When Rights Collide: The Right of Publicity v. First Amendment Rights

I. Introduction

"Of all the miserable, unprofitable, inglorious wars in the world [the worst] is the war against words. Let men say just what they like. Let them propose to cut every throat and burn every house...We have nothing to do with a man's words or a man's thoughts, except to put against them better words and better thoughts, and so to win in the great moral and intellectual duel that is always going on, and on which all progress depends."[1]

Though mildly dramatic, these words do adequately capture the ardent fervor with which our nation reveres the First Amendment. The benefit of so highly prioritizing free speech is that it ensures the ongoing and uncensored sharing of ideas and public discourse.[2] However, this hallmark American value does not come without a price. On the other side of the coin, giving the First Amendment such weight does create serious legal tensions.

A keystone to the foundation of this country, freedom of speech and of the press has always been treated by the courts with especially measured hands and cautious minds. However, as technology continues to evolve, the world has grown smaller, shrinking personal privacy with it, and speech has only become more powerful. As a result, the longstanding feud between free speech and privacy rights has become impossible to ignore.[3] Judges have been forced to further define the reach of First Amendment protections in this context. However, while courts agree they must find a balance between these rights, they struggle to agree on a solution.[4] The case of Rogers v. Lane illustrates why agreement amongst the courts has become so critical.

Staff Sergeant Steve Rogers, known as "Hawk Eye", is a very adept sniper with a unique tattoo on his trigger finger. He first met Lois Lane, a combat correspondent and aspiring screenwriter, in Kandahar, Afghanistan in 2009. Shortly after, Lane became an embedded reporter in Rogers' unit for six months. Rogers agreed Lane could mention him by name in her articles if the

stories told arose during Lane's stay with his unit. During this time, Rogers recounted his father's death on 9/11 and how that impacted his decision to enlist. He also told Lane about how his wife had miscarried during his sniper training. Last, Rogers discussed the time he and his unit were attacked in Afghanistan's Arghandab Valley, and he was trapped in a firefight for four days until troops could rescue him.

After returning to the U.S., Lane published three successful articles about her time with Rogers. Rogers also returned home and began a dog rehab center to train former military dogs as service animals for veterans with PTSD. In 2011, an article on Rogers' work with veterans titled "From Hawk Eye to a Dog's Eye" was published. It spread across social media and, after appearing on national talk shows and "Ballroom with B-listers," Rogers was launched into mild celebrity success. He even entered book deal negotiations with a major publisher, Black Canary Publishers. Meanwhile, Lane had returned to screenwriting and sold a screenplay titled "Hawk Eye," about a sniper named Richard Grayson, a 6'2" boy-next-door who was clean cut, except for a tattoo on his index finger, stationed in Afghanistan in 2009, for $5 million.

Upon learning of the screenplay, Black Canary Publishers pulled their book deal fearing that anything published would be too similar. Three plot points were of major significance: (1) Grayson enlisted because his father died in 9/11; (2) Grayson's wife miscarried while enrolled in sniper school; and (3) Grayson fought his way out of the Arghandab Valley. Although Lane also included several embellishments, new plot points, and even some of her own experiences in Afghanistan, those three plots points and the name did in fact come from Rogers and so he sued for violation of his right of publicity.

The District Court ruled in Rogers' favor, finding that Lane had infringed his right of publicity and that the First Amendment did not immunize Lane's conduct. On appeal, the court should affirm the District Court's ruling using the Sixth Circuit hybrid test.

II. Irreconcilable Goals: The Right of Publicity and the First Amendment

The right of publicity is a legal doctrine which shares elements of both property and tort law.[5] In general, it aims to protect against commercial loss caused by appropriation of an individual's identity for commercial exploitation and requires three distinct elements: (1) The defendant used plaintiff's name as a symbol of his identity (2) without consent (3) and with the intent to obtain a commercial advantage.[6]

The First Amendment, which states "Congress shall make no law...abridging the freedom of speech, or the press," has commonly been used as a defense against a right of publicity claim.[7] It has consistently protected both popular and unpopular speech in all mediums, including those for artistic or entertainment purposes such as video games or even a play.[8]

The very nature of each of these rights presents irreconcilable goals.[9] The First Amendment "protects the dissemination of ideas and information," while the right of publicity "significantly constrains the dissemination of ideas and information by limiting who can use celebrity images."[10]

a. Finding an Answer: Zacchini and the Four Competing Tests

These two rights cross paths when a form of speech that may normally be protected involves the name or identity of another. In our ever-shrinking world, this is only becoming more common. In 1977, the Supreme Court decided Zacchini v. Scripps-Howard Broadcasting Co.—notoriously the first and only time the highest court has offered guidance on the issue of whether the First Amendment protected a defendant who had allegedly infringed on another's right of publicity, specifically by airing the plaintiff's entire "cannonball act" on the news.[11] The court established a narrow holding that the freedom of expression defense was restricted where a news station reproduced an entire act because the performer was entitled to compensation for his performance.[12]

Despite this infamous lack of specific instructions on right of publicity actions, lower courts have used Zacchini as a guide for creating a

test to balance the interests of protecting freedom of expression with that of state right of publicity laws.[13] In fact, Zacchini is most important because it demonstrates that the right of publicity can, in some instances, outweigh First Amendment interests.[14]

Although this landmark decision finally opened the door for courts to create reasonable limits on the untouchable First Amendment, circuit courts remain staunchly divided on what exactly should be measured to make such a critical determination and thus four competing tests have resulted: (1) the "Ad Hoc" Balancing Test, (2) the Rogers or "Relatedness" Test, (3) the Transformative Use Test, and (4) the Predominant Purpose Test.[15] Although each test clearly has both merits and faults, some are more useful than others.

The ad hoc balancing test, for example, demands that a court "balance the consequences of restricting a defendant's freedom of expression against the justifications for a plaintiff's right of publicity."[16] This test has been criticized as too unpredictable because it requires a determination of whether the "economic interest of a person in preventing a given portrayal outweighs the social value of a given expressive work."[17] As the test stands now, it is difficult to argue that it is specific enough to limit a right as important as the First Amendment.

The Rogers Test states that "use of another's identity in a novel, play or motion picture...is not ordinarily an infringement of the right of publicity, unless the name or likeness is used solely to attract attention to a work that is not related to the identified person."[18] Proponents of this test argue that it appropriately confines the right of publicity tort to situations in which speakers have "used a depiction of, or reference to, a celebrity to sell something—either by falsely claiming a celebrity commercial endorsement or by including a celebrity image in a publication gratuitously, just to attract attention."[19] However, critics, including the Hart court, have

rejected this test for fear that it is too demanding and would discourage right of publicity claims altogether.[20]

The transformative test has, in particular, garnered much attention. Under this test, a work that depicts a celebrity enjoys First Amendment protection if it is the artist's creative expression rather than merely an imitation of a celebrity's likeness.[21] The benefit of this test is that it clearly protects wholly creative works, such as parody and other fantastical works, since these types of expression would easily be considered "transformed."[22] Although this test has been endorsed by the Third and Ninth Circuits, this test has also been subject to at least two major criticisms. First, the transformative test lacks a mechanism for coping with situations where an expression is attempting to depict accurate or realistic subjects. Some argue this test only rewards fanciful or distorted portrayals and chills any natural or accurate work.[23] Second, it is argued that this test chills expression because, in applying such a subjective standard (asking a judge to evaluate whether the work is a "creative expression") it is entirely unpredictable.[24]

The final test endorsed by the Eighth and Tenth Circuits is the predominant purpose test, which literally asks about the main purpose of the work. Specifically, the test states "an unauthorized use of another's identity is protected if the purpose of the work is predominantly expressive, but is an infringement of right of publicity if purpose of work is predominantly commercial."[25] For example, in Doe, a hockey player's unique nickname and persona was used in creating a comic book character by the same name.[26] Although the comic book character had other characteristics and original ideas put into it (thus, also giving it an expressive component), the Doe court held that the predominant purpose of using the hockey player's identity was commercial and thus, not protected speech.[27] Critical in the court's decision was the fact that defendants had specifically used Doe's

identity to market their comic to hockey fans.[28] The Doe court decided on the predominance test because, unlike the Rogers test or the transformation test, it can account for situations where a use of one's name and identity has both expressive and commercial components.[29] The Hart court, however, rejected this test on grounds similar to the ad-hoc test: too much subjectivity.[30]

b. Outside the Box: Other Possible Solutions

Overall, each of the tests mentioned above lack the ability to cope perfectly with the conflict presented here. It is possible that courts are unsatisfied because a better solution still exists. Thus, it is critical to note the possibility of many more creative alternatives, along with other suggested "refined" versions of the already existing tests. For example, the Sixth Circuit has offered a solution involving a combination of the ad-hoc balancing test and the transformation test.[31] Another proposed solution may be a hybrid of the ad-hoc balancing test, perhaps with more defined factors to be considered by the court, combined with the predominant purpose test.

Other proposed solutions have included a radical re-thinking of how the right of publicity tort is understood in the first place. One suggestion focuses on the categorization of the speech in question. This stance suggests a return to the original purpose of the First Amendment (advancing democratic deliberation) and argues that the defendant's use of the celebrity identity may be classified as political speech with the highest constitutional value if it contributes to the democratic process and that such uses should be accorded greater value than artistic speech or entertainment.[32]

Alternatively, another solution that has been offered includes re-evaluating the weight placed on celebrity images. By shifting the paradigm through which this problem is viewed in this way, it becomes possible to pick apart the various arguments often made in favor of the right of publicity tort in the first place, including notions of unjust enrichment and economic and moral arguments. For example, this argument explores the idea that there

is no unjust enrichment in borrowing a celebrity's identity because they themselves have surely borrowed it from somewhere else.[33]

Moving forward, a few things are certain. The test chosen must certainly be one which is flexible enough to recognize multiple purposes of a particular expression. However, it must also be predictable enough to establish a clear rule of law regarding this battle of rights. Regardless, recurring themes are present. Most prominently, unfair enrichment concerns and the stifling or chilling of speech must be balanced. Despite the uncertainty, one thing is clear: a line must be drawn for what constitutes free speech when it concerns the identity of others.[34]

III. Rogers v. Lane Revisited

In the case of Rogers v. Lane, the appellate court should apply the Sixth Circuit's modified ad-hoc-balancing-test-transformative test. This is the most reliable test because its balancing mechanism allows the court some discretion in each case. This is a critical element because, given the court's and this country's history of favoring the First Amendment, it will provide an avenue through which the court can subjectively consider the role of this important right in the unique situation at hand. Additionally, this test provides the most balanced solution because, as the balancing aspect may favor the defendant, the transformation aspect of the test ensures the protection of the right of publicity for the plaintiff. This will occur especially where it is at least debatable as to whether the work is unique to the alleged offender. Thus, this test wholly protects speech which is clearly expressive and also asks the courts to balance the rights against one another where it is less clear. This relieves the serious tension between these rights because it favors expression where it clearly exists and only becomes subjective where it is already questionable as to whether there was protectable expression in the first place. Since it is a modified version of the transformative test, the criticism that the transformative test does not

protect depictions which attempt to be realistic is not damning. If taken further, it could be argued that purely realistic depictions or impersonations of others should be limited speech anyway since there is no new contribution connected with the "work" in this form. At this stage, it could further be helpful to the courts to adopt the strategy suggested above of determining whether the speech is political or purely entertaining and separate out protectable realistic works from purely commercial ones.

Thus, applying the Sixth Circuit modified test, the appellate court should affirm the district court's ruling. After first balancing Lane's First Amendment rights against Rogers' right of publicity in his own identity, the court should then apply the transformative test. Although Lane would likely argue that her screenplay contains political commentary, and as such should not be stifled, the transformative test should ultimately sway the court. In applying the transformative test, this court should consult Doe, which is extremely similar. In both cases a unique nickname was used and in Doe, the plaintiff's personality traits were borrowed, and even further here, multiple of plaintiff's exact literal life experiences were literally used. Based on these striking resemblances, the appellate court here should rule similarly and affirm the District Court's ruling denying First Amendment protection.

IV. Conclusion

While this particular intersection of law continues to pose significant problems, it appears that the courts are still waiting for the right test. However, the courts should remain optimistic, as useful key factors have clearly been identified within the current tests available. This case presents an opportunity for the courts to officially establish a hybrid test that can be used in all right of publicity applications. As illustrated above, a hybrid test offers the strongest solution for evaluating how much weight each right should be given and when—adequately balancing First Amendment and privacy rights in an increasingly interconnected world.

[1] **Theodore Schroeder, Free Speech for Radicals** 43 (enlarged ed. 1916).

[2] Snyder v. Phelps, 131 S. Ct. 1207, 1215 (2011).

[3] Hart v. Elec. Arts, Inc., 717 F.3d 141 (3d Cir. 2013).

[4] Id.

[5] Dora Georgescu, Two Tests Unite to Resolve the Tension Between the First Amendment and the Right of Publicity, 83 **Fordham L. Rev.** 907, 915 (2014).

[6] Doe v. TCI Cablevision, 110 S.W.3d 363, 368-69 (Mo. 2003).

[7] **U.S. Const.** amend. I.

[8] See, e.g., Petition for a Writ of Certiorari at 2-4, Elec. Arts, Inc. v. Keller, No. 13-377 (Sept. 23, 2013) (recognizing video game as form of speech in legal case) and Henry Samuel, 'Call of Duty Game Depicts Our Father as Barbarian,' Say Late Angolan Warlord's Sons, **Telegraph** (Feb. 3, 2016, 1:07 PM), http://www.telegraph.co.uk/news/wordnews/europe/france/12138020/Call-of-Duty-game-depicts-our-father-as-barbarian-say-late-Angolan-warlords-sons.html (same). See also Wei-Huan Chen, Legal Qualms lead to IndyFringe Play's Shutdown, **Indianapolis Star** (May 15, 2015, 6:01 AM), http://www.indystar.com/story/life/2015/05/15/legal-qualms-lead-indyfringe-plays-shutdown/27331099 (recognizing theatrical play as form of speech in possible legal case).

[9] Georgescu, supra note 5, at 917

[10] Id.

[11] Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 565 (1977).

[12] Kevin L. Chin, The Transformative Use Test Fails to Protect Actor-Celebrities' Rights of Publicity, 13 **Nw. J. of Tech. & Intell. Prop.** 197, 200 (2015).

[13] Id.

[14] Georgescu, supra note 5, at 926.

[15] Id. at 909.

[16] Id. at 910.

[17] Petition for a Writ of Certiorari at 34, Elec. Arts, Inc. v. Keller, No. 13-377 (Sept. 23, 2013).

[18] Parks v. Laface Records, 329 F.3d 437, 461 (6th Cir. 2003).

[19] Petition for a Writ of Certiorari at 35, Elec. Arts, Inc. v. Keller, No. 13-377 (Sept. 23, 2013).

[20] Chin, supra note 10, at 206.

[21] Georgescu, supra note 5, at 910.

[22] Chin, supra note 10, at 203.

[23] Petition for a Writ of Certiorari at 5, Elec. Arts, Inc. v. Keller, No. 13-377 (Sept. 23, 2013).

[24] Id.

[25] Georgescu, supra note 5, at 910.

[26] Doe, 110 S.W.3d at 363.

[27] Id. at 374.

[28] Id.

[29] Id.

[30] Hart, 717 F.3d at 153–54.

[31] Georgescu, supra note 5, at 944.

[32] David Tan, Political Recoding of the Contemporary Celebrity and the First Amendment, 2 **Harv. J. of Sports & Ent. L.**, no. 1, <year> at 1, 18.

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

[34] See Megan Carpentier, Hulk v. Gawker: 'Bizarre Case' Could Have Profound Consequences for Free Speech, **The Guardian** (Mar. 12, 2016, 7:00 AM), http://www.theguardian.com/media/2016/mar/12/hulk-v-gawker-sex-tape-free-speech-first-amendment-privacy (extreme example of clash of free speech and privacy rights case).