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Two Tests Unite to Resolve the Tension Between the First Amendment and the Right of Publicity

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NOTES

TWO TESTS UNITE TO RESOLVE THE TENSION BETWEEN THE FIRST AMENDMENT AND THE RIGHT OF PUBLICITY

*Dora Georgescu**

The right of publicity is an established legal doctrine that grants individuals the exclusive right to control the commercial use of their image. Though it has many important and laudable uses, one unfortunate consequence of the right of publicity is that it restricts artists' abilities to portray real persons in their works. In so doing, the right of publicity directly conflicts with the First Amendment protections of an individual's freedom of expression.

*While the U.S. Supreme Court addressed this tension in *Zacchini v. Scripps-Howard Broadcasting Co.*, the Court did not create a clear standard for balancing the interests of each right. Without guidance from the Supreme Court, lower courts have developed four tests for balancing the right of publicity against the First Amendment: the relatedness test, the predominant purpose test, the transformative use test, and the ad-hoc balancing test.*

*Although most courts use only a single test to analyze the conflict between the right of publicity and the First Amendment, the Sixth Circuit, in *ETW Corp. v. Jireh Publishing Inc.*, relied on both the transformative use test and the ad-hoc balancing test to form its analysis. This Note proposes a test based on the Sixth Circuit approach, which creates a predictable standard for balancing the First Amendment against the right of publicity.*

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INTRODUCTION

Electronic Arts, Inc. has created a series of National Collegiate Athletic Association (NCAA) football video games.¹ One of the characters in these games strongly resembles the college quarterback Ryan Hart.² Because Hart never consented to the use of his image in these games, he sued Electronic Arts for violating his right of publicity.³ Electronic Arts responded that the First Amendment shields it from right of publicity claims.⁴ How should this dispute be resolved?

Determining the prevailing party hinges on how the court balances two legal rights between which there is an “inherent tension”: the right of publicity and the First Amendment.⁵ While the right of publicity grants individuals⁶ the “exclusive right” to the commercial use of their image, the First Amendment seeks to protect freedom of expression.⁷ Artists, publishers, and other content makers routinely assert that the right of publicity curtails their freedom of expression by restricting their ability to use representations of real persons in their works.⁸ Thus, the right of publicity has the potential to suppress creative works and therefore undermine First Amendment goals.⁹

The U.S. Supreme Court addressed this tension in *Zacchini v. Scripps-Howard Broadcasting Co.*¹⁰ The Court’s holding, however, was tailored to the unique facts of the case and therefore did not create a clear standard for analyzing typical right of publicity cases.¹¹ With no clear guidance from the Supreme Court, the lower courts have taken various approaches to balancing the right of publicity against the First Amendment.¹² Four dominant tests have emerged: the relatedness test, the predominant purpose test, the transformative use test, and the ad-hoc balancing test.¹³ Under the relatedness test, a title that uses a celebrity’s name will be protected by the

1. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 145 (3d Cir. 2013).

2. See *id.*

3. See *id.*

4. See *id.*

5. See *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 931 (6th Cir. 2003); see also Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 47 (1994).

6. Everyone has a right of publicity, however, celebrities are generally the plaintiffs in right of publicity cases. See Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 217 (1954).

7. James Barr Haines, *First Amendment II: Developments in the Right of Publicity*, 1989 ANN. SURV. AM. L. 211, 226 (1990).

8. See Pamela Samuelson, *Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 TUL. L. REV. 836, 836 (1983).

9. See Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 125, 146 (1993). This is problematic because states may not impose laws that can impair the freedom of speech. See generally *Tinker v. Des Moines Indep. Cmty. Sch. Dist.*, 393 U.S. 503 (1969); *Near v. Minnesota ex rel. Olson*, 283 U.S. 697 (1931).

10. 433 U.S. 562 (1977).

11. See David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment*, 2 HARV. J. SPORTS & ENT. L. 1, 19 (2011).

12. *Id.* at 19–20.

13. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 153–64 (3d Cir. 2013).

First Amendment as long as it is not “wholly unrelated” to the contents of the work.¹⁴ Under the predominant purpose test, an unauthorized use of another’s identity is protected if the purpose of the work is predominantly expressive, but it is an infringement of the right of publicity if the purpose of the work is predominantly commercial.¹⁵ Under the transformative use test, a work that depicts a celebrity enjoys First Amendment protection if it is the artist’s creative expression rather than merely an imitation of the celebrity’s likeness.¹⁶ Finally, under the ad-hoc balancing test, courts balance the consequences of restricting a defendant’s freedom of expression against the justifications for a plaintiff’s right of publicity.¹⁷

In *ETW Corp. v. Jireh Publishing Inc.*,¹⁸ the Sixth Circuit addressed the conflict between the First Amendment and the right of publicity by relying on both the transformative use test and the ad-hoc balancing test.¹⁹ This Note addresses the merits of the Sixth Circuit approach by examining the transformative use test and the ad-hoc balancing test. While scholars have addressed the transformative use test,²⁰ no article carefully scrutinizes the ad-hoc balancing test or the Sixth Circuit’s application of the transformative use and ad-hoc balancing tests together. Thus, this Note fills the gap in the scholarship in two significant ways. First, it examines the ad-hoc balancing test on its own terms, addressing in particular the justifications for the right of publicity. Second, it examines whether the Sixth Circuit approach provides a predictable standard for resolving the tension between the right of publicity and the First Amendment.

Part I outlines the development of the right of publicity and then examines the conflict between the right of publicity and the First Amendment. Part II explains the Court’s reasoning in *Zacchini* and then describes the four tests that have developed to balance the conflicting interests of the right of publicity and the First Amendment. Finally, Part III examines the Sixth Circuit’s approach, which relies on two existing tests. This Note concludes that a modified version of the Sixth Circuit’s approach should be adopted, because it creates a clear and predictable standard for resolving the tension between the First Amendment and the right of publicity.

Without a predictable standard to balance the right of publicity against the First Amendment, it is impossible to predict with certainty how courts

14. *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989).

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

16. *See Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808–09 (Cal. 2001).

17. *See Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 972 (10th Cir. 1996).

18. 332 F.3d 915 (6th Cir. 2003).

19. *Id.* at 936.

20. *See generally* Tan, *supra* note 11; F. Jay Dougherty, *All the World’s Not a Stooge: The “Transformativeness” Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 COLUM. J.L. & ARTS 1 (2003); Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903 (2003).

will decide a particular case.²¹ Art, mass media, books, and video games routinely depict real people, so legal uncertainty chills a wide swath of protected speech.²² Because free speech maintains “the integrity of the political process that constitutes our system of self-government,”²³ it is imperative that the courts adopt a predictable standard to balance the right of publicity against the First Amendment.

I. BUTTING HEADS: THE RIGHT OF PUBLICITY AND THE FIRST AMENDMENT

Before analyzing the courts’ various approaches for rectifying the conflict between the rights of publicity and free speech, it is necessary to briefly provide some background and overview of each of these rights. Part I.A defines the right of publicity and outlines its history, which began in a separate legal doctrine, the right to privacy. Next, Part I.B explains the First Amendment doctrines that intersect with the right of publicity, including the distinction between commercial and expressive speech, and the newsworthiness doctrine.

A. *The Right of Publicity*

The right of publicity protects individuals from unauthorized commercial use of their identity.²⁴ It originated in the right to privacy, which is a “right to be let alone.”²⁵ The right to privacy focuses on the victim’s mental trauma when his or her privacy is breached.²⁶ However, it does not offer protection for famous individuals who have sought publicity.²⁷ From the right to privacy evolved the right of publicity, which protects celebrities who want compensation for the use of their identity, regardless of whether this use has caused them mental distress.²⁸ This section outlines that evolution.

21. See Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1591 (1979).

22. *Id.* at 1594. The chilling effect of legal uncertainty is “a very real threat.” *Id.* at 1595.

23. *Id.* at 1597. Because celebrities are “widely recognized cultural sign[s],” expressive use of a celebrity’s image qualifies for “the highest level of First Amendment protection as political speech.” Tan, *supra* note 11, at 4–5; see also *infra* Part I.B.1 (explaining how artistic depictions of celebrities advance First Amendment goals).

24. See J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1.3 (2d ed. 2013); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995) (stating that the right of publicity prohibits others from appropriating “the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade”).

25. MCCARTHY, *supra* note 24, § 1.7.

26. See *id.*

27. See *id.*

28. See *id.*

1. The Proposal and Debate of a Right to Privacy

In 1890, Samuel D. Warren and Louis D. Brandeis published “The Right to Privacy,”²⁹ in which they argued that the press had overstepped its boundaries and intruded into individual privacy.³⁰ They denounced an industry that, through public disclosure of embarrassing private facts, subjected others “to mental pain and distress, far greater than could be inflicted by mere bodily injury.”³¹ Drawing on Justice Thomas Cooley’s recognition that everyone has the “right to be let alone,”³² Warren and Brandeis urged the courts to create a remedy for those whose privacy had been violated and to include a “right to privacy” in the common law.³³

New York rejected the common law adoption of a right to privacy in a 1902 decision in *Roberson v. Rochester Folding Box Co.*³⁴ The court rejected the theme set forth by Warren and Brandeis, concluding that the right to privacy could not be “incorporated without doing violence to settled principles of law by which the [press] and the public have long been guided,” such as the freedom of speech.³⁵ Noting the precedential effects of its holding, the court observed that it could not invoke a legal doctrine that had not yet been established.³⁶ Instead, the legislature would be better suited to “interfere and arbitrarily provide” a statute to prevent the unpermitted use of one’s likeness for advertisement.³⁷

Three years after *Roberson*, the Georgia Supreme Court took the opposite approach in *Pavesich v. New England Life Insurance Co.*,³⁸ and embraced Warren and Brandeis’ proposed right to privacy.³⁹ The court found that the right to privacy is an absolute right along with the rights of personal security and personal liberty,⁴⁰ and adopted Warren and Brandeis’ definition of the right to privacy as a right “to be secure from invasion by

29. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1891).

30. *Id.* at 196 (“The press is overstepping in every direction the obvious bounds of propriety and of decency.”). During Warren and Brandeis’s time, the press was known for prying into the private lives of many people. See MCCARTHY, *supra* note 24, § 1.13. With over sixty newspaper articles written about Warren and his family, scholars have hypothesized that this law review article was a direct response to the press’s interference with his life. *Id.*

31. Warren & Brandeis, *supra* note 29, at 196.

32. Irwin R. Kramer, *The Birth of Privacy Law: A Century Since Warren and Brandeis*, 39 CATH. U. L. REV. 703, 710 (1990).

33. Warren & Brandeis, *supra* note 29, at 198.

34. 64 N.E. 442 (N.Y. 1902). In this case, the defendants circulated about 25,000 photographs of the plaintiff despite knowing that they did not have the authority to do so. *Id.* at 442.

35. *Id.* at 447.

36. *See id.* at 444.

37. *Id.* at 443. The legislature followed the court’s suggestion; the New York statute is codified at N.Y. CIV. RIGHTS LAW §§ 50–51 (McKinney 1995).

38. 50 S.E. 68 (Ga. 1905).

39. Justice Cobb denounced the court’s decision in *Roberson* as “the result of an unconscious yielding to the feeling of conservatism which naturally arises in the mind of a judge who faces a proposition which is novel.” *Id.* at 78.

40. *Id.* at 70.

the public into matters of a private nature.”⁴¹ While the *Pavesich* court recognized, as did the court in *Roberson*, that the right to privacy conflicted with the constitutional rights of free speech and the freedom of press, it trusted in the “wisdom and integrity of the judiciary” to strike the proper balance between these conflicting rights.⁴²

After the *Roberson* and *Pavesich* decisions, states were divided; some favored *Roberson*, while others accepted *Pavesich*.⁴³ However, by the 1940s, most states had recognized the right to privacy.⁴⁴

In 1960, William Prosser⁴⁵ divided the tort of invasion of privacy into four separate categories: (1) intrusion; (2) disclosure; (3) false light; and (4) appropriation.⁴⁶ These four categories are distinct kinds of invasions and represent distinct interests of the plaintiff. The first kind of invasion is defined as the “physical intrusion” into a plaintiff’s private life.⁴⁷ This sort of invasion includes activities such as the physical harassment of overzealous paparazzi, “peeping toms,” and police officers searching a home without a warrant.⁴⁸ The second kind of invasion is the “public disclosure of embarrassing private facts.”⁴⁹ The disclosed information must be “embarrassing” from the viewpoint of a person “of ordinary sensibilities.”⁵⁰ The third category that Professor Prosser identified is very closely related to the law of defamation. This “false light” invasion of privacy requires “injury to human dignity” as a result of the public presentation of a plaintiff in a false light.⁵¹ The final category of invasion of privacy involves the unpermitted use of a plaintiff’s identity “with damage to plaintiff’s dignitary interests and peace of mind.”⁵² This category was the precursor to the right of publicity.⁵³

2. The Evolution of the Right of Publicity

Privacy law developed with a focus upon the “mental trauma incurred when one’s identity [is] widely disseminated in an unpermitted commercial use.”⁵⁴ This conception became problematic when famous plaintiffs began to appear in court.⁵⁵ These plaintiffs were not concerned with the

41. *Id.* at 72.

42. *Id.*

43. MCCARTHY, *supra* note 24, § 1.18.

44. *Id.*

45. Regarded as “a great Master of Torts,” William Prosser wrote numerous highly influential and authoritative works on torts. Christopher J. Robinette, *The Prosser Notebook: Classroom As Biography and Intellectual History*, 2010 U. ILL. L. REV. 577, 579.

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

47. MCCARTHY, *supra* note 24, § 1.20.

48. *Id.*

49. *Id.* § 1.21.

50. *Id.* The right to privacy is not intended to protect those who are “abnormally sensitive about . . . publicity.” *Id.*

51. *Id.* § 1.22.

52. *Id.* § 1.23.

53. *Id.*

54. *Id.* § 1.7.

55. *Id.*

dissemination of their identity, but rather they wanted to “control when, where and how their identity was so used.”⁵⁶ Because privacy rights had come to mean the “right to be left alone,” courts struggled with the claims for invasion of privacy of plaintiffs that had built their careers in order to gain publicity.⁵⁷ As a result, courts limited celebrities’ ability to recover under right to privacy claims,⁵⁸ and celebrities could not protect their economic interests under the right to privacy.⁵⁹

A Fifth Circuit case from 1941 illustrates this problem. In *O’Brien v. Pabst Sales Co.*,⁶⁰ professional football player David O’Brien sued Pabst Beer Company for using his photograph in its “Pabst Blue Ribbon” beer advertising calendar.⁶¹ The district court dismissed O’Brien’s invasion of privacy case.⁶² The court of appeals agreed with the district judge’s opinion that the association of O’Brien with a glass of beer “could not possibly disgrace [him] . . . or cause him damage.”⁶³ Furthermore, because O’Brien was not a “private person,” the court reasoned that he could not be harmed by publicity because he had already been seeking and receiving the publicity imparted by Pabst Beer Company.⁶⁴

The dissent characterized O’Brien’s claim as one for a “right of property,” which belongs to everyone.⁶⁵ Noting that the majority left celebrities without remedy for nonlibelous use of their image, the dissent focused instead upon O’Brien’s commercial value.⁶⁶ Judge Edwin Holmes observed that commercial advertisers may take advantage of the publicity that celebrities have gained through their “talent and accomplishment” in order to “increase their sales,” without compensating the celebrities from whose name they profited.⁶⁷

The *O’Brien* dissent’s focus on property rights in the context of privacy rights was a step in advancing the right of publicity, but it wasn’t until 1953 that these two concepts were explicitly linked. In *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,⁶⁸ the Second Circuit first used the term “right of publicity” and explained it as a property right in a person’s identity:

56. *Id.*

57. *Id.*

58. *See, e.g.,* *Gautier v. Pro-Football, Inc.*, 107 N.E.2d 485, 489 (N.Y. 1952) (denying damages); *Miller v. Madison Square Garden Corp.*, 28 N.Y.S.2d 811, 813–14 (Sup. Ct. 1941) (awarding nominal damages of six cents).

59. Nimmer, *supra* note 6, at 203–13. Scholars have noted that the economic focus of the right of publicity makes it a “more practical” right than the right to privacy. *See, e.g.,* Richard Ausness, *The Right of Publicity: A “Haystack in a Hurricane,”* 55 TEMP. L.Q. 977, 988 (1982).

60. 124 F.2d 167 (5th Cir. 1941).

61. *Id.* at 168.

62. *Id.* at 169.

63. *Id.* at 169–70.

64. *Id.* at 170.

65. *Id.* at 170–71 (Holmes, C.J., dissenting).

66. *Id.* at 171.

67. *Id.*

68. 202 F.2d 866 (2d Cir. 1953).

We think that, in addition to and independent of that right of privacy (which in New York derives from statute), 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, and that such a grant may validly be made “in gross,” i.e., without an accompanying transfer of a business or of anything else

This right might be called a “right of publicity.” For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, buses, trains and subways.⁶⁹

Shortly after *Haelan*, Professor Melville Nimmer, an authority on free speech and intellectual property, wrote an article echoing the *Haelan* court, which established the right of publicity as a viable legal doctrine.⁷⁰ Nimmer noted that the doctrine developed by Brandeis and Warren, while sufficient “to protect the sensibilities of nineteenth century Brahmin Boston, is not adequate to meet the demands of the second half of the twentieth century, particularly with respect to the advertising, motion picture, television, and radio industries.”⁷¹ He reasoned that the celebrities working in these industries “do not seek the ‘solitude and privacy’ which Brandeis and Warren sought to protect.”⁷² Instead, celebrities wish to protect the use of their name and likeness, which have economic value.⁷³ Because this value could not be protected under a privacy theory, the newly recognized right of publicity was a more adequate legal doctrine for commercial misappropriation of one’s likeness.⁷⁴

3. The Right of Publicity Today

Today, the right of publicity is an established legal doctrine.⁷⁵ It is an intellectual property right created by state law,⁷⁶ and infringement of the right of publicity can result in liability for the commercial tort of unfair competition.⁷⁷ While it is a distinct legal category, the right of publicity shares elements of both property and tort law.⁷⁸

69. *Id.* at 868.

70. MCCARTHY, *supra* note 24, § 1.27.

71. Nimmer, *supra* note 6, at 203.

72. *Id.* at 203–04.

73. *Id.* at 204.

74. *Id.*

75. *See* Kwall, *supra* note 5, at 52.

76. Although the right of publicity is created by state law, its intersection with the First Amendment presents a federal issue. *See* *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 568 (1977).

77. MCCARTHY, *supra* note 24, § 1.3.

78. *Id.* § 1.7. The right of publicity is categorized as the commercial tort of unfair competition and as a form of property, specifically a form of intellectual property. *Id.*

Almost every state has recognized the right of publicity either by statute or at common law.⁷⁹ Nineteen states have codified the right of publicity in statutes.⁸⁰ Additionally, the Third Restatement of Unfair Competition recognizes the right of publicity.⁸¹ A prima facie right of publicity claim requires three basic elements: (1) ownership of an enforceable right in the identity of a human being; (2) use by another, without permission, of some aspect of the plaintiff's identity in such a way that it is identifiable from the unauthorized use; and (3) likelihood that the defendant's use will cause economic injury to the value of that identity.⁸²

Despite the widespread adoption of the right of publicity, it is no clearer than it was three decades ago, when Professor Ausness characterized it as a "haystack in a hurricane."⁸³ To begin with, courts have not come up with a consistent test to determine what the right of publicity covers.⁸⁴ While some courts have suggested that almost any recognizable characteristic is protected, other decisions have narrowed the right of publicity.⁸⁵ Similarly, while some statutes are "drawn too narrowly" to protect only celebrities' names, portraits, or pictures,⁸⁶ "broadly drawn" statutes extend protection to include additional traits such as voice, likeness, and personality.⁸⁷ Yet, perhaps the most troubling uncertainty about the right of publicity comes from its interaction with the First Amendment.

B. *Tension Between the First Amendment and the Right of Publicity*

This section explains the competing interests of the First Amendment and the right of publicity. In addressing the conflict between the right of publicity and the First Amendment, courts begin their analysis by determining whether the use of a person's likeness is "expressive" or "commercial."⁸⁸ Thus, Part I.B.2 describes the types of expressive speech

79. *Id.* § 6.1. California, Florida, and Wisconsin recognize the right of publicity through both statute and common law. See Christopher Pesce, *The Likeness Monster: Should the Right of Publicity Protect Against Imitation?*, 65 N.Y.U. L. REV. 782, 794 (1990).

80. MCCARTHY, *supra* note 24, § 6.8. Seven states recognize a statutory right of publicity. Arizona, Alabama, California, Connecticut, Florida, Georgia, Hawaii, Illinois, Kentucky, Michigan, Minnesota, Missouri, New Jersey, Ohio, Pennsylvania, Texas, Utah, and Wisconsin recognize a common law right of publicity. *Id.* §§ 6.1–127. Indiana, Massachusetts, Nebraska, Nevada, New York, Oklahoma, Rhode Island, Tennessee, Virginia, and Washington have statutes protecting the right to privacy, which also embody the right of publicity. *Id.*

81. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

82. MCCARTHY, *supra* note 24, § 3.2.

83. Ausness, *supra* note 59, at 978.

84. Felcher & Rubin, *supra* note 21, at 1590.

85. *Compare* Lahr v. Adell Chem. Co., 300 F.2d 256, 260 (1st Cir. 1962) (granting relief for plaintiff's distinctive speaking style), with *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 718 (9th Cir. 1970) (denying relief for imitation of singing style).

86. Haines, *supra* note 7, at 216.

87. *Id.* at 219.

88. See Tan, *supra* note 11, at 16; see also *Doe v. TCI Cablevision*, 110 S.W.3d 363, 373 (Mo. 2003) (noting that expressive works, such as those in *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (9th Cir. 2001), *Cardtoons v. Major League Baseball Players Ass'n*, 95 F.3d 959, 969–70 (10th Cir. 1996), and *Rogers v. Grimaldi*, 875 F.2d 994, 1003–05 (2d Cir. 1989), are fully protected, while commercial works, such as those in

that receive First Amendment protection and distinguishes protected expressive speech from less protected commercial speech. To illustrate this rather elusive distinction, Part I.B.3 outlines two cases where courts found works that contained commercial elements to be expressive enough to outweigh the right to privacy.⁸⁹ Finally, Part I.B.4 briefly describes the types of speech that are exempt from right of publicity claims under the newsworthiness doctrine.

1. Irreconcilable Goals of the First Amendment and the Right of Publicity

The First Amendment “protects the dissemination of ideas and information.”⁹⁰ The right of publicity significantly constrains the “dissemination of ideas and information” by limiting who can use celebrity images.⁹¹ In fact, it appears that the right of publicity “has been defined as if it existed in isolation from the First Amendment.”⁹² As a result, there is “an inherent tension” between the right of publicity and First Amendment rights.⁹³

To understand the conflict between the First Amendment and the right of publicity, it is helpful to understand two important goals of the First Amendment.⁹⁴ First, it serves “‘to preserve an uninhibited marketplace of ideas’ and to repel efforts to limit the ‘uninhibited, robust and wide-open’ debate on public issues.”⁹⁵ Because celebrities take on public meaning,⁹⁶ the use of their likeness may be important for an uninhibited debate about

Downing v. Abercrombie & Fitch, 265 F.3d 994, 1002 (9th Cir. 2001), White v. Samsung Elec. Am., Inc., 971 F.2d 1395, 1397–99 (9th Cir. 1992), and Midler v. Ford Motor Co., 849 F.2d 460, 462–64 (9th Cir. 1988), are rarely protected).

89. Although these cases address the right to privacy, they were brought under N.Y. CIV. RIGHTS LAW §§ 50–51 (McKinney 1995), which encompasses both the right to privacy and the right of publicity. See *infra* note 125 and accompanying text.

90. Ausness, *supra* note 59, at 1026. The First Amendment provides that “Congress shall make no law . . . abridging the freedom of speech.” U.S. CONST. amend. I.

91. Felcher & Rubin, *supra* note 21, at 1590.

92. *Id.* at 1590. This may be explained by the fact that the right to privacy was articulated decades before free speech took a central role in American jurisprudence. *Id.* at 1596 n.92.

93. ETW Corp. v. Jireh Publ’g, Inc., 332 F.3d 915, 931 (6th Cir. 2003); see also Martin Luther King, Jr., Ctr. For Soc. Change, Inc. v. Am. Heritage Prods., Inc., 296 S.E.2d 697, 708 (Ga. 1982) (Weltner, J., concurring) (noting that the right of publicity has “created an open-ended and ill-defined force which jeopardizes a right of unquestioned authenticity-free speech.”).

94. Professor Emerson explains that freedom of expression is justified on four grounds: (1) to assure “individual self-fulfillment,” (2) to advance truth and knowledge, (3) to secure society’s participation in social and political decision making, and (4) to balance social stability and change. Thomas I. Emerson, *Toward a General Theory of the First Amendment*, 72 YALE L.J. 877, 878–79 (1963).

95. Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454, 458 (Cal. 1979) (citing Gertz v. Robert Welch, Inc., 418 U.S. 323, 339 (1974); Red Lion Broad. Co. v. FCC, 395 U.S. 367, 388 (1969)).

96. Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 802–03 (Cal. 2001). Stars embody “the social categories in which people are placed and through which they have to make sense of their lives . . . categories of class, gender, ethnicity, religion, sexual orientation, and so on.” Stuart Hall, *Introduction: Who Needs “Identity?”* in QUESTIONS OF CULTURAL IDENTITY 1, 5 (Stuart Hall & Paul Du Gay eds., 1996).

cultural values.⁹⁷ Second, the First Amendment assures “individual self-fulfillment” by allowing individuals to express their views.⁹⁸ Creative use of celebrity images can serve as an “important avenue of individual expression.”⁹⁹ By allowing celebrities to control how, and by whom, their images are used, the right of publicity has the potential to undermine these First Amendment goals.¹⁰⁰

2. Distinguishing Expressive Speech from Commercial Speech

Courts faced with the competing interests of the right of publicity and the First Amendment begin their analysis by determining whether the speech in question is “expressive” or “commercial.”¹⁰¹ Expressive speech and commercial speech are entitled to varying degrees of First Amendment protection, which in turn affects how each type of speech is treated in the right of publicity context.¹⁰²

Expressive speech is speech that conveys an idea or message.¹⁰³ This includes the spoken and written word,¹⁰⁴ visual art,¹⁰⁵ video games,¹⁰⁶ movies, music, and live entertainment.¹⁰⁷ Informative speech and entertaining expressive speech are equally protected.¹⁰⁸ Conduct is also considered speech if it is intended to convey a specific message and if it is

97. *Comedy III*, 21 P.3d at 802–03.

98. Emerson, *supra* note 94, at 878–79.

99. *Comedy III*, 21 P.3d at 803.

100. *Id.*

101. *See* Tan, *supra* note 11, at 16; *see also* Doe v. TCI Cablevision, 110 S.W.3d 363, 373 (Mo. 2003).

102. *See Doe*, 110 S.W.3d at 373.

103. George Vetter & Christopher C. Roche, *The First Amendment and the Artist—Part I*, R.I.B.J., 7, 9 (1996). This need not be a “narrow, succinctly articulable message.” Hurley v. Irish-Am. Gay, Lesbian and Bisexual Grp. of Bos., 515 U.S. 557, 569 (2011).

104. Vetter & Roche, *supra* note 103, at 8.

105. *Bery v. City of New York*, 97 F.3d 689, 695 (2d Cir. 1996) (“Visual art is as wide ranging in its depiction of ideas, concepts and emotions as any book, treatise, pamphlet or other writing, and is similarly entitled to full First Amendment protection One cannot look at Winslow Homer’s paintings on the Civil War without seeing, in his depictions of the boredom and hardship of the individual soldier, expressions of anti-war sentiments, the idea that war is not heroic.”). Although art is protected because it has “intrinsic value,” courts often look to the political value of the art as well. Tan, *supra* note 11, at 15. Therefore, artwork generally must make political or social commentary in order to be granted First Amendment protections. *See, e.g.*, *Sefick v. City of Chicago*, 485 F. Supp 644, 653 (N.D. Ill. 1979) (holding that installations satirizing the mayor of Chicago and his wife constituted protected speech); *see also* Vetter & Roche, *supra* note 103, at 9. *But see* *Close v. Lederle*, 424 F.2d 988, 990–91 (1st Cir. 1970) (holding that the nudity and sexual references in defendant’s work did not constitute political or social speech and could therefore be removed from display in a university corridor).

106. *See* *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 148 (3d Cir. 2013) (citing *Brown v. Entm’t Merchs. Ass’n*, 131 S. Ct. 2729, 2733 (2011)).

107. *See* *Schad v. Borough of Mount Ephraim*, 452 U.S. 61, 65 (1981).

108. *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 459 (Cal. 1979) (noting that the “line between the informing and the entertaining is too elusive” to warrant a distinction in the protection that each type of speech receives (quoting *Winters v. New York*, 333 U.S. 509, 510 (1948))).

likely that others would understand the message conveyed.¹⁰⁹ In a right of publicity case, if the speech at issue is expressive, the court will likely find that the interest in free speech outweighs the right of publicity interest.¹¹⁰

Commercial speech is “expression related solely to the economic interests of the speaker and its audience.”¹¹¹ Critics note that the distinction between expressive and commercial speech makes little sense in the modern “commercial culture,” where commercial speech often contains expressive elements.¹¹² Nonetheless, commercial speech generally receives lesser First Amendment protection than noncommercial speech¹¹³ because it has a “high potential for consumer deception and unjust enrichment.”¹¹⁴ Commercial speech is protected by the First Amendment only if it is not misleading and concerns “lawful activity.”¹¹⁵ The government can constitutionally restrict commercial speech when the restriction is justified by a substantial state interest and when the restriction is narrowly tailored to serve that interest.¹¹⁶ In situations where commercial and noncommercial speech is “inextricably intertwined,” the speech is analyzed under the standard of review used for noncommercial speech.¹¹⁷ Commercial speech is often at issue in right of publicity cases,¹¹⁸ and generally the right of publicity will outweigh the First Amendment where speech is commercial.¹¹⁹

109. *Texas v. Johnson*, 491 U.S. 397, 399 (1989) (holding that burning the American flag was a form of communication and therefore was “speech” protected by the First Amendment).

110. Tan, *supra* note 11, at 21; *see also infra* Part I.B.2.

111. *Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 561 (1980). Such speech “does no more than propose a commercial transaction.” *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 776 (1976) (Stewart, J., concurring). However, not all works sold for profit are considered commercial speech. *See Simeonov v. Tiegs*, 602 N.Y.S.2d 1014, 1017–18 (Civ. Ct. 1993).

112. David L. Hudson, Jr., *Legal Almanac: The First Amendment: Freedom of Speech* § 6.9 (2012); *see also White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1520 (9th Cir. 1993) (Kozinski, J., dissenting) (“In our pop culture, where salesmanship must be entertaining and entertainment must sell, the line between the commercial and noncommercial has not merely blurred; it has disappeared.”).

113. *Cent. Hudson*, 447 U.S. at 566. Although the Supreme Court initially considered that commercial speech did not deserve any protection, *see Valentine v. Chrestensen*, 316 U.S. 52, 55 (1942), *overruled by Payne v. Tennessee*, 501 U.S. 808 (1991). The Court has since recognized the value of commercial speech. *See City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 420 (1993).

114. Kwall, *supra* note 5, at 52.

115. *Id.* at 75 n.127.

116. *Cent. Hudson*, 447 U.S. at 565–66.

117. *See Riley v. Nat’l Fed’n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988); *see also Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (9th Cir. 2001) (holding that any commercial aspect of the defendant’s product was “inextricably entwined” with expression and, therefore, was fully protected).

118. Tan, *supra* note 11, at 16 (noting that many right of publicity claims involve the unauthorized use of a celebrity in advertisements).

119. *Id.* at 21–22; *see, e.g., Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1002 (9th Cir. 2001); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397–99 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460, 462–64 (9th Cir. 1988).

3. How the Distinction Between Expressive and Commercial Speech Impacts the Right of Publicity Analysis

The following two cases illustrate how the distinction between expressive and commercial speech affects the right of publicity analysis. Both cases were brought under New York's right to privacy statute.¹²⁰ Although a right to privacy statute, it is sufficiently broad to encompass the right of publicity as well.¹²¹ New York's privacy statutes prohibit the unauthorized use of another's image for advertising and trade purposes.¹²² This limitation enables courts to balance First Amendment interests against government interests in restricting commercial speech.¹²³ However, this limitation does not prohibit all profitable use of another's image. In *Simeonov v. Tiegs*,¹²⁴ the court held that an artist could sell "at least a limited number of copies" of artwork that includes another's likeness, without violating New York privacy law.¹²⁵

In *Hoepker v. Kruger*,¹²⁶ plaintiff Thomas Hoepker, a German photographer, created a photographic image of plaintiff Charlotte Dabney in 1960.¹²⁷ Thirty years later, defendant Barbara Kruger created a collage of photographs that incorporated Hoepker's 1960 piece of Charlotte Dabney.¹²⁸ Krueger then sold this collage to the Museum of Contemporary Art Los Angeles.¹²⁹ Hoepker and Dabney filed suit in the Southern District of New York, alleging violation of Dabney's right to privacy.¹³⁰

Dabney's claim satisfied three out of four elements for a right to privacy claim in New York: (1) her image had been used, (2) without her consent, (3) in New York State.¹³¹ Therefore, the court set out to determine whether the fourth element, that this use was "for advertising purposes or for the purposes of trade," had been satisfied.¹³² The court found that "advertising that is undertaken in connection with a use protected by the First Amendment falls outside the statute's reach."¹³³ Thus, because the Kruger

120. New York has codified the right to privacy. N.Y. CIV. RIGHTS LAW §§ 50–51 (McKinney 1995).

121. Pesce, *supra* note 79, at 782. By passing these statutes, the legislature sought to "protect against the commercial appropriation of a plaintiff's name or likeness." *Foster v. Svenson*, No. 651826/2013, 2013 WL 3989038, at *1 (N.Y. Sup. Ct. Aug. 5, 2013).

122. *See* N.Y. CIV. RIGHTS LAW §§ 50–51; *see also* *Hoepker v. Kruger*, 200 F. Supp. 2d 340, 348 (S.D.N.Y. 2002).

123. *Kruger*, 200 F. Supp. 2d at 348 (noting that "[t]he advertising and trade limitation in New York's privacy statutes was crafted with the First Amendment in mind.>").

124. 602 N.Y.S.2d 1014 (Civ. Ct. 1993).

125. *Id.* at 1018.

126. 200 F. Supp. 2d 340 (S.D.N.Y. 2002).

127. *Id.* at 342.

128. *Id.*

129. *Id.*

130. *Id.* at 344.

131. *Id.* at 348.

132. *Id.*

133. *Id.* at 350.

composite was protected artistic expression, it outweighed Dabney's right to privacy.¹³⁴

The New York Supreme Court reached the same conclusion years later in *Foster v. Svenson*.¹³⁵ During the course of a year, photographer Arne Svenson photographed strangers inside their apartments.¹³⁶ He displayed these photographs, titled "The Neighbors," in an exhibit at a New York gallery.¹³⁷ Svenson did not have consent to photograph any of the people portrayed in "The Neighbors" or to display the photographs.¹³⁸

Plaintiffs, the parents of two young children who had appeared in Svenson's photographs, filed suit pursuant to New York Civil Rights Law sections 50 to 51.¹³⁹ One of the photographs portrayed a "clearly identifiable" image of one child's face.¹⁴⁰ The plaintiffs claimed that these photographs had exposed the location of their apartment, which compromised "the security and safety of the[ir] children."¹⁴¹

The court noted that an artistic work that uses another's image is not simply "advertising or trade," but is protected speech, which may be sold as part of "the right to disseminate the 'speech.'"¹⁴² Thus, the court rejected the plaintiffs' contention that because Svenson had used the photos in the media to promote his exhibition and had offered these works for sale, his actions constituted "advertising and trade" under New York Civil Rights Law sections 50 to 51.¹⁴³ The court concluded that Svenson's photographs served "more than just an advertising or trade purpose because they promote the enjoyment of art in the form of a displayed exhibition."¹⁴⁴

Noting that "it makes Plaintiffs cringe to think their private lives and images of their small children can find their way into the public forum of an art exhibition," the court nonetheless concluded that the "value of artistic expression" of Svenson's photographs outweighed any commercial value "that stem[ed] from the published photos".¹⁴⁵ Thus, the court held in favor

134. *Id.* However, the court noted that First Amendment rights do not completely negate privacy rights. *Id.* at 348.

135. No. 651826/2013, 2013 WL 3989038, at *1 (N.Y. Sup. Ct. Aug. 5, 2013).

136. *Id.*

137. See Dan Arnheim, *Right to Privacy v. Freedom of Expression in Case of "Peeping Tom" Photographer*, CTR. FOR ART LAW (July 21, 2013), <http://itsartlaw.com/2013/07/21/right-to-privacy-v-freedom-of-expression-in-case-of-peeping-tom-photographer/>.

138. *Foster*, 2013 WL 3989038, at *1. In fact, Svenson admitted: "The Neighbors don't know they are being photographed; I carefully shoot from the shadows of my home into theirs." *Id.*

139. *Id.*

140. *Id.*

141. *Id.* In their complaint, plaintiffs stated that they were "greatly frightened and angered by defendant's utter disregard for their privacy and the privacy of their children . . . [and] now fear that they must keep their shades drawn at all hours of the day in order to avoid telephoto photography by a neighbor." Adam Klasfeld, *Parents Blast Photographer for Telephoto Shots*, COURTHOUSE NEWS SERVICE (May 24, 2013, 9:15 AM), <https://www.courthousenews.com/2013/05/24/57929.htm>.

142. *Foster*, 2013 WL 3989038, at *1.

143. *Id.*

144. *Id.*

145. *Id.*

of Svenson, finding that the right to privacy yields to the First Amendment.¹⁴⁶

In *Hoepker* and *Foster*, each court found that the First Amendment interests outweighed the right to privacy interests only after determining that the speech at hand was expressive rather than commercial.¹⁴⁷ Such a determination is unnecessary in cases where the speech is part of news coverage, and therefore automatically shielded from right of publicity claims. The following section addresses this category of protected speech.

4. The Newsworthiness Doctrine: Speech Shielded from Right of Publicity Claims

Under the newsworthiness doctrine, the media may use the unauthorized image of celebrities in its “everyday news coverage.”¹⁴⁸ “News coverage” has been construed broadly to include “virtually all types of information and entertainment communicated by the media.”¹⁴⁹ Courts read the newsworthiness doctrine broadly because they believe “it is not the place of courts to determine which issues may or may not interest the general public.”¹⁵⁰ Over half of the states that have right of publicity statutes include an express media exception.¹⁵¹

While the newsworthiness doctrine gives the media broad leeway in using celebrities’ images,¹⁵² non-media defendants are generally not exempt from liability for the unauthorized use of celebrity identities even if this use has some “newsworthy content.”¹⁵³ Additionally, the newsworthiness doctrine has two significant limitations for media defendants. First, the newsworthiness doctrine does not protect publishers who use another’s identity only to “draw attention to an unrelated article.”¹⁵⁴ Second, where news coverage “destroys the total economic

146. *Id.* This decision likely shocked many, because Svenson’s work was greeted with outrage by many New Yorkers. See David Walker, *Judge Dismisses Privacy Lawsuit Against “Voyeur” Artist Arne Svenson*, PHOTO DISTRICT NEWS (Aug. 6, 2013), <http://www.pdnonline.com/news/Judge-Dismisses-Priv-8708.shtml>.

147. See *supra* notes 132, 143 and accompanying text.

148. Patrick Whitman, *Everyone’s a Critic: Tiger Woods, the Right of Publicity and the Artist*, 1 HOUS. BUS. & TAX L.J. 41, 57 (2001). The doctrine is not limited to current events but rather also applies to any story that is “accurate and deals with a matter of public interest.” Ausness, *supra* note 59, at 1030.

149. Tan, *supra* note 11, at 22. Thus, parodies and satires are protected. See J. Thomas McCarthy, *The Spring 1995 Horace S. Manges Lecture—The Human Persona as Commercial Property: The Right of Publicity*, 19 COLUM.-VLA J.L. & ARTS 129, 131 (1995).

150. Ausness, *supra* note 59, at 1030.

151. MCCARTHY, *supra* note 24, § 6.18.

152. See Ausness, *supra* note 59, at 1030; see also Tan, *supra* note 11, at 22 (noting that there is a “strong presumption in favor of the media,” and a “media defendant who invokes the newsworthiness exception often escapes liability”).

153. See Tan, *supra* note 11, at 22–23.

154. Ausness, *supra* note 59, at 1031; Whitman, *supra* note 144, at 60; see also *Grant v. Esquire, Inc.*, 367 F. Supp 876, 885 (S.D.N.Y. 1973) (finding a violation of the plaintiff’s right of publicity because the use of the plaintiff’s picture was unrelated to the content of defendant’s article).

viability of a performer's act," the court limits its protection of the media.¹⁵⁵

II. THE COURTS TRY TO RESOLVE THE TENSION BETWEEN THE RIGHT OF PUBLICITY AND THE FIRST AMENDMENT

This part explains the current approaches that the courts use to reconcile free speech and the right of publicity. Part II.A explains the only Supreme Court case to address the conflict, *Zacchini v. Howard-Scripps Broadcasting Co.*¹⁵⁶ Part II.B explores the four approaches that courts have developed in response to the Supreme Court's unclear holding of how the conflicting interests of the right of publicity and the First Amendment should be balanced. The Sixth and Second Circuits have adopted the relatedness test, which looks to the relationship between the use of a celebrity's likeness and the work as a whole.¹⁵⁷ The Missouri Supreme Court has adopted the predominant purpose test under which works that are predominantly commercial violate the right of publicity, while works that are predominantly expressive do not.¹⁵⁸ The Third Circuit and the California Supreme Court have adopted the transformative use test, which asks whether a work depicting a celebrity is artistic expression rather than a literal depiction of the celebrity.¹⁵⁹ Finally, the Eighth and Tenth Circuits use an ad-hoc balancing test that weighs the policy justifications for the right of publicity against the content creator's First Amendment interests.¹⁶⁰

In *ETW Corp. v. Jireh Publishing Inc.*, the Sixth Circuit used two tests—the transformative use test and the ad-hoc balancing test—to decide a case that involved a clash between the right of publicity and the First Amendment.¹⁶¹ Part II.C summarizes this approach, and then Part III evaluates it in greater detail.

A. The Supreme Court Creates an Unclear Standard

The Supreme Court has addressed the conflicting interests of the First Amendment and the right of publicity only once, in *Zacchini v. Scripps-Howard Broadcasting Co.*¹⁶² *Zacchini* was an entertainer who performed a "human cannonball" act in which he was shot out of a cannon at the Geauga

155. Whitman, *supra* note 148, at 57.

156. 433 U.S. 562 (1977).

157. See *Parks v. LaFace Records*, 329 F.3d 437, 461 (6th Cir. 2003); *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989).

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

159. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 163 (3d Cir. 2013); *Winter v. DC Comics*, 69 P.3d 473, 475 (Cal. 2003); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807 (Cal. 2001); *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 400–01 (Ct. App. 2011).

160. *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 823–24 (8th Cir. 2007); *Cartoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 972 (10th Cir. 1996).

161. See *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 936 (6th Cir. 2003).

162. 433 U.S. 562 (1977).

County Fair in Burton, Ohio.¹⁶³ On August 31, 1972, a reporter for Scripps-Howard Broadcasting Co. videotaped Zacchini's entire act, which lasted approximately fifteen seconds, and aired the clip on a news program.¹⁶⁴ Zacchini brought a suit in Ohio State court, claiming that Scripps-Howard Broadcasting Co. unlawfully appropriated his professional property when it publicized his act without his consent.¹⁶⁵ On certiorari, the U.S. Supreme Court sought to answer whether First and Fourteenth Amendment rights permitted Scripps-Howard Broadcasting Co. to infringe upon Zacchini's right of publicity.¹⁶⁶

1. The Majority Opinion in *Zacchini v. Scripps-Howard Broadcasting Co.*

The Court held that the First Amendment did not permit the station to broadcast the entire performance.¹⁶⁷ The Ohio Supreme Court had ruled that Scripps-Howard was "constitutionally privileged to include in its newscasts matters of public interest that would otherwise be protected by the right of publicity."¹⁶⁸ The court had relied heavily on *Time, Inc. v. Hill*¹⁶⁹ to reach this conclusion.¹⁷⁰

The Supreme Court distinguished the case before it from *Time, Inc.* on two grounds. First, the Court explained that in *Time, Inc.* the Court had addressed a "false light" case rather than a case involving "appropriation" of another's identity for commercial purposes.¹⁷¹ Thus, *Time, Inc.* did not involve the rights of a performer whose name had a commercial value.¹⁷² Second, the Court distinguished the State's interests in allowing a cause of action in each case.¹⁷³ The State's interests in *Time, Inc.* was to protect the plaintiff's reputation.¹⁷⁴ The State's interest in permitting a right of publicity is in "the right of the individual to reap the reward of his endeavors."¹⁷⁵

Therefore, Scripps-Howard was not privileged to broadcast Zacchini's entire performance, because this posed "a substantial threat to the economic value of [his] performance."¹⁷⁶ Zacchini earned a living through his

163. *Id.* at 563. To watch this extraordinary feat, see Ray Zate, *Zacchini: Human Cannonball (Official Trailer)*, YOUTUBE (Aug. 7, 2013), <http://www.youtube.com/watch?v=HSizGn8vbFQ>.

164. *Zacchini*, 433 U.S. at 563–64.

165. *Id.* at 564.

166. *Id.* at 565–66.

167. *Id.*

168. *Id.* at 569.

169. 385 U.S. 374 (1967).

170. *Zacchini*, 433 U.S. at 570–71. *Time, Inc.* held that the media has the privilege to report matters of public interest, even if such reporting infringes upon privacy rights of those portrayed. *See Time, Inc.*, 385 U.S. at 388.

171. *Zacchini*, 433 U.S. at 573.

172. *See id.* at 574 (noting that *Time, Inc.* did not involve the broadcast of a performer's entire act for which he normally gets paid).

173. *See id.* at 573.

174. *See id.*

175. *Id.*

176. *Id.* at 575.

performance, and the broadcast of the entire performance for free dissuaded the public from going to the fair and paying to see the performance.¹⁷⁷ Thus, if Scripps-Howard broadcasted his entire performance, it was required to recognize Zacchini's "commercial stake in his act," and pay him.¹⁷⁸

Recognizing that individuals have an "economic incentive . . . to produce a performance of interest to the public," the Court considered that protecting performers' economic rights would increase the level of entertainment available to the public, and thereby advance First Amendment goals.¹⁷⁹

2. The Dissenting Opinion in *Zacchini v. Scripps-Howard Broadcasting Co.*

Justice Powell, joined by Justices Brennan and Marshall, dissented primarily because they were concerned with the majority's focus on the broadcast of the "entire act."¹⁸⁰ Justice Powell noted that the majority's "repeated incantation of a single formula: 'a performer's act'" did not provide a clear standard.¹⁸¹ Moreover, Justice Powell considered the majority's opinion insensitive to First Amendment interests, noting that the broadcast by Scripps-Howard was a "routine example of the press' fulfilling the informing function so vital to our system."¹⁸² He explained that the majority's holding could lead to "media self-censorship;" unsure of what portrays an "entire act," broadcasting stations may decline to cover even "clearly newsworthy events."¹⁸³ In this case, the public is deprived of the values that the First Amendment fosters.¹⁸⁴

The dissent proposed a different analytical framework from the one employed by the majority.¹⁸⁵ Rather than looking to whether Zacchini's entire act had been broadcasted, the question should be how Scripps-Howard had used the film footage.¹⁸⁶ Under this framework, a news broadcast is protected unless the plaintiff can demonstrate that the news broadcast was a "subterfuge or cover for private or commercial exploitation."¹⁸⁷ Because a plaintiff like Zacchini had made himself public through his performance, it would be inconsistent with the principles of the First Amendment for him to recover for "routine" news coverage.¹⁸⁸

177. *Id.* at 575–76.

178. *Id.* at 578.

179. *Id.* at 575–76; *see also* Ausness, *supra* note 59, at 1035.

180. *Zacchini*, 433 U.S. at 580–81 (Powell, J., dissenting); *see also* Samuelson, *supra* note 8, at 854.

181. *Zacchini*, 433 U.S. at 580–81; *see also* Ausness, *supra* note 59, at 1035 (noting that the "entire act" standard does not provide guidance about the extent to which the First Amendment protects against the appropriation of something less than an entire act).

182. *Zacchini*, 433 U.S. at 579–80.

183. *Id.* at 580–81.

184. *Id.* at 581.

185. *Id.*

186. *Id.*

187. *Id.*

188. *Id.*

While this “routine news” test has been less criticized than the majority opinion, it too creates uncertainty.¹⁸⁹ Distinguishing between routine news and commercial entertainment, as Justice Powell proposed, is difficult because many news shows have both commercial and entertainment components.¹⁹⁰

3. What Did *Zacchini* Establish?

Zacchini demonstrates that the right of publicity can outweigh First Amendment interests.¹⁹¹ However, the majority focused on the narrow situation of when a television company has broadcasted a performer’s entire act, rather than on the broader question of when the use of one’s name or likeness violates his publicity rights.¹⁹² Thus, no general rule can be clearly derived from *Zacchini* to resolve the conflict between the First Amendment and the right of publicity.¹⁹³

Unpredictability has always been considered especially detrimental when free speech is at issue.¹⁹⁴ Many exercises of the First Amendment include portrayals of celebrities as part of movies, television shows, and plays.¹⁹⁵ However, the threat of liability due to a finding that such works have infringed on a celebrity’s right of publicity may deter production of such works.¹⁹⁶ This is especially true if those who have produced the works do not have insurance against sanctions because “of the uncertainty of the prevailing legal rules.”¹⁹⁷

Additionally, overprotecting the right of publicity may create “a monopoly over the raw material of creative expression.”¹⁹⁸ On the other hand, under-protecting the right of publicity may reduce incentives for celebrities to engage in creative endeavors.¹⁹⁹

Since *Zacchini*, the Supreme Court has denied numerous writs of certiorari asking the Court to create a uniform standard for balancing the right of publicity against the First Amendment.²⁰⁰ Without guidance from

189. Ausness, *supra* note 59, at 1035; *see also* Haines, *supra* note 7, at 229.

190. Ausness, *supra* note 59, at 1035.

191. *See* Hart v. Elec. Arts, Inc., 717 F.3d 141, 167 (3d Cir. 2013).

192. Volokh, *supra* note 20, at 906.

193. *See* McCarthy, *supra* note 24, § 8.27; *see also* Tan, *supra* note 11, at 19 (noting that *Zacchini* is of “limited precedential value”).

194. Felcher & Rubin, *supra* note 21, at 1594 (“First Amendment rights require ‘breathing space,’ and uncertainty about the legal standards that control these rights is regarded as having a ‘chilling effect’ on freedom of expression.”).

195. *Id.* at 1595.

196. *Id.*

197. *Id.*

198. *See* *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 976 (10th Cir. 1996).

199. *See id.*

200. *See, e.g.,* C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P., 505 F.3d 818, 820 (8th Cir. 2007), *cert. denied*, 533 U.S. 1090 (2008); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001), *cert. denied*, 534 U.S. 1078 (2002); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 208 F.3d 885 (10th Cir. 2000), *cert. denied*, 531 U.S. 873 (2000).

the Supreme Court, the lower courts have created various tests for addressing the tension between the First Amendment and the right of publicity.

B. Four Tests Emerge in Response to Zacchini

In line with the doctrine of constitutional avoidance,²⁰¹ many courts facing a conflict between the First Amendment and publicity rights interpret the right of publicity narrowly so as to avoid the constitutional question regarding the First Amendment.²⁰² However, the conflict cannot always be avoided. Therefore, the lower courts have created four tests in an attempt to strike a balance between the competing interests in right of publicity cases: the relatedness test, the predominant purpose test, the transformative use test, and the ad-hoc balancing test.²⁰³ This section describes all four tests; however, particular emphasis is placed on the transformative use test and the ad-hoc balancing test because these shape the test proposed in Part III of this Note.

1. The Relatedness Test

The relatedness test, which originated in *Rogers v. Grimaldi*,²⁰⁴ asks whether the use of the celebrity's likeness is related to the work as a whole.²⁰⁵ In *Rogers*, the appellees produced a film entitled "Ginger and Fred."²⁰⁶ The film portrayed two fictional Italian cabaret performers who had built a career in Italy by imitating the famous Hollywood duo, Ginger Rogers and Fred Astaire.²⁰⁷ Rogers alleged that the defendant's use of her first name in the title of the film confused consumers, in violation of the Lanham Act,²⁰⁸ and violated her common law right of publicity.²⁰⁹

The Second Circuit used the same test to address the Lanham Act claim and the right of publicity claim.²¹⁰ Although the right of publicity is broader than the Lanham Act,²¹¹ both laws serve similar interests. While the right of publicity protects against the unauthorized use of a celebrity's

201. See *NLRB v. Catholic Bishop of Chi.*, 440 U.S. 490, 508–09 (1979).

202. *McCarthy*, *supra* note 24, § 8.36; see also *Valentine v. C.B.S., Inc.*, 698 F.2d 430, 433 (11th Cir. 1983) (holding that a statute which prohibited the use of a person's name without their consent should be construed to avoid any constitutional issues); *Simeonov v. Tiegs*, 602 N.Y.S.2d 1014, 1018 (Civ. Ct. 1993) ("If a Court can avoid declaring a provision of law unconstitutional, it must do so.").

203. "[C]ourts have gradually constructed" a "careful balance . . . between the right of publicity and the First Amendment." *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000).

204. 875 F.2d 994 (2d Cir. 1989).

205. See *id.* at 1004–05.

206. *Id.* at 996.

207. *Id.* at 997.

208. Trademark (Lanham) Act of 1946, 15 U.S.C. § 1125(a) (2012). The Lanham Act protects the public from commercial deception. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767–68 (1992).

209. *Rogers*, 875 F.2d at 997.

210. *Id.* at 999–1002.

211. *Id.* at 1004.

image,²¹² the Lanham Act protects against the use of a celebrity's image in a way that falsely implies the celebrity's endorsement of a certain product.²¹³ Therefore, courts have observed that the "Lanham Act is the federal equivalent of a right of publicity claim."²¹⁴

The Second Circuit rejected Rogers's argument that the First Amendment only protects the author if he has no alternative means to express his idea.²¹⁵ Noting that the *Lloyd Corp. v. Tanner* "alternative avenues of communication" test²¹⁶ had been applied in trademark cases,²¹⁷ the panel rejected this test because it "does not sufficiently accommodate the public's interest in free expression."²¹⁸

Instead, the court looked to three cases that had addressed the use of a celebrity's name in a fictional or semi-fictional book or movie title.²¹⁹ Based on these cases, the court held that because the movie title "Ginger and Fred" was related to the contents of the movie (the main characters were in fact known as Ginger and Fred in Italy) and was not "a disguised

212. See MCCARTHY *supra* note 24, § 1.3.

213. See, e.g., *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395, 1399–1400 (9th Cir. 1992).

214. *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 614 (Ct. App. 2006); see also *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 937 (6th Cir. 2003).

215. *Rogers*, 875 F.2d at 998–99. This argument was based on *Lloyd Corp. v. Tanner*, where the Supreme Court determined whether a privately owned shopping center could prohibit others from distributing handbills, which were unrelated to the center's business, on its property. 407 U.S. 551, 552 (1972). The Court noted that the respondents had alternative methods of delivering their handbills, outside of the shopping complex. *Id.* at 566–67. Thus, the Court concluded: "It would be an unwarranted infringement of property rights to require them to yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist. Such an accommodation would diminish property rights without significantly enhancing the asserted right of free speech." *Id.* at 567.

216. See *Lloyd Corp.*, 407 U.S. at 567.

217. See *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402–03 (8th Cir. 1987) (holding that because defendants could convey their message without infringing the plaintiff's trademark, in other words, there existed an "adequate alternative avenue[] of communication," and they were not protected under the First Amendment); see also *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (same).

218. *Rogers*, 875 F.2d at 999. The court addressed the *Lloyd* test in its analysis of Rogers's trademark infringement claim; however, the argument that it does not accommodate the public's interest in free expression was applied to the right of publicity in *Cardtoons, L.C. v. MLB Players Ass'n*, 95 F.3d 959, 971 (10th Cir. 1996). See also *infra* notes 309–10 and accompanying text.

219. *Rogers*, 875 F.2d at 1004. In *Hicks v. Casablanca Records*, the court found no right of publicity claim where it was obvious to the public that an event depicted in a movie was fictional. 464 F. Supp. 426, 433 (S.D.N.Y. 1978). In *Frosch v. Grosset & Dunlap, Inc.*, New York's appellate division said that the right of publicity did not prohibit the use of a celebrity's name in a title as long as the work was not "simply a disguised commercial advertisement for the sale of goods or services." 427 N.Y.S.2d 828, 829 (App. Div. 1980). In *Guglielmi v. Spelling-Goldberg Productions*, Justice Newmann noted that free expression would be significantly reduced if authors could not write fictional stories depicting prominent individuals, and thus concluded that the use of a celebrity's name would not infringe on the celebrity's right of publicity as long as the use was not "wholly unrelated" to the celebrity. 603 P.2d 454, 457 n.6 (Cal. 1979) (Newman, J., concurring).

advertisement” for the sale of a product or service, it did not violate the Oregon common law right of publicity.²²⁰

The Sixth Circuit adopted the *Rogers* approach in *Parks v. LaFace Records*.²²¹ In *Parks*, Rosa Parks, an international symbol of the civil rights movement,²²² sued record producers LaFace Records and the rap duo OutKast, alleging that the musicians had violated her right of publicity with their hit single song titled “Rosa Parks.”²²³

Noting that the Third Restatement of the Unfair Competition supports the *Rogers* formulation,²²⁴ the court applied *Rogers* to determine “the artistic relevance of the title, *Rosa Parks*, to the content of the song.”²²⁵ Accordingly, it looked to the song lyrics, specifically, “Ah ha, hush that fuss. Everybody move to the back of the bus.”²²⁶ Although OutKast’s song was not about Rosa Parks “in a strictly biographical sense,” and OutKast admitted that they had never intended the song to be about Rosa Parks, OutKast’s use of her name and the phrase “move to the back of the bus” could be considered a reference to Rosa Parks.²²⁷ Thus, the court found that the title of the song was not ‘wholly unrelated’ to the content of the song and precluded summary judgment on OutKast’s First Amendment defense.²²⁸

The relatedness test has been criticized because it was created in response to a claim under the Lanham Act.²²⁹ The right of publicity is broader than trademark law, and therefore any right of publicity test should have a broader scope than a trademark law test.²³⁰ Additionally, because the analysis focused entirely on the title of a work, the *Rogers* concurrence cautioned that the “unique case” would be an “inappropriate vehicle for fashioning a general rule.”²³¹ Finally, the relatedness test has been criticized because it has been applied inconsistently.²³² While the Sixth Circuit used the relatedness test to resolve a right of publicity issue in *Parks v. LaFace Records*, just a few months later, in *ETW Corp. v. Jireh*

220. *Rogers*, 875 F.2d at 1002.

221. 329 F.3d 437 (6th Cir. 2003).

222. *Id.* at 442.

223. *Id.*

224. *Id.* at 461 (“Use of another’s identity in a novel, play, or motion picture is . . . not ordinarily an infringement [of the right of publicity, unless] the name or likeness is used solely to attract attention to a work that is not related to the identified person.” (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (1995))).

225. *Id.* at 442.

226. *Id.*

227. *Id.* at 452–53.

228. *Id.* at 461.

229. *See Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 157 (3d Cir. 2013).

230. *Id.* (noting that the relatedness 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 profit from one’s own identity”).

231. *Rogers v. Grimaldi*, 875 F.2d 994, 1006 (2d Cir. 1989) (Griesa, J., concurring).

232. *See Hart*, 717 F.3d at 156.

Publishing Inc., it declared that the relatedness test is not applicable to right of publicity claims.²³³

2. The Predominant Purpose Test

Under the predominant purpose test adopted in *Doe v. TCI Cablevision*,²³⁴ an unauthorized use of an individual's identity violates the individual's right of publicity only if the use is "predominantly commercial," while a "predominantly expressive" use of the individual's identity does not violate his or her right of publicity.²³⁵ Noting that right of publicity cases focus on whether the use of a person's identity is "expressive" or "commercial,"²³⁶ the Missouri Supreme Court considered that the relatedness test and the transformative use test did not give sufficient thought to the fact that many uses of a person's identity could have both expressive and commercial elements.²³⁷

Therefore, the court applied the predominant purpose test,²³⁸ finding that it "better addresses the cases where speech is both expressive and commercial."²³⁹ Under this test, a work that "predominantly exploits the commercial value of an individual's identity" violates the individual's right of identity even if the work has some expressive components.²⁴⁰ On the other hand, a work whose purpose is predominantly expressive should receive First Amendment protection in a right of publicity claim.²⁴¹

With this framework, the court analyzed Anthony "Tony" Twist's right of publicity claim against Todd McFarlane Productions, Inc.²⁴² Plaintiff, Tony Twist, was a hockey player who played for the Quebec Nordiques, and who was known for his "tough-guy 'enforcer'" persona.²⁴³ In 1992, McFarlane created a comic book that included a "tough-guy 'enforcer'" character name Anthony "Tony Twist" Twistelli.²⁴⁴ In 1994, in a response to fan questions, McFarlane admitted that the comic book character Tony Twist was the name of a hockey player for the Quebec Nordiques.²⁴⁵

233. See *ETW Corp. v. Jireh Publ'g Inc.*, 332 F.3d 915, 936 (6th Cir. 2003).

234. 110 S.W.3d 363 (Mo. 2003).

235. *Id.* at 374.

236. *Id.* at 373 (noting that while use of a person's likeness in news and creative works is expressive speech, and therefore fully protected, use of a person's likeness for "purely commercial purposes" is commercial speech and generally not protected).

237. *Id.* at 373-74 (noting that the relatedness test and the transformative use test do not actually balance the right of publicity and First Amendment interests but instead automatically grant First Amendment protection to works that are expressive and deny protection to works that are commercial).

238. This test was initially proposed by intellectual property litigator, Mark Lee. See Mark Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 500-01 (2003).

239. *Doe*, 110 S.W.3d at 374.

240. Lee, *supra* note 233, at 500.

241. *Id.*

242. *Doe*, 110 S.W.3d at 366.

243. *Id.*

244. *Id.*

245. *Id.*

The court found that the defendants had used Twist's identity for commercial gain, yet there was also an expressive element to the use of his name "as a metaphorical reference to tough-guy 'enforcers.'"²⁴⁶ Comparing the commercial and expressive components of the comic book character, the court found that the use of Twist's name did not serve as an "artistic or literary expression," but instead had become "predominantly a ploy" to sell merchandise.²⁴⁷ Thus, Tony Twist's right of publicity trumped McFarlane's free speech rights.²⁴⁸

Jurisdictions outside of Missouri have not adopted the predominant purpose test.²⁴⁹ Critics note that the test does not balance free speech and right of publicity values.²⁵⁰ Instead, the test requires judges to look to artists' motivations in creating works.²⁵¹ This inquiry does not offer an accurate analysis of the value of the art; artists are often motivated by profit, yet this does not reduce the expressive value of their works.²⁵² Additionally, the test does not provide guidelines for determining when a work is "predominantly expressive."²⁵³

3. The Transformative Use Test

Under the transformative use test, a work depicting a celebrity does not infringe on the celebrity's right of publicity if it is the artist's creative expression rather than a literal depiction of the celebrity.²⁵⁴ This test was developed in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,²⁵⁵ where Comedy III Productions, Inc., the registered owner to a comedy act known as the Three Stooges, brought suit against Saderup, an artist who specialized in charcoal drawings of celebrities.²⁵⁶ Saderup's drawings were used to create lithographic prints on T-shirts.²⁵⁷ Without obtaining Comedy III's permission, Saderup sold lithographs and T-shirts bearing an image of The Three Stooges.²⁵⁸

The California Court of Appeal ruled in favor of Comedy III, concluding that Saderup's works did not receive First Amendment protection because "they were reproductions rather than original works of art."²⁵⁹ On appeal, the Supreme Court of California noted that reproductions are also entitled to

246. *Id.* at 374.

247. *Id.*

248. *Id.*

249. Tan, *supra* note 11, at 29. The Third Circuit has called the test "subjective at best, [and] arbitrary at worst." *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 154 (3d Cir. 2013).

250. See Tan, *supra* note 11, at 29–30; see also Michael S. Kruse, *Missouri's Interfacing of the First Amendment and the Right of Publicity: Is the "Predominant Purpose" Test Really That Desirable?*, 69 MO. L. REV. 799, 816 (2004).

251. See Kruse, *supra* note 245, at 815–16.

252. *Id.*

253. Tan, *supra* note 11, at 30.

254. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001).

255. 21 P.3d 797 (Cal. 2001).

256. *Id.* at 800–01.

257. *Id.* at 800.

258. *Id.* at 800–01.

259. *Id.* at 799.

First Amendment protection and chose to resolve the issue by analyzing the works themselves.²⁶⁰

The court drew on the “fair use” analysis from copyright law and looked to “the purpose and character of use” of works which threatened one’s right of publicity.²⁶¹ The purpose of looking into this fair use factor was to determine whether a new work is “transformative.”²⁶² Thus, the court held that the balance between the right of publicity and the First Amendment turns on “whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.”²⁶³ The First Amendment protects works with transformative elements—that is, works that “add[] something new, with a further purpose or different character, altering the first [work] with new expression, meaning, or message.”²⁶⁴

To determine whether a work is transformative, courts may consider whether the value of the work derives “primarily from the fame of the celebrity depicted.”²⁶⁵ If the value of the work comes not from the depicted celebrity’s fame but rather from “the creativity, skill, and reputation of the artist,” the work is likely sufficiently transformative.²⁶⁶

Based on the transformative use test, the court concluded that the right of publicity outweighed Saderup’s First Amendment rights.²⁶⁷ The court compared Saderup’s works to Andy Warhol’s silkscreens, which depicted images of Marilyn Monroe, Elizabeth Taylor, and Elvis Presley.²⁶⁸ It observed that while Warhol distorted the celebrities’ images to convey a “social comment on the dehumanization of celebrity itself,” Saderup’s goal was to create “literal, conventional depictions of the Three Stooges so as to exploit their fame.”²⁶⁹ The court considered that protecting Saderup’s works would eviscerate the right of publicity entirely because celebrities would no longer have sole control over the use of their images.²⁷⁰

260. *Id.*

261. *Id.* at 808. The court looked to copyright law because both laws are similar in that they encourage creativity by incentivizing entertainers with personal profit. *See* Ausness, *supra* note 59, at 989.

262. *Comedy III*, 21 P.3d at 809.

263. *Id.*

264. *Id.* at 808. Transformative elements include parody, factual reporting, fictionalized portrayal, heavy-handed lampooning, and subtle social criticism. *Id.* at 809.

265. *Id.* at 810.

266. *Id.*

267. *Id.* at 799.

268. *Id.* at 811.

269. *Id.* *But see* *Winter v. DC Comics*, 69 P.3d 473, 476 (Cal. 2003) (holding that a comic book featuring “half-worm, half-human” creatures had sufficiently transformed the plaintiffs’ likeness and, thus, was protected by the First Amendment). In between the *Comedy III* and *Winter* spectrum is *Kirby v. Sega of America, Inc.*, in which the California Court of Appeal found a video game character sufficiently transformed because although the character was “reminiscent” of the plaintiff, there were significant differences between the plaintiff’s traits and those of the character. 50 Cal. Rptr. 3d 607, 613 (Ct. App. 2006).

270. *Comedy III*, 21 P.3d at 811.

a. *Critiques of the Transformative Use Test*

Scholars have noted three significant flaws with the transformative use test. First, the transformative use test stems from the fair use doctrine in copyright law, which is “murky and unpredictable.”²⁷¹ Second, the definition of a “transformative” work is unclear.²⁷² Third, the test places the judiciary in the position of art critic rather than judge, when deciding whether a work is transformative.²⁷³

Because the transformative use test has created uncertainty in fair use analysis,²⁷⁴ scholars criticize its expansion to right of publicity cases.²⁷⁵ When applied to copyright cases, the transformative use test furthers the goal of copyright law, which is to “encourage the production of new expressive works.”²⁷⁶ Yet, in the right of publicity context, the transformative use test has the opposite effect by limiting new expressive creations unless they are “transformative in the right of publicity sense.”²⁷⁷ For example, while Saderup’s drawing in *Comedy III* deserved copyright protection because it reflected original creation by depicting the Three Stooges realistically, it violated the right of publicity.²⁷⁸

Additionally, *Comedy III* did not create a clear definition of what constitutes a transformative use.²⁷⁹ The *Comedy III* court defined “transformative” use in three distinct ways. A transformative work is one which: (1) “contribut[es] something more than a ‘merely trivial’ variation,” (2) uses the celebrity’s likeness as only “one of the ‘raw materials’” to create an original work, and (3) alters the “expression, meaning, or message” of the celebrity’s images.²⁸⁰ These three definitions can be difficult to reconcile.²⁸¹ A work can satisfy the first two definitions without necessarily altering the “expression, meaning, or message” of the celebrity’s image.²⁸² Therefore, it can be difficult to determine what is

271. Dougherty, *supra* note 20, at 28. The phrase “transformative use” was first used in fair use cases in copyright law. See *supra* Part II.B.3. In a 1990 Harvard Law Review article, Judge Pierre Leval of the Second Circuit first explained that under the “purpose and character [test]” of the fair use doctrine, a work could be copied so long as that work was “transformative.” See Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990). Just four years later, in *Campbell v. Acuff-Rose Music, Inc.*, the Supreme Court defined transformative use as “altering the first with new expression, meaning, or message.” 510 U.S. 569, 579 (1994). The Court emphasized that a “transformative use” is central for a finding of fair use. *Id.*

272. See Dougherty, *supra* note 20, at 29.

273. See *id.* at 70.

274. *Id.* at 32; Diane Leenheer Zimmerman, *The More Things Change the Less They Seem “Transformed”*: *Some Reflections on Fair Use*, 46 J. COPYRIGHT SOC’Y U.S.A. 251, 254 (1998).

275. See Volokh, *supra* note 20, at 922; see also Dougherty, *supra* note 20, at 28.

276. Dougherty, *supra* note 20, at 32 (noting that the transformative use test requires works to “incorporate new expression”).

277. *Id.*

278. See *id.*

279. Volokh, *supra* note 20, at 916.

280. *Id.* at 916–17.

281. See *id.* at 917.

282. *Id.*

transformative.²⁸³ As a result, the transformative use test has yielded inconsistent results. For instance, courts have reached opposing decisions due to different understandings of what must be “transformed” in order for a work to pass the transformative use test; it is unclear whether a work is “transformative” if the celebrity’s image has been transformed or if the work as a whole has transformative elements.²⁸⁴ Moreover, an unclear definition leaves artists confused about what sort of works they can and cannot create, which in turn may limit the types of art produced.²⁸⁵

Finally, the test allows too much subjectivity in judgment.²⁸⁶ The test requires judges to act as art critics, which is a “dangerous undertaking” for which they are unprepared.²⁸⁷ Critics of the test question “whether society would benefit from judicial art critics deciding which art adds to societal commentary and which art does not.”²⁸⁸ When judges are influenced by their aesthetic preferences in their decisions, there is a risk that they will shape the art created in the future.²⁸⁹ To guarantee protection of their artwork, artists may begin shaping their art to “meet the aesthetic preferences of judges.”²⁹⁰

However, considering that the transformative use test is applied in cases involving artistic creations, some commentators have noted that subjectivity is inevitable, and not entirely undesirable.²⁹¹ Given varying artistic tastes and preferences, judging artistic creations “objectively” is nearly impossible. Therefore, “instead of hiding behind a bright line rule with an illusory promise of objectivity,” the transformative use test acknowledges the minimal subjectivity inherent in its application.²⁹² Additionally, the *Comedy III* court constrained the subjectivity of the transformative use test

283. *See id.*

284. *Compare* Hart v. Elec. Arts, Inc., 717 F.3d 141, 169 (3d Cir. 2013) (finding that a video game with significant creative elements did not pass the transformative use test because the plaintiff’s image had not been creatively altered), *with* ETW Corp. v. Jireh Publ’g, Inc., 332 F.3d 915, 938 (6th Cir. 2003) (finding that a work consisting of a collage of images was transformative even though the plaintiff’s image was a literal representation).

285. *See* Volokh, *supra* note 20, at 917–18.

286. *See* Jacy T. Jasmer, ETW Corp. v. Jireh Publishing, Inc.: *A Workable Standard, an Unworkable Decision*, 5 MINN. INTEL. PROP. REV. 293, 316 (2004).

287. Pete Singer, *The Three Stooges Latest Act: Attempting to Define the Scope of Protection the First Amendment Provides to Works of Art Depicting Celebrities*, *Comedy III Productions, Inc. v. Saderup, Inc.*, 21 P.3d 797 (Cal. 2001), 27 U. DAYTON L. REV. 313, 313 (2002) (quoting *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (“It would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation . . . At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge.”)).

288. Whitman, *supra* note 148, at 44; *see also* Petition for a Writ of Certiorari at 8, *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001) (No. 01-368), 2001 WL 34116904 (noting the “elitism built into the court’s concept of art that is ‘creative’ or ‘transformative’”).

289. Alfred C. Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. CAL. L. REV. 247, 248–49 (1998).

290. *Id.*

291. *See* Jasmer, *supra* note 286, at 316.

292. *Id.* at 317.

by emphasizing that courts should not be concerned with the quality of the art at issue when deciding whether it is transformative.²⁹³

b. Justifications for the Transformative Use Test

Despite the flaws of the transformative use test, it also has several justifications. First, the transformative use test provides a uniform framework for balancing right of publicity interests against First Amendment interests.²⁹⁴ The framework of the transformative use test strikes the proper balance between the First Amendment and the right of publicity by limiting the number of situations in which a celebrity has a right of publicity claim.²⁹⁵ Works that are artistic expressions rather than the mere likeness of a celebrity do not threaten the celebrity's commercial value.²⁹⁶ The right of publicity protects individuals' economic interests in their identities; therefore determining whether a work is transformative furthers this right of publicity goal.²⁹⁷ Yet, by restricting right of publicity claims to "a very narrow universe of expressive works" (non-transformative works), the transformative use test protects the First Amendment.²⁹⁸

Additionally, the transformative use test allows for flexibility in judicial decisions.²⁹⁹ The cases that present tension between the First Amendment and the right of publicity are "unique and fact-intensive" because they involve artistic creations.³⁰⁰ With the transformative use test, courts can make "case-by-case determinations on the contribution(s) of authors to the specific piece of art at issue."³⁰¹

4. The Ad-Hoc Balancing Test

In *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, the Tenth Circuit used an ad-hoc balancing test to weigh the plaintiff's First Amendment right to freedom of expression against the defendant's right of publicity.³⁰² Cardtoons produced parody baseball trading cards portraying caricatures of major league players.³⁰³ As part of its marketing plan, Cardtoons advertised its trading cards in a May 1993 issue of *Sports*

293. See *Comedy III*, 21 P.3d at 809–10.

294. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 162 (3d Cir. 2013).

295. Jasmer, *supra* note 286, at 314–15.

296. See *Comedy III*, 21 P.3d at 808 (“[W]orks of parody or other distortions of the celebrity figure are not, from the celebrity fan’s viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect.”).

297. *Id.*

298. *Hart*, 717 F.3d at 163.

299. *Id.* at 162.

300. Jasmer, *supra* note 286, at 316.

301. *Id.*

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

303. *Id.* at 962 (noting that 71 out of 130 cards designed and produced by Cardtoons featured caricatures of baseball players on the front and “humorous commentary about their careers on the back”).

Collectors Digest.³⁰⁴ This advertisement caught the attention of the Major League Baseball Players Association (MLBPA), who issued cease and desist letters to Cardtoons and Champs Marketing, Inc., the printing company that Cardtoons had hired.³⁰⁵ In response, Cardtoons filed a suit for a declaratory judgment that its cards did not violate MLBPA members' right of publicity.³⁰⁶

The court first addressed Cardtoons's First Amendment rights, noting that the parody cards are fully protected because they provide "social commentary on public figures."³⁰⁷ The court rejected MLBPA's contention that Cardtoons's speech is less protected because it does not use a traditional medium of expression, citing numerous cases that established that the First Amendment also protects nontraditional mediums of expression.³⁰⁸ The court also rejected MLBPA's argument that Cardtoons's cards are commercial speech, noting that the cards "are not transformed into commercial speech merely because they are sold for profit."³⁰⁹

Once the court determined that Cardtoons's cards deserved full First Amendment protection, it turned to the crux of the case—whether Cardtoons's First Amendment right outweighed MLBPA players' rights of publicity.³¹⁰ First, the court rejected the defendant's contention that the *Lloyd* alternative avenues of communication test should be used.³¹¹ The court explained that restrictions on how a speaker may communicate run "a substantial risk of suppressing ideas in the process."³¹² In this case, Cardtoons could not have effectively depicted its parody without the use of player identities.³¹³ Therefore, MLBPA's attempts to enjoin the parody went to the content of the speech.³¹⁴

Instead of applying the *Lloyd* test, the court directly balanced the restriction on free speech against the government's interest in protecting the right of publicity.³¹⁵ This balancing test required two steps: first, the court analyzed "the importance of Cardtoons's right to free expression and the

304. *Id.* at 963.

305. *Id.*

306. *Id.* at 964.

307. *Id.* at 969; *see also* Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454, 460 (Cal. 1979) (Bird, C.J., concurring) (noting that the right of publicity does not prohibit "caricature, parody and satire").

308. *Cardtoons*, 95 F.3d at 969 (citing *Texas v. Johnson*, 491 U.S. 397 (1989) (flag burning) and *Schad v. Borough of Mount Ephraim*, 452 U.S. 61 (1982) (nude dancing)).

309. *Id.* at 970 (citing *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 761 (1976)).

310. *Id.*

311. *Id.* at 971.

312. *Id.*; *see also* *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (noting that a "restriction on the *location* of a speech," as in *Lloyd* is "different from a restriction on the *words* the speaker may use").

313. *Cardtoons*, 95 F.3d at 971.

314. *Id.* at 972. Content-based restraints on expression are subject to strict scrutiny, which means that such restraints are constitutional only if they advance a "compelling government interest" in the least restrictive way possible. *Solantic, L.L.C. v. City of Neptune Beach*, 410 F.3d 1251, 1258 (11th Cir. 2005).

315. *Cardtoons*, 95 F.3d at 972.

consequences of limiting that right,” and second, the court weighed “those consequences against the effect of infringing on MLBPA’s right of publicity.”³¹⁶

Addressing the first step of its analysis, the court explained the value of parodies in our society.³¹⁷ As a social criticism, parodies “expose the foolish and absurd in society.”³¹⁸ Furthermore, as a means of self-expression, parodies allow artists to add new meaning to earlier works.³¹⁹ Parodies of celebrities are especially valuable because celebrities play an important role in society.³²⁰ Therefore, a parody of a celebrity “does not merely lampoon the celebrity, but exposes the weakness of the idea or value that the celebrity symbolizes in society.”³²¹ Recognizing the value of parodies, the court noted that MLBPA’s injunction of *Cardtoons* would reduce future celebrity parodies, which impinges on the First Amendment interests in the dissemination of ideas.³²²

Next, the court evaluated society’s interest in MLBPA’s publicity right.³²³ The court applied the facts of the *Cardtoons* case to the justifications for the right of publicity.³²⁴ After a thorough analysis of the economic and noneconomic justifications for the right of publicity, the court concluded that the effect of limiting MLBPA’s right of publicity was insignificant.³²⁵

*a. Cardtoons, L.C. v. Major League Baseball Players Ass’n
Considers the Policy Justifications for the Right of Publicity*

The *Cardtoons* court identified three main policy justifications supporting the right of publicity.³²⁶ First, the right of publicity protects an individual’s personal investment in their public image and prevents others from unfairly profiting by appropriating it.³²⁷ Second, the right properly incentivizes persons toward creative effort and achievement, which enriches society.³²⁸ Finally, the right protects consumers by protecting them from

316. *Id.*

317. *Id.*

318. *Id.*

319. *See id.*

320. *Id.*; *see also* Tan, *supra* note 11, at 32–37 (describing the way in which celebrities shape individuals’ perceptions of self and society).

321. *Cardtoons*, 95 F.3d at 972 (noting that *Cardtoons*’ trading cards “comment on the state of major league baseball by turning images of our sports heroes into modern-day personifications of avarice.”).

322. *Id.* at 973 (“The last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them.”).

323. *Id.*

324. *Id.*

325. *Id.* at 976.

326. *Id.* at 973–76.

327. *Id.* at 975–76; *see also* Whitman, *supra* note 148, at 51 (“Courts have recognized that celebrities cultivate their talents and public persona and are due a right to the commercial value of their efforts in order to prevent others from ‘free riding’ on their fame.”).

328. *Cardtoons*, 95 F.3d at 973; *see also* Madow, *supra* note 9, at 178.

“deception and related marketplace harms.”³²⁹ This Note refers to these arguments as the moral argument, economic argument, and consumer protection argument, respectively. The following three sections evaluate the justifications for the right of publicity from the perspective of the *Cardtoons* court, as well as from the perspective of right of publicity scholars.

i. The Moral Argument

The moral argument that a celebrity should alone economically benefit from his likeness is based upon “visceral impulses of ‘fairness.’”³³⁰ This argument is based on three premises. First, because celebrities have invested much time and effort into creating their image, they alone should be able to control the value of that image.³³¹ Second, “no social purpose is served” by allowing others to free ride off the commercial value of a celebrity’s image.³³² Finally, the right of publicity prevents emotional injuries of celebrities who do not wish to have their names linked to any commercial uses.³³³

Scholars find that the moral argument is weak.³³⁴ Celebrities often do not create their image alone; many players, such as writers, directors, and coaches, help ensure a celebrity’s success.³³⁵ In addition to relying on the vision and marketing skills of others to create their image, celebrities draw “upon a pre-existing body of techniques, tools, and craft knowledge.”³³⁶ Moreover, a celebrity’s fame may have more to do with the interests and needs of their audience than with the celebrity’s accomplishments.³³⁷

Similarly, the *Cardtoons* court did not find the moral argument persuasive, noting that publicity rights “are meant to protect against the loss of financial gain, not mental anguish.”³³⁸ The Eight Circuit echoed the *Cardtoons* reasoning in a similar case involving the right of publicity of major league baseball players.³³⁹ Noting that noneconomic justifications for the right of publicity are unpersuasive, the Eighth Circuit considered

329. Madow, *supra* note 9, at 135; *see also Cardtoons*, 95 F.3d at 975. Such harms include consumer confusion regarding whether a “celebrity has endorsed a particular good.” Whitman, *supra* note 148, at 52 (internal quotations omitted).

330. MCCARTHY, *supra* note 24, § 2.1.

331. Madow, *supra* note 9, at 191; *see also Cardtoons*, 95 F.3d at 975 (noting that the right of publicity allows “celebrities to enjoy the fruits of their labors” (citing *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977))).

332. *Cardtoons*, 95 F.3d at 976 (noting that the right of publicity prevents unjust enrichment); *see also Zacchini*, 433 U.S. at 576.

333. *See Cardtoons*, 95 F.3d at 976.

334. *See Madow*, *supra* note 9, at 196; *see also Whitman*, *supra* note 148, at 53.

335. Whitman, *supra* note 148, at 53; *see also Madow*, *supra* note 9, at 191.

336. Madow, *supra* note 9, at 196 (“Cultural production is *always* (and necessarily) a matter of reworking, re-combining, and redeploying already-existing symbolic forms, sounds narratives, and images.”).

337. *See id.* at 189.

338. *See Cardtoons*, 95 F.3d at 976.

339. *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 824 (8th Cir. 2007).

that noneconomic interests supported by the moral argument, such as “protecting natural rights, rewarding celebrity labors, and avoiding emotional harm,” are better protected by the right to privacy.³⁴⁰

ii. The Economic Argument

The economic argument made in support of the right of publicity was the basis of the Supreme Court’s analysis in *Zacchini*.³⁴¹ The Court explained that the right of publicity incentivizes actors, artists, and athletes who enrich society with their talents to spend time and effort developing their talents if they know they can protect the use of their image.³⁴²

The *Cardtoons* court explained that the argument that the right of publicity provides an incentive for creativity had been exaggerated because celebrities earn a significant income, irrespective of the commercial value of their identities.³⁴³ Celebrities earn a living through their performances as athletes, actors, singers, and other professionals, and they would continue to earn a living even without the protections offered by the right of publicity.³⁴⁴

Noting the distinction between the value of a person’s performance and the value of his identity, the court criticized the Supreme Court’s analysis in *Zacchini*.³⁴⁵ In *Zacchini*, the plaintiff had complained of the use of his performance, not the use of his identity.³⁴⁶ The *Cardtoons* court noted that the Supreme Court’s reasoning, which was based on an incentives rationale, would be more convincing in a right of performance case than in a right of publicity case which involved the use of a person’s identity.³⁴⁷

The court considered the incentives argument to be even less persuasive in the context of celebrity parodies.³⁴⁸ The reason celebrities would likely not permit parodies of their image is not because they would not make money from the parodies but rather because they want to protect themselves from ridicule.³⁴⁹ Although the court did not deny that publicity rights

340. *Id.*

341. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576–77 (1977).

342. *Id.* at 576.

343. *Cardtoons*, 95 F.3d at 973 (comparing copyright law, which protects the primary source of an author’s income with the right of publicity which protects a commercial interest that is merely a “by-product” of the celebrity’s performance value).

344. *Id.* at 924 (noting the high compensation of many celebrities and pointing to Jim Carrey’s \$20 million paycheck for one movie). Some commentators have criticized the courts’ references to celebrities’ paychecks when determining whether there has been a violation of their right of publicity. See Melissa Desormeaux, *When Your Rights Depend on Your Paycheck: The Scary Way Courts Are Deciding Right of Publicity Cases*, 12 TUL. J. TECH. & INTELL. PROP. 277, 290 (2009). Most celebrities who bring right of publicity claims are very well paid, so the suggestion that because of this, celebrities do not have a right of publicity would leave many celebrity plaintiffs without a remedy for harm suffered. *Id.*

345. *Cardtoons*, 95 F.3d at 973.

346. See *Zacchini*, 433 U.S. at 569.

347. *Cardtoons*, 95 F.3d at 973.

348. *Id.* at 974.

349. *Id.*

provide some incentives for achievement, it concluded that those incentives were “reduced or eliminated in the context of celebrity parodies.”³⁵⁰

Next, the court addressed the argument that the right of publicity “promotes the efficient allocation of resources.”³⁵¹ According to this argument, because not everyone can commercially exploit a celebrity’s image, the value of that image is preserved.³⁵² Thus, the economic value of an identity is higher when that identity is controlled by a limited number of people.³⁵³ While the court considered this a valid argument in the context of advertising, “where repeated use of a celebrity’s likeness to sell products may eventually diminish its commercial value,” it was not persuaded by its application to non-advertising uses.³⁵⁴

iii. The Consumer Protection Argument

A final rationale for the right of publicity is that it protects consumers from “deceptive trade practices.”³⁵⁵ When advertisements depict celebrities, there is a risk that consumers will be deceived into thinking that the celebrity is endorsing the product that is being advertised.³⁵⁶ As a result, they may purchase a product that they would not have otherwise purchased.³⁵⁷ Thus, the right of publicity acts as a “mechanism for advertising regulation.”³⁵⁸

The *Cardtoons* court found this argument inapplicable to the right of publicity because the Lanham Act already addresses consumer deception in trademark law.³⁵⁹ Rather than protecting consumers, critics argue that “the right of publicity grants the celebrity an information monopoly.”³⁶⁰ The right of publicity focuses on “the *celebrity’s* interest in controlling and benefiting from the economic value of his identity” rather than on “the interest of the consuming *public* in freedom from deception.”³⁶¹

b. Examining the Merits of the Balancing Test

Arguably “one of the most significant developments in judging practice in the twentieth century,” balancing tests have been abundantly used in American jurisprudence.³⁶² The balancing test is justified on three grounds: it is “simple, descriptive, and just.”³⁶³ Balancing tests involve three

350. *Id.*

351. *Id.*

352. *Id.* at 974–75.

353. *See id.* at 975.

354. *Id.*

355. Madow, *supra* note 9, at 228.

356. *Id.*

357. *Id.* at 229.

358. *Id.* at 228.

359. *Cardtoons*, 95 F.3d at 975.

360. Whitman, *supra* note 148, at 54; *see also* Madow, *supra* note 9, at 233.

361. Madow, *supra* note 9, at 233.

362. Patrick M. McFadden, *The Balancing Test*, 29 B.C. L. REV. 585, 587 (1988).

363. *Id.* at 622.

straightforward steps.³⁶⁴ First, the interests that need to be balanced are determined; second, the elements of each interest are weighed; and third, one interest is determined to outweigh the other.³⁶⁵ This sort of analysis can often be easier than “traditional legal reasoning.”³⁶⁶ Additionally, there is simplicity in the fact that when a court engages in a balancing test, it directly states what it is doing.³⁶⁷ Thus, “the balancing test is a more accurate description of judging than the description suggested by [traditional legal reasoning].”³⁶⁸

The simple structure of the balancing test allows judges to consider all of the elements that may influence a decision.³⁶⁹ Additionally, it allows for flexibility, which leads to more nuanced judicial decisions not bound by rigid standards.³⁷⁰ Each time the balancing test is used it is applied to the facts of the case at hand, so even a balancing test that has been repeated often provides flexibility.³⁷¹

Courts have long used a balancing test to weigh society’s interest in free speech against government interests to restrain speech.³⁷² In *American Communications Ass’n v. Douds*,³⁷³ the Supreme Court stated that when faced with conflicting rights, “the duty of the courts is to determine which of these two conflicting interests demands the greater protection under the particular circumstances presented.”³⁷⁴ Thus, in *New York Times Co. v. Sullivan*,³⁷⁵ the Supreme Court balanced First Amendment interests against society’s concern with libel.³⁷⁶ Similarly, in *Miller v. California*,³⁷⁷ the Supreme Court weighed the interests of the First Amendment in assuring free discourse against the societal interest in sexually explicit conduct, finding that the First Amendment does not protect obscene material.³⁷⁸

The balancing test is “based on an attractive metaphor—the weighing of interests upon a scale of justice.”³⁷⁹ However, use of a balancing test means that there is no clear rule or standard by which a speaker can gauge whether his speech will be protected.³⁸⁰ Although there is no guarantee of how a rule will be applied to a new circumstance, when there is no rule,

364. *Id.* at 623.

365. *Id.*

366. *Id.*

367. *Id.* at 625.

368. *Id.*

369. *Id.* at 634.

370. *Id.* at 635.

371. *Id.*

372. *See Hicks v. Casablanca Records*, 464 F. Supp. 426, 431 (S.D.N.Y. 1978).

373. 339 U.S. 382 (1950).

374. *Id.* at 399.

375. 376 U.S. 254 (1964).

376. *Id.* at 283.

377. 413 U.S. 15 (1973).

378. *Id.* at 36–37.

379. McFadden, *supra* note 362, at 588.

380. *Id.*

uncertainty is guaranteed.³⁸¹ Uncertainty is especially dangerous in the context of free speech because “it tends to deter all but the most courageous (not necessarily the most rational) [speech] from entering the market place of ideas.”³⁸²

While the balancing test offers a nuanced analysis of competing interests, the lack of structure inherent in a balancing test may decrease the predictability of results.³⁸³ Nonetheless, some right of publicity scholars believe that in balancing the interests of the right of publicity against the First Amendment, the ad-hoc balancing test “best allows” courts to evaluate the harms and benefits of the parties involved based on a thorough consideration of multiple factors.³⁸⁴

C. *The Sixth Circuit Combines the Transformative Use Test and the Ad-Hoc Balancing Test*

In *ETW Corp. v. Jireh Publishing Inc.*, the Sixth Circuit balanced the right of publicity against First Amendment interests by relying on the *Comedy III* transformative use test and the *Cardtoons* ad-hoc balancing test.³⁸⁵ Plaintiff, ETW Corporation, the licensing agent of professional golfer Tiger Woods, had the exclusive right to exploit Tiger Woods’s publicity rights.³⁸⁶ When “America’s sports artist,” Rick Rush created a painting commemorating Tiger Woods’s victory at the 1997 Masters Tournament, ETW brought suit against Jireh Publishing, the publisher of artist Rick Rush for violation of Woods’s right of publicity.³⁸⁷ First, to define the right of publicity, the court referenced the Third Restatement of Unfair Competition.³⁸⁸ Next, to balance Woods’s right of publicity against Rush’s First Amendment interests, the Sixth Circuit relied on two different tests.

The court looked to the Tenth Circuit’s ad-hoc balancing test used in *Cardtoons*.³⁸⁹ In balancing Woods’s interest against free speech restriction, the court noted that Woods, like most celebrities, makes his income through

381. *Id.*; see also Emerson, *supra* note 94, at 913 (noting that the ad-hoc balancing test casts the court “loose in a vast space, embracing the broadest possible range of issues, to strike a general balance in the light of its own best judgment.”).

382. Melville B. Nimmer, *The Right to Speak from Times to Time: First Amendment Theory Applied to Libel and Misapplied to Privacy*, 56 CALIF. L. REV. 935, 939 (1968); see also Emerson, *supra* note 94, at 913 (noting that the uncertainty of the ad-hoc balancing test “makes it realistically impossible for a court . . . to . . . check the unruly forces that seek to destroy a system of free expression”).

383. Michael Madow, *Personality As Property: The Uneasy Case for Publicity Rights*, in INTELLECTUAL PROPERTY AND INFORMATION WEALTH 349–52 (Peter Yu ed., 2007).

384. Tan, *supra* note 11, at 44.

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

386. *Id.* at 918.

387. *Id.* at 918–19.

388. *Id.* at 930.

389. *Id.* at 935.

professional golf, which is an activity unrelated to his right of publicity.³⁹⁰

Thus, the court found that a print depicting Woods would likely not “reduce the commercial value of his likeness.”³⁹¹ The court further noted that Rush had “added a significant creative component of his own to Woods’s identity.”³⁹² Therefore, permitting Woods’s right of publicity to override Rush’s freedom of expression would smother Rush’s right to profit from his creativity.³⁹³ Based on this balancing of Rush’s freedom of expression and Woods’s right of publicity, the court found that “society’s interest in freedom of artistic expression” outweighed Woods’s right of publicity.³⁹⁴

Next, the court drew on the transformative use test adopted by the Supreme Court of California in *Comedy III*.³⁹⁵ The court compared Rush’s work with the work of the artist in *Comedy III*: while the artist in *Comedy III* had created “nearly photographic reproduction of the faces of The Three Stooges,” Rush’s prints combined images to “describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods’s achievement in that event.”³⁹⁶ Therefore, the court found that Rush’s work was sufficiently transformative to warrant First Amendment protection.³⁹⁷

Judge Clay’s dissent characterized the majority’s holding as “disjointed” because the majority referenced the Third Restatement of Unfair Competition, the *Cartoons* test, and the *Comedy III* test in order to reach one conclusion.³⁹⁸ Judge Clay criticized the majority’s analysis as well as its outcome, finding instead that the court should have applied the *Comedy III* transformative use test.³⁹⁹ He considered that the transformative use test “takes into account all of the competing interests while allowing for a single well-determined outcome that provides guidance and adds to the jurisprudence as a whole.”⁴⁰⁰ Applying the transformative use test to the facts of the case, Justice Clay found that Rush’s goal had been to create “literal, conventional depictions of [Tiger Woods] so as to exploit

390. *Id.* at 938. This was the same consideration weighed by the court in *Cartoons. Id.* at 937; *see also* *Cartoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 973 (10th Cir. 1996).

391. *ETW Corp.*, 332 F.3d at 938.

392. *Id.* Rush’s artistic portrayal of a “historic sporting event” conveyed a message about the value American culture places on sporting events. *Id.* at 936.

393. *Id.* at 938.

394. *Id.*

395. *Id.*

396. *Id.*

397. *Id.*

398. *Id.* at 951 (Clay, J., dissenting) (“[I]t appears that the majority engages in three separate analyses, and arrives at three separate holdings, although all of which reach the same result.”).

399. *Id.* at 951–52.

400. *Id.* at 952.

his . . . fame.”⁴⁰¹ Therefore, Judge Clay would have found that Woods’s right of publicity outweighed Rush’s freedom of expression.⁴⁰²

Commentators agree with Judge Clay that the majority’s analysis was flawed.⁴⁰³ After a thorough discussion on the background of the right of publicity and how other courts have balanced this right against the First Amendment, the court’s analysis of the case before it consists of only few paragraphs.⁴⁰⁴ Additionally, the majority combined the Lanham Act and the right of publicity analysis, making it difficult to understand which facts and law applied to which claims.⁴⁰⁵

III. A PROPOSAL FOR RESOLVING THE TENSION

A modified version of the *ETW* approach offers a workable standard for resolving the tension between the First Amendment and the right of publicity. Although courts have treated the transformative use test and the ad-hoc balancing test as two separate approaches,⁴⁰⁶ the Sixth Circuit’s use of both tests to determine one issue illustrates that the two tests actually work in conjunction to create a predictable standard for balancing the First Amendment against the right of publicity. Rather than engaging in two separate inquiries as the *ETW* court did, courts should formally incorporate the transformative use test into the ad-hoc balancing test to create a more comprehensive standard that reliably protects the competing interests at stake.

Part III.A outlines the steps a court would take under this proposed test. Part III.B explains why this proposed test offers a predictable standard for resolving the still unresolved tension between the First Amendment and the right of publicity.

A. Applying the Proposed Test

Under this proposed test, a court would begin by identifying the interests to be balanced, the right of publicity versus the First Amendment. To guide its analysis of the right of publicity, the court would call upon the transformative use test. The incorporation of the transformative test at this point is particularly effective because the extent to which a piece has been transformed can be determinative of whether the traditional justifications for recognizing the right of publicity are present.

401. *Id.* at 959.

402. *Id.* at 959–60; *see also* Tan, *supra* note 11, at 48 (noting that Jireh Publishing should not have been protected by the First Amendment).

403. *See* Jasmer, *supra* note 286, at 324–32; *see also* Tan, *supra* note 11, at 47 (noting that the majority engaged in a “tenuous application” of the transformative use test).

404. *See* Jasmer, *supra* note 286, at 326 (“The court painstakingly explained the law in each area but then failed to apply it as carefully. The decision reads as if the court suddenly became tired of thinking about the issues and uncomfortably penned a string of conclusions as fast as possible to get rid of the case.”).

405. *Id.*

406. *See, e.g.,* Hart v. Elec. Arts, Inc., 717 F.3d 141, 165 (3d Cir. 2013).

The purpose of the transformative use test is directly linked to the economic justification for the right of publicity;⁴⁰⁷ “transformative” works that represent the artist’s creative talent rather than a literal depiction of the celebrity do not offer “good substitutes for conventional depictions of the celebrity” and, therefore, do not threaten the celebrity’s commercial value that the right of publicity is meant to protect.⁴⁰⁸ Therefore, because a celebrity’s commercial interests are less likely to be directly threatened by transformative works than non-transformative works, assessing the transformative nature of a piece is relevant to evaluating the economic justifications for recognizing a right of publicity. A finding that a work is transformative would shift the balancing test in favor of the First Amendment interests, while a finding that a work is not transformative, but rather a literal depiction of the celebrity, would shift the balancing test in favor of the right of publicity.

The extent to which a piece is transformative is also helpful in determining whether moral arguments justify recognizing the right of publicity in a given case. The right of publicity recognizes that individuals invest in creating their public images and, therefore, it is only fair to allow them to own and control the value that they have created.⁴⁰⁹ Moral justifications for the right of publicity also disfavor allowing others to unjustly enrich themselves by capitalizing on the work of the celebrity whose image they are using.⁴¹⁰ However, when a piece is sufficiently transformative—that is, when a piece reflects the artist’s creativity and talent—its value comes from the labor of the artist, rather than simply from the fame of the celebrity depicted.⁴¹¹ Therefore, the artist is not unjustly enriching himself because his alterations themselves create value independent of that which comes from the celebrity depicted. Accordingly, transformative works shift the balancing test in favor of recognizing the First Amendment interests of the artist as a matter of fairness.

Transformativeness can even inform the consumer protection justifications for the right of publicity. Proponents argue that the right of publicity can be used to protect not only the interests of celebrities but also the interests of consumers who might purchase products that they incorrectly believe are endorsed by a celebrity.⁴¹² However, arguably the more transformative elements a piece has, the less likely consumers will be confused into thinking the piece represents an affiliation or approval of the celebrity it depicts.

Having used the transformative use test to guide its analysis of the right of publicity, the court would then weigh the interests of the free speech at

407. In fact, one of the questions courts may ask when applying the transformative use test is whether the work’s value derives primarily from the artist’s creativity or from the celebrity’s fame. *See supra* note 263 and accompanying text.

408. *Comedy III Prods., Inc. v. Gary Saderup*, 21 P.3d 797, 808 (Cal. 2001); *see also supra* Part II.B.3.b.

409. *See supra* note 330 and accompanying text.

410. *See supra* note 330 and accompanying text.

411. *See supra* note 264 and accompanying text.

412. *See supra* notes 353–55 and accompanying text.

issue. The greater the value the speech adds to society, the more likely it is that the First Amendment interests would outweigh the right of publicity interests.

B. Why the Proposed Test Offers a Workable Standard

The transformative use test and the ad-hoc balancing test both allow for flexibility in judicial decisions.⁴¹³ Nuanced case-by-case analysis is especially desirable when artistic creations are at issue, such as in right of publicity cases.⁴¹⁴ However, on their own, both tests present flaws that reduce the predictability of their application.⁴¹⁵ The transformative use test offers an unclear definition of what constitutes a transformative use.⁴¹⁶ As a result, cases applying this test have yielded inconsistent results.⁴¹⁷ The ad-hoc balancing test lacks a framework to guide courts in their analyses.⁴¹⁸ As a result, judges can draw on a potentially limitless range of factors that they believe should be considered when balancing the interests at stake.

By incorporating the transformative use test into the balancing test, the proposed test reduces outcome uncertainty in two significant ways. First, requiring an analysis of the transformative elements of a work allows for a more targeted consideration of the competing interests at stake. Because the transformative nature of a piece is directly relevant to determining whether the justifications for recognizing a right of publicity are present, the incorporation of the transformative use test makes the balancing test more uniform and, therefore, more predictable. Second, retaining the second part of the balancing test, which looks beyond the transformative elements of a work and addresses the value that the expression at issue adds to society, ensures that the transformative elements of a work alone are not dispositive. This, in turn, mitigates the danger that the vagueness of the transformative use test will lead to an unfair result.

Combining the transformative use test and the ad-hoc balancing test into a single inquiry builds on the strengths of each test while tempering their weaknesses. Therefore, a single unified test provides judges with the best approach for determining the line between protecting free speech and recognizing an individual's right of publicity.

CONCLUSION

Over thirty years after the Supreme Court noted the tension between the First Amendment and the right of publicity, the lower courts still lack a consistent method of resolving the conflict between these two laws. In order to maintain the right of publicity while protecting the First

413. *See supra* notes 297, 367–69 and accompanying text.

414. *See supra* notes 298–99 and accompanying text.

415. *See supra* Part II.B.3.a; notes 379–82 and accompanying text.

416. *See supra* notes 279–83 and accompanying text.

417. *See supra* notes 282–84 and accompanying text.

418. *See supra* notes 380–81 and accompanying text.

Amendment, it is crucial that the courts adopt a uniform standard for balancing the right of publicity against the freedom of expression.

The test proposed in this Note, which is based off of the Sixth Circuit's approach in *ETW Corp. v. Jireh Publishing Inc.*, offers such a standard. Combining two already established tests benefits from the best elements of each test, while reducing their limitations. Therefore, courts should adopt the proposed test because it creates a predictable standard for balancing the First Amendment against the right of publicity.