The right of publicity protects a person’s name, likeness and other indications of identity from commercial exploitation by others without permission. Despite its recognition and growing acceptance by courts during the twentieth century, the right of publicity remains ‘fundamentally constrained by the public and constitutional interest in freedom of expression’. This article provides an overview of how US courts have addressed right-of-publicity claims targeting expressive works. First, it looks at the protection that courts have provided to traditional expressive works like books, movies, visual art and songs. Second, it examines the lack of coherence in case law addressing right-of-publicity claims against non-traditional expressive works like comic books and video games, and the proliferation of competing First Amendment tests that courts have applied.

**Traditional expressive works**

The tension between the right of publicity and the First Amendment is less problematic when a right-of-publicity or false-endorsement claim targets the use of a celebrity’s name or likeness in commercial advertising or promotion - in other words, commercial speech. In such cases, the celebrity is likely to prevail.

However, when such claims target expressive works, the tension with the First Amendment is greater, but courts have generally provided broad protection to traditional expressive works such as books, movies, songs and visual art. They have done so either by construing the requirement that a use be ‘commercial’ narrowly to exclude expressive works or by recognizing an independent First Amendment defense.

For example, courts have rejected right-of-publicity claims based on biographies of Marilyn Monroe and Howard Hughes. They have also dismissed right-of-publicity claims targeting docu-dramas and biographical films, such as the claims brought by the families of the fishermen depicted in ‘A Perfect Storm’ and Bobby Seale’s claim over use of his likeness in a movie about the Black Panther movement. In the realm of visual art, the Sixth Circuit held that the First Amendment protected a painting depicting Tiger Woods at the Masters with likenesses of famous golfers
of the past looking down at him. Bob Dylan won a case over the use of the name ‘Patty Valentine’ in his famous song about Rubin ‘Hurricane’ Carter.

Non-traditional expressive works
One might therefore expect the courts to carry this trend forward when it comes to non-traditional expressive works, and to some extent they have done so successfully with fantasy sports games and trading cards. On the other hand, courts have struggled to balance the right of publicity against the First Amendment in cases involving comic books and video games, and the case law has produced confusing and conflicting results. The proliferation of different legal tests threatens to chill constitutionally protected expression.

Fantasy sports and trading cards
Fantasy sports games have produced First Amendment – friendly decisions, including C.B.C. Distribution and Marketing v. Major League Baseball Advanced Media where the Eighth Circuit applied a balancing test and held that the defendant’s First Amendment interest in drawing on baseball player names and statistics for its fantasy baseball products outweighed the economic interests protected by the right of publicity. Cases involving trading cards have led to a similar result. In Cardtoons, L.C. v. Major League Baseball Players Association, the Tenth Circuit also applied a balancing test and held that the defendant’s First Amendment interest in creating trading cards parodying famous athletes outweighed the interests of professional baseball players. As helpful as these cases are, their ad hoc balancing approach does not afford adequate guidance for future courts or content creators.

Comic books
Comic books have not fared as well as fantasy sports games or trading cards. In the same year, two right-of-publicity cases with similar facts resulted in diametrically opposite results. In Doe v. TCI Cablevision, the Missouri Supreme Court adopted a ‘predominant-use’ test in a right-of-publicity claim targeting a comic book that used ‘Tony Twist’ as the nickname for a fictional mafia boss inspired by the plaintiff’s real-life persona as an NHL ‘enforcer’. The court held that the comic book was not protected by the First Amendment because its use of the plaintiff as a literary device “[had] very little literary value compared to its commercial value” and was “predominantly a ploy to sell comic books.”
This ruling led to a $15 million judgment that forced the defendant into bankruptcy.

By contrast, in Winter v. D.C. Comics, the California Supreme Court applied its ‘transformative-use’ test and held that another comic book’s use of fictional characters inspired by the real-life Winter Brothers was protected by the First Amendment. So far, no other court has adopted the Missouri Supreme Court’s ‘predominant-use’ test from Doe, but this constitutionally suspect test — which is highly subjective and hinges on the creator’s profit motivation — still lingers as a question mark for content creators. Several courts have adopted the California Supreme Court’s transformative-use test, but that test has proved difficult to apply.

Video games

The right-of-publicity case law involving video games highlights the difficulty that some courts have faced in extending First Amendment protections to non-traditional expressive works. This is perhaps surprising given the U.S. Supreme Court’s recognition that interactive video games, “like the protected books, plays and movies that preceded them,” are core expressive works and “as much entitled to the protection of free speech as the best of literature,” (Brown v. Entertainment Merchants Association). In Kirby v. Sega of Am., Inc., and Romantics v. Activision Publishing, Inc the courts did not hesitate to afford video games the same protection against right-of-publicity claims enjoyed by more traditional forms of expression.

But some courts have hesitated to do so in cases involving video games that depict their subjects realistically. The inconsistency in the case law is well illustrated by the right-of-publicity cases pending against one video game publisher, Electronic Arts Inc. (EA). Former college and pro football players have sued EA in several actions across the country for allegedly using their likenesses in EA’s Madden NFL and NCAA Football games. Although both games are visually realistic, game play is fictional and driven by user choices and skills; the games do not recreate or imitate real-life or historical football games.

Three separate district courts in the Ninth Circuit have reached disparate conclusions regarding these similar games. In Brown v. Electronic Arts the district court granted EA’s motion to dismiss football legend Jim Brown’s false-endorsement claim under the Lanham Act. Applying the Rogers test, the court held that the First Amendment defeated Brown’s claim because the use of his image was clearly relevant to a game about NFL football and his mere presence in the game could not explicitly mislead consumers into thinking he endorsed the game. Just a few months later, in Keller v. Electronic Arts, Inc., another district court denied EA’s anti-SLAPP motion to strike a right-of-publicity claim arising from NCAA Football. Because the court dealt with a right-of-publicity claim under California state law, it applied the ‘transformative-use’ test rather than the Rogers test. It concluded that EA’s use of the plaintiff’s likeness was not sufficiently transformative because EA realistically depicted him as “what he was: the starting quarterback for Arizona State
University.” Most recently, a third district court decision followed Keller, denying EA’s motion to strike right-of-publicity claims targeting the use of retired players in Madden NFL.

At the same time these cases were being litigated in California, former Rutgers quarterback Ryan Hart sued EA in federal district court in New Jersey for allegedly using his likeness in NCAA Football. In Hart v. Electronic Arts, the court granted EA summary judgment on Hart’s right-of-publicity claim, concluding that it was barred by the First Amendment irrespective of whether California’s ‘transformative-use’ test or the Rogers test was applied. Applying the transformative test, the court concluded that EA’s alleged use was transformative because the game’s interactive features allowed video-game users to alter the appearance and characteristics of the virtual college players and because the game featured numerous independent elements created by EA. Applying the Rogers test, the court easily concluded that the alleged use of Hart’s likeness and statistics was clearly relevant to a game about college football and was not a disguised advertisement for an unrelated product. The plaintiff appealed the decision to the Third Circuit, and oral argument is scheduled for September 2012. Hart argues, predictably, that the Third Circuit should adopt the Missouri Supreme Court’s ‘predominant-use’ test or, in the alternative, follow the Keller court’s interpretation of the ‘transformative-use’ test.

What is remarkable—and disturbing for content creators—is that the courts in the EA cases have thus far reached different conclusions on similar facts, often because different First Amendment tests are being applied. What content creators need is certainty to provide the breathing space to generate new expressive works. Previously, courts were successful in providing that breathing space to traditional media. But, at least so far, courts have failed to do the same for non-traditional media and decisions like Keller even call into question—presumably unwittingly—the older cases involving biography, docu-drama and the like. Ideally, the Third and the Ninth Circuits will use the EA cases as an opportunity to clarify that non-traditional media must be treated like traditional media, and will bring greater certainty to content creators. Failing that, the U.S. Supreme Court may be called upon to clarify the appropriate approach to be followed by the lower courts.

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Footnotes

1 Section 43(a) of the Lanham Act provides for a ‘false endorsement’ cause of action, under which a celebrity’s name or likeness is treated like a trademark. It has been described as the federal equivalent of a state-law right-of-publicity claim.

2 The U.S. Supreme Court has held that whether speech is sold for profit is legally irrelevant to whether it receives protection under the First Amendment, yet Doe holds that a profit motive can disqualify speech from First Amendment protection.

3 The Ninth Circuit has adopted the test devised by the Second Circuit in Rogers v. Grimaldi, for false-endorsement claims under the Lanham Act.