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PART I RIGHT OF PUBLICITY

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INTRODUCTION

It has been a few years since the MLRC last gave the right of publicity an in-depth look. Since then, one might have expected that the courts would have gotten their arms around this area of law. But, instead, right of publicity is going through its version of the cosmic Big Bang, with an ever-expanding universe of theories of liability and defense, wildly divergent attempts to fix appropriate remedies once liability has been found, the continuing migration of the right from a privacy-based to a property-based tort, with many courts not appreciating the difference, and recent efforts to include under its increasingly broad umbrella not just living plaintiffs, but also long dead and non-individual, corporate plaintiffs. The majority of states have now jumped on the right of publicity bandwagon, but the case law reflects little uniformity and a lot of individuality in how each state's courts examine a publicity claim.

The right of publicity had its origins in privacy theories, as articulated by Dean Prosser, that protected an individual's right to be left alone and to not have his or her name or likeness appropriated for someone else's advantage. But the cases are now moving far beyond such humble beginnings.

Lincoln D. Bandlow (Lathrop & Gage LLP) provides a very useful analysis of all of the increasingly creative theories that plaintiffs are using to try to defeat a defendant's First Amendment defense, including misreading the Supreme Court's *Zacchini v. Scripps Howard Broadcasting Co.* opinion, assertions that mere "entertainment" is not worthy of First Amendment protection, assertions that any business operating for a profit-based motive should not be permitted to use the First Amendment, misstatement of what is protected parody, comment or criticism, and misapplication of the likelihood of confusion factors under the LANHAM ACT in the false endorsement context.

Timothy L. Alger (Deputy General Counsel, Litigation, Google) examines cases where courts have now included an actual malice requirement in the right of publicity context, particularly where there is some assertion of falsity, and cases where courts refuse to import that standard. He illustrates the strengths and weaknesses of the transformative use test first announced in California and shows how it is particularly unpredictable, and how some courts are following it while others reject it. He also provides an in-depth analysis of how cases go astray when courts try to turn the right of publicity into something other than what it was intended to address, misread the Supreme Court's *Zacchini v. Scripps Howard Broadcasting Co.* opinion, or misapply First Amendment principles.

Benjamin Mulcahy (Sheppard Mullin Richter & Hampton LLP) analyzes cases following in the footsteps of *Montana v. San Jose Mercury News, Inc.*, *Cher v. Forum International, Ltd.*, and *Zacchini* that address whether using a person's persona to advertise another work that uses that person's persona in a protected manner is privileged. He then creates guidelines that can be used to help predict whether such uses will be protected when they appear in connection with today's quickly evolving media, such as the creation of virtual worlds and photo-realistic animation.

A.J. Thomas (David Wright Tremaine LLP) shows a sudden leap in the past year from protecting the quick to protecting the long dead under right of publicity theories. Recent

decisions denied licensees of Marilyn Monroe's name and likeness rights the ability to enforce postmortem rights, so celebrities have banded together to get legislation passed that not only looks forward to the deaths of celebrities, but also reaches back in time to give long dead celebrities rights that were not even in existence or recognized by the state when that celebrity died. In the forefront of that effort, Gov. Schwarzenegger has morphed from "The Terminator" to "The Reanimator," largely in recognition of the special interest group to which he belonged in California before he moved into the Governor's Mansion.

Stacy Allen (Jackson Walker LLP) examines how what used to be the right of an individual, natural person to stop the misappropriation of his or her persona is being asserted // beyond its origins in privacy law and expanding to include non-individuals. He discusses arguments over partnerships, corporations, and rock bands, who assert a collectivist identity in the group as opposed to its individual members, asserting right of publicity claims.

Bruce E.H. Johnson (Davis Wright Tremaine LLP) gives us a very detailed analysis of another hot new issue in the right of publicity arena—the immunity given to interactive computer services from publication-based tort claims based on posting actionable content provided by a third party. Such immunity is subject to an "intellectual property" exception if the challenged material constitutes "intellectual property." But a divergence of opinion has now developed, with the Ninth Circuit finding that the intellectual property exception to the immunity provision in Section 230(c)(1) of the COMMUNICATIONS DECENCY ACT applies only to federal intellectual property law, and that interactive computer services therefore are immune from state right of publicity claims, while a District Court in New Hampshire has expressly rejected that approach and found that the right of publicity is an "intellectual property" right and therefore subject to the exception to immunity. Bruce analyzes the historical underpinnings of the right of publicity tort and compares that history to the policies inherent in the protections given patents, copyrights, and trademarks to present a compelling argument as to why the right of publicity should not be considered a form of intellectual property.

Joel M. Smith (Leopold Petrich & Smith PC) looks at the courts' responses to plaintiffs' claims for monetary recovery, and finds that the courts are all over the map in determining how, if liability is found, one should compensate a plaintiff. The theories of recovery are as broad as the plaintiffs are creative. There is recovery for the fair market value of use of the plaintiff's persona, general damages arising from the plaintiff's loss of the ability to control how and where his or her persona is used, statutory damages in some states that recognize the difficulties in showing actual damage, disgorgement by the defendant of the benefit the plaintiff would have received but for the defendant's misappropriation, disgorgement of the profits the defendant would not have realized but for the misappropriation, disgorgement of only those profits realized that can be shown to be attributed to the unlawful use of the plaintiff's persona and not to other factors, the possible recovery of both damages *and* profits, punitive damages awards, and attorneys' fees awards. He illustrates the wildly divergent views of the courts with a thorough examination of the Taster's Choice coffee man case, *Christoff v. Nestlé USA, Inc.*

Finally, I did my best to determine whether a unified theory of right of publicity fair use defenses can be divined, but, after examining the transformative use test, the RESTATEMENT'S relatedness

test, Missouri's predominant use test, and the First Amendment *ad hoc* balancing test used in federal courts, I have to admit that no one-size-fits-all test can be found, nor should one be found. The transformative use, relatedness, and First Amendment balancing tests provide courts with a great deal of flexibility in addressing the myriad factual scenarios that come before them. But each has its strengths and weaknesses. In an effort to come up with additional tools that the courts might use to help find the appropriate constitutional balance between competing expressive and commercial interests, I suggest importing a couple of factors used in the copyright and trademark fair use tests into the right of publicity fair use mix.

If anything is certain, our culture will continue to be fascinated with all things celebrity, *TMZ.com* will spawn many imitators, there will be many more plaintiffs asserting right of publicity claims, and the Big Bang expansion of this area will continue for some time, with plaintiffs, courts, commentators, and legislators all doing their best to expand the scope of what will be included under the right of publicity umbrella and the legal theories that will need to be employed in order to try to make some sense of it.

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**BETWEEN CHER AND JOE MONTANA – WHEN IS IT OKAY TO USE
A PERSON’S IMAGE TO ADVERTISE A PROTECTED USE OF THAT IMAGE?**

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BETWEEN CHER AND JOE MONTANA – WHEN IS IT OKAY TO USE A PERSON’S IMAGE TO ADVERTISE A PROTECTED USE OF THAT IMAGE?

In deciding whether the unauthorized use of a third party’s name, voice, likeness or persona (collectively, “Image”) violates such third party’s publicity rights, the first level of inquiry is whether the use is properly categorized as a “commercial” or a “noncommercial” use. If an Image is used without permission in a noncommercial or “newsworthy” context, such use is generally protected so long as the Image used is reasonably related to the aspect of the use that makes it newsworthy and so long as less than the Image owner’s “entire act” is used.

Distinguishing between commercial and noncommercial uses is a context-specific inquiry, and describing the precedent on that issue is beyond the scope of this article. But where the underlying use is concededly noncommercial, such that permission does not need to be obtained from the person whose Image is depicted, this article addresses whether the Image can also be used to advertise or promote the underlying use without giving rise to a valid right of publicity claim by the person whose Image is depicted.

In the context of print publishing, it is well established that an Image originally published in one issue of a periodical as part of a newsworthy item (and therefore concededly protected) may be republished subsequently in another medium as an advertisement for the periodical itself (but not on or as an advertisement for a collateral commercial product), without the consent of the person whose Image is depicted, so long as the advertising does not falsely claim that such person is affiliated with or endorses the periodical.¹ Analogously, if a video documentary contains a protected use of a person’s Image, there is little question that an advertisement for the documentary containing a clip of that use would be permissible.²

One of the leading cases in this area is *Montana v. San Jose Mercury News, Inc.*,³ which held that the reproduction in poster form of actual newspaper pages containing plaintiff Joe Montana’s photograph and artist rendition of Montana’s likeness, and the subsequent sale of such posters, were protected by the First Amendment against Montana’s common law and statutory commercial misappropriation claims. Each of the newspaper pages had been reproduced in poster form within two weeks of its original printing in the newspaper and had been made available for sale to the general public. The defendant San Jose Mercury News had submitted undisputed evidence that it had sold the posters to advertise the quality and content of its newspaper. The posters were exact reproductions of pages from the paper. They contained no additional information not included on the newspaper pages themselves, and they did not state

¹ See, e.g., *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App.4th 790, 797 (Cal. Ct. App. 1995).

² *Dora v. Frontline Video*, 15 Cal. App. 4th 536, 544 (Cal. Ct. App. 1993); accord *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997) (dismissing publicity claim brought by Fred Astaire’s widow against distributor of instructional dance video featuring Astaire’s dancing performances [which video had been authorized by Astaire] based on distributor’s use of actual films clips of such performances in advertisements for the video itself), *opinion amended* 136 F.3d 1208 (9th Cir. 1998); *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal.3d 860 (Cal. 1979) (Bird, C.J., concurring) (holding that the context and nature of the defendant’s use of Valentino’s name and likeness in a fictional movie, even if created for financial gain, was protected by the constitutional right to free expression, and “Since the use of Valentino’s name and likeness in the film was not an actionable infringement of Valentino’s right of publicity, the use of his identity in advertisements for the film is similarly not actionable.”).

³ *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639 (1995).

or imply that Montana endorsed the newspaper. In holding such use to be protected, the court explained:

It is well established “a person’s photograph originally published in one issue of a periodical as a newsworthy subject (and therefore concededly exempt from the statutory prohibitions) may be republished subsequently in another medium as an advertisement for the periodical itself, illustrating the quality and content of the periodical, without the person’s written consent.”⁴

Citing precedent, the court then explained:

Constitutional protection extends to the truthful use of a public figure’s name and likeness in advertising which is merely an adjunct of the protected publication and promotes only the protected publication. Advertising to promote a news medium, accordingly, is not actionable under an appropriation of publicity theory so long as the advertising does not falsely claim that the public figure endorses that news medium.⁵

The protection given to using another’s Image to advertise or promote the concededly protected speech in which such Image appeared has been held not to extend to advertising that suggests or implies endorsement of the underlying use by the person whose Image is depicted. A case brought by Cher against a magazine publisher illustrates this principle.⁶ In that case, Cher was interviewed for an article that was originally intended for *US Magazine*. The article was published instead in *Forum* magazine, which used the interview (and Cher’s Image), along with copy that read “So take a tip from Cher and hundreds of thousands of other adventurous people and subscribe to Forum,” to advertise subscriptions to *Forum* magazine. Holding that the magazine had exceeded permissible boundaries, the U.S. Court of Appeals for the Ninth Circuit explained that “*Forum* would have been entitled to use Cher’s picture and to refer to her truthfully in subscription advertising for the purpose of indicating the content of the publication,”

⁴ *Id.* at 642 (quoting *Booth v. Curtis Publishing Company*, 223 N.Y.S. 2d 737 (1962)).

⁵ *Id.* at 642; accord *Namath v. Sports Illustrated*, 371 N.Y.S. 2d. 10 (1975) (dismissing with little discussion a publicity claim brought by Joe Namath, star quarterback of the New York Jets at the time, against Sports Illustrated, which had reported on the New York Jets’ 1969 Super Bowl victory, for using one of Namath’s action photos from its Super Bowl issue in subsequent advertisements in other magazines as promotional material for the sale of subscriptions to Sports Illustrated, holding that, where the use of an athlete’s photograph was merely incidental to advertising a magazine in which athlete had earlier been properly and fairly depicted, and language of the advertisement did not indicate athlete’s endorsement of the magazine, there is no invasion of the athlete’s right of privacy in violation of New York’s Civil Rights Law, citing to *Booth v. Curtis Publishing Co.*, 223 N.Y.S. 2d 737 (1962), in which it was written: “Consequently, it suffices here that so long as the reproduction was used to illustrate the quality and content of the periodical in which it originally appeared, the statute was not violated, albeit the reproduction appeared in other media for purposes of advertising the periodical.” Dissenting opinion argued that the case involved advertising use because the Namath advertisement included, in addition to the photograph, the heading, “The Man You Love Loves Joe Namath” and the heading “How To Get Close To Joe Namath,” seemingly trading on the name of the personality involved).

⁶ *Cher v. Forum Intern. Ltd.*, 692 F.2d 634 (9th Cir. 1982).

but “*Forum* falsely proclaimed to the readers of its advertising copy that Cher ‘tells *Forum*’ things that she ‘would never tell *US*,’” and such conduct is not protected.⁷

Although distinguishing between “commercial” and “noncommercial” underlying uses is beyond the scope of this article, there are at least theoretical limits even on the concededly noncommercial use of a person’s Image without authorization. To illustrate, what if a celebrity’s Image is used in set dressing for or as a character in a television show (for example, that iconic “red swimsuit” poster of Farrah Fawcett hanging on a teenager’s bedroom wall in a television series or a computer-generated image of a fictional character shaking hands in a movie with a real Nobel prize winner)? Using Farrah Fawcett’s Image in the television show and the Nobel prize winner’s Image in the movie is almost certainly “noncommercial”, and therefore, such uses are entitled to the full breadth of protection under the First Amendment.⁸ Nevertheless, do those uses ever give rise to a viable right of publicity claim? The United States Supreme Court has given some guidance on that issue in the only right of publicity case to be decided in the Court’s history - *Zacchini v. Scripps-Howard Broadcasting Co.*⁹

In *Zacchini*, a performer in a “human cannonball” act brought an action against a television broadcasting company to recover damages allegedly suffered when, against his wishes, the broadcasting company videotaped his entire performance and played the videotape on a television news program. The Ohio Supreme Court entered judgment in favor of the broadcasting company on the ground that it was constitutionally privileged to include matters of public interest in its newscast which otherwise would be protected by the right of publicity. On *certiorari*, the United States Supreme Court held that, although the State of Ohio might, as a matter of its own law, privilege the press under the circumstances of the case, the First and Fourteenth Amendments did not require it to do so. Recognizing the constitutional right to report on newsworthy events, the court read the plaintiff’s complaint as claiming something more:

If under this standard respondent had merely reported that petitioner was performing at the fair and described or commented on his act, with or without showing his picture on television, we would have a very different case. But petitioner is not contending that his appearance at the fair and his performance could not be reported by the press as newsworthy items. His complaint is that respondent filmed his entire act and displayed that film on television for the public to see and enjoy.¹⁰

Distinguishing between the appropriation of an entire act and the mere reporting of such performance, the Court explained:

It is evident, then there is no claim here to the contrary, that petitioner’s state-law right of publicity would not serve to prevent respondent from

⁷ *Id.* at 639.

⁸ *See, e.g., Time, Inc. v. Hill*, 385 U.S. 374, 397, 87 S.Ct. 534 (1967); *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal.3d 860 (Cal. 1979).

⁹ *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 97 S.Ct. 2849 (1977).

¹⁰ *Id.* at 2854.

reporting the newsworthy facts about petitioner's act. Wherever in the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments did not immunize the media when they broadcast a performer's entire act without his consent.¹¹

This decision should be kept in mind in the event any noncommercial use could arguably constitute taking a person's "entire act."

CONCLUSION

As virtual worlds and photo-realistic animation continue to evolve, the law on these issues will continue to search for controlling principles. The bedrock of that evolution, however, will be that an image originally used in a way that is concededly protected may be used as an advertisement for the underlying use without the consent of the person whose image is depicted, so long as the advertising does not falsely claim that such person endorses either the underlying use or the medium in which it was used. And the use of an image without permission in a noncommercial or "newsworthy" context is generally protected as long as the image used is reasonably related to the aspect of the use that makes it newsworthy and as long as less than the image owner's "entire act" is used.

¹¹ 433 U.S. at 574-75, 97 S.Ct. at 2857.

**FAIR USE AND THE RIGHT OF PUBLICITY:
A SEARCH FOR A MORE BALANCED APPROACH**

By Kent R. Raygor and Valerie E. Alter*

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FAIR USE AND THE RIGHT OF PUBLICITY: A SEARCH FOR A MORE BALANCED APPROACH

I. INTRODUCTION

When is it fair to use some part of a celebrity's persona in connection with a product, service, report, or other communication to the public? This is a question with which courts continue to struggle in trying to balance the public's right of free expression against celebrities' rights to control the commercial aspects of their persona.

Celebrities, for better or worse, play a larger-than-life role in the American public's collective psyche. They are not simply people who act in movies, make music, or play professional sports. They "are 'common points of reference for millions of individuals who may never interact with one another, but who share, by virtue of their participation in a mediated culture, a common experience and a collective memory.' Through their pervasive presence in the media, sports and entertainment celebrities come to symbolize certain ideas and values."¹

For example, when Nirvana lead singer Kurt Cobain committed suicide in 1994, "[t]he news came as a shock to millions of rock fans, and MTV pre-empted its usual programming for hours of J.F.K.-like mourning, with a somber Kurt Loder playing the Walter Cronkite role."² On a lighter note, when actors Brad Pitt and Jennifer Aniston divorced and Pitt began seeing Angelina Jolie, America took sides. Kitson, an upscale Los Angeles boutique, sold t-shirts emblazoned with "Team Aniston" or "Team Jolie." The Team Aniston t-shirts reportedly so "outstripped" the Team Jolie t-shirts that Kitson had to put people who wanted Team Aniston t-shirts on a three-month waiting list.³ Finally, "[i]n December 1990, . . . shortly before the outbreak of the Gulf War, a story circulated in Washington that President George H.W. Bush had boasted to a congressional delegation that Saddam Hussein was 'going to get his ass kicked.' When reporters pressed Bush to confirm the statement, he did not answer directly. Instead, he hitched up his pants in the manner of John Wayne. Everyone got the point."⁴

Given the emphasis American society places on the actions and opinions of celebrities, "the appropriation of their likenesses may have important uses in uninhibited debate on public issues, particularly debates about culture and values. And because celebrities take on personal meanings to many individuals in society, the creative appropriation of celebrity images can be an important avenue of individual expression."⁵ Such uses have long enjoyed constitutional protection as

¹ *Cardtoons, L.C. v. Major League Baseball Players Association*, 95 F.3d 959, 972 (10th Cir. 1996) (internal citations omitted and quoting John B. Thompson, IDEOLOGY AND MODERN CULTURE: CRITICAL SOCIAL THEORY IN THE ERA OF MASS COMMUNICATION 163 (1990)).

² Bruce Handy, "Never Mind", *Time Magazine* (April 18, 1994).

³ See "Team Aniston", Team Jolie, http://www.factio-magazine.com/specialfeatures/des_TeamAnistonTeamJolie.htm.

⁴ *Cardtoons*, 95 F.3d at 972 (quoting Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 128 (1993)).

⁵ *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 397 (2001). See also *World Wrestling Federal Entertainment, Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 445 (W.D. Pa. 2003) ("Big Dog's use of dogs to poke fun at celebrities and societal icons is an important form of entertainment and expressive commentary that deserves First Amendment protection [T]he celebrity status of the high profile of the WWE characters, which WWE admits and Big Dog does not dispute, make them prime targets of satire and parody.").

matters that are “newsworthy” or of “public concern”, or that address or reflect “public affairs” or the “public interest”.⁶ The source of such protection is found in the First Amendment to the United States Constitution and various state constitutions, such as Article I of the California Constitution, which protect and encourage open discussion of matters of “public concern” or “public interest.”⁷ The United States Supreme Court, explaining the “public interest” privilege in a privacy context, stated: “Exposure of the self to others in varying degrees is a concomitant of life in a civilized community. The risk of this exposure is an essential incident of life in a society which places a primary value on freedom of speech and of press.”⁸ In balancing these sometimes competing interests in the right of publicity context, the California Supreme Court stated that the right of publicity cannot overshadow the right to free expression because doing so would chill reports and commentaries on the conduct of prominent persons.⁹

Most states now recognize that celebrities have a right of publicity—largely an economic right—that enables them to control the use of their names and likenesses.¹⁰ That said, “[w]hat the right of publicity holder possesses is not a right of censorship, but a right to prevent others from

⁶ “[N]ewsworthiness is not limited to ‘news’ in the narrow sense of reports or current events. It extends also to the use of names, likenesses or facts in giving information to the public for purposes of education, amusement or enlightenment, when the public may reasonably be expected to have a legitimate interest in what is published.” *Shulman v. Group W Publications, Inc.*, 18 Cal. 4th 200, 225 (1998) (quoting RESTATEMENT (SECOND) OF TORTS, § 652D, comment j, p. 393). The privilege extends to information disseminated about entertainers. *See Carlisle v. Fawcett Publications, Inc.*, 201 Cal. App. 2d 733, 746 (1962) (“[T]here is a public interest which attaches to people who by their accomplishments, mode of living, professional standing or calling, create a legitimate and widespread attention to their activities. Certainly, the accomplishments and way of life of those who have achieved a marked reputation or notoriety by appearing before the public such as actors and actresses, professional athletes, public officers, noted inventors, explorers, war heroes, may legitimately be mentioned and discussed in print or on radio or television.”).

⁷ *See Dora v. Frontline Video, Inc.*, 15 Cal. App. 4th 536, 545-46 (1993) (noting that the common law “public interest” protection is synonymous with the First Amendment “public affairs” protection set forth in California’s right of publicity statute, CAL. CIV. CODE § 3344(d)).

⁸ *Time, Inc. v. Hill*, 385 U.S. 374, 388, 87 S. Ct. 534, 542 (1967). The Court added: “Freedom of discussion, if it would fulfill its historic function in this nation, must embrace all issues about which information is needed or appropriate to enable the members of society to cope with the exigencies of their period.” *Id.* (internal quotation omitted); *accord Abood v. Detroit Board of Education*, 431 U.S. 209, 231, 97 S. Ct. 1782, 1797 (1977) (“[O]ur cases have never suggested that expression about philosophical, social, artistic, economic, literary, or ethical matters—to take a nonexhaustive list of labels—is not entitled to full First Amendment protection.”).

⁹ *Guglielmi v. Spelling-Goldberg Productions*, 25 Cal. 3d 860, 872 (1979).

¹⁰ “The right of publicity has developed to protect the commercial interest of celebrities in their identities. The theory of the right is that a celebrity’s identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from unauthorized commercial exploitation of that identity.” *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992) (quoting *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983)). A right of publicity tort was first developed in the common law as an outgrowth of rights of privacy. *See Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 571 n.7, 97 S. Ct. 2849, 2855 n.7 (1977); *Virgil v. Time, Inc.*, 527 F.2d 1122, 1125 (9th Cir. 1975); *Kapellas v. Kofman*, 1 Cal. 3d 20, 35 n.16 (1969) (all citing Prosser, *Privacy*, 48 CALIF. L. REV. 383 (1960), or Prosser, LAW OF TORTS 831-832 (3d ed. 1964)). Many states now also have right of publicity statutes. *See, e.g.*, CAL. CIV. PROC. CODE §§ 3344 (for living persons) and 3344.1 (for “deceased personalities”); FLA. STAT. § 540.08; ILL. REV. STAT. ch. 765 §§ 1075/1, *et seq.*; IND. CODE § 32-36; KY. REV. STAT. § 391.170; MASS. GEN. LAWS ANN. ch. 214, § 3A; NEB. REV. STAT. § 20-202; NEV. REV. STAT. §§ 597.770-597.810; N.Y. CIVIL RIGHTS LAW §§ 50, 51; OHIO REV. CODE ANN. §§ 2741.01, *et seq.*; OKLA. STAT. Tit. 12, §§ 1448, 1449; PA. CONS. STAT. Tit. 42, § 8316; R.I. GEN. LAWS §§ 9-1-28, 9-1-28.1(a)(2); TENN. CODE ANN. §§ 47-25-1102 through 1107; TEX. PROPERTY CODE ANN. §§ 26.001, *et seq.*; UTAH CODE ANN. §§ 45-3-1 *et seq.*; VA. CODE § 8.01-40; WASH. REV. CODE §§ 63.60.010, *et seq.*; WIS. STAT. § 995.50(2)(b).

misappropriating the economic value generated by the celebrity's fame through the merchandising of the name, voice, signature, photograph, or likeness of the celebrity."¹¹ Given the public's right and desire to use celebrities to express itself, and given celebrities' rights to exploit their fame economically, "[t]here is an inherent tension between the right of publicity and the right of freedom of expression under the First Amendment."¹²

In attempts to balance the public's right to use celebrities' names and likenesses in expressive content against celebrities' right to capitalize economically on their fame, courts have developed a variety of tests to determine whether a particular use of indicia of a celebrity's identity is a fair use, and therefore privileged. All fair use tests are grounded in the First Amendment, but the number of fair use tests that courts employ and the differences between them have led to an unfortunate unpredictability in the law and, at times, overprotection of celebrities, particularly in the context of merchandising. For example, despite the message it conveys, it is unclear whether the Team Aniston and Team Jolie t-shirts mentioned above would have been found to be a fair use, in at least some of the courts that have wrestled with this issue.

This article analyzes the four primary fair use defenses that have been employed in right of publicity cases—(1) California's transformative use test, (2) the RESTATEMENT (THIRD) OF UNFAIR COMPETITION's relatedness test, (3) Missouri's predominant use test, and (4) federal courts' broadly termed First Amendment defense—and analyzes their strengths and weaknesses when one moves away from pure editorial uses, which are virtually always protected, and instead encounters uses that have at least a partial commercial or merchandising purpose. It is apparent that there is no one-size-fits-all fair use test for right of publicity cases, nor is it likely that one can be developed. Every mixed-use right of publicity case brings a unique set of circumstances before the trier of fact, where the particular commercial or merchandising uses must be weighed against any public interest, editorial, or newsworthiness interests. Depending on the nature of the underlying use (*e.g.*, is it an editorial use, just a name, visual art, a photograph on the cover of a magazine, an advertisement?), one or more of the tests listed above will certainly work better than others, and at least one (Missouri's predominant use test) is particularly flawed in addressing First Amendment concerns. But trying to find a one-size-fits-all test or develop a unified theory of fair use is a bit of a fool's errand. While abandoning that quest necessarily leads to some unpredictability, the current state of the law gives courts some needed flexibility in trying to properly balance the myriad challenged uses against the public's interest in constitutionally protected expression.¹³

¹¹ *Comedy III Productions*, 25 Cal. 4th at 403.

¹² *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 931 (6th Cir. 2003). In express recognition of the danger that exercising the right to prohibit misappropriation of the economic value in one's name, likeness, *etc.* could lead to undue censorship, numerous states now expressly incorporate the constitutional "editorial", "newsworthiness", or "public interest" privilege into right of publicity statutes. *See, e.g.*, CAL. CIV. CODE § 3344(d) ("[The] use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required . . ."); IND. CODE § 32-36-1-1(c)(3) ("in connection with the broadcast or reporting of an event or a topic of general or public interest"); FLA. STAT. § 540.08(3); ILL. REV. STAT. ch. 765 § 1075/35(b)(2); NEB. REV. STAT. § 20-202(1), OHIO REV. CODE ANN. § 2741.09(A); WASH. REV. CODE § 63.60.070(1).

¹³ This article addresses the fair use defense in the context of right of publicity claims only. For purposes of comparison, fair use defenses in the trademark and copyright areas have a relatively settled, consistent application. That predictability, however, has not yet been achieved in the right of publicity context. The primary fair use defenses in the trademark area are the nominative and classic fair use defenses. Under the classic fair use defense, a

II. FAIR USE AS A DEFENSE TO RIGHT OF PUBLICITY CLAIMS

A. The Transformative Use Test.

The transformative use test appears in mixed expressive and commercial use cases, and was first articulated by the California Supreme Court in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*¹⁴ An artist sketched drawings of The Three Stooges in charcoal and then sold lithographs and t-shirts bearing them. The plaintiff, which was the registered owner of Curly's, Moe's, and Larry's rights of publicity, sued, claiming that the t-shirts and lithographs misappropriated The Three Stooges' right of publicity. The case ended up before the California Supreme Court, which formulated the transformative use test, "essentially 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."¹⁵ In applying the transformative use test,

the inquiry is whether the celebrity likeness is one of the "raw materials" from which an original work is synthesized, or whether the depiction or imitation of celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness. And when we use the word "expression," we mean expression of something other than the likeness of the celebrity.¹⁶

It is not the courts' role to determine the subjective merit of the expression. "[C]ourts are not to be concerned with the quality of the artistic contribution—vulgar forms of expression fully

defendant is entitled in good faith to use any mark in a descriptive manner, *i.e.* other than as a trademark. *See, e.g., Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150-51 (9th Cir. 2002) (distinguishing classic and nominative fair use defense); *see also WCVB-TV v. Boston Athletic Association*, 926 F.2d 42 (1st Cir. 1991). Whereas the classic fair use defense generally involves the use of a "mark" to describe something concerning the *defendant's* goods or services, the nominative fair use defense concerns the use of a "mark" to refer to the *plaintiff's* goods or services, where (a) such products or services are not readily identifiable without use of the "mark," (b) the defendant uses only so much of the "mark" as is reasonably necessary to identify the plaintiff's products or services, and (c) the defendant does nothing that suggests sponsorship or endorsement by the mark's owner. *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302, 308 (9th Cir. 1991) (upholding a newspaper's use of polling questions naming the band "New Kids on the Block" because there was no word available to denote the band other than its name). The fair use defense in copyright is found in 17 U.S.C. § 107 ("[T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . . , comment, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work."). Protecting the ability to comment on or criticize another's copyrighted work promotes the free flow of ideas, which is a main goal of the copyright laws. *See Suntrust Bank v. Houghton Mifflin Company*, 268 F.3d 1257 (11th Cir. 2001).

¹⁴ 25 Cal. 4th 387 (2001).

¹⁵ *Id.* at 391.

¹⁶ *Id.* at 406.

qualify for First Amendment protection.”¹⁷ In other words, the inquiry is “more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.”¹⁸

Applying this test to the situation before it in *Comedy III*, the California Supreme Court held that the lithographs and t-shirts based on the artist’s drawings were not transformative because they bore too literal a resemblance to The Three Stooges. Rather than transforming The Three Stooges’ images into something more, the charcoal drawings were merely traditional portraits.¹⁹

In *Bosley v. Wildwett.com*,²⁰ another case that considered a literal depiction, a television news anchor who was videotaped in various stages of undress while participating in a wet t-shirt contest sought a preliminary injunction stopping the defendants from using her image to promote their sexually explicit goods and services. The court held that the defendants’ use of the plaintiff’s image was not transformative because “the images of Catherine Bosley do not contain any transformative elements. It appears that the Defendants are using the images of Plaintiff Bosley solely for the purpose of commercially exploiting her fame.”²¹

On the opposite end of the spectrum, courts have held that incorporating a celebrity’s image into a larger work is protected by the fair use doctrine. In *Winter v. D.C. Comics*,²² the only other California Supreme Court case to apply the transformative use test, albino musicians Johnny and Edgar Winter sued D.C. Comics over a comic book featuring the characters “Johnny and Edgar Autumn,” half-human and half-worm creatures with pale faces and long hair. Applying the transformative use test, the Court held that, unlike the situation in *Comedy III*, the comic book characters were not just literal depictions of the Winter brothers, but instead were transformed into cartoon creatures who were part human and part worm.

Similarly, in *World Wrestling Federation Entertainment, Inc. v. Big Dog Sportswear Holdings, Inc.*,²³ the WWE sued a t-shirt manufacturer over t-shirts that depicted wrestling figures as cartoon dogs and featured slogans such as “Live on Paw-Per-View,” “Wrestling Big Dog Federation (WBDF),” “Hollywood Hound Hogan,” and “Bone Cold Steve Pawstin.”²⁴ The bottom of each graphic stated, “Big Dog Sportswear. THIS IS A PARODY.”²⁵ The court held that the t-shirts were protected under the transformative use test: “The graphics are not literal depictions, as the California Supreme Court found in *Comedy III*, but caricatures of WWE’s wrestling characters. Big Dog’s use of dogs to poke fun at celebrities and societal icons is an

¹⁷ *Id.* at 407.

¹⁸ *Id.*

¹⁹ *Id.* at 409. Ironically, as the Court recognized, the transformative use test provides little protection for talented sketch artists or painters whose skills lie in realistic drawings and paintings because “a literal depiction of celebrity, even if accomplished with great skill, may still be subject to a right of publicity challenge.” *Id.* at 407.

²⁰ 310 F. Supp. 2d 914 (N.D. Ohio 2004).

²¹ *Id.* at 928.

²² 30 Cal. 4th 881 (2003).

²³ 280 F. Supp. 2d 413 (W.D. Pa. 2003).

²⁴ *Id.* at 420.

²⁵ *Id.*

important form of entertainment and expressive commentary that deserves First Amendment protection.”²⁶

Finally, in *ETW Corp. v. Jireh Publishing, Inc.*,²⁷ the Sixth Circuit considered whether a painting, *The Masters of Augusta*, that commemorated Tiger Woods’ victory at the Augusta Masters Tournament, was transformative.²⁸ The foreground of the painting showed three views of Woods posing in front of the Augusta clubhouse. The background depicted images of famous golfers of the past looking down on Woods.²⁹ The court concluded that the painting was transformative and entitled to First Amendment protection because the work was not simply a “literal depiction of Woods. Rather, [the] work consists of a collage of images in addition to Woods’s image which are combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods’s achievement in that event.”³⁰

Although the transformative use test has been applied cleanly in cases on either end of the transformation spectrum, predicting the outcome of cases falling in the middle of that spectrum has proven more difficult. In *Kirby v. Sega of America*,³¹ Kierin Kirby, the lead singer of the musical group Deee-Lite, sued Sega for distributing a video game that allegedly misappropriated her name and likeness by featuring a character, Ulala, in the video game. The court recognized that there were significant similarities between Kirby and Ulala: they had a similar appearance and fashion sense, the name Ulala was a phonetic variant of a phrase associated with Kirby, and the character mimicked Kirby’s speech patterns. Nonetheless, the court held that Sega’s use was transformative. The court reasoned that (1) Ulala’s physique, hairstyle, and costumes differed from Kirby’s; (2) Ulala’s appearance as a space-age reporter in the 25th century was unlike any public depiction of Kirby; and (3) Ulala’s dance moves were unlike Kirby’s movements in any of her music videos.³²

The court’s reasoning, however, is not entirely satisfying. While Ulala was not a literal depiction of the celebrity as was the case in *Comedy III* and *Bosley*, Ulala was not very far removed from Kirby’s personal characteristics, either. She was not a half-human half-worm creature, or a cartoon dog, as was the case in *Winter* and *Big Dog Sportswear*. Rather, Ulala was depicted as a human, albeit in a video game, who resembled Kirby.³³ Thus, Ulala was not entirely transformative, nor was she entirely literal. The transformative use test—which, as noted above, considers “whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation”³⁴—does not

²⁶ *Id.* at 445.

²⁷ 332 F.3d at 915.

²⁸ The Sixth Circuit, apparently unwilling to pick a test, considered the painting pursuant to the transformative use test, the RESTATEMENT’s relatedness test, and a First Amendment balancing test. *Id.* at 936.

²⁹ *Id.* at 918.

³⁰ *Id.* at 938.

³¹ 144 Cal. App. 4th 47 (2006).

³² *Id.* at 59.

³³ In fact, “[i]n July 2000, Kirby was contacted by PD*3 Tully Co. (PD3), a firm retained by a subsidiary of Sega Japan, in connection with its effort to launch a version of SC5 in England” because it was considering using one of Deee-Lite’s songs to promote the game. *Id.* at 52.

³⁴ *Comedy III*, 25 Cal. 4th at 391.

provide much direction when a work appears somewhat transformative, but not entirely so, resulting in a body of law that is perhaps more fact- and court-specific than principled.

In addition, it requires that courts make value judgments about the artistry reflected in the use—at what point is the use sufficiently creative and sufficiently transformed from a literal depiction to entitle it to constitutional protection? Charcoal drawings of The Three Stooges on t-shirts did not meet the mark, while albino half-human, half-worm creatures were sufficiently transformative, as was the dancing Ulala character in Sega’s video game. In *Kirby*, however, the question was close. While the court recognized that Ulala and plaintiff Kirby looked similar, wore similar fashions, had speech and phrases in common, and had other similarities, Ulala’s physique and hairstyle were different, they moved differently, and Ulala was a reporter in the 25th Century. But in noting these similarities and then drawing these distinctions, the court was necessarily expressing its opinion about the relative artistic worth of the Ulala characterization, a particularly dangerous slope for courts to venture onto from a First Amendment point of view. Depending on the panel examining the facts, the court could easily have come out the other way.

The transformative use test also works best in the area of visual art. Each of the cases discussed above considered a visual depiction of a celebrity. With the visual arts, one can create a likeness, photograph, or image that is a quite literal depiction of the celebrity, or can create something that is so abstract that the subject of the likeness, photograph, or image is hard to divine, and, while there is an almost infinite number of stops one can make in the continuum between those extremes, the transformative test provides an easily applied tool for determining how much the work has been changed into something more than just a celebrity imitation. But if one uses something other than a visual depiction of a celebrity—such as a celebrity’s name, voice or signature—then the transformative use test is much less probative. For example, is merely adding “Team” to “Jolie” or “Aniston” in the t-shirt sales described above sufficiently transformative to insulate the t-shirt purveyor from right of publicity liability? Is the use of an unaltered photograph in a non-editorial context always going to lead to strict liability under the transformative test? In the *Winter* case, D.C. Comics changed the names Johnny and Edgar Winter to Johnny and Edgar Autumn. If that was all D.C. Comics had done, and the comic book characters themselves were still albino musicians with long hair instead of half-human and half-worm creatures with pale faces and long hair, would simply changing “Winter” to “Autumn” be sufficiently transformative to insulate D.C. Comics from liability? In such cases, the transformative use test is not a very useful tool and one or more of the other tests discussed below will provide a better point of reference.³⁵

B. The Relatedness Test.

The so-called “relatedness” test derives from the RESTATEMENT (THIRD) OF UNFAIR COMPETITION. It protects the use of a person’s name or image in a work that is “related” to the person. In applying this test, courts consider whether the use of the celebrity’s name or likeness is truly related to the work in which it appears, or whether it is “simply [a] disguised commercial

³⁵ The transformative test also should not be applied to literal visual depictions that are used for editorial purposes, such as the use of a photograph of a celebrity as an illustration in an editorial article about that celebrity. Such uses are almost always constitutionally protected as matters that are “newsworthy” or of “public concern” or “public interest.”

advertisement for the sale of goods or services.”³⁶ According to the RESTATEMENT, the uses of a celebrity’s name or likeness that typically pass muster under the relatedness test include the following:

[T]he use of a person’s name or likeness in news reporting, whether in newspapers, magazines, or broadcast news, does not infringe the right of publicity. The interest in freedom of expression also extends to use in entertainment and other creative works, including both fiction and nonfiction. The use of a celebrity’s name or photograph as part of an article published in a fan magazine or in a feature story broadcast on an entertainment program, for example, will not infringe the celebrity’s right of publicity. Similarly, the right of publicity is not infringed by the dissemination of an unauthorized print or broadcast biography. Use of another’s identity in a novel, play, or motion picture is also not ordinarily an infringement. The fact that the publisher or other user seeks or is successful in obtaining a commercial advantage from an otherwise permitted use of another’s identity does not render the appropriation actionable. However, if the name or likeness is used solely to attract attention to a work that is not *related* to the identified person, the user may be subject to liability for a use of the other’s identity in advertising.³⁷

This test is very limited in its applicability. While the transformative use test is most useful in examining visual depictions of celebrities, the relatedness test is most useful in examining traditional, editorial uses of a celebrity’s indicia of identity. The RESTATEMENT’s list of permissible uses is focused almost exclusively on editorial types of uses—a name or likeness used in “news reporting,” as “part of an article,” in an “unauthorized print or broadcast biography,” or in “a novel, play, or motion picture.” These are all traditional editorial, criticism, or commentary types of uses that have long been subject to First Amendment protections. The RESTATEMENT contrasts such uses with the gratuitous use of the name or likeness of a person who has no relation whatsoever with the work in which his or her name or likeness appears and which is being used solely to attract attention to the work, which will not be protected. But again this has long been recognized as a limit on First Amendment protection for such uses. What the RESTATEMENT does not address are the more troublesome types of uses, such as merchandising or hybrid uses that combine both an editorial element and a commercial element.

³⁶ *Montgomery v. Montgomery*, 60 S.W.3d 524, 529 (Ky. 2001) (quoting *Frosch v. Grosset & Dunlap*, 75 A.D.2d 768 (N.Y. 1980)).

³⁷ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47, comment c (emphasis added). Although most courts applying the “RESTATEMENT test” rely on Section 47, comment c, at least one court has relied on comment d. Comment d “articulates a rule analogous to the rule of fair use in copyright law. Under this rule, the substantiality and market effect of the use of the celebrity’s image is analyzed in light of the informational and creative content of the defendant’s use.” *ETW*, 332 F.3d at 937. Applying this test to a painting of Tiger Woods after he won the Augusta Masters’ Tournament, the Sixth Circuit held that the painting “has substantial informational and creative content which outweighs any adverse effect on ETW’s market and that [the] work does not violate Woods’s right of publicity.” *Id.*

This limitation on the applicability of the relatedness test is reflected in the cases. For example, in *Montgomery v. Montgomery*,³⁸ the personal representative of Harold Montgomery's estate brought suit against Harold's son, country singer John Michael Montgomery, for using Harold's name, likeness, and voice in a music video of a song dedicated to Harold. The court held that the younger Montgomery's use of his father's image satisfied the relatedness test because Harold "is intimately related to the underlying work (the song and video are both a tribute to him) and the music video itself is not a disguised commercial advertisement for the sale of compact discs . . . or the album."³⁹

Similarly, in *Thoroughbred Legends, LLC v. The Walt Disney Company*,⁴⁰ the owners, trainer, and jockey of a famous racehorse named Ruffian that tragically died during a race, sued Disney for making an ABC film, *Ruffian*, based on the story. The film used the names and identities of people involved with the horse. The court held that the use was protected under the relatedness test because the work was expressive and clearly related to the plaintiffs. Moreover, the court noted that "[t]he fact that the publisher or other user seeks or is successful in obtaining a commercial advantage from an otherwise permitted use of another's identity does not render the appropriation actionable."⁴¹

It is unclear how one would apply the RESTATEMENT's relatedness test to merchandising uses, where the work does not have a storyline to which a celebrity's name or likeness could relate.⁴² For example, consider the *Paris Hilton v. Hallmark Cards* case presently pending before the Ninth Circuit.⁴³ Hallmark released a greeting card that poked fun at Paris Hilton's hyper-manufactured celebrity status, superimposing a photograph of her face over a cartoon body of a waitress serving food to a patron, along with the dialogue, "Don't touch that, it's hot. What's hot? That's hot.", one of her catch-phrases. Although any of numerous celebrities' images might have been used to convey the particular message being presented by Hallmark, the use of this particular image may make a particularly powerful parody statement. The relatedness test, however, is ill-suited to addressing such mixed-message uses as it becomes almost impossible to measure exactly where the use of a celebrity's name or likeness starts or stops being "related" to the work in which it appears. "Relatedness" is simply too amorphous a concept to provide much useful guidance in such cases.

C. The Predominant Use Test.

The predominant use test has been applied by the Missouri Supreme Court in a single case: *Doe v. TCI Cablevision*.⁴⁴ The facts in *TCI* were as follows: defendant Todd McFarlane created a

³⁸ 60 S.W.3d at 524.

³⁹ *Id.* at 529.

⁴⁰ 2008 WL 616253 (N.D. Ga. 2008).

⁴¹ *Id.* at *12.

⁴² That said, at least one federal court has used language evoking the relatedness test in a right of publicity case involving merchandising uses. In *Cardtoons, L.C.*, 95 F.3d at 959, the defendant trading card producer sold "parody trading cards" bearing cartoons of well-known baseball players. The court held the cards were protected by the First Amendment, at least in part, because "they do not merely advertise an unrelated product." *Id.* at 970.

⁴³ U.S. District Court for the Central District of California, Case No. 2:07-cv-05818-PA-AJW; Court of Appeals for the Ninth Circuit, No. 08-55443.

⁴⁴ 110 S.W.3d 363 (Mo. 2003) (*en banc*).

comic book called *Spawn* that had a character called “Tony Twist,” named after a famous professional hockey player who began his career with the St. Louis Blues. The fictional “Tony Twist” in the comic book was a Mafia don who commits murder, abducts children, and has sex with prostitutes. The hockey player sued. In *TCI*, the Missouri Supreme Court recognized that the fictional and real Tony Twist bore no physical resemblance to each other and, aside from the common nickname, were similar only in that each could be characterized as having an “enforcer” or tough-guy persona.⁴⁵

The court discussed but then rejected more forgiving First Amendment tests such as the relatedness test and the transformative use test because “they give too little consideration to the fact that many uses of a person’s name and identity have both expressive and commercial components.”⁴⁶ Instead, it adopted a “predominant use” test, which had been proposed by a legal commentator but had not previously been used by a court:

If a product is being sold that predominantly exploits the commercial value of an individual’s identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some “expressive” content in it that might qualify as “speech” in other circumstances. If, on the other hand, the predominant purpose of the product is to make an express comment on or about a celebrity, the expressive value could be given greater weight.⁴⁷

As appears to have been the Missouri Supreme Court’s intention, this “predominance” test sharply tilts in favor of the celebrity. Thus, in *TCI* the Missouri Supreme Court, faced with a fact pattern similar to that considered by the California Supreme Court in *Winter* but coming to a different conclusion, held that Missouri’s right of publicity law prohibited a celebrity reference in a comic book.

The *TCI* court, however, failed to apply its own articulated test. It did not truly balance the expressive elements of the *Spawn* comic book against the commercial impact of the use of the Tony Twist name for an “enforcer” character, which the court had already found bore no resemblance to the real Tony Twist. Instead, the court completely discounted the expressive side of the equation and took a swipe at the comic book’s literary value:

Twist made a defensible case that respondents’ use of his name and identity was for a commercial advantage. Nonetheless, there is still an expressive component in the use of his name and identity as a metaphorical reference to tough-guy “enforcers.” And yet, respondents agree (perhaps to avoid a defamation claim) that the use was not a parody or other expressive comment or a fictionalized account of the real Twist. As such, the metaphorical reference to Twist, though a literary device, has very little literary value compared to its commercial value. On the record

⁴⁵ *Id.* at 366.

⁴⁶ *Id.* at 374.

⁴⁷ *Id.* (quoting Mark S. Lee, *Agents Of Chaos: Judicial Confusion In Defining The Right Of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 500 (2003)).

here, the use and identity of Twist's name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity.⁴⁸

The court also gave undue weight to the commercial impact of the use of the character name given that there was no evidence of any commercial exploitation of the value of Tony Twist's name, *i.e.*, there was no indication that anyone bought a *Spawn* comic book because of the name of this one character who was added to later issues of the *Spawn* series.

The predominant use test is troubling because it may give too much weight to a celebrity's economic prerogative and not enough weight to the public's right to express itself. Unlike the transformative use test and the relatedness test, the predominant use test, at least in the sole case to have applied it, did not turn on whether a work is an "expression of something other than the likeness of the celebrity."⁴⁹ The Missouri Supreme Court's test, in doling out First Amendment protection based on the "predominant" purpose of a particular product, is too mathematical and provides for too little First Amendment analysis or protection. For example, what does one do with a product with a "purpose" that is 49% expressive and 51% commercial? The better test, as the California courts and most of the Federal Circuits have adopted, focuses on the nature and quality of the First Amendment expression itself and requires a balancing of all of the competing expressive, economic, and non-economic interests.

D. The First Amendment Test.

Although each of the three foregoing tests, at its most basic level, has its roots in the First Amendment, many federal courts have opted not to apply such tests and instead have simply undertaken an *ad hoc* balancing of First Amendment speech rights against the right of publicity. This has led to a certain amount of unpredictability and inconsistency in the case law that, like the transformative use case law, often appears to be more a function of the particular facts before a particular court than normative principle, but generally the First Amendment balancing test gives the courts the most flexibility in examining the disparate fact scenarios that come before them for decision and provides a fairly well-understood public policy underpinning for such analyses.

In *White v. Samsung Electronics America, Inc.*,⁵⁰ the Ninth Circuit considered whether an advertisement featuring a robot dressed to resemble *Wheel of Fortune* spokesperson Vanna White on a mock *Wheel of Fortune* set infringed White's right of publicity. The defendant argued that its advertisement was protected speech under the First Amendment. The majority disagreed, finding that the advertisement was commercial speech and its interests were subservient to the right of publicity: "This case involves a true advertisement run for the purpose of selling Samsung VCRs. The ad's spoof of Vanna White and *Wheel of Fortune* is subservient and only tangentially related to the ad's primary message: 'buy Samsung VCRs.'"⁵¹ This case,

⁴⁸ *Id.*

⁴⁹ *Comedy III*, 25 Cal. 4th at 406.

⁵⁰ 971 F.2d at 1395.

⁵¹ *Id.* at 1401.

much like the Missouri Supreme Court's opinion in *TCI*, appears to overstate a celebrity's right in her name or likeness at the expense of public expression. Judge Kozinski, in a dissent from a denial of a petition for rehearing *en banc*, argued as much: "Instead of having an exclusive right in her name, likeness, signature or voice, every famous person now has an exclusive right to anything that reminds the viewer of her."⁵²

Other circuits have distinguished the majority's analysis in *White*. In *Cardtoons, L.C. v. Major League Baseball Players Association*,⁵³ the defendant trading card producer sold "parody trading cards" bearing cartoons of well-known baseball players. The Tenth Circuit distinguished *White* from the situation before it because "the speech involved is not commercial, but rather speech subject to full First Amendment protection."⁵⁴ It then balanced the defendants' First Amendment rights against the players' right of publicity and examined the various policies underlying the right of publicity. Ultimately the court concluded that the cards' expressive value—particularly their usefulness in commenting on our national pastime—outweighed any right of publicity interest.⁵⁵

In *Hoffman v. Capital Cities/ABC, Inc.*,⁵⁶ the Ninth Circuit itself distinguished its earlier decision in *White*. In *Hoffman*, actor Dustin Hoffman sued for violation of the right of publicity (among other things) over a *Los Angeles Magazine* fashion article. The article featured still photographs from various older movies, but the photos had been altered so that it appeared the actors were wearing the season's latest fashions. The magazine took a photo of Hoffman from the movie *Tootsie*, in which he had appeared in drag, and altered it so his dress and shoes matched fashion trends at the time the article was published. The Ninth Circuit distinguished *Hoffman* from *White* on the ground that the article was not commercial speech because (1) it "did not use Hoffman's image in a traditional advertisement printed merely for the purpose of selling a particular product;" (2) the magazine "did not receive any consideration from the designers for featuring their clothing in the fashion article;" and (3) the article did not advance a commercial message, but rather was "a combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors."⁵⁷ The court held that, unlike the situation in *White*, "[a]ny commercial aspects" of the article "[were] inextricably entwined with expressive elements, and so they cannot be separated out from the fully protected whole."⁵⁸ The

⁵² *White v. Samsung Electronics America Inc.*, 989 F.2d 1512, 1515 (9th Cir. 1993) (Kozinski, J, dissenting from denial of rehearing *en banc*).

⁵³ 95 F.3d at 959.

⁵⁴ *Id.* at 970. The Tenth Circuit also criticized the Ninth Circuit's analysis in *White*, stating that the Ninth Circuit denied Samsung's motion for summary judgment "without engaging in a methodical commercial speech analysis of Samsung's First Amendment defense." *Id.* The court "disagree[d] with the result in that case for reasons discussed in the two dissents that it engendered." *Id.*

⁵⁵ The court stated: "The application of the Oklahoma publicity rights statute to Cardtoons' trading cards presents a classic case of overprotection. Little is to be gained, and much lost, by protecting MLBPA's right to control the use of its members' identities in parody trading cards. The justifications for the right of publicity are not nearly as compelling as those offered for other forms of intellectual property, and are particularly unpersuasive in the case of celebrity parodies. The cards, on the other hand, are an important form of entertainment and social commentary that deserve First Amendment protection." *Id.* at 976.

⁵⁶ 255 F.3d 1180 (9th Cir. 2001).

⁵⁷ *Id.* at 1185.

⁵⁸ *Id.* This is similar to California's transformative use test in that the essence of the Ninth Circuit's holding is that Hoffman's image, although an ingredient in the magazine article, had been transformed from a mere imitation of

court ultimately concluded, after a full-blown First Amendment analysis, that *Los Angeles Magazine* did not act with actual malice in that it did not intend to trick readers into believing that Hoffman actually posed for the photograph, and that the article was protected by the First Amendment.⁵⁹

In *ETW Corporation v. Jireh Publishing, Inc.*,⁶⁰ the Sixth Circuit, following the lead of the Tenth Circuit in *Cardtoons*, balanced expressive and commercial elements to determine whether a painting depicting Tiger Woods' win at the Augusta Masters Tournament was protected speech. The court concluded that the "work is expression which is entitled to the full protection of the First Amendment and not the more limited protection afforded to commercial speech."⁶¹ The court reached this conclusion, at least in part, because "through their pervasive presence in the media, sports and entertainment celebrities have come to symbolize certain ideas and values in our society and have become a valuable means of expression in our culture."⁶²

celebrity likeness such that "it has become primarily the defendant's own expression rather than the celebrity's likeness." See *Comedy III*, 25 Cal. 4th at 406. In fact, in a footnote, the Ninth Circuit referenced the transformative use test, and noted that if it had applied that test, then it would have been clear that the photograph contained "significant transformative elements." *Hoffman*, 255 F.3d at 1184 n.2. The court, however, declined to apply the transformative use because it read *Comedy III* as limited to "artists" and "artistic expression." The court did not consider *Los Angeles Magazine* an "artist" or the altered *Tootsie* photograph "artistic expression." *Id.*

⁵⁹ Unlike California's transformative use test and the vast majority of federal cases, the Ninth Circuit did not end its analysis with the conclusion that the article's use of Hoffman's image was inextricably intertwined with its expressive elements. Instead, the court proceeded to examine whether *Los Angeles Magazine* acted with actual malice. The court explained why it applied the actual malice standard when other courts had not as follows: "In many right of publicity cases, the question of actual malice does not arise, because the challenged use of the celebrity's identity occurs in an advertisement that 'does no more than propose a commercial transaction' and is clearly commercial speech." *Id.* at 1185. Perhaps the better explanation for the absence of an actual malice standard in the right of publicity case law, however, is that the right of publicity protects against the unauthorized use of a celebrity's name or likeness for commercial purposes, not against the false use of a celebrity's name or likeness. See *C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 824 (8th Cir. 2007), *cert. denied* 128 S. Ct. 2872 (2008) ("the right of publicity is intended to promote only economic interests and . . . noneconomic interests are more directly served by so-called rights of privacy."). The latter conduct is actionable pursuant to causes of action for defamation or invasion of privacy by placing the plaintiff in a false light, and a public figure must prove actual malice to succeed on such a claim. See *Fellows v. National Enquirer, Inc.*, 42 Cal. 3d 234, 239-40 (1986) (explaining the applicability of the actual malice standard to causes of action for defamation and false light involving public figures). Thus, it appears that the Ninth Circuit—because Hoffman alleged that the article falsely suggested he had posed for the photograph—treated Hoffman's right of publicity claim as a claim for defamation or false light, even though he had not asserted such causes of action, and applied the actual malice standard.

⁶⁰ 332 F.3d at 915.

⁶¹ *Id.* at 937. Although the Sixth Circuit concluded that the painting at issue was not commercial speech, it did not follow the Ninth Circuit's lead in *Hoffman* and apply the actual malice test, most likely because there were no allegations of falsity in the case before it.

⁶² *Id.* at 937-38. The Sixth Circuit also appeared to consider the economic implications of the painting on Woods' earning capacity: "In balancing these interests against Woods's right of publicity, we note that Woods, like most sports and entertainment celebrities with commercially valuable identities, engages in an activity, professional golf, that in itself generates a significant amount of income which is unrelated to his right of publicity. Even in the absence of his right of publicity, he would still be able to reap substantial financial rewards from authorized appearances and endorsements. It is not at all clear that the appearance of Woods's likeness in artwork prints which display one of his major achievements will reduce the commercial value of his likeness." *Id.* at 938.

Finally, in *C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*,⁶³ the Eighth Circuit considered whether a fantasy baseball game violated baseball players' rights of publicity. The court held that the defendant's First Amendment rights trumped the plaintiff's right of publicity claims. Given Americans' "enduring fascination" with baseball, the court held that the "recitation and discussion of factual data concerning the athletic performance of [professional baseball players] command a substantial public interest, and, therefore, is a form of expression due substantial constitutional protection."⁶⁴ The interest in this expression outweighed countervailing interests in the right of publicity, both economic and non-economic.⁶⁵

III. A PROPOSAL FOR A MORE BALANCED APPROACH

As the above analysis shows, there is significant discord between the various right of publicity fair use tests when they are applied to anything other than pure editorial uses of celebrity names or images. When examining mixed expressive and commercial uses, California's transformative use defense works well if the use is in the visual arts and is very imitative or highly transformative, but not so well if the use falls somewhere between those extremes or when the contested use falls outside the visual arts arena. The RESTATEMENT's relatedness test is too amorphous and does not appear to be aimed at anything other than traditional, editorial types of uses, which are already adequately protected under traditional First Amendment analyses. It is particularly ill-suited for addressing hybrid uses of a celebrity's name or likeness where both expressive and commercial aspects are found. Missouri's predominant use test has been isolated to a single case and rejected by subsequent courts, and appears to overprotect celebrities. While the federal courts' First Amendment *ad hoc* balancing analyses provide a great deal of flexibility and there now is a significant body of law applying the standard in many different situations, there often is a tendency to engage in ends versus means adjudication, rather than principled decision making.

The question thus becomes whether there could be a one-size-fits-all fair use test that would adequately balance the public's First Amendment rights of expression against celebrities' economic rights of publicity. If such a unified theory could be developed, then the primary beneficiary would be predictability. But that predictability would likely come at the expense of judicial flexibility in addressing the myriad expressive and commercial uses that come before the courts. Cases where celebrity names or likenesses are being used for editorial purposes, or where very literal, imitative uses of names or likenesses are being used on the proverbial coffee mug, or where names and likenesses are highly transformed into something far removed from a mere copying of celebrity identity in order to sell a product, are relatively easy to predict as protected or not, and therefore are not often the subject of adjudication. In such cases, the transformative, relatedness, and First Amendment *ad hoc* balancing tests can work well. But for those contested uses that fall somewhere in the middle, it is suggested that an increased consideration of other factors, such as those developed for fair use analyses in the copyright and

⁶³ 505 F.3d at 818.

⁶⁴ *Id.* at 823-24 (quoting *Gionfriddo v. Major League Baseball*, 94 Cal. App. 4th 400, 411 (2001)).

⁶⁵ In so holding, the Eighth Circuit departed from the First Amendment analysis undertaken by the Missouri Supreme Court in *TCI*. Although it relied on *TCI* to determine whether the defendant's use of baseball players' names in the fantasy baseball game fell within the scope of Missouri's right of publicity law, it did not so much as mention *TCI's* predominant use test in its First Amendment discussion. *Id.* at 823-24.

trademark contexts, could provide some additional guidance for the courts in determining where to strike the appropriate balance between expressive and commercial interests.

Courts and commentators agree that, while the right of publicity originally had a privacy genesis, it currently is thought of as predominantly an economic right.⁶⁶ The primary economic justification given for “the right of publicity is that it provides an incentive for creativity and achievement.”⁶⁷ Pursuant to this argument, “publicity rights induce people to expend the time, effort, and resources to develop the talents prerequisite to public recognition.”⁶⁸ If we take away a celebrity’s right to capitalize on his or her fame, the argument goes, there will be little incentive for people to become actors, singers, or professional athletes.⁶⁹

As a predominantly economic right, it then makes sense to tether a fair use defense, at least in part, to the economic effects of a work incorporating a celebrity’s name or likeness. One way to take such effects into account would be to include in any analysis where a court is being asked to weigh expressive versus commercial interests the consideration of two additional factors:

- (1) Is the work at issue an economic substitute for the use of a celebrity’s name or likeness; in other words, does it affect the potential market for or value of the celebrity’s name or likeness?
- (2) Would a reasonable person likely believe that the work is an endorsement by the celebrity whose name or likeness is used?

⁶⁶ See, e.g., *Comedy III*, 25 Cal. 4th at 403 (“the right of publicity is essentially an economic right”); Dogan, Stacey L. and Lemley, Mark A., *What The Right Of Publicity Can Learn From Trademark Law*, 58 STAN. L. REV. 1161. (Feb. 2006). See also *Cardtoons* and *C.B.C. Distribution*, *supra*, where the courts undertook a detailed analysis of both the economic and non-economic policies underlying the right of publicity.

⁶⁷ *Cardtoons*, 95 F.3d at 973. There are other economic justifications, like preventing a tragedy of the commons with respect to celebrity names and likenesses. *Id.* at 974-75 (“Without the artificial scarcity created by publicity rights, identities would be commercially exploited until the marginal value of each use is zero. Creating artificial scarcity preserves the value to [the celebrity], to advertisers who contract for the use of his likeness, and in the end, to consumers, who receive information from the knowledge that he is being paid to endorse the product. Giving people control of the commercial use of their identities, according to this analysis, maximizes the economic and informational value of those identities.” (internal quotations and citations omitted)). Courts have also considered preventing consumer confusion. *Id.* at 975 (“The final economic argument offered for rights of publicity is that they protect against consumer deception. The Lanham Act, however, already provides nationwide protection against false or misleading representations in connection with the sale of products.” (internal citations omitted)). Such justifications, however, have been overwhelmed by the incentive justification, and have analytical problems of their own that are outside the scope of this article. *Id.* at 974-75.

⁶⁸ *Id.*; see also *White*, 971 F.2d at 1398 (“The right of publicity has developed to protect the commercial interest of celebrities in their identities. The theory of the right is that a celebrity’s identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity.”).

⁶⁹ There are some obvious fallacies with this argument, not the least of which is that celebrities are already paid well for their various endeavors, and that alone may be incentive enough. *Cardtoons*, 95 F.3d at 973 (“Most sports and entertainment celebrities with commercially valuable identities engage in activities that themselves generate a significant amount of income; the commercial value of their identities is merely a by-product of their performance values.”). See also *C.B.C.*, 505 F.3d at 824 (“major league baseball players are rewarded, and handsomely, too, for their participation in games and can earn additional large sums from endorsements and sponsorship arrangements.”); *ETW*, 332 F.3d at 930 (“The commercial value of a person’s identity often results from success in endeavors such as entertainment or sports that offer their own substantial rewards. Any additional incentive attributable to the right of publicity may have only marginal significance.”).

The first question is drawn from the fair use defense in copyright law, as well as from comments in some right of publicity case law concerning the financial impacts of a particular use on the celebrity's economic publicity rights.⁷⁰ Although the California Supreme Court at one time considered and rejected the “wholesale importation of the fair use doctrine [of copyright law] into right of publicity law,”⁷¹ the court later noted that the doctrine could provide “some guidance.”⁷² In *Comedy III*, the court reasoned that “[a]t least two of the factors employed in the fair use test, ‘the nature of the copyrighted work’ and ‘the amount and substantiality of the portion used’” are not well-suited to a right of publicity analysis.⁷³ It found that the first fair use factor, however, “the purpose and character of the use,” was useful in a right of publicity analysis and in that regard announced the transformative use test: “[W]hen a work contains 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.”⁷⁴ The final fair use factor—the effect of the use on the market for the copyrighted work—is largely irrelevant in a right of publicity case if the defendant's work is highly transformative. And, if the work lies on the other end of the spectrum and is merely imitative instead of transformative, and the marketability and economic value of the defendant's work derives “primarily” from the celebrity's fame, then it is unlikely that the defendant's work would enjoy First Amendment protection under a borrowed copyright fair use analysis in any event.⁷⁵ But in between these two extremes, the fourth copyright fair use factor may provide some guidance for the court in determining how, exactly, to balance the competing expressive and commercial aspects of the challenged use and whether it falls too far on the commercial side to be worthy of constitutional protection.

The second question is drawn from the elements of a false endorsement claim under Section 43(a) of the LANHAM ACT, 15 U.S.C. § 1125(a),⁷⁶ and the nominative fair use defense in trademark law.⁷⁷ Adding this factor to the analysis would help ensure that the right of publicity is not expanded beyond its primary justification, namely a celebrity's right to earn money by

⁷⁰ See footnotes 14 and 63, *ante*. See also, e.g., *Comedy III*, 25 Cal. 4th at 405 (noting that the transformative use test considers whether a work is a good substitute “for conventional depictions of the celebrity” and whether it threatens “markets for celebrity memorabilia that the right of publicity is designed to protect”); *Winter*, 30 Cal. 4th at 890 (holding that comic books depicting half-human half-worm cartoon characters were transformative because “Plaintiffs’ fans who want to purchase pictures of them would find the drawings of the Autumn brothers unsatisfactory as a substitute for conventional depictions”).

⁷¹ *Comedy III*, 25 Cal. 4th at 404.

⁷² See *Winter v. D.C. Comics*, 30 Cal. 4th at 889.

⁷³ *Comedy III*, 25 Cal. 4th at 404.

⁷⁴ *Id.* at 405.

⁷⁵ See *Winter*, 30 Cal. 4th at 889; *Comedy III*, 25 Cal. 4th at 407 (“[W]hen an artist is faced with a right of publicity challenge to his or her work, he or she may raise as affirmative defense that the work is protected by the First Amendment inasmuch as it contains significant transformative elements or that the value of the work does not derive primarily from the celebrity's fame.”).

⁷⁶ Under the LANHAM ACT, 15 U.S.C. § 1125(a), “[a] false endorsement claim based on the unauthorized use of a celebrity's identity . . . alleges the misuse of a trademark, i.e., a symbol or device such as a 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.” *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992) (emphasis added).

⁷⁷ See footnote 14, *ante* (the final factor considered in the nominative fair use test is that “the defendant does nothing that suggests sponsorship or endorsement by the mark's owner”).

selling his or her image either through merchandising or endorsements, and help the court determine exactly what message is being conveyed—is it primarily individual expression aimed at public discourse or commentary, or it is trying to ride the coattails of someone’s celebrity status in order to hawk a product?

Adding these factors to a right of publicity fair use analysis also would help inform a decision in cases where the uses are not merely imitative, as in *Comedy III*, or highly transformative, as in *Winter*. For example, in *Kirby*, where Ulala, the videogame character, was not entirely imitative nor entirely transformative, an examination of the impact of the challenged use on the potential market for or value of Kirby’s name or likeness, and an examination of whether, in context, any reasonable person would likely believe that the work was endorsed by Kirby, would have provided further depth to and justification for the court’s decision, properly balanced all of the competing interests, and made the court’s decision more informative for precedential purposes.⁷⁸ In addition, adding these factors to the mix of factors that the courts will have to examine will not interfere with the transformative use case law that already exists, or with the traditional First Amendment *ad hoc* balancing analysis. On the contrary, adding these two factors will help ensure that the courts have as much flexibility as needed to properly analyze all of the myriad uses that will come before them and can find the proper constitutional balance between competing expressive and commercial interests.

IV. CONCLUSION

Celebrities are an integral part of the common American cultural fabric, and are invoked to express a wide variety of ideas and emotions. Courts must be careful, therefore, not to emphasize the right of publicity, a largely economic right, over the public’s ability to express itself. Adopting California’s transformative use test or using the First Amendment *ad hoc* balancing test, and also considering what impact, if any, the challenged use would have on the potential market for or value of the celebrity’s name or likeness, and whether, in context, any reasonable person would likely believe that the work was endorsed by the celebrity, would help strike the appropriate balance.

⁷⁸ The *Kirby* court noted the plaintiff’s LANHAM ACT claim for false endorsement and that in examining such a claim one must determine whether the celebrity’s image or persona is used in connection with a product in a manner likely to falsely imply a celebrity product endorsement, but stated that such a test “does not apply in a case such as this, in which there is a colorable defense that the use of the celebrity’s likeness or identity is entitled to First Amendment protection.” *Kirby*, 144 Cal. App. 4th at 57 n.4. It is difficult to understand why entitlement to First Amendment protection would make consideration of such a factor inapplicable. If anything, considering whether any reasonable person would likely believe that the work was endorsed by Kirby would help support a decision that the challenged use, which contained both transformative and commercial elements, was protected by the First Amendment.