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RAISING WALLS AGAINST OVERLAPPING RIGHTS: PREEMPTION AND THE RIGHT OF PUBLICITY

*Rebecca Tushnet**

INTRODUCTION

The right of publicity overlaps with trademark in its protections against false endorsement, with copyright in its (supposed) justifications in incentivizing performances, and with traditional privacy and defamation torts in protecting personal dignity and control over one's own presentation of the self. Yet the right of publicity has been used to extend plaintiffs' control over works and uses that don't violate any of the rights with which it shares a justification. This quicksilver nature is what makes the right of publicity so dangerous.

The law overlaps in the form of preemption cases might offer some assistance in suggesting a purposive approach. Where the state-law right of publicity has a similar purpose to that of copyright, it can conflict with that right and be preempted by federal law. Where the right of publicity's purpose is different, however, the relevant purpose or purposes furthered should guide our analysis of the appropriate limits on the right. The fact that plaintiffs have renamed their claims should not enable them to extend their rights beyond the underlying justifications for those rights.

By comparing how preemption and First Amendment law have used purposive approaches to limit the right of publicity, we can see something about how boundary work in intellectual property law (IP) is done—badly, usually, with justifications that aren't consistent or that assume that other regimes work differently than they actually do. One improvement would be to embrace categorical approaches, rather than unpredictable case-by-case balancing; both preemption and First Amendment doctrines can lend themselves to this approach. Another improvement would be to think of the First Amendment as an intellectual property regime of its own, one with general preemptive power. As Justice Brandeis said, the general rule is that ideas are “free as the air to common use,” subject to changes worked by positive law,

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but the First Amendment can prevent positive law from putting ideas or facts off-limits.¹

I. THE EXPANSION OF THE RIGHT OF PUBLICITY

The stunning expansion of the right of publicity has been extensively covered elsewhere.² I will offer only two appalling recent examples: in 2015, a district court allowed a right of publicity claim against a racing video game to proceed.³ The theory of the case was that the game offered a visual representation of an actual racing track, including an image of a banner displaying the trademark of Virag, an Italian flooring company.⁴ Virag is also the last name of Mirco Virag, one of Virag’s owners, and the court accepted the allegation that the Virag trademark was a “personification” of Mirco Virag.⁵ As a result, although the First Amendment precluded a claim against the video game based on allegations of trademark infringement,⁶ a right of publicity claim survived based on the game’s alleged use of Mirco Virag’s identity—based on the same banner that triggered the First Amendment-barred confusion claim.⁷ Even in such cases of flat-out conflict between trademark’s and the right of publicity’s respective First Amendment limits, courts have been unwilling to limit the right of publicity.⁸

Similarly, a California trial court recently found that a plaintiff had shown a probability of success on the merits of his claims that Facebook’s practice of putting advertisements on webpages, including Facebook pages set up to criticize the plaintiff, made a commercial use of the plaintiff’s name and likeness and thus violated his statutory right of publicity and constituted common-law misappropriation under California law.⁹ Truth and lack of neg-

1 *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 250 (1918) (Brandeis, J., dissenting).

2 *See, e.g.*, Stephen McKelvey et al., *The Air Jordan Rules: Image Advertising Adds New Dimension to Right of Publicity—First Amendment Tension*, 26 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 945, 954–59 (2016).

3 *Virag, S.R.L. v. Sony Comput. Entm’t Am. LLC*, No. 3:15-cv-01729, 2015 WL 5000102 (N.D. Cal. Aug. 21, 2015), *appeal filed* *Virag, S.R.L. v. Sony Comput. Entm’t Am. LLC*, No. 16-15137 (9th Cir. Jan. 29, 2016).

4 *Id.* at *2.

5 *Id.* at *1.

6 *Id.* at *8–13.

7 *Id.* at *7. Because this claim is identity-based, it does not depend on the Virag mark being the same, orthographically, as Mirco Virag’s last name. On this theory, the use of “Microsoft” implicates Bill Gates’s right of publicity, “Apple” implicates Steve Jobs, “Virgin” implicates Richard Branson, etc.

8 *Compare* *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1242–47 (9th Cir. 2013) (finding a video game protected by the First Amendment against a false endorsement claim based solely on use of plaintiffs’ image and biographical data), *with* *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013) (finding a video game unprotected by the First Amendment against a right of publicity claim based on the same conduct).

9 *Cross v. Facebook, Inc.*, No. CIV537384, 2016 WL 7785723 (Cal. Super. Ct. May 31, 2016).

ativity in the portrayal aren't defenses to a right of publicity claim, so the right is far more expansive than plaintiff-friendly defamation rules the Supreme Court invalidated long ago. Channeling the plaintiff's claim into the proper cause of action—preventing him from evading the well-justified limits on defamation law¹⁰—is the obvious solution to the problem; instead, the court approved an interpretation of the right of publicity that on its face allows President Donald Trump to control every mention of his name in ad-supported or for-profit media, which is to say almost all media outlets.¹¹

One reason for this expansion is that, without a coherent justification for the right of publicity, there are no obvious stopping points for its scope. If the justification is merely about allowing a person control over unconsented uses of her image, then any uses or even reminders of her identity would violate the right, subject at most to the external constraint of others' First Amendment rights to engage in speech about the world.¹² Following this logic, courts have generally only limited the right based either on statutory exclusions, which need no theories behind them,¹³ or based on an often cramped view of the First Amendment.¹⁴

There are comprehensive theories of the right of publicity that attempt to give it an existence of its own, with boundaries defined by the nature of the interest to be protected. Mark McKenna, for example, has offered a personhood-based account of the right of publicity.¹⁵ However, courts have generally not tried to provide any coherent theory behind the right. Some cases offer a grab bag of possible interests that the right can serve, from personhood to incentive for performance to anti-false-association.¹⁶ Other cases announce that the right of publicity is a property right, apparently a black box into which one can inquire no further.¹⁷ I myself am skeptical that an internal justification can be found that successfully distinguishes the right of publicity from a trademark-type right against false endorsement, but the lack

10 See *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46 (1987).

11 *Cross*, 2016 WL 7785723, at *4.

12 See *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993).

13 See, e.g., N.Y. CIV. RIGHTS LAW §§ 50–51 (McKinney 2016); *Messenger ex rel. Messenger v. Gruner + Jahr Printing & Publ'g*, 727 N.E.2d 549, 551–52 (N.Y. 2000) (per curiam) (“New York does not recognize a common-law right of privacy [The New York statute] is to be narrowly construed . . .”).

14 *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001) (applying the right of publicity to art prints and t-shirts bearing copies of the art prints).

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

16 See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 967–68 (10th Cir. 1996).

17 *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013). *Cardtoons*, by contrast, labeled the right of publicity “a form of property protection that allows people to profit from the full commercial value of their identities,” 95 F.3d at 968, but then proceeded to examine the specific justifications for the right and provided First Amendment protection for unauthorized uses when those justifications did not work, whether as a matter of fact applied to the situation before the court or as a matter of First Amendment treatment of those justifications in other contexts, *id.* at 976.

of judicial attention to the right's justifications contributes to the lack of judicial attention to the right's boundaries.

II. COPYRIGHT PREEMPTION AS BOUNDARY ENFORCER

Recent cases have highlighted the potential for using preemption theories to create a sort of definition of the right of publicity by subtraction: where Congress has tried to achieve a particular aim, such as encouraging the production of creative works, in a particular way, then states should not be allowed to upset that balance by encouraging production in a different way. Although better First Amendment treatment for the right of publicity still remains an important need where a speaker is creating a new depiction of a real person, preemption can define the boundaries of publicity rights where the challenged use is based on an existing copyrighted work in which the person voluntarily appeared.

A. *How Copyright Preemption Ought to Work in Right of Publicity Cases*

The helpful role of preemption can be illustrated by *Dryer v. National Football League*,¹⁸ which involved former football players' right of publicity claims based on the use of truthful, nondefamatory clips of them playing games in films that were compilations of game footage and interviews.¹⁹ Offered a choice of First Amendment and preemption arguments with which to dismiss the players' claims, the Court of Appeals for the Eighth Circuit chose preemption. The challenged films depicted "significant games, seasons, and players in the NFL's [National Football League's] history" via compilations of game footage and interviews with players, coaches, and other individuals involved in the game.²⁰

The right of publicity here conflicted with the copyright owner's right to exploit its copyright, a not uncommon problem with expansive right of publicity claims.²¹ In *Dryer*, the players sought to prevent NFL Films from commercially exploiting films to which it owned the copyright.²² Copyright preemption under section 301 of the Copyright Act—express preemption—exists when (1) the plaintiff's claim is based on a right equivalent to copyright, and (2) there is no "extra element" to distinguish the plaintiff's claim from copyright.²³ Both parts of this test can be extremely fuzzy—it's clear that intent isn't an extra element, for example, because an intent require-

18 814 F.3d 938 (8th Cir. 2016).

19 *Id.* at 941.

20 *Id.*

21 *See, e.g.,* *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284, 1286 (9th Cir. 1999) (Kozinski, J., dissenting from denial of reh'g en banc); *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting from denial of reh'g en banc).

22 *Dryer*, 814 F.3d at 940.

23 Copyright Act, 17 U.S.C. § 301 (2012); *see also* Mark Lindsay, *Complete Preemption and Copyright: Toward a Successive Analysis*, 20 J. INTELL. PROP. L. 43 (2012) (explaining the "extra element" test).

ment simply shrinks the set of instances of copying that can be actionable, but when and whether common-law misappropriation claims are preempted has remained the subject of judicial dithering across multiple circuits.²⁴

In order to avoid copyright preemption, the former players in *Dryer* argued that their performances in the filmed games were part of their identities, and thus that they weren't making claims based on the copyrighted works.²⁵ The Court of Appeals rejected this argument, because modern copyright subject matter specifically encompasses fixed recordings of live sports performances.²⁶ NFL Films had permission to record those live performances, and had valid copyrights to its footage.²⁷ Thus, the right of publicity claims were based on a work within the subject matter of copyright.²⁸

Dryer is exactly right—but it is worth noting that some courts have rejected the very same argument when the plaintiffs' claims were based on still photographs rather than on moving images.²⁹ In the conflicting cases, courts accept the argument that the right of publicity protects a person's face or appearance in general, as some sort of Platonic ideal, and not the particular moment captured by a photo.³⁰ My suspicion is that law's general trouble

24 See generally Joseph P. Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976*, 10 VAND. J. ENT. & TECH. L. 1, 71–80 (2007) (discussing multiple difficulties courts have faced applying § 301 to right of publicity claims); Thomas F. Cotter & Irina Y. Dmitrieva, *Integrating the Right of Publicity with First Amendment and Copyright Preemption Analysis*, 33 COLUM. J.L. & ARTS 165, 165 (2010) (arguing for conflict preemption of right of publicity claims in cases involving noncommercial speech, absent specific exceptions); Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 231 (2002) (arguing that conflict preemption should preclude a right of publicity claim when the depicted persons consented to the original work and the use does not infringe copyright).

25 *Dryer*, 814 F.3d at 942.

26 *Id.*

27 *Id.*

28 See also *Ray v. ESPN, Inc.*, No. 13-1179-CV, 2014 WL 2766187, at *5 (W.D. Mo. Apr. 8, 2014) (finding preemption where the defendant “air[ed] video recordings depicting [plaintiff] in a ‘work of authorship,’ which is plainly encompassed by copyright law”); *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 647 (Cal. Ct. App. 1996) (finding preemption where plaintiffs consented to appear in film but alleged that they were not paid and so their performances were not authorized).

29 See, e.g., *Toney v. L’Oreal USA, Inc.*, 406 F.3d 905, 910 (7th Cir. 2005); *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1005 n.4 (9th Cir. 2001).

30 Courts rejecting § 301 preemption reason that regulation of the celebrity identity captured in an image is not the same as regulation of the copyright-protected image itself. However, the fact that a persona is not copyrightable does not end the inquiry under § 301. Congress intended to preclude states from giving copyright-like protection to matter within the general scope of copyright even if that matter was not copyrightable. See, e.g., *Montz v. Pilgrim Films & Television, Inc.*, 649 F.3d 975, 979–80 (9th Cir. 2011) (en banc) (“[T]he scope of the subject matter of copyright law is broader than the protections it affords. . . . For preemption purposes, ideas and concepts that are fixed in a tangible medium fall within the scope of copyright . . . despite the exclusion of fixed ideas from the scope of actual federal copyright protection.”); *Toney*, 406 F.3d at 910–11 (“[S]tate laws that intrude on the domain of copyright are preempted even if the particular expression is

dealing with images leads to some disrespect for photography, meaning that courts fail to grant photography equal dignity with other types of copyrightable works when compared with the depicted person's rights. The same trouble with images likely contributes to courts' difficulty making the rather evanescent distinction between a claim based on the use of a person's persona that just happens to be captured in a photo, and a claim based on the use of the photo of the person. The courts that hold that photo-based right of publicity claims fall within the subject matter of copyright are more honest.³¹

In any event, the remaining 17 U.S.C. § 301 question was whether there was any extra element to save the claims. The *Dryer* court looked to the justification for the right of publicity to answer this question, and found no such extra element. The court reasoned that the purpose of copyright is to "suppl[y] the economic incentive to create and disseminate ideas,"³² while the purposes of the right of publicity are "the desire to provide incentives to encourage a person's productive activities and to protect consumers from misleading advertising."³³ Because of the state's consumer protection interests, a right of publicity claim based on use of a copyrighted work in an advertisement could have consumer protection, antideception purposes unrelated to copyright's aims. But for noncommercial uses, such a claim "seeks to subordinate the copyright holder's right to exploit the value of that work to the plaintiff's interest in controlling the work's dissemination" and thus attempts to claim "exclusive rights within the general scope of copyright," triggering preemption.³⁴

neither copyrighted nor copyrightable."); *Nat'l Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 849 (2d Cir. 1997) (holding that state protection for uncopyrightable facts such as baseball scores was preempted).

31 *E.g.*, *Maloney v. T3Media, Inc.*, 94 F. Supp. 3d 1128, 1137–38 (C.D. Cal. 2015) ("Accepting Plaintiffs' interpretation [that the right of publicity extended to the sale and distribution of photos of athletes] without separating the likeness from the work would impermissibly negate Copyright's intended preemptive effect. Further, it would destroy copyright holders' ability to exercise their exclusive rights under the Copyright Act, effectively giving the subject of every photograph veto power over the artist's rights under the Copyright Act and destroying the *exclusivity* of rights the Copyright Act aims to protect."); *Milo & Gabby, LLC v. Amazon.com, Inc.*, 12 F. Supp. 3d 1341, 1350 (W.D. Wash. 2014) (finding § 301 preemption of right of publicity claim based on reproduction of photos showing plaintiffs' children), *appeal filed* *Milo & Gabby LLC v. Amazon.com, Inc.*, No. 16-1290 (Fed. Cir. Dec 7, 2015).

32 *Dryer v. Nat'l Football League*, 814 F.3d 938, 942–43 (8th Cir. 2016) (alteration in original) (internal quotation marks omitted) (quoting *Harper & Row Publishers, Inc. v. Nation Enters., Inc.*, 471 U.S. 539, 558 (1985)).

33 *Id.* at 943 (internal quotation marks omitted) (quoting *C.B.C. Distrib. & Mktg. Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 824, *reh'g en banc denied* (8th Cir. 2007)).

34 *Id.* at 943 (quoting *Nat'l Car Rental Sys., Inc. v. Comput. Assocs. Int'l, Inc.*, 991 F.2d 426, 428 (8th Cir. 1993)). Professor McCarthy has also advocated using § 301 preemption to make an advertising/nonadvertising distinction. 2 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 11:55, at 817 (2d ed. 2008) (suggesting that preemption is appro-

Unpacking the reasoning a bit, the “productive activities” incentivized by the right of publicity are not exactly the same as “ideas,”³⁵ but—especially in the modern economy—productive activities are often memorialized in creative works, and the value of celebrities’ productive activities is often derived from monetizing creative works.³⁶ Thus there is so much overlap between incentivizing the creation of new works and incentivizing celebrity-generating productive activities that they should be treated the same for preemption purposes.³⁷ Without an element of consumer deception in a commercial context, then, there was nothing “extra” distinguishing the right of publicity from copyright.

The *Dryer* court’s reasoning strongly implies that not all advertising uses should be within the right of publicity either. Not all commercial or advertising uses will involve an element of deception. “Madonna has never had one of our bananas, but we think she’d like them if she did” is not likely to create

appropriate when a defendant “reproduces a recorded performance in an expressive, non-advertising medium”). Several other circuits have also endorsed a commercial advertising/ordinary exploitation distinction. See *Facenda v. NFL Films, Inc.*, 542 F.3d 1007, 1029 (3d Cir. 2008) (“The rationale is that state law has a role in regulating practices of trade, including advertising. But limiting the way that material can be used in expressive works extends beyond the purview of state law and into the domain of copyright law.”); *Laws v. Sony Music Entm’t*, 448 F.3d 1134, 1141 (9th Cir. 2006) (preemption analysis ought to differentiate between uses to advertise something else and use of a work itself); see also I MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 1.01[B][3][b][iv][1] (rev. ed. 2015) (surveying relevant caselaw and finding a general divide between uses that are simply exploitations of the copyrighted work and uses of the copyrighted work to sell some other product).

35 In the standard account, copyright is supposed to incentivize expression, since copyright doesn’t provide exclusive rights over ideas, but ideas may be thrown off as a side effect.

36 *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 973 (10th Cir. 1996) (“The principal economic argument made in support of the right of publicity is that it provides an incentive for creativity and achievement. Under this view, publicity rights induce people to expend the time, effort, and resources to develop the talents prerequisite to public recognition. While those talents provide immediate benefit to those with commercially valuable identities, the products of their enterprise—such as movies, songs, and sporting events—ultimately benefit society as a whole.” (citations omitted)).

37 For example, the players in *Dryer* were paid for playing in the recorded football games; the amount they could command clearly related to the television market for the games. See also *C.B.C. Distrib. & Mktg.*, 505 F.3d at 824 (rejecting right of publicity claims by Major League Baseball players and noting that the players “are rewarded, and handsomely, too, for their participation in games and can earn additional large sums from endorsements and sponsorship arrangements”); *Cardtoons*, 95 F.3d at 973 (“Most sports and entertainment celebrities with commercially valuable identities engage in activities that themselves generate a significant amount of income; the commercial value of their identities is merely a by-product of their performance values.”); *id.* at 974 (“Moreover, the additional inducement for achievement produced by publicity rights are often inconsequential because most celebrities with valuable commercial identities are already handsomely compensated.”).

a false endorsement.³⁸ Nor is a truthful report about or image of President Obama wearing an advertiser's jacket on a trip to the Great Wall of China.³⁹ Moreover, the *Dryer* court drew a commercial speech/noncommercial speech line for preemption without acknowledging that the trademark law analogue—a false endorsement claim—could also be applied to “noncommercial” speech such as the NFL films. The reason that false endorsement claims based on noncommercial speech generally fail is that trademark doctrine *itself* has developed special First Amendment-influenced treatment for noncommercial speech, so that the usual “likelihood of confusion” test doesn't apply to uses of trademarks in films, songs, and the like.⁴⁰

Courts, that is, do recognize that deception about endorsement is possible in otherwise noncommercial speech. For example, it is possible that a biography could be falsely labeled as an authorized biography, which might affect consumers' purchasing decisions. But the risks of overclaiming by plaintiffs seeking to suppress truthful mentions of them—such as a plaintiff claiming that consumers will assume that an ordinary biography has or requires her permission—are so great that we do not allow plaintiffs to try to prove actionable endorsement confusion unless the false endorsement is explicit. This rule denies plaintiffs in noncommercial speech cases access to the circumstantial evidence on which plaintiffs bringing false endorsement or affiliation confusion theories can rely in cases involving ordinary consumer products. Trademark has therefore set up a mostly impermeable boundary between noncommercial speech and endorsement liability.

Thus, if it is the purpose of avoiding false endorsement that distinguishes the right of publicity from copyright law, then the commercial/noncommercial line is only a proxy for actions that further that purpose, and not always a good one. Claims truly based on false endorsement are the ones that should survive preemption; a purposive approach could help give meaning both to the “right equivalent to copyright” and to the “extra element” in § 301 preemption, as the *Dryer* court's reasoning indicates. Such treatment would also explain what the “extra element” in a right of publicity claim actually is. By contrast, requiring merely that the challenged speech be commercial, like requiring intentional copying, merely shrinks the set of instances in which the overlapping right applies, rather than adding an extra element that goes beyond the prerequisites for a copyright infringement claim and thus avoids preemption.

38 See *Cardtoons*, 95 F.3d at 968 (“If [the hypothetical company] Mitchell Fruit posted a billboard featuring a picture of Madonna and the phrase, ‘Madonna may have ten platinum albums, but she’s never had a Mitchell banana,’ Madonna would not have a claim for false endorsement. She would, however, have a publicity rights claim, because Mitchell Fruit misappropriated her name and likeness for commercial purposes.”).

39 See Stephanie Clifford, *Coat Maker Transforms Obama Photo into Ad*, N.Y. TIMES (Jan. 6, 2010), <http://www.nytimes.com/2010/01/07/business/media/07garment.html>.

40 See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (holding that use of a mark in an expressive work is insulated from liability unless the use has “no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the [use] explicitly misleads as to the source or the content of the work” (footnote omitted)).

While cases finding copyright preemption of the right of publicity can be explained based on § 301 because the elements of § 301 preemption are so fuzzy, the separate concept of conflict preemption can also help understand the right of publicity/copyright boundary.⁴¹ Conflict preemption occurs when a state law obstructs a federal statute's aims, and can exist even when a statute also has an explicit preemption provision, as the Copyright Act does.⁴² Conflict preemption is often appropriate where states' rights are asserted in the context of works that fall within the general scope of copyright or patent law, regardless of whether the material claimed would be copyrightable or patentable.⁴³ The Supreme Court has, in its more recent conflict preemption cases, taken a purposive approach similar to that of the Eighth Circuit in *Dryer*: states can pursue consumer protection objectives, but they cannot seek to encourage production directly by granting monopoly rights over federally unprotected subject matter.⁴⁴

Most saliently, in *Bonito Boats v. Thunder Craft Boats*, the Court expressed its concern that "through the creation of patent-like rights, the States could essentially redirect inventive efforts away from the careful criteria of patentability developed by Congress over the last 200 years."⁴⁵ Although a right focused on consumer protection would not be preempted, a pure anticopying right dealt with "the protection of producers as an incentive to product innovation," which is only the appropriate role of federal policy.⁴⁶ The Court identified incentivizing creation as the state's (unacceptable) goal in

41 See Rebecca Tushnet, *A Mask That Eats into the Face: Images and the Right of Publicity*, 38 COLUM. J.L. & ARTS 157, 194–95 (2015); cf. *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1145 (9th Cir. 2006) ("We sense that, left to creative legal arguments, the developing right of publicity could easily supplant the copyright scheme. This, Congress has expressly precluded in § 301. Were we to conclude that [plaintiff's] voice misappropriation claim was not preempted by the Copyright Act, then virtually every use of a copyrighted sound recording would infringe upon the original performer's right of publicity. . . . It is hard to imagine how a copyright would remain meaningful if its licensees were potentially subject to suit from any performer anytime the copyrighted material was used."). At a minimum, to the extent that the "subject matter" and "extra element" inquiries of § 301 are ambiguous, conflict preemption considerations favor reading them to preempt right of publicity claims against nonadvertising uses of copyrighted works.

42 See *Geier v. Am. Honda Motor Co.*, 529 U.S. 861, 867 (2000).

43 See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231–32 (1964) ("To allow a State by use of its law of unfair competition to prevent the copying of an article which represents too slight an advance to be patented would be to permit the State to block off from the public something which federal law has said belongs to the public."); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237–38 (1964) (same).

44 See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 156–57 (1989); see also *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 487 (1974) (finding no conflict between state trade secret law and patent law where the type of conduct targeted was substantially different and the law protected an interest in privacy, even if trade secret protection also had incentive effects).

45 *Bonito Boats*, 489 U.S. at 157.

46 *Id.*

creating anticopying rules for boat hulls in *Bonito Boats*.⁴⁷ The state didn't apply the same constraints on protection as patent law's high innovation standard, and that ease of access to the state right was a problem that created interference with the federal scheme and its more targeted incentives.⁴⁸ With unpreempted state protection for trade secrets, by contrast, the Court explained that "the state restrictions on the use of unpatented ideas were limited to those necessary to promote goals outside the contemplation of the federal patent scheme."⁴⁹

In the context of creative works depicting public events, the justification for the right of publicity is fundamentally the same as that of the copyright law: to incentivize production of creative performances.⁵⁰ Conflict preemption means that the efficacy or lack thereof of this proposed incentive is irrelevant, because providing incentives of this sort is a power reserved to the federal government. In this way, the right of publicity differs from other, nonpreempted causes of action such as trademark, defamation, and invasion of privacy—and, under the purposive approach, a right of publicity that furthers the protection of consumers, reputation, or privacy would not be preempted, but would be subject to relevant First Amendment constraints on the protection of those interests.

B. *The Role of Consent*

All of this discussion assumes that the person depicted in a copyrighted work consented to the work's creation, which may not be true of caricature, biography, paparazzi photos, or works that use a person's name. Because preemption only makes sense for works in which the depicted person con-

47 *Id.* at 158.

48 *Id.*; *see also id.* at 159–60 ("We think it clear that such protection conflicts with the federal policy 'that all ideas in general circulation be dedicated to the common good unless they are protected by a valid patent.'" (quoting *Lear, Inc. v. Adkins*, 395 U.S. 653, 668 (1969))); *id.* at 164–65 ("The States are simply not free in this regard to offer equivalent protections to ideas which Congress has determined should belong to all.").

49 *Id.* at 166. In the same sentence, the Court does say that "state protection was not aimed exclusively at the promotion of invention itself," possibly suggesting that the right of publicity can aim to incentivize creation as long as it also has other aims, but that interpretation of "exclusively" seems inconsistent with the rest of the Court's reasoning, given that the Court goes on to conclude that what was acceptable were rules "limited to those necessary" to promote nonincentive objectives. *Id.* That is, incentives might also be a side effect of the state-law right, but they could not on their own justify any increment of protection that would not be justified by other goals, such as prevention of consumer deception.

50 *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) ("[T]he protection [afforded by a right to control the broadcast of an entire act] provides an economic incentive for [the performer] to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright laws . . ."); *see also C.B.C. Distrib. & Mktg., Inc., v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 824 (8th Cir. 2007) (stating that publicity rights are intended "to provide incentives to encourage a person's productive activities and to protect consumers from misleading advertising"); *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1145 (9th Cir. 2006) (recognizing the similarity).

sented to appear, it can't play the primary role in limiting the right of publicity.

However, consent will often protect copyright owners' rights to exploit their works. For example, by playing in football games with the certain knowledge that they were being filmed by NFL Films, the players in *Dryer* consented to the creation of copyrighted works—films of football games—embodying their contributions.⁵¹ This consent suffices to justify copyright preemption.⁵² The football players' consent to appear in the work need not be valid for purposes of applying state publicity law, because the issue is whether there was consent for federal copyright purposes: consent to appear in the copyrighted video in which their appearances were fixed. That consent exists regardless of how one thinks about the question of whether the players count as “authors” for purposes of copyright's authorship requirement.⁵³

Would the same copyright preemption rationale apply to cases such as *Wendt*, in which the claim was that a copyright owner violated actors' rights of publicity by creating animatronic robot versions of them as part of a derivative work based on the TV show in which they appeared?⁵⁴ The answer should be yes, though the Ninth Circuit found that the actors had a valid claim.⁵⁵ The actors need not consent to the creation of the derivative works; they consented to the creation of the underlying copyrighted work without putting conditions on the consent limiting the copyright owner's right to exploit that work. Because the copyright owner has the right to make derivative works, any incentive-based theories need to respect Congress's intent to give copyright owners incentives to make or authorize derivative works. Only a right of publicity based on some other theory, such as false endorsement in the case of advertising uses, should survive preemption.

51 *Dryer v. Nat'l Football League*, 55 F. Supp. 3d 1181, 1200 (D. Minn. 2014); *see also* *Balt. Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 675–76, 675 n.22 (7th Cir. 1986) (finding preemption in similar circumstances).

52 Professor Jennifer Rothman has argued that, for similar reasons, conflict preemption of the right of publicity should occur whenever a person consented to appear in a copyrighted work, including when the work is subsequently used as part of an advertisement. *See* Rothman, *supra* note 24, at 254; *see also* Cotter & Dmitrieva, *supra* note 24, at 215 (arguing for conflict preemption of right of publicity claims in cases involving noncommercial speech, absent specific exceptions).

53 *Cf. Jules Jordan Video, Inc. v. 144942 Can. Inc.*, 617 F.3d 1146, 1155 (9th Cir. 2010) (finding preemption when a movie actor alleged that his name and likeness appeared in counterfeit films, because “[t]he essence of [the actor]’s claim is that the . . . defendants reproduced and distributed the [films] without authorization,” not that the original copyrighted film had been made without the actor’s knowing participation); *Nat'l Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 847 (2d Cir. 1997) (noting that “Congress specifically had sporting events in mind” when it drafted the fixation provision and finding that fixation merged the performance with the fixed work for preemption purposes).

54 *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 809 (9th Cir. 1997), *reh'g denied* 197 F.3d 1284 (9th Cir. 1999).

55 *Id.* at 814–15.

What about people who didn't consent to be evoked or depicted? For the other torts with justifications that overlap with those of the right of publicity, a person need not consent to be depicted or evoked in most cases of truthful speech. This rule is subject only to the outer limits where the manipulation of the truth conveys a misleading impression (a cause of action known as false light⁵⁶) or invades the person's privacy with insufficient public interest justification (which would be very hard to establish where the depiction is based on public events). Just as with consent-based works, false endorsement might sometimes be an appropriate theory—it is a better fit for ads than false light, though the basic idea is the same.

Nonetheless, people depicted without their consent may have broader right of publicity claims and can take advantage of the incentive theories underlying copyright. The key Supreme Court case that launched the expansion of the right of publicity, *Zacchini*, was functionally a common-law copyright case involving a performance fixed without the performer's consent by a TV news crew.⁵⁷ *Zacchini* was decided in 1977, before the current Copyright Act became effective (January 1, 1978). The 1976 Copyright Act, unlike its predecessors, protects expressive works as soon they are fixed in a tangible medium, not when they are published; state-common-law copyright is preempted except insofar as it covers unfixed works.⁵⁸ While that change would affect some right of publicity claims, *Zacchini*'s claim, founded on a live performance that was not fixed with his consent, would still be outside the scope of the modern Copyright Act and thus his claim would remain non-preempted if brought today.

Understanding the consent cases in terms of copyright preemption also helps us understand the proper scope of nonconsent cases, insofar as the appropriate reach of the right of publicity approved by *Zacchini* corresponds to the scope of common-law copyright and its incentive and privacy protec-

56 RESTATEMENT (SECOND) OF TORTS § 652E (AM. LAW INST. 1977).

57 See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977) (“[T]he State’s interest [in permitting a right of publicity] is closely analogous to the goals of patent and copyright law”); *id.* at 575 (“The Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner”); *id.* at 576 (stating that “[t]his same consideration underlies the patent and copyright laws long enforced by this Court”); MCCARTHY, *supra* note 34, at 819 (“The proper category for *Zacchini*’s claim was the state law of common law copyright, not the right of publicity.” (footnote omitted)); Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn From Trademark Law*, 58 STAN. L. REV. 1161, 1187 (2006) (same); Wendy J. Gordon, *An Inquiry into the Merits of Copyright: The Challenges of Consistency, Consent, and Encouragement Theory*, 41 STAN. L. REV. 1343, 1365 n.97 (1989) (same); Diane Leenheer Zimmerman, *Who Put the Right in the Right of Publicity?*, 9 DEPAUL-LCA J. ART & ENT. L. 35, 49–50, 50 n.43 (1998) (same); *cf.* *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 806 (Cal. 2001) (“*Zacchini* was not an ordinary right of publicity case: the defendant television station had appropriated the plaintiff’s entire act, a species of common law copyright violation.”).

58 See *Lapham v. Porach*, No. 06-Civ-6861, 2007 WL 1224924 at *13 (S.D.N.Y. Apr. 25, 2007).

tion justifications.⁵⁹ The expansion of the right of publicity far beyond the claim of copying of an entire performance also goes far beyond those legitimate boundaries. Consent to appear in a work without reserving rights to approve subsequent uses of the work should regularly trigger copyright preemption; lack of consent should provide rights where common-law copyright would do so to preserve the depicted person's incentives to create and her right to wait until a work is finished before sharing it. But those rights should not extend beyond those performance-incentivizing boundaries unless the right serves some other specific objective compatible with the First Amendment, such as consumer protection against false endorsement. Otherwise we are left only with a person's right to control any discussion about herself, a right unable to distinguish an unauthorized biography or roman à clef from an unauthorized video game with any coherence.

III. FIRST AMENDMENT LESSONS FROM PREEMPTION

A. *The Utility of a Purposive Approach*

Although the purposive approach is most visible in preemption cases, the Eighth Circuit took a purposive approach in its First Amendment analysis in *C.B.C. Distribution & Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*,⁶⁰ a case involving the claim that for-profit fantasy baseball leagues infringed baseball players' Missouri rights of publicity by using their names and other identifying data as part of the games. The Eighth Circuit reasoned that the players had stated a claim for infringement of their rights of publicity, as understood by state law, even though "CBC's use does not fit neatly into the more traditional categories of commercial advantage, namely, using individuals' names for advertising and merchandising purposes in a way that states or intimates that the individuals are endorsing a product."⁶¹ However, Missouri law didn't require false endorsement for a right of publicity claim, merely that the defendant have an intent or purpose to benefit commercially from the use of a person's identity.⁶²

Nonetheless, the First Amendment overrode the state-law claim under these circumstances. The court of appeals began with the proposition that "the information used in CBC's fantasy baseball games is all readily available in the public domain, and it would be strange law that a person would not have a first amendment right to use information that is available to every-

59 See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 973 (10th Cir. 1996) ("Zacchini . . . complained of the appropriation of the economic value of his *performance*, not the economic value of his *identity*. The Court's incentive rationale is obviously more compelling in a right of performance case than in a more typical right of publicity case involving the appropriation of a celebrity's identity." (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. c (AM. LAW INST. 1995))).

60 505 F.3d 818 (8th Cir. 2007).

61 *Id.* at 822.

62 *Id.*

one.”⁶³ Moreover, the Court of Appeals pointed out, “[T]he facts in this case barely, if at all, implicate the interests that states typically intend to vindicate by providing rights of publicity to individuals.”⁶⁴ The court pointed to an individual’s right to reap where she sowed and earn a living, incentives to engage in productive activities, and protection from misleading advertising, but noted that none of these were seriously implicated by use of truthful data about well-paid baseball players.⁶⁵

As for nonmonetary interests, such as “protecting natural rights, rewarding celebrity labors, and avoiding emotional harm,” they also weren’t relevant where the data depended on an already-compensated player’s actual performance; in addition, “some courts have indicated that the right of publicity is intended to promote only economic interests and that noneconomic interests are more directly served by so-called rights of privacy,” and the court endorsed an approach that limited the right of publicity to protection of economic interests.⁶⁶ (Another way to say this might be to say that any right of publicity based on moral rights should be subject to the same First Amendment constraints as a right of privacy based on moral rights, a treatment that clearly excludes the data on baseball players’ public performances from the players’ control.) The error in the *C.B.C.* court’s reasoning was in its framing of these questions as matters of case-by-case balancing, rather than more categorical balancing based on the commercial or noncommercial status of the speech being challenged.⁶⁷

Similarly, when the Tenth Circuit decided a case involving baseball cards using parody names, images, and facts about baseball players, the court chose the approach of balancing the interests protected by the right against the First Amendment.⁶⁸ However, the Tenth Circuit spoke more generally about

63 *Id.* at 823.

64 *Id.* at 824.

65 *Id.*

66 *Id.* (citation omitted). California’s test, while deeply problematic as applied to artworks, also at least recognizes that, as an economic right, the right of publicity is not appropriately used against criticism:

[T]he right of publicity cannot, consistent with the First Amendment, be a right to control the celebrity’s image by censoring disagreeable portrayals. 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. The necessary implication of this observation is that the right of publicity is essentially an economic right. What the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity’s fame

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

67 Melville B. Nimmer, *The Right to Speak From Times to Time: First Amendment Theory Applied to Libel and Misapplied to Privacy*, 56 CALIF. L. REV. 935, 942–43 (1968) (explaining the benefits of categorical balancing).

68 *Cardtoons v. Major League Baseball Players Ass’n*, 95 F.3d 959, 972–73 (10th Cir. 1996). In *Cardtoons*, the Tenth Circuit also mentioned a congestion, tragedy-of-the-commons argument: celebrities should get to control their images to avoid overexposure,

the effect of parodies on the relevant interests, rather than relying on the value of the particular parody before it.⁶⁹ A purposive approach need not redo balancing anew in each individual case. It can identify, for example, whether a particular right of publicity claim against an ad involves a false endorsement. If it does, then real confusion over endorsement in the context of commercial speech should avoid First Amendment problems.⁷⁰ Cate-

which will ultimately destroy the value of a celebrity's image. *Id.* at 974–75. This is essentially a dilution rationale; as the *Cardtoons* court noted, the theory is only acceptable, if at all, in the context of commercial advertising. *See id.* at 975. Perhaps more importantly, the theory doesn't seem to have any basis in reality; the empirical evidence for dilution—especially dilution via overexposure—is simply lacking. Studies of supposedly dilutive uses do not show any effect on well-known trademarks. Paul J. Heald & Robert Brauneis, *The Myth of Buick Aspirin: An Empirical Study of Trademark Dilution by Product and Trade Names*, 32 CARDOZO L. REV. 2533 (2011). Studies of uses of works in the public domain likewise don't show an overexposure effect. Christopher Buccafusco & Paul J. Heald, *Do Bad Things Happen When Works Enter the Public Domain?: Empirical Tests of Copyright Term Extension*, 28 BERKELEY TECH. L.J. 1 (2013); Paul J. Heald, *Does the Song Remain the Same? An Empirical Study of Bestselling Musical Compositions (1913–1932) and Their Use in Cinema (1968–2007)*, 60 CASE W. RES. L. REV. 1 (2009); Paul J. Heald, *Does the Song Remain the Same? An Empirical Study of Bestselling Musical Compositions (1913–1932) and Their Use in Cinema (1968–2007)*, 60 CASE W. RES. L. REV. 1 (2009); Paul J. Heald, *Property Rights and the Efficient Exploitation of Copyrighted Works: An Empirical Analysis of Public Domain and Copyrighted Fiction Bestsellers*, 92 MINN. L. REV. 1031 (2008). Overexposure hasn't hurt the communicative value of the American flag or countless other symbols. Mark A. Lemley, *Ex Ante Versus Ex Post Justifications for Intellectual Property*, 71 U. CHI. L. REV. 129, 146 n.63 (2004) (“Where a work is truly iconic, even repeated debasement is unlikely to affect public perceptions. . . . [T]he Statue of Liberty, the Mona Lisa, Mount Rushmore, and the Eiffel Tower retain their iconic status despite repeated uses and abuses in many different contexts. So too do the works of Shakespeare and the characters Frankenstein (and his monster), Dracula, Scrooge, Uncle Sam, and King Arthur.” (citation omitted)); *see also* Christo Boshoff, *The Lady Doth Protest Too Much: A Neurophysiological Perspective on Brand Tarnishment*, 25 J. PROD. & BRAND MGMT. 196 (2016) (finding no empirical basis for tarnishment); Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507 (2008) (attacking the empirical basis for dilution and analyzing dilution as unconstitutional commercial speech regulation).

69 The *Cardtoons* court did emphasize that the players at issue were already well compensated, suggesting that its analysis could have differed were the players some other type of public figure, such as comparatively less well-paid politicians or professors whose activities make the news. *Cardtoons*, 95 F.3d at 974. This, I think, was a mistake, given that parody is likely to have the same effect on the incentives of anyone, even if they are not well compensated by other means, and given the First Amendment value of allowing parody and the unlikelihood that victims will regularly authorize parodists. *See id.* (“Since celebrities will seldom give permission for their identities to be parodied, granting them control over the parodic use of their identities would not directly provide them with any additional income. It would, instead, only allow them to shield themselves from ridicule and criticism.”).

70 In general, I argue for a materiality requirement in false advertising and trademark claims. Rebecca Tushnet, *Running the Gamut From A to B: Federal Trademark and False Advertising Law*, 159 U. PA. L. REV. 1305 (2011). However, the FTC presumes that endorsements are material in that they are likely to affect consumers' purchasing decisions, whether or not consumers *should* be guided by celebrity opinions, and this seems to me to be a consti-

gorical approaches need not engage in the dangerous and artistically difficult task of judging the merits of an individual work against which the right of publicity is asserted. Doctrines such as trademark law's *Rogers v. Grimaldi* test, which protect artistic uses against infringement liability unless the speaker is explicitly misleading about the claimant's endorsement or affiliation, simplify the inquiry, which itself has a speech-protective effect by making clear when claimants should not bother to sue.⁷¹

B. The Insufficiency of Borrowing "Transformativeness" From Copyright

Why not instead borrow the concept of fair use from copyright? One could argue that copyright's First Amendment safeguards are as relevant to an incentive-based right of publicity as the First Amendment tests I've advocated borrowing from trademark and defamation.⁷² I disagree, for several reasons related to the different purposes served by copyright and many right of publicity claims.

First, copyright's preemption principles mean that, where incentives are at issue, copyright preemption will often preclude a right of publicity claim regardless of the First Amendment. To the extent that the right of publicity covers unauthorized copying of unfixed performances and serves to protect incentives in that limited, unpreempted circumstance, as in *Zacchini*, then a fair-use-style defense might well be appropriate. However, copyright fair use is a poor fit as a major limitation on other acts alleged to violate the right of publicity—and this poor fit makes sense once we start thinking about the right of publicity in purposive ways.

Second and relatedly, copyright fair use identifies situations where the incentives of other creators would be harmed too much or where copyright owners would not be relevantly incentivized by extending the copyright owner's control over a subsequent use. Where the primary considerations involve false association or reputational interests, copyright fair use isn't configured to identify situations where *those* interests aren't enough to justify liability.

Third, the Supreme Court has clearly indicated that it is not just fair use that makes copyright law tolerable under the First Amendment. The idea/expression distinction and the lack of protection for facts also limit copyright; the free speech implications of control over ideas or facts would be too great to be borne. Thus, a right of publicity defense that *only* borrowed fair use and not the lack of protection for ideas and facts would not have the full

tionally permissible approach. 16 C.F.R. § 255.1(b) (2009). In addition, if an ad causes confusion about whether a celebrity endorses a particular product, the celebrity's dignity interest in avoiding a false association—an interest that is possessed by humans but not by trademarks—probably should be given greater weight than the mere mention or reference that defies the celebrity's desire to control all commercial uses of her identity.

⁷¹ William McGeeveran, *The Trademark Fair Use Reform Act*, 90 B.U. L. REV. 2267, 2289, 2313 (2010).

⁷² See Pamela Samuelson, *Reviving Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 TUL. L. REV. 836, 837 (1983).

range of First Amendment safeguards that copyright does. Information identifying celebrities is usually factual—appropriating celebrity identity generally requires reproducing attributes that the celebrities actually have.⁷³ In some cases, such as *White v. Samsung*⁷⁴ (where the defendant made an ad with a robot in a blonde wig that evoked Vanna White) or *Geller v. Fallon McElligott Advertising*⁷⁵ (where the defendant’s ad featured a person who could bend spoons, a trick that was allegedly uniquely associated with Uri Geller), one might argue that what is copied is not facts as such but a more free-floating “persona”—but “persona” in that sense sounds a lot like a style, which is generally considered to be an unprotectable idea. So, if we truly borrowed copyright principles to limit the right of publicity, it might well be narrowed to the point of nonexistence.⁷⁶

Copyright’s lack of protection for facts and ideas also helps explain another problem with borrowing fair use for the right of publicity. As Mark McKenna has cogently argued, a fair-use defense requires the comparison of one work with another, to see if the defendant’s work transforms the plaintiff’s work by providing a new meaning or message.⁷⁷ But this comparison requires two works, whereas a right of publicity claim involves a person and a work, and it’s just not clear how to identify when the transition from one to the other is “transformative.” Especially given that the elements of the person’s identity that are taken in the allegedly infringing work will usually be facts or ideas, fair use’s idea of transformation—which is focused on the expressive, protectable elements of a work—lacks any real purchase on the plaintiff’s identity. This incommensurability contributes to the deep incoherence in the caselaw: courts can’t decide whether it’s the overall accused work that should be transformative or the specific depiction of the plaintiff within the work.

73 See *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 823 (8th Cir. 2007).

74 989 F.2d 1512 (9th Cir. 1993).

75 No. 90 Civ. 2839, 1991 WL 640574 (S.D.N.Y. July 22, 1991).

76 For example, copyright does not ever protect facts, so using copyright limitations would mean that facts about a celebrity could be used without hindrance in ads, even if, as some courts have speculated, the appearance of a celebrity in an ad—or even a celebrity’s name—implies endorsement. See *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 413 (9th Cir. 1996) (“[U]se of celebrity endorsements in television commercials is so well established by commercial custom that a jury might find an implied endorsement in General Motors’ use of the celebrity’s name in a commercial”); *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 627 n.8 (S.D.N.Y. 1985) (“When a public figure of Woody Allen’s stature appears in an advertisement, his mere presence is inescapably to be interpreted as an endorsement.”).

77 Mark P. McKenna & Shelby Niemann, 2016 Trademark Year in Review 35 (Feb. 5, 2015) (unpublished manuscript), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2886627. There are also a series of purpose-transformation copyright cases where a pure copy of the plaintiff’s work is nonetheless fair because the purpose of the defendant’s use is completely different from the plaintiff’s, as when a search engine copies webpages in order to index the Internet rather than to communicate the expressive message of any particular webpage. But the problem of fit is basically the same.

Finally, these problems of theory have been borne out in practice: a number of courts have adopted a version of copyright fair use to provide First Amendment limits on the right of publicity, and it's been a disaster. Courts have attempted to simplify the test by asking only whether the defendant's use is transformative, and not addressing the other usual considerations. Asking how factual or creative the plaintiff's identity is—factor two of the copyright fair-use test—and asking what effect the defendant's use would have on the market for the “original” or its authorized derivatives—factor four—are so obviously nonsensical or at best circular that they make the conceptual mismatch far too clear, while asking “how much” of a celebrity identity was taken—factor three—seems metaphysical at best.

Even with this simplification, copyright transformativeness doesn't work for the right of publicity. Numerous scholars, myself among them, have made the case against transformativeness as a right of publicity defense.⁷⁸ Our objections cluster around two problems. First, because it is hard to figure out what it means for a work to “transform” a persona, the standard leads to unpredictable results with chilling effects on speech.⁷⁹ Second, the transformativeness standard leads to the conclusion that realistic depictions of a celebrity are infringing, but that implies that news stories and photographs—

78 See, e.g., Stacey Dogan, *Bullying and Opportunism in Trademark and Right-of-Publicity Law*, 96 B.U. L. REV. 1293, 1309–10 (2016); David Franklyn & Adam Kuhn, *Owning Oneself in a World of Others: Towards a Paid-For First Amendment*, 49 WAKE FOREST L. REV. 977 (2014); Tushnet, *supra* note 41; Thomas E. Kadri, Comment, *Fumbling the First Amendment: The Right of Publicity Goes 2–0 Against Freedom of Expression*, 112 MICH. L. REV. 1519 (2014); Geoffrey F. Palachuk, Note, *Transformative Use Test Cannot Keep Pace with Evolving Arts: The Failings of the Third and Ninth Circuit “Transformative Use” Tests at the Intersection of the Right of Publicity and the First Amendment*, 16 U. DENV. SPORTS & ENT. L.J. 233 (2014).

79 See, e.g., *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 165–66 (3d Cir. 2013) (majority and dissent disagreeing about whether the depiction of a football player in the context of made-up football games was transformative); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 936–37 (6th Cir. 2003) (majority and dissent disagreeing about the value of what painter-defendant contributed to painting); *Winter v. DC Comics*, 69 P.3d 473, 476 (Cal. 2003) (reversing the Court of Appeals's finding of nontransformativeness); *Daniel v. Wayans*, 213 Cal. Rptr. 3d 865 (Cal. Ct. App. Feb. 9, 2017) (majority and dissent disagreeing about whether the juxtaposition of a photo with a cartoon was transformative); Tushnet, *supra* note 41, at 170–78 (discussing inconsistencies inherent in transformativeness applied to the right of publicity). Compare *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1271 (9th Cir. 2013) (holding that use of athletes' likenesses in a fantasy video game was not “transformative”), and *Hilton v. Hallmark Cards*, 599 F.3d 894, 911 (9th Cir. 2010) (finding that the use of Paris Hilton's face superimposed over a cartoon body in a greeting card parody of the television show *The Simple Life* was not transformative because “the basic setting is the same” as in the show), with *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 n.2 (9th Cir. 2001) (stating that a magazine's use of an image of Dustin Hoffman from the movie *Tootsie* was transformative because “Hoffman's body was eliminated and a new, differently clothed body was substituted in its place”), and *Noriega v. Activision/Blizzard, Inc.*, No. BC551747, 2014 WL 5930149, at *5 (Cal. Super. Ct. Oct. 27, 2014) (finding that use of Manuel Noriega's likeness in *Call of Duty: Black Ops II* was transformative because the game as a whole, not the use itself, was transformative).

at the core of protected noncommercial speech—should be considered infringing, and courts have simply dealt with the problem by unconvincing fiat, distinguishing some kinds of realism from others.⁸⁰

IV. FURTHER DIRECTIONS IN DEFENDING AND LIMITING THE RIGHT OF PUBLICITY

It's also possible to defend the right of publicity as protecting a celebrity's interest in the integrity of her personhood or her privacy. These interests are not the same as either incentives for production or false endorsement. However, here too there is already extensive precedent about these moral justifications and their very limited force with respect to truthful information; the First Amendment itself precludes most rights based purely on personhood claims.⁸¹ Facts can't be owned, broadly speaking.⁸² When an organization "lawfully obtains truthful information about a matter of public significance[,] then state officials may not constitutionally punish publication of the information, absent a need to further a state interest of the highest order."⁸³ A personhood-based right of publicity thus would be very far from a right to control public discourse about truthful, nondefamatory information.⁸⁴

There is also a line of argument condemning appropriation of a person's image, and the labor expended to create that image, for another's benefit. In order to justify a right of publicity based on an anti-free-riding or misappropriation principle, however, we would need a clear understanding of what is wrong with free riding, especially in the context of noncommercial speech. We would also need some explanation of why an entity that creates a video game or a painting or even a funny ad is free riding in terms of labor, even if the subject of the resulting work is of interest to other people because

80 See, e.g., *Hart*, 717 F.3d at 168; cf. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001) (opining that, while the lesser-known defendant's charcoal drawings of the Three Stooges were nontransformative, Andy Warhol's visual depictions of celebrities were transformative because Warhol was engaged in commentary on the phenomenon of celebrity).

81 Cf. *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 824 (8th Cir. 2007) (reasoning that celebrities can protect their economic interests by controlling sponsorships and blocking confusing commercial uses, and any noneconomic interests in controlling truthful reporting about their performances do not justify suppressing truthful speech).

82 See *Int'l News Serv. v. Associated Press*, 248 U.S. 215, 250 (1918) (Brandeis, J., dissenting) ("The general rule of law is, that the noblest of human productions—knowledge, truths ascertained, conceptions, and ideas—become, after voluntary communication to others, free as the air to common use.").

83 *Smith v. Daily Mail Publ'g Co.*, 443 U.S. 97, 103 (1979).

84 Cf. *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 50 (1988) (refusing to allow the tort of intentional infliction of emotional distress to evade the strict requirements of defamation as applied to editorial speech).

it is about a specific topic or even a single person.⁸⁵ We are all standing on the shoulders of giants, but only metaphorically. Without interference with their physical persons, those giants need an explanation for why we shouldn't be able to build on their work. Copyright, defamation, and trademark law all provide decent answers to that question in at least some instances, but the right of publicity does not. Or, as the Tenth Circuit put it in *Cardtoons*, “[B]lind appeals to first principles carry no weight in our balancing analysis.”⁸⁶

CONCLUSION

The First Amendment has a preemptive role to play in setting boundaries for what is capable of reduction to private property in information. However, the caselaw currently allows claimants to evade First Amendment limits on trademark by switching their claims to the right of publicity, with *Viraj* as only one very blatant example. Likewise, some trademark owners now tout the virtue of copyright protection for logos in order to control uses that wouldn't constitute trademark infringement,⁸⁷ which is especially important because copyright fair use is not oriented towards the same types of situations as trademark defenses are.⁸⁸ Thus, while the First Amendment should contribute to the management of potential intellectual property overlaps, right now courts are insufficiently attentive to the risks involved in allowing private

85 See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996) (“As in all celebrity parodies, *Cardtoons* added a significant creative component of its own to the celebrity identity and created an entirely new product. Indeed, allowing [baseball players] to control or profit from the parody trading cards would actually sanction the theft of *Cardtoons*' creative enterprise.”).

86 *Id.* at 975. Similar difficulties attend a labor-desert approach claiming that celebrities have earned the right to appropriate every economic benefit from their celebrity, or an unjust-enrichment approach making the inverse argument that others have no right to benefit from the value of the celebrity's identity. See *id.* at 975–76. Not only are celebrities not famous through their efforts alone, but it is generally acceptable for other people to benefit from the labor of others without paying, as when I appreciate a neighbor's well-kept garden. See Lemley, *supra* note 68, at 149.

87 See, e.g., Janet Fries & Kelly Horein, *Protect Your Brand Via Copyright*, DBRANDING BLOG (Apr. 4, 2016), <http://www.dbrandingblog.com/protect-your-brand-via-copyright/>; Rebecca Tushnet, *INTA: Copyright Law for Trademark Lawyers*, REBECCA TUSHNET'S 43(B)LOG (May 9, 2012, 8:54 AM), <http://tushnet.blogspot.com/2012/05/inta-copyright-law-for-trademark.html> (summarizing a discussion among trademark owner representatives about how to leverage copyright to obtain additional rights); see also *Omega S.A. v. Costco Wholesale Corp.*, 776 F.3d 692, 696 (9th Cir. 2015) (affirming the rejection of an attempt to use copyright to override first sale rights under trademark). The opposite problem, using trademark to expand rights not granted by copyright, may also occur, even after *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003). See Mary LaFrance, *A Material World: Using Trademark Law to Override Copyright's First Sale Rule for Imported Copies*, 21 MICH. TELECOMM. & TECH. L. REV. 43, 70–72 (2014).

88 See, e.g., Matthew D. Bunker, *Advertising and Appropriation: Copyright and Fair Use in Advertising*, 54 J. COPYRIGHT SOC'Y U.S.A. 167, 168 (2007) (pointing out that “trademark fair use is quite different conceptually from its copyright cousin” (emphasis omitted)).

parties their choice of different property-type claims over speech. It is disconcerting, but perhaps unsurprising in our current political context, that defendants asserting private property rights of their own (copyright) have done better avoiding incursions by others' right of publicity claims than defendants asserting First Amendment rights to speak. A coherent, purposive approach applied both to preemption and to First Amendment defenses might improve judicial understanding of how the right of publicity allows celebrities too much control over nondefamatory speech, both commercial and noncommercial.

