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All Your Face Are Belong To Us: Protecting Celebrity Images in Hyper-Realistic Video Games

Krista Correa

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All Your Face Are Belong To Us: Protecting Celebrity Images in Hyper-Realistic Video Games

by
KRISTA CORREA*

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* J.D. University of California, Berkeley, Berkeley Law School. Law clerk at the Los Angeles Superior Court. The views expressed here are solely my own and should in no way be attributed to the court. I would like to thank Todd Smithline for giving me the idea to write this paper, Chris Hoofnagle for helping me refine and revise it, and my husband Paul Correa for listening to me talk endlessly about it.

I. Introduction

A car careens down the street, engine smoking, windows smashed. The driver, perhaps realizing that he cannot regain control, jumps out, rolling to relative safety. The car, left unmanned, jumps a curb and lands on a sidewalk filled with pedestrians. As the car continues to wreak havoc on the sidewalk, leaving a trail of injured pedestrians in its wake, the erstwhile driver stands up, brushes himself off, and walks into a nearby bar. He quickly enters into conversations with a variety of underworld characters: gangsters, criminals, and even prostitutes. When he leaves the bar, he walks up to a car stopped at a red light, brandishes a gun, steals the car, and drives off into the sunset.

The scene described above, or some similar variation, can be found in any of the infamous *Grand Theft Auto* series of video games produced by Rockstar Games (“Rockstar”). *The Guinness Book of World Records* named the series the “most controversial” video game in history in both 2008 and 2009; also in 2008, the fourth game in the series, *Grand Theft Auto IV*, held the records for the Highest Grossing Video Game in 24 Hours and the Highest Revenue Generated by an Entertainment Product in 24 Hours.¹ Rockstar has continued to release games in the series; the most recent, *Grand Theft Auto: The Ballad of Gay Tony*, was released on October 29, 2009. Each version of the game has been more technologically advanced than the previous version, and the graphics have been increasingly realistic. Rockstar’s history of pressing the boundaries of game development, as well as its tendency to stir up controversy, leads to a simple question: what next?

Imagine, if you will, that the characters in the underworld bar described at the beginning of this paper had the faces of people you know. What if Rockstar decided to use the face of a well-known celebrity as the obvious model for one of the gangsters? What if they used a vivid animation of a celebrity as a model for one of the prostitutes? Would that celebrity have a legal right to prevent the game from being released, or to require Rockstar to edit the game? The answers to these questions are not as clear as might be expected—a troubling situation in a world where technological advances outstrip the development of the law by a significant margin.

1. GUINNESS WORLD RECORDS 2009: GAMER’S EDITION 108–09 (Craig Glenday ed., 2009); GUINNESS WORLD RECORDS 2009, 307 (Craig Glenday ed., 2009).

Recent developments in digital imaging technology have allowed video game publishers to create ever more realistic looking games. Many game players seek out the higher level of authenticity that this realism allows, encouraging producers in turn to continue to work at improving the technology. The upsides to improved digital imagery are dramatically realistic scenery, movement, and of course, characters like the ones described above. The downside, however, is that it is now plausible to envision a scenario in which a celebrity might see her literal face being used in a game without her consent, in a situation that she does not endorse. This possibility was troubling when game images were highly pixilated and thus virtually unrecognizable; how much more troubling, then, is it now, when faces are rendered in stunning accuracy? And what legal remedies, if any, exist to protect that celebrity?

Part II of this paper will review the legal rights and remedies currently available to a celebrity whose face or image was used by a game developer without the celebrity's consent.² Part III of this paper will then consider whether the current regime provides sufficient protection to celebrities who seek to prevent misuse of their images. Part IV of this paper will then turn to other sources of law and consider whether an alternative scheme, such as a moral rights system based on the European model, would be more appropriate. Finally, Part V of this paper will conclude that a federal right of publicity is necessary and will consider what such a statute would need to address.

II. The Current Legal Options

The most common legal claim made by a celebrity seeking to challenge an unauthorized use of her image is a right of publicity claim. The right of publicity is purely state-based and can be either statutory or developed through common law.³ It is often referred to

2. Many of the same issues also arise in the context of user-generated content and non-celebrity images. However, the rights implicated are somewhat different and are beyond the scope of this paper.

3. As of this writing, fifteen states have codified rights of publicity, while sixteen more have a comparable common law right. ROBERT PETER MERGES ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 1020 (5th ed. 2010). Some states, such as California, have both: Cal. Civ. Code section 3344 provides a statutory right, while courts have recognized a broader common law right as well. *See, e.g.,* *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979) (holding that a common law right of publicity existed in California and complemented the statutory right). Other writers have placed the numbers significantly higher. *See, e.g.,* Barbara A. Solomon, *Can the Lanham Act Protect Tiger Woods? An Analysis of Whether the Lanham Act is a Proper*

as an off-shoot of misappropriation, one of the four traditional invasion of privacy torts first described by William Prosser in 1960,⁴ though that is not an entirely accurate description of the current legal landscape, as will be discussed below.

Celebrities can also make a more traditional invasion of privacy claim, such as general misappropriation, publication of private information, or false light.⁵ These claims, however, are often difficult for celebrities to prove, due to their status as public figures.⁶ Both the traditional invasion of privacy torts and the right of publicity are sometimes referred to under the general name of a right to privacy.⁷ In addition to these common law torts, many states have statutory or constitutional rights to privacy.⁸ However, the right to privacy has a complex and often confusing history in American jurisprudence that can make a celebrity's claim particularly challenging and the outcome difficult to anticipate.⁹

In addition to the various invasion of privacy claims, a celebrity can also bring a claim for unfair competition or false endorsement.¹⁰ The former can be brought under either state or federal laws, while

Substitute for a Federal Right of Publicity, 94 TRADEMARK REP. 1202, 1205 (Nov.–Dec. 2004) (“Some version of the right of publicity is recognized in 42 states; by statute in 18 states and by common law in 35 states (of which 11 also have statutes).”).

4. See William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960) (describing the four invasion of privacy torts); *id.* at 406–07 (describing the right of publicity as a version of the tort of misappropriation). Prosser's characterization of the right of publicity as a form of misappropriation has since been adopted by many courts; see, e.g., *KNB Enterprises v. Matthews*, 92 Cal. Rptr. 713, 716–17 (Cal. Ct. App. 2000); *but see* J. THOMAS MCCARTHY, 1 *Rights of Publicity and Privacy* § 1:3 (2d ed.) (“The right of publicity is a state-law created intellectual property right whose infringement is a commercial tort of unfair competition. It is a distinct legal category, not just a “kind of” trademark, copyright, false advertising or right of privacy. While it bears some family resemblances to all these neighboring areas of the law, the right of publicity has its own unique legal dimensions and reasons for being.”).

5. The fourth invasion of privacy tort, publication of private information, is less relevant to these claims and is not typically alleged in cases such as those being discussed here.

6. See, e.g., *Braun v. Flynt*, 726 F.2d 245, 249–50 (5th Cir. 1984) (holding that the higher “actual malice” standard articulated by the Supreme Court in *New York v. Sullivan*, 376 U.S. 254 (1964), in the context of alleged defamation of a public figure applied equally to invasion of privacy claims involving public figures).

7. See Prosser, *supra* note 4, at 389.

8. See, e.g., CAL. CONST., art. I, § 1.

9. See generally ELLEN ALDERMAN & CAROLINE KENNEDY, *THE RIGHT TO PRIVACY* (1995).

10. See, e.g., *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006); see also *Brown v. Elec. Arts*, No. 2:09-cv-01598-FMC-RZx (C.D. Cal. Sep. 23, 2009), *appeal docketed*, No. 09-56675 (9th Cir. Oct. 23, 2009).

the latter is typically raised under federal trademark law, codified in the Lanham Act at 15 U.S.C. § 1125. A Lanham Act claim may seem appealing because it allows a plaintiff to invoke a clearly defined federal statute; however, relying on trademark or competition law to enforce what is essentially a privacy claim has its own dangers, as will be discussed below.

On occasion, celebrities have also made other claims such as copyright infringement.¹¹ However, the requirement that a creation be “fixed in a tangible medium” generally makes a copyright claim more difficult to prove.¹² Although where the copyright claim is based on misappropriation of a tangible work, such as a photograph or film, some celebrities have been more successful.¹³

A. The Right of Publicity

The right of publicity is defined by J. Thomas McCarthy as “the inherent right of every human being to control the commercial use of his or her identity.”¹⁴ Under this definition, the right of publicity can only be used to prevent someone else from improperly *profiting* from a celebrity’s image, thereby preventing the celebrity from exploiting his or her own image in that context—it does *not* prohibit mere reputational harm. This definition has been accepted by most courts and explicitly incorporated into many of the right of publicity statutes.¹⁵

11. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) (holding that a performer had a right to damages after a new reporter broadcast an unauthorized recording of the performer’s act and the performer brought a claim alleging a “cause of action for conversion and for infringement of a common-law copyright.”).

12. Cf. *KNB Enters. v. Matthews*, 92 Cal. Rptr. 2d 713, 723 (Cal. Ct. App. 2000) (holding that a right of publicity claim based on misappropriation of a photograph was not pre-empted by the Copyright Act based on Nimmer’s assertion that “[a] *persona* can hardly be said to constitute a ‘writing’ of an ‘author’ within the meaning of the Copyright Clause of the Constitution.” 1 NIMMER ON COPYRIGHT (1999) § 1.01[B][1][c], 1-22-1-23 (footnotes omitted)).

13. See, e.g., *Browne v. McCain*, 611 F. Supp. 2d 1062 (C.D. Cal. 2009) (finding a probability of success on Browne’s right of publicity claim and a lack of First Amendment protection where Browne also claimed copyright infringement due to McCain’s use of Browne’s music in a political campaign commercial).

14. See MCCARTHY, *supra* note 4 at § 1:3.

15. See, e.g., CAL. CIV. CODE § 3344 (West 2011) (statutory right of publicity only applies to uses for the “purposes of advertising or selling”) (emphasis added); see also *Jim Henson Prods., Inc. v. John T. Brady & Assocs., Inc.*, 867 F. Supp. 175, 188 (S.D.N.Y. 1994) (“The right to publicity protects that value as property, and its infringement is a commercial, rather than a personal tort.”). The Supreme Court also appears to subscribe to this definition; see *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

In California, to prevail on a statutory right to publicity claim, the plaintiff must demonstrate that his or her “name, voice, signature, photograph, or likeness” was used “on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of products, merchandise, goods or services, without such person’s prior consent.”¹⁶ While the precise standard for demonstrating a right of publicity varies somewhat in other states, a requirement that the use be commercial and involve the unauthorized use of the individual’s “likeness” is typical.¹⁷

The term “likeness” does not appear in every state’s right of publicity laws, but where it does, courts have often struggled to determine precisely what the term encompasses.¹⁸ California courts have differentiated between the statutory right of publicity, which involves misappropriation of “another’s name, voice, signature, photograph, or likeness”¹⁹ and the common law right of publicity, which the Ninth Circuit applies when a “celebrity’s identity is commercially exploited . . . whether or not his ‘name or likeness’ is used.”²⁰ Federal courts both within California and elsewhere have held that the right of publicity therefore protects a celebrity’s voice,²¹ signature introduction,²² and even general “identity”²³ as well as his or her name and image.²⁴ Based on courts’ willingness to expand the right of publicity to encompass a wide variety of uses, it seems safe to

16. CAL. CIV. CODE § 3344(a) (West 2011).

17. See, e.g., Pennsylvania: 42 PA. CONS. STAT. ANN. § 8316(a) (“Any natural person whose name or *likeness* has commercial value and is *used for any commercial or advertising purpose* without the written consent . . . ”); Florida: FLA. STAT. § 540.08 (2011) (“No person shall publish, print, display or otherwise publicly use for purposes of trade or for *any commercial or advertising purpose* the name, portrait, photograph, or other *likeness* of any natural person . . . ”); Kentucky: KY. REV. STAT. ANN. § 391.170(2) (West 2011) (“The name or *likeness* of a person who is a public figure shall not be used for *commercial profit* . . . ”) (all emphasis added).

18. See, e.g., *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

19. CAL. CIV. CODE § 3344 (West 2011).

20. *White v. Samsung Elecs., Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992) (quoting *Carson v. Here’s Johnny Portable Toilets*, 698 F.2d 831, 835 (6th Cir. 1987)).

21. *Id.*

22. *Carson*, 698 F.2d 831.

23. *White*, 971 F.2d 1395.

24. See, e.g., *Toney v. L’Oreal USA, Inc.*, 406 F.3d 905, 910 (7th Cir. 2005) (holding that a model’s right of publicity claim based on L’Oreal’s alleged misuse of the model’s image as captured in photographs was protected by the Illinois right of publicity statute and not preempted by federal copyright law).

assume that a strikingly realistic rendering of a celebrity's face, used in a videogame, will be accepted as a protected category.²⁵

These state rights, whether statutory or common law, are the only protections explicitly designed to protect an individual's image, voice, persona, or identity from misappropriation.²⁶ Unfortunately, because they are state-based and often case law-based, they tend to vary dramatically by state and sometimes even by court.²⁷ This disparity in protection encourages forum shopping and makes predicting the outcome in any given case extremely difficult.²⁸ Moreover, because these cases are often based in state laws, litigants are forced to address issues of federal preemption and limited jurisdiction when they bring suit in federal courts.²⁹

The common law nature of these rights in some states means that there is no explicit explanation of legislative intent in many cases, leaving courts to divine the core goal of the law or previous holding. The consensus today appears to be that the right of publicity is primarily intended to ensure that celebrities, and to a lesser extent private individuals, are able to profit economically from the exploitation of their images.³⁰ The logical consequence of this reasoning is that while an individual might be able to block the use of his or her image due to a financial misappropriation claim, a claim based on a purely moral or reputational argument would be unlikely to succeed.³¹ The reasons for this situation can be found in the origins of the right itself.

25. This is, in fact, proven to be the case in the cases decided on this subject thus far: *see, e.g., Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 612-14, (Cal. Ct. App. 2006) (comparing a singer's celebrity appearance to the video game character that the singer alleged to be a misappropriation of her likeness; although the court dismissed the singer's claim, it accepted the character as a potential likeness).

26. Although the Lanham Act is used to achieve a similar end, that is not its stated purpose. Solomon, *supra* note 3, at 1212. ("There is no mention of a person's likeness in the statute. There is no indication that commercial appropriation of a likeness itself is actionable.")

27. *Id.* at 1203-04.

28. *Id.*

29. *See, e.g., Burnett v. Fox*, 491 F. Supp. 2d 962, 974 (C.D. Cal. 2007) (dismissing Burnett's copyright and trademark claims and declining to exercise jurisdiction over her state right claims); *see also Brown v. Elec. Arts*, No. 2:09-cv-01598-FMC-RZx (C.D. Cal. Sep. 23, 2009) (dismissing Brown's Lanham Act claim and declining to extend jurisdiction to his state claims), *appeal docketed*, No. 09-56675 (9th Cir. Oct. 23, 2009).

30. *See, e.g., Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 807 (Cal. 2001) ("The necessary implication . . . is that the right of publicity is essentially an economic right.")

31. *See id.*

1. *The History of the Right of Publicity*

In order to understand the right of publicity as it exists today, it is first necessary to consider its origins. Much of the difficulty experienced by courts today stems from the fact that the right of publicity has something of a dual nature. It developed to complement the right to privacy, yet many modern courts categorize it as a property right.³²

Courts have only recognized the existence of a right of publicity, sometimes called the right of celebrity, for just over fifty years. Judge Frank of the Second Circuit coined the phrase “right of publicity” in *Haelan Laboratories v. Topps Chewing Gum*.³³ *Haelan* addressed whether a baseball player had “the right to grant the exclusive privilege of publishing his picture . . .”³⁴ In holding that the player did have such a right, Judge Frank first differentiated this right from a more general right to privacy, which he characterized as “a personal and non-assignable right not to have his feelings hurt by such a publication.”³⁵ Given the baseball player’s celebrity status, the goal of the lawsuit was not simply to prevent publication of the player’s likeness but rather to control, and thus financially exploit, that publication.³⁶ Judge Frank held that the player did indeed have that right, which he called a “right of publicity.”³⁷ However, Judge Frank was careful not to specify whether this new “right of publicity” qualified as a true property right, noting that the question was unnecessary to his decision.³⁸

Over time, the majority of courts and commentators have determined that a right of publicity is essentially a property right designed to deal with commercial misappropriation and nothing else.³⁹ Others, however, have continued to see the right of publicity as an offshoot of the right to privacy with the potential for wider application.⁴⁰ This divide underscores a serious dichotomy in right of publicity law: not only are the available remedies different, depending on the nature of the violation, but the very concepts inherent in the

32. MERGES ET AL., *supra* note 7, at 1020.

33. *Haelan Labs. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir. 1953).

34. *Id.*

35. *Id.*

36. *Id.*

37. *Id.*

38. *Id.*

39. *See, e.g., Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988).

40. *See, e.g., N.Y. CIV. RIGHTS § 50* (McKinney 2009) (called the right to privacy but encompassing the court-recognized right of publicity).

right, and thus their potential scope, are also different. Many courts, however, would probably agree with the following delineation:

The privacy-based action is designed for individuals who have not placed themselves in the public eye. It shields such people from the embarrassment of having their faces plastered on billboards and cereal boxes without their permission. The interests protected are dignity and peace of mind, and damages are measured in terms of emotional distress. By contrast, a right of publicity action is designed for individuals who have placed themselves in the public eye. It secures for them the exclusive right to exploit the commercial value that attaches to their identities by virtue of their celebrity. The right to publicity protects that value as property, and its infringement is a commercial, rather than a personal tort. Damages stem not from embarrassment but from the unauthorized use of the plaintiffs' property.⁴¹

B. Major Right of Publicity Case Law

1. Midler v. Ford Motor Company (9th Cir. 1988)

Bette Midler brought claims under California Civil Code section 3344 (“section 3344”) and common law right of publicity against Ford Motors after discovering that Ford had produced a commercial using one of Midler’s famous songs performed by a vocal imitator. The Ninth Circuit dismissed Midler’s section 3344 claims but allowed her to go to trial on her common law right of publicity claims, based on the highly distinctive nature of Midler’s voice and Ford’s deliberate imitation of it.⁴² The court reasoned that although Ford had not used Midler’s “likeness” in a more traditional sense, it had intentionally exploited her well-known and recognizable sound in a commercial context.⁴³ Midler’s voice was considered recognizable enough to potentially confuse consumers regarding her involvement in the commercial, making her “sound” as well as her voice a key part of her protectable celebrity identity.⁴⁴

41. *Jim Henson Prods., Inc. v. John T. Brady & Assocs., Inc.*, 867 F. Supp. 175, 188 (S.D.N.Y. 1994).

42. *Midler*, 849 F.2d at 463.

43. *Id.* (In fact, the court explicitly stated that Ford had not used Midler’s likeness: “The term ‘likeness’ refers to a visual image not a vocal imitation.”).

44. Midler actually presented evidence that some people at least had mistakenly believed that she was the singer featured in the commercial. *See id.* at 461–62.

a. *White v. Samsung Electronics America, Inc.* (9th Cir. 1992)

In many ways *White v. Samsung Electronics America, Inc.*⁴⁵ represents the high-water mark of celebrity right of publicity protection. In an oft-criticized decision, Judge Goodwin of the Ninth Circuit held that Vanna White had a right of publicity claim against Samsung for the latter's use of a robot modeled after White in a televised commercial.⁴⁶ White alleged three separate claims: a federal Lanham Act claim, a California Civil Code statutory right of publicity claim ("section 3344"), and a California common law right of publicity claim.⁴⁷ Although the Ninth Circuit dismissed White's section 3344 claim,⁴⁸ it upheld her right to proceed to trial on both her Lanham Act⁴⁹ and common law right of publicity claims.⁵⁰

One of the interesting aspects of both *Midler* and *White* is that while section 3344 is simply a codified right of publicity, those claims were dismissed but *Midler* and *White*'s common law claims on the same subject were accepted.⁵¹ The *White* court, relying on its earlier decision in *Midler*, held that section 3344 only protected an individual's "likeness" in a fairly literal sense.⁵² Because Samsung had used a robot dressed to resemble White, as opposed to an image of her face, White did not qualify for section 3344 protection.⁵³

However, just as in *Midler*, *White*'s common law right of publicity claim was allowed to go before a jury.⁵⁴ The Ninth Circuit held that *White*'s typical attire and pose, mimicked in Samsung's ad, were iconic enough to constitute misappropriation when used without her permission.⁵⁵ The court distinguished *White*'s claim from the unauthorized use of photographs at issue in *Eastwood v. Superior Court*,⁵⁶ which the district court had relied on to dismiss *White*'s claim. In *Eastwood*, the court required four elements in order to plead a common law right of publicity claim: "(1) the defendant's use

45. *White v. Samsung Elec., Inc.*, 971 F.2d 1395 (9th Cir. 1992).

46. *Id.* at 1402.

47. *Id.* at 1397-98.

48. *Id.* at 1397.

49. *Id.* at 1401.

50. *Id.* at 1399.

51. *White*, 971 F.2d at 1397-98; *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988).

52. *See White*, 971 F.2d at 1397 ("[T]he robot at issue here was not *White*'s "likeness" within the meaning of section 3344.").

53. *Id.*

54. *Id.* at 1399.

55. *Id.*

56. *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 346-47 (Cal. Ct. App. 1983).

of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury."⁵⁷ The critical part of the *White* court's analysis held that, although misappropriation of a celebrity's name or likeness would clearly constitute a violation of that celebrity's right of publicity, "the common law right of publicity is not so confined."⁵⁸

b. *Brown v. Electronic Arts* (C.D. Cal., 2009)

On the other end of the protection spectrum is the currently pending case involving Jim Brown, the former football player and actor, and Electronic Arts ("EA"), the video game publisher.⁵⁹ Brown brought suit against EA, alleging that EA had used Brown's image and general identity in creating one of the unnamed players in the most recent installment of the Madden Football video game franchise.⁶⁰ Like *White*, Brown asserted claims under the Lanham Act, the California Civil Code, and the California common law right of publicity.⁶¹ Unlike *White*, however, Brown was unsuccessful—his Lanham Act claim was dismissed, leaving the federal district court free to decline to extend jurisdiction over the state court claims.⁶² The court reasoned that even though a consumer might well recognize that one of the unnamed characters in the game was intended to represent Brown, that recognition would not necessarily imply endorsement, a key factor in alleging a Lanham Act false endorsement violation.⁶³ The court also noted that important First Amendment rights were implicated, due to the creative nature of the video game.⁶⁴ Once the sole federal claim was dismissed, the court declined to consider the state claims, dismissing them without prejudice and leaving Brown to pursue them in another venue.⁶⁵ Brown has since appealed the district court's decision to the Ninth Circuit.⁶⁶

57. *White*, 971 F.2d at 1397 (quoting *Eastwood*, 198 Cal. Rptr. At 346-47).

58. *Id.*

59. *Brown v. Elec. Arts, Inc.*, No. 2:09cv01598 (C.D. Cal. Sept. 23, 2009), *appeal docketed*, No. 09-56675 (9th Cir. Oct. 23, 2009).

60. *Id.* at 3.

61. *Id.*

62. *Id.* at 9-10.

63. *Id.* at 9.

64. *Id.* at 7-8.

65. *Id.* at 10.

66. *Brown v. Elec. Arts, Inc.*, No. 2:09cv01598 (C.D. Cal. Sept. 23, 2009), *appeal docketed*, No. 09-56675 (9th Cir. Oct. 23, 2009).

c. *Keller v. Electronic Arts* (N.D. Cal., 2010)⁶⁷

Jim Brown is not the only athlete to challenge the unauthorized use of his image in a video game.⁶⁸ Sam Keller, a former Arizona State University and University of Nebraska football player, filed a class action lawsuit against EA Sports in 2009.⁶⁹ His complaint alleged violations of California's statutory and common law rights of publicity and California's Unfair Competition Law.⁷⁰ EA moved to dismiss the claims, arguing that their use was transformative,⁷¹ protected by the public interest exception,⁷² and the section 3344 public affairs exemption.⁷³ While the court recognized the artistic aspects of EA's games, it noted that in order for a transformative use defense to prevail, the transformation must be of the plaintiff's image, not other elements of the game.⁷⁴ Because EA failed to demonstrate any transformation of the players themselves, the court denied EA's use of the defense.⁷⁵ The court also acknowledged a general public interest in "products created for entertainment," but distinguished *Keller* from another similar case, *C.B.C. Distribution and Marketing v. Major League Baseball Advanced Media*, 505 F.3d 818 (8th Cir.

67. This case was consolidated with *O'Bannon v. NCAA*, No. C 09-1967 CW, 2010 U.S. Dist LEXIS 19170 (N.D. Cal. Dec. 8, 2010), a case based on similar facts but instead alleging anti-trust violations. See Complaint at 2.

68. Herb Adderley also brought suit on behalf of 2,056 retired players against the NFL Players Association ("NFLPA"), alleging that NFLPA had failed to protect the players' interests in the context of video game marketing. *Parrish v. Nat'l Football League Players Inc.*, No. C 07-00943 WHA, 2009 WL 88484 (N.D. Cal. Jan. 13, 2009). The suit was heard by a jury in the Northern District of California, who found for Adderley and ordered NFLPA to pay \$28.1 million in damages. See Judgment, *Parrish*, No. C 07-00943 WHA, 2009 WL 88484 (N.D. Cal. Jan. 13, 2009). Although NFLPA initially appealed the decision, it has since settled with the players, agreeing to pay \$ 26.2 million in damages. See Order Granting Motion for Final Approval of the Settlement Agreement and Proposed Plan of Distribution, *Parrish*, No. C 07-00943 WHA, 2009 WL 88484 (N.D. Cal. Jan. 13, 2009).

69. *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 WL 530108 (N.D. Cal. Feb. 8, 2010). Keller also named the National Collegiate Athletics Association ("NCAA") as a defendant, alleging violations of his Indiana right of publicity, as well as civil conspiracy and breach of contract. *Id.* at *7-8. The court dismissed the right of publicity and breach of contract claims with leave to amend due to deficiencies in the pleadings. *Id.* at *11, *30. The court did, however, find sufficient support for Keller's civil conspiracy claim against the NCAA. *Id.* at *27.

70. *Id.* at *8 (Keller also alleged several other violations that do not bear on this discussion).

71. *Id.* at *12-13.

72. *Id.* at *18.

73. *Id.* at *22-23.

74. *Id.* at *18.

75. *Id.* at *16.

2007).⁷⁶ In *C.B.C.*, the court upheld the unauthorized use of athletes' personas on the grounds that the game at issue in *C.B.C.* relied on real-time "recitation and discussion" of the players' performance, a factor not present in *Keller*.⁷⁷ The court therefore also denied EA's public interest defense.⁷⁸ Finally, the court determined that, in order to qualify for the section 3344 public affairs exemption, EA's use would have to extend no further than reporting information about the players.⁷⁹ Because EA's use extended far beyond those bounds, this defense was also denied.⁸⁰ The decision is currently on appeal before the Ninth Circuit and all claims related to EA's First Amendment defense have been stayed.⁸¹

Keller and *Brown* have since been assigned to the same Ninth Circuit panel for consideration of the merits.⁸² A group of *amici* have filed substantially identical *amicus* briefs on behalf of EA Sports in both cases.⁸³ The *amicus* brief opens with this telling statement: "It would be difficult to invent two related cases that more starkly illustrate the troubled state of the law concerning the relationship between the right of the publicity, the Lanham Act, and the First Amendment."⁸⁴

76. *Id.* at *21.

77. *Id.* at *22.

78. *Id.*

79. *Id.* at *25.

80. *Id.*

81. See Order Granting in Part and Denying in part EA's Motion to Stay, Denying CLC's and NCAA's Motions to Stay, and Denying Without Prejudice Publicity-Rights Plaintiffs' Motion to De-Consolidate, *In re* NCAA Student-Athlete Name & Likeness Litig., No. 09-1967, 2010 U.S. Dist. LEXIS 139724 (N.D. Cal. Dec. 17, 2010) (Dec. 17, 2010). The case designation was changed to reflect that *Keller* had been consolidated with several other student athlete claims.

82. See Order, *Brown v. Elec. Arts, Inc.*, No. 09-56675 (9th Cir. Oct. 23, 2009) (filed Apr. 30, 2010) (granting *Brown*'s motion to assign his appeal and *Keller*'s appeal to the same panel for consideration of the merits).

83. See Motion for Leave to File Amicus Brief, *Brown*, No. 09-56676 (9th Cir. Oct. 23, 2009) (filed Sep. 27, 2010); see also Order Granting Leave to File Amicus Brief, *Brown*, No. 09-56676 (9th Cir. Oct. 23, 2009) (filed Feb. 10, 2011) (indicating that *amici* include, among others, Motion Picture Association of America, Inc., Advance Publications, A&E Television Networks, Comic Book Legal Defense Fund, ESPN, Namco Bandai Games America, Konami Digital Entertainment, Take Two Interactive Software, Viacom, and the *Los Angeles Times*).

84. See Prospective Amicus Brief at 1, *Brown*, No. 09-56676 (9th Cir. Oct. 23, 2009) (filed Sep. 27, 2010).

C. The Right to Privacy

The term “right to privacy” is imprecise, because this beguiling expression has been used to designate many different rights of varying importance, from the Fourth Amendment freedom from arbitrary searches and seizures, to the right not to have one’s name bruited about in gossip columns.⁸⁵

The “right not to have one’s name bruited about in gossip columns” refers, of course, to the invasion of privacy torts mentioned in the beginning of this section. These personal rights are, like the right of publicity, of relatively recent origin. The famous article *The Right to Privacy*, by Samuel D. Warren and Louis D. Brandeis was the first place where it was described.⁸⁶ The right was first codified by the state of New York in 1903 in response to a case in which a young woman was held to have no common law right to prevent a flour company from using her picture in their advertisements without her consent.⁸⁷ The law was narrowly phrased and prohibited only the use of an individual’s name or likeness, without the individual’s consent, for advertising or trade purposes.⁸⁸ Nowhere does the statute refer to the “right not to have [one’s] feelings hurt” that Judge Frank referred to in *Haelan*,⁸⁹ or even the simple “right to be let alone” described by Warren and Brandeis.⁹⁰

However, some courts have seen the right to privacy as a sort of moral right in one’s image: Justice Greenbaum, in 1915, referred to “rights for outraged feelings”⁹¹ and as recently as 1983, Judge Sofaer noted that “New York’s Section 51 protects a person’s feelings and right to be let alone . . . interests also protected in California, Illinois, and Georgia. Relief is available under the applicable privacy law only for acts that invade plaintiffs’ privacy and consequently bruise their feelings.”⁹²

85. *Cordell v. Detective Publ’n, Inc.*, 419 F.2d 989, 990 (6th Cir. 1969).

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

87. Samantha Barbas, *The Death of the Public Disclosure Tort: A Historical Perspective*, 22 YALE J.L. & HUMAN. 171, 179 (2010). The case was *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442, 447–48 (1902) and the law that it spawned remains New York Civil Rights Law sections 50 and 51.

88. Prosser, *supra* note 4, at 385–86.

89. *See Haelan Labs. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir. 1953).

90. Warren, *supra* note 86, at 205.

91. *Haelan Labs.*, 202 F.2d at 868, (citing *Pekas Co., Inc. v. Leslie*, 52 N.Y. L.J. 1864 (1915)).

92. *Bi-Rite Enters. v. Button Master*, 555 F. Supp. 1188, 1198 (D.C.N.Y. 1983) (citations omitted).

Today the right to privacy is not typically seen in these terms, at least when it is applied to celebrities.⁹³ Celebrities, as public figures, are expected to endure a certain amount of attention, including negative attention.⁹⁴ “Once the celebrity thrusts himself or herself forward into the limelight, the First Amendment dictates that the right to comment on, parody, lampoon, and make other expressive uses of the celebrity image must be given broad scope.”⁹⁵ The California Supreme Court in *Saderup* reasoned that, due to the strong First Amendment protections granted to artistic expression, a celebrity’s right of publicity was necessarily confined to an economic right.⁹⁶ However, other courts have found that celebrities do retain a traditional right to privacy, although the level of invasion required to support the claim may be higher than for non-celebrities.⁹⁷ It is therefore possible for a celebrity to bring a traditional invasion of privacy claim successfully, should she be able to present a persuasive enough case while simultaneously avoiding a First Amendment defense.

D. False Endorsement and Unfair Competition

At the federal level, both false endorsement and unfair competition claims may be brought under the Lanham Act, the federal statute governing trademark law.⁹⁸ Because these claims are grounded in trademark law, to show that the celebrity’s likeness is protectable under trademark law, it is necessary to demonstrate that the alleged action has caused the plaintiff some kind of economic harm. Additionally, every state has an unfair competition statutory

93. “Consequently, the ‘severely circumscribed’ privacy interest of a public figure does not permit an appropriation tort action for a wide category of types of publicizations related to public figures’ public personalities . . .” DAVID A. ELDER, *PRIVACY TORTS* § 6:9 (updated June 2010) (internal citations omitted).

94. *See Hustler Magazine v. Falwell*, 485 U.S. 46, 51 (1988) (“Such criticism, inevitably, will not always be reasoned or moderate; public figures as well as public officials will be subject to ‘vehement, caustic, and sometimes unpleasantly sharp attacks[.]’” (internal citation omitted)).

95. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, Cal. Rptr. 21 P.3d 797, 807 (Cal. 2001).

96. *Id.*

97. *See, e.g.,* *Waits v. Frito-Lay*, 978 F.2d 1093, 1103 (9th Cir. 1992) (holding that celebrity singer Tom Waits could rightfully recover for mental and emotional damage caused by Frito-Lay’s unauthorized use of a Wait’s sound-a-like in a Dorito’s commercial; Waits’ well-known refusal to commercially exploit his image in this manner was an important factor in the court’s reasoning).

98. 15 U.S.C. § 1112 (2006).

regime, which may or may not include a section addressing false endorsement.

1. *Federal False Endorsement and Unfair Competition Law*

In order to prevail on a claim of false endorsement under section 43(a) of the Lanham Act, the plaintiff must demonstrate that his or her “name, symbol, or device” has been used in commerce in a way that is likely to cause confusion in the mind of the consumer regarding plaintiff’s sponsorship or endorsement of the product.⁹⁹

In addition to any claims under a state right of publicity, many celebrities bring a claim under the false endorsement section of the Lanham Act.¹⁰⁰ In some ways a federal trademark statute seems unrelated to a right of privacy or publicity. However, the section dealing with false endorsement includes elements similar to those in a misappropriation claim; the primary difference is that a Lanham Act false endorsement claim focuses on consumer confusion.¹⁰¹ A false endorsement claim only applies, however, if the court finds that the misuse is “likely to cause confusion, or to cause mistake, or to deceive . . . as to the origin, sponsorship, or approval of his or her goods.”¹⁰²

Some have suggested that a celebrity might choose to bring a Lanham Act claim primarily to ensure that the case will be heard in federal court, allowing enforcement of any judgment across state lines and diminishing the variability that exists in the state right of publicity laws.¹⁰³ This course of action, however, is not without potential dangers, as will be discussed in Part III below.

2. *State Unfair Competition Laws*

There are also state-based unfair competition laws¹⁰⁴ that celebrities may seek to enforce in addition to the Lanham Act.¹⁰⁵ They do not, however, differ substantially from the terms of the

99. See, e.g., *White v. Samsung Elecs. Am.*, 971 F.2d 1395, 1399 (9th Cir. 1992).

100. *Id.*

101. See Solomon, *supra* note 3, at 1206 (discussing why the Lanham Act is not a true analog for a right of publicity).

102. *Id.* at 1206–07.

103. See, e.g., Lindsay Coleman, *Virtual Confusion—How the Lanham Act Can Protect Athletes from the Unauthorized Use of Their Likenesses in Sports Video Games*, 1 AM. U. INTELL. PROP. BRIEF 9, (2010).

104. See, e.g., CAL. BUS. & PROF. CODE § 17200 (West 2011).

105. See, e.g., *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 610 (Cal. Ct. App. 2006).

Lanham Act. The California Unfair Competition statute, for example, prohibits “unfair competition . . . includ[ing] any unlawful, unfair or fraudulent business act or practice and unfair, deceptive, untrue or misleading advertising.”¹⁰⁶ Like the Lanham Act, these state laws are designed to prevent harm to consumers.¹⁰⁷ Where a celebrity’s image has been appropriated to create a false impression of endorsement, an unfair competition claim may be an appropriate addition to a right of publicity claim.¹⁰⁸

E. Copyright

Although copyright is one of the oldest forms of intellectual property law, it extends only to creations that are “fixed in a tangible medium.”¹⁰⁹ Therefore, although a celebrity’s physical creation, such as an autobiography, can be copyrighted, the celebrity’s persona cannot.¹¹⁰ However, courts have sometimes looked to copyright law when determining the contours of common law rights of publicity, especially in the context of a fair use defense.¹¹¹

III. Application of the Legal Standards

One of the major problems facing would-be celebrity litigants is that the application of both the right to privacy and the right of publicity is highly variable depending on the state, and even the court, in which the litigation is initiated. Some general rules, however, tend to apply in the majority of the cases that courts have decided thus far.

A. Applying the Right of Publicity

Today, most courts see the right of publicity as a property right intended to address commercial abuse.¹¹² Therefore, where a celebrity is claiming a purely commercial harm, it can be a very useful

106. BUS. & PROF. § 17200 (West 2011) (this statute has been preempted in several areas that are not relevant to this paper).

107. Rosal v. First Fed. Bank of Cal., 671 F. Supp. 2d 1111, 1126 (N.D. Cal. 2009).

108. See, e.g., Butkus v. Downtown Athletic Club of Orlando, Inc., No. CV 07-2507 PA (JWJX), 2008 WL 2557427 (C.D. Cal. Apr. 21, 2008).

109. 17 U.S.C. § 101 (2006).

110. “A *persona* can hardly be said to constitute a ‘writing’ of an ‘author’ within the meaning of the Copyright Clause of the Constitution.” 1-1 NIMMER ON COPYRIGHT § 1.01[B][1][c] at 1-22 to 1-23, (footnotes omitted) (1999).

111. See, e.g., Comedy III Prods., Inc. v. Gary Saderup, Inc., P.3d 797, 807–08 (Cal. 2001) (considering whether to incorporate the copyright fair use defense into the California right of publicity).

112. See, e.g., White v. Samsung Elec. Inc., 971 F.2d 1395 (9th Cir. 1992); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

tool.¹¹³ It is not, however, without its downsides. First, the First Amendment can trump its protection if a court finds the allegedly offending work has significant expressive goals.¹¹⁴ Moreover, if the harm the celebrity suffers is one of personal outrage or moral offense, rather than an economic harm, they do not have a claim under most rights of publicity.¹¹⁵ This view is in accordance with the development of the right of publicity as a property right, since the economic value of a celebrity's image is seen as her intellectual property under this rationale. Therefore, a celebrity would probably be unable to bring a valid right of publicity claim based on the use described at the beginning of this paper were a court to find either that the offending use (1) did not affect the celebrity's ability to exploit her image economically, or (2) was a protected expressive work.¹¹⁶

However, the right of publicity is sometimes seen as deriving from the right to privacy, which leaves open the possibility of twisting the right of publicity to cover claims of personal offense. The statutes that address the right of publicity typically specify the commercial nature of the harm,¹¹⁷ but the common law is always somewhat open to judicial reinterpretation.

This dual nature of the right of publicity may go a long way towards explaining the inconsistency prevalent in that area of law. The two rights, privacy and publicity, are similar in that they both address the level of control that an individual may exert over image and likeness. However, over the past fifty years, the two rights have diverged in a number of dramatic ways, and each has continued to develop independently, sometimes in ways that have arguably been detrimental to the core rights they were intended to protect.¹¹⁸

Due to this inconsistency, attempting to use either or both of these rights to create a celebrity claim based on misuse of persona with noneconomic damages seems unwise. While it might be workable, further twisting an area of the law already fraught with such problems is inviting chaos. Additionally, since these are both

113. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

114. *See, e.g., Winter v. D.C. Comics*, P.3d 473, 476 (Cal. Ct. App. 2003).

115. 63C AM. JUR. 2D PROPERTY § 6 (2d ed. 2011).

116. *See, e.g., White*, 971 F.2d at 1398; *see also Winter*, P.3d 473 at 478.

117. *E.g.* CAL. CIV. CODE § 3344 (West 2011).

118. *See, e.g., Arrington v. New York Times*, 55 N.Y.2d. 433 (1982) (holding that the *New York Times'* right to freedom of expression trumped Arrington's right not to have his photograph displayed on the cover page accompanying a story with which he violently disagreed).

state or common law-based rights, such an adjustment would likely vary from state to state and would not exist everywhere.

B. Applying the Right to Privacy

The more suitable claim, when the asserted injury is more of a personal affront, is the right to privacy.¹¹⁹ Tort law provides a number of invasion of privacy torts that could be claimed in this situation, such as false light, or misappropriation of image.¹²⁰ There is one serious bar to applying this right to the situations under discussion: Even where a court might consider whether feelings of outrage are sufficient to constitute a claim of action, celebrities are not likely to be included in that protection due to their public stature.¹²¹ Therefore, although the right to privacy is the most applicable doctrine in a situation where the celebrity's complaint relates not to economic injury, but rather to distasteful or offensive material, the public status of a celebrity is likely to bar its use.¹²²

C. Applying the Lanham Act

The goal of trademark law is to prevent consumer confusion and protect a company's investment in its marks.¹²³ Protection of an individual's image does not fit into either of these categories unless the image can somehow be claimed as a mark.¹²⁴ However, a more recent addition to trademark law is the false endorsement section of the Lanham Act.¹²⁵ This section does not specifically mention celebrities but courts consistently find that it "permits celebrities to vindicate property rights in their identities against allegedly misleading commercial use by others."¹²⁶

The key phrase here is "misleading commercial use." Trademark law is, as a whole, solidly grounded in commercial use.¹²⁷ Even more clearly than with the right of publicity, a claim made by a celebrity that fails to assert economic damage will not succeed under a Lanham

119. See *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1198 (D.C.N.Y. 1983) (discussing this aspect of privacy law in a celebrity suit).

120. See, e.g., RESTATEMENT (SECOND) OF TORTS § 652D (1977).

121. See *Jim Henson Prods., Inc. v. John T. Brady & Assocs, Inc.*, 867 F. Supp. 175, 188 (S.D.N.Y. 1994); see also RESTATEMENT (SECOND) OF TORTS § 652D, cmt (e) (1977).

122. See *Bi-Rite Enters.*, 555 F. Supp. 1188 (D.C.N.Y. 1983).

123. MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 2.2 (4th ed. 2007).

124. *ETW Corp. v. Jireh Publ'g, Inc.*, 99 F. Supp. 2d 829, 831-32 (2000).

125. 15 U.S.C. § 1125 (a)(1) (2006).

126. *Parks v. LaFace Records*, 329 F.3d 437, 459 (6th Cir. 2003).

127. *Id.*

Act claim. Therefore, just as a celebrity would be unable to proceed with her claim under the right of publicity if she were found not to be economically damaged by Rock Star's use, so too would a Lanham Act claim be barred if the game publisher's use were found to be noncommercial, or if a court found it unlikely that a consumer would mistakenly believe that the use indicated the celebrity's endorsement.

Additionally, the First Amendment can provide a complete defense to Lanham Act false endorsement claims.¹²⁸ Video games are considered expressive works, entitled to the full protection of the First Amendment.¹²⁹ Even though video game publishers clearly hope to profit from the sales of their games, an ultimate goal of profit does not preclude categorization as noncommercial use.¹³⁰ Moreover, a use that is morally antithetical to the offended celebrity is actually less likely to be prohibited under the Lanham Act than a neutral one would be, since the greater the distance between the purported infringing work and the celebrity persona, the lower the chance of consumer confusion and, ultimately, the stronger the First Amendment claim.

The recent ruling in *Jim Brown v. Electronic Arts, Inc.*, indicates that such a claim by other similarly situated celebrities may not prove fruitful.¹³¹ In *Brown*, the California district court held that Brown's "mere presence in *MaddenNFL* d[id] not constitute an *explicit* attempt to convince consumers the [sic] Brown endorsed the games."¹³² However, *Brown* is currently on appeal to the Ninth Circuit so the final outcome remains uncertain. The question of whether Brown's presence in *MaddenNFL* is an important one; many eyes will be on the Ninth Circuit as it considers this appeal.¹³³ EA's use of Brown's persona seems difficult to deny; however, the fact that Brown's image does not appear on any promotional material seems

128. E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1101 (9th Cir. 2008).

129. See Kirby v. Sega of Am., Inc., 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006), citing *Interactive Digital Software v. St. Louis County*, 329 F.3d 954, 956–58 (8th Cir. 2003).

130. See, e.g., *Mattel v. MCA*, 296 F.3d 894, 905–06 (9th Cir. 2002).

131. *Brown v. Elec. Arts*, No. 2:09-cv-01598-FMC-RZx (C.D. Cal. Sep. 23, 2009), *appeal docketed*, No. 09-56675 (9th Cir. Oct. 23, 2009).

132. *Id.*

133. One of the distinctions the district court made was between the use of a celebrity image in promotional material and use within the game, reasoning that while the former might well be seen as indicating endorsement, the latter did not. On appeal, Brown has argued that this decision was improper because it relied on findings of fact not supported by Brown's complaint. Brief for Appellant at 16, *Brown v. Elec. Arts.*, No. 09-56675, (9th Cir. July 6, 2010).

likely to undermine his Lanham Act claims, meaning that the Ninth Circuit may, like the district court, decline to hear the state court claims.

The Lanham Act is, at its heart, a trademark statute with the primary goal of preventing consumer confusion.¹³⁴ The Act's false endorsement section aligns neatly with that goal; using that section to protect either a moral or economic right to one's image does not.¹³⁵ Although some celebrities have managed to prevail on Lanham Act claims in cases that more clearly resembled violations of a right of publicity than false endorsement,¹³⁶ relying on the Lanham Act to provide federal right of publicity protection remains unwise.¹³⁷ Many other celebrities have not prevailed on their Lanham Act claims; in Jim Brown's case, his misguided reliance on a Lanham Act claim prevented his state law claims from being heard in federal court.¹³⁸ Moreover, as the ability of celebrities to bring Lanham Act false endorsement claims to obtain federal right of publicity protection supports the argument that there is no need for an actual federal right of publicity statute.¹³⁹

D. The Impact of New Technology on a Right to Publicity

If the legal standards governing noncommercial misappropriation of celebrity images is confusing today, the situation will likely worsen as new technology leaps ahead of the law. Already companies are able to "re-animate" deceased celebrities and place their images into movies and commercials.¹⁴⁰ While this phenomenon has not yet gained popularity in the United States, it is widespread in some

134. Solomon, *supra* note 3, at 1206.

135. *See id.* at 1206–07.

136. *See, e.g.,* Allen v. Nat'l Video, Inc., 610 F. Supp. 612 (D.C.N.Y. 1985) (holding that the use of a Woody Allen look-a-like violated the Lanham Act by potentially misleading consumers into the belief that Woody Allen endorsed the product).

137. This is particularly true given concerns that trademark law, like other growing fields of intellectual property, has been forced to accommodate a growing array of rights that do not align with the core goals of trademark law. *See generally* Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1999).

138. *See* Brown v. Elec. Arts, No. 2:09-cv-01598-FMC-RZx (C.D. Cal. Sep. 23, 2009), *appeal docketed*, No. 09-56675 (9th Cir. Oct. 23, 2009).

139. *See* Solomon, *supra* note 3, at 1211–12.

140. Stuart Klawans, *Ideas & Trends: Dead Stars, Alive Again; Yes, Marilyn May Fall in Love With Viggo*, N.Y. TIMES, Aug. 1, 2004, available at <http://query.nytimes.com/gst/fullpage.html?res=9D04E7D71E3DF932A3575BC0A9629C8B63>.

countries, such as Korea.¹⁴¹ Similarly, video game developers have begun to incorporate celebrity images into games, both with celebrity authorization and without.¹⁴² Given the popularity of playing these real-life characters, the practice seems unlikely to disappear any time soon.

In the past, if a third party misappropriated a celebrity's image, the worst damage that the celebrity was likely to suffer was the appearance of the image in an advertisement that its owner found objectionable.¹⁴³ Regardless of the context of the use, the image was simply that—a still image. Today, far more is possible. The advancement of highly realistic imagery in video games means that developers can now place a celebrity's image in the midst of a realistic world where third parties control his or her actions. The level of potential invasion is therefore substantially higher and calls for a stricter protection regime.¹⁴⁴

141. See, e.g., Hyung Doo Nam, *The Emergence of Hollywood Ghosts on Korean TVs: The Right of Publicity from the Global Market Perspective*, 19 PAC. RIM L. & POL'Y J. 487 (2010).

142. The MaddenNFL franchise is only one such example. NBAJam, also by EA Sports, has included a celebrity player feature since its earliest incarnation in 1993; the new version for the Wii allows fans to unlock teams that include the Beastie Boys, numerous historic basketball favorites, President Barack Obama, Joe Biden, Bill and Hillary Clinton, Al Gore, George W. Bush, Sarah Palin, John McCain, and Dick Cheney. ESPN interview by Jon Robinson with Trey Smith, creative director of NBA Jam (Oct. 5, 2010) available at http://espn.go.com/espn/thelife/videogames/blog/_/name/thegamer/id/5650055/palin-obama-star-nba-jam?readmore=fullstory. During the interview, Robinson asked Smith how EA had received permission from the various politicians, to which Smith answered simply, "I have no idea."

143. See, e.g., *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (9th Cir. 2001) (holding that *Los Angeles Magazine's* publication of an altered photograph, based on the famous 'Tootsie' poster featuring Hoffman in a red evening gown, of Hoffman's head from the original picture on the body of a male model dressed in an evening gown and heels was protected noncommercial speech).

144. The band No Doubt has a pending suit against Activision on very similar grounds. Gwen Stefani (the band's well-known lead singer) and other band members allege that they agreed to appear in Activision's Band Hero video game in a limited way. The band claims that their images were then used beyond the bounds set in their contract with Activision. Stefani specifically claims injury based on Activision allowing game players to use Stefani's character to perform songs that Stefani finds personally offensive, including the Rolling Stones' "Honky Tonk Woman." The suit is currently pending before the Los Angeles Superior Court. *No Doubt v. Activision Publ'g Inc.*, No. CV 09-8872 SVW (VBKx). It seems clear from the band's complaint, however, that the interactive aspect of the game, which allowed players to control band members' images, was part of what made the alleged invasion of privacy that much more offensive to the plaintiffs. See Alex Dobuzinskis, *Rockers Sue Activision Over Band Hero*, REUTER, (Nov. 4, 2009, 7:00pm, <http://www.reuters.com/article/idUSTRE5A400320091105>); see also *No Doubt v. Activision*, 702 F. Supp. 2d 1139 (C.D. Cal. 2010).

Video game developers often use real-life images as the basis for the art they produce for video games.¹⁴⁵ The artistic aspect of video games provides the artists a high level of First Amendment protection, often allowing game designers to overcome both trademark and right of publicity claims.¹⁴⁶ At the same time, both the right of publicity and right to privacy have been invoked in the past to prevent unauthorized uses of celebrity images when those images cause economic injury or extreme offense, respectively. The question becomes: where do First Amendment protections end, and celebrity rights begin? This paper suggests that the increased realism of video games necessitates the drawing of a more precise line, especially when there is no economic injury. Allowing this area of law to remain unsettled places game designers in a position of uncertainty with regard to whether their creations, which are costly and labor intensive, will be protected, and celebrities in a position of uncertainty with regard to which uses they may legitimately prevent. This will lead to increased litigation, and could have a chilling effect on the development of the gaming industry. The results in *Brown* and *Keller*, as discussed in Part II above, demonstrate the need for a clear standard in this area; Part IV of this paper will suggest ways this could be achieved. Whichever approach is ultimately selected, however, it seems clear that clarification and increased consistency are needed.¹⁴⁷

IV. Alternative Approaches

Part of the difficulty with finding a way to protect a celebrity's right to her image apart from any economic considerations is that American jurisprudence has generally opted to put less emphasis on moral rights than on economic ones, especially in the realm of

145. See *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1097 (9th Cir. 2008).

146. See *Brown v. Elec. Arts*, No. 2:09-cv-01598-FMC-RZx (C.D. Cal. Sep. 23, 2009), *appeal docketed*, No. 09-56675 (9th Cir. Oct. 23, 2009) (discussed above, holding that EA's alleged violation of the Lanham Act was protected by the First Amendment); see also *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 614–16 (Cal. Ct. App. 2006) (holding that the use that allegedly violated Kirby's right of publicity was transformative enough to merit First Amendment protection).

147. *But cf.* Oliver A. Khan, *Me, Myself, and My Avatar: The Right to the Likeness of Our Digital Selves*, 5 ISJLP 447 (2010) (discussing whether players have a right of publicity in avatars, or character images, designed to represent themselves. While Khan indicates that they probably do not have such a right at this time, he also suggests that this may change as video games become more photorealistic).

intellectual property.¹⁴⁸ One reason for this could be that the First Amendment right to free expression is seen as a basic, inalienable right. Because the Constitution explicitly protects the right to free expression, any action seen as censorship tends to be subject to strict scrutiny. Alternately, it could simply be that economic rights are easier to delineate and enforce, which improves consistent enforceability. Whatever the reason, between the limited availability of a right of privacy action for celebrities and the primarily commercial focus of the right of publicity and false endorsement laws, celebrities are seemingly left with no reliable way to challenge use of their images that they find personally objectionable, short of a defamation or false light claim.¹⁴⁹

Parts II and III of this paper attempted to provide an accurate description of the general state of affairs in this area of the law. In light of that description, it appears that celebrities who have suffered a noncommercial harm, especially one that may not rise to the level of outrage sometimes required in invasion of privacy cases, may have a difficult time identifying the appropriate course of action. One proposed solution is the adoption of a moral rights scheme similar to those common in Europe.¹⁵⁰ While this solution does have a certain appeal, it also has serious flaws that make its adoption in America seem unlikely. A more plausible solution is the adoption of a more clearly defined federal right of publicity. These two options will both be discussed in great detail in the following sections.

A. Incorporating Moral Rights into the American System

1. Moral Rights in Europe

In European copyright law, “moral rights” refer to the rights of a creator (1) to receive (or deny) attribution for her works; (2) to prevent unauthorized alteration of her work; and (3) to withdraw or

148. For an interesting discussion of why this might be in the context of copyright law, see Joan Pattarozzi, *Can the Australian Model Be Applied to U.S. Moral Rights Legislation?*, 15 CARDOZO J. INT'L & COMP. L. 423 (2007).

149. Although defamation and false light look like appealing alternatives at first blush, they are prone to many of the same weaknesses as the rights discussed above; they are based in state law, they have numerous specific elements that can be difficult to prove, and they are generally more difficult for celebrities to invoke. Moreover, they don't tend to be used as often (perhaps for those reasons) so this paper has not addressed them in depth.

150. See, e.g., Roberta Rosenthal Kwall, *Preserving Personality and Reputational Interests of Constructed Personas Through Moral Rights: A Blueprint for the Twenty-First Century*, 2001 U. ILL. L. REV. 151, 152 (2001).

correct her work.¹⁵¹ The second right, often called the right to integrity, has been interpreted as including the right to prevent another from destroying the work, displaying a distorted version of the work, performing the work without following the creator's instruction for doing so, or displaying the work out of context.¹⁵² It is important to note that these rights continue after the work has been sold, are inalienable, and depending on the circumstances, may be unwaivable.¹⁵³

France provides the most extensive protection with its Code de la Propriété Intellectuelle Arts ("I.P. Code").¹⁵⁴ The code protects not only authors, painters, and other traditional "artists" but also performers in general, providing them with inalienable rights to exercise some level of control over their creations and to protect their reputations.¹⁵⁵ This is contrary to some of the other codes that extend only to more traditional fields; for example, the Berne Convention for the Protection of Literary and Artistic Works extends similar rights but only to "authors."¹⁵⁶ There has, however, been a movement throughout Europe and some of the common law countries during the last fifty years or so to provide broader protection to performers, including protection for a performer's "reputational and personality rights."¹⁵⁷

151. Thomas F. Cotter, *Pragmatism, Economics, and the Droit Moral*, 76 N.C. L. REV. 1, 12 (1997). For an explanation of how these right typically function, see Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 VAND. L. REV. 1, 5-7 (1985).

152. Cotter, *supra* note 151, at 13-14 (internal citations omitted). Each example in this list comes from an actual case brought in France or Germany.

153. Cotter, *supra* note 151, at 12.

154. See Kwall, *supra* note 151 at 12.

155. CODE DE LA PROPRIÉTÉ INTELLECTUELLE art. L. 212-2: "A performer shall have the right to respect for his name, his capacity and his performance. This inalienable and imprescriptible right shall attach to his person. It may be transmitted to his heirs in order to protect his performance and his memory after his death." This right extends to "persons who act, sing, deliver, declaim, play in or otherwise perform literary or artistic works, variety, circus or puppet acts." *Id.* at art. L. 212-1.

156. Berne Convention for the Protection Literary and Artistic Works art. 6bis, July 24, 1971/828 U.N.T.S. 221 [hereinafter *Berne Convention*] "The Berne Convention was signed in 1886 and is the oldest multilateral treaty governing copyright protection. Article 6bis of the Berne Convention addresses moral rights of authors, but does not cover performers." Kwall, *supra* note 150 at 156, n.35.

157. Kwall, *supra* note 151 at 155-56.

2. *Moral Rights in America*

The United States has generally declined to create a specific “moral right” for artists.¹⁵⁸ The Visual Artists Rights Act of 1990 (“VARA”) creates something akin to a moral right but it only extends, as the name suggests, to visual artists.¹⁵⁹ The United States is also a signatory to the Berne Convention, which includes a moral rights clause.¹⁶⁰ However, when the United States signed the Berne Convention in 1988, it did so with the understanding that the moral rights clause would not apply. The argument was that the treaty is not self-executing, and because the United States already protects those same rights with all of the protections discussed above, the moral rights clause is unnecessary.¹⁶¹ Therefore, American artists in nonvisual arts fields have had to continue to rely on the patchwork of privacy, publicity, unfair competition, and tort law described above. While there are legitimate First Amendment concerns when considering a system of inalienable moral rights such as the one in France, there are also serious concerns with the United States’ unwillingness to join the rest of the Western world in extending some kind of coherent, universal protection to artists.¹⁶²

Commentators have been discussing the possibility of incorporating moral rights into the United States’ intellectual property landscape for decades.¹⁶³ This raises several problems, however. First, haphazard as the laws of privacy, publicity, and unfair competition are, they have existed long enough to become a settled part of the system. Changing settled laws creates uncertainty. This danger only increases when the change in law would occur by way of importing a civil law concept with the potential to run headlong into First Amendment issues. Moreover, the United States has always favored free alienability, which the French moral rights system prohibits, and the freedom to contract, which the French system limits

158. *Geisel v. Poynter Prods, Inc.*, 295 F. Supp. 331, 340 n.5 (S.D.N.Y. 1968).

159. 17 U.S.C. § 101.

160. *Berne Convention*, *supra* note 156.

161. See Justin Hughes, *American Moral Rights and Fixing the Dastar “Gap,”* 2007 UTAH L. REV. 659, 665–66 (2007).

162. See, e.g., Jennifer M. Driscoll, *It’s a Small World After All—Conflict of Laws and Copyright Infringement on the Information Superhighway*, 20 U. PA. J. INT’L ECON. L. 939 (1999).

163. See, e.g., Kwall, *supra* note 151; Edward J. Damich, *The Right of Personality: A Common-Law Basis for the Protection of the Moral Rights of Authors*, 23 GA. L. REV. 1, 15 (1988); Adolf Dietz, *Alai Congress: ANTWERP 1993, The Moral Right of the Author: Moral Rights and the Civil Law Countries*, 19 COLUM.-VLA J.L. & ARTS 199, 212 (1995).

in a number of ways. Why, then, should we even consider such a system?

Mark McKenna, an assistant professor at the Saint Louis University School of Law, posited an interesting theory in his article *The Right of Publicity and Autonomous Self-Definition*.¹⁶⁴ Professor McKenna's premise is that everyone, whether famous or not, has an inherent interest in his or her public image that deserves protection.¹⁶⁵ He describes the potential damage of a situation involving the appropriation of a celebrity's image in a non-commercial but personally offensive way as causing "destabilization of meaning" because it tends to create new associations in the minds of viewers, regardless of confusion over endorsement.¹⁶⁶

While Professor McKenna does not describe his proposal in terms of moral rights, what he is advocating could be described in such terms, given that the protection he suggests is for an individual's right of self-definition. Alice Haemmerli, former dean at Columbia Law School, made a similar argument in support of a proposed amendment to the Lanham Act that would have functioned as a federal right of publicity.¹⁶⁷ In contrast, Roberta Rosenthal Kwall, a professor at the DePaul College of Law, proposes incorporating European moral rights into the American copyright system.¹⁶⁸ In *Preserving Personality and Reputational Interests of Constructed Personas Through Moral Rights*, Kwall makes a two-fold argument: first, she argues that a celebrity persona is a creative work protectable by copyright law, and second, she proposes that the United States implement European-style moral rights at a federal level.¹⁶⁹ She notes at least six countries have already enacted provisions that specifically

164. Mark McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 225 (2005–2006).

165. *Id.* at 279–80.

166. "This destabilization might result from third-party uses that offer inconsistent or negative interpretations of an identity." *Id.* at 288.

167. See Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 410 (1999).

168. Kwall, *supra* note 150 at 159; see also Kwall, *supra* note 151.

169. Kwall, *supra* note 150, at 159–60, 165–66. Kwall also suggests that celebrity personas should be protectable under the current copyright scheme, although that is not currently the case: "Additionally, federal moral-rights protection is necessary to protect the reputational and personality interests of performers and others whose personas are subject to mutilation through misappropriation. Unfortunately, in the United States, conventional moral-rights and copyright doctrines have ignored the reality that constructed personas are works of authorship, and therefore eligible for protection under federal copyright law." *Id.* at 154.

protect the public personas of celebrities¹⁷⁰ and points to a number of international conventions that have done the same.¹⁷¹ One of the primary reasons she believes this change is necessary is the state of confusion described above.¹⁷²

Ultimately, the problem with attempting to incorporate moral rights into the American system, whether through the Lanham Act, copyright law, or independently, is that any discussion of a moral rights system will inevitably invite comparisons with the European system. The danger of the comparison is that when one looks at the European system, it quickly becomes apparent that many aspects of those systems are fundamentally incompatible with the First Amendment.¹⁷³

B. Federal Right of Publicity Legislation

Although adopting a European-style moral rights scheme would pose serious difficulties, this does not mean that creating a modified moral right, with appropriate limitations, is not feasible. Though Congress has considered proposals for a federal right of publicity in

170. See *id.* at 155, n.31: Dr. Adolf Dietz, *Germany*, in INTERNATIONAL COPYRIGHT LAW AND PRACTICE GER-1, § 9 (Paul Edward Geller et al. eds., 1999) (“One moral right is recognized in Section 83, which entitles the performer to prohibit such distortion or other alteration of his performance as might prejudice his prestige or reputation . . .”); Dr. Mario Fabiani, *Italy*, in INTERNATIONAL COPYRIGHT LAW AND PRACTICE ITA-1, § 9[1][a][i] (Paul Edward Geller et al. eds., 1999) (“Article 81 of the Act affords to performers the moral right to relief from such dissemination, transmission, or reproduction of their performances as would be prejudicial to their honor or reputation.”); Dr. Gunnar Karnell, *Sweden*, in INTERNATIONAL COPYRIGHT LAW AND PRACTICE SWE-1, § 9[1][a][i] (Paul Edward Geller et al. eds., 1999) (“Performers have the same moral rights as authors.”); Andre Lucas, *France*, in INTERNATIONAL COPYRIGHT LAW AND PRACTICE FRA-1, § 9[1][a][i] (Paul Edward Geller et al. eds., 1999) (“A performing artist has rights to respect for his name and status . . . and to respect for his interpretation, that is, for its integrity.”); Alain Strowel & Jan Corbet, *Belgium*, in INTERNATIONAL COPYRIGHT LAW AND PRACTICE BEL-1, § 9[1][a][i] (Paul Edward Geller et al. eds., 1999) (“The 1994 Copyright Act grants artistic performers . . . [t]he right of integrity, like that in Article 6bis of the Berne Convention, is predicated on showing prejudice to honor or reputation.”); Joshua Weisman, *Israel*, in INTERNATIONAL COPYRIGHT LAW AND PRACTICE ISR-1, § 9[1][a] (Paul Edward Geller et al. eds., 1999) (“Performers have moral rights like those of authors, except that they are protected only against modifications of a derogatory nature . . .”).

171. *Id.* at 156.

172. *Id.* at 159–60.

173. See Lawrence Adam Beyer, *Intentionalism, Art, and the Suppression of Innovation: Film Colorization and the Philosophy of Moral Rights*, 82 NW. U. L. REV. 1011, 1055 (1988) (arguing that the moral rights movement is in reality an attempt to “impose through the law their views on public immaturity, ignorance, or psychological enslavement.”).

the past, it has yet to approve one.¹⁷⁴ One of the problems inherent in these proposals has been the attempt to graft the right of publicity on to a pre-existing statute, most often the Lanham Act.¹⁷⁵ The Lanham Act, however, already provides sufficient protection for celebrities that are concerned with a false impression of endorsement.¹⁷⁶ The protections that are missing are: (1) consistent protection for commercial misuse that does not qualify as false endorsement, and (2) for significant moral offense, whether commercial or not. Attempts to wedge a right of publicity that would address both of these issues into a well-defined framework designed to reach a wholly separate issue is unwise and likely to cause more problems than it would resolve. A new statute delineating which rights deserve protection while simultaneously providing adequate First Amendment protections would serve both celebrities and the judicial system far more effectively.

V. Conclusion

Judges and legislators have worked to find a way to balance privacy rights with free speech rights for the last hundred years. While their intentions were good, and some useful laws have been passed, the result is a mishmash of laws, state and federal, that overlap in some areas, neglect other areas, and leave individuals uncertain as to what exactly their protections are. This uncertainty is amplified in the case of public figures who have often been excluded from many of the privacy protections, yet granted expanded publicity rights. Until recently, it could be argued that, confusing as the system was, when combined with the ability to contract freely, it was adequate. This is no longer the case. The potential for significant noncommercial violations has increased exponentially with advances in technology, while the protection granted has remained in a state of flux. Moreover, increasing globalization makes the United States' unwillingness to comply with other Western nations all the more glaring. Finally, very few major companies operate in a single state anymore, making the state by state nature of the current protections even more problematic.

174. See Marci A. Hamilton et al., *Rights of Publicity: An In-Depth Analysis of the New Legislative Proposals to Congress*, 16 CARDOZO ARTS & ENT. L.J. 209 (1998).

175. Eric J. Goodman, *A National Identity Crisis: The Need for a Federal Right of Publicity Statute*, 9 DEPAUL-LCA J. ART & ENT. L. & POL'Y 227, 247-50 (1999).

176. See, e.g., *White v. Samsung Elecs., Inc.*, 971 F.2d 1395, 1401 (9th Cir. 1992).

It could be argued that any action taken now would be premature, given that no one has actually abused the uncertainty in the law in the way described at the opening of this paper. No actor or actress has challenged any improper use of her face in *Grand Theft Auto* nor does such action seem imminent. Or does it? The *Brown* and *Keller* cases are on appeal to the Ninth Circuit right now and, while they do not involve either player's face being put in any kind of compromising position, they do involve allegations of the wholesale use of celebrity personas without permission. No Doubt's pending lawsuit against Activision is premised largely on the band members' personal distaste for the scenarios in which developers placed their images in the video game "Band Hero."¹⁷⁷ And in 2010, one of the backup singers in Cypress Hill, Michael "Shagg" Washington, filed suit against Rockstar, alleging that they used his persona as the basis for the character of C.J., the lead character in *Grand Theft Auto: San Andreas*.¹⁷⁸ So perhaps the hypothetical raised here is not as distant as one might be hope.¹⁷⁹ While it is certainly possible (and perhaps necessary, in the case of judicial action) to wait to take action until a game developer actually oversteps the boundaries of decency, it is also possible for Congress to take preemptive action to clarify this issue before it becomes even more of a morass.

A. The Need for a Federal Right of Publicity Statute

The need for a federal right of publicity statute is increasingly clear, given the plethora of related lawsuits brought in the context of video games in recent years. The traditional tort laws may have been sufficient in the days of print media (though that statement itself is certainly open to debate) but they are no longer adequate today, as

177. See *No Doubt v. Activision Publ'g Inc.*, 702 F. Supp. 2d 1139 (C.D. Cal. 2010). Interestingly, the Ninth Circuit panel recently requested that the plaintiffs in *Brown v. EA* and *Keller v. EA* submit supplemental briefs discussing how the California Court of Appeals' recent ruling in *No Doubt v. Activision*, affirming the trial court's denial of Activision's transformative use argument, might affect the appeal. Order, *Brown v. Elec. Arts*, Case No. 09-56675, (filed Feb.18, 2011).

178. Complaint at 1, *Washington v. Rockstar Games, Inc.*, No. BC 450602 (Complaint) (Cal. Super. Ct., Los Angeles, filed Dec. 6, 2010); see also Drew Boortz, Developing Concerns: Legal Developments Pertaining To and Affecting the Video Game Industry, *Grand Theft Copyright? Rockstar and Take-Two Sued for \$250 Million* (Dec. 10, 2010) <http://www.developingconcerns.com/2010/12/articles/intellectual-property-1/grand-theft-copyright-rockstar-and-taketwo-sued-for-250-million/>.

179. See Richard Masur, *Right of Publicity from the Performer's Point of View*, 10 DePaul-LCA J. ART & ENT. L. & POL'Y 253, 258 (2000) ("As technology develops, enabling more and more thefts of both still and moving images to occur, a mechanism for curtailing this type of abuse becomes increasingly necessary.").

can be witnessed by the bewildering array of allegations made in many of these cases. What is critical is that Congress not attempt to graft yet another side law onto preexisting intellectual property law. It is time for the legal world to recognize that privacy law, while connected to intellectual property, is not merely a subset of trademark or copyright law. Any attempt to fit a federal right of publicity into an existing scheme will serve only to muddy the laws further. Instead, Congress must draft a new statute that delineates precisely which rights a famous individual has with regard to the use of her name, image, voice, and persona. Additionally, Congress must articulate which First Amendment protections are available to creators.

B. Suggested Parameters of a Federal Right of Publicity Law

One possible model for a federal right of publicity is the Trademark Dilution Revision Act (“TDRA”).¹⁸⁰ The TDRA was designed to protect only the most famous marks, providing those marks with protection against tarnishing or offensive uses that would otherwise be permitted, regardless of whether the damage is pecuniary or not.¹⁸¹ Private citizens are already protected against public misappropriation of their images by the traditional invasion of privacy torts. Congress could provide celebrities with protection against technological misappropriations without significantly hindering free expression by providing a separate right of publicity against unauthorized commercial and noncommercial use to those celebrities that establish the requisite level of fame.

Under the TDRA, before a mark qualifies for protection, the mark holder must demonstrate that the mark is famous.¹⁸² The statute provides a nonexhaustive list of evidence through which a mark holder may provide that proof, including the distinctiveness of the mark, the duration and extent of use, the duration and extent of related advertising, the geographical extent of use, the channels of trade in which the mark is used, the degree of recognition of the mark

180. 15 U.S.C. § 1125(c) (2006). The TDRA also protects against “diluting uses,” or those that lessen the mark’s power to serve as a distinctive identifier. However, that application does not appear appropriate in the celebrity image context and will not be addressed in this paper.

181. See *Trademark Dilution Revision Act of 2005: Hearing on H.R. 683 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. 12 (2005) (statement of Ann Gundelfinger).

182. See *Louis Vittone Malletier, S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 264–65 (4th Cir. 2007).

in those channels, whether other third parties use the same or similar marks and if so to what extent, and the nature of the mark's registration.¹⁸³ With reasonable alterations, this list could be adjusted for use in the celebrity arena: a celebrity could provide proof of her widespread appearance in media, the distinctiveness of her name, persona, or other protectable asset, the length of time during which she has publicized the protectable asset, and the venues in which she uses the protectable asset.

One problem that courts have encountered in applying the TDRA is determining what level of fame must be present before a mark qualifies for TDRA protections.¹⁸⁴ Therefore, Congress must include clearer instructions in the federal right of publicity statute, that inform celebrities and courts alike of which celebrities will be permitted to claim this protection. One possible way to achieve this would be to require celebrities to provide evidence of at least three of the factors of fame, or to demonstrate recognition by the public in the specified region, at or above the level of a certain percent.

The TDRA also includes a section that outlines the First Amendment protections available to creators. The last thing that a reasonable celebrity wants is for the entertainment world to lose the ability to parody or comment on people. Instead, the statute should prohibit only uses that take someone's image or persona and insert it into a work without any meaningful purpose, along the lines of the traditional *Rogers* test.¹⁸⁵ An intent to parody or comment must qualify as protected expression, as should artistic expression. For example, federal right of publicity should clearly protect a use such as Addicting Games' depiction of former Vice President Cheney in *Cheney's Fury* (in which the player takes on the role of former Vice President Cheney and attempts to shoot other political figures while hunting) since the game is a timely parody of Cheney's hunting incident.¹⁸⁶ In contrast, the federal right should not protect the

183. 15 U.S.C. § 1125(c).

184. *Compare* Board of Regents v. KST Electric, Ltd., 550 F. Supp. 2d 657, 679 (W.D. Tex. 2008) (finding that the Texas Longhorn mascot was not sufficiently famous to merit protection under the TRDA) *with* Univ. of Kansas v. Sinks, 565 F. Supp. 2d 1216, 1258 (D. Kan. 2008) (finding that the Kansas Jayhawk mascot was sufficiently famous to overcome a motion for summary judgment).

185. *See* *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). The *Rogers* test asks whether the allegedly infringing use has any artistic relevance and, if so, whether the use is likely to be misleading. *Id.* The claims in *Rogers* were based in both the Lanham Act's false endorsement provision and state law right of publicity and defamation claims.

186. *Cheney's Fury*, Addicting Games, <http://www.addictinggames.com/life-style-games/chenygame.jsp> (last visited Oct. 18, 2011).

hypothetical game featuring a known actress, unless the game producers could demonstrate that they had some kind of legitimate comment to make regarding that celebrity.

The unfortunate reality of such a distinction is that it will still require difficult line drawing. However, even such a test as that, based on federal legislation, would be preferable to the muddle that exists at present. It might be possible, also, for Congress to incorporate aspects of the state laws that have proved most effective and thus craft a workable federal statute.

C. Whether Moral Rights Should Be Addressed in the Federal Right of Publicity Statute

Professor McKenna's suggestion of a single right of self-definition statute that would apply to all individuals, regardless of fame, is an interesting possibility but may prove too close to traditional moral rights law for comfort. Reopening the discussion of the possibility of incorporating more of a moral rights scheme into U.S. law could eventually prove fruitful, however. The question is not whether the United States should follow in the footsteps of France—that would be impractical, given the countries' different histories and values, and it would be unnecessary. However, a vast area exists to be explored between the current lack of moral rights in most areas in the United States and the expansive protections granted in France. The passage of the VARA indicates that there is some level of willingness to create moral rights in the United States. The questions that remain are: (1) Which rights deserve such protection, and (2) How can that protection best be extended? Optimally, a federal right of publicity statute would include a moral rights provision for artists and performers in such a way as to balance them with First Amendment rights at the outset.

The critical goal, in the end, is for Congress to recognize this problem before it grows too large to contain. If performers begin to feel too threatened, it's entirely possible that they will relocate. The fact that California has both the most expansive protections for performers and the largest population of performers is no accident; there is no reason the next move could not be to Europe. Rather than continue in a system that simply encourages performers to file suit in advantageous states (thus overwhelming those systems) and tack on every possible claim in the hopes that one will stick, the legislature must work towards implementing a new rule that is coherent, consistent, and practical. Only in doing so, can the law

provide the stability and enforceability that are the hallmarks of any good legal plan.