

# SO MANY WATERS UNDER THIS TROUBLED BRIDGE: NAVIGATING RIGHT OF PUBLICITY JURISPRUDENCE

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## INTRODUCTION

Right of publicity jurisprudence encompasses some of the most controversial issues in intellectual property law,

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particularly with respect to the problem of resolving conflicts between publicity rights and competing First Amendment interests.<sup>2</sup> Many legal commentators attribute much of the turbulent uncertainty to the absence of a single, definitive judicial balancing test for evaluating such conflicts. However, recent court decisions demonstrate the benefit of having a range of judicial tests for resolving these disputes.<sup>3</sup>

The thesis of this essay is that the prevailing publicity rights and First Amendment judicial balancing tests should not be viewed as inherently mutually exclusive; rather, these tests can and should be reconciled to form a “spectrum of adjudication” for resolving conflicts between these important interests. At the beginning of this spectrum lies unauthorized commercial speech, such as advertising, wherein First Amendment concerns are minimal and the balance generally weighs in favor of protecting publicity rights. Next are unauthorized “quasi-marketing” uses, such as the titles of works, which can involve important First Amendment interests and to which the *Rogers Test* should be applied to distinguish between permissible expressive uses and impermissible “disguised advertising.”

First Amendment concerns can be most critical when a publicity persona is incorporated into the body or substance of an unauthorized expressive work. In these situations, the *Comedy III* test should be applied to assess whether the subject persona has been appropriately “transformed” by the user such that on balance, the use

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<sup>2</sup> See generally James Schwabe, *Delay of Game: When Will the Supreme Court Tackle First Amendment Issue in Madden NFL? The Uncertain Future of The Right of Publicity*, 16 VA. SPORTS & ENT. L. J. 120 (2016); Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471 (2003).

<sup>3</sup> See, e.g., *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013).

should be allowed under the First Amendment.<sup>4</sup> Finally, in difficult or complex use-characterization situations, the Predominant Purpose test can equitably supplement an analysis derived under one of the foregoing tests.

Reconciling the leading publicity rights/First Amendment balancing tests to form an “adjudication spectrum” should bring clarity and predictability to judicial resolution of these conflicts. Courts should remain careful, however, to confirm that cognizable publicity and First Amendment interests actually conflict, prior to invoking *any* balancing test. Where courts cursorily presume a conflict between these rights, they risk unnecessary and improper application of an otherwise effective balancing test, as well as exacerbation of any uncertainty as to its scope and function. Through affirmative, preliminary evaluation of the parties’ respective claims, courts can avoid such confusion.

## **I. PUBLICITY RIGHTS: AN ABBREVIATED HISTORY**

The origins of the right of publicity can be traced to the landmark law review article by Samuel D. Warren and Louis D. Brandeis calling for judicial recognition of the right of privacy—“a right to be let alone.”<sup>5</sup> Eventually this right would be recognized as a distinct species of the right of privacy.

We think that in addition to and independent of [a] right of privacy . . . a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture. . . . This right might be called a ‘right of publicity.’ For it is common knowledge that many prominent persons

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<sup>4</sup> See e.g. *No Doubt v. Activision Publ’g, Inc.*, 122 Cal. Rptr. 3d 397, 405–12 (Cal. Ct. App. 2011); *Winter v. DC Comics*, 69 P.3d 473, 476 (Cal. 2003).

<sup>5</sup> See Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 195 (1890).

(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, busses, trains and subways.<sup>6</sup>

In 1960, Dean Prosser published a seminal article charting the various judicial conceptions of privacy rights and outlined four categories of privacy interests, including the right to protect one’s image or likeness from commercial misappropriation.<sup>7</sup> Thereafter, both the Restatement of Torts and the Restatement of Unfair Competition included the right of publicity.<sup>8</sup>

**A. *Elements and Scope of the Right of Publicity***

“The right of publicity is an intellectual property right . . . which has been defined as the inherent right of every human being to control the commercial use of his or

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<sup>6</sup> *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953); *see also* Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 203–04 (1954) (“Well known personalities...do not seek the ‘solitude and privacy’ which Brandeis and Warren sought to protect. . . . 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.”).

<sup>7</sup> William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960) (identifying “[i]ntrusion upon the plaintiff’s seclusion or solitude, or into his private affairs”; “[p]ublic disclosure of embarrassing private facts about the plaintiff”; “[p]ublicity which places the plaintiff in a false light in the public eye”; and “[a]ppropriation, for the defendant’s advantage, of the plaintiff’s name or likeness”).

<sup>8</sup> *See, e.g.*, RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995); RESTATEMENT (SECOND) OF TORTS § 652C (1977).

her identity.”<sup>9</sup> Although the right is today widely recognized, its scope and breadth continue to be the subject of discord and debate.<sup>10</sup> Perhaps the most significant controversy regarding the right of publicity surrounds its conflict with the First Amendment.<sup>11</sup> American society places high value on free and accurate discourse of public matters, including the roles of public and private individuals therein. If individuals were granted absolute control over the use of their personas in commercial contexts, including commercially distributed newspapers or history texts, they could effectively censor public discussion of factual matters and events.<sup>12</sup> “[T]he right of publicity cannot be used to prevent someone’s name or picture in news reporting. It cannot be used to prevent the use of identity in an unauthorized biography. It cannot prevent use of identity in

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<sup>9</sup> *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 928 (6th Cir. 2003).

<sup>10</sup> Almost every state recognizes the right of publicity under common law, by statute, or both. *See, e.g.*, J. THOMAS, 1 *THE RIGHTS OF PUBLICITY AND PRIVACY* 2D 6:3 (2018); Gregory L. Curtner et al., *Show and Tell: Misappropriation of the Right of Publicity*, in *COUNSELING CLIENTS IN THE ENTERTAINMENT INDUSTRY* 263 (2011); Jonathan Faber, *Statutes & Interactive Map*, *RIGHT OF PUBLICITY*, <http://rightofpublicity.com/statutes>.

<sup>11</sup> Yolanda M. King, *The Right-of-Publicity Challenges for Tattoo Copyrights*, 16 *NEV. L.J.* 441 (2016); James Schwabe, *Delay of Game: When Will the Supreme Court Tackle First Amendment Issue in Madden NFL? The Uncertain Future of The Right of Publicity*, 16 *VA. SPORTS & ENT. L.J.* 120 (2016). *See generally* *New York Right of Publicity: Reimagining Privacy and the First Amendment in the Digital Age- AELJ Spring Symposium 2*, 36 *CARDOZO ARTS & ENT. L.J.* 601 (2018); Jennifer Rothman, *The Right of Publicity: Privacy Reimagined for New York*, 36 *CARDOZO ARTS & ENT. L.J.* 573 (2018).

<sup>12</sup> *See, e.g.*, *Arrington v. N.Y. Times Co.*, 434 N.E.2d 1319 (N.Y. 1982); *Finger v. Omni Publ’ns Int’l*, 77 N.Y.2d 138 (1990); *Nussenzweig v. diCorcia*, 832 N.Y.S.2d 510 (N.Y. App. Div. 2007) (Tom, J.P., concurring).

an entertainment parody or satire, such as that of Rich Little or Saturday Night Live.”<sup>13</sup>

At the same time, however, the Supreme Court has observed that the right of publicity serves an important social utility function in providing incentives to invest effort and resources in the development and stylization of individual talent, skills, and attributes, and to achieve accomplishments in areas of public and popular interest.<sup>14</sup> “[T]he State’s interest in permitting a right of publicity is in protecting a proprietary interest of the individual in his act to encourage such entertainment. . . . [t]he State’s interest is closely analogous to patent or copyright law, focusing on the right of the individual to reap the reward of his endeavors . . . .”<sup>15</sup> Entertainers, athletes, and others, like authors and inventors, often make important social contributions at great personal sacrifice. “[C]elebrities ‘create’ their valuable personas in much the same way that a novelist creates a work of fiction or an inventor a new device. Thus, giving the famous individual a property right in this form of intellectual property has been explained as an incentive to promote future creativity, a reward for a valuable service to the public, or a means of preventing unjust enrichment.”<sup>16</sup>

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<sup>13</sup> J. Thomas McCarthy, *The Spring 1995 Horace S. Manges Lecture--The Human Persona as Commercial Property: The Right of Publicity*, 19 COLUM.-VLA J.L. & ARTS 129, 130–31 (1995); see also *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 969 (10th Cir. 1996); *Vinci v. Am. Can Co.*, 591 N.E.2d 793, 794 (Ohio Ct. App. 1990) (permitting unauthorized use of athletes’ personas where “the mention of the athletes’ names [was] within the context of accurate, historical information . . . [and] . . . purely informational.”).

<sup>14</sup> See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

<sup>15</sup> *Id.* at 576.

<sup>16</sup> Melissa B. Jacoby & Diane Leenheer Zimmerman, *Foreclosing on Fame: Exploring the Uncharted Boundaries of the Right of Publicity*, 77 N.Y.U. L. REV. 1322, 1330 (2002); see also Roberta Rosenthal Kwall, *The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis*, 70 IND. L. J. 47, 74 (1994) (identifying the “harms from the toleration of unauthorized uses of an individual’s persona [as]

While the *Zacchini* Court concluded that First Amendment interests do not axiomatically eclipse publicity rights, the Court did not articulate a mechanism for resolving conflicts between these respective rights.<sup>17</sup> As discussed in the next section, various courts have endeavored to fill this gap.

## II. THE LEADING PUBLICITY RIGHTS/FIRST AMENDMENT JUDICIAL BALANCING TESTS

### A. *Publicity Rights and Commercial Speech*

Courts have long held that commercial speech is not afforded full First Amendment status.<sup>18</sup> Accordingly, a First Amendment defense typically will not prevail where a publicity persona is used in unauthorized commercial speech.

For example, in *Jordan v Jewel Food Stores, Inc.*, *Sports Illustrated* produced a commemorative issue devoted to basketball Hall of Famer Michael Jordan, wherein Jewel Food Stores was offered free advertising space in exchange for its agreement to stock the magazine in its stores.<sup>19</sup> Jewel submitted a full-page “congratulatory message,” which included its trademarked logo and its marketing slogan “Good things are just around the corner,” positioned above a pair of basketball shoes bearing Jordan’s number “23.”<sup>20</sup>

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increased potential for consumer deception, and . . . increased potential for diminished incentives.”)

<sup>17</sup> *Zacchini*, 433 U.S. at 574-75 (“Wherever the line . . . is to be drawn between media reports that are protected and those that are not, we are quite sure that the First . . . Amendment [does] not immunize the . . . broadcast [of] a performer’s entire act without his consent.”).

<sup>18</sup> See, e.g., *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 478 (1989).

<sup>19</sup> 743 F.3d 509 (7th Cir. 2014).

<sup>20</sup> *Id.* at 512.

Jordan brought suit asserting, *inter alia*, misappropriation of publicity rights, against which Jewel defended on First Amendment grounds.<sup>21</sup> The court concluded that Jewel’s “congratulatory message” constituted unprotected commercial speech.<sup>22</sup>

Jewel’s ad . . . prominently features the ‘Jewel-Osco’ logo and marketing slogan, which are creatively and conspicuously linked to Jordan in the text of the ad’s congratulatory message. Based on its content and context, the ad is properly classified as a form of image advertising aimed at promoting the Jewel-Osco brand. The ad is commercial speech and thus is subject to . . . Jordan[’s publicity rights].<sup>23</sup>

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<sup>21</sup> *Id.* at 511.

<sup>22</sup> The court also noted that Jordan had mistakenly conceded that unless the congratulatory message constitutes commercial speech, it is protected by the First Amendment. *Jordan*, 743 F.3d at 514–15 (“The parties have agreed that if Jewel’s ad is ‘noncommercial speech’ . . . then the First Amendment provides a complete defense . . . We’re not sure that’s right . . .” “Even if Jewel’s ad qualifies as noncommercial speech, it’s far from clear that Jordan’s . . . claims fail without further ado. . . there is no judicial consensus on how to resolve conflicts between intellectual-property rights and free-speech rights; instead, the courts have offered ‘a buffet of various legal approaches to [choose] from’ . . .”).

<sup>23</sup> *Id.* at 511-12; *accord*, *Yeager v. AT&T Mobility, LLC*, 104 U.S.P.Q.2d 1165, 2012 WL 3778926, at \*2–3 (E.D. Cal. Aug. 31, 2012) (Wherein defendant’s press release for its mobile emergency service read “Nearly 60 years ago, the legendary test pilot Chuck Yeager broke the sound barrier and achieved Mach 1. Today, Cingular is breaking another kind of barrier with our MACH 1 and MACH 2 mobile command centers . . . .” The court affirmed Yeager’s jury verdict for publicity rights misappropriation, noting that “one purpose of the press release ‘was to create positive association in consumers’ minds” and accordingly the release constituted commercial speech.).



**B. “Quasi-Commercial” Speech: The Rogers  
Test**

One of the first publicity rights/First Amendment judicial balancing tests was promulgated by the Second Circuit in *Rogers v. Grimaldi*.<sup>24</sup> In *Rogers*, the contested use involved a reference to movie legend Ginger Rogers in a movie title, *Ginger and Fred*.<sup>25</sup> Rogers claimed that because the film was not about the famous Rogers and Astaire dance team, the title was merely an attempt to trade upon her celebrity persona.<sup>26</sup>

The court disagreed, finding that the title constituted protectable artistic expression.<sup>27</sup> The film’s subject was a satiric, social commentary on the Hollywood Glamour Age, featuring two fictional and decidedly unglamorous “contemporaries” of Rogers and Astaire.<sup>28</sup> Consequently, the court concluded that the unauthorized use was more akin to an expressive parody, as opposed to a deceptive marketing ploy:

In light of the [state’s] concern for the protection of free expression, [the court] would not expect [the state] to permit the right of publicity to bar the use of a celebrity’s name in a movie title unless the title was “wholly unrelated” to the movie or was “simply a disguised commercial advertisement for the sale of goods or services.” Here . . . the title “Ginger and Fred” is clearly related to the content of the movie and is not a disguised advertisement for the sale of goods or services or a collateral commercial product.<sup>29</sup>

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<sup>24</sup> 875 F.2d 994 (2d Cir. 1989).

<sup>25</sup> *Id.* at 997.

<sup>26</sup> *Id.*

<sup>27</sup> *Id.* at 1004–05.

<sup>28</sup> *Id.* at 996–97.

<sup>29</sup> *Id.* at 1004–05.

While the *Rogers* test is frequently invoked by publicity defendants, courts increasingly restrict its application to assessing the role of a publicity persona in the title of a work, which can be a means of marketing the work.<sup>30</sup> “Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion.”<sup>31</sup> Accordingly, courts apply the *Rogers* test in such “quasi-marketing” and related commercial contexts which present the prospect of false or misleading endorsement by the subject personality.<sup>32</sup>

### C. *The Comedy III Test*

Perhaps the most widely used publicity rights/First Amendment balancing test is that articulated by the California Supreme Court in *Comedy III Prods., Inc. v. Saderup*.<sup>33</sup> In *Comedy III*, defendant created and reproduced on T-shirts a lithograph drawing of the Three Stooges.<sup>34</sup> In response to plaintiffs’ publicity rights misappropriation claims, defendant argued that his rendering was protected First Amendment expression.<sup>35</sup>

In balancing the parties’ respective interests, the court noted:

What the [plaintiff] possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity’s fame through the merchandising of the ‘name, voice, signature, photograph, or likeness’ of the celebrity. . . . When artistic expression takes the

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<sup>30</sup> See *Davis v. Elec. Arts, Inc.*, 775 F.3d 1172, 1179 (9th Cir. 2015); *Hart v. Electronic Arts, Inc.*, 808 F. Supp. 2d 757, 788 (D.N.J. 2011), *rev’d on other grds.*, 717 F.3d 141 (3d Cir. 2013).

<sup>31</sup> *Rogers*, 875 F.2d at 998.

<sup>32</sup> See, e.g., *Hart*, 808 F. Supp. at 788.

<sup>33</sup> *Comedy II Prods., Inc. v. Saderup*, 21 P.3d 797 (Cal. 2001).

<sup>34</sup> *Id.* at 800–01.

<sup>35</sup> *Id.* at 801, 802.

form of a literal depiction or imitation of a celebrity for commercial gain . . . without adding significant expression . . . the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist . . . . 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.<sup>36</sup>

Given that defendant's use consisted solely of the Three Stooges' exact likenesses, the court concluded that their personas had not been "transformed" and thus "the marketability and economic value of [defendant's] work derives primarily from the fame of the celebrities depicted."<sup>37</sup>

The *Comedy III* test has become the leading test for balancing First Amendment and publicity rights in an unauthorized expressive work. Among other things, the test enables a court to scrutinize defendant's expressive contributions to evaluate whether consumer interest is motivated by such expression, or by the replication of the plaintiff's persona.<sup>38</sup>

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<sup>36</sup> *Id.* at 808–09. The court derived its test from the copyright Fair Use Doctrine, which permits the unauthorized use of copyrighted works. One factor considered under the Doctrine is whether the unauthorized use builds upon, repurposes, or otherwise "transforms" the copyrighted work. See Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1110 (1990); see also *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 574–77, 579 (1994).

<sup>37</sup> *Comedy III*, 21 P.3d at 811.

<sup>38</sup> See, e.g., *No Doubt*, 122 Cal. Rptr. 3d at 410–11 (applying *Comedy III* and holding that the unauthorized depiction of the plaintiff rock band in a video game "doing what they do" lacked sufficient transformation to outweigh the band's publicity rights: "In . . . *Band Hero* . . . the avatars perform rock songs, the same activity by which the band achieved . . . its fame. . . . That the avatars can be manipulated to perform at fanciful venues including outer space or to sing songs the real band would object to singing . . . does not transform the avatars into anything other than

### D. *The Predominant Purpose Test*

The Predominant Purpose test was promulgated in response to perceived deficiencies in the *Rogers* and *Comedy Three* tests. “The weakness of the . . . ‘relatedness’ . . . and . . . ‘transformative’ test[s] is that they give too little consideration to the fact that many uses of a [persona] have both expressive and commercial components. . . . Though these tests purport to balance the prospective interests involved, there is no balancing at all - once the use is determined to be expressive, it is [deemed] protected. . . .”<sup>39</sup>

The Missouri State Supreme court consequently adopted the Predominant Purpose test as a means by which to evaluate the overall commercial impact of an unauthorized use of a publicity persona.<sup>40</sup> “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*

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exact depictions of No Doubt’s members doing exactly what they do as celebrities.”); *accord, in re* NCAA Student-Athlete Name & Likeness Licensing Litigation, 724 F.3d 1268, 1276 (9th Cir. 2013) (defendant’s avatar “literally recreates Keller in the very setting in which he has achieved renown.”); *Hart*, 717 F.3d at 166 (“[t]he digital Ryan Hart 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 a college football game.”). *But cf. Winter*, 69 P.3d at 476 (stating that comic book depictions of rock star personas as half human, half worm creatures in a fantasy tale held protected transformative use.).

<sup>39</sup> *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003); *see also* Lateef Mtima, *What’s Mine Is Mine but What’s Yours Is Ours*, 15 SMU SCI. & TECH. L. REV. 323, 384 (2012) (“Some courts . . . employ the transformative test to evaluate . . . the overall expressive quality of the defendant’s work, which misconstrues the purpose of the test. While [such] assessment . . . may be relevant to analyzing whether the work is copyrightable, it may say little or nothing about the impact of [defendant’s expressive contributions] on the plaintiff’s . . . publicity interests.”).

<sup>40</sup> *Doe*, 110 S.W.3d at 374.

*Amendment*, even if there is some “expressive” content in it that might qualify as ‘speech’ in other circumstances.<sup>41</sup> Although the Predominant Purpose test has not been widely adopted, it nonetheless provides courts the opportunity to consider the actual commercial impact of an unauthorized use.<sup>42</sup>

### III. THE PUBLICITY RIGHTS/FIRST AMENDMENT “ADJUDICATION SPECTRUM”

Each of the foregoing balancing tests addresses a different category of use for publicity personas. While many commentators advocate for a single, omnibus test, the courts have demonstrated that a one-size-fits-all approach is neither practical nor necessary.<sup>43</sup> Properly construed, the foregoing tests can be reconciled to comprise a comprehensive “adjudication spectrum” or framework for judicial balancing of publicity rights and First Amendment interests when they conflict.

The adjudication spectrum begins with commercial speech such as advertising: the primordial impetus for recognition of publicity rights and wherein First Amendment interests are at their nadir. Courts generally have little difficulty construing First Amendment and other precedent to weigh the balance in favor of protecting publicity rights in these cases.<sup>44</sup>

Certain “quasi-marketing” activities are close to commercial speech; however, as demonstrated in *Rogers*,

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<sup>41</sup> *Id.* (adopting the test proposed in Lee, *supra* note 2, at 500).

<sup>42</sup> Like the *Whelan* non-literal copyright infringement test, the Predominant Purpose test is often inaccurately characterized as insufficiently nuanced. See e.g. *Comput. Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 705–06 (2d Cir. 1992).

<sup>43</sup> See e.g. *Hart*, 717 F.3d 141. Cf. *in re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d at 1276.

<sup>44</sup> See, e.g., *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 416 (9th Cir. 1996).

they can nonetheless involve protectable expression.<sup>45</sup> Titles of works are one such example; product packaging may be another. The *Rogers Test* has proven particularly effective in distinguishing between permissible, expressive “quasi-marketing” activity and impermissible “disguised advertising.”<sup>46</sup>

First Amendment concerns are typically most significant where a publicity persona is incorporated into the body or substance of an expressive work. In such cases, the *Comedy III* test is most appropriate toward assessing whether the subject persona has been appropriately “transformed,” such that the use should be allowed as protected First Amendment expression.

Finally, some situations will present difficult or complex use-characterization issues, wherein the application of the pertinent test leaves some penumbral ambiguity. In such cases, the Predominant Purpose test can augment a court’s analysis under one of the other tests. For example in *ETW Corp. v. Jireh Pub., Inc.*, upon considering both *Rogers* and *Comedy III*, the court concluded that an unauthorized, limited-edition print of Tiger Woods’ 1997 Masters Tournament victory constitutes protectable expression, notwithstanding the fact that the print prominently features Woods’ exact likeness.<sup>47</sup> “Corroborative application” of the Predominant Purpose test lends ballast to the court’s ultimate assessment that the artist’s purpose was “to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods’s achievement in that event”.<sup>48</sup>

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<sup>45</sup> *Rogers*, 875 F.2d at 997.

<sup>46</sup> Accordingly, a growing number of courts restrict *Rogers* to “quasi-marketing” and similar uses which might cause consumer confusion. See, e.g., *Davis*, 775 F.3d at 1179.

<sup>47</sup> *ETW Corp. v. Jireh Pub., Inc.*, 332 F. 3d 915 (6th Cir. 2013).

<sup>48</sup> *Id.* at 938. Similarly, in *Doe*, while the plaintiff’s persona initially provided only the inspiration for defendant’s fictional character,

Augmentative invocation of the Predominant Purpose test can also be helpful in fashioning remedies in “close” cases, as it allows courts to acknowledge that some uses are “expressive/commercial hybrids.” In such cases, a court might thus refuse to enjoin the unauthorized use, but instead require payment of a publicity-license fee.<sup>49</sup>

**A. The “Pre-Balancing/ Anti-SLAPP”  
Threshold**

While the organization of the prevailing balancing tests into a publicity rights/First Amendment adjudication spectrum enhances the efficacy of the tests, courts should nonetheless remain careful to first confirm that cognizable publicity and First Amendment interests are in fact present and in conflict before resorting to any of these tests. When a court gives insufficient consideration to this prerequisite, it risks improper application and obfuscation of an otherwise effective balancing test.

Some courts undertake this preliminary analysis pursuant to a statutory “Anti-SLAPP” procedure. For example, in California:

[t]he Anti-SLAPP statute is designed to discourage suits that masquerade as ordinary lawsuits but are

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defendant subsequently paired plaintiff’s actual photograph with the character to market products towards plaintiff’s hockey fan base. *Doe*, 110 S.W.3d at 363. In short, defendant deployed a transformative use toward a marketing (and predominantly) commercial purpose. Supplemental application of the Predominant Purpose test can also be useful in evaluating unauthorized merchandising uses, to consider *both* defendant’s transformation of, and primary purpose for using, a publicity persona.

<sup>49</sup> See *eBay v. MercExchange, L.L.C.*, 547 U.S. 388, 391-92 (2006); see also King, *supra* note 11, at 447–48. Professor King cogently argues for application of the Predominant Purpose test to unauthorized celebrity “persona tattoo” uses, in as much as such uses can involve *both* expressive and commercial objectives.

brought to deter common citizens from exercising their political or legal rights . . . . [Under the statute the] defendant must first make a prima facie showing that the plaintiff’s suit arises from an act by the defendant made in connection with a public issue in furtherance of the defendant’s right to free speech . . . . Second . . . we evaluate whether the plaintiff has establish[ed] a reasonable probability that [she] will prevail on . . . her [publicity] . . . claim.<sup>50</sup>

In *Sarver v. Chartier*, Sarver served as an Explosive Ordinance Disposal Technician during the war in Iraq.<sup>51</sup> The defendant journalist wrote an article about plaintiff’s wartime experiences, which he later developed into the screenplay for the film *The Hurt Locker*.<sup>52</sup> Sarver brought suit, contending that the film’s main character was based on him and thus infringed upon his right of publicity.<sup>53</sup>

Defendants moved for dismissal under California’s “Anti-SLAPP” statute.<sup>54</sup> The court had little difficulty finding that the film’s subject matter involved “matters of public concern.”<sup>55</sup> The court then concluded that Sarver had failed to how the film encompassed his publicity interests:

[U]nlike the plaintiffs in *Zacchini* [and similar cases] Sarver did not make the investment required to produce a performance of interest to the public, . . . or . . . a marketable . . . identity. . . . Neither the journalist who initially told Sarver’s story nor the movie . . . stole Sarver’s entire act or otherwise exploited the economic value of any performance or persona he had worked to develop. . . . *The Hurt Locker* is speech that

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<sup>50</sup> *Sarver v. Chartier*, 813 F.3d 891, 901 (9th Cir. 2016) (quotations omitted).

<sup>51</sup> *Sarver*, 813 F.3d at 901.

<sup>52</sup> *Id.* at 896.

<sup>53</sup> *Id.*

<sup>54</sup> *Id.*

<sup>55</sup> Although Sarver argued that the film was about his individual role in the War, the court disagreed, finding that the film was about Sarver’s *occupation* in the War as a military demolition expert. *Id.* at 902.



is fully protected by the *First Amendment*, which safeguards the storytellers and artists who take the raw materials of life—including the stories of real individuals, ordinary or extraordinary—and transform them into art, be it articles, books, movies, or plays.<sup>56</sup>

In short, whereas defendants demonstrated an important First Amendment interest in making *The Hurt Locker*, Sarver had no pertinent publicity right to be weighed against that interest.<sup>57</sup>

Similarly, in *Lohan v. Take-Two Interactive Software*,<sup>58</sup> the court rejected plaintiff's claim that a digital avatar in the video game "Grand Theft Auto V" constituted her protectable "portrait" within the meaning of the New York right of publicity statute.<sup>59</sup> After noting that the statute was "cabined . . . 'to avoid any conflict with the free dissemination of thoughts, ideas, newsworthy events, and matters of public interest,'" the court concluded that plaintiff had not demonstrated any cognizable, much less conflicting, publicity interest.<sup>60</sup>

Manifestly, there can be no appropriation of "[a] plaintiff's [likeness]...if he or she is not recognizable from the [image in question]"....Here, the [avatar] simply is not recognizable as plaintiff inasmuch as it

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<sup>56</sup> *Id.* at 905 (quotations omitted).

<sup>57</sup> See also *De la Huerta v. Lions Gate Entm't Corp*, No. B271844, 2017 WL 4676234 at \*3, \*6 (Cal. Ct. App. Oct. 18, 2017), wherein actress brought publicity suit when her film dialogue was dubbed without her permission. Granting defendants' Anti-SLAPP motion, the court held "[defendant's] decision to use a voice double to rerecord [plaintiff's] lines . . . is a creative decision implicating a matter of public interest . . . within . . . the anti-SLAPP statute." *Id.* at \*3. In contrast, plaintiff's publicity claim was preempted by federal copyright law as "her performance was a 'work made for hire' [within the] Copyright Act." *Id.* at \*6.

<sup>58</sup> 31 N.Y.3d 111 (N.Y. 2018).

<sup>59</sup> *Id.* at 120–21.

<sup>60</sup> *Id.* at 120.

merely is a generic artistic depiction of a ‘twenty something’ [and] the “indistinct, satirical representations of the style, look, and persona of a modern, beach-going young woman that are not reasonably identifiable as plaintiff.”<sup>61</sup>

In *Sarver*, *De la Huerta*, *Lohan*, and similar cases, the courts resolved purported publicity rights and First Amendment conflicts without resort to *any* balancing test. There is no need to “balance” these interests where only one of these rights is actually at issue.<sup>62</sup> To avoid improper application of a balancing test, courts should take care to confirm *cognizable legal interests on both sides* of the subject dispute.<sup>63</sup> By first undertaking an “Anti-SLAPP-styled” claim assessment, courts can diminish confusion as to how and when each of these tests should be used.

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<sup>61</sup> *Lohan*, 31 N.Y.3d at 122–23. *But cf.* *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397–01 (9th Cir. 1992) (finding a depiction of celebrity as a robot actionable); *Midler v. Ford Motor Co.*, 849 F.2d 460, 462–64 (9th Cir. 1988) (ruling on the intentional imitation of popular singer’s voice); *see also* *King*, *supra*, note 11, at 449 (“[W]hen the medium is the body of a celebrity, and the tattoo becomes more associated with the celebrity tattoo bearer’s identity...the tattoo...serv[es] as indicia of the celebrity’s identity.”).

<sup>62</sup> *See, e.g.*, *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1002 (9th Cir. 2001) (finding unauthorized use of surfers’ photograph as “window dressing” for a “spring fever” themed sales catalogue “does not contribute significantly to a matter of the public interest” and thus not entitled to First Amendment protection); *see also* *Lee*, *supra* note 2, at 498 (“[B]road-brush arguments concerning the expansiveness of “speech” address only half of the issue. The right of publicity-free speech interface involves not merely the constitutional right to ‘speak,’ but also the right to control one’s property.”).

<sup>63</sup> *See, e.g.*, *Davis*, 775 F.3d at 1179 (undertaking Anti-SLAPP analysis, finding *both* First Amendment and publicity interests, and concluding that the latter interest prevails); *accord*, *Hunter v. CBS Broad., Inc.*, 221 Cal. App. 4th 1510 (2013) (analyzing First Amendment versus Equal Protection interests); *see also* *Mtima*, *supra* note 39, at 382–84 (arguing for such preliminary “cognizable legal interest” analysis as part of a balancing framework).

## CONCLUSION

The unauthorized use of publicity personas can implicate a variety of important social utility issues, from adequate protection for First Amendment interests to other social justice concerns.<sup>64</sup> Reconciling the leading publicity rights/First Amendment balancing tests into a comprehensive adjudication spectrum will assist courts in undertaking more nuanced and uniform balancing of these important legal rights. Properly applied, this balancing framework can provide further clarity and predictability to judicial resolution of these disputes.

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<sup>64</sup> See *in re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d at 1273 n.5 (discussing the social equities involved in the commercial exploitation of student athlete personas, where the students, many from inner city neighborhoods and rural towns, are themselves precluded by NCAA rules from exploiting their images. “The NCAA received revenues of \$871.6 million in fiscal year 2011-12, with 81% of the money coming from television and marketing fees. However, few college athletes will ever receive any professional compensation. The NCAA reports that in 2011, there were 67,887 college football players. Of those . . . only 255 athletes were drafted for a professional team. Thus, only 1.7% of seniors received any subsequent professional economic compensation for their athletic endeavors.”); *Parks v. LaFace Records*, 329 F.3d 437, 453 (6th Cir. 2003) (discussing whether use of Civil Rights icon persona in a rap song is appropriately “relevant” expression); Anjali Vats & Deidre A. Keller, *Critical Race IP*, 36 CARDOZO ARTS & ENT. L.J. 735 (2018); Andrew Gilden, *IP, R.I.P.*, 95 WASH. U. L. REV. 639 (2017) (exploring the dignity and other perspectives of the publicity figure’s heirs); Kirsten West Savali, *Jordan Edwards’ Family: ‘We Are Not Ready to Make a Martyr of Our Son’*, THE ROOT (May 5, 2017), <https://www.theroot.com/jordan-edwards-family-we-are-not-ready-to-make-a-martyr-1794961566> (discussing family’s plea against use of late son’s name as a hashtag); Randy Kennedy, *White Artist’s Painting of Emmett Till at Whitney Biennial Draws Protests*, THE NEW YORK TIMES (Mar. 21, 2017), [https://www.nytimes.com/2017/03/21/arts/design/painting-of-emmett-till-at-whitney-biennial-draws-protests.html?\\_r=0](https://www.nytimes.com/2017/03/21/arts/design/painting-of-emmett-till-at-whitney-biennial-draws-protests.html?_r=0) (discussing the controversy regarding white artist’s gallery presentation of her depiction of black lynching victim).

