

## WHO OWNS THE ATHLETE?: THE APPLICATION OF THE TRANSFORMATIVE USE TEST IN THE RIGHT OF PUBLICITY CONTEXT

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### I. INTRODUCTION

In 2007, college football game attendance reached nearly 49 million people for the year.<sup>1</sup> Seeking to capitalize on the college football frenzy, Electronic Arts, Inc. (“Electronic Arts”) created *NCAA Football 2006*. Already popular for its National Football League (“NFL”) simulation videogames, Electronic Arts would now give the fans the opportunity to control their hometown college or alma mater’s team.<sup>2</sup> *NCAA Football 2006* simulates the college football experience, including stadiums, mascots, and players.<sup>3</sup> The game places the user in control of the team, allowing him or her to dictate the plays, decide the roster, and determine recruitment for his or her fantasy team’s next season.<sup>4</sup>

Dedicated to realism and detail, *NCAA Football 2006* includes “over 100 virtual teams’ . . . populated by digital avatars that resemble their real-life counterparts,” and share their “vital and biographical information.”<sup>5</sup> Among the digital avatars, the Rutgers quarterback, number thirteen, is the digital twin of Ryan Hart.<sup>6</sup> Like Hart, the avatar weighs 197 pounds and stands six feet two inches tall.<sup>7</sup> Certainly such attention to detail fulfills Electronic Arts’ desire to simulate a realistic experience by letting fans control the moves of digital copies of their favorite teams and players. Ryan Hart, however, argued that the videogame company went too far, taking advantage of his persona for commercial gain.<sup>8</sup> The dispute between the company and the player raises

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<sup>2</sup> See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141,146 (3d Cir. 2013).

<sup>3</sup> *Id.*

<sup>4</sup> *Id.*

<sup>5</sup> *Id.*

<sup>6</sup> *Id.*

<sup>7</sup> *Id.*

<sup>8</sup> *Hart*, 717 F.3d at 147.

the question of when the use of a celebrity image becomes a misappropriation of that person's own identity, rather than a unique creation of the writers and developers in the videogame world. Central to the resolution of this dispute, as undertaken by the United States Court of Appeals for the Third Circuit in *Hart v. Electronic Arts, Inc.*, is the reconciliation of the tension between the player's right to his identity and the videogame company's right to its creative work.<sup>9</sup>

In *Hart*, a case of first impression for the Third Circuit, the court sought to balance the interests of the Rutgers University quarterback, Ryan Hart, in his identity, likeness, and celebrity and the interests of Electronic Arts in developing and marketing a realistic college football videogame.<sup>10</sup> More specifically, the court had to balance the right of publicity under intellectual property law that Hart claimed against Electronic Arts' interest in free expression under the First Amendment.<sup>11</sup>

The First Amendment prevents the suppression of speech, while the right of publicity stops speech that takes advantage of another person's interest in his or her own identity.<sup>12</sup> Accordingly, the two interests must be balanced so that valuable speech is not suppressed, and an individual's identity is not exploited, without his or her consent. The Third Circuit's determination in *Hart* of the way in which the interests of the First Amendment and the right of publicity are balanced reflects an application of the transformative use test.<sup>13</sup> The decision, therefore, may have far reaching implications, as this test, and the way in which it is applied, will be the determinative factor in future right of publicity cases. Thus far, a broad range of circumstances has implicated the right of publicity, including: the use of Babe Ruth photographs in a baseball calendar;<sup>14</sup> a play in which performers simulate the style of the Marx Brothers;<sup>15</sup> a videogame character with mannerisms and spoken phrases similar to those of a musician;<sup>16</sup> and the use of baseball players' names and stats in a fantasy league.<sup>17</sup> Few courts, however, have directly

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<sup>9</sup> *Id.*

<sup>10</sup> *Id.* at 148–149.

<sup>11</sup> *Id.* at 148.

<sup>12</sup> See Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 GEO. WASH. L. REV. 1, 3 (2013).

<sup>13</sup> *Hart*, 717 F.3d at 163.

<sup>14</sup> *Pirone v. MacMillan, Inc.*, 894 F.2d 579 (2d Cir. 1990).

<sup>15</sup> *Groucho Marx Prods., Inc. v. Day and Night Co.*, 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982).

<sup>16</sup> *Kirby v. Sega of Am., Inc.*, 144 Cal. App. 4th 47 (Ct. App. 2006).

<sup>17</sup> *C.B.C. Distrib. & Mktg. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007).

addressed the interplay between the right of publicity property interest and free expression.<sup>18</sup> The balancing of the property interest and free expression is the same balancing of interests that copyright and trademark law address.<sup>19</sup> Accordingly, the balancing in the right of publicity context should mirror the balancing of the same interests in copyright and trademark law.

This Comment, using *Hart v. Electronic Arts* as a starting point, argues that the balancing of interests undertaken in the right of publicity context should mirror the balancing undertaken in other areas of intellectual property. Part II discusses the development of the right of publicity and its clash with the First Amendment provision for freedom of speech. Part II also examines the majority and dissenting opinions in *Hart*. Part III provides a brief overview of the operative structures, concerns, and criticisms in copyright and trademark law and their intersection with free speech and the First Amendment. Part IV argues that the transformative use test should be interpreted to account for the common interests underlying the right of publicity, copyright, and trademark, particularly the commercial interests central to the discussion of the right of publicity and explicit in the balancing regimes of copyright and trademark law. Part V concludes.

## II. DEVELOPMENT OF THE RIGHT OF PUBLICITY

The right of publicity protects an individual's right to the exclusive commercial use of his or her name and likeness.<sup>20</sup> Historically based in the somewhat-analogous right to privacy tort, the right of publicity seeks to protect an individual from exploitation of that individual's fame or notoriety without his or her consent.<sup>21</sup> The right originates in the tort of "invasion of privacy by appropriation," which provides that an individual's likeness, image, or identity cannot be used by another without authorization.<sup>22</sup> Put differently, one party cannot capitalize on the fame of another without his or her consent. Essentially, the right of publicity grants an individual a property interest in his or her own identity.<sup>23</sup>

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<sup>18</sup> See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 805 (Cal. 2001)

<sup>19</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

<sup>20</sup> See *Toffoloni v. LFP Publ'g Grp., LLC*, 572 F.3d 1201, 1205 (11th Cir. 2009).

<sup>21</sup> *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 151 (3d Cir. 2013).

<sup>22</sup> *Id.* at 150 (citing J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:23 (2d ed. 2012)).

<sup>23</sup> *Id.* (quoting *Edison v. Edison Polyform Mfg. Co.*, 67 A. 392, 394 (N.J. Ch. 1907)).

The application of the right of publicity is broad.<sup>24</sup> Though traditionally exercised by celebrities, the right is available to all individuals.<sup>25</sup> The use of a celebrity image as a false or misleading endorsement of a product, for example, is a readily apparent application of the right of publicity because the fame and household recognition accompanying celebrity provides a building block upon which the creator of the new work or product can capitalize.<sup>26</sup> When baseball cards carry a cartoon image of a famous baseball player, they are more enticing to fans than a generic player image.<sup>27</sup> By using a celebrity's image or identity, the creator of a new product can capitalize on a celebrity's notoriety by leading the consumer to believe that the celebrity has endorsed the product.<sup>28</sup>

Multiple rationales support the right of publicity's protection of an individual's interest in his or her own identity.<sup>29</sup> These include: (1) a judgment of moral disapproval for the appropriation of another's efforts, (2) an interest in the economic effect, and (3) an interest in protecting consumers from false advertisements of endorsement.<sup>30</sup> The moral rationale centers on societal disapproval for riding on the coattails of a celebrity's "time, effort, skill, and even money."<sup>31</sup> Meanwhile, the economic rationale focuses on incentivizing individuals to "expend the time, effort and resources necessary to develop talents and produce works that ultimately benefit society as a whole."<sup>32</sup> Finally,

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<sup>24</sup> See K.J. Greene, *Intellectual Property Expansion: The Good, the Bad, and the Right of Publicity*, 11 CHAP. L. REV. 521, 536–38 (2008).

<sup>25</sup> *Id.*

<sup>26</sup> See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 805 (Cal. 2001) (noting that "depictions of celebrities amounting to little more than the appropriation of the celebrity's economic value are not protected expression under the First Amendment").

<sup>27</sup> See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996).

<sup>28</sup> See, e.g., *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003). The same set of facts gave rise to both a Lanham Act claim under trademark law that the use of Rose Parks' name created a potential for consumer confusion and a right of publicity claim for capitalizing on Rosa Parks' name. *Id.* at 446, 459–61.

<sup>29</sup> See Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 54 (1994).

<sup>30</sup> *Id.*

<sup>31</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) ("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.").

<sup>32</sup> Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 206 (1993).

the consumer protection rationale is motivated by a desire to protect consumers from advertisers who falsely present their product as being endorsed by a particular celebrity.<sup>33</sup>

*A. Balancing the Right of Publicity with the First Amendment*

Though few courts have addressed the issue, the right of publicity often conflicts with the First Amendment.<sup>34</sup> This conflict has arisen in disputes involving consumer products, such as trading cards,<sup>35</sup> videogames,<sup>36</sup> art work,<sup>37</sup> and comic books.<sup>38</sup> Free speech is raised as an affirmative defense in these right of publicity suits.<sup>39</sup> The First Amendment protects speech from proscription by the government, yet, by granting the protection for the right of publicity, the government allows the suppression of one individual's speech in order to protect the rights of the other.<sup>40</sup> This tension creates conflict between the rights.

There is no question that videogames and similar entertainment constitute "speech" within the meaning of the First Amendment.<sup>41</sup> The United States Supreme Court has determined that the First Amendment protects "entertainment [including, but certainly not limited to,] motion pictures, programs broadcast by radio and television, and live entertainment, such as musical and dramatic works."<sup>42</sup> Specifically, the Supreme Court has concluded that videogames are protected within the bounds of the First Amendment as they "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

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<sup>33</sup> See *id.* at 231–32.

<sup>34</sup> See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 805 (Cal. 2001) ("Although surprisingly few courts have considered in any depth the means of reconciling the right of publicity and the First Amendment, we follow those that have in concluding that depictions of celebrities amounting to little more than the appropriation of the celebrity's economic value are not protected expression under the First Amendment.").

<sup>35</sup> See *Cardtoons, L.C. v. Major League Players Assoc.*, 95 F.3d 959, 968 (10th Cir. 1996).

<sup>36</sup> See *Kirby v. Sega of Am., Inc.*, 144 Cal. App. 4th 47 (Cal. Ct. App. 2006).

<sup>37</sup> See *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 918, 924–25, 937–38 (6th Cir. 2003).

<sup>38</sup> See *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003).

<sup>39</sup> See, e.g., *Comedy III Prods.*, 21 P.3d at 810; *DC Comics*, 69 P.3d at 477–78.

<sup>40</sup> See Jed Rubenfeld, *The Freedom of Imagination: Copyright's Constitutionality*, 112 YALE L.J. 1, 5 (2002).

<sup>41</sup> See *Brown v. Entm't Merchs. Ass'n.*, 131 S. Ct. 2729, 2733 (2011).

<sup>42</sup> *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 149–50 (3d Cir. 2013) (quoting *Tacyne v. City of Phila.*, 687 F.2d 793, 796 (3d Cir. 1982)).

world).<sup>43</sup> Once it is established that a work, words, or conduct is “speech” within the meaning of the First Amendment, the next step is to determine how to balance the protection afforded by that Amendment against competing interests.<sup>44</sup>

In *Zacchini v. Scripps-Howard Broadcasting Co.*, the Supreme Court examined the intersection of the First Amendment and right of publicity in the context of a news broadcast of a performance at a fair.<sup>45</sup> Zacchini, a human cannonball, filed suit against a news network that broadcast the entirety of his performance.<sup>46</sup> The Court determined that the news network’s conduct violated Zacchini’s right of publicity.<sup>47</sup> The Court recognized that the right of publicity was a property right, akin to that in intellectual property, stating that “the State’s interest in permitting a ‘right of publicity’ is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment.”<sup>48</sup> The purpose of protecting the right of publicity, the Court reasoned, was to prevent unjust enrichment.<sup>49</sup> The Court found that the goal of the right of publicity is “analogous to the goals of patent and copyright law” in that they serve to protect an individual’s ability to “reap the reward of his endeavors.”<sup>50</sup> The Court stated that “[t]he economic philosophy behind the clause empowering Congress to grant patents and copyrights” is that providing economic protection for the end-product encourages the effort to develop the talent, skill, or art.<sup>51</sup> In its reasoning, the Court highlighted that the protection provided by the right of publicity—of the performer’s economic interests—provided an economic incentive for the investment in the performance production, and that this was the same consideration of incentive for production underlying copyright law.<sup>52</sup>

In ruling in favor of the human cannonball, the Court held that:  
[w]herever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments *do not immunize the media when they broadcast a performer’s*

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<sup>43</sup> *Brown*, 131 S. Ct. at 2733.

<sup>44</sup> *Hart*, 717 F.3d at 150.

<sup>45</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

<sup>46</sup> *Id.* at 563.

<sup>47</sup> *Id.* at 565–66.

<sup>48</sup> *Id.* at 573.

<sup>49</sup> *Id.* at 576.

<sup>50</sup> *Id.* at 573.

<sup>51</sup> *Zacchini*, 433 U.S. at 576 (quoting *Mazer v. Steins*, 347 U.S. 201, 219 (1954)).

<sup>52</sup> *Zacchini*, 433 U.S. at 576.

*entire act without his consent.* The Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner.<sup>53</sup>

According to the Court, ultimately, the harm done by the news broadcast, and the violation of the right of publicity, were economic disincentives for development of a skill.<sup>54</sup> The human cannonball act “[was] the product of [Zacchini’s] own talents and energy, the end result of much time, effort, and expense.”<sup>55</sup> The Court noted that if the public saw the newscast, allowing them to view the performance for free, then they would not pay to view that same performance.<sup>56</sup> Accordingly, the Court held that the news broadcast deprived Zacchini of the economic value of his performance.<sup>57</sup> Since then, three different tests have been used<sup>58</sup> in attempting to find the appropriate balance between the right of publicity and the First Amendment: the predominant use test, the *Rogers* test, and the transformative use test.

#### 1. The Predominant Use Test

While not widely accepted, the predominant use test, which appeared first in *Doe v. TCI Cablevision*, asks whether the predominant purpose of the work is commercial rather than expressive.<sup>59</sup> If the predominant purpose is commercial, then the work is not protected by the First Amendment.<sup>60</sup> Specifically, the test states that regardless of whether there is some expressive purpose of the work, if the product predominantly “exploits the commercial value of an individual’s identity,” it violates the right of publicity and is not protected by the First Amendment.<sup>61</sup> By contrast, if the work is predominantly “an expressive comment on or about a celebrity” then it may be protected.<sup>62</sup>

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<sup>53</sup> *Id.* at 574–75 (emphasis added).

<sup>54</sup> *Id.* at 575.

<sup>55</sup> *Id.*

<sup>56</sup> *Id.*

<sup>57</sup> *Id.* at 575–76.

<sup>58</sup> *See, e.g.*, *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003); *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003); *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003). There is an additional smattering of cases that takes an ad hoc approach, which this Comment will not discuss.

<sup>59</sup> *See Doe*, 110 S.W.3d at 374.

<sup>60</sup> *Id.*

<sup>61</sup> *Id.* at 374 (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)).

<sup>62</sup> *Id.*

## 2. The *Rogers* Test

The *Rogers* test, also referred to as the relatedness test or the re-statement test, examines the relationship between the “celebrity image and work as a whole.”<sup>63</sup> Originating in the trademark case of *Rogers v. Grimaldi* in the Second Circuit,<sup>64</sup> the test asks whether the use of the celebrity’s name, or image, is “wholly unrelated” to the work.<sup>65</sup> The *Rogers* court looked at a movie titled “Ginger and Fred,” in which the central characters were named “Ginger” and “Fred” after Ginger Rogers and Fred Astaire.<sup>66</sup> The Court concluded that “these names [were] not arbitrarily chosen just to exploit the publicity value of their real life counterparts but instead [had] genuine relevance to the film’s story” and were, therefore, protected.<sup>67</sup>

The Sixth Circuit applied the *Rogers* test in *Parks v. LaFace Records*.<sup>68</sup> In *Parks*, Rosa Parks, civil rights icon, brought suit against LaFace Records, a record producer, and music duo OutKast for the use of her name as a song title on the album “Aquemini.”<sup>69</sup> In determining whether OutKast’s right to free expression protected it from Rosa Parks’ claim of violation of the right of publicity, the Sixth Circuit first applied the *Rogers* test to determine the validity of Rosa Parks’ trademark infringement claim.<sup>70</sup> The Sixth Circuit found a genuine issue of material fact as to whether the use of Rosa Parks’ name “[was] artistically related to the content of the song or whether the use of the name Rosa Parks [was] nothing more than a misleading advertisement for the sale of the song.”<sup>71</sup> Courts have been reluctant, however, to extend the *Rogers* test beyond consideration of the title of a work.<sup>72</sup> One month after the *Parks* decision, the Sixth Circuit decided another right of publicity case, *ETW Corp. v. Jireh Publishing, Inc.*, using the transformative use test.<sup>73</sup>

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<sup>63</sup> *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 154 (3d Cir. 2013).

<sup>64</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989); *see infra* Part III.B. (examining the balancing of the trademark intellectual property interest against freedom of expression).

<sup>65</sup> *Rogers*, 875 F.2d at 1004.

<sup>66</sup> *Id.* at 1001.

<sup>67</sup> *Id.*

<sup>68</sup> *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003).

<sup>69</sup> *Id.* at 441–42.

<sup>70</sup> *Id.* at 451.

<sup>71</sup> *Id.* at 456.

<sup>72</sup> *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008).

<sup>73</sup> *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003).

### 3. The Transformative Use Test

The final, and more widely accepted, approach taken in balancing the competing interests is the transformative use test. In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, a suit for copyright infringement brought against a rap music group, the California Supreme Court imported the transformative use test from copyright law.<sup>74</sup> According to the *Comedy III* court, “the inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.”<sup>75</sup> Ultimately, the transformative use test asks “whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.”<sup>76</sup> Because the Court provided minimal guidance as to the correct interpretation of the “purpose and use” language, the transformative use test has been applied in multiple ways by multiple courts.

In *Winter v. DC Comics*, the California Supreme Court applied the transformative use test to a case in which a comic book took the identifiable persona of the Winter brothers, singers Edgar and Johnny Winter, and created the Autumn brothers, half-human, half-worm-like creatures.<sup>77</sup> Expressing the test as requiring that “[a]n artist depicting a celebrity must contribute something more than a ‘merely trivial’ variation [but must create] something recognizably ‘his own’ in order to qualify for legal protection,”<sup>78</sup> the *Winter* court concluded that while the “fictional characters Johnny and Edgar Autumn [were] less-than-subtle evocations of Johnny and Edgar Winter, the books d[id] not depict plaintiffs literally.”<sup>79</sup> Furthermore, “the Autumn brothers [were] but cartoon characters – half-human and half-worm – in a larger story, which [wa]s itself quite expressive.”<sup>80</sup> In this case, not only were the celebrity images placed in a new world, but the celebrities themselves were transformed into fantastical creatures.

In *ETW Corp. v. Jireh Publishing, Inc.*, the Sixth Circuit applied the transformative use test to a photograph of Tiger Woods within a collage.<sup>81</sup> The photograph itself was an un-transformed photograph of

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<sup>74</sup> *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001).

<sup>75</sup> *Id.* at 809.

<sup>76</sup> *Id.* at 810.

<sup>77</sup> *Winter v. DC Comics*, 69 P.3d 473, 477–78 (Cal. 2003).

<sup>78</sup> *Id.* at 478 (citing *Comedy III Prods.*, 21 P.3d 797).

<sup>79</sup> *Id.* at 479.

<sup>80</sup> *Id.*

<sup>81</sup> *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003).

Woods.<sup>82</sup> The *ETW* court, however, concluded that the collage included significant transformative elements<sup>83</sup> as it did not focus solely on Woods, but rather, “consist[ed] of a collage of images in addition to Wood’s image which [were] combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Wood’s achievement in that event.”<sup>84</sup> This application of the transformative use test focused on the entirety of the work in which the unaltered celebrity image was placed.

In *Kirby v. Sega of America, Inc.*, the California Court of Appeals applied the transformative use test in the context of videogames.<sup>85</sup> The *Kirby* court concluded that Sega’s creation of the character of Ulala, while similar with respect to spoken phrases, clothing, and appearance to musician Kierin Kirby, was protected by the First Amendment because “Ulala was not a mere digital recreation of Kirby.”<sup>86</sup> Instead, the creators used the celebrity image as fodder for the character creation.<sup>87</sup> This application of the transformative use test had elements of both an altered world and altered celebrity image.

In *No Doubt v. Activision Publishing, Inc.*, the Court of Appeal of California also examined the right to publicity within the videogame context, however, this time the application of the transformative use test yielded the conclusion that the work was not protected.<sup>88</sup> The *No Doubt* court concluded that “no matter what else occurs in the game [*Band Hero*] 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.”<sup>89</sup> No transformative elements were apparent in *No Doubt* as neither the environment in which the celebrity image was placed, nor the image itself, was altered. Ultimately, however, few courts have directly addressed the appropriate way in which to balance the competing interests of the right of publicity and the First Amendment.<sup>90</sup>

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<sup>82</sup> *Id.* at 938.

<sup>83</sup> *Id.*

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

<sup>85</sup> *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607 (Ct. App. 2006).

<sup>86</sup> *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 161 (3d Cir. 2013) (citing *Kirby*, 50 Cal. Rptr. 3d at 613).

<sup>87</sup> *Kirby*, 50 Cal. Rptr. at 616.

<sup>88</sup> *No Doubt v. Activision Publ’g, Inc.*, 122 Cal. Rptr. 3d 397 (Ct. App. 2011)

<sup>89</sup> *Id.* at 410–11.

<sup>90</sup> *See Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 805 (Cal. 2001).

*B. Right of Publicity Balancing in Hart v. Electronic Arts, Inc.*

In a case of first impression, the Third Circuit sought to reconcile the parties' opposing interests in publicity and freedom of speech, and to determine the test most appropriate to be used in the future.<sup>91</sup> After determining the proper test to be applied, the *Hart* court then ruled on the appropriate application of that test.<sup>92</sup> The task of striking the appropriate balance between the interests at issue was made more difficult by the lack of applicable case law, as the right of publicity itself is relatively new.

1. Background of *Hart v. Electronic Arts, Inc.*

Electronic Arts, Inc., founded in 1982, is "one of the world's leading interactive entertainment software companies."<sup>93</sup> It "develops, publishes, and distributes interactive software worldwide" for consoles, cell phones, and PCs.<sup>94</sup> After success in NFL football videogames, Electronic Arts created a college version, *NCAA Football 2006*.<sup>95</sup> Largely based on realism, the *NCAA Football* franchise recreates sounds, game mechanics, and team mascots.<sup>96</sup> The virtual teams are filled with avatars resembling their real-life counterparts, including vital and biographical statistics.<sup>97</sup>

From the 2002 season through the 2005 season, Ryan Hart wore number thirteen for the Rutgers Scarlet Knights, the Rutgers University National Collegiate Athletics Association ("NCAA") Men's Division I Football team.<sup>98</sup> At six feet and two inches tall and weighing 197 pounds, Ryan Hart held the position of starting quarterback, and still holds the school records for career attempts, completions, and interceptions.<sup>99</sup> Accordingly, the Rutgers quarterback in *NCAA Football 2006*, wears the number thirteen, is six feet and two inches tall, weighs

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<sup>91</sup> While the Tenth, Eighth, Sixth, and Ninth Circuits have all addressed the balance between the right of publicity and the First Amendment, neither the Third Circuit nor a New Jersey court has previously weighed in. See *Hilton v. Hallmark Cars*, 599 F.3d 894 (9th Cir. 2010); *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media*, 505 F.3d 818 (8th Cir. 2007); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003); *Cardtoons, L.C. v. Major League Players Assoc.*, 95 F.3d 959 (10th Cir. 1996).

<sup>92</sup> *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 146 (3d Cir. 2013).

<sup>93</sup> *Id.* at 146.

<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

<sup>96</sup> *Id.*

<sup>97</sup> *Id.*

<sup>98</sup> *Hart*, 717 F.3d at 145.

<sup>99</sup> *Id.*

197 pounds, and shares the same hometown and general physical features with Ryan Hart.<sup>100</sup> Notably, while appearance and statistics may be changed by the videogame player, the avatar's home state, home town, team, and class year may not be altered.<sup>101</sup>

Electronic Arts obtains licenses from the NCAA's licensing agent, the Collegiate Licensing Company, that include "the right to use member school names, team names, uniforms, logos, stadium fight songs, and other game elements."<sup>102</sup> Unlike other franchises, however, Electronic Arts does not obtain a license for the players' likenesses and identities.<sup>103</sup> This is likely due, in large part, to the NCAA rules that require all NCAA players to be "amateurs."<sup>104</sup> Under NCAA rules, in order to be eligible for intercollegiate athletics, the student-athlete must be considered an "amateur."<sup>105</sup> This means that the student may not take advantage of commercial opportunities, because amateur status is lost if the athlete: (1) "[u]ses his or her athletics skill (directly or indirectly) for pay in any form in that sport"<sup>106</sup> or (2) "[a]ccepts any remuneration or permits the use of his or her name or picture to advertise, recommend or promote directly the sale or use of a commercial product or service of any kind."<sup>107</sup> Accordingly, Ryan Hart and similar college athletes would not be able to accept any form of payment or licensing agreement offered by Electronic Arts.<sup>108</sup>

Additionally, the NCAA places an affirmative burden on the student athletes to keep their names and images out of commercial use.<sup>109</sup> According to the NCAA manual, where a college athlete's

name or picture appears on commercial items . . . or is used to promote a commercial product sold by an individual or agency without the student-athlete's knowledge or permission, the student athlete (or institution acting on behalf of the student-athlete) is required to take steps to stop such an activity in order to retain his or her eligibility for intercollegiate athletics.<sup>110</sup>

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<sup>100</sup> *Id.* at 146.

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

<sup>102</sup> *Id.* at 146 n.5.

<sup>103</sup> *Id.* In its NFL series videogames, Electronic Arts pays for the right to use the professional football players' likenesses. *Hart*, 717 F.3d at 146 n.5.

<sup>104</sup> NCAA, 2011-12 NCAA DIVISION I MANUAL § 12.1.1 (2011), available at <http://www.ncaapublications.com/productdownloads/D112.pdf>.

<sup>105</sup> *Id.*

<sup>106</sup> *Id.* at § 12.1.2.

<sup>107</sup> *Id.* at § 12.5.2.

<sup>108</sup> See *Hart*, 717 F.3d at 146.

<sup>109</sup> NCAA, 2011-12 NCAA DIVISION I MANUAL at § 12.5.2.2.

<sup>110</sup> *Id.*

This rule provided further incentive for Ryan Hart to seek to prevent Electronic Arts from commercially benefiting from his image.

Ryan Hart brought suit against Electronic Arts, alleging that the clearly identifiable use of his likeness in the game violated his right of publicity.<sup>111</sup> For the purposes of the summary judgment motion, Electronic Arts conceded that it had violated Hart's right of publicity through the use of his image and personal characteristics in the 2004, 2005, and 2006 *NCAA Football* video games.<sup>112</sup> Electronic Arts contended, however, that it was entitled to summary judgment on First Amendment grounds.<sup>113</sup>

The District Court granted summary judgment in favor of Electronic Arts, holding that the game, *NCAA Football*, was entitled to First Amendment protection and therefore was "shielded from right of publicity claims by the First Amendment."<sup>114</sup> Hart appealed and the majority of the Third Circuit held in his favor.<sup>115</sup>

## 2. Determinations of the Majority

Acknowledging that courts have different balancing approaches in addressing the tension between free expression and protecting the right of publicity, the majority noted that it must first look at the interests that need to be balanced, then consider the different approaches taken by courts "to resolv[e] the tension between the First Amendment and the right of publicity."<sup>116</sup> To determine "whether the interest in safeguarding the right of publicity overpowers the interest in safeguarding free expression,"<sup>117</sup> the majority looked at the predominant use test and the *Rogers* test before deciding that application of the transformative use test best balances publicity and free speech.<sup>118</sup>

The *Hart* court rejected the predominant use test as "subjective at best and arbitrary at worst."<sup>119</sup> According to the court, application would require the judge to act as both impartial jurist and discerning art critic.<sup>120</sup> Furthermore, adoption of the predominant use test, the

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<sup>111</sup> Hart v. Elec. Arts, Inc., 808 F. Supp. 2d 757, 760 (D.N.J. 2011).

<sup>112</sup> *Id.* at 766.

<sup>113</sup> *Id.*

<sup>114</sup> Hart v. Elec. Arts, Inc., 717 F.3d 141, 147 (3d Cir. 2013).

<sup>115</sup> *See id.* at 145.

<sup>116</sup> *Id.* at 149.

<sup>117</sup> *Id.* at 150.

<sup>118</sup> *See id.* at 153–63.

<sup>119</sup> *Id.* at 154.

<sup>120</sup> *Hart*, 717 F.3d. at 154.

*Hart* court explained, would “suppose that there exists a broad range of seemingly expressive speech that has no First Amendment Value.”<sup>121</sup>

The *Hart* court then found the *Rogers* test unsuitable here because it is not carefully calibrated to balance two fundamental protections: “the right of free expression and the right to control, manage, and profit from one’s own identity.”<sup>122</sup> The court indicated that application of the test would yield nonsensical results. The court explained that because Ryan Hart was a college football player, his likeness is, as a matter of course, related to *NCAA Football*.<sup>123</sup> Because the game and his celebrity are related, the game is not a commercial advertisement for some unrelated product. Accordingly, Hart would fail the *Rogers* test.<sup>124</sup> This outcome, however, was unacceptable because “[i]t [could not] be that the very activity by which Appellant achieved his renown now prevents him from protecting his hard-won celebrity.”<sup>125</sup>

Ultimately accepting the transformative use test, the *Hart* court explained that a balance can be struck between a celebrity’s right to profit from his image and the value of the new expressive work by looking at the “the purpose and character of the use.”<sup>126</sup> If the work contains “significant transformative elements,” the court reasoned, it is “less likely to interfere with the economic interests implicated by the right of publicity.”<sup>127</sup> In applying the test, the *Hart* majority concluded that, like in *No Doubt*, the digital avatar mirrored the real Ryan Hart: they both play football in college football stadiums, “filled with all the trappings of a college football game. This is not transformative; various digitized sights and sounds . . . do not alter or transform the [player]’s identity in a significant way.”<sup>128</sup>

In applying the transformative use test to Hart, the court found that it must focus on “the specific aspects of the work that speak to whether it was merely created to exploit a celebrity’s likeness.”<sup>129</sup> The court noted that the avatar matches Hart in hair color and style, skin tone, and accessories worn. It also mirrors Hart’s vital and biographical statistics.<sup>130</sup> The court then noted that in order to find some transformative element, it “must look somewhere other than just the in-

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<sup>121</sup> *Id.*

<sup>122</sup> *Id.* at 157.

<sup>123</sup> *Id.*

<sup>124</sup> *Id.* at 158.

<sup>125</sup> *Id.*

<sup>126</sup> *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001).

<sup>127</sup> *Hart*, 717 F.3d at 159.

<sup>128</sup> *Id.* at 166.

<sup>129</sup> *Id.* at 163.

<sup>130</sup> *Id.* at 166.

game digital recreation.”<sup>131</sup> The court stated that it must look at context, but dismissed Electronic Arts’ suggestion that other creative elements in the game are so numerous as to render the work transformative.<sup>132</sup> The court stated that “[d]ecisions applying the [t]ransformative [u]se [t]est invariably look to how the *celebrity’s identity* is used in or is altered by other aspects of the work. Wholly unrelated elements do not bear on this inquiry.”<sup>133</sup> The majority’s analysis of whether or not the videogame was transformative focused closely on the image of Ryan Hart himself, looking at that specific aspect of the game.

### 3. Judge Ambro’s Dissenting Application of the Transformative Use Test

In his dissent, Judge Ambro agreed that the transformative use test was the operative test to balance publicity and free speech, but concluded that the work must be looked at as a whole rather than as the use of the individual by itself.<sup>134</sup> He stated that “[t]o determine whether an individual’s identity has been ‘transformed’ for purposes of the Transformative Use Test, I believe it is necessary to review the likeness in the context of the work in its entirety, rather than focusing only on the individual’s likeness.”<sup>135</sup>

Judge Ambro explained that application of the test to the work as a whole is consistent with the application taken by the architect of the transformative use test, the California Supreme Court.<sup>136</sup> Furthermore, the dissent compared application of transformative use in publicity to the way it is applied in books and art, stating that the test “must mesh with existing constitutional protections for works of expression.”<sup>137</sup> The *Winter* court emphasized that the comic contains “significant expressive content other than plaintiffs’ mere likeness” and noted that the characters are placed within a larger story, “which is itself quite

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<sup>131</sup> *Id.*

<sup>132</sup> *Id.* at 166–67.

<sup>133</sup> *Hart*, 717 F.3d at 169.

<sup>134</sup> *See id.* at 171 (Ambro, J., dissenting).

<sup>135</sup> *Id.*

<sup>136</sup> *See id.*

<sup>137</sup> *Id.* (citing *Matthews v. Wozencraft*, 15 F.3d 432 (5th Cir. 1994); *Ruffin-Steinbeck v. dePasse*, 82 F. Supp.2d 723 (E.D. Mich. 2000); *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996); *Hicks v. Casablanca Records*, 464 F.Supp. 426 (S.D.N.Y. 1978) in support of the conclusion that constitutional protection cannot be diminished simply “because a celebrity’s name or likeness was used to increase a product’s value and marketability”).

expressive.”<sup>138</sup> *ETW* featured a photograph of Tiger Woods.<sup>139</sup> The actual image of Woods had not been altered at all, but rather, the majority noted that it received protection because “*the collage* ‘contain[ed] significant transformative elements.’”<sup>140</sup>

Concluding that Electronic Arts’ use of realistic avatars merited First Amendment protection, the dissent noted the “myriad of original graphics, videos, sound effects, and game scenarios,” which allow a user to either dictate the play of a college team or create an entirely new team.<sup>141</sup> Judge Ambro reasoned that attempting to separate Hart’s image from the creative elements of the game as a whole “disregards *NCAA Football*’s many expressive features beyond an avatar having characteristics similar to Hart.”<sup>142</sup> Further, “[h]is likeness is transformed by the artistry necessary to create a digitally rendered avatar within the imaginative and interactive world EA has placed that avatar.”<sup>143</sup>

### III. BALANCING INTELLECTUAL PROPERTY INTERESTS AGAINST FREE EXPRESSION

The same tension, between an intellectual property interest and free expression, arises under copyright and trademark law and is settled by way of internal doctrinal mechanisms.<sup>144</sup> While the doctrine of these intellectual property categories seeks to balance precisely the same tension, they have developed in different ways with different checks, values, concerns, and considerations.<sup>145</sup> Nonetheless, the balancing of these developed intellectual property doctrines may yield valuable insight and consideration for the balancing undertaken in the right of publicity context.

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<sup>138</sup> *Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003).

<sup>139</sup> *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003).

<sup>140</sup> *Hart*, 717 F.3d at 173.

<sup>141</sup> *Id.* at 175.

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

<sup>143</sup> *Id.*

<sup>144</sup> See *Bartholomew & Tehranian*, *supra* note 12, at 7.

<sup>145</sup> See *Kwall*, *supra* note 29, at 58. *Kwall* explains that while copyright law and the right of publicity may be analogous, they are different both in their “theoretical underpinnings and objectives. Thus, the incorporation of a copyright law doctrine as the springboard for analysis in the First Amendment/right of publicity dilemma will result in the adoption of an imprecise analytical framework and potentially inappropriate outcomes.”

*A. Copyright Law*

The purpose of copyright is to promote both the creation and publication of expression, just as the purpose of the right of publicity is to promote investment in development of a skill.<sup>146</sup> The Supreme Court explains that “[b]y establishing a marketable right to the use of one’s expression, copyright supplies the economic incentive to create and disseminate ideas.”<sup>147</sup> Multiple elements of the fair use defense look at the economic nature and impact of the new work in comparison with the original.<sup>148</sup>

Copyright law is firmly rooted in statutory construction and has a long precedential history.<sup>149</sup> The Supreme Court has determined that any tension between the First Amendment and copyright law has been addressed by the two limitations placed on copyright: (1) the idea versus expression dichotomy and (2) the fair use defense.<sup>150</sup> The idea versus expression dichotomy states that the “idea” giving rise to the work is part of the public domain while the “expression” produced by the individual is protected by copyright.<sup>151</sup> Accordingly, it is only the expression itself that is protected.<sup>152</sup> In order for there to be a copyright infringement, the work must be deemed “expression.”<sup>153</sup> The fair use defense is a determination that a use of a work is not an infringement on the copyright.<sup>154</sup> The fair use defense, codified in section 107 of the 1976 Copyright Act, requires the evaluation of:

(1) the purpose and character of the use, including whether such use is of commercial nature . . . ; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.<sup>155</sup>

The elements provide guidance from which the court can make the determination that the use of the original work in the new work is

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<sup>146</sup> Eldred v. Ashcroft, 537 U.S. 186, 219 (2003).

<sup>147</sup> *Id.* (quoting Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 558 (1985)).

<sup>148</sup> See 17 U.S.C. § 107(1) (2012).

<sup>149</sup> See Bartholomew & Tehranian, *supra* note 12, at 11–13.

<sup>150</sup> *Id.* at 12.

<sup>151</sup> Edward Samuels, *The Idea-Expression Dichotomy in Copyright Law*, 56 TENN. L. REV. 321, 323 (1989).

<sup>152</sup> *Id.*

<sup>153</sup> *Id.* at 324.

<sup>154</sup> Michael J. Madison, *A Pattern Oriented Approach to Fair-Use*, 45 WM. & MARY L. REV. 1525, 1554 (2004).

<sup>155</sup> 17 U.S.C. § 107 (2012).

“fair,” meaning that it is not an infringement.<sup>156</sup> The determination involves consideration not only of “the purpose and character of the use” from which the transformative use test is derived,<sup>157</sup> but also whether the use is of a commercial nature for economic gain.<sup>158</sup> The second element considers the nature of the work, whether it is commercial, educational, or instructional.<sup>159</sup> The third element looks at how much of the original work has been incorporated into the new work in question, while the fourth factor explicitly inquires into the market impact of the appropriation.<sup>160</sup> Additionally, distinctions may be drawn between commercial and noncommercial use,<sup>161</sup> transformative and non-transformative use,<sup>162</sup> and productive and non-productive use, all of which increase the difficulty of the fair use determination.<sup>163</sup>

Recent court discourse has seen an increase in the discussion of transformative use,<sup>164</sup> embodied in the first half of the first factor of the fair use defense.<sup>165</sup> For example, in *Campbell v. Acuff-Rose Music Inc.*,<sup>166</sup> in which the owner of a rock ballad sued a rap music group for copyright infringement, the court cited with approval Judge Pierre Leval’s article *Toward a Fair Use Standard*,<sup>167</sup> which supports increased attention to transformative use within the fair use test as providing broader protection for First Amendment interests.<sup>168</sup>

The Supreme Court has found that copyright’s built-in free speech safeguards are “generally adequate,”<sup>169</sup> and has expressed confidence in copyright’s internal checks addressing issues of free speech, rather than constitutional scrutiny.<sup>170</sup> The critique of copyright juris-

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<sup>156</sup> Madison, *supra* note 154, at 1558.

<sup>157</sup> See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 159–60 (3d Cir. 2013) (explaining the development of the transformative use test in *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001)).

<sup>158</sup> See 17 U.S.C. § 107.

<sup>159</sup> See *id.*

<sup>160</sup> See *id.*

<sup>161</sup> Madison, *supra* note 154, at 1558 (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 450–51 (1984)).

<sup>162</sup> Madison, *supra* note 154, at 1558 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)).

<sup>163</sup> Madison, *supra* note 154, at 1558–59.

<sup>164</sup> See *Bartholomew & Tehranian*, *supra* note 12, at 12–13.

<sup>165</sup> *Id.* at 13.

<sup>166</sup> *Campbell v. Acuff-Rose Music Inc.*, 510 U.S. 569, 579 (1994).

<sup>167</sup> Pierre Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990).

<sup>168</sup> See *Bartholomew and Tehranian*, *supra* note 12, at 13.

<sup>169</sup> *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003).

<sup>170</sup> *Golan v. Holder*, 132 S. Ct. 873, 890–91 (2012).

prudence is that it is a test of necessity and that the original copyrighted work *must* be intrinsic to the new work's message in order for the new work to be allowed.<sup>171</sup> The fact remains, however, that the "fair use" defense is relatively broad, providing protection for not only the use of facts and ideas, but also, in certain circumstances, the expression contained in the copyrighted work.<sup>172</sup> Copyrighted work can be copied, without violation, for "criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research . . . ."<sup>173</sup> In fact, according to the Supreme Court, copyright's fair use defense provides "latitude for scholarship and comment,"<sup>174</sup> "and even for parody."<sup>175</sup>

### B. Trademark Law

Just as the right of publicity and copyright law emphasize economic interests, trademark law, too, seeks to promote economic efficiency. Trademark law focuses on minimizing the likelihood of consumer confusion in the marketplace, thereby promoting economic efficiency. As professors Mark Bartholomew and John Tehranian stated, in their comprehensive comparison of intellectual property frameworks, "[t]he promotion of economic efficiency serves as the dominant rationale for trademark rights and is achieved by minimizing the likelihood of consumer confusion in the marketplace."<sup>176</sup> Unlike the right of publicity, trademark law implicates the potential for consumer confusion.<sup>177</sup> In contrast to copyright's strict historical tradition, trademark law has been more flexible, sometimes allowing for the production of new doctrine to accommodate speech.<sup>178</sup> But trademark law is similar to copyright law in its reliance on internal mechanisms to address issues of free expression.<sup>179</sup> The new mechanisms for infringement evaluation, however, are then placed within the traditional view

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<sup>171</sup> See Bartholomew & Tehranian, *supra* note 12, at 13 (discussing the difference between protected parody and unprotected satire).

<sup>172</sup> *Eldred*, 537 U.S. at 219.

<sup>173</sup> *Id.* at 219–20 (quoting 17 U.S.C. § 107(2012)).

<sup>174</sup> *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985).

<sup>175</sup> *Eldred*, 537 U.S. at 220 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (holding that a rap group's musical parody of Roy Orbison's "Oh, Pretty Woman" may be fair use)).

<sup>176</sup> Bartholomew & Tehranian, *supra* note 12, at 41. See Mark Bartholomew, *Making a Mark in the Internet Economy: A Trademark Analysis of Search Engine Advertising*, 58 OKLA. L. REV. 179, 195–96 (2005); Sonia K. Katyal, *Trademark Intersectionality*, 57 UCLA L. REV. 1601, 1614–15 (2010).

<sup>177</sup> See *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989).

<sup>178</sup> See Bartholomew & Tehranian, *supra* note 12, at 79–81.

<sup>179</sup> *Id.* at 41.

of the purpose of trademark law, effectively narrowing their interpretation.<sup>180</sup> Recent court decisions have occasionally directly addressed First Amendment issues.<sup>181</sup>

In *Rogers v. Grimaldi*, the court developed a new test to determine trademark infringement.<sup>182</sup> While, as discussed *supra*, the *Rogers* test was later appropriated for use in the right of publicity context, it originally developed within the trademark framework.<sup>183</sup> Within trademark law, prior tests had simply asked whether the title was likely to confuse consumers, or whether the filmmaker could have made his or her point in other ways.<sup>184</sup> The new test asks whether “the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, [whether] the title explicitly misleads as to the source or content of the work.”<sup>185</sup>

Generally, two questions are asked under the *Rogers* test: “(1) whether use of the plaintiff’s trademark is ‘artistically relevant’ to the defendant’s work; and (2) whether use of the plaintiff’s trademark is ‘explicitly misleading.’”<sup>186</sup> Artistic relevance is interpreted broadly, with deference given to the defendant.<sup>187</sup> The phrase “explicitly misleading” is taken to mean that “defendant’s work must make some affirmative statement of the plaintiff’s sponsorship or endorsement beyond the mere use of plaintiff’s name or other characteristic.”<sup>188</sup> Keeping the burden on the plaintiff and requiring an additional affirmative statement by the defendant renders the *Rogers* test particularly protective of speech.<sup>189</sup>

Trademark law, however, also requires consideration of the distinction between commercial and noncommercial speech.<sup>190</sup> This limits the availability of a First Amendment defense to a trademark infringement claim. In *Facenda v. N.F.L. Films, Inc.*, the Third Circuit

<sup>180</sup> *See id.*

<sup>181</sup> *See, e.g.*, *Univ. of Ala. Bd. of Tr. v. New Life Art, Inc.*, 683 F.3d 1266, 1276–79 (11th Cir. 2012); *Lamparello v. Falwell*, 420 F.3d 309, 313–14 (4th Cir. 2005).

<sup>182</sup> *See Rogers*, 875 F.2d 994.

<sup>183</sup> For a discussion of how this test was later borrowed for use in the right of publicity context as in *Parks v. LaFace*, see *supra* Part II.A.2.

<sup>184</sup> *Bartholomew & Tehranian*, *supra* note 12, at 48.

<sup>185</sup> *Rogers*, 875 F.2d at 999.

<sup>186</sup> *Bartholomew & Tehranian*, *supra* note 12, at 49 (quoting *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008)).

<sup>187</sup> *Id.*

<sup>188</sup> *Dillinger, LLC v. Elec. Arts, Inc.*, No. 1:09-cv-1236, 2011 WL 2457678, at \*6 (S.D. Ind. June 16, 2011) (citing *Rogers*, 875 F.2d at 1001; *E.S.S. Entm’t*, 547 F.3d at 1101).

<sup>189</sup> *Bartholomew & Tehranian*, *supra* note 12, at 50.

<sup>190</sup> *See id.* at 52.

determined that where the defendant's use of a mark is commercial speech, there is no First Amendment defense.<sup>191</sup> In trademark law, once an activity is considered commercial, the violation is evaluated within trademark law's own framework and is no longer considered to directly implicate the First Amendment.<sup>192</sup>

#### IV. DEVELOPING A COMPREHENSIVE BALANCING SCHEME

From the first case addressing the right of publicity, the Supreme Court noted that the right of publicity was a property right akin to that in intellectual property; the Court found that the goal of the right of publicity is "analogous to the goals of patent and copyright law," in that they serve to protect an individual's ability to "reap the reward of his endeavors."<sup>193</sup> In the most recent case addressing the right of publicity and the First Amendment, Judge Ambro stated for the Third Circuit that the "[t]ransformative use [test] must mesh with existing constitutional protections for works of expression."<sup>194</sup> Examining the work of previous decisions in various courts, the Third Circuit attempted to determine the appropriate test and interpretation.<sup>195</sup> Settling on the transformative use test, the majority in *Hart v. Electronic Arts, Inc.* applied a narrow interpretation to the requirement of transformation, concluding that the First Amendment did not protect the defendant from its admitted violation of the right of publicity.<sup>196</sup>

This narrow reading is commensurate with the balancing undertaken in both copyright and trademark law. Recognized by the Supreme Court as employing adequate balancing of interests, the framework employed in copyright recognizes both the interest in free expression of the defendant and the economic interests of the property protection.<sup>197</sup> While the Third Circuit's ultimate determination echoed the narrow free expression exception to copyright violations, the analysis that the court employed did not reference the strong economic considerations underpinning not only the right of publicity, but also copyright and trademark law.<sup>198</sup> In order to adequately balance

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<sup>191</sup> *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008).

<sup>192</sup> *See* Bartholomew & Tehranian, *supra* note 12, at 80.

<sup>193</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

<sup>194</sup> *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 173 (3d Cir. 2013) (Ambro, J., dissenting).

<sup>195</sup> *See id.* at 153–161.

<sup>196</sup> *Id.* at 169.

<sup>197</sup> *See* *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003).

<sup>198</sup> *Cf. Hart*, 717 F.3d at 163–166.

the competing interests of the right of publicity and free expression, the commercial interests at play should be recognized just as they are in copyright and trademark law.

In contrast to copyright's rigid framework, the right of publicity's single factor test, looking at the degree of transformation of the celebrity, is exceedingly flexible.<sup>199</sup> But this flexibility allows the transformative use test to be attuned to the tension of interests between the property holder, the celebrity, and the speaker. The flexibility also allows the right of publicity to be interpreted in a way that is consistent with the other intellectual properties<sup>200</sup> to account for their balancing of parallel interests.<sup>201</sup>

The balance between the right of publicity and the First Amendment must be carefully calibrated because "the very importance of celebrities in society means that the right of publicity has the potential of censoring significant expression by suppressing alternative versions of celebrity images that are iconoclastic, irreverent or otherwise attempt to redefine the celebrity's meaning."<sup>202</sup> The Supreme Court, however, has found that copyright law's built-in free speech safeguards are "generally adequate,"<sup>203</sup> and expressed confidence in copyright law's internal checks addressing issues of free speech, rather than constitutional scrutiny.<sup>204</sup>

The transformative use test is derived from the first prong of copyright's fair use test.<sup>205</sup> The interests and incentives that frame the construction of copyright law should therefore be reflected in the understanding of the right of publicity. The underlying economic incentive for the protection of the right of publicity is for the individual to make "the investment required to produce a performance of interest to the public."<sup>206</sup> The same interest underlies copyright law since a copyright's purpose is to *promote* the creation and publication of free expression: "The Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and

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<sup>199</sup> See *supra* Part II.A.3.

<sup>200</sup> Hart, 717 F.3d at 173 (Ambro, J., dissenting).

<sup>201</sup> See *supra* notes 197–198.

<sup>202</sup> Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 803 (Cal. 2001).

<sup>203</sup> Eldred v. Ashcroft, 537 U.S. 186, 221 (2003).

<sup>204</sup> Golan v. Holder, 132 S. Ct. 873, 890–91 (2012).

<sup>205</sup> *Id.*; see 17 U.S.C. § 107 (2012).

<sup>206</sup> Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 576 (1977).

disseminate ideas.”<sup>207</sup> Accordingly, the interpretation of the transformative use test should mirror the balancing undertaken in the copyright and trademark context, as they are protecting the same interests.

Copyright law places primary importance on “protecting a plaintiff’s right to exploit potential licensing markets, even in the face of a First Amendment defense.”<sup>208</sup> Multiple elements of the fair use defense look at the economic nature and impact of the new work in comparison with the original.<sup>209</sup> In the scheme of copyright, market concerns take center stage. Half of the fair use defense explicitly evaluates economic considerations: “the purpose and character of the use, including whether such use is of commercial nature,” and “the effect of the use upon the potential market for or value of the copyrighted work.”<sup>210</sup>

Trademark law similarly emphasizes commercial concerns because the main inquiry seeks to protect business identity and asks whether a consumer may be confused by the use of the mark.<sup>211</sup> “The promotion of economic efficiency serves as the dominant rationale for trademark rights and is achieved by minimizing the likelihood of consumer confusion in the marketplace.”<sup>212</sup> Trademark law looks at the specific mark by itself, similar to the majority’s focus on the specific use of the celebrity image, and asks whether there would be consumer confusion<sup>213</sup>—whether a consumer would think that the new work is connected with the familiar brand holding that mark. Similarly, in the right of publicity context, application of the consumer confusion principle would yield the question of whether there would be confusion that the celebrity endorsed the new work. In other words, the court should consider whether use of the celebrity image in the new work is so unaltered, untransformed, and recognizable as to cause the audience to believe that the celebrity himself is connected to the new work. Direct consideration of the economic interests, as in trademark law, would ensure that the understanding and application of transformative use clearly addresses the economic interest grounding the right of publicity.

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<sup>207</sup> *Eldred*, 537 U.S. at 219 (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985)).

<sup>208</sup> See Bartholomew & Tehranian, *supra* note 12, at 21.

<sup>209</sup> See 17 U.S.C. § 107(1) (2012).

<sup>210</sup> *Id.*

<sup>211</sup> See Bartholomew & Tehranian, *supra* note 12, at 80.

<sup>212</sup> *Id.* See also Bartholomew, *supra* note 176, at 195–96; Katyal, *supra* note 176, at 1614–15.

<sup>213</sup> Bartholomew & Tehranian, *supra* note 12, at 41.

The centrality of the economic interest in the right of publicity, or in this case, the economic effect of the use of a celebrity's image or identity, is important to consider as part of the balancing of property and free speech interests.<sup>214</sup> It is one of the three rationales providing a base for the protection of the right of publicity, and scholars have argued that the central reason for protection of the right of publicity is to preserve a celebrity's right to commercial gain from their own person.<sup>215</sup> In *Zacchini*, the Supreme Court approved of the right of publicity as an economic incentive for individuals to develop a performance or persona.<sup>216</sup> The centrality of economics to both the reasoning behind the right of publicity and the analysis applied in other intellectual property doctrines indicates that commercial gain should be factored into the considerations in balancing the breach of right of publicity and the interests of the First Amendment. While economics is not the only consideration for the right of publicity, in contrast to trademark law, and it is not even explicitly part of the test, in contrast to copyright law, it is part of the larger scheme of intellectual property in which the right of publicity is placed.<sup>217</sup> Accordingly, the critiques and understandings of these developed intellectual property doctrines may yield valuable insight and consideration for developing the appropriate balancing in the right of publicity context.

Despite the extensive similarities between the right of publicity, copyright law, and trademark law, the right of publicity lacks the history of statutory construction of trademark and copyright law.<sup>218</sup> This difference allows right of publicity discourse to be receptive to the development of an interpretation similar to the other intellectual properties.<sup>219</sup> This means that the right of publicity, and the transformative use test specifically, is left with a great deal of vagueness in how it is to be properly applied; at the same time, there is flexibility within looking at the "purpose and use" to apply the transformative use test so that it

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<sup>214</sup> See Kwall, *supra* note 29, at 55.

<sup>215</sup> See *id.* The labor and unjust enrichment justifications focus on taking away or denying the celebrity economic gain earned from his persona. Critics, however, argue that these justifications are overstated as the individual would have no earning potential without the media, audience, and culture of celebrity creating a marketable identity. *Id.*

<sup>216</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575–576 (1977).

<sup>217</sup> See Bartholomew & Tehranian, *supra* note 12, at 3.

<sup>218</sup> See *id.* at 8.

<sup>219</sup> See *id.*

is consistent with the balancing undertaken in copyright and trademark law.<sup>220</sup> Accordingly, the transformative use test may be read narrowly to directly account for the economic interests at the heart of intellectual property.

Ultimately, though approaching the economic interests indirectly, the *Hart* majority decided that if the work contains “significant transformative elements . . . it is less likely to interfere with the economic interests implicated by the right of publicity.”<sup>221</sup> This interpretation provides a narrow First Amendment exception to right of publicity infringement that is consistent with the understanding that the right of publicity is similar to copyright.<sup>222</sup> Copyright law places primary importance on “protecting a plaintiff’s right to exploit potential licensing markets, even in the face of a First Amendment defense.”<sup>223</sup> It is also consistent with the underlying interest in protecting the economic incentive to develop a skill or identity that undergirds both the right of publicity and copyright: as “[t]he Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one’s expression, copyright supplies the economic incentive to create and disseminate ideas”<sup>224</sup> and the “same consideration underlies . . . copyright laws long enforced by [the Supreme] Court.”<sup>225</sup> Therefore, the interpretation of the transformative use test as applied by the *Hart* majority should be adopted in the right of publicity context, with the additional understanding of the prominence that economic interests play in the intellectual property balancing scheme.

## V. CONCLUSION

The right of publicity does not have a great deal of precedent defining its interpretation and scope. This lack of history provides flexibility in determining the appropriate way in which to balance the competing issues: the right of publicity’s property interest versus the First

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<sup>220</sup> See *supra* Part II.A.3 (discussing different courts’ applications of “purpose and use” within the transformative use test).

<sup>221</sup> *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 159 (3d Cir. 2013).

<sup>222</sup> See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 805 (Cal. 2001) (“Although surprisingly few courts have considered in any depth the means of reconciling the right of publicity and the First Amendment, we follow those that have in concluding that depictions of celebrities amounting to little more than the appropriation of the celebrity’s economic value are not protected expression under the First Amendment.”).

<sup>223</sup> See *Bartholomew & Tehranian*, *supra* note 12, at 21.

<sup>224</sup> *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985)).

<sup>225</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

Amendment free expression. Despite the right of publicity's lack of precedent, however, both copyright and trademark law have fully developed frameworks that balance identical interests. Accordingly, the affirmative defense of free expression for a violation of the right of publicity should be narrowly available, as provided by the majority in *Hart*, to echo its availability in the other areas of intellectual property. Additionally, attention should be paid to the strong economic interests at stake, which the intellectual property schemes seek to protect.