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PRESERVATION OF FIRST AMENDMENT RIGHTS: FINDING THE PROPER BALANCE BETWEEN EXPRESSION AND EXPLOITATION IN WORKS OF ART

Cecilia Chung*

I. INTRODUCTION

Andy Warhol is perhaps one of the most recognized and influential American artists of the twentieth century, and is well known for his juxtaposition of art and popular culture. Warhol's work reflects America's preoccupation and association with famous brands and celebrities. For instance, he ingeniously merged everything from mundane, commercial objects such as Campbell's soup cans and Coca-Cola bottles to images of mega-celebrities including Marilyn Monroe and Elvis into works of art. Despite the commercial nature of Warhol's artwork, few would object to the proposition that it is entitled to protection under the First Amendment. Nevertheless, under similar circumstances, celebrities are asserting their property rights to prevent the unauthorized use of a persona in works of art, memorabilia, caricatures, and editorials.

The ownership of intellectual property presents a unique problem because this type of property can be owned by an unlimited number of individuals at any given time.1 For instance, a famous actor may claim that he owns his persona and that this right of publicity is protected as intellectual property. However, an actor is paid to personify a character,
which in most instances was created by someone else. In this case, both the actor as well as a creator's character may claim a right to the personified character. An interesting question arises with respect to an individual's right to assert ownership of his or her personality or identity. Moreover, when personality or identity rights become intertwined with income, the problem often devolves into a legal battle. The legal controversy involves control over one's public image and the reaping of economic rewards brought on by celebrity status.

The right of publicity is defined as the "inherent right of every human being to control the commercial use of his or her identity." By 1953, courts recognized the right of publicity as an outgrowth of the right to privacy. Moreover, "[a]lthough the right of publicity has been recognized as a distinct common-law doctrine since 1953, only in recent years have courts begun to take the First Amendment seriously as a limit on the extent to which . . . celebrities can use the doctrine to control the use of their images." Today, the tension between the right of publicity and the First Amendment is widely recognized in the legal community, reflected by a need to draw a line between free riding and free expression. On the one hand, "[a] rich and varied public domain is essential to a properly functioning system of
intellectual property so that creators will have free access to
the raw material they need to fashion new works for the
public. So, too, is a rich public domain crucial to the
enjoyment of First Amendment freedoms.7 On the other
hand, society seemingly finds some inherent injustice in
reaping the fruits of another's labor.

Neither Congress nor the United States Supreme Court
has created a bright-line rule to balance First Amendment
interests against the right of publicity.8 The courts,
depending on the jurisdiction, employ various common law
tests to resolve disputes concerning the right of publicity
where the First Amendment is an asserted defense. This
comment argues that the current tests used by the courts are
vague and lack uniformity,9 resulting in a chilling effect on
speech. Artists who draw from the public domain and whose
contributions enrich the public domain are burdened most.
For instance, artists who depict celebrities in their work are
likely to face opposition where a celebrity finds the artist's
message unfavorable, or where the celebrity demands
compensation from the artist. Due to the chilling effect of
litigation on free expression, if the right of publicity is to be
properly balanced against the First Amendment, courts
should use a uniform standard to address the right of
publicity.

Part II of this comment describes the historical
development of the right of publicity10 and discusses the
various ways in which state and federal courts have
inadequately resolved the tension between the First
Amendment and the right of publicity.11 Part III discusses
the two most recent balancing tests adopted by the Supreme
Courts of California12 and Missouri13 to illustrate the need for

Amicus Curiae Brief of Seventy-Three Law Professors in Support of
(2000).

8. The only case heard by the United States Supreme Court to date that
discusses and attempts to resolve the tension between the First Amendment
and the right of publicity is Zacchini v. Scripps-Howard Broadcasting Co., 433

9. See discussion infra Part IV.A-C.

10. See discussion infra Part II.A-B.

11. See discussion infra Part II.C.

2001) (applying the transformative use test).
a more uniform standard. Part IV identifies the weaknesses of these two tests and show how a clearer standard would strengthen courts' rulings in this area of law. Part V proposes that the United States Supreme Court clarify the standards to be used when balancing the right of publicity and the First Amendment. In addition, it also proposes that Congress lobby for a statute that ensures uniformity in the outcomes of litigation. This may prove to be a difficult proposition because the right of publicity has generally been governed by state law. However, uniform and rational bright-line rules may lead to less frustration on the part of plaintiffs and less litigation in the long run.

II. BACKGROUND—EVOLUTION OF THE RIGHT OF PUBLICITY

A. Historical Roots: The Right of Privacy

In their famous article, The Right to Privacy, Louis Brandeis and Samuel Warren articulated concern that the media had become an encroachment into "the sacred precincts of private and domestic life . . . ." Fearful that the media overstepped in every direction, Brandeis and Warren discussed the consequences of modern enterprise and invention that had the ability to subject society to mental pain and distress, oftentimes far greater than that which could be inflicted by mere bodily injury. Furthermore, Brandeis and Warren suggested that protection of society must stem from the rights of individuals, so that an injured individual can recover compensation under the law for a violation of the right of publicity. In other words, to offset the media's intrusion into areas where citizens had a reasonable expectation of privacy, individuals must have a legal cause of action against violations of this right.

13. See Doe v. TCI Cablevision, 110 S.W.3d 363 (Mo. 2003) (applying the predominant purpose test).
14. See discussion infra Part IV.
15. See discussion infra Part V.
16. See MCCARTHY, supra note 3, at § 3:1.
18. Id. at 196.
19. Id.
20. Id. at 215.
Since the conception of the right to privacy, there has been tension between the right to one's persona and the First Amendment. Absent actual defamation, a private citizen whose persona or likeness was taken without permission historically had no cause of action. One of the first cases to address this tension was *Roberson v. Rochester Folding Box Co.* This case involved a commercial appropriation of a private citizen's likeness on an advertisement for flour without her permission. The private citizen, Roberson, was unable to recover for the type of injury described by the Brandeis and Warren article because New York refused to recognize any common law right of privacy. However, shortly thereafter, due in part to public outrage, the New York legislature passed a law that recognized an individual's cause of action for violation of the right to privacy.

In 1905, Georgia became the first state to recognize a common law right to privacy in *Pavesich v. New England Life Insurance Co.* Like *Roberson*, the case involved the unauthorized use of the plaintiff's likeness in an advertisement, this time for life insurance. The Georgia Supreme Court found that the right to privacy is a natural right, and that such privacy rights have always coexisted with the First Amendment and could still be harmonized.

23. *See id.*
24. *Id.* at 447 (holding that the right of privacy is not one of the ills that can be redressed under the law).
25. N.Y. CIV. RIGHTS LAW § 50 (McKinney 2004) ("A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, or if a minor of his or her parent or guardian, is guilty of a misdemeanor.").
26. *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905) (holding that an individual has a right to privacy which can be enforced and which the courts will protect against invasion).
27. *Id.*
28. *Id.* at 73 ("The stumbling block which many have encountered in the way of a recognition of the existence of a right of privacy has been that the recognition of such right would inevitably tend to curtail the liberty of speech and of the press. The right to speak and the right of privacy have been coexistent. Each is a natural right, each exists, and each must be recognized and enforced with due respect for the other.").
B. Creation of the Right of Publicity

In 1953, the Second Circuit Court of Appeals was the first court to recognize the concept that is now referred to as the "right of publicity," in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* This case involved an exclusive contract between a seller of chewing gum and a baseball player for use of the player's photograph in connection with the sale of gum. With knowledge of this preexisting contract, a rival company deliberately induced the same baseball player to simultaneously authorize use of his photos and thus breach his preexisting exclusive contract.

The court rejected the contention that plaintiff's contract did not vest any property right in the plaintiff. The court ruled that "in addition to and independent of that right of privacy . . . a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made 'in gross' . . . ." Furthermore, the court reasoned that prominent persons such as actors and ball-players would be sorely deprived if they could not receive money for use of their likenesses in public places.

Six years later, Professor William Prosser published his famous article on torts providing what are now considered the definitive elements of the privacy cause of action. In this definition, he included the right of publicity, the type of claim that Professor Melville Nimmer argued was protected under the right of publicity following *Haelan.* Prosser divided the right to privacy into four categories: 1) intrusion

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30. *Id.*
31. *Id.* at 867.
32. *Id.*
33. *Id.* at 868.
34. *Id.*
37. BARRETT, *supra* note 1, at 1025.
38. *See Nimmer, supra* note 35.
upon the plaintiff's seclusion, solitude, or private affairs, 2) public disclosure of embarrassing private facts about the plaintiff, 3) publicity which places the plaintiff in a false light in the public eye, and 4) appropriation of the plaintiff's name or likeness for the defendant's advantage. The inclusion of both private and public plaintiffs in this category blurred the distinction between the right to privacy and the right of publicity identified by Haelan.

In 1977, the United States Supreme Court granted certiorari in its first and only right of publicity case: Zacchini v. Scripps-Howard Broadcasting Company. Zacchini involved an alleged commercial misappropriation of an entertainer's human cannonball act. The defendant videotaped the plaintiff's entire act and broadcasted it on the news. The United States Supreme Court overturned the Ohio Supreme Court and held that the First Amendment did not shield the defendant from liability. The Court's primary concern was the substantial economic threat posed by broadcast of the plaintiff's performance because if the public can see the act for free on television, then they would be less willing to pay to see it live. The Court also made a distinction between the unauthorized use of a person's name or likeness for purposes of trade and the incidental use of a performer's name or likeness by the press. In this case, such a distinction was especially justified because the broadcast went "to the heart of the petitioner's ability to earn a living."

In 1979, the California Supreme Court decided the next seminal case involving the right of publicity in Lugosi v. Universal Pictures. Lugosi involved the postmortem

40. See BARRETT, supra note 1, at 1025.
42. Id. at 565.
43. Id.
44. Id.
45. Id. at 575-76. The tension between the First Amendment and the right of publicity is evident in this case. While society may be enriched by broadcast of Zacchini's act, the court heavily weighs the inequitable result in favor of Zacchini. Id.
46. Id.
47. Zacchini, 433 U.S. at 575-77. See also infra Part I.C. for a more extensive discussion of the right of publicity and the First Amendment.
publicity rights of Bela Lugosi and the use of his likeness as Count Dracula in connection with the sale of commercial merchandise. The majority found that Lugosi neither portrayed himself nor created the character of Dracula, but merely acted out a popular role that became well known over time. Therefore, he could not control exploitation of the Count Dracula character. Because his performance gave him no more of a claim to Count Dracula than any other actor who also played a memorable role, Lugosi had no inheritable property right.

In contrast, the dissent in Lugosi argued that a separate right of publicity was needed to protect a celebrity's interest in the economic value of commercial use of his name or likeness. The dissent also argued that this interest should be inheritable because it was proprietary during the celebrity's lifetime. As a matter of course, five years after the decision in Lugosi, the California legislature passed a statute recognizing postmortem rights of publicity.

In 1992, the Ninth Circuit Court of Appeals broadened the common law definition of the right of publicity in White v. Samsung Electronics America, Inc. This case involved an advertisement for Samsung video cassette recorders (VCRs) which evoked the image of Vanna White. Although the

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49. See id. at 426-27.
50. Id. at 432.
51. Id.
52. Id. The court also notes that a contract specifying the postmortem publicity right of the Count Dracula character in Lugosi and his heirs might have resulted in a different outcome. Id.
53. Id. at 444-45 (Bird, C.J., dissenting).
54. Lugosi, 603 P.2d at 447 (Bird, C.J., dissenting).
55. CAL. CIV. CODE § 3344.1 (Deering 2004) (“Any person who uses a deceased personality’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purpose of advertising or selling, or soliciting purchases, of products, merchandise, goods, or services, without prior consent from the person or persons specified . . . shall be liable for any damages sustained by the person or person injured thereof.”).
56. This right was initially articulated by the California Court of Appeals. See Eastwood v. Superior Court, 149 Cal. App. 3d 409 (1983). The common law cause of action for the right of publicity may be plead by alleging: “(1) the defendant’s use of the plaintiff’s identity; (2) the appropriation of plaintiff’s name or likeness to defendant’s advantage, commercial or otherwise; (3) lack of consent; and (4) resulting injury.” Id. at 417.
58. Id. at 1396 (“The ad depicted a robot, dressed in a wig, gown, and jewelry . . . consciously selected to resemble White’s hair and dress. The robot
majority held that the advertisement in question did not appropriate White’s name or likeness,\(^5\) it nevertheless found in White’s favor.\(^6\) The court held that a common law right of publicity claim need not necessarily be limited to an allegation for appropriation of a name or likeness, but could also include an image, identity or anything associated with the person.\(^6\) Furthermore, the majority rejected the defendants’ parody defense\(^6\) and stated that their arguments were better addressed to non-commercial parodies.\(^6\) Both defendants’ arguments and those of the dissenters will be considered in more detail below.\(^6\)

In 1995, the Restatement (Third) of Unfair Competition\(^6\) defined the right of publicity as the appropriation of the “commercial value of a person’s identity.”\(^6\) The Restatement recognized that the right of publicity is fundamentally

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59. See id. at 1396-98.
60. Id.
61. Id. at 1397-98.
62. Id. at 1401 (“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.’”).
63. Samsung, 971 F.2d at 1401. In disagreement with the dissent, Judge Goodwin stated:

In warning of a first amendment chill to expressive conduct, the dissent reads this decision too broadly . . . This case concerns only the market which exists in our society for the exploitation of celebrity to sell products, and an attempt to take a free ride on a celebrity’s celebrity value. Commercial advertising which relies on celebrity fame is different from other forms of expressive activity in two crucial ways.

First, for celebrity exploitation advertising to be effective, the advertisement must evoke the celebrity’s identity. The more effective the evocation, the better the advertisement. If, as Samsung claims, its ad was based on a “generic” game-show hostess and not on Vanna White, the ad would not have violated anyone’s right of publicity, but it would also not have been as humorous or as effective.

Second, even if some forms of expressive activity, such as parody, do rely on identity evocation, the first amendment hurdle will bar most right of publicity actions against those activities.

Id. at 1401 n.3 (citations omitted).
64. See discussion infra Part II.C.
66. Id. (“One who appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade is subject to liability for the relief appropriate under the rules stated [herein].”).
constrained by public policy and constitutional interests in the freedom of expression. The authors further stated that "[t]he use of a person's identity primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation of the person's right of publicity." This limitation was not restricted to news reporting but also extended to entertainment and other creative works. The Restatement, however, stated that protection would be limited if either the name or likeness was used solely to attract attention to a work unrelated to the identified person, or if the work contained substantial falsifications.

C. The Scope of the Right of Publicity and the First Amendment

Currently, the right of publicity is generally known as the right to control the use of one's own name, picture, or likeness in order to prevent others from using it, without consent, for commercial benefit. While each state sets forth its own right of publicity standards, the right is generally recognized as based in common law, and often supplemented by statute. While most courts agree on the elements that establish the right of publicity cause of action, whether or not the use of a person's identity is protected under the First

67. Id. § 47 cmt. c.
68. Id.
69. Id.
70. Id.
71. See MCCARTHY, supra note 3, at § 3:2.
72. See id. §§ 6:1-6:127. Seven states, including New York, recognize a statutory right of publicity. Id. The following states recognize a common law right of publicity: Arizona, Alabama, California, Connecticut, Florida, Georgia, Hawaii, Illinois, Kentucky, Michigan, Minnesota, Missouri, New Jersey, Ohio, Pennsylvania, Texas, Utah and Wisconsin. Id. Furthermore, ten additional states have statutes protecting the right of privacy, but are worded in such a way to embody the right of publicity: Indiana, Massachusetts, Nebraska, Nevada, New York, Oklahoma, Rhode Island, Tennessee, Virginia, and Washington. Id.
73. See, e.g., ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003); Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001); Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959 (10th Cir. 1996); World Wrestling Fed'n Entm't, Inc. v. Big Dog Holdings, Inc., 280 F. Supp. 2d 413 (W.D.Pa 2003); Winter v. DC Comics, 69 P.3d 473 (Cal. 2003); Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797 (Cal. 2001); Doe v. TCI Cablevision, 110 S.W.3d 363 (Mo. 2003).
Amendment remains unresolved.

Generally, courts apply four main approaches to determine whether expression under the First Amendment is protected at the expense of the right of publicity. Under the first approach, courts evaluate whether the use by a defendant is commercial or non-commercial in nature. Under the second approach, courts take into account whether the use is a parody. Under the third approach, courts may consider whether the use is transformative as compared to the original work. Under the final approach, courts assess whether the predominant purpose of the use is expressive or commercial. This comment will focus on the last two approaches, and in particular, will examine the legitimacy of each approach.

1. Commercial Speech

Since the Supreme Court's ruling in Zacchini, lower courts have recognized that commercial speech has special meaning within the context of the First Amendment. While commercial speech is entitled to some First Amendment protection; it is not entitled to the same level of protection as other types of protected expression. Thus, the threshold

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74. See, e.g., Levine, supra note 6, at 180-84, 216-21; Wanat, supra note 6, at 256-70.
75. See, e.g., Hoffman, 255 F.3d at 1180.
76. See, e.g., White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1395 (9th Cir. 1992); World Wrestling Fed'n Entm't, 280 F. Supp. 2d at 413; Cardtoons, 95 F.3d at 972.
77. A transformative use is one in which the alleged infringing work supersedes the original work. Comedy III Prods., 21 P.3d at 809. Cf. L. Batlin & Sons, Inc. v. Snyder, 536 F.2d 486, 490-91 (2d Cir. 1976) (defining transformative as something more than a "merely trivial variation").
78. See, e.g., ETW Corp., 332 F.3d at 915; Comedy III Prods., 21 P.3d at 797; Winter, 69 P.3d at 473.
79. See, e.g., Doe v. TCI Cablevision, 110 S.W.3d 363 (Mo. 2003).
80. Hoffman, 255 F.3d at 1184-85.
82. Hoffman, 255 F.3d at 1184-85 (citing prior cases that have addressed
question for some courts when publicity rights are at odds with the First Amendment has often been whether the expression in question is commercial or non-commercial. 83 Although the Court has concluded that the commercial nature of speech is irrelevant for purposes of determining whether such speech comes within the First Amendment, 84 lower courts have rarely given protection to the use of a person's identity when the use is for a purely commercial purpose. 85

Today, because celebrity endorsements have enormous selling power and because public perception of any particular celebrity affects their fame, celebrities have an interest in the products on which their photographs or likenesses appear. For instance, in Hoffman v. Capital Cities/ABC, Inc., 86 the Ninth Circuit Court of Appeals held that Los Angeles Magazine's ("LAM") article featuring digitally altered photographs of actors and their famous characters wearing modern fashion designs was not commercial speech and was therefore entitled to the full First Amendment protection accorded to non-commercial speech. 87 The court determined that any commercial aspect of LAM's article was inextricably intertwined with expression and this was fully protected. 88 After Hoffman, courts were left with two important considerations when balancing the conflict between the right

the nature of and constitutional protection given to commercial speech). See, e.g., Cent. Hudson, 447 U.S. at 561-65.


84. Va. State Bd. of Pharmacy, 425 U.S. at 762. However, the Court also noted that there are certain circumstances where First Amendment protection would not be provided, such as when speech falls in the realm of false or deceptive advertising. Id.

85. See, e.g., Downing v. Abercrombie & Fitch, 265 F.3d 994, 1002 (9th Cir. 2001) (finding that Abercrombie's use of surfer's photographs in it's catalog was significantly commercial in nature and thus not entitled to full First Amendment protection); White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1397-99 (9th Cir 1992); Midler v. Ford Motor Co., 849 F.2d 460, 462-64 (9th Cir. 1988) (holding that when a distinctive voice of a celebrity singer is imitated to sell a product, the sellers have misappropriated her voice).

86. Hoffman, 255 F.3d 1180 (involving a cause of action for commercial misappropriation of an actor's likeness in an article which used computer technology to alter famous film stills).

87. Id. at 1185-87.

88. Id. at 1185 (describing the article as "a combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors").
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of publicity and the First Amendment: "(1) whether the purpose of the use is definitively advertising to sell a product; and (2) whether the commercial quality of the use, if any, is inseparable from expressive content."89

2. Parody

First Amendment protection is unconditionally granted to certain types of expression such as parody. In the copyright context, parody is often viewed as a fair use,90 allowing for use of a work for a limited purpose, despite the exclusive copyright law rights vested in an author. In his dissenting opinion in White v. Samsung, Judge Kozinski made a passionate and compelling argument in support of a rich public domain.91 This called for a parody exception to the right of publicity, even where commercial speech was involved.92 Judge Kozinski argued that the First Amendment was a means to protect not only the free development of culture, but also of religion and politics.93 Accordingly, Judge Kozinski viewed parody as one of the vital components to the marketplace of ideas.94

The Tenth Circuit Court of Appeals also examined the parody defense in Cardtoons, L.C. v. Major League Baseball Players Association.95 Here, while the court recognized the

89. Wanat, supra note 6, at 257.
90. See 17 U.S.C. § 107 (2000) ("[T]he fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by §§ 106 and 106A, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.").
91. White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting from order rejecting rehearing en banc).
92. Id. at 1513 (Kozinski, J., dissenting from order rejecting rehearing en banc).
93. Id. at 1519 (Kozinski, J., dissenting from order rejecting rehearing en banc).
94. Id. (Kozinski, J., dissenting from order rejecting rehearing en banc).
95. Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959 (10th Cir. 1996). The court held that the expressive materials found on the
social value served by parodies, it also found that they were not per se protected.96 A more recent decision that addressed the parody defense was World Wrestling Federation Entertainment, Inc. v. Big Dog Holding, Inc.97 In this case, the court held that the defendant’s use of World Wrestling Federation Entertainment’s (“WWE”) character caricatures on its merchandise, was an important form of expressive commentary which deserved First Amendment protection.98 The court followed the framework of Cardtoons and found that the defendant added significant artistic and imaginative expression to its graphics.99 These contributions superseded any interest in the protection of WWE’s publicity right.100

3. Transformative Use

The California Supreme Court adopted what has become known as the transformative use test in its recent ruling in Comedy III Productions, Inc. v. Gary Saderup, Inc.101 The transformative use test attempts to strike a balance between the First Amendment and the right of publicity.102 Comedy III involved a cause of action against Saderup, a professional artist who created and sold copies of a charcoal drawing of the Three Stooges without permission from the Stooges’ estates.103 Although the court found expressive elements in Saderup’s work, it rejected his First Amendment defense.104

trading cards in question contained various artistic and literary devices, namely parody. Id. at 969-70.

96. Wanat, supra note 6, at 265.
97. World Wrestling Fed’n Entm’t, Inc., v. Big Dog Holdings, Inc., 280 F. Supp. 2d 413 (W.D.Pa. 2003). This case involved the sale of merchandise which poked fun, mocked, and ridiculed certain well-known wrestling characters whose intellectual property rights were owned WWE. Id. at 418.
98. Id. at 445.
99. Id.
100. Id.
102. Id. at 799.
103. Id. at 800-02. Lithographic prints of the drawings as well as T-shirts with the drawing printed on it were sold. Id. at 800-01. However, the “lithographs and T-shirts did not constitute an advertisement, endorsement, or sponsorship of any product.” Id. at 801.
104. Id. at 803. The court also points out that other courts often observe that “entertainment is entitled to the same constitutional protection as the exposition of ideas.” Id. at 804 (citing Guglielmi v. Spelling-Goldberg Prods., 603 P.2d 454, 458-59 (Cal. 1979) (Bird, C.J., concurring)). Furthermore, the fact that Saderup’s expression takes the form of visual representation does not remove it from First Amendment protection. Id. at 804.
The court looked at the purposes of the First Amendment and adopted an element of the fair use test employed by copyright law. Accordingly, it stated that the inquiry was "whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's expression rather than the celebrity's likeness." The court noted that this inquiry should be conducted quantitatively rather than qualitatively. In other words, as opposed to looking at the work as a whole, a court must assess whether the literal, imitative, or the creative elements predominate the work in such a way as to make the work transformative. Ultimately, the court ruled against Saderup because it did not discern any significant transformative or creative input in his work.

Winter v. DC Comics and ETW Corp. v. Jireh Publishing, Inc. are two recent cases that have applied the transformative use test and have ruled in favor of an artist's right to the protection of publicity under the First Amendment. In Winter, the California Supreme Court found that a comic book which contained the likeness of two famous singers as half-worm, half-human villains possessed significant creative elements that transformed them into

105. Id. at 803. The purposes stated were "to preserve an uninhibited marketplace of ideas" and a "fundamental respect for individual development and self-realization." Id. (citing Guglielmi, 603 P.2d at 458 (Bird, C.J., concurring)).

106. See id. at 808-09. The court adopted the "purpose and character of use" element of the fair use test used in copyright law. See 17 U.S.C. § 107(2) (2000). This element was deemed pertinent in reconciling the rights of expression and publicity because a new work that supersedes "the original creation, or instead adds something new, with a further purpose or different character" furthers the goal of intellectual property rights; that of promoting the science and the arts. Comedy III Prods., 21 P.3d at 808-09.

107. Comedy III Prods., 21 P.3d at 809. The court also notes that expression "means[s] expression of something other than the likeness of the celebrity." Id.

108. Id.

109. Id. at 809 n.11 (comparing and disagreeing with the ruling in ETW Corp. v. Jireh Publ'g, Inc., 99 F. Supp. 2d 829 (N.D. Ohio 2000)).

110. Id. at 811. But see ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003) (finding that a work of art consisting of a collage of images in addition to the likeness of Tiger Woods contains significant transformative elements); Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001) (finding that alternation of a photograph using computer technology would be sufficient for purposes of the transformative use test).


112. ETW Corp., 332 F.3d 915.
something more than mere celebrity likenesses.\footnote{Winter, 69 P.3d at 476. This case involved a cause of action against DC Comics by well known musicians Johnny and Edgar Winter for misappropriation of their name and likeness. Id.} The court stated that while the fictional characters were hardly subtle evocations of the Winter brothers, the books did not literally depict them.\footnote{Id. at 479.} Thus, to the extent that the drawings of the comic book characters resembled the plaintiffs, such resemblances were distorted for purposes of lampoon, parody, or caricature.\footnote{Id.} Moreover, the comic book characters did not affect the plaintiffs' right of publicity in the economic sense because fans who sought pictures or drawings of the Winter Brothers would have found the comic book characters an unsatisfactory substitute.\footnote{Id. at 479.}

In *ETW Corp. v. Jireh Publishing, Inc.*, the Sixth Circuit Court of Appeals similarly found that artwork that included the likeness of Tiger Woods contained significant transformative elements making it worthy of First Amendment protection under the transformative use test.\footnote{ETW Corp., 332 F.3d at 938. This case involved a cause of action against the publisher of a work created by Rick Rush, a sports artist, entitled *The Masters of Augusta*, which contains the likeness of Tiger Woods. Id. at 918. ETW is the licensing agent of Tiger Woods. Id.} The court found that the work was a piece of art, portraying a historic moment in sports history,\footnote{Id. at 936.} and was thus more than a mere literal likeness of Tiger Woods.\footnote{Id.} Viewing the two works as a whole, the artwork in *ETW* contained a collage of images to commemorate an event as opposed to a literal depiction of a celebrity's likeness. Therefore, the distinction between the work in question here and the charcoal drawings in *Comedy III* was that the former did not capitalize solely on a literal depiction of Tiger Woods.\footnote{Id. at 938.}

4. Predominant Purpose

In contrast, the Missouri Supreme Court's 2003 ruling in *Doe v. TCI Cablevision*\footnote{Doe v. TCI Cablevision, 110 S.W.3d 363 (Mo. 2003).} adopted the predominant purpose test to determine the circumstances under which the First
Amendment prevails over the right of publicity. In *Doe*, Tony Twist, a former professional hockey player, brought a suit for misappropriation after he learned that a villainous character shared his name in the *Spawn* comic book series. However, the fictional Tony Twist bore no physical resemblance to the plaintiff. Perhaps the only similarity between the two was that both could be characterized as having “tough guy” personas. Nevertheless, the evidence showed that fans associated the comic character with the real Tony Twist, while the creators of *Spawn* benefited from the use of Tony Twist’s name.

In order to balance the comic book creator’s First Amendment right against the right of publicity, the Missouri Supreme Court found that California’s transformative use test did not adequately consider that many uses of a person’s name and identity can have both expressive and commercial components. Where both expressive and commercial speech is involved, the court found that the predominant purpose test provided a better balance between the First Amendment and the right of publicity. Therefore, the proper inquiry is:

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 expressive comment on or about a celebrity, the expressive values could be given greater weight.

The court applied this test and held in favor of Tony Twist because the use of his identity was predominately a ploy to sell comics books and other merchandise unrelated to

122. *Id.* at 365.
123. *Id.* at 366.
124. *Id.*
125. *Id.* at 367.
126. *Id.* at 374.
any interest in artistic or literary expression.\textsuperscript{129}

III. LEGAL PROBLEM—LIMITING GROWTH OF THE PUBLIC DOMAIN AND CHILLING FREE SPEECH

The purpose of any intellectual property right is to encourage creativity, promote diversity, and preserve a competitive marketplace.\textsuperscript{130} In part, this goal is achieved both by the placement of ideas into the public domain and respect for the First Amendment.\textsuperscript{131} Therefore, the overprotection of intellectual property is just as dangerous as under-protection.\textsuperscript{132} However, the incentive for creativity is tied up in the expectation that creators will benefit from the fruits of their labor.\textsuperscript{133} For example, a celebrity that expends time and effort developing a character should be entitled to a property right in his or her investment. On the other hand, the argument can be made that celebrities, their likenesses and their identities belong to the public domain because celebrities are universal points of reference for the public, allowing society to share a common experience and a collective memory.\textsuperscript{134} Celebrities allow people to make connections to other people and across generations through the characters they play and what they represent.

Given the central societal role celebrities play, protection of their publicity rights should not come at the expense of the public domain. The problem involves protection of expression under the First Amendment and simultaneous preservation of the right of publicity without inconsistent and arbitrary results. Courts apply a variety of tests and consider approaches such as the commercial or transformative nature of the alleged use, and the predominant purpose of the use.\textsuperscript{135}

\textsuperscript{129} \textit{Id.}
\textsuperscript{130} See \textit{Barrett}, \textit{supra} note 1, at 2.
\textsuperscript{131} U.S. CONST. amend. I.
\textsuperscript{132} White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting from order rejecting rehearing \textit{en banc}).
\textsuperscript{133} See \textit{Barrett}, \textit{supra} note 1, at 2-3.
\textsuperscript{134} JOHN B. THOMPSON, IDENTITY AND MODERN CULTURE: CRITICAL SOCIAL THEORY IN THE ERA OF MASS COMMUNICATION 163 (1990).
\textsuperscript{135} See, e.g., ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003); Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001); Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959 (10th Cir. 1996); World Wrestling Fed'n Entm't, Inc. v. Big Dog Holdings, Inc., 280 F. Supp. 2d 413 (W.D.Pa 2003); Winter v. DC Comics, 69 P.3d 473 (Cal. 2003); Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797 (Cal. 2001); Doe v. TCI
All of these tests, however, have shortcomings. For example, because commercial speech is afforded some First Amendment protection,\textsuperscript{136} it is not clear whether expression is commercial or non-commercial speech. Additionally, protected expression\textsuperscript{137} is often so intertwined with commercial speech that the two cannot be separated.\textsuperscript{138} The transformative use test does not clearly define how much transformation is needed in order for a work to be protected.\textsuperscript{139} The predominant purpose test primarily assesses whether expression is commercial and is thus a heightened manifestation of the transformative use test.\textsuperscript{140} Consequently, the predominant purpose test calls for a comparison of values while at the same time unduly restricting First Amendment protection. Thus, with the exception of parody, the tests currently imposed are vague and lack concrete elements.

The application of vague tests results in inconsistent and inefficient outcomes for both courts and litigants. Courts that apply a variety of tests will be faced with a higher number of appeals since litigants will advocate for the adoption of an

\textsuperscript{Cablevision, 110 S.W.3d 363 (Mo. 2003).}
\textsuperscript{136. See, e.g., Greater New Orleans Broad. Ass'n, Inc. v. United States, 527 U.S. 173 (1999) (setting forth a four part test to evaluate the constitutionality of governmental regulation of speech that is commercial in nature).}
\textsuperscript{137. See Nat'l Endowment for the Arts v. Finley, 524 U.S. 569, 601-03 (1998). (giving examples of expression that are protected under the First Amendment).}
\textsuperscript{Constitutional protection of artistic works turns not on the political significance that may be attributable to such productions, though they may indeed comment on the political, but simply on their expressive character, which falls within a spectrum of protected "speech" extending outward from the core of overtly political declarations. Put differently, art is entitled to full protection because our "cultural life," just like our native politics, "rests upon [the] ideal" of governmental viewpoint neutrality.}
\textsuperscript{Id. at 602-03 (citing Turner Broad. Sys. v. FCC, 512 U.S. 622, 641 (1994)) (footnote omitted).}
\textsuperscript{138. See Hoffman, 255 F.3d at 1185-86. (citing Gaudiya Vaishnava Soc'y v. City & County of San Francisco, 952 F.2d 1059, 1064 (9th Cir. 1990) (showing the difference between protected speech and speech that does no more than propose a commercial transaction)).}
\textsuperscript{139. See Dougherty, supra note 6, at 7, 22-28.}
alternative test. Further, without a clear rule, litigants are faced with inconsistent rights and obligations depending on the jurisdiction in which they bring their claims. This leads to the potential procedural problem of forum shopping. If the right of publicity is over-protected at the expense of the First Amendment, there will be a limited public domain as well as a chilling effect on free speech.

IV. ANALYSIS

A. The Weaknesses of the Transformative Use Test

The transformative use test asks whether an original work is a synthesis of a celebrity likeness or whether the depiction of the celebrity is the main substance of the work in question.\textsuperscript{141} The test measures this by asking "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."\textsuperscript{142}

Unfortunately, the transformative use test has many open-ended questions that preclude it from providing a workable resolution. Most notably, the test does not clearly define the point at which expression becomes transformative. In addition, the portion of the test requiring an inquiry into the marketability and economic value of the challenged work is difficult for courts because it is very subjective. Lastly, the test will lead to the unintentional and undue chilling of free speech and expression.

The court rejected Saderup's argument that all portraiture involves creative decision and therefore merits protection by the First Amendment.\textsuperscript{143} The court reasoned that an artist "must contribute more than a 'merely trivial' variation."\textsuperscript{144} To illustrate what constitutes sufficient variation, the court referred to the portraits of Marilyn Monroe and Elvis Presley created by Andy Warhol.\textsuperscript{145} The

\textsuperscript{141} Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 809 (Cal. 2001).

\textsuperscript{142} Id.

\textsuperscript{143} Id. at 810.

\textsuperscript{144} Id. (quoting L. Batlin & Sons, Inc. v. Snyder, 536 F.2d 486, 490 (2d Cir. 1976)).

\textsuperscript{145} Id. at 811 ("Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial
court felt that Warhol's work was transformative because it undeniably exhibited a departure from the conventional celebrity portrait and entered the realm of social commentary. By referencing Warhol's art, the court seemingly required that the artistic expression enter the realm of social commentary in order to be considered transformative. Such a standard, however, contradicts precedent set by the United States Supreme Court which states that a work of art is protected by the First Amendment even if it conveys no discernable message.

The transformative use test applied in Comedy III is misleading because the court did not follow its own standard for determining whether a work is transformative. As stated above, it did not define what would constitute "more than a 'merely trivial' variation" or something "recognizably '[the artist's] own." Although Saderup made charcoal drawings of celebrities for over twenty-five years, the court found his drawings were not works that recognizably belonged to him.

The phrase "more than a merely trivial variation" was prominently applied in a copyright case involving a plastic reproduction of a toy bank. There, the court ruled that changing the medium of expression from a cast iron toy bank to a plastic toy bank was insufficient originality to warrant a new copyright, and was therefore not entitled to First Amendment protection. In contrast, the same cannot be said of Saderup's charcoal drawing, since it was his original creation. Thus, if transformativeness is more than a mere trivial variation recognizably belonging to an artist, original works of art that include the likeness of a celebrity should be protected under the First Amendment.

Cases subsequent to Comedy III that have ruled in favor exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself.

146. Id.
148. Id. at 810 (quoting L. Batlin & Sons, 536 F.2d at 490).
149. Id. at 800.
150. Id. at 797.
151. L. Batlin & Sons, 536 F.2d at 490 (quoting Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 103 (2d Cir. 1951)).
152. Id. at 491.
of an artist's First Amendment right provide more guidance as to what constitutes a transformative work. Shortly after Comedy III, the Ninth Circuit, considered the transformative use test in its ruling in Hoffman. The court noted that Hoffman's body was edited out and a new, differently clothed body was substituted in its place, making the photograph in question significantly transformative. Therefore, it is possible to infer that a change in the composition of an original photograph constitutes sufficient transformation.

In Comedy III, the court also stated that the inquiry of transformativeness should be "more quantitative, rather than qualitative." The court did not mean to imply that a specific numerical determination was necessary. Rather, the court looked at whether some quantity of transformation was made to the allegedly infringing work instead of using a pure qualitative aesthetic analysis. A quantitative analysis is difficult because it requires line-drawing and because it is unclear as to how much expression must be added to an original work to achieve transformativeness. Moreover, the issue of who determines transformativeness is troubling because artistic or aesthetic judgment is traditionally not the role of judges and juries. Ultimately, it may become necessary for courts to require testimony from an "is-it-imaginative-or-is-it-creative expert," thereby adding further complication to existing litigation. The qualification such an expert creates would be an entirely subjective task because it is difficult to view art within a purely objective or analytical framework.

As a secondary inquiry, the Comedy III court stated that if the value of the work came principally from creativity, skill and reputation of the artist rather than from a celebrity's fame, then it could be presumed that there were sufficient transformative elements to warrant First Amendment

153. See Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1184 (9th Cir. 2001). The court also considered factors such as whether the use was commercial, whether the article contained expressive elements, and whether there was an intent to deceive the reader of the article. See id. at 1184-89.
154. Id.
155. Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 809 (Cal. 2001) ("The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.").
156. Levine, supra note 6, at 217.
FINDING THE PROPER BALANCE

This inquiry is difficult to assess within the context of any work in which a celebrity's likeness is appropriated because of its inherent value. Even Andy Warhol's social commentary on celebrities would have had little value absent the celebrities' fame. Perhaps one might argue that in Warhol's case, his skill and reputation surpassed the fame of the celebrities, but very few artists are likely to achieve his level of celebrity.

In 2003, the Sixth Circuit also recognized transformativeness in an artist's creation in ETW Corp. v. Jireh Publishing, Inc. The court reasoned that since the artist's work was a "collage of images combined to describe, in artistic form, a historic event in sports history," the work contained significant transformative elements. The significant factor of this work was its combination of images. Thus, while an image of Tiger Woods alone might not have received constitutional protection, Tiger Woods's likeness in combination with the likenesses of other golf legends sufficed to pass the transformative threshold.

In summary, Hoffman and ETW Corp. both indicate that if Saderup's work included an element that changed the way in which the Three Stooges were commonly depicted, or if Saderup chose to combine the likeness of the Three Stooges with other comedians or a historical event, then his portraits would have been considered transformative.

The final weakness of the transformative use test is that it quickly chills free speech. For example, celebrity depictions created with any skill will become a thing of the past, while artists either will have to pay for the right to depict celebrities in their work or refrain from depicting them altogether. Celebrity impersonators will also face the negative effects of the transformative use test; for instance, poor imitators will be labeled creative while skilled ones are forced out of business. Accordingly, a better-defined and more categorical compromise is needed. If a potential lawsuit threatens every artist that accurately depicts a celebrity, then the incentive to create artistic depictions will be entirely lost.

157. Comedy III Prods., 21 P.3d at 810.
158. ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 938 (6th Cir. 2003).
159. Id.
160. See generally Dougherty, supra note 6, at 1.
161. Levine, supra note 6, at 219.
This will certainly stifle creativity in the public domain.

B. The Weaknesses of the Predominant Purpose Test

The predominant purpose test looks at whether the product being sold predominately exploits the commercial value of an individual's identity, even if it contains some expressive content that qualifies as speech in other circumstances.\(^{162}\) This test is even less effective than the transformative use test. First, it fails to explain how courts should determine the predominant purpose of a challenged use that is both highly expressive and also commercial.\(^ {163}\) Second, by placing significant value on whether a work receives commercial benefit, the test undermines the value of free expression and unintentionally stifles creativity.

The predominant purpose test articulated in \textit{Doe} asks whether the use of a person's name and identity is "expressive," in which case it is protected, or "commercial," in which case it is generally not protected.\(^ {164}\) Consequently, this test fails to address an entire category of works: those that are both highly, if not equally, expressive and commercial. For example, even if Andy Warhol's portrait of Marilyn Monroe\(^ {165}\) had been created in order to make prints or sell T-shirts, then under the transformative use test, the portrait would have received First Amendment protection. However, under the predominant purpose test, the result for the same portrait is unclear. If Warhol's intent was predominately to use Marilyn Monroe's likeness in order to sell reproductions of his work, it is unclear whether his work would be given First Amendment protection under the predominant purpose test even though it is difficult to deny that Warhol's work is highly expressive.

The \textit{Doe} court criticized \textit{Comedy III}'s transformative use test for giving "too little consideration to the fact that many uses of a person's name and identity have both expressive and commercial components."\(^ {166}\) However, this contention lacks

\(^{162}\) Doe v. TCI Cablevision, 110 S.W.3d 363, 374 (Mo. 2003).
\(^{163}\) Recent Case, First Amendment—Right of Publicity, supra note 140, at 1280.
\(^{164}\) \textit{Doe}, 110 S.W.3d at 374.
\(^{165}\) \textit{See Comedy III Prods., Inc. v. Gary Saderup, Inc.}, 21 P.3d 797, 811 (Cal. 2001).
\(^{166}\) \textit{Doe}, 110 S.W.3d at 374.
merit. While the transformative use test is more focused on who produces a celebrity image and who appropriates value from its production, certain forms of expressive activity fall outside the boundaries of the First Amendment. This does not mean the test fails to recognize that the use of a person's identity can have both expressive and commercial components. Rather, the Doe court acted too hastily in denying First Amendment protection to works that are commercial, and it effectively undermined the precedent that commercial speech receives First Amendment protection.

It may be difficult to determine what is meant by “predominant” under the predominant purpose test because it is possible for a work to be equally expressive and commercial. In Doe, the court found evidence of commercial value based on the fact that Twist made out a prima facie case that the defendants had used his name for commercial gain. However, this finding is circular because the plaintiff’s prima facie case is necessary to reach the defendant’s First Amendment defense. Therefore, as one commentator points out, the predominant purpose test, like the transformative use test, will usually turn on expressive value and is “little more than a heightened incarnation of the California test.”

When the Doe court found against First Amendment protection, it downplayed the literary value of the comic book character and instead emphasized that the identity of the celebrity’s name had “become predominantly a ploy to sell comic books and related products.” Prominence invites creative comment, and by dismissing the literary value of

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167. Comedy III Prods., 21 P.3d at 811.
168. Doe, 110 S.W.3d at 372-73.
170. Recent Case, First Amendment—Right of Publicity, supra note 140, at 1280.
171. Id.
172. Id.
173. Doe, 110 S.W.3d at 374.
the comic book character, the court essentially gave censorship power to celebrities that is available to them when they are unhappy with certain depictions of their identities. At the same time, the court essentially destroyed the value of the artist’s metaphorical expression. The court’s preoccupation with the defendant’s commercial purpose ignored the fact that in entertainment, the expression and the commercial nature of the work or product that embodies this expression go hand in hand.

C. Comparing the Transformative Use and Predominant Purpose Tests

Applied alone, Missouri’s predominant purpose test does not provide guidance toward the achievement of a balance between the right of publicity and the First Amendment. Although the transformative use test is far from perfect, it comparatively is still more comprehensive than the predominant purpose test because it recognizes the importance of protecting expression. An examination of a case similar to Doe, decided through an application of the transformative use test will be helpful in exhibiting this position. In Winter v. DC Comics, unlike in Doe, the California Supreme Court held that DC Comics’ use of the celebrity’s likeness was protected speech. The plaintiffs argued there was evidence that the defendants traded on the plaintiff’s likeness and reputation in order to generate interest in the comic book and to increase sales. The court held that the marketing of the comic book was irrelevant to whether or not the comic book was constitutionally protected expression because under the transformative use test, the way in which a transformative work is advertised cannot

misappropriation of a plaintiff’s property right solely for commercial purposes, as if the ‘property’ was a copyrighted work that was being duplicated for profit, rather than as a commentary about a person whose celebrity status is legitimately the subject of public scrutiny”).

175. For example, the right to comment on the violence in society and the mafia by using hockey (a violent sport) and an athlete with a reputation for being a tough guy.
176. See Winter v. DC Comics, 69 P.3d 473 (Cal. 2003).
177. Id. at 476.
178. Id. at 479.
179. Id.
make the work non-transformative. If the court had adopted the predominant purpose test, the marketing of the comic book and its related merchandise would certainly have made the use predominantly commercial, regardless of DC Comics' initial intent.

The transformative use test attempts to resolve the controversy between "the recognized stature of art as speech and the protected status of commercial dissemination of speech." For example, unconditionally protecting an artist's right to use a celebrity's likeness would also allow creators of other merchandise embodying an image of the celebrity to seek protection. This would lead to a significant loss of economic rights for celebrities and may be unfair because a celebrity might invest significant time developing his or her persona. On the other hand, if the court wholly denied constitutional protection to artistic endeavors, despite a determination that the work clearly embodies expression, it would violate the First Amendment. It is difficult to draw a line, but one must be drawn. Otherwise, we will end up with a standard that is essentially categorical "under which some art would be fully protected speech under the First Amendment but other art would be treated as mere merchandise." Thus, courts should adopt a standard that looks at both the commercial nature of the work as well as the level of transformation embodied in the work and set out guidelines to determine circumstances under which a work passes the threshold of transformation.

V. PROPOSAL

Society's interests are best served if the transformative use test meets both the goals of the First Amendment and the goals of intellectual property. The First Amendment has two commonly acknowledged purposes. First, it preserves "an uninhibited marketplace of ideas" and repels efforts to limit

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180. Id. at 479-80. If the way in which a transformative work is advertised makes it non-transformative, the First Amendment would be completely undermined. See id.
181. Dougherty, supra note 6, at 28.
182. See id.
183. See id.
184. See id.
185. Id.
robust and wide-open public debate.\textsuperscript{186} Second, it protects a "fundamental respect for individual development and self-realization."\textsuperscript{187} By extension, an artist's creation plays a role in the achievement of these First Amendment goals. Be it a photograph,\textsuperscript{188} portrait,\textsuperscript{189} painting,\textsuperscript{190} or comic book,\textsuperscript{191} each of these creations contribute to the marketplace of ideas. On the other hand, celebrities are already given sizeable economic incentives for their creations and achievements.\textsuperscript{192} Therefore, it is unrealistic to argue that celebrities would not maintain their fame simply because someone gained an economic benefit as well.\textsuperscript{193} In comparison to celebrities, however, most artists will find that their economic incentives to create are stifled by a celebrity's claimed publicity right.

The United States Supreme Court has not granted certiorari to any right of publicity case since Zacchini.\textsuperscript{194} This is especially unfortunate for state and lower federal courts that would benefit from the existence of a definitive analysis for balancing the right of publicity and the First Amendment. Until the Supreme Court accepts a case, one solution may be for Congress to enact legislation to implement a test with clear standards that outlines situations in which the First Amendment trumps the right of publicity. Unlike its authority over the areas of patents and copyrights, however, Congress does not have express constitutional authority to regulate the right of publicity. Nevertheless, Congress may find authority under the Commerce Clause.\textsuperscript{195}

Another solution is to replace both the transformative use and predominant purpose tests with bright-line


\textsuperscript{187} Guglielmi, 603 P.2d at 458 (Bird, C.J., concurring).

\textsuperscript{188} Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001).

\textsuperscript{189} Comedy III Prods., 21 P.3d 797.

\textsuperscript{190} ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003).

\textsuperscript{191} Winter v. DC Comics, 69 P.3d 473 (Cal. 2003); Doe v. TCI Cablevision, 110 S.W.3d 363 (Mo. 2003).

\textsuperscript{192} ETW Corp., 332 F.3d at 938 (finding that "[e]ven in the absence of his right of publicity, [Tiger Woods] would still be able to reap substantial financial rewards from authorized appearances and endorsements").

\textsuperscript{193} See id.


\textsuperscript{195} U.S. CONST. art. I, § 8, cl. 3 ("Congress shall have Power . . . to regulate Commerce with foreign Nations, and among the several States . . . .").
categories that clearly delineate which products of expression are protected.196 As one commentator has observed, "[i]f, ultimately, non-advertising uses of expressive works depicting real people are not categorically protected from right of publicity claims, then at a minimum, visual artists should be protected from such claims when they sell copies of their works not incorporated in unrelated merchandise."197 This proposal is much more objectionable than any balancing test. While bright line categories may provide more consistent results in theory, flexibility allows for more equitable results. For example, a bright line rule against commercial merchandise will exclude highly expressive work. Moreover, within the general category of commercial merchandise, it is especially difficult to draw the line. For example, what is the difference between a work of art on canvas, as opposed to the same work printed in a magazine or a T-shirt?

The best solution is modification of the transformative use test. It should lay out more distinct standards to determine when artwork becomes transformative, and force courts to apply these standards consistently. If transformativeness is "more than a 'merely trivial' variation" that recognizably belongs to the artist,198 then original works of art should be protected under the First Amendment, even if they duplicate the likeness of a celebrity. Under this standard, the medium of expression is irrelevant; thus, it is of no consequence whether the expression is placed on canvas, on paper, or on a T-shirt. Although the marketability of the challenged work and its derivation from the status of the celebrity depicted should be considered in assessing the transformativeness of a work, this factor should not be conclusive and should not lead to a result where an expressive work with transformative elements is deemed nontransformative. Creativity, skill, and intent of the artist are subjective factors, but nevertheless relevant when determining whether a work should be protected under the

196. See Dougherty, supra note 6, at 34-41.
197. Id. at 78. Under this standard, any artwork or photograph portraying an individual in the form of print, posters, lithographs, or other reproductions, without regard to transformativeness, would be protected, while unrelated image merchandise such as T-shirts would not be protected. Id. at 73.
198. L. Batlin & Sons, Inc. v. Snyder, 536 F.2d 486, 490 (2d Cir. 1976).
First Amendment.

The transformative use test should also place the burden of proof on the plaintiff to prove non-transformativeness rather than on the defendant to prove transformativeness. Logically, the plaintiff is better positioned to identify elements that make a work a mere reproduction as opposed to something expressive. Few artistic endeavors are ever truly original because, more often than not, they derive, at least in part, from previously existing works or ideas. In addition, from the point of view of the defendant, a work is always his or her original interpretation.

The goal of intellectual property rights is to encourage a rich and creative public domain. The Constitution expressly states that patents and copyrights are given for the purpose of promoting the “Progress of Science and useful Arts . . . .” 199 Of all the intellectual property rights, the right of publicity falls closest to being an individual, natural right, inherent in all people. For this reason, most celebrities work hard to create and maintain their status as celebrities. Where the fruits of their labor are exploited, free-riding occurs, leading to unjust enrichment. However, the First Amendment is very central to the functioning of a democratic society, 200 so it would be dangerous to limit creative freedom. Balancing the interests, celebrities are less likely to be affected when their publicity rights are abrogated, than artists whose First Amendment rights are restricted.

VI. CONCLUSION

Protection of a celebrity’s right to publicity, while still encouraging creativity, requires careful balancing by courts. Although celebrities are private individuals, their influence and presence in popular culture is often so pervasive that their names, likenesses, images, characters, and identities are naturally part of the public domain. The purpose behind having a public domain is so that all members of society may draw from it and subsequently add to it. As such, when economic rights of individuals encroach upon a more

compelling public interest, the economic rights should yield. The United States Supreme Court should intervene to resolve variations among lower courts as to how the competing rights should be balanced. In the absence of such intervention, however, Congress should codify a clear and consistent test to which courts can adhere. Courts applying the proper transformative use test would help strike the correct balance between competing public and private interests. Ideally, such balance will encourage celebrities and those who depict celebrities to continue to add to the public domain, the former through the characters they embody, the latter through their works of art.
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