

DISCIPLINING THE RIGHT OF PUBLICITY'S NEBULOUS FIRST AMENDMENT DEFENSE WITH TEACHINGS FROM TRADEMARK LAW[♦]

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Abstract

Academic commentators, practitioners and students alike have written a flurry of articles on the First Amendment defense in right of publicity law, as courts cannot seem to agree on the appropriate balancing test that should be used to weigh celebrities' publicity rights against the public's rights to use celebrity personas as communicative tools. Various tests have been proposed as the panacea, but are ultimately unsatisfactory, due to inadequacies that prevent them from striking a normatively desirable balance.

This Article suggests that the core normative justification behind the right of publicity is the prevention of unjust enrichment. Thus, following recent developments in trademark law evincing the courts' unwillingness to allow free riders to reap what they have not sown, limiting doctrines in trademark law may provide helpful guidance in the right of publicity context. Specifically, it is proposed that a principled First Amendment defense may be fashioned by adopting a modified version of trademark law's First Amendment balancing test.

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INTRODUCTION

Celebrities are ubiquitous in our lives today and greet us at every turn. We see Justin Bieber on television advertisements promoting Calvin Klein underwear, LeBron James on Coca Cola cans, David Beckham on a fifty-foot Billboard in New York promoting his new Bodywear Collection for H&M, and the list goes on. Celebrities dominate the marketplace simply because consumer brands view celebrity personas as valuable tools to market their products. Harvard Business Professor Anita Elberse and Barclays Capital Analyst Jeroen Verleun, in their study¹ examining the impact of celebrity endorsements on sales and stock returns, concluded that "a firm's decision to enlist an athlete endorser generally has a positive pay-off in brand-level sales . . . and increases the firm's stock returns."² Besides product endorsements, consumer brands also use celebrity personas in other ways that generate

¹ Anita Elberse & Jeroen Verleun, *The Economic Value of Celebrity Endorsements*, 52 J. ADVERT. RES. 149 (2012).

² *Id.* at 163.

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a commercial benefit, such as leveraging on their grab value to draw consumer attention to their products.³

This economic impact that celebrities have upon the marketability of products they endorse or are associated with has been termed as “associative value.”⁴ This “associative value,” stemming from the desirable attributes the public perceives celebrities to have, is transferred to products when celebrity images are placed on or associated with them.⁵ In turn, the public views these products more favorably, thus helping brands distinguish themselves in a cluttered marketplace to eventually increase sales for the brand.⁶

To protect the commercial value inherent in celebrity personas, the Second Circuit in the landmark decision of *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,⁷ in 1953 recognized a right of publicity. The right of publicity is defined as “the inherent right of every human being to control the commercial use of his or her identity.”⁸ However, apart from appealing to the sore deprivation that celebrities would feel if they no longer received money from endorsement deals,⁹ the Second Circuit in *Haelan* did not otherwise attempt to provide a principled theoretical justification for the right. Significantly, the court did not consider the First Amendment speech interests that are implicated by expressive uses of celebrity personas. Celebrity personas, being repositories of cultural meaning, may be used as tools of expression. Hence, allowing celebrities to control how their personas are used may potentially chill valuable expression.

In the wake of *Haelan*, subsequent courts and academic commentators were left with the unenviable task of justifying the right of publicity, and cabining it to prevent undue chilling of free speech. In the ensuing decades, there has been much judicial and academic

³ Hazel Carty, *Advertising, publicity rights and English Law*, INTELL. PROP. Q. 2004, 3, at 209–258, 217 (“[t]he ‘eye-catching’ effect of celebrity. The theory behind such use is that the product to which the celebrity persona is in some way associated is made more glamorous or eye-catching as a result.”).

⁴ Sheldon W. Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L.J. 853, 856 (1995).

⁵ *Id.* (“commercial use of an individual’s identity [to, *inter alia*, promote commercial products] is intended to increase the value or sales of the product by fusing the celebrity’s identity with the product and thereby siphoning some of the publicity value or good will in the celebrity’s persona into the product.”)

⁶ Kineta Hung, *Why Celebrity Sells: A Dual Entertainment Path Model of Brand Endorsement*, 43 J. ADVERT. 155, 155 (2014) (“Celebrity endorsement is a highly effective strategy to gain consumer interests and brand loyalty in a cluttered marketplace.”).

⁷ *Haelan Labs. Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953).

⁸ J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:3 (2d ed. 2015).

⁹ *Haelan*, 202 F.2d at 868 (“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.”).

discussion on whether the right of publicity can be justified and if so, how its contours can be properly defined.¹⁰

Attempting to find a principled basis for the right of publicity, Professors Stacey Dogan and Mark Lemley have argued that “[t]he best justifications for a right of publicity are trademark-based justifications.”¹¹ They argue that both branches of law are concerned with the prevention of consumer confusion: “[t]rademark law . . . protect[s] the integrity of a mark’s meaning by preventing uses of the mark that confuse consumers,”¹² while right of publicity law protects people from being “misled by the use of a celebrity name or likeness.”¹³ Finally, they opine that trademark law provides a workable framework to analyze the right of publicity.¹⁴ More recently, Celeste Boyd and Stuart Paynter have suggested that trademark law is developing in a way that brings it conceptually closer to the right of publicity.¹⁵ They further suggest that this development allows “cross-pollination between the two areas of law.”¹⁶

Drawing on these insights, this Article argues that, in the context of the right of publicity’s First Amendment defense, a modified version of trademark law’s artistic relevance test¹⁷ should be adopted to balance the public’s free speech interests against celebrities’ publicity interests. This proposed test strikes a judicious balance between the countervailing interests involved in the interplay between the right of publicity and First Amendment speech values.

Part I charts the development of the right of publicity from its historical origins in the law of privacy to its current state today. To set the stage for the discussion in the following sections, Part I also provides a brief overview of the tension between the right of publicity and the First Amendment.

Part II examines the various normative bases proffered for the

¹⁰ See *ETW Corp. v. Jireh Publ’g Inc.*, 332 F.3d 915 (6th Cir. 2003); see also Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 127 (1993); Roberta Rosenthal Kwall, *Fame*, 73 IND. L.J. 1 (1997); Vincent M. de Grandpré, *Understanding the Market for Celebrity: An Economic Analysis of the Right of Publicity*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 73 (2001).

¹¹ Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1220 (2006).

¹² *Id.* at 1190.

¹³ *Id.*

¹⁴ *Id.* at 1191.

¹⁵ Celeste H.G. Boyd & Stuart Paynter, *What a Tangled Family Tree We Weave: Trademarks, Publicity Rights, and the Cross-Pollination of First Amendment Defenses Through Video Games*, 4 J. INT’L MEDIA & ENT. L. 69, 71 (2011–12).

¹⁶ *Id.*

¹⁷ The artistic relevance test was first propounded in the trademark context in the case of *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Under this test, an artistic work’s use of a trademark that would otherwise violate the Lanham Act is not actionable “unless the use of the mark has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless it explicitly misleads as to the source or content of the work.” *Id.* at 999.

recognition of the right of publicity. The right of publicity can be defended on a myriad of considerations—unjust enrichment, allocative efficiency, incentive creation, and to a certain extent, free speech considerations. My premise is that some forms of free riding are “reprehensible” and ought not be countenanced, as they impinge on these aforementioned considerations. In Part IV, where the intersection of the right of publicity and the First Amendment is considered, a test that allows courts to promote the public’s speech interest, and at the same time clamp down on “reprehensible” free riding will be proposed.

Part III considers the increasing overlap that trademark law is perceived to share with the right of publicity.¹⁸ These expansions seem attributable to the courts’ perceptions that trademark law ought to prevent misappropriation of goodwill that trademark holders have in their marks.¹⁹ This anti-free riding impetus is keenly felt in cases involving “sponsorship or affiliation” confusion. Under the guise of keeping within trademark law’s goals of reducing consumer confusion, courts seem to have extended this form of confusion to enjoin unauthorized associative uses of trademarks that they consider unfair. Accordingly, the concept of “sponsorship or affiliation” confusion could be a useful “heuristic device” to identify when free riding is “reprehensible.”²⁰ In the right of publicity context, courts apply the First Amendment defense to identify whether a particular instance of misappropriation is actionable. Thus, it is suggested that trademark law’s First Amendment balancing test (*i.e.* the artistic relevance test) could be a useful starting point for fashioning a principled First Amendment defense for right of publicity law.

Part IV gives a brief overview of trademark law’s First Amendment balancing test and argues that the right of publicity should adopt a modified version of this test to delineate the contours of its nebulous First Amendment defense. This Article will seek to show that this modified test is more normatively desirable than the other First Amendment balancing tests that have been fashioned to reconcile the inherent tension between the right of publicity and the First Amendment.

Part V will provide the conclusion.

I. OVERVIEW OF THE RIGHT OF PUBLICITY IN THE UNITED STATES

A. Development of an Independent Right of Publicity Distinct From Its

¹⁸ Boyd & Paynter, *supra* note 15, at 71 (“[A] trademark law expands its common ground with the right of publicity, the likelihood increases that doctrines developed in one field will more easily be imported into the other . . .”).

¹⁹ J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 2:1 (4th ed. 2016).

²⁰ William McGeeveran & Mark P. McKenna, *Confusion Isn’t Everything*, 89 NOTRE DAME L. REV. 253, 254 (2013).

Historical Privacy Roots

The right of publicity, which was first recognized in the early twentieth century, has its roots in the right of privacy.²¹ This right of an individual “to be let alone”²² was argued to be necessary to prevent “unpermitted public disclosure of private facts which are embarrassing to a reasonable person.”²³ The focus of the right was to vindicate an “injury” to one’s feelings, which results from “public intrusion.”²⁴

Although some courts believed that recognizing a right of privacy would be contrary to First Amendment values,²⁵ the judicial sentiment that individuals’ dignitary interests deserved some protection, at the very least, turned the tide in favor of recognizing a right of privacy.²⁶ However, the contours and limits of the right remained unclear. One paradigm of cases, in which plaintiffs frequently alleged right of privacy violations, involved the unauthorized uses of plaintiffs’ identities, whether for commercial or non-commercial purposes.²⁷

In cases where a plaintiff’s identity was used to advertise unsavory products, the plaintiff could surely avail himself of the right of privacy.²⁸ This was because courts were able to find the requisite harm to the plaintiff’s feelings or reputation.²⁹ However, in cases where dignitary interests were not at stake, the right of privacy did not provide a remedy.³⁰ One example would be when celebrities tried to enjoin unauthorized commercial uses of their identities.³¹ Celebrities, in their pursuit of fame, have clearly permitted their identities to be widely used in the media, thus exposing themselves to public scrutiny.³² Their

²¹ MCCARTHY, *supra* note 8, § 1:7 (“the right to control the commercial use of one’s identity first historically developed within the domain of ‘privacy’ law.”)

²² Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 205 (1890).

²³ MCCARTHY, *supra* note 8, § 1:11.

²⁴ *Id.*

²⁵ *Id.* § 1:16 (citing *Roberson v. Rochester Folding Box Co.*, 171 N.Y. 538 (1902), which rejected the common law adoption of a right of privacy, justified its decision on the basis of preserving the “ability of the press to make legitimate comment on the private affairs of persons.”) (internal quotation marks omitted).

²⁶ *Id.* § 1:18 (stating that “the tide had turned in favor of the right of privacy.”).

²⁷ *Id.* § 1:23 (“While the vast majority of cases falling into the “appropriation” category involve the unpermitted use of one’s name or picture for advertising or trade purposes, a few situations involve one who uses another’s name for a non-advertising purpose.”)

²⁸ *Id.* § 1:25 (“The traditional “appropriation” type of invasion of privacy by unpermitted commercial use of identity focuses upon tort law concepts of personal injury to dignity and state of mind, measured by mental distress damages . . . Liability is created simply by the public advertising disclosure of a private person’s identity. The gist of the wrong is the damage to an individual’s self-respect in being made a public spectacle.”) (internal quotation mark omitted).

²⁹ *Id.*

³⁰ *Id.* (“when a plaintiff whose identity was already well known sued under this approach, the courts could not see how there could be “indignity” or “mental distress” when plaintiff’s identity was already in widespread use in the media.”)

³¹ *Id.*

³² *Id.*

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complaints with respect to unauthorized commercial uses of their identities were not that they suffered from mental distress, but that they should not be deprived of value-generating, albeit unauthorized, uses of their identities.³³

Even where celebrities succeeded in right of privacy actions, “their damages were limited to the personal injury that they suffered, rather than the economic value that the use brought to the advertiser.”³⁴

It may be said that the right of privacy’s inadequacy in protecting celebrities’ economic interest in their identities was the motivating factor behind the right of publicity’s birth in *Haelan*.³⁵ *Haelan* involved a dispute between two chewing gum manufacturers over the use of leading baseball players’ photographs in connection with the sale of their respective brands of chewing gum.³⁶ The plaintiff chewing gum manufacturer had entered into agreements with these players, giving it the exclusive right to use the players’ images in connection with the sale of its gum.³⁷ The defendant, a rival chewing gum manufacturer, obtained licenses from the players through third parties and proceeded to use their photographs to market its gum.³⁸ The plaintiff then sued the defendant for inducing a breach of contract.³⁹ The defendant argued that the plaintiff’s action could not be sustained in instances where it had acquired the license from a third party, who did not act as the plaintiff’s agent.⁴⁰ More significantly, the defendant argued that the plaintiff could not assert the players’ right of privacy against the defendant, as it was personal and non-transferable.⁴¹ Perhaps influenced by the equities in favor of the plaintiff, the Second Circuit recognized that the players had assignable rights in the publicity value of their identities,⁴² and had assigned them to the plaintiff.⁴³ This allowed the plaintiff to potentially sue the defendant for violation of the players’ right of publicity. In coming up with this new legal right, the Second Circuit expressly gave effect to the instinctive need to protect the commercial value inhering in

³³ *Id.*

³⁴ Dogan & Lemley, *supra* note 11, at 1171.

³⁵ MCCARTHY, *supra* note 8, § 1:25.

³⁶ *Haelan Labs. Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 867 (2d Cir. 1953).

³⁷ *Id.*

³⁸ *Id.*

³⁹ *Id.* at 866.

⁴⁰ *Id.* at 867.

⁴¹ *Id.* at 868 (The defendant’s contention was that “none of [the] plaintiff’s contracts created more than a rel[e]ase of liability, because a man has no legal interest in the publication of his picture other than his right of privacy, i.e., a personal and non-assignable right not to have his feelings hurt by such a publication.”).

⁴² *Haelan*, 202 F.2d at 868. (“[T]he right to grant the exclusive privilege of publishing [a man’s] picture . . . may validly be made ‘in gross,’ i.e., without an accompanying transfer of a business or of anything else.”).

⁴³ *Id.* at 869 (The plaintiff was found to be the “exclusive grantee of [the baseball] player’s right of publicity” (internal quotation mark omitted)).

an individual's persona.⁴⁴ The bold and innovative decision in *Haelan* paved the way for subsequent development of the right of publicity.

B. *From Haelan to the Present*

After its birth in *Haelan*,⁴⁵ the right of publicity has received differing levels of recognition across the United States.⁴⁶ Some states have not recognized the right of publicity. In those states that do, the right of publicity is enforced under common law, statutes, or both.⁴⁷ Even among the states that do recognize a right of publicity, the "cause of action, scope of protection, duration of protection, statute of limitations, and remedies differ substantially."⁴⁸ Calls for the enactment of a federal right of publicity to unify the disparate law of the states have thus far gone unheeded.⁴⁹

Be that as it may, the right of publicity, in general, proscribes unauthorized commercial uses of an individual's persona.⁵⁰ For example, California's common law right of publicity comprises four elements: (1) use of identity, (2) appropriation of commercial value of identity, (3) lack of consent, and (4) resulting injury.⁵¹ Although damage to the commercial value of the celebrity's persona is stated as an element required for infringement of the right of publicity, the celebrity plaintiff need not prove quantifiable commercial damage to his persona, nor a tangible gain by the defendant from its use.⁵² Damage is

⁴⁴ The Second Circuit noted that:

[I]t 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.

Id.

⁴⁵ *Haelan* was decided in 1953.

⁴⁶ MCCARTHY, *supra* note 8, § 6:3.

⁴⁷ *Id.* § 6:3 ("[A]t the time of this writing, under either statute or common law, the right of publicity is recognized as the law of 31 states.")

⁴⁸ Charles Bahlert, *College Football, Electronic Arts, and the Right of Publicity: Reality-Mimicking Run Amok*, 18 INTELL. PROP. L. BULL. 149, 154 (2014).

⁴⁹ MCCARTHY, *supra* note 8, § 6:3.

⁵⁰ MCCARTHY, *supra* note 8, § 3:2 ("To prevail on a prima facie for liability of infringement of the right of publicity, a plaintiff must plead and prove the following basic elements: (1) *Validity* . . . (2) *Infringement*. (A) Defendant, without permission, has used some aspect of identity or persona in such a way that plaintiff is identifiable from defendant's use; and (B) Defendant's use is likely to cause damage to the commercial value of that persona")

⁵¹ *Id.* § 6:21 (citing a list of Californian cases adopting and applying this list of elements, including *Eastwood v. Super. Ct. for L.A. Cnty.*, 149 Cal. App. 3d 409 (Cal. Ct. App. 1983), and *White v. Samsung Elecs. Am. Inc.*, 971 F.2d 1395 (9th Cir. 1992)).

⁵² MCCARTHY, *supra* note 8, § 3:2 ("Likely damage to commercial value is a hallmark of the right of publicity, distinguishing it from the various types of 'privacy' rights. However, this is not to state that evidence of some quantifiable commercial damage is an essential element of proof of liability for infringement of the right of publicity. Similarly, the plaintiff need not prove that the

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presumed once the celebrity plaintiff proves that the defendant has used his persona “in such a commercial context that one can state that such damage is likely.”⁵³

Even if the celebrity plaintiff can prove the foregoing, the defendant may still be immunized from liability if he manages to avail himself of the First Amendment defense, under which unauthorized uses may be justified by free speech considerations.⁵⁴ The recognition of a right of publicity inevitably impinges on First Amendment free speech values. Celebrity identities are cultural signs, which may be endowed with different meanings; as Vincent de Grandpré succinctly puts it, celebrity identities can “acquire secondary meaning and become shorthand expressions for timely views, events or ideals.”⁵⁵ As such, it follows that celebrity identities may be useful tools for expression of ideas—an aim that the First Amendment seeks to further.⁵⁶ When courts allow celebrities to control the public’s use of their identities, they may inadvertently chill valuable expression, thus running counter to the purpose of the First Amendment. The United States Supreme Court in *Zacchini v. Scripps-Howard Broad Co.*⁵⁷ had to expressly consider and weigh these competing interests. The issue before the Court was whether First Amendment values immunized a television station from its alleged infringement of a performer’s right of publicity through its unauthorized broadcast of the performer’s entire “human cannonball” act.⁵⁸ The Court held that Ohio’s recognition of a right of publicity was not barred by the First Amendment, as its protection was necessary to provide “an economic incentive for [performers] . . . to produce a performance of interest to the public.”⁵⁹ Regrettably, the Supreme Court did not lay down an authoritative statement with regard to how the balance should be struck, thus allowing the lower courts to fashion a

defendant realized some tangible gain for the challenged use of the plaintiff’s identity.”).

⁵³ *Id.*

⁵⁴ David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment*, 2 HARV. J. SPORTS & ENT. L., 1, 3 (2011) (“If a plaintiff succeeds in proving that he or she has been identified by the defendant’s use and that the defendant has appropriated the associative value of his or her identity, the plaintiff still may have to face the formidable argument by the defendant that the unauthorized commercial use is nevertheless protected by the First Amendment.”).

⁵⁵ de Grandpré, *supra* note 10, at 106.

⁵⁶ Michael Feinberg, *A Collision Course between the Right of Publicity and the First Amendment: The Third and Ninth Circuit Find EA Sport’s NCAA Football Video Games Infringe Former Student-Athletes Right of Publicity*, 11 SETON HALL CIR. REV. 175, 187 (2014) (“There are several theories and policies supporting First Amendment protections, which include fostering a marketplace of ideas, encouraging human dignity and self-fulfillment, and promoting democratic self-governance. Specifically, protecting free speech under the First Amendment preserves an uninhibited marketplace of ideas that advances knowledge and the search for the truth.”).

⁵⁷ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

⁵⁸ *Id.* at 563–565.

⁵⁹ *Id.* at 576.

mélange of different tests to balance the competing considerations.⁶⁰

This Article will consider four of the more prevalent tests adopted by the lower courts. They are the: (1) Transformative Use Test,⁶¹ (2) Direct Balancing Test,⁶² (3) Predominant Purpose Test,⁶³ and (4) Artistic Relevance Test.⁶⁴ Although none of these tests per se competently achieve this task, this Article takes the position that the Artistic Relevance Test may be modified to strike a judicious balance between the aforementioned competing considerations.

II. NORMATIVE BASES FOR THE RECOGNITION OF A RIGHT OF PUBLICITY

Since the right of publicity was abruptly recognized in *Haelan*, courts and commentators have spilled much ink trying to justify the right's existence.⁶⁵ While some commentators are convinced that a right of publicity is necessary, others are diametrically opposed to its recognition.⁶⁶ There are four main justifications that commentators have proffered to justify the right of publicity, i.e. Lockean labor, unjust enrichment, incentive creation and allocative efficiency considerations. Part II will consider the coherence of these justifications and will also discuss the criticisms leveled against them.

Contrary to some commentators' assertions that free speech considerations militate against the right's very existence,⁶⁷ this Article takes the position that the right of publicity can be justified on unjust enrichment, incentive creation, and allocative efficiency grounds. These concerns are implicated when third parties "reprehensibly" free ride on the associative value inhering in the celebrity persona. In fact, it is contended that free speech considerations actually justify according celebrities some measure of protection against unauthorized exploitation of their personas.

A. Moral Justifications

1. Lockean Labor Theory

The eponymous advocate of the Lockean Labor theory, John

⁶⁰ Tan, *supra* note 54, at 18.

⁶¹ Comedy III Prod., Inc. v. Gary Saderup, Inc., 25 Cal.4th 387, 404–05 (Cal. 2001). This test has most recently been applied by the Ninth Circuit in *Keller v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litigation)*, 724 F.3d 1268 (9th Cir. 2013).

⁶² *Cardtoons, L.C. v. Major League Baseball Players Ass'n.*, 95 F.3d 959, 972 (10th Cir. 1996).

⁶³ *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003).

⁶⁴ *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

⁶⁵ See Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954); Madow, *supra* note 10.

⁶⁶ See, e.g., Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903, 929 (2003) ("As a critic of the right of publicity, I wouldn't mind seeing the right of publicity eviscerated this way, even as to commercial advertising.").

⁶⁷ *Id.*

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Locke, argued that an individual's ownership of his labor follows from his ownership of his body.⁶⁸ Thus, when one has labored upon resources, he has a natural property right in the product of his labor; and the state has a duty to respect and enforce that natural right.⁶⁹ Accordingly, under Lockean philosophy, the celebrity individual ought to be the sole person deriving benefit from the economic value inhering in the celebrity's persona, as this value resulted from the celebrity individual's pursuit of fame.

This rationale has some support in the case law⁷⁰ and from academic commentators. For example, esteemed academic commentator Professor Melville Nimmer⁷¹ has opined, "persons who have long and laboriously nurtured the fruit of publicity values [ought to be able to] control and profit from the publicity values which he has created or purchased."⁷²

While Lockean philosophy may be able to explain other branches of intellectual property law, it is inadequate in the context of the right of publicity because a fundamental requirement for Lockean labor considerations to apply is that the celebrity must have expended effort in the creation of his/her persona. Although Professor Nimmer considers it almost axiomatic that "a person achieves publicity values of substantial pecuniary worth only after he has expended considerable time, effort, skill and even money,"⁷³ the better view is that this statement does not adequately represent the situation today.

First, Catherine Walsh astutely points out that although it may have been true in the past that celebrities achieved fame as a result of their talents and achievements, many modern celebrities achieve fame as a result of mere happenstance, such as through participation in reality television programs.⁷⁴ One good example is the American television program "The Biggest Loser," where plus-sized contestants work to lose weight, and the one who loses the most weight wins a huge cash prize. Clearly, some of these contestants may have achieved "well-knownness"⁷⁵—the hallmark of being a celebrity—through their

⁶⁸ David Tan, *Beyond Trademark Law: What the Right of Publicity can learn from Cultural Studies*, 25 CARDOZO ARTS & ENT. L.J. 913, 928 (2008) (citing Roberta Rosenthal Kwall, *The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 54 (1994)).

⁶⁹ *Id.* (citing Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1547 (1993)).

⁷⁰ See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

⁷¹ Nimmer, *supra* note 65.

⁷² *Id.* at 216.

⁷³ *Id.*

⁷⁴ Catherine Walsh, *The Justifications Underlying Personality Rights*, 24 ENT. L. REV. 17, 18 (2013).

⁷⁵ Tan, *supra* note 68, at 946 (citing Daniel Boorstin's work on the celebrity as a social construct).

participation in the “The Biggest Loser,” but their fame can hardly be attributable to any talent they may have.

Further, it has also been persuasively argued that “a celebrity’s persona is the product of a number of individuals.”⁷⁶ Borrowing from cultural studies, Professor David Tan states that the “celebrity trinity,” comprising the celebrity individual, the audience, and the producers, are responsible for creating the celebrity persona.⁷⁷ Thus, granting the celebrity individual the right to control uses of the celebrity persona disregards the substantial labor put in by the other constituents of the celebrity trinity.⁷⁸

2. Unjust Enrichment Considerations

The intuitive appeal of the unjust enrichment theory⁷⁹ in justifying the right of publicity is apparent. If the “celebrity trinity” is responsible for creating the celebrity persona, it seems manifestly unfair that third parties can sit back and wait for the celebrity persona to develop commercial value, and then conveniently appropriate it for use in connection with their goods and services, once all the grunt work has been completed.

As the Supreme Court in *Zacchini* categorically stated,

The rationale for (protecting the right of publicity) is the straightforward one of preventing unjust enrichment by the theft of good will [, as] 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.⁸⁰

The clear import of the Supreme Court’s statement is that given the moral reprehensibility of the third party free rider’s conduct, the law ought to step in to prevent the third party’s unjust gain.

Although most commentators empathize with the unfairness that may result if the law does not provide a remedy, some legal commentators have expressed manifest unease at relying on one’s instincts to justify the recognition of a right of publicity. The first objection is that the “visceral impulses of fairness”⁸¹ underlying the unjust enrichment rationale cannot explain why the law should award the celebrity individual a proprietary remedy in the form of the right of publicity. As Professors Dogan and Lemley have pointed out, “[t]he

⁷⁶ Walsh, *supra* note 74, at 18.

⁷⁷ *Id.* at 931.

⁷⁸ *Id.*

⁷⁹ Tan, *supra* note 68, at 932.

⁸⁰ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (internal quotation marks omitted).

⁸¹ MCCARTHY, *supra* note 8, § 2:2.

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moral claim for ownership of publicity rights presumes that someone must have property rights in the value of a celebrity persona.”⁸² But they argue that this presumption is problematic, as some justification is required as to why property rights ought to inhere in personality.⁸³ Accordingly, they state that since it is simply assumed that someone must own rights in an individual’s persona, the unjust enrichment rationale “fails to provide a standalone explanation for the publicity right.”⁸⁴

At the outset, it must be stated that I agree with Professors Dogan and Lemley’s observations. Recognizing a full property right in a celebrity persona solely because it has commercial value is problematic, as this involves circular reasoning.⁸⁵ This is because, while the commercial value of personality rights “depends upon the extent to which it is legally protected”,⁸⁶ the extent of legal protection determines the right’s value. However, their concern can be addressed by recognizing that property rights may be limited. The term “property” is capable of different meanings. The right of publicity may be conceived merely as the celebrity’s entitlement to control his personality vis-à-vis third party free riders.

Other commentators have focused on the negative free speech implications engendered by the recognition of a right of publicity. Professor Michael Madow asserts that a right of publicity “facilitate[s] private censorship of popular culture.”⁸⁷ In his opinion, celebrity personas as cultural icons ought to “be treated as part of our cultural commons, freely available for use in the creation of new cultural meanings and social identities.”⁸⁸ On a related note, Professor Tan argues that awarding a full property right to the celebrity based solely on unjust enrichment concerns fails to “account for the role of the audience that has participated in the celebrity-creation process.”⁸⁹ Although Professor Tan does not explicitly state that his concern is about the negative consequences on free speech, it is implicit in his argument that the audience ought to have an interest in the use of the celebrity persona.

While it is true that free speech concerns are implicated if the celebrity individual exercises his right of publicity to exclude the

⁸² Dogan & Lemley, *supra* note 11, at 1182.

⁸³ *Id.*

⁸⁴ *Id.* at 1183 (“[T]he unjust enrichment rationale makes just such an assumption. As such, it fails to prove a standalone explanation for the publicity right.”).

⁸⁵ Felix Cohen, *Transcendental Nonsense and the Functional Approach*, 102 COLUM. L. REV. 809, 815 (1935).

⁸⁶ *Id.*

⁸⁷ Madow, *supra* note 10, at 138.

⁸⁸ *Id.* at 239.

⁸⁹ Tan, *supra* note 68, at 933.

public's valuable expressive uses, these concerns ought not to be exaggerated. The law should protect celebrity individuals from unauthorized uses of their personas by corporate advertisers, who do not pay licensing fees. As Professor Sheldon Halpern has persuasively pointed out, as between the celebrity, who contributed to the creation of his persona, and corporate advertisers, who exploit celebrities merely to achieve greater sales, the celebrity is definitely more deserving of the concomitant benefits of fame.⁹⁰ Further, the law currently provides a doctrinal tool in the form of the First Amendment defense for courts to take free speech interests into account and excuse defendants from liability when their uses advance compelling speech interests.⁹¹ While the effectiveness of the First Amendment defense adopted by the courts in protecting the public's speech interests is definitely open to debate, this Article proposes a novel formulation of the defense that (it is submitted) adequately addresses these speech interests.

From the above, we can see that, to a large extent, the objections to the unjust enrichment rationale go to the scope of the right, rather than its very existence. Taken in this light, the unjust enrichment rationale still "seems quite sufficient to provide a firm support for the existence of a right of publicity."⁹² As long as the right is narrowly drawn to protect celebrities only against uses that are purely exploitative, there should not be significant circularity or free speech concerns.

B. *Economic Considerations*

1. Incentive Creation Considerations

A significant number of United States courts⁹³ and commentators⁹⁴ have asserted that, similar to how copyright law incentivizes creative production,⁹⁵ the right of publicity provides an economic incentive for

⁹⁰ Halpern, *supra* note 4, at 872 ("In short, whether or not there is some moral or public benefit from commercial exploitation of celebrity, . . . the choice is between the individual to whom that associative value attaches and a stranger to the process who would make money out of it. Even if, at its lowest level, the choice is that between two sets of scavengers trading on the ephemera of fame, logic and fairness would seem to compel favoring the scavenger who has at least some colorable connection to the phenomenon.").

⁹¹ Tan, *supra* note 54, at 3 ("If a plaintiff succeeds in proving that he or she has been identified by the defendant's use and that the defendant has appropriated the associative value of his or her identity, the plaintiff still may have to face the formidable argument by the defendant that the unauthorized commercial use is nevertheless protected by the First Amendment.").

⁹² MCCARTHY, *supra* note 8, § 2:2.

⁹³ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (The U.S. Supreme Court noted that the protection given by the right of publicity "provides an economic incentive for him to make the investment required to produce a performance of interest to the public.").

⁹⁴ See David E Shipley, *Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673 (1981).

⁹⁵ Dogan & Lemley, *supra* note 11, at 1164 ("We grant copyrights in order to encourage the creation of new works of authorship.").

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celebrities to attain fame that ultimately enriches society.⁹⁶ However, commentators have argued that the incentive theory does not provide a compelling justification for the recognition of a right of publicity.⁹⁷ As discussed below, two main objections have been leveled.

First, Huw Beverley-Smith argues that, since there are established legal mechanisms, such as other intellectual property laws, to encourage “performances, inventions and endeavors,”⁹⁸ the right of publicity is unnecessary as an additional incentive.⁹⁹ Yet, his argument misses the mark. While it is undoubtedly true that other intellectual property laws exist to provide incentives for creative production, the right of publicity’s purpose does not speak to creative production. Rather, it is aimed at incentivizing the pursuit of fame. In this vein, it may be asserted that it is not clear why the pursuit of fame ought to be encouraged, as it is frivolous and morally repugnant. However, apart from being commercially valuable to advertisers as tools to capture consumer interests and brand loyalty,¹⁰⁰ fame results in the creation of celebrity personas, which are useful cultural tools to express one’s sense of individuality and to define one’s identity.¹⁰¹ One good example is the use of Farah Fawcett-Majors’ celebrity persona as a symbol for men: as a “foc[al] point of their active heterosexuality.”¹⁰² Such social uses thus support some measure of encouragement for the pursuit of fame.

Second, commentators argue that even assuming the right of publicity does create an incentive for celebrity individuals to develop their celebrity personas, it erroneously sets up celebrities’ collateral incomes from licensing their personas for advertising and merchandizing as the primary motivation.¹⁰³ Their argument is that a

⁹⁶ Shipley, *supra* note 94, at 681 (“Protecting the right of publicity provides incentive for performers to make the economic investments required to produce performances appealing to the public.”).

⁹⁷ See, e.g., HUW BEVERLEY-SMITH, *THE COMMERCIAL APPROPRIATION OF PERSONALITY* (2002); David Tan, *Beyond Trademark Law: What the Right of Publicity can learn from Cultural Studies*, 25 *CARDOZO ARTS & ENT. L.J.* 913 (2008); Rosina Zapparoni, *Propertising Identity: Understanding the United States Right of Publicity and Its Implications — Some Lessons for Australia*, 28 *MELB. U. L. REV.* 690, 721 (2004).

⁹⁸ *Lugosi v. Universal Pictures*, 603 P.2d 425, 441 (Cal. 1979) (Bird, C.J. dissenting).

⁹⁹ HUW BEVERLEY-SMITH, *THE COMMERCIAL APPROPRIATION OF PERSONALITY* 302 (2002) (“[I]f performances, inventions and endeavours are to be encouraged, then they can be properly encouraged and rewarded through the law of copyright, performance rights . . . or patents. In jurisdictions where these rights already exist, it is not clear why a right of publicity should be necessary as a further incentive.”) (internal quotation marks omitted).

¹⁰⁰ Hung, *supra* note 6, at 155, n.4.

¹⁰¹ Justin Hughes, “*Recoding*” *Intellectual Property and Overlooked Audience Interests*, 77 *TEX. L. REV.* 923, 956 (1999) (citing Deyan Sujic on “why people are drawn to cultural images attached to—or in the form of—consumer goods.”).

¹⁰² *Id.* at 955.

¹⁰³ Tan, *supra* note 68, at 935 (“While copyright protects the primary source of income for the artist, writer and composer, . . . the right of publicity protects only the incidental or collateral income of actors, entertainers, and athletes.”); see also Rosina Zapparoni, *Propertising Identity: Understanding the United States Right of Publicity and Its Implications — Some Lessons for*

celebrity's commercial marketability is merely a "by-product of their main activities for which they [already] receive exorbitant rewards."¹⁰⁴ Thus, even without a right of publicity, it will be business as usual—celebrities will continue to strive to excel in their work, be famous, and derive substantial income from their commercialization of fame. Paul Czarnota notes that celebrities whose primary incomes come from sports and entertainment already have substantial incentive, so much so that their secondary incomes provide marginal extra impetus to excel in their fame-generating activities.¹⁰⁵ However, contrary to Czarnota's view, it is argued that the incentive theory has more currency today, given that celebrities' secondary incomes from advertising and merchandizing are rather substantial these days. Indeed, it has been reported that "the top three highest-paid American athletes in 2010 . . . made over seven times as much from endorsements (\$147 million) than from salaries and winnings."¹⁰⁶ In addition, the value of a sports celebrity's endorsements reportedly increases with every major victory.¹⁰⁷ This empirical evidence suggests that individuals may be motivated to achieve fame to enjoy the concomitant benefits fame confers upon them, in the form of endorsement opportunities and merchandizing deals among others.

2. Allocative Efficiency Considerations

Under the allocative efficiency rationale, for the sake of an efficient use of celebrity personas, the law should recognize a right of publicity to enable the celebrity to exert some control over the use of their personas.¹⁰⁸ The tacit assumption is that celebrity personas are scarce, valuable resources. Thus, the law ought to grant celebrity individuals property rights in their personas for the good of society.¹⁰⁹ Commentators have challenged the presupposition that celebrity

Australia, 28 MELB. U. L. REV. 690, 721 (2004) ("In contrast to copyright law, which generally protects the primary source of a writer's income through provision of a monopoly grant, the right of publicity merely protects a 'by-product of [celebrity's] performance values' by preventing unauthorised advertising or merchandising use of celebrity image, with sports and entertainment celebrities generating significant income from their primary activities.").

¹⁰⁴ Walsh, *supra* note 74, at 19.

¹⁰⁵ Paul Czarnota, *The Right of Publicity in New York and California: A Critical Analysis*, 19 VILL. SPORTS & ENT. L.J. 481, 508 (2012) (Today celebrities are no longer poorly paid for their trades, thus "while the right of publicity was arguably justified under the economic incentive rationale when financial rewards for sporting or entertainment endeavors were trivial, it is not persuasive in the modern era where financial rewards for sporting activities are significant in and of themselves.").

¹⁰⁶ Elberse & Verleun, *supra* note 1, at 149–50.

¹⁰⁷ *Id.* at 150 ("[T]o secure the services of the most sought-after endorsers, firms have started offering athletes bonus payments for major victories (be it an Olympic Gold Medal for swimmer Michael Phelps or a Grand Slam win for tennis player Roger Federer), lifetime deals that extend beyond their active playing days, revenue-sharing deals, or equity stakes . . .").

¹⁰⁸ Walsh, *supra* note 74, at 20.

¹⁰⁹ *Id.*

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personas are scarce resources, arguing that celebrity personas are public goods due to their non-rivalrous nature—i.e., one’s use of a celebrity persona does not reduce the amount available for use by others.¹¹⁰ Some even suggest that greater use of celebrity personas in the marketplace, even if unauthorized, increases the demand for the celebrity.¹¹¹ This purportedly happens because of the bandwagon effect,¹¹² or the fact of simultaneous consumption and learning.¹¹³

Celebrity personas, however, are not always non-rivalrous goods. As Michael Grady has pointed out, although initial uses of celebrity personas may “increase the value of subsequent repetitions, . . . there is a point of diminishing marginal returns beyond which subsequent displays and performances diminish the value of the asset.”¹¹⁴ This point may be reached when the market has been inundated with crass uses of a celebrity persona, such that it no longer appeals to the public.¹¹⁵ Put another way, the public no longer deifies, idolizes, or admires the celebrity enough to desire to be associated with him/her. However, one potential counterargument to my response is that even if it is possible for some celebrity personas to suffer from exhaustion, there will always be new celebrities who will provide a “fresh face,” given “the desire to be famous”¹¹⁶ today. That said, this counterargument is superficially attractive and may be easily disposed of. Although there will always be individuals who want to become famous, Walsh sensibly points out that the overused celebrity persona may not be replaceable.¹¹⁷ This can be explained by recourse to cultural studies, which teach us that celebrity personas are useful tools that aid in expression of ideas,¹¹⁸ as they represent a distinct set of meanings, which in turn evoke particular emotions.¹¹⁹ Accordingly, since each celebrity persona is associated with a distinct bundle of meanings, it

¹¹⁰ Madow, *supra* note 10, at 222, n.445 (“Celebrity personas clearly have *some* public good attributes. Once a celebrity has developed or acquired a commercially valuable identity, others can use or appropriate it at a cost that is close to zero. Use of the identity, moreover, is “nonrivalrous”: If I use Madonna’s name or face on a poster or T-shirt, that in no way prevents her (or anyone else) from doing likewise.”).

¹¹¹ de Grandpré, *supra* note 10, at 104 (“Many uses of celebrity identity are faddish and, at certain points along the demand curve for celebrity goods and services, individual consumptions are not rivalrous, but complementary.”).

¹¹² *Id.* (Bandwagon effect occurs when “early consumption of goods by some people modifies the taste of others.”).

¹¹³ *Id.* at 105 (One’s exposure to celebrity may subsequently endear the celebrity to him).

¹¹⁴ Mark F. Grady, *A Positive Economic Theory of the Right of Publicity*, 1 UCLA ENT. L. REV. 97, 103 (1994).

¹¹⁵ For example, when a desirable celebrity persona is repeatedly used to advertise inferior (both in the “quality” sense and the “prestige” sense) products.

¹¹⁶ Walsh, *supra* note 74, at 20.

¹¹⁷ *Id.* (“[I]ndividual scarcity is lost”).

¹¹⁸ de Grandpré, *supra* note 10, at 106 (Celebrity identities “acquire a secondary meaning and become shorthand expressions for timely views, events or ideals.”).

¹¹⁹ *Id.*

may not be possible for new individuals to be groomed to represent the exact same set of meanings as the overexploited celebrity persona.¹²⁰ Thus, celebrity individuals ought to be able to protect their personas from overuse.

C. *First Amendment Free Speech Concerns*

In Part II.B.2 immediately above, it was argued that allocative efficiency considerations merited granting celebrities some measure of control over the use of their personas. The focus there was on promoting an efficient marketplace, where there will continue to be a ready supply of socially valuable celebrity personas. In making my argument, I suggested that celebrity personas serve as valuable means of expression.

Free speech “advocates” may view my implicit acceptance of the utility of celebrity personas in speech as undermining my above arguments in favor of the recognition of the right of publicity. As Professor McCarthy has noted, “the free speech argument [has been used] as a broad-based criticism of the very existence of . . . [the] right of publicity.”¹²¹ The argument is that the right of publicity is inconsistent with First Amendment values of free speech.¹²²

However, although free speech concerns will certainly be implicated if the right of publicity is too robust, they do not militate against the right’s very existence. They are merely valid concerns that ought to be taken into account when balancing the celebrity individual’s right of publicity against the “public rights of free access to socially and politically useful ideas.”¹²³

In fact, providing celebrities with some measure of control over their celebrity personas may instead further free speech concerns. Free speech advocates often assert that cultural symbols, which include celebrity personas, ought to be freely available for the public’s use so that the public can recode them to express new viewpoints.¹²⁴ However, this focus on recoding¹²⁵ uses pays scant attention to the need of other non-owners for the persona at issue to have a “stable, commonly

¹²⁰ Walsh, *supra* note 74, at 20 (“[I]ndividual scarcity is lost. The public in their mind build up a relationship with a celebrity, and through over-exploitation, comes the breakdown of this relationship. Yes there are other celebrities out there, but do those celebrities convey the same message?”).

¹²¹ MCCARTHY, *supra* note 8, § 2:4.

¹²² *Id.*

¹²³ *Id.*

¹²⁴ Hughes, *supra* note 101, at 924–25 (“Along these lines it is argued that authors need greater latitude to quote existing texts, that performing artists need more liberty to interpret theatrical works, that minority groups need greater liberty to manipulate or recode existing cultural symbols like celebrity images”) (internal quotation marks omitted).

¹²⁵ Recoding refers to the “appropriat[ion] of materials at hand to create something new.” Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 432.

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understood set of meanings.”¹²⁶ A stable celebrity persona allows many in the audience to “derive noninformational utility from it by identifying with it, by communicating with it, or by using it as a cultural reference. They may use the image as a projection screen on which they bring their own feelings, thoughts, and experiences to focus.”¹²⁷

Thus, giving celebrities some legal control over the use of their personas ensures that celebrity personas, which have been imbued with a specific cluster of cultural meanings, will not lose these meanings through wrongful third party exploitation. While the public ought to be able to freely use celebrity personas for passive and recoding uses, the same cannot be said for passive uses that merely seek to capitalize on a celebrity persona’s fame. On the contrary, passive uses that merely seek to capitalize on a celebrity persona’s fame could potentially inundate the market, leading to its diminished utility as a source of cultural expression. As Walsh has succinctly stated, “[c]autious brand management is required for the maintenance of the mental image and opinions conjured up in a fan’s mind of the celebrity persona.”¹²⁸ In addition, celebrity individuals should also be able to enjoin recoding uses that erroneously suggest the celebrity’s sponsorship of a “cause[] . . . in which [he/she] does not believe,”¹²⁹ as it infringes the celebrity’s right not to speak under the First Amendment.¹³⁰ Thus, the celebrity individual, who is arguably in the best position to protect his/her persona,¹³¹ should be allowed to clamp down on such third party unauthorized uses.

D. *Interim Conclusions*

The above analysis suggests that the recognition of a right of publicity may be supported on a number of normative bases. While there is no unifying rationale behind the right of publicity, it may generally be said that a right of publicity is granted to minimize the negative consequences resulting from “reprehensible” free riding on the associative value inhering in celebrity personas.

The difficulty, however, is in differentiating between “reprehensible” and “non-reprehensible” free riding. In right of publicity law, courts have “turned to the First Amendment to do th[is]

¹²⁶ *Id.* at 941 (“The problem is that putting the focus on the need of some non-owners to recode the cultural object de-emphasizes how much all non-owners rely on that same cultural object having a stable, commonly understood set of meanings.”).

¹²⁷ *Id.* at 955 (internal quotation marks omitted).

¹²⁸ Walsh, *supra* note 74, at 20.

¹²⁹ Hughes, *supra* note 101, at 929.

¹³⁰ *Id.*

¹³¹ Richard A. Posner, *The Economic Approach to Law*, 53 TEX. L. REV. 757 (1975) (arguing that economics should guide the development of law).

heavy lifting.”¹³² However, none of the articulated approaches have been completely satisfactory. In view of the recent judicial trend where courts seem to evince a desire to prevent unjust enrichment through expansive interpretations of trademark rules,¹³³ Part III will look to trademark law and consider whether it offers any useful doctrinal tools that shed light on this inquiry.

III. TRADEMARK LAW’S DOCTRINAL EXPANSION AND IMPLICATIONS FOR THE RIGHT OF PUBLICITY

Unlike copyright law and patent law, which are both predominantly—if not exclusively—targeted at incentivizing creation, trademark law has a different pedigree. Courts have often asserted that trademark law serves two goals.¹³⁴ The first goal is to “facilitate the transmission of accurate information to the market,”¹³⁵ and in so doing prevent consumer confusion in the marketplace.¹³⁶ The second is to protect the goodwill that trademark holders have in their marks.¹³⁷

That said, the current orthodoxy among trademark commentators in the United States¹³⁸ is that trademark law’s core goal is to “reduce consumer search costs and thus promote overall efficiency in the economy.”¹³⁹ Further, there is general agreement¹⁴⁰ that while trademark law does protect producers, courts should eschew emphasis on the notion that trademark law protects producer goodwill in

¹³² Stacey L. Dogan, *Haelan Laboratories v. Topps Chewing Gum: Publicity as a Legal Right*, in *INTELLECTUAL PROPERTY AT THE EDGE: THE CONTESTED CONTOURS OF IP* 17, 24 (Rochelle Cooper Dreyfuss & Jane C. Ginsburg eds., 2014).

¹³³ Boyd & Paynter, *supra* note 15, at 84 (“Recently, however, a number of trends have begun to expand the scope of trademark rights in ways that indicate courts are relying on a sense of fundamental unfairness in the trademark context as well. These trends all indicate that courts are relying on a rationale for trademark protections rooted not in market efficiency, but in concerns about unjust enrichment—the same concerns trademarks share with the right of publicity. . . . These trends include an expansion of protections against trademark dilution, an increased willingness to protect trademark owners’ ability to prevent merchandising and other non-trademark uses of their marks, and the expansion of false endorsement claims under § 43(a) of the Lanham Act—particularly in cases involving the use of celebrity identities.”)

¹³⁴ *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 854 n.14 (1982).

¹³⁵ Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 548 (2006).

¹³⁶ MCCARTHY, *supra* note 19, § 2:2.

¹³⁷ *Id.*; see also Bone, *supra* note 135, at 548.

¹³⁸ Stacey L. Dogan & Mark A. Lemley, *A Search-Costs Theory of Limiting Doctrines in Trademark Law*, 97 TRADEMARK REP. 1223, 1223 (2007) (“Over the past two decades, the search costs theory of trademark law has attracted a substantial following among both commentators and courts.”); see also Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1844 (2007) (“It would be difficult to overstate the level of consensus among commentators that the goal of trademark law is -- and always has been -- to improve the quality of information in the marketplace and thereby reduce consumer search costs.”).

¹³⁹ Dogan & Lemley, *supra* note 138, at 1223.

¹⁴⁰ For an interesting, albeit unpersuasive, argument in favor of seller protection as the dominant goal, see generally McKenna, *supra* note 138.

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delineating the contours and limits of trademark rights. This is because a broad conception of goodwill could potentially lead to propertization of trademark rights,¹⁴¹ which runs counter to the pro-information and pro-competition goals of trademark law.¹⁴²

Be that as it may, trademark law has significantly broadened in recent times.¹⁴³ First, the threshold “actionable use” requirement¹⁴⁴ that a plaintiff must satisfy to assert a trademark infringement claim has been significantly watered down. In the past, only branding uses, i.e. uses in which the defendant appropriates his competitor’s mark “to brand or advertise [his goods or] services or to suggest an affiliation with [his competitor],”¹⁴⁵ could be enjoined, but now trademark owners seem increasingly able to assert trademark infringement against defendants who have merely appropriated their marks, but not used them in the branding sense.¹⁴⁶ Second, courts have recognized new forms of actionable confusion. In the past, courts only found confusion if the defendant’s use of the plaintiff’s trademark deceived consumers and thus affected their purchasing decisions.¹⁴⁷ However, the courts have recently expanded the concept of confusion to enjoin uses that cause confusion per se, notwithstanding that they do not affect consumers’ purchasing decisions.¹⁴⁸ Last but not least,¹⁴⁹ trademark law now enjoins even non-confusing uses of trademarks through the trademark dilution doctrine.¹⁵⁰ For example, under the doctrine of dilution by tarnishment, a trademark owner can now protect against damage to his/her trademark’s positive associations or connotations.¹⁵¹

¹⁴¹ Bone, *supra* note 135, at 550 (This happens when goodwill is used to refer to Bone’s concept of “inherent goodwill,” i.e. when a trademark is protected as if it valuable per se).

¹⁴² Dogan & Lemley, *supra* note 138, at 1227.

¹⁴³ For a detailed account of trademark law’s expansion, see McKenna, *supra* note 138, at 1896 (“Courts, with some help from Congress, significantly broadened trademark law during the twentieth century.”).

¹⁴⁴ See, e.g., Lanham Act § 43(a), 45 U.S.C. § 1125(a) (2012) (stating that a claim for trademark infringement can only be sustained, if the defendant “on or in connection with any goods or services, . . . uses in commerce any [mark] . . .”).

¹⁴⁵ Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 805 (2004).

¹⁴⁶ Boyd & Paynter, *supra* note 15, at 86–87 (Boyd & Paynter point out that Courts are increasingly enjoining (1) uses of trademarks as part of products themselves (i.e., merchandising uses); and (2) uses of trademarks on the Internet).

¹⁴⁷ Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 422 (2010).

¹⁴⁸ *Id.* at 414 (focusing on “sponsorship or affiliation” confusion); see also McKenna, *supra* note 138, at 1905–06 (discussing a slew of ways in which the concept of confusion has expanded).

¹⁴⁹ This is not an exhaustive list describing all ways that trademark law has expanded in recent times. The purpose of this account is to merely to highlight three significant changes.

¹⁵⁰ Lanham Act § 43(c), 45 U.S.C. § 1125(c) (2012) (codifying both dilution by blurring and dilution by tarnishment).

¹⁵¹ Back in 2010, Victoria’s Secret successfully sued Moseley under trademark dilution by tarnishment for using “Victor’s Little Secret” or “Victor’s Secret” to sell assorted merchandise, including “sex toys” and other sexually oriented products. *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382 (6th Cir. 2010).

These expansions cannot be defended under the search costs theory, and seem attributable to the courts' growing, albeit questionable, emphasis on the protection of producer goodwill as a legitimate goal of trademark law. The courts appear to be concerned with remedying the "unjust enrichment of defendants who misappropriate the goodwill created by . . . producers of goods and services."¹⁵²

Given that this unjust enrichment impetus underlying trademark law's expansion seems to equally drive the courts' recognition of the right of publicity, Boyd and Paynter have recognized the possibility that doctrines in trademark law may be imported into the right of publicity.¹⁵³ Upon surveying the myriad ways in which trademark law has expanded, it seems that courts have applied an *expanded notion* of "sponsorship or affiliation" confusion to effectively prevent the same harm (i.e., unjust enrichment) that motivated the recognition of a right of publicity. Thus, this raises the possibility that trademark law's limiting doctrines may be adopted in the right of publicity context and tailored to take into account the competing interests involved. Specifically, trademark law's artistic relevance test (hereinafter the *Rogers* test), first articulated in *Rogers v. Grimaldi*,¹⁵⁴ which is used to analyze whether the First Amendment protects the unauthorized artistic uses in question, could be useful to courts seeking to balance celebrities' publicity interests against the public's First Amendment interests.

"Sponsorship or affiliation" confusion is said to occur when a defendant's use of a trademark confuses consumers as "to the affiliation or sponsorship between the trademark owner and the defendant, even if no one thinks the trademark owner actually supplied the defendant's products."¹⁵⁵ This form of actionable confusion is most pertinent to the right of publicity, because in many right of publicity cases celebrities seek to enjoin defendants who use their personas to erroneously suggest to the audience that they endorse the defendants' product.¹⁵⁶ In fact, celebrities in jurisdictions without a right of publicity have had much success in enjoining such uses. Most recently, famous pop star Rihanna successfully sued defendants for their unauthorized uses of her image on their garments under the UK law of passing off,¹⁵⁷ on the basis that consumers would likely wrongly believe that Rihanna had "approved

¹⁵² Boyd & Paynter, *supra* note 15, at 81.

¹⁵³ *Id.* at 71.

¹⁵⁴ *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

¹⁵⁵ Dogan & Lemley, *supra* note 11, at 1192.

¹⁵⁶ Dogan & Lemley, *supra* note 11, at 1193 (citing *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) as one such example. In *Midler*, Bette Midler, a well-known singer, sued Ford for using a "sound-alike" to sing a song identified with her as part of a commercial advertisement for an automobile).

¹⁵⁷ *Fenty v. Arcadia Group Brands Ltd.*, [2015] EWCA Civ 3, [14].

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and authorized” the defendants’ goods.¹⁵⁸

However, courts have expanded the concept of “sponsorship or affiliation” confusion beyond the false endorsement context to prohibit uses that wrongly suggest a relationship between the plaintiff trademark owner and the defendant, but which do not affect consumers’ decision-making processes.¹⁵⁹ Whatever the merits of this *expanded notion* of “sponsorship or affiliation” confusion in the trademark context, the crucial point here is that this *expanded notion* of “sponsorship or affiliation” confusion represents a manipulation of trademark rules to prevent unjust enrichment. In the seminal merchandising case of *Boston Professional Hockey Ass’n v. Dallas Cap & Emblem Manufacturing, Inc.*,¹⁶⁰ the Fifth Circuit Court of Appeals allowed the National Hockey League (NHL) to enjoin the defendant “emblem manufacturer from making and selling embroidered cloth emblems embodying the teams’ registered trademarks and service marks” on the basis of “source or sponsorship” confusion.¹⁶¹ This was ostensibly because of the likelihood that the public would wrongly associate the mark with the teams. As Professors Dogan and Lemley have noted, the court’s only plausible justification for this expansion is that the “defendants are capturing commercial value that ought to belong to the plaintiffs,” which in short is unjust enrichment.¹⁶² Although some subsequent cases have criticized “the Boston Hockey court’s approach to likelihood of confusion in merchandise cases,”¹⁶³ a sizeable number of courts are still finding “sponsorship or affiliation” confusion on the basis of mere (mis)association of the defendant’s product or advertisement with the plaintiff, as a result of the defendant’s misappropriation of the plaintiff’s mark.¹⁶⁴ And in these cases, the courts’ analyses seem strongly influenced by the perceived need to enjoin uses by defendants that they perceive to be unfairly free riding on the trademark owner’s goodwill.¹⁶⁵

Since the impetus underlying judicial expansion of “sponsorship or affiliation” confusion is an unjust enrichment impulse, the *expanded*

¹⁵⁸ *Id.* at [47]–[48].

¹⁵⁹ *See, e.g.*, Lemley & McKenna, *supra* note 147, at 416 (“Uses alleged to cause confusion about more nebulous relationships . . . should be actionable only when a plaintiff can prove the alleged confusion is material to consumers’ decision making.”).

¹⁶⁰ *Bos. Prof’l Hockey Ass’n v. Dall. Cap & Emblem MFG. Inc.*, 510 F.2d 1004 (5th Cir. 1975).

¹⁶¹ Note that the Fifth Circuit does not use this term in the decision, but in effect, the court’s decision recognized this form of confusion as actionable under the Lanham Act.

¹⁶² Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 475 (2005).

¹⁶³ *Id.*

¹⁶⁴ Irene Calboli, *The Case for a Limited Protection of Trademark Merchandising*, 2011 U. ILL. L. REV. 865, 882–84 (2011) (analyzing a number of cases, post *Boston Hockey* to present, in which courts find actionable confusion solely on the basis of “likely consumer association.”).

¹⁶⁵ Dogan & Lemley, *supra* note 162, at 478 (“To begin, we consider the theory of unjust enrichment or free riding that seems to underlie the instincts of courts and trademark owners in many of the merchandising cases.”).

notion of “sponsorship or affiliation” confusion is a useful proxy for unjust enrichment. It follows that limiting doctrines in trademark law may be applicable to the right of publicity context. In particular, the *Rogers* test that many courts have adopted in the trademark context¹⁶⁶ to balance “the public interest in avoiding consumer confusion [against] the public interest in free expression”¹⁶⁷ seems particularly useful as a starting point to balance celebrities’ right of publicity interests against the public’s speech interests.

However, some courts have nevertheless held that the *Rogers* test is irrelevant to the intersection of the right of publicity and the First Amendment. For example, the Ninth Circuit in *Keller v. Elec. Arts Inc.*¹⁶⁸ held that the *Rogers* test, which focuses on preventing consumer confusion, had no currency in right of publicity cases, as publicity rights protected celebrities from unlawful misappropriation.¹⁶⁹ With respect, this reasoning and its concomitant conclusion are flawed. The *Rogers* test may be tailored to the right of publicity context by simply tweaking its focus on consumer confusion to the prevention of “sponsorship or affiliation” confusion, expansively interpreted.¹⁷⁰ The result will be that the *Rogers* test now balances unjust enrichment concerns against speech interests. In Part IV, I will show how the two limbs of the *Rogers* test may be modified to fashion a principled First Amendment defense so that a judicious balance can be struck between the need to protect celebrities’ personality rights and First Amendment values of free speech.

IV. FASHIONING A PRINCIPLED FIRST AMENDMENT DEFENSE WITH THE AID OF TRADEMARK LAW

A. *The Rogers Test*

Trademark law has adopted the *Rogers* test to balance the public interest in free speech against the public interest in avoiding consumer confusion when a trademark is used without authorization in an expressive work.¹⁷¹ Under this test, an unauthorized use of a trademark

¹⁶⁶ MCCARTHY, *supra* note 8, § 8:71 (“The *Rogers* test is used by almost all courts as the way to balance free speech policies with traditional trademark infringement claims. It is also the test most commonly used to balance free speech with false endorsement claims against uses in expressive works.”).

¹⁶⁷ *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

¹⁶⁸ *Keller et al. v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litigation)*, 724 F.3d 1268 (9th Cir. 2013).

¹⁶⁹ *Id.* at 1281 (“Keller’s [right of publicity] claim is that EA has appropriated without permission and without providing compensation, his talent and years of hard work on the football field.”).

¹⁷⁰ This is just another way of referring to the *expansive notion* of “sponsorship or affiliation” confusion.

¹⁷¹ MCCARTHY, *supra* note 19, § 31:149 (“The courts invariably use the *Rogers* two-part test to make the balance between trademark law and free speech when marks are used in expressive

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is not actionable under the Lanham Act “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless [it] explicitly misleads as to the source or the content of the work.”¹⁷²

In *Rogers*, the defendants had used Ginger Rogers’ name without authorization in the title of their movie “Ginger and Fred.”¹⁷³ However, it was found that the defendants’ use of Rogers’ first name in their movie title did not amount to trademark infringement, as it had artistic relevance “to the film’s story”¹⁷⁴ and did not “explicit[ly] indicat[e] that [she] endorsed the film or had a role in producing it.”¹⁷⁵ While the Second Circuit in *Rogers* articulated this test to resolve countervailing expressive and property interests when a mark is used within the title of the work, the courts have subsequently extended its application to unauthorized uses of marks in the content of the work.¹⁷⁶

More importantly, although the *Rogers* test has been regarded as a balancing test specifically tailored to balance trademark rights against speech interests, the Second Circuit in *Rogers* never intended the test to be so restricted. In fact, *Rogers* also involved a right of publicity claim, as the word “Ginger” was clearly an aspect of Ginger Rogers’ identity. While the court did not expressly apply the *Rogers* test to Rogers’ right of publicity claim, it in effect balanced the competing interests¹⁷⁷ in the right of publicity context in the same way as it did for the trademark claim. Specifically, the court noted, “the right of publicity . . . [does not] bar the use of a celebrity’s name in a movie title unless the title was wholly unrelated to the movie¹⁷⁸ or was simply a disguised commercial advertisement¹⁷⁹ for the sale of goods and services.”¹⁸⁰ Accordingly, since the title “Ginger and Fred” was “clearly related to the content of

works.”).

¹⁷² *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

¹⁷³ *Id.*

¹⁷⁴ *Id.* at 1001.

¹⁷⁵ *Id.*

¹⁷⁶ *See, e.g.*, *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (The court applied the *Rogers* test to find that a video game maker did not infringe a strip club owner’s trademark (i.e., “Play Pen”) or trade dress for the depiction of a club called “Pig Pen” in its Grand Theft Auto videogame, stating that “there is no principled reason why [the *Rogers* test] ought not also apply to the use of a trademark in the body of the work.”); MCCARTHY, *supra* note 19, § 10:22 (While the *Rogers* case was decided on the context of a challenge to the title of an expressive work, “[t]he courts have expanded the *Rogers* balancing approach to encompass all ‘works of artistic expression.’”).

¹⁷⁷ That is to say, an individual’s publicity rights vs. the public’s free speech interests.

¹⁷⁸ Mirrors the “artistic relevance” limb in the *Rogers* test. Thus, if the defendant’s use of the plaintiff’s identity has no artistic relevance to the subject of the challenged work, then the plaintiff’s right of publicity outweighs the public’s speech interests.

¹⁷⁹ Mirrors the “explicit misrepresentation” limb in the *Rogers* test. Thus, even if the defendant’s use of the plaintiff’s identity is artistically relevant, it cannot misrepresent that the plaintiff sponsors or endorses the defendant’s product.

¹⁸⁰ *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989) (internal quotation marks omitted).

the movie and was not merely a disguised advertisement for the sale of goods or services or a collateral commercial product,”¹⁸¹ Ginger could not succeed in her right of publicity claim. However, that said, only the Sixth Circuit has adopted the *Rogers* test in the context of the right of publicity¹⁸² and even then, its adoption has been equivocal at best.¹⁸³ In contradistinction, other courts have plainly rejected the *Rogers* test as the apposite test for the right of publicity.¹⁸⁴

As argued in Part III, this Article takes the position that the *Rogers* test provides a good starting point to fashion a principled First Amendment defense for the right of publicity. However, the current formulation of the *Rogers* test does not strike the optimal balance and certain modifications must be made for the *Rogers* test to capture the “starring role.”¹⁸⁵ The inadequacies of the current *Rogers* test and my suggested modifications will be considered in Part IV.B.

B. Critique of the Rogers Test and Proposals for Reform

As can be seen from the Second Circuit’s articulation of the test, the *Rogers* test encompasses two prongs. The “artistic relevance” prong considers whether “the asserted name or mark has any artistic relevance to the subject of the challenged work.”¹⁸⁶ The “explicitly misleading” prong considers “whether the asserted name or mark, even if there is some artistic relevance, explicitly misleads as to the source of the work.”¹⁸⁷

The main perceived benefit of the *Rogers* test is that it “grants broad First Amendment protection without chilling the right of publicity.”¹⁸⁸ This is ostensibly because it offers a bright line standard under which the full panoply of expressive uses are protected without the need for “qualitative valuations into the artistic sufficiency of the

¹⁸¹ *Id.* at 1004–05.

¹⁸² *Parks v LaFace Records*, 329 F.3d 437, 451–452 (6th Cir. 2003) (Remanded case to trial court to apply the *Rogers* test to determine if Outkast’s use of Rosa Parks’ name as title of single, with no reference to Parks in song, except “*Ah ha, hush that fuss; Everybody move to the back of the bus*” was a violation of Parks’ right of publicity.)

¹⁸³ MCCARTHY, *supra* note 8, § 8:71 (“While the Sixth Circuit in the Rosa Parks case used the *Rogers* test for both right of publicity and false endorsement claims, just over a month later another panel of the Sixth Circuit decided the Tiger Woods painting case, applying the Transformative Use Test for the right of publicity claim.”).

¹⁸⁴ *See, e.g.,* Keller et al. v. Elec. Arts Inc. (*In re* NCAA Student-Athlete Name & Likeness Licensing Litigation), 724 F.3d 1268, 1280 (9th Cir. 2013) (The court “disagree[d] that the *Rogers* test should be imported wholesale for right-of-publicity claims,” and preferred California’s transformative use test instead).

¹⁸⁵ Gloria Franke, *The Right of Publicity vs. The First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CAL. L. REV. 945, 991 (2006).

¹⁸⁶ James E. Stewart & Amy A. Lehman, *The First Amendment and the Lanham Act: What is this Thing Called Artistic Relevance?*, 28 COMM’N LAW. 4, 4 (2012).

¹⁸⁷ *Id.*

¹⁸⁸ Geoffrey F. Palachuk, *Transformative Use Test Cannot Keep Pace With Evolving Arts*, 16 U. DEN SPORTS & ENT. L.J. 233, 276 (2014).

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works.”¹⁸⁹

On the other hand, detractors have asserted two main reasons as to why the *Rogers* test ought not be applied to right of publicity cases. The first is that the test is inappropriate because it was “created in response to a [trademark] claim”¹⁹⁰ and thus “is a falsity-based test which does not fit with the right of publicity, which has no requirement of falsity.”¹⁹¹ The reasoning is that since the right of publicity does not share trademark law’s concern of preventing consumer confusion in the marketplace, the latter’s confusion-based test is not relevant.¹⁹² As alluded to above, this argument can be quickly disposed of, as the concept of confusion may be broadly interpreted to cover the interests furthered by the right of publicity, i.e., the prevention of unjust enrichment. The second criticism—that the *Rogers* test fails to accord adequate protection to the publicity rights involved—is more persuasive¹⁹³, and will be addressed in the ensuing paragraphs.

In Parts IV.B.1 and IV.B.2 below, a detailed critique of arguments for and against the *Rogers* test will be undertaken. It will be seen that while the *Rogers* test does have its good points, it suffers from some flaws that undermine its utility in striking a judicious balance between celebrities’ publicity rights and the public’s speech interests. I suggest that two modifications may be made to the *Rogers* test: (1) the “artistic relevance” prong ought to be reformulated to consider whether the defendant’s use has a “distinct expressive purpose,” and (2) the confusion targeted by the “explicitly misleading” prong ought to be the *expanded notion* of “sponsorship or affiliation” confusion. Accordingly, under my modified test, a defendant’s use will be protected if: (1) the use has a “distinct expressive purpose;” *or* (2) the use does not

¹⁸⁹ *Id.* at 259.

¹⁹⁰ Dora Georgescu, *Two Tests Unite to Resolve the Tension Between the First Amendment and the Right of Publicity*, 83 *FORDHAM L. REV.* 907, 929 (2014).

¹⁹¹ MCCARTHY, *supra* note 8, § 8:71.

¹⁹² See *Hart v. Elec. Arts Inc.*, 717 F.3d 141, 158 (3rd Cir. 2013) (“[T]he right of publicity does not implicate the potential for consumer confusion and is therefore potentially broader than the protections offered by the Lanham Act. . . . Indeed, therein lies the weakness of comparing the right of publicity to trademark protections: the right of publicity is broader and, by extension, protects a greater swath of property interests. Thus, it would be unwise for us to adopt a test that hews so closely to traditional trademark principles. Instead, we need a broader, more nuanced test, which helps balance the interests at issue in cases such as the one at bar.”); *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268, 1280 (9th Cir. 2013) (“[W]e disagree that the *Rogers* test should be imported wholesale for right-of-publicity claims. . . . As the history and development of the *Rogers* test makes clear, it was designed to protect consumers from the risk of consumer confusion—the hallmark element of a Lanham Act claim. . . . The right of publicity, on the other hand, does not primarily seek to prevent consumer confusion. . . . Rather it primarily ‘protects a form of intellectual property [in one’s person] that society deems to have some social utility.’”).

¹⁹³ Wesley W. Wintermyer, *Who Framed Rogers v. Grimaldi?: What Protects Trademark Holders Against First Amendment Immunity for Video Games?*, 64 *ALA. L. REV.* 1243, 1256 (2013).

explicitly suggest that the celebrity individual sponsors the defendant's product, or is in any way affiliated with the defendant.

1. The "Artistic Relevance" Prong and the Improved "Distinct Expressive Purpose Inquiry"

Although the Second Circuit did not expressly say so, the "artistic relevance" prong was fashioned with the view of giving overriding weight to the public's interest in free expression. This is exemplified by the court's repeated statements throughout its judgment that a "low threshold of minimal artistic relevance" is enough for First Amendment concerns to prevail over the possibility of consumer confusion.¹⁹⁴ The Second Circuit has stated that although the unauthorized "use of a celebrity's name might implicitly [and falsely] suggest endorsement or sponsorship to some people," this "slight risk" of consumer confusion "is outweighed by the danger of restricting artistic expression."¹⁹⁵ The Ninth Circuit in *E.S.S.*¹⁹⁶ subsequently affirmed this low threshold by holding that all that was required was that "the level of relevance . . . be above zero."¹⁹⁷

As briefly mentioned above, commentators have lauded this low threshold of "artistic relevance" on the basis that it removes "the need for judges to make an artistic scrutiny of the importance of the accused use in the defendant's overall expressive work,"¹⁹⁸ thus protecting a broad range of works that have some sliver of artistic merit. In turn, this purportedly furthers First Amendment goals by ensuring that all expressive uses—regardless of artistic merit—are adequately protected.

This reasoning is ostensibly justified on the basis that the First Amendment, as a constitutional norm, ought to be given overriding weight over both statutory and common law rights of publicity. However, the better view is that while the First Amendment certainly necessitates robust protection of the public's speech interests, it does not entail the complete disregard of the countervailing property interests of individuals. Given that the low threshold of "artistic relevance" is so easily satisfied, this prong of the *Rogers* test is problematic, as it elevates speech interests over celebrity interests in their personas in almost all instances, including those circumstances in which speech interests are minimal, while celebrity interests are substantial.

As Wintermyer points out, almost all unauthorized uses will have some tenuous relevance to the content of the allegedly infringing

¹⁹⁴ *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

¹⁹⁵ *Id.* at 1000.

¹⁹⁶ *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008).

¹⁹⁷ *Id.* at 1100.

¹⁹⁸ MCCARTHY, *supra* note 19, § 31:144.50.

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work.¹⁹⁹ For example, in *Dillinger LLC v. Electronic Arts Inc.*,²⁰⁰ the court held that Electronic Arts' naming of two guns in its Godfather video game after the late John Dillinger, a deceased American gangster and bank robber, was artistically relevant to the video game on the basis of the "Dillinger guns' relationship to the virtual mafia world."²⁰¹ This reasoning is questionable, as arguably naming the guns "Dillinger" had no relevant connection to the expressive content of the video game.²⁰² Although Wintermyer made this argument in the context of unauthorized uses of trademarks in video games, it is clear that his criticism is equally forceful in the right of publicity context, as a celebrity whose name had been used in a similar manner could also assert a right of publicity violation. The only reason why Dillinger's family failed to assert Dillinger's post-mortem right of publicity was because Dillinger had died before the enactment of the Indiana post-mortem right of publicity statute, and the court held that the statute "[did not] apply to personalities who died before its enactment."²⁰³

Thus, the jurisprudence on the "artistic relevance" prong suggests that even a minimally expressive use suffices to outweigh the implicit confusion that could result; and only pure advertising uses, where celebrity personas are used to advertise some unrelated product,²⁰⁴ will be enjoined for failing to satisfy the "artistic relevance" prong. This hardly provides any meaningful protection for celebrities, as it simply assumes that all expressive uses are equally worthy of First Amendment protection. Yet it is unclear why this should be so, as some speech interests are weightier than others. As will be elaborated in the next few paragraphs, while recoding uses of celebrity personas ought to qualify for absolute protection under the First Amendment, passive uses should attract a reduced level of protection. Thus, a First Amendment balancing test that can separate recoding uses from passive uses is sorely needed.

Cultural studies suggest that expressive uses of celebrity personas may be classified as either recoding or passive uses.²⁰⁵ Recoding uses happen when the public depicts the celebrity persona in a way that

¹⁹⁹ Wintermyer, *supra* note 193, at 1256.

²⁰⁰ *Dillinger, LLC v. Elec. Arts, Inc.*, 101 U.S.P.Q.2d 1612 (S.D. Ind. 2011).

²⁰¹ Wintermyer, *supra* note 193, at 1253.

²⁰² *Id.* at 1253 ("The family of John Dillinger . . . argued that because John Dillinger appeared nowhere in the games' plots, naming the guns "Dillinger" bore no relevant connection to any tangible aspect of the games.").

²⁰³ *Dillinger, LLC v. Electronic Arts Inc.*, 795 F.Supp.2d 829, 834 (S.D. Ind. 2011).

²⁰⁴ Dogan, *supra* note 132, at 24.

²⁰⁵ Hughes, *supra* note 101 (arguing that the current orthodoxy places too much emphasis on recoding uses vis-à-vis passive uses); *see also* Tan, *supra* note 68, at 973 ("[U]se of th[e] celebrity] cultural sign may be to reinforce the cultural encoding or to oppose its popular connotation.").

changes the cluster of meanings associated with it.²⁰⁶ On the other hand, passive uses occur when the public relies on the cultural meanings already inherent in the celebrity persona for “her own act of communication.”²⁰⁷ Recoding uses deserve a heightened level of First Amendment protection vis-à-vis passive uses for two reasons.

First, an analysis of Supreme Court decisions suggests that political speech is accorded greatest protection under the First Amendment, followed by art and entertainment, then commercial speech and finally fighting words, obscenity, and child pornography, which receive no First Amendment protection at all.²⁰⁸ Recoding uses deserve greater First Amendment protection, because in contradistinction to passive uses, they may potentially encompass political speech.²⁰⁹ As Professor Tan has pointed out, recoding uses amount to political speech when minority groups depict the celebrity in a way that challenges majoritarian ideals.²¹⁰ This can take many forms, ranging from “heavy-handed lampooning to subtle social criticism.”²¹¹ One good example of this is the “appropriat[ion of] . . . the Judy Garland sign [by the gay community] as an expression of their alternative social identities.”²¹² This is “a form of subtle political activism [through which the gay community] seek[s] affirmative association with society in general.”²¹³ Given the high status political speech is accorded under the First Amendment, any principled First Amendment test must give effect to minority groups’ rights to “appropriate[e] celebrity signs for the construction of their social identities.”²¹⁴

Second, given that recoding uses do not rely on the well-accepted meanings inhering in celebrity personas, there is arguably less concern about unjust enrichment—the main harm against which the right of publicity is targeted.²¹⁵ On the other hand, passive uses, such as literal artistic portraits of celebrities, raise stronger free riding concerns, as they are more likely than not attempts to profit from a celebrity

²⁰⁶ Haemmerli, *supra* note 125, at 432.

²⁰⁷ Hughes, *supra* note 101, at 926.

²⁰⁸ Tan, *supra* note 54, at 14.

²⁰⁹ Passive uses are uses that do not change the well-accepted meaning of the celebrity persona, thus by definition, it does not challenge majoritarian ideals, which is the core of what political speech is about. Hughes, *supra* note 101, at 926.

²¹⁰ Tan, *supra* note 54, at 31 (“If the celebrity semiotic sign is recognized to represent the values of a majoritarian public, then the debate and opposition to these ‘encoded’ ideals may be expressed by using the same signs in a ‘recoded’ manner, and such counterpublic uses can therefore be categorized as ‘political speech.’”).

²¹¹ Tan, *supra* note 54, at 47 (citing *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001)).

²¹² Tan, *supra* note 68, at 970.

²¹³ *Id.*

²¹⁴ *Id.* at 974.

²¹⁵ *See* Part II.D above.

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persona's associative value.

To accord greater protection to celebrities, Wintermyer urges that the courts adopt a First Amendment test that “determine[s] at the threshold whether the use is protected free speech.”²¹⁶ Accordingly, he suggests that courts adopt the transformative use test, which only confers First Amendment protection on uses in which significant new expression has been added to a depiction of the celebrity.²¹⁷ The aim of this suggestion is noble, as a work containing significant transformative elements is more likely to be a recoding use than another work with little or no transformative elements, and thus more likely to constitute protected speech under the First Amendment. However, the transformative use test is inadequate to protect the whole range of free speech concerns implicated by the right of publicity. This is because the transformative use test seems transfixed with the need for visual transformation.²¹⁸ As Professor Tan points out, possible implications of this (mis)emphasis are that there may be “overprotecti[on] of art and entertainment that contribute little to the discussion of public issues, [and] underprotecti[on] of political speech which may be contextually transformative . . . though not visually transformative,”²¹⁹ such that “their recoded meaning . . . carries significant political content.”²²⁰

To address this concern, this Article proposes that the inquiry is better framed by asking whether the defendant's use has a “distinct expressive purpose.”²²¹ This inquiry is essentially a broader interpretation of the transformative use test. A “distinct expressive

²¹⁶ Wintermyer, *supra* note 193, at 1257.

²¹⁷ See *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 25 Cal.4th 387, 404–05 (Cal. 2001) (“When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist. On the other hand, when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity.”) (citations omitted); see also Tan, *supra* note 75, at 973–74: (“The key question [for courts adopting this test] is whether the depiction or imitation of the celebrity is the very sum and substance of the work in question [in which case the defendant is liable for commercial appropriation of identity] or whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather the celebrity's likeness (in which case the First Amendment [trumps the plaintiff's claim]).”).

²¹⁸ Tan, *supra* note 54, at 26.

²¹⁹ *Id.*

²²⁰ *Id.* at 46.

²²¹ Professor Netanel's empirical analysis of US Fair Use cases from 2005–2011 implicitly suggests that the key question today for judicial determination of fair use is whether the defendant's use has a “distinct expressive purpose.” I find this inquiry equally applicable in the right of publicity context. Neil Weinstock Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715, 768 (2011) (“Today, the key question for judicial determination of fair use is not whether the copyright holder would have reasonably consented to the use, but whether the defendant used the work for a different expressive purpose from that for which the work was created.”).

purpose” exists when the defendant’s use of the celebrity sign causes it to take on a different meaning through recoding. This inquiry adequately protects political speech, as it will protect non-visually albeit contextually transformative uses of the celebrity persona. For example, the portrayal of David Beckham kissing another male to further the gay rights movement is clearly not visually transformative—and thus not protectable under the transformative use test—but it evidently serves a distinct expressive purpose and ought to be protected under the First Amendment. This is because Beckham’s celebrity persona, which connotes majoritarian-heterosexuality, has been recoded to connote counter-majoritarian homosexual ideals—political speech at the heart of the First Amendment. Further, this inquiry will not overprotect artistic speech, as adding new visual elements that do not in any way change the usual cluster of meanings associated with the celebrity sign will not constitute a distinct expressive purpose protected by the First Amendment.

One possible criticism of my suggested inquiry parallels that levelled against the transformative use test.²²² The “distinctive expressive purpose” inquiry is amorphous and thus gives judges a significant measure of interpretive freedom.²²³ The worry seems to be that judges will manipulate the inquiry in a way that gives effect to their instinctive feelings as to what the equitable result of the case ought to be. While this criticism is valid, it does not undermine the utility of the “distinct expressive purpose” inquiry. To draw an analogy, while the reasonable man standard in the law of negligence tends to lend itself to judicial manipulation²²⁴ and thus creates some measure of uncertainty,²²⁵ nobody today—at least in the realm of Anglo-American law—seriously challenges that this is the correct standard to be adopted in negligence cases, as the reasonable man standard accords with the

²²² Franke, *supra* note 185, at 972–73 (arguing the vague transformative standard lacks clear guidelines; and thus “encourages judges to be art critics or to base decisions on value judgments or external factors such as the fame of the artist.”); see also Matthew D. Bunker, *Free Speech Meets the Publicity Tort: Transformative Use Analysis in Right of Publicity Law*, 13 *COMM’N L. & POL’Y* 301, 317 (2008) (Bunker argues that the amorphous transformative inquiry leads to “confusion, vagueness, and unpredictability.”).

²²³ *Id.*

²²⁴ Robyn Martin, *Feminist View of the Reasonable Man: An Alternative Approach to Liability in Negligence for Personal Injury*, 23 *ANGLO-AM. L. REV.* 334, 345 (citing Jones, *Textbook on Torts*, 3rd edn (1991), p.104 that “. . . in practice, ‘reasonable care’ can be manipulated to produce standards which range from very low to almost strict liability.”).

²²⁵ John E. Calfee & Richard Craswell, *Some Effects of Uncertainty on Compliance with Legal Standards*, 70 *VA. L. REV.* 965, 968 (1984) (“In the most general terms, uncertainty occurs whenever people cannot be sure what legal consequences will attach to each of their possible courses of action. Such uncertainty arises from a number of sources. Perhaps the most common source (and the easiest to think about) is that people may not know in advance just where the legal standard will be set. For example, it is difficult to predict where a negligence jury will draw the line between ‘reasonable’ and ‘unreasonable’ speeds . . .”).

law's underlying policy considerations.²²⁶ Likewise, the “distinct expressive purpose” standard is justified on the basis of the need to protect recoding uses of celebrity personas, which amount to valuable expression. In addition, legal standards allow judges to make fact-sensitive determinations. Overall, these benefits reduce the persuasiveness of this possible criticism.

2. The “Explicitly Misleading” Prong

In the trademark context, even if the unauthorized use satisfies the “artistic relevance” prong, the defendant will nevertheless be unable to avail himself of the First Amendment's protection if the use amounts to an explicit false endorsement.²²⁷ As Professor McCarthy has noted in his treatise, “[u]se of the modifier ‘explicitly’ . . . mean[s] that to defeat the free speech defense, the deception or confusion must be relatively obvious and express, not subtle and implied.”²²⁸

Given my suggested “distinct expressive purpose” inquiry, one may question the continued need for the “explicitly misleading” prong. One may argue that if my proposed inquiry were indeed capable of protecting recoding uses, there would ostensibly be no need to inquire into whether the use was explicitly misleading, since the First Amendment interests furthered by recoding uses would effectively trump any possible confusion. However, the problem with this argument is that it is premised on the improper assumption that all passive uses of the celebrity persona are not worthy of First Amendment protection. As mentioned above, passive uses refer to uses consistent with the set of cultural meanings already inhering in a particular celebrity persona.²²⁹ Examples include idolatrous commercial uses of the celebrity persona, such as where one draws and sells portraits of a celebrity to signify the celebrity's greatness.²³⁰ While these passive uses do not deserve the same level of protection as recoding uses, as they are unlikely to involve any element of political speech, they do however deserve some measure

²²⁶ Osborne M. Reynolds, Jr., *The Reasonable Man of Negligence Law: A Health Report on the “Odious Creature”*, 23 OKLA. L. REV. 410, 414 (“The reasonable man's development by the courts is generally thought to have been necessitated by the difficulty of applying a constantly changing standard based on individual capabilities and limitations, and the need of those who live in society to expect and require that all others behave to some minimal extent, in a prescribed way.”); see also RESTATEMENT (SECOND) OF TORTS, § 283 (1965).

²²⁷ Rogers v. Grimaldi, 875 F.2d 994, 1000 (2d Cir. 1989) (“Even where a title surpassed the appropriately low threshold of minimal artistic relevance but was explicitly misleading as to source or content, a violation could be found.”).

²²⁸ MCCARTHY, *supra* note 19, § 31:144.50 (internal quotation marks omitted).

²²⁹ See *infra* Part IV.B.1.

²³⁰ ETW Corp. v. Jireh Publ'g Inc., 332 F.3d 915, 936 (6th Cir. 2003) (The alleged infringing work depicted three different images of Tiger Woods on this way to victory in the Masters golf tournament. In finding transformation, the majority stated that the work conveyed a message “that Woods himself will someday join that revered group” and it “communicates and celebrates the value our culture attaches to such events.”).

of First Amendment protection, as they facilitate identity formation.²³¹ Given that “[o]ne’s identity in society is . . . often expressed through cultural signs,”²³² First Amendment values ought to insist that society be given some access to these celebrity cultural signs. For example, many “African-Americans and women . . . may want to be identified with Halle Berry”²³³ through passive idolatrous uses of her persona—e.g. drawing portraits of Halle Berry for sale to other women. In such a situation, withholding all First Amendment protection could have the negative effect of impoverishing our cultural domain. This is because it would effectively engender a mandatory licensing regime under which all celebrity merchandise must be licensed. Such licensing costs reduce the public’s access to such socially valuable products. In some cases, the public’s access may even be completely cut off, as will be the case when the celebrity individual, for some idiosyncratic reason, vehemently refuses to license his/her persona.

These identified negative consequences are evident in the context where celebrity individuals have wielded their publicity rights to enjoin unauthorized, literal depictions of their personas in video games. In the cases of *Hart v. Electronic Arts, Inc.*²³⁴ and *Keller*,²³⁵ former college football players sued video game maker Electronic Arts (“EA”) for right of publicity violations, on the basis that the latter had literally depicted them in their simulated football games without first obtaining their permission. Applying California’s transformative use test in substantially the same way, both appellate courts held that EA could not avail itself of First Amendment protection because the game did not sufficiently transform the players’ likenesses.²³⁶ The Ninth Circuit in *Keller* stated that “EA’s use [did] not qualify for First Amendment protection . . . because it literally recreate[d] Keller in the very setting in which he ha[d] achieved renown.”²³⁷ The same result would also be reached under my proposed “distinctive expressive purpose” inquiry. This is because EA’s literal depiction of the football players’ personas

²³¹ Tan, *supra* note 68, at 973 (“From a cultural studies’ perspective, it is . . . important for the law to give the audience access to the celebrity sign for both forms of expression as part of the identity formation process.”)

²³² *Id.*, at 971.

²³³ *Id.* at 972.

²³⁴ *Hart v. Elec. Arts Inc.*, 717 F.3d 141 (3rd Cir. 2013).

²³⁵ *Keller et al. v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litigation)*, 724 F.3d 1268 (9th Cir. 2013).

²³⁶ *Hart v. Elec. Arts Inc.*, 717 F.3d 141, 170 (3rd Cir. 2013) (“We . . . hold that the *NCAA Football 2004*, *2005* and *2006* games at issue in this case do not sufficiently transform Appellant’s identity to escape the right of publicity claim . . .”); *Keller et al. v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litigation)*, 724 F.3d 1268, 1276 (9th Cir. 2013) (“ . . . we conclude that EA’s use of Keller’s likeness does not contain significant transformative elements such that EA is entitled to the defense as a matter of law.”).

²³⁷ *Keller et al. v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litigation)*, 724 F.3d 1268, 1271 (9th Cir. 2013).

in the setting in which the public ordinarily perceives them (i.e. playing football) neither visually nor contextually transforms them. Accordingly, there is no recoding use of the celebrity persona to communicate a different cluster of meanings that would attract the First Amendment trump. Yet, it is undesirable to allow celebrity individuals to clamp down on all literal depictions of their personas, as realistic portrayals in video games further First Amendment free speech values by providing video game players with an invaluable means of self-expression and consequently promote their identity formation.²³⁸ This is supported by MIT Professor Sherry Turkle's study, in which she opined that because games "presented people with ideas . . . [and new] experiences,"²³⁹ they "provoked self-reflection and stimulated thought."²⁴⁰ In turn, this "promote[d] the creation and adoption of new self-representations."²⁴¹ Thus, mandating video game makers to always acquire exclusive licenses to use celebrity personas in their games could potentially lead to net welfare loss caused by monopolistic conduct. This is because video game makers will in turn have to charge more for the products to offset the licensing fees paid to celebrities, and these socially valuable video games could be priced beyond an average consumer's reach.

This Article takes the position that the "explicitly misleading" prong in the *Rogers* test may be adopted, albeit modified, to strike the appropriate balance between the public's right to make passive uses of celebrity personas and celebrities' publicity rights. Before discussing how a normatively desirable balance may be struck between the competing interests at stake, two preliminary points should be noted.

First, there is a need to state that the confusion that the "explicitly misleading" prong is targeted at in the right of publicity context is not consumer confusion as to the source of the work, but consumer misapprehension that the celebrity individual is in any way affiliated with the defendant. What is required is only a showing that consumers are misinformed. The effect on consumers' decisions is irrelevant. This is because, pursuant to my discussion in Part III, "confusion" here is merely a proxy to determine when free riding is "reprehensible."

Second, vis-à-vis the *Rogers* test, the "explicitly misleading" prong is applied in a different manner under my proposed test. Under the *Rogers* test, a defendant who satisfies the "artistic relevance" prong will only be liable under the Lanham Act if his use overtly suggests that the

²³⁸ See Sherry Turkle, *Constructions and Reconstructions of Self in Virtual Reality: Playing in the MUDs*, 1 MIND, CULTURE, AND ACTIVITY 158 (1994).

²³⁹ *Id.* at 164 (1994).

²⁴⁰ *Id.*

²⁴¹ Andrew K. Przybylski et al., *The Ideal Self at Play: The Appeal of Video Games That Let You Be All You Can Be*, 23 PSYCHOL. SCI. 69, 70 (2012).

plaintiff trademark owner either authored or endorsed the defendant's work.²⁴² The balance was ostensibly struck this way to encourage free expression involving celebrity personas. As the Second Circuit in *Rogers* noted, the confusion potentially caused by an implicit but false suggestion "that the named celebrity had endorsed the work or had a role in producing it. . . . is outweighed by the danger of restricting artistic expression, and the Lanham Act is not applicable."²⁴³ The court justified its construction on the basis of accommodating both "consumer and artistic interests."²⁴⁴

In contrast, my proposed test only renders the "explicitly misleading" prong relevant *if* the defendant fails to satisfy the first prong, i.e. the "distinct expressive purpose" prong. In the right of publicity context, this modification is required to strike the right balance between the competing interests involved, as it extends First Amendment protection to some socially valuable passive uses, while ensuring that those guilty of "reprehensible" free riding on the celebrity persona's associative value do not escape liability. Passive uses explicitly misrepresenting that the celebrity is in some way associated with the defendant are paradigm cases of "reprehensible" free riding, as they clearly manifest the defendant's intent to confuse the consuming public.²⁴⁵ Conversely, implicitly misleading uses are less likely to amount to "reprehensible" free riding, as they tend not to be a manifestation of the defendant's intent to deceive the consuming public. This consideration of the defendant's intent effectively differentiates between "reprehensible" and "non-reprehensible" free riding, as the intent to deceive makes the "unjust enrichment" element seem more prominent. This is demonstrated in the trademark merchandising cases of *Board of Supervisors for La. State Univ. v. Smack Apparel Co.*,²⁴⁶ *University of Ga. Athletic Ass'n v. Laite*,²⁴⁷ and *Boston Hockey*.²⁴⁸ The courts in these cases adopted the *expanded notion* of "sponsorship or affiliation" confusion to effectively "penalize" the defendant for unjust enrichment. Much emphasis was placed on the defendants' intent of deriving benefit from the reputation of the mark holder in concluding

²⁴² *Rogers v. Grimaldi*, 875 F.2d 994, 999–1000 (2d Cir. 1989).

²⁴³ *Id.*

²⁴⁴ *Id.* at 1000.

²⁴⁵ *Bos. Prof'l Hockey Ass'n v. Dall. Cap & Emblem MFG, Inc.*, 510 F.2d 1004, 1012 (5th Cir. 1975) (finding that the defendant's use was likely to cause "sponsorship or affiliation" confusion, the court seems to have been influenced by the fact that the defendant's intent was to confuse the consuming public. The "[d]efendant reproduced Toronto's common law mark on embroidered emblems with the intent that the public recognize and purchase the emblems as the symbol of the Toronto team. In the language of § 1125, defendant used a symbol . . . which tended falsely to represent goods, the embroidered emblems, in commerce.").

²⁴⁶ *Bd. of Supervisors for La. State Univ. v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008).

²⁴⁷ *Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535 (11th Cir. 1985).

²⁴⁸ *Bos. Prof'l Hockey Ass'n v. Dall. Cap & Emblem MFG, Inc.*, 510 F.2d 1004 (5th Cir. 1975).

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that there was a likelihood of confusion.²⁴⁹

The normative desirability of my formulation of the “explicitly misleading” prong may be further demonstrated by applying it to the factual matrices of *Hart*²⁵⁰ and *Keller*.²⁵¹ It is likely that the two cases would have been decided differently under my proposed inquiry. Although the uses of the football players’ personas were passive uses, there was no explicit indication by EA that the football players were in any way associated with EA. This is because the game was not centered on any particular player²⁵² and its objective was to recreate reality so that consumers are, *inter alia*, able to experience football from the perspective of the stars they admire²⁵³. This accords greater protection to the public’s access to celebrity personas as tools for communication and self-expression, without running roughshod over celebrities’ personality rights.

Wintermyer criticizes the “explicitly misleading” prong on the basis that the court’s application in the trademark context affords too little protection to mark holders whose marks have been misappropriated.²⁵⁴ This is purportedly because the courts only find this prong satisfied when there is an “affirmative statement” of sponsorship;²⁵⁵ and this neglects the reality that widespread confusion

²⁴⁹ See, e.g., *Smack Apparel*, 550 F.3d at 483–84 (“Smack’s use of the Universities’ colors and indicia is designed to create the illusion of affiliation with the Universities and essentially obtain a ‘free ride’ by profiting from confusion among the fans of the Universities’ football teams who desire to show support for and affiliation with those teams. This creation of a link in the consumer’s mind between the t-shirts and the Universities and the intent to directly profit therefrom results in ‘an unmistakable aura of deception’ and likelihood of confusion.”).

²⁵⁰ *Hart v. Elec. Arts Inc.*, 717 F.3d 141 (3rd Cir. 2013).

²⁵¹ *Keller et al. v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litigation)*, 724 F.3d 1268, 1276 (9th Cir. 2013).

²⁵² *Hart v. Elec. Arts Inc.*, 717 F.3d 141, 146 (3rd Cir. 2013) (“In no small part, the *NCAA Football* franchise’s success owes to its focus on realism and detail — from realistic sounds, to game mechanics, to team mascots. This focus on realism also ensures that the ‘over 100 virtual teams’ in the game are populated by digital avatars that resemble their real-life counterparts and share their vital and biographical information.”); *Keller et al. v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litigation)*, 724 F.3d 1268, 1287 (9th Cir. 2013) (“In contrast, *NCAA Football* includes . . . thousands of virtual actors.”).

²⁵³ See *Keller et al. v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litigation)*, 724 F.3d 1268, 1285–1286 (9th Cir. 2013) (“Although the game changes from year to year, its most popular features predominately involve role-playing by the gamer. For example, a player can create a virtual image of himself as a potential college football player. The virtual player decides which position he would like to play, then participates in a series of ‘tryouts’ or competes in an entire high school season to gauge his skill. Based on his performance, the virtual player is ranked and available to play at select colleges. The player chooses among the colleges, then assumes the role of a college football player. He also selects a major, the amount of time he wishes to spend on social activities, and practice—all of which may affect the virtual player’s performance. He then plays his position on the college team.”).

²⁵⁴ Wintermyer, *supra* note 193, at 1256.

²⁵⁵ *Id.* at 1254 (citing *Dillinger, LLC v. Elec. Arts Inc.*, 2011 WL 2457678, at *6 (S.D. Ind. 2011)).

could result from “mere uses of a mark.”²⁵⁶ He cited the district court decision of *Dillinger*²⁵⁷ as support for the requirement that an affirmative statement of sponsorship is required for the “explicitly misleading” prong to be satisfied.²⁵⁸ Citing *Rogers* and *E.S.S.*, the district court indeed stated that for “the defendant’s use of the plaintiff’s trademark . . . [t]o be ‘explicitly misleading,’ the defendant’s work must make some affirmative statement of the plaintiff’s sponsorship or endorsement, beyond the mere use of plaintiff’s name or other characteristic.”²⁵⁹

However, it is argued that *Rogers* and *E.S.S.* do not support this categorical rule. *Rogers* concerned an unauthorized use of a trademark in the title of an artistic work and taken in that context, it is clear that if a mere use of a trademark were sufficient to be “explicitly misleading”, it would “render [the] *Rogers* [test] a nullity.”²⁶⁰ However, it would go too far to lay down as a categorical rule that a mere use of a trademark can never be explicitly misleading, especially with regard to a use in the content of an expressive work. While the Ninth Circuit in *E.S.S.* did hold that the use of the plaintiff’s trademarked strip club in the defendant’s Grand Theft Auto video game was not explicitly misleading, its reasoning implicitly suggested that a similar use in other contexts may satisfy the “explicitly misleading” prong. Specifically, the court stated that the defendant’s game did not “revolve around running or patronizing a strip club” and thus “a reasonable consumer would not think [that the strip club owner] also produces a . . . video game like San Andreas.”²⁶¹ This suggests the possibility that if the game really revolved around the strip club, the plaintiff strip club owner would more likely be able to show that the defendant’s use was explicitly misleading. This makes good sense, as a use falling short of an express statement of celebrity sponsorship or affiliation may nevertheless overtly suggest affiliation through its labeling, appearance and surrounding context.²⁶² Thus, in the right of publicity context, it is suggested that the “explicitly misleading” prong ought to be interpreted to enjoin passive uses, which taken in the context of the work as a

²⁵⁶ *Id.* at 1255.

²⁵⁷ *Dillinger, LLC v. Elec. Arts Inc.*, 2011 WL 2457678 (S.D. Ind. 2011).

²⁵⁸ Wintermyer, *supra* note 193, at 1254 (“Applying the explicitly-misleading prong to video games, courts have required ‘some affirmative statement of the plaintiff’s sponsorship or endorsement’ beyond the mere use of the plaintiff’s mark.”).

²⁵⁹ *Dillinger, LLC v. Elec. Arts Inc.*, 2011 WL 2457678 at *6 (S.D. Ind. 2011).

²⁶⁰ *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (citing *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (2002), the Ninth Circuit stated that since a trademark infringement claim presupposed a use of the mark, a mere use cannot vitiate the First Amendment defense, if not the defense would be hollow).

²⁶¹ *Id.* at 1100–01.

²⁶² See *Network Automation v. Advanced Systems Concepts*, 638 F.3d 1137, 1154 (9th Cir. 2011).

whole, clearly suggest to a reasonable person that the celebrity may be associated with the product. This interpretation is consistent with my rationale for adopting the “explicitly misleading” prong, i.e. to distinguish “reprehensible” free riding from “non-reprehensible” free riding, as the “illusion of affiliation”²⁶³ that is created reflects negatively on the defendant’s intent.

Accordingly, an unauthorized use of LeBron James’ persona in a video game revolving around him could potentially satisfy the “explicitly misleading” prong, as an objective person will likely perceive that he is associated in some way with the video game. In contradistinction, if LeBron James’ persona were, as in *Hart and Keller*, used in a realistic basketball video game in which he was just a bit part, it is unlikely that a reasonable person would regard the use to be “explicitly misleading.”

C. Inadequacies of the Other Balancing Tests

For the sake of completeness, three other balancing tests that lower courts have fashioned to resolve conflicts between the First Amendment and the right of publicity shall be briefly considered. The key take-away is that these three tests should not be adopted because they suffer from fatal flaws that undermine their utility in clarifying how publicity interests may be reconciled with First Amendment values. They are the transformative use test, the direct balancing test and the predominant purpose test.

1. The Transformative Use Test

The transformative use test has been adopted by a significant number of cases in California and the Ninth Circuit²⁶⁴, and is the balancing test that most courts use to balance “the plaintiff’s assertion of the right of publicity with the defendant’s assertion of the right to free speech and expression.”²⁶⁵ The key question under this test is whether significant new expression has been added to a depiction of a celebrity such that the interest in promoting free speech concerns outweighs the celebrity’s commercial interest in their personas.²⁶⁶ If

²⁶³ *Bd. of Supervisors for La. State Univ. v. Smack Apparel Co.*, 550 F.3d 465, 483 (5th Cir. 2008).

²⁶⁴ *See, e.g., Keller et al. v. Elec. Arts Inc. (In re NCAA Student-Athlete Name & Likeness Licensing Litigation)*, 724 F.3d 1268 (9th Cir. 2013); *Comedy III Prod., Inc. v. Gary Saderup, Inc.*, 25 Cal.4th 387, 404–05 (Cal. 2001).

²⁶⁵ *McCarthy*, *supra* note 8, § 8:23.

²⁶⁶ *Comedy III*, 25 Cal.4th at 405 (“When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist. . . . On the other hand, when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest

significant new expression has been added, the defendant's use of the plaintiff's persona will "likely be immunized from liability for right of publicity infringement."²⁶⁷ Given that my proffered "distinct expressive purpose" inquiry is related to transformative use test, the reasons as to why the transformative use test is deficient have already been discussed at length²⁶⁸: (1) it does not adequately protect the whole range of speech interests, as it overprotects artistic speech and under protects political speech; and (2) its focus on recoding uses accords too little protection to passive uses of the celebrity persona. Thus, the same discussion will not be repeated here.

2. The Direct Balancing Test

The direct balancing test has been expressly adopted only in the Tenth Circuit²⁶⁹ in the case of *Cardtoons, Inc. v. Major League Baseball Players Association*.²⁷⁰ It weighs the justifications behind the need to protect free speech against the justifications for right of publicity protection, to consider which justifications are more compelling.²⁷¹ The main benefit of this test is that it allows a nuanced weighing of all relevant interests to produce the most normatively desirable result for all possible factual matrices. However, the benefit is undermined by the manifest uncertainty as to how the test will be applied. Given that it is impossible to predict what factors will be taken into account and what weight judges will ascribe to each interest, litigants will have no practical way of determining their rights and liabilities prior to trial. This is extremely problematic, as it subverts the law's norm-guiding function. It is even plausible that third parties may err on the side of caution when using celebrity personas, given that, except in clear cases, they have no way of knowing whether their use is infringing. This chilling effect on free speech could impoverish our cultural domain.

3. The Predominant Purpose Test

Missouri is the lone jurisdiction²⁷² that has adopted the

protected by the right of publicity.").

²⁶⁷ McCarthy, *supra* note 8, § 8:23.

²⁶⁸ See *infra* Part IV.B.1.

²⁶⁹ Although the court in *ETW Corp. v. Jireh Publ'g Inc.*, 332 F.3d 915 (6th Cir. 2003) applied the direct balancing test, it does not count as an express adoption, as the court also sought to apply the transformative use test and the *Rogers* test, without giving a definitive opinion what is the test to be adopted.

²⁷⁰ *Cardtoons, L.C. v. Major League Baseball Players Ass'n.*, 95 F.3d 959, 972 (10th Cir. 1996) (holding that caricatures of baseball players featured in parody trading cards was protected under the First Amendment, as the producer's First Amendment rights outweighed players' right of publicity, the court adopted a direct balancing of free speech rights against property rights).

²⁷¹ Tan, *supra* note 54, at 23 ("The direct balancing approach explicitly engages in the weighing of benefits and harms to determine if the public interest served by the First Amendment . . . outweighs the public interest served by publicity rights . . .").

²⁷² Georgescu, *supra* note 190, at 931.

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predominant purpose test in the case of *Doe v. TCI Cablevision*.²⁷³ This test protects the unauthorized use of an identity if it is predominantly “expressive,” but not one that is predominantly “commercial.”²⁷⁴ The motivation behind the adoption of this test was apparently the perceived need to give effect to celebrities’ personality interests, as the other First Amendment balancing tests²⁷⁵ were seen to preclude a successful right of publicity claim when the unauthorized use of the celebrity persona had some expressive elements.²⁷⁶ While the motivation was legitimate and theoretically defensible, the implementation of the test is practically impossible. In uses where expressive and commercial elements are inextricably intertwined, it is an impossible task to determine the predominant purpose of the use.²⁷⁷ As Dora Georgescu aptly notes, “artists are often motivated by profit, yet this does not reduce the expressive value of their works.”²⁷⁸

CONCLUSION

Ever since the right of publicity was judicially recognized in *Haelan*, courts and commentators alike have grappled with how to articulate meaningful limits on the right. The fear is that, given the utility of celebrity personas as useful expressive tools, an overly expansive right of publicity could potentially interfere with the freedom of speech and expression guaranteed by the First Amendment. Various tests have been articulated to negotiate these muddy waters, but they all have shortcomings that undermine their utility. Building on the insights of various commentators who have suggested that trademark law is the right of publicity’s closest neighbor, this Article looks to trademark law for guidance in fashioning a principled test. Accordingly, since the concept of “sponsorship or affiliation” confusion in trademark law may be interpreted in a way that gives effect to an unjust enrichment impulse,²⁷⁹ this Article suggests that the *Rogers* test, which balances

²⁷³ *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003).

²⁷⁴ *Id.* at 374 (“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 might 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.”).

²⁷⁵ *Id.* (discussing the Restatement’s “relatedness” test and California’s “transformative” test).

²⁷⁶ *Id.* (The relatedness test and the transformative test “operate to preclude a cause of action whenever the use of the name and identity is in any way expressive, regardless of its commercial exploitation.”).

²⁷⁷ Franke, *supra* note 185, at 985 (“How are courts supposed to determine a product’s predominant purpose when making an expressive comment goes hand in hand with making a buck?”) (internal quotation marks omitted).

²⁷⁸ Georgescu, *supra* note 190, at 931.

²⁷⁹ Dogan, *supra* note 132, at 24 (suggesting that the right of publicity “has retained the core unjust-enrichment impulse reflected in the” seminal case of *Haelan*).

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First Amendment values against consumer confusion, may be adopted and modified to provide a principled resolution to the competing interests in the right of publicity: speech interests and the interest in preventing “reprehensible” free riding.