

## FROM NOW TO ETERNITY: WHAT WENT WRONG WITH PUBLICITY RIGHTS

MIRA MOLDAWER\*

Introduction.....	107
I. The Arena of Copyright Law .....	125
A. Transformative Use v. Publicity Rights.....	125
B. Revisiting Transformative Use .....	131
II. The Arena of Trademark Law.....	140
A. The Rise and Fall of Rogers Test.....	141
B. The Rise and Fall of the Commercial Speech.....	145
III. What is the Future of Publicity Rights? .....	152

---

\* © Mira Moldawer, ORCID: 0000-0002-7989-6406. Attorney at Law; Director and Senior Acting Instructor, Beit Zvi, School of the Performing Arts, Israel; BFA in Theatre & Directing (Cum Laude); Instructors Course Drama Centre, London, U.K; LL.B. Tel – Aviv University; M.A. Thesis Program in Law, Technology and Business Innovation, Harry Radzyner Law School, Reichman University (Summa Cum Laude); Ph.D. (Summa Cum Laude), Harry Radzyner School of Law, Reichman University; This article continues my Ph.D. thesis. I wish to thank Prof. Lior Zemer for his supervision, Prof. Roberta Rosenthal Kwall and Prof. Dov Greenbaum for giving me the honor of serving on my committee, and Prof. Shlomit Yanisky-Ravid and Prof. Lior Barshack for giving me the honor of taking part in my examination committee. I also thank Harry Radzyner Law School, Reichman University's senior staff and colleagues for their suggestions, and my family and friends for their love and support. I am also thankful to the IDEA: THE LAW REVIEW OF THE FRANKLIN PIERCE CENTER FOR INTELLECTUAL PROPERTY team for their sharp editorial eye and constructive criticism.

FROM NOW TO ETERNITY: WHAT WENT WRONG WITH  
PUBLICITY RIGHTS 107

A. The Preliminary Maze of Digital NIL Authorship ... 156

B. Hohfeld’s Legal Relations as an Organizing Principle..... 160

C. The New Phenomenon of Digital NIL Authorship ..... 163

Conclusion ..... 172

INTRODUCTION

This article argues that publicity rights, as a “legal metastasis,” threaten to devour all current paradigms of copyright and trademark law, not only in the present, but from now to eternity, regarding their metamorphosis into digital replicas.<sup>1</sup> Initially, the gist of publicity rights sounds simple, regarded as “the right to prevent unauthorized commercial uses of one’s name, image, or likeness (NIL) or other aspects of one’s identity (such as one’s voice).”<sup>2</sup>

---

<sup>1</sup> See generally David Lange, *Reimagining the Public Domain*, 66 L. & CONTEMP. PROBS. 463, 467–68 (2003) (regarding publicity rights and dilution as a kind of metastasis in the law and relating to his previous article which explains: “I turned then to what I had begun to see as a kind of metastasis in the law, particularly in the developing law of publicity, but no less so in the laws of trademark dilution and unfair competition (of the misappropriation variety), both of which latter doctrines had troubled me before.”); David Lange, *Recognizing the Public Domain*, 44 L. & CONTEMP. PROBS. 147 (1981); see also Wendy J. Gordon, *On Owning Information: Intellectual Property and the Restitutionary Impulse*, 78 VA. L. REV. 149, 152–53 (1992) (arguing the tort of “misappropriation” was grounded in the phenomenon she calls sisterly rights, that begot publicity rights on the one hand and dilution in trademark law on the other hand, which are all embedded in the restitution paradigm).

<sup>2</sup> CHRISTOPHER T. ZIRPOLI, CONG. RSCH. SERV., LSB11052, ARTIFICIAL INTELLIGENCE PROMPTS RENEWED CONSIDERATION OF A FEDERAL RIGHT OF PUBLICITY 1 (2024).

Nothing could be more misleading. Rightly described as “a patchwork quilt of state-law causes of actions for using names, likenesses and other indicia of persona without permission,” referring to misappropriation, publicity rights evolved from the right of privacy into the strongest intellectual property (“IP”) rights in our legal system.<sup>3</sup>

Much scholarship admits the blurry theoretical infrastructure that attempts to justify the “property turn” taken by the courts, expanding publicity rights far beyond commercial advertisements, initially serving as a new category for necessary legal rights in contrast to dignitary harms protected by the tort of privacy.<sup>4</sup> Although most scholars sharply differentiate between the right of privacy—coined by Samuel D. Warren and Louis D. Brandeis as “the right to be left alone,” which is essentially meant to protect hurt feelings—and the commercial nature of publicity rights, which focus on controlling the commercial use of one’s identity and preventing its unauthorized appropriation, prominent scholars prove this dichotomy to be an oversimplification.<sup>5</sup> Accordingly, the right of publicity and

---

<sup>3</sup> PATRICK KABAT, *THE RIGHT OF PUBLICITY: THROUGH THE THICKET? THE REPORT OF THE RIGHT OF PUBLICITY WORKSHOP AT YALE LAW SCHOOL 1* (2015) [hereinafter *THE YALE WORKSHOP REPORT*].

<sup>4</sup> *Id.* at 1–2 (quoting *Ettore v. Philco Television Broad Corp.* 229 F.2d 481, 485 (3d Cir. 1956), “By the 1950s, after half a century of largely privacy-driven jurisprudence, RoP claims were broadly recognized enough to warrant their own collective name, but neither the court that christened it nor others that followed it had a coherent understanding of what this “right” protected, or its limits, and quickly complained that “[t]he state of the law is still that of a haystack in a hurricane.”).

<sup>5</sup> Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 193 (1890). This dichotomy was created in *Haelan Lab’ys, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953). As explained by Roberta Rosenthal Kwall, *A Perspective on Human Dignity, the First Amendment, and the Right of Publicity*, 50 B.C. L. REV. 1345, 1345–46 (2009), while the right of publicity is intended to control the commercial use of one’s identity and prevent its unauthorized appropriation, the right to privacy is meant to protect hurt feelings. For

the right of privacy are intertwined, with the latter being the original right of publicity, intended to block “unwarranted publicity” about oneself.<sup>6</sup>

However, two benchmarks of publicity rights are the common premise of current research. First, in *Haelan Laboratories*, two rival companies secured the use of leading baseball players’ photographs to enhance sales, while the defendant knew about an already existing contract between the baseball players and the plaintiff before luring them to sign his.<sup>7</sup> The defendant’s claim for exemption from liability was based on his perception of Sections 50 and 51 of the New York Civil Rights Law as dealing with the invasion of the right of privacy, which is not a property right. It follows that as a right of privacy, it is not an assignable right, and no legal interest was invaded.<sup>8</sup> The Second Circuit created the often-quoted dichotomy between the dignitary interests of publicity rights, intended to defend bruised feelings, and the publicity rights as property rights with full assignability.<sup>9</sup> Thus, the Second Circuit added a new crucial dimension to publicity rights as property rights through transferability, evolving into posthumous rights.<sup>10</sup>

---

a contrary review of publicity rights’ development *see* Jennifer E. Rothman, *The Right of Publicity’s Intellectual Property Turn*, 42 COLUM. J.L. & ARTS 277, 279 (2019).

<sup>6</sup> JENNIFER E. ROTHMAN, *THE RIGHT OF PUBLICITY: PRIVACY REIMAGINED FOR A PUBLIC WORLD* 4 (Harvard Univ. Press 2018); Rothman, *supra* note 5, at 279.

<sup>7</sup> *Haelan Lab’ys.*, 202 F.2d at 867.

<sup>8</sup> *Id.*

<sup>9</sup> *Id.* at 268 (“We think that, in addition to and independent of that right of privacy . . . a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture . . . For it is common knowledge that many prominent persons . . . 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.”).

<sup>10</sup> For the evolution of assignability and duration as the first traits to indicate the transition of publicity rights from a tort to a property right,

Second, in *Zacchini v. Scripps-Howard Broadcasting Co.* (“*Zacchini*”), the only publicity rights case to reach the Supreme Court of the United States, the plaintiff’s entire fifteen-second act as a human cannonball, shot from a cannon into a net 200 feet away, was copied by the defendant with no authorization.<sup>11</sup> In the majority opinion delivered by Judge Byron White, the Court refused the defendant the protection of the First and the Fourteenth Amendments due to the copying of the plaintiff’s act in its entirety.<sup>12</sup> The outcome was not just the supremacy of publicity rights, but its ideological equation to copyright law infrastructure, thus creating the conjoined authorship of the right of publicity with copyright law.<sup>13</sup> Hence, some major

---

see Daniel Gervais & Martin L. Holmes, *Fame, Property, and Identity: The Scope and Purpose of the Right of Publicity*, 25 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 181, 215 (2014) (describing how various states’ enactments of a postmortem right of publicity statute were their reactions to the refusal of the courts to recognize publicity rights as posthumous, while arguing that “the right of publicity should end with a person’s death, or soon thereafter,” to morph it back into a privacy tort). For illustrating the different implications caused by the metamorphosis from assignability to descendibility, culminating in publicity rights as posthumous rights regarding Elvis Presley’s ample adjudication, see Mira Moldawer, *ELVIS Act: From Authorship to Ownership in Intellectual Property Law*, 33 *TEX. INTELL. PROP. L.J.* 19, 26–30 (2024).

<sup>11</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 563–64 (1977).

<sup>12</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 11 (“[t]he claim at issue in *Zacchini* was not a ‘right of publicity’ claim as we know it today, but a unique variant involving the wholesale appropriation of a *performance*, rather than an individual likeness.”) (stating in bolder words, “As one discussant observed, the plaintiff’s claim in *Zacchini* would have been the same if he had launched a pig, rather than himself, from the canon—the claim was for that act and about the plaintiff’s right to monetize it by performing it in its entirety, not the plaintiff’s personal likeness and his right of publicity to enjoin depictions of it.”).

<sup>13</sup> *Zacchini*, 433 U.S. at 566–68 (holding that the First and Fourteenth Amendments do not immunize the news media when they broadcast a performer’s entire act without his consent). For prominent scholars claiming that the *Zacchini* Court sought to close the gap in copyright law’s coverage by recognizing *Zacchini*’s claim under the state’s right

justifications for publicity rights echo copyright law, the first being the dominant incentive approach “[t]o create or efficiently manage valuable personae.”<sup>14</sup> The legal interpretation of persona management means “providing legal protection for the economic value in one’s identity against unauthorized commercial exploitation [which] creates a powerful incentive for expending time and resources to develop the skills or achievements prerequisite to public recognition.”<sup>15</sup>

Second, the Lockean/labor approach, according to which the labor of the artist is the focus and the commercially marketable public image or persona is viewed as its product, created through its labor.<sup>16</sup> In terms of preventing unjust enrichment, the contest between the persona and the unauthorized appropriator of its image is used as a doctrinal vehicle to strengthen the Lockean approach, framed as “sower versus reaper.”<sup>17</sup>

Third is the personhood approach, whose premise is that personality and its development are the driving forces of

---

of publicity, see Robert C. Post & Jennifer E. Rothman, *The First Amendment and the Right(s) of Publicity*, 130 YALE L.J. 86, 98 n.48–49 (2020).

<sup>14</sup> *Id.* at 12; see *Mazer v. Stein*, 347 U.S. 201, 219 (1954); see also *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (claiming that the main purpose of copyright is to “secure a fair return for an ‘author’s’ creative labor” by creating this incentive “to stimulate artistic creativity for the general public good.”).

<sup>15</sup> *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 840 (Cal. 1979) (Bird, C.J., dissenting).

<sup>16</sup> See Noa Dreyman, *John Doe’s Right of Publicity*, 32 BERKELEY TECH. L.J. 673, 683–84 (2017). For the Lockean/labor approach regarding publicity rights, see Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 125, 181–96 (1993).

<sup>17</sup> *Cf.* THE YALE WORKSHOP REPORT, *supra* note 3, at 12 (phrasing this principle as “[a]n equitable intuition that such control is inherently fair, or necessary to prevent unjust enrichment.”). For coining “sower vs. reaper,” see Madow, *supra* note 16, at 196.

humankind, evolving in European legal systems—especially in France, Germany, and Italy—to the recognition of authors’ moral rights (*droit moral*), the most important of which are the right of attribution and the right of integrity.<sup>18</sup>

However, this is only a fraction of the justification arsenal of publicity rights, as their common traits with trademark law have led scholars to link them with “a form of consumer protection to stave off false personal endorsements.”<sup>19</sup> To make matters worse, publicity rights are a sisterly doctrine to dilution in trademark law, but as a publicity rights lawsuit does not require consumer deception, it is not distinct from copyright.<sup>20</sup> However, the deterioration of the consumer confusion test in trademark law into “a mere likelihood of association test,” instead of the customary likelihood of consumer confusion, blurs the distinction between trademark and the right of publicity laws.<sup>21</sup>

---

<sup>18</sup> KIM TREIGER- BAR-AM, *POSITIVE FREEDOM AND THE LAW* 167–68 (2019) (“The Anglo-American incentive model is instrumental: authors are presumed to rely upon the incentive of copyright protection and profits for their efforts of creation. The Continental deontological models for authors’ rights (*droit d’auteur*) are rights in property (in France) and personality (in Germany). Copyright is often considered to exist on two norms and, indeed, as caught between them. Yet both instrumental and deontological aspects of the doctrine function side by side . . . . Moral rights in copyright may be termed deontological rights.”).

<sup>19</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 12.

<sup>20</sup> Compare Rebecca Tushnet, *Raising Walls Against Overlapping Rights: Preemption and the Right of Publicity*, 92 NOTRE DAME L. REV. 1539, 1545 (2017), with Post & Rothman, *supra* note 13, at 111 (“The aspect of the right of commercial value that is based on confusion is analogous to trademark infringement and false endorsement laws that protect against confusion as to the source or sponsorship of products and services.”).

<sup>21</sup> Barton Beebe, *What Trademark Law Is Learning from the Right of Publicity*, 42 COLUM. J.L. & ARTS 389, 394 (2019) (“In sum, what is conventionally recognized as one of the fundamental distinctions between trademark law and right of publicity law—that the former

The historical evolution of publicity rights from the right to privacy led scholars to follow this track by advocating the dignity and autonomy values that equate publicity rights with moral rights, thus creating a symmetrical justification to the personhood approach of copyright law, although attempting to justify publicity rights as rights per se.<sup>22</sup> The borderline between publicity right as a tort of property and a property right was unclear even in *Haelan Laboratories*, as Judge Frank found that the “‘property right’ [label] is immaterial . . . [as] the tag ‘property’ simply symbolizes the fact that courts enforce a claim which has pecuniary worth.”<sup>23</sup>

Following Dean Prosser’s legacy of defining the fourth prong of the tort of privacy as the appropriation of another’s name or likeness, it is plausible to assume that the lawsuit’s label matters with regard to its implications.<sup>24</sup> Dean Prosser’s “privacy” title has two contradictory facets, as he did not remove it from the privacy framework.<sup>25</sup> Because the personal and commercial facets of the injuries

---

requires a showing of consumer confusion while the latter does not—has arguably become a distinction without a difference.”).

<sup>22</sup> See 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, 166 (2001); Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 418, 420–21, 427–28, 468 (1999); Jennifer E. Rothman, *Navigating the Identity Thicket: Trademark’s Lost Theory of Personality, the Right of Publicity, and Preemption*, 135 HARV. L. REV. 1271, 1271 (2022) (“Current jurisprudence provides little to no guidance on the most basic questions surrounding this thicket, such as what right to use a person’s identity, if any, flows from the transfer of marks that incorporate indicia of a person’s identity, and whether such transfers can empower a successor company to bar a person from using their own identity and, if so, when.”).

<sup>23</sup> *Haelan Lab’ys, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

<sup>24</sup> William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960).

<sup>25</sup> See *id.* at 406.



are intertwined, privacy gets different meanings by each aspect.

Not only does controlling the persona identity create a legal maze, as every scholar creates a spectrum of justifications, but the conjoined authorship with copyright law leads to an irreconcilable gap regarding its ingredients.<sup>26</sup> Whereas the sine qua non of copyrightability is the fixation of the relevant work in a tangible form, in the case of persona authorship, the personality itself is the work in question.<sup>27</sup> Jennifer Rothman delineates the impossibility of publicity rights authorship by asking:

Are we talking about the author of the underlying film or the underlying work, or instead, are we perhaps talking about a different type of authorship—meaning authorship over oneself, one’s name, or one’s

---

<sup>26</sup> Compare Tushnet, *supra* note 20, at 1539 (“The right of publicity overlaps with trademark in its protections against false endorsement, with copyright in its (supposed) justifications in incentivizing performances, and with traditional privacy and defamation torts in protecting personal dignity and control over one’s own presentation of the self. Yet the right of publicity has been used to extend plaintiffs’ control over works and uses that don’t violate any of the rights with which it shares a justification. This quicksilver nature is what makes the right of publicity so dangerous.”), with THE YALE WORKSHOP REPORT, *supra* note 3, at 12 (identifying six overlapping rationales in publicity rights case law: “(1) an incentive-based rationale to create or efficiently manage valuable personae; (2) a form of consumer protection to stave off false personal endorsements; (3) a privacy-based rationale accepting that persons have emotional interests in controlling untoward disseminations of their likenesses; (4) an expression-based right that protects an individual’s freedom to make use of her image as an aspect of public self-definition; (5) a sense of moral authorship in one’s person, that we own our personas and should be able to control their use; and (6) an equitable intuition that such control is inherently fair, or necessary to prevent unjust enrichment.”).

<sup>27</sup> For fixation as the sine qua non of copyrightability, see David E. Shipley, *Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673, 703–04 (1981).

likeness? This latter notion of being the author of oneself is the purview of the right of publicity.<sup>28</sup>

Thus, the persona fails to cross the threshold of the first prong required for copyrightability, the subject matter prong.<sup>29</sup> When the first prong is met, the following stage needs to answer the second prong, known as the general scope requirement, which covers the works of authorship protected by copyright law, including the reproduction, adaptation, publication, performance, and display of those works.<sup>30</sup>

The preemption doctrine protects only rights that are equivalent to copyright.<sup>31</sup> “[T]he focus of the ‘equivalency’ analysis is on whether the ‘nature’ of a state law action ‘is qualitatively different from a copyright infringement claim.’”<sup>32</sup> Therefore, the preemption doctrine as a restraining vehicle is lost vis-à-vis publicity rights, especially regarding their posthumous traits, which in some states surpass their copyright counterpart.<sup>33</sup>

---

<sup>28</sup> Jennifer E. Rothman, *The Other Side of Garcia: The Right of Publicity and Copyright Preemption*, 39 COLUM. J.L. & ARTS 441, 441 (2016).

<sup>29</sup> 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.17 (Matthew Bender rev. ed., 2024) [hereinafter NIMMER ON COPYRIGHT] (“To specify, the ‘work’ that is the subject of the right of publicity is the *persona*, i.e., the name and likeness of a celebrity or other individual. A *persona* can hardly be said to constitute a ‘writing’ of an ‘author’ within the meaning of the Copyright Clause of the Constitution. *A fortiori*, it is not a ‘work of authorship’ under the Act.”).

<sup>30</sup> 17 U.S.C. § 106.

<sup>31</sup> *Urbont v. Sony Music Ent.*, 831 F.3d 80, 93 (2d Cir. 2016) (stating that the U.S. Copyright Act of 1976 preempts “state law claims asserting rights equivalent to those protected within the general scope of the statute.”).

<sup>32</sup> *Melendez v. Sirius XM Radio, Inc.*, 50 F.4th 294, 308 (2d Cir. 2022).

<sup>33</sup> See *Right of Publicity, Statutes & Interactive Map*, RIGHT OF PUBLICITY, <https://rightofpublicity.com/statutes> [<https://perma.cc/4MKG-7XQK>] [hereinafter RIGHT OF PUBLICITY] (showing the current legal status of the right of publicity in each state); Jennifer E. Rothman, *Right of Publicity State-by-State*, ROTHMAN’S

The lack of fixation shakes the conjoined publicity rights authorship with copyright law, specifically concerning the most important dichotomy of copyright law that makes it constitutional: the idea/expression dichotomy.<sup>34</sup> At the same time, the persona's defended traits were expanded to its evocation in *White v. Samsung Electronics America, Inc.*, in which the use of a robot wearing a wig and outfit that resembled Vanna White, famous for her role in the Wheel-of-Fortune TV game show, was considered a violation of the latter's right of publicity ("RoP"), ruining the idea/expression principle.<sup>35</sup> Patrick Kabat provided a summary regarding the outcome of RoP's lack of fixation:

Indeed, because the RoP has no "fixation" or concreteness requirement, the multiplicity of "likeness"-invoking speech included within the RoP suggests that the RoP forbids expression that embodies the idea of a person, not the manner in which that person has reduced that *idea* to tangible expression through individual authorship, putting the analogy at odds with well-recognized limitations on copyright.<sup>36</sup>

---

ROADMAP TO RIGHT OF PUBLICITY,  
<https://www.rightofpublicityroadmap.com> [<https://perma.cc/5MMZ-UP5R>] [hereinafter ROTHMAN'S ROADMAP].

<sup>34</sup> Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's "Total Concept and Feel,"* 38 EMORY L.J. 393, 395 (1989) ("[The idea/expression dichotomy] is perhaps the most important limit on the unwarranted expansion of copyright. It operates by denying protection to the ideas which underlie copyrightable works. Consequently, only the original 'expressions' contained in these works can actually receive copyright protection. This makes certain portions (the 'ideas') of every work freely available for others to copy. Such permitted borrowing from copyrighted works ostensibly keeps copyright from unduly restricting speech and running afoul of the First Amendment.").

<sup>35</sup> *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1396, 1398 (9th Cir. 1992).

<sup>36</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 26.

However, despite the complex issues caused by publicity rights conjoining authorship with copyright law, the issue of what constitutes its authorship is neglected.<sup>37</sup> Regardless of scholarship claiming persona authorship to be constantly created and remodeled by its users, this aspect is omitted from all relevant scholarship that assumes persona is created solely by the person, just as exclusive authorship is granted to a sole author of a book or a poem.<sup>38</sup> Therefore, the unsolved infrastructure of publicity rights evolving into unrestrained yet unjustified authorship, compared to its copyright law counterpart, challenges our IP systems regarding First Amendment concerns.

The question posed is: If publicity rights are not preempted and the principle of the idea/expression collapses, what is left to square with the First Amendment?<sup>39</sup> This

---

<sup>37</sup> The embedment of publicity rights under copyright law, thus causing their conjoined authorship, was titled by Judge Deanell Tacha of the United States Court of Appeals for the Tenth Circuit as “a red herring” in *Cardtoons, LC v. Major League Baseball Players Ass’n*, 95 F.3d 959, 973 (10th Cir. 1996) (“The Supreme Court’s sole case involving a right of publicity claim, is a red herring.”).

<sup>38</sup> See, e.g., RICHARD DYER, *HEAVENLY BODIES: FILM STARS AND SOCIETY* 137–91 (2d ed. 2004) (showing the public as a crucial component in the persona/celebrity creation and consumption of the greatest stars of the Golden Age of Hollywood); Madow, *supra* note 16 (analyzing what constitutes fame, and why the persona is not entitled to all its fruits in its entirety); ROSEMARY J. COOMBE, *THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES: AUTHORSHIP, APPROPRIATION, AND THE LAW* 89 (1998) (“Celebrity names and images, however, are not simply marks of identity or simple commodities; they are also cultural texts—floating signifiers that are continually invested with libidinal energies, social longings, and, I will argue, political aspirations.”). As summed up by Marilyn Monroe: “If I am a star – the people made me a star, no studio, no person, but the people did” (retrieved from Dean MacCannell, *Marilyn Monroe Was Not a Man*, 17 *DIACRITICS* 114, 115 (1987)).

<sup>39</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 13 (“Moreover, as another discussant pointed out, these property- and incentive-based rationales subvert a fundamental First Amendment presumption: that the restriction, not the speech, must justify itself.”).

question should be analyzed regarding the two arenas relevant to publicity rights. The first arena is copyright law, in which publicity rights are embedded due to *Zacchini's* legacy.<sup>40</sup> The second arena is trademark law, which prominent scholars claim is the appropriate IP law under which wingspan publicity rights should be located.<sup>41</sup> In both arenas, this article attempts to demonstrate a similar process. First, the conflict with the First Amendment is delineated. Second, there seems to be a judicial cure. Third, the Supreme Court of the United States rejects this cure, thus returning to all the problems that initiated the process to begin with.

Part I discusses the metamorphosis of the transformative use as the first possible solution to square publicity rights with the First Amendment within the copyright law arena. First, the gaining of supremacy for the first fair use factor and incentivizing creativity, *Campbell v. Acuff-Rose Music, Inc.* questioned the appellant's "Pretty Woman" commercial parody, which was claimed to be infringing Roy Orbison's rock ballad, "Oh, Pretty Woman," to which the respondent held the copyright.<sup>42</sup>

Second, *Campbell's* legacy resulted in new originality and First Amendment chaos by creating genre discrimination between a protected parody and an infringing satire, thus forsaking the long-standing tradition of protecting any threshold of an artistic work, provided it is not copied.<sup>43</sup> While publicity rights adjudication seems to

---

<sup>40</sup> See generally Mira Moldawer, *Publicity Rights and Copyright Law: Conjoined Authorship as a Red Herring*, 45 LOY. L.A. ENT. L. REV. 27 (2024).

<sup>41</sup> Mark A. Lemley, *Privacy, Property, and Publicity*, 117 MICH. L. REV. 1153, 1170–71 (2019).

<sup>42</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 573, 580, 593 (1994).

<sup>43</sup> Bruce P. Keller & Rebecca Tushnet, *Even More Parodic than the Real Thing: Parody Lawsuits Revisited*, 94 TRADEMARK REP. 979, 985–92

embrace the transformative use, in practice, it morphed into a double request to answer it. Using persona as raw material in a larger story was no longer sufficient to cross the required threshold; the likeness of the persona should also be transformed, thus creating a sub-transformative test within the transformative test.<sup>44</sup>

Following the narrowing artistic scope of publicity rights' transformative test, deriving from genre-discrimination and judicial bias, transformative use morphed into different tests at war with each other, in which publicity rights' commerciality is always at war with the creativity requested.<sup>45</sup> In addition to the transformative use test, the tests in question are the predominant use test, the actual malice test, the relatedness/restatement test, the *Rogers* test, and the ad-hoc test.<sup>46</sup>

*De Havilland v. FX Networks, LLC* seemed to provide a judicial cure, as the lawsuit unsuccessfully attempted to enjoin the production of the eight-part docudrama, *Feud: Bette and Joan*, about 1960s film stars Bette Davis and Joan Crawford's rivalry, in which Catherine

---

(2004) (indicating that the courts find difficulties distinguishing between the two).

<sup>44</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 22.

<sup>45</sup> Mira Moldawer, "What is an Author" of a Persona? *The Taming of the Shrew—Rephrasing Publicity Right*, 20 VA. SPORTS & ENT. L.J. 156, 174–76 (2021).

<sup>46</sup> Kwall, *supra* note 5, at 1357–62 (offering the Transformative Use Test, the Predominant Use Test, the Actual Malice Test, the Relatedness/Restatement Approach, and the Ad Hoc Balancing Approach); see also Matthew Savare & John Wintermute, *A Haystack in a Hurricane: Right of Publicity Doctrine Continues to Clash with New Media*, 32 COMPUT. & INTERNET LAW. 1, 2 (Aug. 2015). In comparing Kwall's classifications to Savare & Wintermute's, what Kwall regards as the ad hoc balancing approach is not existent in Savare & Wintermute's, which instead refers to the *Rogers* test from *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), a test that is not considered an independent standard on its own merits in Kwall's classification.

Zeta-Jones portrays her as a close friend of the former.<sup>47</sup> The *De Havilland* Court reversed the trial court's denial to strike the complaint on all four causes of action under California's anti-SLAPP law, Code of Civil Procedure Section 425.16., based on the error of the sub-transformative test within the transformative test.<sup>48</sup> Namely, because *Feud*'s portrayal of de Havilland was realistic, the work was not considered "transformative."<sup>49</sup>

Unfortunately, in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith* ("Andy Warhol Foundation"), the Supreme Court of the United States held that the late Andy Warhol's unauthorized use of the respondent's photograph was infringing, rephrasing *Campell*'s legacy by subjecting the first fair use factor to commercial assessment.<sup>50</sup> What was considered a mere infringing copy by the majority in *Andy Warhol Foundation* was regarded as a transformative use, marked by the unique style of Andy Warhol by the trial court, rendering the transformative use even more elusive.<sup>51</sup> Thus, squaring publicity rights with the First Amendment is even harder, as its main vehicle has been legally weakened.

Part II analyzes how the second arena of trademark law squares publicity rights with the First Amendment by tracing the evolution of the *Rogers v. Grimaldi* test ("Rogers test").<sup>52</sup> Ginger Rogers brought Lanham Act and publicity rights claims to enjoin Fellini's *Ginger and Fred*, which depicts two washed-up and aging dancers who built their careers by impersonating the Hollywood Golden Age

---

<sup>47</sup> *De Havilland v. FX Networks, LLC*, 21 Cal. App. 5th 845, 850 (Cal. Ct. App. 2018).

<sup>48</sup> *Id.* at 852, 862–63.

<sup>49</sup> *Id.* at 863.

<sup>50</sup> *See Andy Warhol Foundation v. Goldsmith*, 598 U.S. 508, 525, 550–51 (2023).

<sup>51</sup> *Id.* at 522.

<sup>52</sup> *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

glamorous couple and are ultimately crushed by the current show business culture.<sup>53</sup> Rogers' claims are not cut from the same cloth, as publicity rights do not require consumer confusion, which is essential to lawsuits anchored in the Lanham Act.<sup>54</sup>

The powerful *Rogers* test requires two prongs.<sup>55</sup> First, § 43(a) will not be applied to expressive works unless the trademark use has no artistic relevance to the underlying work.<sup>56</sup> Second, § 43(a) will be applied only if the alleged infringement is explicitly misleading as to the source or the content of the work.<sup>57</sup> The *Rogers* test's rise to power is linked to trademark law's evolution. Trademark law's first prong, incarnated in its triad model of a 'signifier' (the tangible form of the mark), a 'signified' (the mark's meaning), and a 'referent' (the product itself), was meant to avoid consumer confusion.<sup>58</sup>

However, the first prong became obsolete once trademarks and brands evolved into commodities in their own right.<sup>59</sup> Thus, the first prong was devoured by the second prong of dilution, which is intended to protect the

---

<sup>53</sup> *Id.* at 996–97.

<sup>54</sup> *Id.* at 1004.

<sup>55</sup> *Id.* at 999.

<sup>56</sup> *Id.*

<sup>57</sup> *See Id.* at 1000.

<sup>58</sup> Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 625 (2004).

<sup>59</sup> *Id.* at 625, 656–57; Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 397–98, 400 (1990):

[I]deograms that once functioned solely as signals denoting the source, origin, and quality of goods, have become products in their own right, valued as indicators of the status, preferences, and aspirations of those who use them. Some trademarks have worked their way into the English language; others provide bases for vibrant, evocative metaphors. In a sense, trademarks are the emerging lingua franca: with a sufficient command of these terms, one can make oneself understood the world over, and in the process, enjoy the comforts of home.



trademark's goodwill.<sup>60</sup> Consequently, *Rogers'* reasoning that artistic and literary works should be protected unless they explicitly mislead consumers led courts to forget consumer confusion.<sup>61</sup> The recent *Jack Daniel's Properties, Inc. v. VIP Products LLC* ("*Jack Daniel's*") decision changed this trajectory.<sup>62</sup>

In *Jack Daniel's*, the plaintiff, renowned for its high-quality Tennessee whiskey boasting of 40% alcohol by volume, sued the manufacturer of the Silly Squeakers line of chew toys for infringement of the Lanham Act.<sup>63</sup> The plaintiff claimed that the defendant was misleading customers and hurting the plaintiff's goodwill by recalling the plaintiff's "Old No. 7 brand" and "Tennessee Sour Mash Whiskey," labeling one of the chew toys as "The Old No. 2 on Your Tennessee Carpet," and declaring "43% Poo by Vol" and "100% Smelly."<sup>64</sup>

The United States Court of Appeals for the Ninth Circuit followed the *Rogers* test and held the parodied appellant's trademark and trade dress to be attached to an "expressive work" and not explicitly misleading regarding endorsement by the plaintiff, whereas the Supreme Court focused on the first prong of avoiding consumer confusion.<sup>65</sup> Therefore, the *Rogers* test, meant to be the trademark law cure to the flawed balance of publicity rights with the First Amendment, lost its supremacy.

---

<sup>60</sup> See Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996) (codified as amended in scattered sections of 15 U.S.C.); see Zachary Shufro, *Based on a True Story: The Ever-Expanding Progeny of Rogers v. Grimaldi*, 32 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 391, 410–15 (2022).

<sup>61</sup> Shufro, *supra* note 60, at 410–15.

<sup>62</sup> See *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 163 (2023).

<sup>63</sup> *Id.* at 144, 149.

<sup>64</sup> *Id.* at 148–50.

<sup>65</sup> *Id.* at 152, 161.

As this article attempts to demonstrate, the same phenomenon occurs concerning the rise and fall of commercial speech. Whereas previous adjudications of the Supreme Court of the United States acknowledged that commercial speech is entitled to First Amendment protection the same as its non-commercial counterpart, this trajectory was reversed in *Vidal v. Elster*.<sup>66</sup> Steve Elster was denied registration by the Patent and Trademark Office (“PTO”) for the trademark “Trump too small” for use on shirts and hats, due to 15 U.S.C. § 1052(c) of the Lanham Act (the “names clause”), which prohibits the registration of a mark that “[c]onsists of or comprises a name . . . identifying a particular living individual except by his written consent.”<sup>67</sup>

In addition, the PTO also denied registration of the mark under § 1052(a)’s false association clause, which bars registration of trademarks that “falsely suggest a connection with persons, living or dead.”<sup>68</sup> The Trademark Trial and Appeal Board (“Board”) affirmed the PTO’s decision, rejecting Elster’s claims for a First Amendment right to free speech.<sup>69</sup> The *Vidal* Court chose to diminish the conflict between publicity rights and the First Amendment to a free-speech challenge regarding a viewpoint-neutral, content-

---

<sup>66</sup> Compare *Vidal v. Elster*, 602 U.S. 286, 310 (2024), with *Matal v. Tam*, 137 S. Ct. 1744 (2017), *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (for a contradictory judicial trajectory regarding squaring the commercial speech with the First Amendment).

<sup>67</sup> *Vidal*, 602 U.S. at 291–92 (alteration in original) (citations omitted) (citing 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 13:37, at 31 (5th ed. 2024) in reference to the names clause, excluding from registration “not only full names but also surnames, shortened names, and nicknames, so long as the name does in fact identify a particular living individual.”).

<sup>68</sup> *Id.* at 292 n.1.

<sup>69</sup> *Id.* at 292.

based condition on trademark registration, ignoring the real message of the entire requested trademark.<sup>70</sup>

Part III attempts to analyze the future trajectory of publicity rights, reflected in the massive new legislation regarding their extension as digital NIL, i.e., the digital replica of the name, image, and likeness of the individual's identity in a much broader sense, including any "other indicia of identity," following publicity rights legislation and adjudication.<sup>71</sup> Whereas neither publicity rights authorship nor their metamorphosis into a legal hybrid has been resolved, the new legislation, backed by the *Register Of Copyrights Report* and the *USPTO NIL Roundtable*, creates a new legal phenomenon of digital NIL authorship.<sup>72</sup>

Accordingly, the language of torts, intended to shield rightsholders from misappropriation, gains supremacy over IP rights restraints designed to square IP rights with the First Amendment, in contrast to the IP Clause of the United States Constitution. It follows that the already existing failure of publicity rights to square their exaggerated power with the First Amendment is not solved but rather enhanced, because instead of dealing only with digital NIL as the second layer of publicity rights, their first flawed layer is left intact. Thus, the cost of all the constitutionally untaken roads accumulates.

---

<sup>70</sup> *Id.* at 292–94.

<sup>71</sup> Ann Chaitovitz, U.S. PAT. AND TRADEMARK OFF., TRANSPARENCY STAKEHOLDER LISTENING SESSION: *Name, Image, and Likeness Protection in the Age of AI* 5 at ll. 7–14 (Aug. 5, 2024) <https://www.uspto.gov/sites/default/files/documents/080524-USPTO-Ai-NIL.pdf> [<https://perma.cc/55JG-5TAT>] [hereinafter USPTO NIL ROUNDTABLE].

<sup>72</sup> U.S. COPYRIGHT OFF., *Copyright and Artificial Intelligence Part 1: Digital Replicas*, A REPORT OF THE REGISTER OF COPYRIGHTS (July 2024), <https://www.copyright.gov/ai/Copyright-and-Artificial-Intelligence-Part-1-Digital-Replicas-Report.pdf> [<https://perma.cc/8HWS-FW9V>] [hereinafter REGISTER OF COPYRIGHTS REPORT]; USPTO NIL ROUNDTABLE, *supra* note 71.

Lastly, I conclude by claiming publicity rights to be a threat to all the current paradigms of copyright and trademark laws and their balance with the First Amendment. This phenomenon is the result of publicity rights' conjoined yet different authorship with copyright law. While they share copyright law's infrastructure, they are not bound by its idea/expression dichotomy or the preemption clause. Due to their blurry and unjustified theoretical infrastructure, publicity rights enhance their unsolved authorship reflected by their second layer: digital NIL. The transformative use, already open to contradictory interpretations, was greatly diminished by *Andy Warhol Foundation*.

From the prism of trademark law, the recent *Jack Daniel's* case subjected the *Rogers* test to trademark's first prong, thus weakening its importance in reshaping the balance of publicity rights with the First Amendment. In addition, commercial expression, a crucial factor in constituting publicity rights, lost First Amendment protection in the recent *Vidal v. Elster* case. As the flawed balance of publicity rights with the First Amendment is left intact by the new phenomenon of digital NIL authorship, we are bound to follow this trajectory from here to eternity.

## I. THE ARENA OF COPYRIGHT LAW

### A. *Transformative Use v. Publicity Rights*

As the idea/expression principle of copyright law was practically erased in *White*, the only shield left to square the conjoined authorship of publicity rights with copyright law is transformative use.<sup>73</sup> The evolution of transformative use into the quintessence of fair use is a good example of how the road to hell is paved with good intentions. Gaining supremacy in *Campbell*, following Judge Pierre Leval's

---

<sup>73</sup> *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1396–99 (9th Cir. 1992).

legacy, the idea was to cure copyright balance by enhancing its initial goal to incentivize creativity.<sup>74</sup>

In *Campbell*, the U.S. Supreme Court found the first statutory factor of fair use, the purpose and character of the use, to be the dominant criterion of the first use doctrine.<sup>75</sup> However, its application created a new chaos of genre and blurred the parody/satire dichotomy.<sup>76</sup> Accordingly, whereas “the heart of any parodist’s claim [is] to quote from existing material,” and thus the parodist is bound to use “some elements of a prior author’s composition to create a new one that, at least in part, comments on that author’s works,” a satire “can stand on its own two feet and so requires justification for the very act of borrowing.”<sup>77</sup>

Further, *Campbell* created a new originality and First Amendment chaos.<sup>78</sup> First, *Campbell* bypassed the legacy of *Bleistein v. Donaldson Lithographing Co.*, which held that the originality threshold for copyrightability could be satisfied with minimal artistic quality.<sup>79</sup> Second, it followed that the originality criterion for a work of authorship and a derivative work requires different thresholds.<sup>80</sup> Third, as demonstrated by prominent scholars, not only did the courts find difficulties distinguishing between a parody defended by fair use and infringing satire, but they paved a slippery

---

<sup>74</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 (1994); Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1109 (1990) (“[A]ll intellectual creative activity is in part derivative. There is no such thing as a wholly original thought or invention. Each advance stands on building blocks fashioned by prior thinkers.”).

<sup>75</sup> *Campbell*, 510 U.S. at 578–79.

<sup>76</sup> *Id.* at 580–81.

<sup>77</sup> *Id.*

<sup>78</sup> *Id.* at 593.

<sup>79</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903).

<sup>80</sup> 1 NIMMER ON COPYRIGHT, *supra* note 29, § 3.03 (“However, in order to qualify for a separate copyright as a derivative or collective work, the additional matter injected in a prior work, or the manner of rearranging or otherwise transforming a prior work, must constitute more than a minimal contribution.”).

slope for artistic discrimination depending on genres and the arbitrary taste of the judges.<sup>81</sup> The consequence is that constitutional protection is withdrawn from a whole arsenal of media and expressive works, once biased as mass-marketed “‘low’ or ‘popular’—videogames, comic books, t-shirts, greeting cards, and other visual art forms.”<sup>82</sup>

*Campbell*’s mechanism, adopting one factor of the four-part fair use analysis as a condition for First Amendment protections, culminating with the transformative use test, was first applied by the California Supreme Court in *Comedy III Productions, Inc. v. Gary Saderup, Inc.* (“*Comedy III*”) regarding publicity rights.<sup>83</sup> The plaintiff, who owned the rights to *The Three Stooges*, sued the defendants for misappropriation of their publicity rights by creating and using the faces of the Stooges’ drawing on lithographs and t-shirts.<sup>84</sup> However, as demonstrated by *The Yale Workshop Report*, while the use of a persona as raw material in a larger story was sufficient to satisfy the required threshold under *Comedy III*’s transformative use standard, later adjudication required that the likeness of the persona also be transformed, thus creating a sub-transformative test within the transformative test.<sup>85</sup>

The narrowing artistic scope of publicity rights transformative test, deriving from genre-discrimination, judicial bias, and a twisted interpretation of *Comedy III*’s rationale, is further exacerbated as it morphs into conflicting tests where the commerciality of publicity rights is

---

<sup>81</sup> Keller & Tushnet, *supra* note 43, at 985–92; THE YALE WORKSHOP REPORT, *supra* note 3, at 5 (“Each of these unfortunate tendencies – new-medium prejudice, high-art bias, and visual-image preoccupation – played prominent roles in the judicial trend . . .”).

<sup>82</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 5.

<sup>83</sup> *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001); Gil Peles, *Comedy III Productions v. Saderup*, 17 BERKELEY TECH. L.J. 549 (2002).

<sup>84</sup> *Comedy III*, 21 P.3d at 800–01.

<sup>85</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 22.

perpetually at odds with the requested creativity.<sup>86</sup> In addition to the transformative use test conceived in *Comedy III*, the tests in question are the predominant use test, the actual malice test, the relatedness/restatement test, the *Rogers* test, and the ad-hoc test.<sup>87</sup>

The “predominant use test” requires the allegedly infringing work to be primarily expressive rather than primarily commercial.<sup>88</sup> This test can easily be interpreted through the transformative test lens, as “transformative” is replaced by “expressive” without adding any value or meaning to the new component<sup>89</sup>.

The third test, the actual malice test, was adopted in *Hoffman v. Capital Cities/ABC, Inc.* (“*Hoffman*”).<sup>90</sup> The *Hoffman* court held that a magazine article that used the digitally altered image of Dustin Hoffman in *Tootsie*, wearing a contemporary designer dress and heels to demonstrate spring fashions, was noncommercial speech because not only did the article not intend to sell a particular product, but the article aimed to comment on Hollywood’s past and present, combining fashion, photography, humor, and visual and verbal editorial comment.<sup>91</sup> The *Hoffman*

---

<sup>86</sup> See Moldawer, *supra* note 45, at 174–76 (surveying the combat within the transformative test of publicity rights).

<sup>87</sup> *Comedy III*, 21 P.3d at 808; *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003); *Hoffman v. Cap. Cities/ABC, Inc.*, 255 F.3d 1180, 1186 (9th Cir. 2001); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (Am. L. Inst. 1995); *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1989); Kwall, *supra* note 5, at 1361–64 (showing the ad-hoc test’s problematic classification); Savare & Wintermute, *supra* note 46, at 2 (offering additional ad-hoc tests).

<sup>88</sup> *Id.*; *TCI Cablevision*, 110 S.W.3d at 374.

<sup>89</sup> *TCI Cablevision*, 110 S.W.3d at 373–74.

<sup>90</sup> Moldawer, *supra* note 45; *Hoffman*, 255 F.3d at 1186.

<sup>91</sup> *Hoffman*, 255 F.3d at 1185–86 (“It is a complement to and a part of the issue’s focus on Hollywood past and present. Viewed in context, the article as a whole is a combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors. Any commercial aspects are ‘inextricably entwined’ with expressive

court used the “actual malice” standard applicable in defamation cases to determine the overriding issue regarding the Lanham Act, the state law right-of-publicity claims, and the First Amendment defense involved in the case.<sup>92</sup> It was proven that there was no “actual malice” to mislead readers into believing that they were seeing Hoffman’s body in an altered photograph of him; thus, the “actual malice” standard morphed into another version of transformative use.<sup>93</sup>

The fourth test, the relatedness/restatement approach, stresses the use of another’s identity solely to attract attention to the defendant’s work, with no justified nexus to it, thereby rephrasing the fair/transformative use test.<sup>94</sup> In a sense, the gist of unauthorized appropriation is developed in the *Rogers* test, which some scholars classify as an independent test, while others regard it as an ad hoc classification, accommodating miscellaneous tests.<sup>95</sup>

The fifth test, the *Rogers* test, was initiated by another Hollywood golden era icon, Ginger Rogers, attempting to enjoin the distribution of the 1986 Federico Fellini film *Ginger and Fred*.<sup>96</sup> The *Rogers* Court held that “section 43(a) of the Lanham Act does not bar a minimally relevant use of a celebrity’s name in the title of an artistic work where the title does not explicitly denote authorship, sponsorship, or endorsement by the celebrity or explicitly mislead as to content.”<sup>97</sup> Hence, artistic value prevails if

---

elements, and so cannot be separated out ‘from the fully protected whole.’ ‘There are commonsense differences between speech that does no more than propose a commercial transaction and other varieties,’ and common sense tells us this is not a simple advertisement.”).

<sup>92</sup> *Id.* at 1183–84, 1186–87.

<sup>93</sup> *Id.* at 1189.

<sup>94</sup> Moldawer, *supra* note 45.

<sup>95</sup> Compare Savare & Wintermute, *supra* note 46, at 1–2, with Kwall, *supra* note 5, at 1361–64 (showing different classifications of the conflicts between the First Amendment and the right of publicity).

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

<sup>97</sup> *Id.* at 1005.



there is no explicit intent to mislead commercially, which was the essence of Ginger Rogers' lawsuit against Fellini for infringing her commercial image.<sup>98</sup>

The sixth test, the ad hoc test, problematically contains every possible test not previously in use and is the amalgamation of some of the tests above.<sup>99</sup> However, scholars differ in their classification. While some scholars refer to the ad hoc balancing test as an independent test, others do not recognize it as independent but offer the *Rogers* test as a different classification, which is not unanimously acknowledged.<sup>100</sup>

The constant disharmony is the natural outcome of publicity rights' unsolved legal justification and the erroneous embedment in copyright law. Their metamorphosis to IP rights with all the lucrative benefits, yet without sufficient First Amendment restraints led *The Yale Workshop Report* to conclude that "[c]ompounding the problem, courts have borrowed the speech-restricting analyses without the speech-protective aspects of copyright law."<sup>101</sup> *The Yale Workshop Report* reflected on the legal problems of publicity rights in 2015.<sup>102</sup> Hence, the question is: What happened ever since? There was a ray of hope that the balance of publicity rights with the First Amendment was

---

<sup>98</sup> *Id.* at 996–97, 1005.

<sup>99</sup> Kwall, *supra* note 5, at 1361–64 (showing the ad hoc test's problematic classification); Savare & Wintermute, *supra* note 47, at 2 (offering additional ad-hoc tests).

<sup>100</sup> Compare Kwall, *supra* note 5, at 1361–64, with Savare & Wintermute, *supra* note 46, at 2.

<sup>101</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 26 ("And unlike the law of copyright, where restrictions on speech are only permitted to the extent that they can be shown to promote more original expression, the RoP is purely negative. The essence of the claim is a right to prevent speech: entitling claimants to forbid speech or extract rents for uses of a likeness that already exists, and serving primarily as a wealth-generating or censorial device by likeness-holders and their assigns.").

<sup>102</sup> See generally, THE YALE WORKSHOP REPORT, *supra* note 3.

changing for the benefit of the public. The short life of this ray is discussed in the following section.

**B. Revisiting Transformative Use**

*The Yale Workshop Report* claims that the inherent contradiction of publicity rights—conjoining authorship with copyright law—evolved into the latter’s transformative test, which was erroneously applied by federal courts in order to exclude documentary-realistic works from its scope.<sup>103</sup> Thus, many errors were combined, such as genre discrimination, the artistic bias of the judiciary, and the First Amendment’s neglect.<sup>104</sup> The possibility of rephrasing transformative use, thus apparently solving those problems, was demonstrated in *De Havilland*.<sup>105</sup>

Olivia de Havilland, one of the Hollywood golden era’s icons, a two time Academy-Award winner, remembered for her roles in *Gone With The Wind*, *The Heiress*, and many others, sued the respondents who created and produced the eight-part docudrama, *Feud: Bette and Joan*, nominated for eighteen Emmy awards, in which her

---

<sup>103</sup> Compare *id.* at 24 (“At bottom, the transformative use test, as it has been applied by recent federal courts, appears to do precisely what Comedy III promised not to: constrain authors entirely to the realm of the fantastical.”), with *Right of Publicity*, ELECTRONIC FRONTIER FOUNDATION, <https://www EFF.ORG/issues/right-publicity> [https://perma.cc/ZH3Z-FBGK] (“Right of publicity cases raise important freedom of expression issues. When celebrities claim that a TV show or some other work violates their right of publicity, the cases effectively ask whether celebrities should have a veto right over creative works that depict them. Courts have struggled to develop a coherent test for how the First Amendment should apply in these cases.”).

<sup>104</sup> See Mira Moldawer, *Myths, and Clichés: The Doctrinal Myopia of Publicity Right*, 22 UIC REV. INTELL. PROP. L. 48, 75–83 (2022) (discussing the influence of the judiciary’s artistic bias over fair use in copyright law).

<sup>105</sup> *De Havilland v. FX Networks, LLC*, 21 Cal. App. 5th 845, 862–64 (Cal. Ct. App. 2018).

role consumes fewer than seventeen minutes of the 392-minute miniseries.<sup>106</sup> First, a fictitious interview features Zeta-Jones portraying de Havilland, in which she discusses *Feud*'s main topics—Hollywood's treatment of women and the Crawford/Davis rivalry—referring to her sister as a “bitch” when, in fact, the term she actually used was “dragon lady.”<sup>107</sup>

Second, there is a scene with actress Susan Sarandon playing Bette Davis, relating to Frank Sinatra's overabundant consumption of alcohol.<sup>108</sup> The most important part of a story is how you choose to tell it, and the judiciary is no exception. Judge Egerton's premise, before analyzing the case is: “As played by Zeta-Jones, the de Havilland character is portrayed as beautiful, glamorous, self-assured, and considerably ahead of her time in her views on the importance of equality and respect for women in Hollywood. *Feud* was nominated for [eighteen] Emmy awards.”<sup>109</sup>

*De Havilland* alleges four causes of action attempting to enjoin the distribution and broadcast of the television program and to recover money damages: “(1) the common law privacy tort of misappropriation; (2) violation of Civil Code section 3344, California's statutory right of publicity; (3) false light invasion of privacy; and (4) ‘unjust enrichment.’”<sup>110</sup> *De Havilland* grounded the claims on the lack of her permission to *Feud*'s creators “to use [her] name, identity[,] or image in any manner.”<sup>111</sup>

The trial court denied the defendant's special motion to strike the complaint on all four causes of action under California's anti-SLAPP law, based on the error argued by

---

<sup>106</sup> *Id.* at 851.

<sup>107</sup> *Id.* at 850–52.

<sup>108</sup> *Id.* at 854.

<sup>109</sup> *Id.* at 851.

<sup>110</sup> *Id.* at 851–52.

<sup>111</sup> *De Havilland*, 21 Cal. App. 5th at 850 (alteration in original).

*The Yale Workshop Report*, because *Feud*'s portrayal of de Havilland was realistic and therefore not considered "transformative" under *Comedy III Productions*, thus losing First Amendment protection.<sup>112</sup> Even the unique variant of California anti-SLAPP legislation, designed to frustrate SLAPPs by providing a quick and inexpensive defense whenever a complaint arose from conduct that fell within the rights of free speech of public interest, could not avoid the trial court's discrimination of a drama based on real people by conflating dramatic interpretation with falsity.<sup>113</sup>

Reversing the trial court's decision in a two-step process required resolving the anti-SLAPP motion, and the *De Havilland* Court held that "[f]irst, the defendant must show the conduct underlying the plaintiff's cause of action arises from the defendant's constitutional rights of free speech or petition in connection with a public issue."<sup>114</sup> After this prong is satisfied, "the burden shifts to the plaintiff to prove she has a legally sufficient claim and to prove with admissible evidence a probability that she will prevail on the claim."<sup>115</sup> When the plaintiff, referred to by her attorneys as "a living legend" and "an internationally-known celebrity,"

---

<sup>112</sup> *Id.* at 852 n.4 ("SLAPP is an acronym for strategic lawsuit against public participation.") (citation omitted); *Anti-SLAPP Law in California*, DIGITAL MEDIA LAW PROJECT (Sept. 9, 2024), <https://www.dmlp.org/legal-guide/anti-slapp-law-california> [<https://perma.cc/6L36-Q9NA>] (discussing the Anti-SLAPP Law in California).

<sup>113</sup> *De Havilland*, 21 Cal. App. 5th at 854–56 (citations omitted) ("A special motion to strike under the anti-SLAPP statute, Code of Civil Procedure section 425.16, 'is a procedural remedy to dispose of lawsuits brought to chill the valid exercise of a party's constitutional right of petition or free speech. The purpose of the anti-SLAPP statute is to encourage participation in matters of public significance and prevent meritless litigation designed to chill the exercise of First Amendment rights. The Legislature has declared that the statute must be "construed broadly" to that end.'").

<sup>114</sup> *Id.* at 855.

<sup>115</sup> *Id.*

and therefore a public figure, “to establish a prima facie case she must demonstrate by clear and convincing evidence that the defendant acted with ‘actual malice.’”<sup>116</sup>

The *De Havilland* Court refused to attribute “actual malice” to *Feud*’s creators regarding both scenes involving de Havilland, as the whole gist of fiction is its fallacy and imagination.<sup>117</sup> Writing fiction does not automatically imply that the author is liable for “actual malice.”<sup>118</sup> The *De Havilland* Court echoed an ancient feud: the feud between Plato, who regarded art as “a third-rate truth” for attempting to mimic truth, culminating in expelling poets from his *Republic*, and Aristotle and Friedrich Nietzsche, who argued that art reveals hidden truth through its fallacy.<sup>119</sup>

Although the proof of “actual malice” requested from public figures derives from First Amendment concerns for the freedom of expression, the importance of *De Havilland* is the court framing a new balance between publicity rights and the First Amendment beyond the scope

---

<sup>116</sup> *Id.* at 856, 869.

<sup>117</sup> *Id.* at 869–70.

<sup>118</sup> *Id.* at 869 (“But fiction is by definition untrue. It is imagined, made-up. Put more starkly, it is false. Publishing a fictitious work about a real person cannot mean the author, by virtue of writing fiction, has acted with actual malice.”).

<sup>119</sup> See generally PLATO, THE REPUBLIC, Book X (Benjamin Jowett trans., The Project Gutenberg eBook of the Republic, by Plato 1998), <https://www.gutenberg.org/files/1497/1497-h/1497-h.htm> [<https://perma.cc/5AYD-TPJU>] (“[A]ll poetical imitations are ruinous to the understanding of the hearers, and that the knowledge of their true nature is the only antidote to them.”); but see ARISTOTLE, THE POETICS OF ARISTOTLE, IX (S.H. Butcher trans, The Project Gutenberg eBook, 2008), <https://www.gutenberg.org/files/1974/1974-h/1974-h.htm> [<https://perma.cc/J96C-SRGE>]; Nietzsche, *On Truth and Lies in a Nonmoral Sense*, in PHILOSOPHY AND TRUTH: SELECTIONS FROM NIETZSCHE’S NOTEBOOKS OF THE EARLY 1870S, 96–97 (Daniel Breazeale, ed., and trans., 1990).

of California anti-SLAPP legislation.<sup>120</sup> De Havilland's causes of action were grounded in violating the statutory right of publicity, Civil Code Section 3344, and the common law tort of misappropriation.<sup>121</sup>

Regarding Section 3344, the court questioned whether a docudrama is a product or merchandise within its meaning.<sup>122</sup> Without determining whether the portrayal of a real person in a docudrama constitutes a product or merchandise, the court held that the docudrama was constitutionally protected by the First Amendment, regardless of its use of de Havilland's name or likeness.<sup>123</sup> The *De Havilland* court followed the path of other precedents that decided the supremacy of the First Amendment versus publicity rights without leaning on anti-SLAPP legislation, granting First Amendment protection to creators who transformed the stories of real people into art.<sup>124</sup> The court stated that "[a]s with that expressive work, *Feud* 'is speech that is fully protected by the First

---

<sup>120</sup> *De Havilland v. FX Networks, LLC*, 21 Cal. App. 5th 845, 856 (Cal. Ct. App. 2018) ("The requirement that a public figure plaintiff prove malice by clear and convincing evidence arises from First Amendment concerns that freedom of expression be provided 'the "breathing space" that [it] "need[s] ... to survive ...."'") (alteration in original) (citations omitted).

<sup>121</sup> *Id.* at 851, 857.

<sup>122</sup> *Id.* at 857 (stating "Section 3344, subdivision (a) provides, in part, 'Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services, without such person's prior consent, ... shall be liable for any damages sustained by the person or persons injured as a result thereof.'") (alteration in original).

<sup>123</sup> *Id.* at 858–59.

<sup>124</sup> *Id.* at 858 (quoting *Matthews v. Wozencraft*, 15 F.3d 432, 439 (5th Cir. 1994) "Courts long ago recognized that a celebrity's right of publicity does not preclude others from incorporating a person's name, features, or biography in a literary work, motion picture, news or entertainment story. Only the use of an individual's identity in advertising infringes on the persona.").

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>125</sup>

In short, the court refused to accept *de Havilland*’s claim that basing an artistic work on a real person means its automatic endorsement.<sup>126</sup> Neither was the use of *de Havilland*’s picture, intended to promote only the work in question, considered a misappropriation.<sup>127</sup> Applying *Comedy III*’s transformative use test, the *De Havilland* court held “as a matter of law that *Feud*’s ‘marketability and economic value’ does not ‘derive primarily from [*de Havilland*’s] fame’ but rather ‘comes principally from . . . the creativity, skill, and reputation’ of *Feud*’s creators and actors.”<sup>128</sup> In addition, the court refused to limit the First Amendment protection “to those who publish without charge.”<sup>129</sup> Consequently, *de Havilland*’s consent was not required to use her name or likeness in *Feud*.<sup>130</sup>

It is tempting to view *De Havilland* as enhancing *Campbell*, emphasizing the first fair use factor at the expense of the second and fourth, thereby allowing creativity to prevail over commerciality, which is what makes the conflict between publicity rights and the First Amendment so volatile. However, this argument is far from explicit in *De Havilland*. *De Havilland* resonates more with *Rogers* and the test’s common refusal to link the use of a celebrity name or likeness to an automatic endorsement.

Regarding the ancient battle of art as the quintessence of fallacy versus the truth, *de Havilland*’s claim of false light invasion of privacy failed, as she had not

---

<sup>125</sup> *Id.* at 860 (citations omitted).

<sup>126</sup> *De Havilland*, 21 Cal. App. 5th at 861.

<sup>127</sup> *Id.* at 861–62.

<sup>128</sup> *Id.* at 864 (alteration in original).

<sup>129</sup> *Id.* at 859.

<sup>130</sup> *Id.* at 857–58.

carried her burden of proof as a public figure to demonstrate with reasonable probability that the defendant's statements about her were "(1) assertions of fact, (2) actually false or create a false impression about her, (3) highly offensive to a reasonable person or defamatory, and (4) made with actual malice."<sup>131</sup> The leitmotiv underneath this failure is that, unlike the trial court, the *De Havilland* court refused to regard fiction, fallacy, and actual malice as synonyms, giving the public the credit that creative liberties are taken in expressive works.<sup>132</sup> Once the automatic link between fiction and actual malice was denied, the court found no defamatory or highly offensive meaning in the scenes portraying de Havilland, as perceived by a reasonable person.<sup>133</sup>

Consequently, once "de Havilland's right of publicity and false light claims fail, her unjust enrichment claim fails as well."<sup>134</sup> The irony is that unjust enrichment remains one of the most important justifications for publicity rights, either as a right per se or accompanying the Lockean labor-based approach in copyright law, where publicity rights share a common infrastructure due to *Zacchini's* legacy.<sup>135</sup>

---

<sup>131</sup> *Id.* at 865.

<sup>132</sup> *De Havilland*, 21 Cal. App. 5th at 869 ("Publishing a fictitious work about a real person cannot mean the author, by virtue of writing fiction, has acted with actual malice.").

<sup>133</sup> *Id.* at 867–70.

<sup>134</sup> *Id.* at 870.

<sup>135</sup> Madow, *supra* note 16, at 134–35, 196 (focusing on what is at stake and the justifications for publicity rights including the view of recompense for unjust enrichment); David Tan, *Beyond Trademark Law: What the Right of Publicity Can Learn from Cultural Studies*, 25 CARDOZO ARTS & ENT. L.J. 913, 928–38 (2008) (offering the economic/utilitarian approach, the Lockean/labor approach, and the incentive approach for enhancing creativity, together with the restitution paradigm of unjust enrichment approach, as justifications of publicity rights); Kwall, *supra* note 5, at 1356 ("[i]t has been said that the right of publicity promotes the societal interests of 'fostering creativity,



However, what was tacitly implied in *De Havilland* was not followed by the Supreme Court of the United States in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith* (“*AWF v. Goldsmith*”).<sup>136</sup> The late Andy Warhol obtained a license from the respondent for a “one-time” use of her Prince photographs for an “artist reference” to be published in *Vanity Fair*; however, Warhol created fifteen additional works from the same photo without her knowledge.<sup>137</sup> One of these works was licensed by the appellant to Condé Nast to illustrate a magazine story about Prince for \$10,000, without crediting or paying the respondent.<sup>138</sup> The Supreme Court majority not only deemed the change from the respondent’s photograph to an unconventional museum and art gallery-quality pop art portraiture as a derivative use, thus infringing the copyrighted work, but they also interpreted the “purpose and character” of the first fair use factor as a matter of degree, in

---

safeguarding the individual’s enjoyment of the fruits of her labors, preventing consumer deception, and preventing unjust enrichment.”); Michelle M. Wu, *Defeating the Economic Theory of Copyright: How the Natural Right to Seek Knowledge is the Only Theory Able to Explain the Entirety of Copyright’s Balance*, 64 *IDEA* 135, 147 (2023) (claiming unjust enrichment to be anchored in copyright law since its inception, thus “equity, not money, formed the basis for the rights granted by copyright.”).

<sup>136</sup> *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S.508, 550–51 (2023). *Compare De Havilland*, 21 Cal. App. 5th at 864 (applying the transformative test: “as a matter of law...*Feud*’s ‘marketability and economic value’ does not ‘derive primarily from [de Havilland’s] fame’ but rather ‘comes principally from ... the creativity, skill, and reputation’ of *Feud*’s creators and actors”), *with Goldsmith*, 598 U.S. at 525 (changing the transformative use to accommodate commerciality at the expense of creativity).

<sup>137</sup> *Goldsmith*, 598 U.S. at 518–19.

<sup>138</sup> *Id.* at 519–20.

which commercial use should be assessed.<sup>139</sup> The Court stated:

In sum, the first fair use factor considers whether the use of a copyrighted work has a further purpose or different character, which is a matter of degree, and the degree of difference must be balanced against the commercial nature of the use. If an original work and a secondary use share the same or highly similar purposes, and the secondary use is of a commercial nature, the first factor is likely to weigh against fair use, absent some other justification for copying.<sup>140</sup>

As already mentioned by *The Yale Workshop Report*, a volatile artistic taste of the judiciary was one of the most contested issues in *AWF v. Goldsmith*.<sup>141</sup> What was considered a mere infringing copy by the majority in *AWF v. Goldsmith* was regarded by the trial court as a transformative use, marked by the unique style of Andy Warhol, which was one of the main causes of the Supreme Court's majority and the Court of Appeals for the Second Circuit not to "create a celebrity-plagiarist privilege."<sup>142</sup> In short, the line between artistic merit and disadvantage, as

---

<sup>139</sup> *Id.* at 525; Copyright Act of 1976, 17 U.S.C. § 107(1) ("[T]he purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes.").

<sup>140</sup> *Goldsmith*, 598 U.S. at 532–33.

<sup>141</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 5.

<sup>142</sup> Compare *Andy Warhol Found. for Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 325–26 (S.D.N.Y. 2019) (stating that Warhol's work "[e]mploy[s] new aesthetics with creative and communicative results distinct from Goldsmith's"), with *Andy Warhol Found. for Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 43 (2d Cir. 2021) (refusing to change the criteria of the first fair use factor because of a famous artist's recognizable style, to avoid "creat[ing] a celebrity-plagiarist privilege."); see also *Goldsmith*, 598 U.S. at 550.

well as the line between transformative and derivative use, has never been blurrier.<sup>143</sup>

However, this is only part of the problem. The whole idea of *Comedy III* was to reconcile publicity rights with the First Amendment from a copyright perspective by applying the transformative use test. Now that transformative use has succumbed to commerciality, since the first use factor lost *Campbell*'s supremacy, how can we square an already impoverished fair use with the ever-growing legal power of publicity rights? It seems easy to limit *De Havilland* to California anti-SLAPP legislation, but this does not do justice to its innovations regarding the short revival of transformative use. Due to *AWF v. Goldsmith*, much of *De Havilland*'s appeal is lost once commerciality takes over. This outcome leaves us with the arena of trademark law, as discussed in the following section.

## II. THE ARENA OF TRADEMARK LAW

This part attempts to analyze what remains from the hope of adopting the *Rogers* test for right of publicity cases.<sup>144</sup> Prima facie, embedding publicity rights under copyright law's wingspan is considered an error by the judiciary and many scholars.<sup>145</sup> The rationale for placing

---

<sup>143</sup> Rebecca Tushnet, *Judges as Bad Reviewers: Fair Use and Epistemological Humility*, 25 L. & LITERATURE 20, 27 (2013) (regarding judges as bad reviewers, thus "[w]ithout recognizing that works mean different things to different people, transformativeness as a concept is at war with itself.").

<sup>144</sup> ROTHMAN'S ROADMAP, *supra* note 33; *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1989); THE YALE WORKSHOP REPORT, *supra* note 3, at 32 ("The participants generally agreed that this test hewed the RoP more closely to its strongest validating interest than the transformative use test.").

<sup>145</sup> *Cardtoons, LC v. Major League Baseball Players Ass'n*, 95 F.3d 973 (10th Cir. 1996) (stating that "[t]he Supreme Court's sole case involving a right of publicity claim, is a red herring."); Lemley, *supra* note 41, at 1170 n.76.

publicity rights under trademark law is to protect the recognized interest of avoiding unauthorized commercial endorsement, harmonizing with trademark law's premise to prevent consumer confusion from misleading or false advertisements.<sup>146</sup> Consequently, the first stage required is to trace the evolution of the *Rogers* test in current adjudication.

**A.      *The Rise and Fall of Rogers Test***

The powerful *Rogers* test accomplished what the transformative test of copyright law failed to do regarding First Amendment concerns, holding that “suppressing an artistically relevant though ambiguous[ly] title[d] [film]” on trademark grounds would “unduly restrict expression.”<sup>147</sup> The *Rogers* test states, “section 43(a) of the Lanham Act does not bar a minimally relevant use of a celebrity’s name in the title of an artistic work where the title does not explicitly denote authorship, sponsorship, or endorsement by the celebrity or explicitly mislead as to content.”<sup>148</sup>

Until the recent case of *Jack Daniel’s Properties, Inc. v. VIP Products LLC* (“*Jack Daniel’s*”), the rise of the *Rogers* test could not be separated from the evolution of

---

<sup>146</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 31 (“Trademark law primarily serves to police the commercial marketplace, focusing on the right of consumer audiences to be free of confusion and misrepresentation, and the analogy certainly avoids some of the problems engendered by copyright. Trademark rights are not, strictly speaking, property rights, leaving the doctrinal focus squarely on the public interest in keeping the marketplace free from misleading or false endorsements, without permitting ownership-based claims to the idea of a particular person, or facts about that person, to thwart valuable speech where there is no meaningful threat of confusion.”).

<sup>147</sup> *Rogers*, 875 F.2d at 1001.

<sup>148</sup> *Id.* at 1005.

trademark law's two prongs.<sup>149</sup> As noted by *The Yale Workshop Report*, the function of trademark law was to identify goods and distinguish their source from others to prevent consumer confusion.<sup>150</sup> To achieve this goal, the first prong of trademark law, the triad model, was created, justified by reducing the search costs for consumers and incentivizing trademark owners to invest in their trademarks.<sup>151</sup> As explained by Barton Beebe “[t]raditionally, trademark commentators have conceived of the trademark as a three-legged stool, a relational system consisting of a ‘signifier’ (the tangible form of the mark), a ‘signified’ (the semantic content of the mark, its meaning), and a ‘referent’ (the product to which the mark is affixed).”<sup>152</sup>

However, as argued by many scholars, the triad model has become obsolete as trademarks have morphed into commodities in their own right, evolving into “expressive genericity,” distinctive from their original aims to identify the source of goods and distinguish them from others.<sup>153</sup> In addition, even in the heyday of the triad model, the model was not sufficient, because diluting the mark

---

<sup>149</sup> *Jack Daniel’s Props. v. VIP Prods. LLC*, 599 U.S. 140, 153 (2023); see Moldawer, *supra* note 40 (discussing a detailed analysis of trademark law’s two prongs).

<sup>150</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 31.

<sup>151</sup> For the development of trademark law rationale, reflected in converging its two prongs as the final result of trademarks’ “propertization,” see Oren Bracha, *The Emergence and Development of the United States Intellectual Property Law*, in THE OXFORD HANDBOOK OF INTELLECTUAL PROPERTY LAW 257, 262 (Rochelle Dreyfuss & Justine Pila eds., 2018). For the financial rationale, see William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 265–66 (1987).

<sup>152</sup> Barton Beebe, *supra* note 58, at 625.

<sup>153</sup> Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 397–98, 400 (1990); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 974 (1993).

harms the protected goods more than mere confusion regarding its source, as argued by Frank Schechter in his seminal article, which influenced the inception of the second prong of the Federal Trademark Dilution Act (“FTDA”), meant to defend the goods’ distinction.<sup>154</sup> Dilution might occur either by “blurring” (e.g., through overuse of the mark) or by “tarnishment,” (by causing the negative association of the mark through unauthorized use).<sup>155</sup>

The first prong’s fragility is the result of trademark law’s evolution to defend goodwill through the second dilution prong. The second prong’s ideology of avoiding “copying” the trademark devoured the first prong of the triad model, as consumer confusion was no longer the primary task of trademark law.<sup>156</sup> *Rogers*’ reasoning that artistic and literary works should be protected unless they explicitly mislead consumers led courts to forget anything else, let alone consumer confusion.<sup>157</sup> This evolution is demonstrated when tracing the *Rogers* test’s rise and fall in the different courts that dealt with the *Jack Daniel’s* case.<sup>158</sup>

The United States Court of Appeals for the Ninth Circuit held the parodied appellant’s trademark and trade dress to be attached to an “expressive work,” although it was

---

<sup>154</sup> Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 821–24 (1927); Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996) (codified as amended in scattered sections of 15 U.S.C.); For the influence of Schechter’s legacy on the FTDA enactment, see generally Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 810 (2010).

<sup>155</sup> 15 U.S.C. § 1125(c).

<sup>156</sup> Beebe, *supra* note 154, at 848; see generally Xiyin Tang, *Against Fair Use: The Case for a Genericness Defense in Expressive Trademark Uses*, 101 IOWA L. REV. 2021 (2016).

<sup>157</sup> See generally Shufro, *supra* note 60, at 410–15.

<sup>158</sup> Compare *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023), with *VIP Prods. LLC v. Jack Daniel’s Props. Inc.*, 953 F.3d 1170 (9th Cir. 2020).

one that was sold as a commercial product.<sup>159</sup> Following the *Rogers* test, the next step, once an allegedly infringing work is classified as an “expressive work,” is to decide whether the use of the trademark in question is inherently related to the work, and then whether the defendant’s work is explicitly misleading as to its endorsement by the plaintiff.<sup>160</sup> Absent anything explicitly misleading, the lower court concluded that VIP’s use of Jack Daniel’s trademarks is protected by the First Amendment.<sup>161</sup> By focusing on the *Rogers* test, the Ninth Circuit ignored the first prong of consumer confusion, letting the dilution prong deal with the issue of goodwill, thus leaving the latter as the only prong that mattered.

The premise of Justice Kagan’s opinion reversed this trajectory, stating that, “[t]he only question in this suit going forward is whether the Bad Spaniels marks are likely to cause confusion,” although the plaintiff sued for trademark dilution by tarnishment as well.<sup>162</sup> It follows that if the first prong gains supremacy, an “expressive work” is not automatically immune to infringement lawsuits, as the dilution doctrine is subordinated to the first prong of trademark law’s original aim to identify a product’s source and to distinguish that source from others, regardless of First Amendment concerns.<sup>163</sup> The same applies to the fair-use exclusion for parody that cannot nullify the protection of the designated source.<sup>164</sup>

Although the *Rogers* test fares better in trademark law adjudication regarding First Amendment concerns than its transformative use counterpart in copyright law, in the

---

<sup>159</sup> See generally Shufro, *supra* note 60 (for the detailed analysis of VIP Prods. LLC v. Jack Daniel’s Props. Inc., 953 F.3d 1170 (9th Cir. 2020)).

<sup>160</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d. Cir. 1989).

<sup>161</sup> *Jack Daniel’s Props., Inc.*, 953 F.3d at 1175–76.

<sup>162</sup> *Jack Daniel’s Props., Inc.*, 599 U.S. at 161.

<sup>163</sup> *Id.* at 146–52.

<sup>164</sup> *Id.* at 153–54.

context of the right of publicity, the same problem occurs.<sup>165</sup> The transformative use was greatly weakened once the first fair use factor was no more detached from commerciality, thus the whole equation of publicity rights with the transformative use to answer the First Amendment is already flawed. Likewise, the *Rogers* test, meant to be the cure of trademark law to this flawed balance, is far from satisfactory. Hence, the next stage is the defense of the commercial speech per se as a legitimate expression entitled to First Amendment protection, regarding publicity rights' commerciality, which creates this free speech lacuna to begin with. The next section attempts to check the rise and fall of this possibility.

**B.     *The Rise and Fall of the Commercial Speech***

The question of whether commercial speech deserves First Amendment protection regarding publicity rights is a complicated one. More than twenty years ago, scholars claimed that the right of publicity is “unconstitutional as to all noncommercial speech, and perhaps even as to commercial advertising as well.”<sup>166</sup>

Therefore, it is tempting to apply the commercial speech doctrine directly to provide a cleaner resolution beyond the scope of the *Rogers* test.<sup>167</sup> Accordingly, commercial speech, still inferior to non-commercial speech, “would be subject to reduced First Amendment protections” against publicity rights claims, dependent on its classification, and, “[i]f expressly false and misleading, it would receive no protection at all . . . .”<sup>168</sup> A commercial

---

<sup>165</sup> See THE YALE WORKSHOP REPORT, *supra* note 3, at 32.

<sup>166</sup> Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 Hous. L. Rev. 903, 930 (2003).

<sup>167</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 35.

<sup>168</sup> *Id.* at 36.



speech found to be truthful and non-misleading would be addressed under the Supreme Court's *Central Hudson* test, satisfying First Amendment scrutiny, if:

- (1) "the asserted government interest is substantial";
- (2) the restriction "directly advances the governmental interest asserted" and does not "provide[] only ineffective or remote support for the government's purpose"; and (3) it is narrowly tailored to achieve that purpose, for "if the governmental interest could be served as well by a more limited restriction on commercial speech, the excessive restrictions cannot survive."<sup>169</sup>

However, two caveats should be noted. First, the commercial/non-commercial distinction fails to achieve a coherent criterion.<sup>170</sup> Its spectrum varies from an "expression related solely to the economic interests of the speaker and its audience" to a "speech which does 'no more than propose a commercial transaction.'"<sup>171</sup> Second, this over-optimistic approach ignores the hybrid use of commercial speech in show business and current media. In our culture, it is almost impossible to distinguish between news, art, and commerce, as they all are blended. As Judge Kozinski wrote: "[i]n our pop culture, where salesmanship must be entertaining and entertainment must sell, the line between the commercial and noncommercial has not merely blurred; it has disappeared."<sup>172</sup>

---

<sup>169</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 36–37 (citing *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 563–66 (1980)).

<sup>170</sup> Savare & Wintermute, *supra* note 46, at 4.

<sup>171</sup> *Id.*

<sup>172</sup> *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1520 (9th Cir. 1993); *see generally* Matthew Savare, *Image is Everything*, INTELL. PROP. MAG. 52 (Mar. 2013), <https://www.lowenstein.com/media/4712/publicity-rights.pdf>

Up to the recent holding in *Vidal v. Elster*, there was room to hope for the rehabilitation of the commercial speech in two Supreme Court holdings.<sup>173</sup> First, in *Matal v. Tam*, the request for federal registration of “The Slants” as a trademark for a rock group was denied by the PTO under 15 U.S.C. § 1052(a) of the Lanham Act, which prohibited trademark registration of marks that disparage, viewing “slants” as a humiliating term for Asian persons.<sup>174</sup> Reversing this decision, the Supreme Court acknowledged the hybrid speech problem while premising that trademarks possess expressive content, stating:

The commercial market is well stocked with merchandise that disparages prominent figures and groups, and the line between commercial and non-commercial speech is not always clear, as this case illustrates. If affixing the commercial label permits the suppression of any speech that may lead to political or social “volatility,” free speech would be endangered.<sup>175</sup>

The Supreme Court found no reason for asserting that commercial speech is inferior in value to noncommercial speech; on the contrary, it equated commercial speech with any copyrightable speech under the copyright law by recognizing that the realm of trademarks constitutes a marketplace of ideas.<sup>176</sup> Following this logic, the contested clause was found unconstitutional because it

---

[<https://perma.cc/4X7C-DDK8>] (claiming hybrid media as the most challenging publicity rights issue).

<sup>173</sup> *Vidal v. Elster*, 602 U.S. 286 (2024).

<sup>174</sup> *Matal v. Tam*, 582 U.S. 218, 223 (2017).

<sup>175</sup> *Id.* at 239, 247.

<sup>176</sup> *Compare id.* at 252, with Judge Thomas’ view in *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 575 (2001) (Thomas, J. concurring) (stating “[t]here is no ‘philosophical or historical basis for asserting that “commercial” speech is of “lower value” than “noncommercial” speech.’”).

violated the Free Speech Clause of the First Amendment.<sup>177</sup> First, speech may not be banned because it expresses ideas that offend; second, federal registration does not render private speech government speech.<sup>178</sup>

*Iancu v. Brunetti* followed *Matal v. Tam*'s invalidation of 15 U.S.C. § 1052(a) of the Lanham Act.<sup>179</sup> The next Lanham Act prohibition to be invalidated for being unconstitutional was 15 U.S.C. § 1052(a)'s "immoral" or "scandalous" provision, on which the PTO based its refusal to register the Erik Brunetti clothing line trademark "FUCT." In harmony with *Matal v. Tam*, the Supreme Court held that a law disfavoring "ideas that offend," in which discrimination is based on viewpoint, violates the First Amendment, just as refusing the registration of "immoral or scandalous" trademarks does.<sup>180</sup> Whether attempting to censor offending ideas or avoiding scandalous or moral ones, the conclusion is the same: "We hold that this provision infringes the First Amendment for the same reason: It too disfavors certain ideas."<sup>181</sup>

So far, it seems that the Supreme Court followed its rationale, according to which "courts must apply strict scrutiny to legal doctrines that, on their face, require courts to look at content, even if the purpose of the doctrine is content or viewpoint neutral."<sup>182</sup> Due to *Matal v. Tam* and *Iancu v. Brunetti*, the expectation of *The Yale Workshop Report* requiring publicity rights, either common law or

---

<sup>177</sup> *Matal*, 582 U.S. at 247.

<sup>178</sup> *Id.* at 239.

<sup>179</sup> *Iancu v. Brunetti*, 588 U.S. 388 (2019).

<sup>180</sup> *Id.* at 397–99; *Matal*, 582 U.S. at 223, 243; *see also Matal*, 582 U.S. at 249–50 (Kennedy, J., concurring).

<sup>181</sup> *Iancu*, 588 U.S. at 590.

<sup>182</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 16 (citing *Reed v. Town of Gilbert*, Ariz., 576 U.S. 155, 165 (2015)) ("A law that is content based on its face is subject to strict scrutiny regardless of the government's benign motive, content-neutral justification or lack 'animus toward the ideas contained' in the regulated speech.").

statutory, to satisfy strict scrutiny regardless of whether the conflicting expressive material is classified as commercial or noncommercial speech seems obvious.<sup>183</sup> In contrast, this was not the road taken by the Supreme Court in *Vidal v. Elster*.<sup>184</sup>

The Federal Circuit reversed the Board's decision, regarding the names clause as a viewpoint-neutral, content-based restriction on speech subject to at least intermediate scrutiny, which it failed to satisfy because it did not advance any substantial governmental interest; therefore, it was held to violate the First Amendment, rendering the names clause unconstitutional.<sup>185</sup> The Supreme Court of the United States reversed the Federal Circuit's decision, focusing on the names clause as a free-speech challenge to a viewpoint-neutral, content-based condition on trademark registration, while ignoring the real message of the requested trademark, which stemmed from a 2016 presidential primary debate exchange between then-candidate Donald Trump and Senator Marco Rubio.<sup>186</sup>

The conflict of the First Amendment with publicity rights, which was the core of the matter in the Federal Circuit, was hardly mentioned by the Supreme Court. Justice Thomas' historically oriented verdict, leaning on the tradition of coexistence of the First Amendment with restricting the trademarking of names, focused on the names clause's emphasis on unauthorized use of names, regardless of the content involved.<sup>187</sup> Accordingly, both prongs of trademark law supported this coexistence.

---

<sup>183</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 17.

<sup>184</sup> See *Vidal v. Elster*, 602 U.S. 286 (2024).

<sup>185</sup> *In re Elster*, 26 F.4th 1328, 1333–34, 1339 (Fed. Cir. 2022) (“For the foregoing reasons, we hold that the Board’s application of section 2(c) to Elster’s mark is unconstitutional under any conceivable standard of review, and accordingly reverse the Board’s decision that Elster’s mark is unregistrable.”).

<sup>186</sup> *Vidal*, 602 U. S. at 310–11.

<sup>187</sup> *Id.* at 289.

The first prong's rationale—avoiding confusion by identifying the ownership and source of goods, which requires the content-based nature of trademark protection for identification—was strengthened by the second prong, focusing on the established connection between a trademark and its protection of the mark holder's reputation and goodwill, particularly when the mark contains a person's name.<sup>188</sup> Therefore, § 1052(c)'s content-based, viewpoint-neutral restrictions were deemed constitutional, in harmony with the First Amendment's history and tradition.<sup>189</sup>

To render it constitutional, Justice Barrett focused on the reasonability of the names clause's restriction in light of the trademark law's purpose of facilitating source identification.<sup>190</sup> Thus, the content-based registration restrictions reasonably relate to the purposes of the trademark system, as trademark protection cannot exist without content discrimination. While partially joining Justice Barrett, only Justice Sotomayor treated *Vidal v. Elster* as part of a trilogy, along with *Matal v. Tam* and *Iancu v. Brunetti*, just as the Federal Circuit had done, though she reached different conclusions regarding the constitutionality of the relevant clauses of the Lanham Act.<sup>191</sup>

Despite being the only one to evoke the issue of publicity rights by supplying examples of justified registration's refusal of unauthorized use of the best bats and catchers' mitts in baseball, such as Derek Jeter and Jorge Posada because of the names clause, her rationale to the constitutionality of this refusal is anchored in the purpose of trademark law's two prongs, concurring with Justice

---

<sup>188</sup> *Id.* at 288.

<sup>189</sup> *Id.* at 301.

<sup>190</sup> *Id.* at 311–12 (Barrett, J., concurring in part).

<sup>191</sup> See *In re Elster*, 26 F.4th 1328, 1331 (Fed. Cir. 2022) (“While neither *Tam* nor *Brunetti* resolves this case, they do establish that a trademark represents ‘private, not government, speech’ entitled to some form of First Amendment protection.”).

Barrett's analysis.<sup>192</sup> The carefully crafted omission of the real conflict between Trump's publicity rights, especially as a public figure, and the First Amendment, narrowing it to a free-speech challenge to a viewpoint-neutral, content-based condition on trademark registration, renders trademark law's rationale absurd, as "[n]o plausible claim could be or has been made that the disputed mark suggests that President Trump has endorsed Elster's product."<sup>193</sup>

The narrow scope chosen by the Supreme Court left a whole arsenal of important issues—ones that could constrain the legal power of publicity rights—unaddressed. The first lesson drawn from *Matal v. Tam* and *Iancu v. Brunetti* is that commercial speech is no lesser than non-commercial speech regarding First Amendment protection.<sup>194</sup> Second, there exists the unsolved conflict between publicity rights and the First Amendment.<sup>195</sup> Third, the old tradition of trademark law's tolerance toward parodies and satires stands in contrast to false endorsement,

---

<sup>192</sup> Compare *Vidal*, 602 U.S. at 337–38 (Sotomayor, J., concurring), with *In re Elster*, 26 F.4th at 1331–32 (“We recognize, as the government contends, that section 2(c) does not prevent Elster from communicating his message outright. But whether Elster is free to communicate his message without the benefit of trademark registration is not the relevant inquiry—it is whether section 2(c) can legally disadvantage the speech at issue here.”).

<sup>193</sup> *Id.* at 1336–37 (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. b (Am. L. Inst. 1995)) (“The right of publicity does not support a government restriction on the use of a mark because the mark is critical of a public official without his or her consent.”).

<sup>194</sup> Following Justice Thomas' view in *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 575 (2001) (“There is no philosophical or historical basis for asserting that commercial speech is of lower value than noncommercial speech.”).

<sup>195</sup> *In re Elster*, 26 F.4th 1328 at 1334–35 (“The question here is whether the government has an interest in limiting speech on privacy or publicity grounds if that speech involves criticism of government officials—speech that is otherwise at the heart of the First Amendment.”).

consumer confusion, or dilution, as such expressions are inherently meant to evoke the parodied persona.<sup>196</sup>

As often cited: “[a] parody must convey two simultaneous—and contradictory— messages: that it is the original, but also that it is not the original and is instead a parody.”<sup>197</sup> Fourth, no attention was paid by the Supreme Court to the scrutiny that needed to be applied.<sup>198</sup> Hence, the question posed is: Where are we heading? The massive flood of adjudication regarding digital replicas as the new metamorphosis of publicity rights follows all the roads not taken so far, threatening to repeat every possible mistake, as discussed in the next part.

### III. WHAT IS THE FUTURE OF PUBLICITY RIGHTS?

Generally speaking, little remained of the hopes expressed in the *Yale Workshop Report* regarding the future trajectory of publicity rights.<sup>199</sup> Not only was *Zacchini*’s legacy left intact, but *AWF v. Goldsmith* weakened the fair use doctrine and made the transformative use even blurrier considering the commercial traits of publicity rights, thus annulling their recommended strict scrutiny.<sup>200</sup> The *Rogers*

---

<sup>196</sup> *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1518 (9th Cir. 1993) (Kozinski, J., dissenting).

<sup>197</sup> *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 503 (2d Cir. 1996) (quoting *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989)).

<sup>198</sup> See THE YALE WORKSHOP REPORT, *supra* note 3, at 16–20.

<sup>199</sup> ROTHMAN’S ROADMAP, *supra* note 33 (summarizing the main takeaways of THE YALE WORKSHOP, “Particular hopes ranged from overruling or at least narrowing *Zacchini v. Scripps-Howard Broadcasting*, 433 U.S. 562 (1977), to applying strict scrutiny to right of publicity claims (at least outside commercial speech cases), to adopting the *Rogers* test for right of publicity cases, to hoping to at least make the transformativeness test as workable and broad as possible.”).

<sup>200</sup> See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977); see also *Andy Warhol Found. for Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508 (2023).

test was greatly diminished after *Jack Daniel's*, and the previous protection of the commercial speech was narrowed after *Vidal v. Elster*.<sup>201</sup> The hope to reach a coherent common theoretical basis for publicity rights fared no further as their problematic infrastructure is still with us.<sup>202</sup>

However, what sounds like a relatively marginal concern in *The Yale Workshop Report*, considering the reanimation of personas for reuse in the future, substituting the living with their digital replicas emerged as the main topic of current legislation.<sup>203</sup> Strangely enough, despite *The Yale Workshop Report*'s awareness of the chaotic legal state of publicity rights, it perceives the experience gained by

---

<sup>201</sup> See *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); see also *Jack Daniel's Props. v. VIP Prods. LLC*, 599 U.S. 140 (2023); see also *Vidal v. Elster*, 602 U.S. 286 (2024).

<sup>202</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 40 (“[C]ourts should be exhorted to focus intently on particular justifications for RoP claims, rather than accept the basic property-like intuitions or copyright analogies. Attempts to borrow from areas of law that address different interests must be consistently opposed to avoid packing interests into the RoP that it was never intended to protect, and the boundaries between those areas of law and the RoP must be refined through preemption and other arguments.”).

<sup>203</sup> Compare ROTHMAN'S ROADMAP, *supra* note 33, and THE YALE WORKSHOP REPORT, *supra* note 3, at 14–15, with the REGISTER OF COPYRIGHTS REPORT, *supra* note 72, at 15 (enumerating 191 AI-related bills, thirty-seven of them addressing deepfakes regarding state regulation of digital replicas). For federal regulation, see REAL Political Advertisements Act, H.R. 3044, 118th Cong. (2023); see also Candidate Voice Fraud Prohibition Act, H.R. 4611, 118th Cong. (2023); REAL Political Advertisements Act, S. 1596, 118th Cong. (2023); Protect Elections from Deceptive AI Act, S. 2770, 118th Cong. (2023); Preventing Deepfakes of Intimate Images Act, H.R. 3106, 118th Cong. (2023); Protect Victims of Digital Exploitation and Manipulation Act of 2024, H.R. 7567, 118th Cong. (2024); DEFIANCE Act of 2024, S. 3696, 118th Cong. (2024); TAKE IT DOWN Act of 2024, S.4569, 118th Cong.(2024); No AI FRAUD Act, H.R. 6943, 118th Cong. (2024) [hereinafter No AI FRAUD Act]; The Nurture Originals, Foster Art, and Keep Entertainment Safe Act of 2023, S. 4875, 118th Cong. (2023) [hereinafter NO FAKES Act].



decades of state adjudication as an asset, not as a cause for maintaining this chaos by contradictory results, such as whether publicity rights should be classified as IP rights to begin with.<sup>204</sup> Consequently, the preemption doctrine is the only tool left to square publicity rights with the First Amendment.<sup>205</sup>

The future trajectory of publicity rights can be drawn from the legislation concerning the digital NIL in their broadest sense.<sup>206</sup> No wonder the Notice of Inquiry on AI and Copyright, published by the United States Copyright Office in August 2023, “sought input on ‘the treatment of generative AI outputs that imitate the identity or style of human artists,’ among other topics,” rendering digital NIL

---

<sup>204</sup> Compare THE YALE WORKSHOP REPORT, *supra* note 3, at 15–16 (“The discussants rejected the notion of a federal RoP statute out of hand—the history of state legislation reveals a powerful and organized celebrity-estate lobby that has already dramatically expanded the descendability of the right in several jurisdictions, and any new statute would subject the already formidable task of developing coherent constitutional limitations to the rough-and-tumble compromises of interest-group politics, exacerbating rather than lessening the problem. The solution must come from the courts.”), with the contradictory adjudication concerning the question of whether publicity rights are IP rights to be excluded from the haven provided for Internet service providers (“ISPs”) for liability for infringement committed in the cyber world, by Section 230 of the Communications Decency Act (“CDA”). In *Hepp v. Facebook*, 14 F.4th 204 (3d Cir. 2021), publicity rights were held IP rights due to *Zacchini*’s legacy. Thus, the ISPs were not exempt from liability for infringing the plaintiff’s publicity rights. In contrast, *Ratermann v. Pierre Fabre U.S., Inc.*, 651 F. Supp. 3d 657 (S.D.N.Y. Jan. 17, 2023) reached the opposite legal result. For further discussion of these adjudications see Moldawer, *supra* note 104.

<sup>205</sup> THE YALE WORKSHOP REPORT, *supra* note 3, at 27–29.

<sup>206</sup> Chaitovitz, *supra* note 73, at 5, ll. 7–14 (“[E]xplore issues at the intersection of AI and protections for an individual’s reputation, name, image, voice, likeness, or other indicia of identity. Now, that’s a long thing until the rest of the time. Today, I’m just going to call it NIL, but it captures, I think, the broader concept, not just the narrow concept of many, what we call, you know, right of publicity laws.”).

to be the extension of the current state of publicity rights.<sup>207</sup> Thus, the *Register Of Copyrights Report*, following the Notice of Inquiry, seems to start where the *Yale Workshop Report* ended regarding the problematic classification of publicity rights long before they transformed into digital replicas.<sup>208</sup> Accordingly, “[t]he right of publicity addresses the use of individuals’ personas in commercial contexts, aiming to prevent others from profiting from unauthorized uses. The right evolved from the tort of invasion of privacy by appropriation to protect celebrities and well-known figures.”<sup>209</sup>

The fear of our fake replicas that might steal our identity is far from new. As early as 1835–1836, the great Russian writer Nikolay Gogol wrote *The Nose*, a story about a St. Petersburg official whose nose leaves his face and begins a better life on its own, doing everything it can to humiliate and mock him.<sup>210</sup> Thus, Gogol created an identity replica long before the invention of Generative Artificial intelligence (“Gen AI”). Likewise, in 1846, Fyodor Dostoevsky published *The Double: A Petersburg Poem*, a story about a minor clerk named Yakov Petrovich Golyadkin, who discovers that his double has stolen every aspect of his life—possessing skills and charms he himself lacks—ultimately driving him to a psychotic break as he begins to see countless replicas of himself.<sup>211</sup>

---

<sup>207</sup> REGISTER OF COPYRIGHTS REPORT, *supra* note 72, at 6.

<sup>208</sup> *Id.* at 10–15.

<sup>209</sup> *Id.* at 10.

<sup>210</sup> See NICHOLAS GOGOL, *The Nose*, in PROJECT GUTENBERG’S THE MANTLE AND OTHER STORIES, (Claud Field, trans., 2011), [https://www.gutenberg.org/files/36238/36238-h/36238-h.htm#Page\\_67](https://www.gutenberg.org/files/36238/36238-h/36238-h.htm#Page_67) [<https://perma.cc/HE6J-TUX3>]; See generally, JANKO LAVRIN, *Nikolay Gogol*, in ENCYCLOPEDIA BRITANNICA, (2024), <https://www.britannica.com/biography/Nikolay-Gogol> [<https://perma.cc/D5YT-EG7W>].

<sup>211</sup> See FYODOR DOSTOEVSKY, *THE DOUBLE* (Constance Garnett, trans., 2024) (1859).

Our fears of unauthorized use of our traits should be dealt with, but panic is a bad counselor. The old fears of duplicating our identity, reflected so well in Gogol's *The Nose*, not only leave old problems unsolved but also enhance them or create new ones. While dealing with all sorts of possible damages and harm, the source is not dealt with. The authorship in digital NIL is not discussed in either the *Register of Copyrights Report* or the *USPTO NIL Roundtable*. This phenomenon of dealing with the smoke, while denying the fire, is discussed in the next section.

### A. *The Preliminary Maze of Digital NIL Authorship*

Authorship itself was never easy to define, let alone its boundaries. Four layers mark the current legal maze regarding digital NIL authorship, or the lack of it, in new legislative discussion.

First, the components of human authorship are based on the contested originality and fixation concepts, none of which fit current creativity and technology.<sup>212</sup> Unprecedented originality proved a false myth created by the Enlightenment intellectuals who wanted to live by their pen, yet borrowed from their predecessors and contemporaries.<sup>213</sup>

---

<sup>212</sup> What is Copyright?, THE COPYRIGHT OFFICE, <https://www.copyright.gov/what-is-copyright/> [<https://perma.cc/8MCQ-SWW7>]; 17 U.S.C. § 102.

<sup>213</sup> See generally Martha Woodmansee, *The Genius and the Copyright: Economic and Legal Conditions of the Emergence of the 'Author,'* 17 EIGHTEENTH-CENTURY STUD. 425, 426 (1984); THE CONSTRUCTION OF AUTHORSHIP: TEXTUAL APPROPRIATION IN LAW AND LITERATURE (Martha Woodmansee & Peter Jaszi eds., 1994); Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 1019 (1990); Olufunmilayo B. Arewa, *The Freedom to Copy: Copyright, Creation, and Context*, 41 U.C. DAVIS L. REV. 477 (2007); Friedemann Kawohl, *Commentary on Kant's essay "On the Injustice of Reprinting Books" (1785)*, in PRIMARY SOURCES ON COPYRIGHT (1450–1900) (L. Bently & M. Kretschmer eds., 2008),

The concept of fixation in a tangible form, which transforms an uncopyrightable idea into a copyrightable expression, is the *sine qua non* of copyrightability; though its justification has eroded with new technologies that have rendered fixation increasingly obsolete, and it persists and remains a primary reason for why publicity rights have escaped the preemption doctrine.<sup>214</sup>

Second, the authorship of publicity rights is even harder. The blurry boundaries concern the delineation of authorship itself because the image of the persona/celebrity is not only their own, but their fans' as well.<sup>215</sup> The answer

---

[https://www.copyrighthistory.org/cam/tools/request/showRecord.php?id=commentary\\_d\\_1785](https://www.copyrighthistory.org/cam/tools/request/showRecord.php?id=commentary_d_1785) [<https://perma.cc/5FZD-J2GE>].

<sup>214</sup> See John Perry Barlow, *Selling Wine Without Bottles: The Economy of Mind on the Global Net*, 18 DUKE L. & TECH. REV. 8, 17 (2019); John Perry Barlow, *A Declaration of the Independence of Cyberspace*, ELECTRONIC FRONTIER FOUNDATION (Feb. 8, 1996), <https://www.eff.org/cyberspaceindependence> [<https://perma.cc/27J2-B6AN>]; Rachel Aridor-HersHKovitz, *Antitrust Law – A Stranger in the Wikinomics World? Regulating Anti-Competitive Use of the DRM/DMCA Regime*, 27 J. MARSHALL J. COMPUT. & INFO. L. 1 (2009) (for the development of the DMCA in contrast to Barlow's vision); for celebrities/persona failing to cross the scope of "writings" within the meaning of the Copyright Clause essential for copyrightability, see NIMMER ON COPYRIGHT, *supra* note 29 ("To specify, the "work" that is the subject of the right of publicity is the *persona*, i.e., the name and likeness of a celebrity or other individual. A *persona* can hardly be said to constitute a "writing" of an "author" within the meaning of the Copyright Clause of the Constitution. *A fortiori*, it is not a "work of authorship" under the Act.").

<sup>215</sup> See generally Madow, *supra* note 16, at 194; see RICHARD DYER, STARS 192 (New ed. 1998) (analyzing the transformations of Judy Garland, Greta Garbo, and Marilyn Monroe, all a far cry from what the mainstream wanted them to be seen as); Dyer, *supra* note 38, at 137–91; Rosemary J. Coombe, *Author/izing the Celebrity: Publicity Rights, Postmodern Politics, and Unauthorized Genders*, 10 CARDOZO ARTS & ENT. L. J. 365, 395 (1992) (arguing the public is a crucial component in the persona/celebrity creation and consumption); Rosemary J. Coombe & Andrew Herman, *Culture Wars on the Net: Intellectual Property and*

is already given within Richard Dyer’s question: “are stars a phenomenon of production (arising from what the makers of films provide) or of consumption (arising from what the audience for films demands)?”<sup>216</sup>

Third, while digital NIL is considered, the Gen AI that enhanced it (already heavily influenced by publicity rights’ problematic infrastructure and practice) is currently out of the authorship scope because authorship is preserved for humans only.<sup>217</sup>

Fourth, it would be far from trivial for new federal NIL laws, in a broad sense, to be enacted considering the idea/expression principle in copyright law in which publicity rights are embedded.<sup>218</sup> Whereas the *Register of Copyright report* takes the authorization to morph digital replicas into new federal NIL IPs for granted, Jonathan Band, representing the Library Copyright Alliance, argues that “Congress simply does not have the authority to grant broad IP rights in name, image, and likeness.”<sup>219</sup> His argument reflects that publicity rights are a legal hybrid because he claims that NIL is the counterpart of unoriginal facts, thus out of the scope of IP legislation due to *Feist Publications*,

---

*Corporate Propriety in Digital Environments*, 100 THE S. ATL. Q. 919, 920–22 (2001).

<sup>216</sup> DYER, *supra* note 215, at 9.

<sup>217</sup> Thaler v. Perlmutter, 687 F. Supp. 3d 140, 146 (D.D.C. 2023) (“Copyright is designed to adapt with the times. Underlying that adaptability, however, has been a consistent understanding that human creativity is the *sine qua non* at the core of copyrightability, even as that human creativity is channeled through new tools or into new media.”). This approach was recently affirmed in Thaler v. Perlmutter, No. 23-5233 (D.C. Cir. 2025).

<sup>218</sup> *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977); Post & Rothman, *supra* note 13, at 98 n.48–49 (2020) (claiming that the *Zacchini* Court sought to close the gap in copyright law’s coverage by recognizing *Zacchini*’s claim under the state’s right of publicity).

<sup>219</sup> USPTO NIL ROUNDTABLE, *supra* note 71, at 276:6–9.

*Inc. v. Rural Tel. Serv. Co.* (“Feist”) (holding no copyrightability for ideas).<sup>220</sup>

This is the dilemma of style: should it be considered a personality trait protected under a federal NIL law? The *Register of Copyrights Report* does not recommend including style in the coverage of new legislation due to inconsistency with the idea/expression dichotomy stated in Section 102(b) of the Copyright Act.<sup>221</sup> However, other voices advocate for style as a personality trait comparable to a personal signature, such as Hemingway’s, and thus worth protection.<sup>222</sup> The debate reflects the exaggerated legal power of publicity rights because some states might include style among their protected personality traits.<sup>223</sup>

Consequently, digital NIL legislation so far is supposed to deal with four layers of unsolved authorship, yet it relates to none. In terms of Wesley Newcomb Hohfeld’s analysis of rights, considered by prominent scholars as “by far the most widely followed and influential systemization

---

<sup>220</sup> *Id.* at 27:11–15; *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 364 (1991) (holding that compiled telephone directories did not cross the originality threshold required for copyrightability).

<sup>221</sup> REGISTER OF COPYRIGHTS REPORT, *supra* note 72, at 54 (“As noted by several commenters, copyright protection for style would be inconsistent with section 102(b)’s idea/expression dichotomy.”).

<sup>222</sup> Compare USPTO NIL ROUNDTABLE, *supra* note 71, at 134:2–10 (“But, you know, there’s some taking, and we’re trying to figure that out, too, because it’s like, in some cases, it is actual style, you know, when the style is very sort of recognizable or signature, like a Hemingway style or, you know, George R. R. Martin style, I guess, like, in that case, style is sort of tied also to expression. The kind of imagination that George R. R. Martin has that other authors might not have.”), *with id.* at 166:19–21 (“Ernest Hemingway, God bless him, does not have a monopoly on short sentences.”).

<sup>223</sup> See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992).

of the form of rights,” NIL creates a new legal phenomenon, as discussed in the following section.<sup>224</sup>

### ***B. Hohfeld’s Legal Relations as an Organizing Principle***

Hohfeld classified legal rights by breaking them into eight distinct ‘jural’ relationships, structured as four pairs of jural correlatives and four pairs of jural opposites; the pairs are derived from his suggested four legal relations to the legal constitution of “right:” claim-right, privilege (or liberty), power, and immunity.<sup>225</sup> Correlative thinking defines the normative relationship between, on the one hand, a “right-subject” (i.e. a right’s holder), and on the other hand, a “right-object” (i.e. “the party the right is held over or against”).<sup>226</sup> Accordingly, there are four pairs of correlatives: claim/duty, privilege/no-claim, power/liability, and immunity/disability.<sup>227</sup>

A claim right means that someone else must abide by it; a privilege means that someone else has no right over the

---

<sup>224</sup> Ori Herstein, *Legal Rights*, in THE STAN. ENCYCLOPEDIA OF PHIL., (Edward N. Zalta & Uri Nodelman eds., 2023); Pierre Schlag, *How to Do Things with Hohfeld*, 78 L. & CONTEMP. PROBS. 185, 187 (2015) (“One of the most striking aspects of Hohfeld’s work is how much its architecture and arguments remain relevant—even biting so—today ... how his thinking remains a powerful corrective to common errors in contemporary legal thought ... the great virtue of Hohfeld’s approach is not so much that Hohfeld’s analyses are right, but rather that they are useful and thought-provoking.”).

<sup>225</sup> See generally Wesley Newcomb Hohfeld, *Some Fundamental Legal Conceptions as Applied in Judicial Reasoning*, 23 YALE L.J. 16 (1913) [hereinafter Hohfeld 1913]; Wesley Newcomb Hohfeld, *Fundamental Legal Conceptions as Applied in Judicial Reasoning*, 26 YALE L.J. 710 (1917); WESLEY NEWCOMB HOHFELD, FUNDAMENTAL LEGAL CONCEPTIONS AS APPLIED IN JUDICIAL REASONING AND OTHER LEGAL ESSAYS (Walter Wheeler Cook ed., 1919).

<sup>226</sup> Herstein, *supra* note 224.

<sup>227</sup> *Id.*

privileged use.<sup>228</sup> Legal power means creating legal norms by the right-subject, correlating to the liability of the right-object to obey them.<sup>229</sup> The right-subject's immunity correlates with the right-object's disability, due to the latter's lack of power to alter the former's position.<sup>230</sup> The Hohfeldian architecture is completed with four pairs of jural opposites as well: "[r]ight is opposed to no right, duty to privilege, power to disability, and liability to immunity."<sup>231</sup>

Before proceeding, a couple of caveats should be addressed. First, while Hohfeld includes claim-right, privilege (or liberty), power, and immunity in his legal constitution of "right," scholars wonder if privilege should qualify as a right if its holder possesses no correlative claim, thus rendering it a "naked privilege".<sup>232</sup> Second, there is some doubt surrounding whether power and immunity should be classified as independent rights "when divorced of privilege to exercise or to refrain from exercising that power."<sup>233</sup> Third, scholars argue that even the strongest "right" (i.e. claim-rights) does not always correlate with a duty, thus each component in the Hohfeldian architecture is shakable.<sup>234</sup>

However, the biggest problem is the very gist of Hohfeld's innovative approach; his approach "is a story of relations between and among persons."<sup>235</sup> Therefore, can we use Hohfeld's theory regarding Gen AI that includes non-humans? Even critics admit that deconstructing legal rights

---

<sup>228</sup> *Id.*; Séverine Dusollier, *Intellectual property and the bundle-of-rights metaphor*, in 4 KRITIKA: ESSAYS IN INTELLECTUAL PROPERTY 12 (2020).

<sup>229</sup> Herstein, *supra* note 224.

<sup>230</sup> *Id.*

<sup>231</sup> Dusollier, *supra* note 228, at 12.

<sup>232</sup> Herstein, *supra* note 224.

<sup>233</sup> *Id.*

<sup>234</sup> *Id.*

<sup>235</sup> Dusollier, *supra* note 228, at 13; *see generally* VISA A.J. KURKI, A THEORY OF LEGAL PERSONHOOD (2019) (advocating for a more nuanced theory of rights including non-humans as well).



according to Hohfeld's categories "is an excellent clarificatory tool, providing a precise picture of the legal relations at play."<sup>236</sup> This part attempts to prove this statement, claiming that even if Hohfeld never imagined his theory to apply to non-humans, the theory helps to clarify what went wrong in both the *Register of Copyrights Report* and the *USPTO NIL Roundtable*.

Prima facie important issues, such as the fair use of or First Amendment restraints on digital NIL, and ISPs' immunity, are frequently discussed in both the *Register of Copyrights Report* and the *USPTO NIL Roundtable*, and can easily follow Hohfeldian classification.<sup>237</sup> First, leaving aside the debate on if fair use should be considered a privilege or a right, the minimal request of fair use as a privilege means that, in certain cases sheltered by the First Amendment, the users might choose to create or not to create an unauthorized digital replica of NIL. The reason is that, while having a privilege, the users have no duty to execute it.

Second, the question of whether digital NIL should be considered an IP right, thus excluding ISPs from Section 230's immunity once IPs are infringed, represents the opposites of immunity versus liability within Hohfeld's prism of opposites.<sup>238</sup> Accordingly, the question is: Are ISPs free from legal power in case of infringing digital NIL on their sites? As legal power will determine the amount of control over the legal relation between ISPs and digital NIL rightsholders, the Hohfeldian correlation of liability with power is completed.

---

<sup>236</sup> Herstein, *supra* note 224.

<sup>237</sup> See REGISTER OF COPYRIGHTS REPORT, *supra* note 72, at 36–41 (discussing the secondary liability of ISPs versus their immunity), 43–48 (discussing First Amendment concerns). Almost every stakeholder related to these issues in the USPTO NIL ROUNDTABLE, *supra* note 71.

<sup>238</sup> Dusollier, *supra* note 228, at 12.

Not only are liability and immunity contested issues in both the *Register of Copyrights Report* and the *USPTO NIL Roundtable*, but we can see the mechanism of power at work. No wonder the concept of control, as the essence of the recommended legislative power, is used by some stakeholders as the main key to Gen AI legislation.<sup>239</sup> So far, while some components of what constitutes “right” (such as privilege, power, and immunity) can be adapted to both the *Register of Copyrights report* and the *USPTO NIL Roundtable*, the most important concept of claim-right is obscure and misleading as argued in the following section.

**C.      *The New Phenomenon of Digital NIL  
Authorship***

Sometimes, the most important part of a text is the part that is missing. The *Register of Copyrights report* illustrates this assumption in its premise, as stated in its mission:

The topic of digital replicas does not fall neatly under any one area of existing law. While some characterize it as a form of intellectual property, protection against the use of unauthorized digital replicas raises overlapping issues including privacy, unfair competition, consumer protection, and fraud. It relates to copyright in a number of ways: creators such as artists and performers are particularly affected; copyrighted works are often used to produce digital replicas; and the replicas are often disseminated as part of larger copyrighted works. Moreover, the noncommercial harms that may be caused are similar

---

<sup>239</sup> See e.g., USPTO NIL ROUNDTABLE, *supra* note 71, at 33:1–11 (Will Kreth, CEO and founder of Hand Human and Digital referring to the potential violations of the four C’s: consent, control, credit, and compensation).

to violations of moral rights protected in part through the copyright system.<sup>240</sup>

The whole report concerns potential risks, but the missing point is the most important: the authorship of digital NIL. Digital NIL authorship was not overlooked by some of the *USPTO NIL Roundtable*'s contributors, who wondered what the copyright register has to do with personality rights, thus demonstrating the problem of publicity rights being out of the scope of copyright law.<sup>241</sup> Both the *Register of Copyrights Report* and the *USPTO NIL Roundtable* apply Hohfeld's legal relations from a false claim-right holders' point of view based on the unauthorized NIL holders' risks.

Therefore, even the correlations and oppositions between the NIL's claim-right holders and other stakeholders get blurry. Starting with what should be simple in Hohfeldian terms, the opposition between liability and immunity concerns ISPs whose sites infringe digital NIL holder rights. The competing interests are between those who advocate for more liability, using similar mechanisms to DMCA, and those who are anxious about losing their coveted immunity if NIL is considered an IP right.<sup>242</sup>

---

<sup>240</sup> REGISTER OF COPYRIGHTS REPORT, *supra* note 72, at 6.

<sup>241</sup> USPTO NIL ROUNDTABLE, *supra* note 71, at 43:1–5 (“We think in contrast with copyright law, which is addressed a different type of problem or a different type of issue, we think the goal of any new law should be to protect identity and personhood.”). This view is shared by other contributors regarding IP by and large, and not just copyright law, as demonstrated by James Gatto, *id.* at 64:1–9 (“The USPTO at times designed to describe IP as creative works or ideas embodied in a form that can be shared or enabled others to create, emulator, manufacture them. In contrast, right of publicity covers protectable aspects of a personal identity or characteristics of a person. These are not things that a person creates, but rather inherent characteristics, traits, or identifiers of an individual.”).

<sup>242</sup> Compare Michael Lewan, Managing Director of state and federal advocacy for the Recording Academy, *id.* at 27:6–12 (“Similarly,

However, liability is a key concept in the *Register of Copyrights Report* and the *USPTO NIL Roundtable*.

Stakeholders attempt to enlarge or diminish liability depending on their interests. Some recommend enlarging liability to include either more stakeholders or more types of infringement, such as the moral rights of NIL holders.<sup>243</sup> In contrast, others seek to release some factors in the supply chain of a given industry from liability.<sup>244</sup> This might be the reason why the *Register of Copyrights Report* uses the concept of secondary liability for ISPs and infringing acts with liability, arising “from the distribution or making available of an unauthorized digital replica, but not the act

---

creation of a federal standard should also incentivize secondary parties like platforms to establish an effective system to quickly take down and keep down unauthorized digital replicas and empower the creators to control how their likeness is used on these platforms”), with Joshua Landau, Senior Counsel for Innovation Policy at the Computer and Communications Industry Association, *id.* at 141:4–11 (“It’s particularly concerning given that there are First Amendment protected, unauthorized uses. So, how do you prescreen for those, if you are trying to have an automated system that detects was this AI generated? Was it authorized? Is it First Amendment protected? That’s just beyond what I think AI will be able to do anytime soon, or possibly ever.”).

<sup>243</sup> *Id.* at 131:8–12.

<sup>244</sup> Compare Colin Rushing, the Executive Vice President and General Counsel of the Digital Media Association (representing large music streaming companies), *id.* at 43:6–16 (“We think that the liability for any harmful content that’s created should fall squarely on the creator and the person who introduced the content into the supply chain”), and Umair Kazi, Director of Policy & Advocacy of the Authors Guild, *id.* at 131:8–12 (advocating for NIL rights as moral rights as well), with Bijou Mgbujukwe, (on behalf of the Entertainment Software Association, the trade association that represents U.S. video game companies), *id.* at 114:4–15 (“We also believe that there should be no additional liability, which is something we’ve seen on the state level, for video game publishers who either license out likeness creation tools to others for game development, virtual experiences, or even movie production, or for those who make those tools available to players for avatar customization within the game, or even those that populate open worlds with what’s called non-player characters.”).

of creation alone.”<sup>245</sup> The same concept of liability amalgamates the Hohfeldian legal relations of liability and duty, and the First Amendment exemptions are the opposite of the latter.

The question becomes who has the duty of not abusing NIL rights? Scrutinizing the *Register of Copyrights Report* and the *USPTO NIL Roundtable*, the answer seems trivial. The right-claims belong to the NIL’s holders. But this is an oversimplification because once the question of the digital NIL authorship is ignored, there are some strange anomalies that evolve from the nature of Gen AI. The real challenge that none of the aforementioned documents mentioned is that, due to the main characteristics of Gen AI, the ability for self-learning makes its future creation unpredictable, transforming its outputs to completely different works from their inputs, and second, deciding the causation of infringement is almost impossible, as liability is a contested issue between trainers, designers, users, and ISPs.<sup>246</sup>

It follows that an IP system, reflected in both the *Register of Copyrights Report* and the *USPTO NIL Roundtable*, speaks the language of torts while ignoring the basic concepts of Intellectual Property law. Namely, who is considered the author of the digital NIL, which is a different question than who owns the personal traits. The *Register of Copyrights Report* admits that “[c]opyright does not, however, protect an individual’s identity in itself, even when incorporated into a work of authorship. A replica of their image or voice alone would not constitute copyright infringement.”<sup>247</sup>

---

<sup>245</sup> REGISTER OF COPYRIGHTS REPORT, *supra* note 72, at iv.

<sup>246</sup> See generally Mira Moldawer, *The Shadow of the Law Versus a Law with No Shadow: Pride and Prejudice in Exchange for Generative AI Authorship*, 14 SEATTLE J. OF TECH., ENV’T & INNOVATION L. (2024).

<sup>247</sup> REGISTER OF COPYRIGHTS REPORT, *supra* note 72, at 17.

The new legislation, whether federal or state law, is based on redressing harms, which are better dealt with by tort law.<sup>248</sup> Publicity rights, as the undercurrent motive of the new legislation, are not only initiated from the tort of privacy but also with property rights; they are regarded “as a hybrid of privacy interests and a form of property.”<sup>249</sup> One of the important questions raised by the *Register of Copyrights Report* was “[t]o what extent will AI-generated content replace human authorship,” but the question, let alone any answers, is not dealt with by either the *Register of Copyrights Report* or the *USPTO NIL Roundtable*.<sup>250</sup>

Consequently, a new legal hybrid is born. Both the *Register of Copyrights Report* and the *USPTO NIL Roundtable* deal with digital NIL as a new tort from a claim-rights perspective, focusing on the broad spectrum of harms caused by unauthorized use.<sup>251</sup> Yet, the privilege’s

---

<sup>248</sup> Ben Sheffner, representing the Motion Picture Association (MPA), USPTO NIL ROUNDTABLE, *supra* note 71, at 13:11–23 (“[B]efore rushing to enact legislation or regulations around depictions of individuals, NPA urges policymakers and stakeholders to first pause and ask whether the harms they seek to address are already covered by existing law, such as the Lanham Act, state right of publicity law, defamation, fraud, intentional infliction of emotional distress, or other torts.”).

<sup>249</sup> REGISTER OF COPYRIGHTS REPORT, *supra* note 72, at 41.

<sup>250</sup> *Id.* at 4 (the quote is brought in full to indicate how the majority of the issues titled as fundamental or existential are not dealt with in the very same report: “AI raises fundamental questions for copyright law and policy, which many see as existential. To what extent will AI-generated content replace human authorship? How does human creativity differ in nature from what AI systems can generate, now or in the future? What does this mean for the incentive-based foundation of the U.S. copyright system? In what ways can the technology serve as a valuable tool to amplify human creativity and ultimately promote science and the arts? How do we respect and reward human creators without impeding technological progress?”).

<sup>251</sup> Hohfeld 1913, *supra* note 225, at 55 (“A right is one’s affirmative claim against another.”); best demonstrated by THE REGISTER OF

perspective, the opposite of the legal relation to duty, speaks in terms of fair use appropriate to IP laws.<sup>252</sup> A lot of time and trouble is dedicated to fair use, which is a complicated issue even in the regular frame of copyright law, let alone in publicity rights that blend commerciality and creativity, thus easily escaping First Amendment protection.<sup>253</sup>

The patched legal system, based on contradictory layers of federal and state legislation that emerge from both the *Register of Copyrights Report* and the *USPTO NIL Roundtable*, derives from their common error: leaving the blurry infrastructure of publicity rights intact while dealing with their digital evolvement. In addition, Gen AI authorship is denied to non-humans, thus leading the legal

---

COPYRIGHTS REPORT’S recommendation, *supra* note 72, *Executive Summary*, at iii:

Based on all of this input, we have concluded that a new law is needed. The speed, precision, and scale of AI-created digital replicas calls for prompt federal action. Without a robust nationwide remedy, their unauthorized publication and distribution threaten substantial harm not only in the entertainment and political arenas, but also for private individuals.

<sup>252</sup> Hohfeld 1913, *supra* note 225, at 55 (“[A] privilege is one’s freedom from the right or claim of another.”).

<sup>253</sup> REGISTER OF COPYRIGHTS REPORT, *supra* note 72, at 43–44 (“The application of First Amendment principles in right of publicity cases has been described by scholars as ‘a confusing morass of inconsistent, incomplete, or mutually exclusive approaches, tests, and standards.’”); *id.* at 46 (“In addition, we note that in today’s online environment, traditional categories such as ‘news’ or ‘public affairs’ are often difficult to define.”). For the miscellaneous and contradictory fair use tests regarding publicity rights, *see* Kwall, *supra* note 5, at 1357–58 (offering the Transformative Use Test); *id.* at 1357–59 (the Predominant Use Test); *id.* at 1359–60 (the Actual Malice Standard); *id.* at 1361 (the Relatedness/Restatement Approach); *id.* at 1362 (the Ad Hoc Balancing). *See also* Savare & Wintermute, *supra* note 46, at 2. In comparing Rosenthal Kwall’s classifications to Savare & Wintermute’s, what Rosenthal Kwall regards as the ad hoc balancing approach is nonexistent in Savare & Wintermute’s, who refer to the *Rogers* test, which, in turn, is not considered to be independent on its merit by Kwall.

system to focus only on its risks, which correlates to understanding society only based on its criminal and tort laws; numerous theories offer different stakeholders as Gen AI authors, deriving from different perceptions of ownership, control, and accountability, which are key concepts in both the *Register of Copyrights Report* and the *USPTO NIL Roundtable*.<sup>254</sup>

For policy reasons, some scholars vest ownership of AI-generated works in AI owners, while others address the copyrightability of generative AI through the prism of ownership and accountability, best demonstrated by the work made for hire model (“WMFH model”), which splits authorship and ownership for human works as well.<sup>255</sup> Others point to the importance of users as the focus of current copyright law shifts into a prompt-based creativity system, thus concentrating on a new interpretation of the incentive approach.<sup>256</sup> As Gen AI enables users to create

---

<sup>254</sup> Ryan Abbott & Elizabeth Rothman, *Disrupting Creativity: Copyright Law in the Age of Generative Artificial Intelligence*, 75 FLA. L. REV. 1141, 1196–97 (2023) (advocating for generative AI authorship by positing ownership-related policy justifications); Shlomit Yanisky-Ravid, *Generating Rembrandt: Artificial Intelligence, Copyright, and Accountability in the 3A Era—The Human-Like Authors are Already Here—A New Model*, 2017 MICH. ST. L. REV. 659, 671–72, 705, 707 (2017) (justifying her proposed model for Work Made for Hire (“WMFH”) by the users of generative AI in terms of control and accountability).

<sup>255</sup> Abbott & Rothman, *supra* note 254, at 1196; Yanisky-Ravid, *supra* note 254, at 716.

<sup>256</sup> Mark A. Lemley, *How Generative AI Turns Copyright Upside Down*, 25 SCI. & TECH. L. REV. 21, 28 (2023) (“The most common and most plausible answer, I think, seeks to locate creativity not in the generation of outputs from AI but in the human structuring of the prompts that produce those outputs.”); *cf. id.* at 30–31 (“The mere fact that copyrightability turns on iterated instructions gives users an incentive to issue those instructions, because doing so will be the difference between owning the output and having it fall into the public domain.”); Robert Denicola, *Ex Machina: Copyright Protection for Computer-Generated Works*, 69 RUTGERS L. REV. 251, 286 (2016) (titling the user as the



new content, its designers and trainers might take part in prompt-based creativity as well. Hence, so far, because Gen AI authorship might have too many parents, it ends as a legal orphan.

However, all the stakeholders who call for liability cannot supply the answer to the question: Who is liable? Especially when terms like “knowingly” keep recurring for direct liability and not just for the secondary liability of ISPs.<sup>257</sup> When the *Register of Copyrights Report* recommends a knowledge standard for direct liability, who is liable when it comes to causation?<sup>258</sup> Thus, the ignored issue of authorship is not dead, but resurrects in every lawsuit.

The *Register of Copyrights Report* is well aware of the impossibility of an objective or “should have known” standard, given that the nature of Gen AI makes the user the wrong party to hold liable; nevertheless, the report still recommends imposing liability even in the absence of intent to deceive, particularly in cases involving commercial profit or harassment.<sup>259</sup> Attempting to mitigate this solution—which overlooks the question of what level of harassment or ridicule is permissible under the First Amendment—by requiring a higher standard of proof for subjective intent creates a vicious cycle: if there is neither intent to deceive

---

author of AI-generated works as, otherwise, our system “denies the incentive of copyright to an increasingly large group of works that are indistinguishable in substance and value from works created by human beings.”).

<sup>257</sup> REGISTER OF COPYRIGHTS REPORT, *supra* note 72, at 35 (“[W]e recommend adoption of an actual knowledge standard for direct liability.”).

<sup>258</sup> *Id.* (“Under the actual knowledge standard, liability would attach only where the distributor, publisher, or displayer acted with actual knowledge both that the representation in question was a digital replica of a real person, and that it was unauthorized.”).

<sup>259</sup> *See id.*

nor actual knowledge, it becomes unclear what, if anything, remains to be proven.<sup>260</sup>

The law of torts cannot solve questions of liability and causation in a system that denies their source. The premise that individuals own their identity traits is not linked with their new authorship nor abuse. Unauthorized use can still amount to fair use, yet it is not regarded as such in the new legislation, which diminishes the public domain.<sup>261</sup> Concentrating only on the unauthorized risks of digital replicas instead of offering a coherent solution perpetuates the current legal problems, as neither Gen AI nor publicity rights authorship is concerned.

Focusing only on the unauthorized risks of digital NIL creates a new legal phenomenon, speaking the language of torts while ignoring the most important concept: who the author is. Not only is the already existing legal maze of publicity rights unsolved, but it is also further complicated by the fact that, instead of dealing solely with digital NIL as the second layer of publicity rights, the first layer remains intact—thus ignoring scholars who argue that the legal maze of publicity rights is unconstitutional.<sup>262</sup>

---

<sup>260</sup> *Id.*

<sup>261</sup> ROTHMAN, *supra* note 6, at 212 (“In particular, the speech-restrictive potential of the right of publicity goes much further than that of trademark law, and even libel law, and it may mean that the doctrine as a whole is substantively unconstitutional, at least as to noncommercial speech but perhaps even as to commercial speech.”).

<sup>262</sup> Tushnet, *supra* note 20, at 1539 (“The right of publicity overlaps with trademark in its protections against false endorsement, with copyright in its (supposed) justifications in incentivizing performances, and with traditional privacy and defamation torts in protecting personal dignity and control over one’s own presentation of the self. Yet the right of publicity has been used to extend plaintiffs’ control over works and uses that don’t violate any of the rights with which it shares a justification. This quicksilver nature is what makes the right of publicity so dangerous.”); Rothman, *supra* note 28, at 446 (“In particular, the speech-restrictive potential of the right of publicity goes much further than that of trademark law, and even libel law, and it may mean that the doctrine

The preemption clause, already recognized as a recommended restraint on publicity rights' first layer by *The Yale Workshop Report*, was deserted by the *Register of Copyrights Report* regarding the second layer, despite the initiative of their federal enactment as digital NIL.<sup>263</sup> Instead of the second layer mitigating the first, the *Register of Copyrights Report* took a contradictory trajectory, stating: "Full preemption would reduce existing protections for individuals in states that currently provide broader rights, causing discrepancies between protection for digital replicas and other imitations of their personas."<sup>264</sup>

Thus, all the roads untaken concerning the exaggerated legal power of publicity rights are with us from now to eternity.

## CONCLUSION

This article argues that publicity rights, as a "legal metastasis," threaten to devour all the current paradigms of copyright and trademark laws in both layers. First, as state law IP rights, sharing copyright law's infrastructure, are not bound either by its constraints or the preemption clause, the persona is not considered a "writing" within the scope of copyright law because personas do not meet the fixation requirement. Second, the blurry and unjustified theoretical infrastructure of publicity rights—which leaves us in the

---

as a whole is substantively unconstitutional, at least as to noncommercial speech but perhaps even as to commercial speech.").

<sup>263</sup> REGISTER OF COPYRIGHTS REPORT, *supra* note 72, at 28–9 (delineating its crucial elements, out of which interaction with state laws, i.e. the preemption doctrine, is last in its list, "[W]e have identified the following critical elements: (1) the definition of "digital replica;" (2) the persons protected; (3) the term of protection; (4) prohibited acts; (5) secondary liability; (6) licenses and assignments; (7) accommodation of First Amendment concerns; (8) remedies; and (9) interaction with state laws.").

<sup>264</sup> *Id.* at 50.

dark regarding the legal interest they are meant to protect—is further complicated by their second layer: digital NIL.

Attempting to draw lessons from *The Yale Workshop Report*, this article traces all the roads untaken by the new legislation and adjudication surrounding the two layers of publicity rights in copyright and trademark laws. First, as the idea/expression principle of copyright law was practically erased in *White*, the only shield left to square the conjoined authorship of publicity rights with copyright law is transformative use.

Gaining supremacy for the first fair use factor, meaning incentivizing creativity in *Campbell*, its legacy ended with new originality and First Amendment chaos by creating genre discrimination between a protected parody and an infringing satire. This shift abandoned the long-standing *Bleistein* tradition, which upheld protection for any artistic work that is not copied, regardless of its quality or genre. Regarding publicity rights, a sub-transformative test within the transformative test was created. Using persona as raw material in a larger story was no longer sufficient to cross the required threshold; the likeness of the persona must also be transformed.

The narrowing artistic scope of publicity rights' transformative test, derived from genre-discrimination and judicial bias, morphed into different tests at war with each other where publicity rights' commerciality is always at war with the requested creativity. But scholars offer different classifications, in addition to transformative use, including the predominant use test, actual malice test, relatedness/restatement test, *Rogers* test, and the ad-hoc test.

For a short while, it seemed that *De Havilland* provided a cure for the sub-transformative test, meant as a vehicle for documentary-drama bias, because it held that creators who transform the story of real people into art are entitled to First Amendment protection. However, *AWF v. Goldsmith*, by submitting the first fair use factor to

commercial assessment, rephrased *Campbell* and weakened transformative use. Consequently, squaring publicity rights with the First Amendment is even harder.<sup>265</sup>

The evolution of the *Rogers* test demonstrates how the second arena of trademark law squares publicity rights with the First Amendment. In its heyday, the courts prioritized the *Rogers* test in cases of publicity rights infringement to the original prong of trademark law—the triad model—meant to avoid consumer confusion. The recent *Jack Daniel’s* case reversed this trajectory by subjecting the *Rogers* test to trademark’s first prong, thus weakening an important tool in reshaping the balance of publicity rights with the First Amendment.<sup>266</sup>

The evolution of commercial speech, entitled to no lesser First Amendment protection, fared no better in trademark law adjudication.<sup>267</sup> In *Matal v. Tam* and *Iancu v. Brunetti*, the Supreme Court held 15 U.S.C. § 1052(a) of the Lanham Act unconstitutional because it violated the Free Speech Clause of the First Amendment by attempting to ban commercial speech from registration due to content-based and viewpoint-based discrimination.<sup>268</sup> However, *Vidal v. Elster* diminishes the conflict between publicity rights and the First Amendment to a viewpoint-neutral, content-based condition on trademark registration, ignoring the real

---

<sup>265</sup> *Andy Warhol Foundation v. Goldsmith*, 598 U.S. 508, 525, 550–51 (2023).

<sup>266</sup> *Compare* *Jack Daniel’s Props. v. VIP Prods. LLC*, 599 U.S. 140 (2023), *with* *VIP Prods. LLC v. Jack Daniel’s Props. Inc.*, 953 F.3d 1170 (9th Cir. 2020); *See generally*, Shufro, *supra* note 60 (for the detailed analysis of *VIP Prods. LLC v. Jack Daniel’s Props. Inc.*, 953 F.3d 1170 (9th Cir. 2020)).

<sup>267</sup> *Compare* *Vidal v. Elster*, 602 U.S. 286, 310 (2024), *with* *Matal v. Tam*, 582 U.S. 218 (2017), *and* *Iancu v. Brunetti*, 588 U.S. 388 (2019) (for a contradictory judicial trajectory regarding squaring the commercial speech with the First Amendment).

<sup>268</sup> *Matal*, 582 U.S. at 223, 243; *Iancu*, 588 U.S. at 397–99.

message of the entire requested trademark—which, in *Vidal*, was not merely “Donald Trump,” but “Trump too small.”<sup>269</sup>

The future trajectory of squaring publicity rights with the First Amendment, as reflected in the massive new legislation regarding their extension as digital NIL, is grim. The patchwork legal system—built on contradictory layers of federal and state legislation, as reflected in the *Register of Copyrights Report* and the *USPTO NIL Roundtable*—is left intact by the new legislation. Not only does the blurry foundation that makes publicity rights so problematic persist, but the emerging phenomenon of digital NIL authorship further destabilizes the already flawed balance with the First Amendment, with no recommendations for preemptive measures. The cost of all the roads not taken in restraining publicity rights may haunt us from now to eternity.

---

<sup>269</sup> *Vidal*, 602 U.S. 286.