²²⁶ *Keller*, 724 F.3d at 1285 ("[B]ecause excessive deconstruction of *Comedy III* can lead to misapplication of the test[,] . . . it is at this juncture that I must respectfully part ways with my colleagues in the majority.").

²²⁷ *Id.*

²²⁸ *Id.* at 1285–87.

²²⁹ *Id.* at 1286 ("The athletic likenesses are but one of the raw materials from which the broader game is constructed[;] [t]he work, considered as a whole, is primarily one of EA's own expression[;] [t]he creative and transformative elements predominate over the commercial use of likenesses[;] [t]he marketability and economic value of the game comes from the creative elements within, not from the pure commercial exploitation of a celebrity image[;] [and] [t]he game is not a conventional portrait of a celebrity, but a work consisting of many creative and transformative elements.").

²³⁰ *Id.* at 1287–88 ("As a quantitative matter, *NCAA Football* is different from other right of publicity cases in the sheer number of virtual actors involved" because "*NCAA Football* includes not just Sam Keller, but thousands of virtual actors[;]" and thus, [t]he sheer quantity of the virtual players in the game underscores the inappropriateness of analyzing the right of publicity through the lens of one likeness only."); see also *id.* at 1288 ("As a qualitative matter, the essence of *NCAA Football* is founded on publicly available data, which is not protected by any individual publicity rights.").

²³¹ *Id.* at 1286.

In short, when balancing the interest that the right of publicity protects against those interests that the First Amendment protects, the Third and Ninth Circuits agreed that the methodology set forth by the Transformative Use Test strikes the best balance. Panels within the Third and Ninth Circuit, however, disagreed as to the proper formulation and application of the Transformative Use Test in the video game context. Part IV addresses these two concerns, as well as justifying why the Transformative Use Test provides the best balancing framework when weighing the interests between the right of publicity and First Amendment in the video game context.

IV. ANALYSIS

This Comment contends that in the context of video games the most effective analytical framework among varying mythologies for balancing the right of publicity and the First Amendment is the Transformative Use Test. Part IV A compares and contrasts the three different analytical balancing tests, demonstrating that the Transformative Use Test is the most refined test when applied to video games. Part IV B discusses why the majority opinions' in *Hart* and *Keller* properly applied the Transformative Use Test, whereas adopting the dissenting opinions' analyses would turn the right of publicity on its head. More specifically, while Part IV B (i) examines the proper formulation of the Transformative Use Test in the video game context, Part IV B (ii) analyzes the test's correct application.

A. The Transformative Use Test is the Proper Analytical Framework for Balancing the Tension between the First Amendment and the Right of Publicity

After analyzing the Predominant Use Test, the *Rogers* Test, and the Transformative Use Test, Judge Greenaway correctly determined that the Transformative Use Test is the proper balancing framework for resolving the conflict between the First Amendment and the right of publicity when applied to video games.²³² First, with respect to the Predominant Use Test,

²³² *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 165 (3d Cir. 2013). *But see*, David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment*, 2 HARV. J. SPORTS & ENT. L. 1, 25–26 (2011) (criticizing courts for adopting the Transformative Use Test because it “can encourage judges to be art critics or base decisions on external factors like the fame of the artist In addition, the cryptic judicial comments that literal depictions like Andy Warhol’s silkscreens of celebrities may also be transformative if they carry a particular social message lend little guidance to how a court may meaningfully determine what constitutes the criteria for transformative use. As shown by recent California decisions, the test is focused on visual transformation which can be

the Third Circuit and commentators correctly noted that the application of the test overprotects the right of publicity.²³³ Initially, the *TCI* court conceded that the Predominant Use Test is particularly for “cases where speech is both *expressive and commercial*.”²³⁴ As such, the Predominant Use Test, rather than focusing on expression, examines the product sold and whether it predominantly exploits the commercial value of the celebrity’s identity.²³⁵

Although a consideration under the Transformative Use Test is whether the “marketability and economic value of the challenged work derive primarily from the fame of the celebrities depicted,”²³⁶ the

overprotective of art and entertainment that contribute little to the discussion of public issues, but underprotective of political speech which may be contextually transformative (because of its recoding) though not visually transformative.”); E. Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903, 916 (2003) (criticizing the Transformative Use Test as uncertain and unpredictable); F.J. Dougherty, *All the World’s Not a Stogie: The ‘Transformativeness’ Test for Analyzing a First Amendment Defense to a Right of Publicity Claim against Distribution of a Work of Art*, 27 COLUM. J. L. & ARTS 1, 73 (2003) (“A better test that would be less vague and would be more effective in protection valuable First Amendment [i]nterests would permit the sale of image copies – that is, any artwork or photograph portraying an individual in the form of prints, posters, lithographs or other mere reproductions – without regard to their artistic quality, while prohibiting sale of unrelated image merchandise, such as T-shirts, buttons or cups, that embody such a work. In other words, it would be better for judges to determine what is unrelated merchandise than to determine whether a given image work is good enough to qualify as speech.”); McCarthy, *supra* note 38, § 8.72 (commenting that the California Supreme Court’s formulation of the Transformative Use Test “will unfortunately prove extremely difficult to predict and apply because it requires a court to make an aesthetic judgment about the challenged artistic use[,]” and thus, “th[e] transformative test is subjective in application, unpredictable in outcome and fraught with ambiguity.”).

²³³ See *Hart*, 717 F.3d at 154; see also Diane Leenheer Zimmerman, *Money as a Thumb on the Constitutional Scale: Weighing Speech Against Publicity Rights*, 50 B.C. L. REV. 1503, 1512 (2009) (discussing the “‘Transformative Use’ approach is certainly more speech-protective than the Supreme Court of Missouri’s ‘predominant use’ test, in part because California does not count a defendant’s intent to gain a marketing advantage from the use against him if he contributes sufficient input of his own.”).

²³⁴ *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (en banc) (emphasis added).

²³⁵ *Id.* at 374.

²³⁶ See *Comedy III*, 25 Cal. 4th at 407; see also *Winter v. DC Comics*, 30 Cal. 4th 881, 889 (Cal. 2003) (citations omitted) (internal quotation marks omitted) (“If it is determined that a work is worthy of First Amendment protection because added creative elements significantly transform the celebrity depiction, then independent inquiry into whether or not that work is cutting into the market for the celebrity’s images . . . appears to be irrelevant [E]ven if the work’s marketability and economic value derive primarily from the fame of the celebrity depicted, the work may still be transformative and entitled to First Amendment protection. However, if the marketability and economic value of the challenged work do not derive primarily from the celebrity’s fame, there would generally be no actionable right of publicity. When the value of the work comes principally from some source other than the fame of the celebrity – from the creativity, skill, and reputation

California Supreme Court importantly emphasized that this is merely a secondary consideration to be analyzed only in close cases.²³⁷ Because it is undisputed that video games constitute *expressive speech*, and *not commercial speech* under the Supreme Court's First Amendment jurisprudence,²³⁸ the only logical conclusion is that the Predominant Use Test is unfit for a balancing test that requires calibrated balancing between two fundamental and competing interests. In addition, the subjective nature of the Predominant Use Test is problematic because it may put courts in a dangerous and unfamiliar position of "call[ing] upon judges to act as both impartial jurists and discerning art critics[.]" two roles that cannot co-exist.²³⁹ Given the limited inquiry of the Predominant Use Test focusing not on the creative elements of an artist's expression, but rather on the expressive value of the celebrity's identity, it is likely that such focus will result in suppressing valuable expressive speech.²⁴⁰ Thus, applying the Predominant Use Test in the video game context does not sufficiently weigh the underlying interests protected by the First Amendment.

Unlike the Predominant Use Test, applying the Transformative Use Test provides a more effective balancing approach because it "requires a more circumscribed inquiry" that will require courts to recognize the fundamental protections afforded to the First Amendment by "focusing on the specific aspects of a work that speak to whether it was merely created

of the artist – it may be presumed that sufficient transformative elements are present to warrant First Amendment protection.”).

²³⁷ *Id.*; see also *Hart*, 717 F.3d at 163 n.29 (“The court in *Comedy III* rightly recognized that the balancing inquiry suggested by the Supreme Court in *Zacchini* cannot start and stop with commercial purpose or value.”).

²³⁸ *Brown v. Entm’t Merch. Ass’n*, 131 S. Ct. 2729, 2733 (2011).

²³⁹ *Hart*, 717 F.3d at 154 (“Adopting [the Predominant Use Test] would be tantamount to admitting that it is proper for courts to analyze select elements of a work to determine how much they contribute to the entire work’s expressiveness.”). But see *Keller v. Elec. Arts, Inc.*, 724 F.3d 1268 (9th Cir. 2013), *petition for cert. filed*, 2013 U.S. S. Ct. Briefs LEXIS 3988, at *13 (U.S. Sept. 23, 2013) (No. 10–15387) (arguing the Third and Ninth Circuit’s holdings that “the depiction of a person’s image or likeness in an expressive work enjoys First Amendment protection against a right-of-publicity claim only if the depiction sufficiently alters or “transforms” the plaintiff’s image or likeness” will result in “chill[ing] expression, both because it is hard to predict what a court will decide is sufficiently ‘transformative,’ and because such an inquiry inevitably requires a court to make a subjective judgment about whether a depiction is “artistic,” thus warranting protection, or ‘literal,’ and thus subject to liability.”); McCarthy, *supra* note 38, § 8.72 (explaining that the “transformative” test is subjective in application, unpredictable in outcome and fraught with ambiguity.”).

²⁴⁰ *Hart*, 717 F.3d at 163; see also *id.* at 154 (positing that a consequence of the Predominant Use Test “would suppose that there exists a broad range of seemingly expressive speech that has no First Amendment value.”).

to exploit a celebrity's likeness."²⁴¹ Furthermore, contrary to the Predominant Use Test, which merely evaluates the expressive "value" of a celebrity's identity,²⁴² *Hart*'s formulation of the Transformative Use Test evaluated not only the expressive "value" of *Hart*'s likeness, but also the use of *Hart*'s identity in the context of EA Sports's *NCAA Football* video game series.²⁴³ Accordingly, the failure of the Predominant Use Test to examine how other creative elements in the work affect the celebrity's identity will likely chill expressive speech that United States Constitution protects.

Second, with respect to the *Rogers* Test, the Third and Ninth Circuits, as well as commentators have properly found the test unfit for carefully calibrated balancing between the First Amendment and the right of publicity because the trademark-based test overprotects the First Amendment.²⁴⁴ As an initial matter, the Third Circuit appropriately agreed with the Second Circuit in *Rogers* that the right of publicity is broader than trademark protection.²⁴⁵ The *Rogers* test was intended to be used in trademark-like right of publicity cases under the Lanham Act,²⁴⁶ but the

²⁴¹ *Id.* at 163

²⁴² *See Doe*, 110 S.W. 3d at 374 (rejecting the Transformative Use Test because it operates "to preclude a cause of action whenever the use of the name and identity is in any way expressive, regardless of its commercial exploitation.").

²⁴³ *Hart*, 717 F.3d at 164 n.30 ("[T]he Predominant Use Test . . . merely looks to the expressive 'value' of a celebrity's identity, not its use, vis-à-vis the challenged work.").

²⁴⁴ *Id.* at 155–57 ("Adopting [the *Rogers* Test] would potentially immunize a broad swath of tortious activity."); *see also* *Keller v. Elec. Arts Inc.*, 724 F.3d 1268, 1280 (9th Cir. 2013) (emphasis added) ("EA argues that we should extend this test, created to evaluate Lanham Act claims, to apply to right-of-publicity claims because it is 'less prone to misinterpretation' and 'more protective of free expression' than the transformative use defense."); Joseph Gutmann, Note, *It's In the Game: Redefining the Transformative Use Test for the Video Game Arena*, 31 CARDOZO ARTS & ENT. L.J. 215, 220 (2012) ("A work can be a complete imitation even if there is no explicit deception present in it. These works, despite having little to no redeeming creative value on their own would still unquestionably pass the *Rogers* Test.").

²⁴⁵ *Hart*, 717 F.3d at 155 n.19 (citations omitted); *see also id.* at 159 ("[W]hile the *Rogers* Test was arguably forged in the crucible of trademark law – and the *Rogers* court appeared to consult trademark principles for inspiration – the court also pointed out that the right of publicity, unlike the Lanham Act, has no likelihood of confusion requirement and is therefore potentially more expansive than the Lanham Act [T]he right of publicity is broader and, by extension, protects a greater swath of property interests."); *see also Keller*, 724 F.3d at 1281 ("Keller's publicity claim is not founded on an allegation that consumers are being illegally misled into believing that he is endorsing EA or its products[,] [but] [i]nstead, Keller's claim is that EA has appropriated, without permission and without providing compensation, his talent and years of hard work on the football field."); *Cardtoons*, 95 F.3d at 967 ("Although publicity rights are related to laws preventing false endorsement, they offer substantially broader protection.").

²⁴⁶ *Hart*, 717 F.3d at 157 ("While the [*Rogers*] Test may have a use in trademark-like right of publicity cases, it is inapposite here."); *see also Keller*, 724 F.3d at 1280

common law right of publicity does not implicate consumer confusion.²⁴⁷ Thus, because the *Rogers* Test focuses on whether an artistic or literary work explicitly misleads consumers,²⁴⁸ and because the right of publicity protects the property and economic interests of the celebrity, not the consumer,²⁴⁹ the *Rogers* Test fails to properly weigh celebrities' commercial rights in their identities.²⁵⁰ Accordingly, Judge Greenaway properly decided not "to adopt a test that hews so closely to traditional trademark principles."²⁵¹

Contrary to the *Rogers* Test, the Transformative Use Test provides a more effective methodology because it "maintains a singular focus on whether the work sufficiently transforms the celebrity's identity or likeness."²⁵² Specifically, the Transformative Use Test's incorporation of copyright's fair use doctrine properly balances the extent of a defendant's use of a celebrity's image against the years of hard work the celebrity expended in developing his or her marketable identity.²⁵³ As a result, this singular focus analysis properly allows courts to consider "the fact that misappropriation can occur in any market segment, including those related to the celebrity" without overreaching by seeking to protect consumers from the risk of consumer deception, which is adequately protected by trademark law.²⁵⁴ Accordingly, the Transformative Use Test captures the

("Although . . . there is some overlap between the transformative use test formulated by the California Supreme Court and the *Rogers* test, [the Ninth Circuit] disagree[s] that the *Rogers* test should be imported wholesale for right-of-publicity claims.").

²⁴⁷ *Hart*, 717 F.3d at 158; *accord Keller*, 724 F.3d at 1280 (citations omitted) (disagreeing "that the *Rogers* Test should be imported wholesale for right-of-publicity claims[.]" which is "consistent with the Third Circuit's rejection of EA's identical argument in *Hart*. As the history and development of the *Rogers* test makes clear, it was designed to protect consumers from the risk of consumer confusion – the hallmark element of a Lanham Act claim[.], [whereas] [t]he right of publicity . . . does not primarily seek to prevent consumer confusion."); *see also Parks v. LaFace Records*, 329 F.3d 437, 460 (6th Cir. 2003) (citing *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989) ("[A] right of publicity claim does differ from a false advertising claim in one crucial respect; a right of publicity claim does not require any evidence that a consumer is likely to be confused.")).

²⁴⁸ *Hart*, 717 F.3d at 158; *Keller*, 724 F.3d at 1280.

²⁴⁹ *Keller*, 724 F.3d at 1281.

²⁵⁰ *See id.* at 1280 (citing *Comedy III*, 25 Cal. 4th at 399) (discussing the purpose behind the legal protection afforded to the right of publicity since it "primarily protects a form of intellectual property [in one's person] that society deems to have some social utility.").

²⁵¹ *Hart*, 717 F.3d at 158.

²⁵² *Id.* at 163.

²⁵³ *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 777 (D.N.J. 2011), *rev'd on other grounds*, 717 F.3d 141 (3d Cir. 2013).

²⁵⁴ *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 163 (3d Cir. 2013); *see also id.* at 157–58 (disagreeing with EA Sport's argument "that [Hart] should be unable to assert a claim for appropriating his likeness as a football player precisely because his likeness was used for a game about football[.]" because . . . "[a]dopting this line of reasoning threatens to turn

intricacies necessary to determine whether a challenged work contains the creative elements entitled to First Amendment protection or merely an attempt to misappropriate the economic value generated by a celebrity's fame without due compensation.

Because the Third and Ninth Circuits correctly found that the Transformative Use Test is the proper balancing framework for resolving the tension underlying the competing interests between the right of publicity and the First Amendment in the context of video games, Part IV B turns to the test's proper formulation and application.

B. Both Majority Opinions in Hart and Keller Properly Formulated and Applied the Transformative Use Test

i. Formulation of the Transformative Use Test

Before analyzing the proper application of the Transformative Use Test, it is first necessary to determine the proper formulation of the test in the video game context. Specifically, the majority and dissenting opinions in *Hart* and *Keller* noted that the threshold issue is whether the Transformative Use Test considers the other creative elements in the video game that do not affect or alter the celebrity's likeness.²⁵⁵ Because the Transformative Use Test does focus on whether an individual's likeness was sufficiently transformed in the creative work as a whole, the primary focus of this inquiry is the magnitude of how the celebrity's identity is transformed in the entire work.²⁵⁶ Thus, the test neither focuses on the

the right of publicity on its head." The Third Circuit additionally noted that "[i]t cannot be that the very activity by which [the celebrity] achieved his renown now prevents him from protecting his hard-won celebrity."); *see also Keller*, 724 F.3d at 1281 ("The right of publicity protects the celebrity, not the consumer.").

²⁵⁵ *Hart*, 717 F.3d at 169 ("Decisions applying the Transformative Use Test invariably look to how the celebrity's identity is used in or is altered by other aspects of a work."); *see also Keller*, 724 F.3d at 1273 (citation omitted) ("The transformative use defense . . . is a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.").

²⁵⁶ *Hart*, 717 F.3d at 169 (emphasis in original) ("Decisions applying the Transformative Use Test invariably look to how the *celebrity's identity* is used in or is altered by other aspects of a work."); *see also Keller*, 724 F.3d at 1279 n.10 (citation omitted) ("[O]ne of the factors identified in *Comedy III* requires an examination of whether a likely purchaser's primary motivation is to buy a reproduction of the celebrity, or to buy the expressive work of that artist."); McCarthy, *supra* note 46, § 8.27 ("When the accused work is a story-telling vehicle, . . . the issue is whether the overall 'personality' of the plaintiff has been transformed as it appears in the accused work. Thus, the accused work must be analyzed as a whole, taking into account not only the visual image, but also the personality of the accused depiction in the context of the accused work as a whole, including the story line.").

“creative work in the aggregate,”²⁵⁷ nor examines whether the creative elements “predominate” the work as a whole,²⁵⁸ if the other creative elements do not affect the context upon which the celebrity’s identity is altered.²⁵⁹

Judge Ambro’s dissent in *Hart* argued that the California Supreme Court’s application of the Transformative Use Test in *Comedy III* and *Winter* showed that the inquiry must focus on how a celebrity’s “likeness is incorporated into and transformed by the work as a whole[.]”²⁶⁰ In this regard, Judge Ambro contends that if the work as a whole contains significant expressive content, then the creative elements taken together will transform the work.²⁶¹ This formulation of the Transformative Use Test, however, is overbroad because such an inquiry considers all the creative elements in the work, even if those added elements do not affect a celebrity’s likeness.²⁶² Consequently, applying this overbroad test would distract courts from the primary focus of the Transformative Test, which requires courts to determine whether the factual setting of the video game acted upon a celebrity’s identity in such a way that it transformed it with some added creativity that is central to a user’s game experience.²⁶³

²⁵⁷ *Hart*, 717 F.3d at 172 (Ambro, J., dissenting) (“The repeated focus on the use of an individual’s likeness in the context of the work as a whole leaves me little doubt that we must examine the creative work in the aggregate to determine whether it satisfies the Transformative Use Test and merits First Amendment protection.”) (emphasis added)).

²⁵⁸ See *Keller*, 724 F.3d at 1285 (Thomas, J., dissenting) (“The salient question is whether the entire work is transformative, and whether the transformative elements predominate, rather than whether an individual persona or image has been altered.”) (emphasis added)).

²⁵⁹ *Hart*, 717 F.3d at 169 (“To the extent that [the *Comedy III*, *Winter*, and *Kirby*] cases considered the broader context of the work (e.g., whether events took place in a ‘fanciful setting’), this inquiry was aimed at determining whether this context acted upon the celebrity identity in a way that transformed it or imbued it with some added creativity beyond providing a ‘merely trivial variation.’”) (emphasis added); see also *Comedy III*, 25 Cal. 4th at 407 (“[A] literal depiction of a celebrity, even if accomplished with great skill, may still be subject to a right of publicity challenge. The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.”) (emphasis added)); *Winter*, 30 Cal. 4th at 888–89 (quoting *Comedy III*, 25 Cal. 4th at 408) (“An artist depicting a celebrity must contribute something more than a merely trivial variation, but must create something recognizably his own, in order to qualify for legal protection.”) (quoting *Comedy III*, 25 Cal. 4th at 408) (emphasis added) (internal quotation marks omitted)).

²⁶⁰ *Hart*, 717 F.3d at 173 (Ambro, J., dissenting).

²⁶¹ *Id.* at 172–73.

²⁶² See *id.* at 169 (Greenaway, J., majority) (“Decisions applying the Transformative Use Test invariably look to how the celebrity’s identity is used in or is altered by other aspects of a work[,] [and thus] [w]holly unrelated elements do not bear on this inquiry.”).

²⁶³ *Id.* at 169 n.46 (finding “the broader context of NCAA Football does not transform [Hart’s] likeness into anything other than a digital representation of [Hart] playing the sport for which he is known, while surrounded by the trappings of real-world competition.”); see

Accordingly, courts that consider “wholly unrelated elements” that do not bear on how the celebrity’s identity is used or altered may effectively eviscerate the legal protection afforded to the right of publicity.²⁶⁴

This is especially problematic when considering the developments in technology that provide video game companies, such as EA Sports, the tools to create realistic and detail-oriented video games at low cost.²⁶⁵

also *Keller*, 724 F.3d at 1276 (concluding Keller’s likeness was not transformed based on the following considerations: (1) “EA is alleged to have replicated Keller’s physical characteristics in *NCAA Football*,” (2) users manipulate the characters in the performance of the same activity for which they are known in real life—playing football in this case,” and (3) [t]he context in which the activity occurs is [] similarly realistic . . . ”realistic depictions of actual football stadiums in *NCAA Football*)).

²⁶⁴ *Hart*, 717 F.3d at 169 (“Acts of blatant misappropriation would count for nothing so long as the larger work, on balance, contained highly creative elements in great abundance.”); see also *Comedy III*, 25 Cal. 4th at 406 (listing potentially “transformative or creative contributions” focused on elements or techniques that affect the celebrity identity, which encompassed factual reporting, fictionalized portrayal, heavy-handed lampooning, and subtle social criticism.); *Winter*, 69 P.3d at 478–79 (noting that “[a]n artist depicting a celebrity must contribute something more than a ‘merely trivial’ variation” before proceeding to discuss how the Winter brothers’ likenesses were altered directly and through context); *No Doubt v. Activision Publishing, Inc.*, 122 Cal. Rptr. 3d 397, 411 (Cal. Ct. App. 2011) (finding [t]hat the avatars can be manipulated to perform at fanciful venues including outer space or to sing songs the real band would object to singing, or that the avatars appear in the context of a videogame that contains many other creative elements [] does not transform the avatars into anything other than exact depictions of No Doubt’s members doing exactly what they do as celebrities.”); *Hilton*, 599 F.3d at 911 (finding that the Hallmark card and the episode of Hilton’s reality show *The Simple Life* contained the same basic setting: “Paris Hilton, born to privilege, working as a waitress.”); *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 960 (6th Cir. 2003) (Clay, J., dissenting) (finding the right of publicity trumped the First Amendment because “it [was] clear that the prints gain their commercial value by exploiting the fame and celebrity status that Woods has worked to achieve.”); *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1360 (D.N.J. 1981) (acknowledging that the show impersonating Elvis Presley had some informational value inasmuch as it preserved a live Elvis Presley act for posterity, “[t]his recognition that defendant’s production has some value does not diminish our conclusion that the primary purpose of defendant’s activity is to appropriate the commercial value of the likeness of Elvis Presley.”).

²⁶⁵ *Hart*, 717 F.3d at 169 (considering the proper protection afforded to the First Amendment in the video game context: “Acts of blatant misappropriation . . . [are] particularly acute in the case of media that lend themselves to easy partition such as video games” because “[i]t cannot be that content creators escape liability for a work that uses a celebrity’s unaltered identity in one section but that contains a wholly fanciful creation in the other, larger section.”); see also Neil G. Hood, Note, *The First Amendment and New Media: Video Games As Protected Speech and the Implications For the Right of Publicity*, 52 B.C. L. REV. 617, 625 (2011) (“As the technology advanced throughout the 1990s to present day, this trend of diversification and increased capabilities dramatically improved.”); Christian Dennie, *Tebow Drops Back to Pass: Videogames Have Crossed the Line, But Does the Right of Publicity Protect a Student–Athlete’s Likeness When Balanced Against the First Amendment?* 62 ARK. L. REV. 645, 646 (2009) (“Videogames depicting currently enrolled student–athletes are a top priority each year for many fans, alumni, and

Thus, under Judge Ambro's Transformative Use Test, although EA Sports purposely uses an indistinguishable copy of the student-athlete's identity performing the same activity for which he is widely recognized, the First Amendment will protect its video games so long as it adds other creative or transformative features to the game as a whole. Such a result would not only incentivize video game developers to appropriate the economic value of a celebrity's identity, but it would also create a First Amendment safe harbor in the context of video games.

Moreover, Judge Thomas's dissent in *Keller* argued that the Transformative Use Test, as set forth in *Comedy III*, intended a more "holistic" examination, considering "whether the transformative and creative elements of a particular work predominate over commercially based literal or imitative depictions."²⁶⁶ Applying this holistic examination analysis, Judge Thomas contended that the Transformative Use Test should turn on a two-step inquiry: (1) whether the work as a whole is transformative, examining whether the creative elements predominate the work at issue, and (2) whether the challenger's publicity rights trump the added creative elements to the contested work at issue.²⁶⁷ This formulation of the Transformative Use Test, however, conflicts with the multiple analytical factors articulated by the California Supreme Court in *Comedy III*.²⁶⁸ The purpose of the Transformative Use Test, as noted by Judge Thomas, is not to deconstruct these five analytical factors in determining whether a celebrity's right of publicity outweighs an artist's right of free expression.²⁶⁹ Instead, the implicit purpose in Judge Mosk's analysis was to provide guidance for courts in balancing the fundamental tension underlying the rights of free expression and publicity by flexibly considering the five factors.²⁷⁰

children and have gained Electronic Arts, Inc. (EA) a stronghold on the market for videogames featuring NCAA student-athletes. These games have evolved substantially over the course of the last decade and now depict student-athletes in great detail. Due to the technological advances of the images and likenesses depicted in these videogames, student-athletes' rights of publicity have been violated because they have not been compensated for the use of their images and likenesses.").

²⁶⁶ *Keller*, 724 F.3d at 1285 (Thomas, J., dissenting).

²⁶⁷ *Id.* at 1285–87.

²⁶⁸ See *Comedy III*, 25 Cal. 4th at 406–08 (noting the five-factors. It is important to note, however, that Judge Mosk never explicitly stated that the Transformative Use Test is limited to these five factors. Instead, these analytical factors provide guidance for courts in weighing the conflicting interests protected by the First Amendment and right of publicity).

²⁶⁹ *Keller*, 724 F.3d at 1285 (Thomas, J., dissenting).

²⁷⁰ *Hart*, 717 F.3d at 163 ("[T]he Transformative Use Test appears to strike the best balance because it provides courts with a flexible – yet uniformly applicable – analytical framework."); see also McCarthy, *supra* note 38, § 8.72 (describing the Transformative

As a result, a proper consideration of the Transformative Use Test examines whether the creative elements predominate the work as a whole,²⁷¹ but this consideration must be analyzed among the other relevant factors to properly balance the competing interests at stake. Accordingly, Judge Thomas's formulation of the Transformative Use Test would result in overprotecting the First Amendment because it fails to adequately consider how the context of a work acts upon, alters or transforms the celebrity's likeness in the context of the disputed work.²⁷²

In contrast, the correct formulation of the Transformative Use Test considers the interplay of the five analytical factors in how the work uses, alters, and/or transforms a celebrity's identity in the context of other aspects of the work.²⁷³ The critical element to the test's proper formulation is that each inquiry must examine how the creative features or elements affect the artistic visual depiction of a celebrity's likeness at issue. Focusing on how the creative elements affect the celebrity's identity ensures that the right of publicity maintains its legal force, as intended by *Zacchini*.²⁷⁴ Otherwise, crediting a defendant's creative contributions that do not affect a celebrity's likeness would interfere with the calibrated balancing that the Transformative Use Test requires.²⁷⁵

Even if the commercial value of an artistic visual depiction of a celebrity's image derives primarily from such identification, this does not end the inquiry.²⁷⁶ Rather, the Transformative Use Test also requires courts to consider the context in which the celebrity's identity is acted

Use Test as "not a 'one test fits all' analysis for any and all possible infringements of the right of publicity.").

²⁷¹ *Keller*, 724 F.3d at 1285 (Thomas, J., dissenting).

²⁷² *Hart*, 717 F.3d at 169.

²⁷³ *Id.*

²⁷⁴ See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578 (1977) ("[I]t is important to note that neither the public nor [the television station] will be deprived of the benefit of [the plaintiff's] performance as long as his commercial stake in his act is appropriately recognized.").

²⁷⁵ See *Comedy III*, 25 Cal. 4th at 391 (emphasis added) ("We formulate instead what is essentially a *balancing test* between the First Amendment and the right of publicity based on whether the work in question adds *significant creative elements* so as to be transformed into something more than a mere celebrity likeness or imitation."); see also *Hart*, 717 F.3d at 169 (emphasis in original) (holding that the wholly unrelated elements – that is, the "other creative elements of *NCAA Football*" – are not credited as creative elements pursuant to finding a transformative use because "[t]o hold otherwise could have deleterious consequences [to the legal protection afforded the right of publicity]" since "[a]cts of blatant misappropriation would count for nothing so long as the larger work, on balance, contained highly creative elements in great abundance.").

²⁷⁶ *No Doubt*, 122 Cal. Rptr. 3d at 410 (citing *Comedy III*, 25 Cal. 4th at 409) ("[E]ven literal reproductions of celebrities can be 'transformed' into expressive works based on the context into which the celebrity image is placed.").

upon in determining the magnitude of the creative elements that affect how the celebrity's identity is used or altered as it is incorporated into the work.²⁷⁷ In this regard, a work that primarily derives its profit from the celebrity's identity may still constitute a transformative use. For instance, parodies typically satisfy the Transformative Use Test as long as the work contains "significant transformative elements" relating to a celebrity's identity.²⁷⁸ As a result, if courts examine the effect of how a defendant uses, alters, and/or transforms a celebrity's identity among the other creative elements in the work, courts will properly weigh the conflicting interests.

In sum, when determining whether a work in question is sufficiently transformative, courts are not required to apply all five of the *Comedy III* analytical factors. Rather, courts should apply those factors necessary to resolve the conflict underlying the right of free speech and the right of publicity based on the sum of the "significant transformative elements" that affect the celebrity's image. The Transformative Use Test therefore provides a flexible approach in determining whether a celebrity's right of publicity outweighs an artist's right of free expression. Given the underlying framework of the Transformative Use Test, Part IV B (ii) discusses the proper application of this balancing test.

ii. Proper Application of the Transformative Use Test

While considering the five analytical factors articulated by the *Comedy III* court in the context of video games, the first step in applying the Transformative Use Test focuses on how the defendant's video game

²⁷⁷ See *Comedy III*, 25 Cal. 4th at 405 ("[W]hen a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity."); see also *Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003) (finding the defendant's use was transformative because it could "readily ascertain that [the portrayals] are not just conventional depictions of plaintiffs but contain significant expressive content other than plaintiffs' mere likenesses."); *No Doubt.*, 122 Cal. Rptr. 3d at 410 (citing *Comedy III*, 25 Cal. 4th at 391) ("[E]ven literal reproductions of celebrities may be 'transformed' into expressive works based on the context into which the celebrity image is placed.").

²⁷⁸ *Comedy III*, 25 Cal. 4th at 405 (citation omitted) (discussing that because "works of parody . . . are not, from the celebrity fan's viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect[,] . . . First Amendment protection of such works outweighs whatever interest the state may have in enforcing the right of publicity.").

uses the celebrity's identity.²⁷⁹ Applying the first analytical factor in the video game context, a celebrity's "identity" encompasses not only his or her likeness, but also any identifying information that would make it appear to an ordinary prudent person that the video game character depicts that celebrity.²⁸⁰ Although courts have held that the First Amendment protects publicly available information about celebrities,²⁸¹ the depiction of a celebrity as a digital avatar in the video game context suggests a different analysis because the game uses virtual likenesses of actual celebrities.²⁸² In other words, the recreation of a celebrity's presence in a video game as a digital avatar containing public information, such as his or her biographical information, may still infringe that celebrity's likeness.²⁸³ Thus, if a video game depicts celebrities as a digital avatar that merely recreates an imitation of their identities in a separate digital medium of expression, the video game does not sufficiently transform those celebrities identities.²⁸⁴ By contrast, if a video game adds

²⁷⁹ See, e.g., *Hart*, 717 F.3d at 164 (quoting *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 581 (1977)) (Powell, J., dissenting) ("[W]hat use did the [defendant] make of the [celebrity identity]?").

²⁸⁰ See *id.* at 165 (defining "the term 'identity' to encompass not only [the celebrity's] likeness, but also his biographical information. It is the combination of these two parts – which, when combined, identify the digital avatar as an in-game recreation of [the celebrity] – that must be sufficiently transformed.").

²⁸¹ See *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 823–24 (8th Cir. 2007) (holding that a fantasy baseball product that uses publicly available information is protected by the First Amendment).

²⁸² *Hart*, 717 F.3d at 165; see also *Keller*, 724 F.3d at 1283 ("It is seemingly true that each likeness is generated largely from publicly available data . . . but finding this fact dispositive would neuter the right of publicity in our digital world. Computer programmers with the appropriate expertise can create a realistic likeness of any celebrity using only publicly available data. If EA creates a virtual likeness of Tom Brady using only publicly available data – public images and videos of Brady – does EA have free reign to use that likeness in commercials without violating Brady's right of publicity? We think not, and thus must reject [the dissent's] point about the public availability of much of the data used given that EA produced and used actual likenesses of the athletes involved.").

²⁸³ See *Keller v. Elec. Arts, Inc.*, No. 09-1967, 2010 U.S. Dist. LEXIS 10719, at *22 (N.D. Cal. Feb. 8, 2010) ("EA's game provides more than just the players' names and statistics; it offers a depiction of the student athletes' physical characteristics and, as noted, enables consumers to control the virtual players on a simulated football field[,] which 'goes far beyond what the court considered in *C.B.C. Distribution*.'"), *aff'd*, 724 F.3d 1268 (9th Cir. 2013).

²⁸⁴ *Id.* at 166 ("[T]he digital avatar does closely resemble [Hart]. Not only does the digital avatar match [Hart] in terms of hair color, hair style and skin tone, but the avatar's accessories mimic those worn by [Hart] during his time as a Rutgers player. The information, as has already been noted, also accurately tracks [Hart's] vital and biographical details."); *Keller*, 724 F.3d at 1276 ("EA is alleged to have replicated Keller's physical characteristics in NCAA Football . . ."); *No Doubt v. Activision Publ'g. Inc.*, 122 Cal. Rptr. 3d 397, 411 (Cal. Ct. App. 2011) (finding "that the avatars appear in the context

“significant transformative elements” to celebrities’ virtual likenesses such that it becomes the developer’s own expression, then those celebrities’ identities are sufficiently transformed.²⁸⁵ An inquiry focusing on how creative elements or features affect the identities of celebrities is consistent with Judge Mosk’s first and second analytical factors because it considers whether the visual artistic image is a literal depiction of a particular celebrity or whether it is primarily the defendant’s own expression.²⁸⁶ Accordingly, the proper first step in applying the Transformative Use Test in the video game context is to ask how the video game creator used or altered the celebrity’s identity, focusing on both the celebrity’s likeness and identifying information.

Under the second step of the Transformative Use Test, even if the video game uses a realistic depiction of the celebrity as a digital avatar that merely recreates the celebrity in a digital medium of expression, courts must next consider how the context of the video game incorporates the celebrity’s identity.²⁸⁷ Given that this step of the Transformative Use Test examines the quantitative nature of the creative elements in determining whether the work is primarily the video game creator’s own expression, or whether the creative elements merely illustrate a literal depiction of the celebrity, such analysis is akin to the third and fourth analytical factors articulated by the *Comedy III* court.²⁸⁸ When applying this step of the Transformative Use Test, on the one hand, if the digital avatar depicts celebrities performing the same activity for which they are known for in real life, the video game probably does not sufficiently transform those celebrities’ likenesses.²⁸⁹ On the other hand, if the video game depicts the

of a video game that contains many other creative elements, does not transform the avatars into anything other than exact depictions of No Doubt’s members doing exactly what they do as celebrities.”).

²⁸⁵ See *Kirby*, Cal. App. 4th at 59 (holding “Ulala is more than a mere likeness or literal depiction of Kirby,” noting Ulala’s “extremely tall, slender computer-generated physique,” her “hairstyle and primary costume,” her dance moves, and her role as “a space-age reporter in the 25th century,” all of which were “unlike any public depiction of Kirby.”).

²⁸⁶ See *Comedy III*, 25 Cal. 4th at 406 (“[W]hether the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized . . . [W]hether 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.”).

²⁸⁷ See *Hart*, 717 F.3d at 166 (“[L]ooking at how [the celebrity’s] identity is ‘incorporated into and transformed by’ [the video game].”).

²⁸⁸ See *Comedy III*, 25 Cal. 4th at 407 (“[W]hether the literal and imitative or the creative elements predominate in the work . . . [D]oes the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted?”).

²⁸⁹ See, e.g., *Hart*, 717 F.3d at 166 (“The digital Ryan Hart does what the actual Ryan Hart did while at Rutgers: he plays college football, in digital recreations of college football stadiums, filled with all the trappings of a college football game. This is not transformative;

celebrity in a setting that is not similar to that in which the celebrity is known, courts will probably find the context acted upon the celebrity in a way that sufficiently transformed the celebrity's identity.²⁹⁰ Thus, the second step of the Transformative Use Test turns on the magnitude of how the celebrity's identity is used or altered as it is incorporated in the video game.

The application of the third and final step depends on whether the user's ability to alter the celebrity's avatar constitutes a transformative use.²⁹¹ In other words, can video game developers satisfy the Transformative Use Test by creating a feature that allows the video game user to alter the celebrity's digital avatar appearance?²⁹² Consistent with the fifth analytical factor of the Transformative Use Test, the focus of this inquiry turns on whether the interactive feature is a mere pretext by video game developers to commercially exploit celebrities' fame or whether the interactive features transform those celebrities' images so it becomes video game developers own creative expression.²⁹³ Video game developers argue that the user's ability to alter the celebrity's avatar constitutes a creative element protected by the First Amendment because this feature acts in conjunction with the other creative features in the game. Thus, the alteration feature constitutes "one of the 'raw materials' from

the various digitized sights and sounds in the video game do not alter or transform the [Hart's] identity in a significant way."); *Keller*, 724 F.3d at 1276 (citation omitted) ("Keller is represented as what he was: the starting quarterback for Arizona State and Nebraska, and the game's setting is identical to where the public found [Keller] during his collegiate career: on the football field."); *No Doubt*, 122 Cal. Rptr. 3d at 410–11 ("[N]o matter what else occurs in the game during the depiction of the No Doubt avatars, the avatars perform rock songs, the same activity by which the band achieved and maintains its fame.").

²⁹⁰ See *Winter v. DC Comics*, 30 Cal. 4th 881, 890, 892 (Cal. 2003) ("To the extent the drawings of the Autumn brothers resemble plaintiffs at all, they are distorted for purposes of lampoon, parody, or caricature[.] and thus, "DC Comics depicting fanciful, creative characters, not pictures of the Winter brothers."); *Kirby*, 144 Cal. App. 4th at 59 ("[T]he setting for the game that features Ulala – as a space-age reporter in the 25th century – is unlike any public depiction of Kirby").

²⁹¹ Compare *Hart*, 717 F.3d at 166 (finding "a third avatar-specific element is also present: the users' ability to alter the avatar's appearance."), with *No Doubt*, 122 Cal. Rptr. 3d at 410 (noting that the digital avatars representing No Doubt were "at all times immutable images of the real celebrity musicians").

²⁹² See *Hart*, 717 F.3d at 167 (determining "to what extent the ability to alter a digital avatar represents a transformative use of [Hart's] identity" constitutes a transformative use").

²⁹³ *Comedy III*, 25 Cal. 4th at 408 ("[W]hen an artist's skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist's right of free expression is outweighed by the right of publicity.").

which an original work is synthesized . . . [rather than] the very sum and substance of the work in question.”²⁹⁴

The proper application of the Transformative Use Test, however, does not hold interactivity as an end unto itself. Rather, the balancing inquiry requires courts to determine whether the interests protected by the right of publicity are sufficient to *overcome* the already-existing First Amendment protections.²⁹⁵ As *Zacchini* illustrated in the context of a newscast broadcasting, the right of publicity can trump another’s First Amendment interest in situations where the dissemination of such expression receives strong First Amendment protection.²⁹⁶ If courts found an interactive feature allowing a user to alter a digital avatar as an end unto itself and thus, satisfying the Transformative Use Test, the result would create a safe harbor that would destroy the legal protection afforded to publicity rights.²⁹⁷ Consequently, video game developers would not bear any legal liability for diluting as much commercial value of celebrities’ likenesses as they desire.²⁹⁸ The Transformative Use Test, therefore, cannot hold that the First Amendment protects a video game by merely including a particular interactive feature, such as the users’ ability to alter the digital avatar’s appearance.²⁹⁹

Instead, in determining whether the degree of interactivity to alter a digital avatar’s appearance sufficiently transforms that celebrity’s

²⁹⁴ *Hart*, 717 F.3d at 166–69; *see also Keller*, 724 F.3d at 1277 (“EA suggests that the fact that NCAA Football users can alter the characteristics of the avatars in the game is significant.”); *Comedy III*, 25 Cal. 4th at 406.

²⁹⁵ *Hart*, 717 F.3d at 167; *see also id.* at 170 n.47 (summarizing the Transformative Use Test’s proper inquiry in balancing the First Amendment and the right of publicity: “[The Third Circuit’s] inquiry looked to whether other interests may surmount the First Amendment protection – as they can surmount protections for other modes of expression. In finding that NCAA Football failed to satisfy the Transformative Use Test, [the Third Circuit] do[es] not hold that the game loses First Amendment protection[,] [but rather,] . . . the interest protected by the right of publicity in this case outweighs the Constitutional shield.”).

²⁹⁶ *Zacchini*, 433 U.S. at 578.

²⁹⁷ *See Hart*, 717 F.3d at 166 n.39 (“It is no answer to say that digitizing [Hart’s] appearance in and of itself works a transformative use. Recreating a celebrity’s likeness or identity in some medium other than photographs or video cannot, without more, satisfy the test; this would turn the inquiry on its head – and would contradict the very basis for the Transformative Use Test.”).

²⁹⁸ *See id.* at 166 (“If the mere presence of the [interactive] feature were enough, video game companies could commit the most blatant acts of misappropriation only to absolve themselves by including a feature that allows users to modify the digital likenesses.”); *see also Keller*, 724 F.3d at 1279 n.10 (citing *McCarthy*, *supra* note 38, § 8:72; *Comedy III*, 25 Cal. 4th at 406) (internal quotation marks omitted) (“[O]ne of the factors identified in *Comedy III* requires an examination of whether a likely purchaser’s primary motivation is to buy a reproduction of the celebrity, or to buy the expressive work of that artist.”).

²⁹⁹ *Hart*, 717 F.3d at 167.

likeness, courts must determine, as a threshold matter in applying the third step, whether the celebrity's unaltered likeness or default position is an essential element to the user's game experience.³⁰⁰ If the celebrity's unaltered likeness is a critical element to the user's game experience, as was the case in *Hart* and *Keller* because the video games replicated both college football players performing the same activity for which they were known in real life,³⁰¹ a court should not credit the user's ability to alter the digital avatar as a "significant transformative element," which would in turn support a finding of a transformative use.³⁰²

Crediting users' ability to alter the appearances of digital avatars as a transformative element would be illogical when the realistic depiction of the "unaltered likeness is central to the core of the game experience" because such users will be discouraged from using this interactive feature.³⁰³ For instance, because the realistic depictions of Hart and Keller's default appearances in *NCAA Football* were critical elements to users' game experience, users would be disinclined to alter their likenesses because such realism "permit[s] users to recreate the setting of a bitter defeat and, in effect, achieve some cathartic readjustment of history."³⁰⁴ Therefore, the expressive value of allowing users to alter the players' digital avatars in games such as *NCAA Football* is minimal, which indicates that such feature fails to add "something new, with a further purpose or different character, altering the first with new expression, meaning, or message."³⁰⁵

In contrast, if the celebrity's unaltered likeness is not an essential element to the users game experience, an interactive feature that allows users to alter the digital avatar's appearance shall be credited as "one of the 'raw materials' from which the broader game is constructed."³⁰⁶ As

³⁰⁰ *Id.* at 168.

³⁰¹ *Id.* at 167; *see also Keller*, 724 F.3d at 1279 ((affirming the district court's ruling that "Keller is represented as what he was: the starting quarterback for Arizona State and Nebraska, and the game's setting is identical to where the public found [Keller] during his collegiate career: on the football field.") (citation omitted) (internal quotation marks omitted)).

³⁰² *Hart*, 717 F.3d at 168.

³⁰³ *Id.*; *see also No Doubt v. Activision Publ'g. Inc.*, 122 Cal. Rptr. 3d 397, 411 (Cal. Ct. App. 2011) ("Activision's use of lifelike depictions of No Doubt performing songs is motivated by the commercial interest in using the band's fame to market Band Hero, because it encourages the band's sizeable fan base to purchase the game so as to perform as, or alongside, the members of No Doubt.").

³⁰⁴ *Hart*, 717 F.3d at 168.

³⁰⁵ *Id.*

³⁰⁶ *See, e.g., Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47, 61 (Cal. Ct. App. 2006) (finding that "Ulala is a 'fanciful, creative character' who exists in the context of a unique and expressive video game."); *Winter* 69 P.3d at 479 (finding that the defendant's

indicated in *Kirby v. Sega of America, Inc.*, for example, if a video game depicts a space-age reporter in the 25th century, which is unlike a public depiction of a popular singer, such alleged use constitutes a significant creative element.³⁰⁷

Thus, in the video game context, a court must make a threshold determination as to whether the celebrity's unaltered or default digital avatar "is central to the core of the game experience" when either crediting or discrediting the user's ability to alter the avatar's appearance as a transformative element.³⁰⁸ In other words, if the enjoyment of the game remains "in the users' ability to play 'as, or alongside' their preferred players or team,"³⁰⁹ any modification to the avatar will not constitute a "significant transformative element" that supports a transformative use defense. However, this determination of whether or not the celebrity's unaltered appearance is an essential element to a user's game experience should not be dispositive. Instead, the ability to alter a digital avatar is merely another factor to consider in resolving the tension between the right of publicity and the First Amendment.³¹⁰

Therefore, this threshold determination should turn on whether users, in fact, desire the ability to alter a celebrity's digital avatar. In making this determination, courts should survey a sufficient sample of users to establish whether the celebrity's unaltered appearance is an essential element to that particular video game. If the quantity of users using the interactive feature to alter a celebrity's avatar is statistically insignificant or insubstantial, courts will find that celebrity's unaltered likeness is an essential element to a user's game experience. In such instances, courts will not credit the interactive feature as a "significant creative element." Statistically, if, however, a substantial quantity of users use the interactive feature, then a court should find that celebrity's unaltered likeness is not an essential element. Under these circumstances, courts will credit such an alteration feature as a "significant creative element," which thereby supports a finding of a transformative use. Accordingly, in applying the final step of the Transformative Use Test, courts should ask whether the

artistic depictions satisfied the Transformative Use Test because the defendant's "depict[ed] fanciful, creative characters, not pictures of the Winter brothers."); *Keller*, 724 F.3d at 1286 (Thomas, J., dissenting).

³⁰⁷ *Kirby*, 144 Cal. App. 4th at 59.

³⁰⁸ *Hart*, 717 F.3d at 168.

³⁰⁹ *Id.* at 169 (quoting *No Doubt*, 122 Cal. Rptr. 3d at 411).

³¹⁰ *Id.* at 168 n.45 ("Admittedly, just as the presence of a photorealistic depiction of a celebrity cannot be the end of the inquiry, the mere fact that [Hart's] likeness is the default appearance of the avatar cannot, without more, end our analysis" because "[i]t is merely another factor to consider in the balancing exercise.").

type and extent of the video game's interactivity sufficiently transforms the celebrity's likeness to the extent the celebrity's appearance is not essential to the core of the users' game experience.³¹¹

To summarize, the proper application of the Transformative Use Test in the video game context requires courts to first consider how the defendant's video game uses the celebrity's identity. After focusing on the use of the celebrity's identity, including his or her appearance and other relevant information associated with the celebrity, courts should then consider how the context of the video game incorporates the celebrity's identity. Finally, if a video game contains an interactive feature, a court must examine whether the type and degree of interactivity that affects the celebrity's likeness is an essential element to users' game experience. Courts must examine all three steps independently, while also ignoring "wholly unrelated elements" that fail to act upon or affect the celebrity's identity.

V. CONCLUSION

As intellectual property rights (including the right of publicity) have expanded, defining the scope of protected speech under the First Amendment has become very complex. Courts have used a variety of balancing tests, including an ad-hoc approach, the Predominant Use Test, the trademark-based *Rogers* Test, and the copyright-based Transformative Use Test, in weighing these competing interests.

Both the Third and Ninth Circuit addressed the conflict between the right of publicity and the First Amendment when two former college football players sought legal relief from EA Sports for misappropriating their likeness without their consent in EA Sports's *NCAA Football* video games series. In determining the proper analytical framework for balancing the former college football players' right of publicity against EA Sports's right to free speech, both circuits properly agreed that the Transformative Use Test provided the best balancing test.

In applying the Transformative Use Test, both circuits noted how technological innovation allowed video game companies to develop realistic games that included depictions that virtually resembled the former student-athletes. Consequently, although video games may contain "significant creative elements" as a whole, these creative features are insufficient by themselves to constitute the kinds of expressive speech that the First Amendment intended to protect. Instead, the Transformative Use Test requires video game developers to transform the identity or likeness of celebrities depicted within the context of the video game. Thus, the

³¹¹ *Hart*, 717 F.3d at 167–68.

focus of applying the Transformative Use Test remains to be on how other aspects of the game use the identity or likeness of the celebrity.

If the application of the Transformative Use Test considers “wholly unrelated elements” that are not essential to users’ game experience, the right of publicity would no longer have any legal effect in the video game context. Since this result would give video game developers a license to misappropriate a valuable property right, it is imperative that future courts applying the Transformative Use Test in the context of video games to disregard creative elements that are not central to the core of the game experience; thus fail to act upon the identity of the celebrity.

The majority decisions in *Hart* and *Keller* came to the correct conclusion in holding that EA Sports’s *NCAA Football* video game series did not sufficiently transform the particular student-athletes’ likenesses because the game depicted these former college football players’ identically performing the same activity for which they were recognized in real life. Because the creative elements depicted in EA Sports’s video games involved elements that failed to transform the identities of the players and were not essential to users’ game experience, the Third and Ninth Circuit’s correctly disregarded such elements. Accordingly, the Third and Ninth Circuit decisions serve as valuable precedent for resolving the conflict between the right of publicity and the First Amendment in the video game context by providing greater clarity in balancing these competing interests that has caused great debate and flux since its inception in *Zacchini*.