

# College Football, Electronic Arts, and the Right of Publicity: Reality-Mimicking Run Amok

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## INTRODUCTION

Manti Te'o sprints out of the tunnel, leading the Notre Dame Fighting Irish back into the second half of the 2013 College Football National Championship Game. Despite trailing the vaunted Alabama Crimson Tide by two touchdowns, the star middle linebacker goads his teammates onward. Inspired by his leadership, Notre Dame rallies from behind to defeat Alabama 34-31 and win the Irish's first National Championship since 1988.

Of course, as any college football fan knows, this sequence of events is a fiction. In reality, on January 7, 2013, Alabama crushed Notre Dame 42-14, continuing the recent dominance of the Southeastern Conference;<sup>1</sup> Notre Dame failed to live up to its media-driven hype;<sup>2</sup> and Manti Te'o was infamously "catfished"<sup>3</sup> by a young man pretending to be his online girlfriend.<sup>4</sup> However, Electronic Arts' ("EA's") videogame, *NCAA Football '13*, allows players to create the fictional scenario described above on any given Saturday. Thousands of gamers purchase EA's product and recreate real-life college football matchups in virtual stadiums using virtual players.<sup>5</sup>

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1. Barret Sallee, *Will SEC Dominate 4-Team College Football Playoff Like It Has Dominated the BCS?*, BLEACHER REPORT (Jan. 8, 2013), <http://bleacherreport.com/articles/1475500-will-sec-dominate-4-team-college-football-playoff-like-it-has-dominated-the-bcs>; see also Reeves Wiedeman, *Big-Boy Football: Alabama Wins*, NEW YORKER (Jan. 8, 2013), <http://www.newyorker.com/online/blogs/sportingscene/2013/01/big-boy-football-alabama-beats-notre-dame.html>.

2. Pat Caputo, *CAPUTO: Notre Dame Was Over-hyped, Not Great on the Field*, PRESS & GUIDE (Jan. 9, 2013), <http://www.pressandguide.com/articles/2013/01/09/sports/doc50eca42de4101477545025.txt>.

3. See *Online Dating Red Flags: Warning Signs of a Catfish*, DR. PHIL, <http://www.drphil.com/articles/article/720> (last visited Apr. 23, 2013) (defining "catfish" as "a person who creates a false online identity in the hopes of luring people into romantic relationships").

4. Tim Goodman, *Manti Te'o, 'Catfish,' Katie Couric, Oprah and the Sports World: Paging Dr. Phil!*, HOLLYWOOD REPORTER (Jan. 24, 2013), <http://www.hollywoodreporter.com/bastard-machine/manti-teo-story-hooks-media-415094>.

5. James Brightman, *EA Sports Sells 700k Copies of NCAA Football in Two Weeks*, INDUSTRY GAMERS (July 26, 2011), <http://www.industrygamers.com/news/ea-sports-sells-700k-copies-of-ncaa-football-in-two-weeks/>; see also *NCAA Football 12 Kicks Off to Record Start at Retail*, ELEC. ARTS (July 26, 2011), <http://investor.ea.com/releasedetail.cfm?releaseid=594113>.

Each year, EA produces a new version of its long-running college football series, *NCAA Football*.<sup>6</sup> EA goes to great lengths to replicate the college game day experience, paying special attention to transforming real-life players into their videogame counterparts.<sup>7</sup> Each videogame character has the same jersey number, height, weight, skin tone, athletic ability, home state, and accessories (helmet, visor, eye black, and wristbands) as the real-life player.<sup>8</sup> Two former college football players, Sam Keller and Ryan Hart, separately sued EA for violating their rights of publicity due to the realistic nature of the game characters. One suit was a California class action titled *Keller v. Electronic Arts, Inc.*,<sup>9</sup> and the other was a New Jersey class action titled *Hart v. Electronic Arts, Inc.*<sup>10</sup> Although EA did not use the players' names in their games, both plaintiffs sought compensation for EA's use of their identifying personal features.<sup>11</sup>

In seeking redress, both Keller and Hart relied on the right of publicity, a common law privilege granting every person control over the commercial use of his identity.<sup>12</sup> EA did not challenge the sufficiency of the players' ability to establish prima facie elements for a right of publicity claim.<sup>13</sup> Instead, EA claimed a First Amendment defense based on the right to free speech.<sup>14</sup>

Courts typically consider videogames expressive works.<sup>15</sup> Thus, *NCAA Football* is an expressive work entitled to First Amendment protection. In both *Keller* and *Hart*, the California and New Jersey courts applied the Transformative Use Test.<sup>16</sup> The test was first introduced by the

6. Lang Whitaker, *With Realism Aplenty, NCAA 12 Football Keeps Pushing Limits*, N.Y. TIMES (July 11, 2011), <http://www.nytimes.com/2011/07/12/sports/ncaafotball/ea-sports-ncaa-football-12-goes-the-extra-yard.html>. EA announced it would not publish the 2014 version of the game due in part to legal concerns. Steve Eder, *E.A. Sports Settles Lawsuit with College Athletes*, N.Y. TIMES (Sept. 26, 2013), [http://www.nytimes.com/2013/09/27/sports/ncaafotball/ea-sports-wont-make-college-video-game-in-2014.html?\\_r=1&](http://www.nytimes.com/2013/09/27/sports/ncaafotball/ea-sports-wont-make-college-video-game-in-2014.html?_r=1&).

7. Jesse Temple, *NCAA 13 Ratings 'Down to a Science'*, FOX SPORTS WIS. (July 2, 2012), [http://www.foxsportswisconsin.com/07/02/12/NCAA-Football-13-ratings-down-to-a-scien/landing\\_badgers.html?blockID=755166](http://www.foxsportswisconsin.com/07/02/12/NCAA-Football-13-ratings-down-to-a-scien/landing_badgers.html?blockID=755166).

8. Steve Wieberg, *Ex-QB Sues NCAA, EA Sports Over Use of Athletes' Likeness*, USA TODAY (May 7, 2009), [http://usatoday30.usatoday.com/sports/college/2009-05-07-keller-ncaa-easports-lawsuit\\_N.htm](http://usatoday30.usatoday.com/sports/college/2009-05-07-keller-ncaa-easports-lawsuit_N.htm).

9. No. C 09-1967 CW 2010, 2010 WL 530108 (N.D. Cal. Feb. 8, 2010). Keller is the former starting quarterback for the Arizona State University football team. *Id.* at \*1.

10. 808 F. Supp. 2d 757 (D.N.J. 2011). Hart is the former starting quarterback for the Rutgers University football team. *Id.* at 761.

11. *Keller*, 2010 WL 530108, at \*1; *Hart*, 808 F. Supp. 2d at 760–61. EA, along with the Collegiate Licensing Company (“CLC”), have settled the anti-trust class action for about \$40 million. Annie Youderian, *Media Groups Root for NCAA in High Court*, COURTHOUSE NEWS SERV. (Nov. 27, 2013), <http://www.courthousenews.com/2013/11/27/63290.htm>.

12. J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1:3 (2d ed. 2012).

13. *Keller*, 2010 WL 530108, at \*3; *Hart*, 808 F. Supp. 2d at 766.

14. *Keller*, 2010 WL 530108, at \*3; *Hart*, 808 F. Supp. 2d at 768.

15. *Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729, 2733 (2011) (“Like the protected books, plays, and movies that preceded them, 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). That suffices to confer First Amendment protection.”).

16. *Keller*, 2010 WL 530108; *Hart*, 808 F. Supp. 2d 757.

California Supreme Court in 2001 and seeks to determine whether a work contains enough new features to move it beyond a literal depiction of the underlying protected persona.<sup>17</sup> Since both courts applied the same test to nearly identical facts, it could reasonably be assumed the courts reached the same outcome. The California court, however, determined that EA's game was not transformative and not entitled to the First Amendment defense,<sup>18</sup> while the New Jersey court ruled that the game was transformative and absolved EA from liability.<sup>19</sup>

So why the discrepancy? There is no simple answer. The right of publicity is complicated because it varies significantly among each state<sup>20</sup> and lacks an established underlying justification.<sup>21</sup> The Transformative Use Test adds to the complexity by directing courts to focus solely on the content of the expression.<sup>22</sup> Focusing on expression forces judges to make subjective decisions, which means the application of the test results in conflicting and unpredictable outcomes.<sup>23</sup> Unpredictability creates a chilling effect at the clearance level<sup>24</sup> and barricades otherwise protected speech behind a wall of uncertainty.<sup>25</sup>

This Article addresses the failure of reality sports videogame makers to compensate the real-life players on whom their games are based. It argues that this unauthorized use of likeness violates the players' right of publicity. The Article therefore proposes a modern legal test—the Reality Mimicking Predominant Use Test—for courts to apply when determining whether a videogame exploits a player's likeness. Under the proposed test, a videogame receives less First Amendment protection if the game's predominant purpose is to mimic reality.<sup>26</sup> Where a videogame is less about

17. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 406–07 (2001).

18. *Keller*, 2010 WL 530108, at \*5.

19. *Hart*, 808 F. Supp. 2d at 787.

20. Talor Bearman, *Intercepting Licensing Rights: Why College Athletes Need A Federal Right of Publicity*, 15 VAND. J. ENT. & TECH. L. 85, 88–89 (2013) (“In the states that do [recognize it], courts enforce the right of publicity under state common law, state statutes, or both. But the law setting out the elements of publicity rights varies greatly from state to state.”).

21. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995); *see also* Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127 (1993).

22. *Comedy III Prods.*, 25 Cal. 4th at 399 (“Nor does the fact that Saderup’s art appears in large part on a less conventional avenue of communications, T-shirts, result in reduced First Amendment protection. As Judge Posner stated in the case of a defendant who sold T-shirts advocating the legalization of marijuana, ‘its T-shirts . . . are to [the seller] what the New York Times is to the Sulzbergers and the Ochs—the vehicle of her ideas and opinions.’”).

23. MCCARTHY, *supra* note 12, § 8:72 (“This ‘transformative’ test is subjective in application, unpredictable in outcome and fraught with ambiguity. Difficulty of application and incertitude of result are the hallmarks of the court’s ‘transformative’ test.”).

24. At the clearance level, an attorney determines whether the particular use of a persona is defensible through fair use or if it requires a license. *See, e.g., Clearance of Rights Basics*, LAW OFFICES OF GREEN & GREEN, <http://greenandgreen.com/lib/clearbas.html> (last visited Apr. 21, 2014).

25. *See* MCCARTHY, *supra* note 12, § 8:9; usfschooloflaw, *McCarthy Symposium Entertainment—Part 2*, YOUTUBE (Mar. 22, 2013), [http://www.youtube.com/watch?v=w6DBRjlc5ZM&list=UUO1Fw4mEyY7l9l\\_ieVHU5uA&index=6](http://www.youtube.com/watch?v=w6DBRjlc5ZM&list=UUO1Fw4mEyY7l9l_ieVHU5uA&index=6) (presentation by Stacey Byrnes at the 2013 USF School of Law McCarthy Institute and Microsoft Corporation Symposium) (“[U]ncertainty about the legal rules governing speech protected by the First Amendment is viewed as having a ‘chilling effect’ on freedom of speech.”).

26. *See Presley v. Russen*, 513 F. Supp. 1339, 1359–60 (D.N.J. 1981) (“Entertainment that is

telling a story and more about mimicking reality, a higher burden is placed on the defendant videogame maker to show a fair use. This standard stems from principles established by the Supreme Court in *Zacchini v. Scripps-Howard Broadcasting Company*,<sup>27</sup> where the Court noted that “the strongest case for a right of publicity [is] . . . the appropriation of the very activity which the entertainer acquired his reputation in the first place.”<sup>28</sup>

The Reality-Mimicking Predominant Use Test proposed later in this Article better balances the strongest rationales for the right of publicity (i.e., preventing unjust enrichment,<sup>29</sup> protecting personal dignity and autonomy,<sup>30</sup> and rewarding moral rights<sup>31</sup> and labor<sup>32</sup>) against free speech interests, placing a premium on predictability and clarity.

Sports videogames seeking to replicate the real-life version of the game typically fall into the reality-mimicking category since fans purchase the games in order to play as their favorite college football teams and stars. A court applying the Reality-Mimicking Predominant Use Test to *Keller* and *Hart* would likely conclude that EA’s First Amendment defense fails because the videogame, while containing expressive elements, is primarily designed to mimic reality. EA’s motto, “[i]f it’s in the game, it’s in the game,” further emphasizes EA’s reality-mimicking intent.<sup>33</sup>

Part I of this Article discusses the background and development of the right of publicity. Part II explains how free speech interests compete against the right of publicity, paying particular attention to the flaws in the Transformative Use Test and comparing it to other balancing tests. Part III describes the Reality-Mimicking Predominant Use Test, applies it to *Keller* and *Hart*, and advocates for its adoption by courts. Part IV compares the right of publicity to trademark law, an area of law where courts look to the

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merely a copy or imitation, even if skillfully and accurately carried out, does not have a significant value as pure entertainment. . . . [The public interest in entertainment] does not give a privilege to appropriate another’s valuable attributes on a continuing basis as one’s own without the consent of the other.”).

27. 433 U.S. 562 (1977).

28. *Id.* at 576 (internal quotation marks omitted).

29. MCCARTHY, *supra* note 12, § 2:2 (“It has been observed that the prevention of unjust enrichment is probably the most common judicial theory in favor of the right of publicity.” (internal quotation marks omitted)).

30. See *Lugosi v. Universal Pictures*, 25 Cal. 3d 813 (1979) (Bird, C.J., dissenting); Diane Leenheer Zimmerman, *Who Put the Right in the Right of Publicity?*, 9 DEPAUL-LCA J. ART & ENT. L. & POL’Y 35, 80 (1998) (“I realize that, when all else is said and done, the reason that publicity rights have such a broad and loyal following is rooted in an intuition about fairness, a sense of the potential for a form of distributive injustice if celebrities cannot demand control over and payment for uses of their attributes.”).

31. See MCCARTHY, *supra* note 12, § 2:1; Roberta Rosenthal Kwall, *Preserving Personality and Reputational Interests of Constructed Personas Through Moral Rights: A Blueprint for the Twenty-First Century*, 2001 U. ILL. L. REV. 151, 158–60 (2001).

32. See DANIEL SOLOVE & PAUL M. SCHWARTZ, *PRIVACY AND THE MEDIA* 212–13 (2008) (“One of the predominant rationales for the right of publicity is that the celebrity, through her labor, creates her persona.”); Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 216 (1954) (linking one’s publicity rights to each individual’s moral right to “the fruit of his labors”); *Zacchini*, 433 U.S. at 576; *Matthews v. Wozencraft*, 15 F.3d 432, 437 (5th Cir. 1994).

33. *EA Sports*, WIKIPEDIA, [http://en.wikipedia.org/wiki/EA\\_Sports](http://en.wikipedia.org/wiki/EA_Sports) (last visited Feb. 1, 2014). This motto has recently been shortened to EA Sport’s present motto: “It’s in the game.” *EA Sports*, ELEC. ARTS, [https://jobs.ea.com/teams/ea\\_sports/](https://jobs.ea.com/teams/ea_sports/) (last visited Feb. 1, 2014).

defendant's intent in certain causes of action to combat attempts at free-riding. Finally, Part V anticipates and refutes potential criticisms of the proposed Reality-Mimicking Predominant Use Test.

## I. BACKGROUND AND DEVELOPMENT OF THE RIGHT OF PUBLICITY

The right of publicity developed out of privacy law.<sup>34</sup> In their seminal 1890 law review article, *The Right to Privacy*, Samuel Warren and Louis Brandeis argued in favor of a common law right of privacy, which they viewed as “a right preventing truthful but intrusive and embarrassing disclosures by the press.”<sup>35</sup>

Over the next few decades, courts broadened Warren's and Brandeis's focus beyond protecting private matters to prohibit the unauthorized use of a person's name and image in advertising.<sup>36</sup> In 1902, a flour company used a young woman's picture without her permission in over 25,000 print advertisements.<sup>37</sup> The woman brought suit, but the New York court rejected her claim because the state did not recognize a right to privacy.<sup>38</sup> The public was outraged by this decision,<sup>39</sup> so, the following year, the New York legislature enacted statutes proscribing a right to control the use of one's identity in advertising.<sup>40</sup> In 1905, Georgia became the first state to embrace the right to privacy in common law.<sup>41</sup> Earlier Georgian cases relied on tort law to protect a person's name and likeness, focusing on the damage to a private citizen's psyche.<sup>42</sup>

Throughout the early 20th century, courts continually dismissed cases brought by famous individuals, where the gravamen shifted from psychological to pecuniary damage.<sup>43</sup> It was thought that celebrities could not suffer indignity or mental distress upon revelation of personal details since their identities were already widely known.

In 1953, the U.S. Court of Appeals for the Second Circuit became the first court to officially recognize the “right of publicity.”<sup>44</sup> In a landmark

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34. See MCCARTHY, *supra* note 12, § 1:4.

35. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890); 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28.3 (4th ed. 2012).

36. MCCARTHY, *supra* note 35, § 28.3.

37. *Roberson v. Rochester Folding Box Co.*, 171 N.Y. 538, 542 (1902).

38. *Id.* at 556.

39. See *Lerman v. Flynt Distrib. Co.*, 745 F.2d 123, 129 (2d Cir. 1984).

40. N.Y. CIV. RIGHTS LAW §§ 50–51 (McKinney 2013) (proscribing the use of “name, portrait, or picture of any living person . . . for advertising purposes, or for the purposes of trade . . . without having first obtained the written consent of such person”).

41. *Pavesich v. New England Life Insurance Co.*, 122 Ga. 190 (1905) (holding that the use of a private citizen's photograph in conjunction with an advertisement violated the new common law tort of the right to privacy).

42. See, e.g., *Fisher v. Murray M. Rosenberg, Inc.*, 23 N.Y.S.2d 677 (N.Y. Sup. Ct. 1940) (awarding \$300 in damages for misappropriation of a well-known dancer's likeness in shoe advertisements).

43. See, e.g., *O'Brien v. Pabst Sales Co.*, 124 F.2d 167 (5th Cir. 1941) (dismissing a famous college football player's privacy claim because he was already famous).

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

decision, the Second Circuit grappled with the question of whether baseball players had a right of publicity that could be exclusively licensed away.<sup>45</sup> Answering in the affirmative, the court paid special attention to the pecuniary damage celebrities would suffer without such a remedy:

[I]t is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, buses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.<sup>46</sup>

Professor Melville Nimmer also assisted in the right of publicity's transition from tort to property by emphasizing celebrities' desire to control the commercial value of their identities rather than protect against unreasonable intrusion into their privacy.<sup>47</sup> In 1977, the right of publicity arrived for the first and last time at the doors of the Supreme Court.<sup>48</sup> In *Zacchini*, the Court differentiated the right of publicity from other privacy torts, focusing on its underlying purposes of encouraging entertainment and rewarding individuals for their work.<sup>49</sup>

Unsurprisingly, the transition from privacy to publicity, and from tort to property, has not generated a coherent body of law. The right of publicity remains codified on only a state level, with a mere twenty-nine states offering protection through common law, statute, or both common law and statute.<sup>50</sup> Thus, in twenty-one states, a plaintiff with a right of publicity claim remains without legal recourse. Even in the states adopting a right of publicity, the cause of action, scope of protection, duration of protection, statute of limitations, and remedies differ substantially.<sup>51</sup> Some jurisdictions only grant the right of publicity to famous people,<sup>52</sup> while others permit its use by every individual.<sup>53</sup> This state-by-state, quilt-like protection has led many to call for a federal right of publicity statute.<sup>54</sup>

45. *Id.* at 867–68.

46. *Id.* at 868.

47. Nimmer, *supra* note 32, at 203–04 (“Well known personalities connected with these [advertising, motion picture, television, and radio] industries do not seek the solitude and privacy which Brandeis and Warren sought to protect. Indeed, privacy is the one thing they do not want, or need. Their concern is rather with publicity, which may be regarded as the reverse side of the coin of privacy. However, although the well known personality does not wish to hide his light under a bushel of privacy, neither does he wish to have his name, photograph, and likeness reproduced and publicized without his consent or without remuneration to him.” (internal quotation marks omitted)).

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

49. *Id.* at 576–77.

50. *See* Bearman, *supra* note 20, at 85–101.

51. *Id.* at 100.

52. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995) (“[A] few cases appear to require some minimum degree of fame or notoriety as a prerequisite for relief. However, the identity of even an unknown person may possess commercial value.”).

53. *See* MCCARTHY, *supra* note 12, § 1:3 (“The right of publicity is not merely a legal right of the ‘celebrity,’ but is a right inherent to everyone to control the commercial use of identity and persona and recover in court damages and the commercial value of an unpermitted taking.”).

54. For example, in 1998, the International Trademark Association (“INTA”) proposed a federal

## II. RIGHT OF PUBLICITY AND THE FIRST AMENDMENT

In addition to the confusion caused by the varying state laws, First Amendment challenges to the right of publicity have led to a number of disparate tests and subsequent unpredictable results. The First Amendment provides that “Congress shall make no law . . . abridging the freedom of speech.”<sup>55</sup> Free speech is highly valued in the United States because it fosters the exchange of ideas, which is crucial to democratic self-governance.<sup>56</sup> The right of publicity potentially frustrates this purpose because celebrities, who make up the bulk of right of publicity claims,<sup>57</sup> play a large role in our society and are considered essential to common discourse. Professor Michael Madow, a critic of the right of publicity, argues that celebrities are part of the fabric of our culture:

Entertainment and sports celebrities are the leading players in our Public Drama. We tell tales, both tall and cautionary, about them. We monitor their comings and goings, their missteps and heartbreaks. We copy their mannerisms, their styles and their modes of conversation and consumption. Whether or not celebrities are “the chief agents of moral change in the United States,” they certainly are widely used—far more than are institutionally anchored elites—to symbolize individual aspirations, group identities, and cultural values. Their images are thus important expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our cultural business and everyday conversation.<sup>58</sup>

Madow questions the assumption that the right of publicity is a settled matter,<sup>59</sup> arguing instead that the traditional rationales for creating the right fall short of supporting the enforcement of a property-like legal right.<sup>60</sup>

Courts’ attempts at balancing First Amendment interests against other

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right of publicity statute. See *Board Resolutions U.S. Federal Right of Publicity*, INT’L TRADEMARK ASS’N (Mar. 3, 1998), <http://www.inta.org/Advocacy/Pages/USFederalRightofPublicity.aspx>; Bearman, *supra* note 20, at 85.

55. U.S. CONST. amend. I.

56. MCCARTHY, *supra* note 12, §§ 7:3, 8:16, 8:18; *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal. 3d 860, 866 (1979) (“The First Amendment . . . serve[s] ‘to preserve an uninhibited marketplace of ideas’ and to repel efforts to limit the ‘uninhibited, robust and wide-open debate on public issues.’ . . . These rights are essential in a democratic system of government. Free speech is also guaranteed because of our fundamental respect for individual development and self-realization. The right to self-expression is inherent in any political system which respects individual dignity. Each speaker must be free of government restraint regardless of the nature or manner of the views expressed unless there is a compelling reason to the contrary.” (quoting *Red Lion Broad. Co. v. FCC*, 395 U.S. 367, 390 (1969))).

57. See K.J. Greene, *Intellectual Property Expansion: The Good, the Bad, and the Right of Publicity*, 11 CHAP. L. REV. 521, 536–38 (2008); *Fraley v. Facebook*, 830 F. Supp. 2d 785, 809 (N.D. Cal. 2011) (noting that the typical right of publicity case involves advertisers exploiting the commercial value of celebrities) (“While traditionally, advertisers had little incentive to exploit a non-celebrity’s likeness because such endorsement would carry little weight in the economy at large, Plaintiffs’ allegations suggest that advertisers’ ability to conduct targeted marketing has now made friend endorsements ‘a valuable marketing tool,’ just as celebrity endorsements have always been so considered.”).

58. See Madow, *supra* note 21, at 128 (quoting RICHARD SCHICKEL, *INTIMATE STRANGERS: THE CULTURE OF CELEBRITY* 29 (1985)).

59. *Id.* at 127; see also MCCARTHY, *supra* note 12, § 1:34 (“[T]he initial phase of questioning what the right of publicity is, and whether it should exist at all, has passed into history. Most courts accept the existence of the right and concern themselves with polishing its contours as they apply it to a diversity of factual settings.”).

60. See Madow, *supra* note 21, at 134; *infra* Part V.

types of rights have generated a wide variety of tests and legal doctrines. For example, federal copyright law, which arguably shares the right of publicity's incentive rationale,<sup>61</sup> includes a statutory fair use defense that acts as a safe harbor for First Amendment concerns.<sup>62</sup> Trademark law, sharing the right of publicity's concern for protecting against unjust enrichment,<sup>63</sup> also has First Amendment fair use defenses.<sup>64</sup> In the right of publicity context, courts have fashioned a number of tests that attempt to weigh right of publicity interests against free speech concerns.

#### A. THE BALANCING TESTS

Currently, *Zacchini* is the only Supreme Court case to evaluate the right of publicity. In the case, the Court analyzed a unique situation involving the display of Hugo Zacchini's human cannonball act on a local news broadcast.<sup>65</sup> The news station recorded Zacchini's fifteen-second act at a county fair in Ohio and later broadcast it during the eleven o'clock news.<sup>66</sup> Zacchini filed a claim against the television station for, among other things, violating his right of publicity.<sup>67</sup> The Court first noted the differences between privacy and publicity rights, opining that the former focuses on protecting an individual's reputation and mental health, while the latter protects an individual's monetary interests by providing incentives for the creation of entertainment and rewarding the fruits of one's labor.<sup>68</sup>

Applying these principles to the facts, the Court paid particular attention to the adverse economic impact the station's broadcast had on Zacchini's cannonball act:

[I]n this case, Ohio has recognized what may be the strongest case for a "right of publicity"—involving, not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired

61. See MCCARTHY, *supra* note 12, § 2:6.

62. See 17 U.S.C. § 107 (2012). A nonexclusive list of permissible uses of a copyrighted work without obtaining permission from the rights holder include "for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research . . . ." *Id.*

63. Compare *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) ("The rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay." (internal quotation marks omitted)), with Robert C. Denicola, *Institutional Publicity Rights: An Analysis of the Merchandising of Famous Trade Symbols*, 62 N.C. L. REV. 603, 623 (1984) ("Concern with the prevention of unjust enrichment is likewise a basic motivation for the protection of trademarks.").

64. See MCCARTHY, *supra* note 12, §11:45.

65. *Zacchini*, 433 U.S. 562.

66. *Id.* at 563–64.

67. *Id.* at 564.

68. *Id.* at 573 ("[T]he State's interest in permitting a 'right of publicity' is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment. As we later note, the State's interest is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation.").

his reputation in the first place.<sup>69</sup>

The countervailing interest was the station's First Amendment right to free speech—notably, in the strongly-protected news context.<sup>70</sup> Justice White briefly acknowledged the station's right, but held that it could not deprive Zacchini of the commercial fruits of his entertainment act.<sup>71</sup>

After *Zacchini*, courts crafted numerous balancing tests to weigh the right of publicity against First Amendment interests. Among today's most prevalent tests are: (i) the *Rogers* Test, (ii) the Predominant Use Test, and (iii) the Transformative Test.

### 1. The *Rogers* Test

The *Rogers* Test comes from a case involving the popular 1930's and 40's Hollywood musical stars Ginger Rogers and Fred Astaire, often referred to only by their first names: "Ginger and Fred."<sup>72</sup> In 1986, Italian film director Federico Fellini produced and distributed *Ginger and Fred*, a movie about two fictional Italian cabaret performers.<sup>73</sup> The fictional pair called themselves "Ginger and Fred" because their performances mimicked those of Rogers and Astaire.<sup>74</sup>

Rogers brought suit against Fellini, claiming the film violated the Lanham Act and her right of publicity.<sup>75</sup> Weighing Fellini's First Amendment interests in the context of the Lanham Act claim, the Second Circuit applied the "artistic relevance" test:

In the context of allegedly misleading titles using a celebrity's name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.<sup>76</sup>

To balance First Amendment interests with the right of publicity, the *Rogers* court postulated an even broader test: where the use of a person's name in the title of an expressive work is "wholly unrelated" to the underlying work, such that it is "simply a disguised commercial advertisement for the sale of goods or services," the First Amendment defense does not prevail.<sup>77</sup> Applying the test, the court affirmed summary judgment in favor of the defendants, finding the film's title relevant to the content of the movie.<sup>78</sup> Further, the court found that the use of the actors'

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69. *Id.* at 576.

70. *Id.* at 566–67.

71. *Id.* at 578 ("There is no doubt that entertainment, as well as news, enjoys First Amendment protection. It is also true that entertainment itself can be important news. . . . But it is important to note that neither the public nor respondent will be deprived of the benefit of petitioner's performance as long as his commercial stake in his act is appropriately recognized. Petitioner does not seek to enjoin the broadcast of his performance; he simply wants to be paid for it.")

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

73. *Id.* at 996–97.

74. *Id.*

75. *Id.*

76. *Id.* at 999.

77. *Id.* at 1005.

78. *Id.* at 1002–05.

names in the title was not “a disguised advertisement for the sale of goods or services.”<sup>79</sup>

If creating a bright-line test was the end goal, the *Rogers* Test would suffice due to its extremely low requirements. The right of publicity defeats the First Amendment “only when the use is solely commercial and is otherwise unrelated to that person.”<sup>80</sup> Thus, where use of a persona adds no transformative or creative value to the underlying work, and even if the use is only slightly related to the underlying work, the right of publicity claim fails. This test is likely to be popular with content producers because almost any expressive use would insulate them from liability.<sup>81</sup>

There are three major problems with the extremely low threshold created by the *Rogers* Test. First, by favoring the First Amendment over the right of publicity in nearly every expressive scenario, the *Rogers* Test does not adequately account for the right’s strong policy rationales of rewarding moral rights and labor and preventing unjust enrichment.<sup>82</sup>

Second, the *Rogers* Test fails to account for evidence of bad faith to commercially exploit a persona. Use of a person’s likeness might be expressive, commercial, or both. The *Rogers* Test “preclude[s] a cause of action whenever the use of the name and identity is in any way expressive, regardless of the commercial exploitation.”<sup>83</sup>

Finally, applying the *Rogers* Test to the current EA videogame litigation would “turn the right of publicity on its head [because] the very activity by which [Ryan Hart] achieved his renown now prevents him from protecting his hard-won celebrity.”<sup>84</sup> In *Hart*, the U.S. Court of Appeals for the Third Circuit noted that “[b]ecause, as a former college football player, Hart’s likeness is not ‘wholly unrelated’ to *NCAA Football* and the game is not a commercial advertisement for some unrelated product, Hart [would not meet the test].” The Third Circuit concluded that the *Rogers* Test “is a blunt instrument, unfit for widespread application in cases that require a carefully calibrated balancing of two fundamental protections: the right of free expression and the right to control, manage, and profit from one’s own identity.”<sup>85</sup> The Ninth Circuit in *Keller* agreed with the Third Circuit that the *Rogers* Test is not applicable because it is calibrated towards the question of consumer confusion, which is primarily a concern of trademark law, not the right of publicity.<sup>86</sup>

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79. *Id.* at 1004.

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

81. For example, Jeremy Williams, in-house counsel for Warner Brothers Entertainment Group, advocated for the *Rogers* Test during his panel presentation on the Right of Publicity at the USF School of Law McCarthy Institute and Microsoft Corporation Symposium. See usfschooloflaw, *supra* note 25.

82. See *infra* Part V.A for a discussion on Madow’s criticism of the right of publicity.

83. *TCI Cablevision*, 110 S.W.3d at 374.

84. *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 157–58 (3d Cir. 2013).

85. *Id.* at 157.

86. *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268, 1280 (9th Cir. 2013) (“As the history and development of the *Rogers* Test makes clear, it was designed to protect consumers from the risk of consumer confusion—the hallmark element of a Lanham Act claim.”).

## 2. The Predominant Use Test

The Missouri Supreme Court created the Predominant Use Test in a case involving a retired professional hockey player from the National Hockey League (“NHL”).<sup>87</sup> Tony Twist was a known “enforcer”<sup>88</sup> on the Quebec Nordiques and the St. Louis Blues and often fought other teams’ players, which earned him a reputation as a “tough guy.”<sup>89</sup>

Based on Twist’s behavior and reputation, Todd McFarlane, an avid hockey fan and author of the popular comic book series *Spawn*, added a new character to his series named “Anthony ‘Tony Twist’ Twistelli.”<sup>90</sup> McFarlane admitted that he named the fictional Twist, a mafia don who kidnapped children and committed murders, after the real Twist.<sup>91</sup> Twist filed suit, claiming McFarlane misappropriated his name.<sup>92</sup>

The Missouri Supreme Court explicitly disagreed with California’s Transformative Use Test,<sup>93</sup> which offers First Amendment protection “whenever the use of a name is in any way expressive, regardless of the commercial exploitation.”<sup>94</sup> The court instead favored a “predominant use” balancing test:

If a product is being sold that predominantly exploits the commercial value of an individual’s identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some “expressive” content in it that might qualify as “speech” in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.<sup>95</sup>

Applying this new test, the court ruled that McFarlane’s use of Twist’s name was predominantly a ploy to sell more comic books, as opposed to an artistic expression, due in part to McFarlane’s admission to the media and the existence of a marketing campaign targeting hockey games.<sup>96</sup> Accordingly, the court found that Twist’s right of publicity overcame McFarlane’s free speech interests.<sup>97</sup>

According to the Third Circuit in *Hart*, the Predominant Use Test is “subjective at best, arbitrary at worst, and in either case calls upon judges to act as both impartial jurists and discerning art critics.”<sup>98</sup> On appeal, the

87. See *TCI Cablevision*, 110 S.W.3d at 365–66.

88. NHL teams often employ “enforcers” to protect more-skilled teammates from overzealous opponents through intimidation and bare-knuckle fights. Alex Capstick, *Are Ice Hockey ‘Enforcers’ the Toughest Guys in Sport?*, BBC (Feb. 23, 2014), <http://www.bbc.co.uk/news/magazine-16383129>.

89. *TCI Cablevision*, 110 S.W.3d at 366.

90. *Id.*

91. *Id.* at 366–67 (“The Mafia don . . . is named for former Quebec Nordique’s hockey player Tony Twist, now a renowned enforcer (i.e., “Goon”) for the St. Louis Blues of the National Hockey League.”).

92. *Id.* at 365.

93. See *infra* Part II.A.3 for a discussion on the Transformative Use Test.

94. *TCI Cablevision*, 110 S.W.3d at 374.

95. *Id.*

96. *Id.*

97. *Id.* at 374, 376.

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

*Hart* court refused to adopt the Predominant Use Test.<sup>99</sup> The court stated that adopting the test “would be tantamount to admitting that it is proper for courts to analyze select elements of a work to determine how much they contribute to the entire work’s expressiveness.”<sup>100</sup> In addition, the Third Circuit opined that while the Predominant Use Test purports to examine what use the defendant made of a celebrity identity, it actually “merely looks to the expressive ‘value’ of a celebrity’s identity, not its use, via-a-vis the challenged work.”<sup>101</sup>

While the Predominant Use Test’s focus on a defendant’s commercial purpose is arguably “dangerous” if courts abandon the practice of comparing the expressive use of a celebrity’s identity within the challenged work, the examination of a defendant’s commercial purpose or intent should remain in any right of publicity test.<sup>102</sup>

### 3. The Transformative Use Test

Currently, the most popular test for the right of publicity is the Transformative Use Test, a test first articulated by the California Supreme Court in *Comedy III Productions v. Gary Saderup, Inc.*<sup>103</sup> In *Comedy III*, artist Gary Saderup reproduced his own charcoal drawing of the Three Stooges on t-shirts.<sup>104</sup> Comedy III Productions, the registered owner of all rights to the Three Stooges comedy act, filed a claim against Saderup for violating the Stooges’ descendible right of publicity.<sup>105</sup> The court determined that Saderup’s work was expressive and thus afforded First Amendment protection,<sup>106</sup> but also recognized certain limits to this protection.<sup>107</sup> The court conceived the right of publicity as “a kind of natural property right or as an incentive for encouraging creative work.”<sup>108</sup>

The court borrowed a test from copyright law to balance the competing interests of Saderup and the Stooges. Specifically, the court incorporated the first prong of the fair use defense from the Copyright Act, “the purpose and character of the use,”<sup>109</sup> looking to the Supreme Court’s “transformative use” test to guide the analysis.<sup>110</sup> The core of the test

99. *Id.*

100. *Id.*

101. *Id.* at 164 n.30.

102. See *infra* Part III for an introduction to the Reality-Mimicking Predominant Purpose Test.

103. 25 Cal. 4th 387 (2001).

104. *Id.* at 393.

105. *Id.* at 392–93.

106. *Id.* at 396 (“[T]he present case does not concern commercial speech. . . [and although] his work was done for financial gain, ‘the First Amendment is not limited to those who publish without charge.’”).

107. *Id.* at 399 (“[W]e need not conclude that all expression that trenches on the right of publicity receives such protection. The right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility.”).

108. *Id.* at 400.

109. *Id.* at 404.

110. *Id.* (“As the Supreme Court has stated, the central purpose of the inquiry into this fair use factor is to see, in Justice Story’s words, whether the new work merely supersede[s] the objects of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent

examines whether the work in question contains enough transformative elements to move it beyond a literal depiction of the underlying celebrity likeness.<sup>111</sup> The court provided a number of iterations of the test, including the following oft-quoted “raw materials” language:

Another way of stating the inquiry is whether the celebrity likeness is one of the “raw materials” from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. 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. And when we use the word “expression,” we mean expression of something other than the likeness of the celebrity.<sup>112</sup>

Turning to the facts, the California Supreme Court disagreed with Saderup’s argument that all drawings involve creative decisions and are thus sufficiently transformative.<sup>113</sup> Instead, the court found Saderup’s charcoal drawings not transformative because “[h]is undeniable skill [was] manifestly subordinated to the overall goal of creating literal, conventional depictions of the Three Stooges so as to exploit their fame.”<sup>114</sup>

#### B. POST-COMEDY III AND THE NCAA FOOTBALL LITIGATION

Since *Comedy III*, many courts have applied the Transformative Use Test in right of publicity cases. The following sections briefly analyze several of these cases in the context of the *Keller* and *Hart*. Both *Keller* and *Hart* highlight courts’ determinations of when a videogame can depict a real-life person without compensation.

##### 1. *Keller v. Electronic Arts*

Sam Keller was a starting quarterback at Arizona State University and the University of Nebraska.<sup>115</sup> EA used Keller’s likeness in the videogame *NCAA Football*, a game in which players can control realistic avatar versions of college football players in simulated games.<sup>116</sup> Keller filed a claim against EA for violating his right of publicity.<sup>117</sup> Keller alleged that to make the videogame realistic, EA replicated real-life players as much as possible by using the players’ jersey numbers, physical characteristics, and home state.<sup>118</sup> He noted that the realism of EA’s game is not only an attractive feature, it is EA’s motto: “If it’s in the game, it’s in the game.”<sup>119</sup>

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the new work is transformative. Although such transformative use is not absolutely necessary for a finding of fair use, the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works.” (internal quotation marks omitted).

111. *Id.* at 406–07.

112. *Id.* at 406.

113. *Id.* at 408.

114. *Id.* at 409.

115. *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 WL 530108, at \*1 (N.D. Cal. Feb. 8, 2010).

116. *Id.*

117. *Id.* at \*2.

118. *Id.* at \*1.

119. *EA Sports*, WIKIPEDIA, [http://en.wikipedia.org/wiki/EA\\_Sports](http://en.wikipedia.org/wiki/EA_Sports) (last visited Apr. 22, 2013).

EA did not challenge the sufficiency of Keller's claims, but instead relied on a First Amendment defense.<sup>120</sup> The court balanced Keller's right of publicity against EA's First Amendment interests, using the Transformative Use Test laid out in *Comedy III*.<sup>121</sup> In framing its analysis, the court also considered two subsequent cases similar to *Comedy III*.

In *Winter v. DC Comics*,<sup>122</sup> Johnny and Edgar Winter sued DC Comics for misappropriation after a DC cartoonist depicted the famous blues-rock musicians as half-human, half-worm cartoon characters named Johnny and Edgar Autumn.<sup>123</sup> The *Winter* court determined the cartoonist had merely used the Winter brothers as "the raw materials from which the comic books were synthesized."<sup>124</sup> Where the *Comedy III* court found Saderup's "literal, conventional depictions" of the Three Stooges lacked sufficient transformative elements, the *Winter* court found the comic book characters were clearly transformative.<sup>125</sup> With the *Comedy III* and *Winter* decisions serving as "bookends" of the transformative spectrum, the *Keller* court turned to a recent case that struggled with applying the Transformative Use Test to a videogame.

In *Kirby v. Sega of America*,<sup>126</sup> a California district court held that despite similarities between a famous musical performer, Kieren Kirby, and a videogame character, Ulala (pronounced "ooh la la" and mimicking the catch-phrase made popular by Kirby), sufficient differences existed between the two to provide the defendant with a transformative use defense for the right of publicity claim. Key differences between the characters included Ulala's extreme height and unique clothing, as well as the space-age 25th century setting for the game in which Ulala appeared that was unlike any depiction of the musician Kirby.<sup>127</sup>

Using these cases for guidance, the *Keller* court ruled that EA's use of Keller's image was not sufficiently transformative for two reasons. First, Keller and his videogame counterpart shared enough characteristics to be virtually identical.<sup>128</sup> Second, EA had placed Keller's videogame character in the precise setting that the real Sam Keller derived his fame: the football field.<sup>129</sup> The district court concluded that EA could not prove as a matter of law that its use of Keller's likeness was permissible based on the transformative use defense.<sup>130</sup>

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This motto has been shortened to EA Sport's present motto: "It's in the game." See *It's in the Game*, ELEC. ARTS, [https://jobs.ea.com/teams/ea\\_sports/](https://jobs.ea.com/teams/ea_sports/) (last modified Apr. 13, 2014).

120. *Keller*, 2010 WL 530108, at \*3.

121. *Id.*

122. 30 Cal. 4th 881, 890 (2003).

123. *Id.*

124. *Id.*

125. *Keller*, 2010 WL 530108, at \*4.

126. 144 Cal. App. 4th 47 (2d Dist. 2006).

127. *Id.* at 59.

128. *Keller*, 2010 WL 530108, at \*5 ("EA does not depict Plaintiff in a different form; he is represented as he [sic] what he was: the starting quarterback for Arizona State University.").

129. *Id.*

130. *Id.*

## 2. *Hart v. Electronic Arts*

Less than a year after *Keller*, a New Jersey district court expressly disagreed with the *Keller* ruling in a nearly identical case—the only significant factual difference between the two was the identity of the plaintiff.<sup>131</sup> Just like Sam Keller, Ryan Hart, a former college football quarterback, alleged that EA violated his right of publicity by using his likeness in *NCAA Football*. Again, EA did not challenge the elements of Hart’s claim and instead asserted a First Amendment defense.<sup>132</sup>

The New Jersey court primarily analyzed the facts pursuant to the Transformative Use Test. Similarly to *Keller*, the *Hart* court examined *Comedy III*, *Winter*, and *Kirby*.<sup>133</sup> The court also looked at another California videogame case in which transformation was not found. In *No Doubt v. Activision, Inc.*,<sup>134</sup> the popular rock band No Doubt sued Activision for using avatars that were “painstakingly designed to mimic [the real rock stars’] likenesses, movements, and sounds” in the videogame *Rock Band*.<sup>135</sup> The court held in favor of the band, finding insufficient transformation:

Activision intentionally used these literal reproductions so that players could choose to “be” the No Doubt rock stars. The game does not permit players to alter the No Doubt avatars in any respect; they remain at all times immutable images of the real celebrity musicians, in stark contrast to the “fanciful, creative characters” in *Winter* and *Kirby*.<sup>136</sup>

The *Hart* court noted that Hart’s virtual avatar plays college football, similar to the real Hart.<sup>137</sup> But the similarity was not enough for the court to rule in Hart’s favor. Applying the alteration logic from *No Doubt*, the court concluded that the ability to alter the virtual football players in various ways made the cases significantly different.<sup>138</sup> Additionally, examining the work as a whole, the court determined that EA had added enough creative elements, like “virtual stadiums, athletes, coaches, fans, sound effects, music, and commentary,” to be sufficiently transformative.<sup>139</sup> Accordingly, the court found EA was entitled to a First Amendment defense for its use of Hart’s likeness.<sup>140</sup>

## 3. *Keller* and *Hart* on Appeal

On appeal, the Third Circuit reversed the district court’s holding in

131. *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 760 (D.N.J. 2011).

132. *Id.* at 768.

133. *Id.* at 778–82.

134. 192 Cal. App. 4th 1018 (2d Dist. 2011).

135. *Id.* at 1033.

136. *Id.*

137. *Hart*, 808 F. Supp. 2d at 783.

138. *Id.* (“[Hart’s] image can be altered in many ways—from his personal characteristics (height, weight, athletic ability), to his accessories (helmet visor, wristband). In addition, the image’s physical abilities (speed and agility, throwing arm, passing accuracy), attributes, and certain biographical details (right handed/left handed) can also be edited by the user.”).

139. *Id.* at 784.

140. *Id.* at 787.

*Hart*, finding EA had not sufficiently transformed Hart's identity.<sup>141</sup> The key reason for the reversal was the court's decision to focus its Transformative Use analysis on the individual avatar rather than the entire work.<sup>142</sup>

The court first determined Hart's "identity" was limited to his likeness and biographical information.<sup>143</sup> The Third Circuit held that by replicating Hart's hairstyle, uniform accessories, biographical information, and career statistics, EA had indeed used Hart's likeness.<sup>144</sup> Next, the court examined the context in which Hart's avatar appeared and found that by placing the avatar on the football field, EA had not transformed Hart's likeness enough to receive First Amendment protection.<sup>145</sup>

The court also disagreed the district court's determination that a videogame user's ability to alter an avatar's appearance created a factual distinction between EA's use and the use of the videogame maker in *No Doubt*.<sup>146</sup> The Third Circuit stated, "[g]iven that [Hart's] unaltered likeness is central to the core of the game experience, we are disinclined to credit users' ability to alter the digital avatars in our application of the Transformative Use Test to this case."<sup>147</sup>

A few months after the Third Circuit's ruling, the Ninth Circuit affirmed the *Keller* district court, holding that EA's use was not transformative.<sup>148</sup> Relying on *No Doubt*, the Ninth Circuit disregarded EA's argument that the court should focus its Transformative Use analysis on the entire work.<sup>149</sup> The court also dismissed EA's argument that the ability to alter the football avatars within the game amounted to a transformative use.<sup>150</sup>

Thus, both the Third Circuit and Ninth Circuit agreed that EA's use of Ryan Hart and Sam Keller's identities in *NCAA Football* was not sufficiently transformative to receive First Amendment protection. But the appellate level consistency does not negate the fact that two district courts applied the same test to identical facts and came out with opposite holdings. Further, despite a pending settlement by EA and the Collegiate

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141. *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 145 (3d Cir. 2013).

142. *Id.* at 165–69.

143. *Id.* at 165.

144. *Id.* at 166.

145. *Id.* (“[Hart’s avatar] does what the actual Ryan Hart did while at Rutgers: he plays college football, in digital recreations of college football stadiums, filled with all the trappings of college football games.”).

146. *Id.* at 168.

147. *Id.*

148. *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268, 1271 (9th Cir. 2013).

149. *Id.* at 1276 (“According to the court, the fact ‘that the avatars appear in the context of a videogame that contains many other creative elements[] does not transform the avatars into anything other than exact depictions of No Doubt’s members doing exactly what they do as celebrities.’”).

150. *Id.* at 1278 (“[T]he ability to modify the avatar counts for little where the appeal of the game lies in users’ ability to play as, or alongside[,] their preferred players or team.” (internal quotation marks omitted)).

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Licensing Company (“CLC”),<sup>151</sup> the case might still make its way to the Supreme Court.<sup>152</sup>

### C. CRITICISM OF THE TRANSFORMATIVE USE TEST

Due in part to its subjectivity, the Transformative Use Test inevitably leads to unpredictable results. The district court holdings in *Keller* and *Hart* support this phenomenon. Two judges, examining virtually identical facts, reached opposite conclusions.

In addition to its various articulations of the Transformative Use Test, the *Comedy III* court’s example of a transformative work leaves one to wonder how the court concluded that Saderup’s charcoal painting was not sufficiently transformative. Attempting to provide guidance to the lower courts, the California Supreme Court searched for examples of what would constitute a truly transformative work under the test and found them in Andy Warhol’s silkscreens of celebrities. Warhol’s take on Marilyn Monroe, Elvis Presley, and Elizabeth Taylor all “went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself [due to techniques like] distortion and the careful manipulation of context.”<sup>153</sup> The court quoted from Don DeLillo’s *Mao II: A Novel*, to reiterate that Warhol’s silkscreens were sufficiently transformative:

He moved along and stood finally in a room filled with images of Chairman Mao. Photocopy Mao, silk-screen Mao, wallpaper Mao, synthetic-polymer Mao. A series of silk screens was installed over a broader surface of wallpaper serigraphs, the Chairman’s face a pansy purple here, floating nearly free of its photographic source. Work that was unwitting of history appealed to [him]. He found it liberating. Had he ever realized the deeper meaning of Mao before he saw these pictures?<sup>154</sup>

Yet compare the court’s and DeLillo’s critique above with the following description of Gary Saderup’s artwork:

[H]is flawless style, when examined closely, reveals the delicate application of charcoal to the surface by his hand alone. Just study his collection to see the characterization, the textures of hair, the skin tones and, most importantly, the eyes. If eyes are the windows of the soul, then look deeply as you feel the persona of Marilyn Monroe flirtatiously staring back at you, the generous heart of Michael Landon looking off into the spiritual distance, or the compassionate strength exuded by John Wayne. Martin Luther King seems to reflect his life’s divine purpose. The list of descriptions goes on, and the world receives artist Gary Saderup as a conservator of these souls. So what makes a face unique? The image of that face which remains in your heart and stains

151. Youderian, *supra* note 11 (stating that two of the three defendants (EA and the CLC) have settled the antitrust class action for about \$40 million); Michael McCann, *O’Bannon Settles with EA and CLC in Class Action, NCAA Still Remaining*, SPORTS ILLUSTRATED (Sept. 26, 2013), <http://sportsillustrated.cnn.com/college-football/news/20130926/mccann-obannon-ea-clc-settlement/>.

152. McCann, *supra* note 151. The NCAA filed a petition to intervene in order to “continue to press the important First Amendment arguments.” *Id.*

153. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 408–09 (2001).

154. *Id.* at 409 n.12.

your memory. Gary Saderup makes a face unique.<sup>155</sup>

Both Warhol and Saderup use their respective art mediums to portray celebrities through their own eyes. Just as countless art fans can quickly point out a “Warhol,” fans of Saderup’s work could likely recognize a classic “Saderup.”<sup>156</sup> Framed in such a light, one could envision another court—perhaps the *Hart* court—swapping Warhol’s silkscreen for Saderup’s charcoal drawing as an example of an “expression [that] may well be entitled to First Amendment protection.”<sup>157</sup> A reasonable judge, viewing Gary Saderup’s art in light of his creative decisions in making charcoal drawings that “see into the heart of subjects,” could reason that Saderup transforms the underlying celebrity into a “Gary Saderup original.” However, the court in *Comedy III* concluded that Saderup’s work contained “no significant transformative or creative contribution” and was not entitled to a First Amendment defense.<sup>158</sup> This example, in addition to the conflicting opinions of *Keller* and *Hart*, illustrates the extreme subjectivity underlying the Transformative Use Test.

### III. PROPOSAL: THE REALITY-MIMICKING PREDOMINANT USE TEST

Given the apparent confusion around the Transformative Use Test<sup>159</sup> and the popularity of videogames,<sup>160</sup> it is not surprising that there exists a large body of scholarly discussion covering the intersection of the two areas.<sup>161</sup> Despite the dialogue, no one has yet to propose a test that examines the defendant’s intent in using a person’s name or likeness in reality-mimicking videogames.<sup>162</sup> Expanding the Transformative Use Test to include a defendant’s underlying purpose in using a person’s likeness

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155. *About the Artist*, CHARCOALS BY SADERUP, <http://www.garysaderup.com/AboutArtist.html> (last visited Apr. 22, 2013).

156. *See Profile of Gary Saderup*, FORBES, <http://www.forbes.com/profile/gary-saderup/> (last visited Apr. 22, 2013) (“Saderup has sold his work internationally, including in Japan, Australia, South Africa, the U.K., Germany and Canada, as well as within the U.S.”).

157. *Comedy III*, 25 Cal. 4th at 409.

158. *Id.*

159. Jeremy Williams, deputy general counsel of Warner Brothers, quipped, “if trademark law is designed to prevent confusion among consumers, I think right of publicity law is designed to create confusion among judges.” *usfschooloflaw*, *supra* note 25.

160. ENT. SOFTWARE ASS’N, 2011 SALES, DEMOGRAPHIC AND USAGE DATA: ESSENTIAL FACTS ABOUT THE COMPUTER AND VIDEO GAME INDUSTRY 2 (2011) (stating that seventy-two percent of U.S. households play some type of computer or videogame).

161. *See, e.g.*, Neil Hood, *The First Amendment and New Media: Video Games as Protected Speech and the Implications for the Right of Publicity*, 52 B.C. L. REV. 617 (2011) (observing that the term videogame fails to grasp the variety of games available, and that a categorical free speech exemption for videogames would provide some non-expressive games too much First Amendment protection); Garrett Mathew & James Mott, *Game Over for Regulating Violent Video Games? The Effect of Brown v. Entertainment Merchants Ass’n on First Amendment Jurisprudence*, 45 LOY. L.A. L. REV. 633 (2012); Joseph Gutmann, *It’s in the Game: Redefining the Transformative Use Test for the Video Game Arena*, 31 CARDOZO ARTS & ENT. L.J. 215 (2012).

162. *See, e.g.*, Gutmann, *supra* note 161, at 235 (“The solution in the redefined test is to look at the evidence present in the work in question to see what, if anything, the creator meant to add or change. In video games, for example, it is possible to make objective determinations based on an alteration’s place in the game. If an alteration is critical to the public appeal of the game and thereby a source of profit, it can be said that the work was meant to be its own expression.”).

would provide “a more balanced balancing test . . . that better addresses the cases where speech is both expressive and commercial.”<sup>163</sup>

The Reality-Mimicking Predominant Use Test includes a variety of non-exclusive factors that are derived from current right of publicity case law as well as other legal areas such as copyright fair use, trademark law, and the Anticybersquatting Consumer Protection Act’s (“ACPA”) “bad faith” factors. The proposed test would allow courts to consider the following factors:

- (1) The purpose and character of the use;<sup>164</sup>
- (2) Evidence of intent;<sup>165</sup>
- (3) Whether the use contains the actual name or likeness of the person versus more generalized indicia of identity;<sup>166</sup>
- (4) Extent of appropriation;<sup>167</sup>
- (5) Extent to which the person is distinctive or famous;
- (6) Defendant’s prior dealings in same or similar circumstances.<sup>168</sup>

Including evidence of the defendant’s intent as a factor better balances First Amendment interests against rationales for the right of publicity—namely, preventing unjust enrichment, protecting personal dignity and autonomy,<sup>169</sup> and rewarding moral rights<sup>170</sup> and labor.<sup>171</sup>

#### A. APPLICATION OF THE REALITY-MIMICKING PREDOMINANT USE TEST USING THE DISTRICT COURTS’ REASONING IN *KELLER* AND *HART*

Applying the Reality-Mimicking Predominant Use Test to EA’s *NCAA Football* series, a court would first look at the underlying medium of expression—here, a videogame. As courts have broadly labeled

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

164. This factor is essentially the Transformative Use Test, which is still helpful in close cases where the work’s content must be analyzed.

165. *See TCI Cablevision*, 110 S.W.3d at 370–71 (finding intent where defendant sought to gain commercial advantage by associating Tony Twist with the *Spawn* comic book and targeting marketing to hockey fans, thereby attracting consumer attention to the product).

166. *See White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992).

167. *See Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (“[W]hat may be the strongest case for a ‘right of publicity’ involving . . . the appropriation of the very activity which the entertainer acquired his reputation in the first place.”). *But see Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 404 (2001) (“We conclude that a wholesale importation of the fair use doctrine into right of publicity law would not be advisable. . . . [T]he amount and substantiality of the portion used . . . seem[s] particularly designed to be applied to the partial copying of works of authorship fixed in [a] tangible medium of expression.” (internal quotation marks omitted)).

168. *See Comedy III*, 25 Cal. 4th at 393. The court noted that defendant Saderup had drawn celebrity charcoal sketches for twenty-five years with no mention of prior licenses. Such an extensive history of unlicensed celebrity charcoal drawings, coupled with no prior legal action, could indicate Saderup’s good faith belief that no license was needed. *Id.*

169. *See Lugosi v. Universal Pictures*, 603 P.2d 425, 438 (Cal. 1979) (Bird, C.J., dissenting); Zimmerman, *supra* note 30, at 80 (“I realize that, when all else is said and done, the reason that publicity rights have such a broad and loyal following is rooted in an intuition about fairness, a sense of the potential for a form of distributive injustice if celebrities cannot demand control over and payment for uses of their attributes.”).

170. *See MCCARTHY*, *supra* note 12, §§ 21, 894; Kwall, *supra* note 31, at 158–60.

171. *See SOLOVE & SCHWARTZ*, *supra* note 32, at 212–13 (“One of the predominant rationales for the right of publicity is that the celebrity, through her labor, creates her persona.”); Nimmer, *supra* note 32, at 216 (linking one’s publicity rights to each individual’s moral right to “the fruit of his labors”); *Zacchini*, 433 U.S. at 576; *Matthews v. Wozencraft*, 15 F.3d 432, 437 (5th Cir. 1994).

videogames expressive works,<sup>172</sup> EA's work would receive First Amendment protection.

Next, the court would apply the reality-mimicking factors. The first factor adopts much of the current Transformative Use Test. Thus, the *Keller* court would find EA's videogame lacking sufficient transformative elements to overcome the right of publicity claim. The court would again find that the avatar of Sam Keller shared so many characteristics with the real Sam Keller that the two are virtually identical.<sup>173</sup> In addition to the extensive shared characteristics, the court would likely emphasize that the avatar was placed on the college football field—the very same setting in which the real Sam Keller made a name for himself.<sup>174</sup>

Meanwhile, where the *Keller* court saw very little transformation, the *Hart* court found plenty. Again, the *Hart* court viewed the ability to change and edit the virtual players,<sup>175</sup> in addition to EA's added creative elements, like fans, stadiums, and commentary, as transformative.<sup>176</sup> But the mere ability to change the virtual players' appearances should not prove end the analysis where the intent of the game makers is to mimic reality. Instead, if the game is principally designed to imitate life and not to alter reality, then the work should not be found transformative.<sup>177</sup> In *NCAA Football*, EA seeks to create a realistic college football experience.<sup>178</sup> The ability to alter virtual players complicates the transformation analysis, but that feature alone should not be dispositive.<sup>179</sup> "Rather, the game, in its base format, attempts to maximize realism, and the changeability is merely tangential."<sup>180</sup>

Even if a jury were to rule that the ability to alter the virtual football players is a sufficiently transformative use, the inquiry would continue. Applying the reality-mimicking factors, the *Hart* court would be able to consider evidence beyond the game's content. The *Hart* opinion is rife with acknowledgments of EA's clear purpose to capitalize on college football players' fame by creating a reality-mimicking game, but such evidence is outside the scope of the Transformative Use Test inquiry.<sup>181</sup> Instead of

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172. *Brown v. Entm't Merch. Ass'n*, 131 S. Ct. 2729, 2733 (2011).

173. *Keller*, 2010 WL 530108, at \*5 ("EA does not depict Plaintiff in a different form; he is represented as he [sic.] what he was: the starting quarterback for Arizona State University.")

174. *Id.*

175. *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 783 (D.N.J. 2011).

176. *Id.* at 784.

177. *See* Gutmann, *supra* note 161, at 232–33 (advocating for a modified transformative test for videogames by drawing a line between games intended to be played in "altered realities" and those intended as an "imitation of life").

178. Matt Cesca, *NCAA Football 12 Interview with Assistant Designer Jordan Peterson*, GAMES EYE VIEW (July 11, 2011), <http://www.gameseyeview.com/2011/07/11/ncaa-football-12-interview-with-assistant-designer-jordan-peterson> ("We truly attempt to make each in game experience as realistic as we can.")

179. Gutmann, *supra* note 161, at 230.

180. *Id.*

181. *See, e.g., Hart*, 808 F. Supp. 2d at 783 (admitting that EA's reality-mimicking game capitalizes upon players' fame, but that such evidence "does not mean that EA's use of Hart's image was not transformative"); *id.* at 785 (noting that evidence of EA's stated purpose of replicating the

exclusively focusing on the content of the work, the reality-mimicking factors would allow the *Hart* court to appropriately weigh evidence of intent.

Applying the second factor—evidence of intent—the *Hart* court would have ample evidence to tip the scales in favor of college football players. For example, a defendant’s promotional, marketing, and customer targeting tactics may indicate intent to gain commercial advantage.<sup>182</sup> With regard to such tactics, the *Hart* court cited statements from EA’s website that EA’s goal is to create “the most realistic authentic [football] performance [so that the user may] feel what it’s like to cover the field and play at the most elite level in college football.”<sup>183</sup> EA could easily create a game comprised entirely of fictional players, but in order to make a more realistic and profitable product, EA uses real-life players.<sup>184</sup> The *Hart* court admitted as much:

Placing present and former college athletes, including Hart, into the fittingly-titled NCAA Football game setting strongly suggests that the goal of the game is to capitalize upon the fame of those players. Indeed, “[i]t seems ludicrous to question whether video game consumers enjoy and, as a result, purchase more EA-produced video games as a result of the heightened realism associated with actual players.”<sup>185</sup>

Because the court’s analysis was strictly limited to the content of the game itself, rather than EA’s seemingly clear intent to leverage players’ likenesses to increase sales, EA successfully defeated Hart’s right of publicity claim. Had the *Hart* court evaluated the evidence of EA’s intent, the result would likely have been different.

The third factor—whether the use contains the actual name or likeness of the person versus more generalized indicia of identity—would likely weigh in the players’ favors as well. This factor examines the scope of the use, appreciating the fact that a more attenuated use is intrinsically less abusive.<sup>186</sup> EA’s use of real-life players in *NCAA Football* included nearly every element of college football players’ identities except their names.<sup>187</sup> On the spectrum of possible uses, EA’s virtual players fall closer to an

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college football experience “is not the focus of [the judge’s] inquiry”).

182. *Doe v. TCI Cablevision*, 110 S.W.3d 363, 366–67 (Mo. 2003).

183. *Hart*, 808 F. Supp. 2d at 786.

184. *See, e.g.*, Darren Rovell, *All Madden, All the Time*, ESPN (Dec. 14, 2004), <http://sports.espn.go.com/espn/sportsbusiness/news/story?id=1945691>. The insurgent *NFL 2K* series, published by Sega, briefly competed with EA’s *Madden NFL* series. In 2004, Sega released *NFL 2K5* at the very low price of \$19.99, compared to Madden’s \$49.95 price tag. EA responded by securing an exclusive license to the NFL teams and players’ likenesses. *Id.*

185. *Hart*, 808 F. Supp. 2d at 783 (quoting James J.S. Holmes et al., *Defining Liability for Likeness of Athlete Avatars in Video Games*, 34 L.A. LAWYER 17, 20 (2011)).

186. *See, e.g.*, *White v. Samsung Elec. Am., Inc.*, 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting), *cert. denied*, 508 U.S. 951 (1993) (“[T]he panel majority erects a property right of remarkable and dangerous breadth: Under the majority’s opinion, it’s now a tort for advertisers to remind the public of a celebrity. Not to use a celebrity’s name, voice, signature or likeness; not to imply the celebrity endorses a product; but simply to evoke the celebrity’s image in the public’s mind.”).

187. *Hart*, 808 F. Supp. 2d at 761 (the court noted that the players’ names could later be added in by the users).

exact representation than an attenuated use.<sup>188</sup> Given that the Ninth Circuit has held that the unlicensed use of a celebrity's distinctive car infringed upon a plaintiff's right of publicity, it is reasonable to conclude that the *Hart* court would concede that even with their helmets on, football players' likenesses are equally deserving of protection.<sup>189</sup>

The fourth factor—the extent of appropriation—examines the nature of the defendant's appropriation and its economic impact on the plaintiff. This factor reflects the Supreme Court's argument in favor of publicity rights in *Zacchini*: a defendant that utilizes “the very activity which the entertainer acquired his reputation in the first place” should receive less protection.<sup>190</sup> Similarly, even a skillfully appropriated entertainment act “does not . . . give a privilege to appropriate another's valuable attributes on a continuing basis as one's own without the consent of the other.”<sup>191</sup> The concern is such takings deprive the entertainer of the fruits of his labor.

The *Hart* court shared its concern about EA's possible exploitative practices despite such inquiries falling outside the Transformative Use Test's scope:

[A] game developer that bases its work on real players, in the context of the games that bring them notoriety, may walk a fine line between using reality as a building block for the developer's own creative work and exploiting the hard-earned reputations of college players for its own profit. For this reason, the Court appreciates the plight of college players who are prohibited by NCAA bylaws from entering into licensing agreement and other ‘commercial opportunities’ during their playing years.<sup>192</sup>

The *Hart* court clearly sympathized with the college players' economic plight. If the court had been able to look beyond the Transformative Use Test and the extent to which EA appropriated the players' fame-creating activity, it could have concluded that EA's use of the players' likenesses to recreate the football game appropriated the very activity by which the players acquired their reputations. Accordingly, the *Hart* court would likely find the fourth factor in favor of the players.

The fifth factor—the extent to which the person is distinctive or famous—measures a person's general level of fame. While this endeavor is inexact, companies exist that offer valuation methods for fame or celebrity brand value.<sup>193</sup> A rough estimate for height of fame or brand value could

188. See *White*, 971 F.2d at 1399 (finding that the combination of a metallic robot turning letters on a game show set while dressed in a blond wig, gown and jewelry was enough to resemble Vanna White). Here, the use of all of the players' likeness other than the name is much closer to a complete taking than the combination of features that led the Ninth Circuit to side with Vanna White in her right of publicity claim.

189. See *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1974) (finding a famous professional driver's car distinctive enough to cause “some persons to think the car in question was plaintiff's and to infer that the person driving the car was the plaintiff”).

190. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

191. See generally *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1359–60 (D.N.J. 1981) (quoting Victor S. Netterville, *Copyright and Tort Aspects of Parody, Mimicry and Humorous Commentary*, 35 S. CAL. L. REV. 225, 254 (1962)).

192. *Hart*, 808 F. Supp. 2d at 783, *rev'd*, *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013).

193. See, e.g., James Cook et al., *Your Two Weeks of Fame and Your Grandmother's*, ARXIV

also, for example, be derived from the number of people following a celebrity's Twitter feed.<sup>194</sup> The purpose of this measurement is not to determine with exact certitude the level of fame a plaintiff has attained, but rather where he generally falls on the spectrum between superstar and private citizen. In the sports context, this inquiry focuses on where along the "marquee player" to "marginal player" spectrum the plaintiff falls.<sup>195</sup>

Applying this factor, the *Hart* court would consider how "famous" Ryan Hart is and, to a larger extent, the level of celebrity value for each player. Certainly there is a difference between Heisman winner Johnny "Johnny Football" Manziel<sup>196</sup> and the backup offensive guard at the University of Buffalo.<sup>197</sup> The fact that most college football players will not go on to play professionally<sup>198</sup> and that college teams are divided between "haves" and "have-nots"<sup>199</sup> are indicators of the varying levels of talent within college football teams. Since the right of publicity protects against economic harms,<sup>200</sup> each player would have different levels of financial harm.<sup>201</sup> However, *Keller* and *Hart* are class action filings,<sup>202</sup> and damages are awarded to the class as a whole.<sup>203</sup> Looking specifically at Ryan Hart

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(Apr. 20, 2012), available at <http://arxiv.org/pdf/1204.4346v1.pdf> (measuring fame as the chance a person reading news at random would find an article mentioning a celebrity's name and the time period such a celebrity's name continues to appear in news stories); *Personal Brand Valuations*, INTERBRAND, [http://www.interbrand.com/Libraries/Articles/22\\_Personal\\_Brand\\_Valuation\\_pdf.sflb.ashx](http://www.interbrand.com/Libraries/Articles/22_Personal_Brand_Valuation_pdf.sflb.ashx) (last visited Apr. 22, 2013) (determining a celebrity's brand value in relation to a business strategy); Jasmina Ilicic & Cynthia M. Webster, *Celebrity Brand Value: Using the MECCAS Model to Evaluate Celebrity Endorsement Advertising Strategy*, ANZMAG (Apr. 22, 2013), <http://anzmac.org/conference/2011/Papers%20by%20Presenting%20Author/Ilicic>.

194. See *Twitter, Top 100: Most Followers*, TWITTER COUNTER, <http://twittercounter.com/pages/100> (last visited Feb. 22, 2013) (Justin Bieber, Lady Gaga, and Barack Obama are currently in the top five); Jo Piazza, *How Much Can a Celebrity Make for Tweeting?*, VULTURE (Jan. 28, 2012), [http://www.vulture.com/2012/01/how-much-can-a-celebrity-make-for-tweeting.html?mid=nymag\\_press](http://www.vulture.com/2012/01/how-much-can-a-celebrity-make-for-tweeting.html?mid=nymag_press) (noting the sliding scale payment structure for celebrity tweets, where "Snoop Dogg (6.3 million followers) is in the top tier of payments, on the upside of \$8,000 apiece, while Paula Abdul (2.2 million followers) falls somewhere in the middle, in the \$5,000 range, and Whitney Port (800,000 followers) falls in the bottom tier, making around \$2,500 per tweet).

195. Anastasios Kaburakis et al., *NCAA Student-Athletes' Rights of Publicity, EA Sports, and the Video Game Industry*, 27 ENT. & SPORTS LAWYER 1, 29 (2009) (discussing the court's determination of "marquee versus marginal players" and "revenue versus nonrevenue producing teams").

196. Ian Berg, *5 Pieces of Advice Tim Tebow Would Give Johnny Manziel*, BLEACHER REPORT (Apr. 13, 2013), <http://bleacherreport.com/articles/1601557-5-pieces-of-advice-tim-tebow-would-give-johnny-manziel>; Gabe Zaldivar, *Johnny Manziel's Fame Forces Him Off Campus, Takes Online Classes this Spring*, BLEACHER REPORT (Feb. 19, 2013), <http://bleacherreport.com/articles/1535390-johnny-manziels-fame-forces-him-off-campus-takes-online-classes-this-spring>; Graham Watson, *Johnny Manziel Might Be off Twitter, but His Instagram Fame Lives On*, YAHOO SPORTS (Apr. 3, 2013), <http://sports.yahoo.com/blogs/ncaaf-dr-saturday/johnny-manziel-might-off-twitter-instagram-fame-lives-164312290--ncaaf.html>.

197. See *Jake Pickett Bio Page*, STATE UNIV. OF N.Y., BUFFALO, FOOTBALL TEAM ROSTER, [http://www.ubbulls.com/sports/fball/2013-14/bios/pickett\\_jake\\_2jxb](http://www.ubbulls.com/sports/fball/2013-14/bios/pickett_jake_2jxb) (last visited Feb. 16, 2014).

198. Tony Manfred, *Here Are the Odds that Your Kid Becomes a Professional Athlete (Hint: They're Small)*, BUSINESS INSIDER (Feb. 10, 2012), <http://www.businessinsider.com/odds-college-athletes-become-professionals-2012-2?op=1>.

199. See T.J. Mcaloon, *College Football 2011: 20 FBS Programs that Will Never Make a BCS Game*, BLEACHER REPORT (June 28, 2011), <http://bleacherreport.com/articles/751606-college-football-2011-20-fbs-programs-that-will-never-make-a-bcs-game>.

200. See MCCARTHY, *supra* note 12, § 11:31.

201. Kaburakis, *supra* note 195, at 29.

202. *Id.* at 13; *Hart*, 808 F. Supp. 2d at 760.

203. See Kaburakis, *supra* note 195, at 29 ("[T]he challenge will be to concoct methods to

and Sam Keller, it is unclear what level of fame the *Hart* court would grant the players. While both play the marquee position of quarterback, neither player reached the level of stardom of Johnny Manziel.

Finally, the *Hart* court would look to the sixth factor—the defendant’s prior dealings in the same or similar circumstances. EA licenses publicity rights from the National Football League (“NFL”) and its players, and also enters into licensing agreements with the CLC and the NCAA for college trademarks and logos.<sup>204</sup> The *Hart* court noted the “element of unfairness” in a licensing scheme where the schools and organizations make the deals, yet the college football players are left out.<sup>205</sup> In light of the court’s repeated mention of “unfairness,” and of EA’s “exploit[ation of] the [student-athlete’s] hard-earned reputations,” it is fair to infer that the *Hart* court would weigh these pre-existing licensing schemes against EA to find factor six favors Hart.

In conclusion, applying the Reality-Mimicking Predominant Use Test, the *Hart* court would likely find that EA’s predominant purpose in creating a virtual Ryan Hart was to exploit the commercial value of the real Hart. While no factor is dispositive, the preexisting licensing agreements, the level of detail in replicating the student-athletes, and the indisputable evidence of EA’s intent summarized in the company’s own motto—“It’s in the game”—should all favor a New Jersey District Court ruling in favor of Ryan Hart.

#### IV. AREAS BEYOND THE RIGHT OF PUBLICITY

Despite concerns that focusing on intent in right of publicity cases is a misguided endeavor, the inquiry into intent has been successful in trademark law. Trademark law is an appropriate area of intellectual property law from which to seek guidance for right of publicity cases because both disciplines seek to prevent unjust enrichment.<sup>206</sup> Due to the significant overlap, courts commonly analyze trademark and right of publicity claims in the same case.<sup>207</sup> Furthermore, the prevalence of reality-mimicking videogames provides the best “cross-pollination” point to intermix trademark and right of publicity principles due to the increasing property rights in trademark law (through the dilution doctrine, merchandising, and false endorsement claims).<sup>208</sup> Trademark claims in both the United States and abroad use the defendant’s intent as a factor in

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apportion the financial impact and damages suffered by the class as a whole, as opposed to the court setting a toe into the swamp of individual class members’ inquiries. This is instrumental, as some class members would have a heavy burden of proof with respect to, for example, commercial value in their likenesses prior to the video games’ use.” (internal quotation marks omitted).

204. *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 783–84 (D.N.J. 2011).

205. *Id.* at 784.

206. MCCARTHY, *supra* note 12, § 2:2.

207. *See, e.g.*, *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) (looking to the artistic relevancy).

208. *See Celeste H.G. Boyd & Stuart Paynter, What a Tangled Family Tree We Weave: Trademarks, Publicity Rights, and the Cross-Pollination of First Amendment Defenses Through Video Games*, 4 J. INT’L MEDIA & ENT. L. 69, 70–71 (2012).

determining liability. The following section examines the domestic and international approaches used in determining liability in trademark law to show the importance of intent.

#### A. ANTICYBERSQUATTING LAWS

The ACPA allows trademark owners to prevent “cybersquatters” from trading off the trademark’s goodwill. Under the ACPA, cybersquatting:

[O]ccurs when a person other than the trademark holder registers the domain name of a well known trademark and then attempts to profit from this by either ransoming the domain name back to the trademark holder or by using the domain name to divert business from the trademark holder to the domain name holder.<sup>209</sup>

The ACPA allows a trademark owner to bring a cause of action where: (1) the mark is distinctive or famous, (2) the defendant’s domain name is identical or confusingly similar to the mark (or dilutes the mark), and (3) the defendant had a bad faith intent to profit from the mark.<sup>210</sup>

The ACPA also provides a nonexclusive list of “bad faith” factors to help guide a court when analyzing the intent of the domain name registrant.<sup>211</sup> After weighing the ACPA factors, many courts have determined that a domain name registrant had a bad faith intent to profit.<sup>212</sup> However, similar to the right of publicity and other areas of trademark law, the ACPA protects uses that are otherwise lawful under the First Amendment with a fair use exception.<sup>213</sup> Where criticism is the primary reason for cybersquatting, a bona fide noncommercial or fair use factor can defeat an ACPA claim.

In *Mayflower Transit, LLC v. Prince*,<sup>214</sup> a New Jersey court ruled that

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209. *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 680 (9th Cir. 2005) (quoting *DaimlerChrysler v. The Net Inc.*, 388 F.3d 201, 204 (6th Cir. 2004)).

210. *See* 15 U.S.C. § 1125(d)(1)(A) (2012); *Shields v. Zuccarini*, 254 F.3d 476, 482 (3d Cir. 2001).

211. 15 U.S.C. § 1125(d)(1)(B)(i). These factors include: (1) the registrant’s trademark or other intellectual property rights in the domain name; (2) whether the domain name contains the registrant’s common or legal name; (3) the registrant’s prior use of the domain name in connection with the bona fide offering of goods or services; (4) the registrant’s bona fide noncommercial or fair use of the mark on a site accessible by the domain name; (5) the registrant’s intent to divert consumers from the mark owner’s online location to a site accessible under the domain name that could harm the goodwill represented by the mark for commercial gain or with the intent to tarnish or disparage the mark; (6) the registrant’s offer to sell, transfer, or otherwise assign the domain name to the mark owner or a third party for financial gain without having used the mark on a legitimate site; (7) the registrant’s provision of misleading false contact information when applying for registration of the domain name; (8) the registration or acquisition of multiple domain names that the registrant knows are identical or confusingly similar to marks of others; and (9) the extent to which the mark in the domain name is distinctive or famous. *Id.*

212. *See, e.g., Shields*, 254 F.3d at 485–86 (affirming the district court’s finding of a defendant’s bad faith profit motive where defendant’s sites were primarily commercially driven and converted to “political protest” only on the eve of litigation in an attempt to avoid liability); *Toronto-Dominion Bank v. Karpachev*, 188 F. Supp. 2d 110 (D. Mass. 2002) (finding bad faith where a disgruntled customer registered sixteen domain names that resembled plaintiff’s mark or were simply misspellings); *PETA v. Doughney*, 263 F.3d 359, 368 (4th Cir. 2001) (finding bad faith with intent to profit where defendant made statements in the press and on his website for plaintiff to “settle” and “make him an offer”).

213. 15 U.S.C. § 1125(d)(1)(B)(ii).

214. 314 F. Supp. 2d 362, 369 (D.N.J. 2004).

despite the fact that the plaintiff's MAYFLOWER trademark was distinctive and the defendant's website, "mayflowervanline.com," was confusingly similar to the mark,<sup>215</sup> the defendant did not possess the requisite bad faith intent to profit from the mark.<sup>216</sup> The court examined each of the bad faith factors, finding five factors favored the plaintiff.<sup>217</sup> The court emphasized the fourth factor—whether the defendant had a "bona fide noncommercial or fair use of the mark"—as the primary purpose for dismissing the plaintiff's claim.<sup>218</sup> The court focused on the defendant's critical commentary, which was motivated by his poor customer experience with Mayflower movers, to determine his registration of "mayflowervanline.com" was not fueled by a profit motive.<sup>219</sup>

The ACPA's bad faith factors are one example of courts protecting intellectual property rights when the predominant purpose of the infringer is to capitalize off of the owner's goodwill. As the ACPA illustrates, a focus on the purpose or intent of the defendant effectively counteracts a defendant's attempt to free ride. *Mayflower* illustrates that such bad use factors do not always lead to incrimination, but can also help to exculpate a defendant.

#### B. THE EUROPEAN PERSPECTIVE

The United States is not the only country that looks to a person's bad faith when examining an intellectual property complaint. Countries in the European Union ("EU") prohibit registration of a mark designed to take "unfair advantage" of a prior mark.<sup>220</sup> Italy specifically looks to a registrant's "parasitic intent" when analyzing an unfair advantage claim.<sup>221</sup>

A recent Italian case illustrates a broad interpretation of the EU's unfair advantage claim. In *L'Oréal v. Bellure*, the Court of Justice of the European Union ("CJEU"), the EU's highest court, found a valid claim for unfair advantage in the perfume industry.<sup>222</sup> In the case, defendant Bellure sold affordable imitation perfumes of plaintiff L'Oréal's well-known marks (TRÉSOR, MIRACLE, ANAÏS ANAÏS).<sup>223</sup> Bellure's versions were similar in both smell and product packaging, but did not contain L'Oréal's word marks.<sup>224</sup> The General Court denied L'Oréal's claim because it would amount "to some sort of nebulous tort of unfair competition."<sup>225</sup> In

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215. *Id.* at 367.

216. *Id.* at 372.

217. *Id.* at 368.

218. *Id.* at 369.

219. *See id.* at 369–70.

220. *See* Directive 2008/95/EC, of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, 2008 O.J. (L 299) 25.

221. *See* David Franklyn, *Debunking Dilution Doctrine: Toward a Coherent Theory of the Anti-Free-Rider Principle in American Trademark Law*, 56 HASTINGS L.J. 117, 160 (2004).

222. *L'Oréal SA v. Bellure NV*, 2009 E.C.R. I-5185, P 49.

223. *Id.* at P 17.

224. *Id.*

225. *L'Oréal SA & Ors v. Bellure NV*, [2007] EWCA (Civ) 968 (internal quotation marks

overturning the General Court's decision, the CJEU held:

[W]here a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark.<sup>226</sup>

Following the decision, many commentators, including the referring court, criticized the CJEU's holding because it did not provide guidance as to what constituted "permissible free-riding" versus "impermissible free-riding."<sup>227</sup> Nevertheless, the *L'Oréal* decision confirmed the EU's acceptance of the concept of unfair competition by "parasitism" or "free-riding."<sup>228</sup> While the scope of protection remains open for debate, the EU seems relatively comfortable with providing wider protection for famous marks.

Trademark law provides a strong foundation to build a refined First Amendment balancing test for the right of publicity since both laws seek to prevent unjust enrichment and are members of unfair competition law.<sup>229</sup> Furthermore, since trademark protection expands beyond preventing consumer confusion, there will be an increasing overlap between these two areas of law.<sup>230</sup> This overlap, particularly in the reality-mimicking videogame context, could lead to cross-pollination between the legal doctrines.<sup>231</sup> Considering that other areas of trademark law effectively examine defendants' intent and punish free-riding, courts should similarly calibrate their inquiries to include defendants' intent in right of publicity cases.

## V. CRITICISM OF THE REALITY-MIMICKING PREDOMINANT USE TEST

The following section anticipates and responds to criticisms of the Reality-Mimicking Predominant Use Test.

### A. CRITICISM #1: THE RIGHT OF PUBLICITY SHOULD RECEIVE LESS, NOT MORE, PROTECTION

It is not the purpose of this Article to provide an exhaustive justification for the right of publicity. However, this Article advocates for stronger right of publicity enforcement. As such, one critique of the proposed Reality-Mimicking Predominant Use Test is that the right of

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omitted).

226. *Id.* at P 49.

227. *See* *L'Oréal SA v. Bellure NV*, [2010] EWCA (Civ) 535, P 49.

228. *L'Oréal SA v. Bellure NV*, 2009 E.C.R. I-5185, P 41.

229. *See* *Boyd & Paynter*, *supra* note 208, at 70.

230. *Id.* at 70–71.

231. *Id.* at 71.

publicity's scope of protection should be more deferential to First Amendment interests.

In *Private Ownership of Public Image: Popular Culture and Publicity Rights*, Professor Madow attacks the right of publicity on two fronts: (1) that the right facilitates private censorship of popular culture;<sup>232</sup> and (2) that the right's existence is not justified because an individual does not become famous primarily due to his own labor and talent, but rather because society confers fame on him based on a series of serendipitous events.<sup>233</sup> Madow's critiques, however, minimize the importance of the labor in achieving fame and fail to recognize that First Amendment concerns are accounted for when courts apply balancing tests.

First, Madow argues that the right of publicity unduly restricts free speech, which in turn hurts a democratic society.<sup>234</sup> Madow uses the example of "butch John Wayne" greetings cards to show how a celebrity (or his descendants) can control the use of his image to limit ideas expressed by those images.<sup>235</sup> Madow paints the following bleak picture:

If the New York Legislature were to make John Wayne's right of publicity descendible, however, it would confer on Wayne Enterprises the power to determine that this particular appropriation of the John Wayne image is "illegitimate," and to enforce that determination by denying a license to the greeting card maker. Wayne Enterprises would henceforth have the power to fix, or at least try to fix, the meaning that "John Wayne" has in our culture: his meaning for us.<sup>236</sup>

Madow argues that by enjoining the butch John Wayne cards, the gay rights movement would lose one strong voice or source of expression in its fight for equality. For the sake of analysis, Madow presumes that Wayne's heirs would be able to enjoin the sale of the cards without mentioning that such a claim would likely fail under traditional First Amendment balancing tests. If the heirs of John Wayne sued the card-makers to enjoin the sale of the cards, the defendants would point to the parodic value of flipping the "conservative macho image" of John Wayne on its head with the butch version's bright red lipstick and catchy one-liner about the difficulties faced by the gay community.<sup>237</sup> Under traditional fair use analysis, the overt political message on the card would likely defeat the plaintiff's high burden for an injunction.

Second, with regard to unjust enrichment, Madow minimizes the labor and moral value a person has in his fame. Madow criticizes the dichotomy of "Sower" versus "Reaper,"<sup>238</sup> yet spends the majority of his article

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232. See Madow, *supra* note 21, at 138.

233. *Id.* at 185–91 (discussing why Albert Einstein, and not other notable scientists of his era, grew to become synonymous with "genius" and a cultural icon).

234. See *id.* at 142–45.

235. *Id.* at 144–45.

236. *Id.* at 145.

237. See *id.* at 144–45.

238. *Id.* at 196 ("The contest between the celebrity and the unauthorized appropriator of his image is thus framed starkly as Sower v. Reaper. The reality, however, is a good deal more complicated and morally ambiguous.").

harping on the fact that celebrities do not actually “sow,”<sup>239</sup> citing examples like Elvis borrowing from rhythm and blues, Vanilla Ice stealing from KRS-One and Public Enemy, and Madonna borrowing from Marilyn Monroe.<sup>240</sup> To prove just how fortuitous fame is, Madow looks to Einstein’s meteoric rise as a worldwide celebrity. In 2012 alone, Einstein’s estate earned \$12 million in royalties.<sup>241</sup> Madow wonders why Einstein, and not Heisenberg, Bohr, or Schrodinger, became wildly popular and synonymous with the word “genius.”<sup>242</sup> Madow cites to Einstein’s serendipitous path, starting as “the somewhat obscure originator of a frightening and ‘un-American’ theory (relativity)” to a man “widely admired in the general populace, well on his way to secular sainthood and cultural iconization.”<sup>243</sup> Madow concludes that fame is conferred by others and that “a celebrity’s public image is always the product of a complex social, if not fully democratic, process in which the ‘labor’ (time, money, effort) of the celebrity herself (and of the celebrity industry, too) is but one ingredient, and not always the main one.”<sup>244</sup>

Madow significantly downplays a celebrity’s labor, assuming that Locke’s labor theory rewards only work,<sup>245</sup> and celebrities, even Kim Kardashian, provide enough “labor” to deserve the “fruits.” Of course, there are many ways to define labor. Perhaps Kim Kardashian’s maintenance of her good looks are her labor; or Einstein’s superior intellect was his; or LeBron James’ impressive athletic combination of size, speed, and power are his. However you define labor, the typically seems to flow from that person rather than society conferring fame on him.

Admittedly, there are cases, particularly in the context of Hollywood, where fame stems not just from the underlying person but also from the character he portrays. For example, Neil Patrick Harris seemingly has adopted the eternal bachelor charisma of his character, Barney Stinson, from the sitcom *How I Met Your Mother*.<sup>246</sup> While Harris certainly delivers

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239. *See id.* (“For one thing, it is a fairly safe bet that the celebrity plaintiff has done some ‘borrowing’ himself. . . . Cultural production is always (and necessarily) a matter of reworking, recombining, and redeploying already-existing symbolic forms, sounds, narratives, and images.”).

240. *Id.* at 197.

241. Geoffrey Golden, *The 10 Highest Earning Dead Celebrities*, CELEBRITY NET WORTH (Aug. 6, 2012), <http://www.celebritynetworth.com/articles/entertainment-articles/the-10-highest-earning-dead-celebrities/>.

242. Madow, *supra* note 21, at 185.

243. *Id.* at 187–88 (quoting Marshall Missner, *Why Einstein Became Famous in America*, 15 SOC. STUD. SCI. 267, 288 (1985)).

244. *Id.* at 195.

245. *But cf.* Jeffrey J. Brown, Note, *Defending the Right of Publicity: A Natural Rights Perspective*, 10 INTELL. PROP. L. BULL. 131, 139 (“Locke used the concept that one has property in one’s self as the fulcrum for his subsequent reasoning on property rights: one’s labor flows from one’s self. While labor is a potent ingredient in the formula of ownership, labor itself is not the moral basis for Locke’s Natural Rights theory. Labor is a moral component of property rights because it flows from the one thing an individual truly owns: one’s self. Thus, the moral basis for Locke’s Natural Rights theory is the self.”).

246. *See, e.g.,* Zac Estrada, *Barney Stinson, Err, Neil Patrick Harris Needs Help Buying a Minivan*, JALOPNIK (Mar. 30, 2013), <http://jalopnik.com/barney-stinson-err-neil-patrick-harris-needs-help-buy-462255369>.

the lines and moves of the suit-wearing, womanizing, yet playful playboy,<sup>247</sup> the character of Barney Stinson is also the amalgamation of writers, directors, and co-stars.<sup>248</sup> This instance presents the question of who should receive the fruits of Barney Stinson: Neil Patrick Harris<sup>249</sup> or a third party appropriating his image to sell merchandise?<sup>250</sup> Between the famous person and a third party, people generally believe the famous person should reap the fruits of the labor.<sup>251</sup> Therefore, even in the television sitcom context, the star deserves to reap the fruits of his persona.

Responding to the general sentiment of discouraging people from reaping where they have not sown, Madow vaguely alludes to principles of liberty<sup>252</sup> before proceeding to an even less persuasive brand of reasoning. He argues that anti-free-riding sentiment is not valid because, presently, there is no cause of action for this behavior in America.<sup>253</sup> Yet such an appeal to ignorance is not persuasive, especially considering that similar doctrines exist elsewhere.<sup>254</sup>

In conclusion, a Madow's critiques can be countered in at least two way. First, Madow's free speech concerns can be sufficiently mitigated if courts take into account traditional fair uses like commentary, criticism, news reporting, or political speech. Second, Madow significantly downplays the role a celebrity's labor plays in his or her fame. He fails to recognize the justification for the right of publicity under an anti-free-riding or unjust enrichment principle.

#### B. CRITICISM #2: PERFORMANCE VALUES SHOULD NOT BE PROTECTED BY THE RIGHT OF PUBLICITY

The typical right of publicity case involves "recognition" values as opposed to "performance" values.<sup>255</sup> Professor J. Thomas McCarthy believes that the right of publicity should protect a person's recognition value and that protecting performance values is not the right's purpose.<sup>256</sup>

247. *Barney Stinson*, WIKIPEDIA, [http://en.wikipedia.org/wiki/Barney\\_Stinson](http://en.wikipedia.org/wiki/Barney_Stinson) (last visited Apr. 22, 2013).

248. This divorce from reality is made especially apparent considering the "real" Neil Patrick Harris does not date women at all; he is engaged to his longtime partner David Burtka. Nardine Saad, *Neil Patrick Harris, David Burtka Haven't Split, Internet!*, L.A. TIMES (Feb. 28, 2013), <http://articles.latimes.com/2013/feb/28/entertainment/la-et-mg-neil-patrick>.

249. This statement assumes there are no contractual licensing or work-for-hire issues.

250. *Barney Stinson Suit Up TV Series Inspired Funny T-Shirt*, EBAY, <http://www.ebay.com/itm/himym-Barney-Stinson-Suit-Up-TV-Series-Inspired-Fun> (last visited Apr. 22, 2013).

251. See Franklyn, *supra* note 221, at 139.

252. Madow, *supra* note 21, at 200 ("A 'free-floating evil' of this kind seems hardly serious enough, all by itself, to overcome 'the standing case for liberty.'" (quoting 4 JOEL FEINBERG, *THE MORAL LIMITS OF THE CRIMINAL LAW: HARMLESS WRONGDOING* 214 (1988)).

253. Madow, *supra* note 21, at 201 ("But despite the renewed vigor of the so-called 'misappropriation doctrine,' there is still no general common law prohibition against benefiting from the commercial efforts of others.").

254. See *supra* Part IV.B for a discussion on Europe's unfair advantage claim.

255. MCCARTHY, *supra* note 12, § 8:24.

256. *Id.* § 11:55.

Professor McCarthy cites *Zacchini*, where the Ohio Supreme Court mistakenly analyzed the use of the plaintiff's cannonball performance as a right of publicity case rather than state copyright law, as the source of this confusion.<sup>257</sup> The U.S. Supreme Court's subsequent review of the plaintiff's performance through a right of publicity lens seems to affirm the performance value analysis. Accordingly, the belief that the right of publicity protects performance values "spread like a virus" to lower courts.<sup>258</sup> Considering all of the above, those following Professor McCarthy's ideas would likely criticize the Reality-Mimicking Predominant Use Test to the extent that it advocates for protecting performance values through the right of publicity. Specifically, one might critique the Reality-Mimicking Predominant Use Test's fourth factor, which asks courts to take into account the extent of the appropriation.

Misgivings about the Reality-Mimicking Predominant Use Test only come to the fore when balancing the right of publicity against First Amendment interests. The factors do not advocate for expanding the scope of the right of publicity itself. Rather, the factors afford the fact finder the opportunity to use all available evidence when balancing the right of publicity with the First Amendment. As discussed earlier, the *Hart* court acknowledged the extent to which EA's game used the players' identities, implying that EA's attempt to recreate the players in the very setting in which they created their fame speaks to EA's intent to leverage the players' identification value to increase sales. Hart and Keller would not be able to couch a copyright claim within their right of publicity cause of actions by arguing that EA replicated their prior performance. Each EA game played is a unique football simulation, not a replication of a real college football game. Thus, concerns that the Reality-Mimicking Predominant Use Test allows for protecting performance values prove misguided. Indeed, Professor McCarthy acknowledges that limiting the scope of a right of publicity claim to only identification values allays performance value concerns.<sup>259</sup>

Further, examining the degree of misappropriation addresses the economic concerns the Supreme Court discussed in *Zacchini*.<sup>260</sup> Professor McCarthy notes that in the context of impersonators or parodists, the nature or amount taken is an important area to examine: "A series of short impressions is one thing. A whole show or movie or television series based on the imitation of one performer is another . . . [because] it begins to deprive the original of actual or potential bookings."<sup>261</sup> Such "whole show"

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257. *Id.*

258. *Id.*

259. *Id.* ("If the scope of the tort of infringement of the right of publicity is properly limited to an assertion of identification values, not performance values, then there would be no federal-state conflict and no need to discuss preemption.")

260. *See Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

261. MCCARTHY, *supra* note 12, § 8:114; *see also* Victor S. Netterville, *Copyright and Tort Aspects of Parody, Mimicry and Humorous Commentary*, 35 S. CAL. L. REV. 225, 274-75 (1962) ("[A] counter-balancing factor might be the extent to which the use of one's name, likeness or imitated

takings resonate with the Supreme Court's policy rationale in *Zacchini* of not depriving the artist the fruits of his labor.<sup>262</sup> Thus, in the context of parodists and impersonators, Professor McCarthy would seemingly approve of such an inquiry into the degree used.

Finally, Professor McCarthy's suggested replacement claims of copyright and false endorsement<sup>263</sup> fail to adequately protect against appropriation of a performance in the unique scenarios created by the *Keller* and *Hart* cases. Under copyright, Professor McCarthy notes that unlike stage plays with "fixed" lines and stage directions, sports performances remain "unfixed" because there is no script.<sup>264</sup> Since federal copyright protection requires works to be fixed,<sup>265</sup> live sports performances do not qualify for protection. In the unique circumstances of a reality-mimicking videogames, like *NCAA Football*, federal copyright law provides no remedy for college football players because EA is not recreating a live performance; rather, EA and the game user create a new performance each time a game is played.<sup>266</sup> Thus, copyright protection does not protect the players' performance value because no prior performance is ever reproduced.

Similarly, a false endorsement claim under Lanham Act § 43(a) does not provide the players with adequate protection. Professor McCarthy proclaims that "[a]n attempt to fulfill the demand for the entertainment services of the 'original' by use of an imitator would be a clear case of false representation under Lanham Act § 43(a)."<sup>267</sup> Yet as the name indicates, § 43(a) requires false representation or designation.<sup>268</sup> Furthermore, a § 43(a) claim requires likelihood of confusion,<sup>269</sup> a requirement that is absent from a right of publicity claim. This distinction is important, particularly when applied to videogames, because it is difficult to argue that by inserting an avatar of a real person into a videogame, a game producer attempts to confuse the public that the avatar is actually the real person. The avatars are not literally the same as their real-life counterparts, but are merely portrayals of the real person. Indeed, in *Brown v. Electronic Arts, Inc.*, a California district court dismissed such a claim under summary judgment because "it would require a leap of logic to conclude that the anonymous, mis-numbered player's presence in the games equates to [NFL legend Jim] Brown's endorsement of the games."<sup>270</sup>

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performance is made for the purpose of or results in replacing the plaintiff or divesting the plaintiff of the opportunity to exploit the valuable attributes of his public personality.").

262. *Zacchini*, 433 U.S. at 576; MCCARTHY, *supra* note 12, § 8:114.

263. MCCARTHY, *supra* note 12, § 8:113.

264. *Id.* § 5:46.

265. 17 U.S.C. § 102(b) (2012).

266. Which, in and of themselves, would be subject to copyright protection as original works of art fixed in a tangible medium of expression.

267. MCCARTHY, *supra* note 12, § 8:113.

268. *See* 15 U.S.C. § 1125(a)(1).

269. 15 U.S.C. § 1125(a)(1)(A).

270. *Brown v. Elec. Arts, Inc.*, 2009 WL 8763151, at \*5 (C.D. Cal. Sept. 23, 2009).

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Arguments against adopting the Reality-Mimicking Predominant Use Test are misguided. The test is necessary because: (1) copyright and false endorsement law provide inadequate protection; (2) “whole show” takings deprive people the fruits of their labor; and (3) the proposed test does not expand the scope of the right of publicity, but merely directs courts to use all available evidence to determine the defendant’s predominant purpose.

## VI. CONCLUSION

The right of publicity is an extremely confusing area of law, particularly where First Amendment concerns surface in expressive works. This Article advocates for replacing the Transformative Use Test with a Reality-Mimicking Predominant Use Test in the context of videogames to increase predictability and decrease the chilling effects brought by uncertainty. In difficult cases, the test’s factors provide a more holistic approach to balancing the right of publicity with the First Amendment by allowing courts to consider evidence beyond the content of the work. Where evidence of intent to mimic reality is clear, like in *Keller* and *Hart*, courts should be able to penalize defendants to prevent free riding and unjust enrichment.