

THE TRANSFORMATIVE USE TEST: A SOLUTION THAT RESTORES ORDER TO OUR COURTS

I. INTRODUCTION

The right of publicity is typically described as “the inherent right of every human being to control the commercial use of his or her identity.”¹ It allows lawsuits by: the children of an African warlord for use of his likeness by a video game developer, a former wrestling champion for publishing his sex tape, and a former Governor for use of her picture to promote anti-aging products and plastic surgery.² Defendants in such suits “routinely assert that the right of publicity curtails their freedom of expression by restricting their ability to use representations of real persons in their works.”³ Now, disarray in our courts regarding how to address the conflict between the right to publicity and the right to free speech is threatening to undermine the First Amendment. The case of Lois Lane, a reporter-turned-screenwriter, elucidates the substantial need for guidance from our nation’s highest court.

Lane was dispatched to Afghanistan after accepting an assignment by The Daily News to serve as a combat correspondent. There, Lane met Staff Sergeant Steve “Hawk Eye” Rogers, a sniper known both for his marksmanship and distinctive trigger finger tattoo. For nearly half a year, Lane was embedded in Roger’s unit where the two exchanged personal stories including that Rogers decided to enlist after his father’s death on United Flight 93, one of the planes hijacked on September 11, 2001, that his wife had miscarried while Rogers was away in sniper school, and that his unit had been under siege in the Arghandab Valley for several days until being rescued.

Lane and Rogers ultimately left Afghanistan and returned stateside to resume their respective lives. Lane published three highly successful articles about her time with Rogers’ unit and was later promoted to the White House press corps; Rogers and his wife created a center to rehabilitate former military dogs into service animals equipped to aid veterans with PTSD.

A 2011 article detailing Rogers' success on and off the battlefield went viral online causing "Hawk Eye's" fame to soar to unprecedented heights. Due to his newfound celebrity, Rogers began appearing on national television. A major publishing house even approached Rogers about a potential book deal.

Lane wrote a screenplay about a character, Richard Grayson, a clean-cut 6'2'' sniper with a tattoo on his index finger, stationed in Afghanistan in 2009. While Lane's screenplay bore similarities to the details Rogers had shared with Lane during their time together, it also contained key differences including embellishments and new plot arcs. Lane was able to sell her screenplay, "Hawk Eye," for \$5 million with the possibility of earning additional profits. After learning of "Hawk Eye," the publisher broke off negotiations with Rogers fearing the works might be too similar.

Enraged that Lane had used his story without his permission, Rogers filed suit in a federal district court alleging infringement of his right of publicity. Lane defended her screenplay on First Amendment grounds but the court disagreed, finding in favor of Rogers. It is the position of this article that on appeal, the ruling of the district court should be reversed on the basis that Lane's screenplay is protected speech under the First Amendment. Part II begins by providing a brief history of the right of publicity, including its origins and its current status. Part III discusses the conflict between the First Amendment and the right of publicity, including an attempt by the United States Supreme Court to resolve the conflict. Part IV addresses current approaches utilized by the courts to address the problem and proposes a solution. Part V suggests that Rogers' right of publicity was not violated. Part VI concludes that the district court erred in finding for Rogers and should be reversed on appeal.

II. DEVELOPMENT OF THE RIGHT OF PUBLICITY

In 1890, Samuel D. Warren and Louis D. Brandeis published "The Right to Privacy," an article advocating for the establishment of a court-enforced

right to be let alone.⁴ In 1960, after states began recognizing the right to privacy, William Prosser wrote "Privacy," which further expounded upon earlier work by dividing "the tort of invasion of privacy into four separate categories: (1) intrusion; (2) disclosure; (3) false light; and (4) appropriation," with appropriation having developed into publicity.⁵

As of late 2015, "thirty-one states have recognized the right of publicity through either statute or common law."⁶ In those states, a "prima facie right of publicity claim [generally] requires three basic elements: (1) ownership of an enforceable right in the identity of a human being; (2) use by another, without permission, of some aspect of the plaintiff's identity in such a way that it is identifiable from the unauthorized use; and (3) likelihood that the defendant's use will cause economic injury to the value of that identity."⁷ The continued existence of the right is generally justified on three grounds: morality, economics, and consumer protection.⁸ The right of publicity has been "invoked mainly by celebrities to prevent unauthorized commercial uses of various aspects of their personae."⁹

III. THE FIRST AMENDMENT AS A RESTRICTION ON THE RIGHT OF PUBLICITY

The First Amendment ensures that "Congress shall make no law ... abridging the freedom of speech, or the press."¹⁰ The Supreme Court has consistently held that the First Amendment applies to "entertainment [including] motion pictures, programs broadcast by radio and television, and live entertainment."¹¹ The Court has made clear that "the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable."¹² Yet, the Court has walked a fine line, noting that "[N]ot all speech is of equal First Amendment importance."¹³

To date, Zacchini represents the **only** time the United States Supreme Court has ever considered whether speech that allegedly infringes on an individual's right to publicity is protected under the First Amendment.¹⁴ There, a reporter filmed a performer's entire "human cannonball act" without

permission and the footage was broadcast by a television station.¹⁵ In a narrow holding, the Court emphasized that while the performer's right of publicity would not prevent the reporting of facts regarding the performance, the "First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent."¹⁶ Given the unique circumstances of Zacchini, "many commentators and courts have construed Zacchini to be of limited precedential value, relevant only in the rare situation where the plaintiff's 'entire act' has been appropriated."¹⁷

IV. MODERN JUDICIAL APPROACHES TO RESOLVE THE CONFLICT

Thus far, the Supreme Court has not yet articulated a preferred method of analysis, leaving lower courts to fashion their own tests to resolve conflicts between the rights of publicity and free speech. The most common approaches taken by American courts will be discussed in turn.

1. RELATEDNESS TEST

The Sixth and Second Circuits employ the "relatedness test," imported from trademark law, which evaluates whether use of a celebrity's likeness in a title is related to the work as a whole or is instead a disguised false endorsement.¹⁸ In Parks, a Sixth Circuit panel applied the test beyond the title to the content of the work where civil rights icon Rosa Parks brought a publicity claim against the rap group OutKast regarding their song titled "Rosa Parks."¹⁹ Soon after, a different Sixth Circuit panel refused to use the test, holding that it is inapplicable to right of publicity claims.²⁰

In Hart, the Third Circuit declined to apply the test where a former athlete brought suit against a video game developer, reasoning that the test would bar publicity claims if the infringing use is even tangentially related to the celebrity's source of fame.²¹ Such inconsistency in application, coupled with the fact that the right of publicity protects more than a celebrity's right to be free from false endorsements, make the relatedness test the wrong choice to address the conflict for courts nation-wide.

2. PREDOMINANT USE TEST

The Missouri Supreme Court applies the “predominant use test,” which seeks to determine whether the work is predominantly commercial or expressive.²² In Doe, a former professional hockey player brought suit against a comic book creator for including in the comic book a character which shared the player’s name and “tough-guy” persona but bore no other similarities.²³ The creator had marketed the character directly to hockey fans by distributing hockey jerseys, pucks, and other memorabilia.²⁴ While conceding that use of the player’s name had some expressive value, the court held that the First Amendment did not bar the player’s claim since the use “has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression.”²⁵

However, the test has been criticized on many fronts. For one, the test assigns judges the impossible task of decoding artists’ inspiration in creating works. Further, the test ignores the reality that while artists are often motivated by profit, the work may still be largely expressive and thus protected.²⁶ Moreover, the test fails to specify the requisite expression needed for First Amendment protection. Therefore, the predominant use test is not the proper framework by which courts should resolve the tension.

3. AD-HOC BALANCING TEST

The Eighth and Tenth Circuits use an ad-hoc balancing test which weighs a celebrity’s right of publicity against a defendant’s First Amendment interests on a case-by-case basis.²⁷ Because a lack of predictability in publicity cases already exists based on the disagreement amongst courts about which test to apply, the ad-hoc balancing test, which provides no factors or framework, offers the least guidance for courts, celebrities, and artists and is therefore inappropriate for uniform adoption.

4. TRANSFORMATIVE USE TEST

The Ninth and Third Circuits as well as the California Supreme Court use the "transformative use test," which imports parts of the fair use doctrine from copyright law.²⁸ The first prong assesses whether "the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted."²⁹ The second prong evaluates "whether the product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own [protected] expression rather than the celebrity's likeness."³⁰

The Third Circuit adopted the test in Hart, holding that a video game developer's avatar, which closely resembled an actual football player biographically and physically, was not sufficiently transformed to overcome the player's right to publicity.³¹ The Ninth Circuit came to a similar decision when it too chose to use the transformative test in Keller, a case involving the same developer and a different college football player.³²

The transformative use test can be (and has been) applied to a wide array of mediums including comic books, video games, and photograph collages yet may be reconciled with past decisions in cases predating the test's creation involving other mediums such as film.³³ Critics of the transformative use test bemoan that the test will make impossible the portrayal of individuals unless those portrayals are "fanciful" rather than "realistic."³⁴ Yet these critics ignore the explicit directives of the test's creators, namely that "'the transformative elements' ... may include ... factual reporting, fictionalized portrayal, heavy-handed lampooning, and subtle social criticism."³⁵ Courts across the country would be wise to adopt the transformative use test as the uniform test to balance a celebrity's right of publicity with an artist's freedom of expression.

V. ROGERS' CLAIM SHOULD FAIL UNDER THE TRANSFORMATIVE USE TEST

The appellate court should apply the transformative use test and reverse the district court's ruling that Lane has infringed on Rogers' right of publicity. Here, Rogers is a celebrity that could bring value to a creative work which depicts him. However, it is not clear that the value and marketability of Lane's screenplay is derived primarily from Roger's celebrity. Lane is arguably a celebrity in her own right -- her three articles chronicling her time spent in Rogers' unit earned her praise as a war correspondent and a promotion to the White House Press Corps; it is possible that Lane's own reputation was contributory. That Lane sold her first successful screenplay for at least \$5 million suggests that the production company placed value in Lane specifically. Even assuming that the screenplay's value is derived primarily from its depiction of Rogers, the creators of the test cautioned that such a work may still be transformative.³⁶

The current body of cases applying the transformative use test can be characterized on a spectrum between two extremes: non-transformative uses on one end ("mere literal depictions of celebrities recreated in a different medium") and highly transformative uses on the other ("fanciful characters, placed amidst a fanciful setting, that draw inspiration from celebrities").³⁷ Comparison to the Hart case, which lies somewhere in the middle, makes clear that Lane's screenplay is much closer to the protected transformative end of the spectrum than the prohibited non-transformative end.

In Hart, the court held an avatar, which matched the player in height and weight, hair color/style and skin tone, and signature accessories was not sufficiently transformed.³⁸ Here, while Rogers and Grayson both have tattoos on their trigger/index fingers, there is nothing to indicate that each's tattoo is the same design or on the same hand. Moreover, nothing suggests a physical resemblance between Rogers and Grayson. Even assuming such a

resemblance, Lane's work may nonetheless still be sufficiently transformative since the test makes clear that fictionalized portrayals may qualify.³⁹

In Hart, the avatar was from the same state, attended the same college, played the same position, and wore the same number as the player.⁴⁰ Here, while some biographical similarities exist between Rogers and Grayson - both were stationed in Afghanistan in 2009, joined the Army following the deaths of their fathers in 9/11, lost a child after their wives miscarried while they were in sniper school, and were attacked in Arghandab Valley - there are notable differences. Though Grayson suffers from PTSD, nothing suggests that Rogers suffers from PTSD. While Grayson is unable to cope with civilian life such that he decides to reenlist and return to Afghanistan where he is killed by a roadside bomb, Rogers has adapted to civilian life rather well, operating a charity/business, receiving favorable media coverage, and appearing on national television. It does not appear that Rogers has decided to reenlist and he has most certainly not died given his successful lawsuit and pending appeal. Additionally, while Rogers was rescued, Grayson fought his way out. These biographical differences between Rogers and Grayson, taken together with Lane's inclusion of several embellishments, new plot points, and Lane's own experiences represent a sufficient transformation.

VI. CONCLUSION

The appellate court should adopt the transformative use test to decide conflicts between a celebrity's right of publicity and an artist's right to expression. As such, the ruling of the district court should be reversed because Lane's screenplay is more than just an imitation of Rogers' life story but instead her own protected expression. It is imperative that those who create entertainment be given guidance to discern the boundary between permissible and prohibited when discussing, satirizing, and portraying real life figures. Of the four tests discussed, only the transformative use test is capable of uniform application across all mediums of expression while

ensuring some level of predictability. In an era when anyone can become a celebrity with an actionable right of publicity, predictability can not only be the difference between a multi-million dollar judgment, but also the creation of expressive works, popular or not, crucial to American society.

¹ Kevin L. Chin, Comment, The Transformative Use Test Fails to Protect Actor-Celebrities' Right of Publicity, 13 **Nw. J. Tech. Intell. Prop.** 197, 199 (2015).

² Henry Samuel, 'Call of Duty game depicts our father as barbarian,' says late Angolan warlord's sons, **The Telegraph**, Feb. 3, 2016; Megan Carpentier, Hulk v. Gawker: 'bizarre case' could have profound consequences for free speech, **The Guardian**, Mar. 3, 2016; Yvonne Wingett Sanchez, Ex-Gov. Jan Brewer 'revenge makeover' ads taken down, **The Arizona Republic**, Sept. 3, 2015.

³ Dora Georgescu, Note, Two Tests Unite to Resolve the Tension Between the First Amendment and the Right of Publicity, 83 **Fordham L. Rev.** 907, 909 (2014).

⁴ E.g., Georgescu, supra note 3, at 912.

⁵ Id. at 913.

⁶ Chin, supra note 1, at 200.

⁷ Georgescu, supra note 3, at 916.

⁸ Michael Madow, Private Ownership of Public Image: Popular Culture and Publicity Rights, 81 **Calif. L. Rev.** 127, 178 (1993).

⁹ David Tan, Political Recoding of the Contemporary Celebrity and the First Amendment, 2 **Harv. J. Sports & Ent. L.** 1, 6 (<year>).

¹⁰ **U.S. Const.** amend. I.

¹¹ Hart v. Elec. Arts, Inc., 717 F.3d 141, 149-50 (3rd Cir. 2013).

¹² Snyder v. Phelps, 131 S. Ct. 1207, 1219 (2011).

¹³ Id. at 215.

¹⁴ E.g., Tan, supra note 9, at 19.

-
- ¹⁵ Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 564 (1977).
- ¹⁶ Id. at 575.
- ¹⁷ Tan, supra note 9, at 19.
- ¹⁸ See Georgescu, supra note 3, at 923.
- ¹⁹ Parks v. LaFace Records, 329 F.3d 437, 461 (6th Cir. 2003).
- ²⁰ Georgescu, supra note 3, at 929-930.
- ²¹ Hart, 717 F.3d at 157-58.
- ²² Doe v. TCI Cablevision, 110 S.W.3d 363, 374 (Mo.banc 2003).
- ²³ Id. at 366.
- ²⁴ Respondent's Brief In Opposition to Petitioner's Writ of Certiorari at 6, McFarlane v. Twist, No. 03-615 (U.S. Nov. 21, 2003).
- ²⁵ Doe, 110 S.W.3d at 374.
- ²⁶ Georgescu, supra note 3, at 931.
- ²⁷ Id. at 923.
- ²⁸ Chin, supra note 1, at 203-05.
- ²⁹ Hart, 717 F.3d at 158.
- ³⁰ Id. at 161.
- ³¹ Id. at 166.
- ³² See Chin, supra note 1, at 205.
- ³³ See Hart, 717 F.3d at 160-165.
- ³⁴ Brief for Petitioner Writ of Certiorari at 27, Elec. Arts Inc. v. Keller, No. 13-377 (U.S. Sep. 23, 2013).
- ³⁵ Hart, 717 F.3d at 159.
- ³⁶ See Tan, supra note 9, at 26.
- ³⁷ Hart, 717 F.3d at 161.
- ³⁸ Id. at 166.
- ³⁹ Id. at 159.
- ⁴⁰ Id. at 146