Journal of Law and Policy

Volume 14
Issue 1
SCIENCE FOR JUDGES V:
Risk Assessment Data: Disclosure and Protection

Article 14

2005

Adjudicating the Right of Publicity in Three Easy Steps

David M. Schlachter

ADJUDICATING THE RIGHT OF PUBLICITY IN THREE EASY STEPS

David M. Schlachter[*]

INTRODUCTION

Celebrities' names, images, and identities are unique and valuable entities.[1] The right of publicity was created to protect these entities. While celebrities usually have wealth, fame, and prestige, they also have the right of publicity to protect their personas. This additional advantage is warranted because celebrities have a set of heightened property and privacy interests in their personas.[2] The right of publicity, therefore, makes it unlawful to misappropriate a valuable identity without permission.[3]

Courts have historically struggled to define the right of publicity. This difficulty is apparent in inconsistent approaches to defining the right.[4] Without a firm definition of the right of publicity, courts are left to question its necessity, how far the right should extend, and who may bring a cause of action under the right's authority. Furthermore, issues such as whether the right of publicity is derived from privacy or property jurisprudence, and

---

[*] B.A., Brooklyn College, CUNY; J.D. candidate, 2006, Brooklyn Law School. The author extends his sincere gratitude to Professor Aaron D. Twerski for his guidance, and to Brooke Crescenti, Michael Freedman, and Beth Lemanowicz for their stellar efforts in preparing this Note for publication.

[1] A celebrity is one that is widely known or celebrated, or is honored for some signal achievement. Parks v. LaFace Records, 329 F.3d 437, 447 n.3 (6th Cir. 2003). A celebrity does not have to be a member of the entertainment world. *Id*.

[2] *See* text *infra* § I.

[3] Bosley v. Wildwett.com, 310 F. Supp. 2d 914, 919 (N.D. Ohio 2004).

[4] *See* text *infra* §I.

whether the First Amendment right to freedom of expression serves to limit or expand the right of publicity, also contribute to the confusion surrounding this right. Such uncertainty has led courts to apply varying and divergent methods of adjudicating a right of publicity cause of action. Therefore, both plaintiffs and defendants are left with little guidance on how to litigate cases which deal with the right of publicity.

The purpose of this Note is to untangle the right of publicity and annunciate its defining issues. Part I explains the right's foundation and the various privacy and property interests that the right of publicity protects. Part II discusses the interaction of the right of publicity with the First Amendment, explaining how varying degrees of First Amendment protection act as a restraint on the right of publicity. Part III highlights the necessity of a new uniform test and examines flaws in current right of publicity jurisprudence, reflecting a lack of understanding of the right that leads to confusion and injustice. Finally, Part IV suggests a new three-prong test to consistently adjudicate right of publicity actions and applies the new test to several fact patterns for illustrative purposes.

I. GENERAL INTRODUCTION TO THE RIGHT OF PUBLICITY

In order to understand the right of publicity, one must first have an understanding of its roots in the law. The right of publicity has no direct ancestor in common law. Rather, it developed from two areas of law: privacy[5] and intellectual property.[6] The term "right of publicity" was first coined in the 1953 case of *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*[7] In *Haelan,* the court derived the right of publicity from the right to privacy,

---

[5] Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 967 (10th Cir. 1996) (the right of publicity "was originally intertwined with the right of privacy").

[6] *Parks*, 329 F.3d at 449. The court points out that right of publicity claims follow those of trademark claims—that the two causes of action are similar. *Id*. at 447. Thereby, the court asserts that the right of publicity falls under the general category of intellectual property. *Id*. at 449.

[7] 202 F.2d 866, 868 (2d Cir. 1953).

holding that individuals have a right to be protected from unwanted public exposure.[8] The court coined the term "right of publicity because it protected the publicity value of one's photograph."[9] The right also drew from property law, as the Supreme Court acknowledged in *Zacchini v. Scripps-Howard Broadcasting Co.*[10] In *Zacchini*, the Court held that if there is market value in any part of a person, such as the person's image, that person should be able to protect that value through equitable and monetary remedies.[11] Thus, the holdings in *Haelan Laboratories* and *Zacchini* demonstrate that the right of publicity was earliest identified as a unique derivative of both privacy and property jurisprudence.

A. The Privacy Aspect of the Right of Publicity

The right of publicity is partly derived from the right to privacy.[12] At common law, an individual's right to privacy can be invaded in a variety of ways.[13] One type of invasion of the right to

---

[8] *Id. See also* Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 799 (Cal. 2001).

[9] *Haelan Laboratories*, 202 F.2d at 868.

[10] 433 U.S. 562, 576 (1977).

[11] *Id.* In other words, if a celebrity has market value in his or her likeness, i.e., his or her photograph can be sold in the free market, then that celebrity should be granted some sort of protection for that likeness. This protection will bar the use of the likeness by others without permission. *See id*. Since this ruling, many other courts have followed this line of reasoning and have ruled that the right of publicity is a right derived from intellectual property law. *See, e.g.*, Parks v. LaFace Records, 329 F.3d 437, 459 (6th Cir. 2003).

[12] ETW Corp. v. Jireh Publ'g Inc., 332 F.3d 915, 928 (6th Cir. 2003). *See also Parks*, 329 F.3d at 445 (stating that the Lanham Act, to which right of publicity is similar, is rooted in the right to privacy); Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619, 622 (6th Cir. 2000); Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 967 (10th Cir. 1996); *Haelan Labratories*, 202 F.2d at 868; Bosley v. Wildwett.com, 310 F. Supp. 2d 914, 920 (N.D. Ohio 2004) (stating that the right of publicity is derived from the common law right to privacy); Zoll v. Ruder Finn, Inc., 2004 U.S. Dist. LEXIS 4129 at *7 (S.D.N.Y. 2004); *Comedy III*, 21 P.3d at 799.

[13] *Bosley*, 310 F. Supp. 2d at 919. The four categories are: (1) "Intrusion upon the plaintiff's seclusion or solitude," or into private affairs; (2) Public exposure of private facts about the plaintiff; (3) "Publicity which places the

privacy akin to the right of publicity is the appropriation of an individual's name or image for another's advantage.[14] This type of misappropriation served as the basis for the right of publicity's roots in privacy law.[15] "Name or image" is the persona or publicity value that a celebrity is trying to protect.[16] The appropriation of the name or image of another, for one's own benefit, has been extended from a cause of action of the right to privacy to a cause of action under the right of publicity.[17] In fact, when both causes of action are applicable, many courts limit the pleadings to only the claims under the right of publicity.[18]

Deriving the right of publicity from the common law of privacy has various implications.[19] For example, while New York recognizes the right of publicity, the state imposes limitations owing to its privacy law jurisprudence.[20] The New York courts have ruled that because the right of publicity is grounded in theories of privacy, it only protects identity so long as the injured party is alive,[21] holding that there is no privacy issue after a person dies.[22] New York has also limited the right of publicity's remedies

---

plaintiff in a false light in the public eye" and (4) Appropriation of the plaintiff's identity for the defendant's benefit. *Id.*

[14] Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 799 n.2 (Cal. 2001). *See also Bosley*, 310 F. Supp. 2d at 919.

[15] *Comedy III*, 21 P.3d at 799; *Bosley*, 310 F. Supp. 2d at 919.

[16] *Bosley*, 310 F. Supp. 2d at 919. "In asserting that Defendants breached her 'common law right to persona and image,' Plaintiff Bosley alleges the fourth cause of action—appropriation of her name or likeness for the defendant's advantage." *Id*.

[17] *Landham*, 227 F.3d at 622.

[18] The right of publicity extends beyond the general right to privacy. Parks v. LaFace Records, 329 F.3d 437, 460 (6th Cir. 2003). Therefore, the right of publicity incorporates the right to privacy claim. *See id*.

[19] As a consequence of deriving the right of publicity from the common law right of privacy, the right of publicity has non-economic attributes. Since many courts find the right of publicity to have been created through the right to privacy, those courts attribute several non-economic values to the right. *See* text *infra* this section.

[20] Zoll v. Ruder Finn Inc., U.S. Dist. LEXIS 4129 at *7 (S.D.N.Y. 2004).

[21] Lombardo v. Doyle, Dane & Bernbach, Inc., 58 A.D.2d. 620, 621 (N.Y. App. Div. 1977); *Zoll*, U.S. Dist. LEXIS 4129 at *7.

[22] *Lombardo*, 58 A.D.2d at 621.

to injunctive relief and nominal damages,[23] because the theoretical basis of privacy law is to prevent injury to feelings. [24] Thus, most awards in actions for the wrongful invasion of an individual's right of publicity in New York, and other states which view the right of publicity wholly as a derivative of the right to privacy, are limited to nominal damages. [25]

Holding that the right of publicity is derived from privacy also implicates the remedy of unjust enrichment.[26] "Unjust enrichment is a judicially created remedy for avoiding benefit to one to the unfair detriment of another."[27] Indeed, the remedy of unjust enrichment rests on the basis that allowing the free appropriation of a celebrity's identity serves no social purpose.[28] In order to establish a claim for unjust enrichment, a plaintiff must demonstrate that (1) the defendant received a benefit, (2) at plaintiff's expense, (3) under circumstances that would make it unjust for the defendant to retain benefit without paying for it.[29] Thus, appropriating the likeness of another for capital gain, without permission, will serve as the basis for an unjust enrichment claim, because the celebrity loses marketability of the likeness

---

[23] *Zoll*, U.S. Dist. LEXIS 4129 at *7.

[24] *Lombardo*, 58 A.D.2d at 621.

> In New York there is a distinction between the statutory right which protects the living persons from commercial exploitation of their names and pictures without their written consents, as embodied in *sections 50* and *51 of the New York Civil Rights Law*, and the common-law property right in one's public personality. The statutory right is deemed a 'right of privacy' and is based upon the classic right of privacy's theoretical base, which is to prevent injury to feelings. Accordingly, in most cases where damages have been awarded under the Civil Rights law, they have been nominal.

Id. (emphasis in original) (citation omitted).

[25] *Id*.

[26] Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 976 (10th Cir. 1996) (citing Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 576 (1977)).

[27] Martinez v. Colo. Dep't. of Human Servs., 97 P.3d 152, 159 (Colo. Ct. App. 2003).

[28] *Cardtoons*, 95 F.3d at 976.

[29] Donchez v. Coors Brewing Co., 392 F.3d 1211, 1221 (10th Cir. 2004).

while the appropriator receives economic benefit.[30]

B. The Property Aspect of the Right of Publicity

In addition to privacy characteristics, many courts attribute property interests to the right of publicity.[31] Even *Haelan Laboratories v. Topps Chewing Gum, Inc.,*[32] which considered the right as mainly a protection of the privacy interest of ballplayers, stated that there is some economic, or property, aspect to the right of publicity.[33] Furthermore, in *Zacchini v. Scripps-Howard Broadcasting Co.*, the United States Supreme Court noted that the right of publicity exists more to protect an individual's right to reap the rewards of his endeavors than to protect an individual's feelings or reputation.[34] Trademark law plays a key role in this respect.[35] Thus, the concept of the economic property value of the Fifth Amendment has developed as an equal or competing issue alongside the personal privacy interests in the right of publicity.

In order to prevail on a right of publicity claim, one need not be a celebrity.[36] As far as the economic property value is concerned, courts have long recognized the property interests in identities as

---

[30] *Id.* For further explanation of how the celebrity loses likeness marketability, *see* text *infra* Part III(A).

[31] *Cardtoons*, 95 F.3d at 967. Although many courts consider the right as a legislative offspring of the right to privacy, most find several additional property interests in the right of publicity. *See Zacchini*, 433 U.S. at 575-76; *Donchez*, 392 F.3d at 1220; ETW Corp. v. Jireh Publ'g Inc., 332 F.3d 915, 928 (6th Cir. 2003); Parks v. LaFace Records, 329 F.3d 437, 447 (6th Cir. 2003); Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1183 (9th Cir. 2001); Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619, 622-23 (6th Cir. 2000); *Cardtoons*, 95 F.3d at 973; Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953); Bosley v. Wildwett.com, 310 F. Supp. 2d 914, 920 (N.D. Ohio 2004); Zoll v. Ruder Finn, Inc., 2004 U.S. Dist. LEXIS 4129 at *7 (S.D.N.Y. 2004); Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 808 (Cal. 2001) (all attributing property characteristics to the right of publicity).

[32] 202 F.2d at 868. This court first coined the term "right of publicity."

[33] *Id*.

[34] 433 U.S. 562, 575-76 (1977).

[35] *Parks,* 329 F.3d at 460; *Bosley*, 310 F. Supp. 2d at 920.

[36] Landham v. Galoob Toys, Inc., 227 F.3d 619, 624 (6th Cir. 2000).

the inherent right of every person to control the commercial value of his or her identity.[37] However, this right extends only to individuals that have an identity with *commercial* value.[38] It is this value that the right of publicity is protecting.[39] The identity of an individual, thus, has pecuniary value with accompanying rights which may be asserted if that value is diminished by the wrongful actions of someone else.[40]

A valuable identity is created by a mixture of hard work and talent.[41] A highly valuable identity is attained when the name, image, or likeness of an individual is readily identifiable to the public.[42] Celebrities, or those individuals who have achieved a highly valuable identity, should have the right to enjoy the fruits of their labor.[43] It follows that endorsement value—the ability of celebrities to license to advertisers the use of their image or likeness—is a protectable property interest.[44] The right of publicity, then, clearly has economic components.[45] In simplest form, it protects an individual's hard work behind obtaining celebrity status.[46] Likewise, the right prevents others from

---

[37] ETW Corp. v. Jireh Publ'g Inc., 332 F.3d 915, 928-29 (6th Cir. 2003); Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1184 (9th Cir. 2001).

[38] Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1098 (9th Cir. 1992). *See also Hoffman*, 255 F.3d at 1183-84.

[39] Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 967 (10th Cir. 1996).

[40] Haelan Laboratories, Inc., v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953).

[41] Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 805 (Cal. 2001).

[42] *Id*.

[43] *Cardtoons*, 95 F.3d at 975. The court considers this a "noneconomic" justification. *Id*. Yet, the court also explains this right by stating that the celebrity must practice for years in order to gain marketable status. *Id*. If it is marketable status that the celebrity attains, it is hard to see how this is a noneconomic justification for the right of publicity.

[44] *Id.* at 974; ETW Corp. v. Jireh Publ'g Inc., 332 F.3d 915, 952 (6th Cir. 2003) (Clay J., dissenting).

[45] *Comedy III*, 21 P.3d at 807. "[T]he right of publicity is essentially an economic right." *Id*.

[46] *ETW,* 332 F.3d at 957-58 (Clay, J., dissenting) (citing *Comedy III*, 21 P.3d at 802-05).

exploiting the good name and will that the celebrity has attained for him or herself.[47] The right of publicity, therefore, makes it unlawful to misappropriate a valuable identity.[48] As this aspect of the right is economic, the right extends to the celebrity's heirs.[49]

Another economic characteristic of the right of publicity is its similarity to intellectual property law.[50] Intellectual property law generally, and trademark law specifically, grants an individual a civil cause of action against one who wrongfully uses a trademark without the owner's permission.[51] A trademark is a symbol or device that is adopted by the mark owner, to the exclusion of use by all other persons, in order to distinguish the goods or property made or sold by the owner.[52] Just as trademark law protects the trademark owner's exclusive use of the commercial identification

---

[47] Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 805 (Cal. 2001).

[48] Bosley v. Wildwett.com, 310 F. Supp. 2d 914, 919 (N.D. Ohio 2004). It would be futile for an advertiser or anyone else to appropriate an identity that had no value. Such appropriation would not provide the advertiser with any benefit. Advertisers after all, seek to gain marketability from the appropriation. White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1399 (9th Cir. 1992).

> Advertisers use celebrities to promote their products. The more popular the celebrity, the greater the number of people who recognize her, and the greater the visibility for the product. The identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice.

Id. Therefore, the assumption here is that the identities dealt with have some commercial value.

[49] *Comedy III*, 21 P.3d at 805.

[50] Trade-Mark Cases, 100 U.S. 82, 92 (1879); ETW Corp. v. Jireh Publ'g Inc., 332 F.3d 915, 928 (6th Cir. 2003); Parks v. LaFace Records, 329 F.3d 437, 447 (6th Cir. 2003); *Bosley*, 310 F. Supp. 2d at 920 (stating that trademark protection is a property right protection).

[51] *Trade-Mark*, 100 U.S. at 92.

[52] *Id*. The Court gives a brief summary of trademark rights:

> The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has been long recognized by the common law and the chancery courts of England and of this country, and by the statutes of some States.

Id.

of a product, the right of publicity protects the individual celebrity's exclusive use of the commercial identifications of him or herself.[53] Additionally, in the same way that misuse of a trademark may lead to consumer confusion about a product not associated with the trademark owner, the misuse of a celebrity's name or image in association with a product might lead to consumer confusion about whether the celebrity endorsed the product.[54] Avoiding such consumer confusion is a goal shared by trademark law and the right of publicity.[55]

Finally, in addition to preventing mark confusion, another protection afforded by trademark law is the prevention of mark dilution.[56] Dilution occurs in two situations: (1) when the value of the mark is degraded, which occurs when an identity is used freely, lessening any endorsement value it may have, or (2) when the value of the mark is tarnished, which occurs when an exploiter attaches obscene, pornographic, or base material to the image.[57] In this way, the right of publicity is again similar to trademark law because it protects the endorsement value of the celebrity's name or image and also protects against the tarnishing of the celebrity's name or image, albeit to a lesser degree.[58]

It is clear from courts' use of the right of publicity in protecting privacy and property interests, as well as its similarity to trademark law, that the right is well-grounded in property jurisprudence and privacy jurisprudence. The rights associated with property and privacy have long been acknowledged as basic and fundamental rights.[59] As with all rights, however, the right of publicity is not

---

[53] *Id*.

[54] *Id*. at 446.

[55] *Id*. at 445. The goal of the Lanham Act was to avoid "confusion among consumers or to cause consumers to make a mistake or to deceive consumers." *Id.* For further discussion, see text *infra* § I(B).

[56] Coca-Cola Co. v. Purdy, 382 F.3d 774, 777 (8th Cir. 2004).

[57] *Id*.

[58] *Id.* at 777-78. The right of publicity concerns itself more with endorsement value and preventing exploitation of the fame of the celebrity, than with name tarnishing. *See* text *infra* IV(B)(b).

[59] U.S. CONST. amends. V and IV, respectively.

absolute.[60] The First Amendment is an important competing and limiting factor on the use of the right of publicity.[61]

II. THE FIRST AMENDMENT'S INTERACTION WITH THE RIGHT OF PUBLICITY

Defendants in right of publicity actions often assert the First Amendment as an affirmative defense.[62] The First Amendment protects certain speech from governmental regulation.[63] There are various levels of First Amendment protection and courts have taken degree-oriented approaches. For instance, newscasts on matters of public interest enjoy a very high degree of protection.[64] Expressive materials sold for profit also retain some First Amendment protection,[65] but enjoy a lower level of protection because the danger of consumer deception warrants some governmental regulation.[66] Books and movies have a high level of protection because they are vehicles through which ideas and opinions are disseminated;[67] less so for posters and other forms of merchandise having a commercial interest.[68]

A. Free Speech Protection & its Limitations

First Amendment protection is far reaching but is limited by certain public interests.[69] The Supreme Court found the

---

[60] *See* text *infra* § II.

[61] *Id*.

[62] Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 810 (Cal. 2001). *See* Winter v. DC Comics, 69 P.3d 473, 477-78 (Cal. 2003).

[63] Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 968 (10th Cir. 1996). Application of statute or common law by a court satisfies this state action requirement. *Id*.

[64] Zacchini v. Scripps-Howard Broad., 433 U.S. 562, 567 (1977).

[65] City of Lakewood v. Plain Dealer Publ'g Co., 486 U.S. 750, 755-56 n.5 (1988).

[66] Rogers v. Grimaldi, 875 F.2d 994, 997 (2d Cir. 1989).

[67] Parks v. LaFace Records, 329 F.3d 437, 449 (6th Cir. 2003); Hicks v. Casablanca Records, 464 F. Supp. 426, 430 (S.D.N.Y. 1978).

[68] *Parks*, 329 F.3d at 449; *Hicks*, 464 F. Supp. at 430.

[69] Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959,

distribution of pamphlets,[70] circulation of handbills,[71] display of yard signs,[72] flag burning,[73] nude dancing,[74] and jackets bearing profanity[75] all to be protected by the First Amendment. Entertaining speech, like informative speech, is protected.[76] Art does not even need a message in order to be protected.[77] Nevertheless, there are limitations to the right. Legitimate and actual expression receives the highest degree of First Amendment protection.[78] However, the degree of protection decreases when the primary goal of the work is to market or sell the work or another item.[79] Works with minimal expression which primarily try to sell another product, such as advertisements, have the least First

969 (10th Cir. 1996). "This case instead requires us to directly balance the magnitude of the speech restriction against the asserted governmental interest in protecting the intellectual property right. We thus begin our analysis by examining the importance of Cardtoons' right to free expression and the consequences of limiting that right." *Id*. at 972. *See also* Smith v. Daily Mail Pub. Co., 443 U.S. 97, 106 (1979) (Rehnquist, J., concurring) ("Historically, we have viewed freedom of speech and of the press as indispensable to a free society and its government. But recognition of this proposition has not meant that the public interest in free speech and press always has prevailed over competing interests of the public.").

[70] Lovell v. Griffin, 303 U.S. 444, 451-52 (1938).

[71] Jamison v. Texas, 318 U.S. 413, 416 (1943).

[72] City of Ladue v. Gilleo, 512 U.S. 43 (1994).

[73] Texas v. Johnson, 491 U.S. 397 (1989).

[74] Schad v. Borough of Mount Ephraim, 452 U.S. 61, 68 (1981).

[75] Cohen v. Cal., 403 U.S. 15, 29 (1971).

[76] Cardtoons, L.C., v. Major League Baseball Players Ass'n, 95 F.3d 959, 969 (10th Cir. 1996).

[77] Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 804 (Cal. 2001).

[78] *See* Parks v. LaFace Records, 329 F.3d 437, 452 (6th Cir. 2003).

[79] *See id.* at 454. In *ETW Corp. v. Jireh Publishing Inc.*, the court states that when there is First Amendment protection, there is no need to even check for consumer confusion or deception. 332 F.3d 915, 926 (6th Cir. 2003). "[W]e conclude that where the defendant has articulated a colorable claim that the use of celebrity's identity is protected by the First Amendment, the likelihood of confusion test is *not appropriate* because it fails to adequately consider the interests protected by the First Amendment." *Id*. (emphasis added). This is bad law. Even if there is a valid and 'colorable' First Amendment claim, the court still needs to see if there is consumer confusion. If there is confusion, then the First Amendment protection will be diminished. *See* text *infra* § II(B).

Amendment protection.[80] For commercial messages and advertisements, the First Amendment yields to the greater public interest in truthful and accurate commercial speech.[81] Thus, the fact that there is a message conveyed by a work does not mean that the message will be protected by the First Amendment.[82]

The First Amendment also yields to copyright and trademark law.[83] Copyright and trademark law protects authors and creators of works from infringement by others.[84] These laws prevent people from creating works which are confusingly similar to those of another.[85] In preventing people from making infringing works, the infringer's First Amendment right to free speech must again yield to the greater public interest in allowing creators to retain ownership of their innovations.[86]

B. Commercial Speech Is More Vulnerable to Regulation

As mentioned above, commercial speech is afforded less First Amendment protection than artistic or informational speech.[87] Although the boundary between commercial and noncommercial speech has yet to be clearly defined, at its core, commercial speech

---

[80] *Parks*, 329 F.3d at 447. The First Amendment only protects the expressive elements in a work. It does not protect any part of a work that is not expressive. Incidentally, if there are enough expressive elements in a work, the whole work will be under First Amendment protection. *Comedy III*, 21 P.3d at 810.

[81] Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of N.Y., 447 U.S. 557, 566 (1980).

[82] Coca-Cola Co. v. Purdy, 382 F.3d 774, 787 (8th Cir. 2004).

[83] Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 467 F. Supp. 366, 375 (D.C.N.Y. 1979). "It has long been settled in our jurisprudence that rights of free expression, embodied in the First Amendment and other legal doctrines, are subject to rights under the copyright and trademark laws." *Id*.

[84] Rogers v. Grimaldi, 875 F.2d 994, 998 (2d Cir. 1989). A trademark is infringed upon when an exploiter uses the trademark without permission. *Id*.

[85] *Id*.

[86] *Id*. It would be inimical to the protections of the First Amendment if the law did not recognize the right of creators to protect their creative work against infringement by other creators. *Id*.

[87] 44 Liquormart, Inc. v. Rhode Island, 517 U.S. 484, 498 (1996).

aims to facilitate commercial transactions by attracting consumers to a product or service.[88] The Supreme Court has determined, therefore, that commercial speech will not be as highly protected as other types of expression, such as newscasts, political commentary, or art.[89]

Many right of publicity cases revolve around commercial speech which uses the identity of a celebrity without permission.[90] Examples include the use of a baseball player's image in a printed beer advertisement,[91] the use of a basketball star's former name in a television car commercial,[92] the imitation of a singer's voice in a

---

[88] Bolger v. Youngs Drug Prod. Corp., 463 U.S. 60, 66 (1983).

[89] *Id.*; Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1184 (9th Cir. 2001). In *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of N.Y.*, 447 U.S. 557, 566 (1980), the United States Supreme Court established a four-part test to determine if commercial speech can be governmentally regulated:

> At the outset, we must determine whether the expression is protected by the First Amendment. For commercial speech to come within the provision, it at least must concern lawful activity and not be misleading. Next, we ask whether the asserted governmental interest is substantial. If both inquiries yield positive answers, we must determine whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest.

Id.

[90] *Hoffman*, 225 F.3d at 1185.

[91] Newcombe v. Adolph Coors Co., 157 F.3d 686, 691 (9th Cir. 1998). Plaintiff Newcombe was an all-star Major League Baseball player. *Id*. at 689. He was one of the first African-American ballplayers in Major League Baseball. *Id*. Coors Brewing Co. published an advertisement which featured a drawing of an old-time baseball game. *Id*. The drawing featured a pitcher in the windup position which was immediately recognizable as Newcombe. *Id*.

[92] Abdul-Jabbar v. Gen. Motors Corp., 85 F.3d 407, 409 (9th Cir. 1996). Famed basketball player Kareem Abdul-Jabbar's birth name was Ferdinand Lewis ("Lew") Alcindor. *Id*. While he used the name Abdul-Jabbar for endorsement purposes, he never used his former name Alcindor. *Id*. A car commercial, by defendant, featured the quote "Who holds the record for being voted the most outstanding player of this tournament?" *Id*. Then the printed words, "Lew Alcindor, UCLA, '67, '68, '69" appeared on the screen. *Id*. Afterwards, the voiceover talks about the attributes of the Oldsmobile Eighty-Eight. *Id*.

radio snack-food advertisement,[93] the use of a game-show hostess' identity in a printed advertisement selling VCRs,[94] and the sound-alike rendition of a song that a popular singer recorded.[95] In cases such as these, the celebrity's identity is used entirely for the purposes of selling a product.[96] The commercial aspects are "inextricably entwined" with the expressive elements, which the Court has found to be minimal.[97] Our society has a market for the exploitation of celebrities in order to sell products.[98] Such exploitation is "an attempt to take a free ride on a celebrity's celebrity value."[99] In order for the marketing message to be effective, the advertisement must clearly evoke the celebrity's identity.[100] After all, if consumers do not realize that the celebrity is associated with the product, the advertiser does not benefit from

---

[93] Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1097-98 (9th Cir. 1992). Waits was a renowned singer, songwriter, and actor with a distinctive voice. *Id*. at 1097. He achieved both critical and commercial success in his career. *Id*. Frito-Lay, Inc. produced packaged chips. *Id*. In introducing a new product, the chip company used one of Waits' songs in a commercial. *Id*. The company also used an imitator that sounded like Waits and "captured" his style. *Id*.

[94] White v. Samsung Elec. Am., Inc., 971 F.2d 1395, 1396 (9th Cir. 1992). Plaintiff White was the hostess of a popular game show with over forty-million viewers daily. *Id*. In an advertising campaign, defendant used a robot which was dressed and formed to resemble the famous hostess. *Id*. The robot had on a wig, gown, and jewelry all modeled after the hostess. *Id*. The caption of the advertisement read: Longest-running game show. 2012 A.D. *Id*.

[95] Midler v. Ford Motor Co., 849 F.2d 460, 461 (9th Cir. 1988). Midler was a very popular and acclaimed actress and singer. *Id*. Defendant produced a commercial that featured one of Midler's songs. *Id*. After Midler turned down the advertising company's request to perform on the commercial, the advertising company found another singer that "sounded exactly" like Midler. *Id*. While neither a picture nor image of Midler was used in the commercial, the commercial did feature the sound-alike singer singing one of Midler's songs. *Id*.

[96] Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1185 (9th Cir. 2001).

[97] *Id*. The *Hoffman* court found this to be true in all of the previous examples. *Id*.

[98] *White*, 971 F.2d at 1401 n.3.

[99] *Id*. This is, if there is misappropriation. *Id.*

[100] *Id*. At least clear enough to the point of recognition. *Id*.

exploiting the identity.[101] Such an attempt to take a free ride at the celebrity's expense is impermissible under intellectual property law.[102]

In general, courts have held that when an identity is exploited in order to sell products which consist of the identity itself, such as baseball cards, it is not considered commercial speech.[103] Parodies are a prime example, which are considered creative expression and not commercial speech.[104] They necessarily rely on evoking the image of the target celebrity.[105] Additionally, putting a literal

---

[101] *Id*. "The more effective the evocation [of the identity], the better the advertisement." *Id*. If the ad is generic, then the ad would not violate the right of publicity, but it would also not be all that effective. *Id*.

[102] *Id*.

[103] Cardtoons, L.C., v. Major League Baseball Players Ass'n, 95 F.3d 959, 976 (10th Cir. 1996).

[104] *Id*.

[105] *Id.* at 972. Parodies have an important place in our society. *Id*. "A parodist, with deft and wit, can readily expose the foolish and absurd in society." *Id*. A parody is also a valuable form of self-expression. *Id*. It allows an artist to shed light on earlier works and, at the same time, create new ones. *Id*. As a means of social criticism and a means of self-expression, parodies are a vital commodity in the marketplace of ideas. *Id.*

"Parodies of celebrities are an especially valuable means of expression because of the role celebrities play in modern society." *Id*. A celebrity is a common point of reference for millions of individuals that share nothing else. *Id*. They may never have interacted with each other, but they share the knowledge of this celebrity. *Id*. Celebrities have come to symbolize many ideas through their pervasive presence in the media. *Id*. "Celebrities then, are an important element of the shared communicative resources of our cultural domain." *Id*. A parody of a celebrity does more than just lampoon that celebrity. It exposes the weakness of the idea or value that that particular celebrity symbolizes in society. *Id*. Thus, restricting the use of the celebrity in a parody restricts the communication of ideas. *Id*.

Additionally, no endorsement value is diminished by the use of a celebrity identity in a parody. *Id*. at 975. Celebrities do not want to endorse their own criticism. If given the power to restrict the use of their identities for parodies, they would censor, not endorse. That is, they would not sell their rights to parodists. *Id*. They would, instead, bar the allowance of artists to parody them. *Id*. Therefore, this power will turn into one of censorship, not protection. *Id*. For the foregoing reasons, parodies receive extra protection. *Id*. at 976.

Additional insight into parody can be gained from *Cliffs Notes, Inc. v.*

depiction of a likeness on T-shirts may not constitute commercial speech and would be afforded First Amendment protection if the image were used expressively.[106] Yet, if that likeness on the T-shirt were used to market another product, such as a soft-drink, it would likely be considered commercial speech and would not be afforded First Amendment protection. The right of publicity prevents the image from exploitation in such circumstances by making the

---

Bantam Doubleday Dell Publ'g Groups, Inc., 886 F.2d 490 (2d Cir. 1989). The plaintiff in that case was the producer of summaries on literary classics. *Id*. at 491. These summaries are widely used amongst students of all levels. *Id*. The defendant created a three book series called Spy Notes. *Id*. at 492. It was a one-time parody of the famous Cliffs Notes. *Id*. Inside the books were humorous content instead of serious comment. *Id*. However, the main issue was the cover of the books. *Id*. Spy Notes copied every prominent feature of the cover of Cliffs Notes. *Id*. However, there were some differences. The cover of Spy Notes prominently stated five times in red lettering that it was a satire and bore the notation "A Spy Book" along with the Spy Magazine logo. It also showed a clay sculpture of New York City rather than the famous clay sculpture of a mountain that is found on the cover of Cliffs Notes. *Id*. In light of these changes, and the defendant's expressive elements in the form of parody, the court found for the defendants. *Id*. at 497.

In its ruling, the court stated that "parody is a form of artistic expression, protected by the First Amendment." *Id*. at 493. Parody protection is so strong that no recovery, under any cause of action, will be rewarded for injury caused by parody, unless actual malice can be shown. *Id*. Thus, parody and satire deserve substantial freedom. *Id*. That is both "as entertainment and as a form of social and literary criticism." *Id*. (quoting *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541, 545 (2d Cir.) *cert. denied,* 379 U.S. 822 (1964)).

The keystone of parody is imitation. *Id*. at 494. For a parody to be successful it must evoke the major elements of its target. *Id*. "A parody must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is *not* the original and is instead a parody." *Id*. (emphasis in original). To the extent that it only conveys that it is the original, without conveying any parody, it not only is a poor parody, but will be vulnerable to trademark law. *Id*. This is, because it confuses the consumer. *Id*. The better the parody the less likely it is to cause confusion. *Id*. at 495. Alternatively, the poorer the parody, the more likely it will be to cause consumer confusion. *Id*. Therefore, parodies done well will receive protection, while poor parodies will be vulnerable to intellectual property law. *Id*.

[106] Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 803 (Cal. 2001). In *Comedy III*, the literal depiction was of The Three Stooges, a famed comedy group. *Id*. at 801.

misappropriation unlawful.[107]

Commercial speech retains significantly less First Amendment protection than other speech in general because its main purpose is to sell, not to be creative.[108] Furthermore, commercial speech that is misleading will not be afforded any First Amendment protection.[109] Speech that is a mixture of commercial promotion and creative expression has only limited protection.[110] It is likely in these instances that the right of publicity will protect the image.[111] The First Amendment will comport with the limitations imposed by the right of publicity.[112] Therefore, even if commercial speech

---

[107] *Id*.

[108] Bosley v. Wildwett.com, 310 F. Supp. 2d 914, 928 (N.D. Ohio 2004).

[109] *Id.* at 925. "For example, the First Amendment does not shield from liability commercial messages which contain misleading material or relate to illegal activity." *Id*.

[110] *Id.* at 929.

[111] *Id*.

[112] *Id*. In *Bosley*, the district court enjoined the defendant from selling images of the plaintiff, a regional celebrity, and from using her images to sell its product. *Id*. at 936. Plaintiff was a local television news broadcaster, and defendant was the distributor of a pornographic website. *Id.* The use of the images did not involve any creative expression. *Id*. This case, however, is pending appeal. Bosley v. Wildwett.com, 2004 U.S. App. LEXIS 11028, *1 (6th Cir. 2004). Upon granting a stay to the injunction pending appeal, the circuit court stated that the "present case 'illustrates the difficulty of drawing bright lines that will clearly cabin commercial speech in a distinct category.'" *Id.* at *2. Further, the court stated that it was "not persuaded, at th[at] stage in the proceedings, that the defendant's speech [wa]s outside the protection of the First Amendment." *Id*. It remains to be seen how the law will change, at least in the 6th Circuit. Based on the court's language in the stay, it is reasonable to suspect that the court will find for defendant on appeal.

In a recent case, the Sixth Circuit found for a defendant that used the image and likeness of a professional golfer in a lithograph. ETW Corp. v. Jireh Publ'g Inc., 332 F.3d 915, 918 (6th Cir. 2003). Over five thousand reprints of the lithograph were sold. *Id*. The court found that since the collage of images depicted was combined to describe a historic event, the work was artistic. *Id*. Therefore, the court found that the First Amendment protected the work. *Id*. In other words, the court went so far to diminish the right of publicity, that it found that First Amendment protection extends to literal depictions that are meant for sale. It is very likely, then, that the same court will find that the First Amendment also protects purely commercial speech; i.e., speech for the sole

is also creative, it will not necessarily be granted First Amendment protection if the purpose of the speech is primarily commercial.[113]

III. THE NEED FOR A NEW TEST

A. The Unbalanced Approach Taken by the Courts

Surprisingly, few courts have tried to reconcile the right of publicity with the First Amendment.[114] Instead, courts just seem to grapple blindly with the right.[115] Some try their own balancing but end up severely minimizing the right.[116] Others arrive at the correct outcome but for uncertain reasons.[117] Unfortunately, such uncertainty has resulted in confusion on how to litigate cases involving the rights of publicity, and has even resulted in injustice in some cases.[118]

For example, in *Cardtoons, L.C., v. Major League Baseball Players Association,* the plaintiff baseball card company produced a series of parody cards lampooning various players in Major League Baseball.[119] In this declaratory judgment, defendant Major League Baseball Player's Association argued that the card company's unauthorized use of players' likenesses diminished the players' licensing value, which generated over seventy percent of their revenue.[120] In discussing the rights of the parties, the Tenth

---

purpose of exploiting the identity of the celebrity in order to market a product. This would, indeed, be a mistake. It would all but do away with the right of publicity.

[113] Coca-Cola Co. v. Purdy, 382 F.3d 774, 787 (8th Cir. 2004).

[114] Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 805 (Cal. 2001).

[115] *See*, *e.g.*, Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 959-76 (10th Cir. 1996). *See also infra* this section.

[116] *ETW*, 332 F.3d at 949 (Clay, J., dissenting). *See also infra* this section.

[117] *See*, *e.g.*, Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1189 (9th Cir. 2001). *See also infra* this section.

[118] *See*, *e.g.*, Donchez v. Coors Brewing Co., 392 F.3d 1211, 1213 (10th Cir. 2004). *See also infra* this section.

[119] 95 F.3d at 962. This case was a declaratory judgment not a lawsuit for damages. *Id*.

[120] *Id.* at 963.

Circuit put forth many justifications for upholding the right of publicity.[121] However, the court curtly changed gears and granted plaintiff's petition for a declaratory judgment that plaintiff's cards did not infringe on the defendant's publicity rights, after building an extensive case for the defendant because plaintiff's use of the players' likenesses did not diminish defendant's endorsement value.[122] The court noted that the right of publicity reserves the value of the identity to "advertisers who contract for the use of [the] likeness."[123] Yet, the court also stated that "even in the absence of publicity rights, celebrities would still be able to reap financial reward from authorizing appearances and endorsements."[124] The court's statements are contradictory, because it first stated that endorsement value is preserved by publicity rights, but then stated that endorsement value will thrive regardless of publicity rights.[125] The court acknowledged that "the right of publicity is said to protect various noneconomic interests, such as safeguarding natural rights, securing the fruits of celebrity labors, preventing unjust enrichment, and averting emotional harm."[126] However, the court ultimately found all of these justifications non-compelling and decided the case in favor of the plaintiff.[127] Instead of applying a clear standard to the rights, the court struggled to find (and ultimately found) justification for using a celebrity's identity for parody.[128]

---

[121] Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 967-76 (10th Cir. 1996). The court listed economic and noneconmic justification. *Id*. at 973. The right's economic goals include "stimulating athletic and artistic achievement, promoting the efficient allocation of resources, and protecting consumers." *Id*. The right's non-economic goals include "safeguarding natural rights, securing the fruits of celebrity labors, preventing unjust enrichment, and averting emotional harm." *Id*.

[122] *Id.* at 975-76.

[123] *Id.* at 974-75. This is endorsement value. *See id*. at 975.

[124] *Id*. at 974.

[125] *Id*. at 974-75.

[126] *Cardtoons*, 95 F.3d at 973.

[127] *Id.* at 976.

[128] The court was mainly protecting the public interest in parodies. *Id*. at 972. Still, the fact that the case was about a parody seems to get lost in the shuffle. Instead of focusing on this, the court stumbles its way through the

ETW Corp. v. Jireh Publishing Inc. is a case which illustrates how a bad balancing test can almost neutralize the right of publicity. In *ETW Corp*., the defendant artist used the likeness of a famous golfer in a drawing.[129] This drawing contained three exact likenesses of the golfer.[130] Over five thousand prints of the drawing were put on the market.[131] The golfer sued for the exploitation of his image.[132] In its lengthy discussion, the court adopted the "transformative elements test" for guidance.[133] Even though the court agreed that the depictions were a "literal likeness," it still refused to find for the plaintiff because it found transformative elements in the fact that the drawing contained more than one literal likeness.[134] In a confusing manner, the court stated that using a single literal depiction is not allowed, but using a collage of images is permissible, because a collage of images apparently has more expressive elements.[135] This holding allows

---

policy considerations of the right of publicity. *Id*. at 973-76.

[129] ETW Corp. v. Jireh Publ'g Inc., 332 F.3d 915, 928 (6th Cir. 2003). The golfer was Tiger Woods. *Id*.

[130] *Id*.

[131] *Id*.

[132] *Id*.

[133] *Id.* at 935. The court stated that "the transformative elements test adopted by the Supreme Court of California in *Comedy III Productions*, will assist us in determining where the proper balance lies between the First Amendment and Woods's intellectual property rights." *Id*. at 936. *See also* text *supra* § IV(A).

The transformative elements test determines how directly the work at issue has used the celebrity's identity. Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 808 (Cal. 2001). If the work has just adopted a literal depiction of the identity, then the work will be vulnerable to right of publicity protection. *Id*. If, however, the work changed or added some elements to the identity, the work will be afforded First Amendment protection. *Id*. *See* text *infra* § III(B) for further explanation.

[134] *ETW,* 332 F.3d at 938.

[135] ETW Corp. v. Jireh Publ'g Inc., 332 F.3d 915, 938 (6th Cir. 2003). "Rush's work does not capitalize *solely* on a literal depiction of Woods. Rather, Rush's work consists of a collage of images in addition to Woods's image." *Id*. (emphasis added). The court reasoned that the multiple images created an expressive element. *Id*. That is, it captured a moment in sports history. *Id*. This, however, is a grave misconstruction. *Id.* at 959 (Clay, J., dissenting). The images

imitators to exploit likenesses so long as more than one image is used in a single work. In sum, the majority misapplies the law of publicity.[136]

---

used in the drawing are nearly identical to those used in authorized Nike posters. *Id*. The majority errs in not protecting the rights of the plaintiff. *Id.* at 960. "The Majority's failure to do so in this case is in complete contravention to the intent of Congress, the principles of trademark law, and the well-established body of jurisprudence in this area." *Id*.

[136] *Id.* at 948 (Clay, J., dissenting). The court in *ETW* seems to suggest that having an actual depiction with a clever title will protect the work from publicity liability. *Id*. at 938. "While the right of publicity allows celebrities . . . to enjoy the fruits of their labors, here [the artist] has added a significant creative component of his own to [the celebrity's] identity," the title of the work. *Id*. When there is a collage of images together, suggesting a moment in sports history, the use of the literal depictions will be protected. *Id*. All the more so when the work has an artistic title. *Id*. at 919. *Bosley v. Wildwett.com* explained the holding in *ETW*. 310 F. Supp. 2d 914, 927 (N.D. Ohio 2004). The court explained that *ETW* did not directly address the role of the First Amendment in advertising cases. *Id*. It was only speaking about an artistic work. *Id*. Note, however, that this artistic work was trying to sell itself. *ETW*, 332 F.3d at 919. It was not merely a single print, but over five thousand were put on the market. *Id*. It is uncertain, then, that in a case where a product designer appropriates an image, and uses it on the product itself, and not in advertising, whether *ETW* would not control.

ETW should be overturned. The facts of the case do not pass the new test. The artist used a collage of likenesses in a work of art. *Id.* at 918. The art was reprinted over five thousand times, and put on the market for sale. *Id*. at 919. The collage featured literal depictions of Tiger Woods, a superstar golfer, in his signature poses. *Id.* at 918. In the accompanying literature, Woods's name is mentioned twice. *Id*. at 919.

Applying the factors of the test is not difficult in this case. The work has a dual purpose. As it does seek to capture a moment in time, it is also focusing on the celebrity Tiger Woods. The main purpose of the art is to capitalize off of the fame that Tiger Woods worked hard to attain. The event depicts the day he became the youngest player in sports history to win the Masters tournament. *Id*. at 918. He also created a new 72-hole record in the tournament. *Id*. He has risen to the pinnacle of his sport. *Id*. The artist is capitalizing off of this success. Painting literal depictions is not any more expressive than putting together a collage of photographs. The purpose is the same, to take advantage of another's fame for personal gain. True, the artist claims to commemorate an event, but he is also exploiting an image.

This type of product leads to confusion and dilution. Such a commemorative work will likely be seen by consumers as affiliated in some way

On the other hand, the case of *Hoffman v. Capital Cities/ABC Inc.* is an example where the Ninth Circuit arrived at the correct ruling, but for the wrong reasons.[137] Plaintiff actor Dustin Hoffman starred in "Tootsie," a movie in which he played a male actor who dresses like a woman in order to get a part on a television soap opera.[138] A memorable still from the movie depicts the actor dressed in a red long-sleeved sequined evening dress, posing in front of an American flag.[139] The defendant magazine publisher published an article which contained altered photographs of famous movies to make it appear that the actors were sporting the current fall fashion.[140] The final shot in the article was of the memorable "Tootsie" still, altered by replacing the actor's body with that of a male model in the same pose, wearing a spaghetti-strapped, cream-colored, silk evening dress.[141] The actor sued, claiming that the magazine was tortuously exploiting his identity.[142] The court reasoned that using an identity for commercial purposes is beyond the scope of First Amendment protection.[143] However, the court found that the altered photo was not used to sell the fall line, just to present the trick photography, instead of stating that there were expressive elements in the work.[144] Thus, the correct holding—that the magazine can use the

---

to the player. The poses shown, after all, are identical to the ones used in Nike posters that are endorsed by the celebrity. *Id*. at 947 (Clay, J., dissenting). Aside from confusion, there is also dilution. Tiger Woods would want to sell the rights to such a project. Especially since it is commemorative, it views him in the greatest light possible. Therefore, there is a great likelihood of confusion and dilution.

Summary judgment should have been awarded to Woods.

[137] Hoffman v. Capital Cities/ABC Inc., 255 F.3d 1180 (9th Cir. 2001).

[138] *Id.* at 1182.

[139] *Id*.

[140] *Id.* at 1183.

[141] *Id*.

[142] *Id*.

[143] Hoffman v. Capital Cities/ABC Inc., 255 F.3d 1180, 1185 (9th Cir. 2001). "If the altered photograph had appeared in a Ralph Lauren advertisement, then we would be facing" a different kind of case, one where the right of publicity will be upheld. *Id*.

[144] *Id.* Therefore, it could be argued that the photograph had a clear

image—was arrived at, but with the wrong analysis—due to lack of commercial purposes, rather than being clear that it was the expressive elements in the work.[145] Results of this kind are dangerous for they may lead to more confusion in the case law.

The case of *Donchez v. Coors Brewing Company* is an example of injustice as a result of failure to appreciate the need to protect publicity rights.[146] Plaintiff in the case was the first beer vendor to be licensed for the Colorado Rockies. While working as a beer vendor he created his own distinct character,[147] calling himself "Bob the Beerman."[148] Plaintiff even went so far as to file the "Bob the Beerman" character for state trademark protection.[149] He then worked as this character in various sporting events in and out of Colorado.[150] He also performed on television and radio, and at charitable events.[151] During this time, he authored a book and starred in a video as his character.[152] Defendant beer company, hearing about this character, pursued negotiations with the plaintiff to use the character in an ad campaign.[153] However, the beer company ultimately declined to enter into any contractual relationship with the plaintiff.[154]

Following this unsuccessful pursuit, the beer company began a national television advertising campaign utilizing many different

---

expressive purpose. *Id*.

[145] It is clear that the purpose of the magazine was (1) to parody the movies, and (2) to illustrate the ability to alter photographs. *Id*. Therefore, the article should be protected as speech and not because of a lack of actual malice.

[146] 392 F.3d 1211 (10th Cir. 2004).

[147] *Id*. at 1214.

[148] *Id*. Plaintiff would call out to the crowd "My favorite word in the English language: Beer! Two favorite words: Cold Beer! Three favorite words: Cold Beer Man!" *Id*. He would use beer, peanuts and Cracker Jacks as props. *Id*. He would put on this act in order to entertain the crowd. *Id*.

[149] *Id*.

[150] *Id*.

[151] *Id.*

[152] Donchez v. Coors Brewing Co., 392 F.3d 1211, 1214 (10th Cir. 2004).

[153] *Id.*

[154] *Id*. No reasons are stated in this case. It can be presumed, however, that money was the deciding factor. The beer company, perhaps, did not want to pay for a character they could exploit for free. *See* text *infra* this section.

actors and actresses portraying beer vendors.[155] The beer vendors would interact with the crowd in entertaining ways and were referred to, by the crowd and themselves, as "Beerman." [156] Many who knew the plaintiff or had seen his act commented that they thought he had licensed his character to the beer company.[157] Plaintiff then filed suit in order to protect the character he created.[158]

Claiming to balance the rights of the parties, the court instead summarily favored the defendant. The court claimed to "view the evidence, and draw reasonable inferences therefrom."[159] Even so, the court found for defendant.[160] It stated that the mark "Bob the Beerman" was too generic, and did not acquire secondary meaning.[161] "Secondary meaning" is a meaning in the minds of the public other than the plain meaning of the words.[162] The court noted, as well, that the defendant never used "Bob the Beerman," but simply "Beerman."[163] As for the right of publicity, the court

---

[155] *Id.*

[156] *Id*. at 1214-15. The facts do not note whether the beer vendors looked like the plaintiff. However, this does not seem likely. There were many actors that played the part. Additionally, there were actresses.

[157] *Id*. at 1214. This was based on a survey gathered by the Plaintiff. *Id*.

[158] Donchez v. Coors Brewing Co., 392 F.3d 1211, 1214 (10th Cir. 2004).

[159] *Id.* at 1215.

[160] *Id.* at 1223.

[161] *Id*. at 1217.

[162] *Id*. at 1216. An example is Seven-Up. *Id*. at 1218. When hearing these words combined in such a way, it is automatically assumed that the speaker refers to the soft drink, not the number seven going up. *Id*. The term "beerman" however, did not attain such secondary meaning. *Id*. It was thought of as a man that has beer. *Id*. This is the plain meaning. *Id*.

[163] *Id.* at 1217. The court seemed to rest its decision on the fact that the plaintiff failed to present much evidence. *Id*. While he did have evidence that the term "Beerman" was identifiable to himself, he failed to present it on appeal. *Id*. "For whatever reason, however, Donchez has not included that report in his appellate appendix." *Id*. Thus, the court knew of the evidence, and yet still ignored it. *Id*. "Thus, we cannot consider the report and the statements included therein in determining whether there is a genuine issue of material fact regarding the classification of the term 'beerman.'" *Id*. This is even though the court will incidentally be leaving the plaintiff without any evidence on the matter. *Id*. "In turn, that leaves Donchez without any evidence to support his assertion that the

dismissed that inquiry by stating that "the Colorado Supreme Court does not appear to have expressly recognized this tort."[164] Thus, the court concluded that the plaintiff did not sufficiently present evidence that he had a protectable interest in his mark "Beerman."[165] In this case, the court ignored the fact that the plaintiff took the initiative to have his character protected in the state patent office,[166] that he was recognizable as the character,[167] that he used the character for capital gain,[168] and that the beer company only ran the advertising campaign *after* meeting with him.[169] Instead of protecting creativity, the court allowed free misappropriation of the created persona.[170] Furthermore, the court also failed to protect consumers from confusion.[171] Consumers may erroneously believe that Donchez endorsed the beer commercials or that the character was created by the beer company. In sum, instead of protecting ideas, publicity, trademark, and consumer interests, the court opened the door for further

---

term 'beerman' is suggestive." *Id*. Instead of considering this evidence, perhaps not in the opinion, but as policy, the court utterly ignores it. *Id*.

Further, the plaintiff had evidence that his character was so prevalent, that there were many who only knew him by his character name. *Id*. at 1219. The court, again, refused to acknowledge this evidence. *Id*. "Donchez has not, however, included any of those deposition excerpts in his appendix." *Id*. Even though the court knew of the evidence, and it was presented at trial, it refused to consider it on appeal. *Id*.

[164] Donchez v. Coors Brewing Co., 392 F.3d 1211, 1220 (10th Cir. 2004). What about the common law right of publicity? Landham v. Galoob Toys, Inc., 227 F.3d 619, 622 (6th Cir. 2000). The Donchez court utterly disregards the clearly established federal common law right of publicity. *See id*.

[165] *Donchez*, 392 F.3d. at 1219. "In turn, we conclude he has failed to present sufficient evidence to allow a jury to find he has a protectable interest in the mark 'beerman.'" *Id*.

[166] *Id.* at 1214.

[167] *Id.*

[168] *Id*.

[169] *Id.* The implication here is that the beer company wanted the use of the character for free. After negotiations for buying the license to use the character stalled, the beer company used the character without paying any licensing fees.

[170] Donchez v. Coors Brewing Co., 392 F.3d 1211, 1222 (10th Cir. 2004).

[171] *Id.* at 1214.

misappropriation.[172]

The court struck down the right of publicity claim because "Donchez has not presented any evidence to establish that he, as opposed to the character he created, is a celebrity."[173] This is clearly faulty reasoning, in light of the fact that the court admits that the created persona did become a celebrity.[174] Therefore, it is clear from *Donchez* and the previous cases that without the proper guidance, publicity rights are in danger of being invaded by individuals and corporations looking to exploit the images of individuals who have already cultivated a market. Presently, courts lack the proper guidance to adjudicate matters in which publicity rights have been invaded by free-riders.

B. Courts Lack Proper Guidance

A uniform test is needed mainly because different courts have adopted different tests, leading to inconsistency in the law of publicity. The following subsections will highlight some of those tests, along with their shortcomings.

1. The Transformative Elements Test

In *Comedy III Prod., Inc. v. Gary Saderup, Inc.* the Supreme Court of California established the "transformative elements" test.[175] "The inquiry into whether a work is 'transformative' appears to us to be necessarily at the heart of any judicial attempt to square the right of publicity with the First Amendment."[176]

---

[172] What follows from this holding, is that now, if an advertiser wants to use a creative character invented by someone else, the advertiser need only to slightly alter the character and make it generic. Additionally, now that Coors created the generic "beerman" character, it might be able to succeed, under the court's logic, on an action to prevent Donchez from using his "Bob the Beerman" character. The company would, theoretically, be successful in a trademark claim against Donchez. This is not justice.

[173] *Id.* at 1221.

[174] *Id*.

[175] Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 808 (Cal. 2001).

[176] *Id*.

When a work that contains a celebrity's identity has "*significant* transformative elements" it will be afforded more protection.[177] A work with such changes is afforded more First Amendment protection because it is less likely to interfere with the economic interests protected by the right of publicity.[178] Transformative elements are found by inquiring into where the work derives its value from.[179] When the principal value of the work comes from the creativity, skill, and reputation of the artist, and not from the fame of the celebrity, then it may be presumed to contain sufficient transformative elements to warrant First Amendment protection.[180] However, literal depiction of a celebrity, even if done with great skill and talent, will be vulnerable to the right of publicity.[181] The inquiry is whether it is literal and imitative or creative elements that predominate in the work.[182] The "expression" in the work must be something other than the likeness of the celebrity.[183]

The transformative elements test was adopted in *Winter v. DC Comics*.[184] As the California Supreme Court explains the test, its limitations become apparent.[185] The test protects against trespassing on the commercial value of the celebrity.[186] Commercial value, however, is the limit of the protection. The

---

[177] *Id.* (emphasis added).

[178] *Id*. The more changes a work has the less likely it is to cause consumer confusion and dilution. *See* text *infra* § IV(B)(b).

[179] *Id.* at 810.

[180] *Id*.

[181] Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 809 (Cal. 2001). Ironically, it is works created with less skill that may be protected. The more skill exhibited in the work, the more likely it is to cause consumer confusion and dilution if appropriated. This is because artistic works with great skill will look like a literal depiction. The less skill used in creating the work, the less the work will literally depict the celebrity. The work will be less likely to cause confusion and dilution. This is because the work will resemble the celebrity but not be a literal depiction. Thus, works created with less skill have a greater chance of being protected.

[182] *Id*.

[183] *Id*. *See infra* note 287 for the facts of this case.

[184] 69 P.3d 473, 477 (Cal. 2003).

[185] *Id*.

[186] *Id*.

court stresses that works containing transformative elements are "less likely to interfere with the *economic* interest" of the celebrity.[187] Further, in applying the test to the facts in front of it, the court stated that a comic book that uses the likenesses of celebrities, but turns them into fantastic characters, will not be infringing on the celebrities' right of publicity.[188] This is because fans will not consider the comic book a good substitute for the actual image of the celebrities.[189] This test falls short of protecting the right of publicity because although the economic interest of image value is protected, it still leaves endorsement value vulnerable, as well as the privacy interests that the right of publicity protects. It also does not protect at all against consumer confusion as to affiliation. Therefore, this test is ineffective at protecting the totality of the right of publicity.

2. The Rogers *Balancing Test*

In *Rogers v. Grimaldi*, the Second Circuit suggested another balancing test.[190] Generally, under the *Rogers* test, the right of publicity is "construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the

---

[187] *Id.* (emphasis added).

[188] *Id.* at 479. This case dealt with a comic book that used the images of two musicians in creating fantastic worm-like characters. *Id*. Although the musicians were readily recognizable in the comic book, their names were changed and they were transformed into worm-like antiheroes. *Id*.

[189] *Id.* at 470. But celebrities may want to endorse a comic book that uses their personas as heroes. The court misses this point.

[190] 875 F.2d 994, 999 (2d Cir. 1989). Celebrity Ginger Rogers sued the producers and distributors of a motion picture alleging that the title of their film contained her name in it in violation of the rights of publicity. *Id*. at 996. Rogers teamed up frequently with the late Fred Astaire. *Id*. The two made a very famous dance duo. *Id*. Together they starred in many films. *Id*. They "established themselves as paragons of style, elegance, and grace." *Id*. They are of the few elite of the entertainment world whose identities are readily called to mind by just their first names. *Id*. The defendant created a film entitled "Ginger and Fred." *Id*. It was about two fictional Italian dancers that imitated Rogers and Astaire. *Id*. at 996-97. The court allowed the use of the duo's names to be used in the title of the film, because the title had minimal artistic relevance to the film and did not explicitly mislead as to sponsorship. *Id*. at 1005.

public interest in free expression."[191] The court reasoned that a misleading use of an identity that has no artistic relevance cannot be sufficiently justified by a free expression interest.[192] Expressive works that are sold in the commercial marketplace have a dual interest.[193] While the expressive aspects need protection, there is legitimate governmental interest to regulate in order to prevent consumer confusion.[194] Therefore, the interests are balanced to determine which one outweighs the other.[195]

The *Rogers* balancing test has been widely adopted.[196] *Parks v. LaFace Records*[197] explained that *Rogers* is a two prong test.[198] The first inquiry is whether the use of the identity has artistic relevance to the underlying work.[199] If it has no relevance then the inquiry ends and the right of publicity is upheld.[200] If there is *some* artistic relevance, then the second inquiry is if the use "*explicitly* misleads as to the source of the content;" if so, then the right of publicity is also upheld.[201] Barring these two outcomes, the First Amendment will protect the work.[202]

However, this test also comes up short in protecting the right of publicity. The test concerns itself mainly with balancing the

---

[191] *Id.* at 999.

[192] *Id*.

[193] *Id.* at 998.

[194] *Id*.

[195] *Id.* at 999.

[196] ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 927 (6th Cir 2003); Parks v. LaFace Records, 329 F.3d 437, 450 (6th Cir. 2003).

[197] 329 F.3d 437 (6th Cir. 2003).

[198] *Id.* at 451.

[199] *Id*. at 452. "Artistic relevance" is found when there is *any* artistic relationship between the identity and the underlying work. *Id*.

[200] *Id*. When an artist claims that the identity is used as a "symbol" for the work, but upon examination the claim is deemed questionable, "a legitimate question is presented as to whether the artist's claim is sincere or merely a guise to escape liability." *Id*. at 454.

[201] *Id.* at 451 (emphasis added). "Explicitly misleading" is when the work goes out of its way to convey a false connection between the celebrity and the work. *Id*. at 459.

[202] *Id.* at 451.

interests behind the right of publicity and First Amendment.[203] However, it gives virtually no guidance on how to determine what the interests are. Additionally, its inquiries only seem to delve into the confusion issue. It does not inquire, at all, into whether there is any endorsement exploitation, or privacy interests infringed upon. Therefore, this test inadequately protects the right of publicity.

3. The Alternative Avenues Test

The "alternative avenues" test was created by the United States Supreme Court[204] and applied to trademark cases in *Mutual of Omaha Insurance Co. v. Novak*.[205] This test's inquiry is whether there are alternative avenues for the expressive work that would not infringe on the celebrity's interests.[206] This test is derived from real property law.[207] The main premise is that just as a landowner may exclude speakers from his property if there are alternative avenues available to the speaker, a celebrity may restrict the use of his or her identity in speech if there are alternative avenues available to the artist.[208] Several courts have noted the awkwardness of analogizing property rights in land to those of ideas and words.[209] To some, suggesting that alternative words and means of expression can be used just as well as the ones selected by the artist borders on silly.[210] As the famous American author Mark Twain stated, "The difference between the almost-right word

---

[203] *Id.* at 450.

[204] Lloyd Corp. v. Tanner, 407 U.S. 551, 566-67 (1972).

[205] 836 F.2d at 402 (8th Cir. 1987).

[206] Parks v. LaFace Records, 329 F.3d 437, 488 (6th Cir. 2003).

[207] *Id*. at 449; Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 206 (2d Cir. 1979).

[208] *Parks*, 329 F.3d at 449-50. For example, if a shopping mall owner may exclude a speaker from his property. *Lloyd*, 407 U.S. at 567. The Court ruled that the shopping mall owner may exclude a speaker from his property if there are alternative avenues available to the speaker to get his message across. *Id*. The parallel is thus drawn: a celebrity may prohibit the use of his name or image so long as alternative avenues exist for the artist to communicate his idea. *Parks*, 329 F.3d at 450.

[209] *Parks*, 329 F.3d at 450.

[210] *Id*.

and the right word is really a large matter—it's the difference between the 'lightning-bug' and the 'lightning.'"[211] There is no need to "belabor the point that some words, phrases or symbols better convey their intended meanings than others."[212] Therefore, the alternative avenues test does not sufficiently accommodate the public's interest in free expression.[213]

C. The Key Issues Behind Fashioning an Effective Test

The primary goal of intellectual property law is maximizing creative expression.[214] The right of publicity tries to achieve this goal by "striking a proper balance between the right of a creator to the fruits of his labor and the rights of future creators to free expression."[215] "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."[216] Courts do not have much guidance because few courts have truly tried to reconcile the two rights.[217] Cases dealing with the right of publicity only arise sporadically nationwide, so there have not been many opportunities for courts to address the matter.[218] Unsure of how to properly deal with the right, courts often look to the entire body of law.[219] However, this method allows courts to pick and choose which cases they want to follow[220] and which standard to apply.[221]

---

[211] J. BARTLETT, FAMILIAR QUOTATIONS 527 (16th ed. 1992).

[212] New Kids on the Block v. News Am. Publ'g, Inc., 971 F.2d 302, 306 (9th Cir. 1992).

[213] Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989).

[214] Cardtoons, L.C., v. Major League Baseball Players Ass'n, 95 F.3d 959, 976 (10th Cir. 1996).

[215] *Id*.

[216] Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 807 (Cal. 2001).

[217] *Id.* at 805.

[218] Landham v. Galoob Toys, Inc., 227 F.3d 619, 622 (6th Cir. 2000).

[219] *Id.* at 623.

[220] *See, e.g., Comedy III*, 21 P.3d at 805. Unsure how to proceed, the court noted, "we follow those that have in concluding that depictions of celebrities amounting to little more than the appropriation of the celebrity's economic value are not protected expressions under the First Amendment." *Id*.

In fact, some courts have expressed concerns about even applying a standard at all.[222] Thus, a uniform standard needs to be set.[223]

To articulate an exhaustive list of all the ways that publicity is protected is to invite clever marketers to discover new ways to exploit identities.[224] The tests that courts have come up with thus far have fallen short of providing adequate protection.[225] Even the consumer confusion test, which tests whether consumers will likely be confused as to a celebrity's connection to the product, is inadequate because it does not balance the First Amendment right against the right of publicity.[226]

Finally, courts have presented conflicting policy considerations of the right of publicity. There are many suggestions to limit the right. They include: even pure commercial speech may be found to be within First Amendment protection;[227] since the right is derived

---

[221] Rogers v. Grimaldi, 875 F.2d 994, 1002 (2d Cir. 1989). When the Second Circuit was faced with a right of publicity claim under the substantive law of Oregon, the court grappled with the question of where to start in applying a standard. *Id*. "We are therefore obliged to engage in the uncertain task of predicting what the New York courts would predict what the Oregon courts would rule as to the contours of the right of publicity under Oregon law." *Id*.

[222] *Id.* at 1005. "[W]e need not, and do not, reach the issue of whether the First Amendment would preclude a state from giving broader application to the right of publicity." *Id.* at 1005 n.13. This is stated, despite the Supreme Court already resolving that issue. Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 563, 578-79 (1977). *See also* text *infra* §V.

[223] Landham v. Galoob Toys, Inc., 227 F.3d 619, 622-23 (6th Cir. 2000).

[224] *Id.* at 624-25. (explaining that if a laundry list is presented, marketers will find a loophole around the list. (*citing* Abdul-Jabbar v. Gen. Motors Corp., 85 F.3d 407, 413-15 (9th Cir. 1996)).

[225] Parks v. LaFace Records, 329 F.3d 437, 448-49 (6th Cir. 2003). *See also* text *supra* §III.

[226] *Id*. at 449. The consumer confusion test looks at whether consumers will erroneously attribute sponsorship or affiliation of a product to a celebrity, when a marketer exploited that celebrity's persona. *Id*. If the use is one that a celebrity would likely endorse, i.e., use in the form of advertisement, then the use leads to such consumer confusion. *Id.* If the use of the identity is to parody the identity, then that use will not lead to consumer confusion. *Id*. This is because celebrities do not endorse a self-parody. *Id*. *See* text *supra* §IV(B)(b) for a further discussion of the confusion test.

[227] Bosley v. Wildwett.com, 2004 U.S. App. LEXIS 11028 at *2 (6th Cir.

from privacy, a cause of action only exists during the lifetime of the celebrity;[228] not all states recognize the right;[229] copyright law preempts the right in many cases;[230] an artistic work that is used for commercial purposes is not merely a commercial product, but is also a means of communication;[231] affording celebrities a police power to control the use of their identities will restrict public discourse to some extent;[232] the right will allow celebrities to shield themselves from ridicule and criticism;[233]and it is the media, not the celebrity, that has created a market for the identity.[234]

Conversely, many other courts have put forth policy considerations supporting the right of publicity. While many celebrities are highly compensated in their respective fields, a majority of their revenue still comes from endorsements.[235] The right of publicity protects this endorsement value.[236] Without this protection, identities could be commercially exploited until their value was worthless.[237] No matter how much celebrities earn in their respective fields, if they hold a property interest in their identities, it should be protected.[238] "People deserve the right to profit from the commercial value of their identities, because, quite

---

2004).

[228] Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 799 (Cal. 2001).

[229] Donchez v. Coors Brewing Co., 392 F.3d 1211, 1220 (10th Cir. 2004).

[230] Toney v. L'Oreal U.S.A., Inc., 384 F.3d 486, 489 (7th Cir. 2004).

[231] Parks v. LaFace Records, 329 F.3d 437, 449 (6th Cir. 2003).

[232] *Id*.

[233] Cardtoons, L.C., v. Major League Baseball Players Ass'n, 95 F.3d 959, 974 (10th Cir. 1996).

[234] White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1399 (9th Cir. 1992). Thus, the celebrity does not earn the value of his identity. That value was created for him or her.

[235] *See, e.g., Cardtoons*, 95 F.3d at 963. "Since 1966, MLBPA [Major League Baseball Players Association] has entered into group licensing arrangements for a variety of products, such as candy bars, cookies, cereals, and, most importantly, baseball trading cards, which generate over *seventy percent* of its licensing revenues." *Id*. (emphasis added).

[236] *Id.* at 974.

[237] *Id*.

[238] *See id*. This is because "publicity rights stem from some notion of natural rights." *Id*. at 975.

simply, they've earned it."[239] A celebrity's identity is his authentic seal.[240] The identity carries the good name and will of the celebrity.[241] When another wrongfully uses the identity of someone else who has cultivated a good name and will, the user does so with the expectation that others will be influenced by the reputation which comes along with that good name and will.[242] This wrongful procurement allows the borrower to "ride the coat-tails" of the celebrity, which itself is an injury to the celebrity, even without tarnishing the reputation.[243] Thus, unless the borrower's use is so foreign to the owner's use to ensure against any assimilation of the two, it is unlawful.[244]

Furthermore, by "[a]llowing individuals the exclusive right to capitalize on their persona, like copyright law, [they are encouraged] to invest in developing their skills and talents."[245] Publicity rights also provide incentives to excel in the fields of sports and entertainment.[246] For instance, there are relatively very few actors who manage to create immediately recognizable identities, an invaluable asset to an actor.[247] The protection of this value as a property asset is an incentive to becoming the best in the entertainment field.[248] Additionally, rights of publicity are consistent with the Copyright Act,[249] so as not to be preempted by

---

[239] Cardtoons, L.C., v. Major League Baseball Players Ass'n, 95 F.3d 959, 974 (10th Cir. 1996).

[240] Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 467 F.Supp. 366, 375 (S.D.N.Y. 1979) (*citing* Elec. Corp. v. Robertson, 26 F.2d 972, 974 (2d Cir. 1928)).

[241] *Id*.

[242] *Id*.

[243] *Id*. Thus, right of publicity does not focus on tarnishing of name or image. *See id.*

[244] *Id*. Such a foreign use will not offend the celebrity. *See* text *infra* § IV(A).

[245] Bosley v. Wildwett.com, 310 F. Supp. 2d 914, 929 (N.D. Ohio 2004).

[246] Cardtoons, L.C., v. Major League Baseball Players Ass'n, 95 F.3d 959, 974 (10th Cir. 1996).

[247] Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 805 (Cal. 2001).

[248] *Cardtoons,* 95 F.3d at 974.

[249] 17 U.S.C. § 301 (1998).

copyright law.[250]

Any distinctive aspect of the persona that identifies the celebrity is protected under the right of publicity.[251] A plaintiff merely has to show commercial value in the identity.[252] The right is not limited to false endorsement.[253] The use of a catch phrase that is distinctive to the celebrity,[254] a slightly altered picture of a famous driver's race car,[255] a drawing of a nude black boxer identified by a distinctive nickname,[256] and the famous nickname of a professional football player as the name of a leg shaving cream[257] were all found to violate the right of publicity.

---

[250] Landham v. Galoob Toys, Inc., 227 F.3d 619, 623 (6th Cir. 2000). The only time the right will be preempted is when a celebrity already licensed out his rights to another, and then is disputing the licensee's use of the identity in mass media. *Id*.

[251] *Id.* at 624-25.

[252] *Id*. at 624.

[253] *Id*. at 624 n.1.

[254] Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 835 (6th Cir. 1983). Carson was the famous host of the "Tonight Show," which ran five nights a week on broadcast television. *Id*. at 832. For twenty years Carson was introduced onto the show with the line "Here's Johnny." *Id*. Appellee made and rented Here's Johnny portable toilets. *Id*. at 833. Shortly after appellee went into business Carson brought an action against it. *Id*. The court ruled that in using the famous phrase the celebrity's identity had been misappropriated and exploited. *Id*.

[255] Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 827 (9th Cir. 1974). Plaintiff is an internationally known and recognized racecar driver. *Id*. at 822. Plaintiff also "individualized" his racecar, by making it identifiable as his. *Id*. In a commercial produced by defendant, the defendant used the plaintiff's car. *Id*. Plaintiff's face was not visible. *Id*. The court found that the distinguishable racecar would be enough of a likeness of the plaintiff, to bar its use. *Id*. at 827.

[256] Ali v. Playgirl, Inc., 447 F. Supp. 723, 726-27 (S.D.N.Y. 1978). Ali was heavyweight boxing champion of the world. *Id*. at 725. A portrait of the boxer was depicted without permission in an issue of Playgirl Magazine. *Id*. The portrait depicted a nude black man sitting in the corner of a boxing ring. *Id*. The boxer was referred to as "the Greatest." *Id*. at 727. This was Ali's nickname. *Id*. The nude boxer was clearly recognizable as Ali. *Id*. at 725. The court found this was a misappropriation of the boxer's persona, and granted the boxer an injunction. *Id*.

[257] Hirsch v. S.C. Johnson & Son., Inc., 280 N.W.2d 129, 137 (Wisc.

Presently, there is no test that produces consistent outcomes in matters of publicity rights.[258] Therefore, a new test must be proposed. However, this new test must insulate from restriction works with sufficient artistic relevance that are ambiguous or only implicitly misleading, but leave vulnerable works that are explicitly misleading as to source or content, or have minimal or no artistic relevance at all.[259] Only in this manner will the test resolve the conflicting interests of the First Amendment and the individual's interests in rights of publicity.

IV. A NEW THREE-PRONG TEST TO CONSISTENTLY ADJUDICATE THE RIGHT OF PUBLICITY

The following section outlines the proposed right of publicity test and illustrates its application and effectiveness with case-based hypotheticals.

1979). Hirsch, a professional football player was nicknamed "Crazylegs." *Id*. at 131. Defendant used that nickname to market their products. *Id*. at 132. The court found that such misappropriation is enough to be considered unlawful. *Id*. at 140.

[258] Parks v. LaFace Records, 329 F.3d 437, 448-49 (6th Cir. 2003). Even the *Rogers* balancing test comes up short in this respect. *See* text *supra* §III(B)(2). No one test that is already in case law adequately balances the interests of artists and celebrities. However, it is possible to suggest a single test that can answer the right of publicity question in every case. *See* text *infra* § IV(A).

[259] Rogers v. Grimaldi, 875 F.2d 994, 1000 (2d Cir. 1989). The court states how federal trademark law accommodates consumer and artistic interest. "It insulates from restriction titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading but leaves vulnerable to claims of deception titles that are explicitly misleading as to source or content, or that have no artistic relevance at all." *Id*. Note the higher standard that *Rogers* provides. *Id*. That is because titles deserve more protection than ordinary works. *Id*. at 997. The new test suggested here does just this. *See* text *infra* § III(B)(2).

A. The New Test

1. The "Purpose" Prong

The first inquiry goes to the purpose of the defendant's use of another's persona. When there is no expressive speech or action, there is no First Amendment protection.[260] Exploiting an identity without adding any expressive elements will violate publicity rights and will not invoke First Amendment protections.[261] A work in which the expressive element, such as a parody, is subservient to the commercial element, such as the sale of a product, will also not be shielded from right of publicity claims.[262] Like the transformative elements test, this first purpose prong asks whether there are any additional elements added to the work that illuminate the purpose of the work.[263] An important inquiry is whether the

---

[260] Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1184-85 (2001) (finding that if the "commercial aspects [of a work] are inextricably entwined with [its] expressive elements," the work will have "a measure of First Amendment protection").

[261] *Id.* (use of altered movie still in print ad to sell clothes); Newcombe v. Adolph Coors Co., 157 F.3d 686, 691 (9th Cir. 1998) (using a baseball pitcher's image in printed beer ad); Abdul-Jabbar v. Gen. Motors Corp., 85 F.3d 407, 409 (9th Cir. 1996) (use of basketball player's former name in television commercial); Waits v. Frito-Lay Inc., 978 F.2d 1093, 1097-98 (9th Cir. 1992) (imitating famous singer's voice in snack-food commercial); Midler v. Ford Motor Co., 849 F.2d 460, 461 (9th Cir. 1988) (use of sound-alike rendition of singer's song in a car commercial) (all not protected by First Amendment).

[262] White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1401 (9th Cir. 1992). Additionally, where the parody is invoked in bad faith, used in order to justify exploiting of an image, it will not be protected. Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 467 F. Supp. 366, 375 (D.C.N.Y. 1979). When film footage of a celebrity is used to sell itself, and is not accompanied by editorial comments, the film will not be protected. Bosley v. Wildwett.com, 310 F. Supp. 2d 914, 928 (N.D. Ohio 2004). Even an impersonation, if not accompanied by any comment, will not be protected. Estate of Presley v. Russen, 513 F. Supp. 1339, 1359 (D.N.J. 1981) (finding that an Elvis impersonator's concerts constituted a copying of Elvis Presley's persona and was not protected by the First Amendment).

[263] Comedy III Productions, Inc. v. Saderup, Inc., 21 P.3d 797, 808 (Cal.

creative elements predominate.[264] If the purpose of the work is to *express* something,[265] then it triggers potential First Amendment protection. However, if the purpose is to exploit the image for monetary gain with very little creative manipulation of the image, then it leans more toward violating the publicity rights of the celebrity.[266]

2. The "Confusion/Dilution" Prong

After the purpose of the work is determined, courts should next examine the harmful effects of the identity exploitation, namely, confusion and dilution.[267] A court in a right of publicity case uses

---

2001).

[264] *Id.* at 810 ("We ask, in other words, whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness."). This test is not the end of the inquiry, however. In *Winter v. DC Comics*, the court applied the transformative elements test. 69 P.3d 473, 477 (Cal. 2003). The court found that a comic book exploited the likenesses of two musicians, but had creative elements, and was protected by the First Amendment. *Id*. at 479. The comic book had clear appropriations of the musicians. *Id*. at 476. The comic included long white hair, albino features, and tall black hat that were signatures of the plaintiffs. *Id*. Additionally, the title use, "Autumns of Our Discontent," was clearly an appropriation of the plaintiffs' names. *Id*. The plaintiffs' name was Winter. *Id*. There is a Shakespearian phrase "winter of our discontent" in Richard III, act I, scene I, lines 1-2. *Id*. at 476 n.1. Even with evidence of clear appropriation, the court found for the defendant. *Id*. at 479. That is because there were transformative elements, like making the musicians into alien worm creatures. *Id*. Thus, the transformative elements test, that does not consider confusion, is clearly only a start to the inquiry. *See* text *supra* § III(B)(1).

[265] This expression must be something other than the likeness, or to sell a product. *Comedy III*, 21 P.3d at 809.

[266] After this inquiry, the harmful effects must be determined. These are confusion and dilution. The reason why the inquiry cannot end here, is that the full breadth of the policy considerations cannot be evaluated until the harmful effects of the work are determined. *See* text *supra* §III(B). The more the work is used to sell, the more it is commercial speech and is afforded less First Amendment protection. Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N. Y., 447 U.S. 557, 566 (1980).

[267] ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 948 (6th Cir 2003) (Clay, J., dissenting).

the eight-factor inquiry adopted by courts in trademark cases in order to measure the amount of confusion created by the identity exploitation. [268] The eight factors are not used in a precise mathematical way, but merely as a guide.[269] As trademark and right of publicity claims are similar in that the harm to plaintiffs in both cases revolves around confusion and dilution, these eight factors will be strong indicators of right of publicity violations. A key factor in the inquiry is whether the use of the identity in the product or work will create consumer confusion as to source, affiliation, or sponsorship.[270] That is, the court must ask whether consumers believe that a celebrity is associated with the product.[271] A second factor is whether the use of the identity in the product or work will dilute the value of the identity.[272] This assumes that any profit off of the fame of a celebrity would likely diminish the value of the celebrity's endorsement value.[273] If identities are used

---

[268] Landham v. Galoob Toys, Inc., 227 F.3d 619, 627 (6th Cir. 2000). The eight factors are: (1) strength of plaintiff's mark; (2) relatedness of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; (7) defendant's intent in selecting the mark; (8) likelihood of expansion of the product lines. *Id.* at 626-27. There is no need to prove actual confusion. Parks v. LaFace Records, 329 F.3d 437, 460 (6th Cir. 2003).

[269] *Landham,* 227 F.3d at 627.

[270] *Parks*,329 F.3d at 445-46.

[271] *Id.* at 445. Confusion and dilution may be intertwined. If the use of an identity will lead consumers to believe that the celebrity is behind the product, then that is a product that the celebrity may want to endorse. It follows that confusion is found more easily in products or works that the celebrity would be more likely to endorse. If a celebrity would be less likely to endorse a product or work, then the use of an identity will be less likely to cause consumer confusion. *See* White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1401 (9th Cir. 1992).

[272] Coca-Cola Co. v. Purdy, 382 F.3d 774, 777 (8th Cir. 2004). *See also* text *supra* § I(B).

[273] Rogers v. Grimaldi, 875 F.2d 994, 1003-04 (2d Cir. 1989). Taking a free ride off of the fame is tantamount to unjust enrichment. Cardtoons, L.C., v. Major League Baseball Players Ass'n, 95 F.3d 959, 976 (10th Cir. 1996). Even using the identity of one celebrity to make fun of another will violate the right of publicity. Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 901 (9th Cir. 2002). However, using a celebrity's identity to make fun of that celebrity is fully First Amendment protected. *Id*.

without paying for them, then identities lose their marketability.[274] Accordingly the higher degree of confusion and dilution the more harmful the identity exploitation is, and the more vulnerable to attack the work becomes.[275]

3. The "Balancing" Prong

After determining the purpose of a work as a function of its expressive elements and harmful identity exploitation in the first two prongs, public interest concerns are evaluated.[276] The policy considerations behind the right of publicity are balanced against those of free expression.[277] A court will have to evaluate the extent of the commercial aspects of the work,[278] coupled with the extent of harm it will likely cause,[279] and determine whether or not the public interest in a free marketplace of ideas prevails. For instance, if the purpose of the work is to sell itself or a product, and it will likely lead to consumer confusion and dilution,[280] then the right of publicity will prevail. However, if the work's main purpose is to express an idea, and there is little likelihood of confusion or dilution,[281] then the First Amendment will protect the work. In this way, the elements are truly in balance.[282]

---

[274] *Rogers*, 875 F.2d at 1004.

[275] After determining the amount of expression and harmful exploitation a work has, it is then time to balance the interests behind rights of publicity and free expression.

[276] *Rogers*, 875 F.2d at 999.

[277] *Id*.

[278] I.e., what its purpose is.

[279] I.e., the level of confusion and dilution.

[280] I.e., in advertising.

[281] I.e., a parody.

[282] When the commercial, confusion, and dilution aspects are found more prevalent, the interest in protecting this work absconds. As the expressive and creative elements start to dominate, then the right of publicity gives way to the protection of the First Amendment. *See* text *supra* §III(B).

B. Application of the New Test

Applying the new test to different hypothetical situations inspired by actual cases will demonstrate how the test is properly applied. The hypotheticals will also show how the proposed test can be uniformly applied to differing types of right of publicity actions.

1. Appropriation of Photograph Case

A publisher creates a monthly calendar.[283] In the calendar, the producer uses multiple photographic images of the legendary baseball player Babe Ruth. The baseball great appears three times in the calendar. Ruth's daughters bring an action asserting the right of publicity along with state and federal trademark claims.

Applying the new test to the right of publicity claim, the court will first determine the purpose of the image appropriation. The court will look at the calendar to find out if the use of Ruth's image is to express an idea or to sell the calendar. The purpose is likely to sell as many calendars as possible by including photographs of the American icon. There is no commentary accompanying the photographs. There are virtually hundreds of different kinds of calendars on the market. The photographs were probably necessary

---

[283] This hypothetical is taken from the facts in Pirone v. MacMillan, Inc., 894 F.2d 579 (2d Cir. 1990). Baseball has been America's national pastime since the early 1900s. *Id*. at 580. One such ball player, "Babe Ruth[,] hardly needs an introduction." *Id*. Ruth was often paid by manufacturers for the use of his picture on their products. *Id*. at 581. The defendant calendar maker created a calendar. *Id*. This calendar did not feature Ruth's name anywhere on the front or back cover. *Id*. The calendar contained pictures of many great baseball players. *Id*. The calendar also included three photographs of Babe Ruth. *Id*. The court found for the defendant. *Id*. at 583. It stated that, "a photograph of a human being, unlike a portrait of a fanciful cartoon character, is not inherently 'distinctive' in the trademark sense." *Id*. The court concluded that an ordinarily prudent consumer would think that although the celebrity is the subject matter of the calendar it by no means indicates sponsorship. *Id*. at 585. This is clearly misguided reasoning. The court does not explain why a consumer, seeing all the photographs of the celebrity, will think that it was an appropriation and not from the celebrity himself.

to give the calendar a marketing edge. Thus, the primary purpose appears to be to use the image for commercial purposes.

Next, the court must determine whether the photographs cause confusion as to affiliation, sponsorship, or source, and dilution by lessening the endorsement value of the image. The calendar may confuse consumers, who, upon seeing the photographs in the calendar, may think that it has some affiliation or approval from Babe Ruth's estate.[284] The calendar may also cause dilution because a calendar is something that a celebrity may want to sell endorsement rights for in order to make a profit. In fact, celebrities endorse a variety of common products.[285] In this circumstance, the defendant's free use of the photograph in the calendar likely diminishes the endorsement value of the celebrity's image.[286] Thus, there is harm in the exploitation.

Finally, the competing interests—free expression on one hand, and privacy and property on the other hand—must be balanced. Exploitation for commercial purposes is present, with few, if any, expressive elements. Ruth's image was inserted in the calendar in order to differentiate the calendar from others in the eyes of consumers. This was to help sell more calendars. Additionally, there is the high likelihood of confusion and dilution. Many consumers would believe that Ruth's license holders endorsed the calendar. Additionally, using the image without paying for it decreases the endorsement value of the image. Marketers will not want to pay for an image that they can use for free. Therefore, the right of publicity outweighs that of free expression.[287]

---

[284] Or, whomever holds the rights to his image.

[285] The list includes T-shirts, watches, lunch boxes, photo frames, and towels.

[286] Advertisers and product designers will not pay for likenesses that can be obtained for free. While this is one example, this can create a dangerous precedent.

[287] After all, there is no expression in this product.

A similar hypothetical can be drawn from Comedy III Prod., Inc. v. Saderup, Inc., 21 P.3d 797 (Cal. 2001). The Three Stooges were a huge comedy hit in their day. The group was made up by Moe, Jerome "Curly" Howard, and Larry Fein. Starting in vaudeville and then later in movie shorts, the trio were at the top of their profession for twenty years. During these years they developed their own style incorporating "nyuk-nyuk," "whoop-whoop-whoop," eye pokes,

2. Appropriation of Identity

An actor stars in a low-budget movie which unexpectedly becomes very popular.[288] Afterwards, a toy company starts to produce, market, and sell action figures based on the characters in the movie. Each of these figures, though diminutive, have a very clear resemblance to the actors that played the parts in the movie.[289] At no time did the actor sign a waiver of his rights to his

---

and head conks. Their images have become synonymous with comedy and a distinct brand of physical humor. Defendant artist, who had over twenty-five years of experience, draw a depiction of the famous trio. He sold that depiction on lithographs, silkscreen, and on T-shirts. The charcoal drawing was original in that it did not copy any existing photograph of the trio. It did, however, literally depict the comedian group. Comedy III, the registered owner of all rights to the former comedy act, sued to protect their publicity rights.

Plugging this fact pattern into the new test is simple. The purpose of the charcoal drawing is to literally depict the trio. That is, to capitalize off of their fame. The depiction was sold as lithographs, and put on T-shirts, in order to sell to fans. There was no message in the drawing, other than to identify the images of The Three Stooges. While artwork is protected by the First Amendment, that is expressive art, or art that does not violate anyone else's rights. A work that exploits the image of a celebrity will not be automatically protected.

Consumer confusion is very likely in this case. Since the depictions are literal, and were sold as prints or on T-shirts, consumers will very likely be led to believe that The Three Stooges were affiliated with the products. While all members of the trio are dead, their rights belong to Comedy III. As for dilution, T-shirts and prints are common avenues for celebrities to sell endorsements. Endorsements are not only sold for advertising, but for product placement as well. Therefore, by using the images without compensating the celebrity, it causes a dilution of the value of the identity. Additionally, it is taking a free ride on the fame of the celebrity. This is unjust enrichment.

Balancing First Amendment and publicity rights are relatively simple. There are not that many expressive elements in the work, but there is a lot of harmful exploitation. Therefore, summary judgment should be granted to the plaintiff. The right of publicity should be firmly upheld.

[288] This hypothetical is taken from the facts in Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619 (6th Cir. 2000).

[289] In *Landham* the toys that were made were tiny, with no clear resemblance at all to any of the actors. *Id.* at 622. In fact, the toy designer purposely avoided any resemblance. *Id*. Therefore, no right of publicity violation was found. *Id*. at 627.

character in the movie, and the production company never contracted with him to retain all marketing rights in the film.[290] The actor sues to protect his publicity rights.

In applying the proposed three-pronged test, the court first looks at the purpose of the toy company using the likeness of the actor. The clear purpose of the toys is twofold. One, to create a toy that evokes the character played in the move. Two, based on this evocation, sell the toys. Thus, the predominant purpose is to exploit the character's image to sell the toys.

Next, the court weighs the confusion and dilution. The appropriation may not be harmful. First, as to confusion, most consumers would probably think that the movie, not the actor, is associated with the toy. Unless otherwise demonstrated, few consumers would think that the actor solely authorized the making of the toy. In fact, it is likely that the consumers do not care if the toy looks like the actor or not. The main purpose of the action figure is to evoke the image of the character, not necessarily the actor that starred in the role.[291] Therefore, there is not much likelihood of consumer confusion as to affiliation.

Dilution would have a similar analysis. While an actor may want to endorse action figures which depict his or her likeness, there may not be an actual opportunity to do so. The lack of an opportunity is because when a toy company obtains a license from movie producers, often it is only after an actor has waived his or her rights to the characters.[292] Therefore, dilution may not be

---

[290] Presumably, most major production companies make it standard practice to reserve all marketing rights stemming from their films, but in the case of an indie film, such a precaution may not seem critical. Therefore, this hypothetical contemplates a situation in which all bets are off when it comes to the actor exploiting his own character.

[291] The toy would have the same appeal no matter who played in the role. Although some main characters become famous because of who starred in the role, i.e., the *Terminator* starring Arnold Schwarzennegger, the majority become famous because of the movie. Thus, in most instances, consumers do not care who the toy looks like, as long as it is the character from the movie. This is especially true for characters that wear masks and the like, concealing the identity of the actor. Some examples are Darth Vader from *Star Wars*, Batman, and Spider-Man.

[292] Landham v. Lewis Galoob Toys, Inc., 227 F.3d 621 (6th Cir. 2000).

present because although this particular toy company can produce the toy that evokes the image, others that want to evoke the image would still have to obtain a license.

In balancing, however, the right of publicity would prevail. While the public interest in preventing publicity exploitation is weak in this case, due to the lack of harmful exploitation, there is no expression that is to be protected. The identity on the toy is clearly commercially related. Therefore, in a case where the actor did not waive his right to the character he plays, a toy company will have to seek his permission before creating a toy that evokes his likeness.[293]

---

[293] This will lead to toy manufacturers having to get licensing from the studio and from the actor. However, that is only if the toy looks like the actor. If it only looks like the character, then licensing will only need to be obtained from the movie studio. *Id*. at 626.

This can be compared to a hypothetical drawn from Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001). Dustin Hoffman plays a character that dresses up like a woman in order to get a part on a daytime television soap opera. A memorable still from the movie is a shot of the male actor dressing up like a woman. He is wearing a long-sleeved red evening gown. Years later a magazine wants to show off its prowess in computer graphics. It takes the famous still, along with many others, and alters them. The article replaced the bodies of the famous actors and replaced them with male models sporting the fall fashion. In the case of this particular actor, it kept the head as is, but replaced the body with that of a male model. The model was wearing a spaghetti strapped, cream colored, evening gown. It included a caption that read "Dustin Hoffman isn't a drag in the butter-colored silk gown by Richard Tyler and Ralph Lauren heels." The actor then sued to protect his publicity value.

The purpose of the article was to express an idea. That idea is what actors in famous roles would look like wearing the fall line. The purpose was not merely to exploit the image, but to lampoon it. The parody is not of the actor, but putting the actor in a silly situation. Thus, the lampooning was more of the still than of the actor. Either way, the expressive element stays the same. That is, to illustrate the power of computer graphics. The caption under the altered photograph went along with this theme.

There is little likelihood that consumers will think any of the actors, including Dustin Hoffman, is affiliated with the article. For one, it is in a magazine. It is very unlikely that magazines have to pay celebrities every time they want to include an image along with an article. Another reason, is that it lampoons the memorable roles. Few actors would want to reduce their memorable role to a scene of them in women's clothing. As for dilution, it

3. Appropriation of Image Case

A poster for sale is created that depicts a robot.[294] The robot has male features, an African-American complexion, and a bald head. The robot is wearing black high-top basketball sneakers, a red basketball uniform with black trim, baggy shorts, and the number 23 on the jersey.[295] The poster depicts the robot dunking a basketball one-handed, stiff armed. The arms and legs are spread out, like scissors, and the tongue is hanging out. Seeing this, famed basketball player Michael Jordan[296] sues the poster company under a right of publicity claim.[297] Jordan asserts that the robot is depicting his likeness.

Consider the three prongs of the proposed test.[298] First, the purpose prong. The robot appears to be evoking the image of Michael Jordan: it is wearing a uniform that is very similar to his Chicago Bulls[299] uniform, "23" is the number he wore, and the

---

follows the same reasoning. That is, it does not diminish endorsement value, because celebrities will not want to endorse such an article. Additionally, it is an article, and celebrities do not usually endorse articles.

The policy here is clear. The article contains definite expressive elements. The exploitation of the identity is necessary to convey the ideas expressed. This exploitation is also not harmful. Therefore, the public interest in free expression clearly prevails.

[294] This hypothetical is posed in White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1399 (9th Cir. 1992).

[295] While this is famed Chicago Bulls basketball player Michael Jordan's number, it does not say "Jordan" or "Bulls" anywhere on the uniform.

[296] Former professional basketball superstar.

[297] The hypothetical, as posed in *White*, has this image as part of an advertisement. 971 F.2d at 1399. It is used as a plain poster in order to isolate the image exploitation aspect. If it would be used as an advertisement, then there would be even more reason to believe the image represents commercial speech.

[298] "Considered individually, the robot's physical attributes, its dress, and its stance tell us little." *White*, F.2d at 1399. The court notes, however, that "Taken together, they lead to the only conclusion that any sports viewer who has registered a discernable pulse in the past five years would reach: the ad is about Michael Jordan." *Id*.

[299] A professional basketball team, part of the National Basketball

arms, legs, and tongue are all in his signature positions. The use of the image appears to be in order to sell the poster. A poster is only sold because of the image on it, not for the value it has as paper. The image, however, does contain expressive elements. Here, the poster undoubtedly imitates the plaintiff basketball superstar. This makes the poster a parody. The impersonation, however, is the end of the expression. The poster does not comment specifically on the ballplayer. It merely is expressing that this robot is like Michael Jordan.[300] Thus, there are commercial and expressive elements, neither set particularly stronger than the other.

Second is the confusion and dilution prong in order to judge the harmfulness of the appropriation. In this case there is a likelihood of confusion present, but it is not very strong. While a celebrity will want to sponsor posters of him or herself, a robotic depiction is arguably not the usual goal. Therefore, a consumer may think that the celebrity had something to do with the poster, but it is not a very strong inference.[301] On the same token, this depiction is not the type of parody that lampoons the player, and so it is not unthinkable that the player somehow approves or is affiliated with the poster.[302] As for diluting endorsement value, this depiction is not an avenue that the player usually would endorse. A player would endorse a poster with an actual image, perhaps, but not one of a robot that merely depicts his likeness. However, this poster is taking a free ride on the fame of the celebrity. The artist

---

Association.

[300] Expressing likeness is not considered creative expression. Comedy III Prod. v. Saderup, Inc., 21 P.3d 797, 809 (Cal. 2001).

[301] Using the eight-factor test as guidance, confusion is found. The characteristic pose along with the number and red uniform lead to a likelihood of confusion. There is a strong mark, the goods are related and similar, marketing channels are the same, there is a low degree of purchaser care for posters, and the intent of using the mark was to exploit the image. As for evidence of actual confusion and expansion of product lines, those lean toward the defendant. Therefore, there would be confusion found.

[302] To a certain extent, celebrities welcome well thought out parodies. Parodies done in good taste, that don't criticize the celebrity, but merely make fun, are found to be endorsed by the celebrities themselves. In fact, in many occasions celebrities play cameo parts in movies or in advertisements that poke fun at them.

likely used a robot instead of an actual image of Jordan in order to escape paying endorsement fees. The parody is a way to market posters of the celebrity to fans without paying compensation.[303] Therefore, there is only a small likelihood of confusion, but a great amount of dilution.

As for balancing the free expression and property and privacy interests, the interests are well-balanced; that is, neither interest is particularly strong. Although there is clear image exploitation, the exploitation would not likely be considered injurious to the celebrity's publicity value because celebrities do not generally endorse parodies. At the same time, however, there is not much expression in this work. While the poster expresses that the player sticks his tongue out while playing basketball, that is the totality of the expressed ideas. This image use is an example of the artist capitalizing off of the fame of the celebrity. Rights of publicity protect such unjust enrichment and freeloading. Free expression does not have much at stake in this work because little is known of the artist's opinion of the basketball player. Ultimately, an injunction to protect the ballplayer's persona should likely be granted to the ballplayer because the purpose of the poster is commercial gain, and not substantive commentary on Jordan.[304]

---

[303] Depicting the celebrity in this way will get around paying for the identity. Although the celebrity will not want to endorse *this* poster, but the celebrity will want to endorse posters. By not using any actual image of the celebrity, the artist is trying to market a product to the fans of the basketball player without having to pay licensing fee. Therefore, there is dilution. This is an example of taking a free ride off of the fame of a celebrity without compensating the celebrity. This then, is also unjust enrichment.

[304] The defendant can easily escape liability in this case if there was more expression in the poster. Perhaps show money trailing out of the pocket of the uniform, or add springs to the bottom of the sneakers. However, this may defeat the artist's purpose. It seems that the artist may want to market this poster to those who hold Michael Jordan in high regard. Therefore, the artist would not want to lampoon the celebrity this way.

A similar hypothetical is derived from the facts in White v. Samsung Elecs. Am., Inc., 971 F.2d 1395 (9th Cir. 1992). An electronics company created a vast print ad marketing campaign. The main theme was showing its products in the context of twenty years in the future. It used a mixture of celebrities and common items for the campaign. An example is showing raw meat with the caption "Revealed to be health food, year 2025." Another showed a talk-show

host in front of an American flag with the caption "Presidential Candidate, year 2020." All of the advertisements depicting celebrities were done with permission. The one exception was the one that is up for dispute. This advertisement featured a robot with female features, white gown, pearls, and blond wig. It was posed in front of a game board which was instantly recognized as the Wheel of Fortune game-show set. The look and stance of the robot was clearly modeled after Wheel of Fortune game-show hostess Vanna White. The caption read "Longest-running game show. 2012 A.D.." This advertisement was selling VCRs. Upon seeing this ad, the hostess sued to protect her identity.

The purpose of the advertisement is clearly to sell the VCRs. Although it parodies the game show and its hostess, that is just an incidental purpose of the commercial message. The parody message is clearly expressive. It states that the game show is very popular and will still be running twenty years in the future, as illustrating, in exaggerated form, the famous aspects of its hostess. Still, the main purpose of the advertisement is to be an advertisement. That is, to sell the VCRs.

This advertisement will not likely lead to consumer confusion. Consumers will not think that the game show is affiliated with the ad. If the game show would be affiliated with the ad, the depiction of the game show would be a lot more literal. Since the ad only depicts the readily recognizable aspects of the show without any literal depictions, it is most likely viewed as a parody. Parodies of this kind are not likely affiliated with the producers of the game show, even if it does depict the show in a positive light. It is less likely affiliated with Vanna White, its hostess. However, there might be some confusion as to permission or approval of the depiction. As for dilution, there is no direct diminishing of the celebrity value. The hostess will not likely endorse such a parody. It is not literal enough. However, the ad does capitalize off of her famous identity. Her persona is used without compensating her. Thus, the ad is taking a free ride off of her hard work and talent. Therefore, there is dilution, exploitation, and unjust enrichment.

It is not simple to balance these rights. There clearly is a message. The advertisement parodies the game-show and its hostess, and therefore has expressive elements. By the same token, the purpose of the advertisement reveals its commercial purpose. Additionally, the identity exploitation is harmful. Although there is not a strong likelihood of consumer confusion, and no direct dilution, there is the capitalizing off of the identity. This capitalization diminishes endorsement value by finding an alternative way to reach fans of the celebrity without paying for licensing rights. Therefore, even though this is a close case, summary judgment should have been given to plaintiff.

This hypothetical is an example of a parody not done correctly. When a parody is not done correctly, it loses its expressive potency. When a parody is intertwined with commercial elements, like trying to sell a product, then the parody is less effective in it of itself. Therefore, it receives less protection than

CONCLUSION

The right of publicity is a difficult and elusive area of law. The right's basis in two different areas of law has caused more confusion than comfort, as demonstrated by the various and divergent outcomes in cases dealing with the right of publicity. In exhibiting both privacy and property aspects the right has a wide range of interests. However, while the interests of the right are apparent, courts have historically struggled to determine what protections the rights of publicity afford. A primary concern is the interplay between the right and the First Amendment. By protecting the marketplace of ideas and expression, the First Amendment puts a limitation on the breadth of the right of publicity. Intellectual property and the right of publicity in turn, put limitations on the First Amendment as well. There is great dispute among courts as to how far each of these limitations extend. Unsure, courts have been more inclined to limit the right of publicity than the First Amendment.

The First Amendment is by far not absolute. The First Amendment's protection extends only to the expressive elements of a work. A work will incidentally be protected if it contains sufficient expressive elements. When there are commercial or identity-exploitative elements in a work, the work will be afforded less protection. Thus is the interaction between the First Amendment and the right of publicity. In a work that contains both expressive and identity exploitative elements, there will be friction between the rights of free expression and publicity. Each right will protect its respective interest in the work. Therefore, a court must balance the rights to find which one outweighs the other.

Precise balancing is what has troubled courts. Many courts find the task daunting and have shied away from it. Others have tackled it head on, albeit misguidedly. Still others have tried to gingerly strike a delicate balance. All these approaches, however, have met little success. The task of balancing the rights still looms dauntingly before courts. The unbalanced and haphazard

---

parodies whose purpose is to convey a message.

approaches used have only led to more confusion.[305] Such approaches have also led to injustice.[306] Aside from the courts, the parties in right of publicity disputes are left without any direction. Celebrities are unsure of how to plead a right of publicity case, while artists have no clear guideline of how much their work may incorporate the identity of another.

A growing concern is the lack of appreciation some courts have for the policy considerations for the right of publicity. Many courts choose only to list the public policy against the right which helps justify limiting the right. These courts, though, are unwittingly diminishing the property right of the celebrity. No good reason has been put forward to explain why the First Amendment's right of free expression should automatically trump the Fifth Amendment's right to property. Without a clear understanding of the public interest in upholding the right, courts will continue to disregard it. On the contrary, courts should realize the great public interest that the right of publicity carries. The right of publicity prevents the misappropriation of a valuable identity, one that the celebrity worked very hard in creating. The right gives the celebrity the sole right to exploit his or her identity. The right also prevents unjust enrichment, consumer confusion, and the dilution of the celebrity's property interest. In this way, it is quite akin to trademark law. Therefore, better understanding and respect should be paid toward the property interests the right is protecting.

In light of the need to protect both the valuable identity and the free market of ideas, a proper balancing test is needed. Courts should adopt an approach that will incorporate the interests of both parties. In order for this to happen, courts must acknowledge the need to uphold the purposes of both parties' rights. Only then can a proper balance be struck. This Note proposed a three-pronged test that can accomplish the goal of balancing the rights. The first prong is to consider the purpose of the work in question. This will determine if the work is primarily to convey a message, or for the most part trying to sell something. The next prong is to consider how harmful the identity exploitation is. If the persona use will

---

[305] *See* text *supra* § III(A)-(B).

[306] *See* text *supra* § III(A).

likely cause consumer confusion as to affiliation or sponsorship then it will be found to be harmful. Persona use will also be harmful if the use dilutes the value of the identity it is using, or tries to capitalize on the fame of another. Finally, the last prong balances the opposing interests in the work. The expressive components are weighed against the commercial and identity exploitative components to find if the First Amendment or the right of publicity will prevail. In this way, publicity and free expression rights are firmly upheld. With this test, courts and parties will have clear guidance of how to act in regard to the identity rights of celebrities.

Indeed, because of the necessity in upholding *both* the public interest in free expression and right of publicity, jurisdictions nationwide are urged to adopt the right of publicity in this way. The states that have not yet adopted any form of the right of publicity should do so immediately. The states that have already adopted the right via the common law or statute should consider modifying their case law to adequately protect both of these interests. The test this Note suggests may be adopted or used as guidance. When limiting or expanding the right of publicity, the public has much at stake. Artists and merchants need guidelines for determining when identity exploitation is permissible. Furthermore, celebrities deserve protection for their identities and personas. Thus, many members of our society have a stake in how the balance is struck.[307] Federal courts should acknowledge that there exists a federal common law right of publicity as well. Thereby, all courts should consider the need for adoption of a formal balancing standard. As the Supreme Court has not heard a right of publicity case since 1977, it is quite obvious that the issue is overdue before the Court. If the Court carefully strikes a proper balance between the two competing interests, other courts nationwide will finally obtain some clarity. Only then will this issue no longer daunt courts, but be one of the many laws in our

[307] Indeed, living in a capitalist society, every member of society has the potential to become an artist, merchant, celebrity, or all three. Therefore, every member of society has a stake in how the right of publicity and its interplay with the First Amendment is defined. Therefore, it is imperative for courts to adopt a clear method for balancing the rights.

jurisprudence that will protect the interests of all parties.