

2017

Finding a Fair Balance for the Right of Publicity and First Amendment Protections

Christine DiGregorio

Follow this and additional works at: <http://digitalcommons.tourolaw.edu/lawreview>



Part of the [First Amendment Commons](#), and the [Intellectual Property Law Commons](#)

Recommended Citation

DiGregorio, Christine (2017) "Finding a Fair Balance for the Right of Publicity and First Amendment Protections," *Touro Law Review*: Vol. 33 : No. 3 , Article 14.

Available at: <http://digitalcommons.tourolaw.edu/lawreview/vol33/iss3/14>

This Article is brought to you for free and open access by Digital Commons @ Touro Law Center. It has been accepted for inclusion in Touro Law Review by an authorized editor of Digital Commons @ Touro Law Center. For more information, please contact ASchwartz@tourolaw.edu.

FINDING A FAIR BALANCE FOR THE RIGHT OF PUBLICITY AND FIRST AMENDMENT PROTECTIONS

Christine DiGregorio *

I. INTRODUCTION

Today's society is consumed with the lives of celebrities and incorporates them as an important part of modern everyday life. Many individuals today "keep up" with the Kardashians as much as they keep up with the lives of their personal friends.¹ A contestant on "The Bachelor" or "The Voice" is now a household name with whom some fans feel a personal connection.² As a result, a celebrity's identity pervades and influences our culture.

Celebrities have even become prominent in political and societal movements. For example, the attendance of Beyoncé, Katy Perry and many others at the Second Inauguration of former President Barack Obama was highly publicized.³ More recently, the revelation

* J.D. Candidate 2017, Touro College Jacob D. Fuchsberg Law Center; Bachelor of Science 2014, State University of New York at Albany. I would like to thank my Mom and Dad for their endless love, moral support, and encouragement throughout my entire law school career; and my brothers, Danny and Brian, who always lifted my spirits at times when I was too stressed to do so on my own. Additionally, I would like to thank all my close family and friends who have extended words of encouragement and support throughout my time at law school. You truly motivated and inspired me to get through some of the longest days and nights. Finally, I would like to thank Professor Rena Sepowitz for her guidance and invaluable insight throughout the writing process of this comment.

¹ Keeping up with the Kardashians June 4, 2013 premiere averaged three million viewers. *The Kardashians Still Going Strong in Season 8*, LIVE JOURNAL (June 4, 2013), <http://ohnotheydidnt.livejournal.com/78395171.html>.

² Millions of viewers express their opinions on social media each time the show is aired about the contestants on reality TV shows such as "Keeping up with the Kardashians," "American Idol," and "The Voice." See, e.g., *Weekly Top Ten*, NIELSEN SOCIAL, <http://www.nielsensocial.com/nielsentwittertratings/weekly> (last visited Mar. 7, 2017).

³ Kelly Clarkson, Jamie Fox and John Legend all performed at the inauguration. Additionally, rapper Jay-Z, singer John Mayer, actress Eva Longoria, and actor Mario Lopez were in attendance. *Celebrities of President Barack Obama's Second Inauguration*, SF GATE (Jan. 21, 2013), <http://blog.sfgate.com/politics/2013/01/21/celebrities-of-president-barack-obama-s-second-inauguration-with-photo-gallery/>.

by Caitlyn Jenner⁴ has paved the way for the acceptance of transgender individuals in both society and professional sports.⁵ Kanye West's whirlwind announcement of his run for presidency in 2020 at the MTV Video Music Awards⁶ threw society into a frenzy.⁷ The cultural and political influences of these household names demonstrate how celebrities have developed into more than figures of entertainment.

These famous individuals are just a few of the celebrities who have extended their influence in areas far beyond the entertainment field.⁸ Many people duplicate diets of celebrities,⁹ and even follow celebrities' suggestions on Instagram¹⁰ posts, dining at places that they believe the celebrity had visited.¹¹ It is no wonder that so many commercial retailers, business owners, and restaurant owners desire a celebrity's endorsement for their products.

However, it is precisely the celebrities' influence that reinforces the importance of their right of publicity in their own

⁴ Caitlyn, formerly Bruce Jenner, revealed in an exclusive interview with Diane Sawyer that she was a transgendered woman, and after years of hiding her real identity, would be making the change to a woman. *Transcript of Bruce Jenner Coming Out as Transgender Will Only Make You Respect Jenner More*, BUSTLE (Apr. 24, 2014).

<http://www.bustle.com/articles/78832-transcript-of-bruce-jenner-coming-out-as-transgender-will-only-make-you-respect-jenner-more>. See also *Bruce Jenner - The Interview*, ABC (July 15, 2015) <http://abc.go.com/shows/2020/listing/2015-04/24-bruce-jenner-the-interview>.

⁵ Caitlyn Jenner was awarded the Arthur Ashe Courage Award at the 2015 ESPYS. *Caitlyn Jenner Accepts Arthur Ashe Courage Award*, ESPN (July 16, 2015), http://espn.go.com/espys/2015/story/_/id/13264599/caitlyn-jenner-accepts-arthur-ashe-courage-award-espys-ashe2015.

⁶ *Kanye West Declares 2020 Presidency vid at VMAs*, CNN (Sept. 5, 2015), <http://www.cnn.com/2015/08/31/politics/kanye-west-2020-running-for-president-vma/>.

⁷ See, e.g., *This is How Twitter Wants Kanye West's Presidential Dream to Unfold!*, DNA INDIA (Sept. 1, 2015), <http://www.dnaindia.com/entertainment/report-this-is-how-twitter-wants-kanye-west-s-presidential-dream-to-unfold-2120971>.

⁸ See *supra* notes 1-7.

⁹ *5 Healthy Celebs – And How to Eat Like Them*, PEOPLE (Dec. 12, 2013), <http://greatideas.people.com/2013/12/30/5-healthy-celebs-and-how-to-eat-like-them/>.

¹⁰ Instagram is a social media site where members of society post pictures of their everyday lives. An individual can “like” a picture that someone else posts, to represent his approval or support of the photo. *A Quick Overview of Instagram*, BUSINESS PRODUCTIVITY (Sept. 10, 2012), <https://www.instagram.com>.

¹¹ See, e.g., *jonathancheban*, INSTAGRAM, <https://instagram.com/p/BB5JBC3j6tx/> (last visited Mar. 7, 2017). Celebrity Jonathan Cheban – known for being best friends with the Kardashian sisters – posted a picture of a milkshake from Black Tap Craft Burgers and Beer in New York City. The picture has over 16,000 likes, meaning that over 16,000 people saw the picture and now know where to find a milkshake exactly like the one that Jonathan posted. *Id.*

identity. The right of publicity is an intellectual property right that enables celebrities to control the use of their identities and prohibit their unauthorized use.¹² The difference between a celebrity endorsement of a commercial product¹³ and the exploitation of a celebrity's identity for commercial benefit¹⁴ is crucial. The celebrity must be protected from pirates of his identity; however, this protection must also be limited because he is not entitled to a monopoly in his identity. Many intellectual property rights have been established as a way of promoting science and fostering creation of ideas.¹⁵ Accordingly, the right of publicity protection must stay true to this intellectual property law foundation, and not hinder creativity. Problems arise when the right of publicity is invoked in forms of expression that can also fall under the First Amendment free speech protection, and thus a proper balance between the two important protections must be determined.

This comment argues that the best way to resolve the ongoing conflict of balancing the First Amendment and right of publicity protections is with a modified fair use defense, that utilizes both the copyright fair use doctrine and the Federal Lanham Act fair use defense in its analysis. Section II provides a background of the right of publicity and its increasing expansion. Section III reviews the balancing tests that are currently applied in the Circuit Courts and points out the problems with the tests. Section IV compares copyright

¹² The right of publicity prohibits the appropriation of “the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for the purposes of trade.” RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995); *see also* CAL. CIV. CODE § 3344 (West) (prohibiting “using another’s name, voice, or likeness, in any manner or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of products, merchandise, goods, or services.”). Generally, the right of publicity protects the “commercial use” of the name, image or likeness. *See* J. Thomas McCarthy, 1 THE RIGHTS OF PUBLICITY AND PRIVACY § 3.2 (West) (describing that “what is required is proof that the defendant intended to obtain a commercial advantage.”).

¹³ *Celebrity Endorsements*, ADWEEK, <http://www.adweek.com/topic/celebrity-endorsements> (last visited Mar. 7, 2017).

¹⁴ Michael Jordan was successful in his claim against the Chicago-based super market chain Dominick’s for using his name and promoting a product without his permission. *Supermarket Chain Pay Michael Jordan*, ESPN (Aug. 22, 2015), http://espn.go.com/nba/story/_/id/13486052/supermarket-chain-pay-michael-jordan-89-million-use-name

¹⁵ U.S. CONST. art. I, 8, cl. 8 (stating that the purpose of Congress is “to promote the progress of science and useful arts”). *See also* *White v. Samsung Elec. Inc.*, 989 F.2d 1512, 1513-16 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc) (emphasizing that “intellectual property rights aren’t free: they’re imposed at the expense of future creators and of the public at large;” and that “creativity is impossible without a rich public domain.”).

law with the right of publicity, and examines the Fair Use Doctrine as used in copyright law. Section V delineates the proposed new Right of Publicity Defense to be used in right of publicity cases. Finally, Section VI analyzes two cases under the new proposed balancing test exemplifying the compelling justification for the new defense.

II. THE BIRTH OF THE RIGHT OF PUBLICITY AS RIGHT OF PRIVACY

The right of publicity originated in the right of privacy, which stems from “the right to be left alone.”¹⁶ In 1890, Samuel Warren and Louis Brandeis published *The Right to Privacy*, which has since been deemed one of the most influential law review articles in history, and planted the seed for the right of publicity.¹⁷ Warren and Brandeis argued that the law already established a need for a right of privacy, and that this privacy included the right to life and the right to enjoy life.¹⁸ Thus, in their influential article, they expanded these rights, and interpreted the right to life and the right to enjoy life as a right to be left alone,¹⁹ better known as a right to privacy. At the time of the seminal article, changes in society had created a need for a privacy right.²⁰ Unauthorized intrusion into one’s private life offered no recourse, and although not every state was quick to adopt the common law right of privacy,²¹ this need for protection and a right to recover from this nonconsensual intrusive disclosure of personal information

¹⁶ Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

¹⁷ Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 203 (1954).

¹⁸ Warren & Brandeis, *supra* note 16, at 193-96.

¹⁹ Michael Schoenberger, *Unnecessary Roughness: Reconciling Hart and Keller with a Fair Use Standard Benefitting the Right of Publicity*, 45 CONN. L. REV. 1875, 1879-80 (2013) (quoting Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 193 (1890)); *see also* *Olmstead v. United States*, 277 U.S. 438, 478 (1928) (Brandeis, J., dissenting) (“[The Founders] sought to protect Americans in their beliefs, their thoughts, their emotions, and their sensations. They conferred, as against the government, the right to be let alone – the most comprehensive of rights and the right most valued by civilized men.”).

²⁰ Warren & Brandeis, *supra* note 16, at 195-96 (emphasizing that the invention of new mechanisms like the instantaneous photo and the methods of the news media created a need for a protection of private lives).

²¹ The New York Court of Appeals originally rejected the adoption of a common law right of privacy. *See Roberson v. Rochester Folding Box Co.*, 64 N.E. 442, 443 (N.Y. 1902), superseded by statute, N.Y. CIV. RIGHTS LAW § 50, § 51 (Consol. 2001 & Supp. 2005).

and pictures led to many states recognizing a common law right of privacy.²²

This right of privacy still made it difficult for celebrities to recover for damage as a result of infringement of their image, since many courts were unsympathetic to their claim, holding that a celebrity's lifestyle diminished her rights to privacy.²³ Consequently, celebrities sought a way to protect themselves against the unauthorized commercial use of their images and likeness.²⁴ The Second Circuit first addressed this concern in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*²⁵ In that case, the court held that a professional baseball player not only had a right of privacy, but also had a right of publicity for the value of his photographs used by a gum manufacturer.²⁶ Judge Jerome Frank, writing for the court, recognized that "[i]n addition to and independent of the right of privacy, a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture."²⁷

Following this case, two influential law review articles expanded and solidified the justification for the right of publicity. First, Melville Nimmer expanded on the Warren-Brandeis privacy essay, and reiterated the inadequacy of available legal protections for celebrities to avoid the unauthorized commercial exploitation of their identities.²⁸ Additionally, Nimmer noted that an individual invests a great deal of time, effort, and skill in order to obtain a publicly desired

²² As a result of the article written by Warren & Brandeis, fifteen states adopted a common law right of privacy: Alabama, Arizona, California, Georgia, Florida, Illinois, Indiana, Kansas, Kentucky, Michigan, Missouri, Montana, North Carolina, Oregon, and Pennsylvania. Nimmer, *supra* note 17, at 203 nn.3-4.

²³ *O'Brien v. Pabst Sales Co.*, 124 F.2d 167, 170 (holding that a professional football player could not claim damages under privacy law for the unauthorized use of his picture in a beer advertisement since he is not a private person); *Paramount Pictures, Inc. v. Leader Press, Inc.*, 24 F. Supp. 1004, 1007-09 (W.D. Okla. 1938) (finding that Paramount celebrities waived their right to privacy and the defendant could sell posters with their names and photographs without their permission), *rev'd on other grounds*, 106 F.2d 229 (10th Cir. 1939); *Pallas v. Crowley Milner & Co.*, 54 N.W.2d at 596-97 (holding that plaintiff model waived her rights of privacy and could not recover because she was a public figure).

²⁴ *See generally* *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* 202 F.2d 866 (2d Cir. 1953).

²⁵ 202 F.2d 866 (2d Cir. 1953).

²⁶ *Id.* at 869.

²⁷ *Id.* at 868.

²⁸ Nimmer, *supra* note 17, at 216.

status,²⁹ and that accordingly, “every person is entitled to the fruits of their labors.”³⁰

Moreover, in 1960 William Prosser expanded on the right of privacy and categorized it into four distinct torts: intrusion to solitude, public disclosure of embarrassing private facts, false light in the public eye, and appropriation of one’s name and likeness for the defendant’s advantage.³¹ Prosser defined his fourth category as a “defendant making use of the name to pirate the plaintiff’s identity for some advantage of his own;”³² this later became known as the right of publicity.³³

Further, in 1977, the Supreme Court, in its only decision addressing the right of publicity, *Zacchini v. Scripps-Howard Broadcasting Co.*,³⁴ acknowledged the right of publicity as a state law cause of action,³⁵ but did not define its scope. As a result, while most states recognize the right of publicity either via case law, statute, or both,³⁶ the scope varies from state to state.³⁷

A. Expanding the Scope of the Right of Publicity and the First Amendment Implications

I. The Scope of the Right of Publicity

The scope of the right of publicity extends far beyond the protection of the mere image of a celebrity. Courts have extended the

²⁹ *Id.*

³⁰ *Id.*

³¹ William Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960).

³² *Id.* at 403.

³³ *Carson v. Here’s Johnny Portable Toilets, Inc.* 698 F.2d 831, 835 (6th Cir. 1983). *See also Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 563 (1977).

³⁴ 433 U.S. 562, 567 (1977).

³⁵ *Id.* at 566.

³⁶ MCCARTHY, *supra* note 12, at § 10:7 (stating that “courts have uniformly held that the right of publicity is a property right.”).

³⁷ *Hart v. Elec. Arts, Inc.* 717 F.3d 141, 152 (3d Cir. 2013) (recognizing that *Zacchini* “is the only supreme court case addressing the First Amendment in a right of publicity context.”). Some states recognize the right of publicity as a property right, acknowledging that an individual’s identity is her own property, which she is free to control as she wants. Moreover, other states recognize the right of publicity more narrowly as a privacy right. MCCARTHY, *supra* note 12, at § 6:3; *see* CAL. CIV. CODE § 3344 (West) (expressly prohibiting “using another’s name, voice, or likeness,” and protecting it as a publicity right; *but see* NEB. REV. STAT. § 20-202 (West) (protecting an unwanted use of a name or likeness as a “privacy” right).

right to objects such as racecars,³⁸ slogans such as “The Greatest,”³⁹ and even catch phrases such as “Here’s Johnny.”⁴⁰ One significant demonstration of a broad interpretation of right of publicity protection was *White v. Samsung Elec. Am., Inc.*⁴¹ In that case, the Ninth Circuit held that the use of a robot in a Samsung commercial dressed similarly to the celebrity television personality, Vanna White, was a violation of White’s right of publicity.⁴² The advertisement contained an image of a robot wearing a wig, gown, and jewelry, which were all used to resemble Vanna White’s attire on the television show.⁴³ In addition to the similarities in physical appearance, the robot was also posed next to a game board which was undeniably recognizable as the Wheel of Fortune game show set, in a way that White was infamously known to do.⁴⁴ The court emphasized that the more popular a celebrity becomes, the easier it is to evoke her identity without resorting to the obvious means such as name, likeness, or voice;⁴⁵ and therefore, the identities of the most popular celebrities are the most attractive for advertisers and should be afforded ample protection.⁴⁶

The need to balance the right of publicity with the First Amendment was evident to Judge Alcaron, who emphasized the need to ensure that protection of the creators of intellectual property should not hinder the freedom of expression guaranteed by the First Amendment.⁴⁷ Additionally, he acknowledged the important role the courts play balancing these competing interests when necessary.⁴⁸

³⁸ *Motschenbacher v. R.J. Reynolds Tobacco*, 498 F.2d 821 (9th Cir. 1974) (holding that the use of a white pinstripe on a red race car in a commercial, without an actual picture of the plaintiff, violated the plaintiff’s right of publicity because these objects were identifying characteristics that implied the plaintiff’s likeness and therefore constituted an unauthorized commercial use of his identity).

³⁹ *Ali v. Playgirl Inc.*, 447 F. Supp. 723, 727 (S.D.N.Y. 1978) (holding that captioning a drawing of a nude boxer in the magazine as “the Greatest” sufficiently identified Ali as the implied character in the picture and therefore invaded his right of publicity).

⁴⁰ *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983) (holding that the use of the phrase “Here’s Johnny” for the portable toilet company was an infringement of Carson’s right of publicity because the phrase was broadly associated with Carson and was part of his identity).

⁴¹ 971 F.2d 1395, 1399 (9th Cir. 1992).

⁴² *Id.*

⁴³ *Id.* at 1396.

⁴⁴ *Id.*

⁴⁵ *Id.* at 1408 (Alcaron, J., dissenting).

⁴⁶ *White*, 971 F.2d at 1408 (Alcaron, J., dissenting).

⁴⁷ *Id.* (Alcaron, J., dissenting).

⁴⁸ *Id.* (Alcaron, J., dissenting).

Moreover, Judge Kozinski in his dissent to the denial of rehearing *White* warned of the risks of overprotecting the right of publicity.⁴⁹ He emphasized that a rich public domain was essential for creativity, and cautioned “overprotection stifles the very creative forces it’s supposed to nurture.”⁵⁰

With such a broad interpretation of the publicity right, it was inevitable that conflicts with other rights would emerge.

2. *First Amendment Protections of Free Speech and Expression*

The First Amendment is the safeguard of freedom of speech and expression in our society.⁵¹ It provides that “Congress shall make no law ... abridging the freedom of speech or of the press.”⁵² Two widely accepted justifications for the First Amendment are: (1) The fostering of a “free marketplace of ideas” essential to a democratic society; and (2) “fulfilling the human need for self-expression.”⁵³ While many celebrities claim exclusive ownership under the right of publicity for the use of their identities,⁵⁴ the defendants in these cases argue that this power to exclude others from appropriating their identities violates the free speech clause of the First Amendment because it limits their means of expression.⁵⁵ To resolve this conflict, courts have invoked a commercial speech doctrine.⁵⁶ Under this doctrine, the First Amendment affords greater protection to noncommercial speech because it serves as an essential service to the

⁴⁹ *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1513 (9th Cir. 1993).

⁵⁰ *Id.* (emphasizing that “creativity is impossible without a rich public domain” because each creator builds on the works of those before him).

⁵¹ U.S. CONST. amend. I.

⁵² *Id.*

⁵³ Roberta Rosenthal Kwall, *The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis*, 70 *IND. L.J.* 47, 66 (1994).

⁵⁴ See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 564 (1977) (arguing that defendant appropriated his property right in his performance); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1396-97 (9th Cir. 1992) (alleging that Samsung used plaintiff’s image in violation of plaintiff’s property right to her image).

⁵⁵ See *id.* at 1397 (arguing that Samsung’s use of the robot was protected by the freedom of expression); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 396 (2001) (arguing that plaintiff’s right of publicity claim violated defendant’s right to free speech and expression that is protected under the First Amendment).

⁵⁶ MCCARTHY, *supra* note 12, at § 8:13.

public.⁵⁷ Courts have relied on the line between commercial and noncommercial speech in defining the common law right of publicity, and have denied plaintiff's right of publicity claims if the use is noncommercial speech,⁵⁸ and granted protection when it has constituted commercial speech.⁵⁹ The need for the balance of these two important rights is clear;⁶⁰ however, courts are still struggling to reach a consensus on the precise way to balance these interests fairly.⁶¹

III. BALANCING THE PROTECTIONS: THE RIGHT OF PUBLICITY BALANCING TESTS

A. The Rogers' Test

The first test utilized to find a balance between the right of publicity and the First Amendment is the Rogers' test, which gained its name from the case in which it originated, *Rogers v. Grimaldi*.⁶² In that case, the Second Circuit was faced with a challenge brought by Ginger Rogers, an Academy Award winning actress, famous for her appearance in a series of motion pictures with her co-star Fred

⁵⁷ Noncommercial speech such as news is differentiated from commercial speech because it provides valuable information to the public and contributes to the marketplace of ideas for the public to enjoy. MCCARTHY, *supra* note 12, at § 8:14-8:15.

⁵⁸ *G. D. v. Kenny*, 15 A.2d 300, 321 (N.J. 2011) (holding that the use of a political aide's criminal history in a campaign flyer, created by public relations at the request of a political opponent did not satisfy the commercial element of misappropriation).

⁵⁹ *White*, 971 F.2d at 1398-99 (holding that because defendant's misappropriation was used in an advertisement, the use was implicating commercial interests and therefore constituted a violation of the right of publicity); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983) (finding that the use of Carson's name in a commercial product constituted infringement on his right of publicity by the defendant).

⁶⁰ *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 574-75 (1977) (emphasizing the importance of finding the balance between the two rights and reasoning that Zacchini's economic interest in his performance clearly outweighed the news station's First Amendment defense because it had taken the entire act to unjustly enrich the station); *see C.B.C. Distrib. & Mktg. Inc. v. Major League Baseball Advanced Media L.P.*, 505 F.3d 818, 823 (8th Cir. 2007) (analyzing *Zacchini* as a direction by the Supreme Court that state law rights of publicity must be balanced against first amendment considerations).

⁶¹ The Third and Ninth Circuits apply the transformative use test, while the Sixth Circuit has applied the Rogers' test and Missouri Courts have applied the predominant use test. *See Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 166 (3d Cir. 2013); *Keller v. Elec. Arts Inc.*, 724 F.3d 1268, 1271 (9th Cir. 2013); *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003); *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003).

⁶² 875 F.2d 994 (2d Cir. 1989).

Astaire.⁶³ Rogers brought the action under the Lanham Act⁶⁴ against the defendant company producers and directors of the movie entitled “Ginger and Fred” for the use of her name claiming that it was false endorsement. She also claimed the company producers and directors violated her common law right of publicity and defamed her and violated her common law right of privacy by depicting her in a false light.⁶⁵ The film was about two fictional Italian cabaret performers who became known as Ginger and Fred in Italy, but otherwise the names had very little to do with either Ginger Rogers or Fred Astaire.⁶⁶ The defendants contended that the First Amendment right of free expression protected the screenplay.⁶⁷

The Second Circuit first formulated a test for Lanham Act liability claims, mandating that the Lanham Act should not be invoked unless a title has no relevance to the underlying work, or if somewhat relevant, is misleading.⁶⁸ The court reasoned that protecting a title that lacks artistic bearing does not advance the interests of the First Amendment free expression clause.⁶⁹ Additionally, it emphasized that even if there is a slight relevance, if the work is considered seriously misleading the Lanham Act should be invoked.⁷⁰ Therefore, under this test, if a title is found to have at least some artistic relevance and is not considered seriously misleading, it will not be a violation.⁷¹

⁶³ *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1989). Ginger Rogers and Fred Astaire are a famous film duo known predominantly by their first names, Ginger and Fred. *Id.*

⁶⁴ 15 U.S.C. § 1125(a) (liability for “any person who shall affix, apply, annex, or use in connection with any goods or services ... a false designation of origin, or any false description or representation ... and shall cause such goods or services to enter into commerce”). Congress created the Lanham Act in 1946 as a way to register and protect trademarks. In re Tam, 808 F.3d 1321, 1328 (Fed. Cir. 2015).

⁶⁵ *Rogers*, 875 F.2d, at 996-97. The false light defamation claim is not relevant for purposes of this comment.

⁶⁶ *Id.*

⁶⁷ *Id.* at 997

⁶⁸ *Id.* at 999 (when there are “misleading titles using a celebrity’s name, that balance will normally not support application of the [Lanham] Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or content of the work.”). *Id.* This test has become known as a “relevance test.” *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 788 (D.N.J. 2011).

⁶⁹ *Rogers*, 875 F.2d at 999.

⁷⁰ *Id.*

⁷¹ *Id.* at 1000.

In addition to the Lanham Act test,⁷² the court formulated a two part right of publicity test in order to balance the plaintiff's rights with the defendant's freedom of expression.⁷³ Under this test, the right of publicity bars the use of a celebrity's name in a title when: (1) the use is "wholly unrelated" to the movie; or (2) the use is "simply a disguised commercial advertisement for the sale of goods or services."⁷⁴

The Second Circuit held that the film title "Ginger and Fred" was clearly related to the film, since the main characters were named Ginger and Fred.⁷⁵ Additionally, the court reasoned that the movie title was not a disguised commercial advertisement employed to enhance sales because it was actually a reflection on the film-maker's artistic expression.⁷⁶ Therefore, the court held that Rogers' right of publicity was not violated.⁷⁷ Thus, the first important test for balancing the right of publicity protection with First Amendment freedoms was born.

There are two main flaws presented by the Rogers' test. First, the Rogers' right of publicity test mirrors the Lanham Act test, which is problematic because, unlike the Lanham Act, the right of publicity does not require a showing that consumers are likely to be confused.⁷⁸ Thus, the scope of the right of publicity is more expansive than the Lanham Act.⁷⁹ Second, the Rogers' test has typically been applied in cases involving the titles of work,⁸⁰ and potentially unfit for cases that involve broader right of publicity claims.⁸¹

⁷² The Lanham Act test, although not explicitly a right of publicity test, is important for analysis in this comment because some courts have described the Lanham Act as the federal equivalent of a state right of publicity. *See Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47, 50 (2006).

⁷³ *Rogers*, 875 F.2d at 1002.

⁷⁴ *Id.* at 1004.

⁷⁵ *Id.* at 1001. The title refers directly to the film's main characters who are known to the audience by the names "Ginger and Fred." *Id.*

⁷⁶ *Id.* (referencing an affidavit from the filmmaker who explained he purposely used the names as a way to satirize the banality of contemporary television).

⁷⁷ *Rogers*, 875 F.2d at 1005.

⁷⁸ *Id.* at 1004; 15 U.S.C. § 1125(a) ("any person who ... uses in commerce any word, term, name, symbol or device ... which is likely to cause confusion ... shall be liable for such act"). *See also Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 158 (3d Cir. 2013) (suggesting the weakness of applying the Rogers' trademark-based test to right of publicity actions without accounting for the difference).

⁷⁹ *Rogers*, 875 F.2d at 1004.

⁸⁰ *See, e.g., Rogers*, 875 F.2d at 1004 (applying the test to a movie title); *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003) (applying the test to a song title).

⁸¹ *Hart*, 717 F.3d at 157 ("We are concerned that this test is a blunt instrument, unfit for widespread application in cases that require a carefully calibrated balancing of two fundamental protections: the right of free expression and the right to control, manage, and

B. The Transformative Use Test

The transformative use test is derived from the first factor of the copyright fair use doctrine.⁸² The California Supreme Court adopted this test in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*⁸³ In that case, Comedy III was the owner of all rights to the former comedy act known as The Three Stooges, and Saderup was an artist recognized for his charcoal drawings of celebrities.⁸⁴ Saderup converted charcoal drawings he had created of The Three Stooges to lithographic prints, placed them on t-shirts, and sold the shirts for profit.⁸⁵ Comedy III claimed that the use of the image of The Three Stooges violated the Three Stooges' right of publicity; however, Saderup contended that his First Amendment rights of free speech and expression would be violated if he were prohibited from creating and selling the t-shirts.⁸⁶

The court applied the transformative use test,⁸⁷ and emphasized that the main inquiry is “whether a product containing a celebrity likeness is so transformed that it has become the defendant’s own expression rather the celebrity’s likeness.”⁸⁸ Moreover, the court recommended that in close cases, when determining whether a use is sufficiently transformative, the court should look to the root of the

profit from one’s own identity.”); *see also* *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3d Cir. 2008) (recognizing that not many courts extended the Rogers’ test beyond a title of a work); *see also* *Keller v. Elec. Arts Inc.*, 724 F.3d 1268, 1281-82 (9th Cir. 2013) (acknowledging that even the 6th Circuit, which originally adopted the Rogers’ test, later used the transformative use test).

⁸² The court derived the test from the first factor for the copyright fair use doctrine recognizing that the factor was “particularly pertinent to the task of reconciling the rights of free expression and publicity.” *Comedy III Prodc., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 404 (2001). In copyright, the transformative use test focuses on “whether the new work merely supersedes the objects of the original creation, ... or instead adds something new, with a further purpose or character, altering the first with new expression, meaning, or message.” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

⁸³ 25 Cal. 4th 387 (2001).

⁸⁴ *Id.* at 393.

⁸⁵ *Id.*

⁸⁶ *Id.*

⁸⁷ The transformative use test, similar to the transformative use test in copyright law, focuses on whether and to what extent the new work has added something more to the work or created a new purpose for the work. *Campbell*, 510 U.S. at 579.

⁸⁸ *Comedy III*, 25 Cal. 4th at 406. The court also phrased the test as, “whether the celebrity likeness is one of the raw materials from which an original work is synthesized, or whether the depiction or imitation is the very sum and substance of the work in question.” *Id.*

economic value of the work.⁸⁹ If the value of the work comes from a source other than the depicted celebrity, such as the artistic ability of the creator, then a right of publicity would generally not be implicated.⁹⁰ Using this test, the court held that Saderup's realistic depictions of The Three Stooges were not transformative and therefore not entitled to First Amendment protections.⁹¹

The transformative use test has been subject to criticism since it was adopted.⁹² One leading commentator on the right of publicity described the test as vague and unhelpful.⁹³ Additionally, as another legal scholar emphasized, the test does not provide objective guidelines, and as a result encourages judges to take the role of art critics, which may cause a subjective determination based on the fame of the artist.⁹⁴ Moreover, even the *Comedy III* court itself recognized that the distinction between protected and unprotected expression, under the transformative use test, is very "subtle."⁹⁵ Thus, the transformative use test puts substantial weight on the expressiveness of the creation, and does not account for the potential commercial exploitation of a celebrity in a work.⁹⁶ Although a creation may be very expressive, the creator is still exploiting a celebrity's identity in his artwork without permission, which should also be considered when balancing the right of publicity with the freedom of expression.

C. Predominant Use Test

The third test is the predominant use test. The Missouri Supreme Court rejected both the Rogers' test and the transformative

⁸⁹ *Id.* at 407.

⁹⁰ *Id.* (reasoning that when the value of the work comes from a source other than the fame of the celebrity, the work is presumed to have sufficient transformative elements to warrant a First Amendment defense).

⁹¹ *Id.* at 409 (holding that the literal depictions of The Three Stooges substantially exploited their fame, and that the economic value of his work derived from the fame of the celebrities).

⁹² 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, 493 (2003) (noting that the transformative use test can be problematic).

⁹³ MCCARTHY, *supra* note 12, at § 8:71-§ 8:72 (emphasizing that "difficulty of application and incertitude of result are the hallmarks of the court's transformative test.").

⁹⁴ David Tan, *Political Recording of the Contemporary Celebrity and the First Amendment*, 2 HARV. J. SPORTS & ENT. L. 1, 25-26 (2011).

⁹⁵ *Comedy III*, 25 Cal. 4th at 811.

⁹⁶ *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003). Under the transformative use test, a work that is created for the sole purpose of commercially exploiting a celebrity's identity is not actionable if it is found sufficiently transformed in expression. *Id.*

use test, and adopted a “more balanced predominant use test.”⁹⁷ In *Doe*. TCI Cablevision, Anthony “Tony” Twist, a former National Hockey League player, sued the defendants for alleged use of his identity in a comic book series.⁹⁸ The series contained a villain named “Tony Twist Twistelli,” who was characterized as a tough guy, similar to the plaintiff.⁹⁹

In its holding, the court adopted the predominant use test, which stated that if a product being sold “predominantly exploits the commercial value of an individual’s identity, that product should be held to violate the right of publicity.”¹⁰⁰ Conversely, if the purpose of the product is predominantly to make an expressive comment or statement, it should be allotted greater protection.¹⁰¹ In applying this test, the court found that the use of the plaintiff’s identity was predominantly to boost product sales,¹⁰² and not to create an artistic expression, and therefore “free speech must give way to the right of publicity.”¹⁰³

The problem with the predominant use test is that, while trying to include actions that would otherwise be dismissed under the Rogers’ or transformative use tests,¹⁰⁴ it does not provide guidance for uses that are simultaneously commercial and expressive.¹⁰⁵ This is problematic because although speech that is deemed to be fully expressional speech is granted greater protection under the First Amendment freedom of

⁹⁷ *Id.*

⁹⁸ *Id.* at 365.

⁹⁹ *Id.* at 366 (recognizing that the fictional and real Tony are only similar in nickname and characteristic, and did not have physical resemblance).

¹⁰⁰ *Doe*, 110 S.W.3d at 374 (emphasizing that even if the product contains some expressive content, and might otherwise qualify as speech, it should not be protected by the First Amendment when the predominant purpose is to exploit the commercial value of the celebrity).

¹⁰¹ *Id.* This differs from the transformative use test which focuses on the expressive nature of the work itself; however, the predominant use test determines the prevailing purpose intended with the exploitation of the celebrity’s identity, not the extent it has been transformed.

¹⁰² *Id.* (stating that “the metaphorical reference to Twist, though a literary device, has very little value compared to its commercial value.”).

¹⁰³ *Id.*

¹⁰⁴ *Id.* (cautioning that the tests preclude actions whenever a use is expressive, regardless of the commercial exploitation).

¹⁰⁵ The first step in the predominant use test is to determine if the predominant purpose of the work is to exploit commercial value of the celebrity. If the court finds that this is in fact the predominant purpose of the work, according to *Doe*, 110 S.W.3d at 374, it should not be afforded protection under the First Amendment. Pursuant to this analysis, the court will never even consider the expressive nature of the work.

expression, not all speech is purely expressional.¹⁰⁶ Many times a work or expression will fall somewhere between the spectrum of commercial and expressive and therefore the use must be balanced properly with competing rights.¹⁰⁷ Additionally the predominant use test is vulnerable to the subjectivity of the judges.¹⁰⁸ It requires judges to act as art critics and determine the level of the expressiveness that a particular work has.¹⁰⁹ It is not proper for courts to discern the artistic elements of a work.¹¹⁰

The transformative use test is currently the test used in a majority of circuits.¹¹¹ Thus, this test has been deemed to be the least problematic of the three, even in light of the aforementioned problems.¹¹²

IV. COPYRIGHT LAW AND THE FAIR USE DOCTRINE

A. Copyright Law

The United States Constitution grants Congress the power to enact the copyright law for the purpose of promoting science and fostering the creation of ideas.¹¹³ Congress, pursuant to this power, enacted the Copyright Act of 1976, and granted exclusive rights to original works of authorship.¹¹⁴ The purpose of the Copyright Act is

¹⁰⁶ Michael Jordan v. Jewel Food Stores, Inc. & Super Valu, Inc., WL 12-1992, 3 (2014). (Appeal from the United States District Court for the Northern District of Illinois, Eastern Division) (recognizing that expressional speech grants more protection than commercial speech, but there can be speech which is a mix of both).

¹⁰⁷ *Id.*

¹⁰⁸ Hart v. Elec. Arts, Inc., 717 F.3d 141, 154 (3d Cir. 2013) (stating that “the predominant use test is subjective at best, arbitrary at worst”).

¹⁰⁹ *Id.* (cautioning that a judge cannot act as both an impartial jurist and a discerning art critic).

¹¹⁰ *Id.* (recognizing that it is improper for “courts to analyze select elements of a work to determine how much they contribute to the entire work’s expressiveness.”).

¹¹¹ The Third, Sixth, and Ninth Circuits use the transformative use test. *See Hart*, 717 F.3d at 163; *ETW Corp. v. Jireh Publishing Company*, 332 F.3d 915 (6th Cir. 2003); *Keller v. Elec. Arts Inc.*, 724 F.3d 1268, 1276 (9th Cir. 2013).

¹¹² *See supra* notes 92-96.

¹¹³ U.S. CONST. art. I, 8, cl. 8 (“to promote the Progress of Science and useful Arts”).

¹¹⁴ 17 U.S.C. § 102(a) (2016) (“Copyright protection ... subsists in original works of authorship fixed in any tangible medium of expression); *id.* at § 106 (“The owner of a copyright under this title has exclusive rights.”). The exclusive rights enable a copyright holder to have the ability to reproduce and distribute copies of their works, prepare derivatives based on the original, and to perform or display or transmit the work publicly. *Id.*

to promote creation and distribute the creative works to the public.¹¹⁵ The exclusive rights enhance the goal of the Copyright Act by providing authors with protection for their creativity and investment, and with an incentive to create more works by guaranteeing availability to the public.¹¹⁶ However, these exclusive rights can also hinder the goals of the Copyright Act by creating a monopoly over the creations, thus preventing access to preexisting works.¹¹⁷ Authors and creators depend on the works of others in order to create their own individualized works.¹¹⁸ Thus, there is a strong desire to balance the tension between protecting exclusive rights and the public's need to access preexisting works.¹¹⁹ The framers of the Constitution recognized that while providing authors with control of their creations provided incentive to continue creating, they also needed to ensure that society could benefit from the availability of these creations, and therefore they mandated that the copyright protection be "for limited times."¹²⁰ Accordingly, acting on this constitutional command, Congress placed limitations on the exclusive rights, including a fair use limitation.¹²¹

¹¹⁵ *Stewart v. Abend*, 495 U.S. 207, 228 (1990) (stating that the goal of the Copyright Act is to disseminate creative works to the public).

¹¹⁶ Tina Ham, *The Right of Publicity: Finding a Balance in the Fair Use Doctrine – Hoffman v. Capital Cities/ABC, Inc.*, 36 U.C. DAVIS L. REV. 543, 561 (2003) referencing CRAIG JOYCE ET AL., COPYRIGHT LAW 13, 333 (5th ed. 2001) ("As reward for [author's] contribution to the storehouse of human knowledge, she receives ownership of a copyright in the work.").

¹¹⁷ Randall T.E. Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781, 813 (1988).

¹¹⁸ *Emerson v. Davies*, 8 F. Cas. 615, 619 (No. 4,436) (C.C.D. Mass. 1845) ("in truth, in literature, in science and in art, there are, and can be, few, if any, things, which, in an abstract sense, are strictly new and original throughout."). For example, 2 Live Crew, a rap group, used a preexisting country song to create a parodied rap song. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

¹¹⁹ *Authors Guild, Inc. v. Google Inc.*, 804 F.3d 202, 212 (2d Cir. 2015) (emphasizing that the overall objectives of copyright law are to "expand public knowledge and understanding" by providing an "incentive to create informative, intellectually enriching works for public consumption.").

¹²⁰ U.S. CONST. art. 1, § 8, cl. 8.

¹²¹ 17 U.S.C. § 107 (Supp. 2001) ("Limitation on exclusive rights: ... the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes of criticism, comment, news, reporting, teaching, scholarship, or research is not an infringement of copyright."). Fair Use Doctrine is also accepted in common law precedents. See generally *Campbell*, 510 U.S. at 569; *Stewart*

B. Comparison of Copyright Law and The Right of Publicity

Copyright law and the right of publicity share some similar purposes.¹²² While copyright law grants exclusive rights to authors of original creations, the right of publicity grants a celebrity the exclusive right to his identity.¹²³ Both copyright law and the right of publicity provide incentives for creativity while benefitting public welfare.¹²⁴ Additionally, both copyright law and the right of publicity ensure that the “creators” will be able to reap the rewards from their endeavors.¹²⁵

While copyright law and the right of publicity naturally have undeniable similarities,¹²⁶ their differences cannot be ignored when altering the fair use doctrine of copyright protection to fit the right of

v. Abend, 495 U.S. 207 (1990); Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539 (1985).

¹²² See *infra* notes 123-25.

¹²³ 17 U.S.C. § 106 (granting copyright owners the exclusive rights to reproduce, prepare derivatives, distribute copies, and to perform, display, or transmit publicly). Restatement (Third) of Unfair Competition § 46 (1995) (granting an exclusive right to celebrities of their identities by prohibiting the appropriation of the commercial value of a person’s identity). See also Coyne, *supra* note 117, at 814 (“If copyright grants exclusive rights in creative works, the right of publicity grants exclusive rights in personal attributes.”).

¹²⁴ *Stewart*, 495 U.S. at 228 (stating that the goal of the Copyright Act is to disseminate creative works to the public); *Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663, 678 (7th Cir. 1986) (“The reason that state law protects individual pecuniary interests is to provide an incentive to performers to invest the time and resources required to develop such performances.”); *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576 (1977) (“Ohio’s decision to protect petitioner’s right of publicity here rests on more than a desire to compensate the performer for the time and effort invested in his act; the protection provides an economic incentive for him to make an investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyrights laws long enforced by this court.”).

¹²⁵ *Zacchini*, 433 U.S. at 576. The Court in *Zacchini* recognized the importance of the ability of a performer to capitalize from the very activity that made him famous in the first place, and emphasized that this was the very essence of the right of publicity protection. *Id.* See also *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992) (Alcaron, J., dissenting) (emphasizing the need to protect and reward the work and investment of those who create intellectual property).

¹²⁶ See *supra* notes 123-25.

publicity policies. The most obvious is that right of publicity protects the identity of a person, while copyright protects works that have been fixed in tangible form. While the right of publicity can protect a sound, such as a celebrity voice¹²⁷ or a nickname,¹²⁸ copyright protection is only afforded to an original expression of an idea in tangible form, but not to the idea itself.¹²⁹ Courts have expressed wariness in applying a wholesale incorporation of the copyright fair use doctrine to right of publicity law without compensating for the differences.¹³⁰

C. Copyright Fair Use Doctrine

The Fair Use Doctrine acts as a balance between the interests of individual authors and the interests of the public by limiting the potential of copyright monopolies.¹³¹ The doctrine allows for the fair use of copyrighted works “to fulfill copyright’s purpose To promote the Progress of Science and useful Arts,”¹³² and, to advance copyright’s goal to provide protection to authors and inventors and simultaneously permit others to use protected works to advance the progress of arts and sciences.¹³³ As noted by Justice Story, “every book in literature, science, and art, borrows, and must borrow, and use much which was well known and used before.”¹³⁴ The Fair Use Doctrine allows for this evolution of creation in literature, science, and art in a way that still provides protection to original creators.

¹²⁷ *Kirby*, *infra* notes 221-23.

¹²⁸ *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983) (granting relief to Carson for the unauthorized use of the phrase “Here’s Johnny”).

¹²⁹ 17 U.S.C. § 102 (“Copyright protection subsists ... in original works of authorship fixed in any tangible medium of expression”).

¹³⁰ *Comedy III Prodc., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 404 (Cal. 2001) (expressing the belief that some copyright fair use factors are designed to apply to the partial copying of works and will not be helpful in “determining whether the depiction of a celebrity is protected by the First Amendment.”).

¹³¹ *Stewart v. Abend*, 495 U.S. 207, 228 (1990) (“The Copyright Act ... creates a balance between the artist’s right to control the work during the term of the copyright protection and the public’s need for access to creative works.”).

¹³² *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994); *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985); *see also* U.S. CONST. art. 1, § 8, cl. 8.

¹³³ *Authors Guild, Inc. v. Google Inc.*, 804 F.3d 202, 212 (2d Cir. 2015) (recognizing that while authors are important intended beneficiaries of copyright, the public is also an important beneficiary).

¹³⁴ *Emerson v. Davies*, 8 F. Cas. 615, 619 (No. 4,436) (C.C.D. Mass. 1845)).

The Fair Use Doctrine is an affirmative defense to copyright infringement actions.¹³⁵ It “provides [and requires] courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.”¹³⁶ The doctrine requires a case-by-case analysis,¹³⁷ and calls for all four factors of the doctrine to be explored and weighed together in light of the purposes of copyright.¹³⁸

The first factor in the fair use analysis is “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes.”¹³⁹ The statute provides examples that guide the court in making a determination under this factor.¹⁴⁰ Courts look to see whether the work merely “supersedes” or “supplants” the original creation,¹⁴¹ or if the work is “transformative.”¹⁴² If a court finds that the use is transformative, then this factor will weigh in favor of the defense.¹⁴³

The transformative use determination is the most important part of the court’s analysis of the first factor;¹⁴⁴ however, finding transformative use is not absolutely necessary.¹⁴⁵ Courts also consider the commerciality of the work, deciding whether it serves a commercial use, or some other purpose.¹⁴⁶ In general, a work that is

¹³⁵ *Campbell*, 510 U.S. at 590.

¹³⁶ *Id.* at 577, quoting *Stewart*, 495 U.S. at 236.

¹³⁷ *Campbell*, 510 U.S. at 577; *Harper & Row*, 471 U.S. at 560;

¹³⁸ *Campbell*, 510 U.S. at 577-78 (stating that the four factors enumerated in the statute are non-exclusive and provide only “general guidance;” they are “to be explored and weighed together in light of the purposes of copyright.”).

¹³⁹ 17 U.S.C. § 107(1) (Supp. 2001).

¹⁴⁰ 17 U.S.C. § 107 (Supp. 2001) (“the fair use of a copyrighted work ... for purposes such as criticism, comment, news reporting, teaching, scholarship, or research, is not an infringement of copyright”).

¹⁴¹ *Campbell*, 510 U.S. at 579; accord *Harper & Row*, 471 U.S. at 562.

¹⁴² *Campbell*, 510 U.S. at 579. A work is transformative if it adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message. *Id.*

¹⁴³ See *Authors Guild, Inc. v. Google Inc.*, 804 F.3d 202, 217 (2d Cir. 2015). The court held that Google’s use of copyrighted books was highly transformative because it changed the copyrighted books into comprehensive word indexes, providing scholars with a helpful way to identify books, and adding value to the basic transformative search function. *Id.*

¹⁴⁴ *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 923 (2d Cir. 1994) (stating that “the concept of ‘transformative use’ is central to a proper analysis under the first factor”). See also *Campbell*, 510 U.S. at 579 (stating that the more transformative the new work is the less significant the other factors will be).

¹⁴⁵ *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 455 (1984).

¹⁴⁶ 17 U.S.C. § 107(1) (Supp. 2015).

commercial tends to weigh against a fair use finding;¹⁴⁷ however, a commercial element in the use alone does not conclusively bar fair use.¹⁴⁸

The second factor in the fair use determination is the nature of the copyrighted work.¹⁴⁹ The primary considerations here are whether the work is fiction or non-fiction, or published or non-published.¹⁵⁰ Additionally, this factor recognizes that some works are closer to the intention of copyright protection than others, and tries to ensure that those works will be protected.¹⁵¹ A work that is creative in nature weighs against fair use, while factual works receive less protection.¹⁵²

The third factor in the fair use analysis is the amount and substantiality of the portion used in relation to the copyrighted work as a whole.¹⁵³ The primary inquiry here is whether the quality and the quantity of the copied material are reasonable in relation to the purpose of the copied use.¹⁵⁴ The court considers “the degree to which the work

¹⁴⁷ In *Sony Corp. of America v. Universal City Studios, Inc.*, the Court emphasized that “every commercial use is presumptively ... unfair” 464 U.S. at 451. Courts later clarified that the mere commercial character of a use does not bar a finding of fairness. *Campbell*, 510 U.S. at 584; *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985).

¹⁴⁸ *Campbell*, 510 U.S. at 584 (emphasizing that commercial nature is but one of four important factors in determining fair use); see also *Authors Guild*, 804 F.3d at 219 (recognizing that Google undoubtedly had a profit motivation, but this motivation did not deny a fair use defense).

¹⁴⁹ 17 U.S.C. § 107(2). The second factor is the least helpful factor in determining fair use and is rarely found to be determinative. *Campbell*, 510 U.S. at 586 (stating that the factor is not likely much help in any case when separating the “fair use sheep from the infringing goats”); *Authors Guild*, 804 F.3d at 220 (noting that the second factor rarely plays a significant role in fair use determination); *Cariou v. Prince*, 714 F.3d 694, 709 (2d Cir. 2013) (making the distinction that the factor is particularly useless in actions where the work of art is being used for a transformative purpose).

¹⁵⁰ *Stewart v. Abend*, 495 U.S. 207, 237 (1990) (recognizing that whether a work is published is critical to its nature under factor two because the scope of fair use is narrower with respect to unpublished works).

¹⁵¹ *Campbell*, 510 U.S. at 586. See, e.g., *Stewart*, 495 U.S. at 237-38 (contrasting fictional short stories with factual works); *Harper & Row*, 471 U.S. at 563-64 (contrasting soon-to-be-published memoir with published speech); *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 456 (1984) (contrasting motion pictures with news broadcasts); *Feist Publications Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 348-51 (1985) (contrasting creative works with bare factual compilations).

¹⁵² There is a greater need to disseminate factual works than works of fiction or fantasy, and these factual works are more susceptible to a finding of fair use. *Campbell*, 510 U.S. at 586; *Harper & Row*, 471 U.S. at 563-64; *Stewart*, 495 U.S. at 237-38.

¹⁵³ 17 U.S.C. § 107(3).

¹⁵⁴ *Campbell*, 510 U.S. at 586-87 (suggesting that no more than what is necessary should be taken).

may serve as a market substitute for the original.”¹⁵⁵ Moreover, a majority of courts have held that even when a work has been copied in its entirety, it may still be fair use.¹⁵⁶ For example, a complete copying of a work can be appropriate in instances where there is a transformative purpose.¹⁵⁷ Additionally, when determining whether the copying was qualitatively substantial, the court looks to see whether the heart of the original was used and made into the heart of the new work.¹⁵⁸

The fourth factor is the effect of the use upon the potential market for or value of the copyrighted work.¹⁵⁹ The purpose of this factor is to protect copyright owners against uses that would cause economic harm.¹⁶⁰ Courts look not only at the extent of the market harm to the original, but also to potential derivative works,¹⁶¹ because the licensing of derivatives is an important economic incentive to creation.¹⁶² However, courts must be sure to consider only those derivative markets that the creators would in general develop.¹⁶³ When a work is not transformative and is merely a duplicate of the original, substantial market harm can occur because the work may act as a

¹⁵⁵ *Id.* at 587-88.

¹⁵⁶ *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 449-50 (1984).

¹⁵⁷ *Authors Guild, Inc. v. Google Inc.*, 804 F.3d 202, 221 (2d Cir. 2015) (recognizing that “complete unchanged copying has repeatedly been found justified as fair use when the copying was reasonably appropriate to the copier’s transformative purpose”); *see also Campbell*, 510 U.S. 569 at 587 (holding that a parody’s humor comes from the ability to recognize the original through the imitation, and thus even though the parody is exact copying, it is reasonable to the extent that it was meant to parody the original).

¹⁵⁸ *Id.* (reasoning that “a work composed primarily of an original, particularly its heart, with little added or changed, is more likely to be a merely superseding use” and favors protection for the original); *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 564-68 (1985) (emphasizing that even though the *Nation* had only taken 300 words from President Ford’s memoirs, the significance of the quotations amounted to the heart of the book, the part that was likely to be newsworthy and important in licensing).

¹⁵⁹ 17 U.S.C. § 107(4).

¹⁶⁰ *Campbell*, 510 U.S. at 590.

¹⁶¹ *Harper & Row*, 471 U.S. at 568 (“the inquiry must take account not only of harm to the original but also of harm to the market for derivative works.”).

¹⁶² *Campbell*, 510 U.S. at 592; *see* 17 U.S.C. § 106(2) (copyright owners have exclusive rights “to prepare derivative works”).

¹⁶³ *Campbell*, 510 U.S. at 592 (recognizing that there is no protectable derivative market for criticism because it is unlikely that the creator of a work would license critical reviews of his own product).

market replacement.¹⁶⁴ However, a transformative use that provides a different function from the original favors a finding of fair use.¹⁶⁵

As previously mentioned, copyright law and the right of publicity share similar purposes.¹⁶⁶ Both grant the creators exclusive rights and provide incentives for creativity.¹⁶⁷ Additionally, both areas of law have experienced conflicts with the competing First Amendment freedom of expression interests.¹⁶⁸ Thus, while some courts have expressed wariness of a wholesale adoption of the copyright fair use factors,¹⁶⁹ these above factors, when altered to accommodate right of publicity law, would be critical in balancing the First Amendment with the right of publicity.

V. FACTORS FOR THE PROPOSED FAIR USE – RIGHT OF

¹⁶⁴ *Id.* at 591 (reasoning that a transformative use is less likely to serve as a market substitution).

¹⁶⁵ *Id.* Accordingly, in *Authors Guild*, the court found that Google Books was not likely to harm the market for books because it does not replace the books, it merely scans them. The scan does not replace the physical book, but rather utilizes it and creates an additional beneficial use of the physical book. Additionally, it found that Google Books actually enhances the sale of books because it acts similarly to an in-store book display and provides researchers with a way to identify books for purchase. *Authors Guild, Inc. v. Google Inc.*, 804 F.3d 202, 212 (2d Cir. 2015).

¹⁶⁶ See *supra* notes 123-25.

¹⁶⁷ 17 U.S.C. § 106 (this section grants copyright owners the exclusive rights to reproduce, prepare derivatives, distribute copies, and to perform, display, or transmit publicly). Restatement (Third) of Unfair Competition § 46 (1995) (grants exclusive right to celebrities of their identities by prohibiting the appropriation of the commercial value of a person's identity). See also *Coyne*, *supra* note 117, at 814 (“If copyright grants exclusive rights in creative works, the right of publicity grants exclusive rights in personal attributes.”).

¹⁶⁸ See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 566 (1985) (recognizing that the Copyright Act must be balanced with the First Amendment); *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 574-75 (1977) (emphasizing the importance of balancing the right of publicity and the First Amendment).

¹⁶⁹ *Comedy III Prodc., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 404 (2001) (expressing the belief that some copyright fair use factors are designed to apply to the partial copying of works and will not be helpful in “determining whether the depiction of a celebrity is protected by the First Amendment.”).

PUBLICITY DOCTRINE

A. Adjusting the Factors

The incorporation of copyright fair use factors to right of publicity law has been suggested by scholars in the past.¹⁷⁰ While some believe that this would be beneficial, others do not think that it would provide the best solution to balancing the competing First Amendment and right of publicity rights.¹⁷¹ This comment, however, offers a new solution, and in addition to adjusted fair use factors, proposes a fifth factor, which utilizes the likelihood of confusion test for right of publicity actions coined by the Second Circuit in the Rogers' case.¹⁷² This helps to bridge the gap between the expansive right of publicity protection and the more confined Lanham Act protection,¹⁷³ and incorporates the important considerations of the Lanham Act, which is also frequently asserted in right of publicity actions.¹⁷⁴

1. The Nature of the Use

The prima facie case for a violation of the right of publicity requires a showing of commerciality,¹⁷⁵ and therefore, this factor will not focus on whether the use is of commercial nature, as in the first

¹⁷⁰ See generally Tina Ham, *The Right of Publicity: Finding a Balance in the Fair Use Doctrine – Hoffman v. Capital Cities/ABC, Inc.*, 36 U.C. DAVIS L. REV. 543, 561 (2003); Randall T.E. Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781, 813 (1988); Michael Schoenberger, *Unnecessary Roughness: Reconciling Hart and Keller with a Fair Use Standard Benefitting the Right of Publicity*, 45 CONN. L. REV. 1875, 1879 (2013).

¹⁷¹ MCCARTHY, *supra* note 262, at § 8:38.

¹⁷² See *supra* notes 68-71.

¹⁷³ *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 158 (3d Cir. 2013) (suggesting the weakness of applying the Rogers' trademark-based test to right of publicity actions without accounting for the differences between the two actions).

¹⁷⁴ See, e.g., *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992) (plaintiff brought an action for a violation of her right of publicity and a violation under the Lanham Act); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983) (plaintiff brought the action alleging violation of his right of publicity and the Lanham Act).

¹⁷⁵ MCCARTHY, *supra* note 12, at § 3:2 (stating that the prima facie case for a right of publicity is: 1- the plaintiff "owns an enforceable right in the identity or persona"; 2 – "defendant, without permission, used some aspect of the identity in such a way that plaintiff is identifiable from defendant's use;" and the use is "likely to cause damage to the commercial value of that persona.").

factor of the copyright fair use doctrine, and will instead focus heavily on whether the use is transformative.¹⁷⁶ However, similar to the first factor of the copyright fair use doctrine, creations that are for criticism, comment, news reporting, teaching, scholarship, or research, generally will not constitute misappropriation.¹⁷⁷

Since most misappropriations in the right of publicity area do not fall cleanly into one of those categories, courts must determine the expressiveness of the misappropriations, and determine whether the use was transformative enough to not violate a celebrity's right of publicity.¹⁷⁸ Thus, this factor embraces the transformative use test derived from *Comedy III* and adopted by the Third and Ninth Circuits for state law right of publicity claims.¹⁷⁹ However, because the test is now a factor in an affirmative defense, it will no longer be dispositive as it was in the Third and Ninth Circuit cases.¹⁸⁰ Instead, similar to the first factor of the copyright fair use doctrine,¹⁸¹ there is an emphasis on the degree to which the new expression is transformative.¹⁸² If the use

¹⁷⁶ The first factor in copyright fair use doctrine specifies a determination of whether the use was commercial. 17 U.S.C. 107(1) ("including whether such use is of a commercial nature or is for nonprofit educational purposes"). This factor for the right of publicity fair use doctrine will instead focus on the most important determination under the first factor, which is whether the use was transformative. See *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 923 (2d Cir. 1994) (recognizing that "the concept of 'transformative use' is central to a proper analysis under the first factor"); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (stating that the more transformative the new work is the less significant the other factors will be).

¹⁷⁷ 17 U.S.C. § 107 ("The fair use of a copyrighted work ... for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright"). In *Campbell*, the Court emphasized that the examples are "illustrative and not limitative" and "provide only a general guidance about the sorts of copying that courts and Congress most commonly have found to be fair uses." *Campbell*, 510 U.S. at 577. The same emphasis should be applied in the Right of Publicity Defense; the categories provide only general guidance.

¹⁷⁸ See *Campbell*, 510 U.S. at 577 (recognizing the need for a case-by-case analysis and not a bright-line rule).

¹⁷⁹ *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 153 (3d Cir. 2013) (adopting the transformative use test because it was "flexible – yet uniformly applicable"); *Keller v. Elec. Arts Inc.*, 724 F.3d 1268, 1276 (9th Cir. 2013) (affirming the decision of the district court which utilized the transformative use test).

¹⁸⁰ *Hart*, 717 F.3d at 163; *Keller*, 724 F.3d at 1276.

¹⁸¹ See *supra* note 144.

¹⁸² This is similar to the transformative use concept in the copyright fair use doctrine. Just as in copyright, this test focuses on the degree to which a work is transformative, and finds that "the more transformative the new work, the less will be the significance of other factors." *Campbell*, 510 U.S. at 579.

is highly transformative,¹⁸³ then the factor will weigh towards fair use.¹⁸⁴

Notably, the Seventh Circuit has questioned the importance of the transformative use test under the first factor of a copyright fair use determination.¹⁸⁵ The Seventh Circuit fears that such a strong emphasis on whether a use is transformative might diminish the importance of the statutory factors.¹⁸⁶ Instead, in its copyright fair use analysis the court determines whether a use is complementary to the protected work, which is allowed, or a substitute, which is not permitted.¹⁸⁷ However, the Second Circuit has subsequently criticized the Seventh Circuit's reasoning,¹⁸⁸ and reiterated the importance of the transformative use test in all copyright fair use determinations.¹⁸⁹ Thus, this first factor, despite the criticism of the Seventh Circuit in copyright law,¹⁹⁰ includes an emphasis on the degree to which the new expression is transformative.¹⁹¹

Moreover, this factor incorporates the predominant use test, using the same concept of deterring the commercial exploitation of a celebrity's identity,¹⁹² but making it less harsh for those creators who did not intend to capitalize from the use. Thus, this factor also acknowledges that although an identity may have been utilized in a creation, the creator in this instance is no longer receiving a commercial benefit from the celebrity's identity, which presumably is part of this new work, but is instead profiting from the new creation itself.

¹⁸³ A work is transformative if it adds something new, with a further purpose or different character, altering the first with a new meaning. *Id.*

¹⁸⁴ *Id.*

¹⁸⁵ *Kienitz v. Sconnie Nation LLC*, 766 F.3d 756, 758 (7th Cir. 2014).

¹⁸⁶ *Id.*

¹⁸⁷ *Id.*

¹⁸⁸ *Authors Guild, Inc. v. Google Inc.*, 804 F.3d 202, 216, n.18 (2d Cir. 2015).

¹⁸⁹ *Id.*

¹⁹⁰ *Kienitz*, 766 F.3d at 758.

¹⁹¹ The transformative use test has been recognized as an important test in right of publicity law since its creation in *Comedy III*, and has since been adopted as the dispositive test in the Third and Ninth Circuits. *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 153 (3d Cir. 2013) (adopting the transformative use test because it was "flexible – yet uniformly applicable"); *Keller v. Elec. Arts Inc.*, 724 F.3d 1268, 1276 (9th Cir. 2013) (affirming the decision of the district court which utilized the transformative use test).

¹⁹² *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003), *supra* notes 101-03.

2. Nature of the Publicity Right

This factor is notably different from the factor in the copyright fair use doctrine. In copyright, the factor focuses on whether the work is published/non-published, or fiction/non-fiction.¹⁹³ However, in the right of publicity, this factor focuses on the amount of work a celebrity dedicated to establishing his famed identity. The factor builds on the reasoning in *Zacchini*, in which the Supreme Court recognized that a celebrity should be able to reap the benefits of his own labor.¹⁹⁴ This factor can be considered to mirror the “sweat of the brow” theory,¹⁹⁵ emphasizing that an individual should be able to benefit from the efforts he exercised to establish a famous identity.¹⁹⁶ Accordingly, as one legal scholar noted, “while one person may build a home, and another knit a sweater so also may a third create a valuable personality.”¹⁹⁷ An individual, under this factor, is incentivized to create a celebrity identity through his own efforts, instead of having one thrust upon him. The more effort a celebrity has put into achieving the status of fame, the less this factor will lean towards fair use.¹⁹⁸

Thus, this factor is measured by determining whether the publicity was earned, which encompasses those celebrities who dedicate their time and effort to establish their fame, or whether the publicity was incidental, which includes those whose fame is thrust

¹⁹³ *Stewart v. Abend*, 495 U.S. 207, 237 (1990).

¹⁹⁴ *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576 (1977) (reasoning that because the press broadcasted *Zacchini*’s entire performance, it hindered his ability to earn a living as a performer). The very essence of right of publicity protection is that a performer be able to capitalize from the very activity that made him famous in the first place. *Id.*

¹⁹⁵ Sweat of the brow is the underlying policy of the unjust enrichment justification. It emphasizes that an individual is entitled to the ownership of his own creation. MCCARTHY, *supra* note 12, at § 2:5. The “sweat of the brow” theory has been discredited for copyright protection because it distinctly goes against a “fundamental axiom of copyright law – that no one may copyright facts or ideas.” *Feist Publications Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 352-56 (1985).

¹⁹⁶ *Zacchini*, 433 U.S. at 574 (holding that there is no social purpose served by allowing an individual to get free some aspect of another that would otherwise have market value and would normally induce a profit). *See also* Nimmer, *supra* note 17, at 216 (emphasizing that an individual is “entitled to the fruits of his own labors”).

¹⁹⁷ MCCARTHY, *supra* note 12, at §§ 2.1; 2.6.

¹⁹⁸ Coyne, *supra* note 117 (when a celebrity “persona is entirely of his own creation, his publicity rights deserve more protection”).

upon them by the public and media.¹⁹⁹ As one legal scholar noted, an individual who attains fame “through sheer luck ... public scandal, or ... grossly immoral conduct” should not receive the same publicity protection as those who have earned their fame.²⁰⁰ A celebrity who has earned his fame, in the eyes of the public, has attained a higher quality of fame as opposed to one who has had fame thrust upon them, and thus the quality of the earned celebrity’s identity is greater and should be adequately protected.²⁰¹ Accordingly, the earned/incidental publicity determination accounts for the fact that not all celebrities achieve fame through their own efforts.²⁰²

For example, under this second factor, a celebrity such as Michael Phelps,²⁰³ who has gone through extensive training and hard work to get to where he is today,²⁰⁴ represents a celebrity with earned publicity. In the public eye, Michael Phelps has achieved a high-quality identity as a result of his Olympic achievements.²⁰⁵ On the other hand, Kylie Jenner, who has become famous from her role on the reality TV show that films her family,²⁰⁶ embodies a celebrity falling in the incidental publicity category. While many people recognize Kylie Jenner as a celebrity, and even buy her makeup products within minutes of their release,²⁰⁷ the quality of her identity is less than Michael Phelps’ because of the way it was achieved.

¹⁹⁹ See Schoenberg, *supra* note 19, at 1912 (suggesting that the best way to differentiate between the two publicity rights is to classify them as either active or passive and weigh the factor accordingly).

²⁰⁰ Michael Madow, *Private Ownership of a Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 179 (1993).

²⁰¹ *Id.*

²⁰² *Id.* at 184 (arguing that to believe that a celebrity’s fame is entirely the result of his own labors is the “folklore of celebrity;” when in reality, celebrities owe much of their fame to social factors and other individuals who contributed to creating the value of their identities).

²⁰³ Michael Phelps is an Olympic Swimmer who has won 18 gold medals. *Michael Phelps*, SWIMSWAM, <https://swimswam.com/bio/michael-phelps/#medals> (last visited Mar. 7, 2017).

²⁰⁴ *Michael Phelps*, SWIMSWAM, <https://swimswam.com/bio/michael-phelps/> (last visited Mar. 7, 2017).

²⁰⁵ *Id.*

²⁰⁶ *Kylie Jenner Fires Back at Critics Says She Deserves to Be on List of Influential Teens*, ABC NEWS (Oct. 30, 2015), <http://abcnews.go.com/Entertainment/kylie-jenner-fires-back-critics-deserves-list-influential/story?id=34856680>.

²⁰⁷ *Kylie Jenner’s New Lip Kits Sold Out in Less Than 10 Minutes*, ELLE (Feb. 15, 2016), <http://www.elle.com/beauty/makeup-skin-care/news/a33867/kylie-jenner-new-lip-kits-sell-out-in-10-minutes/>

Notably, Michael Phelps has had his own episodes of public scandal.²⁰⁸ In 2014, Phelps was even suspended from his Olympic training by the USA Swimming team for six months because of his public scandal.²⁰⁹ However, for the purposes of this factor, this public scandal would not reduce the high-quality level of publicity that Phelps has achieved. Phelps's publicity originated from his Olympic achievements,²¹⁰ which as noted above, fall within the earned publicity category.²¹¹ Although a celebrity may encounter some negative publicity throughout his or her career, this factor focuses on the origin of the publicity, and thus, any publicity, be it positive or negative after the celebrity has become famous in the eyes of the public, does not affect this factor.

Both Michael Phelps and Kylie Jenner are celebrities with known identities that would generate commercial value when misappropriated.²¹² However, under this factor, the level of publicity protection is greater when a celebrity dedicates his life to achieve such fame and creates high quality fame.²¹³ In contrast, when the celebrity did not invest as much into achieving fame, the identity represents a lesser quality and the factor will lean more towards fair use.

3. *Substantiality of the Misappropriation*

For this factor, the court evaluates the extent of the misappropriation.²¹⁴ Unlike copyright, the application of this factor

²⁰⁸ In 2014 Michael Phelps was charged with his second Driving Under the Influence offense. After this, he entered a six-week in-patient rehabilitation program. *Michael Phelps suspended by USA Swimming for six months*, CNN (Oct. 7, 2014), <http://edition.cnn.com/2014/10/06/sport/michael-phelps-suspended/>.

²⁰⁹ *Id.*

²¹⁰ *Michael Phelps*, SWIMSWAM, <https://swimswam.com/bio/michael-phelps/> (last visited Mar. 7, 2017).

²¹¹ *See supra* notes 204-05.

²¹² *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992) (emphasizing that the more popular a celebrity becomes, the easier it is to evoke her identity, and the more attractive the celebrity is to advertisers, and as a result the identities of the most popular celebrities should be afforded ample protection from advertisers).

²¹³ *See supra* note 198; *see also* *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, 483 U.S. 522, 540–541 (concluding that a “defendant’s expressive use ... cannot be divorced from the value the plaintiff’s efforts have given to it”).

²¹⁴ Schoenberger, *supra* note 19, at 1913.

emphasizes the quantity of the expression rather than the quality.²¹⁵ The court in *Comedy III* emphasized that courts should not be concerned with the quality of the artistic work at issue,²¹⁶ but instead the question should be “whether the literal and imitative or the expressive elements predominate a work.”²¹⁷ This reasoning has been reiterated by subsequent court decisions, recognizing that judges should not act as art critics.²¹⁸

Moreover, similar to the reasoning of *Comedy III*, that the determination should be whether the product using a celebrity’s identity has been transformed in a way that causes it to be primarily the creator’s own expression,²¹⁹ this factor considers the work in question as a whole when defining the extent of the misappropriation.

The California Appellate Court is at the forefront of this reasoning. Two influential cases regarding right of publicity protection in video games applied this reasoning using the transformative use test, and considered aspects of the games that were not part of the celebrity’s physical identity in their determinations.²²⁰ In both cases, a celebrity’s identity was fashioned into a video game character without their permission.²²¹ To determine if these games should be afforded First Amendment protection, both courts considered the extent of this misappropriation when viewed as a whole in the video games.²²² Neither court focused on the artistic nature or the quality of the character of the video game, but rather they

²¹⁵ See *supra* note 158 (stressing that in the qualitative determination, courts look to see if the “heart of the work” was taken). In the copyright fair use determination, even if a work is copied in its entirety, it may still be afforded fair use protection. *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 449-50 (1984).

²¹⁶ *Comedy III Prodc., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 407 (2001) (noting that even vulgar expressions qualify for First Amendment protection).

²¹⁷ *Id.*

²¹⁸ See *supra* note 94; see also *supra* note 109.

²¹⁹ *Comedy III*, 25 Cal. 4th at 406.

²²⁰ *Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47 (2006); *No Doubt v. Activision, Inc.*, 192 Cal. App. 4th 1018 (2011).

²²¹ *Kirby*, 144 Cal. App. 4th at 51 (explaining that the plaintiff was a famous singer who alleged the defendant video game producer based a character in the game on her identity); *No Doubt*, 192 Cal. App. 4th at 1024 (stating that the plaintiffs were famous musicians alleging the defendant used their identities in the video game, *Band Hero*).

²²² *Kirby*, 144 Cal. App. 4th at 59 (emphasizing that the fictional space setting and role of the character in the game as a space-age reporter in the 21st century was not a misappropriation of the celebrity who was actually a famous singer); *No Doubt*, 192 Cal. App. 4th at 1033 (finding that the video game characters who were portrayed as musicians were exact replicas of the celebrities themselves and therefore was an extensive misappropriation by the defendant).

considered what quantity of each celebrity's identity was misappropriated.²²³

In *Kirby v. Sega of America Inc.*,²²⁴ the court found that the First Amendment protected the video game's use of the celebrity's identity,²²⁵ and that although the video game character was undeniably a spin-off of the famous celebrity singer,²²⁶ the quantity of these similarities was outweighed by the dissimilar attributes.²²⁷ However, in *No Doubt v. Activision Inc.*,²²⁸ the court found that the First Amendment did not protect a video game's use of the celebrities' identities because the characters and the setting in which they were used were all exact replicas of the celebrities.²²⁹ Thus, the extent of the misappropriation was very great.²³⁰

Kirby and *No Doubt* were correct in their reasoning and together provide a basis for the application of this factor. Therefore, under this factor, if the expressive elements of a work overpower the literal or imitative aspects, thereby limiting the extent of the misappropriation, the factor will favor fair use.²³¹ However, if the quantity of the copying of a celebrity's identity outweighs the expressive elements, the factor will weigh against fair use.

4. *The Effect of the Use on the Potential Market*

The fourth factor in this affirmative defense asks whether the misappropriation affects the celebrity's use of her own identity on the potential market or licensing market. This is similar to the fourth factor in the copyright fair use doctrine,²³² which the Supreme Court

²²³ See *supra* note 222.

²²⁴ 144 Cal. App. 4th 47 (2006).

²²⁵ *Kirby*, 144 Cal. App. 4th at 59.

²²⁶ *Id.* at 55-56. (listing the similarities of Kirby and Ulala, including body and eye shape, lip and hair color, clothing, and even catch phrases).

²²⁷ *Id.* at 59.

²²⁸ 192 Cal. App. 4th 1018 (2011).

²²⁹ *No Doubt*, 192 Cal. App. 4th at 1033.

²³⁰ *Id.*

²³¹ This factor utilizes the reasoning of the courts in both *Kirby* and *No Doubt*, which both weigh the extent of the celebrities' identity, including the settings in which a celebrity was found, in their reasoning. See also *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992) (emphasizing that while the robot with blonde hair and white dress alone may not be extensive misappropriation, when coupled with the setting of the Wheel of Fortune game show, it was an obvious and all-embracing misappropriation of the celebrity identity).

²³² 17 U.S.C. § 107(4).

described stating, “a use that has no demonstrable effect upon the publicity market for, or the value of, the copyrighted work need not be prohibited in order to protect the author’s incentive to create.”²³³

The scope for which a celebrity can suffer a commercial injury expands from a simple misappropriation of a celebrity’s reputation,²³⁴ and extends to the appropriation of an entire work that correlates with a celebrity’s identity.²³⁵ According to the Restatement, courts should analyze the market effect “in light of the informational or creative comment of the defendant’s use.”²³⁶ For example, in *Zacchini*, where the defendant news company misappropriated Zacchini’s entire human cannonball performance, the commercial use lacked any creative comment, and the commercial harm therefore was extensive.²³⁷

Additionally, just as a court under the fourth factor in the copyright fair use doctrine looks to derivative markets,²³⁸ under this factor, the court will consider the effect the misappropriation has on licensing markets. An example is when a celebrity’s misappropriated identity is a performance.²³⁹ Pursuant to the example from *Zacchini*,²⁴⁰ not only did the defendant news company infringe on Zacchini’s ability to capitalize on his live performance,²⁴¹ it also caused commercial injury in a licensing market.²⁴² The defendant news company infringed Zacchini’s right to license his performance to other news companies that may have been willing to pay to broadcast his performance at a later date.²⁴³ Instead, these companies could use the

²³³ Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417, 450 (1984).

²³⁴ For example, in *Carson*, the court held that the defendant’s use of the phrase “Here’s Johnny” for his business capitalized on the reputation of Johnny Carson and therefore amounted to an appropriation of his identity. *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983).

²³⁵ In *Zacchini*, the Court found that the news program’s airing of the plaintiff’s entire act hindered the plaintiff’s ability to reap the benefits of his endeavors, and thus was an intrusion on his right of publicity. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 575 (1977).

²³⁶ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. d (1995).

²³⁷ *Zacchini*, 433 U.S. at 575.

²³⁸ See *supra* notes 161-65.

²³⁹ *Zacchini*, 433 U.S. at 575.

²⁴⁰ See *supra* note 237.

²⁴¹ *Zacchini*, 433 U.S. at 575.

²⁴² A licensing market is similar to a derivative, which is a competing substitute for an original work, or identity, in a marketplace that deprives the original owner of significant revenue. *Authors Guild, Inc. v. Google Inc.*, 804 F.3d 202, 223 (2d Cir. 2015). In this example, the misappropriation of Zacchini’s entire performance created a competing substitute that inhibited Zacchini’s ability to raise revenue in the marketplace for his performance.

²⁴³ *Zacchini*, 433 U.S. at 575.

misappropriated version broadcasted by the defendant without ever obtaining Zacchini's permission, thus causing commercial injury in a licensing market.²⁴⁴ Moreover, under this factor, as demonstrated by *Zacchini*, the plaintiff is entitled not only to protection from lost profits from his performance and lost licensing opportunities, but also to recover for the commercial value that his performance provided the news program.²⁴⁵

B. A Fifth Factor

The Lanham Act has been coined the federal equivalent of state law right of publicity.²⁴⁶ For this reason, celebrities often couple their right of publicity violation claim with a claim for a violation under the Lanham Act Section 43(a).²⁴⁷ The premise of a claim under the Lanham Act is to protect against use of a celebrity's identity that is unauthorized and likely to falsely imply celebrity endorsement or support.²⁴⁸ Courts have considered implementing a likelihood of confusion test in right of publicity actions, but have expressed concerns to having it be the sole decisive test.²⁴⁹ While on its own, the likelihood of confusion test could be insufficient to adequately balance the competing right of publicity and First Amendment protections,²⁵⁰ utilizing the test as a factor in an affirmative defense both exploits the advantages of the test while simultaneously diminishing the disadvantages.²⁵¹ Additionally, this factor incorporates the important principle that a defendant should not be permitted to unduly benefit from the confusion caused to consumers by the use of the celebrity's

²⁴⁴ *Id.*

²⁴⁵ *Id.*

²⁴⁶ *Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47, 57 (2006).

²⁴⁷ *See, e.g., White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397 (9th Cir. 1992) (plaintiff brought an action for a violation of her right of publicity and the Lanham Act); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983) (plaintiff brought the action alleging violation of his right of publicity and the Lanham Act).

²⁴⁸ *Kirby*, 144 Cal. App. 4th at 57.

²⁴⁹ *Parks v. LaFace Records*, 329 F.3d 437, 449 (6th Cir. 2003) (noting that the approach "ignores the fact that the artistic work is not simply a commercial product but is also a means of communication."); *Id.* (finding an unmodified likelihood of confusion approach inadequate to account for the full weight of the public's interest in free expression).

²⁵⁰ *Id.*

²⁵¹ *See supra* notes 78-81.

identity in the work.²⁵² It also fosters the dual interest of consumers to not be misled by the creator, and to enjoy the product of the creator's ability to exercise freedom of expression.²⁵³ Moreover, the concerns some courts expressed regarding the application of this test to right of publicity actions²⁵⁴ are effectively eliminated because the likelihood of confusion test is no longer dispositive, and will be weighed with the other four factors.

1. *Likelihood of Confusion*

This factor is taken from the part of the Lanham Act²⁵⁵ which was discussed in the analysis of the Rogers' Lanham Act test.²⁵⁶ As mentioned in Section V. Part B, celebrities often couple their state law right of publicity violation claim with a claim for violation under the federal Lanham Act § 43(a). Grounded on the similarities of the claims under both state and federal law,²⁵⁷ this factor incorporates the important considerations of the Lanham Act test²⁵⁸ and converts them into a separate factor to be used in the Right of Publicity Defense.

This factor considers whether the use of the celebrity's identity "is likely to cause confusion or to cause mistake, or deceive as to the affiliation, connection, or association of such person with, or as to origin, sponsorship, or approval of"²⁵⁹ the work. The question under this factor is whether the use of the celebrity's identity in the work would cause an individual to believe that the celebrity is somehow affiliated with or behind the work.²⁶⁰ The factor effectively eliminates the problem that existed with the Rogers' test²⁶¹ because it incorporates

²⁵² See *supra* notes 78-81.

²⁵³ *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989).

²⁵⁴ *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 158 (3d Cir. 2013) (suggesting the weakness of applying the Rogers' trademark-based test to right of publicity actions without accounting for the difference).

²⁵⁵ 15 U.S.C. § 1125(a).

²⁵⁶ See *supra* notes 68-71.

²⁵⁷ See *supra* notes 247-48.

²⁵⁸ See *supra* notes 68-71.

²⁵⁹ 15 U.S.C. § 1125(a)(1)(a).

²⁶⁰ See *infra* notes 290-95. The question in *Brown* was whether the people who play Madden NFL would believe that Brown was behind or sponsored the game. *Brown v. Elec. Arts, Inc.*, 2009 WL 8763151, *5.

²⁶¹ See *supra* notes 78-81 (The problem with the Rogers' test is that it mirrors the Lanham Act which requires a showing of a likelihood of consumer confusion while the right of publicity requires no such finding). This comment argues that if the defendant in a right of publicity action can prove that the likelihood of consumer confusion is insignificant, then the

the likelihood of confusion requirement into the new Right of Publicity Defense analysis. Finding a likelihood of confusion is no longer considered dispositive and instead will weigh towards right of publicity protection.²⁶²

Although the First Amendment guarantees freedom of expression,²⁶³ no one has a constitutional right to use a celebrity's identity without his permission to draw attention to their creation or help sell a product.²⁶⁴ A work that causes confusion regarding the celebrity's participation or endorsement of a work will receive less protection under the First Amendment.²⁶⁵ Thus, the fifth factor must evaluate the relevance of the celebrity's identity to the artistic value of the work.²⁶⁶ The use of a celebrity's identity in a work that has no artistic relevance whatsoever can implicitly cause a likelihood of confusion as to the endorsement or approval of the work by the celebrity, and therefore cannot be justified as an interest in freedom of expression because the use of the identity provides no artistic value to the work.²⁶⁷ The irrelevant use of a celebrity's identity in a work can lead a consumer to believe the celebrity has something to do with the work, because for what other reason would the celebrity's identity be used if it is neither artistically relevant, nor an endorsement.²⁶⁸ Therefore, if there is no artistic relevance at all, this factor will weigh against fair use because of the confusion that the use of the celebrity's identity in the work will likely cause consumers. Additionally, even

factor should weigh in the creator's favor and lean towards a finding of fair use. Unlike in the Rogers' test, the fact that someone is likely to be confused by a creator's work does not automatically infringe upon a celebrity's right of publicity. Instead, it is a factor to be weighed with the other factors under this test.

²⁶² While the right of publicity does not require a showing of confusion, when claiming this defense, a defendant who can show there is no likelihood of confusion will be afforded greater protection. MCCARTHY, *supra* note 12, at § 2:4.

²⁶³ U.S. CONST. amend. I.

²⁶⁴ MCCARTHY, *supra* note 12, at § 7:3

²⁶⁵ *Id.*

²⁶⁶ Rogers v. Grimaldi, 875 F.2d 994, 998 (2d Cir. 1989).

²⁶⁷ See, e.g., *id.* at 999 (stating that "a misleading title with no artistic relevance cannot be sufficiently justified by a free expression interest.").

²⁶⁸ See *id.* (if the film-maker used the title with no artistic relevance at all, the confusing suggestions as to the source implicitly conveyed would violate the Lanham Act). Even if an artist claims that the use of the celebrity's identity is symbolic, the question of artistic relevance remains. Parks v. LaFace Records, 329 F.3d 437, 454 (6th Cir. 2003) (emphasizing that "crying symbol" does not change the question of artistic relevance and automatically confer authority to use a celebrity's identity).

when there is a finding of artistic relevance, if the work is explicitly misleading or confusing to consumers, the factor will also weigh against a finding of fair use.²⁶⁹ For example, in *Michael Jordan v. Jewel Food Stores, Inc. & Super Valu, Inc.*,²⁷⁰ the court recognized that Jewel Food Store's use of the image of Jordan sneakers, on a page that also contained the store's trademarked logo and slogan, was relevant because it was placed in a commemorative book praising Michael Jordan.²⁷¹ However, the court also found that Jewel Food Store used the image with the specific intent to advertise its store, and recognized that a reader could easily mistake the advertisement as an endorsement by Jordan.²⁷² Therefore, this use violated Jordan's right of publicity,²⁷³ and under this factor would weigh against a finding of fair use.

Furthermore, when the use of a celebrity's identity in a work falls somewhere between these two ends of the spectrum, and is found to have at least some artistic relevance and is not explicitly for the purpose of confusing consumers, the interest in the First Amendment free expression clause will outweigh the right of publicity protection.²⁷⁴ When the use of a celebrity's identity in a work might suggest that the celebrity had some sort of role in its production or endorsement, even if this suggestion is false, as long as the identity is in some way relevant to the artistic value of the work, the factor will weigh towards a finding of fair use.²⁷⁵ Therefore, under this factor, when the use of a celebrity's identity is at least slightly relevant to the artistic value of the work, and the use does not explicitly mislead the consumer as to the content of the work, the factor will lean towards a finding of fair use and not towards right of publicity protection.²⁷⁶ For example, in *Rogers v. Grimaldi*, although the title of the film was the

²⁶⁹ *Rogers*, 875 F.2d at 999. (stating that even where a title has minimal artistic relevance but is explicitly misleading as to the source, a Lanham Act violation can be found).

²⁷⁰ *Jordan v. Jewel Food Stores, Inc. & Super Valu, Inc.*, WL 12-1992, *3 (2014).

²⁷¹ *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 512 (7th Cir. 2014).

²⁷² *Id.*

²⁷³ *Id.*

²⁷⁴ *Rogers*, 875 F.2d at 1000.

²⁷⁵ *Id.* (emphasizing that "the slight risk that such use of a celebrity's name might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting expression"). See, e.g., *Estate of Hemingway v. Random House Inc.*, 23 N.Y.2d 341, 350 (1968) (holding that the estate of Ernest Hemingway had no cause of action for unfair competition based on likelihood of confusion against the author of a biographical memoir entitled "Papa Hemingway.").

²⁷⁶ This factor utilizes the *Rogers*' test, but instead of a dispositive result under the test, it will weigh as a factor in an overall affirmative defense.

exact name of two famous dancers, the court found that because the title was artistically relevant to the characters in the film, and was not explicitly misleading, the title was not a violation of Rogers' right of publicity.²⁷⁷ Thus, under this factor the use of the names in the title of the film would lean towards a finding of fair use. Moreover, this factor mirrors the Rogers' Lanham Act test²⁷⁸ formulated by the Second Circuit. The only difference is that this test is now a factor instead of a dispositive test, and therefore it must be weighed with the other four factors of the Right of Publicity Defense.

The court in *Brown v. Elecs. Arts, Inc.*,²⁷⁹ was influential in evaluating the likelihood of confusion for the use of a celebrity's identity in an artistic work. In that case, James "Jim" Brown, a retired professional football player, brought an action against Electronic Arts, Inc., (EA),²⁸⁰ creator of the "Madden NFL" video game series, alleging the unauthorized use of his identity in the video game.²⁸¹ Brown sued under the Lanham Act,²⁸² similar to the action brought in *Rogers v. Grimaldi*,²⁸³ and EA argued that the First Amendment provided a complete defense to the alleged Lanham Act violation.²⁸⁴

In its analysis, the court applied the Rogers' Lanham Act test to determine whether the use of Brown's identity was protected under the First Amendment,²⁸⁵ and determined that there was no remedy for Brown under the Lanham Act.²⁸⁶ Moreover, most relevant to the analysis of this new factor, the court evaluated whether the use of Brown's identity in the game was misleading to the consumer.²⁸⁷ First, the court recognized that a Rogers' Lanham Act claim will only

²⁷⁷ *Rogers*, 875 F.2d at 1001. The title refers directly to the film's main characters who are known to the audience by the names "Ginger and Fred." *Id.*

²⁷⁸ *See supra* notes 68-71.

²⁷⁹ 2009 WL 8763151.

²⁸⁰ "EA develops and publishes [various] video games including Madden NFL." *Id.* at 1.

²⁸¹ *Id.* Each of the games in the series contained up to 170 teams and around 1,500 players. The virtual players in the games reflected the real-life players in the NFL, and wore their names and numbers while competing in the virtual games. *Id.*

²⁸² 15 U.S.C. § 1125(a) (liability for "any person who on or in connection with any goods or services ... uses in commerce any word ... or any false designation of origin, or any false misleading description of fact.").

²⁸³ *See supra* notes 63-65.

²⁸⁴ *Brown*, 2009 WL 8763151 at *2.

²⁸⁵ *Id.* at *3.

²⁸⁶ *Id.* at *5 (holding that where there was no consumer confusion, and because of important First Amendment interests, there was no remedy under the Lanham Act).

²⁸⁷ *Id.*

succeed if “the public interest in avoiding consumer confusion outweighs the public interest in free expression.”²⁸⁸ Applying the two-pronged Rogers’ Lanham Act test²⁸⁹ the court recognized that the first step is finding that the use of the celebrity’s identity in a work is relevant to the work itself.²⁹⁰ The threshold of relevance is particularly low, and must “merely be above zero.”²⁹¹ Under this first prong, the court determined that the use of Brown’s image in Madden NFL was not irrelevant.²⁹² Madden NFL is a video game about NFL Football, and Brown is a legendary NFL football player; therefore, the use is undoubtedly relevant.²⁹³

The second step is to determine whether the use of the celebrity’s identity “explicitly misleads consumers as to the source or content of the work.”²⁹⁴ Under this second prong, the court determined that consumers were not likely to believe that Brown was “somehow behind the game or sponsors the product.”²⁹⁵ It reasoned that because Brown’s identity was only utilized in one of the thousands of virtual players in the game,²⁹⁶ and because to conclude that this one player signified Brown’s endorsement would require a “leap of logic,”²⁹⁷ there was not a likelihood of consumer confusion. The court emphasized that the “mere presence”²⁹⁸ in an artistic work does not automatically constitute a finding of a likelihood of confusion.²⁹⁹ Thus, the court held that even when looking at the facts in a light most

²⁸⁸ *Brown*, 2009 WL 8763151 at *3.

²⁸⁹ *See supra* notes 68-71.

²⁹⁰ *Brown*, 2009 WL 8763151 at *3.

²⁹¹ *Id.*

²⁹² *Id.* at *4.

²⁹³ *Id.*

²⁹⁴ *Id.* at *5.

²⁹⁵ *Brown*, 2009 WL 8763151 at *5.

²⁹⁶ *Id.*

²⁹⁷ *Id.* (stating that “it would require a leap of logic to conclude that the player’s presence in the games equates to Brown’s endorsement of the games.”).

²⁹⁸ *Id.* (emphasizing that the player’s mere presence in Madden NFL does not constitute endorsement); *see also* *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (stressing that mere inclusion of a celebrity identity in a work does not satisfy the likelihood of confusion prong of the test).

²⁹⁹ *Brown*, 2009 WL 8763151 at *5 (stating that “EA’s use of Brown’s identity could not constitute an explicit attempt to signify that Brown endorsed the games.”).

favorable to Brown, First Amendment freedom of expression protected EA's use of Brown's identity in the video game.³⁰⁰

This Brown likelihood of confusion analysis³⁰¹ provides a compelling example of the steps that must occur during the examination of a claim under this fifth factor. The inquiry to the likelihood of confusion must be two-fold.³⁰² First, the court must determine whether the use of the celebrity's identity is relevant to the work at issue.³⁰³ Second, the court must determine whether the use of the celebrity's identity "explicitly misleads consumers as to the source of the work,"³⁰⁴ to the extent that the public interest in avoiding this confusion outweighs the public interest in free expression.³⁰⁵ Thus, if the court finds that the likelihood of consumer confusion outweighs the public interest in freedom of expression, this factor will weigh towards right of publicity protection.

Therefore, in accordance with the court's analysis in *Brown*, which determined that there was not a likelihood of confusion,³⁰⁶ under the fifth factor in the new Right of Publicity Defense, the use of Brown's identity in the work would lean towards a finding of fair use.

VI. JUSTIFYING THE NEED FOR THE RIGHT OF PUBLICITY DEFENSE

To exemplify the benefits and the correct use of this proposed Right of Publicity Defense, this Section will discuss and apply the defense to two recent and similar decisions decided by the Third and Ninth Circuits in 2013.³⁰⁷ Similar to *Brown*,³⁰⁸ the cases involve star collegiate athletes, who brought actions against EA alleging violations

³⁰⁰ *Id.* This result is consistent with the holding in *Rogers*, which found that the title of the movie was protected by the First Amendment, and the mere use of the name did not equate to a right of publicity violation. *Rogers*, 875 F.2d at 1000.

³⁰¹ See *supra* notes 288-99.

³⁰² *Rogers*, 875 F.2d at 1100.

³⁰³ See *supra* notes 290-97.

³⁰⁴ See *supra* note 294.

³⁰⁵ *Rogers*, 875 F.2d at 1001 (recognizing that even when there is risk that a consumer might be confused as to endorsement, this risk must outweigh the public interest in artistic expression).

³⁰⁶ *Brown v. Elecs. Arts, Inc.*, 2009 WL 8763151 at *5.

³⁰⁷ *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013); *Keller v. Elec. Arts Inc.*, 724 F.3d 1268 (9th Cir. 2013).

³⁰⁸ 2009 WL 8763151.

of their rights of publicity by EA for its use of their identities in the characters in the video game series “NCAA Football.”³⁰⁹

The Circuit Courts in both cases utilized the transformative use test to reach their decisions.³¹⁰ Each court emphasized that not only were the characters in the video games closely identical in physical characteristics to the famous college athletes,³¹¹ but the characters were also used in the exact context the athletes were found in real life – famous student-athletes playing football in football stadiums.³¹²

Currently, these cases yield corresponding conclusions as a result of the transformative use test applied in the decisions.³¹³ Both courts determined that the former college athletes are entitled to right of publicity protection.³¹⁴ Moreover, as previously mentioned, the Supreme Court has not addressed the issue of the First Amendment in the right of publicity context since *Zacchini* in 1977,³¹⁵ and subsequently there has been vigorous expansion of the right of publicity,³¹⁶ with various courts attempting to balance these two important rights.³¹⁷ Thus, although multiple circuits have applied and adopted the transformative use test,³¹⁸ including the Third and Ninth Circuits,³¹⁹ the test has not been unanimously adopted for all right of publicity cases which require a balancing of the First Amendment.³²⁰ However, some of the decisions adopting the transformative use test, including the Third Circuit decision in *Hart*,³²¹ and the Ninth Circuit decision in *Keller*,³²² also contained stimulating dissenting opinions, which criticized the majority’s decision to use or apply the

³⁰⁹ *Hart*, 717 F.3d at 146-47; *Keller*, 724 F.3d at 1271.

³¹⁰ *Hart*, 717 F.3d at 163; *Keller*, 724 F.3d at 1276.

³¹¹ *Hart*, 717 F.3d at 166 (noting that the video game avatar matched Hart in physical features as well as accessories worn while he played at Rutgers); *Keller*, 724 F.3d at 1276.

³¹² *Hart*, 717 F.3d at 166; *Keller*, 724 F.3d at 1276 (emphasizing that the Keller video game avatar was a college football player in the “identical setting to where the public found [Keller] in his collegiate career: on the football field.”).

³¹³ *Hart*, 717 F.3d at 170; *Keller*, 724 F.3d at 1279.

³¹⁴ *Hart*, 717 F.3d at 170; *Keller*, 724 F.3d at 1279.

³¹⁵ *Hart*, 717 F.3d at 152 (stating that “*Zacchini* is the only Supreme Court case addressing the First Amendment in a right of publicity context.”).

³¹⁶ See *supra* notes 41-46.

³¹⁷ See *supra* Section III.

³¹⁸ *Hart*, 717 F.3d at 163; *Keller*, 724 F.3d at 1276.

³¹⁹ *Hart*, 717 F.3d at 163; *Keller*, 724 F.3d at 1276.

³²⁰ *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (applying the predominant use test); *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003) (applying the Rogers test).

³²¹ *Hart*, 717 F.3d at 170 (Ambro, J., dissenting).

³²² *Keller*, 724 F.3d at 1284 (Thomas, J., dissenting).

transformative use test.³²³ Notably, the dissenting judges in *Hart* and *Keller* both criticized the majority's application of the transformative use test.³²⁴

As emphasized by these dissenting judges, the Circuit Courts' decisions in *Hart* and *Keller* were motivated by fears of extensive misappropriation.³²⁵ While applying the transformative use test, the Ninth Circuit expressed its wariness of "cynical abuse" by video game companies if it decided to recognize the true creative and transformative nature of the interactive functions in NCAA Football and other video games.³²⁶ The courts did not want the balancing tests to weigh against right of publicity protections merely because the works in question contained "highly creative elements in abundance."³²⁷ While these admonitions are significant, the proposed Right of Publicity Defense would adequately combat this fear of blatant misappropriation.³²⁸ Specifically in this instance, the majority in both *Hart* and *Keller* would have been able to recognize the creative and transformative elements in the video games, as was intended by the transformative use test,³²⁹ because the proposed test's four additional factors would adequately safeguard against any blatant misappropriation.³³⁰ Thus, the majority's cautionary approach in both

³²³ *ETW Corp. v. Jireh Publishing Company*, 332 F.3d 915, 960 (6th Cir. 2003) (Clay, J., dissenting) (stating that the majority should have applied the test derived in *Rogers* to correctly balance the rights).

³²⁴ *Hart*, 717 F.3d at 173 (Ambro, J., dissenting) (emphasizing that confining the inquiry to the identity alone is flawed, and that "the whole – the aggregate of many parts (including, here, many people)– is the better baseline for [the transformative use] inquiry."); *see also Keller*, 724 F.3d at 1285 (Thomas, J., dissenting) (stating that "the salient question is whether the entire work is transformative, and whether an individual persona or image has been altered.").

³²⁵ *Hart*, 717 F.3d at 167 (warning that recognizing the interactive feature as influentially transformative could lead to blatant acts of misappropriation, easily protected by including a modification feature).

³²⁶ *Id.*

³²⁷ *Hart*, 717 F.3d at 169 (warning that if not properly considered "acts of blatant misappropriation would count for nothing so long as the larger work, on balance, contained high creative elements in great abundance.").

³²⁸ *See infra* notes 329-30.

³²⁹ *See Comedy III Prodc., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 404 (2001) (emphasizing that the transformative use test was formulated from the first factor of the copyright fair use doctrine). The first factor of the copyright fair use doctrine determines "whether the new work merely supersedes the objects of the original creation, or whether and to what extent it is "transformative," altering the original with new expression, meaning, or message." *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

³³⁰ The dissenting opinions in both *Keller* and *Hart* criticize the majority for straying from this intended application of the transformative use test as a result of the fear of blatant

Hart and *Keller* reiterates the need for a test that will effectively balance the First Amendment and right of publicity protections with the utmost fairness.

A. Applying the Right of Publicity Defense

Applying the new Right of Publicity Defense to the *Hart* and *Keller* cases affords a firm example of the effectiveness of this new test for right of publicity cases.

The first factor looks to the nature of the use.³³¹ EA's use of Hart and Keller's identities in NCAA Football clearly does not fall within the categories of criticism, teaching, or research,³³² and therefore the determination should focus on the degree to which the use is transformative.³³³ In both *Hart* and *Keller*, contrary to the majority decisions which found that EA's use of Hart and Keller's identities was not transformative,³³⁴ this first factor finds that EA's use is transformative³³⁵ and weighs towards a finding of fair use.

The majority opinions in both *Hart* and *Keller* restrict their analysis to the individual avatar in the video game alone,³³⁶ and fail to recognize the transformative elements throughout the entire game.³³⁷ In harmony with the dissenting judges in *Hart* and *Keller*, this factor considers the transformative elements of a work in its entirety,³³⁸

misappropriation and inadequate protection of the right of publicity. *Hart*, 717 F.3d at 172 (Ambro, J., dissenting) (emphasizing that the majority decision shifted away from the traditional transformative use analysis); *see also infra* notes 349-82 (weighing the remaining four factors to ensure that a celebrity's identity is adequately protected from any blatant misappropriation that would exploit the celebrity's efforts to achieve his famed identity or misuse the commercial value of a celebrity's identity without his permission).

³³¹ This factor will refer to the reasoning of the district court decision in *Hart*, because for determination of transformative use, this factor reflects the views of the dissenting judges in *Hart* and *Keller* and requires that the entire work as a whole be considered, just as the district court did in *Hart*.

³³² 17 U.S.C. § 107 ("The fair use of a copyrighted work ... for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.").

³³³ *See supra* notes 180-84.

³³⁴ *Hart*, 717 F.3d at 170; *Keller v. Elec. Arts Inc.*, 724 F.3d 1268, 1279 (9th Cir. 2013).

³³⁵ *See infra* notes 342-45.

³³⁶ *Hart*, 717 F.3d at 166 (emphasizing that the digital avatar of Hart in the game was almost identical to Hart's identity in real life, and therefore determining how the identity was incorporated into the game did not matter); *Keller*, 724 F.3d at 1276.

³³⁷ *Hart*, 717 F.3d at 166; *Keller*, 724 F.3d at 1276.

³³⁸ *Hart*, 717 F.3d at 175 (Ambro, J., dissenting); *Keller*, 724 F.3d at 1285 (Thomas, J., dissenting).

including consideration of the purpose of a work,³³⁹ and analyzes how a celebrity's identity has been transformed and incorporated into a work as a whole.³⁴⁰

Although the identities of both Hart and Keller in the games are actual imitations of the individuals, the entire use of the characters within the games as a whole is transformative.³⁴¹ The video games convey the artistic expressions of EA's design team through the games' graphics and sounds, characters, including characters that are not football players, commentary, and game scenarios.³⁴² EA also created the interactive ability that gives users a chance to embark on their own narrative, allowing them to control the players and teams through multiple seasons.³⁴³ Moreover, the use of this mechanism that grants the gamer a high level of control in the interaction of the game, including the ability to adjust the characters and gaming atmosphere in various different ways,³⁴⁴ demonstrates that the use is transformative.³⁴⁵

Additionally, NCAA Football has a transformative purpose to provide a realistic gaming experience to its users.³⁴⁶ This purpose adds something new to the identities of Keller and Hart, altering them to fit the interactive objective of the game.³⁴⁷ Moreover, EA's commercial benefit derives from the user's desire to play the entire video game as

³³⁹ *Hart*, 717 F.3d at 170 (Ambro, J., dissenting).

³⁴⁰ *Hart*, 717 F.3d at 172 (Ambro, J., dissenting) (emphasizing that to limit the inquiry to likeness alone is at odds with previous Supreme Court decisions on the transformative use test).

³⁴¹ *Hart*, 717 F.3d at 175 (Ambro, J., dissenting) (emphasizing that realistic, interactive gaming experience as a whole transforms Hart's individual image); *Keller*, 724 F.3d at 1288 (Thomas, J., dissenting) (stressing that "only when the creative work is considered in complete context can a proper analysis be conducted.").

³⁴² *Hart*, 717 F.3d at 175 (Ambro, J., dissenting).

³⁴³ *Id.*

³⁴⁴ *Keller*, 724 F.3d at 1286 (Thomas, J., dissenting) (noting that the gamer can change the "abilities, appearances, and physical characteristics," as well as control the "weather, crowd noise, mascots, and other environmental factors.").

³⁴⁵ *Id.* The majority disagreed with this and dismissed the notion that the interactive feature of the video game contributed to the transformative use of the football player's image. *Hart*, 717 F.3d at 166. The majority feared that recognizing the transformative nature of this feature would open the door to blatant acts of misappropriation by video game companies. *Id.*

³⁴⁶ *Hart*, 717 F.3d at 170 (Ambro, J., dissenting) (recognizing that a key to the success of NCAA Football is "consumers' desire to experience a realistic football playing experience with their favorite teams.").

³⁴⁷ See *Author's Guild, Inc. v. Google Inc.*, 804 F.3d 202, 221 (2d Cir. 2015) (recognizing that unchanged copying is permitted where a further purpose is found).

a whole, and not solely from the use of either Hart's or Keller's identity in the game.³⁴⁸ Therefore the commercial value comes from the new creation of the interactive game and not from the use of the identities of Hart or Keller. Thus, this factor weighs in favor of EA and a finding of fair use.

The second factor is determined by examining the effort a celebrity exercised to establish his famous identity.³⁴⁹ This is measured by whether the publicity was earned or incidental.³⁵⁰ In both *Hart* and *Keller*, the football players are classified as achieving earned publicity. The hard work and dedication each famous collegiate athlete devoted to the sport allowed him to excel in college football,³⁵¹ and ultimately was the reason his identity was placed in the video game in the first place. Therefore, this factor weighs against finding fair use and instead toward the protection of Hart's and Keller's right of publicity.

The third factor analyzes the extent of the misappropriation by considering the entire work as a whole in comparison to the celebrity's identity.³⁵² Thus, when applying this factor to both *Hart* and *Keller* the factor considers the extent of the misappropriation with respect to the video games in their entirety. The majority opinions in both *Hart* and *Keller* are most influential with respect to this factor. These opinions focused on the identities of Hart and Keller compared to the virtual characters and the setting of the games.³⁵³ As emphasized in these two opinions, the identities of both Hart and Keller in NCAA Football were realistic portrayals of real life.³⁵⁴ Moreover, the context of the avatars encompassing Hart's and Keller's identities in the video game was the exact context that Hart and Keller were in as collegiate

³⁴⁸ *Hart*, 717 F.3d at 170.

³⁴⁹ *See supra* notes 198-99.

³⁵⁰ *Id.*

³⁵¹ *Ryan Hart Stats*, ESPN, http://espn.go.com/college-football/player/stats/_/id/135377/ryan-hart (last visited Mar. 7, 2017); *Sam Keller Profile*, SUN DEVIL ATHLETICS, http://www.thesundevils.com/ViewArticle.dbml?DB_OEM_ID=30300&ATCLID=208250752 (last visited Mar. 7, 2017).

³⁵² *See supra* notes 219-23.

³⁵³ *Hart*, 717 F.3d at 166; *Keller v. Elec. Arts Inc.*, 724 F.3d 1268, 1276 (9th Cir. 2013).

³⁵⁴ *Hart*, 717 F.3d at 166 (noting that the avatar matched Hart in physical features as well as accessories worn while he played at Rutgers); *Keller*, 724 F.3d at 1276 (recognizing that the video game character was an almost identical replication of Keller in real life, who is represented as "what he was: the starting quarterback for Arizona State").

athletes, playing football in football stadiums.³⁵⁵ Thus, under this factor, the quantity of the misappropriation of both Hart and Keller is very great. Although EA argued that NCAA Football contains many creative and interactive elements and thus was not strictly a replication of Hart's and Keller's identities,³⁵⁶ with respect to quantity, the game misappropriated both Hart's and Keller's entire identities.³⁵⁷

Arguably, had EA chosen to alter the identities of Hart and Keller in the games, creating either unique characteristics or settings, the quantity of the misappropriation would not be so great. For example, in *Kirby v. Sega of America, Inc.*³⁵⁸ the avatar in the game, although evidencing certain similarities, was not a literal depiction of Kirby.³⁵⁹ The avatar was created with several unique characteristics, and was in a mystical space-age setting, and thus was not a misappropriation of the celebrity's identity.³⁶⁰ Under this factor, had EA manipulated the images of Hart and Keller, or changed the setting in which these identities were found, similar to Sega of America, the quantity of the misappropriation would be low. However, because the avatars embodying Hart's and Keller's identities were realistic portrayals of real life,³⁶¹ found in the exact setting as real life,³⁶² the misappropriation is very great. Therefore, this factor will weigh against a finding of fair use and instead towards a right of publicity protection.

³⁵⁵ *Hart*, 717 F.3d at 166 (noting that “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”); *Keller*, 724 F.3d at 1276 (recognizing that the virtual character of Keller performed the exact activity he was known for in the game's setting which “is identical to where the public found [Keller] during his college career”).

³⁵⁶ *Hart*, 717 F.3d at 166; *Keller*, 724 F.3d at 1276.

³⁵⁷ *Hart*, 717 F.3d at 166; *Keller*, 724 F.3d at 1276.

³⁵⁸ 144 Cal. App. 4th 47 (2006).

³⁵⁹ *Id.* at 59.

³⁶⁰ *Id.* (emphasizing that the fictional space setting and role of the character in the game as a space-age reporter in the 21st century was not a misappropriation of the celebrity who was actually a famous singer).

³⁶¹ *Hart*, 717 F.3d at 166 (noting that the avatar matched Hart in physical features as well as accessories worn while he played at Rutgers); *Keller*, 724 F.3d at 1276 (recognizing that the video game character was an almost identical replication of Keller in real life, who is represented as “what he was: the starting quarterback for Arizona State”).

³⁶² *Hart*, 717 F.3d at 166 (noting that “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”); *Keller*, 724 F.3d at 1276 (recognizing that the virtual character of Keller performed the exact activity he was known for in the game's setting which “is identical to where the public found [Keller] during his college career”).

The fourth factor applied to both *Hart* and *Keller* will weigh towards a finding of fair use. This factor considers the effect the use of the celebrity's identity has on the potential market in light of the creative elements of defendant's use. Notably, the NCAA's amateurism rules restrict the ability of student-athletes to enter into licenses with outside companies while they are players in the NCAA.³⁶³ Thus, because of this restriction, neither Hart nor Keller would have been permitted to license his identity to EA during his time as a student-athlete. However, even if these restrictions are set aside,³⁶⁴ when the use of these celebrities' identities is viewed in light of the creative elements of NCAA Football, this factor will weigh towards a finding of fair use. NCAA Football, in addition to the identities of Hart and Keller, contained many creative and interactive elements.³⁶⁵ Unlike in *Zacchini*, where the celebrity's entire performance was taken and broadcasted identically to how it was performed,³⁶⁶ EA added various creative features to NCAA Football while simultaneously misappropriating the celebrities' identities.³⁶⁷ Thus, under this factor the commercial harm to Hart and Keller is less extensive because of the creative and interactive features added to their identities.

Notably, EA is also the creator of several video games based on professional sports and athletes.³⁶⁸ EA adequately compensates the professional athletes whose identities are utilized as a basis for the avatars in these video games.³⁶⁹ Thus arguably, with NCAA

³⁶³ *Amateurism*, NCAA (Mar. 6, 2016), <http://www.ncaa.org/amateurism>; *see also Hart*, 717 F.3d at 146 (recognizing that the NCAA bi-laws prohibit the athlete from using his athletic skills for pay in the sport, or permits his name or picture to advertise or promote a product in any way).

³⁶⁴ The NCAA bi-laws, including the amateurism restrictions, are a completely separate and complex topic, and therefore for the purposes of this note will not be discussed in detail.

³⁶⁵ *Hart*, 717 F.3d at 146 (noting that NCAA Football allows a player to choose the football teams to play in a stadium filled with coaches, referees, mascots, cheerleaders and fans, and allows the player to control the game for multiple seasons).

³⁶⁶ *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 575 (1977).

³⁶⁷ *Hart*, 717 F.3d at 175 (Ambro, J., dissenting) (emphasizing that realistic, interactive gaming experience as a whole transforms Hart's individual image); *Keller*, 724 F.3d at 1286 (Thomas, J., dissenting) (noting that the gamer can change the "abilities, appearances, and physical characteristics," as well as control the "weather, crowd noise, mascots, and other environmental factors.").

³⁶⁸ *See Latest Games*, EA SPORTS, <https://www.ea.com/games> (last visited Mar. 7, 2017).

³⁶⁹ *See, e.g., EA & FIFA – Licensing Agreement Extended Until 2022*, EA SPORTS (May 8, 2013), <https://www.easports.com/fifa/news/2013/ea-sports-and-fifa-extend-licensing-agreement-until-2022>.

amateurism rules³⁷⁰ set aside, Hart and Keller lost the ability to license their identities to EA for use in NCAA Football and receive compensation similar to that of professional athletes.³⁷¹ However, this factor considers the effect the use of the celebrity's identity has on the potential market in light of the creative elements of the defendant's use.³⁷² Therefore, under this factor, the potential market is considered broadly in light of NCAA Football's various creative elements.³⁷³ Thus, the numerous other licensing opportunities available to both Hart and Keller must also be considered.³⁷⁴ Both Hart and Keller can license their identities for use in other video games, commercials, or to other industries seeking to use their identities for endorsement or creative purposes.³⁷⁵ Therefore, under this factor, the interest of free expression outweighs the slight harm³⁷⁶ that arguably occurred to the plaintiffs' licensing opportunities in the market of video games, specifically the NCAA Football series, and this factor will weigh towards a finding of fair use.

The fifth and final factor determines whether there is a likelihood of confusion as to the origin, sponsorship, or approval of the work by determining the relevance of the celebrity's identity to the artistic value of the work, and the likelihood of consumer confusion.³⁷⁷ Both *Hart* and *Keller* are similar to *Brown v. Elecs. Arts, Inc.*³⁷⁸ In that case the court found that there was no likelihood of confusion for the use of Brown's image by EA in its video game series Madden Football.

³⁷⁰ See *supra* note 363.

³⁷¹ See *supra* note 369.

³⁷² See *supra* note 367.

³⁷³ *Id.*

³⁷⁴ Celebrities can license their identity, or even appear personally, in commercials and advertisements for various products including: food, clothing, technology, sports drinks, etc. See *Celebrity Endorsements*, ADWEEK, <http://www.adweek.com/topic/celebrity-endorsements> (last visited Mar. 7, 2017).

³⁷⁵ *Id.*

³⁷⁶ As a result of the NCAA amateurism requirements, college football players are not permitted to be compensated for the use their identities in video games. In contrast, EA compensates the college athletes' celebrity counterparts for the use of their identities in video games. However, student-athletes in the NCAA forfeit their ability to receive compensation by agreeing to the amateurism requirements and contracting with the NCAA. See *supra* note 363.

³⁷⁷ See *supra* notes 255-58.

³⁷⁸ 2009 WL 8763151.

The court's analysis in *Brown*,³⁷⁹ applied to both *Keller* and *Hart*, yields the same conclusion.

First, the use of Hart's and Keller's image in the game does have artistic relevance to the game itself: the game is designed to provide a virtual college football experience, and they are both college football stars.³⁸⁰ Second, as noted in *Brown*, it is very unlikely that an individual playing the game, which has over 1,500 players, would assume that the use of either Hart's or Keller's identity for one of the virtual players represents their sponsorship or creation of the game.³⁸¹ Thus, under this two-pronged analysis, there is no likelihood of confusion.

Arguably, while the First Amendment guarantees a freedom of expression, it does not grant someone a constitutionally protected right to use a celebrity's identity without his permission to draw attention to a creation or help sell a product.³⁸² In both *Hart* and *Keller* it appears that this is precisely what EA intended by using Hart's and Keller's image in the video games.³⁸³ However, under this likelihood of confusion factor, a celebrity will only be successful when the public interest in avoiding consumer confusion outweighs the public interest in free expression.³⁸⁴ Under this two-pronged analysis, if EA's use was determined to cause a likelihood of consumer confusion, the public interest in avoiding this confusion would outweigh the public interest in free expression, and thus the factor would lead towards a right of publicity protection. However, this analysis concludes that there is no likelihood of consumer confusion.³⁸⁵ Therefore this fifth factor in both *Hart* and *Keller* will lean towards a finding of fair use.

Furthermore, the application of the new Right of Publicity Defense to both *Hart* and *Keller* leans towards a finding of fair use

³⁷⁹ See *supra* notes 288-99.

³⁸⁰ *Hart v. Elec. Arts, Inc.*, 717 F.3d 141,158 (3d Cir. 2013) (recognizing that “[g]iven that appellant played intercollegiate football, however, products targeting the sports-fan market would, as a matter of course, relate to him.”).

³⁸¹ *Brown*, 2009 WL 8763151 at *5 (noting that Brown's identity was used in only one of the thousands of virtual athletes in the games). Similarly, Keller and Hart's identities are used in only one of the thousands of athletes in the NCAA Football gaming series. See also *Hart v. Elec. Arts, Inc.*, 717 F.3d at 174 (Ambro, J., dissenting) (finding that Hart's image in the game does not mislead the public to believe he was the source of the game).

³⁸² MCCARTHY, *supra* note 12 at § 7:3.

³⁸³ *Hart*, 717 F.3d at 146-47; *Keller v. Elec. Arts Inc.*, 724 F.3d 1268, 1276 (9th Cir. 2013).

³⁸⁴ *Brown*, 2009 WL 8763151 at *3.

³⁸⁵ See *supra* notes 380-81.

because three out of five of the factors favor fair use.³⁸⁶ The protection of EA's First Amendment free expression rights trumps the right of publicity protections of both *Hart* and *Keller*. Thus, under this new approach, the decisions in both *Hart* and *Keller*, in contrast to the actual decisions,³⁸⁷ would both conclude that EA's use of the plaintiffs' images in the NCAA Football game series constitutes a fair use that is protected by the First Amendment.

VII. CONCLUSION

In conclusion, this proposed Right of Publicity Defense should be adopted as the balancing test to be used uniformly throughout all the circuits. The importance of balancing the right of publicity and First Amendment protections has been recognized since *Zacchini*, and balancing the rights has proven to be a frustrating task. This test resolves the problems of the existing balancing tests by incorporating them as factors to be weighed together. It provides a clear standard that ensures that the right of publicity remains protected without hindering creativity and the freedom of expression.

³⁸⁶ See *supra* Section VI.

³⁸⁷ *Hart*, 717 F.3d at 170; *Keller*, 724 F.3d at 1279.