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The Right of Publicity Gone Wild

Gil Peles*

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I. INTRODUCTION

The right of publicity is now utilized more than ever before. This intellectual property right of persons not to have their image, name, or general likeness used commercially is currently recognized in over half

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of the country.¹ Plaintiffs often spend significant efforts to bring suits to certain states, such as California, with extensive publicity laws and vast case experience.² Both celebrities and non-celebrities are now suing for publicity infringement, while states are passing updated laws that include an assignable post-mortem right.³

At the same time, the right of publicity's application is presently more varied and confusing than ever before. States have applied differing and sometimes conflicting analyses when dealing with right of publicity challenges.⁴ In addition, several states have recently strengthened the right by extending its term, causing a sharp rise in publicity litigation and an increased focus on its conflict with the First Amendment.⁵

While many of the traditional publicity cases have involved celebrities, recent entertainment reflects a huge rise in popularity of "reality" programs—i.e., a popularization of the average person. Once a medium dominated purely by game shows or talk shows, reality television has spread rapidly to prime-time television and film. Today, shows such as *Survivor*,⁶ *American Idol*,⁷ *The Apprentice* and *Elimidate*⁸ have risen to the top of weekly ratings, while game-shows have shifted from daytime to prime-time television with a worldwide audience.⁹ Several

¹ See Alice Haemmerli, *Who's Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 394-98 (1999) (illustrating a scenario where Tom Cruise has separate incentives to bring suit in various states).

² See *id.*

³ In 2001, California enacted a second statute authorizing rights of publicity to be assignable after death, and also extended the term to 70 years—matching copyright law. See CAL. CIVIL CODE § 3344 (West 2001).

⁴ See Stephen R. Barnett, "The Right to One's Own Image": Publicity and Privacy Rights in the United States and Spain, 47 AM. J. COMP. L. 555, 556 (1999) (labeling the current right of publicity a "quilt of inconsistent statutory and common-law interpretations") (citations omitted).

⁵ *Id.*

⁶ CBS Broadcasting, Inc. See website at <http://www.cbs.com/primetime/> (last visited March 14, 2003).

⁷ Fox Broadcasting, Inc. See website at <http://idolonfox.com/home.htm> (last visited March 14, 2003).

⁸ The Apprentice: Mark Burnett Productions in conjunction with Trump Productions LLC. The Apprentice was the #1 new show of the television season for adults 18-49 in its first season (Jan. 8 - Apr. 15, 2004) with an average viewership of 20.7 million people each week. See website at <http://apprentice.tv.yahoo.com/theshow/about.html> (last visited Dec. 19, 2004) Elimidate: Warner Bros. Broadcasting, Inc. See website at <http://elimidate.warnerbros.com/> (last visited Mar. 14, 2003).

⁹ The primetime gameshow "Who Wants to be a Millionaire" has spread to countries all around the world, becoming one of the most popular gameshows of all time. See http://abc.abcnews.go.com/primetime/millionaire/millionaire_home.html (last visited Mar. 14, 2003). Episodes of the Spanish version of American Idol (*Operación Triunfo*) was the most watched show in the history of Spain. Octavio Roca, *From Unknown to Phenom in 2 Years*, MIAMI HERALD, March 21, 2004 at 1M.

reasons probably exist for the reality phenomenon, ranging from a distaste for recycled Hollywood plots to a sense that viewers can relate to the average person in a reality setting.¹⁰

As a result of this “reality” trend, the typical investment required for celebrity status has declined. Now, images of everyday persons can gain significant value and retain similar status to the traditional movie star.¹¹ In the legal realm, this trend raises new issues regarding the ability of an average person to control widespread profiteering out of his or her image. Once a right reserved for celebrities, the scope of the right of publicity has become relevant to the entire population. To this end, courts have increasingly struggled to develop a method of balancing the right of publicity with the First Amendment. While the right of publicity allows celebrities and non-celebrities to control their image, the First Amendment also permits media to display and report on newsworthy people.

This article addresses the current tension between the right of publicity and the First Amendment guarantee of expression. More specifically, in Part II, this article focuses on difficulties posed by the copy and sale of literal reproductions. In Part III, two recently-proposed solutions are presented and evaluated. In *Winter v. DC Comics*,¹² the California Supreme Court utilized a recently developed copyright-based right of publicity test. In *Winter*, a comic book depicted (without permission) plaintiffs Johnny and Edgar Winter, well-known musicians, as half-man half-monster characters.¹³ To decipher whether the comic book could incorporate and sell images of the musicians, the court imported an element of the copyright fair use test to ask whether an artist’s depiction is “transformative.”¹⁴ In *Lane v. MRA Holdings*,¹⁵ the Middle District of Florida relied upon a “related products” test to decide whether a videotaped image of a teenage girl could be internationally marketed and sold for profit within a video series entitled “Girls Gone Wild.”¹⁶ Finally, Part IV proposes an economics-based test, based on a combination of a Second Circuit test and the newly developed California test, in order to reconcile difficulties imposed by the preceding cases and their proposed solutions.

¹⁰ See generally Craig Tomashoff, ‘Reality’ shows’ *Big Brothers*, L.A. TIMES, Feb. 2, 2003, at Calendar Section (documenting the sharp rise in the popularity of reality shows, and contrasting it with gameshows of the past).

¹¹ See *id.*

¹² 30 Cal. 4th 881 (2003).

¹³ *Id.* at 886.

¹⁴ *Id.* at 889.

¹⁵ 242 F. Supp. 2d 1205 (M.D. Fla. 2002).

¹⁶ *Id.* at 1213.

II. BACKGROUND

A. *Origins of the Right of Publicity*

The right of publicity is the right of a person to control the commercial use of his or her identity.¹⁷ Recognition of this right originated within the domain of “privacy” rights.¹⁸ Although historically the average citizen has had a certain amount of privacy protection, the extent to which celebrities and newsworthy people could take advantage of privacy rights was not clear.¹⁹ Some commentators reasoned that if a person’s image is already largely disseminated, it would not affect his or her “privacy” for it to be even further distributed.²⁰ In response to this argument, other commentators created a movement to give celebrities control over their identities.²¹ Scholars such as William Prosser and Melville Nimmer initially proposed the formation of an official “right of publicity,” which incorporated aspects of privacy, property, and tort law.²² Later, the right of publicity came to be viewed as a type of intellectual property.²³ This allowed the rights existing in many fields to converge into one category.²⁴ Consolidation of the right of publicity into the category of intellectual property recognized economic investment in a celebrity identity and, thus, gave it commercial value.²⁵

Today, the right of publicity is recognized in over half of the country.²⁶ California, for example, has a recognized common-law right of publicity as well as an extensive statute allowing for a post-mortem right.²⁷ California Civil Code section 3344 authorizes recovery of damages by any living person whose “name, photograph, or likeness” has

¹⁷ See generally J. Thomas McCarthy, *THE RIGHTS OF PUBLICITY AND PRIVACY*, § 1:37 (2d ed. 2001).

¹⁸ In 1890, Louis D. Brandeis and Samuel D. Warren published in the *Harvard Law Review* an article entitled “The Right to Privacy.” They argued that unauthorized public disclosure of potentially embarrassing facts about one’s private life could harm one’s human dignity. Samuel D. Warren & Louis D. Brandeis, *The Right To Privacy*, 4 HARV. L. REV. 193, 196 (1890); see also *Haelen Lab., Inc. v. Topps Chewing Gum Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (“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 . . .”).

¹⁹ See McCarthy, *supra* note 17, at 1:7.

²⁰ See *id.* § 1:39.

²¹ *Id.* § 1:7.

²² *Id.*

²³ *Id.* § 6:14.

²⁴ *Id.*

²⁵ *Id.* § 1:39.

²⁶ *Id.* § 6:3 (The right to publicity is recognized in 28 states, either by statute or common law.). For an estimate as high as 41 states, see Deborah J. Ezer, *Celebrity Names as Web Site Addresses: Extending the Domain of Publicity Rights to the Internet*, 67 U. CHI. L. REV. 1291, 1293 nn.3-5 (2000) (17 states by statute, 24 others by common law).

²⁷ *Comedy III*, 25 Cal. 4th at 391.

been used without his consent for commercial purposes.²⁸ Section 990 states that any person

who uses a deceased personality's name . . . or likeness . . . for purposes of selling goods . . . without prior consent from the persons specified . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.²⁹

A "deceased personality" is described as a person whose "name, voice, signature, photograph, or likeness has commercial value at the time of his or her death."³⁰ The California statutory right of publicity can therefore be assigned to a designee after death.

Florida, another state with substantial publicity litigation, also has statutory and common law recognition of the right of publicity. Florida Civil Code section 540.08 provides that "[n]o person shall publish, print, display or otherwise publicly use for purposes of trade or for any commercial or advertising purpose the name, portrait, photograph, or other likeness of any natural person without the express written or oral consent to such use. . ."³¹ "Trade," "commercial," or "advertising purpose" has been generally defined as using a person's name or likeness to directly promote a product or service.³²

B. *First Amendment Conflict*

The First Amendment provides a certain amount of protection to speech-related content. The First Amendment goals of preserving an uninhibited marketplace of ideas and fostering self-expression free of government restraint may conflict with the right of publicity.³³ Certain personas might contain some meaning that implicates the public inter-

²⁸ CAL. CIV. CODE § 3344 (West 2001).

²⁹ CAL. CIV. CODE § 3344.1 (2001) (formerly CAL. CIV. CODE § 990 (1984)).

³⁰ *Id.*

³¹ FLA. CIV. CODE § 540.08 (West 2002).

³² See *Valentine v. CBS, Inc.*, 698 F.2d 430, 433 (11th Cir. 1983) (recognizing that the proper interpretation of section 540.08 requires the plaintiff to prove that the defendants used a name or likeness to directly promote a product or service); *Tyne v. Time Warner Entm't Co., L.P.*, 204 F. Supp. 2d 1338 (M.D. Fla. 2002) (recognizing that section 540.08 only prohibits the use of a name or image when such use directly promotes a commercial product or service); *Epic Metals Corp. v. Condec, Inc.*, 867 F. Supp. 1009, 1016 (M.D. Fla. 1994) ("Florida Statute § 540.08 prevents the unauthorized use of a name or personality to directly promote the product or service of the publisher."); *National Football League v. The Alley, Inc.*, 624 F. Supp. 6, 7 (S.D. Fla. 1983) ("Section 540.08 of the Florida Statutes prohibit unconsented use of an individual's name and likeness only when such directly promotes a commercial product or service."); *Loft v. Fuller*, 408 So. 2d 619, 622 (Fla. 4th DCA 1981) ("In our view, Section 540.08, by prohibiting the use of one's name or likeness for trade, commercial, or advertising purposes, is designed to prevent the unauthorized use of a name to directly promote the product or service of the publisher.").

³³ See Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 68 (1994). The First Amendment to the

est.³⁴ Use or discussion of this meaning serves the First Amendment purpose of fostering expression.³⁵ According to Professor Roberta Kwall, “we must have the ability not only to write about, but also to interpret, the thought processes of illustrious individuals who have shaped our society.”³⁶ Thus, a First Amendment interest exists in the use of a newsworthy image for public debate.

At the same time, courts have found that it is in the public interest to allow a person to control his image and, thus, to enforce his right of publicity.³⁷ Generally, there are three policy considerations underlying this right. First, the right of publicity furthers the economic interests of celebrities, enabling those whose identities have monetary value to profit from their fame.³⁸ Celebrities invest substantial resources to increase the value of their image. The right of publicity respects this investment and allows them to reap any benefits that may flow from it.³⁹ Second, the right encourages the production of creative works by providing incentive for people to continue to make the type of investment that is necessary to produce them.⁴⁰ Third, the right prevents the communal use of a person’s identity without compensation under the legal theories of unjust enrichment and deceptive trade practices.⁴¹ It is therefore necessary to strike a balance between a public interest in the First Amendment and the right of publicity.

C. *Balancing the Right of Publicity with First Amendment Concerns*

Federal and state courts have employed several tests in balancing First Amendment rights with the right of publicity. In *Zacchini v. Scripps-Howard Broadcasting Company*,⁴² the United States Supreme Court—in its only right of publicity case to date—considered whether a media company should be allowed to air an entire circus act on an evening newscast, despite the objection of the circus performer.⁴³ The

Constitution provides in pertinent part that “Congress shall make no law . . . abridging the freedom of speech . . .” U.S. CONST. amend. 1.

³⁴ Kwall, *supra* note 33, at 68.

³⁵ *See id.* at 67.

³⁶ *Id.*; *see also* Guglielmi v. Spelling-Goldberg Prods., 25 Cal. 3d 860, 866 (1979) (describing the publicity conflict with the California state Constitution’s reiteration of the First Amendment).

³⁷ Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831, 838 (1983).

³⁸ *Id.*

³⁹ *See* McCarthy, *supra* note 17 at 1:37 (describing policy interests behind the right of publicity).

⁴⁰ Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831, 838 (1983).

⁴¹ *Id.*

⁴² 433 U.S. 562 (1977).

⁴³ *Id.* at 563.

Court found that, although public figures are afforded less First Amendment protection, the First Amendment “[does] not immunize the media when they broadcast a performer’s entire act without his consent.”⁴⁴ From an economic standpoint, the Court found that a performance “is the product of petitioner’s own talents and energy, the end result of much time, effort, and expense”⁴⁵ Thus, the Court found an interest in allowing Zacchini to have control over his image, even to the point of preventing its broadcast via a television newscast.

More recently, the Tenth Circuit in *Cardtoons v. Major League Baseball Players Ass’n* looked to “social purpose” in order to balance the First Amendment with the right of publicity.⁴⁶ In *Cardtoons*, a baseball card company produced comic-book style artwork of baseball players. The court found that, by poking fun at baseball players, the defendant provided “an important form of entertainment and social commentary.”⁴⁷ To evaluate the importance of the defendant’s commentary, the court balanced the “underprotection” and “overprotection” of the right of publicity in question. According to the court,

[u]nderprotection of intellectual property reduces the incentive to create; overprotection creates a monopoly over the raw material of creative expression. The application of the Oklahoma publicity rights statute to *Cardtoons*’ trading cards presents a classic case of overprotection. Little is to be gained, and much lost, by protecting the [Major League Baseball Player’s Association’s] right to control the use of its members’ identities in parody trading cards.⁴⁸

After noting that arguments in support of the right of publicity are “not nearly as compelling as those [arguments] offered for other forms of intellectual property,”⁴⁹ the court held that *Cardtoons* should not be restricted in its card production.

The court in *Cardtoons* considered *Zacchini* to be a “red herring” because it “overstated” the economic incentive argument.⁵⁰ While economic incentive may be a compelling argument for other forms of intellectual property, the court reasoned, “most sports and entertainment celebrities with commercially valuable identities engage in activities that themselves generate a significant amount of income” and do not have the same interests that many copyright or trademark owners

⁴⁴ *Id.* at 575.

⁴⁵ *Id.*

⁴⁶ *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 976 (10th Cir. 1996).

⁴⁷ *Id.*

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ *Id.* at 973.

have.⁵¹ The Tenth Circuit in *Cardtoons* placed significantly less emphasis on economic harm than the Supreme Court. The conflict between the economic analyses of *Cardtoons* and *Zacchini* reflects an ongoing debate about how to balance the First Amendment against the right of publicity.

The Second Circuit attempted to resolve this debate by asking whether a product was created for the purposes of news or trade. In *Titan Sports v. Comics World Corp.*,⁵² a sports promotion company paid magazine publishers to insert poster-size photographs of wrestlers into their periodicals. The Second Circuit asked whether the posters were used for “purposes of trade.”⁵³ According to the court,

a photograph accompanying an article concerning a matter of public interest may still be considered a use for the purposes of trade if it has no real relationship to the article . . . or . . . the article is an advertisement in disguise In contrast to the treatment of newsworthy items, it seems clear that photographs marketed as posters are used for the purposes of trade.⁵⁴

The balance in *Titan Sports* therefore centered on newsworthiness. A purely commercial portrayal of a person would clearly be “for purposes of trade” and would not gain First Amendment protection.⁵⁵ Thus, although *Comics World*’s posters were placed in a periodical, they served no newsworthy purpose, and so they constituted a right of publicity infringement.

Finally, the Ninth Circuit in *White v. Samsung Electronics* expanded celebrities’ control over their identities by broadening the definition of “identity.”⁵⁶ Here, Samsung created a television commercial involving a future recreation of the popular game show “Wheel of Fortune.”⁵⁷ The ad depicted a robot, dressed in a wig and gown, posing next to a game board in such a way that it was instantly recognizable as the stance for which White is famous.⁵⁸ Although White was never compensated and never consented to the advertisement’s creation, Samsung referred to the ad as “the Vanna White ad .”⁵⁹ The court

⁵¹ *Id.*

⁵² 870 F.2d 85 (2d Cir. 1989).

⁵³ *Id.* at 89.

⁵⁴ *Id.* at 88. (citations and internal quotations omitted).

⁵⁵ See Darren F. Farrington, *Should the First Amendment Protect Against Right of Publicity Infringement Actions Where the Media is Merchandiser? Say It Ain't So, Joe*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 779 (1997) (advocating a use of the *Titan* test in other publicity cases).

⁵⁶ 971 F.2d 1395 (9th Cir. 1992).

⁵⁷ *Id.* at 1396.

⁵⁸ *Id.* at 1397.

⁵⁹ *Id.*

found that the right of publicity is not limited to the appropriation of a literal name or likeness, but also includes one's general "identity."⁶⁰ According to the court, a narrow rule "which says that the right of publicity can be infringed only through the use of nine different methods of appropriating identity merely challenges the clever advertising strategist to come up with the tenth."⁶¹ Since Samsung's robot was recognizable as Vanna White, it constituted an appropriation of her identity and violated her right of publicity under California law.⁶²

The conflicts between the differing analyses in *White*, *Cardtoons*, *Titan Sports*, and *Zacchini* illustrate the difficulty in finding a balance between the First Amendment and the right of publicity. To resolve the conflict, each court decided to emphasize separate issues in the dispute. While the Second Circuit focused on newsworthiness, the Ninth Circuit tried to resolve the issue over the control of one's "identity." Recent years have seen both federal and state courts tackle the conflict with increasingly creative reasoning.

III. MODERN SOLUTIONS

Modern case developments have displayed new and creative methods of balancing the right of publicity with First Amendment concerns. California and Florida have recently decided two important cases that may influence courts' reasoning in future right of publicity cases. The California Supreme Court imported an element of the copyright fair use test in order to determine whether depictions were "transformative" enough to deserve right of publicity protection.⁶³ The Middle District of Florida utilized a "related products" test to find that the use of a video clip in television commercials was valid, so long as the commercials were meant to sell the video clip in question.⁶⁴

A. *A Fair Use Test*

In *Winter v. DC Comics*,⁶⁵ the California Supreme Court utilized a recently developed copyright-based right of publicity test. In *Winter*, plaintiffs Johnny and Edgar Winter, both well-known musicians, were—without their permission—depicted in a comic book as half-man, half-monster characters.⁶⁶ The Winter brothers sued DC Comics,

⁶⁰ *Id.* at 1398.

⁶¹ *Id.*

⁶² *Id.* at 1399.

⁶³ *Comedy III*, 25 Cal. 4th at 404.

⁶⁴ *Lane*, 242 F. Supp. 2d at 1205.

⁶⁵ 30 Cal. 4th 881 (2003).

⁶⁶ *Id.* at 886.

alleging several causes of action, including appropriation of their right of publicity under California Civil Code section 3344.⁶⁷ The defendants had not named the characters the “Winter Brothers,” but instead the defendants had selected the names Johnny and Edgar Autumn in order to signal to readers that they were portraying the Winter brothers. In addition, the defendants depicted the “Autumn Brothers” with long white hair and albino features similar to those of the Winters.⁶⁸ The Winter Brothers viewed these characters as “vile, depraved, stupid, cowardly, subhuman individuals who engage in wanton acts of violence, murder and bestiality for pleasure and who should be killed.”⁶⁹

On review, the California Supreme Court held that the comic book’s use of the Winter Brothers’ image was protected by the First Amendment guarantee of freedom of expression.⁷⁰ To arrive at its holding, the court utilized, for only the second time, a test that it developed in 2001—a copyright based “fair use” test for the right of publicity.⁷¹

1. Origins of the California Test

The California publicity fair use test was developed in a 2001 California Supreme Court case, *Comedy III v. Saderup*.⁷² In that case, defendant Gary Saderup, a painter and sketch artist, had produced and sold t-shirts and posters depicting his own charcoal-type drawings of celebrities.⁷³ Plaintiff Comedy III Productions owned the rights to all items bearing an image of The Three Stooges.⁷⁴ Without obtaining permission from Comedy III, Saderup sold lithographic drawings and

⁶⁷ *Id.*

⁶⁸ In addition, the Johnny Autumn character was depicted as wearing a tall black top hat similar to one that Johnny Winter often wore. Furthermore, the title of volume four, “Autumns of Our Discontent,” refers to the famous Shakespearian phrase, “the winter of our discontent.” *Id.*

⁶⁹ *Id.* DC Comics published a five-volume comic miniseries involving giant worm-like creatures, singing cowboys, and the “Wilde West Ranch and Music and Culture Emporium,” named for and patterned after the life of Oscar Wilde. The third volume ends with a reference to two new characters, the “Autumn brothers,” and the cover of volume 4 depicts the Autumn brother characters, with pale faces and long white hair. “Johnny and Edgar Autumn,” depicted as villainous half-worm, half-human offspring born from the “rape of their mother by a supernatural worm creature that had escaped from a hole in the ground.” The Autumn brothers are killed at the end of volume 5 in an underground gun battle. *Id.*

⁷⁰ *Id.* at 892.

⁷¹ *Id.* at 889.

⁷² 25 Cal. 4th 387 (2001).

⁷³ *Id.* at 389.

⁷⁴ *Id.* Comedy III Productions was formed by Larry Fine, Moe Howard, and Curly Joe Dirita in 1959. Fine, Howard, and Dirita were three of the six actors who played the Three Stooges. See The Three Stooges Official Website, at <http://www.threestooges.com/bios/curlyjoe.htm> (last visited July 19, 2004).

shirts bearing a charcoal drawing of the Stooges.⁷⁵ As a result, *Comedy III* brought an action seeking damages and injunctive relief against Saderup under California Civil Code section 990, alleging that Saderup's use of the Stooges' likenesses constituted a violation of the Stooges' publicity rights.⁷⁶

In deciphering how to balance Saderup's First Amendment right against the Stooges' right of publicity, the court imported an element of the four-factor copyright "fair use" doctrine.⁷⁷ One specific fair use factor—"the purpose and character of the use"⁷⁸—was utilized to determine whether Saderup's work "merely 'supersedes the objects' of the original creation," or "adds 'something new'" that makes the work sufficiently "transformative."⁷⁹ Applying the "transformative" test to the right of publicity, the court asked whether a product containing a person's likeness "is so transformed that it has become primarily the defendant's own expression" rather than that of the likeness.⁸⁰

After applying this test, the court found that Saderup's work contained no significant transformative element.⁸¹ Due to its lack of a transformative element, the court found that Saderup must cease his sale of his own artistic depictions of the Stooges.⁸²

2. Application to *Winter*

Winter was brought to the California Supreme Court after the California Court of Appeals refused to utilize a strict application of the *Comedy III* test. In approaching the unauthorized depictions of the half-worm, half-human Winter Brothers, the California Court of Appeals reasoned that the comic book use violated the Winter Brothers' right of publicity because it was "trading on [the plaintiffs'] likenesses

⁷⁵ *Comedy III*, 25 Cal. 4th at 393.

⁷⁶ 68 Cal. App. 4th 744, 747 (Cal. App. 1998). (California Civil Code § 990 requires consent for any use of a deceased individual's likeness on products, merchandise, or goods.) *Comedy III* alleged a statutory (rather than common law) claim as § 990 allowed them to own the rights through assignment. The common law right to publicity is not assignable.

⁷⁷ Copyright's four fair use factors are: (1) The purpose and character of the use, including whether such use is of a commercial nature; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work. 17 U.S.C. § 107 (1994).

⁷⁸ 17 U.S.C. § 107(1) (1994).

⁷⁹ *Comedy III*, 25 Cal. 4th at 404 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 585 (1994)).

⁸⁰ *Id.* at 406.

⁸¹ *Id.* at 409.

⁸² The court found Saderup's work to be expressive, however, his expression was discounted as being "trivial." *Id.* at 408.

and reputations.”⁸³ Had the court of appeals properly applied the *Comedy III* test, it would not have asked a purely economic question. Rather, it would have considered whether the artistic depiction “adds ‘something new’” that is sufficiently “transformative.”⁸⁴ Common sense would dictate that a half-worm body would qualify as “something new,” even though it was an unauthorized depiction that appeared in comic books that were sold on the mass market.

In reversing the court of appeal’s decision, the California Supreme Court stated that it regarded the application of its test to *Winter* to be “not difficult.”⁸⁵ It noted that the half-worm characters “are not just conventional depictions of plaintiffs” and “contain significant expressive content other than plaintiffs’ mere likenesses.”⁸⁶ Although the idea that the comic book characters were based on the Winter brothers was “less-than-subtle,” the court reasoned that “the books do not depict plaintiffs literally. Instead, plaintiffs are merely part of the raw materials from which the comic books were synthesized.”⁸⁷ Reading through the comic itself, the court noted that storyline was much “larger” than a simple “half-human and half-worm” character “which is itself quite expressive.”⁸⁸ The court further noted that the comic book does not serve as a market substitution for the Winter Brothers’ merchandise.⁸⁹ Fans of the Winter Brothers “would find the drawings of the Autumn brothers unsatisfactory as a substitute for conventional depictions.”⁹⁰ Due to the “transformative” nature of the comic book characters, the court found that the comic books were a “fair use” of the Winters’ right of publicity.

3. Copyright Fair Use Importation

The California right of publicity fair use test utilized in *Winter* was developed to serve a similar role as the copyright fair-use doctrine serves. Fair use was first instituted in copyright as a test that would unify future decisions requiring a balance between First Amendment and copyright interests.⁹¹ Justice Story in *Folsom v. Marsh* was motivated by the need for a test that discovered “the value of the materials

⁸³ *Winter v. DC Comics*, 99 Cal. App. 4th 458, 473-74 (2002).

⁸⁴ *Comedy III*, 25 Cal. 4th at 404 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 585 (1994)).

⁸⁵ *Winter*, 30 Cal. 4th at 890.

⁸⁶ *Id.*

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *Folsom v. Marsh*, 9 F. Cas. 342, 349 (C.C.D. Mass. 1841) (No. 4,901).

taken, and the importance of it to the sale of the original work.”⁹² Story’s test marked a significant achievement because, prior to *Folsom*, copyright was marred by the inconsistency of First Amendment jurisprudence.⁹³ Previously, courts had applied a number of subjective tests, which varied from one that considered the “quantity” of the work used, to another that analyzed the intrinsic and societal value of allowing a “fair” quotation of copyrighted material.⁹⁴ Justice Story reasoned that, in reconciling the First Amendment with copyright interests, the main factors that courts should apply were an evaluation of the nature of the new work, the value and quantity of the copyrighted portion used, and the economic impact on the original work’s current or future market.⁹⁵

The right of publicity was born with similar defects. Absent a First Amendment balancing test, the right of publicity finds itself in a similar situation as that of copyright law before the fair use test was implemented. That is, the right of publicity is in need of a clear, unified test to resolve future First Amendment questions. As once was the case for copyright law, courts in right of publicity cases have employed varied and often conflicting balancing tests to delineate between First Amendment protection and the right of publicity. Lines of analyses vary from a pure economic analysis⁹⁶ to a social benefit analysis.⁹⁷ Moreover, the nature and the application of the right of publicity has varied significantly between states.⁹⁸ By drawing on copyright principles, courts can

⁹² *Id.* at 348.

⁹³ *See id.* Prior to Justice Story’s classification, some courts would vary their tests from looking wholly at the “quantity” of the work appropriated, while others would attempt to determine the subjective “value” of the copied work in order to determine if the use interfered with the copyright. *See id.* Story found a need to consolidate these views to create a unified fair use test. His test was later codified in 17 U.S.C. § 107.

⁹⁴ *Id.* Story referred to common law decisions to illustrate the inconsistent ways in which judges reasoned. *See, e.g.,* *Wilkins v. Aikin*, 17 Ves. 422, 424 (1810) (focusing on the quantity of the material used to determine whether the amount used constituted “fair quotation”); *Bramwell v. Halcomb*, 3 Mylne & Cr. 737, 738 (1836) (explaining that “[o]ne writer might take all the vital part of another’s book, though it might be but a small proportion of the book in quantity. It is not only quantity, but value, that is always looked to.” According to this reasoning, it is irrelevant whether the quoted amount was fair, so long as the quotation itself is valuable); *Roworth v. Wilkes*, 1 Camp. 94 (1807) (inquiring into whether the copied work would serve as a “substitute” for the original); *see also* WILLIAM F. PATRY, *THE FAIR USE PRIVILEGE IN COPYRIGHT LAW*, 6-7 (2d ed. 1995) (chronicling the development of fair use prior to *Folsom v. Marsh*).

⁹⁵ *Folsom*, 9 F. Cas. at 348.

⁹⁶ *See* *Zacchini*, 433 U.S. at 575.

⁹⁷ *See* *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1356 (D.N.J. 1981).

⁹⁸ Stephen R. Barnett, “*The Right to One’s Own Image*”: *Publicity and Privacy Rights in the United States and Spain*, 47 AM. J. COMP. L. 555, 556 (1999) (labeling the current right of publicity a “quilt of inconsistent statutory and common-law interpretations”) (citations omitted).

bring a greater amount of predictability into this area.⁹⁹ The test must “distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity.”¹⁰⁰ Application of copyright fair use doctrine into right of publicity decisions can help to achieve a balance between First Amendment free speech interests and the goals underlying the right of publicity; namely, to promote creative endeavors and prevent unjust enrichment.¹⁰¹

4. Evaluation of the California Test

The California fair use publicity test, however, does not contain the proper guidelines to achieve a balance between the First Amendment and the right of publicity. The California test, according to the court in *Winter*, is intended to determine “whether the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.”¹⁰² In other words, it seeks to determine whether the product “is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.”¹⁰³ “Expression” is vaguely classified as “something other than the likeness of the celebrity.”¹⁰⁴ The vague classification and requirement effectively leaves ambiguous the amount of expression that is necessary to be considered transformative.¹⁰⁵

The court in *Comedy III* provided only one example that would hypothetically satisfy its test; however, this example is not particularly helpful because it concerns a parody.¹⁰⁶ In copyright, as well as publicity, parody places itself in an obvious transformative category.¹⁰⁷ It is very easy to demonstrate how parody is “transformative.”¹⁰⁸

The court in *Winter* went a bit further. It explained that the “transformative” elements “are not confined to parody and can take many forms, from factual reporting to fictionalized portrayal, from heavy-

⁹⁹ *Id.*

¹⁰⁰ *Comedy III*, 25 Cal. 4th at 403.

¹⁰¹ See Dall T.E. Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781, 821 (1988).

¹⁰² *Winter*, 30 Cal. 4th at 888 (quoting *Comedy III*, 25 Cal. 4th at 406).

¹⁰³ *Comedy III*, 25 Cal. 4th at 406.

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* at 406.

¹⁰⁶ *Id.* (“*Cardtoons* . . . is consistent with this ‘transformative’ test.”).

¹⁰⁷ See *Campbell*, 510 U.S. at 579 (“Parody has an obvious claim to transformative value Like less ostensibly humorous forms of criticism, it can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one.”).

¹⁰⁸ *Id.*

handed lampooning to subtle social criticism.”¹⁰⁹ Neither *Comedy III* nor *Winter*, however, listed specific elements to be employed in determining whether works are sufficiently transformative. It was this lack of guidance, perhaps, that led the California Court of Appeals in *Winter* to fall back on an economic analysis. While it may be difficult to craft a bright-line rule to determine what constitutes expression, the courts in *Comedy III* or *Winter* could have given further examples of transformative works. Instead, it merely presented broad categories such as “heavyhanded lampooning” and “subtle social criticism.”¹¹⁰

Furthermore, in both *Comedy III* and *Winter*, the California Supreme Court seemed to contradict itself repeatedly with regard to the possibility of employing an economic test. In *Comedy III*, the court spent a fair amount of time explaining why a distinct economic inquiry was “irrelevant” and not helpful.¹¹¹ The court, however, decided to allow economic considerations as an optional inquiry, “particularly in close cases,” as a “subsidiary inquiry.”¹¹² This “subsidiary inquiry” might ask if “the marketability and economic value of the challenged work derive[s] primarily from the fame of the celebrity depicted.”¹¹³ The court further hinted at an economic test when it referred to *Cardtoons* as being properly decided on the grounds that the parody was found “not likely [to] substantially impact the economic interests of celebrities.”¹¹⁴ Thus, a use is more likely to be transformative if it does not impact a celebrity’s “economic interests.”¹¹⁵ It is unclear, however, when this “subsidiary” inquiry should be employed, and how it should be weighed against the general transformative test. Saderup’s situation was considered a close case, however, and the court did not fully utilize the economic test as designated.¹¹⁶

The *Winter* court regarded the economic inquiry in a manner similar to that of the *Comedy III* court. Once again quoting *Comedy III*, the *Winter* court emphasized that “[i]f it is determined that a work is worthy of First Amendment protection because added creative elements significantly transform the celebrity depiction, then independent inquiry into whether or not that work is cutting into the market for the celebrity’s images . . . appears to be irrelevant.”¹¹⁷ Despite the “irrele-

¹⁰⁹ *Winter*, 30 Cal. 4th at 888 (citations omitted).

¹¹⁰ *Id.*

¹¹¹ *Comedy III*, 25 Cal. 4th at 405 n.10.

¹¹² *Id.*

¹¹³ *Id.*

¹¹⁴ *Id.* at 406.

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ *Winter*, 30 Cal. 4th at 890.

vant” label, it then proceeded to engage in an economic inquiry, noting that “[p]laintiffs’ fans who want to purchase pictures of them would find the drawings of the Autumn brothers unsatisfactory as a substitute for conventional depictions.”¹¹⁸ Furthermore, it stated that “[w]hen an artist’s skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist’s right of free expression is outweighed by the right of publicity.”¹¹⁹ On the one hand, the court criticized an economic test as “irrelevant,” and overturned the court of appeals for utilizing an economic inquiry. On the other hand, it repeatedly gave economic examples to justify its right of publicity test. Thus, it remains unclear whether California courts will enlist an economic inquiry in future situations and how this inquiry will materialize. The California right of publicity fair use test, therefore, requires a significant amount of future interpretation to determine its usefulness and practical application.

B. *A Related Products Test*

In *Lane v. MRA Holdings*,¹²⁰ the Middle District of Florida faced a right of publicity question involving a non-famous person. To decide whether an average person’s public image can be sold for financial gain, the court relied on a “related product” test.¹²¹ The court found that there is no right of publicity infringement where the product sold is nothing more than an actual image of the person, so long as the image does not advertise a separate product.¹²²

In *Lane*, the defendant company produced “reality” videos depicting scenes from actual celebrations and events, such as Mardi Gras and various college spring break parties.¹²³ The most popular of these videos, entitled *Girls Gone Wild*, depicts young, usually intoxicated women exposing their bodies on beaches, along streets, and in other public places.¹²⁴ The girls in the videos may or may not have been aware that they were being filmed, and were quite often not required to sign any type of waiver.¹²⁵ One such girl was plaintiff Lane, who was driving an automobile during a spring break celebration in Panama City Beach,

¹¹⁸ *Id.* at 891.

¹¹⁹ *Id.* at 888-89 (citation omitted).

¹²⁰ 242 F. Supp. 2d 1205 (2002).

¹²¹ *Id.* at 1213.

¹²² *Id.*

¹²³ *Id.* at 1208.

¹²⁴ *Id.*; see also website at <http://www.girlsgonewild.com> (last visited Jan. 15, 2004).

¹²⁵ *Id.*

Florida.¹²⁶ While Lane operated her automobile, she and a female passenger, who was sitting in the front passenger seat of Lane's car, were stopped and approached by individuals who were in possession of a video camera.¹²⁷ The individuals requested that Lane, along with her companions, expose themselves before the video camera in exchange for beaded necklaces.¹²⁸ After some conversation, and a reassurance that the video would not be shown anywhere else, Lane and her companion agreed.¹²⁹

After the incident, the defendants acquired, edited, assembled, produced, and distributed clips of Lane exposing her body, together with many similar clips, within their *Girls Gone Wild* video.¹³⁰ The video was marketed internationally through paid television commercials containing a censored three-second clip of Lane exposing herself.¹³¹ In addition, the video in which Lane appeared was marketed and sold along with another video titled *Sexy Sorority Sweethearts*.¹³²

Lane discovered her appearance in *Girls Gone Wild* when she saw herself in the commercials for the video.¹³³ The video shocked Lane because she claimed to be under the impression that the cameraman who approached her had intended to make a film only for his own personal use.¹³⁴ According to Lane, she acted in reliance on the cameraman's representations, and she would not have acted as she did if she had known that the video in question was to become part of *Girls Gone Wild*.¹³⁵ Lane filed a complaint against MRA Holdings in Florida state court.¹³⁶ Based on diversity of citizenship, MRA removed the lawsuit to the United States District Court for the Middle District of Florida.¹³⁷

The district court focused on the method in which Lane's image was used. It found that MRA Holding's use of Lane's image did not violate her right of publicity because the use was "not used to directly promote a product or service."¹³⁸ In defining "trade," the court relied

¹²⁶ *Id.* at 1209. It should be noted that Lane was seventeen years old at the time of the incident.

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Id.*

¹³⁰ *Id.* at 1210.

¹³¹ *Id.* at 1211.

¹³² *Id.*

¹³³ *Id.* at 1210.

¹³⁴ *Id.*

¹³⁵ *Id.*

¹³⁶ *Id.*

¹³⁷ *Id.* at 1211.

¹³⁸ *Id.* at 1213.

upon Section 47 of the Restatement (Third) of Unfair Competition which defines “the purposes of trade” as

[t]he names, likeness, and other indicia of a person’s identity are used “for the purposes of trade” . . . if they are used in advertising the user’s goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user. However, use “for the purpose of trade” does not ordinarily include the use of a person’s identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising incidental to such uses.¹³⁹

Under this definition, the court reasoned that the use of another’s identity in a motion picture is not an infringement unless “the name or likeness is used solely to attract attention to a work that is not related to the identified person.”¹⁴⁰ The court held that, because *Girls Gone Wild* is an expressive work, and Lane is not shown directly endorsing a separate, unrelated product, the use of Lane’s image does not violate her right of publicity under Section 540.08.¹⁴¹

In developing its “related products” test, the court relied on two Florida cases, both of which involved an unauthorized reenactment of events from the plaintiffs’ real lives in movie format.¹⁴² In the first case, *Tyne v. Time Warner*,¹⁴³ a highly publicized boating accident was converted into a movie entitled *The Perfect Storm*. The court reasoned that the plaintiff’s right of publicity was not violated because defendants did not use the plaintiff’s likeness to advertise their movie and, therefore, the plaintiff did not have a cause of action.¹⁴⁴ Addressing the advertising issue, they noted:

In the instant case, Plaintiffs have failed to raise a genuine issue of material fact as to whether the use of decedents’ likenesses and their own likenesses were used for the purposes of trade or a commercial purpose. Plaintiffs have presented no evidence showing that their names and likenesses were used to directly promote *The Perfect Storm*. In the absence of such evidence, Plaintiffs have no cause of action under § 540.08.¹⁴⁵

Thus, Time Warner did not violate Tyne’s right of publicity because they never used his likeness for advertisements.

¹³⁹ *Id.* at 1213.

¹⁴⁰ *Id.* I refer to the Florida test as a “related products” test.

¹⁴¹ *Id.*

¹⁴² The two cases that the court relied on were: *Tyne v. Time Warner Entm’t Co., LP*, 204 F. Supp. 2d 1338 (M.D. Fla. 2002), and *Loft v. Fuller*, 408 So. 2d 619 (Fla. 4th DCA 1981).

¹⁴³ 204 F. Supp. 2d 1338 (M.D. Fla. 2002).

¹⁴⁴ *Id.* at 1344.

¹⁴⁵ *Id.* at 1342.

Despite the fact that *Tyne* involves a permissible publicity use, its connection to the “related product” test is questionable. *Tyne* did not involve the use of plaintiff’s image, name, or likeness in the advertisement of the movie.¹⁴⁶ Furthermore, the film in question was primarily about the plaintiff, as opposed to the clip at issue in *Lane*, which represented only a small part of a larger work.

The second case cited, *Loft*, likewise did not involve the use of the plaintiff’s name or likeness within advertisements.¹⁴⁷ Much like *Tyne*, *Loft* involved a situation where a book, and subsequently a motion picture, were created based on a newsworthy story about the plaintiff.¹⁴⁸ *Loft*’s image or likeness was not used in the advertisements for the product.¹⁴⁹ Again, both *Loft* and *Tyne* involved the depiction of newsworthy events. The clip at issue in *Lane*, however, was merely a snippet of a larger work that was not about the plaintiff. Thus, the newsworthiness of the clip was clearly different than that of the works at issue in the other cases—as was utilization of plaintiff’s image in marketing materials. In solely relying on *Tyne* and *Loft*, the Middle District of Florida constructed its “related product” test on shaky foundation.

1. Benefits of the Florida Test

The “related product” test may solve many current problems with balancing the right of publicity against the First Amendment. In cases like *Comedy III* and *Winter*, it may be much easier to employ a “related product” analysis than to incorporate California’s somewhat vague right of publicity fair use test. Products that merely sell or present a person’s image would pass. Conversely, the use of a person’s image to advertise or sell a separate unrelated product would not pass. Attaching someone’s image to a product that has a separate function (i.e., a clock or food item) would likewise not pass.¹⁵⁰

The related products test would help to eliminate ambiguity inherent in prior tests that used variants of the balancing method. *Cardtoons*, for example, focused on directly balancing the right of publicity with the defendant’s First Amendment right.¹⁵¹ *Comedy III* and *Winter* looked directly at the speech itself, and how much expression

¹⁴⁶ *Id.*

¹⁴⁷ *Loft v. Fuller*, 408 So. 2d 619 (Fla. 4th DCA 1981).

¹⁴⁸ *Id.* at 620.

¹⁴⁹ *Id.* at 621.

¹⁵⁰ Stephen R. Barnett, *The American Right of Publicity and Visual Art: Solutions for the Growing Conflict*, Paper Prepared for the Advancement of Teaching and Research in Intellectual Property (ATRIP) Conference, October 6-8 2002, at 26.

¹⁵¹ *Cardtoons*, 95 F.3d at 976.

existed in the product sold.¹⁵² Under either of these tests, the subjective determinations of the court come into play. In essence, a judge or jury decides how artistic a product must be. Justice Holmes once warned that “[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”¹⁵³ A related products test eliminates such subjective artistic determination.

Furthermore, as Professor Stephen Barnett notes, the right of publicity carries over a type of moral element.¹⁵⁴ A defendant’s use of the plaintiff’s identity to advertise or sell a separate product violates the plaintiff’s ownership right in his or her identity. In such a case, the defendant is misusing the plaintiff’s identity for a selfish purpose.¹⁵⁵ Selling a mere picture of the plaintiff, on the other hand, can be analogized to selling a fact. Facts are not copyrightable, and the related product test carries this permissible use into publicity. In other words, according to Barnett,

if one cannot copyright one’s appearance, one should not be able to monopolize it under the banner of the right of publicity. A property right claimed under the right of publicity in one’s likeness per se therefore should be preempted by the Copyright Act, as well as being inconsistent with the First Amendment and with the original claims of the right of publicity itself.¹⁵⁶

To properly develop a related products test, courts must draw criteria for finding acceptable products. As a guideline for finding acceptable related products, McCarthy suggests that courts analyze the issue according to copyright law’s useful article doctrine.¹⁵⁷ To this end, “[t]raditional ‘media’ objects such as books, magazines, newspapers and videotapes have no function other than to convey information” and would easily pass.¹⁵⁸ Barnett takes this criterion a step further to ask

not whether the article has *an* intrinsic utilitarian function, but whether it serves *primarily* some intrinsic utilitarian function distinct from conveying information. Under this test T-shirts may be a close case . . . [and] [t]his rule, as mentioned, would change the result in

¹⁵² See *Comedy III*, 25 Cal. 4th at 407.

¹⁵³ *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239, 251 (1903).

¹⁵⁴ Barnett, *supra* note 150.

¹⁵⁵ *Id.*

¹⁵⁶ *Id.* at 23.

¹⁵⁷ McCarthy, *supra* note 17, at 7:46.

¹⁵⁸ *Id.*

cases holding that posters of celebrities violate the right of publicity.¹⁵⁹

2. Criticism of the Florida Test

While the related products test may indeed clear up messy situations created by past balancing tests, one can argue that a “related products” test merely shifts the ambiguous subjective determination away from the art and onto the product. In each case involving a product with dual uses, the court would have to determine whether the dual-use product is a related product in the context of that case. Figurines, for example, could be considered pieces of art for adults or play-toys for children. Posters convey information, and yet they also decorate walls. If one assumes that posters are acceptable, then perhaps wallpaper could be considered a “type” of poster. Wallpaper, however, has an intrinsic function somewhat similar to that of posters, only on a larger scale. If T-shirts do not qualify, then what about mass-produced iron-on images that can be affixed to T-shirts? One can easily picture entrepreneurs going to great lengths to create intrinsically non-utilitarian, function-less products that do not require licenses in order to profiteer off of celebrity images.¹⁶⁰

Even if courts embrace one method of classifying artistic products in order to determine which types of celebrity depictions are acceptable, the “related products” test still poses increased difficulties with regard to motion pictures and television. Going back to the *Lane* scenario, a proponent of “related products” might argue that a person should not be able to prohibit dissemination of his or her public image. To do so would create a problem with the dissemination of newsworthy images, and amount to censorship of material even when its availability is in the public interest. It is, however, very difficult to categorize MRA Holdings’ marketing of *Girls Gone Wild* as a newsworthy event. Indeed, MRA Holdings exploited Lane’s image to the highest degree—profiting from it to an extent far beyond what a news outlet would do—all in order to market a video that was not really about Lane.

Two general approaches may be taken to the *Lane* situation. First, one may agree with the Middle District of Florida, and decide that any person—celebrity or non-celebrity—should realize that any public appearance may be recorded, replayed and sold to the entire world.

¹⁵⁹ Barnett, *supra* note 150, at 26. The poster case that Barnett refers to is the Second Circuit’s *Titan Sports* case, *see supra* Section I-C.

¹⁶⁰ One can easily imagine hordes of celebrity merchandise being packaged as art or memorabilia. A Tom Cruise piggy bank would be marketed as an art statuette; a Brad Pitt poster would be marketed as a piece of art that is used primarily to display the celebrity.

Under this approach, even though Lane was promised that her image would not be disseminated, she should have realized that there was a possibility that it would be disseminated, and she should accept the consequences. A second (opposite) reaction may resemble that of the Second Circuit in *Titan Sports*. In that case, the court drew a distinct line between newsworthy or entertainment uses and pure commercial exploitation.¹⁶¹ Under this approach, courts must consider “whether these photos are included primarily for their ‘public interest aspect’ or whether whatever public interest aspect might be involved is merely incidental to the distributors’ commercial purpose.”¹⁶² A new solution is necessary to make this type of determination.

IV. A SUGGESTED SOLUTION

A. *Background*

A dilemma still exists in determining how the right of publicity should be balanced with the First Amendment. This dilemma is exemplified by products that include literal reproductions of a person.¹⁶³ Currently, if a company wants to produce and sell pictures of celebrities, their product might be acceptable in Florida,¹⁶⁴ but rejected in California for lack of a transformative element.¹⁶⁵ The Tenth Circuit may accept it;¹⁶⁶ however, the Second Circuit may reject it for lack of a newsworthy element.¹⁶⁷ The dilemma remains over a proper method of promoting artist expression, retaining celebrity incentive, and allowing dissemination of newsworthy ideas while preventing undue commercial exploitation. This section suggests a “compromise” solution: a test resembling copyright’s fair use doctrine that incorporates both the California Supreme Court’s transformative factor and the Second Circuit’s “newsworthy” test.¹⁶⁸

¹⁶¹ 870 F.2d 85, 88.

¹⁶² *Id.* at 88-89 (citations omitted).

¹⁶³ The tension over literal reproductions is illustrated in *Comedy III*, in which the California Supreme Court heavily criticized the California Appellate Court’s treatment of the subject. According to the California Appellate Court, “Simply put, although the First Amendment protects speech that is sold [citation omitted], reproductions of an image, made to be sold for profit do not per se constitute speech.” *Comedy III*, 25 Cal. 4th at 408. The California Supreme Court found that “this position has no basis in logic or authority . . . a reproduction of a celebrity image that, as explained above, contains significant creative elements is entitled to as much First Amendment protection as an original work of art.” *Id.*

¹⁶⁴ Per the *MRA Holdings*’ related doctrine test, so long as posters, or advertisements for the posters, are selling nothing more than the person’s image.

¹⁶⁵ Per the *Comedy III* or *Winter* transformative test.

¹⁶⁶ Per *Cardtoons*, so long as there is a societal interest in doing so.

¹⁶⁷ Per *Titan Sports*.

¹⁶⁸ *Id.*

The copyright fair use doctrine may prove to be a useful tool for the right of publicity. The California Supreme Court chose to utilize copyright fair use because of several similarities between copyright and the right of publicity. Copyright law is designed to “stimulate activity and progress in the arts for the intellectual enrichment of the public.”¹⁶⁹ This utilitarian goal is achieved by permitting authors to reap the rewards of their creative efforts, while not conferring unfettered ownership, because to do so might stifle creativity.¹⁷⁰ The right of publicity shares similar policy goals.¹⁷¹ Both the First Amendment and copyright law “have a common goal of encouragement of free expression and creativity, the former by protecting such expression from government interference, the latter by protecting the creative fruits of intellectual and artistic labor.”¹⁷² The right of publicity likewise seeks to give celebrities control over their names and likenesses, while stimulating creation and free expression.

Due to the fact that they have analogous goals, copyright law can provide a framework for the right of publicity. First, by permitting individuals to benefit from their personal efforts, both the right of publicity and copyright provide incentive for creative endeavors.¹⁷³ Second, both pose a potential conflict with the First Amendment rights. By utilizing the copyright analogy in right of publicity decisions, courts can inject uniformity and predictability into an area of law that often contains inconsistent reasoning.¹⁷⁴

Unfortunately, the California right of publicity fair use test (a single transformative test with an optional economic subsidiary) did not go far enough.¹⁷⁵ Rather, instituting an “economic” inquiry within a distinct fair use factor, and balancing it with the “transformative” factor, may add clarity to a right of publicity fair use standard. This separate factor could be utilized similarly to copyright’s fourth fair use factor. Deemed by the Supreme Court “undoubtedly the single most important element of [copyright] fair use,”¹⁷⁶ copyright’s fourth fair use factor asks a court to consider “the effect of the use upon the potential

¹⁶⁹ Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1107 (1990).

¹⁷⁰ *See id.* at 1109.

¹⁷¹ *See* Dall T.E. Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781, 813 (1988).

¹⁷² *Comedy III*, 25 Cal. 4th at 405 (citations omitted).

¹⁷³ *See* Dall T.E. Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781, 814 (1988).

¹⁷⁴ *Id.*

¹⁷⁵ *See supra* Section II-A-4. The test was not nearly specific enough on the nature of a “transformative” definition.

¹⁷⁶ *Harper & Row*, 471 U.S. at 566.

market for or value of the copyrighted work.”¹⁷⁷ The Second Circuit reasoned that this factor can create a balance between “the benefit the public will derive if the [copyright] use is permitted and the personal gain the copyright owner will receive if the use is denied.”¹⁷⁸ A similar balance is currently needed in the right of publicity.

While alluding to certain economic considerations, the court in *Winter* rejected an explicit application of copyright’s fourth fair use factor by labeling the factor “irrelevant” to the right of publicity.¹⁷⁹ According to the court,

[i]f it is determined that a work is worthy of First Amendment protection because added creative elements significantly transform the celebrity depiction, then independent inquiry into whether or not that work is cutting into the market for the celebrity’s images appears to be irrelevant . . . even if the work’s marketability and economic value derive primarily from the fame of the celebrity depicted, the work may still be transformative and entitled to First Amendment protection. However, if the marketability and economic value of the challenged work do *not* derive primarily from the celebrity’s fame, “there would generally be no actionable right of publicity. When the value of the work comes principally from some source other than the fame of the celebrity—from the creativity, skill, and reputation of the artist—it may be presumed that sufficient transformative elements are present to warrant First Amendment protection.”¹⁸⁰

The fourth factor is not applicable, according to the court, because it might somehow conflict with the court’s transformative test.¹⁸¹

While ascertaining the harm to the market in a right of publicity context may pose some difficulties, such an inquiry should not be eliminated. In copyright fair use, courts regularly attempt to determine the market effect of derivative works.¹⁸² A right of publicity determination raises similar questions to those raised by copyright derivative works—i.e., whether the related, yet not identical, work harms the original—and the answers can be ascertained in the same manner.¹⁸³

¹⁷⁷ 17 U.S.C. § 107(4) (1994).

¹⁷⁸ *Wright v. Warner Books, Inc.*, 953 F.2d 731, 739 (2d Cir. 1991) (citations and internal quotation marks omitted).

¹⁷⁹ *Winter*, 30 Cal. 4th at 890.

¹⁸⁰ *Id.* (citation omitted).

¹⁸¹ *Id.*

¹⁸² See *Campbell*, 510 U.S. at 593 (determining whether a rap song was a derivative work harming the potential market of a Roy Orbison song); see also *Roy Export Co. v. CBS*, 503 F. Supp. 1137, 1146 (S.D.N.Y. 1980) (“The value of the right to use the copyrighted work to make a derivative work, which the copyright owner may sell or himself exercise, would certainly seem to be diminished by the ability of another to use the copyrighted work in order to compete at will with the derivative work.”).

¹⁸³ *Id.*

B. *The Proposed Test*

Within a right of publicity fair use test, it would be useful to employ the economic factor through a two-pronged analysis, and then balance it against the transformative factor. In the first half of the economic inquiry, the court will look at the potential market of the intended product to determine whether there has been significant displacement. Here, the court should ask whether transformative elements dominate the work to the extent that its economic value is derived from artistic expression, rather than from celebrity.¹⁸⁴ For example, if an artist utilizes a celebrity's image as a subsidiary element within a painting in order to further his or her overarching expressive theme, a court may find that the work does not threaten the type of celebrity market protected by the right of publicity.¹⁸⁵ Economic considerations go beyond mere damages, and "pose [] the issue of whether unrestricted and widespread conduct of the sort engaged in by the defendant . . . would result in a substantially adverse impact on the potential market for, or value of, the plaintiff's present work."¹⁸⁶ The potential market in publicity will presumably look at a realistic monetary impact on the celebrity.¹⁸⁷

Second, per the Second Circuit's *Titan Sports* decision, a court will look to whether the use at issue serves a public interest or newsworthy purpose.¹⁸⁸ In considering a video or photographic reproduction, such as the clip at issue in *Lane*, an economic inquiry may aid in drawing the line between permitted uses and undue commercial exploitation. For example, if the use of a likeness is necessary to develop the plot of a motion picture about a person, it might pass both the transformative and economic prongs of the test if it involves sufficient expression and newsworthy commentary. If an image is marketed for commercial ex-

¹⁸⁴ See *Meeropol v. Nizer*, 560 F.2d 1061, 1070 (2d Cir. 1977) (citations omitted).

¹⁸⁵ See *Comedy III*, 25 Cal. 4th at 405 (admitting that artistic works with significant expressive elements "are not, from the celebrity fan's viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect"); see also *ETW Corp. v. Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829, 835 (2000) (holding that a painting depicting Tiger Woods does not violate Woods' right of publicity because Woods' image is not the primary point of the painting, but rather it is being used to portray a social message about American life. This could therefore be a work where expressive elements in the painting dominate to a point that its sale does not substantially interfere with Woods' memorabilia market.).

¹⁸⁶ See *Campbell*, 510 U.S. at 593 n.23 ("['P]otential market' means either an immediate or a delayed market, and includes harm to derivative works.").

¹⁸⁷ Once again, monetary impact can be determined on a case-by-case basis in the same way that it is accomplished in copyright cases involving derivative works.

¹⁸⁸ *Titan*, 870 F.2d at 88-9 (quoting *Davis v. High Soc. Magazine, Inc.*, 90 A.D.2d 374, 379 (NYSC 1982)).

ploitation, however, with little creative or newsworthy justification, then it would not pass muster. Here, the court should consider “whether [the products in question] are included primarily for their ‘public interest aspect’ or whether the public interest aspect ‘is merely incidental to [the distributors’] commercial purpose.’”¹⁸⁹ Under this test, the use of Lane’s image obviously would not qualify for First Amendment protection.

Finally, the court should weigh the economic factor against the California Supreme Court’s transformative factor. In a scenario similar to the one in *Comedy III* or *Winter*, a court would look at 1) whether the expression is sufficiently transformative,¹⁹⁰ and 2) whether the market for such goods displaces the celebrity market or, in the alternative, whether the use is sufficiently newsworthy. Since an artistic portrait may be a close-call on the transformative side of the analysis, a court could look to the economic factor as the determinative consideration. If a court finds that the artist’s work significantly displaces the celebrity’s market, then it would not pass this test. In a case like *Lane*, where the defendant did not add any creative elements to the plaintiff’s image or market it for any newsworthy purpose, a court might decide that there are no transformative elements or newsworthy purposes, and refuse to allow the use of the plaintiff’s image in a marketing campaign.

C. *Possible Objections to the Suggested Solution*

Of course, this proposed two-part publicity fair use test would not be immune from criticism. First, the test does not abolish subjectivity or obviate the judicial determination of artistic merit. A main problem with the *Comedy III* test was the highly subjective nature of a “transformative” guideline.¹⁹¹ It remains unclear how “transformative” a work must be to satisfy the test, and courts have a great deal of leeway in deciding this. A modified two-factor publicity test would also contain a subjective element. Including an economic analysis, however, somewhat mitigates the importance of the artistic determination, as compared with a purely transformative test.

It is virtually impossible to avoid subjectivity with *any* right of publicity test. The related products test attempted to avoid ambiguity; however, it merely shifted the subjective determination from the art-

¹⁸⁹ *Id.*

¹⁹⁰ The transformative determination: “[W]hen an artist’s skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist’s right of free expression is outweighed by the right of publicity.” *Comedy III*, 25 Cal. 4th at 408.

¹⁹¹ *Id.*

work to the material from which the art is being conveyed.¹⁹² Subjectivity is simply unavoidable in balancing an intellectual property right with First Amendment concerns. In this regard, the copyright fair use test has been lauded as it “permits [and requires] courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.”¹⁹³ According to Judge Leval, “although no simple definition of fair use can be fashioned, and inevitably, disagreement will arise over individual applications . . . fair use [is] integral to copyright’s objectives.”¹⁹⁴ The policy goals underlying copyright are virtually identical to those underlying the right of publicity, namely “stimulating productive thought and public instruction without excessively diminishing the incentives for creativity.”¹⁹⁵ A certain amount of subjectivity is inevitable when balancing the issues in such an area, where creativity is involved, and where case-by-case analysis is required.

Second, the two-part publicity fair use test may be criticized for circular reasoning. As the court in *Comedy III* describes, “it could be argued that if a defendant has capitalized in any way on a celebrity’s image, he or she has found a potential market and therefore could be liable for such work.”¹⁹⁶ The court, however, fails to note the difference between a vague potential market and a detailed market harm analysis. Leval addresses this difference:

By definition every fair use involves some loss of royalty revenue because the secondary user has not paid royalties. Therefore, if an insubstantial loss of revenue turned the fourth factor in favor of the copyright holder, this factor would never weigh in favor of the secondary user The market impairment should not turn on the fourth factor unless it is reasonably substantial. When the injury to the copyright holder’s potential market would substantially impair the incentive to create works for publication, the objectives of the copyright law require that this factor weigh heavily against the secondary user.¹⁹⁷

Although it may be argued that every use of a celebrity’s name or likeness has an effect on the potential market for that celebrity, courts are capable of distinguishing between insignificant and substantial economic impacts. As in copyright, a market harm analysis here aims to

¹⁹² See *supra* Section II-B-1.

¹⁹³ *Stewart v. Abend*, 495 U.S. 207, 236 (1990) (quoting *Iowa State University Research Foundation, Inc. v. American Broadcasting Cos.*, 621 F.2d 57, 60 (1980)).

¹⁹⁴ Leval, *supra* note 169, at 1110.

¹⁹⁵ *Id.*

¹⁹⁶ *Comedy III*, 25 Cal. 4th at 405 n.10.

¹⁹⁷ *Id.* at 1124-5.

respect the incentives for expressive commentary and celebrity investment.

A two-factor fair use test would therefore provide a compromise between the differing standards of *Titan Sports* and *Comedy III* or *Winter*. It would provide a second, economic inquiry in close-call scenarios, such as that of *Comedy III's* artistic reproduction, and would also provide a safeguard against commercial exploitation, such as that in *Lane*. Moreover, it would clarify the *Comedy III* standard by turning its optional economic inquiry into an explicitly defined factor. Finally, the test would provide a certain degree of protection for non-famous persons, while preventing celebrities from abusing the right of publicity to censor unflattering commentary. As in copyright, the publicity fair use test would provide a uniform basis from which to judge expressive works on a case-by-case basis.

V. CONCLUSION

The right of publicity has rapidly evolved since the Supreme Court's 1977 review of it in *Zacchini*.¹⁹⁸ Today, the right is recognized in some capacity within forty-one states, and it has been given a significant amount of treatment by both state and federal courts.¹⁹⁹ Conflicting lines of reasoning in these cases has caused confusion over the extent of the protection afforded by the right of publicity. This problem has been magnified by the national distribution of memorabilia and celebrity forum-shopping. Internet exposure has further exacerbated the problem by making it nearly impossible to limit distribution to jurisdictions that recognize the right.

Perhaps the most difficult publicity decisions are those that involve literal reproductions. In these cases, the commercial use of a picture, video, or reproduction takes place without permission of the person depicted. While the First Amendment allows dissemination of newsworthy images, it is sometimes difficult to draw the line between newsworthiness and commercial exploitation. To solve this problem, courts have employed drastically varied lines of reasoning in attempting to strike a balance between the right of publicity and the First Amendment, as illustrated by cases such as *Lane*, *Comedy III*, and *Titan Sports*.

With these cases in mind, this article suggests a modified fair use test to resolve the issue. The proposed test will clarify the *Comedy III* and *Winter* tests by turning the optional economic inquiry into an ex-

¹⁹⁸ 433 U.S. 562 (1977).

¹⁹⁹ See Ezer, *supra* note 26 (17 states by statute, 24 others by common law).

publicly defined factor for consideration. Furthermore, to prevent the type of economic exploitation that occurred in *Lane*, the economic inquiry gives protection to non-famous persons by considering the newsworthy nature of the use. With rapidly developing technology, entertainment media is able to record and photograph images at an unprecedented rate. An improved right of publicity test can help determine how these many images should be properly utilized.

