
A Change of *Hart*: An Argument Favoring the Transformative Use Test in Right-of-Publicity Cases

*“It is admittedly not a simple matter to develop a test that will unerringly distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity. Certainly, any such test must incorporate the principle that the right of publicity cannot . . . be a right to control the celebrity’s image by censoring disagreeable portrayals. Once the celebrity thrusts himself . . . into the limelight, the First Amendment dictates that the right to comment on, parody, [and] lampoon . . . the celebrity image [T]he right of publicity is essentially an economic right. What the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity’s fame through the merchandising of the ‘name, voice, signature, photograph, or likeness’ of the celebrity.”*¹

I. INTRODUCTION

The First Amendment of the U.S. Constitution guarantees the freedom of expression and seeks to foster an environment where individual ideas can freely flourish and develop.² While the right of free expression is imperative in a democratic society, it is not an absolute right.³ The objective of safeguarding the integrity of free expression must be constantly balanced against competing interests.⁴ One interest that has clashed with the freedom of expression over the last half-century is the right of publicity.⁵

The modern day right of publicity, which protects against the misappropriation of an individual’s identity, recognizes that an individual

1. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807 (Cal. 2001).

2. *See* U.S. CONST. amend. I; *see also Comedy III Prods., Inc.*, 21 P.3d at 803 (highlighting purposes of First Amendment).

3. *See Whitney v. California*, 274 U.S. 357, 373 (1927) (Brandeis, J., concurring) (articulating freedom of expression not absolute).

4. *See Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 150 (3d Cir. 2013) (discussing balancing inquiry of First Amendment against competing interests).

5. *See Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575 (1977) (stating news station’s First Amendment rights do not supersede performer’s rights to control act); *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (asserting baseball player has property right in his own image); *Comedy III Prods., Inc.*, 21 P.3d at 811 (recognizing property right in celebrities to control their own images outside boundary of First Amendment).

should have control over the commercial value of his image.⁶ Courts, however, have struggled to develop a consistent framework to measure this interest against the substantial weight of the First Amendment.⁷ Initially defined in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,⁸ the transformative use test seeks to balance an individual's right of publicity with the interests protected by the First Amendment.⁹ Specifically, the transformative use test examines whether a particular expressive work sufficiently transforms a celebrity's identity, or "likeness," into something more.¹⁰

Recently, the transformative use test has been applied to college athletes suing the National Collegiate Athletic Association (NCAA) and Electronic Arts (EA) for using their likeness to develop video games that seemingly replicate their identities.¹¹ In *Hart v. Electronic Arts, Inc.*,¹² the Third Circuit ruled in a split decision that EA's game did not sufficiently transform a college athlete's likeness so as to outweigh his publicity rights.¹³ In the case *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*,¹⁴ the Ninth Circuit echoed the Third Circuit's sentiment, agreeing that under the transformative

6. See *Haelan Labs., Inc.*, 202 F.2d at 868 (stating man has right to control value of his own image); 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:26 (2d ed. 2014) (defining right of publicity as property right in person's identity).

7. See *Zacchini*, 433 U.S. at 579 (Powell, J., dissenting) (criticizing majority for formulating ambiguous standard); Michael "Bubba" Schoeneberger, Notes, *Unnecessary Roughness: Reconciling Hart and Keller with a Fair Use Standard Befitting the Right of Publicity*, 45 CONN. L. REV. 1875, 1892-93 (2013) (stating *Zacchini* failed to provide guidance for lower courts). Due to the *Zacchini* Court's failure to provide a consistent approach, no test has consistently solved the friction between the First Amendment and the right of publicity. See Schoeneberger, *supra*, at 1892-93.

8. 21 P.3d 797 (Cal. 2001).

9. See *id.* at 805-09 (discussing goal of transformative use test); see also *Hart*, 717 F.3d at 159 (discussing foundation of transformative use test).

10. See *Comedy III Prods., Inc.*, 21 P.3d at 809-10 (articulating transformative use test).

11. See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013) (applying transformative use test); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013) (explaining transformative use test). EA is the producer of the video game "NCAA Football." See *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 WL 530108, at *1 (N.D. Cal. Feb. 8, 2010) (explaining EA's production of "NCAA Football" video game), *aff'd sub nom. In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013). The transformative use test will likely also be applied in cases recently filed against the National Football League (NFL) by former NFL players. See, e.g., *Dryer v. Nat'l Football League*, No. 09-2182 (PAM/AJB), 2013 WL 4781030, at *1 (D. Minn. Sept. 6, 2013) (detailing suits filed by former NFL players against NFL); *Complaint, Tatum v. Nat'l Football League*, No. 2:13-cv-01814 (W.D. Pa. Apr. 24, 2014); *Class Action Complaint, Culp v. NFL Prods. LLC*, No. 13-7815 (NLH/JS) (D.N.J. Sept. 29, 2014); Associated Press, *Former Players, NFL Films Feud Over Image Rights*, USA TODAY (Aug. 22, 2013), <http://www.usatoday.com/story/sports/nfl/2013/08/22/nfl-films-former-players-feud-over-image-rights-john-riggins-dave-casper-tom-mack/2684375/>, archived at <http://perma.cc/PRT9-J8CR> (describing right-of-publicity suit filed by former NFL players); David Voreacos, *NFL Sued by Ex-Players Culp, Riggins, Yary Over Image Use*, BLOOMBERG (Aug. 22, 2013), <http://www.bloomberg.com/news/2013-08-21/nfl-sued-by-ex-players-culp-riggins-yary-over-images-use.html>, archived at <http://perma.cc/SY6K-TBAK> (detailing suit filed by former NFL players).

12. 717 F.3d 141 (3d Cir. 2013).

13. See *id.* at 170 (holding video game does not sufficiently transform college athlete's identity).

14. 724 F.3d 1268 (9th Cir. 2013).

use test, EA's use of a college athlete's likeness in its "NCAA Football" games did not deserve First Amendment protection.¹⁵ If, however, EA's own creative and interactive elements are not considered sufficiently transformative, the question remains: what constitutes a transformative use worthy of First Amendment protection?¹⁶

This Note will analyze the tension between the right of publicity and freedom of expression, particularly as it relates to the recent alleged misappropriation of the images of college athletes.¹⁷ Part II.A examines the development of the right of publicity, including its evolution from the right of privacy and its interplay with the First Amendment.¹⁸ Part II.B outlines the trajectory of the balancing tests used by courts before arriving at the transformative use test, which is emerging as the most effective way to resolve the tension between the two competing interests.¹⁹ Part II.C explores the *Hart* and *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* decisions, discussing the Third and Ninth Circuits' preference for the transformative use test in order to arrive at an equitable result.²⁰ Finally, Part III will analyze *Hart* and *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* and suggest that the courts' willingness to strike the balance in favor of the right of publicity reflects a preference for economic prosperity.²¹ Moreover, this Part argues that the transformative use test is the appropriate test to resolve conflicts between the First Amendment and the right of publicity.²² In favoring the right of publicity in the context of college athletes, courts are not promoting censorship.²³ Rather, courts are allowing college athletes, as public individuals, to capitalize on their commercial value by preventing others from exploiting their image.²⁴

15. See *id.* at 1284 (holding use of college athlete's likeness not protected by First Amendment).

16. See, e.g., *Hart*, 717 F.3d at 152-53 (discussing courts' search for formulized balancing standard); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807 (Cal. 2001) (recognizing difficulty in articulating uniform balancing test); *Doe v. TCI Cablevision*, 110 S.W.3d 363, 373 (Mo. 2003) (en banc) (highlighting several approaches offered to resolve conflict); see also Schoeneberger, *supra* note 7, at 1893 (illustrating courts' and scholars' attempts to devise balancing test).

17. See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1284 (holding use of college athlete's likeness not protected by First Amendment); *Hart*, 717 F.3d at 170 (holding video game does not sufficiently transform college athlete's identity).

18. See *infra* Part II.A.

19. See *infra* Part II.B.

20. See *infra* Part II.C.

21. See *infra* Part III.

22. See *infra* Part III.

23. See *infra* Part III; see also *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807 (Cal. 2001) (stating right of publicity "not a right of censorship," but right to control image).

24. See *infra* Part III; see also *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1284 (9th Cir. 2013) (holding use of college athlete's likeness not protected by First Amendment); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 170 (3d Cir. 2013) (holding video game does not sufficiently transform college athlete's identity).

II. HISTORY

A. *The Right of Publicity's Foundation*

Before the right of publicity emerged as a means of preventing the appropriation of one's image, individuals were confined to asserting the right of privacy.²⁵ One form of the right of privacy was the invasion of privacy by appropriation: the unauthorized use of an individual's likeness or image.²⁶ In *Pavesich v. New England Life Insurance Co.*,²⁷ the court examined whether an advertiser could use the plaintiff's photograph without obtaining his consent.²⁸ Though previous courts were unwilling to formally recognize a right of privacy, the court in *Pavesich* adopted the right, concluding that the publication of an individual's likeness without his or her consent unequivocally violates his or her privacy.²⁹ The invasion of privacy by appropriation right, however, merely accorded the individual the "right to be left alone."³⁰ By appreciating this right, courts recognized invasion of privacy could lead to emotional injury, but did not acknowledge the potential economic harm caused by the commercial exploitation of one's likeness.³¹ As such, publically-known

25. See MCCARTHY, *supra* note 6, § 1:23 (stating right of privacy "historical antecedent" of right of publicity); see also *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (asserting existence of right of publicity and right of privacy); Jordan M. Blanke, *No Doubt About It—You've Got To Have Hart: Simulation Video Games May Redefine the Balance Between and Among the Right of Publicity, the First Amendment, and Copyright Law*, 19 B.U. J. SCI. & TECH. L. 26, 32-33 (2013) (explaining right of privacy preceded right of publicity); J. Gordon Hylton, *The Over-Protection of Intellectual Property Rights in Sport in the United States and Elsewhere*, 21 J. LEGAL ASPECTS SPORT 43, 45 (2011) (discussing emergence of right of publicity from right of privacy).

26. See MCCARTHY, *supra* note 6, § 1:23 (explaining invasion of privacy by appropriation as "unpermitted use of one's name or picture"); William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960) (delineating four categories of right of privacy). In examining Prosser's four right-of-privacy torts, McCarthy draws a parallel between the invasion of privacy by appropriation and the modern day right of publicity. See MCCARTHY, *supra* note 6, § 1:23 (comparing invasion of privacy by appropriation to right of publicity). While Prosser's appropriation privacy seems to protect the commercial value of one's identity, the modern day right of publicity inevitably serves the same function. See *id.*; see also *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 220 (2d Cir. 1978) (equating fourth type of right of privacy with right of publicity), *abrogated by* *Pirone v. MacMillan, Inc.*, 894 F.2d 579 (2d Cir. 1990); Blanke, *supra* note 25, at 33 (discussing four distinct categories of right of privacy, including appropriation).

27. 50 S.E. 68 (Ga. 1905).

28. See *id.* at 81 (examining defendant's use of plaintiff's photograph as invasion of privacy by appropriation).

29. See *id.* at 79 (holding plaintiff's right of privacy invaded); *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442, 450-51 (N.Y. 1902) (Gray, J., dissenting) (asserting right of privacy recognized to protect individual's likeness). The court in *Pavesich* adopted the dissenting opinion of Judge Gray in *Roberson*. See *Pavesich*, 50 S.E. at 79 (supporting Judge Gray's conclusion and reasoning in *Roberson*); see also MCCARTHY, *supra* note 6, § 1:15 (discussing impact of *Pavesich* decision in wake of *Roberson* decision).

30. See MCCARTHY, *supra* note 6, § 1:25 (discussing limitations of privacy right).

31. See *id.* (distinguishing between "right to be left alone" and right to profit from one's own identity). According to McCarthy, the invasion of privacy by appropriation was traditionally rooted in tort law, "focus[ing] upon . . . personal injury to dignity and state of mind, measured by mental distress damages." *Id.*; see also J. Gordon Hylton, *Baseball Cards and the Birth of the Right of Publicity: The Curious Case of Haelan*

plaintiffs had extreme difficulty maintaining an invasion of privacy action because courts were skeptical that such plaintiffs had actually suffered emotional distress or indignity when their identities were already widely known.³²

The court in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,³³ was confronted with solving this enigma and examined whether an individual has a right in the public value of his or her own image, outside the inevitable possibility of mental distress or emotional injury.³⁴ Interestingly, this issue arose in *Haelan Laboratories, Inc.* indirectly, as the suit initially emerged as one between two rival chewing gum manufacturers.³⁵ In *Haelan Laboratories, Inc.*, the plaintiff contracted with a famous baseball player, giving the plaintiff exclusive rights to use the player's photograph in connection with the plaintiff's gum sales.³⁶ The defendant then induced the player to authorize him in a separate contract to use the player's photograph in connection with the defendant's sale of gum.³⁷ The defendant argued that because the right of privacy is personal and not assignable, the player's contract with the plaintiff merely relieved the plaintiff of liability he otherwise would have incurred had he used the player's photograph without consent.³⁸ Moreover, the defendant asserted he could not be liable because the plaintiff's contract with the player did not vest the plaintiff with any property rights.³⁹

Though the defendant's argument conformed to the then current law governing the right of privacy, the court rejected the defendant's position; the court instead found the player had a property right in his own image, and accordingly, he could legally assign the right to his image to the plaintiff in an exclusive contract.⁴⁰ Thus, as the legal possessor of the player's interest, the

Laboratories v. Topps Chewing Gum, 12 MARQ. SPORTS L. REV. 273, 273-74 (2001) (stating right of privacy constitutes tort right, not property right).

32. See MCCARTHY, *supra* note 6, § 1.25 (discussing consequences of courts' interpretations of invasion of privacy and its effects on plaintiffs). *O'Brien v. Pabst Sales Co.* is a prime example of a publically known plaintiff failing to establish an invasion of privacy action. See 124 F.2d 167, 170 (5th Cir. 1941) (stating plaintiff's action fails); see also MCCARTHY, *supra* note 6, § 1:25 (highlighting *O'Brien* case as prime example of early right-of-privacy pitfalls). In the case, the court reasoned that *O'Brien* could not be harmed by the publicity of his image because he was not a private person. See *O'Brien*, 124 F.2d at 170 (asserting *O'Brien* not private person and did not receive any adverse or additional publicity).

33. 202 F.2d 866 (2d Cir. 1953).

34. See *id.* at 868 (finding publically known people entitled to "right of publicity").

35. See *id.* at 867 (describing procedural posture of case); MCCARTHY, *supra* note 6, § 1:26 (highlighting right-of-publicity issue arose "almost by accident").

36. See *Haelan Labs., Inc.*, 202 F.2d at 867.

37. See *id.*

38. See *id.*

39. See *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 867 (2d Cir. 1953).

40. See *id.* at 867-68 (rejecting defendant's argument and instead recognizing plaintiff's property right in player's right of publicity). In order to reject the defendant's argument, the court first needed to recognize the player had a property right in his own image. See MCCARTHY, *supra* note 6, § 1.26 (interpreting defendant's argument and foundation of court's rejection). McCarthy explained that "in rejecting [the] argument of

plaintiff could enforce that interest against the defendant.⁴¹ By instilling a property right in an individual's identity, the *Haelan Laboratories, Inc.* court created the right of publicity.⁴² The basic rationale underlying the *Haelan Laboratories, Inc.* court's decision was that an individual has a right to control and benefit from the public use of his or her identity, rather than merely prohibit impermissible uses of it.⁴³ Moreover, the right of publicity protects against the fundamentally unfair practice of exploiting an individual's accomplishments solely because he or she is publically known.⁴⁴

Though the *Haelan Laboratories, Inc.* decision is significant in that it was the first to articulate the right of publicity, its reach is not comprehensive.⁴⁵ One particular limitation the *Haelan Laboratories, Inc.* court does not discuss is the need to balance the interest in protecting the publicity of one's image with the interest of free expression.⁴⁶ In *Zacchini v. Scripps-Howard Broadcasting Co.*,⁴⁷ the only United States Supreme Court case to examine the

defendant . . . [the court] . . . coined the term 'right of publicity' to denote both a right to prevent commercial use of identity and the corresponding right to grant an exclusive privilege to one firm in a defined market." *Id.*; see also Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 216 (1954) (asserting right of publicity recognized as property right). The player was free to transfer the right to the plaintiff because he owned this property right. See MCCARTHY, *supra* note 6, § 1:26 (highlighting nature of player and plaintiff's interest against defendant).

41. See *Haelan Labs., Inc.*, 202 F.2d at 868 (expounding player's right to grant plaintiff privilege of using player's image); see also MCCARTHY, *supra* note 6, § 1.26 (stressing player's property right and right to transfer); Hylton, *supra* note 31, at 274 (discussing court's willingness to move beyond tort analysis and into property law justifications).

42. See *Haelan Labs., Inc.*, 202 F.2d at 868 (coining term "right of publicity"); see also MCCARTHY, *supra* note 6, § 1.26 (highlighting significance of *Haelan Laboratories, Inc.*'s articulation of right); Nimmer, *supra* note 40, at 221 (discussing *Haelan Laboratories, Inc.*'s definition of right of publicity).

43. See *Haelan Labs., Inc.*, 202 F.2d at 868 (explaining reason for adopting right of publicity). Writing the majority opinion for the court, Judge Frank proffered:

[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. Whether it be labeled a 'property' right is immaterial; for here, as often elsewhere, the tag 'property' simply symbolizes the fact that courts enforce a claim which has pecuniary worth.

This right might be called a 'right of publicity.'

Id.

44. See *id.* (suggesting individuals deprived if they received no compensation for use of identity); Palmer v. Schonhorn Enters., Inc., 232 A.2d 458, 461-62 (N.J. Super. Ct. Ch. Div. 1967) (stating individual accomplishments not exploited merely because public); cf. Nimmer, *supra* note 40, at 217 (positing right of publicity available to more than just publically known people). In his article, Nimmer asserts that while the publicity value of a celebrity is typically larger than lesser-known people, the right of publicity permits all people to recover for the unauthorized use of one's identity. See Nimmer, *supra* note 40, at 217.

45. See Nimmer, *supra* note 40, at 222 (asserting certain limitations of *Haelan Laboratories, Inc.* decision).

46. See *id.* at 217 (highlighting question of whether right of publicity trumps proper exercises of free expression).

47. 433 U.S. 562 (1977).

right of publicity, the Court examined whether an Ohio news station had the right to broadcast a performer's entire "human cannonball" stunt act from a local fair without the performer's permission.⁴⁸ While the Ohio courts initially barred the performer's claim against the news station on First Amendment grounds, the Supreme Court sought to balance the performer's right of publicity with the news station's First Amendment rights; and the Court eventually recognized the performer should have the right to control his own publicity.⁴⁹ In surveying the interests at issue, the Court noted the interest in recognizing a right of publicity "is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment."⁵⁰ Moreover, as the performer's act was the product of his own hard work and talents, the economic value of his performance was grounded in his right to control the publicity of the performance.⁵¹ Most notably, the Court illuminated the fact that the performer did not seek to suppress the broadcast of his performance entirely; he simply sought to receive his commercial stake.⁵² Although the news enjoys considerable First Amendment protection, the Court recognized the public would not be deprived of the benefit of the performer's act if the news station had merely obtained his consent.⁵³

In essence, the Court in *Zacchini* concluded that a news station's broadcast of a performer's entire act violates the performer's right of publicity and the broadcast is not entitled to any First Amendment protection.⁵⁴ While the Court recognized the tension between the right of publicity and the First Amendment, it did not formulate a uniform balancing test to resolve the conflict.⁵⁵ As such, in the wake of *Zacchini*, courts have advanced varying balancing tests in search

48. See *id.* at 562-63 (setting forth central issue in case).

49. See *id.* at 562-63, 575 (recognizing First Amendment rights cannot deprive performer of right to control act).

50. See *id.* at 573 (stating rationale underlying right of publicity). In stating the primary motivation for the right of publicity is to encourage entertainment, the Court equated this goal to those underlying patent and copyright law, "focusing on the right of the individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation." *Id.*; see also *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 151 (3d Cir. 2013) (asserting underlying goal of intellectual property law as encouraging further development of property interest).

51. See *Zacchini*, 433 U.S. at 575 (highlighting threat to value of performance).

52. See *id.* at 578 (noting news station's First Amendment privileges not infringed if consent obtained).

53. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578 (1977) (striking balance in favor of safeguarding right of publicity against First Amendment).

54. See *id.* at 575 (noting media reports do not receive First Amendment protection when reports broadcast performer's entire act); Pamela Samuelson, *Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 TUL. L. REV. 836, 854 (1983) (analyzing *Zacchini*'s holding).

55. See *Zacchini*, 433 U.S. at 579 (Powell, J., dissenting) (criticizing majority for formulating ambiguous standard); Samuelson, *supra* note 54, at 858 (highlighting *Zacchini*'s "entire act" standard as inapplicable in most situations); Schoeneberger, *supra* note 7, at 1892 (stating *Zacchini* failed to provide guidance for lower courts). Due to the *Zacchini* Court's failure to provide a consistent approach, no test has consistently solved the friction between the First Amendment and the right of publicity. See Schoeneberger, *supra* note 7, at 1892-93 (highlighting limits of *Zacchini* ruling).

of a more systematic approach to resolving the discord between the right of publicity and the First Amendment.⁵⁶ Three tests of significance that have emerged are the predominant use test, the *Rogers* test, and the transformative use test.⁵⁷

B. Modern Balancing Tests

1. The Predominant Use Test

First articulated in *Doe v. TCI Cablevision*,⁵⁸ the predominant use test gauges whether the use of a person's likeness is predominantly expressive or commercial in nature.⁵⁹ While uses of a person's likeness that are expressive in nature frequently receive protection under the First Amendment, uses for purely commercial purposes are seldom protected.⁶⁰ In *TCI Cablevision*, the court examined whether a comic book author's use of a professional hockey player's name, "Tony Twist," for a villainous character was predominantly expressive or done purely to exploit the commercial value in Twist's identity.⁶¹ Because the court found the author's use of Twist's identity was predominantly a commercial tactic rather than an expressive commentary, the court ruled that

56. See, e.g., *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 152-53 (3d Cir. 2013) (discussing courts' searches for formulated balancing standard); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807 (Cal. 2001) (recognizing difficulty in articulating uniform balancing test); *Doe v. TCI Cablevision*, 110 S.W.3d 363, 373 (Mo. 2003) (en banc) (highlighting several approaches offered to resolve conflict); see also Schoeneberger, *supra* note 7, at 1893 (illustrating courts' and scholars' attempts to devise balancing test).

57. See *Hart*, 717 F.3d at 153 (highlighting three balancing tests of particular significance); *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989) (articulating *Rogers* test); *Comedy III Prods., Inc.*, 21 P.3d at 808-10 (articulating transformative use test); *TCI Cablevision*, 110 S.W.3d at 374 (articulating predominant use test).

58. 110 S.W.3d 363 (Mo. 2003).

59. See *id.* at 374 (defining predominant use test); Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 500 (2003) (arguing inquiry into predominant purpose for exploitation as proper balancing test). In his article, Lee posits what has been cited by courts as the "predominant use test," arguing

If a product is being sold that predominantly exploits the commercial value of an individual's identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some "expressive" content in it that might qualify as "speech" in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.

See Lee, *supra*, at 500.

60. See *TCI Cablevision*, 110 S.W.3d at 373 (explaining threshold question in right-of-publicity cases).

61. See *id.* at 367. Tony Twist was a professional hockey player who had earned a reputation for being a "tough-guy." See *id.* at 366. Todd McFarlane, creator of the comic book "Spawn," admitted in an interview that his character named "Tony Twist" was named after Tony Twist the hockey player because of his reputation as an enforcer. See *id.* at 367. Not only did McFarlane name his character after Twist, he targeted hockey fans in selling "Spawn" memorabilia. See *id.* (discussing "Spawn" hockey pucks and "Spawn Night" at minor league hockey game).

Twist's right of publicity trumped the author's First Amendment defense.⁶²

In *TCI Cablevision*, the court advocated for the predominant use test over other tests because, while other tests purportedly claimed to balance the right of publicity against the First Amendment, the tests merely deemed a work "expressive" or "commercial."⁶³ Conversely, according to the *TCI Cablevision* court, the predominant use test recognizes the use of one's likeness can be both expressive and commercial.⁶⁴ As such, the test seeks to weigh these objectives and ascertain what the prevailing purpose for the use is.⁶⁵ It is in this subjective approach, however, that the predominant use test has been criticized, as it "calls upon judges to act as both impartial jurists and discerning art critics."⁶⁶ Moreover, because the test compels judges to engage in an overtly subjective inquiry, the application of the test to similar fact situations could lead to conflicting and unpredictable results.⁶⁷

2. The Rogers Test

Derived from principles of trademark law, the *Rogers* test measures whether a celebrity's name in a title or expressive work is "wholly unrelated" to the expressive work or "simply a disguised commercial advertisement for the sale

62. See *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (en banc) (finding author's use of Twist's name purely for commercial purposes).

63. See *id.* (suggesting Restatement's "relatedness" test and California's "transformative" test ignore uses with expressive and commercial elements). The Restatement's "relatedness" test protects the use of a person's likeness in a work related to the person. See *id.* at 373; RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (1995) (articulating "relatedness" test). California's "transformative" test examines whether the work adds sufficiently expressive elements so as to transform the work into something more than a mere appropriation of a person's likeness. See *TCI Cablevision*, 110 S.W.3d at 373.

64. See *TCI Cablevision*, 110 S.W.3d at 374 (advocating for predominant use test for cases with expressive and commercial speech).

65. See *id.* (arguing predominant use test "more balanced balancing test"); Lee, *supra* note 59, at 500 (explaining rationale behind predominant use test). Lee proffers not only does the predominant use test account for both expressive and property interests, it also protects against exploitation while still encouraging creative expression and innovation. See Lee, *supra* note 59, at 500 (aligning objective of predominant use test with objectives of intellectual property law).

66. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 154 (3d Cir. 2013) (describing predominant use test as arbitrary and subjective); see also Joseph Gutmann, Note, *It's in the Game: Redefining the Transformative Use Test for the Video Game Arena*, 31 CARDOZO ARTS & ENT. L.J. 215, 221 (2012) (noting lack of definition for "predominant").

67. Compare *TCI Cablevision*, 110 S.W.3d at 374 (holding comic book character with professional hockey player's likeness created for predominantly commercial purpose), with *Winter v. DC Comics*, 69 P.3d 473, 480 (Cal. 2003) (holding comic book depictions of two well-known musicians protected by First Amendment). While the court in *Winter* used the transformative use test in deciding the artist's creative elements "transformed" the musicians' likeness, the court in *TCI Cablevision* declined to follow the *Winter* court, instead deciding that the predominant use test was a more appropriate balancing test. See *TCI Cablevision*, 110 S.W.3d at 373-74 (comparing facts of case to *Winter* and articulating preference for predominant use test). But see Lee, *supra* note 59, at 500 (indicating balancing approaches other than predominant use test "lack[] substantive content and encourage[] uncertainties"); John Grady et al., *A New 'Twist' for 'The Home Run Guys': An Analysis of the Right of Publicity Versus Parody*, 15 J. LEGAL ASPECTS SPORT 267, 279-80 (2005) (explaining Lee's argument for predominant use test as "fairest" approach).

of goods or services.”⁶⁸ The test was most famously adopted in *Rogers v. Grimaldi*,⁶⁹ where actress Ginger Rogers brought suit against the producers of the film “Ginger and Fred” because it allegedly infringed upon Rogers’s right of publicity.⁷⁰ Specifically, Rogers objected to the use of two characters who came to be known in the film as Ginger and Fred.⁷¹ Rogers claimed that these two characters impermissibly misled viewers as to her connection with the film because they imitated herself and her well-known partner Fred Astaire.⁷² In analyzing whether the Lanham Act should apply to artistic works, the court formulated a balancing approach to reconcile Rogers’s right of publicity with the First Amendment rights of the filmmaker.⁷³ The court concluded that the Lanham Act should only apply to artistic works “where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”⁷⁴ If the title of the work has no artistic relevance to the original

68. *Rogers v. Grimaldi*, 875 F.2d 994, 1004-05 (2d Cir. 1989) (quoting *Frosch v. Grosset & Dunlap, Inc.*, 427 N.Y.S.2d 828, 829 (N.Y. App. Ct. 1980) and *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 457 n.6 (Cal. 1979)). Right-of-publicity claims are comparable to trademark claims because courts must weigh the interest in protecting the relevant property interest against the interest in free expression. See *Hart*, 717 F.3d at 155 (comparing right of publicity to trademark law); see also *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003) (comparing Lanham Act § 1125(a) claim to right-of-publicity claim). The Lanham Act is the United States Trademark Act that governs federal trademark protection, insulating established trademarks from unauthorized imitations that are likely to cause confusion. See Lanham Act §§ 1-73, 15 U.S.C. §§ 1051-1141m (2014). Lanham Act § 1125(a) makes liable “[a]ny person who . . . uses in commerce any word, term, name, symbol, or device . . . or false or misleading representation of fact, which . . . is likely to cause confusion.” 15 U.S.C. § 1125(a)(1)(A). Compare 15 U.S.C. § 1125(a)(1)(A) (setting out ground for false designation of origin action), with *Rogers*, 875 F.2d at 1004-05 (barring use of celebrity’s name in movie title unless title “wholly unrelated” to movie), and RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. C (1995) (“[I]f the name or likeness is used solely to attract attention to a work that is not related to the identified person, the user may be subject to liability for a use of the other’s identity in advertising.”). Instead of the Lanham Act’s “likelihood of confusion” test, the *Rogers* test focuses on whether the use of a celebrity’s likeness or identity is “wholly unrelated” to the work in which it is used. See *Rogers*, 875 F.2d at 1004 (distinguishing Lanham Act action from right of publicity). The *Rogers* test also bears an extremely close resemblance to the Restatement’s “relatedness” test, which renders uses of a person’s likeness in a work not related to the identified person as offensive to the person’s right of publicity. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. C (1995) (defining Restatement’s “relatedness” test). It is important to note that ostensible uses of a person’s likeness, such as the use of “Ginger” in the title of the movie “Ginger and Fred,” do not offend the right of publicity; though the use of “Ginger” was unrelated to Ginger Rogers, it did relate to the content of the movie, and thus, was not used solely for the purpose of appropriating Ginger Rogers’s commercial value. See *Rogers*, 875 F.2d at 1004-05 (refusing to extend right of publicity to bar use of celebrity’s name in movie title).

69. 875 F.2d 994 (2d Cir. 1989).

70. See *id.* at 995 (setting forth procedural posture of case). In the case, Rogers also claimed injury under the Lanham Act, claiming consumers would likely be confused that Rogers either endorsed the movie or that the movie was about her. See *id.* at 1001. The court held that the filmmaker was entitled to summary judgment on Rogers’s false impression claims because the film’s two main characters were named Ginger and Fred, and thus, the title was “entirely truthful as to its content.” See *id.*

71. See *id.* at 996-97 (explaining nature of characters in “Ginger and Fred”).

72. See *id.* at 997 (asserting Rogers’s claims).

73. See *Rogers*, 875 F.2d at 999 (formulating *Rogers* test).

74. See *id.* (explaining when Lanham Act test should apply to right-of-publicity inquiry).

work, then the First Amendment will not protect the work.⁷⁵ Moreover, even if there is artistic relevance, the work will not receive First Amendment protection if it “explicitly misleads as to the source or the content of the work.”⁷⁶ The court ultimately held that the filmmaker’s use of the title was protected by the First Amendment and did not violate Rogers’s right of publicity because the title “Ginger and Fred” was artistically relevant to the underlying work and did not explicitly mislead as to the source of the work.⁷⁷

Some scholars maintain that the *Rogers* test gives proper deference to free speech because there is a close relationship between the Lanham Act and the right of publicity.⁷⁸ Part of the reason for this justification, those scholars argue, is the ostensible similarity between trademark law and the right of publicity, both are primarily concerned with preventing the appropriation of a name or likeness for purely commercial purposes.⁷⁹ A more widely accepted view, however, is that the primary purpose of a right of publicity is protecting an individual’s right to control his or her own image, while trademark law principally seeks to prevent consumer confusion.⁸⁰ Thus, while the *Rogers* test may be practical for analyzing whether the title of a work violates an

75. See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (highlighting first-prong of *Rogers* test).

76. See *id.* (highlighting second prong of *Rogers* test).

77. See *id.* at 1001 (stating title “Ginger and Fred” did not explicitly indicate Rogers endorsed film). The goal of the *Rogers* test is to prevent misleading titles with no artistic relevance to the underlying work from being protected by the First Amendment. See *id.* at 999. To distinguish between the use of “Ginger and Fred” in the actual case and a potentially infringing use, the court offered a hypothetical:

For example, if the characters in the film in this case had published their memoirs under the title “The True Life Story of Ginger and Fred,” and if the film-maker had then used that fictitious book title as the title of the film, the Lanham Act could be applicable to such an explicitly misleading description of content.

Id. at 1000.

Here, the title “Ginger and Fred,” although it included a celebrity’s name, made no explicit statement that the work was about Ginger Rogers, and the relevance of the title was evident upon viewing the film. See *id.* Compare *Rogers*, 875 F.2d at 1001 (stating title genuinely relevant to film’s story), with *Parks v. LaFace Records*, 329 F.3d 437, 455 (6th Cir. 2003) (stating title “Rosa Parks” not relevant to content of OutKast’s song). Where the title “Ginger and Fred” in *Rogers* was not “wholly unrelated” to the filmmakers underlying work, OutKast’s use of “Rosa Parks” was simply a disguised commercial advertisement. See *Parks*, 329 F.3d at 460-61 (applying *Rogers* test to use of “Rosa Parks”).

78. See William K. Ford & Raizel Liebler, *Games Are Not Coffee Mugs: Games and the Right of Publicity*, 29 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1, 80-81 (2012) (asserting benefits of *Rogers* test); see also Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1190 (2006) (asserting trademark law as most apt foundation for right-of-publicity balancing test).

79. See Dogan & Lemley, *supra* note 78, at 1190 (arguing for trademark-based framework for analyzing right of publicity). Dogan and Lemley posit that trademark law is the closest analogy to the right of publicity because both laws are concerned with the protection of names or likenesses in commercial contexts. See *id.*

80. See Ford & Liebler, *supra* note 78, at 80 n.509 (highlighting possible discrepancy between goals of trademark law and right-of-publicity law); see also Nimmer, *supra* note 40, at 220-21 (discussing individual’s right to control commercial value of his likeness).

individual's right of publicity, courts have been hesitant to apply the test in situations examining the general contents of a work.⁸¹ As such, the *Rogers* test may be useful in right-of-publicity cases that are akin to trademark cases, but the majority of courts and scholars have not accepted the test as the proper balancing formula to resolve conflicts between the right of publicity and the First Amendment.⁸²

3. *The Transformative Use Test*

Where the *Rogers* test is founded in trademark law, the transformative use test is rooted in copyright's fair-use doctrine.⁸³ By narrowing its focus to the first fair use factor, "the purpose and character of the use," the California Supreme Court in *Comedy III Productions, Inc.* sought to reconcile the right of publicity with the First Amendment, focusing primarily on whether a work is "transformative."⁸⁴ The court clarified that the balance between the right of publicity and the First Amendment ought to turn on "whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question."⁸⁵

The court in *Comedy III Productions, Inc.* applied the transformative use test in examining whether T-shirts with reproduced images of the Three Stooges

81. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 157 (3d Cir. 2013) (expressing hesitation to apply *Rogers* test outside context of title of work); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008) (declining to apply *Rogers* beyond titles).

82. See *Hart*, 717 F.3d at 157 (defining *Rogers* test as "blunt instrument, unfit for widespread application" in First Amendment cases). The *Rogers* test has also been criticized for the fact that relevance is a largely subjective inquiry and works with no redeeming artistic value could potentially pass the *Rogers* test. See Gutmann, *supra* note 66, at 220 (highlighting common criticisms of *Rogers* test).

83. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807-08 (Cal. 2001) (importing transformative use test from copyright's fair use doctrine).

84. See *id.* at 807-08 (quoting 17 U.S.C. § 107 (2014)) (discussing first fair use factor and "transformative" inquiry). The court in *Comedy III Productions, Inc.* conceded that while incorporating the entire fair use doctrine into right-of-publicity law would be improper, the first fair use factor, "the purpose and character of the use," lies at the heart of squaring the rights of free expression and publicity. See *Comedy III Prods., Inc.*, 21 P.3d at 808 (quoting 17 U.S.C. § 107 (1)). The central purpose of using this fair use factor is to determine "whether the new work merely 'supersede[s] the objects' of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is 'transformative.'" *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (alteration in original) (citations omitted) (discussing first fair use factor). In *Comedy III Productions, Inc.*, the court further noted that while transformative uses are not necessary to finding a fair use, transformative works generally further the goal of copyright law and the First Amendment alike, by promoting scientific, artistic, and expressive works. See *Comedy III Prods., Inc.*, 21 P.3d at 808.

85. See *Comedy III Prods., Inc.*, 21 P.3d at 809 (articulating transformative use test). In explaining the transformative use test further, the court asserted the goal of the test is to determine whether the work containing the celebrity's likeness has become so transformed that it reflects the defendant's own artistic expression rather than a mere reproduction of the celebrity. See *id.*

violated the plaintiff's right of publicity in the Three Stooges' likeness.⁸⁶ In arguing that his T-shirts were sufficiently transformative, the defendant asserted that the portraits he used involved artistic decisions, and as such, no portrait could be considered a mere literal reproduction of a likeness.⁸⁷ The court, however, rejected this categorical position and discerned no significant transformative elements or artistic contributions outside of the reproduction of the Three Stooges' images.⁸⁸ The defendant further argued it was unjust to protect parodies and distortions of celebrity images but not portraits of celebrities honoring their status.⁸⁹ In the court's view, however, the transformative use test did not express a preference for one type of depiction over another.⁹⁰ Rather, it simply recognized that the right of publicity confers on the heirs and assigns of celebrities the exclusive right to exploit the celebrity's likeness.⁹¹ As such, depictions akin to the defendant's T-shirts that do not "transform" the celebrity likeness by adding artistic elements may only be created with the consent of the right of the publicity holder.⁹²

When applied to works of artistry such as portraits, the transformative use test is fairly simple to apply.⁹³ Some critics, however, have posited that the test

86. *See id.* at 810 (examining defendant's T-shirts through transformative use lens).

87. *See id.* (reporting defendant's argument).

88. *See id.* (rejecting defendant's argument).

89. *See Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001) (addressing defendant's injustice argument).

90. *See id.* (distinguishing consequences of transformative use test from defendant's argument).

91. *See id.* (discussing transformative use test's alignment with goal of right of publicity).

92. *See id.* (finding defendant's T-shirts lacked sufficiently transformative elements and violated plaintiff's right of publicity). It is important to note that the court did not disparage any form of portrait as nontransformative. *See id.* In fact, the court compared the defendant's Three Stooges portraits to Andy Warhol's silkscreen portraits, which distorted the images of celebrities such as Marilyn Monroe, Elizabeth Taylor, and Elvis Presley. *See id.* If the court were to scrutinize the Warhol portraits through the transformative use test, it is likely that Warhol's distortion and manipulation of context would constitute sufficiently transformative elements and render the work transformative as a whole. *See id.* at 811. *Compare id.* at 800-01 (evaluating T-shirts bearing likeness of Three Stooges), with *Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003) (applying transformative use test to comic book characters resembling Johnny and Edgar Winter). In *Winter*, the Winter brothers, who are famous musicians, are portrayed as half-human and half-worm and exist in a fantasy world. *See Winter*, 69 P.3d at 479. This use was transformative because the Winter brothers were simply one component of the raw materials from which the comic book was created, and any resemblance that the characters shared with the actual Winter brothers was done purely for the purpose of parody or caricature. *See id.* at 479-80. The use of the Winter brothers' likeness can be firmly contrasted with the use of the Three Stooges in *Comedy III Productions, Inc.*, as the T-shirts consisted entirely of exact reproductions of the Three Stooges' images. *See id.* at 480.

93. *See Winter*, 69 P.3d at 479-80 (holding depictions resembling Winter brothers transformative due to addition of creative elements); *Comedy III Prods., Inc.*, 21 P.3d at 811 (concluding T-shirts containing reproductions of Three Stooges' images nontransformative). *But see* *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 938 (6th Cir. 2003) (finding collage of images of Tiger Woods transformative). In *ETW Corp.*, the Sixth Circuit deemed the artist's work transformative because in addition to the images of Woods, the work combines collages of images to describe a historic event in sports history, thus conveying a message about the significance of Woods' achievement. *See id.* By using Tiger Woods' image as merely a material within a broader work about golf history, the artist's painting in *ETW Corp.* diverts from the T-shirts in *Comedy III Productions, Inc.*, as the latter depictions are devoid of any artistic commentary. *See id.*; *see also* Gutmann,

becomes problematic when it is applied to more nuanced forms of artistic expression, such as video games.⁹⁴ In *Kirby v. Sega of America, Inc.*,⁹⁵ the court applied the transformative use test to a video game that depicted a character “Ulala,” who resembled singer Kierin Kirby, whose signature lyrical catchphrase was “ooh la la.”⁹⁶ The court in *Kirby* juxtaposed the facts of its case with *Winter v. DC Comics*,⁹⁷ another California right-of-publicity case.⁹⁸ In *Winter*, the court reasoned that the comic book portraying two well-known musicians did not violate their rights of publicity because the comic book depicted them as half-human, half-worm creatures in a fantasy world.⁹⁹ The *Kirby* court held that, like in *Winter*, Kirby’s right of publicity did not outweigh the video game creator’s freedom of expression because the character was immersed in a fantasy environment and depicted in a manner that was sufficiently different.¹⁰⁰ In *No Doubt v. Activision Publishing, Inc.*,¹⁰¹ however, the same California court came to a seemingly different conclusion.¹⁰² The court held that the video game “Band Hero” did not sufficiently transform the likeness of the band members of “No Doubt” because they were depicted playing instruments and songs that they played in real life.¹⁰³ Though some critics have called for a reformulation of the transformative use test as applied to video games, so that a line is drawn between games that are played in an “altered reality” and those that are intended as an “imitation of life,” it appears from the *Kirby* and *No Doubt* decisions that the test sufficiently draws that line: games rooted in an alternate reality generally contain sufficiently creative elements to render a work transformative, while those that merely imitate real life are not transformative.¹⁰⁴

supra note 66, at 222 (stating transformative use test useful in solving right-of-publicity claims for most media).

94. See Ford & Liebler, *supra* note 78, at 77 (suggesting courts’ failed to properly apply transformative use test to video game cases); Gutmann, *supra* note 66, at 222 (positing courts’ inconsistent approach to “murky” video game problem); *Right to Publicity Tackles Video Game Company’s Free Speech Rights*, 3rd Circuit Rules Hart v. Elec. Arts, WESTLAW J. DEL. CORP., June 24, 2013, at 1 (questioning reach of *Hart* holding).

95. 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006).

96. See *id.* at 609-10 (describing use of “Ulala”).

97. 69 P.3d 473 (Cal. 2003).

98. See 50 Cal. Rptr. 3d at 616-17 (comparing case to *Winter* case); see also *Winter*, 69 P.3d at 476 (examining whether comic book creator infringed upon *Winter* brothers’ right of publicity).

99. See *Winter*, 69 P.3d at 479-80 (stating use of *Winter* brothers’ likeness highly expressive and entitled to First Amendment protection).

100. See *Kirby*, 50 Cal. Rptr. 3d at 616 (holding use of “Ulala” sufficiently transformative).

101. 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011).

102. See *id.* at 410-11 (contrasting facts of case from *Kirby*); see also Gutmann, *supra* note 66, at 222 & nn.57-58 (questioning application of transformative use test to *No Doubt* compared to *Kirby*).

103. See *No Doubt*, 122 Cal. Rptr. 3d at 410-11 (holding use of *No Doubt*’s likenesses nontransformative).

104. See Gutmann, *supra* note 66, at 222-23 (introducing notion of “Altered Reality” and “Imitation of Life”). Gutmann seems to be advocating for the transformative use test to draw a line between games based in alternate, fanciful realities and those that imitate real life. See *id.* While he concedes *Kirby* is the archetypal “Altered Reality” video game, which the court correctly deemed as transformative, he argues *No Doubt* should

C. The “NCAA Football” Cases

I. Keller I

In 2010, the Federal District Court for the Northern District of California considered *Keller v. Electronic Arts, Inc.*,¹⁰⁵ where former college quarterback Samuel Keller brought suit against EA for allegedly violating his right of publicity.¹⁰⁶ EA is the producer of the video game “NCAA Football.”¹⁰⁷ Keller claimed, that in an effort to make the game as realistic as possible, EA designed the virtual football players in the game to resemble real-life college football athletes.¹⁰⁸ These virtual players shared the same jersey numbers, had identical physical characteristics to their human counterparts, and came from the same home state.¹⁰⁹ In fact, to ensure that EA’s reproductions of the virtual

not be recognized as the quintessential “Imitation of Life” case. *See id.* at 229, 233. Where Gutmann argues that *No Doubt* is not exactly an “Imitation of Life” video game case, he posits that a more apt example of an “Imitation of Life” case is *Hilton v. Hallmark Cards*. *See id.* at 233 (arguing *Hilton* best example of “Imitation of Life” case); *see also* *Hilton v. Hallmark Cards*, 599 F.3d 894, 909-11 (9th Cir. 2009) (applying transformative use test in denying Hallmark First Amendment protection for card imitating Paris Hilton). Gutmann asserts that the card in *Hilton* contains all of the characteristics of an “Imitation of Life” video game, pointing to its foundation in Hilton’s reputation, its attempt to mimic an episode of “The Simple Life,” and its intent to profit off of Hilton’s celebrity status. *See* Gutmann, *supra* note 66, at 233-34. While these observations may be accurate, such observations are also consistent with the characteristics of the Band Hero video game in *No Doubt*, as that game portrayed a famous rock band appearing as themselves playing the exact songs that they perform in real life. *Compare Hilton*, 599 F.3d at 911 (holding depiction of Paris Hilton working as waitress in greeting card nontransformative), *with No Doubt*, 122 Cal. Rptr. 3d at 410-11 (concluding portrayal of No Doubt band members playing their own songs nontransformative), *and Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 616 (Cal. Ct. App. 2006) (deciding conversion of Kirby from 1990s singer into alien reporter in twenty-fifth century transformative). While the use of Kirby clearly fits within the category of “Altered Reality,” it seems the video game in *No Doubt* fits within the “Imitation of Life” category as much as the greeting card in *Hilton* would if it were actually a video game. *See* Gutmann, *supra* note 66, at 233 (comparing *No Doubt* and *Hilton*). Critics’ objection to the application of the transformative use test to video games seems to be based on the Federal District Court of New Jersey’s seemingly disparate holding in *Hart*, where the court found EA’s “NCAA Football” videogame constituted a transformative work due to the built-in ability to edit player’s appearance. *See Ford & Liebler, supra* note 78, at 90 (declaring *Hart* example of court “applying special rules to games”); Gutmann, *supra* note 66, at 224-25 (focusing on apparent contradiction between California and New Jersey courts’ application of transformative use test); *see also* *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 783 (D.N.J. 2011) (focusing on ability of user to edit player), *rev’d*, 717 F.3d 141 (3d Cir. 2013); *infra* Part II.C (discussing *Hart* holding). The Third Circuit’s recent holding in *Hart*, however, conforms to the court’s holding in *No Doubt*, and today, both uses would be viewed by courts as nontransformative under the transformative use test. *See Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 168 (3d Cir. 2013) (equating *Hart* to *No Doubt* in determining use nontransformative); *infra* Part II.C (examining Third Circuit’s decision).

105. No. C 09-1967 CW, 2010 WL 530108, at *1 (N.D. Cal. Feb. 8, 2010), *aff’d sub nom. In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013).

106. *See id.* at *1-2 (stating Keller’s claims). Keller also brought claims against the NCAA and the Collegiate Licensing Company (CLC), alleging that the NCAA violated his right of publicity and the CLC facilitated that use. *See id.* These claims were dismissed with leave to amend to allege that they conspired with others to violate Keller’s right of publicity under Indiana law. *See id.* at *2-3.

107. *See id.* at *1 (explaining EA’s production of “NCAA Football” video game).

108. *See id.* (asserting Keller’s claims against EA).

109. *See Keller*, 2010 WL 530108, at *1 (explaining nature of EA’s use of players’ likenesses).

players were completely accurate, Keller claimed that EA sent questionnaires to team equipment managers to solicit the correct physical attributes of each player.¹¹⁰ Keller claimed that EA violated his right of publicity by using his likeness without his consent.¹¹¹

In analyzing Keller's claims, the court applied the transformative use test to determine whether the use of Keller's likeness in "NCAA Football" was merely one of the raw materials comprising the original work or whether the depictions of Keller and other players were the very sum and substance of the "NCAA Football" game.¹¹² To aid its analysis, the court focused on the *Comedy III Productions, Inc.* and *Winter* cases as "bookend" examples of the transformative nature of expressive works.¹¹³ The court also considered the *Kirby* case, where it compared the use of Keller's likeness in "NCAA Football" to the use of "Ulala" in the fanciful video game portraying Kierin Kirby.¹¹⁴ Ultimately, the court found a marked difference between the use of Keller in "NCAA Football" and the uses of the Winter brothers and "Ulala" in their respective cases.¹¹⁵ While in *Winter* and *Kirby* the characters were portrayed as distorted images of their human counterparts and were set in fanciful and spectacular environments, "NCAA Football" depicted Keller as he was, a college football quarterback playing at the university he actually attended.¹¹⁶ EA argued that the court took an improperly narrow focus in analyzing the video game and asked the court to recognize that "taken as a whole," the game contained transformative elements.¹¹⁷ Relying on the precedents set by *Winter* and *Kirby*, however, the court rejected this contention, focusing instead on the depiction of the plaintiff and not the extraneous elements of the work.¹¹⁸ As such, the court found "NCAA Football's" use of Keller was not transformative

110. See *id.* (positing EA's method of obtaining likenesses).

111. See *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 WL 530108, at *1 (N.D. Cal. Feb. 8, 2010), *aff'd sub nom. In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013) (asserting Keller's right-of-publicity claim).

112. See *id.* at *4 (utilizing transformative use test).

113. See *id.* (comparing facts to *Comedy III Productions, Inc.* and *Winter*); see also *Winter v. DC Comics*, 69 P.3d 473, 478-79 (Cal. 2003) (describing transformative nature of use of Winter brothers); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001) (describing nontransformative nature of Three Stooges T-shirts).

114. See *Keller*, 2010 WL 530108, at *4-5 (comparing facts to *Kirby* case); see also *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 616 (Cal. Ct. App. 2006) (stating use of "Ulala" transformative).

115. See *Keller*, 2010 WL 530108, at *5 (contrasting facts from *Winter* and *Kirby*).

116. See *id.* (deeming use of Keller's likeness nontransformative). Compare *id.* (depicting Keller in his natural environment playing quarterback for Arizona State University), with *Winter*, 69 P.3d at 479 (portraying Winter brothers as half-human, half-worm cartoon characters in fantasy environment), *Comedy III Prods., Inc.*, 21 P.3d at 811 (illustrating literal and conventional portrayals of Three Stooges), and *Kirby*, 50 Cal. Rptr. 3d at 610 (transforming "Ulala" character into news reporter in twenty-fifth century).

117. See *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 WL 530108, at *5 (N.D. Cal. Feb. 8, 2010) (highlighting EA's argument), *aff'd sub nom. In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013).

118. See *id.* (rejecting EA's argument).

and EA had violated Keller's right of publicity by misappropriating his likeness.¹¹⁹

2. Hart I

In *Hart v. Electronic Arts, Inc.*,¹²⁰ Ryan Hart, a college football quarterback for Rutgers University, brought suit against EA in the United States District Court for the District of New Jersey alleging virtually identical claims to those asserted in *Keller*.¹²¹ While the claims by Hart mirrored those of the plaintiff in *Keller*, the Federal District Court for the District of New Jersey's analysis diverged from that of the court in *Keller*.¹²² Hart urged the court to adopt California's transformative use test and apply it as the district court did in *Keller*.¹²³ The *Hart* court undertook a transformative use analysis by comparing Hart's situation with *Kirby* and *No Doubt*, which was decided after the court's initial ruling in *Keller*.¹²⁴ Though the court conceded that the college football players in "NCAA Football" differed from the use of the "Ulala" character in *Kirby*, the court was hesitant to liken the use of the players to the use of the avatars in *No Doubt*, who were exact replicas of No Doubt's band members.¹²⁵ The court differentiated between the use of Hart in "NCAA Football" and the use of the band members in *No Doubt* by highlighting the fact that "NCAA Football" afforded video game users the opportunity to alter the appearance and attributes of the game's players.¹²⁶ According to the *Hart* court, this facet of the game suggested that the goal of the game is not for the user "to 'be' the player."¹²⁷ The court found this difference significant because in *No Doubt*, the band members' avatars could not be altered.¹²⁸

119. See *id.* (denying EA's transformative use defense).

120. 808 F. Supp. 2d 757 (D.N.J. 2011), *rev'd*, 717 F.3d 141 (3d Cir. 2013).

121. See *id.* at 760-61 (stating Hart's claims and EA's use of virtual football players). Compare *id.* (addressing Hart's claims against EA for misappropriating his likeness in "NCAA Football"), with *Keller*, 2010 WL 530108, at *1 (addressing Keller's claims against EA for misappropriating his likeness in "NCAA Football").

122. See *Hart*, 808 F. Supp. 2d at 786-87 (disagreeing with *Keller* analysis).

123. See *id.* at 776, 786 (adopting transformative use test and reasoning from *Keller*).

124. See *id.* at 782-86 (applying transformative use test and comparing facts to *Kirby* and *No Doubt*).

125. See *id.* at 783 (characterizing "NCAA Football's" use of Hart as "closer call"); see also *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 410-11 (Cal. Ct. App. 2011) (describing band members' avatars as literal recreations); *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 616 (Cal. Ct. App. 2006) (describing "Ulala" as more than mere literal recreation of *Kirby*).

126. See *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 787 (D.N.J. 2011) (contrasting "NCAA Football's" use of Hart's likeness with use in *No Doubt*), *rev'd*, 717 F.3d 141 (3d Cir. 2013).

127. See *id.* (asserting goal of game not for user "to 'be' the player").

128. See *id.* (contrasting editing feature of "NCAA Football" from *No Doubt*). For the court in *Hart*, the ability of the user to alter players' appearances and attributes suggested the reproduction of the players' images was merely one of the raw materials of the game as a whole. See *id.* As such, the court believed this facet of the game communicated an artistic and expressive message that was absent in *No Doubt*. See *id.*; see also *Ford & Liebler*, *supra* note 78, at 90 (claiming *Hart* applied "special rules" to arrive at conclusion); *Gutmann*, *supra* note 66, at 224-26 (focusing on contradiction between *Keller* and *Hart*). Interestingly, Ford and Liebler praise

The *Hart* court noted the *Keller* court's failure to discuss the capability of video game users to edit the players contributed to that court's incorrect conclusion.¹²⁹ The court posited that while the depiction of the player's images in "NCAA Football" may not be as fanciful as the half-human, half-worm characters in *Winter*, the ability to edit their appearance and skill level revealed that the imitation of the player's human counterpart is not the entire sum and substance of the work.¹³⁰ Moreover, the *Hart* court disagreed with *Keller*'s approach of focusing solely on the depiction of the plaintiff, rather than viewing the totality of the expressive work.¹³¹ In the view of the *Hart* court, the courts in *Kirby* and *Winter* looked not only to the depictions of the plaintiff but also the larger story the characters were a part of, which also were comprised of transformative elements.¹³² By employing a broader transformative use analysis and in focusing on the ability of users to edit the player's physical attributes, the court in *Hart* concluded EA's "NCAA Football" video game was entitled to First Amendment protection.¹³³

3. *Hart II*

On appeal, the Third Circuit reviewed the district court's decision in *Hart* and made two momentous findings.¹³⁴ First, in surveying the myriad balancing tests at its disposal, the Third Circuit concluded that California's transformative use test was the proper analytical framework to resolve the tension between the First Amendment and right of publicity.¹³⁵ Specifically, the Third Circuit evaluated the predominant use test, the *Rogers* test, and the transformative use test.¹³⁶ The court rejected the predominant use test as subjective and arbitrary, calling on judges to act as "impartial jurists and discerning art critics."¹³⁷ Subsequently, the court rejected the *Rogers* test, deeming it a "blunt instrument," unsuitable for balancing the right of free expression against the right of publicity.¹³⁸ Ultimately, the *Hart* court found favor in the

the court in *Hart* for providing substantial First Amendment protection to the "NCAA Football" video game, but they criticize its inconsistent application of the transformative use test and its focus on the game's customization options as the vehicle for deeming the game transformative. See Ford & Liebler, *supra* note 78, at 90 (analyzing *Hart* case).

129. See *Hart*, 808 F. Supp. 2d at 787 (noting *Keller*'s failure to address editing feature).

130. See *id.* (defining use as more than sum and substance of entire work).

131. See *id.* (disagreeing with *Keller*'s approach of focusing on challenged image).

132. See *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 787 (D.N.J. 2011) (justifying broader analysis than *Keller*), *rev'd*, 717 F.3d 141 (3d Cir. 2013).

133. See *id.* (upholding EA's First Amendment defense).

134. See *id.* (reporting background of case and lower court's findings).

135. See *id.* at 163-65 (holding transformative use test appropriate balancing test in right-of-publicity cases).

136. See *Hart*, 717 F.3d at 153-165 (analyzing predominant use test, *Rogers* test, and transformative use test).

137. See *id.* at 154 (rejecting predominant use test).

138. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 157 (3d Cir. 2013) (declaring *Rogers* test "blunt

transformative use test, as it requires focus on precise aspects of a work that speak to the crux of the issue: the extent to which a work is the artist's own expression.¹³⁹

After definitively proclaiming the transformative use test as the proper

instrument"). *But see* *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241 (9th Cir. 2013) (applying *Rogers* test to *Brown*'s Lanham Act claim). In *Brown*, former National Football League (NFL) player Jim Brown sued EA for violating § 43(a) of the Lanham Act through the use of his likeness in its "Madden NFL" series of football video games. *See id.* at 1238-39 (highlighting *Brown*'s claims); *see also* Lanham Act § 43(a), 15 U.S.C. § 1125(a) (2014). Section 43(a) provides, in part:

[a]ny person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person[.]

15 U.S.C. § 1125(a).

The facts of *Brown*, *Keller*, and *Hart* are all essentially the same; EA used the likeness of an athlete in a video game. *See Brown*, 724 F.3d at 1239-40 (stating facts of case); *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1271 (9th Cir. 2013) (giving case facts); *Hart*, 717 F.3d at 145-46 (reciting facts). The important difference between *Brown*, *Keller*, and *Hart* is that *Brown* did not involve a right-of-publicity claim but rather a claim under the Lanham Act. *See Brown*, 724 F.3d at 1238-39 (highlighting *Brown*'s Lanham Act claim). If *Brown* had involved a right-of-publicity claim, the court would likely have applied the transformative use test rather than the *Rogers* test, and the use of Jim Brown's likeness would have been seen as nontransformative. *See In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1281 (explaining justification for different tests used in *Keller* and *Brown*). *But see* Gutmann, *supra* note 66, at 232-33 (analyzing *Brown* case). Despite the seemingly identical facts of *Brown*, *Keller*, and *Hart*, Gutmann suggests that the use of Jim Brown's likeness in Madden NFL would be considered transformative because the user can play as Jim Brown in a modern setting, and in real life, Jim Brown played in the NFL between 1957 and 1965. *See id.* (arguing use of *Brown*'s likeness transformative). This characterization of EA's use of *Brown*, however, conflicts with the court's analysis in *Hart*, where the court clarified that other creative elements offered by a video game should not impinge on the transformation inquiry, and the focus should remain solely on how the celebrity's identity is used or altered. *See Hart*, 717 F.3d at 169 (stating creative elements other than player's digital avatar irrelevant to transformative use inquiry); *infra* note 147 (discussing effect of other creative elements).

139. *See Hart*, 717 F.3d at 165 (accepting transformative use test as proper balancing test). When creating the transformative use test, the court in *Comedy III Productions, Inc.* did so with the intention of articulating a formula that could properly protect First Amendment interests without endorsing the mere exploitation of a celebrity's image. *See Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807 (Cal. 2001) (stating intention to develop test to distinguish between artistic works and right of publicity). In recognizing that the central inquiry should be whether a work is "transformative," the *Hart* court preserved the intention of the court in *Comedy III Productions, Inc.* *See Hart*, 717 F.3d at 163-65 (approving transformative use test); *see also* *Hilton v. Hallmark Cards*, 599 F.3d 894, 910 (9th Cir. 2009) (stating prevention of "merely merchandising" celebrity's image without consent is core of right of publicity). *Contra Ford & Liebler*, *supra* note 78, at 98 ("Games are routinely expressive and should be treated as such[.]"). Though Ford and Liebler are steadfast in their position that video games should not be subject to the transformative use test because video games are "expressive," the transformative use test does not seek to categorically remove the cloak of the First Amendment from video games or treat games "like merchandise or mere identity carriers." *See id.* Rather, the transformative use test seeks to interpret whether artistic works, such as video games, are sufficiently expressive in regard to its use of a particular identity, not whether the game is without other expressive elements. *See Hart*, 717 F.3d at 169 (focusing primarily on use of celebrity's identity rather than game as a whole).

balancing inquiry, the *Hart* court addressed whether “NCAA Football’s” use of Hart’s digital avatar should be considered transformative.¹⁴⁰ The focus of the *Hart* court’s analysis centered on whether the ability to alter Hart’s digital avatar represented a transformative use of his identity.¹⁴¹ Though the district court in *Hart* found this facet determinative, the Third Circuit noted at the outset that the mere presence of the editing feature, without more, could not satisfy the transformative use test.¹⁴² In reaching its ultimate conclusion, the court recognized that the unaltered likeness of each college football player was central to the aim of “NCAA Football”.¹⁴³ Moreover, the fact that the unaltered likeness of players such as Hart served as the default position for the game supported the notion that realistic depictions of the players were the sum and substance of the original work, rather than a mere component or one of the raw materials.¹⁴⁴ The court rejected the position that the game’s use of players’ likenesses was transformative because “NCAA Football” provided users with the option of making several trivial alterations to players, such as changing their hairstyle or accessories.¹⁴⁵ Furthermore, the court posited that major changes to a player’s avatar do not transform the player’s likeness, but rather obliterate it; the fact that “NCAA Football” lends itself to other uses of a player’s likeness does not absolve it from the original misappropriation of each likeness.¹⁴⁶ Thus, the Third Circuit found in favor of Hart and held that EA had

140. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 165 (3d Cir. 2013) (restating central issue of case utilizing transformative use lens).

141. See *id.* at 167 (considering to what extent editing facet constitutes transformative use).

142. See *id.* at 166-67 (positing editing feature alone not determinative). The *Hart* court justified its position by highlighting that a proper balancing inquiry in right-of-publicity cases does not consider whether an expressive work loses its First Amendment protection, but it instead seeks to determine whether a plaintiff’s right-of-publicity interests are sufficient to trump a work’s already existing First Amendment protection. See *id.* (claiming interactivity not end unto itself).

143. See *id.* at 168 (highlighting goal of “NCAA Football” in using players’ likenesses).

144. See *Hart*, 717 F.3d at 168 (deeming use nontransformative). “Indeed, the ability to modify the avatar counts for little where the appeal of the game lies in users’ ability to play ‘as, or alongside’ their preferred players or team.” *Id.*

145. See *id.* (explaining option to edit players in “NCAA Football” insufficient evidence of transformative use).

146. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 169 (3d Cir. 2013) (explaining major changes to likenesses unable to excuse misappropriation of original likeness). Compare *id.* (stating creative elements other than player’s digital avatar irrelevant to transformative use inquiry), with *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1240 (9th Cir. 2013) (discussing “Madden NFL’s” option to play with “historical and all-time teams”), *No Doubt v. Activision Publ’g, Inc.*, 122 Cal. Rptr. 3d 397, 411 (Cal. Ct. App. 2011) (stating ability to perform as band in outer space does not make use transformative), and *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 616 (Cal. Ct. App. 2006) (discussing futuristic setting of game). The court in *Hart* is clear that other creative elements offered by a video game, such as the ability to edit a player or to play in different stadiums, do not bear on the transformation inquiry into the actual celebrity likeness. See *Hart*, 717 F.3d at 169 (stating transformative use test looks to use of celebrity’s likeness rather than surrounding elements). While the court in *Kirby* does discuss the fanciful, futuristic setting that “Ulala” is portrayed in, the court also highlights the depiction of the “Ulala” character itself makes the use of Kirby’s likeness transformative because it differs greatly from how Kirby appears and acts in real life. See *Kirby*, 50 Cal. Rptr. 3d at 616 (stating “Ulala’s” physique dissimilar from Kirby’s). Similarly, in *No Doubt*, the mere fact that the band members can perform in

violated his right of publicity because “NCAA Football” did not sufficiently transform the players’ likenesses.¹⁴⁷

4. Keller II

After the *Hart* decision, in *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, the Ninth Circuit affirmed the district court’s holding in *Keller*, concluding that EA’s use of the likenesses of college athletes in its “NCAA Football” video game violated the players’ right of publicity.¹⁴⁸ EA again argued that the district court in *Keller*, and the Third Circuit in *Hart*, improperly ignored the transformative elements of the game as a whole.¹⁴⁹ In accordance with EA’s argument, Judge Thomas, who dissented in the Ninth Circuit’s decision, pointed to *No Doubt*, where the court highlighted the inability to alter the avatars.¹⁵⁰ Though the *No Doubt* court distinguished its case from *Kirby* by mentioning the immutability of the avatars, the Ninth Circuit’s decision in *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* rejected the notion that the *No Doubt* decision turned solely on the fact that users were unable to alter the avatars.¹⁵¹ Instead, the court regarded *No Doubt*’s decision as grounded in the fact that no matter where the avatars were depicted performing, be it outer space or other fanciful venues, the avatars still represented the actual band members of No Doubt doing exactly what they do in real life, performing their rock songs.¹⁵² Incorporating this analysis into

outer space does not make the use of their otherwise unchanged avatars transformative. *See No Doubt*, 122 Cal. Rptr. 3d at 411 (stating setting in which band members displayed immaterial). As such, the use of Jim Brown’s likeness in “Madden NFL”, despite the ability of the user to play with him in a modern time frame, would not be considered transformative, as it much closer comports to the uses of the unchanged avatars described in *Hart* and *No Doubt* than the transformative use discussed in *Kirby*. *Contra* Gutmann, *supra* note 66, at 232-33 (arguing “Madden NFL’s” use of Brown transformative due to time frame).

147. *See Hart*, 717 F.3d at 170 (holding “NCAA Football’s” use of players’ likenesses violates right of publicity).

148. *See In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1284 (9th Cir. 2013) (affirming lower court’s ruling).

149. *See id.* at 1276 (addressing EA’s argument for broader application of transformative use test).

150. *See id.* at 1287 (Thomas, J., dissenting) (arguing *No Doubt* court cited immutability of characters as chief factor in decision); *see also No Doubt*, 122 Cal. Rptr. 3d at 409-10 (stating avatars remain immutable at all times).

151. *See In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1276-77 (rejecting dissent’s reading of *No Doubt*).

152. *See id.* at 1277 (aligning *No Doubt* holding with present case); *see also No Doubt v. Activision Publ’g, Inc.*, 122 Cal. Rptr. 3d 397, 411 (Cal. Ct. App. 2011) (deeming avatars literal recreations of band members). The court in *No Doubt* stated:

That the avatars can be manipulated to perform at fanciful venues including outer space or to sing songs the real band would object to singing, or that the avatars appear in the context of a videogame that contains many other creative elements, does not transform the avatars into anything other than exact depictions of No Doubt’s members doing exactly what they do as celebrities.

No Doubt, 122 Cal. Rptr. 3d at 411. The court in *In re NCAA Student-Athlete Name & Likeness Licensing*

its own case, the court posited that the use of the players' likenesses were not transformative because "NCAA Football" used realistic portrayals of college football players in the context of college football games.¹⁵³

III. ANALYSIS

A. *Hart* and *In re NCAA Student-Athlete Name & Likeness Licensing Litigation Got it Right*

1. *The Transformative Use Test: The Proper Balancing Approach*

In adopting the transformative use test as the principal balancing test between the right of publicity and the First Amendment, the decisions in *Hart* and *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* illuminated a hazy area of law and articulated a just definition of the right of publicity against the weight of the First Amendment.¹⁵⁴ The *Comedy III Productions, Inc.* court created the transformative use test to preserve an artist's right to free expression while limiting the artist's ability to exploit an individual's image under the guise of First Amendment protection.¹⁵⁵ While some commentators opine that video games should not be subject to the transformative use test because such forms of media are inherently expressive, the transformative use test does not destroy video game creators' First Amendment rights.¹⁵⁶ Rather, the aim of the transformative use test is to decipher whether an expressive work, such as a video game, is sufficiently expressive in regard to its use of a particular *identity*, not whether the game is devoid of expressive elements altogether.¹⁵⁷

Litigation characterizes these observations by the *No Doubt* court as the crux of their holding. See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1277.

153. See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1279 (stating district court correct in rejecting EA's transformative use defense). The court in *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* aligned its decision with the Third Circuit in *Hart*. See *id.* at 1278. The court in *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* found merit in the *Hart* court's statement that "the lack of transformative context is even more pronounced here than in *No Doubt*." *Id.* (quoting *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 166 (3d Cir. 2013)). The court also agreed with the *Hart* court in that "the ability to modify the avatar counts for little where the appeal of the game lies in users' ability to play as, or alongside[,] their preferred players or team." *Id.* (alteration in original) (quoting *Hart*, 717 F.3d at 168)).

154. See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1273-79 (9th Cir. 2013) (undertaking transformative use analysis); *Hart*, 717 F.3d at 165 (adopting transformative use test as proper balancing framework).

155. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807 (Cal. 2001) (stating intention to develop test distinguishing between artistic works and right of publicity). The court in *Comedy III Production, Inc.* was concerned with maintaining the right of publicity in the face of the First Amendment and sought to formulate a test that allowed celebrities to prevent others from exploiting the economic value of their image, without giving the celebrity a right of censorship. See *id.*

156. *Contra Ford & Liebler*, *supra* note 78, at 98 (arguing video games are expressive).

157. See *Comedy III Prods., Inc.*, 21 P.3d at 809 (focusing on celebrity likeness rather than entire work). In clarifying the nature of the transformative use test, the court stated, "[a]nother way of stating the inquiry is

By focusing on whether an artistic work transforms an identity, the transformative use test allows courts to account for the reality that misappropriation can occur in various markets, including the video game arena.¹⁵⁸ In this light, the courts in *Hart* and *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* properly recognized that the inquiry should begin by considering the extent to which “NCAA Football’s” depiction of college athletes was EA’s own expression and what portion represented exploitation of the value of the players’ images.¹⁵⁹ That is to say, the courts were correct to ask whether EA’s portrayal of college athletes was “transformative.”¹⁶⁰

2. *The Identity Must Be Transformed*

While the courts in *Hart* and *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* agreed the transformative use test is the correct balancing test in right-of-publicity dilemmas, the dissents in both cases vehemently objected to the individualized formulation of the transformation inquiry and submitted that a more holistic and contextual approach is appropriate.¹⁶¹ Judge Thomas, who dissented in the Ninth Circuit’s decision, rationalized his call for a more holistic application of the transformative use test by highlighting the fact that the “gamer controls the teams, players, and games,” including the

whether the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.” *Id.* It is important to note that the *Comedy III Productions, Inc.* court specifically mentioned the depiction of the celebrity, rather than the totality of the work. *See id.* at 809. As such, the *Hart* and *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* courts correctly interpreted the transformative use test in electing to focus on “NCAA Football’s” depiction of each individual, rather than focus on extraneous, potentially expressive elements of the game. *See In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1276-77 (rejecting argument of considering entirety of game); *Hart*, 717 F.3d at 168-69 (focusing primarily on use of celebrity’s identity rather than entirety of game).

158. *See Hart*, 717 F.3d at 163 (commenting on comprehensive nature of transformative use test).

159. *See In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1276 (concluding EA’s use of Keller’s likeness nontransformative); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 163 (3d Cir. 2013) (applying transformative use test in determining whether “NCAA Football” transformed players’ identities). The *Hart* court noted that the transformative use test is most significant due to the underlying question that it poses: “‘what use did the [defendant] make of the [celebrity identity]?’” *Hart*, 717 F.3d at 164 (alterations in original) (quoting *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 581 (1977) (Powell, J., dissenting)). By engaging in this inquiry, courts can uncover whether a work “was merely created to exploit a celebrity’s likeness.” *Id.* at 163; *see also Hilton v. Hallmark Cards*, 599 F.3d 894, 910 (9th Cir. 2009) (stating prevention of “merely merchandising” celebrity’s image without consent core of right of publicity).

160. *See In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1272-73 (9th Cir. 2013) (asking whether Keller’s identity transformed); *Hart*, 717 F.3d at 165 (asking whether Hart’s identity transformed).

161. *See In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1285 (Thomas, J., dissenting) (arguing majority approach contradicts holistic analysis required by transformative use test); *Hart*, 717 F.3d at 171 (Ambro, J., dissenting) (stating majority inappropriately limits transformation inquiry to identity alone).

capability to change the players' appearances and abilities.¹⁶² As such, Judge Thomas characterized the athletes' likenesses in "NCAA Football" as merely one of the raw materials upon which the game was synthesized, rather than the sum and substance of the game.¹⁶³ Judge Thomas seemed to suggest that the likeness should be considered transformed because a third party can manipulate EA's original reproduction of an athlete's likeness.¹⁶⁴ To affirm his position, Judge Thomas made a curious comparison to *Winter* and *Kirby*; he seemed to argue that the virtual college football players in "NCAA Football" are the creative equivalents to the half-human, half-worm creatures depicted in *Winter* and the alien-like space age reporter portrayed in *Kirby*.¹⁶⁵ The driving force behind Judge Thomas's comparison is the idea that a third-party gamer could potentially edit each of the realistically created avatars in "NCAA Football" to reach a level of creativity akin to the fanciful creatures articulated in *Winter* and *Kirby*.¹⁶⁶

The transformative use test, however, does not contemplate a third party's potential for artistic creativity; it measures whether the artist's immediate use of a likeness is sufficiently creative to be considered transformative.¹⁶⁷ Moreover, the question of whether the use of a likeness is one of the raw materials from which the broader work is constructed or whether it represents the very sum and substance of the game cannot be resolved by examining what a third party makes of the use.¹⁶⁸ Further, the transformative inquiry should not

162. See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1286 (Thomas, J., dissenting) (equating gamer's ability to edit avatars to transformative use).

163. See *id.* (stating likenesses but one of many raw materials of broader game).

164. See *id.* at 1285-86 (focusing on gamer's control over game rather than EA's use of likenesses).

165. See *id.* (comparing "NCAA Football" game to comic book in *Winter* and video game in *Kirby*). Compare *id.* at 1271-72 (discussing EA's use of college football players for college football video game), with *Winter v. DC Comics*, 69 P.3d 473, 476 (Cal. 2003) (discussing use of *Winter* brothers for comic book about half-human characters named "Autumn brothers"), and *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 610 (Cal. Ct. App. 2006) (describing purported use of *Kirby*'s likeness in video game featuring alien-like character named "Ulala").

166. See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1286 (9th Cir. 2013) (Thomas, J., dissenting) (aligning virtual players in "NCAA Football" with those described in *Winter* and *Kirby*).

167. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 168 (3d Cir. 2013) (focusing on default use of likeness in "NCAA Football" as evidence of nontransformation).

168. See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1278 (agreeing ability to modify players counts for little in transformative use analysis); *Hart*, 717 F.3d at 168 (declining to credit users' ability to alter players' avatars in transformative use analysis). *Contra* *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1287 (Thomas, J., dissenting) (describing majority's focus on portrayal of single athlete's likeness inappropriate); *Hart*, 717 F.3d at 175 (Ambro, J., dissenting) (deeming inquiry into *Hart*'s individual image limited). If a third party's ability to edit a reproduced likeness could make the use of that likeness transformative, it would follow that the artist's primary use of the Three Stooges' likeness should be considered transformative because a third-party who purchased a T-Shirt bearing the likenesses of the Three Stooges could potentially alter their appearances by drawing a moustache on each of their faces. Compare *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1286 (Thomas, J., dissenting) (arguing gamer's ability to edit players makes EA's use transformative), with *Comedy III Prods., Inc. v. Gary Saderup*,

depend on potential constructions of the use, such as the option in “NCAA Football” to alter or edit each player’s avatar.¹⁶⁹ It is dubious that the very sum and substance of “NCAA Football” depends on the gamer’s manipulation of EA’s default settings.¹⁷⁰ Rather, the customization facet of “NCAA Football” is merely a component, or “raw material,” within a broader game rooted in realism; not one that renders EA’s primary use of each athlete’s likeness transformative.¹⁷¹

B. The Right of Publicity After Hart and In re NCAA Student-Athlete Name & Likeness Licensing Litigation

The courts’ holdings in *Hart* and *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* reflect an emerging recognition among the federal circuits that the right of publicity is not a right of censorship, but an economic right.¹⁷² By firmly acknowledging an individual’s economic right in the value of his or her own image, the Third and Ninth Circuits have not only incentivized artists to obtain an individual’s consent before using his or her likeness but have also encouraged plaintiffs to bring action against potential right-of-publicity infringers.¹⁷³ An example of the increase in right-of-publicity litigation is the recent wave of lawsuits filed by former NFL players against NFL Films.¹⁷⁴ The first suit filed, *Dryer v. National Football League*,¹⁷⁵ was settled in March of 2013 when the parties agreed to a forty-two million dollar

Inc., 21 P.3d 797, 811 (Cal. 2001) (finding appropriate focus on producer of conventional celebrity depictions). The court in *Comedy III Productions, Inc.*, the pioneer of the transformative use test, stated, “we are concerned not with whether conventional celebrity images should be produced but with who produces them and, more pertinently, who appropriates the value from their production.” 21 P.3d at 811. Although it may be true that a third party can alter the artist’s use of an individual’s likeness, the individual’s right of publicity is nonetheless violated by the artist’s initial appropriation. *Cf. id.*

169. *See Hart*, 717 F.3d at 168 (focusing on default use of likeness in “NCAA Football” as evidence of nontransformation).

170. *See id.* (stating realistic depictions of players sum and substance of “NCAA Football”).

171. *See id.* at 167 (discussing unwillingness to convert ability to alter avatar “from mere feature to talisman”).

172. *See In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1284 (9th Cir. 2013) (holding EA’s use of likenesses not protected by First Amendment); *Hart*, 717 F.3d at 170 (holding Hart’s identity not transformed by “NCAA Football”).

The necessary implication of this observation is that the right of publicity is essentially an economic right. What the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity’s fame through the merchandising of the “name, voice, signature, photograph, or likeness” of the celebrity.

Comedy III Prods., Inc., 21 P.3d at 807.

173. *See* Associated Press, *supra* note 11 (describing right-of-publicity suit filed by former NFL players); Voreacos, *supra* note 11 (detailing suit filed by former NFL players).

174. *See supra* note 11 (discussing recent right-of-publicity suits filed by former NFL players).

175. No. 09-2182 (PAM/AJB), 2013 WL 4781030 (D. Minn. Sept. 6, 2013).

settlement.¹⁷⁶ Many of the players involved in the *Dryer* suit, however, were unhappy with the level of compensation and elected to opt out.¹⁷⁷ As a result, two additional suits were filed by former NFL players: *Culp v. NFL Productions, LLC*,¹⁷⁸ which was filed on August 20, 2013 in the United States District Court for the District of New Jersey and *Tatum v. National Football League*,¹⁷⁹ which was filed on August 30, 2013 in the United States District Court for the Western District of Pennsylvania.¹⁸⁰ Although the judge in *Dryer* halted the subsequent lawsuits for violating an injunction against such actions while *Dryer* was pending, the fact that these subsequent suits were filed within a month after the *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* decision and three months after the *Hart* decision evidences future trends of increased right-of-publicity litigation.¹⁸¹

Not only will right-of-publicity suits such as the aforementioned suits against the NFL continue to arise, but such suits will likely be successful.¹⁸² In the NFL Films cases, where former players sued to receive payment for the use of their likenesses in film footage aired on NFL Network, courts would utilize the transformative use test to decipher whether the use of each player's likeness was a mere raw material within a broader work or the very sum and substance of the work.¹⁸³ In light of *Hart* and *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, if the particular footage in question displays a player's likeness doing exactly what he or she does in real life, then the reproduction of that player's likeness will be deemed as the very sum and substance of the work and thereby a violation of the player's right of publicity.¹⁸⁴ Though many critics may chastise this result as an amputation of

176. See Voreacos, *supra* note 11 (describing *Dryer* suit).

177. See *id.* (providing details of *Culp* suit in wake of *Dryer* settlement).

178. Class Action Complaint, *supra* note 11.

179. Complaint, *supra* note 11.

180. See *Dryer*, 2013 WL 4781030, at *1 (detailing filing of *Culp* and *Tatum* suits).

181. See *Dryer v. Nat'l Football League*, No. 09-2182 (PAM/AJB), 2013 WL 4781030, at *4 (D. Minn. Sept. 6, 2013) (dismissing *Culp* and *Tatum* suits without prejudice).

182. See *id.* at *1 (detailing filing of *Dryer*, *Culp*, and *Tatum* suits). The decisions in *Hart* and *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* have paved the way for consistent application of the transformative use test. See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1284 (9th Cir. 2013) (holding EA's use of likenesses not protected by First Amendment); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 170 (3d Cir. 2013) (holding Hart's identity not transformed by "NCAA Football"); *Right to Publicity Tackles Video Game Company's Free Speech Rights*, *supra* note 94, at 2-3 (stating transformative use test applied in *Hart* and *Keller* "emerging trend" and "consensus"). *Contra* Gutmann, *supra* note 66, at 222 (suggesting courts' inconsistent approach to "murky" video game problem).

183. See *supra* note 182 (discussing emerging uniform application of the transformative use test). Compare *Dryer*, 2013 WL 4781030, at *1 (detailing suits involving former NFL players against NFL for reproductions of their likenesses), with *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575-76 (1977) (discussing reproduction of performer's entire live act).

184. See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1284 (holding EA's use of likenesses not protected by First Amendment); *Hart*, 717 F.3d at 170 (holding Hart's identity not transformed by "NCAA Football"); *No Doubt v. Activism Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 410-11 (Cal. Ct. App. 2011) (deeming band members' avatars exact depictions of what they do as celebrities); *Right to Publicity*

artists' First Amendment rights, its effect is nominal.¹⁸⁵ Conversely, courts' willingness to appreciate individuals' right of publicity will separate truly creative works of expression from mere reproductions and misappropriations.¹⁸⁶

IV. CONCLUSION

The right of publicity is neither a right to censorship nor a threat to the existence of free expression. Instead, the right of publicity is an economic right that allows individuals to benefit from the fruits of their achievements. Though in some cases it is difficult to decipher where the First Amendment ends and the right of publicity begins, the transformative use test best reconciles these clashing interests by analyzing whether an expressive work is sufficiently expressive in regard to its use of a particular *identity*. As such, when an

Tackles Video Game Company's Free Speech Rights, *supra* note 94, at 2-3 (stating transformative use test emerging as preferred test). *But see* *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 938 (6th Cir. 2003) (holding collage of images of Tiger Woods transformative due to historical context of display). The court in *ETW Corp.* borrowed from the transformative use test to decide that the arrangement of images in addition to Woods's image sent a particular message about Woods's place in golf history after winning the Masters Tournament in 1997. *See id.* at 938. Specifically, the painting was titled "The Masters of Augusta" and contained the very same caption on the artwork. *See id.* at 918. The collage described in *ETW Corp.* differs from the portrait images discussed in *Comedy III Productions, Inc.* because those images were mere reproductions of the Three Stooges' images. *Compare id.* at 938 (holding painting of Woods's victories transformative due to historical context factor), *with* *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001) (holding artist's work contains no significant creative contributions). If the NFL films cases presented a fact situation similar to that in *ETW Corp.*—for example, if there was a montage of former and current NFL players with the caption "The NFL: Through the Years"—that use may prove to be transformative under the current formulation of the transformative use test. *Cf. ETW Corp.*, 332 F.3d at 938.

185. *See, e.g.*, *Blanke*, *supra* note 25, at 67 (asserting courts must place greater weight on First Amendment); *Ford & Liebler*, *supra* note 78, at 98 (arguing First Amendment should stand in way of treating video games like identity carriers); *Schoeneberger*, *supra* note 7, at 1918 (stating lack of clear standard deterring creative endeavors).

186. *See Comedy III Prods., Inc.*, 21 P.3d at 807. The court's objective in *Comedy III Productions, Inc.* was precisely to develop a test that would differentiate between truly creative uses of an individual's likeness and uses that are mere misappropriations. *See id.*

It is admittedly not a simple matter to develop a test that will unerringly distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity. Certainly, any such test must incorporate the principle that the right of publicity cannot, consistent with the First Amendment, be a right to control the celebrity's image by censoring disagreeable portrayals. Once the celebrity thrusts himself or herself forward into the limelight, the First Amendment dictates that the right to comment on, parody, lampoon, and make other expressive uses of the celebrity image must be given broad scope. The necessary implication of this observation is that the right of publicity is essentially an economic right. What the right-of-publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity's fame through the merchandising of the "name, voice, signature, photograph, or likeness" of the celebrity.

Id.

ostensibly expressive work merely reproduces a celebrity image without adding any significant artistic or creative elements, the transformative use test properly bars the work's creator from using the identity without that person's consent, hampering the creator's ability to hide behind the veil of the First Amendment. By endorsing the transformative use test as the primary balancing instrument between the right of publicity and the First Amendment, the courts in *Hart* and *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* accurately recognized that the inquiry into whether a work has misappropriated an identity must begin by asking the critical question of whether the work has sufficiently *transformed* that identity. In this light, the Third and Ninth Circuits firmly recognized that a person has a material economic right in the value of his own image, and artists who seek to commercialize that image should be compelled to obtain that person's consent.

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