
THE RIGHT OF PUBLICITY VS. THE FIRST AMENDMENT: WILL ONE TEST EVER CAPTURE THE STARRING ROLE?

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I. INTRODUCTION

America's fascination with fame and celebrities is self-evident. In our culture, fame is used effectively to persuade, inspire, and inform the public in almost every aspect of our lives.¹ Thus, for celebrities, 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."² 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.³

The public's fascination with celebrities has evolved into the ubiquitous use of stars to symbolize individual aspirations, group identities, and cultural values.⁴ Celebrity images are therefore important expressive

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1. Roberta Rosenthal Kwall, *Fame*, 73 IND. L.J. 1 (1997).
2. J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:3 (2d ed. 2006).
3. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).
4. Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 128 (1993).

and communicative resources⁵ and the public's use of these images is vital to the realization of the First Amendment goals of self-expression and the creation of a robust public discourse.⁶ Thus, there is a direct conflict between a celebrity's right of publicity and the public's right to free expression embodied in the First Amendment.⁷ Courts, in struggling to accommodate these competing interests, have failed to articulate a clear standard to resolve the conflict, resulting in a confusing morass of inconsistent, incomplete, or mutually exclusive approaches, tests, and standards.⁸ The chaos surrounding the scope of publicity rights in works protected by the First Amendment has led to a real hit on free expression that is especially troubling as we enter the digital age—with the Internet providing a global platform for expression in our multicultural society.⁹ Courts need a clear standard to take the leading role in resolving the conflict between the First Amendment and the right of publicity in expressive works.¹⁰ This Note proposes a test with the clarity and nuance to take center stage and resolve this conflict.

Part II provides a historical perspective of the right of publicity in order to illustrate how society, culture, and technology have shaped the scope of the right since its conception and influenced the right's interaction with the First Amendment. Part III presents the theoretical underpinnings of both the right of publicity and the First Amendment and asserts that balancing the interests these doctrines protect is necessary in formulating a standard. Part IV highlights the difference between expressive and commercial speech and explains how the various types of expressive speech and mediums used to convey the message contribute to the confusion in determining the extent of First Amendment protection. Part V exposes the massive confusion courts face in attempting to resolve the conflict between these rights, and demonstrates the strengths and inadequacies of the numerous balancing approaches available.

5. *Id.*

6. *See infra* Part III.B.

7. U.S. CONST. amend. I (“Congress shall make no law . . . abridging the freedom of speech, or of the press . . .”).

8. Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 472 (2003).

9. *See* Schuyler M. Moore, *Sex, Lies and Videotape: The First Amendment vs. the Right of Publicity for Expressive Works*, ENT. L. REP., Nov. 2003, at 4, 6 (“Because of the muddy law in this area . . . [t]he mantra of most publishers and film companies has thus become, ‘When in doubt, leave it out,’ resulting in a real hit to the First Amendment.”).

10. *See infra* Part IV.

Part VI proposes the primary motivation test to resolve this conflict. This test focuses on the defendant's primary influence or motive—expressive or commercial—in using a celebrity identity, and it proposes a framework to adequately balance the expressive and property interests at stake and the goals underlying each of the rights. The test is applicable to all types of expressive speech, and its formulation takes into account the right of publicity's intellectual property background, existing tests that attempt to resolve the conflict, and current cultural, social, and technological influences. Part VII concludes that the primary motivation test is ready to take center stage as the proper test to balance all of the interests involved in right of publicity claims.

II. INFLUENCES SHAPING THE RIGHT OF PUBLICITY: A HISTORICAL PERSPECTIVE

The expansion and development of society, culture, and technology in America has shaped the scope of the right of publicity since its conception and influenced the right's interaction with the First Amendment. This historical perspective demonstrates that in order to create a test that effectively balances publicity rights with free expression, our current multicultural society, digital technology, and the Internet must be considered.

A. THE BIRTH OF OUR NATION

Our founding fathers enshrined in the First Amendment the values of free expression central to the democratic ideals of our country.¹¹ They also promoted a philosophy that “[f]ame should be freely sought and freely given’ as the ‘only proper reward’ for civic virtue and heroism.”¹² To the founders, the term “fame” or “famous” held its original meaning, derived from the Latin word *fama*, meaning “manifest deeds.”¹³ The definition implied that the ability to perform such deeds and attain such achievements was due to virtue and self-discipline, and thus, people should accept fame modestly and were expected to return some portion of their success to the world through their continual good deeds.¹⁴ Accordingly, the founding fathers did not complain about the appropriation of their images. On the

11. U.S. CONST. amend. I.

12. Madow, *supra* note 4, at 150 (internal citations omitted).

13. RICHARD SCHICKEL, *INTIMATE STRANGERS: THE CULTURE OF CELEBRITY IN AMERICA* 24 (1985).

14. *See id.*

contrary, they believed the broad dissemination of their images would advance the interests of the American public in furthering the cause of independence and nation-building.¹⁵ Therefore, the modern economic conceptions of fame¹⁶ and celebrity¹⁷ that gave rise to the right of publicity were alien to the members of the founding generation, who could not envision a conflict between the right of publicity and First Amendment values of free expression. A historical look at the evolution of the law, mass media technology, and the concept of fame will show how the right of publicity has been in tension with the First Amendment since its predecessor, the right of privacy, was conceived. This perspective will also illuminate the considerations that must be taken into account to achieve the correct balance between the rights in our contemporary popular culture.

B. THE RIGHT TO PRIVACY

The invention of the rotary printing press in the late nineteenth century led to the mass circulation of newspapers and sensationalist human-interest journalism.¹⁸ By the time William Randolph Hearst arrived in New York to challenge Joseph Pulitzer's dominance in the newspaper business,¹⁹ the formula for success was well-established: begin with "the startling, the amazing, and the stupefying" and then find a human symbol to summarize an event or tragedy and apply it on a national scale.²⁰ The concept of fame began evolving as the "names make news" philosophy allowed not only political leaders, but also inventors, business tycoons, writers, athletic figures, criminals, and entertainers who accomplished something "great" in the world to bask in the limelight of fame.²¹

15. Madow, *supra* note 4, at 150. As Michael Madow states, Franklin, like Washington, Jefferson, and even the more artistically puritanical John Adams, appreciated the propaganda value of such images of an exemplary civic virtue, especially . . . in America, where the images of the new heroes served to help create a spirit of unity paralleled by the evolution of more abstract national symbols. America was organizing a culture from the ground up, and in that organization the unifying and crystallizing function of faces was of prime importance.

Id. (internal citations omitted).

16. *See id.* at 150–51.

17. *See* SCHICKEL, *supra* note 13, at 23; Kwall, *supra* note 1, at 8 ("[T]he celebrity epidemic did not begin to emerge until the early 1960s. One study revealed that the use of the term 'celebrity' in titles of magazine articles began a visible escalation in the early 1960s.").

18. *See* CHARLES L. PONCE DE LEON, SELF-EXPOSURE: HUMAN-INTEREST JOURNALISM AND THE EMERGENCE OF CELEBRITY IN AMERICA, 1890–1940, at 44–47 (2002).

19. *See id.*

20. SCHICKEL, *supra* note 13, at 29–30.

21. *See* PONCE DE LEON, *supra* note 18, at 31–32; SCHICKEL, *supra* note 13, at 30–34; Madow, *supra* note 4, at 160 ("A man's name was not apt to become a household word unless he exemplified

The development of intrusive journalism, combined with advertising, led to Louis Brandeis and Samuel Warren's famous 1890 article arguing for the creation of a common law right to privacy.²² They believed that a legal right was necessary to protect an individual's privacy from a press that was "overstepping in every direction the obvious bounds of propriety and of decency."²³ They were appalled that in order to "satisfy a prurient taste the details of sexual relations [were] spread broadcast in the columns of the daily papers."²⁴ In advocating for a fundamental "right 'to be let alone,'"²⁵ Brandeis and Warren stated that human dignity demanded that an individual be free from the "blighting influence" of gossip and instantaneous photography.²⁶ Their argument proved persuasive and a majority of state courts, following Georgia's lead,²⁷ recognized the right to privacy as part of their common law.²⁸ In New York, where the courts refused to recognize the right in *Roberson v. Rochester Folding Box Co.*,²⁹ the New York Legislature reacted swiftly and decisively, creating a statutory right to privacy and establishing both criminal and civil liability for the unauthorized use of a person's "name, portrait or picture" for "advertising purposes, or for the purposes of trade."³⁰ Two years later, the Georgia Supreme Court, in *Pavesich v. New England Life Insurance Co.*, held that the unauthorized use of an artist's photograph in a testimonial advertisement violated a common law right to privacy.³¹ In the ensuing

greatness in some way or other. He might be a Napoleon, great in power, a J.P. Morgan, great in wealth, a St. Francis, great in virtue, or a Bluebeard, great in evil.").

22. Louis D. Brandeis & Samuel D. Warren, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

23. *Id.* at 196.

24. *Id.*

25. *Id.* at 195 (quoting THOMAS M. COOLEY, COOLEY ON TORTS 29 (2d ed. 1898)).

26. *Id.* at 196.

27. See *Pavesich v. New Eng. Life Ins. Co.*, 50 S.E. 68, 74 (Ga. 1905).

28. See Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1581 (1979).

29. See *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442, 443 (N.Y. 1902) (rejecting a young girl's common law privacy action against a box and flour company that used her photograph for its advertisement posters without her consent, and claiming that recognizing a right to privacy would lead to "litigation bordering upon the absurd").

30. N.Y. CIV. RIGHTS LAW §§ 50, 51 (Consol. 2001 & Supp. 2005). The applicable provision states:

[A] person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, or if a minor of his or her parent or guardian, is guilty of a misdemeanor.

Id. In addition to this criminal penalty, the statute also provides for an injunction and both compensatory and punitive damages. *Id.*

31. See *Pavesich*, 50 S.E. at 74 (holding unanimously that the unauthorized use of an artist's photograph in an advertisement for life insurance violated a new common law right of privacy, and, in

years, “protection from unauthorized commercial use of name and likeness became a widely recognized aspect of the right to privacy.”³²

The twentieth century brought Americans two new mediums of communication: the radio broadcast and the silver screen. These new technologies then converged with magazines, newspapers, and new advertising techniques to firmly establish the link between celebrity and consumption, and the economics of fame began to transform.³³ The pervasiveness of motion pictures using the “close-up” technique fostered an illusion of unprecedented intimacy between the public and their favorite actors and generated a widespread hunger to know more about the stars’ private lives.³⁴ A proliferation of fan magazines and newspaper gossip columns fed America’s craving until the names and images of movie stars became embedded in our culture and the public began to look to the rich and famous for cues about what they should buy and how they should live.³⁵ Radio and the motion picture effectively “uncoupled fame from greatness of achievement”³⁶ and created a new form of human eminence—the “celebrity”—a person “known for his well-knownness.”³⁷

The commercial implications of this phenomenon were clear, and Hollywood and Madison Avenue began exploiting the immense marketing power of movie stars, a power which stemmed from celebrities’ ability to inspire emulation and cultivate consumer demand.³⁸ During this period, the advertising techniques of product placement and the celebrity tie-in or

adopting the reasoning of Justices Warren and Brandeis, that this appropriation constituted a tort and was a violation of the personal “right to be let alone”).

32. Madow, *supra* note 4, at 168.

33. *See id.* at 163.

34. *See* SCHICKEL, *supra* note 13, at 34–36; Kwall, *supra* note 1, at 29; Madow, *supra* note 4, at 162.

35. *See* Madow, *supra* note 4, at 162–63.

36. *Id.* at 160.

37. Madow, *supra* note 4, at 161. As Madow explains, Richard Schickel describes the sea change this way:

What happened in this period [1915–1925] was that the public ceased to insist that there be an obvious correlation between achievement and fame. It was no longer absolutely necessary for its favorites to perform a real-life heroic act, to invent a boon for mankind, to create a mighty business enterprise Beginning with the rise of the star system in Hollywood it was possible to achieve “celebrity” through attainments in the realms of play—spectator sports, acting—and almost immediately thereafter it became possible to become a celebrity (a new coinage describing a new phenomenon) simply by becoming . . . a celebrity

Id. (quoting RICHARD SCHICKEL, *HIS PICTURE IN THE PAPERS* 7 (1973)) (alterations in original). *See also* PONCE DE LEON, *supra* note 18, at 12.

38. Madow, *supra* note 4, at 163–64.

product testimonial became widespread,³⁹ and soon the names and faces of screen stars and professional athletes were being used to sell all kinds of consumer goods, from soap and cosmetics to cigarettes.⁴⁰ Michael Madow elaborates:

By the 1930s, then, new “joint consumption” communications technologies (motion pictures, radio) had transformed not only the mechanisms by which fame was generated, but its commercial significance as well. The most obvious change was that celebrity itself had become a source of immense economic value. The “publicity values” of movie and sports stars could now be exploited profitably in a wide range of collateral endeavors.⁴¹

Movie studios frequently licensed the images of their actors to advertisers and merchandisers, and a number of licensing companies were formed solely for the purpose of marketing famous people.⁴² The commodification of celebrity image shed light on the economic dimension of fame and laid the groundwork for this new perception of fame to take hold in America.

The law, however, was unprepared to meet this evolving concept of fame and the right to privacy was unaccommodating to celebrities’ newfound need to protect and control the use of their images. The plaintiffs in *Roberson* and *Pavesich* were relatively unknown and complained of personal injury to their dignity from unwanted publicity. Celebrities, on the other hand, deliberately seek the spotlight, so there should be no real emotional injury when they receive additional publicity.⁴³ For celebrities, the injury complained of was not that their name or likeness had been *used*, but that they had not been *compensated* for its use; a claim that was difficult to reconcile with privacy interests.⁴⁴ Most courts interpreted the right to privacy narrowly and held that celebrities either waived their rights of privacy by assuming a prominent and visible place in society or that they

39. *Id.* at 164. Product placement, the practice of manufacturers and merchandisers offering film studios money, supplies of props, or free advertising in exchange for the studios placing the manufacturers’ consumer goods in movies, was developed during this period. The use of celebrity names and faces in advertising tie-ins and product testimonials also returned to widespread use in the 1920s, when the J. Walter Thompson firm began promoting the idea that “advertising messages should be ‘personified’ to take advantage of three basic tendencies in mass society: curiosity about others, the spirit of emulation, and the search for authority.” *Id.*

40. *Id.* at 165.

41. *Id.* at 166.

42. *Id.*

43. *See id.* at 168.

44. *See id.* at 169.

could only recover for “offensive” publicity.⁴⁵ Thus, a celebrity’s asserted injury could not find a remedy under the “right to be let alone,” and the courts effectively barred famous plaintiffs from recovering for unauthorized appropriation on privacy grounds.⁴⁶

C. THE RIGHT OF PUBLICITY

It was not until 1953 that the economic dimension of fame made its distinctive breakthrough as the Second Circuit recognized a right of publicity and gave legal protection to the commodification of personality in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*⁴⁷ In this landmark case, Judge Jerome Frank, writing for the court, held that people, especially those who are famous, have “in addition to and independent of the right to privacy . . . a right in the publicity value of [their] photograph[s].”⁴⁸ He continued:

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, busses, 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.⁴⁹

Judge Frank stated it was “immaterial” whether this right of publicity was labeled a “property” right, but essentially propertized the right by averring that it could be licensed or assigned and enforced against third parties by the licensee or assignee.⁵⁰

A year later, Melville Nimmer urged the widespread adoption of the property-based right of publicity formulated in *Haelan Laboratories* and developed the theoretical underpinnings for this nascent right.⁵¹ He argued that the legal theories available were inadequate to protect the commercial interests celebrities have in their identities, and while “the concept of privacy which Brandeis and Warren evolved fulfilled the demands of

45. *See id.*

46. *See id.*

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

48. *Id.* at 868.

49. *Id.*

50. *Id.*

51. Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

Beacon Street in 1890,” he doubted that the concept “satisfactorily [met] the needs of Broadway and Hollywood in 1954.”⁵² Nimmer grounded his argument on John Locke’s moral principle that individuals are entitled to the fruits of their labor, absent countervailing public policy considerations.⁵³ Nimmer argued that

persons who have long and laboriously nurtured the fruit of publicity values may be deprived of them, unless judicial recognition is given to what is here referred to as the right of publicity—that is, the right of each person to control and profit from the publicity values which he has created or purchased.⁵⁴

Courts were initially reluctant to embrace the new right,⁵⁵ yet the doctrine gradually won widespread judicial and scholarly acceptance, beginning in 1977 with the Supreme Court’s only decision regarding the right of publicity, *Zacchini v. Scripps-Howard Broadcasting Co.*⁵⁶ Along with firmly establishing the right of publicity as an intellectual property right, *Zacchini* was one of the first cases to deal with the conflict between the right and the First Amendment values of free expression, as well as the rationales underlying both rights.⁵⁷

III. PREPARING FOR THE PART: BALANCING THE JUSTIFICATIONS

In formulating a test that resolves the conflict between publicity rights and free expression, it is necessary to balance the interests that these rights protect. This Part therefore presents the theoretical underpinnings of both the right of publicity and the First Amendment.

A. RIGHT OF PUBLICITY JUSTIFICATIONS

The right of publicity advances the societal interests of “fostering creativity, safeguarding the individual’s enjoyment of the fruits of her labors, preventing consumer deception, and preventing unjust enrichment.”⁵⁸ As follows, the main justifications proposed in support of the right of publicity include moral, economic, and consumer protection

52. *Id.*

53. *See id.* at 216.

54. *Id.*

55. *See Madow, supra* note 4, at 176.

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

57. *See infra* Part V.A.

58. Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 54 (1994).

rationales.⁵⁹ These justifications are all subject to criticism, but the right of publicity is itself well established in American jurisprudence and constitutes an important protection for celebrities' interests in their identities.

1. Moral Rationales

The most frequently recognized moral justification for publicity rights concerns Locke's "fruits of labor" theory.⁶⁰ As Nimmer explains, "every person is entitled to the fruit of his labors unless there are important countervailing public policy considerations."⁶¹ Thus, because celebrities work hard and expend "time, effort, skill, and even money"⁶² to create commercially valuable identities, they deserve the rewards gained from using those identities and the right to control what their efforts have created.

Legal scholar Michael Madow, however, rejects the intuitive appeal of the moral theory, stating that there are many variables that contribute to the creation of celebrity.⁶³ He argues that a celebrity's public image is always the product of a complex social process in which the labor of the celebrity—the celebrity's own time, effort, and money—is but one component, and often not the main one.⁶⁴ This is especially true in today's society, where "the production of fame and [celebrity] image has become more organized, centralized, methodical, even 'scientific.'"⁶⁵ Madow further asserts that the public, rather than the star, bears primary responsibility for the creation of a celebrity's image.⁶⁶ Fame, therefore, is a "relational" phenomenon, something that is *conferred by others*⁶⁷ and has as much to do with the audience and the media as it does with the celebrity. Thus, under this view of Locke's theory, both the public and the celebrity deserve to share the fruits of any celebrity-image labor.

59. See Madow, *supra* note 4, at 178–79.

60. See *id.* at 178.

61. Nimmer, *supra* note 51, at 216. See also *supra* notes 53–54 and accompanying text.

62. Nimmer, *supra* note 51, at 216.

63. See Madow, *supra* note 4, at 195.

64. See *id.*

65. *Id.* at 191 ("The work of 'fashioning the star out of the raw material of the person' is done not only by the star herself, but by an army of specialists—consultants, mentors, coaches, advisors, agents, photographers, and publicists." (internal citation omitted)).

66. See *id.* at 193 ("However strenuously the star may fight the intertextuality of his image, however 'scrupulously' he may try to 'monitor' and 'shape' it, the media and the public always play a substantial part in the image-making process.").

67. *Id.* at 188.

The Supreme Court in *Zacchini* articulated another moral rationale as the prevention of “unjust enrichment by the theft of good will.”⁶⁸ In fact, defendants in right of publicity cases are often labeled free riders and are condemned for misappropriating value that others have created and reaping what others have sown.⁶⁹

Yet, critics see this argument as unconvincing, because celebrities often develop their artistic craft or athletic prowess by borrowing from techniques and forms that were created before them. Madow argues that “[c]ultural production is *always* . . . a matter of reworking, recombining, and redeploying already-existing symbolic forms, sounds, narratives, and images.”⁷⁰ Thus, celebrity plaintiffs themselves typically reap what they have not sown,⁷¹ and conversely, right of publicity defendants often do some sowing of their own. Madow explains, “unauthorized commercial appropriators oftentimes *add* something of their own—some humor, artistry, or wit—to whatever they ‘take,’ and their products may service markets different from those that the celebrity herself (or her licensees) chooses to service.”⁷²

2. Economic Rationales

The economic justifications for publicity rights are twofold. The first is that the right of publicity provides incentives for an individual to create a valuable persona.⁷³ Thus, if people cannot fully exploit the value of their identities, they will lack the incentive to “expend the time, effort, and resources necessary to develop talents and produce works that ultimately benefit society as a whole.”⁷⁴ The Supreme Court supported the

68. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (“No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.” (quoting Harry Kalven, Jr., *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966))).

69. Madow, *supra* note 4, at 196.

70. *Id.*

71. *Id.* at 204.

72. *Id.* “This is most evident when the star image is used to create or carry an oppositional meaning, as in the case of the John Wayne and Judy Garland greeting cards . . .” *Id.* The John Wayne greeting card, sold at gay bookstores, featured a picture of John Wayne wearing a cowboy hat and bright red lipstick, with the caption, “It’s such a bitch being butch.” *Id.* at 144. The Judy Garland greeting card, sold by a gay greeting card company, “depict[ed] Garland as Dorothy, in gingham with Toto in a basket, in a gay bar, with her opening line in *Oz* as the message inside.” *Id.* at 195 (internal citation omitted).

73. *See id.* at 206.

74. *Id.* *See also* *Lugosi v. Universal Pictures*, 603 P.2d 425, 441 (Cal. 1979) (Bird, C.J., dissenting) (“[P]roviding legal protection for the economic value in one’s identity against unauthorized

“incentives” rationale in *Zacchini* and recognized that the right of publicity “provides an economic incentive for [a performer] to make the investment required to produce a performance of interest to the public.”⁷⁵ The Court then analogized the incentives rationale to that underlying other intellectual property regimes:

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.⁷⁶

Yet, fame existed long before the right of publicity and no one apparently needed the law’s incentives to develop a valuable persona before this century.⁷⁷ Critics of this rationale argue that this fact suggests that the costs of developing a well-known identity are slight⁷⁸ or that there are numerous economic incentives⁷⁹ and noneconomic motivations, such as desire for fame, power, or success,⁸⁰ to develop a commercially valuable identity independent of the right of publicity. They conclude that absent a right of publicity, there would still be celebrities, and their quality would probably not be any less stellar.⁸¹

commercial exploitation creates a powerful incentive for expending time and resources to develop the skills or achievements prerequisite to public recognition” (internal citation omitted)).

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

76. *Id.* (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)).

77. See Vincent M. de Grandpre, *Understanding the Market for Celebrity: An Economic Analysis of the Right of Publicity*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 73, 103 (2001).

78. See Madow, *supra* note 4, at 179 (“Fame . . . is ‘no sure test of merit.’ . . . [P]lenty of people become famous nowadays through sheer luck, through involvement in public scandal, or through criminal or grossly immoral conduct.”). See also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. c (1995) (“In [some] cases the commercial value acquired by a person’s identity is largely fortuitous or otherwise unrelated to any investment made by the individual . . .”).

79. See Madow, *supra* note 4, at 208–11. The vast majority of right of publicity plaintiffs “generate commercially marketable fame” from fields of endeavor and activities that are themselves “very handsomely compensated.” *Id.* at 209. Thus, celebrities would still make a living without the right of publicity because it protects only a “collateral source of income for athletes, actors, and entertainers.” *Id.* at 209. Furthermore, celebrities would probably still derive income from their publicity values without the right of publicity. *Id.* at 211.

80. See *id.* at 214–15. There are “uniquely powerful noneconomic motivations to excellence and achievement in fields like sports and entertainment.” These incentives include the desire for fame itself, the satisfaction of realizing and exercising one’s talents, the pleasure of winning people’s applause, inspiring their love and awe, earning their respect and gratitude, and the social and status rewards that are unique to the modern celebrity. *Id.* at 214.

81. See de Grandpre, *supra* note 77, at 103 (2001). See also Madow, *supra* note 4, at 211–12. There is a possibility that “in a world without a right of publicity entertainers would . . . be *more*, not

The second economic rationale is the allocative-efficiency argument, which states that the right of publicity promotes more efficient use of scarce resources, that is, the commercial value of celebrity identity, by conferring a property right to the celebrity.⁸² Richard Posner advanced this argument, suggesting, as follows, that publicity rights prevent inefficient overexploitation of celebrity personas:

There is a perfectly good economic reason for assigning the property right in a photograph used for advertising purposes to the photographed individual: this assignment assures that the advertiser to whom the photograph is most valuable will purchase it. Making the photograph the communal property of the advertisers would not achieve this goal. . . . Furthermore, the multiple use of the identical photograph to advertise different products would reduce its advertising value, perhaps to zero.⁸³

The argument continues that by giving celebrities property rights in their identities, they will seek to maximize their value and prevent the devaluation that may come with overexploitation.⁸⁴

Critics, however, have pointed out that not all uses of celebrity identity tire the public, and many uses increase the value and demand for a celebrity persona. Madow asserts that “[i]n merchandising, where faddism and emulation are important forces,” the value of a celebrity’s photograph may increase “just because ‘everybody’s got one.’”⁸⁵ Furthermore, the overexposure argument is based on the false assumption that barriers to use, such as social preferences or trends, do not exist or are insignificant, when in fact these can be the driving forces behind a celebrity’s popularity.⁸⁶ Posner’s argument also fails to take into account the transaction costs inherent in a private property regime and the problem of moral holdout, both of which affect the efficient allocation of celebrity identity resources.⁸⁷

less, active and productive.” *Id.* at 212. Celebrities might “increas[e] their level of performance and creation (and hence direct income) in order to make up for the lost collateral income.” *Id.* at 211.

82. See Madow, *supra* note 4, at 220–21.

83. Richard A. Posner, *The Right of Privacy*, 12 GA. L. REV. 393, 411 (1978). See Madow, *supra* note 4, at 221.

84. See Madow, *supra* note 4, at 220–21.

85. See *id.* at 221–22. For example, “A Madonna T-shirt may be worth *more*, not less, to consumers precisely because millions of her fans are already wearing them. The value of the T-shirt may be greater just because ‘everybody’s got one.’” *Id.* at 222. The marketing of T-shirts may also increase the demand for other types of celebrity merchandise, like posters, buttons, and similar paraphernalia. *Id.* If this is the case, “then the way to maximize economic value is to make the merchandise available to any and every one who is willing to pay the marginal cost of its production.” *Id.*

86. See *id.* at 220 n.442.

87. See de Grandpre, *supra* note 77, at 109–12; Madow, *supra* note 4, at 223–25.

3. Consumer Protection

The consumer protection justification for the right of publicity is that publicity rights protect consumers from being misled about a celebrity's willingness to be associated with a product or service.⁸⁸ This rationale aims to protect consumers from the likelihood of confusion when an advertiser appropriates a celebrity likeness in a way that creates a false or misleading impression that the celebrity is endorsing the product.

Critics attack this rationale on the ground that it is overinclusive because publicity rights apply even absent a danger that consumers will be misled into believing that there is an association of, or endorsement by, the celebrity of a particular product.⁸⁹ Critics also point out that, to the extent the right of publicity protects consumers from being deceived, the protection is, for the most part, redundant.⁹⁰ In situations where a celebrity's name or likeness is used to deceive or mislead the public, the Lanham Act,⁹¹ or a state law equivalent, can provide the celebrity with appropriate relief. Furthermore, this rationale rests on the assumption that the average consumer infers that celebrities authorize every ad or product featuring their pictures.⁹² This, however, is not at all clear as an empirical matter, and it is possible that today's savvy consumers may infer just the opposite in the case of celebrity merchandise without official labels.⁹³

B. FIRST AMENDMENT JUSTIFICATIONS

In balancing publicity and First Amendment rights, it is also necessary to consider that First Amendment guarantees of free speech serve two important purposes: first, they advance knowledge and the search for truth by fostering a free marketplace of ideas and an "uninhibited, robust, wide-open debate on public issues," and second, they fulfill the human need for self-expression and self-realization.⁹⁴ Justice Thurgood Marshall elaborated on this personhood rationale as follows:

88. James M. Treece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV. 637, 647 (1973).

89. Madow, *supra* note 4, at 231–32.

90. *Id.* at 233.

91. 15 U.S.C. §§ 1051–1127 (2000).

92. *See* Madow, *supra* note 4, at 235.

93. *See id.*

94. Kwall, *supra* note 58, at 65–66. *See also* Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454, 458 (Cal. 1979) (Bird, C.J., concurring) ("The First Amendment . . . serve[s] 'to preserve an uninhibited marketplace of ideas' and to repel efforts to limit the 'uninhibited, robust and wide-open debate on public issues.' . . . Free speech is also guaranteed because of our fundamental respect for individual development and self-realization." (internal quotations and citations omitted)).

The First Amendment serves not only the needs of the polity but also those of the human spirit—a spirit that demands self-expression. Such expression is an integral part of the development of ideas and a sense of identity. To suppress expression is to reject the basic human desire for recognition and affront the individual's worth and dignity.⁹⁵

To achieve these First Amendment goals, the Supreme Court has held that entertainment is entitled to the same constitutional protection as the exposition of ideas. As the Court explains, “The line between the informing and the entertaining is too elusive for the protection of [this] basic right. . . . What is one man's amusement, teaches another's doctrine.”⁹⁶ Furthermore, the Court has explicitly established that all different art forms used for human expression are constitutionally protected, stating, “The actor on stage or screen, the artist whose creation is in oil or clay or marble, the poet whose reading public may be practically nonexistent, the musician and his musical scores . . . are [all] beneficiaries of freedom of expression.”⁹⁷

The right of publicity, however, has a potential for frustrating both of these First Amendment purposes. In our society, celebrities take on both public and personal meanings,⁹⁸ and thus, it is vitally important for the public to be able to speak freely about and creatively use celebrity personas to advance an uninhibited, robust debate on public issues and individual expression. As Madow comments,

Entertainment and sports celebrities are the leading players in our Public Drama. We tell tales, both tall and cautionary, about them. We monitor their comings and goings, their missteps and heartbreaks. We copy their mannerisms, their styles, their modes of conversation and consumption. Whether or not celebrities are “the chief agents of moral change in the United States,” they certainly are widely used—far more than are institutionally anchored elites—to symbolize individual aspirations, group identities, and cultural values. Their images are thus important expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our cultural business and everyday conversation.⁹⁹

95. *Procurier v. Martinez*, 416 U.S. 396, 427 (1974) (Marshall, J., concurring).

96. *Winters v. New York*, 333 U.S. 507, 510 (1948). *See also* *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578 (1977) (“There is no doubt that entertainment, as well as news, enjoys First Amendment protection.”).

97. *Poe v. Ullman*, 367 U.S. 497, 514 (1961).

98. *See* Madow, *supra* note 4, at 136–47.

99. *Id.* at 128. *See* SCHICKEL, *supra* note 13, at 29 (stating that “celebrities have become, in recent decades, the chief agents of moral change”).

If the right of publicity were to allow celebrities to control the use of their identities in *expressive* works, it would grant them the broad power to suppress certain ideas and meanings associated with their identities, impeding not only the creative process, but also the public's ability to express itself.¹⁰⁰ Thus, in formulating a test to resolve this tension, one must balance the rationales supporting the First Amendment against the justifications supporting the right of publicity.

IV. TO BE OR NOT TO BE EXPRESSIVE SPEECH

The First Amendment safeguards the freedoms of speech and expression in our society. Within the sphere of protected speech, the Supreme Court has distinguished between expressive and commercial speech.¹⁰¹ The First Amendment fully protects expressive speech, including political speech, news and matters of public interest, parodies, fictional works, artistic expression, and cultural expression and recoding.¹⁰² Yet, the Constitution affords less First Amendment protection to commercial speech¹⁰³—"speech that does 'no more than propose a commercial transaction'"¹⁰⁴—and offers no protection for false or misleading commercial speech.¹⁰⁵ Thus, the right of publicity will often trump the right of advertisers to make use of celebrity images. Beyond this, however, the line between expressive and commercial speech is far from clear. By way of guidance, courts have held that expressive works are not transformed into commercial speech merely because they are made for financial gain.¹⁰⁶ The First Amendment, therefore, is not limited to those who publish without charge and an expressive activity does not lose its constitutional protection merely because it is undertaken for a profit.¹⁰⁷

Yet, the fact that a lot of expressive speech contains commercial elements adds to courts' confusion in attempting to resolve the conflict between the right of publicity and the First Amendment. Adding to the difficulty is the vast array of expressive speech types and mediums for

100. See Madow, *supra* note 4, at 138.

101. See *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 563 (1980).

102. See *infra* notes 130–32 and accompanying text.

103. *Cent. Hudson*, 447 U.S. at 563.

104. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council*, 425 U.S. 748, 771–72 n.24 (1976) (quoting *Pittsburgh Press Co. v. Human Relations Comm'n*, 413 U.S. 376, 385 (1973)).

105. See *Cent. Hudson*, 447 U.S. at 563–64.

106. See *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 459 (Cal. 1979).

107. *Id.* at 459–60 (citing *Time, Inc. v. Hill*, 385 U.S. 374, 397 (1967); *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 502 (1952)).

conveying the message that are fully protected under the First Amendment's guarantee of free speech. When it comes to the right of publicity, however, judicial opinion shows that not all expression is protected equally. Thus, courts have developed and employ a variety of balancing techniques to draw a fine line and decide what is protected by the First Amendment in speech that contains both expressive and commercial elements.¹⁰⁸ The judicial approach differs when dealing with political speech, news or publications on matters of public interest, parodies, fictional works, artistic expression, and cultural expression or recoding.

Political speech is regarded as the core of constitutionally protected speech and as embodied in other expressive works tends to be fully protected by the First Amendment against right of publicity claims.¹⁰⁹

The Supreme Court has held that the First Amendment provides an absolute defense to publication-based tort actions for publications on matters of public interest, except for statements published with malice—knowing or reckless falsehood.¹¹⁰ Following the Supreme Court, many courts have provided a similar,¹¹¹ *almost* absolute defense to news and publications on matters of public interest in right of publicity actions.¹¹² This broad defense is referred to as the “newsworthy exception”¹¹³ and generally shields media defendants from right of publicity claims, with one

108. See *infra* Part V.

109. See *Paulsen v. Personality Posters, Inc.*, 299 N.Y.S.2d 501 (N.Y. Sup. Ct. 1968) (holding that an unauthorized “For President” poster with a picture of a comedian, who claimed to have entered the presidential race, was protected by the First Amendment because the publicity plaintiff had thrust himself into the political arena, which made him fair game for almost any kind of public comment, even though the comedian made the statement as a joke).

110. See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974) (discussing defamation); *Time, Inc. v. Hill*, 385 U.S. 374 (1967) (discussing false light invasion of privacy action); *N.Y. Times Co. v. Sullivan*, 376 U.S. 254 (1964) (discussing defamation).

111. The defense is similar, but the “malice” test is not applied in right of publicity actions. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 571–74 (1977). The Supreme Court distinguished, at length, the reputational and privacy interests involved in defamation and false light invasion of privacy claims from the economic and property interests at stake in right of publicity actions. These important differences and the fact that the Court did not apply the “malice” test imply that the analysis is inappropriate in right of publicity actions. See also *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 52 (1988) (confirming this interpretation of *Zacchini* by stating that “the ‘actual malice’ standard does not apply to the tort of appropriation of a right of publicity”).

112. See *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1189 (9th Cir. 2001) (holding that a magazine article featuring a digitally altered picture from the film *Tootsie*, showing Dustin Hoffman wearing a current Richard Tyler dress, was a matter of public interest and was, thus, protected by the First Amendment). *But see* *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 727 (S.D.N.Y. 1978) (holding that a magazine cartoon depicting a nude likeness of Ali was not “news” because the cartoon itself had no “newsworthy dimension”).

113. See *infra* Part V.B.

aberrant limitation being the “entire act” standard articulated in *Zacchini*.¹¹⁴

Following the Supreme Court’s holding in *Hustler Magazine v. Falwell*,¹¹⁵ courts routinely have held that parodies are protected by the First Amendment against right of publicity claims.¹¹⁶ The Tenth Circuit, in *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, held, in a publicity action, that parodies of baseball trading cards were protected by the First Amendment and stated that “parody, both as social criticism and a means of self-expression, is a vital commodity in the marketplace of ideas.”¹¹⁷ Furthermore, the court stated, “Parodies of celebrities are an especially valuable means of expression because of the role celebrities play in modern society.”¹¹⁸ One commentator has also noted that parodies are constitutionally protected against publicity claims even if they do not relate to a matter of public interest.¹¹⁹ Thus, they are protected as a valuable means of expression separate and distinct from the newsworthy exception.

Many courts have held that fictionalized stories that use a plaintiff’s identity receive First Amendment protection against a right of publicity claim.¹²⁰ For example, a made-for-television fictionalized version of Rudolph Valentino’s life¹²¹ and a film portraying a boy character named “Squints’ Palledorous,” who resembled the plaintiff, Michael Polydoros, when he was a child,¹²² were both constitutionally protected. In the first case, Chief Justice Bird stated,

114. *Zacchini*, 433 U.S. at 564. The Supreme Court held that a local television station’s broadcast of a performer’s “entire act” posed such a threat to the economic value of his performance that his right of publicity trumped the station’s First Amendment rights. For a more thorough discussion of the entire act standard, see *infra* Part V.A.

115. See *Hustler*, 485 U.S. at 56–57 (holding that a highly offensive cartoon of a public figure was a parody and, thus, was protected by the First Amendment against an intentional infliction of emotional distress claim). See also Schuyler M. Moore, *Putting the Brakes on the Right of Publicity*, 9 UCLA ENT. L. REV. 45, 52 (2001) (“Although the [*Hustler*] decision dealt with an action for intentional infliction of emotional distress, the result would have to be the same for a right of publicity action, or the decision would be toothless.”).

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

117. *Id.* at 972.

118. *Id.* (“Because celebrities are an important part of our public vocabulary, a parody of a celebrity does not merely lampoon the celebrity, but exposes the weakness of the idea or value that the celebrity symbolizes in society.”).

119. See Moore, *supra* note 9, at 5 (citing *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001)).

120. See *id.* at 4 n.7 (citing examples of fictionalized stories protected by the First Amendment from right of publicity actions).

121. See *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 454 (Cal. 1979).

122. See *Polydoros v. Twentieth Century Fox Film Corp.*, 79 Cal. Rptr. 2d 207, 208 (Ct. App. 1997).

It is clear that works of fiction are constitutionally protected in the same manner as political treatises and topical news stories. Using fiction as a vehicle, commentaries on our values, habits, customs, laws, prejudices, justice, heritage and future are frequently expressed. . . . Even the author who creates distracting tales for amusement is entitled to constitutional protection.¹²³

Artistic expression has been held to receive full First Amendment protection as a mode of self-expression and self-realization. As the Second Circuit held, “Visual art is as wide ranging in its depiction of ideas, concepts and emotions as any book, treatise, pamphlet or other writing, and is similarly entitled to full First Amendment protection.”¹²⁴ The Supreme Court has also made it clear that a work of art receives full constitutional protection, even if it conveys no discernable message.¹²⁵ Courts, however, have had differing opinions on the strength of the First Amendment defense for artistic expression in publicity cases. A few tests have emerged, the two most prominent being the transformative test¹²⁶ and the predominant use test.¹²⁷ Differing applications of the defense usually center around the medium for the artistic message, even though the California Supreme Court has stated that the fact that art appears on a less conventional avenue of communication, such as a T-shirt, does not result in reduced First Amendment protection.¹²⁸ The First Amendment, therefore, does not disfavor nontraditional mediums of expression in principle, but the commercial or merchandising aspects can cause confusion for the courts in right of publicity actions.¹²⁹

123. *Guglielmi*, 603 P.2d at 459 (Bird, C.J., concurring) (internal footnote omitted).

124. *Bery v. City of New York*, 97 F.3d 689, 695 (2d Cir. 1996) (finding that an ordinance that required visual artists to obtain licenses to sell their works in public places, but did not require the vendors of books, newspapers, and other written materials to obtain licenses was unconstitutional, and stating that the ordinance “overlooks case law central to First Amendment jurisprudence [and] fundamentally misperceives the essence of visual communication and artistic expression”).

125. *See Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 804 (Cal. 2001) (“[A] narrow, succinctly articulable message is not a condition of constitutional protection, which if confined to expressions conveying a ‘particularized message,’ would never reach the unquestionably shielded painting of Jackson Pollack, music of Arnold Schoenberg, or Jabberwocky verse of Lewis Carroll.” (quoting *Hurley v. Irish-Am. Gay, Lesbian and Bisexual Group of Boston, Inc.*, 515 U.S. 557, 569 (1995))).

126. *See infra* Part V.D.

127. *See infra* Part V.E.

128. *Comedy III*, 21 P.3d at 804 (“As Judge Posner stated in the case of a defendant who sold T-shirts advocating the legalization of marijuana, ‘its T-shirts . . . are to [the seller] what the *New York Times* is to the Sulzbergers and the Ochs—the vehicle of her ideas and opinions.’” (quoting *Ayres v. City of Chicago*, 125 F.3d 1010, 1017 (7th Cir. 1997))).

129. *See, e.g., id.*

Cultural language and recoding can be embodied in any of the expressive speech types discussed above. Cultural expression encompasses the idea that in today's society, individuals and groups—ethnic, racial, gender, and class, for example—create and derive different meanings from celebrity images, and they must be free to manipulate, rework, and recode those images in order to achieve self-expression and self-affirmation.¹³⁰ The process of recoding, in which the public reconstructs meaning, is one of “bricolage,” meaning the appropriation of materials in existence to create something new.¹³¹ This process is particularly important for individuals and groups who, for cultural, social, or sexual reasons, are not aligned with the dominant cultural ideology, and thus use celebrity images to express a meaning that differs from the meaning intended or preferred by the images' producers.¹³² The First Amendment fully protects cultural expression and recoding and does not disfavor nontraditional mediums of expression. But courts tend to afford the defense less weight in right of publicity actions because this type of expression is usually conveyed through merchandise mediums, which can be seen as more commercial.¹³³

Scholars have responded with harsh criticism. Madow, for example, argues that through this approach, “publicity rights facilitate private censorship of popular culture,”¹³⁴ because a lot of cultural expression—and thus, the public's ability to fully express and communicate a sense of self¹³⁵—is constricted in affording merchandise less protection. Jane Gaines adds that the public's right to free speech really takes a hit because bulk-manufactured goods, such as T-shirts, are often “the cheapest to manufacture and the easiest for people's movements to use.”¹³⁶

130. See Madow, *supra* note 4, at 139.

131. See Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 432 n.201 (1999).

132. See *id.* at 432; Madow, *supra* note 4, at 139. See also *supra* note 72 and accompanying text (discussing the oppositional cultural recodings expressed in the John Wayne and Judy Garland greeting cards).

133. See Haemmerli, *supra* note 131, at 432; Madow, *supra* note 4, at 143–46.

134. Madow, *supra* note 4, at 138. Madow also argues that “by centralizing this meaning-making power in the celebrity herself or her assignees, the right . . . facilitates top-down management of popular culture and constricts the space available for alternative and oppositional cultural practice.” *Id.* at 134.

135. *Id.* at 143. Madow argues that people need celebrity paraphernalia to fully express their senses of self:

It is not just the members of marginalized groups, however, who draw on the celebrity image bank to define and identify themselves, or to express their sense of themselves and their particular experience of the world. Everyone from the President on down does it . . . often through the consumption and display of celebrity paraphernalia: T-shirts, posters, greeting cards, etc.

Id.

136. JANE M. GAINES, *CONTESTED CULTURE: THE IMAGE, THE VOICE AND THE LAW* 202 (1991).

Gary Ho argues that a preference for media “traditionally” protected by the First Amendment arguably excludes all “consumer products” from the category of expressive speech, while it may do more than propose a commercial transaction.¹³⁷ He explains that “the medium presumption oversimplifies the problem by focusing on the medium, rather than the content—messages and purposes—behind it. As a result, it violates the literal definition of commercial speech by deeming speech to be commercial even if [it] do[es] more than propose a commercial transaction.”¹³⁸

Thus, the First Amendment fully protects all expressive speech and mediums of expression, and while commercial speech receives less protection,¹³⁹ it is protected nonetheless. But despite valiant efforts, courts have yet to resolve the tension between the individual’s property interest and society’s interest in free expression.

V. THE RAW TALENT: OTHER TESTS COMPETING FOR THE LEAD

This Note will now examine the various approaches courts have taken in trying to adequately balance publicity rights with free expression. This analysis will show that the current lack of a “principled and consistent method” of resolving the conflict between the right of publicity and the First Amendment has resulted in “massive confusion” among the courts.¹⁴⁰

A. THE *ZACCHINI* DECISION: THE ENTIRE ACT STANDARD

The Supreme Court’s sole decision regarding the right of publicity dealt with the tension between publicity rights and the First Amendment. The unique factual setting of the case, however, has created uncertainty in articulating a standard applicable in other right of publicity actions and has led some courts to virtually ignore *Zacchini* when evaluating First Amendment defenses to publicity claims.¹⁴¹

Zacchini involved a performer’s right of publicity claim against a local television station that broadcasted his entire fifteen-second human

137. Chia Heng (Gary) Ho, Note, *Hoffman v. Capital Cities/ABC, Inc.*, 17 BERKELEY TECH. L.J. 527, 544–45 (2002).

138. *Id.* at 545.

139. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 563 (1980).

140. Kwall, *supra* note 58, at 47–48.

141. *See Lee, supra* note 8, at 491.

cannonball act on the evening news without his permission.¹⁴² The Ohio Supreme Court held that the defendant television station had a First Amendment privilege to broadcast newsworthy material.¹⁴³ The Supreme Court reversed, holding that the broadcast of Zacchini's "entire act" posed such a substantial threat to the economic value of his performance that his right of publicity in this case trumped the station's First Amendment rights.¹⁴⁴ The Court emphasized Zacchini's proprietary interest in his act, stating, "The Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner."¹⁴⁵

The *Zacchini* Court, however, had trouble formulating a standard that could be applied universally to First Amendment defenses in publicity actions, and instead decided only the case before it, stating, "Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent."¹⁴⁶ The Court did recognize that this may be the strongest case for the right of publicity because it involves "not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place."¹⁴⁷

Justice Powell's dissent, in addition to displaying that he was irritated by the majority's "repeated incantation of a single formula: 'a performer's entire act,'"¹⁴⁸ also questioned whether the standard was clear enough to decide even the case at hand.¹⁴⁹ He also argued that the "entire act"

142. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 563-64 (1977).

143. *Id.*

144. *Id.*

145. *Id.* at 575.

146. *Id.* at 574-75.

147. *Id.* at 576.

148. *Id.* at 579 (Powell, J., dissenting). In only sixteen pages, the majority opinion refers to Zacchini's "entire act," or a slight variation of that phrase, twelve times. *Id.* at 563-79.

149. *Id.* at 579 n.1. Justice Powell questioned whether Zacchini's "entire act" was only fifteen seconds in duration. He assumed that the actual firing of the cannon was most likely preceded by some fanfare, an introduction of the performer, description of the danger, last-minute check of the equipment, and entry into the cannon. These elements were probably part of the act, as well, so the station could not have appropriated the "entire act" in its fifteen second news clip. Therefore, Justice Powell argued that the majority standard could not even explain the Court's decision in the case at hand. *Id.*

standard had little, if any, precedential value for other publicity cases.¹⁵⁰ As it turns out, his prophecy, thus far, has been correct, and no other First Amendment publicity case has been decided based on the “entire act” standard.

B. NEWSWORTHY EXCEPTION

In *Zacchini*, the Supreme Court recognized that the performer’s right of publicity would not serve to prevent the television station from reporting newsworthy facts about *Zacchini*’s act.¹⁵¹ The Court also recognized that both entertainment and news were protected by the First Amendment and that “entertainment itself can be important news.”¹⁵² Thus, many courts interpret the *Zacchini* Court as advocating a newsworthy or matter-of-public-interest exception to the right of publicity, but the defendant television station, in appropriating the performer’s “entire act,” went beyond the protection of the exception.¹⁵³

Justice Powell contended that the majority’s holding that the station’s ordinary news report was not encompassed by the newsworthy exception “could lead to a degree of media self-censorship.”¹⁵⁴ He argued that the First Amendment requires that the analysis begin not with a quantitative assessment of the performer’s act, but with an inquiry into the defendant’s use.¹⁵⁵ He would have held all uses of publicity rights in news broadcasts as privileged absent a “strong showing by the plaintiff that the news broadcast was a subterfuge or cover for private or commercial exploitation.”¹⁵⁶

Most cases raising the newsworthy defense to a publicity claim, in fact, have used a broad standard closer to Justice Powell’s than to the *Zacchini* Court’s majority opinion. Still, the newsworthy exception has led to inconsistent results when applied by courts. For example, in *Ali v. Playgirl, Inc.*, a nude drawing that resembled Muhammad Ali entitled “Mystery Man,” with a reference to “the Greatest” in a side caption, was found not to be newsworthy.¹⁵⁷ The court held that there was “no such informational or newsworthy dimension to defendants’ unauthorized use of

150. *See id.* at 579.

151. *See id.* at 574 (majority opinion).

152. *Id.* at 578.

153. *Id.* at 576.

154. *Id.* at 580 (Powell, J., dissenting).

155. *Id.* at 581.

156. *Id.*

157. *See Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 727 (S.D.N.Y. 1978).

Ali's likeness."¹⁵⁸ Yet, in *Ann-Margret v. High Society Magazine*, a partially nude photograph of Ann-Margret was found to be newsworthy.¹⁵⁹ The court held that the photograph was, "a matter of great interest to many people" because it was from a film she had appeared in, and it stated, "the scope of what constitutes a newsworthy event has been afforded a broad definition and held to include even matters of 'entertainment and amusement, concerning interesting phases of human activity in general.'"¹⁶⁰ Furthermore, Pamela Samuelson asserts that courts apply the exception as an "excuse" for appropriating a celebrity's persona, and those who rely on the exception in deciding a case seem to announce their conclusions rather than to persuasively reason their way to them.¹⁶¹ The exception, therefore, lacks an established framework for deciding what is newsworthy and provides little guidance outside the realm of media defendants.

C. FAIR USE

Several commentators have advocated the employment of a modified version of copyright's fair use test¹⁶² for analyzing First Amendment claims in right of publicity cases.¹⁶³ Samuelson¹⁶⁴ and Alice Haemmerli¹⁶⁵ urge the application of a two-tiered fair use test. Samuelson's analysis is based on the broader interpretation of *Zacchini*'s holding used in copyright cases, which states that First Amendment protection should be restricted when "substantial property interests of the plaintiff have been interfered with or appropriated."¹⁶⁶ Thus, under her analysis, the first step would be to assess the substantiality of the property interest¹⁶⁷ being appropriated by balancing the four modified fair use factors: (1) the purpose and character of the defendant's use of the publicity right, including whether the primary purpose of the use is commercial or nonprofit, and whether the defendant's use is transformative or acts as a substitute for the plaintiff; (2) the nature of the publicity right affected; (3) the amount and substantiality of the appropriation of the defendant—whether there has been a "wholesale

158. *Id.*

159. *Ann-Margret v. High Soc'y Magazine, Inc.*, 498 F. Supp. 401, 405 (S.D.N.Y. 1980).

160. *Id.*

161. Pamela Samuelson, *Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 TUL. L. REV. 836, 863–64 (1983).

162. 17 U.S.C. § 107 (2000).

163. See Haemmerli, *supra* note 131, at 465–66; Samuelson, *supra* note 161, at 915.

164. See Samuelson, *supra* note 161, at 915–23.

165. See Haemmerli, *supra* note 131, at 464–73.

166. Samuelson, *supra* note 161, at 877.

167. *Id.* at 915.

appropriation” of identity; and (4) the impact on the market value of the plaintiff’s identity—whether it impacts a celebrity’s primary occupation or a collateral activity.¹⁶⁸

If fair use is not found using this test, Samuelson suggests that the next step would be to ask whether “access to the protected matter [is] necessary to achieve the dissemination of information and public debate objectives which underlie the [F]irst [A]mendment.”¹⁶⁹ Haemmerli would expand on this question to ask whether “access is necessary as a matter of artistic expression to permit individuals and groups to ‘play with’ meaning and to come up with new ways of recoding cultural icons, or whether these needs can be satisfactorily fulfilled in alternative ways without invading conflicting property rights.”¹⁷⁰ Stated more succinctly, “Is the use necessary to achieve the public information, public discourse, or self-realization goals that underlie the First Amendment?”¹⁷¹

The two-tiered fair use test seems to be more tailored to analyzing right of publicity cases, because the second step addresses the goals of the First Amendment to more effectively balance the public’s right of free expression and celebrities’ property rights in their identities. But the courts have yet to fully adopt a fair use standard in right of publicity cases¹⁷² and the application outside copyright is usually met with criticism. For example, Roberta Rosenthal Kwall argues that fair use is an unsatisfactory method for resolving the tension between publicity rights and the First Amendment, because the test was formulated for copyright law and, thus, fails to address two fundamental rationales for the right of publicity: unjust enrichment and consumer protection.¹⁷³ Mark Lee asserts that attempts to apply fair use to the right of publicity can best be characterized as noble failures because the factors do not lend themselves to publicity actions,¹⁷⁴

168. *Id.* at 915–16; Haemmerli, *supra* note 131, at 469–70.

169. Samuelson, *supra* note 161, at 916.

170. Haemmerli, *supra* note 131, at 471. In other words, the question should be “whether freedom to exploit commercially is necessary to expressive needs.” *Id.*

171. *Id.* at 473.

172. *See, e.g.,* Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981). In *Estate of Presley v. Russen*, the court did not engage in a fair use analysis but suggested that “[t]he doctrine of fair use may provide guidance as to what types of uses of a name or likeness should be allowed” in First Amendment publicity actions. *Id.* at 1358 n.18. The court implied that no fair use could be found and held that an Elvis Presley impersonator’s attempt to duplicate the live performance of the King was a violation of Presley’s right of publicity and was not protected speech under the First Amendment. *Id.*

173. Kwall, *supra* note 58, at 58–63.

174. Lee, *supra* note 8, at 492.

and furthermore, the fair use test as applied to copyright has been widely criticized.¹⁷⁵

D. TRANSFORMATIVE TEST

Despite these criticisms, in 2001, the California Supreme Court in *Comedy III Productions, Inc. v. Saderup, Inc.*¹⁷⁶ adopted the first fair use factor—“the purpose and character of the use”¹⁷⁷—as its test in “balancing” a First Amendment defense against a right of publicity claim.¹⁷⁸ The court held that Saderup’s charcoal drawing of the Three Stooges, as reproduced on T-shirts and in lithograph prints, was not sufficiently “transformative” and, thus, did not receive First Amendment protection in a publicity claim.¹⁷⁹ The court emphasized that art and entertainment receive full constitutional protection¹⁸⁰ and that expressive works embodied in less conventional mediums of communication, such as lithographs and T-shirts, are not “commercial speech,” even though they are sold commercially.¹⁸¹

The court, however, concluded that the First Amendment defense is only available for works that are “transformative.” “Transformative” is defined at various times throughout the opinion as a work that (1) “adds something new, with a further purpose or different character, altering the first with new expression, meaning or message”;¹⁸² (2) adds “significant expression beyond” the “literal depiction or imitation of a celebrity for commercial gain”;¹⁸³ (3) uses the celebrity likeness as “one of the ‘raw materials’ from which an original work is synthesized,” as opposed to using “the depiction or imitation of the celebrity [as] the very sum and substance of the work”;¹⁸⁴ (4) “is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s

175. See *id.* at 482. The fair use test, as applied to copyright, is “[c]haracterized by one court as ‘so flexible as virtually to defy definition,’” and “an appellate judge famously described copyright’s fair use doctrine as ‘the most troublesome in the whole law of copyright,’ while a leading copyright commentator characterized fair use as a ‘most obscure doctrine.’” *Id.* (internal footnotes omitted).

176. *Comedy III Prods., Inc. v. Saderup, Inc.*, 21 P.3d 797 (Cal. 2001).

177. 17 U.S.C. § 107(1) (2000).

178. *Comedy III*, 21 P.3d at 808.

179. *Id.* at 810–11.

180. *Id.* at 804.

181. *Id.* at 802, 804.

182. *Id.* at 808 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)).

183. *Id.* at 808.

184. *Id.* at 809.

likeness”;¹⁸⁵ (5) involves “creative elements predominating the work,” rather than “the literal or imitative”;¹⁸⁶ (6) has value due principally to “some source other than the fame of the celebrity,” such as “from the creativity, skill, and reputation of the artist”;¹⁸⁷ and (7) involves the artist “contributing something more than a ‘merely trivial’ variation, [and creating] something recognizably ‘his own.’”¹⁸⁸ Saderup’s drawings did not meet this fragmented “transformative” test because the “artist’s skill and talent [was] manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame.”¹⁸⁹

Many scholars have deemed the transformative test “unworkable”¹⁹⁰ because of the difficulties with interpretation and application. Eugene Volokh notes that one definition the court uses—“contributing something more than a ‘merely trivial’ variation, [and creating] something recognizably ‘[the artist’s] own’”—is borrowed from a case defining the standard for copyrightability in works derived from public domain works¹⁹¹ and is therefore much easier to satisfy than other definitions.¹⁹² For example, “add[ing] something new, with further purpose or different character, altering the first with new expression, meaning or message,” which is a borrowed definition of the fair use of a work,¹⁹³ seems to imply that even substantial additions are not enough if they do not make a comment on the original.¹⁹⁴

The lack of one clear definition is not the transformative test’s only flaw. In addition, the test has proven to be extremely vague, as the widely inconsistent holdings of courts that have applied it demonstrate. This is problematic because a vague standard significantly chills free expression—if the public does not know what constitutes a constitutionally protected “transformative” use, they will err on the side of caution to avoid possible

185. *Id.* (defining the term “expression” to mean “expression of something other than the likeness of the celebrity”).

186. *Id.*

187. *Id.* at 810.

188. *Id.* (quoting *L. Baitlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976)).

189. *Id.* at 810.

190. *See, e.g., Lee, supra* note 8, at 492–93; Moore, *supra* note 9, at 5; Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903, 915–25 (2003).

191. *Comedy III*, 21 P.3d at 810 (quoting *L. Baitlin & Son*, 536 F.2d at 490).

192. Volokh, *supra* note 190, at 916–17.

193. *Comedy III*, 21 P.3d at 808 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)).

194. Volokh, *supra* note 190, at 916–17.

litigation.¹⁹⁵ The vagueness of the test was shown in the *Comedy III* opinion itself, when the California Supreme Court stated that Andy Warhol's silkscreens of Marilyn Monroe and Elvis Presley would be protected by the First Amendment as "transformative" works because "through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself."¹⁹⁶ Yet, the court could discern no significant transformative or creative contribution in Saderup's charcoal drawing.¹⁹⁷

To add to this inconsistency, the Sixth Circuit held that Rick Rush's painting, *The Masters of Augusta*, commemorating Tiger Wood's victory and depicting him in various poses with the likenesses of famous golfers of the past gazing down on him, was transformative.¹⁹⁸ The court found that the work did "not capitalize solely on a literal depiction of Woods," but combined a collage of images "to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods' achievement in that event."¹⁹⁹ Thus, since Rush "added a significant creative component of his own to Woods's identity," the work received full First Amendment protection that trumped Woods's right of publicity claim.²⁰⁰

The recent California Supreme Court decision in *Winter v. D.C. Comics*²⁰¹ demonstrates that a vague standard causes problems in even simple transformative use cases.²⁰² The court held that the First Amendment protected D.C. Comics against a right of publicity claim brought by Johnny and Edgar Winter, well-known musicians, based on a comic book series that incorporated the Winter brothers as the characters "Johnny and Edgar Autumn," villainous half-worm, half-human creatures with pale faces and long, white hair.²⁰³ Finding the characters transformative, the court stated, "We can readily ascertain that they are not just conventional depictions of plaintiffs but contain significant expressive

195. *See id.* at 917–18.

196. *Comedy III*, 21 P.3d at 811.

197. *Id.*

198. *See ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 938 (6th Cir. 2003).

199. *Id.*

200. *Id.*

201. *Winter v. D.C. Comics*, 69 P.3d 473 (Cal. 2003).

202. *Id.* at 479. The California Supreme Court began its analysis with the statement, "Application of the test to this case is not difficult." *Id.*

203. *Id.* at 476, 479.

content other than plaintiffs' mere likenesses."²⁰⁴ The California Supreme Court unanimously reversed the court of appeal's decision, which found that there had been a jury question as to the transformative nature of the characters.²⁰⁵ The mere fact that the court of appeal's panel made this error illustrates the difficulties the indefiniteness of the transformative standard causes.

These comparisons also illustrate how the court's lack of clear guidelines encourages judges to be art critics or to base decisions on value judgments or external factors such as fame of the artist. As Justice Holmes warned in *Bleistein v. Donaldson Lithographing Co.*, "It 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."²⁰⁶

Furthermore, Schuyler Moore complains that "there is absolutely no logic for protecting 'transformative' works while not protecting 'non-transformative' works. What exactly is the First Amendment rationale justifying protecting the former but not the latter?"²⁰⁷ Another critic queries, "What's so bad about non-transformative uses? . . . Why should [they] be treated worse than transformative ones?"²⁰⁸ The California Supreme Court, however, did not view the test as expressing a value judgment or preference for one type of depiction over another.²⁰⁹ In deciding to protect only transformative uses, the court assumed that celebrities would create or license nontransformative uses themselves, so the court was "concerned not with whether conventional celebrity images should be produced but with who produces them and, more pertinently, who appropriates the value from their production."²¹⁰ But not all nontransformative "conventional celebrity images" are "mutually interchangeable," and celebrities may not license the images that consumers desire.²¹¹ Thus, even if the right of publicity prohibits only

204. *Id.* ("Although the fictional characters Johnny and Edgar Autumn are less-than-subtle evocations of Johnny and Edgar Winter, the books do not depict the plaintiffs literally. . . . To the extent the drawings of the Autumn brothers resemble plaintiffs at all, they are distorted for purposes of lampoon, parody, or caricature.").

205. *See* *Winter v. D.C. Comics*, 121 Cal. Rptr. 2d 431 (Ct. App. 2002), *rev'd*, 69 P.3d 473 (Cal. 2003).

206. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

207. Moore, *supra* note 9, at 6.

208. Volokh, *supra* note 190, at 923.

209. *Comedy III Prods., Inc. v. Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001).

210. *Id.*

211. Volokh, *supra* note 190, at 923–24. Volokh argues:

nontransformative uses of identity, the range of artistic expression provided for creation and available for purchase is greatly diminished.²¹²

E. PREDOMINANT USE TEST

In 2003, the Supreme Court of Missouri, in rejecting California's transformative test, introduced the predominant use test in *Doe v. TCI Cablevision* as a "more balanced balancing test" that better addresses cases in which speech is both expressive and commercial.²¹³ The test, as articulated by the court, states,

If a product is being sold that predominantly exploits the commercial value of an individual's identity, that product should be held to violate the right of publicity and not be protected by the *First Amendment*, even if there is some "expressive" content in it that may qualify as "speech" in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.²¹⁴

The case involved a right of publicity action by a former professional hockey player, Anthony "Tony" Twist,²¹⁵ against the creator of the comic book *Spawn*, which featured a Mafia don character named "Anthony 'Tony Twist' Twistelli."²¹⁶ The comic creator admitted that "Anthony 'Tony Twist' Twistelli" was in fact named after the hockey player.²¹⁷ In applying

I may not want to see a standard print of Elvis hanging on my wall; I may want to see a Gary Saderup charcoal drawing of Elvis, or someone's impressionist or pointillist Elvis. Or I may want to see an absurd or subversive Elvis, perhaps not subversive enough to qualify as clearly 'transformative' and thus clearly open to others to create, but different enough that the Elvis estate might not authorize it.

Protecting celebrities' exclusive rights to control images of themselves may not always affect 'whether conventional celebrity images are produced'; but it will affect which conventional images are produced. And just as 'I Strongly Resent the Draft' or 'F*** the Draft' doesn't have quite the same meaning as 'Fuck the Draft,' many nontransformative authorized renderings of a celebrity may not have quite the same meaning as the authorized ones.

Id. (internal footnotes omitted).

212. *See id.* at 924.

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

214. *Id.*; Lee, *supra* note 8, at 500 (suggesting this articulation of the predominant use test).

215. *Doe*, 110 S.W.3d at 365–66 (noting Twist's reputation as the National Hockey League's preeminent "enforcer" because of his "violent tactics on the ice").

216. *Id.* at 366. The court states,

The fictional "Tony Twist" is a Mafia don whose list of evil deeds includes multiple murders, abduction of children and sex with prostitutes. The fictional and real Tony Twist bear no physical resemblance to each other and, aside from the common nickname, are similar only in that each can be characterized as having an "enforcer" or tough-guy persona.

Id.

217. *Id.* at 366–67 (explaining that the creator of the comic book series was "an avowed hockey fan" who, on more than one occasion, admitted that the name of the fictional character Tony Twist was based on the real hockey player).

the predominant use test, the court held that the use of Twist's name and identity had become "predominantly a ploy to sell comic books and related products rather than a literary or artistic expression," and thus, free speech must give way to the right of publicity.²¹⁸

Moore, however, calls attention to the difficulties that arise in applying the recently formulated predominant purpose test. He asks, "what if the 'expressive comment' is the image itself, such as a picture book of celebrities?"²¹⁹ And "[h]ow is the finder of fact supposed to distinguish a 'predominant purpose' of making an expressive comment from that of making a buck, when the two go hand in hand?"²²⁰

The originator of the predominant use test, Mark Lee, attempted to answer this second question. Lee stated that other judicial approaches such as the "merchandise v. media" distinction,²²¹ the "alternative means" test,²²² the *Restatement's* "relatedness" test,²²³ and the "transformative" test can assist in determining whether the publicity right is being exploited or the celebrity's image is being commented on.²²⁴ While these approaches may offer some guidance, Lee himself acknowledges that they are

218. *Id.* at 367–69, 374, 375. At the trial court level, the jury returned a verdict in favor of Twist, but the court granted a motion for judgment notwithstanding the verdict ("JNOV") and granted a motion for a new trial in the event that the JNOV was reversed on appeal. The Missouri Supreme Court reversed the JNOV and affirmed the motion for a new trial. A right of publicity action in Missouri required the plaintiff to prove that the defendant *intended* to obtain commercial advantage, but in the trial court, the jury had been allowed to render a verdict without finding the requisite intent. *Id.* at 374–76.

219. Moore, *supra* note 9, at 6.

220. *Id.*

221. See Lee, *supra* note 8, at 488–90, 500. While this distinction is not really a "test," "historically, most courts rejected First Amendment defenses to right of publicity claims involving traditional 'merchandise' . . . while they accepted it when an image was used in traditional 'media.'" *Id.* at 488. Applied to the predominant use test, this distinction could act as a "practical shortcut," because "[w]hile one could argue that a bumper sticker, swizzle stick, bobblehead doll, or poster includes some expressive content, most often they predominantly are intended to capitalize on the commercial value of an individual's identity." *Id.* at 500.

222. See *id.* at 482–84, 497, 501. The "alternative means" test used in trademark infringement and unfair competition actions states that "non-commercial speech is held infringing if there is another way to convey the message without infringing intellectual property rights." *Id.* at 482. Applied to the predominant use test, "[a]n unnecessary use is more likely to be an exploitive, and hence actionable, use of publicity rights." *Id.* at 501.

223. See *id.* at 496–97, 501. The *Restatement (Third) of Unfair Competition* proposes a "relatedness" test in which "the use of other's publicity rights in expressive works is permitted if the rights 'relate' to the work, but not otherwise." *Id.* at 498–97. Applied to the predominant use test, an appropriate "related" use of an individual's identity is more likely to make a genuine comment about, rather than merely exploit, the goodwill of a celebrity. *Id.* at 501.

224. See *id.* at 500–01.

“individually unsatisfying and incomplete.”²²⁵ The “merchandise v. media” distinction fails to pass constitutional muster because the First Amendment clearly does not limit its protection to speech in traditional media.²²⁶ No court has adopted trademark law’s “alternative means” test, although it has been discussed in connection with right of publicity claims.²²⁷ The *Restatement’s* “relatedness” test is too inflexible and excludes all “merchandise” from protection in favor of “traditional media of communication.”²²⁸

Another problem is that the touted “more balanced balancing test”²²⁹ seems to focus only on whether the product is commercially successful *because of* the use of the celebrity’s identity, instead of balancing the interests involved. Lee states that this test “does justice to both expressive and property interests” in that “[i]t protects intellectual property that is being exploited by others, but permits and encourages creative expression that makes meaningful comment on, about, or with intellectual property.”²³⁰ Yet, following Lee’s explanation of the test and its application in *Doe v. TCI Cablevision*, if the product receives commercial success *because of* the individual’s identity, that is the end of the analysis and the First Amendment is not available. Lee’s example further reveals the conceptual shortcomings of this approach: “If people buy a picture of Tiger Woods predominantly because they like Tiger Woods, rather than because they are attracted to the composition of the picture, that picture should be deemed to violate Tiger Woods’ right of publicity.”²³¹ Far from achieving balance between the rights, this approach would leave almost every artistic endeavor without First Amendment protection, for it would seem some people purchase even Andy Warhol’s paintings solely because of their affinity for Marilyn Monroe or Elvis Presley and in spite of the “ironic social comment” embodied in the work. It would be judicial chaos

225. *Id.* at 500.

226. *See id.* at 490. Mark Lee admits that this approach is “vulnerable to First Amendment attack” because “the First Amendment does not limit its protections to speech in ‘recognized media.’” *Id.* *See also* Comedy III Prods., Inc. v. Saderup, Inc., 21 P.3d 797, 804 (Cal. 2001) (reiterating that “First Amendment doctrine does not disfavor nontraditional media of expression” and therefore, the fact that Saderup’s expression appeared on a “less conventional avenue of communication,” such as a T-shirt, did not “result in reduced First Amendment protection”).

227. *See* Lee, *supra* note 8, at 497.

228. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. b, c (1995); Lee, *supra* note 8, at 496–97.

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

230. Lee, *supra* note 8, at 500.

231. *Id.*

indeed if the courts had to assess the predominant factor driving enigmatic consumer demand.

F. EVOCATION

The Court of Appeals for the Ninth Circuit, in the notorious *White v. Samsung Electronics America, Inc.* decision, held that an ad depicting a robot “dressed in a wig, gown, and jewelry” violated Vanna White’s right of publicity.²³² The court held 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.²³³ Thus, Samsung’s futuristic ad, which showed the dressed up robot next to a *Wheel of Fortune* game show set, was an appropriation of White’s identity in violation of her publicity rights.²³⁴ The court dismissed the asserted First Amendment defense because whatever element of parody the ad contained was subservient to the primary commercial message, and thus, no protection was available.²³⁵ This expansive decision creating “a property right of remarkable and dangerous breadth”²³⁶ was met with two vigorous dissents²³⁷ and rancorous scholarly criticism.²³⁸ Judge Kozinski’s famous stinging dissent asserted,

Under the majority’s opinion, it’s now a tort for advertisers to *remind* the public of a celebrity. Not to use a celebrity’s name, voice, signature or likeness; not to imply the celebrity endorses a product; but simply to evoke the celebrity’s image in the public’s mind. This Orwellian notion withdraws far more from the public domain than prudence and common sense allow.²³⁹

232. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1396 (9th Cir. 1992).

233. *See id.* at 1399. The court thought a broad right was necessary because “the identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice.” *Id.*

234. *Id.* at 1396.

235. *Id.* at 1401.

236. *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1514 (9th Cir. 1993) (denying a petition for rehearing en banc).

237. *See White*, 971 F.2d at 1402 (Alcaron, J., dissenting) (Judge Alcaron dissented to most of the original opinion). *See also White*, 989 F.2d 1512 (Kozinski, J., dissenting).

238. *See, e.g.,* Arlen W. Langvardt, *The Troubling Implications of a Right of Publicity “Wheel” Spun Out of Control*, 45 KAN. L. REV. 329, 330 (1997) (claiming that the Ninth Circuit decision in *White* “handed celebrities a new property right with greatly expanded boundaries”); David S. Welkowitz, *Catching Smoke, Nailing JELL-O to a Wall: The Vanna White Case and the Limits of Celebrity Rights*, 3 J. INTELL. PROP. L. 67, 76–85 (1995); Linda J. Stack, Note, *White v. Samsung Electronics America, Inc.’s Expansion of Publicity: Enriching Celebrities at the Expense of Free Speech*, 89 NW. U. L. REV. 1189, 1202–26 (1995) (arguing that the *White* court “expanded the right of publicity in a manner inconsistent with precedent, the Constitution, and societal concerns”).

239. *White*, 989 F.2d at 1514 (Kozinski, J., dissenting).

Furthermore, Kozinski believed the decision threatened the heart of the First Amendment itself:

The First Amendment isn't just about religion or politics—it's also about protecting the free development of our national culture. Parody, humor, irreverence are all vital components of the marketplace of ideas. The last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them, or from "evok[ing]" their images in the mind of the public.²⁴⁰

In *Wendt v. Host International, Inc.*, the Ninth Circuit struck another blow to the First Amendment when it held that the sweeping standard adopted in *White* applied in publicity cases to trump even the rights of copyright holders.²⁴¹ In *Wendt*, the defendant, Host, licensed the copyright for the television show *Cheers* from Paramount to start a chain of *Cheers*-themed airport bars featuring robotic versions of the characters "Norm" and "Cliff."²⁴² George Wendt and John Ratzenberger, the actors who played Norm and Cliff on the television show, brought a right of publicity claim for unauthorized exploitation of their likenesses. The problem was that to the viewing public, "Wendt and Ratzenberger *are* Norm and Cliff; it's impossible to exploit the latter without also evoking thoughts about the former."²⁴³ Under the Copyright Act the answer to this problem is simple because section 301 preempts any state law grant of "legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright."²⁴⁴ Thus, under federal law, Paramount and, by license, Host have the right to present robots resembling Norm and Cliff as derivative works.²⁴⁵ However, the Ninth Circuit held, in effect, that "copyright or no copyright, anyone who wants to use a figure, statue, robot, drawing or poster that reminds the public of Wendt and Ratzenberger must first obtain (and pay for) their consent."²⁴⁶ Judge Kozinski, in another passionate dissent, explains the disastrous implications of the court's extension of *White*:

According to the panel, Paramount and Host may not use Norm and Cliff in a way that reminds people of the actors who played them and whose identity is therefore fused in the public mind. This is a daunting burden.

240. *Id.* at 1519 (internal footnotes omitted).

241. *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284 (9th Cir. 1999) (denying a petition for rehearing en banc).

242. *Id.* at 1284–86.

243. *Id.* at 1286 (Kozinski, J., dissenting).

244. 17 U.S.C. § 301(a) (2000).

245. *See* 17 U.S.C. §§ 103(a), 106(2) (2000).

246. *Wendt*, 197 F.3d at 1286 (Kozinski, J., dissenting) (denying a rehearing en banc).

Can Warner Brothers exploit Rhett Butler without also reminding people of Clark Gable? Can Paramount cast Shelley Long in *The Brady Bunch Movie* without creating a triable issue of fact as to whether it is treading on Florence Henderson's right of publicity?²⁴⁷

Kozinski concludes that this result "cannot be squared with the right of the copyright holder to recreate Norm and Cliff however it sees fit,"²⁴⁸ and unfortunately for the First Amendment, the Ninth Circuit has "again let the right of publicity snuff out creativity."²⁴⁹

Moore, however, has noted the fact that the analysis of *Comedy III* and *Winter* suggests that the "transformative test" extends to advertising.²⁵⁰ If so, the holdings of the California Supreme Court, as the final arbiter of California law, would sub silentio overrule *White* and other Ninth Circuit decisions.²⁵¹ Samsung's portrayal of a robot in a wig and evening gown would undoubtedly be "transformative" under any variation of the test. The California Supreme Court's reasoning in *Winter* provides further evidence that *White*'s evocation standard would be nullified under the "transformative" test. The court held that the fictional Autumn brothers were clearly transformative, even though they were "less-than-subtle evocations of Johnny and Edgar Winter," because "the books do not depict the plaintiffs literally."²⁵² In using the identical language of *White*, the California Supreme Court has led the way to dismissing this overextension of the scope of "identity." Nevertheless, the evocation standard continues to cause an "identity crisis" in other jurisdictions.

VI. THE PRIMARY MOTIVATION TEST TAKES CENTER STAGE

This Note now proposes the primary motivation test to resolve the conflict between the right of publicity and the First Amendment. This test focuses on the defendant's primary influence or motive—expressive or commercial—in using a celebrity identity, and it proposes a framework to adequately balance the expressive and property interests at stake and the goals underlying each of the rights.

247. *Id.*

248. *Id.*

249. *Id.* at 1289.

250. See Schuyler M. Moore, *California Further Defines Transformative Use*, ENT. L. & FIN., July 15, 2003, at 1.

251. *See id.*

252. *Winter v. D.C. Comics*, 69 P.3d 473, 479 (Cal. 2003) (adding, "To the extent the drawings of the Autumn brothers resemble plaintiffs at all, they are distorted for the purposes of lampoon, parody, or caricature.").

A. THRESHOLD TEST OF IDENTITY

The goals of the First Amendment demand that the first step in any right of publicity analysis must be a threshold test of identity.²⁵³ A rich public domain filled with tools for future creation and authorship is essential in promoting a robust public discourse and fulfilling the public's need for self-expression. To preserve this supply of expressive resources, Wendy Gordon argues that "creators should have property in their original works, only provided that such grant of property does no harm to other persons' equal abilities to create or draw upon the preexisting cultural matrix and scientific heritage."²⁵⁴ Following this logic, the public must be free to evoke cultural symbols to fully express themselves²⁵⁵ and thus, *White's* overextension of identity must be tamed. Furthermore, an "evocation" standard would significantly chill even protected speech because the public will have a difficult time evaluating what violates a celebrity's right of publicity.²⁵⁶

This Note proposes an identity threshold test modeled after Moore's no-actual-use defense.²⁵⁷ If there is no actual use of the celebrity, there must be a direct imitation of the celebrity's persona for a right of publicity action to proceed.²⁵⁸ Thus, if a star's persona is called to mind by a mental association, symbolic shorthand, or metaphorical device, this should not be actionable, unless there is a strong showing of likelihood of confusion.²⁵⁹ This threshold test is comparable to copyright's idea-expression dichotomy, which prevents the unauthorized use of the expression of an idea, but allows the unauthorized use of the idea itself.²⁶⁰ In the same way, if there is no actual use of the celebrity's image, it is the idea of the celebrity that is

253. See *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1519 (9th Cir. 1993) (denying a petition for rehearing en banc) (Kozinski, J., dissenting). Kozinski argues, "I can't see how giving White the power to keep others from evoking her image in the public's mind can be squared with the First Amendment. . . . The majority's creation . . . [is] a speech restriction unparalleled in First Amendment law." *Id.* (emphasis added).

254. Wendy J. Gordon, *A Property Right in Self-expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1563-64 (1993).

255. See Stacey L. Dogan, *An Exclusive Right to Evoke*, 44 B.C. L. REV. 291, 316 (2003).

256. See *id.* at 316-17.

257. See Moore, *supra* note 115, at 47. See also Haemmerli, *supra* note 131, at 461 (stating that, although similar to Haemmerli's "immediacy" test, which states that a use of identity must be direct and immediate to be actionable, an identity threshold test is conceptually clearer and, thus, is not as difficult for courts to apply and the public to anticipate).

258. See Moore, *supra* note 115, at 47.

259. In narrowing the scope of identity actionable in a right of publicity action, it is important to include safeguards to protect the rationales underlying the right.

260. See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985).

evoked, and such an expression should be protected by the First Amendment.

Applying this threshold test, *Carson v. Here's Johnny Portable Toilets, Inc.*²⁶¹ would have come out differently. The court found that Johnny Carson's right of publicity was violated by the use of the slogan "Here's Johnny" in conjunction with selling portable toilets.²⁶² Yet, there was no actual use of his persona, and the slogan only called Johnny to mind through a metaphorical device.²⁶³ Furthermore, the public was not likely to believe that Johnny endorsed the portable toilets based solely on the apparent play on words.²⁶⁴ Similarly, *White* would have also come out differently, because there was no use of White's image, and the robot merely calls the idea of Vanna White to mind. Samsung used White only as a symbol or metaphor for the concept of durability, thus the public was not led to believe that she was endorsing Samsung's long-lasting VCRs.

Assuming that a right of publicity claim passes the threshold requirement of an actual or direct appropriation of identity, we are in need of a test to resolve the tension between the right of publicity and the First Amendment's interest in protecting expressive works. There remains a split of authority,²⁶⁵ as one standard has not emerged from the numerous "balancing" approaches to take center stage in this conflict. Thus, this Note proposes a test that has the ability to perform the leading role in resolving the tension between the right of publicity and the First Amendment. It has the ability to balance the rights for all expressive speech types and mediums, and it could even apply to commercial speech, an application that is beyond the scope of this analysis. The primary motivation test is influenced by copyright law and takes a different perspective on the predominant use test that will help solve some of the problems with that and other tests and shed some light on the murky First Amendment-publicity interface.

261. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983).

262. *Id.* at 836.

263. *See id.* at 838 (Kennedy, J., dissenting) ("[T]he phrase containing Johnny Carson's first stage name was certainly selected for its value as a double entendre. . . . The value of the phrase to appellee's product is in the risqué meaning of 'John' as a toilet or bathroom.").

264. *See id.* at 833-34 (holding that Carson failed to establish likelihood of confusion for his claim of unfair competition under the Lanham Act).

265. *See Moore, supra* note 9, at 4-6 (opining that there is now only a "three-way split of authority" for balancing publicity rights and the public's interest in free expression: the newsworthy exception, the transformative test, and the predominant purpose test, which this Note refers to as the "predominant use" test).

B. PRIMARY MOTIVATION TEST

If the speaker or creator of a work being sold was primarily influenced by expressive concerns—making an expressive comment, criticism, or parody on or about a celebrity from an individual or group perspective—the work will receive a strong presumption of full First Amendment protection. But if the speaker or creator of a work being sold was primarily influenced by commercial concerns—exploiting the commercial value of the individual’s identity—the work will violate the right of publicity.

In cases in which it seems that the speaker or creator of a work was equally influenced by expressive and commercial concerns, courts should balance the interests involved and the rationales underlying the right of publicity and the First Amendment. In general, if the work conveys an “expressive comment, criticism or parody on or about a celebrity from an individual or group perspective” that is instrumental in achieving the public information, public discourse, or self-realization goals that underlie the First Amendment, then, absent a clear showing of unjust enrichment or consumer deception, the work should be granted full First Amendment protection. Similarly, the “strong presumption of full First Amendment protection” can be rebutted if there is a rationale that serves the goals of the right of publicity that is being severely impeded.

1. Doctrinal Influences

The primary motivation test has its roots in copyright law, which, since the Supreme Court’s decision in *Zacchini*, has influenced judicial tests that attempt to resolve the conflict between the First Amendment and the right of publicity.²⁶⁶ *Zacchini* provides the only Supreme Court precedent involving the right of publicity, and the decision analogized the property right in publicity to that of copyright, stating that the economic incentives rationale underlies both rights.²⁶⁷ Furthermore, Justice Powell

266. See *supra* Part V.C.–D. Since *Zacchini*, courts and scholars have attempted to apply copyright’s fair use doctrine to resolve the conflict between the First Amendment and the right of publicity. The California Supreme Court developed the transformative test to offer guidance in this conflict.

267. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575–76 (1977). First, the Court analogized the property interest in the right of publicity to that of copyright: “The Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner.” *Id.* at 575. The Court also stated that the economic incentives rationale for the right of publicity is the “same consideration [that] underlies the patent and copyright laws long enforced by this Court” and explained the rationale by quoting the copyright case *Mazer v. Stein*, 347

foreshadowed a test similar to the primary motivation test in his dissent, stating, “We should direct initial attention to the actions of the [defendant]: what use did the station make of the film footage?” Justice Powell argues that such an inquiry would be preferable to asking, “is this or is this not his entire act?”²⁶⁸ While the dissent has no real precedential value, it seems to be more applicable to other right of publicity cases than are the majority’s entire act standard.

The proposed test finds its inspiration from Robert Denicola’s conceptual separability test (the “Denicola test”),²⁶⁹ which is applied in copyright’s useful article doctrine to determine the copyrightability of a work with both aesthetic and utilitarian elements. The Copyright Act provides protection for “pictorial, graphic, and sculptural works,”²⁷⁰ but not for “useful articles,”²⁷¹ in an effort to channel protection for functional works toward the patent system. Section 101, defining “pictorial, graphic, and sculptural works,” explains the distinction, stating,

the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates *pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the work.*²⁷²

In an attempt to determine if a work containing both aesthetic and utilitarian elements is copyrightable, courts have employed a number of conceptual separability tests with varying degrees of success.²⁷³ This difficult line drawing is similar to the courts’ dilemma in having to determine if a work containing both expressive and commercial elements is protected by the First Amendment in a publicity action. The Second Circuit, in *Brandir International, Inc. v. Cascade Pacific Lumber Co.*,

U.S. 201, 219 (1954). *Zacchini*, 433 U.S. at 576. Furthermore, many courts have applied the *Zacchini* holding in copyright cases. See Samuelson, *supra* note 161, at 877 n.145.

268. *Zacchini*, 433 U.S. at 581 (Powell, J., dissenting). See *supra* Part V.A.

269. See *Brandir Int’l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987); Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707 (1983).

270. See 17 U.S.C. § 102 (2000).

271. *Id.* § 101 (defining “useful article” as an “article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a ‘useful article.’”).

272. *Id.* (emphasis added) (defining “pictorial, graphic and sculptural works”).

273. See *Brandir*, 834 F.2d at 1144 (adopting Denicola’s conceptual separability test). The court discussed other standards and explicitly rejected as not “very satisfactory” two tests similar to the predominant use test: “whether the primary use is as a utilitarian article as opposed to an artistic work” and “whether the aesthetic aspects of the work can be said to be ‘primary.’” *Id.*

adopted the Denicola test, which focuses on whether the designer's process in creating a work was influenced more by aesthetic or functional concerns.²⁷⁴ In the same way, the primary motivation test focuses on whether the defendant's expressive or creative process was primarily influenced by expressive or commercial considerations.

The court adopted the Denicola test because its emphasis on the influence of utilitarian concerns in the design process would help to "alleviate the de facto discrimination against nonrepresentational art that has regrettably accompanied much of the current analysis."²⁷⁵ Also, the test would not be too difficult to administer in practice in that "[t]he work itself will continue to give 'mute testimony' of its origins" and the parties can bring forth "evidence relating to the design process and the nature of the work."²⁷⁶

Likewise, the primary motivation test's emphasis on the influence of commercial concerns in the appropriator's creative and expressive process will help alleviate the danger the Supreme Court warned of in *Bleistein*—embroiling the courts in artistic value judgments.²⁷⁷ This test remedies the problem that plagues the transformative test and could creep into the predominant use test.²⁷⁸ Focusing on the concerns that influenced the defendant lessens the possibility that judges are basing First Amendment decisions on value judgments of the quality of art or the medium that conveys the expression.²⁷⁹

Similarly, this test will not be as difficult to apply as other tests have been, because not only does it focus on the defendant's motivations and tangible evidence of the concerns that influenced the creative and expressive process,²⁸⁰ but it also takes into account the "mute

274. See *id.* at 1146. Furthermore, the court "determine[s] whether the aesthetic design elements are significantly influenced by functional considerations" and "focus[es] on the process or sequence followed by the particular designer." *Id.* at 1151 (Winter, J., concurring in part and dissenting in part).

275. *Id.* at 1145 (quoting Denicola, *supra* note 269, at 745).

276. *Id.*

277. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). See *supra* Part V.D.

278. By taking into account the reason consumers are purchasing a work, the predominant use test can base this determination on an unarticulated value judgment of the quality of the work itself or the medium within which the work is embodied.

279. See *supra* Part V.D.

280. For example, in *Comedy III*, evidence that the defendant could have brought forth in his defense was his original charcoal drawing of the Three Stooges that he then reproduced in lithographs and on T-shirts, and what he looked at for inspiration for his drawing, for example, a photograph of the Stooges or the television episodes he had watched. He could have then compared the two to show that his drawing is different from the inspiration, and that the differences comment about the Stooges'

testimony”²⁸¹ of the work itself. Thus, it avoids the difficulties courts have faced in abstractly applying the vague and fragmented transformative test solely to the appropriator’s work.²⁸² In addition, the primary motivation test, unlike the transformative test,²⁸³ will not chill free expression. The speakers and creators have clearer permissibility guidelines and more control over whether their use is protected because they can expect that courts will look at their motivations and creative processes, thereby allowing speakers to modify their behavior accordingly.

The primary motivation test is also influenced in large part by the predominant use test,²⁸⁴ but in taking a different perspective, the primary motivation test attempts to solve some of the difficulties that have arisen in the application of the predominant use test. A main concern with the predominant use test is, How are courts supposed to determine a product’s “predominant purpose” when making an expressive comment goes hand in hand with making a buck?²⁸⁵ A product, however, is an inanimate object and cannot have a purpose; rather, it is the creator who has a purpose for making a product. Thus, the primary motivation test remedies the problem of abstractly determining a product’s purpose by looking to the defendant, who must provide evidence of the primary purpose underlying the use of a celebrity persona in the product.

Critics may argue that because many uses of an individual’s identity have both expressive and commercial elements, the primary motivation test does not make drawing the line any easier than does the predominant use test. But in using the defendant’s motives as the standard, this test should result in a modification of behavior that will lead to fewer borderline cases. Speakers and creators will know that their purpose in using a celebrity identity must be to make an expressive comment on it,²⁸⁶ or else their works will not receive full First Amendment protection. Thus, there will be fewer appropriations motivated by seemingly purely commercial concerns, which is the injury the right of publicity seeks to prevent. In this way, the

prominence in the history of comedy or the public’s loss in their passing. Other evidence might include: the defendant’s attempts, which the plaintiff refused, to license the celebrity identity, which would cut in favor of the plaintiff if defendant’s use was not particularly expressive; notes from meetings with the defendant discussing marketing strategies; discussions expressing a desire to use a celebrity that would bring in the most money; or discussions on what message the defendant intended his image to convey.

281. See *Brandir*, 834 F.2d at 1145.

282. See *supra* Part V.D.

283. See *supra* Part VI.

284. See *supra* Part V.E.

285. Moore, *supra* note 9, at 6.

286. The primary motivation test defines expressive concerns as making an expressive comment, criticism, or parody on or about a celebrity from an individual or group perspective. See *supra* Part VI.

primary motivation test furthers the goals of the right of publicity²⁸⁷ without significantly chilling free expression.

Another difficulty with the predominant use test is its reliance on the reason why the product is a commercial success. If it is due to the celebrity's identity, First Amendment protection is unavailable. Yet, it would be extremely difficult, if not impossible, for courts to assess whether consumers purchase a drawing "predominantly because they like Tiger Woods" or because they like the "composition of the picture."²⁸⁸ Not only is the predominant force driving consumer demand extremely elusive and variable, but also this inquiry has no bearing on the rationales underlying the right of publicity. The primary motivation test shifts the focus from the public's motive for purchasing to the defendant's motives in using the identity and, thus, better addresses the injury complained of in a right of publicity action.

2. Justifying the Starring Role

The primary motivation test helps to safeguard the First Amendment guarantees of free speech by fostering public discourse and self-expression through extension of a strong presumption of First Amendment protection for works primarily influenced by expressive concerns. This test also balances these First Amendment objectives with the rationales underlying the right of publicity.

Celebrities are fully entitled to reap the "fruits of their labor" in developing a valuable persona in works that are primarily influenced by commercial concerns. To the extent that critics argue that the public creates celebrity image²⁸⁹ and is thus entitled to the "fruits of labor," this test allows the public ample breathing room for cultural language, recoding, and symbolic use of celebrity identity, while still protecting the undeniable effort that celebrities expend in constructing their images.²⁹⁰

In addition, by focusing on the defendant's primary influence in using the identity in the work, this test is well-tailored to address the need to prevent unjust enrichment, which is "one of the fundamental rationales underlying the right of publicity."²⁹¹ The defendant is more likely to be

287. See *supra* Part III.A.

288. See *Lee*, *supra* note 8, at 500. See *supra* Part V.E.

289. See *Madow*, *supra* note 4, at 193.

290. See *Kwall*, *supra* note 1, at 41 (arguing that despite outside influences, "the effort in constructing the celebrity persona represents an intellectual, emotional, and physical effort on the part of the celebrity that requires protection").

291. *Kwall*, *supra* note 58, at 62.

unjustly enriched if the work was influenced primarily by commercial concerns, and in borderline cases, expressive works protected by the First Amendment may be trumped by a clear showing of unjust enrichment.

This test also provides ample economic incentives for celebrities to create valuable personas, as they alone control the licensing rights for commercial uses of their identities. Also, the additional incentives motivating individuals to achieve fame and celebrity status are unaffected by this test.²⁹² Furthermore, celebrities maintain control over the use of their valuable personas for commercial purposes in order to prevent overexploitation, which could lead to a lessening in value.

Finally, publicity rights carry strong consumer protection overtones “to assure that consumers receive accurate information about the sponsorship, approval, and certification of goods and services.”²⁹³ The primary motivation test is also especially tailored to this rationale in that if the defendant’s primary influence is commercial, consumer confusion is more likely to occur. In addition, in close cases, expressive works may lose their First Amendment protection by a clear showing of consumer confusion.

The test also states that the strong presumption of full First Amendment protection afforded to works influenced primarily by expressive concerns can be rebutted if a rationale that serves the goals of the right of publicity is being severely impeded. This acts as a safeguard for the right of publicity that is necessary due to the wide variety of appropriations that have already reached the courts.²⁹⁴

3. The Test Takes on 2006: Cultural and Technological Influences

Contemporary popular culture has also inspired the formulation of the primary motivation test in order to strike the correct balance between the rights of free speech and self-expression granted to every American and celebrities’ property right in their identities. The historical analysis of the right of publicity²⁹⁵ shows that the expansion of mass media technologies, along with the evolution of the concept of fame and the rise of the “celebrity,” have shaped the scope of the right of publicity since its birth. Likewise, our multicultural society’s expressive needs and the expansion of the Internet, which has led to the democratization of fame and the increased

292. *See supra* Part III.A.2.

293. *Id.*

294. *See supra* Part V.

295. *See supra* Part II.

use of celebrities as shorthand to express ideas, need to be considered in formulating the correct balance between expressive and property interests today.

Our nation is a melting pot of overlapping subgroups and subcultures structured along racial, ethnic, gender, sexual preference, generational, occupational, and other lines. Diverse individuals and groups “make active and creative use of celebrity images to construct themselves and their social relations, to identify themselves as individuals and as members of subcultural groups, and to express and communicate their sense of themselves and their particular experience of the world.”²⁹⁶ As Madow explains, “Indeed, celebrity images are among the basic semiotic and symbolic raw materials out of which individuals and groups establish their presence, identity and meaning.”²⁹⁷ It follows that in our increasingly diverse and fragmented nation, in which very few people feel that they are part of the cultural mainstream,²⁹⁸ the ability to use celebrity images to fulfill an individual’s constitutionally guaranteed right to self-expression and self-realization is extremely important.

Digital technology and the expansion of the Internet have created an extraordinary medium through which people around the world can actively participate in public discourse, self-expression, and the creative process with the touch of a button. In fact, the Internet is argued to be the best realization of First Amendment goals²⁹⁹ and is touted as “a far more speech-enhancing medium than print, the village green, or the mails.”³⁰⁰ This new technology provides the public with “a forum for a true diversity of political discourse, unique opportunities for cultural development”³⁰¹ and a “never-ending, worldwide conversation.”³⁰² People have seized on

296. See Madow, *supra* note 4, at 143.

297. *Id.* (internal quotation marks omitted).

298. See *id.* The necessity of using celebrity images in constructing individual and group meanings is “especially clear in the case of groups that are outside the cultural mainstream,” as defined by Richard Dyer as the “adult, male, heterosexual culture.” *Id.*

299. See Cristina Fernandez, *The Right of Publicity on the Internet*, 8 MARQ. SPORTS L.J. 289, 300–01 (1998). See also Eugene Volokh, *Cheap Speech and What It Will Do*, 104 YALE L.J. 1807, 1846–47 (1995). Volokh argues that First Amendment doctrine is based on an idealized world “where money is no barrier to speaking; where it’s easy to avert eyes from offensive speech; where there’s more than one newspaper in each town, and something other than a vast wasteland on TV.” *Id.* at 1847. This world, he claims, “is much closer to the electronic media world of the future than it is to the print and broadcast media world of the present.” *Id.* Thus, he concludes that “the First Amendment of today will not only work well with the new information order—it will work better than it ever has before.” *Id.* at 1807.

300. *ACLU v. Reno*, 929 F. Supp. 824, 882 (E.D. Pa. 1996), *aff’d*, 521 U.S. 844 (1997).

301. Communications Decency Act of 1996, 47 U.S.C. § 230(a)(3) (2000).

302. *ACLU*, 929 F. Supp. at 883.

this new opportunity for worldwide communication and self-expression and, as a result, the Internet reveals countless websites,³⁰³ newsgroups,³⁰⁴ chatrooms,³⁰⁵ and blogs³⁰⁶ that focus on celebrity favorites. The nature of the Internet is changing, however, and commercial interests have begun to dominate this communicative landscape.³⁰⁷ Now, “[w]ebsites . . . are part vanity, part advertising, and part information,”³⁰⁸ containing both expressive and commercial aspects. This has led to speech-chilling confusion about the degree of First Amendment protection available for online communications in publicity actions.³⁰⁹

Moreover, the pervasiveness of the Internet, coupled with the phenomenal success of reality programming, has led to the democratization of celebrity, helping to effectuate Andy Warhol’s 1968 prediction that “‘in the future everyone will be world famous for fifteen minutes.’”³¹⁰ The Internet “grant[s] anyone who chooses to make use of this [technology] the illusion of celebrity. It is an ‘outlet’ for opinion, grievance, rumor, and spite that can make you—at the very least—a legend in your own mind.”³¹¹ Thus, the Internet has “empower[ed] the formerly voiceless,”³¹² providing them with a worldwide vehicle for self-expression. People are using this

303. See Fernandez, *supra* note 299, at 293–94 (explaining that “Web sites [are] where super-fans enshrine their priestly powers, displaying their bootlegged and autographed relics for the extended contemplation of other admirers,” and that fans also use sites to “express and communicate worldwide who their idols are” (internal footnotes omitted)); Anthony M. Verna III, WWW.WHATSINaname, 14 SETON HALL J. SPORTS L. 153, 154 (2004) (stating that “[t]he Web allows users to set up sites with pages that contain different types of information, pictures, sound and video”).

304. See Fernandez, *supra* note 299, at 303 (explaining that the “alt.fan” newsgroups are public conversations where people can speak in a richer language containing words, images and sounds that are then fixed and archived); Verna, *supra* note 303, at 153 (explaining that newsgroups “are specialized forums in which users with a common interest share and exchange ideas”).

305. See Verna, *supra* note 303, at 153–54 (“Chatting allows users to send and receive messages instantaneously, enabling users to have a conversation, as if on the telephone. Users can keep in touch with their long-distance friends over Internet chat as well as meet other people by chatting with each other.”).

306. A blog is a website where people post their thoughts and interact with others, similar to an online diary that the world can read and comment on.

307. See Verna, *supra* note 303, at 154.

308. *Id.* at 156.

309. See Michael Overing, *Not-So-Public Figures*, USC ANNENBERG ONLINE JOURNALISM REV. (2001), <http://www.ojr.org/ojr/law/1017956813.php>. Michael Overing discusses, for example, an Indiana case in which Curtis Management Group alleged that the American Legends website was an unauthorized use of James Dean for commercial purposes, because in addition to offering information on a number of legendary celebrities, people can order a copy of Dean’s biography through the site. The case eventually settled, but it left website creators in a state of speech-chilling confusion. *Id.* See also Welcome to American Legends, <http://www.americanlegends.com> (last visited May 19, 2006).

310. Kwall, *supra* note 1, at 31–32.

311. SCHICKEL, *supra* note 13, at 306.

312. *Id.* at 309.

newfound voice not only to star in their own lives,³¹³ but also to use images of stars as shorthand to express themselves, identify with others, and engage in political and cultural discourse. Therefore, an unclear standard of First Amendment protection for this new medium in right of publicity actions will greatly inhibit free speech.

Fearful of this chilling effect on speech, Lawrence Lessig argues that the Internet, as an “*innovation commons*,” should remain free from all controlling property interests in order to reach its full potential as an expressive medium.³¹⁴ He states that free resources—those available for the taking³¹⁵—have been crucial to innovation and creativity, and without them, creativity is crippled.³¹⁶ The Internet, free from restrictions imposed by copyright law and the right of publicity, will enhance creativity, culture, commerce, and innovation³¹⁷—in other words, the First Amendment guarantees of free speech. Lessig counsels,

Just as we are beginning to see the power that free resources produce, changes in the architecture of the Internet—both legal and technical—are sapping the Internet of this power. Fueled by a bias in favor of control, pushed by those whose financial interests favor control, our social and political institutions are ratifying changes in the Internet that will reestablish control and, in turn, reduce innovation on the Internet and in society generally.³¹⁸

The primary motivation test formulates the First Amendment inquiry differently than the predominant use test to fully address our popular culture’s expressive needs and the expansion of digital technology and the Internet. The proposed test first asks whether there are expressive influences in creating the work and, if so, a presumption arises that the work will be protected by the First Amendment. This articulation is especially important in protecting free speech on the Internet, which, as an easy and accessible worldwide forum, is the best realization of the First Amendment. Many “netizens,”³¹⁹ taking advantage of this unique medium,

313. *Id.* (“Give a man a web site that cannot be edited, let alone censored, and he has—at least in his own mind—the ear of the world. He also may have the idea that his opinions are as good as anyone else’s, that he is . . . some kind of celebrity.”).

314. See LAWRENCE LESSIG, *THE FUTURE OF IDEAS: THE FATE OF THE COMMONS IN A CONNECTED WORLD* 23 (2001).

315. *Id.* at 11.

316. *Id.* at 14.

317. *Id.* at 9.

318. *Id.* at 15.

319. See Wikipedia, Netizen, <http://en.wikipedia.org/wiki/Netizen> (last visited May 19, 2006). A Netizen (a portmanteau of Internet and citizen), also known as a cybercitizen, is a person actively involved in online communities for the purpose of giving and receiving viewpoints, furnishing

use celebrity images as symbols or shorthand to express ideas or identify themselves as part of a group or subculture. Thus, many uses of identity, even on a commercial website, do not seek to exploit celebrity images to sell products, but act as an expressive symbol or metaphor. The primary motivation test seeks to protect these symbolic references in order to assist the Internet in reaching its full expressive potential, while also protecting celebrities from the pure exploitation of their valuable personas. The test embodies a compromise between Lessig's ideal and the balancing of two very important rights for Americans.

VII. CONCLUSION

Our culture's fascination with fame and the ubiquity of celebrity references in the mass media and everyday conversations are evidence that the "celebrity" is now a permanent fixture in American culture. The right of publicity, created in response to this cultural phenomenon, thus serves an important role in protecting the commercial value of a celebrity's identity. Yet, it also grants celebrities the power to suppress expression when applied to the public use of celebrity images in expressive speech to "symbolize individual aspirations, group identities, and cultural values."³²⁰ The lack of a clear standard to resolve this conflict between the right of publicity and the First Amendment has resulted in our current state of judicial chaos and confusion.

The primary motivation test is ready to take center stage in this conflict and help courts make consistent, logical rulings in right of publicity actions that encounter First Amendment defenses. By focusing on whether the defendant's primary influence in using a celebrity identity is expressive or commercial, this test successfully balances the expressive and property interests at stake and the goals underlying each of these important rights. It also takes into account the existing doctrines of intellectual property, other tests utilized by the courts, and most importantly, current cultural, social, and technological influences. Thus, the primary motivation test has the ability, as we enter the digital age, to capture the starring role in the resolution of the conflict between publicity rights and free expression.

information, fostering the Internet as an intellectual and a social resource, and making choices for self-assembled communities. *See id.*

320. Madow, *supra* note 4, at 128.

