

A MEDIUM-BASED PROPOSAL TO RESOLVING TENSION BETWEEN PUBLICITY RIGHTS AND THE FIRST AMENDMENT

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“Publicity is the life of this culture—in so far as without publicity capitalism could not survive—and at the same time publicity is its dream.” – John Berger¹

I. INTRODUCTION

One need not look far to spot a nationally or internationally recognizable name or face. Fame is an undeniable component of our culture and has only been exacerbated by the rise of mass communication and social media. Today, human communication relies in part on the use of the images and likenesses of others, and speakers and artists frequently employ textual references and visual representations of others in their works. From titles, names, and characters in literature to modern fine art and computer-generated representations for video games, the likenesses of others are engrained in modern artistic and expressive culture.

Quite rarely, however, is it the actual individual using his or her own image or likeness. Rather, both artistic expression and social commentary thrive on the use of the identities of others. Shepard Fairey’s use of Barack Obama in his renowned HOPE posters and Andy Warhol’s use of Marilyn Monroe, Elizabeth Taylor, Mao Ze Dong, and Elvis Presley in his renowned silkscreen paintings are just a few examples of popular, expressive works that directly employed the image and likeness of a famed individual. Yet not all uses of other’s images or likenesses are so forthright, as the use of the image or likeness can vary both quantitatively and qualitatively. The artist or speaker may employ another’s image or likeness without making that individual the focal point of the expression, as in collages, or use an individual’s image or likeness in part of a larger, more dynamic and complex manner directed at user experience, as seen in video games. In other contexts, the evocation of another’s likeness can be as simple as singing or writing the person’s name, as is the case with musical lyrics. For example, Billy Joel’s “We Didn’t Start the Fire,” references numerous celebrities throughout its verses including: Joe DiMaggio,

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1. JOHN BERGER, *WAYS OF SEEING* 154 (1972).

Malcolm X, Mickey Mantle, James Dean, and Elvis Presley, to name a few.² Still in other contexts, such as a biographical works, the use of the likeness is the fundamental foundation of the work.

It is clear the production of an individual's image or likeness can span the gamut in both the medium in which it is conveyed and the purpose for which the likeness is employed. Nevertheless, the level of legal protection afforded to the various avenues of artistic expression varies by context—the result of a multitude of tests employed by state and federal courts across the United States. But while particular uses of another's image or likeness—like biographical endeavors and movies, books, and songs that include real historical characters in fictional settings—find constitutional protection under the First Amendment under certain tests, not all expression that employs another's image or likeness finds constitutional protection under the First Amendment. Instead, both the level of constitutional protection afforded to artists and speakers and the level of defensible interest one has in his or her own image in likeness is largely dependent on the state or federal law that governs the dispute.

As a result, speakers and artists who create in particular mediums across various industries—such as modern digital media, fine art, visual commentary, and video-game graphics—are left to the discretion of the judicial system in its role as “art critic” determining what “high art” is protected expression, and what “low art” misappropriates another's publicity right. While the notion of allowing courts to take on the role of the art critics, in turn placing value judgments on the expressive caliber of the work at issue, presents the risk that judges may not be appropriately trained to make such an artistic or expressive evaluation, this Comment argues that no one modern test applied across the United States can effectively operate in every medium in which publicity disputes arise. However, much can be learned from the current operating tests. In requiring that the use of another's image or likeness meets a certain transformative threshold, the transformative-work test, albeit implicitly, allows the judiciary to inquire into the purpose of the use of the likeness from the perspective of the speaker or artist. The transformative-work test thus subsumes various relevant inquiries that are the focus of other competing tests across the nation. Coupling the transformative-work test with two important preliminary threshold questions results in a combination that effectively serves as a universally applicable analytical approach to balancing the right of publicity with constitutional protections of the First Amendment.

2. *We Didn't Start the Fire*, AZLYRICS, <http://www.azlyrics.com/lyrics/billyjoel/wedidntstartthefire.html> (last visited Nov. 11, 2016).

Part II details the emergence of the right of publicity, the right's various historical common law roots throughout the states, the tension between the right of publicity and First Amendment free speech rights, and the various tests applied across the states in different contexts that implicate an individual's right of publicity. Finally, through application of various fact patterns in the various test frameworks, Part III illuminates the inconsistencies facing the artistic world and maintains that regardless of the test applied, courts are left determining when the use of one's likeness meets an acceptable threshold for protection, and in turn, what type of artistic use of that likeness society values and should protect. Thus, in a growing area of law that begs for clarity and guidance given the multitude of tests applied across the nation, speakers and artists are left to the fate of what law governs the dispute. This Comment does not intend to derail any justification for a right of publicity as it does not attack the traditional justifications, rather it seeks only to illuminate the inconsistencies of various tests applied across the states and cast light upon the importance of finding on a test that can adequately balance publicity rights and First Amendment free-expression principles across the nation. It recommends that courts should employ a three-pronged test that is universally applicable across the various mediums in which publicity disputes arise.

II. BACKGROUND

A. History of the Right of Publicity and Supporting Rationales

The right of publicity can be traced back to the 1953 Second Circuit case *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*³ In *Topps*, professional baseball players entered into contracts to allow Plaintiff gum manufacturer to use their photographs in connection with gum sales.⁴ The agreement prohibited the players from granting a similar right to any other person or company.⁵ The Defendant, a gum manufacturing competitor, induced the baseball players to enter into similar contracts and used the player's photographs for their own products.⁶ Judge Frank, writing for the majority, stated:

[I]n addition to and independent of that right of privacy . . . a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such

3. *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

4. *Id.* at 867.

5. *Id.*

6. *Id.*

a grant may validly be made “in gross,” i.e., without an accompanying grant of a business or of anything else . . . This right might be called a “right of publicity.” For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, buses, trains and subways.⁷

Record shows that Judge Frank was apparently the first to coin the term “right of publicity”—a label that embodies the “law’s recognition of the property right inherent in the commercial value of a person’s identity”—in 1953.⁸ Although not always under the label “right of publicity,” throughout the 1960s and 1970s this right became recognized under the common law of various states.⁹

The categorization of the right varied across states; some viewed the right as a privacy right, while others saw the right as stemming from a property interest.¹⁰ Other states saw the right stemming from unfair competition.¹¹ Still, others did not view the categorization as an important determination; if there was harm, the law provided a remedy regardless of the name.¹²

There are a few distinct rationales for the right of publicity. The first lies in natural law—derived from “a human being’s right to control the commercialization of his or her identity [a]s a natural and self-evident right.”¹³ This rationale supports a right that allows one to “exercise for his own profit . . . [or] restrain another who is using it for gain.”¹⁴ The natural law justification of the right of publicity hypothesizes that if something has value in the market, the ownership should belong to the person from which the value stems.¹⁵ In essence, the natural law rationale places the individual at the center in which he may control the use of his image or likeness.

7. *Id.* at 868.

8. 1 J. THOMAS MCCARTHY, RIGHTS OF PUBLICITY AND PRIVACY § 6:3 (2d ed.)

9. 1 MCCARTHY, *supra* note 8, § 6:4.

10. *Id.*

11. *Id.*

12. *Motschenbacher v. R. J. Reynolds Tobacco Co.*, 498 F.2d 821, 825–26 (9th Cir. 1974) (The court found it “need not decide whether [California courts] would recognize this right under the rubric of privacy, property, or publicity, [but rather only] determine that [California courts] would recognize such an interest and protect it.”) (internal quotations omitted).

13. 1 MCCARTHY, *supra* note 8, § 2:5.

14. *Munden v. Harris*, 134 S.W. 1076, 1078 (Mo. App. 1911).

15. *Id.*

The second justification for the right of publicity is incentive-based.¹⁶ This rationale posits that individuals who engage in certain activities that require entrance into the public scene deserve an economic incentive, and that any recognition of that commercial value in one's identity would encourage individuals to engage in such activities.¹⁷ However, this characterization of an "incentive" theory begs the following question: which activities does the law incentivize?¹⁸ While there is some debate surrounding this question, there is a general consensus that the activities "are socially enriching actions which bring one's identity into the public eye as a necessary consequence of success in one's profession."¹⁹ Although this justification for the right is applicable in disputes involving famous or well-recognized professionals or celebrities, the incentive rationale carries far less weight in the context of an ordinary layperson who acquires fame through association with an event that provided little incentive to the public at large.²⁰ An example of this would be publicity resulting from acts of racial brutality. In these cases, support for the right of publicity must be found in other rationales such as the natural right.

A third rationale for the right of publicity lies in economic theory. In short, the economic justification for publicity rights posits that "[o]nce the law recognizes a property right in the commercial use of identity, then the advertiser to whom that identity is most valuable will pay to" license it at "market price."²¹ Judge Posner, a renowned economic and legal theorist and sitting judge on the Seventh Circuit, argues that without recognized property rights in publicity rights, there is no "market" or "market price."²² Judge Posner argues that "[c]reating artificial scarcity preserves the value to [the individual], to advertisers who contract for the use of his likeness, and in the end, to consumers, who receive information from the knowledge that he is being paid to endorse the product."²³ Those privy to rationales steeped in social utility find favor in the economic justification for a right of publicity. However, practically speaking, the maximization of "allocative efficiency" is rarely at the forefront of judges' or lawyers' minds when pondering legal rights.²⁴ For this reason, the natural right

16. 1 MCCARTHY, *supra* note 8, § 2:6.

17. *Id.*

18. *Id.*

19. *Id.*

20. *Id.*

21. 1 MCCARTHY, *supra* note 8, § 2:7.

22. *Id.*

23. *Matthews v. Wozencraft*, 15 F.3d 432,438 (5th Cir. 1994).

24. See Mark F. Grady, *A Positive Economic Theory of the Right of Publicity*, 1 UCLA ENT. L. REV. 97, 106 (1994) ("[Judge] Posner has sometimes stressed, since few judges know much about modern economics, it is usually wiser for them to rely on traditional methods of legal reasoning—analagizing and distinguishing prior cases.").

justification, not the economic incentive, finds favor with the majority of legal theorists.

Still other scholars have argued that, similar to the natural law justification, a right of publicity finds support in a right of “autonomous self-definition.”²⁵ At the core of this rationale is the belief that the things people choose to associate themselves with are a reflection of their desired perception.²⁶ Moreover, an unauthorized use of an individual’s identity tramples on that individual’s choice of association.²⁷ Said differently, “[t]here are costs to whatever meaning we project, and those costs are borne uniquely by the individual. It is that interest, and only that interest, that the law should seek to protect.”²⁸ These various theories justify the right of publicity from differing starting points and foundational building blocks. Nevertheless, they are important to keep in mind when evaluating the right in a modern context.

B. Competing Interests: The First Amendment and the Right of Publicity

Critics of the right of publicity contend that the individual right is inherently in conflict with free speech principles of the First Amendment.²⁹ These champions of free speech have gone so far as to argue that the law should discontinue any recognition of the right of publicity, even in the commercial advertising context.³⁰ However, although free speech is no less a valid concern, it is not by itself “a legitimate reason for wholesale rejection of a right of publicity in any and all cases.”³¹ Those who disagree with the free speech advocates insist that if the First Amendment required an abolishment of the right of publicity, similar logic would also require the law to abandon its recognition of other “bodies of civil law, such as copyrights, trademarks, defamation, and antitrust,” all of which can conflict with principles of free speech.³² Any outright abolishment of the right of publicity would upend the traditional balancing of individuals rights and the public’s right to “access

25. See M.P. McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 225 (2005).

26. *Id.* at 229.

27. *Id.* at 294.

28. *Id.*

29. Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 U. HOUS. L. REV. 903, 929–30 (2003) (arguing that in many areas, like biographies and news reporting, the right of publicity has “yielded” to the First Amendment; nevertheless, that it can be argued that “the right of publicity is unconstitutional as to all noncommercial speech.”).

30. *Id.*

31. 1 MCCARTHY, *supra* note 8, § 2:4.

32. *Id.*

. . . socially and politically useful ideas.”³³ Our system has a long history of requiring judges to balance competing rights and interests.³⁴ This constant balancing between publicity rights and free speech rights has resulted in multiple analytical frameworks to balance the competing interests.

C. Misappropriation of Publicity Rights

Across the United States, courts have crafted various tests in attempts to appropriately balance the competing interests of publicity rights and free speech principles in right of publicity disputes. These multiple tests approach the analysis from different angles. Some courts focus on the degree of “transformation” added by the speaker or artist. Others inquire as to the speaker’s or artist’s “purpose” in the use of another’s identity, or the “relation” of the use to the publicity-right holder. Still others simply balance the interest in allowing the speech with the publicity-right holder’s interest in preserving autonomy over the individual right.

1. The First Amendment as a Defense to Publicity Misappropriation

a. The Transformative-Use Test

Both the Third and Ninth Circuits have held that if the use of another’s identity “transforms” the utilized aspect of the person’s identity, then the First Amendment protects such use.³⁵ For example, when speech “distort[s]” or “trans[forms]” a person’s likeness or life story “for purposes of lampoon, parody, or caricature,” such use is protected by the First Amendment.³⁶ Thus, under this transformative-use test, the First Amendment protects a speaker or artist who builds a character based upon a real person that is “more of a ‘fanciful, creative character’ than an ‘imitative character.’”³⁷

However, under this transformative-use test the use of another’s

33. *Id.* (citing Douglas G. Baird, *Common Law Intellectual Property and the Legacy of International News Service v. Associated Press*, 50 U. CHI. L. REV. 411, 420 (1983)).

34. *See* Douglas G. Baird, *Common Law Intellectual Property and the Legacy of International News Service v. Associated Press*, 50 U. CHI. L. REV. 411, 420 (1983) (“[Judges must balance] the natural rights theory of intellectual property [with] the need to keep ideas flowing freely and to keep competition alive generally.”).

35. *See* *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 165 (3rd Cir. 2013); *Davis v. Elec. Arts, Inc.*, 775 F.3d 1172, 1177–78 (9th Cir. 2015); *In Re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268, 1273–78 (9th Cir. 2013).

36. *Hilton v. Hallmark Cards*, 599 F.3d 894, 910 (9th Cir. 2009) (citing *Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003)).

37. *Id.* at 911.

identity is not protected when the likeness is used in the same setting or environment that the person is usually associated with or usually appears in, even if the speech jokes about that context or environment. In other words, the Third and Ninth Circuits' transformative-use test does not afford First Amendment protection for any such use that casts the person in his or her socially recognizable context or environment.³⁸ For instance, when a video game "realistically portray[s]" an athlete, the transformative-use test will not protect such use of an individual's likeness.³⁹

b. The Transformative-Work Test

The California Supreme Court employs a similar, yet distinguishable test from the transformative-use test applied in the Third and Ninth Circuits, known as the transformative-work test. The transformative-work test also focuses the analysis on a "transformation," but rather than focusing on whether a person's name or likeness is itself altered, a transformative-work analysis asks whether the name or likeness is combined with other materials that transform the name or likeness into a new work. Thus if "the work in question [adds] significant creative elements so as to be transformed into *something more than a mere celebrity likeness or imitation*," then the transformative-work approach will protect the work on First Amendment grounds.⁴⁰

In *Comedy III Productions Inc. v. Gary Saderup, Inc.*, defendant Gary Saderup produced lithographs from a charcoal sketch of "The Three Stooges."⁴¹ Applying the transformative-work test, the California Supreme Court found that Saderup's use of the comedy trio's image did not contain significant transformative elements, and that the value of the work derived primarily from the celebrities' fame. Although the Third and Ninth Circuits have understood *Comedy III* as supporting the transformative-use test, the reasoning of *Comedy III* is more in line with the transformative-work approach, which asks whether the speaker has added material to the work in addition to the likeness of the individual⁴² not whether the speaker has necessarily "distort[ed]" the celebrity's identity to satirize, mock, or parody.⁴³

Comedy III's discussion of famed Andy Warhol's direct depictions

38. *Hart*, 717 F.3d at 168–69; *Davis*, 775 F.3d at 1177–78; *In Re NCAA*, 724 F.3d at 1276.

39. *Id.*

40. *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 799 (Cal. 2001) (emphasis added).

41. *Id.* at 800–01.

42. *Id.* at 810.

43. *Hilton*, 599 F.3d at 910.

of Marilyn Monroe uses transformative-use verbiage,⁴⁴ however, its explanation of that reasoning categorizes the analysis under the transformative-work test—a critical distinction to understanding the tests’ differing application. The transformative-work approach has been reaffirmed by the California Supreme Court in its treatment of the *Comedy III* test as cutting in favor of First Amendment protection whenever speech “contain[s] significant expressive content other than plaintiffs’ mere likenesses.”⁴⁵ In *Winter v. DC Comics*, the California Supreme Court reasserted, “What matters is whether the work is transformative, not whether it is parody or satire or caricature or serious social commentary or any other specific form of expression.”⁴⁶

Therefore, under the transformative-work test, the First Amendment would not protect a t-shirt that displays a celebrity’s picture alone; no matter how stunningly realistic the portrayal of the individual, the artist who prints that drawing on a t-shirt infringes that individual’s right of publicity. The *Comedy III* court noted:

[The artist’s] undeniable skill is manifestly subordinated to the overall goal of creating literal, conventional depictions of The Three Stooges so as to exploit their fame. Indeed, were we to decide that [the artist’s] depictions were protected by the First Amendment, we cannot perceive how the right of publicity would remain a viable right other than in cases of falsified celebrity endorsements.⁴⁷

The court viewed the right as an economic right—a right that guards against misappropriation of the economic value of one’s likeness or image.⁴⁸

Under the transformative-work test, the First Amendment protects a work that adds something beyond the actual identity of the person. Applying this test, the court must ask “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.”⁴⁹ In other words, “whether a product containing a celebrity’s likeness is so transformed

44. Brief of 31 Constitutional Law and Intellectual Property Law Professors as Amici Curiae in Support of Petitioner at 8–9, *Elec. Arts, Inc., v. Michael E. Davis et al*, 136 S.Ct. 1448 (2016) (No. 15-424) (denying writ of certiorari).

45. *Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003).

46. *Id.*

47. *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001).

48. *Id.* at 807 (Through control of the merchandising of “name, voice, signature, photograph, or likeness,” a publicity-right holder controls the “economic value generated by the celebrity’s fame.”).

49. *Id.* at 809.

that it has become primarily the defendant's own expression [beyond just the likeness of the celebrity] rather than the celebrity's likeness."⁵⁰

This is the inquiry under the transformative-work test regardless of how the work is categorized; the analysis would not change if the work was predominantly a parody or some other creative use of a person's likeness. Concluding that "the transformative elements or creative contributions that require First Amendment protection are not confined to parody and can take many forms," including "factual reporting," "fictionalized portrayal," "heavy-handed lampooning," and "subtle social criticism," the transformative-work test has applied First Amendment protection in a wide breath of contexts.⁵¹

The Sixth Circuit has applied this transformative-work test as well. In *ETW Corp. v. Jireh Publishing, Inc.*, Jireh Publishing sold prints that depicted Tiger Woods's historic victory at the Masters Tournament.⁵² The prints showed Woods in the foreground, with famous past golfers in the background including Arnold Palmer, Sam Snead, Bobby Jones, and Jack Nicklaus, among others.⁵³ ETW Corporation, Woods's company, sued claiming that the prints infringed upon Woods's right of publicity. Applying the transformative-work language used by the Supreme Court of California in *Comedy III*, the Sixth Circuit concluded that, unlike the non-transformative depiction of The Three Stooges in *Comedy III*, the prints "did not capitalize solely on a literal depiction of Woods."⁵⁴ Instead, the Sixth Circuit emphasized that the prints "consist[ed] of a collage of images in addition to Woods's image which are combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods's achievement" through images suggesting that Woods would eventually join the ranks of the world's best golfers.⁵⁵ Therefore, the Sixth Circuit latched on to the collage element involved in the artistic comment on the historical significance of Woods's victory and concluded that the work had "substantial transformative elements," that demanded First Amendment protection.⁵⁶

50. *Id.*

51. *Id.*

52. *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 918 (6th Cir. 2003).

53. *Id.*

54. *Id.* at 938.

55. *Id.*

56. *Id.*

c. The Relatedness Test

The Second and Fifth Circuits have adopted a test that is even more protective of speech that uses another's image or likeness, known as the "relatedness test."⁵⁷ Under the relatedness test, the use of a person's name or likeness in an expressive work is protected by the First Amendment unless the underlying work is "wholly unrelated" to the individual" or a "disguised advertisement for the sale of goods or services or a collateral commercial product."⁵⁸ In other words, the use of another's identity in a novel, play, or motion picture is also not ordinarily an infringement. Thus, there is a rebuttable presumption in favor of protecting a work that uses another's image or likeness if the court deems the work expressive.

Rogers v. Grimaldi, a Second Circuit case outlining the relatedness test, involved Ginger Rogers' lawsuit over a Federico Fellini movie called *Ginger and Fred*.⁵⁹ Central to the film were "two fictional Italian cabaret performers, Pippo and Amelia, who in their heyday imitated Rogers and Astaire and became known in Italy as 'Ginger and Fred.'"⁶⁰ The setting of the film was a televised reunion of Pippo and Amelia years after retirement.⁶¹ Although the movie used Rogers' name without any distortion or parody, the Second Circuit held that neither the movie nor its title infringed upon the right of publicity, noting First Amendment accommodations.⁶² The court reasoned that the title of the movie only related to Rogers in a roundabout manner.⁶³ Notably, the *Rogers* court approached the analysis from a trademark or unfair competition framework; perhaps that explains why it was important to the Second Circuit that "Rogers [did not] endorse[] the film or ha[ve] a role in producing it."⁶⁴

Moreover, the *Rogers* decision found support in past cases where courts refused to extend the right of publicity to bar the use of a celebrity's name in the title and text of a fictional or semi-fictional book or film. Specifically, in *Guglielmi v. Spelling-Goldberg Productions*, the California Supreme Court stated, "[P]rominence invites creative comment. Surely, the range of free expression would be meaningfully reduced if prominent persons in the present and recent

57. *Rogers v. Grimaldi*, 875 F.2d 994, 1004–05 (2d Cir. 1989); *Matthews v. Wozencraft*, 15 F.3d 432, 440 (5th Cir. 1994).

58. *Rogers*, 875 F.2d at 1004–05.

59. *Id.* at 996–97.

60. *Id.*

61. *Id.* at 997.

62. *Id.* at 1004.

63. *Id.* at 997.

64. *Rogers*, 875 F.2d at 1001.

past were forbidden topics for the imaginations of authors of fiction.”⁶⁵ Therefore, the relatedness test allows for the use of another’s likeness as long as there is at least a tangential relationship to the work and the artist/speaker does not use that likeness in a commercially exploiting manner.

d. The Predominant-Purpose or Predominant-Use Test

When weighing the competing interests of a right of publicity and the First Amendment, the Supreme Court of Missouri has taken a distinct approach inquiring as to whether the use of another’s identity in a work is done predominantly as a commercial exploitation.⁶⁶ In *Doe v. McFarlane*, famous comic book author Todd McFarlane named a character Tony Twistelli after a professional hockey player, Anthony Twist, in a comic book titled *Spawn*.⁶⁷ The character did not resemble Twist.⁶⁸ Nor did the plot strike any similarity to Twist’s life.⁶⁹ Applying the predominant-purpose test, the Missouri Supreme Court found that McFarlane’s work could be found to infringe upon Twist’s right of publicity because it was “predominantly a ploy to sell comic books and related products rather than an artistic or literary expression.”⁷⁰

The predominant-purpose test inquires into the function of the use of the identity of the celebrity; that characterization is vital to court’s decisions applying this test. Framing McFarlane’s use as a “ploy to sell comic books” as opposed to “an artistic or literary expression” was the linchpin of the *TCI Cablevision* decision. Therefore, under the predominant-purpose test, a bumper sticker, poster, or bobblehead doll—all mediums that do not lack in expressive content—will be likely found to misappropriate one’s right of publicity as they are all predominantly intended to capitalize on the likeness of the individual.

e. The Balancing Approaches

Finally, when evaluating First Amendment challenges to right of publicity claims, several Circuits have employed balancing approaches specifically crafted to weigh inherent competing interests between the First Amendment and publicity rights.

65. *Guglielmi v. Spelling-Goldberg Productions*, 603 P.2d 454, 460 (Cal. 1979).

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

67. *Id.* at 365.

68. *Id.* at 370.

69. *Id.*

70. *Id.* at 374.

i. The Eighth Circuit

In *C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media*, the Eighth Circuit sought to balance these competing interests in the context of online fantasy baseball games, which employed players' names and statistics.⁷¹ The court found the use of the players' information to be constitutionally protected, as all the information used in the fantasy baseball game was readily available to the public domain.⁷² Moreover, the court found that such use would not disincentivize professional baseball players who "are rewarded, and handsomely, too, for their participation in [actual baseball] games and . . . endorsements and sponsorship arrangements."⁷³ Therefore, the court found the First Amendment protects such uses of players' identities.⁷⁴

ii. The Tenth Circuit

In *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, the Tenth Circuit was also faced with balancing an individual publicity rights and First Amendment free speech and expression principles.⁷⁵ At issue in *Cardtoons* was the right to produce parody baseball cards.⁷⁶ In upholding the defendant's First Amendment right to make the cards, the Tenth Circuit found that such parodies must be protected and elevated above another's publicity right because the cards "expose[d] the weakness of the idea or value that the celebrity symbolizes in society . . . by turning images of our sports heroes into modern-day personifications of avarice."⁷⁷ Similar to other courts balancing these competing rights, the Tenth Circuit recognized that the focus should be on what is expressed.⁷⁸ Moreover, similar to the court in *C.B.C. Distribution and Marketing, Inc.*, it was important to the court in *Cardtoons* that the cards did not economically disincentivize any of the baseball players, and the court therefore found that the activity was protected under the First Amendment.⁷⁹

71. *C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 821 (8th Cir. 2007).

72. *Id.* at 823.

73. *Id.* at 824.

74. *Id.*

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

76. *Id.* at 963.

77. *Id.* at 972.

78. *Id.* ("[P]arody, both as a social criticism and means of self-expression, is a vital commodity in the marketplace of ideas.")

79. *Id.* at 974. ("[I]t is unlikely that . . . major leaguers will start 'dogging it' to first base if the [Major League Baseball Players' Association] is denied the right to control the use of its members' identity in parody.")

iii. Eleventh Circuit

Similarly, the Eleventh Circuit opinion in *Toffoloni* also called for “fact-sensitive balancing” of free speech rights and the right of publicity.⁸⁰ However, unlike the balancing tests noted above, the *Toffoloni* court weighed the First Amendment interest in freedom of the press.⁸¹ The dispute in *Toffoloni* stems from the murder of professional wrestling personality Nancy Benoit by her husband and famed professional wrestler Christopher Benoit.⁸² The murder attracted global media attention.⁸³ Approximately twenty years before her murder, Benoit posed for nude photographs before photographer Mark Samansky and allegedly ordered the photos to be destroyed following the photo shoot.⁸⁴ Samansky, however, kept the photos and upon Benoit’s death, conveyed the photos to LFP Publishing Group, which then published the photos in a 2008 edition of *Hustler*.⁸⁵

Applying this balancing approach, the court concluded that LFP Publishing Group lacked the right to publish the twenty-year-old nude photographs of Nancy Benoit.⁸⁶ Georgia state law, which governed the case, recognizes a “newsworthiness” exception to the right of publicity allowing publication “where an incident is a matter of public interest, or the subject matter of a public investigation,” finding that “a publication in connection therewith can be a violation of no one’s legal right of privacy.”⁸⁷ However, the *Toffoloni* court focused on a few factors that it found especially compelling, including the late Benoit’s economic interests and the tenuous connection “in time [and] concept” between the photograph and any matter of public concern surrounding her death.⁸⁸ Ultimately, the court did not feel the public’s interest outweighed the late Benoit’s publicity right.⁸⁹

The Eleventh Circuit has recently applied a similar balancing approach in *Rosa & Raymond Parks Institute for Self Development v. Target Corp.*⁹⁰ In *Rosa & Raymond Parks Institute for Self*

80. *Toffoloni v. LFP Publishing Group, LLC*, 572 F.3d 1201, 1208 (11th Cir. 2009).

81. *Id.* (citing *Shulman v. Group W Prods., Inc.*, 955 P.2d 469, 479 (Cal. 1998)) (“It is in the determination of newsworthiness—in deciding whether published or broadcast material is of legitimate public concern—that courts must struggle most directly to accommodate the conflicting interests of individual privacy.”).

82. *Id.* at 1204.

83. *Id.*

84. *Id.*

85. *Id.*

86. *Toffoloni*, 572 F.3d at 1213.

87. *Id.* at 1208 (citing *Waters v. Fleetwood*, S.E.2d 344, 348 (Ga. 1956)).

88. *Id.* at 1213.

89. *Id.*

90. 812 F.3d 824 (11th Cir. 2016).

Development, the estate of Rosa Parks sued Target over its use of Parks' image in a number of books Target sold and most notably, a collage-styled plaque titled, "Civil Rights." that included an artist's depiction of Parks, alongside Dr. Martin Luther King, Jr.⁹¹ The plaque also included the word "CHANGE," a depiction of the bus from which Parks received her notoriety, and a picture of the Congressional Gold Medal that Parks was awarded.⁹² Applying Michigan law, the Eleventh Circuit ruled that Target's use and sale of the plaque, although commercial, was protected from a misappropriation claim under what the court termed a "public-interest" privilege.⁹³ Noting that the fight against racial inequality embodied by Civil Rights Movement was a matter of public concern, the court found the use of Rosa Parks' name and likeness in the books, movie, and plaque were all "necessary to chronicle" that Movement.⁹⁴

III. DISCUSSION

A. *Deficiencies Across the Various Tests*

The debate over the various analytical approaches to balancing the tension between rights of publicity and First Amendment principles is not a recent phenomenon. Yet, as a result of the multitude of tests across the nation, individuals, artists, and speakers alike are stuck in an often-unpredictable quagmire. As this section demonstrates, the application of various facts to the various tests often results in conflicting and illogical results. Where one may find protection of their publicity right in one test's analysis, the application of a different test can result in the exact opposite outcome in favor of the artist's free expression. In other words, the respective test that is applied is largely outcome determinative. Unlikely to know where a misappropriation suit will be filed, artists and speakers are left wondering what use is permissible. As this subsection will demonstrate, no one test currently applied across the state or federal circuits is universally applicable in the variety of contexts in which publicity disputes may arise. Moreover, the various tests are riddled with deficiencies that result in unanswered questions. The bottom-line: none of the tests currently applied can restore any meaningful predictability for publicity disputes.

Dissection of the predominant-purpose test exposes several

91. *Id.* at 827.

92. *Id.* at 828.

93. *Id.* at 830 (citing *Lawrence v. Fox*, 97 N.W.2d 719, 721 (Mich. 1959); *Dienes v. Assoc. Newspapers, Inc.*, 358 N.W.2d 562, 565 (Mich. Ct. App. 1984)).

94. *Id.* at 831-32.

significant weaknesses. Foremost, a number of cases in which the court accepted the First Amendment defense would have likely come out the other way under the microscope of a predominant-purpose analysis. The painting of Tiger Woods at issue in *ETW* was painted by professional artist, Rick Rush, who referred to himself as “America’s sports artist”; undoubtedly, Rush painted for commercial gain, yet his commemorative poster of Tiger Woods’s victory at Augusta National found favor under the transformative-work test.⁹⁵ Moreover, the film producers in *Rogers* certainly intended for their “Ginger and Fred” film to yield financial success.⁹⁶ Therefore, it is not surprising the predominant-purpose test is often a favorite analysis argued by plaintiffs claiming misappropriation of their right of publicity. The predominant-purpose test has been described by one court as “subjective at best, arbitrary at worst.”⁹⁷ And such a criticism carries significant merit. It is clear that one’s opinion of the test’s effectiveness hinges on one’s perspective and interest in the outcome of the lawsuit. Quite obviously, plaintiffs suing for damages from an artist or writer who used their identity in such a manner that produced a profit find favor in the test. Still, on the rare chance an artist who employs another’s identity in a manner that does not turn a profit, that artist may find favor in this test just the same.

Moreover, as applied by the Missouri Supreme Court in *TCI Cablevision*, the predominant-purpose test conflicts with the result of *Winter*—a case with strikingly similar facts—in which the California Supreme Court employed the transformative-work test to protect the use of the identities in a comic book.⁹⁸ In *Winter*, a comic book author named two characters (Johnny and Edgar Autumn) after two famous musician brothers (Johnny and Edgar Winter). The characters, like the real-life musicians, had long white hair and pale skin similar to the plaintiffs.⁹⁹ Nonetheless, the California Supreme Court held that the First Amendment could protect the comic book against the claim of misappropriation on the basis that the comic book satisfied the transformative-work test.¹⁰⁰ Under the predominant-purpose test, the comic book would not find protection given the use of the identity served a commercial purpose.

Additionally, the predominant-purpose test requires juries to solely

95. *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 918 (6th Cir. 2003).

96. *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1989).

97. *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 154 (3rd Cir. 2013).

98. Brief of 31 Constitutional Law and Intellectual Property Law Professors, *supra* note 44, at 4 (comparing *TCI Cablevision* and *Winter*).

99. *Winter v. DC Comics*, 69 P.3d 473, 476 (2003).

100. *Id.* at 480.

consider the defendant's purpose, only adding to the speculative work for a court. A "purpose determination" will likely be tough to specify and delineate, leaving plenty of room for ambiguity. Most successful creators intend *both* to obtain a commercial advantage *and* to express themselves.

Thus, the Missouri Supreme Court's unique analysis no better guides artists toward a legally sustainable and predictable expression. How can an artist ensure that a court would deem the use of another's image or likeness as "predominantly" expressive rather than commercial? Does an artist's relative success or notoriety play a role in that determination? What happens if the artist intended to profit, but did not? Or contrarily, if the artist did not intend to turn a profit, but nevertheless, a market emerges? All of these questions are left unanswered for artists under the predominant-purpose test. Notably, all of this is clearly in conflict with language out of *Winter*—"The question is whether the work is transformative, not how it is marketed."¹⁰¹

The relatedness test recommended by the *Third Restatement on Unfair Competition* has its own deficiencies as well. Foremost, the test has been applied in relatively narrow contexts, namely, disputes over the use of another's likeness in the title of a book or a song. Outside of this context, the test is not suitable to adequately address the various contexts in which publicity disputes may arise. For example, if a court tried to resolve the issue in *Comedy III* using the relatedness test, the inquiry would be thwarted as the direct depiction of The Three Stooges in a charcoal drawing stamped onto a t-shirt is obviously "related to" the dynamic trio. In effect, the relatedness test cannot be applied outside of select context like that of a textual reference to the celebrity.

Likewise, efforts by courts to bolster First Amendment protection through various balancing tests like the public-interest exception in *Rosa & Raymond Parks Institute for Self Development* and the newsworthiness exception applied in *Toffoloni* do little on their own to solve the greater tension between publicity rights and the First Amendment. One obvious weakness in a newsworthiness, public-interest, or historical-importance exception is the fear that topics that carry relatively little importance to the public might find protection under the First Amendment as the "interest" slides from essential to the public at large to important to a relative few individuals. Slipping from historically and socially vital topics to topics of relatively little social utility could result in little protection of individual rights of publicity. One would think that the Civil

101. *Id.* at 479.

Rights Movement is significantly more important to the public than the Masters Golf Tournament. The Civil Rights Movement remains a constant reminder of the fight for racial equality, while the Masters Golf Tournament, however notorious and cherished, remains a professional sporting event. The ambiguity does not end there. Who determines what the public finds notable or important? When is that threshold met?

One clear example of the application of such a flexible legal doctrine that resulted in a questionable legal precedent is *Bichler v. Union Bank & Trust Co. of Grand Rapids*.¹⁰² There, the court found a recognizable public interest in the broadcast concerning the closing of the only dinner theater in Western Michigan.¹⁰³ Clearly, establishing such a low threshold to meet a public-interest exception only opens up the doctrine to protect more than it was designed to safeguard.

To add another wrench in the publicity puzzle, while the *ETW* decision largely rested on the “transformative” nature of the work, i.e., portraying Woods with other successful Masters’ winners, the court noted the “historical” importance of the event justifying the First Amendment protection. It is clear that if the print was analyzed under the transformative-use test it would not have been given First Amendment protection as the print portrays Woods in his recognizable setting. However, such a result remains in tension with any conceived public interest in reporting or commemorating an important person or event. After all, the decisions in *ETW* and *Rosa & Raymond Parks Institute for Self Development* both favored artists who wish to commemorate certain events, the Masters Golf Tournament and the Civil Rights Movement, respectively. Certainly, analyzing the facts of *Rosa & Raymond Parks Institute for Self Development* under the transformative-use test and arriving at a decision that bars First Amendment protection because the artist depicted Rosa Parks in context of her recognizable setting, the Civil Rights Movement, would be illogical given the public’s interest in such an expressive commentary work.

B. Transforming Through Purpose

As noted above, the distinction between the setting and context in which an artist or speaker casts the individual proves quite telling. Both the Third and Ninth Circuits’ transformative-use test does not protect use that casts the person in his or her socially recognizable context or environment. Contrarily, the transformative-work test does

102. 745 F.2d 1006 (6th Cir. 1984).

103. *Id.* at 1011–12.

not focus on the setting or context.¹⁰⁴ This subsection will demonstrate why the transformative-work analysis serves as the most practical foundation for a new multipronged test for publicity-rights disputes as the test has been interpreted to inquire into an artist's purpose as well. It argues that allowing artists and speakers to cast an individual in his or her recognizable setting or context not only adds to the potential for expression, but does not patently trample on publicity rights. Rather, the addition of two threshold questions to the transformative-work test (which in effect narrow down the potential works to be analyzed under the "traditional transformative-work" analysis) can rectify the widespread deficiencies in the law surrounding publicity rights.

For some artists, having the ability to cast an individual in his or her recognizable setting or context is not required. For example, Andy Warhol's silkscreens of Marilyn Monroe depict the famed beauty in a stagnant yellow background that is not evocative of her in recognizable settings, such as on the set of *Some Like It Hot* or *How to Marry a Millionaire*. Notwithstanding lacking any explicit reference to the context or setting from which Monroe derived her fame, Warhol was nonetheless able to adequately express this artistic comment. But the reality remains that not all artistic endeavor is crafted with such an elegant underlying theme or message, as were Warhol's lithographs. In fact, some art requires the ability to employ the individual in his or her recognizable context, e.g., the commemorative Masters poster in *ETW*. Without the ability to cast Woods on the grounds of Augusta National Golf Club, the site of the major golf championship, artists could not explore the sort of expression like the commemorative poster of Woods's victory. Likewise, without showing Rosa Parks within the context of the Civil Rights Movement and the bus that made her famous, the meaning behind the plaque in *Rosa & Raymond Parks Institute for Self Development* would be particularly bare.

Moreover, defining that context in every circumstance and delineating if the artist actually used or hinted at the setting or context can prove difficult. Take for instance, Shepard Fairey's use of Barack Obama's likeness in his HOPE posters in months leading up to the 2008 presidential election. The posters showcased a stylized depiction of Obama's face accompanied only by the words HOPE positioned directly below Obama. Similar to Warhol's silkscreens of Monroe, Shepard Fairey did not depict Obama in the Illinois Congress, or out on the campaign trail. However, a contextual understanding of addition of the words HOPE implicates the context of the presidential

104. See generally *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 938 (6th Cir. 2003); see also *Winter*, 69 P.3d at 476.

election. Clearly, the context is easily debated and hard to pinpoint.

But the determination of context or setting is not always debated. For instance, in the *Madden NFL* video-game litigation,¹⁰⁵ it was quite clear that the video-game makers employed players' identities in the exact context from which they derived their fame—the NFL football arena. A recommendation of a multipronged test with the transformative-work test as its foundation does not automatically trample publicity-rights holder's interest in the context of modern interactive mediums, like video games. However, while it can certainly be argued—as it has previously been—that application of the transformative-work test in the video-game context should allow video-game makers to use the images and likenesses of others in the recognizable context or setting without seeking permission, the test does not demand that outcome.

One might suspect if applied in the video game context, the transformative-work test would protect video games that refer to real athletes. Some have intuitively argued that all of these works “ad[d] significant creative elements” and consist of “something more than a mere celebrity likeness or imitation”¹⁰⁶—like stadium graphics, in-depth play calling options, practice options—all designed to enhance user experience.¹⁰⁷ They contend that the athletic likenesses are “but one of the raw materials” from which the designer constructs the broader game, not the focal point of the expressive work. Moreover, it has been argued that the game derives its marketability and economic value from the creative elements aimed at increased user experience, not from the pure commercial exploitation of the former athletes' likenesses. They contend the game is not a conventional portrait of a celebrity, but rather consists of many creative and transformative elements. The likenesses are but one component of a larger and notably complex technical and artistic work.

That however, has not been the case. In *Davis v. Electronic Arts, Inc.*, the Ninth Circuit refused to apply the transformative-work test in the video game context for *NFL Madden Football* and instead applied a rationale more similar to the transformative-use test.¹⁰⁸ In doing so, the

105. See *Davis v. Elec. Arts, Inc.*, 775 F.3d 1172, 1176 (9th Cir. 2015). Former NFL players sued EA Sports for its unlicensed use of their likenesses in *Madden NFL* that allowed users to play with “historic teams” containing avatars of the retired players. EA Sports defended the unlicensed use on the basis that it was protected by the First Amendment. *Id.* at 1175. Applying the transformative-use test, the Ninth Circuit ruled, “Although the players on the historic teams are not identified by name or photograph, each is described by his position, years in the NFL, height, weight, skin tone and relative skill level in different aspects of the sport. *Id.* at 1175–76.

106. *Comedy III Productions, Inc. v. Saderup, Inc.*, 21 P.3d 797, 799 (Cal. 2001).

107. Brief of 31 Constitutional Law and Intellectual Property Law Professors, *supra* note 44, at 10; see also *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 175 (3rd Cir. 2013) (Ambro, J., dissenting).

108. *Davis*, 775 F.3d at 1172.

Ninth Circuit followed its reasoning in *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, in which the court concluded that the video game context requires an examination of “whether a likely purchaser’s primary motivation is to buy a reproduction of the celebrity or to buy the expressive work of that artist.”¹⁰⁹ According to the majority in *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, such an examination leaves room for distinguishing between cases where the primary objective is to “reproduce reality” (in the video game) and “cases involving other kinds of expressive works.”¹¹⁰ Important to the *Davis* court was the use of the athlete’s likeness in the same setting or context, i.e., the NFL football arena.¹¹¹ Thus, in the same vein as the majority in *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, the *Davis* court refused to recognize the notable differences in the transformative-use test and the transformative-work test in the video-game context.

One could push back on the Ninth Circuit’s characterization of *NFL Madden*’s sole objective to “reproduce reality.” Perhaps a more reasonable objective would be to simulate the atmosphere of a real football player or coach for enhanced user experience. Even more, the requirement of an examination of “a purchaser’s primary motivation” only adds to the ambiguity in the right-of-publicity context. Nevertheless, the approach taken by the Third and Ninth Circuit majorities—the transformative-use test—has not granted First Amendment protection to use of an athlete’s likeness and thus resulted in rulings in favor of the publicity-right holder.¹¹²

Application of the transformative-work test by the Third and Ninth Circuits, however, could have resulted in a similar ruling; those two courts did not need to abandon the transformative-work test in favor of the transformative-use test to reach the same decision—Electronic Arts, Inc. must compensate current and former NFL players it chooses to include in its interactive video game. Under the transformative-work test those courts could have ruled, that the uses of players’ likenesses do not meet the threshold “transformation” to qualify for First Amendment protection. While the game does add additional raw materials to the likenesses of the players, perhaps it is important that *NFL Madden Football* cannot support

109. *In Re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268, 1274 (9th Cir. 2013).

110. *In re NCAA*, 724 F.3d at 1279 n.10.

111. *Davis*, 775 F.3d at 1178 (“*Madden NFL* replicates players’ physical characteristics and allows users to manipulate them in the performance of the same activity for which they are known in real life—playing football for an NFL team.”)

112. *See, e.g., Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 169 (3rd Cir. 2013) (rejecting the view that the creative choices made by video-game designers of *NCCA Football* are so numerous that the video games should be considered transformative under the transformative-work test).

its expression with a recognizable “purpose” like commemorating or drawing attention to a historically significant event.

Having established the need to allow artists to implicate the setting or context in a transformative work, the question still remains: how to consistently distinguish whether or not the speaker or artist chooses to communicate an expressive comment or simply seek financial gain? Some courts have applied a media versus merchandise distinction,¹¹³ granting First Amendment protection to the former, while not protecting the latter given its commercially driven motive. This dichotomy, however, leaves no room for an appropriate categorization for artistic expression by a speaker or artist who has both motives in mind—the expression and the resulting commercial gain. The transformative-work test, however, subsumes the media versus merchandising consideration. By requiring even the slightest scintilla of transformation, the transformative-work test fills the artistic void inherent in the media–merchandising dichotomy.

Application of the transformative-work test would effectively render the same result in *Rosa & Raymond Parks Institute for Self Development*, despite the court’s emphasis of the public-interest exception. The artist who created the plaque at issue in the case, like the artist in *ETW* who created the commemorative Masters poster, used Parks’s image in a collage-like manner, and therefore added other raw materials in addition to simply the likeness of Parks to create a protectable transformative work. Moreover, like the Warhol silkscreens noted in *Comedy III*, the artist in *Rosa & Raymond Parks Institute for Self Development* could support its transformation through the explanation of her purpose—to draw attention to Parks’s contribution to the Civil Rights Movement. While the transformative-work test effectively subsumes both of those considerations, it nonetheless allows the work to enter the commercial market and reap profits—as Target sold the collage at its stores nationwide.

It has also been argued that in order to effectively answer the question of whether or not the speaker or artist chooses to communicate an expressive comment or simply seeks financial gain, a new test should be applied—one that remedies the seeming inconsistencies of the various tests across the nation. One such recommendation fashioned a test termed the “primary-motivation

113. 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, 488–89 (2003) (arguing that courts generally reject First Amendment defenses to claims of misappropriation of publicity rights that involve traditional “merchandise” and generally accept the First Amendment defenses when the likeness was used in traditional “media”).

test.”¹¹⁴ Such an analysis focuses on a whether a defendant’s primary influence or motive in using a celebrity identity is expressive or commercial.¹¹⁵ Moreover, the test proposes a framework to adequately balance the expressive and property interests at stake and the goals underlying each of the rights.¹¹⁶ A close relative of the predominant-use test, such a primary-motivation test requires the defendant to present evidence of the primary purpose behind the use of another’s image or likeness, rather than abstractly inquiring into the purpose of a work or product.¹¹⁷ It has already been demonstrated above how the predominant-use test leaves one to ponder exactly how a court will determine whether the predominant purpose of a work is expressive or commercial given that most authors and artists simultaneously aim to express themselves and garner financial profit.

What the author of the primary-motivation test misses is that the transformative-work test subsumes that very consideration of the defendant’s purpose or motivation. The court in *Comedy III* determined that the Warhol’s silkscreens had the purpose of exposing the dehumanization of the celebrity in twentieth century America. In effect the court applied Warhol’s detailed explanation of this use of popular cultural icons. Thus, in a scenario that involved little “transformation” or “distortion” of the individual’s image or likeness, the court nonetheless found sufficient transformative effects through the vital consideration of Warhol’s purpose in creating the silkscreens. Through the expression of his work itself, Warhol’s use of the images was granted First Amendment protection. What recognizable distinction can be found in the competing determinations of whether Warhol himself had the purpose of exposing this dehumanization or whether the silkscreens function to demonstrate the artist’s purpose? The answer is no distinction with significance. Any distinction on this front does nothing to further an analysis into the intended purpose behind an expressive work. Few artists would contend that their works, standing alone, demonstrate their intended purpose or purposes. The speaker or artist and the work, respectively, are not mutually exclusive. The work’s expressive purpose is given life and meaning only through the artist who labored to create such work.

The California Supreme Court in *Comedy III* noted that when determining whether a work is sufficiently transformative, particularly in close cases, courts may find useful a subsidiary inquiry: “[D]oes the

114. Gloria Franke, *The Right of Publicity vs. the First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CAL. L. REV. 945, 982 (2006).

115. *Id.*

116. *Id.*

117. *Id.* at 984–86.

marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted?”¹¹⁸ The court stated that if the answer is no, then generally there would not be actionable misappropriation as the value of the work comes principally from someone else other than the depicted individual, such as the creativity, skills, or reputation of the artist; in such a scenario, it may be presumed that sufficient transformative elements are present to warrant First Amendment protection.¹¹⁹ Importantly, the court also stated that if the answer is yes, “it does not necessarily follow that the work is without First Amendment protection—it may still be a transformative work.”¹²⁰

In effect, this subsidiary inquiry safeguards any worry that an artist’s expressive purpose in the use is at odds with the practical effect that the marketability and economic value derived primarily from the fame of the celebrity depicted by the artist. A defendant need only show that the work is so transformed that it goes beyond just the likeness of the celebrity and has become primarily the defendant’s own “transformative” expression.¹²¹ Undoubtedly, defendant, Gary Saderup in *Comedy III* was arguing that his depiction of The Three Stooges transformed their personae into his own original art. According to the court, however, Saderup’s artistic choices alone were not sufficient to result in a transformative use.¹²² Rather, the court reasoned that an artist who depicts a celebrity “must contribute something more than a ‘merely trivial’ variation, [and the artist must create] something recognizably ‘his own’ . . . in order to qualify for legal protection.”¹²³

Importantly, the court in *Comedy III* left open the scenario where a work meets a certain “transformative” threshold that overshadows the mere fact the work derives some value from the use of that individual’s likeness. Commenting on this permissible use of direct images, the majority noted:

The silkscreens of Andy Warhol, for example, have as their subjects the images of such celebrities as Marilyn Monroe, Elizabeth Taylor, and Elvis Presley. Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of

118. *Comedy III Productions, Inc. v. Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001).

119. *Id.*

120. *Id.*

121. *Id.*

122. *Id.*

123. *Id.* at 810–11 (quoting *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976)).

celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself.¹²⁴

One could push back on the threshold of distortion that the California Supreme Court found in the Warhol's work, but implicit in that characterization of Warhol's work is the laws recognition of the vital social commentary and free speech implications of expressive works.¹²⁵ Also implicit in the *Comedy III* ruling is that when determining the threshold of transformation, courts should consider and weigh the artistic fervor, novelty, and purpose of the expressive work that implicates another's likeness.¹²⁶ Thus by implication, the *Comedy III* court added a "predominant-purpose" prong to its transformative-work analysis. Without such addition, the court could not have justified works analogous to Warhol's use of Marilyn Monroe or Elvis Presley. In adding this consideration, the court took on the role of the art critic, indirectly awarding a certain "ideology" of artistic expression higher legal status than others.

To some in the artistic community, this may seem like the closest semblance to cultural or artistic totalitarianism in the United States. Justice Holmes himself contended in *Bleistein v. Donaldson Lithographing Co.*:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits . . . some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke.¹²⁷

But perhaps given the fact-specific inquiry in cases of publicity misappropriation, courts should function just as such. After all, such a framework allows an artist to use another's image or likeness without considerable transformation or distortion, so much as that artist can justify the use through his own legitimate explanation of the work's intended purpose, and more importantly, the value society places on artistic expression of that kind. The California Supreme Court went out of its way in *Comedy III* to note that Warhol's use of Marilyn Monroe's image in his prints met the protectable transformative

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

125. *Id.* at 811-12.

126. *Id.*

127. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

threshold given the works' expressive and novel comment on 20th century pop culture. In doing so, the court recognized the "work of genius" that Justice Holmes feared they could not and left open the possibility for future defendants to defend themselves just the same. From a practical standpoint, this may prove difficult for defendants to do, but requiring anything less would erode the long-recognized right of publicity in America. Though the time may come where the walls of the right of publicity yield to the pursuit of free uninterrupted expression, for now, the right of publicity remains vital in American jurisprudence.

Some critics of the transformative-work test contend that the test's lack of protection of "non-transformative works" is unsupported by First Amendment doctrine.¹²⁸ But this comes as no surprise, as the focus on the purpose and transformation in the context of rights of publicity was largely imported from the fair-use analysis as applied in copyright infringement.¹²⁹ Both copyright and the First Amendment are designed to safeguard and encourage creativity and free expression.¹³⁰ But despite these shared interests recognized by the *Comedy III* majority, the court found:

When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.¹³¹

Critics of the transformative-work test further contend that "[i]n deciding to protect only transformative uses, the court assumed that celebrities would create or license non-transformative uses themselves."¹³² While the California Supreme Court did not directly address its reasoning for not protecting non-transformative uses, the next section considers a viable solution.

128. Franke, *supra* note 114, at 973.

129. *Comedy III*, 21 P.3d at 807–09 (importing two of the four fair use factors applied in copyright infringements—the purpose and the transformation—to the transformative-work analysis when weighing the competing First Amendment and publicity interests).

130. *See* *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) (quoting *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 558 (1985)).

131. *Comedy III*, 21 P.3d at 808 (paraphrasing *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 575–76 (1977)).

132. Franke, *supra* note 114, at 973.

C. A Multipronged Proposal

Recognizing that Congress has not acted to remedy the apparent inconsistencies in the various approaches, this Comment recommends that states adopt and follow the transformative-work approach first applied by the California Supreme Court, with minor procedural caveats. As previously stated, this Comment does not recommend that the transformative-work test should function as the only guiding framework in rights of publicity cases. The reality that publicity disputes arise out of various dissimilar mediums cannot be ignored, and nor should the various tests that courts have crafted across the country. Rather, the various tests and dissimilar mediums the tests attempt to accommodate should inform any recommendation that attempts to create a universally applicable test in disputes between publicity rights and free expression.

This Comment recommends that courts must first ask (1) if the use is based solely in text or in some other medium. If the use of another's likeness is based in text, courts should protect the underlying work unless it is wholly unrelated to the individual or a disguised advertisement for the sale of goods, services, or commercial product (the relatedness test). However, if the use is not textually based, courts should then ask (2) whether the use of another's image or likeness is a literal depiction or imitation of that person, and therefore non-transformative. If a court answers in the affirmative, the work shall only be protected if it falls under a recognized state law exception, such as a newsworthiness, public-interest exception, or a noncommercial home use (subsuming the predominant-purpose test). And finally, (3) only after the court has determined that the speaker or artist has not used the image or likeness in a recognized excepted non-transformative manner shall a court apply the transformative-work test.

This three-step inquiry solves various issues common to balancing First Amendment rights and rights of publicity. Foremost, it serves as a universally applicable analytical framework across various mediums of expression. It is applicable in the visual arts, music, literature, and even modern interactive graphic software products. It also eliminates the chance that any protected expression including newsworthy information or information critical to the public interest, is not afforded protection given its lack of transformation. Additionally, the test affords legal protection to expressive works that do not directly depict or imitate another's likeness, but rather add a recognizable nontrivial transformative addition to the image or likeness even if those works lead to financial reward. Moreover, the multipronged test should ease critics of the "transformative-work test" who are fearful of leaving artistic value judgments to the judiciary as the test requires the court to both dissect the work in dispute to see if it is a direct depiction or imitation of the celebrity

and therefore non-transformative, before applying the transformative-work test. Finally, the framework also protects celebrities from blanket carbon-copy uses of their image or likeness without the artist showing that the work has some a transformative “purpose” like Warhol’s lithographs.

IV. CONCLUSION

It is almost axiomatic to say that America has a celebrity obsession. Sports, fashion, design, entertainment, politics, and even an overnight viral online video can catapult someone into the national spotlight. The right of publicity developed as a response to the invasive nature of one person using the image or likeness of another without consent or compensation. Since its emergence, the right of publicity has remained in tension with a fundamental constitutional guarantee in the First Amendment’s right to free expression. Over the years courts have grappled with an appropriate test to balance this tension of conflicting rights. Various tests have emerged across the nation to address publicity disputes, however, no one test is squarely applicable to disputes in all of the mediums in which they arise. A combination of various tests in the form of a three-pronged test that asks two important threshold questions before applying the transformative-work test can serve as a universally applicable test to balancing the right of publicity and the constitutional protections of the First Amendment.