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VIDEO GAMES AND NCAA ATHLETES: RESOLVING A MODERN THREAT TO THE FIRST AMENDMENT

Alex Vlisides*

ABSTRACT

In 2013, two U.S. Courts of Appeals ruled that NCAA athletes could maintain right of publicity claims against a video game maker for use of their likeness. These decisions in favor of sympathetic plaintiffs reveal the threat that current right of publicity doctrine poses to First Amendment rights. The right of publicity tests applied by lower courts conflict with both the Supreme Court precedent and the theoretical foundations of the doctrine. This article reviews and rejects this test, ultimately proposing a new test. This two-tiered right of publicity test better protects the values of right of publicity while protecting the First Amendment rights of content creators.

I. INTRODUCTION

The National Collegiate Athletic Association (NCAA) would not describe its mission as benefitting a “small number of people who get very, very rich on the exploitation of young students.”¹ The NCAA would not describe its relationship with Electronic Arts (EA), the maker of popular college athletics video games, as “exploitation of player’s names and likenesses for commercial purposes.”² It certainly would not describe its insistence that college athletes maintain an unpaid, amateur status as a “transparent excuse for monopoly operations.”³ However, this is how current and former

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1. Third Consolidated Amended Class Action Complaint ¶ 416, *In re* NCAA Student-Athlete Name & Likeness Licensing Litig., No. C 09-01967 CW (N.D. Cal. July 19, 2013) (quoting James Duderstadt, former President of Univ. of Mich. (June 2013)).
2. *Id.* ¶ 414 (quoting E-mail from Dan Beebe, former Comm’r of the Big Twelve (July 27, 2009)).
3. *Id.* ¶ 412 (quoting WALTER BYERS, UNSPORTSMANLIKE CONDUCT: EXPLOITING STUDENT ATHLETES 388 (1995)).

officials of the NCAA and its member universities have described the system.⁴

In *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, current and former college athletes were seeking a share of the billions of dollars in revenue that college athletics produce.⁵ Among the athletes' legal claims was that their likenesses were improperly licensed without compensation from the NCAA and Collegiate Licensing Company (CLC) to EA, thus violating their right of publicity.⁶ On September 26, 2013, the athletes' plaintiff class reached a proposed settlement with EA and the CLC, releasing the right of publicity claims against those defendants in exchange for a reported \$40 million.⁷ This settlement, and the continuing case against the NCAA, satisfies many people's gut-level responses to an NCAA system that enriches large corporations and athletic administrators while denying any compensation to the young, unpaid athletes who sacrifice their time and sometimes health to produce the massive revenues of college sports. The NCAA system, through which EA acquired the license to create its video games, has been described as "unfair,"⁸ "evil,"⁹ and even "tragic."¹⁰ But, as United States Supreme Court Justice Samuel Alito put it, "tragic facts make bad law."¹¹

The recent settlement was spurred by decisions in right of publicity cases that have applied the right too broadly and without respect to the interests that animate the doctrine. In *Hart v. EA*¹² and *In re*

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4. See *supra* notes 1–3 and accompanying text.
 5. Keller v. Elec. Arts, Inc. (*In re NCAA Student-Athlete Name & Likeness Licensing Litig.*), 724 F.3d 1268, 1272 & n.2 (9th Cir. 2013).
 6. Third Consolidated Amended Class Action Complaint, *supra* note 1, ¶¶ 5–6.
 7. Steve Eder, *E.A. Sports and Collegiate Licensing to Pay \$40 Million to Compensate Athletes*, N.Y. TIMES (Sept. 27, 2013), http://www.nytimes.com/2013/09/28/sports/nc-aa-football/ea-sports-and-collegiate-licensing-to-pay-40-million-to-compensate-athletes.html?_r=0.
 8. Michael Rosenberg, *Debate Over Antiquated NCAA Goes Way Beyond Pay-For-Play*, SPORTS ILLUSTRATED (Sept. 27, 2013), <http://www.si.com/college-football/2013/09/27/jim-delany-comments-ncaa-accountability-act>.
 9. Jonathan Weiler, 'A Brilliantly Devised, Evil System,' HUFFINGTON POST (Sept. 23, 2013, 1:37 PM), http://www.huffingtonpost.com/jonathan-weiler/a-brilliantly-devised-evil-b_3972337.html?utm_hp_ref=ncaa.
 10. Tate Watkins, *College Football 101: College Athletes Deserve Academic Credit for Playing*, BLEACHER REPORT, (Nov. 16, 2011), <http://bleacherreport.com/articles/943613-college-football-101-college-athletes-deserve-academic-credit-for-playing>.
 11. *Wyeth v. Levine*, 555 U.S. 555, 604 (2009) (Alito, J., dissenting).
 12. *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013).

NCAA,¹³ U.S. appellate courts found that college football video games violate the student athletes' right of publicity. These decisions applied the wrong doctrinal test for right of publicity, giving too much weight to the economic rights of the athletes and too little weight to the First Amendment rights of the speakers. The implications of these decisions threaten a broad range of expression previously thought to be protected by the First Amendment. The makers of films, novels, music, and even non-fiction writing could be subject to civil suits based on these precedents.¹⁴

In the only right of publicity case the U.S. Supreme Court has ever decided, it announced two competing interests at stake in right of publicity cases: the strong First Amendment rights of speakers and the government's interest in incentivizing individual investment by protecting a limited intellectual property interest.¹⁵ Since the *Zacchini v. Scripps-Howard Broadcasting* decision, lower courts have not focused on these interests, failing to protect the American marketplace of ideas.¹⁶ Judges must make difficult decisions, sometimes against sympathetic plaintiffs, to preserve First Amendment rights. After examining the interests announced by the *Zacchini* court in detail in Part II, this paper argues that courts should embrace a new test for right of publicity that protects speakers while serving the interests that the Supreme Court outlined.¹⁷

In Part II, the author performs a close reading of *Zacchini*, pinpointing the interests identified by the Court. Part III examines *Brown v. Entertainment Merchants Ass'n*, in which the Supreme Court extended broad First Amendment protections to video games and explained why First Amendment theory required that result.¹⁸ Part IV synthesizes the right of publicity doctrine with the marketplace theory of the First Amendment, demonstrating the theoretical underpinnings of the *Zacchini* decision. Part V overviews the development of right of publicity, reviewing the strengths and weaknesses of the three main tests that lower courts have adopted. Part VI analyzes the application of one of these tests—the Transformative Use Test—in *Hart* and *In re NCAA* and explores how the Transformative Use Test fails to reflect the values articulated

13. *Keller v. Elec. Arts, Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig.)*, 724 F.3d 1268, 1268 (9th Cir. 2013).

14. *See id.* at 1289–90 (Thomas, J., dissenting).

15. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 574–76 (1977).

16. *See infra* Part V.

17. *See infra* Parts II, VII.

18. *Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729 (2011).

in *Zacchini*. Part VII proposes a two-tiered test based in part on the commercial speech doctrine, which better identifies expression protected against right of publicity claims by focusing on the interests articulated in *Zacchini*.

II. THE LESSONS OF *ZACCHINI*: THE INTERESTS IDENTIFIED BY THE SUPREME COURT FOR PROTECTION OF RIGHT OF PUBLICITY

Zacchini v. Scripps-Howard Broadcasting Co. is the U.S. Supreme Court's only decision addressing the First Amendment limitations on the right of publicity.¹⁹ A close reading of this case is necessary for any examination of the doctrine for at least two reasons. First, *Zacchini* presented a relatively rare factual scenario that formed very different issues than many of the cases that have interpreted the case and developed the right of publicity doctrine. Second, the Supreme Court articulated in *Zacchini* the interests that animate the doctrine. Right of publicity is a limited property right that can be invoked against those engaged in expression that would otherwise be protected by the First Amendment.²⁰ The *Zacchini* court identified the state interests that allow for the limitation on otherwise constitutionally protected speech.²¹ The development of the doctrine and the tests used to evaluate right of publicity cases, must be analyzed with these interests at the forefront.

Hugo Zacchini was an entertainer who performed novelty shows in which he shot himself out of a cannon into a net about 200 feet away.²² While performing at a county fair in Ohio, Zacchini saw a freelance reporter for a Scripps-Howard television station and asked him not to film the performance.²³ However, the reporter returned the

19. Thomas F. Cotter & Irina Y. Dmitrieva, *Integrating the Right of Publicity with First Amendment and Copyright Preemption Analysis*, 33 COLUM. J.L. & ARTS 165, 168 (2010).

20. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

21. Right of publicity is a right granted by states, either by common law or by statute, to protect the economic value of a person's likeness. See Thomas Phillip Boggess V, *Cause of Action for an Infringement of the Right of Publicity*, in 31 CAUSES OF ACTION 2d §§ 1–2 (Thomson/West 2006). Thus, protections of right of publicity vary by state. See Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 132–33 (1993). This paper analyzes the limits on all state right of publicity laws imposed by the U.S. Constitution.

22. *Zacchini*, 433 U.S. at 563.

23. *Id.* at 563–64.

next day and recorded the performance.²⁴ A local nightly newscast aired a fifteen second film clip which showed Zacchini's entire act.²⁵

Zacchini brought suit for several causes of action including infringement on his right of publicity.²⁶ The Ohio Supreme Court ruled in favor of Scripps-Howard, finding that it had a First Amendment protected right to "report in its newscasts matters of legitimate public interest."²⁷ The U.S. Supreme Court reversed, finding that the First Amendment did not protect Scripps-Howard's expression.²⁸ The Court found the state could restrict the expression because "[w]herever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent."²⁹

The Court's analysis put great weight on the fact that the broadcast captured and reproduced Zacchini's entire act:

The broadcast of a film of petitioner's entire act poses a substantial threat to the economic value of that performance. As the Ohio court recognized, this act is the product of petitioner's own talents and energy, the end result of much time, effort, and expense. Much of its economic value lies in the 'right of exclusive control over the publicity given to his performance'; if the public can see the act free on television, it will be less willing to pay to see it at the fair.³⁰

The Court espoused two rationales for why the First Amendment should not protect the station's otherwise-lawful journalistic activity.³¹

First, the news station captured, at the very least, much of the economic value of Zacchini's act and appropriated it for its own uses. The Court explained that Zacchini's act was newsworthy, and reporting, commenting and even depicting the act on the news may

24. *Id.* at 564.

25. *Id.*

26. *Id.* Zacchini's claim was based in a common law right of publicity recognized by Ohio courts. *Id.*

27. *Id.* at 565 (quoting *Zacchini v. Scripps-Howard Broad. Co.*, 351 N.E.2d 454, 455 (Ohio 1976)).

28. *Id.* at 578.

29. *Id.* at 574–75.

30. *Id.* at 575.

31. *Id.* at 573–75.

very well have been protected speech.³² However, Zacchini had developed a fifteen-second novelty act, which people paid to see live.³³ The important distinction between reporting on the act and showing footage of the entire act is that the latter deprives the performer of the value that he created through developing his act. Broadcast reports, descriptions, and pictures of the act all trade on the likeness of Zacchini, creating content for the newscast by appropriating his likeness. But they do not capture and distribute the very act that Zacchini has invested time, money and effort to develop.

In other words, Zacchini did not have a right to restrict all speech that makes use of his likeness or act, but rather only speech that threatened to sap his economic incentive to develop his act. The Court regarded the “reward to the owner (as) a secondary consideration” of the right of publicity doctrine.³⁴ The right of publicity primarily “provides an economic incentive for him to make the investment required to produce a performance of interest to the public.”³⁵

The Court’s analysis that right of publicity did not protect a likeness holder’s reputation supports this incentive interest. If the doctrine were designed to protect an individual’s right to control his or her likeness, there would be no need to distinguish between the reputational and economic effects of control. An individual’s right is his to exercise without regard to what type of damage he values. However, the doctrine “focus[es] on the right of the individual to reap the reward of his endeavors and [has] little to do with protecting feelings or reputation.”³⁶ Although right of publicity is an action brought by individuals, the state’s interest is in protecting economic incentives.³⁷ The *Zacchini* court defined it as a limited right granted to support investment in expression of public value.³⁸

The Court’s pronouncement that the right of publicity was not a reputational right has another important implication. In right of publicity cases, claimants do not object to the fact of publication, but

32. *Id.* at 578. “If under this standard respondent had merely reported that petitioner was performing at the fair and described or commented on his act, with or without showing his picture on television, we would have a very different case.” *Id.* at 569.

33. *Id.* at 563.

34. *Id.* at 577 (alteration in original) (quoting *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948)).

35. *Id.* at 576.

36. *Id.* at 573.

37. *Id.*

38. *Id.*

rather that they are not compensated.³⁹ The public, and therefore the marketplace of ideas, will not “be deprived of the benefit of petitioner’s performance as long as his commercial stake in his act is appropriately recognized.”⁴⁰ In other words, the public interest is in promoting valuable expression, and this is served by encouraging those like *Zacchini* to develop and broadcast their talents. This is the essence of the right of publicity. Much has been made of the Court’s analogy of right of publicity to more traditional intellectual property.⁴¹ But the Court emphasized that the “economic philosophy behind” protecting the rights “is the conviction that encouragement of individual effort by personal gain *is the best way to advance public welfare.*”⁴² Protection of the right of publicity is largely a means to the end of a richer marketplace of ideas by encouraging people to invest in their expression. The right of publicity prevails where the public interest in encouraging investment by the likeness holder outweighs the speaker’s First Amendment interests.

Zacchini has long stood as a somewhat inscrutable explanation of the First Amendment bounds on the right of publicity.⁴³ But by identifying the interests to be served, lower courts can craft a doctrine in line with the Supreme Court’s reasoning. Foremost, the right of publicity is a means to promote investment in expression. The marketplace of ideas is protected by the tailored limitations on otherwise protected speech because the right of publicity promotes the development of expression that is valuable to the public. This is the value that should underlie all right of publicity analyses.

III. THE LESSONS OF *BROWN*: VIDEO GAMES AS CORE PROTECTED SPEECH AND THE DANGERS OF EVALUATING EXPRESSIVE VALUE

In *Brown v. Entertainment Merchants Ass’n*, the Supreme Court confronted a state law restricting violent video games and declared that video games are, from a First Amendment perspective, indistinguishable from books, plays, movies, and other classically

39. *Id.* at 578.

40. *Id.*

41. *See, e.g.*, 3 RODNEY A. SMOLLA, SMOLLA & NIMMER ON FREEDOM OF SPEECH § 24:4 (2015).

42. *Zacchini*, 433 U.S. at 576 (emphasis added) (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)).

43. *See* Barbara A. Burnett, *The Property Right of Publicity and the First Amendment: Popular Culture and the Commercial Persona*, 3 HOFSTRA PROP. L.J. 171, 192 (1990).

protected forms of expression.⁴⁴ Like these mediums, video games “communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player’s interaction with the virtual world).”⁴⁵ “That,” the Court concluded, “suffices to confer First Amendment protection.”⁴⁶

Like these other forms of expression, video games are protected even when not communicating core political or ideological speech.⁴⁷ The Court has “long recognized that it is difficult to distinguish politics from entertainment, and dangerous to try.”⁴⁸ Moreover, they may be indistinguishable, as “[w]hat is one man’s amusement, teaches another’s doctrine.”⁴⁹ The preservation of the marketplace of ideas requires free expression, and the Court unequivocally includes video games in this protection. “Under our Constitution, ‘esthetic and moral judgments about art and literature . . . are for the individual to make, not for the Government to decree, even with the mandate or approval of a majority.’”⁵⁰

Hart and *In re NCAA*, like *Zacchini*, dealt with the restriction of expression that is given the broadest protection under the First Amendment.⁵¹ In *Brown*, the nation’s highest court reaffirmed a deep distrust of value judgments by courts regarding core protected speech.⁵² The Court made clear that judicial analysis of what protected speech has more or less societal value is both “difficult” and “dangerous.”⁵³ The right of publicity limits First Amendment protected speech. Analysis of the scope of this right must acknowledge the fundamental rights at stake and recognize the dangers of making value assessments regarding core protected speech.

Thus, *Brown* provides two foundational principles necessary for analyzing a case involving the content of a video game. First, this content is creative expression like art or literature and must be given

44. *Brown v. Entm’t Merchs. Ass’n*, 131 S. Ct. 2729, 2733 (2011).

45. *Id.*

46. *Id.*

47. *See id.*

48. *Id.*

49. *Id.* (quoting *Winters v. New York*, 333 U.S. 507, 510 (1948)).

50. *Id.* (quoting *United States v. Playboy Entm’t Grp., Inc.*, 259 U.S. 803, 818 (2000)).

51. *See generally* *Keller v. Elec. Arts, Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig.)*, 724 F.3d 1268 (9th Cir. 2013) (discussing the elements of expression); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013) (analyzing courts’ application of a balancing test with regard to a claimed right of publicity).

52. *See Brown*, 131 S. Ct. at 2731 (citing *United States v. Stevens*, 559 U.S. 460 (2011)).

53. *Id.* at 2733.

the highest First Amendment scrutiny. Second, courts should not base decisions on an evaluation of the subjective value of a creative expression.

IV. THE MARKETPLACE OF IDEAS AND RIGHT OF PUBLICITY

The Supreme Court's First Amendment jurisprudence, including *Zacchini* and *Brown*, has long recognized the Constitution's role in guarding speech rights to protect the marketplace of ideas.⁵⁴ The intellectual roots of marketplace theory are often attributed to two influential thinkers, John Milton and John Stuart Mill. John Milton wrote in the seventeenth century of the metaphorical conflict between truth and falsehood. In many ways, marketplace theory can be defined by Milton's question: "Let [Truth] and Falsehood grapple; who ever knew Truth put to the worse, in a free and open encounter[?]"⁵⁵ In the nineteenth century, John Stuart Mill refined the theory with a focus on the assumptions that underlie any attempt to silence opinion: that the speech of the silencer is more valuable than the speech of those being silenced.⁵⁶ Mill argued that the constant contradictions of the marketplace of ideas were the only way to find truth.⁵⁷ He wrote, "Complete liberty of contradicting and disproving our opinion is the very condition which justifies us in assuming its truth for purposes of action; and on no other terms can a being with human faculties have any rational assurance of being right."⁵⁸

In American jurisprudence, the emergence of this marketplace theory of the First Amendment is often traced to Justice Oliver Wendell Holmes' forceful dissent in *Abrams v. United States*. "[T]he best test of truth is the power of the thought to get itself accepted in the competition of the market That at any rate is the theory of our Constitution."⁵⁹ Though the theory has been challenged and

54. *Id.* See generally *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) (examining the relationship between privileged speech rights and the right to broadcast).

55. JOHN MILTON, *AREOPAGITICA: A SPEECH OF MR. JOHN MILTON FOR THE LIBERTY OF UNLICENC'D PRINTING* 35 (London, W. Johnston 1644).

56. JOHN STUART MILL, *ON LIBERTY* 22 (David Spitz ed., W.W. Norton & Co., Inc. 1975) (1859).

57. *Id.*

58. *Id.* at 20.

59. *Abrams v. United States*, 250 U.S. 616, 630 (1919) (Holmes, J., dissenting).

debated by modern scholars,⁶⁰ it retains significant influence among American courts.⁶¹ Even critics of the theory recognize that it remains perhaps the most powerful theory of the First Amendment in American jurisprudence.⁶² As the modern Supreme Court stated in *Knox v. Service Employees International Union*, “The First Amendment creates ‘an open marketplace’ in which differing ideas . . . can compete freely for public acceptance without improper government interference.”⁶³

The Court has understood this theory not only to protect an individual’s right to speak, but as a collective imperative to safeguard a free marketplace of ideas. In *Bose Corp. v. Consumers Union*, the Court declared, “The First Amendment presupposes that the freedom to speak one’s mind is not only an aspect of individual liberty—and thus a good unto itself—but also is essential to the common quest for truth and the vitality of society as a whole.”⁶⁴ Marketplace theory entails both an individual’s ability to participate in the marketplace and the societal value of the market’s preservation.⁶⁵

Marketplace theory informs the *Zacchini* court’s attempts to reconcile the news station’s speech rights with *Zacchini*’s economic rights. The news station’s First Amendment right to disseminate information implicates core protected speech.⁶⁶ A sprawling, productive marketplace of ideas requires broad freedom to engage in such speech.⁶⁷ However, the government’s interest in protecting *Zacchini*’s likeness also implicates First Amendment values. As explained by the Court in *Brown*, entertainment such as *Zacchini*’s act has great value in the marketplace.⁶⁸ After all, “one man’s amusement, teaches another’s doctrine.”⁶⁹ And as explained by the Court in *Zacchini*, the public’s ability to have access to expression that requires personal investment to develop, such as *Zacchini*’s act, depends on preservation of the economic incentives promoting such

60. See, e.g., Stanley Ingber, *The Marketplace of Ideas: A Legitimizing Myth*, 1984 DUKE L.J. 1, 1 (1984).

61. See 1 SMOLLA, *supra* note 41, § 2:21.

62. *Id.* § 2:15

63. *Knox v. Serv. Emps. Int’l Union, Local 1000*, 132 S. Ct. 2277, 2288 (2012) (quoting *N.Y. State Bd. of Elections v. Lopez Torres*, 552 U.S. 196, 208 (2008)).

64. *Bose Corp. v. Consumers Union of U.S., Inc.*, 466 U.S. 485, 503–04 (1984).

65. *Id.*

66. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578 (1977).

67. *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 270 (1964) (recognizing “a profound national commitment to the principle that debate on public issues should be uninhibited, robust, and wide-open”).

68. *Brown v. Entm’t Merchs. Ass’n*, 131 S. Ct. 2729, 2733 (2011).

69. *Id.* (quoting *Winters v. New York*, 333 U.S. 507, 510 (1948)).

investment.⁷⁰ Although Zacchini’s personal right of publicity claim is based on a property right, not a speech right, the foundation of the right of publicity is the public interest in protecting the marketplace of ideas. The right of publicity is a means to this end.

V. THE RIGHT OF PUBLICITY TESTS

Since *Zacchini*, courts have taken many approaches to evaluate the constitutionally permissible scope of the right of publicity. The Third Circuit in *Hart* and the Ninth Circuit in *In re NCAA* discussed three tests: the Predominant Use Test, the Rogers Test, and the Transformative Use Test.⁷¹ The Predominant Use Test and the Rogers Test focus on the distinction between commercial and expressive uses of a person’s likeness.⁷² Although they have different analyses, the tests seek to determine whether the likeness is being appropriated for commercial use, which may be restricted by a right of publicity claim, or expressive use, which is privileged against such claims.⁷³ The Transformative Use Test, applied in *Hart* and *In re NCAA*, takes the commercial or expressive nature of the use into account, but does not make this distinction dispositive.⁷⁴ Instead, the test borrows a concept from copyright law, asking whether the likeness is just one of the “raw materials” of the expression or “the very sum and substance of the work.”⁷⁵ Each of these tests, upon a careful reading, is inconsistent with the interests that animate the right of publicity doctrine as the U.S. Supreme Court defined it in *Zacchini*.

A. *Predominant Use Test*

The Predominant Use Test, as announced in *Doe v. TCI Cablevision*, focuses on whether the use of a likeness is commercial

70. *Zacchini*, 433 U.S. at 576.

71. *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 153 (3d Cir. 2013); *Keller v. Elec. Arts, Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig.)*, 724 F.3d 1268, 1273 (9th Cir. 2013).

72. *See Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (en banc); *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989).

73. *TCI Cablevision*, 110 S.W.3d at 373.

74. *See Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001) (“We ask . . . 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.”).

75. *Id.*

or expressive.⁷⁶ The Supreme Court of Missouri wrote that “the threshold legal question [is] whether the use of a person’s name and identity is ‘expressive,’ in which case it is fully protected, or ‘commercial,’ in which case it is generally not protected.”⁷⁷ This means that use of a likeness in “news, entertainment, and creative works for the purpose of communicating information or expressive ideas” is highly protected while use in “advertising goods or services or . . . merchandise, is rarely protected.”⁷⁸

The court argued that this Predominant Use Test would best address the issues arising where speech has both expressive and commercial elements.⁷⁹ Courts applying this test are asked to determine which type of use, expressive or commercial, predominates. A product “that predominantly exploits the commercial value of an individual’s identity” is not protected, while a product that predominantly “make[s] an expressive comment on or about a celebrity,” is protected.⁸⁰

Although the distinction between commercial and non-commercial use is a useful one, the court provided little guidance as to how to define which use predominates. Beyond this, the court never attempted to reconcile its pronouncement that expressive use, such as a newscast, is protected with the *Zacchini* decision, which found that a newscast was not protected.⁸¹ The court’s narrow focus on the commercial/expression distinction did not allow for a full consideration of the interests identified in *Zacchini*, including the incentive interest.⁸² In addition, it failed to provide the analytical tools for other courts to make the distinction. Courts are left, essentially, to weigh the expressive value provided by the use, which

76. *TCI Cablevision*, 110 S.W.3d at 373–74.

77. *Id.* at 373.

78. *Id.*

79. *Id.* at 374.

80. *Id.*

81. *See id.* at 373; *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 569–79 (1977) (holding that the First and Fourteenth Amendments did not protect a newscast that displayed a performer’s entire act, as opposed to a newscast that merely reported he was performing or described the act). In fact, one treatise described the Missouri Supreme Court as “[e]ssentially holding that the Supreme Court did not really mean what it said.” MARK LEE, ENTERTAINMENT AND INTELLECTUAL PROPERTY LAW § 17:21, Westlaw (database updated Aug. 2015).

82. *See TCI Cablevision*, 110 S.W.3d at 373; *see also* Jordon M. Blake, No Doubt About It—You’ve Got to Have Hart: Simulation Video Games may Redefine the Balance Between and Among the Right of Publicity, the First Amendment, and Copyright Law, 19 B.U.J. SCI. & TECH. L. 26, 42 (2013) (“The court discussed *Zacchini*, observing that its holding is very narrow and should only be applied in situations analogous to having one’s entire act appropriated.”).

Justice Scalia would likely call a “difficult” and “dangerous” standard on which to rely to discern what speech the Constitution protects.⁸³ Few federal courts have endorsed the Predominate Use Test.⁸⁴

B. Rogers Test

In *Rogers v. Grimaldi*, the Second Circuit introduced what later courts refer to as the *Rogers Test*.⁸⁵ The claim centered on a celebrity duo, Ginger Rogers and Fred Astaire, whose likenesses Rogers claimed had been appropriated by “the use of the title ‘Ginger and Fred’ for a fictional movie that only obliquely relate[d] to Rogers and Astaire.”⁸⁶ The *Rogers Test*, like the Predominant Use Test, focuses mainly on the commercial/expressive distinction.

The court recognized that in reference to celebrities, “prominence invites creative comment.”⁸⁷ Because of the expressive value of such comment, the court crafted a narrow test.⁸⁸ The *Rogers Test* would protect expression from right of publicity claims unless the likeness was “wholly unrelated” to the expression or was “simply a disguised commercial advertisement for the sale of goods or services.”⁸⁹ It asks whether the appropriation of the likeness is a genuine part of the expressive content or a commercial attempt to add value to an existing expression through use of the likeness.⁹⁰ The court found that the title was related to the content of the movie and was not a disguised advertisement, and thus was protected by the First Amendment.⁹¹

83. *Brown v. Entm’t Merchs. Ass’n*, 131 S. Ct. 2729, 2733 (2011).

84. *See, e.g., Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 153–54 (3d Cir. 2013) (rejecting the Predominant Use test and adopting the Transformative Use Test); LEE, *supra* note 81 (stating that a Missouri federal court disregarded *TCI Cablevision* and applied a balancing test instead).

85. *See Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); *see also, e.g., Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013) (referencing the Second Circuit’s creation of the *Rogers Test*); *Parks v. LaFace Records*, 329 F.3d 437, 451–52 (6th Cir. 2003) (applying the *Rogers Test*).

86. *Rogers*, 875 F.2d at 996.

87. *Id.* at 1004 (quoting *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 460 (Cal. 1979) (Bird, C.J., concurring)).

88. *See id.* at 999, 1004–05.

89. *Id.* at 1004 (first quoting *Guglielmi*, 603 P.2d at 457 n.6; then quoting *Frosch v. Grosset & Dunlap, Inc.*, 427 N.Y.S.2d 828, 829 (App. Div. 1980)).

90. *See id.* at 1004–05.

91. *Id.*

The court limited the analysis to the facts at issue, a celebrity's likeness being invoked in a title. It made no attempt to square the decision with *Zacchini* or examine how it would be applied in other fact patterns. Although the test is perhaps sufficient to analyze this narrow fact pattern, it became problematic as later courts applied it in other cases.

The Sixth Circuit applied the *Rogers* Test in *Parks v. LaFace Records*.⁹² Civil rights leader Rosa Parks brought an action against rap group Outkast for appropriation of her likeness in the song *Rosa Parks*.⁹³ Though the song was not about Parks or the civil rights movement, the song advised competing rappers and MCs to “move to the back of the bus.”⁹⁴ Outkast claimed that Rosa Parks' name is a metaphor for the action that she made famous: refusing to “move to the back of the bus.”⁹⁵

The court applied the *Rogers* Test and concluded, “in the context of the lyrics . . . the phrase [‘move to the back of the bus’] has absolutely nothing to do with Rosa Parks.”⁹⁶ Simply, the court did not believe that there was an artistic motivation for naming the song *Rosa Parks*, but instead found it was chosen to “enhance[] the song's potential sale to the consuming public.”⁹⁷ The court denied that “the symbol of Rosa Parks, a symbol of ‘freedom, humanity, dignity, and strength,’ is artistically related to the content of a song that appears to be diametrically opposed to those qualities.”⁹⁸ In other words, the First Amendment did not protect this speech because the court either does not understand or does not approve of the metaphor. The court even helpfully suggested that a different title, “*Back of the Bus*, for

92. 329 F.3d 437, 450 (6th Cir. 2003).

93. *Id.* at 441.

94. *Id.* at 442–43 (quoting OUTKAST, *Rosa Parks*, on AQUEMINI (LaFace Records 1998)).

95. *Id.* at 452.

96. *Id.* at 452 (emphasis omitted). The name is used as short hand for a concept, or concepts, as a variety of names are. Famous names become part of language, and some people must be the first to use the metaphor. Names like Einstein or Shakespeare even become so associated with a definition that they are commonly invoked sarcastically to mean the opposite of their namesake's qualities. The court's reasoning would conclude that any song not about theoretical physics or English literature could violate these famous individual's right of publicity.

97. *Id.* at 453.

98. *Id.* at 456. The Court dismisses Outkast's invocation of Parks, concluding that “[w]hile Defendants' lyrics contain profanity and a great deal of ‘explicit’ language . . . they contain absolutely nothing that could conceivably, by any stretch of the imagination, be considered, explicitly or implicitly, a reference to courage, to sacrifice, to the civil rights movement or to any other quality with which Rosa Parks is identified.” *Id.* at 453.

example,” would better communicate the artist’s message.⁹⁹ This type of evaluation flies in the face of the First Amendment truism that judges should not make “esthetic and moral judgments about art and literature.”¹⁰⁰

This disturbing judicial scrutiny applied to artistic choices is a product of the failures of the *Rogers* Test. The test fails to place the incentive interest at the center of analysis. It is not clear how Outkast’s use of Parks’ name would alter the economic incentives of Parks or those similar to her. *Zacchini* firmly established that the right of publicity is not a reputational right.¹⁰¹ If Parks believed the song defamed, slandered, or otherwise damaged her reputation, other causes of action could be pursued. The right of publicity protects against appropriation to promote individual investment, not against artistic invocation of a famous name for a purpose the likeness holder happens to disagree with.

C. *Transformative Use Test*

The Transformative Use Test was introduced in *Comedy III Productions, Inc., v. Gary Saderup, Inc.*¹⁰² The estates of the famous comedy trio The Three Stooges brought an action against an artist who produced T-shirts featuring charcoal drawings of The Three Stooges.¹⁰³ The parties stipulated that the shirts did not “constitute an advertisement, endorsement, or sponsorship of any product,” but the plaintiffs claimed that the First Amendment nonetheless did not protect the shirts against the right of a publicity claim.¹⁰⁴

The California Supreme Court applied what later courts would call the Transformative Use Test, which analogizes right of publicity to copyright law, borrowing part of the Fair Use Doctrine.¹⁰⁵ The test asks courts to determine whether the challenged work has “so transformed [the likeness] that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.”¹⁰⁶ This is determined by evaluating “whether the celebrity likeness is one of the ‘raw materials’ from which an original work is

99. *Id.* at 453.

100. *Brown v. Entm’t Merchs. Ass’n*, 131 S. Ct. 2729, 2733 (2011) (quoting *United States v. Playboy Entm’t Grp., Inc.*, 529 U.S. 803, 818 (2000)).

101. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

102. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 799 (Cal. 2001).

103. *Id.* at 800–01.

104. *Id.* at 801.

105. *Id.* at 808.

106. *Id.* at 809.

synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.”¹⁰⁷

The California Supreme Court identified many interests that underlie right of publicity. The court spent significant time examining the First Amendment interests at stake and recognized the important expression that the use of famous likenesses can contribute.¹⁰⁸ It acknowledged that the theory of the First Amendment requires protections “‘to preserve an uninhibited marketplace of ideas’ and to repel efforts to limit ‘uninhibited, robust and wide-open’ debate on public issues.”¹⁰⁹

The court reasoned that “when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity.”¹¹⁰ The court described the Transformative Use Test as comporting with many of the values established by the U.S. Supreme Court in *Zacchini* and *Brown*. Because “courts are not to be concerned with the quality of the artistic contribution,”¹¹¹ the test’s inquiry is “more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.”¹¹² This attempt to avoid judicial value judgments of expressive content is laudable and necessary to comport with *Brown*.

The court’s application of the Transformative Use Test had many strengths. It identified the incentive interest for right of publicity established by *Zacchini*.¹¹³ It explicated the strong First Amendment protections even as applied to “nontraditional media of expression.”¹¹⁴ It recognized the dangers of judicial value assessments of expression and attempted to create a framework that avoids such assessments.¹¹⁵

One major weakness of the Transformative Use Test is that it does not provide a clear framework for making the “‘commonsense’

107. *Id.*

108. *Id.* at 802–04.

109. *Id.* at 803 (quoting *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 458 (Cal. 1979) (Bird, C.J., concurring)).

110. *Id.* at 808.

111. *Id.* at 809.

112. *Id.*

113. *Id.* at 808 (citing *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977)).

114. *Id.* at 804.

115. *Id.* at 809 (“[C]ourts are not to be concerned with the quality of the artistic contribution . . .”).

distinction¹¹⁶ between commercial and noncommercial speech. Although some of the analysis seems to assume that commercial speech would be due lesser protection,¹¹⁷ the California Supreme Court never made clear how the operation of the test achieves that end. The failure to make this distinction makes it more difficult to identify expression the First Amendment protects from right of publicity claims, because the Supreme Court has found that the protections due noncommercial speech are different, and greater, than commercial speech.¹¹⁸

A second major weakness is that although the *Comedy III Products* court identified the important interests of the doctrine, the test fails to precisely focus on them. As to the scope of protection, the California Supreme Court found that the right of publicity should protect against “production of conventional, more or less fungible, images of the celebrity.”¹¹⁹ The idea of a “more or less fungible” use of a likeness in many ways cuts to the core of questions about transformative use.¹²⁰ The court was asking, Did the expression appropriate the likeness in a way that could more or less have been made by someone else? Or did the expression require creative investment that transformed it into a valuable contribution in the marketplace of ideas?¹²¹ These questions are paramount. In evaluating close calls and tough factual scenarios, it is indispensable to understand the values fundamental to these questions. However, courts applying the Transformative Use Test have focused on the transformative nature of the use as an end in itself.¹²² The transformative nature of expression is just a proxy, and not the only one, for whether the public will be deprived of a creative contribution if the expression is restricted. The central question is, Was the use transformative, *thereby making it a distinct contribution to the marketplace of ideas?*¹²³

116. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 562 (1980) (quoting *Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 455–56 (1978)).

117. *See Comedy III Prods., Inc.*, 21 P.3d at 803.

118. *Cent. Hudson*, 447 U.S. at 562–63 (citing *Ohralik*, 436 U.S. at 456).

119. *Comedy III Prods., Inc.*, 21 P.3d at 808.

120. *Id.*

121. *Id.* at 809.

122. *See, e.g., Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 163 (3d Cir. 2013) (“[T]he Transformative Use Test maintains a singular focus on whether the work sufficiently transforms the celebrity’s identity or likeness . . .”).

123. *See Comedy III Prods., Inc.*, 21 P.3d at 811 (explaining how Andy Warhol’s “distortion and . . . careful manipulation of context” in his silkscreens of celebrities

The weaknesses of this test become clearer when applied in later cases. The *Hart* and *In re NCAA* cases demonstrate how a generally well-constructed test that recognizes the interests of the doctrine can lead to unpredictable and dangerous conclusions because of a failure to focus precisely and consistently on the proper values.¹²⁴

VI. THE TRANSFORMATIVE USE TEST IN *HART* AND *IN RE NCAA*

Hart and *In re NCAA* were right of publicity cases that presented “materially identical” legal challenges, according to the Ninth Circuit.¹²⁵ The principal plaintiffs in the cases were former Rutgers University quarterback Ryan Hart in *Hart* and former Nebraska University quarterback Samuel Keller in *In re NCAA*.¹²⁶ Both were featured in EA’s football video game series *NCAA Football*.¹²⁷ In these cases, the Third and Ninth Circuits applied the Transformative Use Test, finding that the First Amendment did not, as a matter of law, protect defendant EA’s expression.¹²⁸ These two cases created the legal environment in which EA settled with the plaintiff class of former NCAA athletes for a reported \$40 million.¹²⁹ Though this case has settled, the larger question remains: when can content creators use a person’s likeness without compensation? Evaluating the analysis from these two cases reveals that the outcomes in *Hart* and *In re NCAA* are unacceptable in two ways. First, the decisions failed to properly identify and apply the interests identified by the Supreme Court in *Zacchini*. Second, the muddled analysis, and disagreement amongst the judges in the same circuits, left artists and content creators with little guidance as to when the First Amendment protects their work from a right of publicity suit. As explored further below, this lack of clarity is damaging to First Amendment expression and counter to the values of the right of publicity doctrine.

In *Hart*, the Third Circuit wrote that “the Transformative Use Test maintains a *singular focus on whether the work sufficiently*

created transformative expressions that surpassed a mere reproduction of celebrity portraits).

124. See *Hart*, 717 F.3d at 170; Keller v. Elec. Arts, Inc. (*In re NCAA Student-Athlete Name & Likeness Licensing Litig.*), 724 F.3d 1268, 1283–84 (9th Cir. 2013).

125. *In re NCAA*, 724 F.3d at 1278 (citing *Hart*, 717 F.3d. at 141); see also *Hart*, 717 F.3d at 163 n.28 (“*Keller* is simply [*Hart*] incarnated in California.”).

126. *Hart*, 717 F.3d at 145; *In re NCAA*, 724 F.3d at 1271.

127. *Hart*, 717 F.3d at 146; *In re NCAA*, 724 F.3d at 1271.

128. *Hart*, 717 F.3d at 170; *In re NCAA*, 724 F.3d at 1276, 1284.

129. Eder, *supra* note 7.

transforms the celebrity's identity or likeness."¹³⁰ Right of publicity tests, including the Transformative Use Test, are a means to the end of balancing the property interests and speech interests at stake. By creating a "singular focus" on transformative use,¹³¹ the *Hart* and *In re NCAA* courts failed to ask the deeper and more important question: Does restricting the expression serve to incentivize likeness holders without denying creative and unique speech access to the marketplace of ideas? Transformative use is one way of answering this question, but "singular focus" on the transformative nature of use leads to a predictable conclusion: a failure to serve the interests of the doctrine.

The courts' analyses reveal the consequences of this problematic focus. The *Hart* court concluded that the video game's use of Hart's likeness was not transformative for several reasons. First, the game strived for realism both in Hart's appearance and in the situations in which he appears. In other words, "[t]he digital Ryan Hart does what the actual Ryan Hart did while at Rutgers: he plays college football."¹³² In addition, the games will appeal to the fans of a player's university, implying that the realism is the value of the expression.¹³³ The *In re NCAA* court analogized to *Comedy III Products*, reasoning that like the drawings in that case, making the video games required "undeniable skill" but that skill is "manifestly subordinated to the overall goal of creating literal, conventional depictions" of Keller.¹³⁴ Addressing the argument that the likeness is but a small part of a creative and transformative whole, the court declared that "the Transformative Use Test invariably look[s] to how the *celebrity's identity* is used."¹³⁵ Creative elements are transformative only to the extent that they affect the depiction of a celebrity likeness.

The courts' analyses that the use was not transformative are problematic in a few ways. The dissents in each case identified one issue by pointing out the danger of the majorities' reasoning applied more broadly. The dissent in *In re NCAA* concluded that "[t]he

130. *Hart*, 717 F.3d at 163 (emphasis added).

131. *Id.*

132. *Id.* at 166. The Ninth Circuit applied the same reasoning. See *In re NCAA*, 724 F.3d at 1279 ("*NCAA Football* realistically portrays college football players in the context of college football games . . .").

133. *Hart*, 717 F.3d at 168.

134. *In re NCAA*, 724 F.3d at 1278 (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001)).

135. *Hart*, 717 F.3d at 169.

logical consequence of the majority view is that all realistic depictions of actual persons, no matter how incidental, are protected by a state law right of publicity regardless of the creative context.”¹³⁶ Because, under *Brown*, video games receive the same First Amendment protection as, for instance, books or film, the majority analysis would restrict many expressive works traditionally thought to be protected by the First Amendment.¹³⁷

Another issue is the reliability of the analysis to produce predictable results. Where speakers would be likely to self-censor due to concerns that their speech would be “in or near the uncertain reach of” a law, “[t]he Constitution gives significant protection from overbroad laws that chill speech.”¹³⁸ The First Amendment requires that speakers know when their speech is prohibited.¹³⁹ Although this interest may be slightly lessened in the civil area, it is important nonetheless. It is important to note that each of these cases contained strong dissents, not only finding that EA’s expression should be protected, but also explaining the dangers of the majorities’ reasoning.¹⁴⁰ This vast disparity between judges applying the same test speaks to the lack of clarity that the Transformative Use Test provides.

Another aspect of the *Hart* majority opinion demonstrated the unpredictable results of Transformative Use Test analysis. In addition to the animated depiction of Hart featured in *NCAA Football 2006*, a picture of Hart was used in an introductory montage in *NCAA*

136. *In re NCAA*, 724 F.3d at 1290 (Thomas, J., dissenting).

137. *Id.* (“This logic jeopardizes the creative use of historic figures in motion pictures, books, and sound recordings. Absent the use of actual footage, the motion picture *Forrest Gump* might as well be a box of chocolates. Without its historical characters, *Midnight in Paris* would be reduced to a pedestrian domestic squabble. The majority’s holding that creative use of realistic images and personas does not satisfy the Transformative Use Test cannot be reconciled with the many cases affording such works First Amendment protection.”).

138. *Ashcroft v. Free Speech Coal.*, 535 U.S. 234, 244 (2002).

139. See Kevin Francis O’Neill, *A First Amendment Compass: Navigating the Speech Clause with a Five-Step Analytical Framework*, 29 Sw. U. L. REV. 223, 278–82 (2000).

140. See *In re NCAA*, 724 F.3d at 1289 (Thomas, J., dissenting) (“[A]n individual college athlete’s right of publicity is extraordinarily circumscribed and, in practical reality, nonexistent.”); *Hart*, 717 F.3d at 175–76 (Ambro, J., dissenting) (“I sympathize with the position of Hart and other similarly situated college football players, and understand why they feel it is fair to share in the significant profits produced by including their avatar likenesses into EA’s commercially successful video game franchise. I nonetheless remain convinced that the creative components of *NCAA Football* contain sufficient expressive transformation to merit First Amendment protection.”).

Football 2009.¹⁴¹ However, unlike the depiction in the video game, the court found that “the context of [Hart’s] photograph—the montage—imbues the image with additional meaning beyond simply being a representation of the player.”¹⁴² The court almost inexplicably concluded that an animation of Hart, drawn and animated by designers, placed into an interactive, meticulously designed virtual world, is a “literal” depiction of Hart and thus unworthy of First Amendment protection, while a photograph of Hart, shown in a montage with other football players, had been transformed to be predominately the creative expression of its designers.¹⁴³ This reveals a major problem with the majority’s reasoning. The test is not focused enough to provide consistent application.

When applied to a more traditional form of expression, for instance, a documentary, the First Amendment issues with this application may become clearer. The *Hart* majority insisted that the test would preserve “already-existing First Amendment protections” for “documentaries . . . and other expressive works depicting real-life figures.”¹⁴⁴ One can certainly imagine a documentary, rather than a video game, about college football featuring depictions of Hart. The documentary would, of course, strive for realism, and would likely appeal to college football fans. It would depict Hart participating in the very activity for which he gained prominence: playing football for Rutgers. The depictions of Hart would be literal depictions, perhaps the popular documentary style of a camera panning across an image as a voiceover makes description or commentary. It is simply not clear why any of these uses are more transformative than the video game at issue in *Hart*. The court’s explanation of the Transformative Use Test implies and explicitly identifies traditional expressive works that would be protected,¹⁴⁵ but the logical operation of the test reveals

141. *Hart*, 717 F.3d at 176 n.9.

142. *Id.* at 170 (citing *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 938 (6th Cir. 2003)).

143. *Id.* (“We therefore hold that *NCAA Football 2004*, *2005*, and *2006* games at issue in this case do not sufficiently transform [Hart’s] identity to escape the right of publicity claim [W]e do hold that the only apparent use of [Hart’s] likeness in *NCAA Football 2009* (the photograph) is protected by the First Amendment”). *But see id.* at 170 n.47 (“In finding that *NCAA Football* failed to satisfy the Transformative Use Test, we do not hold that the game loses First Amendment protection. We merely hold that the interest protected by the right of publicity in this case outweighs the Constitutional shield.”).

144. *Id.* at 165 (Ambro, J., dissenting) (quoting *id.* at 173).

145. *See id.*

little distinction between those works and the video game the court found to be outside the scope of First Amendment protection.

Such vexing and amorphous analysis is among the many reasons that the Transformative Use Test is unacceptable. Despite the Supreme Court's deep reservations about judicial decisions on the expressive value of an expressive work,¹⁴⁶ this is ultimately what the Transformative Use Test leads to. As the *Hart* court ironically pointed out in reference to the Predominant Use Test, where courts are asked "to analyze select elements of a work to determine how much they contribute to the entire work's expressiveness," the result is "subjective at best, [and] arbitrary at worst."¹⁴⁷ However, the court's analysis asked whether "imitative" or "creative" elements predominate a work, requiring, as the court pointed out about the Predominant Use Test, a value-laden analysis of the degree of expressiveness.¹⁴⁸ The intuition of a judge about the creative value of protected speech should never be the line between protected and unprotected speech: between that which will reach and that which will be restricted from the marketplace of ideas.

VII. A PROPOSAL: A TWO-TIERED TEST

A fundamental complication within right of publicity doctrine is that there are two different problems to be confronted. The tests examined above generally failed to parse these two issues. The Predominant Use Test and *Rogers* Test largely focused on how to differentiate commercial and expressive content.¹⁴⁹ The Transformative Use Test focused on how to determine whether the use was sufficiently expressive to justify its use of a person's likeness.¹⁵⁰ The problem, then, is that these tests attempt to separate

146. See, e.g., *Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729, 2733 (2011).

147. *Hart*, 717 F.3d at 154.

148. *Id.* at 159 ("The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work." (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001))).

149. *Id.* at 154 ("If a product . . . exploits the commercial value of an individual's identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some 'expressive' content in it that might qualify as 'speech' in other circumstances." (quoting *Doe v. TCI Television*, 110 S.W.3d 363, 374 (Mo. 2003))).

150. *Comedy III Prods., Inc.*, 21 P.3d at 809 ("Another way of stating the inquiry is whether the celebrity likeness is one of 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product

commercial from non-commercial speech, while balancing First Amendment interests of the speaker and property interests of the likeness holder. As that sentence perhaps demonstrates, this approach is destined to result in muddled analysis that does not squarely confront the issues.

A two-tiered approach to the right of publicity simplifies the analysis by separating the issues. First, is the expression commercial? If so, the appropriation is likely not protected by the First Amendment.¹⁵¹ If the expression is noncommercial, then a balancing test of the interests identified in *Zacchini* should be applied.¹⁵² The test should balance the degree to which protection of the right of publicity will protect the economic incentive of the claimant to develop his skill against the degree to which the public will be deprived of the expression that is at issue.¹⁵³

A. *Step One: Commercial Expression*

The Supreme Court has long recognized an intermediate level of protection for commercial speech.¹⁵⁴ There are several reasons for this. First, the “truth of commercial speech . . . may be more easily verifiable by its disseminator” because the speaker “presumably knows more . . . than anyone else,” “about a specific product or service that he himself provides.”¹⁵⁵ Additionally, commercial speech does not necessarily operate like other speech in the marketplace of ideas. Generally, commerce transactions are brief and episodic. Consumers, who must make short-term decisions on products and service with limited information, may not have time for

containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.”).

151. Because this paper has not carefully examined analysis applied to commercial expression, it will not propose a test for such cases. Although some have argued that commercial appropriation of a likeness is due no First Amendment protection, this is a topic for further research. *See, e.g., Lane v. Random House, Inc.*, 985 F. Supp. 141, 147 (D.D.C. 1995).
152. *Hart*, 717 F.3d at 152–53 (“In the wake of *Zacchini*, courts began applying a balancing inquiry to resolve cases where a right of publicity claim collided with First Amendment protections. While early cases approached the analysis from an ad hoc perspective, courts eventually began developing standardized balancing frameworks.” (citation omitted)).
153. *See Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575–76 (1977).
154. *See, e.g., Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 573 (1980) (Blackmun, J., concurring).
155. *Va. Bd. of Pharm. v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771 n.24 (1976).

the “sifting and winnowing” of ideas to take place.¹⁵⁶ As Justice Stevens wrote, “[t]he evils of false commercial speech, which may have an immediate harmful impact on commercial transactions,” justify greater regulation.¹⁵⁷ And finally, commercial speech is less likely to be “chilled” because of the strong economic incentives of the speakers.¹⁵⁸ For these same reasons, it is imperative to make this distinction in right of publicity cases.

Although courts in right of publicity cases have generally recognized that commercial expression is deserving of less First Amendment protection, they have not defined or evaluated commercial expression consistently. To give clarity and consistency to the test, the initial step in right of publicity analysis should be a determination of whether the expression is commercial.

In *Dryer v. National Football League*, former professional football players sought compensation for use of their likenesses in highlight films.¹⁵⁹ On a motion for judgment on the pleadings, the federal district court declared that the “threshold inquiry [was] whether the films [were] . . . expressive works entitled to the highest protection under the First Amendment, or commercial speech entitled to less protection.”¹⁶⁰ The court acknowledged that defining commercial speech with precision had challenged courts, and that the U.S. Supreme Court “commented on ‘the difficulty of drawing bright lines that will clearly cabin commercial speech in a distinct category.’”¹⁶¹ However, the court applied the test designed by the Eighth Circuit in *Porous Media Corp. v. Pall Corp.*,¹⁶² which was derived from the factors enumerated by the Supreme Court in *Bolger v. Youngs Drug Products Corp.*¹⁶³

The three-part *Porous Media Corp.* test concludes that expression is commercial where:

1. It is an advertisement;
2. It refers to a specific product or service; and

156. THEODORE HERFURTH, SIFTING AND WINNOWING (1948), *reprinted in* ACADEMIC FREEDOM ON TRIAL 58, 59 (W. Lee Hansen ed., 1998).

157. *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 496 (1995) (Stevens, J., concurring).

158. *Va. Bd. of Pharm.*, 425 U.S. at 771 n.24.

159. *Dryer v. Nat’l Football League*, 689 F. Supp. 2d 1113, 1115 (D. Minn. 2010).

160. *Id.* at 1116.

161. *Id.* at 1117 (quoting *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 419 (1993)).

162. 173 F.3d 1109 (8th Cir. 1999).

163. 463 U.S. 60, 66–67 (1983).

3. The speaker has an economic motivation.¹⁶⁴

The court applied this analysis, ruling that a reasonable fact finder could find that the films were commercial speech, akin to infomercials for the product of NFL football.¹⁶⁵ Thus, the First Amendment did not necessarily protect against the right of publicity claims.

Though this test has similar difficulty drawing bright lines that other commercial speech tests have,¹⁶⁶ it gives courts a sound framework, based on Supreme Court precedent, to evaluate commercial speech. Importantly, this analysis also excludes other considerations and values for right of publicity analysis; at this stage of analysis, a court need only evaluate the commercial nature of the speech. This separation provides greater transparency and clarity in courts' reasoning. This has the potential to lead not only to better reasoned decisions, but also more predictability for parties.

B. Step Two: Protection of Expressive Speech

If a court finds the expression to be noncommercial, it is due full First Amendment protection. Courts should then apply a balancing test of the interests identified in *Zacchini*.¹⁶⁷ This would balance the degree to which protection of the right of publicity will protect the economic incentive of the claimant to develop their skill against the degree to which the public will be deprived of the expression that is at issue.¹⁶⁸

In evaluating these considerations, courts would be wise to borrow many of the considerations developed by courts applying the existing tests. For instance, the degree to which the likeness is transformed will be very instructive in evaluating the degree to which the public would be deprived of the expression. However, this differs from an application of the Transformative Use Test for a few reasons.¹⁶⁹ First, transformative use is just one of the ways that courts may evaluate this consideration. A court could inquire into the degree of

164. *Dryer*, 689 F. Supp. 2d at 1117 (citing *Porous Media Corp.*, 173 F.3d at 1120). The court acknowledges the limitations of the test including that the “Eighth Circuit itself stressed that ‘commercial speech need not originate solely from economic motives.’” *Id.* (quoting *Porous Media Corp.*, 173 F.3d at 1121).

165. *Id.* at 1121.

166. *Id.* at 1117 (quoting *Discovery Network, Inc.*, 507 U.S. at 419).

167. *See Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 577–78 (1977).

168. *Id.* at 576.

169. *See infra* notes 177–79 and accompanying text.

skill necessary to create the expression, giving greater weight to the type of expression that only a few members of society have the ability to contribute. Second, the evaluation of the use's transformative nature is clearly defined as a means, not an end. Rather than courts broadly concluding that "when a work contains significant transformative elements, it is . . . especially worthy of First Amendment protection,"¹⁷⁰ the analysis is explicitly defined by the interests it serves. The transformative nature of the use necessitates greater protection because it is more likely to make a unique contribution to the marketplace of ideas, whereas a simple reproduction would be "more or less fungible."¹⁷¹ Importantly, the test asks courts to evaluate whether the public will have access to the protected expression, not the value of the protected expression.

As applied to *Hart* and *In re NCAA*, this test simplifies the analysis and ultimately brings about a different conclusion than that of the majorities in those cases. As to the first consideration, it is highly dubious that Keller's use as one among thousands of avatars reduced his incentive to develop his football skill and public profile.¹⁷² In addition, there is little to suggest that the appropriation of Keller's likeness would decrease the public's interest in watching him play football. In other words, the video game does not serve as a replacement for watching live football, but rather contributes another aspect of an interest in college football. Those who "play as" the football players in the *NCAA Football* videogame are at least as likely to become more attached to their favorite teams and players and have a greater incentive to watch them play. Zacchini convincingly argued that the filming of his performance could plausibly replace audiences paying to attend, thus threatening the economic value of his show.¹⁷³ No such showing was made in *Hart* or *In re NCAA*, likely because the video game does not serve as an analogous threat to replace the economic value of players' performances. This does not mean that Keller's likeness was not

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

171. *Id.*

172. *See Keller v. Elec. Arts, Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litig.)*, 724 F.3d 1268, 1287–88 (9th Cir. 2013) (Thomas, C.J., dissenting). The *In re NCAA* dissent also expounds upon the truly minor contribution of Keller's likeness to the game. *Id.* at 1288. Keller and Hart were talented players but known mostly among fans of their colleges. The dissent points out that it is exceedingly unclear what value, if any, Keller's individual likeness contributed to the game. *Id.* Additionally, "one could play *NCAA Football* thousands of times without ever encountering a particular avatar." *Id.*

173. *Zacchini*, 433 U.S. at 576.

appropriated. It was. However, when balancing interests, the incentive interest identified by the Supreme Court is quite weak in this case.

The question, then, is whether the First Amendment concerns outweigh this small, but present, interest. This hinges on the degree to which the public will be denied the First Amendment protected speech. The *Hart* court noted the interactivity and the alterability of the avatar as somewhat transformative elements, though ultimately insufficient.¹⁷⁴ Additionally, the scope of the game's virtual world makes the game a technical accomplishment. EA is likely one of the few speakers with the ability to create this interactive, virtual space. Balancing this against the slight incentive interest at stake, a court applying the two-tiered test would likely find EA's expression to be protected by the First Amendment.

VIII. CONCLUSION

The current right of publicity tests are inadequate to contend with the fundamental issues at stake in such cases. These tests must be improved by a focus on two issues. First, commercial and non-commercial speech are due different levels of constitutional protection. To properly make this important distinction, courts should consider this question as a separate analytical step. The Supreme Court has discussed the elements important to this analysis. Based on this discussion, several circuits have adopted a three-part test defining commercial speech.¹⁷⁵ Although this test has been challenged and is subject to limitations, it provides an important starting point for courts to apply a consistent and methodologically clear analysis identifying commercial speech. Courts and scholars will continue to debate the best way to make the commercial versus noncommercial distinction. For the purposes of right of publicity analysis, it is imperative to apply an initial test to separate out core First Amendment protected speech.

Second, a direct focus on the interests identified in *Zacchini* would protect core First Amendment speech and support the values underlying the right of publicity.¹⁷⁶ Courts should balance the degree to which protection of the right of publicity will protect the economic incentive of the claimant to develop their skill against the degree to

174. *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 167–68 (3d Cir. 2013).

175. *See supra* notes 168–71 and accompanying text.

176. *See supra* notes 74–76 and accompanying text.

which the public will be deprived of the expression that is at issue.¹⁷⁷ Although balancing tests will always leave some opening for ambiguity and interpretation, this test will create greater predictability through more transparent analysis. Courts will need to reason through why the decision in a right of publicity case promotes the First Amendment values. This will protect the marketplace of ideas and lead to more coherent and reliable outcomes for parties.

Although *Hart* and *In re NCAA* applied the right of publicity doctrine to the emerging medium of video games, in cases with very sympathetic plaintiffs, these issues merely serve to cloud the right of publicity analysis. The Transformative Use Test and the other existing tests fail to properly weigh the interests identified in *Zacchini* and in doing so, fail to protect core First Amendment expression. The right of publicity is, at root, an attempt to protect the marketplace of ideas. By applying this two-tiered test, courts can enforce right of publicity claims more predictably and with greater respect for the First Amendment values recognized by the Supreme Court.

177. See *supra* notes 74–76 and accompanying text.