Transformative Use and the Right of Publicity: A Relationship Ready for Revision

Justin L. Rand

Follow this and additional works at: https://repository.uchastings.edu/hastings_comm_ent_law_journal

Part of the Communications Law Commons, Entertainment, Arts, and Sports Law Commons, and the Intellectual Property Law Commons

Recommended Citation
Available at: https://repository.uchastings.edu/hastings_comm_ent_law_journal/vol37/iss2/5

This Commentary is brought to you for free and open access by the Law Journals at UC Hastings Scholarship Repository. It has been accepted for inclusion in Hastings Communications and Entertainment Law Journal by an authorized editor of UC Hastings Scholarship Repository. For more information, please contact wangangela@uchastings.edu.
Transformative Use and the Right of Publicity: A Relationship Ready for Revision

by JUSTIN L. RAND*

I. Introduction .................................................................. 335
II. The Rise of the Right of Publicity ......................................... 338
III. A Delicate Balance: Speech Versus Publicity ......................... 341
   A. The Restatement Test ................................................. 342
   B. The Transformative Use Test ........................................ 346
V. Transforming Right of Publicity Analysis: The Contextual Use Test ......................................................... 354
   A. Factor One: Economic Significance Measured Through Cross-Price Elasticity of Demand ......................... 355
   B. Factor Two: The Transformativeness of the Use .................. 359
   C. Factor Three: The Substantiality of the Use in Relation to the Disputed Work as a Whole .................................. 360
VI. Conclusion: Applying the Contextual Use Test ......................... 362

I. Introduction

A soccer mom can become a celebrity in a second.¹ One YouTube clip can turn a freckled five-year-old into a famous figure overnight.² And viral

---


² See, e.g., WNEP-TV, “Apparently” This Kid Is Awesome, Steals the Show During Interview, YOUTUBE (Aug. 4, 2014), http://www.youtube.com/watch?v=rz5TN7eUeM (showing
videos can transform horrible songs into hit singles. In the digital age, where even society's youngest members are connected by smartphones and social media services, fewer barriers to celebrity exist than ever before. Yet, while advances in technology make notoriety easier to attain, they simultaneously make it more difficult to maintain. With fame becoming increasingly fluid in today’s instantaneous world, celebrities (many of whom are “famous for being famous”) now aggressively guard their images and identities. In their efforts to protect their “right of publicity” against outside encroachment, however, celebrities often implicate another

the initial interview that made Noah Ritter, a young child from Pottstown, Pennsylvania, a popular Internet celebrity; see also The Ellen Show, Ellen Meets the 'Apparently' Kid, Part 1, YOUTUBE (Sept. 11, 2014), http://www.youtube.com/watch?v=QyrbeoDKTo (calling Noah Ritter an “internet sensation” and explaining that his “video has over 15 million views”).

3. See, e.g., iTunes Preview: Rebecca Black, APPLE ITUNES, https://itunes.apple.com/us/artist/rebecca-black/id426285675#fullText (last visited Oct. 17, 2014) (“After attracting less than 1,000 viewers during its first month, ['Friday'] went viral on March 11 ... Before the month was up, [it] cracked the Billboard charts and racked up more than 64 million views on YouTube, despite an almost universally negative response from media outlets.”); see also Rebecca Black, Friday - Rebecca Black - Official Music Video, YOUTUBE (Sept. 16, 2011), http://www.youtube.com/watch?v=kVsfOSbJYO (proving that the song “Friday” is, in fact, quite horrible).


5. See Elizabeth Ann Morgan & Flora Manship, Is Copyright’s Transformative-Use Doctrine a Square Peg in the Round Hole of Right-of-Publicity Cases?, 18 I.P. LITIGATOR 19, 19 (2012) (“As the avenues of media and commerce have broadened in today’s landscape, celebrities’ rights of publicity are implicated more than ever.”); see also 20 Internet Celebrities You Won’t Remember in 10 Years, COMPLEX MAG (Apr. 10, 2013) http://www.complex.com/pop-culture/2013/04/20-internet-celebrities-you-wont-remember-in-10-years/ (“The Internet Celebrity is a fairly new concept to our culture. Thanks to the old social media ... more and more Internet celebrities have had their time in the spotlight ... But like the memories, these Internet celebrities will fade into black.”); Sara Yasin, This Is What the World’s Very First Internet Celebrity Is Doing Today, MIC (Mar. 14, 2014), http://mic.com/articles/85295/this-is-what-the-world-s-very-first-internet- (detailing an early Internet celebrity’s struggle against Sasha Baron Cohen for allegedly using his image in the blockbuster hit “Borat”).

6. See, e.g., Hilton v. Hallmark Cards, 599 F.3d 894, 899 (9th Cir. 2010) (“Paris Hilton is a controversial celebrity known for her lifestyle as a flamboyant heiress. As the saying goes, she is ‘famous for being famous.’”); Galanty Miller, Lifestyles of the Rich & Desperate: The Sociology of Being Famous for Being Famous, HUFFINGTON POST (Oct. 8, 2013, 6:57 PM), http://www.huffingtonpost.com/galanty-miller/lifestyles-of-the-rich-de_b_4051421.html (“Most famous people—the vast majority, in fact—are famous for being famous.”).

7. See, e.g., Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 569 (1977) (“The Ohio Supreme Court agreed that petitioner had ‘a right of publicity’ that gave him ‘personal control over commercial display and exploitation of his personality and the exercise of his talents.’”); Haclan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953) (“This right might be called a ‘right of publicity.’ For it is common knowledge that many prominent persons ... would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses [sic], trains and subways.”).
protected right: freedom of expression under the First Amendment. The tension between these rights is not new, but the digital age makes their interaction far more complex for both celebrities and those attempting to use celebrities’ images, likenesses, and personas. In trying to strike the appropriate balance between these two competing considerations, courts have increasingly turned to the Transformative Use test, which is imported from the Copyright Act’s “fair use” doctrine. This comment argues that the Transformative Use test, when used in isolation, is inappropriate in the right of publicity context. This comment then proposes a multifactor test that would be far more predictable and useful to all parties involved by utilizing economic analysis and established fair use factors.

The remainder of this comment examines the balance between the right of publicity and the First Amendment. Part II traces the origins of the right of publicity, rooted in both statutory and common law. Part III then outlines the different tests that modern courts have used to assess right of publicity claims. Both the Restatement test and the Transformative Use test are discussed within this part. Next, Part IV analyzes Hart v. Electronic Arts, a recent Third Circuit case that applied the Transformative Use test. Following the discussion of Hart, Part V proposes a new multifactor test, the “Contextual Use” test, through which alleged uses of a celebrity’s identity should be analyzed in future cases.

8. See Thomas E. Kadri, Comment, Fumbling the First Amendment: The Right of Publicity Goes 2-0 Against Freedom of Expression, 112 Mich. L. Rev. 1519, 1521 (2014) (“But the right of publicity creates problems for free speech. Friction between two competing ideals—a right to control the use of one’s identity and a right to create expressive works—presents a constitutional dilemma.”); see also Hart v. Elec. Arts, Inc., 717 F.3d 141, 149 (3d Cir. 2013), cert. dismissed, 13-376, 2014 WL 4844579 (U.S. Sept. 30, 2014) (“To resolve the tension between the First Amendment and the right of publicity, we must balance the interests underlying the right to free expression against the interests in protecting the right of publicity.”).

9. See Leichtman et al., supra note 4 (“This tension is not new, but the rapidly changing technological landscape in the digital age presents complicated legal considerations for both celebrities and those who use their images and likenesses.”).

10. See, e.g., Hart, 717 F.3d at 164 (“Finally, we find that of the three tests, the Transformative Use Test is the most consistent with other courts’ ad hoc approaches to right of publicity cases.”); ETW Corp. v. Jireh Publ’g, Inc., 332 F.3d 915, 936 (6th Cir. 2003) (“Finally, we believe that the transformative elements test adopted by the Supreme Court of California in Comedy III Productions, will assist us in determining where the proper balance lies between the First Amendment and Woods’s intellectual property rights.”); No Doubt v. Activision Publ’g, Inc., 122 Cal. Rptr. 3d 397, 415 (Ct. App. 2011) (“Here, we have already concluded that Activision’s use of No Doubt’s avatars is not ‘transformative’ because the avatars are simply precise computer-generated reproductions of the band members that do not meld with the other elements of Band Hero to become, in essence, Activision’s own artistic expression.”).

11. See 17 U.S.C.A. § 107 (West 2012) (“Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work . . . is not an infringement of copyright.”).

Finally, Part VI concludes by applying the Contextual Use test to the facts of *Hart*, highlighting how this test would lead to a different result. In an area of the law that lacks consistency, an appeal to established economic principles and fair use factors may help to avoid confusion and promote predictability moving forward.

II. The Rise of the Right of Publicity

From Roman emperors to Renaissance-era artists, the concept of celebrity is far older than the American legal system. Unlike Marcus Aurelius and Michelangelo, however, celebrities in the digital age are known as much for—sometimes even exclusively for—their secondary endorsement deals, television cameos, and social media accounts. With the scope of fame stretching beyond a celebrity's specific talent or skillset, monetizing one's notoriety is increasingly dependent on protection against outside uses of one's image, likeness, and persona. Yet, pecuniary gain was not the underlying justification for the first courts to recognize a "right of publicity." Instead, the promotion of creativity, safeguarding of the fruits of an individual's labor, prevention of consumer confusion, and avoidance of unjust enrichment collectively drove the initial decisions creating the right. These original justifications have grown increasingly strained as the concept of "celebrity" continues to expand and each generation further tests the limits of the right of publicity.

The seeds of right of publicity jurisprudence were planted in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* The plaintiff in *Haelan*—an enterprising chewing gum company—acquired a baseball card business and entered into contracts with a group of professional baseball players for the use of their photographs. Pursuant to the contracts, the plaintiff owned the exclusive right to use the players' images on baseball cards, which were important for promoting gum sales. The defendant, a rival chewing gum company, was aware of the negative covenants between the

---

13. See Leichtman et al., supra note 4, at 29 ("Few celebrities today have a single discrete act from which they derive their entire income. Rather, today's celebrity income stream is far more diverse.").

14. Kadri, supra note 8, at 1521 ("The right of publicity advances a variety of societal interests, including 'fostering creativity, safeguarding the individual's enjoyment of the fruits of her labors, preventing consumer deception, and preventing unjust enrichment.'" (quoting Roberta Rosenthal Kwall, *The Right of Publicity v. The First Amendment: A Property and Liability Rule Analysis* 70 Ind. L.J. 47, 54 (1994))); see also Palmer v. Schonhorn Enters., Inc., 232 A.2d 458, 462 (N.J. Super. Ct. Ch. Div. 1967) ("Perhaps the basic and underlying theory is that a person has the right to enjoy the fruits of his own industry free from unjustified interference.").

15. 202 F.2d 866, 868 (2d Cir. 1953).

16. Id. at 867.

17. Id.
plaintiff and the players, and induced the players to sign similar contracts with the defendant. After finding that any inducement by the defendant constituted tortious interference with the plaintiff’s contracts, Judge Frank went further. He found, for the first time, a “right of publicity” within the penumbra of New York state privacy statutes. Because the plaintiff held exclusive control over the players’ “right of publicity” through contract, the defendant’s use of their photographs violated that right.

Following its modest roots in baseball cards and chewing gum, the newly minted “right of publicity” was recognized in many different contexts. In Ettore v. Philco Television Broadcasting Corp., for example, the court applied the same New York civil rights statutes that supported the holding in Haelan, to uphold a boxer’s right of publicity claim against unauthorized broadcasts of his fights. The Haelan decision also guided the court in Hogan v. A. S. Barnes & Co. to find that a publishing company violated golf great Ben Hogan’s right of publicity when the company printed unauthorized photographs of him in a book. As the Hogan court explained, however, the contours of the right of publicity remained undefined, and “the lack of direct precedent” forced lower courts to act as “laboratories . . . working out the development of a new common law right.” Two decades passed before any direct precedent became available.

After baffling lower courts for many years, the right of publicity was finally considered by the United States Supreme Court in 1977. In Zacchini v. Scripps-Howard Broadcasting Co., the plaintiff was well known for his fifteen-second “human cannonball” act. He brought a claim against the defendant, an Ohio broadcasting company, for wrongfully appropriating his “professional property” by taping and broadcasting his

18. Id.
19. Id. at 867–68 (“If defendant, knowing of the contract, deliberately induced the ballplayer to break that promise, defendant behaved tortiously.”).
20. Id. at 868 (“We think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture . . . .”). Judge Frank based his reasoning on several New York state privacy statutes, including sections 50 and 51 of the Civil Rights Law.
21. Id. at 869.
22. Ettore v. Philco Television Broad. Corp., 229 F.2d 481, 493 (3d Cir. 1956) (“But the cause of action created by the New York Civil Rights Law was intended to protect the individual’s right in his own personality, to protect a personal as distinguished from a property right.”).
23. Hogan v. A.S. Barnes & Co., 114 U.S.P.Q. 314, No. 8645, 1957 WL 7316, at *1 (Pa. Com. Pl. June 19, 1957) (“While we do not feel it necessary to place a label upon the property right which the court is protecting, if we must do so, we feel that ‘right of publicity’ is as apt a label as any other that might be suggested.”).
24. Id. (internal quotation marks omitted).
full performance. The Ohio trial court granted the defendant’s motion for summary judgment. The state court of appeal unanimously reversed, holding that no First Amendment privilege guarded the defendant from the plaintiff’s conversion and common law copyright infringement claims. The concurring judge explicitly mentioned the plaintiff’s “right of publicity” in the filming of his human cannonball act. The Ohio Supreme Court also recognized the plaintiff’s state law “right to the publicity value of his performance,” but it nevertheless found that the defendant “ha[d] a privilege to report . . . matters of legitimate public interest.” Finally, the Supreme Court granted certiorari on the question of whether the First and Fourteenth Amendments “immunized the [defendant] from damages for its alleged infringement” of the right of publicity.

Justice White, writing for the majority, reversed the Ohio Supreme Court. He explained that a state law right of publicity functions to compensate entertainers “for the time and effort” dedicated to performing and “provide[s] an economic incentive” to create future creative acts—the “same consideration under[lying] the patent and copyright laws long enforced” by the Court. He emphasized the importance of the defendant’s broadcasting the full human cannonball performance, finding that this wholesale appropriation went “to the heart of [the plaintiff’s] ability to earn a living as an entertainer.” The Court explained that although the State of Ohio could privilege the press as a matter of state law, the lower court’s holding that the First and Fourteenth Amendments compelled this result was error. The discussion of the right of publicity in Zacchini remains the Court’s only guidance on the topic.

Following Zacchini, many states began to fashion their own statutory and common law rights of publicity. At present, the vast majority of the states protect an individual’s “right of publicity” or “right to prevent the

26. Id. at 564 (citations omitted).
27. Id.
28. Id.
29. Id.
30. Id. at 565 (citing 47 Ohio St. 2d 224, 351 N.E.2d 454, 455 (1976)).
31. Id.
32. Id.
33. Id. at 578–79.
34. Id. at 576.
35. Id.
36. Id.
unauthorized use of his name, likeness, and other indicia of identity." Certain state legislatures have also extended publicity protections to a period of years after a celebrity’s death, with a dozen jurisdictions now recognizing a postmortem right of publicity by statute.

Whether in life or in death, however, the scope of the right of publicity has enlarged dramatically since the *Haelan* decision. Courts now apply the right within the context of the digital age’s communications revolution, though it was developed well before the sale of even the first color television set. Whether implicated by video games, nationwide advertising campaigns or platinum-selling records, a wide swath of expression across various mediums is now potentially subject to “right of publicity” protections. Yet, this expansion is not without limits, and myriad decisions have now considered the proper balance between free expression and publicity protections. These decisions, and the various tests used to reach their results, however, are seriously flawed.

### III. A Delicate Balance: Speech Versus Publicity

Before discussing potential tests, it is necessary to understand the competing right that is balanced against the right of publicity. Unlike the right of publicity, freedom of expression is based in the First Amendment of the Constitution. The Amendment directs Congress to “make no law... abridging the freedom of speech,” and is applicable to states

---

38. See, e.g., *CAL. CIV. CODE* § 3344 (West 2013); *MASS. GEN. LAWS ANN.* ch. 214, § 3A (2014); *N.Y. CIV. RIGHTS LAW* §§ 50–51 (McKinney 2014); *OHIO REV. CODE ANN.* § 2741.01 (West 2014); see also *Thomas F. Cotter & Irina Y. Dmitrieva, Integrating the Right of Publicity with First Amendment and Copyright Preemption Analysis*, 33 COLUM. J.L. & ARTS 165, 166 (2010) (internal quotation marks omitted); Kadi, *supra* note 8, at 1521 (citing Cotter & Dmitrieva, *supra* and explaining the origins of the right of publicity); Morgan & Manship, *supra* note 5, at 21 (“Today, most states recognize the right of publicity, either through legislation or through common law.”); Leichtman, *supra* note 4, at 28 (“Over the last 48 years since *Haelan*, 19 states have created a statutory right of publicity and 28 more recognize the right via common law.”).

39. See, e.g., *CAL. CIV. CODE* § 3344.1; *FLA. STAT. ANN.* § 540.08(5) (West 2007); *IND. CODE ANN.* § 32-36-1-8(a) (West 2014); *OKLA. STAT. ANN.* tit. 12, § 1448(G) (West 2014); see also *Leichtman, supra* note 4, at 29, 31 (“Only a handful of jurisdictions recognize a statutory postmortem or descendible right of publicity.”).

40. See, e.g., *Hart*, 717 F.3d at 141 (college football); *No Doubt v. Activision Publ’g, Inc.*, 122 Cal. Rptr. 3d 397 (Ct. App. 2011) (rock band simulation).


42. See, e.g., *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003) (hip-hop group OutKast’s song “Rosa Parks”).

43. See U.S. CONST. amend. I.

44. *Id.*
through the Due Process Clause of the Fourteenth Amendment.45 By prohibiting government interference "with the individual’s right to receive and disseminate ideas and information,"46 the Amendment is a cornerstone of democratic society.47 Protecting freedom of expression promotes "the individual need to express and explore ideas, the right to learn and think about a wide range of topics, association with those of common interests, personal autonomy and fulfillment, and no doubt many others."48 In the digital age, where people are developing new forms of expression every day, ideas are expressed through many different mediums. Courts attempt to balance an individual’s freedom of expression with a celebrity’s right of publicity and, therefore, are forced to operate in a highly dynamic area of the law. In this context, modern courts have developed various tests to help strike the correct balance. The two most prominent tests currently in-use—the Restatement and Transformative Use tests—are discussed below.

A. The Restatement Test

The focus of the Restatement test49 is the connection between the celebrity’s image used and the work as a whole.50 Rooted in section 46 of the Restatement of Unfair Competition, the test bars an individual from "appropriat[ing] the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade."51 The comments to section 47 make clear that the right of publicity "is fundamentally constrained by the public and constitutional interest in freedom of expression."52 The First Amendment, however, may

45. U.S. CONST. amend. XIV; see also Angelica M. Sinopole, "No Saggy Pants": A Review of the First Amendment Issues Presented by the State's Regulation of Fashion in Public Streets, 113 PENN ST. L. REV. 329, 335 (2008) (outlining the historical development of the First Amendment.").


47. Id. at 29–30; see also Hart v. Elec. Arts, Inc., 717 F.3d 141, 149 (3d Cir. 2013), cert. dismissed, 13-376, 2014 WL 4844579 (U.S. Sept. 30, 2014) (citing Whitney v. California, 274 U.S. 357, 376 (1927) (Brandeis, J., concurring) (opining that "[i]t is the function of speech to free men from the bondage of irrational fears")).


49. As noted by Judge Greenaway in Hart, the Restatement test is also called the "Relatedness Test" and the "Rogers Test" by various courts and commentators. 717 F.3d at 154–55 n.17.

50. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995) ("One who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability."); see also Hart, 717 F.3d at 155–56.

51. Id.

52. Id. § 47 cmt. c.
not protect the use where "the [celebrity's] name or likeness is used solely to attract attention to a work that is not related to the identified person."\(^3\)

With the clarification of comment (c) in mind, courts have applied the Restatement test to focus on the relation between the use of the celebrity's identity to the larger work. Only where the use is wholly unrelated to the work, meaning that "the public interest in avoiding consumer confusion outweighs the public interest in free expression," will the right of publicity prohibit a particular use under the test.\(^4\)

The Second Circuit was the first court to apply the Restatement test to balance free expression against a right of publicity claim.\(^5\) In Rogers v. Grimaldi,\(^6\) the plaintiff was an award-winning actress known for her roles in films with Fred Astaire.\(^7\) The defendant produced and distributed a film without the plaintiff's consent titled "Ginger and Fred."\(^8\) Soon after the film was distributed, the plaintiff brought claims under the Lanham Act,\(^9\) alleging, inter alia, that the film title violated section 43(a) by creating a false impression that she had sponsored or endorsed the film.\(^10\) She also alleged that the film title violated her common law right of publicity.\(^11\) The district court found the defendant's use of the plaintiff's name in the film title to be "artistic expression [rather than the commercial speech]" covered by the Lanham Act.\(^12\) In granting the defendant's summary judgment motion, Judge Sweet held that the First Amendment also blocked the plaintiff's right of publicity claim.\(^13\)

Judge Newman, writing for the Second Circuit panel, affirmed the district court's decision on alternative grounds.\(^14\) While the lower court erred in finding that the First Amendment insulated the defendant from liability under the Lanham Act, it nevertheless could properly be considered in defining the scope of the Act.\(^15\) Overextending the prohibitions of the Lanham Act to all film titles, the panel reasoned, would "intrude" on,

---

53. Id.
55. Indeed, as mentioned above, many courts have labeled this test as the "Rogers Test."
See supra text accompanying note 50.
56. See Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989).
57. Id. at 996.
58. Id.
60. Rogers, 875 F.2d at 997.
61. Id.
63. Id. at 124.
64. Rogers, 875 F.2d at 996.
65. Id. at 998.
and “conflict” with, freedom of expression. Rather than this approach, the panel proposed a new test drawn from California and New York state case law. Under this newly articulated standard, the right of publicity would not “bar the use of a celebrity’s name in a [movie title]” unless the title was “wholly unrelated” to the movie or was “simply a disguised commercial advertisement for the sale of goods or services.” As comment (c) on section 47 of the Restatement of Unfair Competition explained, only totally unrelated uses of a celebrity’s name or image would attract undeserved public attention and serve to confuse consumers. The Second Circuit affirmed the judgment below, holding that the “Ginger and Fred” title did not violate the plaintiff’s right of publicity because the title was “clearly related” to the film’s subject matter and was not a furtive advertisement for the product.

Several circuits followed suit after the Second Circuit’s application of the Restatement test in Rogers. In Mattel, Inc. v. Walking Mountain Productions, the plaintiff was the producer of the iconic “Barbie” doll and owner of the respective intellectual property rights. The defendant was an independent photographer who created “Food Chain Barbie,” a portfolio of seventy-eight pictures showing the plaintiff’s dolls in “absurd” and “sexualized” positions. Unsatisfied with the defendant’s justification that his photos were a serious social critique of the objectification of women, the plaintiff brought claims for trademark, copyright, and trade dress infringement. The district court granted the defendant’s motion for summary judgment, finding that his use of the “Barbie” copyrights were a fair use.
The plaintiff's trademark claims fared no better because there was no likelihood of consumer confusion caused by the defendant's works.74

The Ninth Circuit affirmed the lower court's grant of summary judgment to the defendant.75 After discussing (and affirming) the district court's findings on copyright infringement, the panel turned to the plaintiff's trademark claim under the Lanham Act.76 While analyzing claims under the Act typically focused on the likelihood of consumer confusion, Judge Pregerson reasoned that certain marks could "transcend their identifying purpose" and become part of the public discourse.77 A famous mark could "assume[] a role outside the bounds of trademark law under these circumstances."78 The panel found that the "Barbie" mark had assumed such a role. Because the mark was so culturally significant, First Amendment considerations had to be balanced against the plaintiff's Lanham Act claims.79

To strike this balance, the panel turned to the Restatement test from Rogers. The Ninth Circuit emphasized that liability under the Lanham Act is appropriate only where the use of the celebrity's name had "no artistic relevance to the underlying work whatsoever or, if it has some artistic relevance, where the title explicitly misleads as to the source or the content of the work."80 First, the court held that the defendant's use of the Barbie was highly relevant to his photographs, as the title accurately described the content of the work.81 Second, the photograph titles would present no danger of misleading consumers into thinking that the plaintiff endorsed or sponsored the work.82 As in Rogers, the "public interest in [the defendant's] free and artistic expression" was held to outweigh any danger of consumer confusion.

Finally, the Sixth Circuit applied the Restatement test in Parks v. LaFace Records.83 There, the defendants were a popular music duo, and its record label used the plaintiff's name as the title of a song.84 In response, the plaintiff—an infamous civil rights figure—alleged, inter alia, that the

74. Mattel, 353 F.3d at 798.
75. Id. at 816.
76. Id. at 806.
77. Id. at 807 (internal quotation marks omitted).
78. Id. (alteration in original).
79. Id.
80. Id. (quoting Rogers, 875 F.3d at 299) (internal quotation marks omitted).
81. Id.
82. Id.
83. 329 F.3d 437 (6th Cir.2003). This decision was mentioned and summarized in Hart, 717 F.3d at 156–57.
84. Parks, 329 F.3d at 441.
After the district court granted the defendant’s motion for summary judgment, the Sixth Circuit reversed as to the plaintiff’s Lanham Act and right of publicity claims. The panel began its analysis of the plaintiff’s right of publicity claim by considering three different tests used to balance First Amendment concerns: (1) the likelihood of confusion factors used in commercial trademark cases; (2) the “Alternative Avenues” test advocated by the plaintiff; and (3) the Restatement test from Rogers. The first two tests failed to “accord[] adequate weight to the First Amendment interests” according to the panel. By contrast, the Restatement test was found to be “the most appropriate method to balance the public interest in avoiding consumer confusion with the public interest in free expression.” After noting that the Second, Fifth, and Ninth Circuits had previously adopted this test, the panel held that, under the first prong, the relatedness between the work and the plaintiff’s name was a disputed issue of fact. Consumer confusion is likely to follow where the use of the plaintiff’s name in a song title is wholly unrelated to the content. As a result, the panel reversed the district court’s grant of summary judgment to the defendants on the right of publicity claim.

B. The Transformative Use Test

As the Parks court’s consideration of three early balancing tests indicates, the struggle to find a proper analytical framework for right of

85. Id.
86. Id. at 442.
87. Id. at 446–49. As the omission from this comment may indicate, courts have not applied the first two of these tests in the digital age. Both tests were seen as alternatives during the 1980s and 1990s, but no federal court of appeals has adopted them in the new millennium. See, e.g., Hart v. Elec. Arts, Inc., 717 F.3d 141, 153 (3d Cir. 2013), cert. dismissed, 13-376, 2014 WL 4844579 (U.S. Sept. 30, 2014) (“Following Zacchini, courts began developing more systematized balancing tests for resolving conflicts between the right of publicity and the First Amendment. . . . Of these, the trademark-based Rogers Test, and the copyright-based Transformative Use tests are the most well-established.”).
88. Parks, 329 F.3d at 448–49.
89. Id. at 450.
90. Id. at 452–53; see also id. at 453 (“We believe that reasonable persons could conclude that there is no relationship of any kind between Rosa Parks’ name and the content of the song—a song that is nothing more and nothing less than a paean announcing the triumph of superior people in the entertainment business over inferior people in that business.”).
91. Id. at 453–55; see also id. at 453–54 (“The use of this woman’s name unquestionably was a good marketing tool[,] . . . but its use could be found by a reasonable finder of fact to be a flagrant deception on the public regarding the actual content of this song.”).
92. Id. at 458.
publicity claims is not a digital age phenomenon. To litigants and commentators alike, this decades-old effort has resembled more of a Three Stooges routine than the development of well-reasoned and predictable jurisprudence. At the turn of the new millennium, however, while a number of courts were still extending the Restatement test, the foundation of a different type of analysis was being laid. This new approach, which became known as the Transformative Use test, was borrowed from the fair use doctrine of copyright law. The doctrine provides a nonexhaustive, four-factor balancing test, which can shield against copyright infringement claims. Under the Fair Use doctrine, the first factor requires courts to analyze "the purpose and character" of the allegedly infringing use. Relevant to this inquiry is the degree to which the allegedly infringing use transforms the original. On the one hand, where the secondary use "merely supersedes the objects of the original creation," it is not transformative. On the other hand, where the use "adds something new [to the original], with a further purpose or different character," it is considered transformative. Therefore, courts assessing the degree of transformation must ask whether the allegedly infringing use is a mere

93. See, e.g., Doe v. TCI Cablevision, 110 S.W.3d 363, 372 (Mo. 2003) ("[W]e next address whether the right of publicity claim is nevertheless prohibited by the First Amendment. Courts throughout the country have struggled with this issue.").

94. See The Three Stooges, The Three Stooges—Slaps, Smacks, and Pokes, YOUTUBE (Oct. 1, 2010), http://www.youtube.com/watch?v=Mw0riLqQBj0 (displaying the elements of suddenness, surprise, and humor that made the Three Stooges popular).

95. See Mark S. Lee, Agents of Chaos: Judicial Confusion in Defining the Right of Publicity—Free Speech Interface, 23 LOY. L.A. ENT. L. REV. 471, 488 (2003) ("In the right of publicity setting, trademark law's unsatisfying splintering of analytic methodologies has only intensified. Lacking even the grounding of trademark law's 'likelihood of confusion' requirements, courts faced with right of publicity-free speech issues have borrowed or invented varying methodologies to address them.").

96. See William K. Smith, Comment, Saving Face: Adopting a Right of Publicity to Protect North Carolinians in an Increasingly Digital World, 92 N.C. L. REV. 2065, 2089 (2014) (defining the Transformative Use test as "[i]mporting the first factor of the Fair Use Test employed in copyright law").

97. 17 U.S.C.A. § 107 (West 2012) ("Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work . . . is not an infringement of copyright.").

98. Id. § 107(1).

99. See, e.g., Monge v. Maya Magazines, Inc., 688 F.3d 1164, 1174 (9th Cir. 2012) ("[T]he more transformative the new work, the less will be the significance of other factors, like commercialism, which may weigh against a finding of fair use.") (alteration in original); see also Michael D. Murray, What Is Transformative? An Explanatory Synthesis of the Convergence of Transformation and Predominant Purpose in Copyright Fair Use Law, 11 CHI.-KENT J. INTELL. PROP. 260, 261 (2012) ("The transformative test has changed copyright law, and it has become the defining standard for fair use.").


101. Id. at 705.
copy, or only incorporates the original as one of the "raw material[s]" for new expression.\textsuperscript{102}

The Supreme Court of California was the first to apply the Transformative Use test in \textit{Comedy III Productions, Inc. v. Gary Saderup, Inc.}, a case that fittingly involved \textit{The Three Stooges}.\textsuperscript{103} The plaintiffs there, registered owners of all rights to the Stooges characters,\textsuperscript{104} brought a right of publicity claim against an artist who reproduced lithographic prints and T-shirts featuring the comedy troupe's images.\textsuperscript{105} Instead of selecting an established test, the court fashioned its own "balancing test between the First Amendment and the right of publicity based on whether the work in question add[ed] significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation."\textsuperscript{106} In attempting to decide on which side of the scale the defendant's use fell, the court defined a transformative use\textsuperscript{107} as one that:

- "adds something new, with a further purpose or different character, altering the first with new expression, meaning or message";\textsuperscript{108}
- "adds significant expression beyond" the "literal depiction or imitation of a celebrity for commercial gain";\textsuperscript{109}
- uses the celebrity's likeness as "one of the 'raw materials' from which an original work is synthesized," as opposed to having "the depiction or imitation of the celebrity [be] the very sum and substance of the work in question";\textsuperscript{109}
- "so transforms [a likeness] that it has become primarily the defendant's own expression rather than the celebrity's likeness,"

\begin{flushleft}
\textsuperscript{102} Castle Rock Entm't, Inc. v. Carol Publ'g Grp., Inc., 150 F.3d 132, 141 (2d Cir. 1998) (quoting Pierre N. Leval, Toward a Fair Use Standard, 103 HARV. L. REV. 1105, 1111 (1990)).
\textsuperscript{103} 21 P.3d 797 (Cal. 2001).
\textsuperscript{104} The members of \textit{The Three Stooges} troupe were defined as "deceased personalities" under the relevant California statute. \textit{See} CAL. CIV. CODE § 990(a)-(g) (West 1999). The State of California recognized a posthumous right of publicity that remained effective for fifty years. \textit{Comedy III}, 21 P.3d at 800 (citing CAL. CIV. CODE § 990(g)). By the time the \textit{Comedy III} opinion was written, the period increased to seventy years. \textit{See} CAL. CIV. CODE § 3344.1(g) (West 2015).
\textsuperscript{105} \textit{Comedy III}, 21 P.3d at 800.
\textsuperscript{106} Id. at 799.
\textsuperscript{107} Professor Eugene Volokh first separated out these different definitions of transformative use provided by the \textit{Comedy III} court. \textit{See} Eugene Volokh, Freedom of Speech and the Right of Publicity, 40 HOUS. L. REV. 903, 914–15 (2004) (arguing that the transformative use test is both over-inclusive and under-inclusive).
\textsuperscript{109} Id.
\textsuperscript{110} Id. at 809.
\end{flushleft}
with the term "expression" "mean[ing] expression of something other than the likeness of the celebrity";\textsuperscript{111}
- involves "the creative elements predominat[ing] in the work" rather than "the literal and imitative";\textsuperscript{112}
- involves the artist "contribut[ing] something more than a merely trivial variation, [but creating] something recognizably his own."\textsuperscript{113}

The Comedy III court found that the defendant's work did not meet any of the above factors, failing to transform or make a creative contribution to the original Three Stooges image.\textsuperscript{114} Without a significant transformation, the use was held to fall outside the bounds of First Amendment protections.\textsuperscript{115}

A federal court of appeals followed the Comedy III approach less than one year later in Hoffman v. Capital Cities/ABC, Inc.\textsuperscript{116} In Hoffman, the plaintiff, a famous actor, brought a right of publicity claim against the defendants for their unauthorized publishing of his photograph in their magazine.\textsuperscript{117} Specifically, the plaintiff's face from one of his notable movie roles was placed on a computer-generated body wearing women's clothing.\textsuperscript{118} Applying the California Supreme Court's rationale in Comedy III, the Hoffman court found the defendants' use to be sufficiently transformative to constitute noncommercial speech under the First Amendment.\textsuperscript{119} Unlike the t-shirts featuring the Three Stooges, which took "the form of a literal depiction or imitation," the magazine image using only the plaintiff's face was found to leave "no question that ... [the] photograph contained significant transformative elements."\textsuperscript{120} As noncommercial speech,\textsuperscript{121} the defendant's use was afforded "full" protection under the First Amendment.\textsuperscript{122}

Courts have expanded the application of the Transformative Use test to uses of celebrity images outside of traditional still photographs. For example, in Winter v. DC Comics, the Supreme Court of California found that the defendant's use of two half-man, half-worm comic book villains, each having long white hair and albino features, did not violate Johnny and

\textsuperscript{111} Id.
\textsuperscript{112} Id.
\textsuperscript{113} Id. at 810 (quoting L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 490 (2d Cir. 1976) (internal quotation marks omitted)).
\textsuperscript{114} Id. at 811.
\textsuperscript{115} Id.
\textsuperscript{116} Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001).
\textsuperscript{117} Id. at 1182–83.
\textsuperscript{118} Id. at 1183.
\textsuperscript{119} Id. at 1184 & n.2, 1189.
\textsuperscript{120} Id. at 1184 n.2.
\textsuperscript{121} Id.
\textsuperscript{122} Id. at 1186.
Edgar Winter's right of publicity. \textsuperscript{123} Defendant's heinous worm characters, whose comic book names were "Johnny and Edgar Autumn," were held to be sufficiently transformative of the plaintiffs' images and likeness. \textsuperscript{124} The court reasoned that these "fanciful" and "creative characters" constituted no literal depiction of the musicians, and Winter Brothers fans would not view the images of the worms as substitutes for actual photos of the men. \textsuperscript{125} Similarly, in \textit{ETW Corp. v. Jireh Publishing, Inc.}, the Sixth Circuit utilized the Transformative Use test to find that the First Amendment protected a painting that incorporated three literal likenesses of Tiger Woods against right of publicity claims. \textsuperscript{126} While the painting featured literal depictions of Woods, it also included likenesses of Augusta National Clubhouse and other championship golfers to convey a metaphorical message that Woods would one day join the ranks of golf's greats. \textsuperscript{127} Because these "significant transformative elements" gave new meaning to the work, Woods' right of publicity claims failed. \textsuperscript{128}

Finally, the digital age forced courts to apply the Transformative Use test to mediums outside of the historic boundaries of the First Amendment. In \textit{Kirby v. Sega America, Inc.}, for example, the California Court of Appeal applied the Transformative Use test to decide a right of publicity claim in the context of video games. \textsuperscript{129} The plaintiff—a musician and dancer famous for her catchphrase "ooh la la"—sued the defendant video game company for naming the primary character in one game "Ulala." \textsuperscript{130} Citing the physical and practical difference between the plaintiff and the fanciful character, the court held that the video game character was "more than a mere likeness or literal depiction" and "contain[ed] sufficient expressive content to constitute a 'transformative work.'" \textsuperscript{131} As a result, the plaintiff's right of publicity claim had to yield to the First Amendment.

By contrast, in \textit{No Doubt v. Activision Publishing, Inc.}, the California Court of Appeal found a video game depiction of the band No Doubt to violate the group's right of publicity. \textsuperscript{132} There, the defendant video game manufacturer originally acquired a license to use No Doubt's likeness in the game, but it violated the terms of the agreement by allowing users to

\begin{footnotesize}
\begin{itemize}
\item \textsuperscript{123} 69 P.3d 473, 476, 480 (Cal. 2003).
\item \textsuperscript{124} \textit{Id.} at 480.
\item \textsuperscript{125} \textit{Id.}
\item \textsuperscript{126} 332 F.3d 915, 938 (6th Cir. 2003).
\item \textsuperscript{127} \textit{Id.} at 936, 938.
\item \textsuperscript{128} \textit{Id.} at 938.
\item \textsuperscript{129} 50 Cal. Rptr. 3d 607, 609 (Ct. App. 2006).
\item \textsuperscript{130} \textit{Id.} at 608–10.
\item \textsuperscript{131} \textit{Id.} at 616.
\item \textsuperscript{132} 122 Cal. Rptr. 3d 397 (Ct. App. 2011), \textit{petition for review denied}, No. B223996, 2011 Cal. LEXIS 6100 (June 8, 2011).
\end{itemize}
\end{footnotesize}
manipulate the No Doubt avatars. Under the Transformative Use test, the court found the avatars to be “literal recreations of the band members,” placed in the context of a rock-and-roll show. Addressing the proper scope of its analysis, the court reasoned that just because “the avatars appear in the context of a videogame that contains many other creative elements, [it] does not transform the avatars into anything other than exact depictions” of the plaintiffs. Without sufficient transformation, the First Amendment could not shield the defendant’s “literal recreations of the band members.”

Relying heavily on the reasoning of No Doubt, the panel in In re NCAA Student-Athlete Name & Likeness Licensing Litigation found that the use of player-avatars in a popular college football game violated the Indiana right of publicity statute. There, the defendant video game manufacturer created a college football video game featuring player-avatars with identical biographical information as actual college football players. The plaintiff, a former college quarterback, alleged that the avatar resembling him violated his right of publicity. Applying the Transformative Use test, the Ninth Circuit affirmed the district court, concluding that the defendant’s avatar did “not contain [the] significant transformative elements” necessary to defend against the plaintiff’s right of publicity claim. Because the avatar was physically identical to the plaintiff, depicted as a starting quarterback, and placed in the context of a football game, the First Amendment provided no protection.

From Comedy III to NCAA, modern courts have repeatedly demonstrated one trend in right of publicity cases: a wide range of expressive works, from still photographs to imaginative avatars, could fail under the Transformative Use test. This more restrictive test now enjoys widespread acceptance.

133. Id. at 402.
134. Id. at 411.
135. Id.
136. Id.
138. Id.
139. Id. at 1271-72.
140. Id. at 1276.
141. Id. at 1279.

Nowhere has the momentum behind the Transformative Use test been more powerfully demonstrated than in a recent opinion by the Third Circuit.¹⁴² When the *NCAA* case was being litigated, a dispute with nearly identical facts landed in the District of New Jersey.¹⁴³ The plaintiff, a former college football quarterback, brought a putative class action against the same video game manufacturer targeted in the *NCAA* litigation.¹⁴⁴ Alleging that the player-avatars in the defendant’s college football video game violated his right of publicity, the plaintiff pointed to a host of game features as supporting evidence, including biographical information of the avatars that mirrored that of the actual players.¹⁴⁵ Notably, Judge Wolfson expressed a preference for the Transformative Use test over the Restatement test,¹⁴⁶ but did not ultimately select a test because the defendant’s “First Amendment defense prevail[ed] under both tests.”¹⁴⁷ The court granted the defendant’s motion for summary judgment on the ground that the defendant’s use was sufficiently transformative under the Transformative Use test, and not wholly unrelated to the product under the Restatement test.¹⁴⁸

On appeal, the Third Circuit reversed and remanded, providing definitive guidance on the proper analytical approach to balance the right of publicity against First Amendment.¹⁴⁹ Judge Greenaway began by acknowledging that

¹⁴². *See Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013), *cert. dismissed*, 13-376, 2014 WL 4844579 (U.S. Sept. 30, 2014). While this opinion was filed before the *NCAA* decision discussed above, Judge Greenaway’s treatment of the right of publicity claim is more instructive for purposes of this comment. In *Hart*, the majority of the panel provided a thoughtful and thorough survey of the three most prominent tests used by modern courts to assess right of publicity claims. This effort was meant to provide guidance to the Third Circuit in a concededly muddled area of the law. Unlike the Ninth Circuit in *NCAA*, the Third Circuit did not have the benefit of precedent or a track record of experience in right of publicity cases. For these reasons, and because of the Third Circuit’s rigorous analysis, the *Hart* case is examined in greater detail in this comment. One final note is that this comment should not be taken in any way as a critique of the *Hart* majority or Judge Greenaway’s analysis. Judge Greenaway is an intellectual giant and one of the most revered jurists on the Third Circuit. The author’s approach aims to draw from, and perhaps build on, the analytical framework of *Hart*.


¹⁴⁴. *Id.* at 762–63. The plaintiff alleged “Invasion of Privacy–Misappropriation of Identities and Likenesses” and “Electronic Arts’ Misappropriation of Plaintiff and Class Members’ Identities and Likenesses is for a Commercial / Trade Purpose-(Infringement).” *Id.* at 763 n.5.

¹⁴⁵. *Id.* at 763–64.

¹⁴⁶. Judge Wolfson labeled the Restatement test the “Rogers test,” which is the label used by many courts. *See id.* at 776–77.

¹⁴⁷. *Id.* at 777.

¹⁴⁸. *Id.* at 787, 793–94.

"[c]ourts have taken varying approaches in attempting to strike [this] balance," and that some approaches were "more appealing than others." In an effort to "resolv[e] the tension" between different approaches, he analyzed the three most prominent balancing tests used by courts in the digital age. The conclusions of this in-depth analysis can be summarized as follows:

- **The Predominant Use test** was rejected for being "subjective at best, arbitrary at worst"; found to "call[] upon judges to act as both impartial jurists and discerning art critics"; and characterized as "antithetical to [the Third Circuit's] First Amendment precedent."

- **The Restatement/Rogers test** was rejected as "a blunt instrument, unfit for widespread application in cases that require a carefully calibrated balancing of two fundamental protections," and because it leads to "the very activity by which [a celebrity] achieved his renown [to]... prevent[] him from protecting his hard-won celebrity."

- **The Transformative Use test** was accepted because "it provides courts with a flexible—yet uniformly applicable—analytical framework"; uniquely "maintains a singular focus on whether the work sufficiently transforms the celebrity's identity or likeness, thereby allowing courts to account for the fact that misappropriation can occur in any market segment, including those related to the celebrity"; and "effectively restricts right of publicity claims to a very narrow universe of expressive works."

After finding that the Transformative Use test was the most appropriate analytical framework, the panel applied it to the college football video game avatars at issue.

In deciding whether the digital avatar was sufficiently transformative of the plaintiff’s identity, the panel first considered the digital representation of the avatar. Judge Greenaway found substantial physical

---

150. *Id.* at 149.
151. *Id.*
152. *Id.*
153. *Id.* at 153–65.
154. Part II, supra, did not discuss the Predominant Use test because the Restatement/Rogers test and the Transformative Use test enjoy much wider acceptance. Indeed, Judge Greenaway characterized the Predominant Use test as "a dangerous and rightly-shunned road." *Id.* at 154.
155. *Id.*
156. *Id.* at 157.
157. *Id.* at 158.
158. *Id.* at 163.
159. Judge Greenaway chose the term "identity" to "encompass not only Appellant's likeness, but also his biographical information." *Id.* at 165.
similarities because the avatar had the same "hair color," "hair style," "skin tone," and "accessories" as the plaintiff.\textsuperscript{160} Less tangible aspects of identity, such as vital and biographical information, were also shared between the plaintiff and his avatar.\textsuperscript{161} Next, the panel considered the "context" of the use, finding that the avatar did exactly what the plaintiff famously "did while at Rutgers: he plays college football, in digital recreations of college football stadiums, filled with all the trappings of a college football game."\textsuperscript{162} Third, and in response to the district court, Judge Greenaway considered "the users' ability to alter the avatar's appearance."\textsuperscript{163} Finding this ability to be insufficient to defend against right of publicity claims, the panel reasoned that recognizing an interactivity defense would "open[] the door to cynical abuse."\textsuperscript{164} Finally, Judge Greenaway addressed the proper scope of analysis under the Transformative Use test.\textsuperscript{165} Instead of analyzing the allegedly volitional use of the plaintiff's identity within the larger college football video game as a whole, the majority held that the focus should remain narrowly on how "the celebrity's identity is used."\textsuperscript{166} To hold otherwise, Judge Greenaway reasoned, would allow "blatant misappropriation . . . [to] count for nothing so long as the larger work, on balance, contained highly creative elements in great abundance."\textsuperscript{167} The court concluded that the First Amendment could not shield the defendant's use because it failed to sufficiently transform the plaintiff's identity.\textsuperscript{168}

V. Transforming Right of Publicity Analysis: The Contextual Use Test

The Hart opinion painted a rosy picture of the Transformative Use test. According to the members of the panel majority, the test did not (and does not) suffer from the faulty characteristic of other analytical approaches.\textsuperscript{169} This view, however, is not supported. While Judge Greenaway rejected other approaches as being "subjective at best, [and] arbitrary at worst," there was no explanation of how courts employing the Transformative Use

\textsuperscript{160} Id. at 166.
\textsuperscript{161} Id.
\textsuperscript{162} Id.
\textsuperscript{163} Id.
\textsuperscript{164} Id. at 167.
\textsuperscript{165} Id. at 169
\textsuperscript{166} Id.
\textsuperscript{167} Id.
\textsuperscript{168} Id. at 170.
\textsuperscript{169} Id. at 163.
test should balance rights without using subjective judgment.170 Indeed, the simple truth that “transformativeness” itself is a case-specific, fact-specific, judge-specific, and era-specific judgment went unacknowledged by the panel. One can justifiably question whether the Third Circuit’s opinion eliminated uncertainty or contributed to it, because separating artistic expression from mere copying is neither easy nor straightforward. While the federal circuit courts currently appear to be moving toward a Transformative Use consensus, this part of the comment aims to chart a new course. Rather than joining the march toward a repackaged status quo, this comment proposes a new, multifactor “Contextual Use” test in an attempt to provide a more objective, uniform standard through which future courts can analyze right of publicity claims.

A. Factor One: Economic Significance Measured Through Cross-Price Elasticity of Demand

The first factor that courts should consider in deciding whether a particular use violates a celebrity’s right of publicity is the economic significance of the use to the work as a whole. On the one hand, if the use of a celebrity’s identity accounts for a significant proportion of the work’s economic value,171 this factor should weigh against a First Amendment defense. On the other hand, if a work would have an identical or substantially similar economic value absent its use of the celebrity’s identity, this factor should support a First Amendment defense. To determine the economic value added by a use under Factor One, courts should measure the price cross-elasticity of demand (“CED”). Because this economic concept requires quantitative expertise and advanced understandings of market dynamics, parties should be required to retain experts. By explicitly importing formal economic analysis into an area of the law where courts have engaged in amateur economics for decades, Factor One will make right of publicity decisions more empirical and less abstract.

CED examines whether two products are “reasonably interchangeable.”172 More precisely, the concept asks whether “consumers

170. Id. at 154.

171. For all intents and purposes, “economic value” here means “commercial value.” As will be discussed below, identifying a use’s value as “economic” or “commercial” in this part is meant to differentiate this more quantitative concept from more abstract concepts like the Predominant Use test’s “expressive value.” See, e.g., Mark S. Lee, Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface, 23 LOY. L.A. ENT. L. REV. 471, 500 (2003).

172. Todd v. Exxon Corp., 275 F.3d 191, 201–02 (2d Cir. 2001); see also Phillip E. Areeda et al., ANTITRUST LAW: AN ANALYSIS OF ANTITRUST PRINCIPLES AND THEIR APPLICATION ¶562a (1995).
would respond to a slight increase in the price of one product by switching to another product.\textsuperscript{173} Focusing on CED, therefore, would allow courts to determine whether two products are substitutes.\textsuperscript{174} But how would this economic concept fit within right of publicity cases? With the help of experts, measuring CED under Factor One would provide quantitative (and objective) evidence about the economic value that the use of a celebrity’s identity adds to a work. This concept is not foreign: The United States Supreme Court has been assessing CED in antitrust matters for over sixty years.\textsuperscript{175} Additionally, CED is central to a host of international trade statutory schemes and administrative proceedings.\textsuperscript{176} In the context of the right of publicity—as in the context of antitrust and international trade law—measuring the economic significance of a disputed use would allow courts to determine whether the use is central or incidental to the work in question.

Measuring CED at Factor One requires courts to compare two or more products. The relevant comparator products in right of publicity cases are: (1) the work in question that uses a celebrity’s identity; and (2) a work that is nearly identical, but does not use the celebrity’s identity. The question

\textsuperscript{173} Todd, 275 F.3d at 201–02.

\textsuperscript{174} See John J. Miles, I Health Care and Antitrust L. § 2:4 (2014) (“A measure of the degree of interchangeability between two products is their price cross-elasticity of demand—the percentage increase in quantity demanded of product B when the price of product A increases by a given percentage.”); see also United States v. E. I. du Pont de Nemours & Co., 351 U.S. 377, 417–18 (1956) (explaining that high cross-elasticity of demand is indicated when a slight decrease in price of one product causes a considerable number of customers of other products to switch to first product); U.S. Horticultural Supply v. Scotts Co., 367 F. App’x 305, 309 (3d Cir. 2010) (explaining that cross-elasticity of demand measures the responsiveness of the demand for one product to changes in the price of the other); Nobody in Particular Presents, Inc. v. Clear Channel Commc’ns, Inc., 311 F. Supp. 2d 1048, 1081 (D. Colo. 2004) (“Economists determine cross-elasticity of demand by dividing the percent change in quantity demanded of product A by the corresponding percent change in price of product B. . . . If the calculation yields a positive number, products A and B are reasonable substitutes for consumers.”); AD/SAT, Div. of Skylight, Inc. v. Associated Press, 181 F.3d 216, 227 (2d Cir. 1999) (“Cross-elasticity of demand exists if consumers would respond to a slight increase in the price of one product by switching to another product.”).

\textsuperscript{175} See, e.g., E. I. du Pont de Nemours & Co., 351 U.S. at 394 (“What is called for is an appraisal of the ‘cross-elasticity’ of demand in the trade.”). Federal courts of appeals, including the Third Circuit, are also very familiar with cross-elasticity of demand. See, e.g., Queen City Pizza, Inc. v. Domino’s Pizza, Inc., 124 F.3d 430, 445 (3d Cir. 1997) (“Our question is whether the interchangeability of, or cross-elasticity of demand between, DPI-approved ingredients and supplies and other ingredients and supplies is sufficient to make the alleged relevant market invalid.”).

\textsuperscript{176} See, e.g., Legal Issues in Certain Tomato Products from Greece, Inv. No. 104-TAA-23, USITC Pub. GC-H-263, 1984 WL 273370, at *2 (Sept. 13, 1984) (explaining that the Commission would have to assess “the interrelationships between multiple like products and/or industries (i.e., their cross-elasticities)” to determine whether countervailing duties are appropriate); Legal Issues in Cotton Yarn from Brazil, Inv. No. 104-TAA-21, USITC Pub. GC-H-127, 1984 WL 273506, at *2 (May 2, 1984) (same).
that experts would help to quantify at Factor One is quite simple: If the price of the work that uses the celebrity identity rose, would consumers turn to the celebrity-less good as an alternative (leading to an increase in demand for the latter)? High CED, where a small percentage increase in the price of the first product results in a large percentage increase in the quantity demanded of the second product, suggests that the comparator products are substitutes.\footnote{In contrast, low CED, where even a large percentage increase in the price of the first good does not lead to a similar percentage increase in the demand for the second good, suggests that the goods are not substitutes.}{footnote} By first characterizing the economic relationship between the two goods, courts at Factor One could extract several insights.

Applying CED to right of publicity cases would help to empirically distinguish works in which a celebrity’s identity is a raw material from those that are mere copies. Where a product that includes the use of a celebrity’s identity is found to be a substitute for a celebrity-less product, meaning that a rise in the former’s price produces a similar rise in the latter’s demand, courts would have concrete evidence that the disputed use adds little or no economic value to the work as a whole. This is to say that if the contribution of a celebrity’s identity to a work is economically negligible, the justifications for recognizing a right of publicity claim lose force. Alternatively, where the two products, differing only in one’s use of a celebrity identity, display no CED, courts would have quantitative evidence that the use of a celebrity identity is highly significant to the value of the disputed work. Additionally, where a work’s economic value and viability in a competitive marketplace relies so heavily on the unauthorized use of a celebrity’s identity, recognizing a right of publicity claim is much more palatable.

Like any legal theory, however, courts must have the ability to operationalize Factor One for it to have any utility.\footnote{The ability to operationalize the social theory embodied in the law is highly relevant . . .}{footnote} Even without the
benefit of econometrics, applying Factor One to several of the most difficult cases discussed above indicates that this concern does not present a major hurdle. For example, it is safe to assume that consumers would not perceive a regular cotton t-shirt as a substitute for the Three Stooges t-shirts in Comedy III. There, it was solely the image of the Three Stooges, not the quality of the shirt or any other design features that allowed the artist to charge a price premium. Because the artist could likely garner a price for his shirts well in excess of what consumers would pay for the same shirt absent the Three Stooges image, CED would be low to zero. In this case, the two comparator shirts are not substitutes, and with the Three Stooge’s image accounting for the majority of the value of the work in question, Factor One would favor the Three Stooges and their right of publicity claim.

In contrast, the disputed comic book in Winter v. DC Comics would display close to perfect CED with a nearly identical comic book lacking albino, half-worm villains. If the price of the Autumn's of Our Discontent comic rose by a certain percentage, consumers would likely turn to an identical comic with different villains instead. The percentage rise in demand of the latter would likely track the percentage rise in the price of the former. Because the comparator comic books in this case would be substitutes—which an expert could use CED analysis to confirm—the disputed use of the Winter Brothers’ identities can empirically be shown to add little economic value to the comic book as a whole. If the disputed use adds no economic value, the right of publicity claims stemming from that use lacks an important foundation.

Finally, one possible critique of Factor One must be addressed before moving to Factor Two. Courts have previously developed, and other courts have largely rejected, tests aimed at measuring the “value added” by a use. Indeed, the first test considered in the Hart opinion, the Predominant Use test developed by the Missouri Supreme Court, aimed to arrive at some measure of a use’s valued added. However, as articulated by the Missouri Supreme Court, and also reiterated by the appellant in Hart, the Predominant Use test instructs courts to measure the “commercial value”

181. 69 P.3d 473, 476 (Cal. 2003).
182. Id.
183. See Doe v. TCI Cablevision, 110 S.W.3d 363 (Mo. 2003).
184. Id. at 374 (quoting Mark S. Lee, Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface, 23 LOY. L.A. ENT. L. REV. 471, 500 (2003)).
added by a celebrity’s identity, and to distinguish this measure from the “expressive value” added. On the one hand, a use violated a celebrity’s right of publicity where the use is found to add significant value under the test but no competing expressive value.186 On the other hand, where a use’s value within a work was found to be primarily expressive, the First Amendment predominated under the Test.187

The focus on differentiating between “expressive” and “commercial” value is precisely what motivated Judge Greenaway’s charge that the Predominant Use test “calls upon judges to act as both impartial jurists and discerning art critics.”188 While this dual role is not unique to the Predominant Use test because the Restatement and Transformative Use tests require similar subjectivity, it can lead modern approaches to appear opaque and random. Using CED analysis, by contrast, can add uniformity, predictability, and independent academic rigor to the right of publicity debate. Courts and litigants might welcome black and white boundaries in an area of the law that is decidedly grey.

B. Factor Two: The Transformativeness of the Use

Factor Two asks courts to decide whether the disputed work sufficiently transforms the celebrity’s identity. This is the exact inquiry of the Transformative Use test outlined above.189 To be clear, however, this comment does not argue that the Transformative Use test has nothing to contribute to right of publicity analysis. Rather, this comment argues against the decision of modern courts to repackage this noncontrolling factor within a multipart test into “a singular, complete defense.”190 The Transformative Use test cannot possibly consider all relevant aspects of a use, and relying on it in isolation becomes unpredictable in practice.191 But transformativeness should be returned to its original position as one relevant inquiry of many because the Test helps courts to understand the character and nature of a specific use in a way not otherwise available. Balanced between the Contextual Use test’s proposed Factors One and Three, the benefits of assessing transformation should be magnified and its limitations reduced.

In relation to Factor One, Factor Two helps to capture misappropriation of a celebrity’s identity that can occur in a wide range of market

186.  *TCI Cablevision*, 110 S.W.3d at 374.
188.  *Hart*, 717 F.3d at 154.
189.  See discussion *supra* Parts II.B and III.
191.  Id.
segments. While Factor One provides a quantitative measure of the economic value added by a particular use, Factor Two allows for a qualitative comparison between the celebrity's identity and the disputed use. This difference is crucial because Factor One cannot capture the character and nature of the disputed use. Under Factor Two, courts should ask whether the use is truly a mere copy of the celebrity's identity or a sufficiently new work deserving of First Amendment protections, regardless of the economic value of a use to a work as a whole. Where a use is found to be sufficiently transformative, this factor should weigh in favor of the defendant even if the use adds significant economic value to the work. On the other hand, where a disputed use is a mere copy, this factor should weigh against the defendant even if the use adds little economic value.

The most challenging decision facing courts attempting to assess the degree of transformation is one of scope. Different results can flow from analyzing the transformativeness of a use itself versus the use in the context of an entire work. For example, the Hart majority and dissent grappled over the merits of analyzing the digital avatar's transformativeness in isolation, as opposed to as part of the NCAA Football video game as a whole. For purposes of the Contextual Use test, however, courts should measure a use's transformativeness in a manner consistent with the majority opinion in Hart. Thus, the scope of Factor Two should remain focused on "how the celebrity's identity is used in or is altered by other aspects of a work."

C. Factor Three: The Substantiality of the Use in Relation to the Disputed Work as a Whole

Factor Three requires courts to measure the amount of the entire work that is qualitatively attributable to the disputed use. Where the disputed use

---

192. See, e.g., Hart, 717 F.3d at 163 (reasoning that the Transformative Use test allows "courts to account for the fact that misappropriation can occur in any market segment, including those related to the celebrity").
193. See discussion supra Part II.B.
194. See id.
195. Compare Hart, 717 F.3d at 169 ("Decisions applying the Transformative Use Test invariably look to how the celebrity's identity is used in or is altered by other aspects of a work. Wholly unrelated elements do not bear on this inquiry.") with id. at 171-73 (Ambro, J., dissenting) ("To me, a narrow focus on an individual's likeness, rather than how that likeness is incorporated into and transformed by the work as a whole, is a flawed formulation of the transformative inquiry.").
196. Id. at 169.
is found to be sufficiently transformative under Factor Two, this inquiry will necessarily become insignificant. After all, where a specific use is found to be transformative, the substantiality of that use does not affect the right of publicity. By contrast, where the disputed use is found to be a mere copy under Factor Two, the Contextual Use test’s inquiry will not end there. Rather, Factor Three provides a qualitative means through which the import of the copied use can be considered. Factor Three also compliments Factor One, which measures the \textit{economic} import of the disputed use to an entire work.\textsuperscript{197} Factor Three has a similar focus, but measures how much of the work at-issue is dependent on the disputed use of the celebrity’s identity. This factor requires judges to make a subjective, but readily makeable decision—one not likely to lend itself to the bright-line rules already rejected in the context of copyright law’s fair use doctrine.\textsuperscript{198}

From the outset, however, it is important to note the similarities and differences between Factor Three and the Fair Use doctrine’s third factor. In deciding the viability of a fair use defense under section 107 of the Copyright Act, courts should consider “the amount and substantiality of the portion used in relation to the \textit{copyrighted work} as a whole.”\textsuperscript{199} The final proposed factor of the new Contextual Use test focuses instead on the amount and substantiality of the use in relation to the \textit{disputed work} as a whole. This linguistic adjustment is necessary to account for the right protected by the right of publicity. This right is different from the right protected by copyright law, and more to the point, right of publicity disputes focus on the use of a person’s identity, not a copyrighted work.\textsuperscript{200} As a result, right of publicity cases do not lend themselves to traditional measures of substantiality like the number of copied pages, chapters, or television episodes often weighed in the fair use context. Yet, even after acknowledging these differences, the inherent similarity between these two inquiries should allow courts—the same courts that have long applied the fair use factors—to feel comfortable in making subjective judgments about substantiality. Judges regularly make subjective decisions, and assessing the amount of a hip-hop song, video game, or golf painting comprised of

\textsuperscript{197} See discussion supra Part IV.A.
\textsuperscript{198} See, e.g., Cambridge Univ. Press v. Patton, 769 F.3d 1232, 1272 (11th Cir. 2014) (internal quotation marks omitted) (“We must avoid hard evidentiary presumption[s] ... and eschew[ ] a rigid, brightline approach to fair use. ... By holding that the third factor favored fair use whenever the amount of copying fell within a 10 percent-or-one-chapter baseline, the District Court abdicated its duty ... ”).
\textsuperscript{199} 17 U.S.C.A. § 107(3) (West 2012) (emphasis added).
\textsuperscript{200} See, e.g., Morgan & Manship, supra note 5 at 24 (“Furthermore, the pragmatic problem with right of publicity cases borrowing a doctrine from copyright law is that the right of publicity concerns a person, usually a celebrity, and the qualities of such a person are vastly different from that of a copyrighted, tangible work.”).
the celebrity's identity is not an alarmingly abstract task. While the subjective judgments necessary at Factor Three may not be perfect, they will be balanced against the separate but related Factors One and Two. Indeed, the final factor of the Contextual Use test simply provides a safety valve, helping to shield innocent uses from liability while capturing more obvious instances of copying. Factor Three also ensures that the Contextual Use test does not sacrifice substance to achieve a more empirically rooted form.

The Contextual Use test's emphasis on assessing the work as a whole is not unique. As mentioned in Part IV.B, Judge Ambro's dissent in *Hart* explains the importance of considering the role of a disputed use within the entirety of the original work. While his views responded to the majority, addressing the proper scope of analysis under the Transformative Use test, his logic applies with equal force under Factor Three here. Judge Ambro opined that "it is necessary to review the likeness in the context of the work in its entirety, rather than focusing only on the individual's likeness." Citing *Comedy III, Winter*, and *ETW*, he admonished the majority for improperly confining its analysis to the transformation of the celebrity's identity alone. Judge Ambro further suggested that courts should look to how that use "is incorporated into...the work as a whole." As he reasoned, any right of publicity test that does not consider the context and substantiality of a use within a work as a whole misses the mark. Characterizing a use as volitional without first considering its role within the larger work—whether the use constitutes substantially all of the work or simply an atomic part—fails to assess the true nature of the use. In applying Factor Three, as well as the rest of the Contextual Use test to the *Hart* case, it becomes apparent why this test is an improvement from the current state of the law.

VI. Conclusion: Applying the Contextual Use Test

An application of the Contextual Use test to *Hart* produces results at odds with the Third Circuit's decision. First, under Factor One, the panel would determine the economic value added by the alleged use of the celebrity's identity. The comparator products at this step would be (1) the *NCAA Football* game as offered and (2) the same *NCAA Football* game

---

201. *Hart*, 717 F.3d at 170–72 (Ambro, J., dissenting); see also *Hart*, 808 F. Supp. 2d at 787 (D.N.J. 2011), rev'd, 717 F.3d 141 (3d Cir. 2013) ("Finally, I disagree with *Keller*’s approach of focusing solely on the challenged image, as opposed to the work as a whole.").
203. Id. at 171.
204. Id. at 172–73.
205. Id. at 173.
with a generic Rutgers quarterback.\textsuperscript{206} Again, even without the use of econometrics, it is relatively clear that a percentage increase in the price of product one would lead to a similar percentage increase in the demand for product two. Thus, consumers would not likely be willing to pay a premium for an \textit{NCAA Football} game simply because it includes a life-like Rutgers quarterback. The comparator products in \textit{Hart} would be classified as substitutes and, therefore, Factor One would weigh in favor of the defendant and First Amendment protection.

Second, under Factor Two, the panel would assess the transformativeness of the disputed use. Comparing the celebrity's identity to the disputed use would reveal—as Judge Greenaway found—that the digital avatar was a mere copy of the plaintiff. The digital representation, physical features, and context of the use were identical to the celebrity, and the ability of users to alter these features does not affect the analysis. Factor Two would militate in favor of the plaintiff and his right of publicity claim because the use would not be sufficiently transformative.

Finally, under Factor Three, the court would consider the substantiality of the use of the celebrity's identity in relation to the \textit{NCAA Football} video game as a whole. As explained by Judge Ambro in the \textit{Hart} dissent, and also by Judge Wolfson in the district court, the video game included "myriad original graphics, videos, sound effects, and game scenarios."\textsuperscript{207} Within this larger work, the avatar that allegedly used the plaintiff's identity was nothing more than one grain of sand on a beach. The status of the claim in \textit{Hart} as a putative class action does have the potential to significantly alter the Contextual Use test because, if class certification was granted, all NCAA football players would become plaintiffs, not just Hart. Nevertheless, the scope of a precertification Factor Three analysis would necessarily be limited to the named parties.\textsuperscript{208} When weighing the substantiality of one avatar within an entire college football video game,

\textsuperscript{206} The selection of this comparator product at Factor One would be a source of great controversy in this case and in future cases. The \textit{Hart} case itself was a putative class action, so one might argue that the proper comparator product here would be the \textit{NCAA Football} game without any of the readily identifiable players. As a putative class action, however, the case remains as one between the named parties until class certification is granted. See FED. R. CIV. P. 23; see also Amchem Prods., Inc. v. Windsor, 521 U.S. 591, 613 (1997) ("Rule 23(a) states four threshold requirements applicable to all class actions: . . . (3) typicality (named parties' claims or defenses are typical . . . of the class); and (4) adequacy of representation (representatives will fairly and adequately protect the interests of the class)") (internal quotation marks omitted); McCleary v. Realty Indus., Inc., 405 F. Supp. 128, 130 (E.D. Va. 1975) ("Thus, the Court inferentially concludes that in a purported class action, the controversy is between only the named parties until such time as the trial court certifies the action as a class action.").

\textsuperscript{207} \textit{Hart}, 717 F.3d at 175 (Ambro, J., dissenting).

\textsuperscript{208} See discussion \textit{supra} note 196.
the use-to-work substantiality comparison falls categorically on the side of the defendant and the First Amendment.

In sum, two of the three Contextual Use factors favor the defendant in *Hart* when applied. As a result, the Third Circuit panel using the Contextual Use test would affirm the grant of the defendant’s motion for summary judgment, and the First Amendment would not yield to the right of publicity. Importantly, this result may not be correct or incorrect; this comment takes no position on the merits of the case. Rather, the result is far more predictable and empirical. Combining the benefits of the Transformative Use test with economic analysis and fair use principles provides courts with a more holistic picture of a disputed use before deciding on its legality. By reformulating the right of publicity analysis in this way, the celebrity identities of the next soccer mom sensation or one-hit-wonder will remain protected from blatant acts of copying. More importantly, however, the Contextual Use test will ensure that the principles underlying the First Amendment are honored in the process.