

Shake-Down: How Professional and College Athletes ‘ Right of Publicity are becoming an Endangered Species

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Abstract. This article compares the right of publicity of celebrities with that of professional and college athletes. Sec. I of this article introduces and defines the concept of right of publicity. Sec. 2 begins with a brief background on the history of the right of publicity and its intersection with the First Amendment. Sec. 3 traces the evolution of the right of publicity as it pertains to professional athletes, collegiate athletes and non-athlete celebrities. Sec. 4 illustrates what the present state of the right of publicity jurisprudence is regarding professional athletes, collegiate athletes and non-athlete celebrities. It proceeds to frame the legal issue of whether there are any discrepancies in the application of the right of publicity as to professional and collegiate athletes compared with that of non-athlete celebrities. To analyze this issue, the paper focuses on an in-depth analysis of the evolution of the right of publicity but more importantly the present state of the right of publicity as applied to the aforementioned three discussed classes. Finally, Sec. 5 concludes that it appears that non-athlete celebrities do enjoy a favorable interpretation of this tort claim compared to professional athletes with collegiate athletes faring the worst.

1. Introduction

Americans have a long standing love affair with sports and celebrities and their ardor shows no sign of cooling off! This is illustrated by the astronomical figure of \$5,826,336,663,000, which represents the amount US consumers spent in 2010 on items such as food, housing, clothing and transportation, all of which use in-one-shape-or-form celebrity endorsers to promote their products.¹ Since the late 1930s, when Red Rock Cola hired baseball great Babe Ruth to endorse its soft drink brand, companies around the world have used athletes and celebrities to promote their products.² Companies utilize celebrity endorsements to communicate their brands to particular segments of customers. In our culture, fame is used effectively to persuade, inspire, and inform the public in almost every aspect of our lives. Thus, for celebrities and athletes, fame has an inherent economic value, which they endeavor to enhance and protect through the relatively recent legal doctrine of the right of publicity. Broadly defined, the right of publicity is the “inherent right of every human being to control the commercial use of his or her identity.”³ Celebrities invoke this right to prevent the unauthorized commercial use of their names, likenesses, or other aspects of their identities in order to protect and control their valuable personas.⁴

This paper begins with a brief background on the history of the right of publicity and its intersection with the First Amendment. It then traces the evolution of this right of publicity as it pertains to professional athletes, collegiate athletes and non-athlete celebrities. Furthermore, it illustrates what the present state of the right of publicity jurisprudence is regarding professional athletes, collegiate athletes and non-athlete celebrities. It proceeds to frame the legal issue of whether there are any discrepancies in the application of the right of publicity as to professional and collegiate athletes compared with that of non-athlete celebrities. To analyze this issue, the paper focuses on an in-depth analysis of the evolution of

¹ United States Department of Labor, Bureau of Labor Statistics, <http://www.bls.gov/news.release/cesan.nr0.htm> (last visited March 13, 2012).

² Red Rock Cola, Coke Girl, <http://www.angelfire.com/tn/traderz/redrock.html> (last visited March 14, 2012).

³ J. Thomas McCarthy, *The Rights of Publicity and Privacy* § 1:3 (2d ed. 2006).

⁴ See [Restatement \(Third\) of Unfair Competition § 46 \(1995\)](#).

the right of publicity but more importantly the present state of the right of publicity as applied to the aforementioned three mentioned classes. In conclusion, this paper confirms it appears that non-athlete celebrities do enjoy a favorable interpretation of this tort claim compared to professional athletes with collegiate athletes faring the worst.

2. The Right of Publicity – Historical Origins

The right of publicity is a creation of state and common law, as no federal right of publicity exists,⁵ and thus, protections vary from state to state in the thirty states that currently recognize this right.⁶ The right of publicity was born out of the right of privacy.⁷ However, the fact that it was originally considered part of the right of privacy has confused many courts over the years.

In 1890, Samuel D. Warren and Louis Brandeis wrote an article in the *Harvard Law Review* titled "The Right to Privacy," which first addressed the right to privacy and the legal arguments for legal recognition of this right by the courts.⁸ Warren and Brandeis suggested that "the common law creates a 'common zone' in each person's life that is immune from the prying of neighbors, the press and the public."⁹ The article further suggested that the law should protect people's feelings from public intrusion, and not just protect individuals from physical harm.¹⁰

"Cases early in the twentieth century concerned a variation on the theme of the 1890 Warren and Brandeis article: the unpermitted use of a person's name or picture in advertising."¹¹ A split of authority soon developed regarding the applicability of the right of privacy in such cases.¹² The cases that did grant restitution for the unauthorized use of a person's name or picture in advertising did so based on traditional tort law concepts such as personal injury to dignity or state of mind.¹³ In such cases, damages were usually measured by the degree of mental distress.¹⁴ Recovery in these cases was based on the concept that when a person's photograph was used for purposes of selling a product against his consent, it affronts his humanity, and damages his dignity.¹⁵ Unfortunately, granting relief based on these grounds, the courts were still focusing on Warren's and Brandeis' concept of the "right to be left alone."¹⁶ Consequently, whenever high profile individuals sought recovery for unauthorized use of their pictures in advertising, courts were less likely to award damages. The courts' rationale for refusing to apply the right of privacy to celebrity figures in these situations was the notion that celebrities should not be able to recover damages for being thrust into the limelight when they have become celebrities precisely because they have sought such attention and profited from it.¹⁷

In contrast to the right of privacy, the right to publicity focuses on the right of an individual to reap the economic reward of his or her endeavors and has little to do with protection of feelings or reputation.¹⁸ It is recognized that public figures exploit a commercial market and, as such, are more

⁵ *C.B.C. Distribution & Mktg., Inc. v. MLB Advanced Media, L.P.*, 443 F. Supp. 2d 1077, 1084 (E.D. Mo. 2006).

⁶ Entertainment Law Chicago, State Right to Publicity Laws, <http://www.entertainmentlawchicago.com/bizlaw/State%20Right%20to%20Publicity%20Laws.pdf> (last visited March 15, 2012).

⁷ McCarthy, *supra* note 3, at 1:7.

⁸ Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 Harv. L. Rev. 193 (1890).

⁹ Martin P. Hoffman, *Trademarks, Copyrights, and Unfair competition for the General Practitioner and the Corporate Counsel* *The Rights of Publicity and Privacy*, SC68 A.L.I.- A.B.A. 217, 219 (1998).

¹⁰ Warren & Brandeis, *supra* note 8, at 197, 219.

¹¹ 4. J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION* § 28:1, at 28-3 (1996).

¹² See *id.*

¹³ See *id.*

¹⁴ See *id.*

¹⁵ See *id.* § 28:3, at 28-4 to 28-5.

¹⁶ *Id.* § 28.3, at 28-5.

¹⁷ *Id.*, § 28:4, at 28-5 ("[W]hen a plaintiff whose identity was already well known sued under [a right of privacy theory], judges were unable to see how there could be 'indignity' or 'mental distress' to a plaintiff whose identity was already in widespread circulation in the news media.")

¹⁸ See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 573 (1977) (noting that the State's interest in permitting a right of publicity is in protecting the proprietary interest of the individual).

concerned with protecting the pecuniary worth of their likenesses.¹⁹ Their likeness is treated as a property interest and in this regard, the right to publicity is analogous to the goals of copyright and patent laws.²⁰

Initially, courts were reluctant to treat a right to likeness as a property right.²¹ For example, in *Vassar College v. Loose-Wiles Biscuit Co.*, the District Court for the Western District of Missouri refused to advocate an absolute property interest in an institution which depended upon and invited wide-spread publicity and further stated, “Where a person is a public character, the right of privacy disappears.”²² Any injurious effects resulting from the unwanted publicity were purely speculative and not protected by the court.²³

However, soon after the decision in *Vassar*, courts began to assume a more active role in protecting the property interest in a name or likeness. In *Madison Square Garden Corp. v. Universal Pictures Co.*, the New York Supreme Court, Appellate Division, held that because the plaintiff had built up considerable good will in its name, misappropriation of that name constituted an infringement of plaintiff’s property rights.²⁴ The reasoning of the court in *Madison Square Garden Corp.*, although predicated on grounds of unfair competition, became the foundation for future misappropriation cases.²⁵

2.1 The O’Brien Case: 1941

In 1941, the Fifth Circuit’s key decision in *O’Brien v. Pabst Sales, Co.* set the stage for the creation of the right of publicity.²⁶ David O’Brien was a famous football player who in the 1930s had earned All-American honors while playing at Texas Christian University and then continued his career as a professional for the Philadelphia Eagles.²⁷ O’Brien sued Pabst Sales Co. for using his photo on Pabst’s 1939 beer advertising calendar.²⁸ O’Brien was upset because he was active in a group, Allied Youth of America, urging teens not to drink alcohol and he had refused similar opportunities to endorse beer in the past.²⁹ Interpreting Texas law, the Fifth Circuit dismissed O’Brien’s case, reasoning that he was not a private person and could not be harmed by more publicity.³⁰ The court adopted the view that if O’Brien did not - and could not - object to the publicity he received in the sports pages, he should not be allowed to object to the publicity he received due to advertising for Pabst beer.³¹ This court’s ruling caught O’Brien in quite a quandary: his refusal to voluntarily endorse Pabst beer was a waiver of his right to recover in court the reasonable value of his identity used to endorse the sale of Pabst beer.³² The court did not view O’Brien’s claim as an assertion of a right to stop the unpermitted use of his identity to sell a brand of beer, despite the fact he was diametrically opposed to beer.³³ However, Judge Holme’s clairvoyant dissenting opinion was that the time was ripe to recognize a legal claim for the uncompensated use of the identity of a professional athlete to help sell a product.³⁴

¹⁹ See *Rosemont*, 294 N.Y.S.2d 122 (Sup. Ct. 1968), *aff’d*, 301 N.Y.S.2d 948 (App. Div. 1969) (noting that the right to publicity recognizes the pecuniary value of a public figure’s name and likeness and is tailored to protect the figure’s financial benefit).

²⁰ *Zacchini*, *supra* note 18, at 577. The Court stated that like copyright and patent laws, the right to publicity was “intended definitely to grant valuable, enforceable rights in order to afford greater encouragement to the production of works or benefit to the public.”

²¹ Warren & Brandeis, *supra* note 8, at 207.

²² 197 F. 982, 985 (W.D. Mo. 1912).

²³ *Id.* at 994.

²⁴ 255 A.D. 459, 466 (App. Div. 1938).

²⁵ See Harold R. Gordon, *Right of Property in Name, Likeness, Personality and History*, 55 NW. U. L. REV. 553, 569 (1960).

²⁶ 124 F.2d 167 (5th Cir. 1941).

²⁷ *Id.* at 168.

²⁸ *Id.*

²⁹ *Id.* at 168-69.

³⁰ *Id.* at 169-70.

³¹ *Id.*

³² *Id.*

³³ *Id.* at 170.

³⁴ *Id.*

2.2 The Haelan Case: 1953

The *O'Brien* case set the stage for the famous 1953 Second Circuit's decision in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, widely lauded as the case that coined the term "right of publicity."³⁵ In *Haelan*, the parties were rival chewing gum makers who were clamoring to obtain the rights from major league baseball players to use their pictures on trading cards.³⁶ The plaintiff alleged that the defendant had induced players who had already signed exclusive deals with the plaintiff to sign a license with the defendant.³⁷ In addition, in some cases, the defendant used the ball-players' pictures without first seeking their consent.³⁸ The defendant attempted to rebut the plaintiff's allegations by claiming that the plaintiff had no right to assert, for all that the players' contracts consisted of were mere releases of the right to sue for an invasion of privacy.³⁹ The defendant argued that "a man has no legal interest in the publication of his picture other than his right of privacy, i.e., a personal and non-assignable right not to have his feelings hurt by such a publication."⁴⁰ As the mere holder of a non-assignable waiver, the plaintiff could not sue its competitor, the defendant.⁴¹

In rejecting this argument, Judge Frank first created a new kind of property right under a new label.⁴² Judge Frank recognized for the first time a property right in identity that can be legally separated from the person in a way that privacy rights cannot.⁴³ He stated that:

We think that in addition to and independent of that right of privacy (which in New York derives from statute), 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, and that such a grant may validly be made "in gross," i.e., without an accompanying grant of a business or of anything else This right might be called a "right of publicity." For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, buses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.⁴⁴

Although the language in *Haelan* seemed to firmly establish the right of publicity, there still remained a conflict over what the right of publicity actually protected.⁴⁵ The historical link to the right to privacy made some courts hesitant to grant relief to "well-known personalities whose celebrity precluded the allegations of injury" to one's personal solitude, which had been traditionally associated with the right to privacy.⁴⁶ As this paper will show, it appears that the courts still struggle with applying this relatively new concept of the right of publicity uniformly.

2.3 What is the Scope of Protection and how is it Enforced

The right of publicity is a property right distinct from trademark, copyright and privacy law.⁴⁷ Right of publicity protection may cover the use of any personal element that allows the public to identify the

³⁵ 202 F.2d 866 (2d Cir. 1953).

³⁶ *Id.* at 867.

³⁷ *Id.*

³⁸ *Id.* at 868.

³⁹ *Id.* at 867.

⁴⁰ *Id.* at 868.

⁴¹ *Id.* at 867.

⁴² *Id.* at 868.

⁴³ *Id.*

⁴⁴ *Id.*

⁴⁵ Restatement (Third), *supra* note 4, at § 46 cmt b.

⁴⁶ *Id.*

⁴⁷ *Zacchini*, *supra* note 18, at 562 (recognizing that the right of publicity is an "entirely different tort" than traditional invasion of privacy) and *Eagle's Eye, Inc. v. Ambler Fashion Shop, Inc.*, 627 F.Supp. 856 (E.D.Pa.1985) (recognizing that the right of publicity does not protect trademarks).

individual; and unique portions of a person's identity, such as nickname, voice or performance (under certain circumstances), can be infringed upon.⁴⁸ In addition to controlling one's identity, the essence of this tort is that celebrities, including professional athletes, have a legal right to receive compensation for the use of their identities; specifically, when another person profits from such use.⁴⁹

The degree to which the right of publicity provides protection varies from state to state.⁵⁰ As previously stated, thirty states currently recognize this tort via statute or common-law.⁵¹ Florida, for example, "prohibits the unauthorized publication or use for commercial or advertising purposes, of the name or likeness of any person" and the right continues for 40 years after death.⁵² Indiana protects against the "unauthorized commercial use of a personality's name, voice, signature, photograph, image, likeness, distinctive appearance, gestures or mannerisms."⁵³ The right continues for 100 years after death.⁵⁴ New Jersey has recognized a common law right of publicity since 1907 yet does not have a right of publicity statute.⁵⁵ New Jersey protects an individual's "name, photograph, image, likeness, performance characteristic, biographical data, vocal style and screen persona."⁵⁶

At common law, to establish a prima facie violation of the right of publicity, a plaintiff must show: (1) use of his identity; (2) appropriation of his name and likeness to the defendant's commercial advantage; (3) lack of his consent; and (4) resulting injury.⁵⁷ In addition, courts also have looked to the Restatement (Third) of Unfair Competition for guidance.⁵⁸

The Restatement defines a violation as an "appropriation of the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade."⁵⁹ Under the Restatement, the elements of a right of publicity violation are: (1) use of the plaintiff's identity; (2) without consent from the plaintiff; and (3) for the purposes of trade.⁶⁰ The Restatement also does not require intent to infringe another's right of publicity to create liability.⁶¹

Regardless of whether a jurisdiction follows the common law or Restatement's definition or incorporates either into its statutes, generally, a plaintiff alleging a right of publicity action must prove the infringer used his identity for an impermissible purpose such as for commercial advantage.⁶² Thus, to satisfy the identity requirement, a plaintiff must show the infringing party used expressions of his identity that are understood by the audience as referring to the plaintiff.⁶³ Next, a plaintiff needs to show the appropriator used the identity for a commercial purpose, which subsequently conferred a commercial benefit on him. The resulting damages must have a commercial aspect; because the infringer's unauthorized use of the athlete's identity is unjust enrichment.⁶⁴

⁴⁸ See *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir.1988) (recognizing a claim for the appropriation of a voice for purposes of trade).

⁴⁹ *Haelan*, supra note 35, at 868 (recognizing that actors and ball-players would be harmed if not able to receive money for the use of their identities).

⁵⁰ Entertainment Law Chicago, supra note 6 (last visited March 15, 2012).

⁵¹ *Id.* (last visited March 15, 2012).

⁵² *Id.* (last visited March 15, 2012).

⁵³ *Id.* (last visited March 15, 2012).

⁵⁴ *Id.* (last visited March 15, 2012).

⁵⁵ Matthew Savare, Right of Publicity Laws: New Jersey, <http://www.lowenstein.com/files/Publication/1d3a8cf1-fbd6-41db-82e6-272705115c3f/Presentation/PublicationAttachment/6252033a-139a-494b-8af3-2a53e1463960/Right%20of%20Publicity%20Laws%20New%20Jersey.pdf>, (last visited March 15, 2012)

⁵⁶ *Id.* (last visited March 15, 2012).

⁵⁷ *Cartoons v. Major League Baseball Players Ass'n.*, 95 F.3d 959, 968 (10th Cir. 1996)

⁵⁸ Richard T. Karcher, *The Use of Players' Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 Penn St. L. Rev. 557, 558 (2007).

⁵⁹ Restatement (Third), supra note 4, at §§ 46-47.

⁶⁰ *Id.* at § 46 cmt. d-f.

⁶¹ *Id.* at § 46 cmt. e.

⁶² *Cartoons*, supra note 57, at 968.

⁶³ See *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831,835 (6th Cir. 1983) (following common law principles held Johnny Carson's identity may be exploited for purposes of a right of publicity action even if his name or picture is not used).

⁶⁴ *Cartoons*, supra note 57, at 968.

2.4 Defense to the Right of Publicity

There has always been a degree of tension between the right of publicity and the freedom of expression provided by our Founders in the First Amendment. As previously discussed, the right of publicity secures the value of a person's fame, prevents unjust enrichment, and protects the public from false suggestions of endorsements.⁶⁵ On the other hand, the First Amendment protects a wide range of speech, ranging from written and spoken word to artistic expression.⁶⁶ In other words, it protects communicative speech but not pure commercial speech.⁶⁷ Courts deal with this tension by balancing a person's right to earn a living due to his fame against the possibility of chilling another's freedom of expression.⁶⁸ To aid in this balancing, courts use an array of tests such as the "transformative" test to determine whether an appropriation of likeness qualifies for First Amendment protection.⁶⁹ The transformative test looks to whether the celebrity's likeness is one of the "raw materials" from which an original work is created.⁷⁰ In order to qualify for First Amendment protection, a defendant must add something new, altering the "likeness" with new expression, meaning, or message.⁷¹

Because of this balancing test, it is important for a person asserting his right of publicity to establish economic harm when facing a First Amendment challenge. Where a defendant's use of a person's likeness threatens that person's ability to make a living, courts are less likely to find permissible First Amendment use.⁷²

3. The Right of Publicity – Evolution of

3.1 Application in Cases involving Professional Athletes

3.1.1 The O'Brien Case: 1941

The *O'Brien* case discussed at length in Section II A, even though not addressing the modern right of publicity per se, is still instructive as a case that interprets the genesis of the right of publicity, the right of privacy.⁷³ The case is a good example of a court's reluctance to apply the protections embodied in the right of privacy to professional athletes. As noted above, the court did not grant O'Brien's claim for invasion of privacy due to their rationale that "the publicity he got was only that which he had been constantly seeking and receiving" throughout his career regardless of whether it was currently desired.⁷⁴

3.1.2 The Ali Case: 1978

Ali v. Playgirl, Inc. involved an action brought by former heavyweight champion, Muhammad Ali, for injunctive relief and damages for the unauthorized printing and distribution of an objectionable portrait of Ali in Playgirl Magazine.⁷⁵ The portrait distributed in Playgirl's February 1978 issue, consisted of a nude black man seated in the corner of a boxing ring, with both hands taped and resting on the ropes.⁷⁶ The picture was captioned "Mystery Man," and the identification of the individual in the portrait was further alluded to by an additional reference to "the Greatest."⁷⁷ Ali claimed that it bore an unmistakable resemblance to him, and that the picture violated his right of publicity. The court examined the facts to

⁶⁵ See *Midler*, *supra* note 48, at 460.

⁶⁶ *Gionfrido v. Major League Baseball*, 94 Cal.App.4th 400, 411-12 (2001).

⁶⁷ *Cardtoons*, *supra* note 57, at 970 (noting that commercial speech is that which merely advertises a product or service for business purposes and thus is related solely to the economic interests of the speaker and its audience.)

⁶⁸ *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001).

⁶⁹ *Id.* at 799.

⁷⁰ *Id.* at 809.

⁷¹ *Id.* at 808.

⁷² See *Zacchini*, *supra* note 18, at 575-76.

⁷³ See *O'Brien*, *supra* note 26, at 167.

⁷⁴ *Id.* at 170.

⁷⁵ 447 F. Supp. 723, 725 (S.D.N.Y. 1978).

⁷⁶ *Id.* at 726.

⁷⁷ *Id.* at 727.

determine if a preliminary injunction was appropriate. When examining the success of Ali's claim on its merits, the Court addressed one defense given by the Defendants. The Defendants argued that the statutory right of privacy does not extend to protect Ali, as he is an "athlete...who chooses to bring himself to public notice, who chooses, indeed, as clearly as the plaintiff here does to rather stridently seek out publicity."⁷⁸ The Court rejected this argument and stated that "such a contention confuses the fact that projection into the public arena may make for newsworthiness of one's activities, and all the hazards of publicity thus entailed, with the quite different and independent right to have one's personality, even if newsworthy, free from commercial exploitation at the hands of another."⁷⁹ In light of the foregoing, the court held there was a likelihood that Ali would prevail on both his statutory and common law right of publicity claims.⁸⁰

The court also considered in detail the issue of "irreparable injury" with regard to the use of a depiction of the famed boxer without his consent:

As has been noted, in the course of his public career plaintiff has established a commercially valuable proprietary interest in his likeness and reputation, analogous to the good will accumulated in the name of a successful business entity. To the extent that defendants are unlawfully appropriating this valuable commodity for themselves, proof of damages or unjust enrichment may be extremely difficult.... [F]urthermore, defendants appear not only to be usurping plaintiff's valuable right of publicity for themselves but may well be inflicting damage upon this marketable reputation.... [T]he "likeness" of Ali which has been published is a full frontal nude drawing, not merely a sketch or photograph of him as he appears in public. Damages from such evident abuse of plaintiff's property right in his public reputation are plainly difficult to measure by monetary standards.⁸¹

The court concluded that the difficulty of establishing monetary damages left Ali without an adequate remedy at law and sufficiently established the requisite irreparable injury. Therefore, the court granted a preliminary injunction.⁸²

Ali clearly recognized that an athlete has a right to control the distribution of his likeness. But one cannot help but wonder how greatly the court was swayed in their ruling due to Ali's reputation as a sport icon coupled with the rather seedy misappropriation of Ali's likeness by Playgirl.

3.1.3 The Cartoons Case: 1996

In *Cartoons L.C. v. Major League Baseball Players Ass'n*, in response to Major League Baseball Players Association's ("MLBPA") cease and desist letter given to Cartoons, Cartoons brought an action against MLBPA to obtain declaratory judgment that parody trading cards did not infringe on players' publicity rights and that they could distribute the cards without the consent of the MLBPA.⁸³ Cartoons was formed to produce parody trading cards featuring caricatures of major league baseball players.⁸⁴ Cartoons caricatures were designed by a political cartoonist, a sports artist, and a sports author and journalist, who designed a set of 130 cards.⁸⁵ The cards mocked various aspects of baseball and its players, including the players' names, on-field behavior, and the physical characteristics of the players.⁸⁶

In deciding whether Cartoons should be granted the relief it sought, the court stated that three factors must be met: (1) whether the cards infringed upon MLBPA's property rights as established by either the Lanham Act or Oklahoma's right of publicity statute, (2) whether the cards are protected by the First Amendment, and (3) a balancing test to determine the relative importance of the rights at stake if both parties have been determined to have cognizable rights.⁸⁷ The court first analyzed whether the cards infringed upon MLBPA's property rights under the Lanham Act. It held that the cards did not create a

⁷⁸ *Id.*

⁷⁹ *Id.*

⁸⁰ *Id.* at 728.

⁸¹ *Id.* at 729.

⁸² *Id.* at 729-30.

⁸³ *Cartoons*, *supra* note 57, at 962.

⁸⁴ *Id.* at 962.

⁸⁵ *Id.*

⁸⁶ *Id.* at 963.

⁸⁷ *Id.* at 966.

likelihood of confusion thus there was no infringement of MLBPA's property rights under the Lanham Act.⁸⁸ The court then analyzed whether all of the elements of the Oklahoma right of publicity statute in question had been met.⁸⁹ It held that all three of the elements of the Oklahoma statute had been met and that the only possibility of relief for Cardtoons was a First Amendment defense.⁹⁰ Therefore, the court moved on to the second step in its analysis on whether to grant Cardtoons relief.

The court found that parody trading cards receive full protection under the First Amendment.⁹¹ The court referred to baseball cards as providing "social commentary on public figures, major league baseball players, who are involved in a significant commercial enterprise, major league baseball."⁹² It further held that the cards were no less protected based on the fact that they were humorous rather than serious commentary.⁹³ To the contrary, the court noted, "speech that entertains, like speech that informs, is protected by the First Amendment because '[t]he line between the informing and the entertaining is too elusive for the protection of that basic right.'"⁹⁴ The court also found that Cardtoons' trading cards did not fall within the commercial speech category because "they do not merely advertise another unrelated product."⁹⁵

Since the court found that the MLBPA's right of publicity had been violated under the Oklahoma statute, and that Cardtoons had a countervailing First Amendment right to publish the cards, it proceeded to the third step of its analysis, balancing the free speech rights with that of the property rights. The court found that Cardtoons' parody cards required the use of player's identities.

Cardtoons' expression requires use of player identities because, in addition to parodying the institution of baseball, the cards also lampoon individual players. Further, Cardtoons' use of the trading card format is an essential component of the parody because baseball cards have traditionally been used to celebrate baseball players and their accomplishments.⁹⁶

The court concluded that the First Amendment right of Cardtoons trumped the right of publicity of the MLBPA and granted Cardtoons a declaratory judgment.⁹⁷

This decision dealt a significant blow to the publicity rights of professional athletes with respect to trading cards. Unlike the court in *Haelan*, the court here felt that a baseball player's right to protect his image was subservient to that of the First Amendment's right of expression. What used to be a booming industry with players receiving sizable fees, appears to have now dwindled to non-existence as long as some alteration or humor is incorporated into the trading card.

3.1.4 The C.B.C. Distribution Case: 2007

The question of whether fantasy sports providers needed a license to use professional athletes' information was addressed in *C.B.C. Distribution & Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*⁹⁸ C.B.C. Distribution and Marketing, Inc. ("CBC") was in the business of distributing and selling fantasy sports products such as online fantasy baseball.⁹⁹ CBC licensed its use of the names and information of major league baseball ("MLB") players from the Players Association from 1995 to 2004.¹⁰⁰ In 2005, the Players Association granted exclusivity to Major League Baseball Advanced Media, L.P. ("Advanced Media") to utilize baseball players' names and information for "all interactive media."¹⁰¹

⁸⁸ *Id.* at 967.

⁸⁹ *Id.* at 968.

⁹⁰ *Id.*

⁹¹ *Id.* at 969.

⁹² *Id.*

⁹³ *Id.*

⁹⁴ *Id.*

⁹⁵ *Id.* at 970.

⁹⁶ *Id.* at 971.

⁹⁷ *Id.* at 976.

⁹⁸ 505 F.3d 818 (8th Cir. 2007).

⁹⁹ *Id.* at 820.

¹⁰⁰ *Id.* at 821.

¹⁰¹ *Id.*

CBC refused to pay licensing fees to Advanced Media and subsequently sought a declaratory judgment to prevent Advanced Media from demanding any fee.¹⁰²

CBC argued that its use of MLB players' names and statistics did not violate their right of publicity.¹⁰³ In addition, CBC alleged that even if such use did violate the baseball players' right of publicity, CBC's appropriation was protected by the First Amendment.¹⁰⁴ In response, Advanced Media argued that CBC's use of players' statistics on its fantasy baseball website violated the baseball players' rights of publicity.¹⁰⁵

The Eighth Circuit, in affirming the district court's ruling, found in favor of CBC but for different reasons than the district court.¹⁰⁶ The court disagreed with the district court's holding that CBC did not violate the MLB player's right of publicity under Missouri state law.¹⁰⁷ Under Missouri law, there are three elements of a right of publicity claim: (1) whether CBC used the MLB players' names as a symbol of their identity; (2) whether CBC had Advanced Media's consent; and (3) whether CBC had the intent to obtain a commercial advantage.¹⁰⁸ The court determined that CBC's use of players' names, statistics, and likenesses satisfied the "symbol-of-identity" element.¹⁰⁹ Second, the court held that CBC definitely used the baseball players' identities to gain a commercial advantage.¹¹⁰ However, the Eighth Circuit agreed with the district court and held the First Amendment trumped MLB athletes' right of publicity because: (1) the information used by CBC was readily available in the public domain; (2) baseball being "the national pastime," the public had a strong interest in access to all baseball related information; and (3) the economic interests at stake weighed in favor of CBC.¹¹¹

Just like in *Zacchini*,¹¹² the court here discussed the economic interests and how it relates to the right of an individual to reap the rewards of his endeavors, which is the basis for the right of publicity.¹¹³ The court concluded that because professional baseball players are handsomely rewarded for their efforts and have the ability to earn additional income from endorsements and sponsorship deals, that the elimination of revenue from fantasy league licensing fees would have very little impact on the players' ability to enjoy the benefits of their toils.¹¹⁴

3.2 Application in Cases involving Collegiate Athletes

3.2.1 The Abdul-Jabbar Case: 1996

In *Abdul-Jabbar v. General Motors Corp.*, Kareem Abdul-Jabbar appealed the district court's summary judgment in favor of General Motors Corporation ("GMC") and its advertising agency, Leo Burnett Co., in his action alleging violations of the Lanham Act and California's statutory and common law right of publicity.¹¹⁵ The former L.A. Lakers superstar recognized for his signature jump shot known as the "skyhook," was named Ferdinand Lewis ("Lew") Alcindor at birth.¹¹⁶ He played basketball under that name throughout his college career and into the early years of his career in the National Basketball Association.¹¹⁷ While in college, he converted to Islam and began to be called "Kareem Abdul-Jabbar" by his friends.¹¹⁸ In 1971, he chose to record the new name officially under an Illinois name recordation statute and began to endorse products under this new name.¹¹⁹

¹⁰² *Id.*

¹⁰³ *Id.* at 820.

¹⁰⁴ *Id.* at 823.

¹⁰⁵ *Id.* at 820.

¹⁰⁶ *Id.* at 825.

¹⁰⁷ *Id.* at 823.

¹⁰⁸ *Id.* at 822.

¹⁰⁹ *Id.*

¹¹⁰ *Id.* at 822-23.

¹¹¹ *Id.* at 823-24.

¹¹² See *Zacchini*, *supra* note 18, at 573, 576.

¹¹³ 505 F.3d 818, 824.

¹¹⁴ *Id.*

¹¹⁵ 85 F.3d 407, 409 (9th Cir. 1996).

¹¹⁶ *Id.*

¹¹⁷ *Id.*

¹¹⁸ *Id.*

¹¹⁹ *Id.*

The dispute concerned a GMC television commercial aired during the 1993 NCAA men's basketball tournament.¹²⁰ It asked the question, "How 'bout some trivia?"¹²¹ The question was then followed by a quote on the screen: "You're talking to the Champ." It then asked, "Who holds the record for being voted the most outstanding player of this tournament?"¹²² The answer then appeared as "Lew Alcindor, UCLA, '67, '68, '69."¹²³ The commercial then stated that the Oldsmobile '88 had made the best buy list three years in a row and was indeed "A Definite First Round Pick."¹²⁴ Abdul-Jabbar brought the above mentioned claim against GMC due to the mention of his former name in the commercial without his consent.¹²⁵

The district court found that 1) Abdul-Jabbar had abandoned the name Lew Alcindor when he recorded his new name in Illinois and 2) that he was not using the name Lew Alcindor at the time of the ad and thus GMC was entitled to summary judgment on both the statutory and common law causes of action.¹²⁶ Abdul-Jabbar argued that abandonment is not a defense to a violation of the right of publicity because the right of publicity protects not only a celebrity's "sole right to exploit his identity, but also his decision not to use his name or identity for commercial purposes."¹²⁷ The court, in overturning the district court's grant of summary judgment to GMC, held that it cannot be possible for a person to lose rights in their own name or likeness through non-use.¹²⁸

One interesting point from this case is that Abdul-Jabbar apparently did not merely stop use of his birth name; he actually took the step of legally changing it as well. Such action seems like it goes beyond nonuse. If legally changing one's name is not considered abandonment of the old one, then it is difficult to imagine a situation where abandonment of one's name would be found.

3.2.2 The Bloom Case: 2002

Another case that addressed the right of a college athlete to control the commercial use of his identity was *Bloom v. National Collegiate Athletic Association*.¹²⁹ Jeremy Bloom was a high school football and track star and was recruited to play football at the University of Colorado ("CU").¹³⁰ Before enrolling at CU, Bloom became the World Cup champion in freestyle moguls while competing at the Olympic and World Cup skiing events.¹³¹ On top of all this, he also appeared on MTV and consequently was offered several paid entertainment opportunities, including a modeling contract with Tommy Hilfiger.¹³² Concerned about his endorsements affecting his eligibility to play football at CU, Bloom requested that CU on his behalf apply to the NCAA for a waiver which the NCAA denied and hence would not permit Bloom to play college football unless he forfeited his modeling and entertainment opportunities.¹³³ Due to the NCAA's ruling, Bloom discontinued his endorsement, modeling and media activities to play football for CU during the 2002 fall season.¹³⁴ However, Bloom instituted an action against the NCAA for declaratory and injunctive relief, asserting that his endorsement, modeling and media activities were necessary to support his professional skiing career, which the NCAA rules permitted as well as forcing him to choose between playing football for CU and his professional skiing career.¹³⁵

As per NCAA Bylaw 12.1.2, the NCAA allows college athletes to play professional sports, such as track and field, during the summer, and then return to their different sports in the fall or spring, as long as

¹²⁰ *Id.*

¹²¹ *Id.*

¹²² *Id.*

¹²³ *Id.*

¹²⁴ *Id.*

¹²⁵ *Id.*

¹²⁶ *Id.* at 414.

¹²⁷ *Id.* at 415.

¹²⁸ *Id.* (noting that the statute's reference to "name or likeness" is not limited to present or current use.)

¹²⁹ 93 P.3d 621 (Colo. App. 2004).

¹³⁰ *Id.* at 622.

¹³¹ *Id.*

¹³² *Id.*

¹³³ *Id.*

¹³⁴ *Id.*

¹³⁵ *Id.*

the only money they accept is salary.¹³⁶ Professional skiers do not receive salaries, though.¹³⁷ Rather, they rely on compensation from endorsements and paid media opportunities.¹³⁸

Under NCAA Bylaws 12.5.2.1 and 12.4.1.1, college athletes are prohibited from using their names and likeness for commercial products.¹³⁹ According to Bloom, these bylaws directly restrict athletes, such as him, that are involved in sports outside of the collegiate level, from pursuing the opportunities presented to them. Similarly, these bylaws of the NCAA also restricted Bloom from participating in his entertainment and modeling opportunities. Bloom argued that these endorsements were not a result of his football ability, but rather a result of his skiing ability, and therefore, he should not have to forego these opportunities.¹⁴⁰ The court denied his request for injunctive relief, recognizing the authority of the NCAA to regulate in this area by holding that the rules were rationally related to the NCAA's stated purposes of maintaining the "clear line of demarcation between intercollegiate athletics and professional sports."¹⁴¹

Bloom also alleged that the NCAA was arbitrary in its application of the endorsement and media bylaws.¹⁴² While the NCAA would prohibit Bloom from accepting commercial endorsements while a college athlete; it would nonetheless allow universities to commercially endorse athletic equipment by having students wear the equipment, with identifying logos and insignias, while engaged in intercollegiate competition.¹⁴³ The court held that this application of the bylaws has a rational basis in economic necessity: "financial benefits inure not to any single student-athlete but to member schools and thus to all student-athletes, including those who participate in programs that generate no revenue."¹⁴⁴ The court in turn held that the NCAA's administrative review process was not only reasonable in scope but also reasonable as being applied to Bloom and consequently denied Bloom's relief.¹⁴⁵

The Bloom decision once again illustrates that even though the NCAA Constitution and Bylaws are a contract solely between the NCAA and its member institutions, student athletes are still considered parties to the contract even though not an original party to it. Hence it appears that college athletes will have to wait until they graduate or leave college in order to reap the financial rewards of their labors.

3.3 Application in Cases involving Non-Athlete Celebrities

3.3.1 The Zacchini Case: 1977

The Supreme Court of the United States has reviewed the right of publicity only once, in the seminal case of *Zacchini v. Scripps-Howard Broadcasting*.¹⁴⁶ Hugo Zacchini was a daredevil whose "human cannonball" act involved him being shot out of cannon into a net approximately 200 feet away and each performance lasted some 15 seconds.¹⁴⁷ A freelance reporter for Scripps-Howard Broadcasting Co. ("Scripps") was covering the Geauga County Fair in Burton, Ohio where Zacchini was performing his "human cannonball" act.¹⁴⁸ The reporter videotaped the entire 15 second act even though Zacchini previously asked him not to do so.¹⁴⁹ The film clip was then aired on Scripps' 11 o'clock news program that night.¹⁵⁰ Zacchini brought an action against the television station claiming that his right of publicity had been violated.¹⁵¹

A divided Supreme Court decided in a five to four decision that granting relief to Zacchini on his state law right of publicity claim would not infringe on the television station's First Amendment rights.¹⁵² In reversing the Ohio Supreme Court's ruling in favor of Scripps, Justice White, writing for the majority,

¹³⁶ *Id.* at 625.

¹³⁷ *Id.*

¹³⁸ *Id.*

¹³⁹ *Id.* at 625-26.

¹⁴⁰ *Id.* at 627.

¹⁴¹ *Id.* at 626.

¹⁴² *Id.* at 627.

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ *Id.* at 628.

¹⁴⁶ *Zacchini*, *supra* note 18, at 562.

¹⁴⁷ *Id.* at 563.

¹⁴⁸ *Id.*

¹⁴⁹ *Id.* at 564.

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

¹⁵² *Id.* at 578.

noted that Zacchini's right of publicity claim would not prevent the television station from reporting the newsworthy aspects of Zacchini's act.¹⁵³ However, the court held that when the media broadcasts a performer's entire act without his consent, the First and Fourteenth Amendments do not immunize the media's conduct.¹⁵⁴ The Court also reasoned that the value of Zacchini's act which was derived from his own talents and energy, depended on the public's desire to witness the event in person, so televising the event detracted from the demand of people willing to pay a fee to see his act.¹⁵⁵ In so reasoning, the Court noted that the decision was not merely to ensure compensation for the performer for the time and effort invested in his act; rather, it was to provide "an economic incentive for him to make the investment required to produce a performance of interest to the public."¹⁵⁶ Accordingly, in language evocative of the policies supporting copyright and patent laws, Justice White crystallized the foundation of the Right of Publicity.

'The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.' Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.'¹⁵⁷

Besides the fact that this was the only instance the Supreme Court has decided to address the right of publicity, what is also worthy of mention is that the Court did not engage in a balancing of competing interests of the First Amendment and the right of publicity. This is important because without the guidance of the Court regarding this crucial inquiry, the lower courts have devised numerous tests to tackle this balancing issue which can only lead to unacceptable variations in application and result.

3.3.2 The Carson Case: 1983

In *Carson v. Here's Johnny Portable Toilets*, renowned talk-show host and comedian Johnny Carson ("Carson") brought an action against Here's Johnny Portable Toilets alleging trademark infringement and infringement of right of privacy and right of publicity.¹⁵⁸ The Defendant was in the business of renting and selling portable toilets which they cleverly named "Here's Johnny" portable toilets.¹⁵⁹ To make a play on words, the Defendant coupled the "Here's Johnny" phrase with "The World's Foremost Comedian."¹⁶⁰ Apparently, Carson did not share the Defendants sense of humor. The Sixth Circuit ruled in favor of Carson with regard to a violation of his right of publicity via the Defendant's use of the catch phrase "Here's Johnny," which was both widely associated with Johnny Carson and used by his business ventures.¹⁶¹ Even though Carson lost his Lanham Act and invasion of privacy claims, the majority believed that the use of the phrase without Carson's consent violated Carson's right of publicity:

[A] celebrity's legal right of publicity is invaded whenever his identity is intentionally appropriated for commercial purposes It is not fatal to appellant's claim that appellee did not use his "name." Indeed, there would have been no violation of his right of publicity even if appellee had used his name, such as "J. William Carson Portable Toilet" or the "John William Carson Portable Toilet" or the "J. W. Carson Portable Toilet." The reason is that, though literally using appellant's "name," the appellee would not have appropriated Carson's identity as a celebrity. Here there was an appropriation of Carson's identity without using his "name."¹⁶²

¹⁵³ *Id.*

¹⁵⁴ *Id.* at 574-75.

¹⁵⁵ *Id.* at 575-76.

¹⁵⁶ *Id.* at 576.

¹⁵⁷ *Id.*

¹⁵⁸ 698 F.2d 831, 833 (6th Cir. 1983).

¹⁵⁹ *Id.* at 833.

¹⁶⁰ *Id.*

¹⁶¹ *Id.*

¹⁶² *Id.* at 837.

The majority appeared to expand the right of publicity which generally would afford protection to an individual's name, likeness, achievements, identifying characteristics or actual performances to now also encompass phrases or other things which are related to the individual's identity. So even though there was no actual use of Carson's persona and it would seem unlikely that the public would believe that Carson endorsed the portable toilets based solely on the apparent play on words, the court felt that Carson's right of publicity had been violated.

3.3.3. The White Case: 1992

The most famous right of publicity cases are the so-called "impersonator" cases. In *White v. Samsung Electronics America, Inc.*, the Ninth Circuit maintained the position it set forth four years earlier in *Midler v. Ford Motor Co.*,¹⁶³ holding that invasion of the right of publicity was "not limited to the appropriation of name or likeness."¹⁶⁴ Vanna White ("White"), who became famous as the letter turner for the game show "Wheel of Fortune," sued Samsung alleging that Samsung had violated her statutory and common law right of publicity under California law and the Lanham Act.¹⁶⁵ The dispute arose out of an advertisement campaign that Samsung ran promoting their VCRs.¹⁶⁶ The ad campaign depicted different aspects of mainstream pop culture which were utilized to hypothesize how they might evolve in the future.¹⁶⁷ One ad in question had a robot, dressed in a blonde wig and evening gown standing before a letter board that resembled the "Wheel of Fortune" set.¹⁶⁸ Samsung referred to this ad as the "Vanna White" ad, and unlike the other celebrities depicted in the ad campaign, White did not consent to the ad nor was she paid.¹⁶⁹

The court in reversing the District Court's summary judgment in favor of Samsung dismissed Samsung's asserted First Amendment defense because whatever element of parody the ad contained was subservient to the primary commercial message, and consequently, no protection would be afforded.¹⁷⁰ The court analogized the difference between a "parody" which is protected and a "knock-off" which is not protected, as being "the difference between fun and profit."¹⁷¹ Even though the majority dismissed White's statutory right of publicity claim, they nonetheless held that Samsung had violated White's common law right of publicity.¹⁷² The court's rationale was that the right of publicity extends beyond a celebrity's name or likeness to cover virtually any symbol that might "evoke" a celebrity's identity for commercial gain.¹⁷³ Thus, since White was the only person known to dress in a gown and turn letters on a game show set, Samsung's ad was an appropriation of White's identity in violation of her publicity rights.¹⁷⁴

The court also proffered a hypothetical which could be used in broadening the scope of protection when it pertains to professional athletes' right of publicity.

Consider a hypothetical advertisement which depicts a mechanical robot with male features, an African-American complexion, and a bald head. The robot is wearing black hightop Air Jordan basketball sneakers, and a red basketball uniform with black trim, baggy shorts, and the number 23 (though not revealing "Bulls" or "Jordan" lettering). The ad depicts the robot dunking a basketball one-handed, stiff-armed, legs extended like open scissors, and tongue hanging out. Now envision that this ad is run on television during professional basketball games. Considered individually, the robot's physical attributes, its dress, and its stance tell us little. Taken together, they lead to the only conclusion that any sports viewer who has registered a discernible pulse in the past five years would reach: the ad is about Michael Jordan.¹⁷⁵

¹⁶³ *Midler*, *supra* note 48, at 460.

¹⁶⁴ 971 F.2d 1395, 1398 (9th Cir. 1992).

¹⁶⁵ *Id.* at 1396.

¹⁶⁶ *Id.*

¹⁶⁷ *Id.*

¹⁶⁸ *Id.*

¹⁶⁹ *Id.*

¹⁷⁰ *Id.* at 1401.

¹⁷¹ *Id.*

¹⁷² *Id.* at 1397, 1399.

¹⁷³ *Id.* at 1398.

¹⁷⁴ *Id.* at 1399.

¹⁷⁵ *Id.* at 1399.

The majority’s opinion, like that in *Carson*, appears to have expanded the purview of the right of publicity. Under the majority’s opinion, it’s now a tort for advertisers to simply remind the public of a celebrity. It seems very plausible that Samsung used White only as a symbol for the concept of durability, thus it would appear that the public would not be led to believe that she was endorsing Samsung’s VCRs.

3.3.4 The Comedy III Case: 2001

In 2001, the California Supreme Court addressed the question of whether unauthorized use of a person’s identity on a T-shirt is protected by the First Amendment in *Comedy III Productions, Inc. v. Saderup, Inc.*¹⁷⁶ Comedy III Productions, Inc. (“Comedy III”) was the registered owner of all the rights to the legendary comedy act “The Three Stooges” of which the original three members were deceased.¹⁷⁷ Gary Saderup and Gary Saderup Inc. (collectively “Saderup”) was an artist with over 25 years’ experience in making charcoal drawings of celebrities.¹⁷⁸ These drawings were then put on T-shirts using a silkscreen process.¹⁷⁹ All the drawings used for the images on the T-shirts were original works of art created by Saderup.¹⁸⁰ The present dispute came about when Saderup sold lithographs and T-shirts bearing a likeness of the Three Stooges without acquiring Comedy III’s consent.¹⁸¹ Comedy III subsequently brought an action against Saderup alleging violation of California’s statutory right of publicity.¹⁸² Saderup countered by contending that the right of publicity statute did not apply in this particular case, and even if it did, that his work was protected by the First Amendment.¹⁸³

In affirming the Court of Appeal’s decision, the California Supreme Court held that Saderup’s “literal, conventional” portrait of the Three Stooges was not protected by the First Amendment and thus violated the “Three Stooges” right of publicity.¹⁸⁴ The court found that the marketability and economic value of Saderup’s work came from the Three Stooges’ fame and not from Saderup’s creative contribution.¹⁸⁵ The court emphasized that art receives full constitutional protection even if it conveys no discernible message and that expressive works embodied in less conventional mediums of communication, such as T-shirts, are not “commercial speech,” even though they are sold for financial gain.¹⁸⁶

The court, however, concluded that the First Amendment defense is only available for works that are in essence “transformative.”¹⁸⁷ The court in considering whether this factor of the fair use test from copyright law had been met, looked at whether the work (1) “adds something new, with a further purpose or different character, altering the first with new expression, meaning or message” or “merely ‘supersede[s] the object’ of the original creation”; (2) adds “significant expression” or is merely “the ‘literal depiction or imitation of a celebrity for commercial gain’”; (3) “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”; (4) whether the “celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness”; (5) contains “creative elements” dominating the work or rather is it “literal or imitative”; (6) has worth primarily due to “some source other than the fame of the celebrity,” such as “from the creativity, skill, and reputation of the artist”; and lastly (7) necessitates the artist contributing “something more than a ‘merely trivial’ variation,” and in the process creating “something recognizably ‘his own.’”¹⁸⁸ The court concluded that Saderup’s charcoal drawings of the Three Stooges, even though reflecting Saderup’s undeniable skill, nonetheless did not meet this “transformative” test because Saderup’s skill

¹⁷⁶ *Comedy III Prod.*, *supra* note 68, at 797.

¹⁷⁷ *Id.* at 800.

¹⁷⁸ *Id.*

¹⁷⁹ *Id.*

¹⁸⁰ *Id.*

¹⁸¹ *Id.* at 800-01.

¹⁸² *Id.* at 800.

¹⁸³ *Id.* at 801, 802.

¹⁸⁴ *Id.* at 811.

¹⁸⁵ *Id.*

¹⁸⁶ *Id.* at 804. See *Guglielmi v. Spelling–Goldberg Productions*, 25 Cal.3d 860, 868 (Cal. 1979) (“[t]he First Amendment is not limited to those who publish without charge.... [An expressive activity] does not lose its constitutional protection because it is undertaken for profit.”)

¹⁸⁷ *Id.* at 808

¹⁸⁸ *Id.* at 808-10.

and talent was ancillary to the overall goal of creating a traditional portrait of celebrities so as to commercially exploit their fame.¹⁸⁹

4. The Right of Publicity – Current State

4.1 Application in Cases involving Professional Athletes

The Jordan Case: 2012

Following the conclusion of one of the most memorable careers in the history of the NBA, superstar Michael Jordan (“Jordan”) was inducted into the Basketball Hall of Fame.¹⁹⁰ Coinciding with this auspicious occasion, *Sports Illustrated* published a commemorative issue devoted to celebrating Jordan’s career.¹⁹¹ Jewel Food Stores, Inc. (“Jewel”), at the behest of the publisher, designed a page for the commemorative issue that headlined a pair of basketball shoes emblazoned on the tongue with the number 23, the number Jordan wore for most of his basketball career.¹⁹² The page also included a message which congratulated Jordan on “scores of rewritten record books and numerous buzzer beaters.”¹⁹³ Below the congratulatory text was Jewel’s logo and slogan: “Good things are just around the corner.”¹⁹⁴ Apparently Jordan was not enamored with the unsolicited tribute because after the issue was published he brought the present action against Jewel alleging violations of the Lanham Act and the [Illinois Right of Publicity Act](#).¹⁹⁵

The central issue in this case was “whether Jewels’ page was ‘noncommercial speech,’ which receives full First Amendment protection, or ‘commercial speech’ which receives lesser protection.”¹⁹⁶ The standard enunciated by the Supreme Court of what constitutes commercial speech is “speech that proposes a commercial transaction.”¹⁹⁷ Jordan argued that due to Jewel using its trade name and its advertising slogan, this in effect proposed a commercial transaction by inviting readers to visit Jewel locations.¹⁹⁸ The district court discredited Jordan’s “commercial speech” claim because Jewel’s page focused “not on Jewel or its particular products and services, but on Jordan.”¹⁹⁹ The court also noted that Jewel’s use of its logo was simply the most effective way to identify Jewel as the speaker and Jewel’s slogan was merely a play on words.²⁰⁰

Additionally, the court held that the Supreme Court’s three-factor test from *Bolger v. Youngs Drug Products Corp.*²⁰¹ to determine whether speech is commercial favored the view that Jewel’s speech was noncommercial.²⁰² The first factor, whether Jewels’ page was an advertisement, was found not to be present because the grocery chain did not pay money to run the page, it agreed to display the magazine only in its stores, and the page did not focus on or praise any product or service.²⁰³ The court also noted that one of Jewel’s competitors, Dominick’s Finer Foods, ran a similar page in the same issue of *Sports Illustrated*.²⁰⁴ The court found this to be significant because “anybody inclined to be swayed by Jordan’s appearance in an advertisement knows that he does not play on two or more sides of the same fence, commercially speaking.”²⁰⁵ The second factor, whether the page “refers to a specific product,” also

¹⁸⁹ *Id.* at 811.

¹⁹⁰ *Jordan v. Jewel Food Stores, Inc. et al.*, No. 10-340, 2012 WL 512584 (N.D. Ill., E. Div. Feb. 15, 2012).

¹⁹¹ *Id.* at 1.

¹⁹² *Id.*

¹⁹³ *Id.*

¹⁹⁴ *Id.*

¹⁹⁵ *Id.*

¹⁹⁶ *Id.*

¹⁹⁷ *Id.* at 3.

¹⁹⁸ *Id.*

¹⁹⁹ *Id.* at 4.

²⁰⁰ *Id.*

²⁰¹ 103 S.Ct. 2875, 2880 (1983).

²⁰² *Jordan*, *supra* note 190, at 9.

²⁰³ *Id.* at 6-7.

²⁰⁴ *Id.* at 7.

²⁰⁵ *Id.*

avored a finding of noncommercial speech for the page did not refer to a particular product or service.²⁰⁶ Lastly, the court acknowledged that Jewel did have an economic motive for producing and placing its page in the commemorative issue, but this by itself was not enough to transform noncommercial speech into commercial speech, hence the third factor weighed in favor of Jewel.²⁰⁷

Even though the court held that Jewel's page in the *Sports Illustrated* issue was noncommercial speech, they left open the possibility that Jordan could continue his suit against Jewel if he could later show that the noncommercial status of Jewel's page does not conclusively defeat his claims.²⁰⁸ In all reality, this would appear to be a lost cause for Jordan because of all the previous case law that supports the notion that noncommercial speech is afforded great First Amendment protection and consequently trumps a right of publicity claim.

4.2 Application in Cases involving Collegiate Athletes

The *Hart* Case: 2011

The question of whether a video game developer's appropriation of a college athlete's likeness is protected speech under the First Amendment was the focal point in *Hart v. Electronic Arts, Inc.*²⁰⁹ Ryan Hart ("Hart"), a former member of the Rutgers University football team, sued Electronic Arts, Inc. ("EA") on behalf of himself and similarly situated athletes, alleging that the videogame maker violated their rights of publicity.²¹⁰ The dispute arose from EA's blockbuster game, *NCAA Football*.²¹¹ The videogame allows users to command the actions of numerous virtual college football teams and players, readily identifiable by the schools' names, uniform designs and logos, attributes EA licensed from the Collegiate Licensing Company, the National Collegiate Athletic Association's licensing agent.²¹² The virtual players on each team are identified by their corresponding jersey numbers, positions, likenesses and attributes and correlate with actual players on college football teams.²¹³ The game permits users to change the virtual player's height, weight and playing abilities.²¹⁴ In addition, certain biographical data may be altered such as the virtual player's first name, last name, position, and number.²¹⁵ The virtual player's home state, hometown, and team may not be altered.²¹⁶ Due to the virtual players in *NCAA Football* corresponding with actual collegiate football players, Hart sought redress for EA's alleged misappropriation and incorporation of his identity and likeness for a commercial purpose in its video game.²¹⁷ EA countered that its use of players' likenesses and attributes in the game was fully protected under the First Amendment.²¹⁸

The court's first inquiry was whether videogames should be entitled to First Amendment protection, and if so, to what degree. The court, citing the Supreme Court's decision in *Brown v. Entertainment Merchants Association*,²¹⁹ affirmed that videogames were entitled to the same level of First Amendment protection as books and movies.²²⁰ The court then proceeded to the central issue of the case, whether EA's First Amendment free expression rights would subvert Hart's interest in safeguarding his right of publicity. In order to balance these two competing interests, the court embarked on the application of two tests: the "transformative" test and the *Rogers test*.²²¹

²⁰⁶ *Id.*

²⁰⁷ *Id.* at 8.

²⁰⁸ *Id.* at 9.

²⁰⁹ 808 F.Supp.2d 757 (D.N.J. 2011).

²¹⁰ *Id.* at 761.

²¹¹ *Id.*

²¹² *Id.* at 760-61.

²¹³ *Id.* at 761.

²¹⁴ *Id.*

²¹⁵ *Id.*

²¹⁶ *Id.*

²¹⁷ *Id.*

²¹⁸ *Id.* at 764.

²¹⁹ 131 S.Ct. 2729, 2733 (2011).

²²⁰ *Hart*, *supra* note 209, at 768.

²²¹ *Id.* at 776.

Under the “transformative” test, the court contrasted EA’s manipulation of football player likenesses and attributes with the videogame at issue in *No Doubt v. Activision Publishing, Inc.*²²² (discussed at length in the following section). The videogame in the *No Doubt* case merely contained literal reproductions of the members of the rock band No Doubt without any alterations.²²³ In *NCAA Football*, by contrast, the court found that even though the game’s virtual player bore resemblance to Hart and was designed with Hart’s personal attributes in mind, gamers could ultimately change the virtual football player’s attributes and likeness in countless ways.²²⁴ For instance, gamers have the ability to alter the virtual player’s physical attributes, such as the player’s height, weight, hairstyle, and athletic ability.²²⁵ Acknowledging that “the goal of the game is to capitalize upon the fame” of actual players such as Hart, the court nevertheless found EA’s use to be adequately transformative since, in addition to the ability to alter virtual players, the game also contains “virtual stadiums, athletes, coaches, fans, sound effects, music, and commentary” all of which were created by EA’s designers.²²⁶

The court also found that EA’s use was protected under the *Rogers* test.²²⁷ The *Rogers* test was first enunciated by the Second Circuit in *Rogers v. Grimaldi*²²⁸ which was a Lanham Act false-endorsement case. In the right of publicity context, the *Rogers* test has two inquiries: (1) “whether the challenged work is wholly unrelated to the underlying work;” or (2) “whether the use of the plaintiff’s name is a disguised commercial advertisement.”²²⁹ The court found that the use of Hart’s image and characteristics were highly relevant to the videogame and that EA’s use of Hart’s image was part of an expressive act that possibly drew upon the public’s familiarity with Hart’s collegiate career but that users of the game would not think that he endorsed it.²³⁰

What appears most striking from this case is the fact that there are so many different judicially created tests for determining whether First Amendment rights of expression should trump that of the right of publicity. The court acknowledged eight tests in its discussion and settled on two. It does not seem to be a stretch to hypothesize that the outcome of this case could possibly have come out differently if one of the other six tests were employed instead.

4.3 Application in Cases involving Non-Athlete Celebrities

The No Doubt Case: 2011

The novel issue of the virtual world of celebrity avatars and the right of publicity was addressed in *No Doubt v. Activision Publishing, Inc.*²³¹ No Doubt, a world renowned rock band featuring Gwen Stefani as its lead singer, sued Activision Publishing Inc. (“Activision”) alleging amongst other things violation of statutory and common law right of publicity.²³² The Defendant, Activision, was the world’s first independent developer and distributor of video games for gaming consoles and the creator and owner of the *Band Hero*, a spinoff of the hit videogame *Guitar Hero*.²³³ *Band Hero* allows players to simulate performing in a rock band as a guitarist, singer, or a drummer in time with popular songs.²³⁴ The computer generated images of the different band members, known as “avatars,” consist of either fictional characters created and designed by Activision or digital representations of real-life rock stars.²³⁵ Another feature of *Band Hero* is the ability for users to “unlock” certain in-game characters, thereby enabling the characters to perform not only their own songs, but other musicians’ songs as well.²³⁶ This “unlock” feature was the catalyst for the present dispute.

²²² 192 Cal.App.4th 1018 (Cal.App. 2011).

²²³ *Hart*, *supra* note 209, at 782.

²²⁴ *Id.* at 784.

²²⁵ *Id.* at 783.

²²⁶ *Id.* at 783-84.

²²⁷ *Id.* at 793.

²²⁸ 875 F.2d 994 (2nd Cir. 1989).

²²⁹ *Hart*, *supra* note 209, at 793.

²³⁰ *Id.*

²³¹ *No Doubt*, *supra* note 222, at 1018.

²³² *Id.* at 1022.

²³³ *Id.* at 1022-23.

²³⁴ *Id.* at 1023.

²³⁵ *Id.*

²³⁶ *Id.*

The two parties entered into an agreement whereas No Doubt granted a license to Activision to use its name and likeness for *Band Hero*.²³⁷ As a result of users of the game being able to have No Doubt performing other musicians' songs, the band demanded that Activision remove this "unlock" feature for No Doubt's avatars due to Activision allegedly assuring that the band's name and likeness would be used only for three of their own songs.²³⁸ Activision refused No Doubt's demand claiming "programming had been finalized and the manufacturers had approved the game for manufacture."²³⁹

In affirming the trial court, the Court of Appeals denied Activision's motion to strike No Doubt's right of publicity claim based on Activision's First Amendment defense.²⁴⁰ Similar to the issue presented in *Comedy III Productions*, the court here had to balance the First Amendment free expression rights of Activision with that of the rights of No Doubt to control the commercial exploitation of its band members' likenesses.²⁴¹ The court began its analysis with the proposition that a work claimed to violate a celebrity's right of publicity will be afforded First Amendment protection only where "added creative elements significantly transform the celebrity depiction."²⁴² In other words, has the work been so transformed that it is better described as the defendant's own expression as opposed to a "mere celebrity likeness or imitation."²⁴³ Applying this "transformative test," the court concluded that even though "video games are expressive works entitled to as much First Amendment protection as the most profound literature," the use of No Doubt's likeness by Activision was not transformative and consequently Activision was not entitled to its First Amendment defense.²⁴⁴ Activision contended that its use of No Doubt's likeness was transformative because it incorporated the No Doubt avatars with "creative elements" such as fanciful venues and performances of other musicians' songs.²⁴⁵ The court rejected Activision's transformative claim because even though Activision employed these "creative elements" with No Doubt's avatars, these avatars were nonetheless identical portrayals of the band members shown performing for which they garnered fame.²⁴⁶ The court further held, "nothing in the creative elements of the *Band Hero* elevates the depictions of No Doubt to something more than 'conventional, more or less fungible, images' of its members that No Doubt should have the right to control and exploit."²⁴⁷

5. Conclusion

The right of publicity has certainly evolved since the first time it was coined by Judge Frank in the *Haelan* case. From its roots in privacy law, this right of publicity now affords one the ability to control the commercial use of their identity. But it appears this tort claim still requires some much needed growth. An analysis of the cases discussed reveals that a discrepancy does exist when the right of publicity is applied in cases dealing with non-athlete celebrities with that of athletes.

This is illustrated in the cases of *Comedy III*, *White*, *Cartoons*, and *Jordan*. All four cases involved a right of publicity action where the defendant invoked a First Amendment defense. The courts in *Comedy III* and *White* held that the respective right of publicity interests trumped the First Amendment considerations. Meanwhile the courts in *Cartoons* and *Jordan* held that the respective First Amendment considerations eclipsed the right of publicity interests. In *Comedy III*, the defendant through his own skill and efforts created an original portrait of the Three Stooges for sale. The court there held that the defendant's portrait was just a literal depiction of the Three Stooges and was ancillary to the main purpose of exploiting the Three Stooges' fame. In *White*, the defendant came up with a clever metaphor of the everlasting game show host, Vanna White, and the durability of its VCRs. Similar to that in *Comedy III*, the court held that the defendant's parody of Ms. White was incidental to its commercial message. In contrast are *Cartoons* and *Jordan*. In *Cartoons*, *Cartoons* sold baseball trading cards that

²³⁷ *Id.*

²³⁸ *Id.* at 1024.

²³⁹ *Id.* at 1025.

²⁴⁰ *Id.* at 1035.

²⁴¹ *Id.* at 1030.

²⁴² *Id.* at 1034.

²⁴³ *Id.* at 1030.

²⁴⁴ *Id.* at 1029, 1035.

²⁴⁵ *Id.*

²⁴⁶ *Id.* at 1034.

²⁴⁷ *Id.* at 1035.

mocked various aspects of baseball and its players. The court held that Cartoon's First Amendment interests subverted the baseball players' right of publicity. The court's rationale was that the trading cards provided important social commentary on public figures and that the cards did not fall within the commercial speech category because they did not advertise another unrelated product. In *Jordan*, the defendant ran a page in a Sports Illustrated issue that consisted of a pair of sneakers that undoubtedly were meant to recall the image of Michael Jordan. The court in *Jordan* held that this misappropriation was protected under the First Amendment because it was "non-commercial" speech due to the page focusing on Jordan and not on the defendant or the defendant's products. Strikingly obvious is that in all four cases, the defendants' primary motives were clearly commercial gain. One could argue that Saderup's drawings of the Three Stooges in *Comedy III* should have been protected because similar to *Jordan*, Saderup's drawings focused on the Three Stooges and not the defendant. Or conversely the court in *Jordan* could have borrowed the rationale used in *Comedy III* to find that Jewel's misappropriation of Jordan's image was not "transformative" enough to warrant First Amendment protection because the page was a literal depiction of Jordan's image. In addition, the court in *Jordan* could have adopted *White's* rationale that the right of publicity extends beyond a celebrity's name or likeness to cover virtually any symbol that might evoke a celebrity's identity for commercial gain; and what is more symbolic of Mr. Jordan than a pair of basketball sneakers emblazoned with his iconic number, 23. One could also argue that a robot dressed in likeness parodying pop culture is at least similar to a baseball card mocking its subject.

Another disturbing trend is when the courts refer to the athlete's ability to earn an income from other avenues as a possible explanation for not finding in favor of his right of publicity claim. Such is the case in *CBC* where the court concluded that because professional baseball players are handsomely rewarded for their efforts and have the ability to earn additional income from endorsements and sponsorship deals, that the elimination of revenue from fantasy league licensing fees would have very little impact on the players' ability to enjoy the benefits of their toils. One could assert then why did this same rationale not apply in a case such as *Carson*. In *Carson*, the court held Carson's right of publicity had been violated even though there was no use of his persona and it would seem unlikely that the public would believe that Carson endorsed the portable toilets based solely on the apparent play on words. In addition, Mr. Carson would most likely be able to still enjoy the benefit of his work if the defendant's First Amendment defense would have been granted. Both *CBC* and *Carson* dealt with a defendant who used another's likeness for financial gain. *CBC's* misappropriation of the baseball players' names and stats was the sole source of its business thus one could argue that anything else was incidental to the motive of *CBC* seeking to prosper from the players' fame. Yet in *Carson*, the defendant simply used Mr. Carson's phrase and not even his name or likeness to help sell its toilets, thus one could say, that the defendant had a commercial intent, but that was not the only one.

As shown in *Bloom*, it is clear that college athletes have virtually no legal protections, in fact they can pose as part of a team which is endorsing a particular sporting product, and although the NCAA gains significant revenue from this advertising, the individual participant cannot be compensated. In fact the individual college athlete cannot be compensated for any commercial advertising or endorsements, while they are attending college.

College athletes' lack of protection under the right of publicity is further reinforced by the court's ruling in *Hart* contrasted with that of *No Doubt*. The court in *Hart* held that a virtual player in *NCAA Football* who was modeled in likeness and attributes of the plaintiff was still afforded full First Amendment protection. In so ruling, the court held the virtual player was "transformative" because users could alter the virtual player's characteristics as well as surrounding environment. Whereas in *No Doubt*, a case which involved virtual band members in the game *Band Hero* created in the likeness of No Doubt members, the court there held that virtual players violated No Doubt's right of publicity. Even though *Band Hero's* virtual players could play different songs and perform in various environments similarly to that in *NCAA Football*, the court held this still was not "transformative" enough.

In their decision, the court in *Hart* also acknowledged that its analysis was in contrast to that in *Keller v. Electronic Arts, Inc.*, in which the District Court for the Northern District of California held that *NCAA Football* was not sufficiently "transformative."²⁴⁸ In distinguishing this case from *Keller*, the court stated that *Keller* failed to address that the virtual player's image could be altered, and disagreed with *Keller's*

²⁴⁸ No. C 09-1967 CW, 2010 WL 530108 (N.D. Cal. Feb. 8, 2010).

approach of focusing solely on the challenged image, as opposed to the work as a whole.²⁴⁹ What appears to be the salient point from *Hart, No Doubt* and *Keller* is that courts have a very difficult time uniformly applying the “transformative” test with unfortunately college athletes feeling the brunt of this misapplication.

Fame is an invaluable asset. Celebrities, including professional and college athletes, have used that asset to become both household and brand names. American society’s obsession with and access to celebrities and professional and collegiate athletes only fuels these individuals’ marketability. Like celebrities, professional and college athletes should be afforded the same protection under the right of publicity, to ensure that all benefit equally from the fruits of their labors.

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²⁴⁹ *Hart, supra* note 209, at 787.