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The Key to Being a Good Referee: The Call the Ninth Circuit Missed When Evaluating False Endorsement Claims

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THE KEY TO BEING A GOOD REFEREE: THE CALL THE NINTH CIRCUIT MISSED WHEN EVALUATING FALSE ENDORSEMENT CLAIMS

ABSTRACT

Society is consumed with celebrities, and celebrity identity has pervasive power. We keep up with the Kardashians and judge singing with Adam Levine. If Doctor Oz recommends a weight-loss pill, we go out and buy it. If a burger restaurant is called Bobby Flay's, that's the hot spot to go eat. Celebrity identities are powerful brands that are subject to abuse by others who may incorporate a celebrity's identity into their product without permission. There are celebrity look-alikes and soundalikes. Celebrity likenesses have been appropriated to sell everything from cars to VCRs. Two bodies of law are turned to when there is unauthorized exploitation of a celebrity's likeness or persona. One, Section 43(a) of the Lanham Act, is a federal trademark statute, and the other is the common law right of publicity. Congress designed Section 43(a) to protect consumers from mistakenly believing that a celebrity endorsed a particular product, while the right of publicity centers on the celebrity's economic interest in his or her own identity.

The interests that both the Lanham Act and the right of publicity are designed to protect must be balanced with the First Amendment interest in free speech. Freedom of speech is a widely and heavily protected constitutional right that encompasses free expression within various platforms, including videogames. If an individual merely states that he does not like Carmelo Anthony, this statement will be protected as free speech, and there are no countervailing concerns of consumer confusion or economic cost to Anthony. If an individual wrote a play about Carmelo Anthony's journey to becoming a basketball star, and Anthony had no involvement in creating the play, then countervailing concerns are present and must be balanced with the interest in free expression. This balancing of interests highlights an inherent tension: when should the broad constitutional right to free speech bow to a countervailing concern for false endorsement of products and a celebrity's right of publicity?

The Ninth Circuit recently decided two cases dealing with this balance. Both cases concern the use of well-known football players' likenesses in a

videogame series. One celebrity opted to bring suit under the Lanham Act, while the other chose the right of publicity. The two cases had very similar fact patterns, but the Ninth Circuit used different tests to analyze the claims, leading to opposite holdings. What was different about the prevailing plaintiff in the right of publicity claim? Is there a way to take the celebrity's and the consumers' interests into account without stifling free speech? What test should the Ninth Circuit, and other courts, use to evaluate Section 43(a) Lanham Act claims?

This Comment advances the novel argument that the Ninth Circuit and other courts should use a new test, combining the transformative use test and a modified likelihood of confusion test when evaluating Section 43(a) Lanham Act claims. The proposed test provides an analysis that focuses on protecting free speech without annihilating the possibility of the balanced concerns prevailing. The test takes the artist's, consumers', and the celebrity's interests into account and mitigates the problems caused by having a lack of a federal right of publicity.

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INTRODUCTION

Celebrities have a powerful influence in society. The public is engrossed by what celebrities wear, say, and do, whether the focus is on how to diet like a particular icon¹ or what lotion a star recommends.² A celebrity's identity is a powerful tool that can be used to sway consumer purchases, regardless of whether the celebrity is affiliated with the product. A celebrity's identity can therefore be used illegally for financial gain at the expense of both the star and the consumer.

Beyoncé is an internationally renowned music artist.³ One of her song's lyrics state, "My persuasion can build a nation," describing her potential influence over society.⁴ She recently released a surprise album, which is the first since 2009 to sell over 300,000 copies during the first three weeks of sales.⁵ Society pays close attention to what Beyoncé does, and this makes her an easy target for exploitation. If a person wrote a book entitled *Queen Bee's Singing Tips*,⁶ fans may be duped into believing that Beyoncé was somehow affiliated with the book, causing consumers to go out and buy it. If the book was entitled *Singing Tips* and discussed how Beyoncé warms up her vocal cords before a show, consumers may still mistakenly think that Beyoncé was

¹ Lisa Lillien, *5 Healthy Celebs—And How to Eat Like Them!*, Tyra Banks, PEOPLE (Dec. 30, 2013, 2:16 PM ET), <http://greatideas.people.com/2013/12/30/5-healthy-celebs-and-how-to-eat-like-them/> (click to page "3 of 6" using the arrows at the top of the webpage).

² Zoë Ruderman, *Exclusive! Shop the Skin-Perfecting Lotion Gweneth Paltrow Uses, Now in Travel Size*, PEOPLE (Nov. 25, 2013, 6:00 AM ET), <http://stylenews.peoplestylewatch.com/2013/11/25/exclusive-prtty-peashun-travel-size-joyus-discount/> (explaining that Gweneth Paltrow, Rihanna, and Cate Blanchett use a particular skin lotion).

³ See BEYONCÉ, <http://www.beyonce.com/> (last visited Apr. 27, 2015).

⁴ BEYONCÉ, *Run the World (Girls)*, on 4 (Columbia Records 2011).

⁵ Keith Caulfield, *Beyoncé Leads for Third Week at No. 1 at Billboard 200 Chart*, BILLBOARD (Jan. 2, 2014, 12:54 PM EST), <http://www.billboard.com/articles/news/5855135/beyonce-leads-for-third-week-at-no-1-on-billboard-200-chart> (explaining that Beyoncé's new album sold 1.3 million copies during the first seventeen days of the album's release in the United States).

⁶ See *Queen Bee (Beyoncé)*, FACEBOOK, <https://www.facebook.com/pages/Queen-Bee-Beyonce/187649358422> (last visited Apr. 27, 2015) (showing that one of Beyoncé's nicknames is Queen Bee and her fans are called the Beyhive); see also *Beyoncé*, FACEBOOK, <https://www.facebook.com/beyonce/timeline> (last visited Apr. 27, 2015); *Beyhive Birthday Love*, BEYONCÉ (Sept. 4, 2012), <http://www.beyonce.com/beyhive-birthday-love-2/>.

connected with the book and in turn purchase the book. The appropriation of Beyoncé's identity is a form of unfair competition.

Unfair competition is a broad area of law⁷ that encompasses unauthorized exploitation of celebrity likeness.⁸ Both Section 43(a) of the Lanham Act and the common law right of publicity concern the use of one's likeness without consent.⁹ Section 43(a) focuses on shielding consumers from confusion—preventing consumers from going out and buying *Singing Tips* due to the belief that Beyoncé endorsed the book. Right of publicity on the other hand is interested in protecting Beyoncé's economic interest in her own identity. Both of those interests need to be balanced with the countervailing First Amendment interest in free expression. For instance, the author of *Singing Tips* has a First Amendment right to create and disseminate the expressive idea captured in her book.

The Ninth Circuit uses different tests to balance these crucial interests depending on whether a claim is brought as a violation of Section 43(a) of the Lanham Act or the right of publicity. Ultimately, this Comment argues that the Ninth Circuit uses an inadequate test when analyzing Section 43(a) claims and that the test the court uses for right of publicity claims does not sufficiently take consumers' interests into account. The Ninth Circuit, and all courts, should use a new test, initially incorporating the test used to analyze right of publicity claims and add to that test to take the author's, consumers', and Beyoncé's interests into account.

Part I of this Comment explores two bodies of law that are applicable to claims of unauthorized use of a celebrity's likeness. First, Part I delves into Section 43(a) of the Lanham Act. After briefly explaining trademark law, Part I details the purpose of Section 43(a). The terms Section 43(a) and false endorsement will be used interchangeably throughout this Comment. Next, Part I discusses the right of publicity and what the right is designed to protect. Part I concludes with a comparison of Section 43(a) and the right of publicity, explaining the key differences between the two.

⁷ See James E. Clevenger, 44 AM. JUR. PROOF OF FACTS 3D *False Advertising Under Lanham Act* § 43(a)(1)(B) (1997).

⁸ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) (“The law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting *consumers* from confusion as to source.”); GRAEME B. DINWOODIE & MARK D. JANIS, *TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY* 883–84 (3d ed. 2010).

⁹ DINWOODIE & JANIS, *supra* note 8, at 883.

Part II introduces the First Amendment and the interests it seeks to protect. Part II discusses the balance of the interest in free speech against Section 43(a) interests, including an explanation of the test the Ninth Circuit uses when balancing such interests. Part II then focuses on the balance of free expression and the interests the right of publicity seeks to protect. Lastly, Part II explores the test the Ninth Circuit uses when evaluating right of publicity claims.

Part III examines two recent Ninth Circuit cases. First, Part III describes the background of the artistic work involved in both cases. Part III then explains the first case, *Brown v. Electronic Arts, Inc.*, a suit alleging a violation of Section 43(a) of the Lanham Act. Part III then explores *In re NCAA Student-Athlete Name & Likeness Licensing Litigation (Keller)*, which was a right of publicity suit. Finally, Part III will describe the Ninth Circuit's application of two different tests when evaluating the claims based on the body of law under which the plaintiff brought suit.

Part IV critiques the analytical reasoning the Ninth Circuit utilized in *Brown* and highlights flaws in the Ninth Circuit's test when balancing Section 43(a) claims against free speech rights. Part IV then explains that the test used in *Keller*, balancing the right of publicity against free speech, is more analytically appropriate for Section 43(a) claims but is still insufficient. Part IV proposes a new test for courts to use, consisting of the transformative use test, combined with a modified likelihood of confusion test. The Ninth Circuit previously used the likelihood of confusion test when analyzing Section 43(a) claims. The proposed test initially balances the First Amendment interest in free speech against the celebrity's interests, and then it takes consumers' interests into account. Part IV concludes with an explanation of why courts should use the new test and applies the proposed test to *Brown* to demonstrate how courts would apply the test and what the outcome of the case would have been.

I. TWO BODIES OF LAW DEALING WITH USE-OF-LIKENESS CLAIMS

There are two main bodies of law that deal with use-of-likeness claims. The first body of law is Section 43(a) of the Lanham Act, which is a federal trademark statute. The second is the common law right of publicity. Although both pertain to the use of a celebrity's likeness, Section 43(a) and the right of publicity are two distinctive claims. A celebrity may opt to bring suit pursuant to Section 43(a) rather than the right of publicity, or vice versa, due to

important differences in the two bodies of law. The differences between these two claims are important to recognize.

A. Section 43(a) of the Lanham Act

In order to understand Section 43(a) of the Lanham Act, it is important to know basic trademark law. “A trademark is a word, name, symbol, device or other designation, or a combination of such designations, that is distinctive of a person’s goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others.”¹⁰ Trademarks have been used for hundreds of years in order to express the ownership or source of goods or services.¹¹

Trademark rights are attained when the trademark is used in commerce.¹² The United States’ use-based system means that an unregistered trademark still has enforceable rights in federal court via the Lanham Act.¹³ Congress enacted the Lanham Act in 1946,¹⁴ codifying trademark law in an attempt to prevent, among other things, unfair competition.¹⁵ Section 43(a) of the Lanham Act focuses on consumer protection with the goal of shielding consumers from confusion.¹⁶ Over time, Section 43(a) has been interpreted to extend trademark protection to a person’s identity.¹⁷ Thus, the goal of Section 43(a) applies to

¹⁰ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (1995).

¹¹ PAUL GOLDSTEIN & R. ANTHONY REESE, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES 167 (7th ed. 2012) (“Archaeologists have unearthed Greek vases of the fifth and sixth centuries B.C. bearing the potter’s mark.”).

¹² DINWOODIE & JANIS, *supra* note 8, at 318–19. A trademark can be registered if an applicant applies for registration and trademark examiners find that the application is in compliance with formal and substantive requirements. *Id.* at 320. “Trademark registration, then, does not create rights; it only confirms the existence of rights.” *Id.* Some of the benefits of registering a trademark are that the trademark owner has prima facie evidence of the validity of the registered mark, ownership of the mark, and the exclusive right to use the registered mark. *Id.*

¹³ 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §27:14 (4th ed. 2008) (“[S]uch a mark or trade dress should receive essentially the same protection as those that are registered.” (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 776 (1992) (Stevens, J., concurring))); *see also* *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1404 (9th Cir. 1997).

¹⁴ GOLDSTEIN & REESE, *supra* note 11, at 167–68 (“Systematic legal protection of trademarks began to take shape in the early years of the nineteenth century as courts in England and the United States gradually evolved a distinct law of trademark infringement as a branch of the more general unfair competition doctrine of passing off.”).

¹⁵ *See* DINWOODIE & JANIS, *supra* note 8, at 833–34.

¹⁶ GOLDSTEIN & REESE, *supra* note 11, at 168.

¹⁷ *Id.*

confusion about celebrity affiliations with, and endorsements of, products.¹⁸ As the Sixth Circuit explained, Section 43(a) “permits celebrities to vindicate property rights in their identities against allegedly misleading commercial uses by others [C]ourts routinely recognize a property right in celebrity identity akin to that of a trademark holder under § 43(a).”¹⁹

Looking at the first part of the quote above, Section 43(a) deals with cases of “unwanted attribution” where a “person’s identity is used without permission in connection with another’s product or service.”²⁰ Under this category, a plaintiff can assert a claim for confusion or passing off, also known as false endorsement under Section 43(a)(1)(A).²¹ Logically, a false endorsement claim involves some element of falsity.²² Specifically, there are two forms of falsity involved in these claims. The fallacy involved in a case may include a misleading description of fact or misleading representation of fact that either

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services or commercial activities[.]²³

An example is helpful here to understand how an element of falsity is involved in false endorsement claims. In *Waits v. Frito-Lay, Inc.*,²⁴ Tom Waits, a professional singer, brought a false endorsement claim under Section 43(a) against Frito-Lay.²⁵ Waits brought the claim because Frito-Lay had

¹⁸ 15 U.S.C. § 1125(a)(1)(A) (2012); *see, e.g.*, *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013); GOLDSTEIN & REESE, *supra* note 11, at 169 (“[The Act] widens the compass of federal unfair competition law under section 43(a)”).

¹⁹ 5 MCCARTHY, *supra* note 13, § 28:15 (alterations and omissions in original) (quoting *Parks v. LaFace Records*, 329 F.3d 437, 445, 447 (6th Cir. 2003)) (internal quotation marks omitted).

²⁰ DINWOODIE & JANIS, *supra* note 8, at 834.

²¹ *Id.* Under the category of unwanted attribution, a plaintiff can also assert a claim for false advertising under Section 43(a)(1)(B). The second category of claims involves “under-attribution,” in which there are misleading omissions that do not give proper credit to an individual. *See id.* While these types of claim exist, they will not be the focus of this Comment and, as such, will not be discussed further.

²² *See* 15 U.S.C. § 1125(a)(1)(A); DINWOODIE & JANIS, *supra* note 8, at 834.

²³ 15 U.S.C. §§ 1125(a)(1)(A)–(B).

²⁴ 978 F.2d 1093 (9th Cir. 1992), *abrogation recognized by* *Fifty-Six Hope Rd. Music, Ltd. v. A.V.E.L.A., Inc.*, 778 F.3d 1059 (9th Cir. 2015).

²⁵ *Id.* at 1096; DINWOODIE & JANIS, *supra* note 8, at 834.

advertisements that used a Waits soundalike to promote its products.²⁶ Waits argued that the use of the soundalike created consumer confusion and improperly suggested Waits's endorsement of the product.²⁷ The Ninth Circuit explained that

[a] false endorsement claim based on the unauthorized use of a celebrity's identity is a type of false association claim, for it alleges the misuse of a trademark, *i.e.*, a symbol or device such as visual likeness, vocal imitation, or other uniquely distinguishing characteristic, which is likely to confuse consumers as to the plaintiff's sponsorship or approval of the product.²⁸

The court held that the evidence, including a comparison of recordings of Waits's voice and recordings of the voice used in the commercial, supported the jury's finding that the advertisement likely caused consumers to be confused into thinking that Waits endorsed Frito-Lay's product.²⁹ Thus, Waits prevailed on his Section 43(a) claim because the use of a soundalike created consumer confusion and improperly implied that Waits endorsed the product.³⁰

As further noted by the Sixth Circuit in the second half of the quoted language above, an individual's persona is a type of trademark that may be infringed by a false endorsement, but all of the traditional characteristics of a trademark are not required.³¹ The Ninth Circuit applies logic similar to that of the Sixth Circuit by holding that a celebrity's persona can serve as a trademark.³² The key is that Section 43(a)(1)(A) prohibits the use of "a false or misleading representation that is likely to cause confusion as to either the

²⁶ *Waits*, 978 F.2d at 1097.

²⁷ *Id.* at 1098; *DINWOODIE & JANIS*, *supra* note 8, at 834.

²⁸ *Waits*, 978 F.2d at 1110.

²⁹ *Id.* at 1111; *DINWOODIE & JANIS*, *supra* note 8, at 835. It is important to note that the test used by the jury, which looked at factors from the likelihood of confusion test, is no longer the test used by the Ninth Circuit for false endorsement claims today. *See id.* The likelihood of confusion test will be discussed in more detail later in this Comment as part of the proposed test for the Ninth Circuit and other courts to apply when evaluating false endorsement claims. *See infra* Part IV.C. The Ninth Circuit has rejected the likelihood of confusion test and held that it failed to fully take First Amendment interests into consideration. *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1242 (9th Cir. 2013). The test used today is the *Rogers* test, which is part of the focus of this Comment. *See Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); *infra* Part IV.A.

³⁰ *See Waits*, 978 F.2d at 1111.

³¹ 5 MCCARTHY, *supra* note 13, § 28:15. According to the RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (1995), a trademark has three main requirements: it must have distinctiveness, functionality, and use. *See also* *DINWOODIE & JANIS*, *supra* note 8, at 45.

³² 5 MCCARTHY, *supra* note 13, § 28:15; *see, e.g.*, *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992) (explaining that Vanna White's persona was the trademark in a case in which Samsung had an advertisement that created consumer confusion over whether White endorsed Samsung's VCR product).

plaintiff's connection with the defendant's goods or services or as to the sponsorship or approval by [the] plaintiff of the defendant's goods, services or commercial activities."³³ Only a likelihood of confusion or deception is necessary.³⁴ Accordingly a false endorsement claim "does not require proof of actual . . . deception."³⁵

B. *The Right of Publicity*

Another body of law that pertains to the use of one's likeness is the right of publicity, which "is the inherent right of every human being to control the commercial use of his or her identity."³⁶ A person's identity consists of a person's "name, voice, signature, photograph, or likeness."³⁷ There is no federally recognized right of publicity, and, as such, protection of publicity rights comes from state law.³⁸ The right developed out of common law privacy rights; thus, a brief understanding of the right of privacy is necessary.³⁹

Right of privacy is a tort law concept designed to prevent "truthful but intrusive and embarrassing disclosures by the press."⁴⁰ Judges felt that the main notion behind the right of privacy, or the "right to be let alone," was inapplicable to a celebrity plaintiff who in fact wanted to be well-known, thus leading to the creation of the right of publicity.⁴¹ The right of publicity

³³ 5 MCCARTHY, *supra* note 13, § 28:15.

³⁴ *Id.*

³⁵ *Id.*

³⁶ *Id.* § 28:1.

³⁷ Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 799 (Cal. 2001).

³⁸ DINWOODIE & JANIS, *supra* note 8, at 836.

³⁹ 5 MCCARTHY, *supra* note 13, § 28:4.

⁴⁰ *Id.* § 28:3. There are four classic rights to privacy. These categories were first suggested by Samuel Warren and Louis Brandeis in 1890. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890). William Prosser then articulated that the four categories incorporated in a personal right to privacy are "1. Protection against intrusion into one's private affairs; 2. Avoidance of disclosure of one's embarrassing private facts; 3. Protection against publicity placing one in a false light in the public eye; and 4. Remedies for appropriation, usually for commercial advantage, of one's name or likeness." DONALD E. BIEDERMAN ET AL., *LAW AND BUSINESS OF THE ENTERTAINMENT INDUSTRIES* 186 (5th ed. 2007). The first three categories are the classic right to be let alone, while the fourth class focuses on the "proprietary interests of protecting against misappropriation of one's name or likeness for commercial gain." *Id.* The right of publicity flowed out of the fourth category. *See id.*

⁴¹ 5 MCCARTHY, *supra* note 13, § 28:4 ("[W]hat the celebrity wanted was not protection against unreasonable intrusion into privacy, but a right to control the commercial value of identity . . ."). Judge Jerome Frank, the first to use the term "right of publicity," noted that "many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likeness, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their

emerged as a separate right, relating to the “commercial damage to the business value of human identity.”⁴² Simply stated, a celebrity will bring a claim for violation of his or her right of publicity based on that individual’s economic interest in his or her own persona.⁴³ The notion behind the claim is that someone else used the celebrity’s persona without consent, impermissibly enriching the person who appropriated the celebrity persona while causing harm to the celebrity’s identity.⁴⁴

There are two sources of the right of publicity: state statutes and the common law.⁴⁵ Thirty-one states recognize the right, and all states that recognize the right deal with it in their own way.⁴⁶ One notable state is New York, where courts have held that both privacy and publicity rights are narrowly confined under a 1903 statute.⁴⁷ California is on the other end of the spectrum and has a more, if not the most, robust right of publicity.⁴⁸ Those two states illuminate the differing treatment by courts: a plaintiff bringing a right of publicity claim in California will have a greater chance of winning the lawsuit than a plaintiff bringing suit in New York.⁴⁹

Generally, the term “persona” encompasses the nature of a person’s identity, which may include a person’s name, voice, performing style, or any other identifiable and distinguishable characteristic associated with that person.⁵⁰ The right of publicity has been described as an in-gross property right, and one’s persona can be understood to be the res, or thing, that attaches to a set of rights.⁵¹ If individuals conceptualize the right of publicity in this

countenances, displayed in newspapers, magazines, busses, trains and subways.” *Id.* (quoting *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953)).

⁴² *Id.* § 28:6.

⁴³ *Id.*

⁴⁴ *See id.*

⁴⁵ *DINWOODIE & JANIS, supra* note 8, at 845 (“In the remaining jurisdictions . . . there are no recent cases in which courts have refused to recognize the right of publicity.”). Some states, such as California, have both a common law and statutory right of publicity. 5 *MCCARTHY, supra* note 13, § 28:18.

⁴⁶ 5 *MCCARTHY, supra* note 13, § 28:16.

⁴⁷ *Id.* The statute confines a prima facie cause of action for a violation of a right of privacy to four narrow elements, and right of publicity is not recognized as a separate right. *See id.* § 28:32.

⁴⁸ *DINWOODIE & JANIS, supra* note 8, at 854.

⁴⁹ *See id.* California has the most robust protection probably in part because of the entertainment industry and the fact that many celebrities have a home located in the state. In fact, California’s tourism website features art and film festivals as some of the things that a visitor can attend while in California. *California’s Top Performance Spaces*, CAL. DREAM BIG, <http://www.visitcalifornia.com/feature/californias-top-performance-spaces> (last visited Apr. 27, 2015).

⁵⁰ 5 *MCCARTHY, supra* note 13, § 28:7.

⁵¹ *See DINWOODIE & JANIS, supra* note 8, at 851 (“Many of the right-of-publicity cases can be understood as engaging in this exercise, even if the courts do not always define the exercise specifically in these terms.”).

manner, the scope of the right can be determined if “the components of that persona” are defined.⁵² Unlike Section 43(a) of the Lanham Act, the right of publicity lacks an element of falsity or deception; instead, it requires unpermitted and damaging use of the plaintiff’s identity.⁵³

C. *The Differences Between False Endorsement and The Right of Publicity*

It is common for plaintiffs to plead both right of publicity infringement and false endorsement under the Lanham Act in personal identity cases brought in federal court.⁵⁴ While the two claims have similarities, there are three important differences between the two legal theories.

First, a substantial difference between right of publicity and false endorsement claims is the absence of a fallacy element in the right of publicity.⁵⁵ Section 43(a) places great emphasis on falsity in false endorsement claims, as falsity is the “sine qua non,” or the crucial element, of false endorsement.⁵⁶

Second, the right of publicity is a creature of state law, either statutory, common law, or both, because there is no federal right of publicity.⁵⁷ False endorsement claims, on the other hand, fall under the Lanham Act, which is a federal statute.⁵⁸ This is an important distinction because a federal statute creates greater uniformity across courts when deciding a claim, whereas states may, and do, decide similar right of publicity claims differently depending on the state’s law.⁵⁹

Lastly, the two bodies of law protect different parties. “The right of publicity is the inherent right of every human being to control the commercial

⁵² *Id.*

⁵³ 5 MCCARTHY, *supra* note 13, § 28:7 (“Under this test, it is only necessary that a more than de minimis number of ordinary viewers (or listeners) of defendant’s use can identify the plaintiff.”).

⁵⁴ DINWOODIE & JANIS, *supra* note 8, at 833–34.

⁵⁵ 5 MCCARTHY, *supra* note 13, § 28:14.

⁵⁶ *Id.*

⁵⁷ DINWOODIE & JANIS, *supra* note 8, at 845.

⁵⁸ 15 U.S.C. § 1125(a)(1)(A) (2012).

⁵⁹ New York does not have an independent common law right of publicity, and any right of publicity claim must be brought under the New York Civil Rights Laws. *See* *Stephano v. News Grp. Publ’ns, Inc.*, 474 N.E.2d 580, 584 (N.Y. 1984) (“Since the ‘right of publicity’ is encompassed under the Civil Rights Law as an aspect of the right of privacy, which, as noted, is exclusively statutory in this State, the plaintiff cannot claim an independent common-law right of publicity.”). *Compare* N.Y. CIV. RIGHTS LAW §§ 50, 51 (McKinney 2009) (providing a limited right to privacy), *with* CAL. CIV. CODE § 3344 (West 1997) (providing extensive privacy protections).

use of his or her identity.”⁶⁰ The focus is on the individual whose identity is being used.⁶¹ On the other hand, the celebrity is not the center of false endorsement claims. Rather, Section 43(a) places great weight on falsity and likelihood of deception in order to protect the consumer from mistakenly believing that the celebrity endorsed the product.⁶²

II. THE FIRST AMENDMENT

Although Section 43(a) of the Lanham Act and the right of publicity protect different parties and interests, both bodies of law are limited by the First Amendment; specifically, the First Amendment interest in free speech. The Ninth Circuit employs two different tests to analyze whether the interest in free speech should act as a check on countervailing interests depending on what claim the celebrity brings. While the court adopted the *Rogers* test for Section 43(a) claims, the court embraced the transformative use test for right of publicity claims. The two tests take free speech concerns into account differently, and the background of the court’s implementation of each test is explained below. Before examining the tests the Ninth Circuit uses to balance interests, it is necessary to understand the First Amendment interest in free speech and why courts seek to protect that interest.

A. *The First Amendment: A Brief Overview of Free Speech*

Whether a celebrity brings an action pursuant to state law right of publicity, a federal claim under the Lanham Act, or both, those laws protect interests that must be balanced with the First Amendment interest in free speech. The First Amendment states, in relevant part, that “Congress shall make no law . . . abridging the freedom of speech.”⁶³ Freedom of speech, also known as free expression,⁶⁴ protects an individual’s right to communicate messages and ideas.⁶⁵ The framers of the Constitution enshrined this notion because they believed that speech should be protected in order to prevent silencing by the government.⁶⁶

⁶⁰ 5 MCCARTHY, *supra* note 13, § 28:1.

⁶¹ *See id.*

⁶² 15 U.S.C. § 1125(a)(1)(A); *see* DINWOODIE & JANIS, *supra* note 8, at 834.

⁶³ U.S. CONST. amend. I.

⁶⁴ *See, e.g.,* Brown v. Entm’t Merchs. Ass’n, 131 S. Ct. 2729, 2743 (2011) (Alito, J., concurring) (“[A] law that regulates expression ‘raises special First Amendment concerns because of its obvious chilling effect on free speech.’” (quoting Reno v. ACLU, 521 U.S. 844, 871–72 (1997))).

⁶⁵ *See id.* at 2733 (majority opinion).

⁶⁶ New York Times, Co. v. United States, 403 U.S. 713, 715–16 (1971) (Black, J., concurring).

The case law of the U.S. Supreme Court extensively protects free speech and has expanded freedom of speech to include freedom within expressive works.⁶⁷ Expressive works are bodies of artistic work such as books, plays, movies, and videogames.⁶⁸ These expressive works have features such as dialogue, plot, music, and characters.⁶⁹ Because the interest in free speech encompasses expressive works, governmental rights cannot silence speech when individuals use expressive components in communications.⁷⁰ However, courts need to balance a party's First Amendment interest in free expression with countervailing interests when an individual's likeness is used. This balance is highlighted when a celebrity brings an infringement of the right of publicity or a violation of Section 43(a) of the Lanham Act claim. When an expressive work uses a celebrity's identity, that use would not be protected were it not for the First Amendment interest in free speech.

B. The Balance Between Section 43(a) Interests and the Interest in Free Expression: The Rogers Test

Section 43(a)'s scope is limited by the interest in free expression because of the value of the communications found in the expressive work.⁷¹ Recognizing the need to balance these concerns, the Second Circuit articulated a new test in *Rogers v. Grimaldi*,⁷² appropriately termed the *Rogers* test.⁷³ In *Rogers*, the famous actress Ginger Rogers alleged that the producers and distributors of the film entitled *Ginger and Fred* violated the Lanham Act and infringed her common law rights of publicity and privacy.⁷⁴

Ginger Rogers and Fred Astaire were an internationally famous duo in the show-business industry.⁷⁵ The defendants—appellees produced and distributed the film in the United States and Europe.⁷⁶ The film depicted a story of two fictional Italian cabaret performers who imitated the famous duo and were known as Ginger and Fred.⁷⁷ The motion picture centered around the televised

⁶⁷ See *Entm't Merchs.*, 131 S. Ct. at 2733.

⁶⁸ *Id.*

⁶⁹ See *id.*

⁷⁰ See *id.*

⁷¹ *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013).

⁷² 875 F.2d 994, 999 (2d Cir. 1989).

⁷³ *Brown*, 724 F.3d at 1239.

⁷⁴ *Rogers*, 875 F.2d at 996.

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.* at 996–97.

reunion of the two imitators years after they retired.⁷⁸ On appeal, the Second Circuit examined whether the use of the title *Ginger and Fred* violated Section 43(a) of the Lanham Act and whether the constitutional interest in free expression should limit Section 43(a).⁷⁹ The court noted that “[b]ecause overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.”⁸⁰ The court therefore determined that Section 43(a) should “apply to artistic works only when the public interest in avoiding consumer confusion outweighs the public interest in free expression.”⁸¹

Under the *Rogers* test, [Section] 43(a) will not be applied to expressive works “unless the [use of the trademark or other identifying material] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the [use of the trademark or other identifying material] explicitly misleads as to the source or the content of the work.”⁸²

Put simply, there are two situations in which a work is not entitled to First Amendment protection, and the balance weighs in favor of protecting Section 43(a) interests.⁸³ The first circumstance is a work that has no artistic relevance.⁸⁴ The second circumstance involves a work that meets the minimum standard of artistic relevance but is explicitly misleading as to the source or the content of the work.⁸⁵ The requirement that the work be explicitly misleading strikes at the core purpose of trademark law. Specifically, trademark law functions to protect against consumer confusion “in the marketplace by allowing a trademark owner to prevent others from duping consumers into buying a product they mistakenly believe is sponsored by the trademark owner.”⁸⁶ The court in *Rogers* held that the film’s title had artistic relevance and was not explicitly misleading, so the interest in free expression outweighed

⁷⁸ *Id.* at 997.

⁷⁹ *Id.* at 998 (“Though First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims, such concerns must nonetheless inform our consideration of the scope of the Act as applied to claims involving such titles. Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion.” (footnote omitted)).

⁸⁰ *Id.*

⁸¹ *Id.* at 999.

⁸² *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013) (second and third alterations in original) (quoting *Rogers*, 875 F.2d at 999).

⁸³ *Rogers*, 875 F.2d at 999.

⁸⁴ *See id.*

⁸⁵ *See id.*

⁸⁶ *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (quoting *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806 (9th Cir. 2003)) (internal quotation mark omitted).

the Section 43(a) interests, and the court held in favor of the film producers and distributors.⁸⁷

The court then turned to Rogers's common law right of publicity and privacy claims. The Second Circuit recognized the difference in interests that the two different bodies of law seek to protect and noted that the right of publicity does not require likelihood of confusion as a necessary element.⁸⁸ Right of publicity "is potentially more expansive than the Lanham Act. Perhaps for that reason, courts delineating the right of publicity, more frequently than in applying the Lanham Act, have recognized the need to limit the right to accommodate First Amendment concerns."⁸⁹ However, since state law governs right of publicity claims, the court applied the substantive law of Rogers's domicile, which was Oregon.⁹⁰ Oregon courts at the time had not determined the scope of the right of publicity. Consequently, the Second Circuit was tasked with determining how the New York courts would predict how the Oregon courts would apply the law.⁹¹ The court determined that New York would recognize limits in Oregon law and would not expect Oregon to allow the right of publicity to act as a bar in the use of a celebrity's name in a film title.⁹² Thus, the court found in favor of the film producers and distributors under both the Section 43(a) claim and Rogers's right of publicity and privacy claims.⁹³

The Ninth Circuit adopted the *Rogers* test for Section 43(a) claims in 2002 in *Mattel, Inc. v. MCA Records, Inc.*⁹⁴ Mattel, a toy manufacturer, created Barbie, a doll described as a "glamorous, long-legged blonde."⁹⁵ In *Mattel*, a Danish band, Aqua, produced a song titled "Barbie Girl," and in the song, a band member impersonated Barbie.⁹⁶ Mattel brought suit against the music

⁸⁷ *Rogers*, 875 F.2d at 1001. As an example of a title that would be explicitly misleading, the court said that the Lanham Act may apply to a title such as "The True Life Story of Ginger and Fred." *Id.* at 1000.

⁸⁸ *Id.* at 1004.

⁸⁹ *Id.* (citing Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 160–66).

⁹⁰ *Id.* at 1002.

⁹¹ *Id.* Note that the case was originally brought in the United States District Court for the Southern District of New York and was then brought to the Second Circuit on appeal. This is why determining how New York courts would apply the law comes into play here. *See id.* at 996.

⁹² *Id.* at 1004.

⁹³ *See id.* at 1001–02, 1005.

⁹⁴ 296 F.3d 894, 902 (9th Cir. 2002); *see also* *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013).

⁹⁵ *Mattel*, 296 F.3d at 898.

⁹⁶ *Id.* at 899 ("[O]ne bandmember impersonates Barbie, singing in a high-pitched, doll-like voice; another bandmember calling himself Ken, entices Barbie to 'go party.'").

companies under various claims, including violation of the Lanham Act for producing, marketing, and selling the song.⁹⁷ The Ninth Circuit explained that “[a] trademark ‘inform[s] people that trademarked products come from the same source.’”⁹⁸ The court noted that trademark owners have property rights that must be balanced with the interest in free expression in order to avoid consumer confusion in the marketplace.⁹⁹ However, the court went on to explain that a problem occurs when trademarks surpass their identifying purpose and become ingrained in society as something more.¹⁰⁰

The Ninth Circuit noted that the test the court traditionally used to balance the trademark owner’s rights against free expression was not adequate when dealing with a trademark that has become more than a source identifier.¹⁰¹ The trademark, Barbie, was considered to be part of society’s everyday vocabulary, making it hard for people to describe the product in any other way.¹⁰² Since Mattel’s trademark had taken on a meaning beyond source identification, and because the name Barbie was used in the title of a song, the court looked to *Rogers v. Grimaldi*.¹⁰³ The Ninth Circuit agreed with the Second Circuit’s analysis in *Rogers* and adopted the two-pronged *Rogers* test.¹⁰⁴ Applying the *Rogers* test, the court held that Barbie was artistically relevant to the work and that the song title did not explicitly mislead consumers into believing that Mattel produced the song; therefore the court held in favor of the song producers.¹⁰⁵

The Ninth Circuit has subsequently expanded the scope of the *Rogers* test from cases involving the use of a trademark, or other identifying material, in

⁹⁷ *Id.*

⁹⁸ *Id.* at 900 (second alteration in original) (quoting *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 305 n.2 (9th Cir. 1992)).

⁹⁹ *Id.* (“Whatever first amendment rights you may have in calling the brew you make in your bathtub ‘Pepsi’ are easily outweighed by the buyer’s interest in not being fooled into buying it.” (quoting Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 973 (1993)) (some internal quotation marks omitted)).

¹⁰⁰ *Id.*

¹⁰¹ *Id.* The court traditionally used the likelihood of confusion test, which will be explained later in this Comment. See *infra* Part IV.C.

¹⁰² *Mattel*, 296 F.3d at 900 (“[W]hen we’d find it difficult to describe the product any other way (as in the case of aspirin), or when the mark (like Rolls Royce) has taken on an expressive meaning apart from its source-identifying function . . .”).

¹⁰³ *Id.* at 900–01.

¹⁰⁴ *Id.* at 902.

¹⁰⁵ *Id.*

titles to uses within the body of the work.¹⁰⁶ Importantly, the Ninth Circuit applied the *Rogers* test in one of the cases central to this Comment, *Brown v. Electronic Arts, Inc.*¹⁰⁷

C. The Balance Between Right of Publicity Interests and the Interest in Free Expression: The Transformative Use Test

Like a trademark, the right of publicity may be infringed—illegally appropriated—when a two-prong test is met.¹⁰⁸ First, a person’s identity must be impermissibly used, and such use must “likely damage the commercial value of [the person’s] inherent right” in his or her own personal identity.¹⁰⁹ Second, the court needs to balance the interest in free speech with the person’s economic interest in the use of his or her identity.¹¹⁰ Infringement only occurs when the interest in free expression does not outweigh one’s economic interest in one’s own identity.¹¹¹ In other words, free expression rights do not protect the commercial use of the celebrity’s identity.¹¹²

The Supreme Court has only addressed the balance between right of publicity interests and free expression once, in *Zacchini v. Scripps-Howard Broadcasting Co.*¹¹³ In *Zacchini*, an employee of a television broadcasting company filmed a performer in a “human cannonball” act against the wishes of the performer.¹¹⁴ The broadcasting company played the video recording in its entirety on the company’s news program.¹¹⁵ The plaintiff brought suit in Ohio,

¹⁰⁶ See E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1099 (9th Cir. 2008). This case involved a claim for the alleged violation of the Lanham Act brought by the owner of a strip club, “Play Pen Gentlemen’s Club,” against the creator of the videogame, *Grand Theft Auto: San Andreas*, for the game’s image of a club named “Pig Pen.” See *id.* at 1097–98. The court held that Rock Star’s use of E.S.S.’s trademark was artistically relevant and not explicitly misleading. *Id.* at 1101.

¹⁰⁷ 724 F.3d 1235, 1239 (9th Cir. 2013).

¹⁰⁸ See 5 MCCARTHY, *supra* note 13, § 28:15.

¹⁰⁹ *Id.* § 28:1; see also *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 565 (1977); *In re NCAA Student-Athlete Name & Likeness Licensing Litig. (Keller)*, 724 F.3d 1268, 1273 (9th Cir. 2013); *Rogers*, 875 F.2d at 1004.

¹¹⁰ See *Keller*, 724 F. 3d. at 1273 (“The defense is ‘a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.’” (quoting Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 799 (Cal. 2001))); 5 MCCARTHY, *supra* note 13, § 28:1.

¹¹¹ See 5 MCCARTHY, *supra* note 13, § 28:1.

¹¹² See *id.*

¹¹³ 433 U.S. 562.

¹¹⁴ *Id.* at 563–64.

¹¹⁵ *Id.* at 564.

and the case ascended to the Supreme Court of Ohio.¹¹⁶ The Supreme Court of Ohio held that although an individual's name or likeness cannot be used by another for that other person's benefit in the absence of license or privilege, free expression interests may sometimes outweigh the right of publicity interests.¹¹⁷ The court therefore held that the broadcasting company had a privilege to report news of public interest that would otherwise be protected by Zacchini's right of publicity, unless the company had the intent "to appropriate the benefit of the publicity for some non-privileged use, or . . . to injure the individual."¹¹⁸ In other words, the broadcasting company was constitutionally free to film and show Zacchini's performance in its entirety.¹¹⁹

The U.S. Supreme Court then granted certiorari to consider the issue of whether the First Amendment protected the broadcasting company from damages for the alleged infringement of Zacchini's state law right of publicity.¹²⁰ The Court reversed the Ohio Supreme Court, holding that the First Amendment does not require protection of the broadcasting company.¹²¹ The Court noted that Ohio may privilege the broadcasting company based on its own state law, but the First Amendment did not require Ohio to do so.¹²²

The rationale behind the Court's decision to protect the right of publicity was to prevent unjust enrichment.¹²³ The Court noted, "No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay."¹²⁴ *Zacchini* illustrates what is potentially the strongest case for right of publicity because the claim involved Zacchini's entire performance.¹²⁵ The use of Zacchini's performance was "not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first

¹¹⁶ *See id.* at 565.

¹¹⁷ *Id.*

¹¹⁸ *Id.* (quoting *Zacchini v. Scripps-Howard Broadcasting Co.*, 351 N.E.2d 454, 455 (Ohio 1976)) (internal quotation mark omitted).

¹¹⁹ *Id.*; *see also id.* at 570.

¹²⁰ *Id.* at 565.

¹²¹ *Id.* at 578–79.

¹²² *Id.*

¹²³ *Id.* at 576.

¹²⁴ *Id.* (quoting Harry Kalven, Jr., *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966)) (internal quotation mark omitted).

¹²⁵ *Id.* ("[T]he broadcast of petitioner's entire performance, unlike the unauthorized use of another's name for purposes of trade or the incidental use of a name or picture by the press, goes to the heart of petitioner's ability to earn a living as an entertainer.").

place.”¹²⁶ The Court therefore used an objective analysis, asking whether the use of the individual’s likeness was the individual’s entire act.¹²⁷

Unfortunately, the U.S. Supreme Court’s analysis did not clarify what interests should prevail in the balance in less clear-cut cases when something less than an individual’s entire performance is used. Additionally, the case did not solve problems that arise due to the different application of the right of publicity across different states. Even though federal constitutional requirements did not require favoring First Amendment interests in *Zacchini*, the Court noted that Ohio may do so on state law grounds, therefore creating uncertainty.¹²⁸

To provide some guidance for balancing free speech and right of publicity interests, the California Supreme Court created the transformative use test in *Comedy III Productions, Inc. v. Gary Saderup, Inc.* as a defense.¹²⁹ The court provided five key factors to consider when applying the transformative use test to determine if an artistic work deserves First Amendment protection.¹³⁰ First, if “the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized, it is more likely to be transformative than if the depiction or imitation of the celebrity is the very sum and substance of the work in question.”¹³¹ Second, as long as the artistic work is something more than the celebrity’s likeness, the work is protected because it is considered to be the artist’s own expression.¹³² Third, “a court should conduct an inquiry ‘more quantitative than qualitative’ and ask ‘whether the literal and imitative or the creative elements predominate in the work.’”¹³³ Fourth, the court should conduct a second inquiry in close cases, asking whether “the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted.”¹³⁴ Finally, “‘when an artist’s skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame,’ the work is not transformative.”¹³⁵

¹²⁶ *Id.*

¹²⁷ *Id.*

¹²⁸ *See id.* at 575–76.

¹²⁹ 21 P.3d 797 (Cal. 2001); *see also Keller*, 724 F.3d 1268, 1273 (9th Cir. 2013).

¹³⁰ *Comedy III*, 21 P.3d at 809–10.

¹³¹ *Id.* at 809.

¹³² *Keller*, 724 F.3d at 1274 (quoting *Comedy III*, 21 P.3d at 809–10).

¹³³ *Comedy III*, 21 P.3d at 810.

¹³⁴ *Id.*

¹³⁵ *Keller*, 724 F.3d at 1274 (quoting *Comedy III*, 21 P.3d at 810).

Comedy III involved an action brought by The Three Stooges against the defendant for selling lithographs and t-shirts containing the group's likeness.¹³⁶ The court explained that the transformative use test is a balance "based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation."¹³⁷ When a work has "significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity."¹³⁸ The court explained that even if an artist created a work for financial gain, the interest in free expression still applies¹³⁹ because two main purposes behind First Amendment protection are "to preserve an uninhibited marketplace of ideas" and to preserve self-expression.¹⁴⁰

The court held that the t-shirts with lithographs of The Three Stooges' faces did not meet the transformative use test; thus right of publicity interests prevailed and outweighed free expression.¹⁴¹ The holding of *Comedy III* was the opposite of the holding in *Rogers*, discussed above, in which the Second Circuit found in favor of the defendants.¹⁴² The contrasting holdings of *Comedy III* and *Rogers* illuminate the lack of uniformity across states when evaluating the balance of interests in right of publicity claims. The courts in those cases apply different tests when evaluating the right, highlighting the differing treatment of the right of publicity in California compared to New York.¹⁴³ California courts have used the transformative use test since *Comedy III*, and the Ninth Circuit continued its use in the second key case of this Comment, *In re NCAA Student-Athlete Name & Likeness Licensing Litigation (Keller)*.

¹³⁶ *Comedy III*, 21 P.3d at 800.

¹³⁷ *Id.* at 799.

¹³⁸ *Id.* at 808.

¹³⁹ *Id.* at 802.

¹⁴⁰ *Id.* at 803 (quoting *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 458 (Cal. 1979) (in banc)) (internal quotation marks omitted).

¹⁴¹ *Id.* at 811.

¹⁴² *See supra* Part II.B.

¹⁴³ *See supra* note 59.

III. TWO KEY NINTH CIRCUIT CASES HIGHLIGHTING THE CONTRAST BETWEEN FALSE ENDORSEMENT AND RIGHT OF PUBLICITY—SIMILAR FACTS, OPPOSITE HOLDINGS

Brown v. Electronic Arts, Inc. and *Keller* are both cases that involve the use of a football player's likeness in a videogame series developed by Electronic Arts (EA). EA has been manufacturing, distributing, and producing the *Madden NFL* series of football videogames since 1989.¹⁴⁴ Users of the game control avatars, which represent well-known football players, and those avatars play in simulated football games.¹⁴⁵ Some of the avatars mirror current NFL players, and those players' names, jersey numbers, physical attributes, and skills are incorporated into the avatars.¹⁴⁶ The NFL and the NFL Players Association have a licensing agreement with EA, allowing EA to use the names and likenesses of current NFL athletes.¹⁴⁷ Some of the versions of the videogame also incorporate historical and all-time teams, but the games don't use the names of players who are no longer NFL athletes.¹⁴⁸ However, these players are easily recognizable, as their playing positions, former team affiliations, ages, heights, weights, ability levels, and other qualities are included.¹⁴⁹

A. *False Endorsement: Brown v. Electronic Arts, Inc.*

Plaintiff–Appellant James “Jim” Brown brought suit against Defendant–Appellee Electronic Arts, Inc., alleging that EA violated Section 43(a) of the Lanham Act.¹⁵⁰ Brown is a retired NFL player and this suit stemmed from EA's alleged use of Brown's likeness in EA's *Madden NFL* series videogames.¹⁵¹ Since Brown is a retired NFL player, his name is not included in the game, but his other attributes are.¹⁵² The licensing agreement between the NFL, the NFL Players Association, and EA therefore does not cover the

¹⁴⁴ *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1240 (9th Cir. 2013).

¹⁴⁵ *Id.*

¹⁴⁶ *Id.*

¹⁴⁷ *See id.*

¹⁴⁸ *Id.*

¹⁴⁹ *Id.*

¹⁵⁰ *Id.* at 1238–39. Brown also brought claims for invasion of privacy and unfair and unlawful business practices under California law, but the district court declined to exercise supplemental jurisdiction over these claims and so the Lanham Act claim was the focus of this case. *Id.* at 1240.

¹⁵¹ *Id.* at 1238–40.

¹⁵² *See id.* at 1240.

use of Brown's likeness because he is retired.¹⁵³ The United States District Court for the Central District of California applied the *Rogers* test and held in favor of EA, finding that neither prong of the test was satisfied, and so the interest in free speech limited Section 43(a) interests.¹⁵⁴

The Ninth Circuit began its discussion of Brown's Lanham Act claim by reiterating that the *Rogers* test is the appropriate test for balancing the interest in free expression with Section 43(a) interests for expressive works.¹⁵⁵ The Ninth Circuit adopted the U.S. Supreme Court's finding that videogames should be given the same protection as more traditional forms of expression, such as protected plays or books.¹⁵⁶ "[V]ideo games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot and music)[,] . . . and . . . these similarities to other expressive mediums 'suffice [] to confer First Amendment protection.'"¹⁵⁷

In applying the first prong of the *Rogers* test, the court explained that "the level of [artistic] relevance [of the trademark or other identifying material to the work] merely must be above zero' for the trademark or other identifying material to be deemed artistically relevant."¹⁵⁸ The use of Brown's likeness was considered to be artistically relevant to the videogames, as the court explained that "EA prides itself on the extreme realism of the games."¹⁵⁹ Brown's likeness was therefore determined to be crucial to the games' expressive purpose.¹⁶⁰ Brown argued that the minimal standard for artistic relevance makes the *Rogers* test a rigid and inflexible rule that automatically protects First Amendment expressive freedom at the cost of consumer confusion.¹⁶¹ The court nevertheless defended its position, stating that the balance does not dictate that both sides are weighted equally and that the test applies when free speech rights are at their peak of importance: when dealing with expressive works.¹⁶²

¹⁵³ *Id.*

¹⁵⁴ *Id.* at 1239.

¹⁵⁵ *Id.* at 1241.

¹⁵⁶ *Id.* (citing *Brown v. Entm't Merchs. Ass'n*, 131 S. Ct. 2729, 2731 (2011)).

¹⁵⁷ *Id.* (final alteration in original) (quoting *Entm't Merchs.*, 131 S. Ct. at 2733).

¹⁵⁸ *Id.* at 1243 (alteration in original) (quoting *E.S.S. Entm't 2000, Inc., v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008)).

¹⁵⁹ *Id.*

¹⁶⁰ *Id.*

¹⁶¹ *Id.* at 1244–45.

¹⁶² *Id.* at 1245.

Turning to the second prong, the court emphasized that “the creator must *explicitly* mislead consumers” and that the “slight risk that . . . use of a celebrity’s name might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression.”¹⁶³ Unless the use is explicitly misleading to consumers, the Lanham Act’s interests are outweighed by free expression concerns.¹⁶⁴ The key question under this prong was whether consumers would be confused or deceived into believing that Brown was somehow behind the games or sponsored them because of the use of his likeness in the games.¹⁶⁵ The mere “use of the mark alone is not enough to satisfy this prong.”¹⁶⁶ Brown argued that the use of his likeness plus a consumer survey, showing that a majority of the public thinks that identifying marks cannot be part of products unless the mark holder gave permission, indicated that consumers were explicitly misled.¹⁶⁷ However, the court gave no weight to the survey evidence, and it was not sufficient to meet the explicitly misleading threshold.¹⁶⁸ The key is that for Brown to have won, EA would have had to explicitly mislead consumers regarding Brown’s involvement, regardless of any implicit assumptions made by consumers.¹⁶⁹

Brown also claimed that EA officials made explicitly misleading comments.¹⁷⁰ Officials allegedly stated, at a University of Southern California Law School conference, that EA was able to use the images and likenesses of NFL athletes because EA has written authorization from the NFL and the NFL players.¹⁷¹ Judge Bybee, writing for the panel, pointed out that the alleged statement was the best argument Brown offered under this prong, but the court held that this statement was made to a limited audience and not to consumers.¹⁷² Had the statement been presented on the back cover of the game, this “might satisfy the ‘explicitly misleading’ prong, . . . but a statement made at an academic conference about all of the likenesses used in the game could

¹⁶³ *Id.* (alteration in original) (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 999–1000 (2d Cir. 1989)) (internal quotation marks omitted).

¹⁶⁴ *Id.*

¹⁶⁵ *Id.*

¹⁶⁶ *Id.*

¹⁶⁷ *Id.*

¹⁶⁸ *Id.* at 1246.

¹⁶⁹ *See id.*

¹⁷⁰ *Id.* at 1247.

¹⁷¹ *Id.*

¹⁷² *Id.*

not realistically be expected to confuse consumers as to Brown's involvement."¹⁷³

The court held that the district court did not err in finding that the use of Brown's likeness was artistically relevant and that EA did not explicitly mislead consumers.¹⁷⁴ Just like the Second Circuit's holding in *Rogers*,¹⁷⁵ and the Ninth Circuit's previous holdings in *Mattel*¹⁷⁶ and *E.S.S.*,¹⁷⁷ the Ninth Circuit here found that free expression outweighed the Lanham Act's interest, despite the fact that Brown "is a public figure whose persona can be deployed for economic benefit."¹⁷⁸

B. *Right of Publicity*: Keller

The facts of *Keller* are extremely similar to those in *Brown*, yet the Ninth Circuit concluded that the right of publicity claim trumped free expression concerns. Samuel Keller is a former college football player, and he filed a class action against videogame developer EA alleging violations of class members' rights of publicity.¹⁷⁹ Keller brought the right of publicity claim due to EA's use of Keller's likeness in the *NCAA Football* videogame series.¹⁸⁰ The 2005 edition of the game had an avatar playing for Arizona State's team with the same height, weight, skin tone, home state, play style, and jersey number (among other characteristics) as Keller had in reality.¹⁸¹ Additionally, in the 2008 edition of the game, the avatar, like Keller, played for Nebraska and had the same characteristics as it did in the 2005 edition, but this version omitted the jersey number, arguably because Keller had changed his number before the actual season started.¹⁸²

The court applied the transformative use test to evaluate EA's use of Keller's likeness and held that there was a lack of significant transformative elements; therefore, EA was not entitled to the transformative use defense.¹⁸³ The court focused primarily on the use of Keller's likeness rather than the

¹⁷³ *Id.*

¹⁷⁴ *Id.* at 1248.

¹⁷⁵ *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989).

¹⁷⁶ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

¹⁷⁷ *E.S.S. Entm't 2000, Inc., v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1101 (9th Cir. 2008).

¹⁷⁸ *Brown*, 724 F.3d at 1240, 1248.

¹⁷⁹ *Keller*, 724 F.3d 1268, 1271–72 (9th Cir. 2013).

¹⁸⁰ *See id.* at 1271.

¹⁸¹ *Id.* at 1272.

¹⁸² *Id.*

¹⁸³ *Id.* at 1276.

transformative elements of the entire videogame.¹⁸⁴ The court held that the avatar representing Keller was not an entirely new character and that, despite anything else that may happen in the game, the avatar was doing the same activity that brought Keller celebrity status.¹⁸⁵ In other words, the videogame recreated Keller “in the very setting in which he has achieved renown,”¹⁸⁶ namely a collegiate career on a football field.¹⁸⁷

The Ninth Circuit held that the right of publicity interests therefore outweighed the First Amendment interest in free expression because the expressive work was not communicating anything new.¹⁸⁸ While EA argued that the court should apply the *Rogers* test to evaluate right of publicity claims, the Ninth Circuit rejected this argument, explaining that the *Rogers* test was designed to protect consumers from confusion—“the hallmark element of a Lanham Act claim”—while “[t]he right of publicity protects the *celebrity*, not the *consumer*.”¹⁸⁹

Judge Thomas dissented and argued that the interest in free expression should outweigh right of publicity interests.¹⁹⁰ Judge Thomas acknowledged the five analytical factors that *Comedy III* provided but noted that those factors were not supposed to be condensed and argued that “excessive deconstruction of *Comedy III* can lead to misapplication of the [transformative use] test.”¹⁹¹ The dissent advocated for examining the transformative elements in the entire videogame and not just focusing on the particular avatar in question.¹⁹²

¹⁸⁴ *Id.* The dissent argued that the transformative elements of the game as a whole should be the focus and not simply the individual avatar. *Id.* at 1285 (Thomas, J., dissenting).

¹⁸⁵ *Id.* at 1277 (majority opinion). As part of the analysis, the court compared the use of Keller’s likeness to the use of a celebrity’s likeness in *Kirby v. Sega of America, Inc.*, 50 Cal. Rptr. 3d 607 (Ct. App. 2006), where a claim was brought by the singer Kierin Kirby for the alleged violation of the singer’s right of publicity for the use of Kirby’s likeness in a videogame. The California Court of Appeals held that the videogame was transformative and was given First Amendment protection, outweighing right of publicity interests because the artistic work was sufficiently transformative. Kirby’s signature expression was “ooh la la,” and the avatar was called “Ulala.” *Id.* at 609. In the game, the avatar was a reporter from outer space, and the court said that it was a “fanciful, creative character” not found in the exact context that brought Kirby fame. *Id.* at 618 (internal quotation marks omitted).

¹⁸⁶ *Keller*, 724 F.3d at 1271.

¹⁸⁷ *Id.* at 1276. The court relied heavily on *No Doubt v. Activision Publishing, Inc.*, 122 Cal. Rptr. 3d 397 (Ct. App. 2011), in which the California Court of Appeals held that Activision’s “Band Hero” videogame did not satisfy the transformative use test because the band members of “No Doubt” were not transformed into entirely new characters as in *Kirby*. *See id.* at 409–12.

¹⁸⁸ *Keller*, 724 F.3d at 1283–84.

¹⁸⁹ *Id.* at 1280–81.

¹⁹⁰ *Id.* at 1284 (Thomas, J., dissenting).

¹⁹¹ *Id.* at 1285.

¹⁹² *Id.*

Looking at the factors derived from *Comedy III*, the dissent argued that Keller's likeness was just one of the "raw materials" of the game.¹⁹³ The dissent further argued that the work as a whole is EA's artistic expression and that the "marketability and economic value of the game" resulted from those transformative elements and not just from the use of the singular athlete's likeness.¹⁹⁴ Judge Thomas concluded that the transformative elements of the game as a whole "predominate[d] over the commercial use of the athletes' likenesses," and so the interest in free expression should have prevailed.¹⁹⁵

IV. PROPOSAL: A NEW TEST FOR EVALUATING FALSE ENDORSEMENT CLAIMS

Part IV will explain why the *Rogers* test is an inadequate test to employ when evaluating false endorsement claims because the test applies an artificial standard of above-zero artistic relevancy, allows artists to implicitly mislead consumers into believing that a celebrity endorsed a product, and fails to sufficiently consider Section 43(a)'s interest in protecting consumers. While the transformative use test is a better test for courts to apply when analyzing a false endorsement claim, it is also insufficient because it, too, fails to adequately take consumers' interests into account.

This Comment proposes that courts adopt a new test that combines the transformative use test and a modified likelihood of confusion test to analyze false endorsement claims. This Part will describe the likelihood of confusion test. Prior to adopting the *Rogers* test, the Ninth Circuit applied the likelihood of confusion test in false endorsement claims. The relevant factors of the modified likelihood of confusion test will be identified and the procedure of how to analyze and weigh the factors will be explained. The proposed test would adequately take consumers' interests into consideration while still emphasizing the importance of protecting free expression. To illuminate how the new test would achieve these ends, this Part concludes by applying the suggested test to *Brown* and explaining how the outcome would differ from the Ninth Circuit's holding.

¹⁹³ *Id.* at 1286.

¹⁹⁴ *Id.* at 1284, 1286. The dissent therefore argued that this case was more aligned with *Kirby* than with *No Doubt* and pointed out that immutability of the avatar was a key factor in *No Doubt*, whereas in the NCAA videogame, players could change the avatars. *Id.* at 1286–87.

¹⁹⁵ *Id.* at 1284.

A. Critique of the Rogers Test

The Ninth Circuit's adoption of the *Rogers* test in *Brown* was inappropriate to evaluate false endorsement claims because the *Rogers* test fails to adequately take consumers' interests into account. There are many issues with the *Rogers* test that need to be exposed to understand why the *Rogers* test is unsuitable to address the concerns of Section 43(a) of the Lanham Act, and this section will employ *Brown* to express why.

The first prong of the *Rogers* test overly favors the interest in free expression and allows an artist to use a celebrity's likeness as long as the court can conjure up a reason as to why the use has above-zero relevance to the art. Under the *Rogers* test, the interest in free expression prevails if an expressive work has artistic relevance.¹⁹⁶ The use of the trademark or other identifying material merely needs to have a scintilla of artistic relevance, such that any slight relevance above zero will satisfy this burden.¹⁹⁷ In *Brown*, the Ninth Circuit reasoned that adopting the relevancy prong provides a "black-and-white rule" that affords a means for the court to make a decision without engaging in "artistic analysis."¹⁹⁸ The court's reasoning sacrificed fairness for the sake of certainty. *Brown* made a valid argument when stating that the first prong is rigid and inflexible.¹⁹⁹ The unyielding minimum standard not only creates an incredible hurdle for a plaintiff to overcome but also comes at the expense of the deceived consumer who spends money on a product, mistakenly believing that the celebrity endorsed it. All the artist needs to do is provide some semblance of artistic relevance, and the use of the trademark or identifying material is in the clear, regardless of the reasoning behind consumer purchases.²⁰⁰ Both consumers and the celebrity are therefore exploited for financial gain.

The court in *Brown* fails to recognize that it is still forced to engage in more than a black-and-white artistic analysis, which it claims to be avoiding.²⁰¹ Though the analysis under the relevancy prong may be less time consuming than the transformative use test, it still requires the court to decipher a reason

¹⁹⁶ See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

¹⁹⁷ See *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241–43 (9th Cir. 2013); see also *Rogers*, 875 F.2d at 999.

¹⁹⁸ See *Brown*, 724 F.3d at 1243.

¹⁹⁹ See *id.* at 1244–45.

²⁰⁰ See *id.* at 1241–43.

²⁰¹ See *id.* at 1243.

as to why the celebrity's likeness was artistically relevant to the work.²⁰² The Ninth Circuit thus uses a standard that makes it extremely difficult for a celebrity to succeed, and the court is willing to accept any plausible reason for the use of the celebrity's likeness, whether or not this was the artist's actual reason. The court turns a blind eye, despite the fact that a celebrity's likeness could be "appropriated solely because of the vastly increased marketing power of a product bearing the name of [the celebrity]" and merely conjures up a reason that the court feels would support the use.²⁰³ The relevancy prong therefore overly favors the interest in free expression and does not provide the clear-cut guidance and omission of analysis that the court believes it does. However, it is the second prong of the *Rogers* test that is most troubling.

The Ninth Circuit's interpretation of the second, "explicitly misleading," prong permits consumers to mistakenly believe that a celebrity endorsed a product so long as the artist implicitly suggests this within the art, rather than explicitly on the packaging of the art.²⁰⁴ In *Brown*, the court noted that the slight risk of consumer confusion due to the use of a celebrity's likeness does not satisfy the prong, providing no support in favor of Lanham Act interests for anything within the videogame that could implicitly mislead consumers.²⁰⁵ The Ninth Circuit noted that the explicitly misleading prong gets at the heart of trademark law, which is to avoid consumer confusion and tricking consumers into buying a product because they believe that the celebrity endorsed that product.²⁰⁶ The court therefore stated that the crucial question under this prong was "whether there was an 'explicit indication,' 'overt claim,' or 'explicit misstatement' that caused . . . consumer confusion."²⁰⁷

Brown offered up a consumer survey that indicated that a majority of the public thought that identifying marks could not be incorporated in products without the trademark holder's permission.²⁰⁸ Yet, the court held that the use of a trademark or identifying material plus a survey showing that the consumers of the game thought that *Brown* endorsed the game was not enough

²⁰² See *id.* The court engaged in this analysis when determining that the reason why *Brown*'s likeness was artistically relevant was due to EA's focus on having extremely realistic videogames.

²⁰³ *Id.* at 1243-44 (alteration in original) (quoting *Parks v. Laface Records*, 329 F.3d 437, 454 (6th Cir. 2003)) (internal quotation marks omitted).

²⁰⁴ See *id.* at 1245-47.

²⁰⁵ See *id.* at 1245.

²⁰⁶ *Id.*

²⁰⁷ *Id.* (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989)).

²⁰⁸ *Id.*

to meet the explicitly misleading standard.²⁰⁹ The court noted that the survey results at most indicated that some members of the public would believe that Brown had some connection with the game, and the First Amendment interest in free expression outweighed this risk of consumer misunderstanding.²¹⁰ The consumer confusion demonstrated in this circumstance was not sufficient for the Ninth Circuit because the misunderstanding was not provoked by an explicit indication on the face of the work.²¹¹ The focus of the explicitly misleading prong therefore looks to the behavior of the user of the identifying material—in *Brown* the user was EA—and not to the impact of the use of the identifying material.²¹² Essentially, this standard allows artists to use a celebrity’s likeness and reap benefits because of consumers’ belief that the celebrity is in some way involved with the product. Since there was no statement on the box of the videogame that Brown in some way endorsed the game, the artist was able to get away with confusing the consumer, and the survey data was ignored.²¹³

According to the Ninth Circuit, the explicitly misleading prong of the *Rogers* test fundamentally stands for the proposition that unless a statement appears on the cover of the game in writing, then the interest in free expression will outweigh Lanham Act interests.²¹⁴ The Ninth Circuit admitted that an oral statement concerning celebrity affiliation with the product is not enough and, even worse, that “[i]f a similar statement appeared on the back cover of a version of *Madden NFL*, that *might* satisfy the ‘explicitly misleading’ prong.”²¹⁵ It logically follows that the Ninth Circuit would say that even if there is an explicit statement on the cover of the game discussing a celebrity’s affiliation with the game, this explicit statement is potentially insufficient to satisfy the second prong of the test.²¹⁶ The court’s use of the language “might,” rather than a definitive, clear-cut “will,” shows just how high the burden of

²⁰⁹ *Id.* at 1245–46.

²¹⁰ *See id.* at 1246.

²¹¹ *Id.*

²¹² *Id.* Other circuit courts of appeals have engaged in similar reasoning. For example, in *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915 (6th Cir. 2003), over 60% of survey participants answered yes when asked if they thought Tiger Woods was connected with artwork that the participants were shown, which depicted the famous professional golfer. *Id.* at 937 n.19. The Sixth Circuit held that the survey evidence at most indicated that some people would incorrectly believe that Woods was somehow connected with the work, and this risk of misunderstanding, not provoked by any explicit indication on the face of the work, was outweighed by the First Amendment interest in free expression. *Id.* at 937.

²¹³ *See Brown*, 724 F.3d at 1246.

²¹⁴ *See id.* at 1247.

²¹⁵ *Id.* (emphasis added).

²¹⁶ *See id.*

satisfying the second prong is and how the *Rogers* test overly and unfairly favors the First Amendment interest in free speech.

If the purpose of Section 43(a) of the Lanham Act is to protect against consumer confusion,²¹⁷ the court in *Brown* appears to have gotten caught up in defining and expanding the scope of meaningless language, while losing sight of the reason why Section 43(a) was created in the first place. A consumer survey demonstrating that a majority of the public believed that Brown was in some way affiliated with the videogame should hold weight if the Ninth Circuit wants to shield consumers from endorsement confusion.²¹⁸ The Ninth Circuit's employment of the second prong, requiring the misleading or confusing aspect of the product to be explicit, has therefore given artists free reign to use a celebrity's likeness as they please, as long as the product's packaging does not plainly state that the celebrity endorses the product.²¹⁹ Focus on the consumer has been lost, and so the Ninth Circuit should be employing a test that properly addresses the focus of Section 43(a), taking both implicitly misleading, as well as explicitly confusing, aspects of a product into consideration.

B. Critique of the Transformative Use Test

Keller illuminates the superiority of the transformative use test and the benefits that the test could provide when evaluating a false endorsement claim because the test requires more than above-zero artistic relevance and only protects expressive works that communicate new messages or ideas.²²⁰ However, the test has its shortcomings and does not sufficiently take consumers' interests into consideration.

The transformative use test, in its attempt to balance the right of publicity against the rights preserved in the First Amendment, centers on the artist adding significant creative elements in the expressive work in such a way that the artist transforms the trademark or identifying material into something more

²¹⁷ See, e.g., GOLDSTEIN & REESE, *supra* note 11, at 168.

²¹⁸ See *Brown*, 724 F.3d at 1245–46.

²¹⁹ See Thomas M. Byron, *Spelling Confusion: Implications of the Ninth Circuit's View of the "Explicitly Misleading" Prong of the Rogers Test*, 19 J. INTEL. PROP. L. 1, 10 (2011) (discussing how the Ninth Circuit's interpretation of the explicitly misleading prong protects trademark holders only for explicit, and not implicit, misleading uses of the trademark in the artistic work).

²²⁰ See *Keller*, 724 F.3d 1268 (9th Cir. 2013); Wesley W. Wintermyer, Note, *Who Framed Rogers v. Grimaldi?: What Protects Trademark Holders Against First Amendment Immunity For Video Games?*, 64 ALA. L. REV. 1243, 1261 (2013) ("[T]he transformative-use test should be the standard to which trademarks appearing in video games are held.")

than just the celebrity's likeness.²²¹ The transformative requirement calls for a level of artistic relevance that is not merely above zero, and therefore the hurdle for the artist to overcome is greater than that in the *Rogers* test.²²² The transformative use test is fair in the sense that the judge must perform more of a gatekeeping role and take a more detailed look into what the artist has added to the elements of the expressive work, rather than simply accepting any arbitrary reason as to why the use of the celebrity's likeness is relevant.²²³

The court in *Rogers* noted that right of publicity recognizes the need to accommodate First Amendment concerns more than in Lanham Act cases.²²⁴ However, case law and a comparison of *Brown* and *Keller* suggest that the exact opposite is true.²²⁵ The court in *Rogers* reasoned that the scope of the right of publicity was "potentially more expansive," and so courts were more likely to favor free expression concerns when making a decision.²²⁶ While the *Rogers* test has overly weighted the First Amendment, the transformative use test has found a more appropriate balance.

The Ninth Circuit explained that an artist's expressive work will be accorded First Amendment protection when sufficient transformative elements have altered the use of the celebrity's likeness to be something more than just an imitation of the celebrity's persona.²²⁷ By examining the five factors provided by *Comedy III*, a court can more fairly determine which interests should prevail, and therefore the interests of both the artist and the celebrity are taken into account.²²⁸ The artist is protected because if the expressive work created is transformative, then the interest in free expression will prevail.²²⁹ However, if the artist's "skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to exploit his or her fame," the celebrity's interest will prevail and the celebrity will be able to preserve his or her economic interest in his or her persona.²³⁰ The transformative use test therefore solves many of the shortcomings of the

²²¹ *Keller*, 724 F.3d at 1273.

²²² *See id.*

²²³ *See id.* at 1274 (explaining the five factors set out in *Comedy III*).

²²⁴ *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989).

²²⁵ *See supra* Part III.

²²⁶ *See Rogers*, 875 F.2d at 1004.

²²⁷ *See Keller*, 724 F.3d at 1274.

²²⁸ *Id.*; *see also supra* notes 129–35 and accompanying text.

²²⁹ *Keller*, 724 F.3d at 1274.

²³⁰ *Id.* (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001)) (internal quotation mark omitted).

Rogers test in that it provides a greater level of fairness, provides more of a balance of interests, and actually gets at the heart of what the body of law is trying to protect in right of publicity claims.

EA's argument that the court should apply the *Rogers* test to evaluate right of publicity claims²³¹ highlights that there is a need for clarity and uniformity in evaluating claims involving the unauthorized use of a celebrity's likeness. Unfortunately, the transformative use test alone does not solve the Ninth Circuit's problem in finding a suitable test to apply.

The lack of federal right of publicity protection creates issues. While the transformative use test is better than the *Rogers* test, courts in different states may assess the right differently,²³² and even judges within the same court may apply the transformative use test differently,²³³ indicating that clarity is lacking for right of publicity claims. *Zacchini* did not provide enough guidance to create unity across courts, and so the lack of a federal right of publicity may lead to issues such as forum shopping.²³⁴

Thus, bringing a right of publicity claim and applying the transformative use test isn't sufficient on its own to provide a means of assessing the use of a celebrity's likeness. In addition to concerns of forum shopping²³⁵ and disuniformity, there is another crucial shortcoming of the transformative use test. The main reason why the transformative use test cannot be adopted as the test in false endorsement claims, therefore making up for the lack of a federal right of publicity, is that the test leaves out one very important party: the consumer.²³⁶ Therefore, courts need to use a new test in order to evaluate false

²³¹ See *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239, 1241–43 (9th Cir. 2013).

²³² Compare *Comedy III*, 21 P.3d at 799 (California court assessment of the right of publicity), with *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989) (New York court assessment of the right of publicity).

²³³ See, e.g., *Keller*, 724 F.3d at 1284 (Thomas, J., dissenting); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 938, 956–58 (6th Cir. 2003) (Clay, J., dissenting) (arguing that the artistic work that had Tiger Woods in it was not transformative).

²³⁴ See *supra* note 128 and accompanying text (discussing the uncertainty created by the Supreme Court's analysis in *Zacchini*). As discussed in Part I.C, differing right of publicity law among states means that various states may, and do, decide right of publicity cases differently. See *supra* note 59 and accompanying text. Because of these differences, a plaintiff may bring suit in California rather than New York because of California's strong right of publicity.

²³⁵ Kevin L. Vick & Jean-Paul Jassy, *Why a Federal Right of Publicity Statute Is Necessary*, COMM. LAW., Aug. 2011, at 14, 16. (“The patchwork of right of publicity laws encourages forum shopping by plaintiffs. . . . Indiana is a good example. In 2005, the estate of Marilyn Monroe sued a photography archive and a licensing company in Indiana for allegedly violating the actress's postmortem right of publicity under Indiana law, despite the fact that Monroe had little or no connection with Indiana during her life.”)

²³⁶ See 5 MCCARTHY, *supra* note 13, § 28:7.

endorsement claims and provide more uniformity across use-of-likeness claims. The new test would allow for the interests of all of the parties to be balanced, and a celebrity would therefore be able to bring a claim under Section 43(a), potentially alleviating the downfalls of not having a federal right of publicity.

C. *The Likelihood of Confusion Test*

Brown argued that the likelihood of confusion test was relevant to analyze his false endorsement claim.²³⁷ The Ninth Circuit rejected this argument, stating that the *Rogers* test was the appropriate test to apply because the likelihood of confusion test does not sufficiently account for First Amendment interests.²³⁸

The Ninth Circuit previously employed the likelihood of confusion test when evaluating consumer confusion in false endorsement claims.²³⁹ The court looked at eight nonexclusive factors in determining whether a likelihood of consumer confusion existed.²⁴⁰ First, the court assessed the strength of the trademark in order to determine how much protection the mark should be afforded.²⁴¹ The court determined where on a distinctiveness hierarchy a mark fell, and the more inherently distinctive the mark was, the more protection it was given.²⁴² The second factor of the test is the proximity of the goods to one another.²⁴³ When goods are related, consumers may mistakenly believe that there is endorsement or association of the related goods to one another.²⁴⁴ For example, if there was a sock line that only produced socks with red soles, there

²³⁷ *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1242 (9th Cir. 2013).

²³⁸ *Id.*

²³⁹ *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1111 (9th Cir. 1992); *cf. Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403 (9th Cir. 1997); *AMF Inc., v. Sleekcraft Boats*, 599 F.2d 341, 347–49 (9th Cir. 1979).

²⁴⁰ *AMF*, 599 F.2d at 348–49.

²⁴¹ *Id.* at 349. The strength of a trademark is determined by assessing where on a distinctiveness hierarchy the trademark falls. From least to most distinctive, a potential trademark may be classified as “(1) generic, (2) descriptive, (3) suggestive, . . . (4) arbitrary or [(5)] fanciful.” *Union Nat’l Bank of Tex., Laredo, Tex. v. Union Nat’l Bank of Tex., Austin, Tex.*, 909 F.2d 839, 844 (5th Cir. 1990).

²⁴² *AMF*, 599 F.2d at 349. For example, Google was a term that did not exist and was created for the purpose of being a trademark. Google is therefore a fanciful term that is afforded the highest protection based on its distinctiveness. On the other end of the spectrum, generic terms are those that are so fundamental that use of the term is given to the public and cannot be protected. *See, e.g., King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 579 (2d Cir. 1963) (explaining that “thermos” was a fanciful term that became generic due to “extraordinary efforts” to make the public aware of the mark).

²⁴³ *AMF*, 599 F.2d at 350.

²⁴⁴ *Id.*

may be consumers who mistakenly believe that those socks are produced by Louboutin, based on the close relationship between socks and shoes.²⁴⁵ When goods are complementary, there is a lesser requirement of similarity between the marks.²⁴⁶

The second factor of the test interplays with the third, which is the similarity of the marks.²⁴⁷ In determining the similarity, the court looks at and compares the sight, sound, and meaning of the marks.²⁴⁸ To evaluate sight, sound, and meaning, survey evidence and expert testimony are admissible.²⁴⁹ Thus, a plaintiff will point to anything that is similar between the two marks, while a defendant will illuminate any difference.²⁵⁰ The fourth factor is evidence of actual confusion, which is the strongest indication that there is a likelihood of confusion.²⁵¹ Fifth is consideration of marketing channels—i.e., the channels of trade.²⁵² Under this factor, the court asks whether there is a possibility of overlap in the markets in which the marks are sold.²⁵³ The sixth factor is the type of goods and purchaser care.²⁵⁴ The analysis under this factor asks how expensive the goods are, what quality the goods have, and how sophisticated the purchasers are.²⁵⁵ When the goods are expensive and are only purchased by an expert purchaser, then the consumer is expected to use greater care in making his purchasing decision, and this will cut against a likelihood of confusion.²⁵⁶ The seventh factor is the intent of the alleged infringer.²⁵⁷ This factor considers whether the mark was adopted with the intent to deceive consumers.²⁵⁸ Lastly, the eighth factor is the likelihood of expansion, and “a ‘strong possibility’ that either party may expand his business to compete with

²⁴⁵ See *Behind the Rouge*, CHRISTIAN LOUBOUTIN, (Jan. 8, 2014), http://us.christianlouboutin.com/us_en/news/en_behind-the-rouge/ (showing that Louboutin shoes are known for having red soles).

²⁴⁶ *AMF*, 599 F.2d at 350.

²⁴⁷ *Id.*

²⁴⁸ *Id.* at 351.

²⁴⁹ See *id.* at 352. This differs from *Brown*, where the Ninth Circuit rejected consumer surveys as evidence that the videogame was explicitly misleading. *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013).

²⁵⁰ See *AMF*, 599 F.2d at 351.

²⁵¹ *Id.* at 352.

²⁵² *Id.* at 353.

²⁵³ See *id.*

²⁵⁴ *Id.*

²⁵⁵ *Id.*

²⁵⁶ *Id.*; see *In re N.A.D., Inc.*, 754 F.2d 996, 999–1000 (Fed. Cir. 1985) (explaining that anesthesia machines are expensive and are purchased by a more sophisticated purchaser, whereas cigarettes are inexpensive and require less purchasing investigation and thought).

²⁵⁷ *AMF*, 599 F.2d at 354.

²⁵⁸ *Id.*

the other will weigh in favor of finding that the present use is infringing.”²⁵⁹ The Ninth Circuit has noted that other factors may be part of the analysis depending on the facts of the case and that the eight factors do not set out a “mechanistic formula.”²⁶⁰ Nowhere in the analysis does the court explicitly ask about the artist’s interest in free expression.

The Ninth Circuit has created a classic Goldilocks scenario, with the likelihood of confusion test giving too little weight to First Amendment concerns and the *Rogers* test affording too much weight to those concerns. Now is the time to find a test that is “just right,” taking all interests adequately into account. The combination of applying the transformative use test, acting as a first step, with a modified likelihood of confusion test is the happy medium for which courts should strive for when evaluating false endorsement claims.

D. *The New Test*

When evaluating a Section 43(a) claim, courts should first apply the transformative use test. The court should apply the test to analyze the specific celebrity’s likeness or persona in question, rather than the artistic work as a whole.²⁶¹ If the artist did not add significant creative elements to the celebrity’s likeness in the expressive work, then the interest in free expression should take a backseat.²⁶² In that scenario, the celebrity’s identity has not been transformed and is merely a depiction of the celebrity’s likeness.²⁶³ The celebrity’s and consumers’ interests should be protected because the artist has not conveyed something new, and the artistic expression is therefore not worthy of First Amendment protection.

If the court finds that the artist did add significant creative elements, therefore transforming the celebrity’s identity, then the First Amendment interest in free expression is at its peak.²⁶⁴ The celebrity’s interest in his or her likeness is at a low because the artistic work is no longer just a mere portrayal

²⁵⁹ *Id.* (quoting RESTATEMENT (FIRST) OF TORTS § 731(b) & cmt. c (1938)).

²⁶⁰ *Dr. Seuss Enters., L.P. v. Penguin Books, USA, Inc.* 109 F.3d 1394, 1404 (9th Cir. 1997) (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. a (1995)).

²⁶¹ The Ninth Circuit adopted this approach in *Keller*, contrary to Judge Thomas’s dissenting opinion that the transformative use test should be applied to the entire artistic work. *See Keller*, 724 F.3d 1268, 1285 (9th Cir. 2013) (Thomas, J., dissenting).

²⁶² *See id.* at 1273 (majority opinion).

²⁶³ *See id.*

²⁶⁴ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001).

of the celebrity.²⁶⁵ Thus, the interest in protecting against consumer confusion is the last hurdle in the way of guarding freedom of speech. Since free expression is paramount at this stage,²⁶⁶ the court should apply a modified version of the likelihood of confusion test to adequately, but not overly, consider the purpose of Section 43(a), which is to protect consumers from confusion.

The Ninth Circuit stated that the eight factors previously used in the likelihood of confusion test were nonexclusive and could be shaped to the specific facts of the case.²⁶⁷ Since trademark protection has been expanded to include celebrities' identities, courts should look at specific significant factors when applying the test.²⁶⁸ The first factor courts should consider is the distinctiveness of the celebrity's identity to assess if the celebrity's image is strong enough to warrant protection. This factor is an alteration of the court's assessment of the strength of the mark. To do this, the court can look at the degree of the celebrity's fame. The more famous a celebrity is, the more likely it is that corporations would target the celebrity's likeness, causing consumers to mistakenly believe that the celebrity endorsed the product.²⁶⁹ In order to assess celebrity identity distinctiveness, expert opinions could be based in part on social media outlets such as Twitter and Facebook.²⁷⁰ Expert opinions and survey evidence could also look at the number of sponsors and endorsements the celebrity has. A celebrity's level of distinctiveness would be determined by comparing the specific celebrity in question to other celebrities who are famous in the same particular field. The more sponsors and endorsement deals the celebrity has, and the larger the celebrity's fan base, the more popular the

²⁶⁵ *Id.* at 799.

²⁶⁶ *Id.* at 808.

²⁶⁷ *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1404 (9th Cir. 1997).

²⁶⁸ 5 MCCARTHY, *supra* note 13, § 28:15; *see also supra* note 32 and accompanying text.

²⁶⁹ *See supra* notes 1–2, 24–30 and accompanying text.

²⁷⁰ *Compare Jim Brown*, FACEBOOK, <https://www.facebook.com/jimbrownofficial> (last visited Apr. 27, 2015) (showing that Jim Brown has more than 100,000 likes on Facebook), *with Kim Kardashian*, FACEBOOK, <https://www.facebook.com/kimkardashian> (last visited Apr. 27, 2015) (showing that Kim Kardashian has more than 24,000,000 likes on Facebook). While expert opinions can be costly, the cost won't be as detrimental to celebrities who seek to protect their likeness, compared to the cost for an average person. *Compare New York Yankees Salary/Payroll Information - 2015*, ESPN, http://espn.go.com/mlb/team/salaries/_name/nyy/new-york-yankees (last visited Apr. 27, 2015) (showing that New York Yankee CC Sabathia's 2015 salary is \$24,285,714), *with NAT'L EDUC. ASS'N, RANKINGS & ESTIMATES: RANKINGS OF THE STATES 2012 AND ESTIMATES OF SCHOOL STATISTICS 2013*, at 76 (2012), *available at* http://www.nea.org/assets/img/content/NEA_Rankings_And_Estimates-2013_%282%29.pdf (stating that the average U.S. classroom teacher's 2012–2013 salary is estimated to be \$56,383).

celebrity is and the more society is aware of the celebrity.²⁷¹ If a celebrity is known worldwide by persons of multiple segments of society, then that person's influence is pervasive and the mark is more distinctive.

For instance, Jay-Z tours worldwide and is known as a famous rapper in the music world by people of all ages.²⁷² Even a sports fan would recognize the name Jay-Z as a previous owner of the NBA team, the Brooklyn Nets.²⁷³ Unlike Jay-Z, Kelly Johnson is not as well-known. Johnson is currently a baseball player for the Atlanta Braves; however, far fewer people would recognize his name, and it is likely that only baseball fans would know who he is.²⁷⁴ Jay-Z's fame would be highly distinctive on the scale, while Kelly Johnson would be less distinctive on the fame hierarchy and his celebrity identity therefore weaker.

The degree of the celebrity's distinctiveness should be the first step in the analysis. The weaker the celebrity's identity, the less likely it is that consumers are going to be confused about celebrity endorsement. Though consumers may recognize the celebrity's likeness incorporated in the product, the celebrity with a weaker identity will not be the reason behind consumer purchases; therefore, free expression should be protected. The celebrity's level of distinctiveness should dictate whether free expression wins out or if the court should continue in its analysis.

The second key factor of the modified likelihood of confusion test is evidence of actual confusion, as this is the best indication that consumers incorrectly believe that the celebrity endorsed the product.²⁷⁵ A strong celebrity identity coupled with actual consumer confusion of celebrity endorsement, demonstrated by survey evidence and expert testimony, should result in

²⁷¹ See Andrew Barker, *Branding Deals With Pop Stars Go Beyond the Casual Endorsement*, VARIETY (Apr. 16, 2013, 8:15 AM PT), <http://variety.com/2013/music/features/endorsement-deals-1200334594/> ("When a flexible company and a brand-conscious artist see eye-to-eye, the results can be spectacular. One need look no further than 50 Cent's deal with Vitamin Water . . .").

²⁷² See Mikael Wood, *It's Good to be King: Jay Z Exercises His Power in a Swaggering Show at Staples*, L.A. TIMES, Dec. 11, 2013, at D1, available at <http://articles.latimes.com/2013/dec/10/entertainment/la-et-ms-review-jay-z-magna-carter-world-tour-staples-center-20131210> ("Jay Z, the king of hip-hop . . . brought his Magna Carter World Tour to a full house of loyal subjects.").

²⁷³ See Mike Ozanian, *Jay Z Sells Piece of Nets for Second-Highest Price in NBA History*, FORBES (Sept. 6, 2013, 11:05 AM), <http://www.forbes.com/sites/mikeozanian/2013/09/06/jay-z-sells-piece-of-nets-for-second-highest-price-in-nba-history/>.

²⁷⁴ See *Kelly Johnson*, FOX SPORTS, <http://www.foxsports.com/mlb/kelly-johnson-player> (last visited Apr. 27, 2015).

²⁷⁵ See *AMF Inc., v. Sleekcraft Boats*, 599 F.2d 341, 352 (9th Cir. 1979).

consumers' interests outweighing the interest in free expression. In this scenario, the celebrity's influence is at an all-time high, and consumer confusion will dictate that the court hold in favor of the plaintiff.

The final factor courts should look at is the artist's intent when using the celebrity's likeness. Without a finding of actual confusion, the court should look at whether the artist intended to deceive consumers to derive financial gain. A finding of intent coupled with a strong celebrity identity is the second scenario in which the court should find in favor of Section 43(a) interests because the artist specifically chose to confuse consumers into believing that the celebrity endorsed the product.²⁷⁶ If there is no actual confusion or intent coupled with a strong celebrity identity, then the balance should weigh in favor of free expression.

The modified test consists of a more concise means for assessing whether there is a likelihood of consumer confusion about celebrity endorsement of the artist's product. If there is not a likelihood of consumer confusion, then there is no infringement, and the court can stop in its analysis, allowing the interest in free expression to prevail. Therefore, in order for Section 43(a) interests to triumph, there are still high hurdles for the plaintiff to overcome, but inquiry into these three key factors at least provides the court an opportunity to take survey evidence and arguments such as *Brown's* into account.²⁷⁷

Some may argue that this is a lot of analysis for the court to engage in, which is why the court rejected the likelihood of confusion test in favor of the *Rogers* test.²⁷⁸ However, the Ninth Circuit recognized that "when expressive works are involved," "First Amendment rights are at their height."²⁷⁹ Therefore it is appropriate for the court to take more than a quick look at whether the artistic relevance of the celebrity's likeness is above zero.²⁸⁰ The Ninth Circuit was correct in stating that "a balance need not be designed to find each of the sides weightier with equal frequency."²⁸¹ The interest in free expression should be given more weight, but it should not completely obliterate the opportunity for countervailing interests to shine through. The combination of the transformative use test and the modified likelihood of confusion test provides

²⁷⁶ See *id.* at 354 ("[R]eviewing courts presume that the defendant can accomplish his purpose . . .").

²⁷⁷ See generally *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245–46 (9th Cir. 2013) (rejecting survey evidence in applying the *Rogers* test).

²⁷⁸ See *id.* at 1241–42.

²⁷⁹ *Id.* at 1245.

²⁸⁰ *Cf. id.* at 1244.

²⁸¹ *Id.* at 1245.

multiple opportunities for the First Amendment interest to come out on top without smothering all other interests. Judge Kozinski made a valid point when stating, “Intellectual property rights aren’t free: They’re imposed at the expense of future creators and of the public at large.”²⁸² The proposed dual-part test alleviates some of Judge Kozinski’s concerns by providing a more flexible and fair analysis, taking all parties’ interests into consideration while still favoring free expression.

Critics may be concerned that the proposed test requires judges to determine what constitutes artistic work. However, when a court initially applies the transformative use test, the judge is not required to make aesthetic decisions. Rather, the court merely needs to determine whether or not the artist communicated something new by looking at the differences between the artistic expression and the specific likeness or persona in question.²⁸³ The court would provide free expression protection to work that provides a new message or idea to society, therefore preventing governmental interests from silencing speech.²⁸⁴ While the transformative use test may require more than a cut-and-dry question of relevance, the court’s analysis is not much more complicated than when applying the *Rogers* test. As long as the artist points to transformative attributes of the work, the artistic expression will be protected.²⁸⁵

E. Application of the Proposed Test to Brown

If the Ninth Circuit applied the proposed, novel test in *Brown*, the holdings of *Brown* and *Keller* would match up. The court would first apply the transformative use test and evaluate whether EA added enough significant creative elements to Brown’s avatar in the videogame. In *Keller*, the Ninth Circuit looked specifically at Keller’s avatar to determine whether EA had transformed the avatar into something more than the mere image of Keller.²⁸⁶ The court held that the avatar was not transformed into something more than Keller’s likeness such that the artistic work merited free expression protection.²⁸⁷ The Ninth Circuit would find that EA’s avatar of Brown fails the

²⁸² *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1516 (9th Cir. 1993) (Kozinski, J., dissenting).

²⁸³ *See Keller*, 724 F.3d 1268, 1273 (9th Cir. 2013) (explaining that the transformative use test requires the artist to transform the expression into something more than an imitation of the celebrity’s likeness).

²⁸⁴ *See Brown v. Entm’t Merchs. Ass’n*, 131 S. Ct. 2729, 2733 (2011).

²⁸⁵ *See Keller*, 724 F.3d at 1273 (explaining that the transformative use test is a defense in a right of publicity claim).

²⁸⁶ *Id.* at 1276.

²⁸⁷ *See id.*

transformative use test because the facts of *Keller* and *Brown* are so similar.²⁸⁸ *Brown*'s avatar is a mere depiction of *Brown* playing football, which is what he is famous for doing.²⁸⁹ Since *Brown*'s avatar would fail the transformative use test, the court would stop in its analysis and would hold that *Brown*'s and consumers' interests outweigh the interest in free expression.

EA could have added significant creative elements to the avatar like Sega did to the avatar of Keirin Kirby in *Kirby v. Sega of America, Inc.*²⁹⁰ Rather than using *Brown*'s exact playing position, age, height, weight, ability levels, and team affiliation, EA could have tweaked the avatar to play different positions at different ability levels.²⁹¹ The avatar's ability level could fluctuate depending on how much the videogame user had the avatar practice. EA could have provided the option of changing *Brown*'s physical features such as lengthening his hair, adding tattoos, or making him more or less muscular. Additionally, there could be special features added, such as giving the avatar super speed if the avatar performed specific moves like scoring a particular number of touchdowns. Although EA changed the avatar's jersey number from thirty-two to thirty-seven in particular versions of the game,²⁹² the Ninth Circuit would find that this minor change is not a significant creative element meriting free expression protection. The suggested alterations would weigh towards the court finding that the avatar was transformed because the avatar would no longer be a replica of *Brown*. It was EA's emphasis on realism that should have lead the Ninth Circuit to conclude that the avatar was a literal depiction of *Brown* not warranting free expression protection.²⁹³

EA needed to make a choice between extreme realism and providing a spectrum of avatars from current players to retirees. Choosing realism would not cause a great disturbance to EA's vision because EA has licensing agreements with the NFL and the NFL Players Association, which allow EA to

²⁸⁸ See *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1240 (9th Cir. 2013).

²⁸⁹ *Id.*; see *Keller*, 724 F.3d at 1276.

²⁹⁰ 50 Cal. Rptr. 3d 607, 613 (Ct. App. 2006). Kirby brought claims alleging that a videogame avatar violated her right of publicity and the Lanham Act. *Id.* at 611. The California Court of Appeals explained that while the avatar and Kirby had many similarities, including both having similarly shaped eyes and faces, having red or pink hair, and using phrases such as "meow," the avatar also differed from Kirby in significant ways. *Id.* at 613. The avatar wore her hair in different styles than Kirby and was seen most often wearing a specific outfit in the game that was different from what Kirby often wore. *Id.* The court held that the avatar was not a literal depiction of Kirby and the interest in free expression prevailed. *Id.* at 618; see also *supra* note 185.

²⁹¹ See *Brown*, 724 F.3d at 1240.

²⁹² *Id.* at 1246.

²⁹³ See *id.* at 1243.

create avatars representing current NFL players.²⁹⁴ If EA felt that realism was of the utmost importance, then the videogame series should have only incorporated NFL players covered by the licensing agreements. However, if EA felt that it was important to provide a spectrum of players, EA should have added significant creative elements to the avatars not covered by the agreements. If EA had transformed Brown's avatar into something more than a reproduction of Brown by making some of the suggested alterations, then the interest in free expression would be paramount and the Ninth Circuit would need to take the next step in its analysis.

Had EA transformed Brown's avatar, the court would next apply the modified likelihood of confusion test, first looking at the distinctiveness of Brown's celebrity identity. Brown is a member of the NFL Hall of Fame and earned league most valuable player (MVP) honors four times in his career.²⁹⁵ He has been coined a "one-of-a-kind running back" and a Jim Brown autographed football currently sells for around \$470.²⁹⁶ Brown also has an acting career, playing roles such as a coach in *Any Given Sunday*²⁹⁷ and starring in the 2002 Spike Lee documentary *Jim Brown: All-American*.²⁹⁸ He is a social activist for African American causes and has more than 100,000 likes on Facebook.²⁹⁹ To figure out the strength of Brown's celebrity identity, the court could compare Brown to other famous football players. Peyton Manning is considered one of the greatest quarterbacks of all time and has been named the NFL's MVP five times.³⁰⁰ Fox Sports and *Sports Illustrated* have named Manning the NFL player of the decade for the 2000s.³⁰¹ Manning has appeared in television commercials for DirecTV and was a guest host on *Saturday Night*

²⁹⁴ *Id.* at 1240.

²⁹⁵ *Jim Brown*, PRO FOOTBALL HALL OF FAME, http://www.profootballhof.com/hof/member.aspx?PLAYER_ID=33 (last visited Apr. 27, 2015).

²⁹⁶ *Jim Brown Autographed Football*, PRO FOOTBALL HALL OF FAME STORE, http://store.profootballhof.com/Jim-Brown-Autographed-Football.aspx?DepartmentId=94&F_PlayerId=864 (last visited Apr. 27, 2015).

²⁹⁷ *Any Given Sunday—Full Cast & Crew*, IMDB MOVIES, http://www.imdb.com/title/tt0146838/fullcredits?ref_=tt_ov_st_sm (last visited Apr. 27, 2015) (showing that Jim Brown played Montezuma Monroe in the film *Any Given Sunday*).

²⁹⁸ *Jim Brown: All American*, IMDB MOVIES, <http://www.imdb.com/title/tt0309735/> (last visited Apr. 27, 2015).

²⁹⁹ *Jim Brown*, *supra* note 270.

³⁰⁰ *About Peyton Manning*, FACEBOOK, <https://www.facebook.com/pages/Peyton-Manning/109563725729117?rf=109929785696723#> (last visited Apr. 27, 2015) (explaining Peyton Manning's biography).

³⁰¹ *Id.*

Live.³⁰² An autographed Manning football sells for as much as \$750,³⁰³ and he currently has approximately 2 million likes on Facebook.³⁰⁴ Brown's background information regarding his fame is fairly similar to Peyton Manning's, and Brown is also known outside of the sports arena for his acting and social activism.³⁰⁵ Therefore, Brown's identity is arguably high on the distinctiveness scale, such that when consumers hear the name "Jim Brown," the name evokes images of Brown specifically in consumers' minds, rather than an image of another individual named Jim Brown.

Since Brown has a strong celebrity identity, the court should then evaluate whether there was actual consumer confusion that Brown endorsed the videogame. Brown submitted a survey to the court, which showed that a majority of the public believes that identifying marks cannot be part of products unless the mark holder granted permission to the product creator.³⁰⁶ While this survey evidence aids Brown's argument supporting actual confusion, more information would need to be elicited, such as if consumers actually believed that Brown endorsed the specific EA videogame series in question. Moreover, *Brown's* facts do not indicate that EA intentionally tried to deceive consumers into mistakenly believing that Brown endorsed the videogame.³⁰⁷ Without showing actual confusion or intent, the strength of Brown's identity is not enough for the Ninth Circuit to find a likelihood of confusion. Thus, if EA added significant creative elements to Brown's avatar, the court would find in favor of free expression.

Applying the proposed test to *Brown* demonstrates that the new test still elevates the interest in free expression above the countervailing interests. The Ninth Circuit should continue to place a thumb on the scale in favor of protecting free expression; however, the new test allows for a more thorough consideration of the celebrity's and consumers' interests. A celebrity, like

³⁰² *Id.* ("The [SNL] episode earned the show's highest household rating in more than 10 months in the metered markets."); see Ralph Vacchiano, Ebenezer Samuel & Chris Dell, *Video: Eli and Peyton Manning Rap Their Way Through a New Commercial for DirecTV's Sunday Ticket*, N.Y. DAILY NEWS (Aug. 6, 2013, 3:04 PM), <http://www.nydailynews.com/sports/football/video-eli-peyton-show-rapping-skills-article-1.1419150>; *SNL Digital Short: United Way*, NBC, <http://www.nbc.com/saturday-night-live/video/united-way/n12129/> (last visited Apr. 27, 2015).

³⁰³ *Peyton Manning Autographed Footballs*, SPORTS MEMORABILIA, http://www.sportsmemorabilia.com/player/Peyton_Manning/autographed-footballs/ (last visited Apr. 27, 2015).

³⁰⁴ *About Peyton Manning*, *supra* note 300.

³⁰⁵ See *Jim Brown Biography*, BIO., <http://www.biography.com/people/jim-brown-9228484> (last visited Apr. 27, 2015).

³⁰⁶ *Brown v. Elec. Arts Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013).

³⁰⁷ *Id.* at 1246.

Brown, can therefore bring a false endorsement claim without having the interest in free speech oppress the interest in protecting against consumer confusion. Further, a celebrity can feel more comfortable bringing a false endorsement claim rather than strategically bringing a right of publicity claim in a more favorable jurisdiction. Lastly, the new test still favors the artist, and the artist merely needs to transform the artistic work to communicate something new, which can be as simple as changing particular features of a celebrity so that the expression is not just an imitation of the celebrity.

CONCLUSION

The more famous a person is the more potential influence that celebrity's likeness has over consumers in society. T.F. Hodge said it best when stating, "Thirsty Celebrity: Many moons in the making, few seconds for the taking."³⁰⁸ The right of publicity does not provide a sufficient forum for use-of-likeness claims due to the absence of a federal right. Although the Lanham Act provides a federal means for a plaintiff to bring a use-of-likeness claim, the Ninth Circuit currently applies a test that overly favors the interest in free expression, squelching the interest in protecting against consumer confusion and not considering the celebrity's interest in his or her own identity. The Ninth Circuit and other courts should instead use the proposed novel test to evaluate false endorsement claims falling under the Lanham Act. The new test acts as a check on unjust enrichment and promotes creativity, while continuing to hold a candle to the interest in free expression. The court is the referee and, just like in a football game, the foul needs to be called and opportunity given to the fouled party to remedy the situation. This is not to say that the game should end in favor of the fouled party, but the favored interest should not nullify other considerations. The proposed test takes all parties'

³⁰⁸ 'GOoD' *Quotes from Within* by T.F. Hodge, LIVING THE 'GOOD' LIFE!, <http://webcache.googleusercontent.com/search?q=cache:http://fromwithindirise.webs.com/quotesbytfhodge.htm> (last visited Apr. 27, 2015 using Google's cache webpages).

interests into account and assuages the need for a federal right of publicity. The whistle needs to be blown, and the Ninth Circuit and other courts should make the call using the new proposed test.

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