

No. \_\_\_\_

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IN THE  
**Supreme Court of the United States**

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ELECTRONIC ARTS INC.,  
*Petitioner,*

v.

RYAN HART, INDIVIDUALLY AND ON BEHALF OF ALL  
OTHERS SIMILARLY SITUATED,  
*Respondent.*

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On Petition for a Writ of Certiorari to the  
United States Court of Appeals for the Third Circuit

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**PETITION FOR A WRIT OF CERTIORARI**

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Alonzo Wickers IV  
DAVIS WRIGHT TREMAINE LLP  
865 S. Figueroa Street  
Suite 2400  
Los Angeles, CA 90017  
(213) 633-6800

Elizabeth A. McNamara  
DAVIS WRIGHT TREMAINE LLP  
1633 Broadway, 27th Floor  
New York, NY 10019  
(212) 489-8230

Paul M. Smith  
*Counsel of Record*  
Kenneth L. Doroshov  
Katherine A. Fallow  
Matthew E. Price  
Mark P. Gaber  
JENNER & BLOCK LLP  
1099 New York Ave. NW  
Suite 900  
Washington, DC 20001  
(202) 639-6000  
psmith@jenner.com

September 23, 2013

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**QUESTION PRESENTED**

Whether the First Amendment protects a speaker against a state-law right-of-publicity claim that challenges the realistic use of a person's name or likeness in an expressive work.

**PARTIES TO THE PROCEEDING**

The Defendant-Appellee below, who is the Petitioner before this Court, is Electronic Arts Inc.

The Plaintiff-Appellant below, who is the Respondent before this Court, is Ryan Hart, individually and on behalf of all others similarly situated.

**CORPORATE DISCLOSURE STATEMENT**

Pursuant to Rule 29.6, Petitioner states that it has no parent corporation and no publicly held corporation owns ten percent or more of Petitioner's stock.

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## OPINIONS BELOW

The opinion of the Third Circuit reversing the grant of summary judgment by the United States District Court for the District of New Jersey and remanding the case is reported at 717 F.3d 141 and reproduced at Petition to the Appendix (“Pet. App.”) 1a. The order of the Third Circuit denying Petitioner’s subsequent motion for rehearing is unreported and reproduced at Pet. App. 174a.

An initial opinion of the District Court granting Petitioner’s motion to dismiss is reported at 740 F. Supp. 2d 658 and reproduced at Pet. App. 147a. The opinion of the District Court granting summary judgment for Petitioner is reported at 808 F. Supp. 2d 757 and reproduced at Pet. App. 72a.

## JURISDICTION

The Third Circuit issued its opinion on May 21, 2013. On June 25, 2013, the original panel and the *en banc* Third Circuit denied rehearing, with two judges dissenting from the *en banc* denial. The jurisdiction of this Court is properly invoked pursuant to 28 U.S.C. § 1254(1).

## CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

This case involves the First Amendment to the United States Constitution, which states that “Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to

assemble, and to petition the Government for a redress of grievances.” U.S. Const. amend I.

### STATEMENT OF THE CASE

This case involves the collision of the First Amendment and the state-law “right of publicity” tort, an issue that has engendered conflict and disarray among the lower courts. The right of publicity is a modern tort, first recognized in 1953.<sup>1</sup> Generally used by celebrities, it accords persons an economic right in their names and likenesses, so they may “profit from the full commercial value of their identities.” *Cardtoons L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 968 (10th Cir. 1996).

In recent years, right-of-publicity suits have proliferated, targeting a variety of speech and speakers, including musicians who named famous people in their lyrics; filmmakers who produced movies documenting the lives of celebrities and historical figures; authors who wrote “unauthorized biographies”; magazines and greeting-card manufacturers who used celebrity images; video-game makers who used celebrity images in constructing virtual worlds; and artists who depicted celebrities in their artworks.<sup>2</sup>

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<sup>1</sup> *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953).

<sup>2</sup> See, e.g., *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003) (OutKast song lyrics); *Valentine v. C.B.S., Inc.*, 698 F.2d 430 (11th Cir. 1983) (Bob Dylan song lyrics); *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996) (feature movie and book about the Black Panther Party); *Ruffin-Steinback v. dePasse*, 82 F. Supp. 2d 723 (E.D. Mich. 2000), *aff’d*, 267 F.3d 457 (6th Cir. 2001) (television miniseries about the Temptations); *Tyne v. Time Warner Entm’t*

Courts have struggled to reconcile this new tort with the protections afforded by the First Amendment. This Court’s only contribution came nearly forty years ago in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977), in which the Court held that the First Amendment did not bar a right-of-publicity claim against a television station that broadcast an entertainer’s entire human-cannonball act. According to the Court, broadcasting Zacchini’s entire act posed a “substantial threat to the economic value of that performance,” and the Court contrasted the use of a performer’s “entire act” with the broadcast of a person’s name or picture in media. *Id.* at 574-76. Thus, *Zacchini* offers little or no guidance in cases involving mere *depictions* of individuals, as opposed to appropriation of their actual performances in full. Indeed, the Court was careful to cabin its decision: “[w]herever 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 do not immunize the media

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*Co., L.P.*, 901 So. 2d 802 (Fla. 2005) (movie about a shipwreck); *Matthews v. Wozencraft*, 15 F.3d 432 (5th Cir. 1994) (book about a police officer); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001) (magazine using image of Dustin Hoffman); *Hilton v. Hallmark Cards*, 599 F.3d 894 (9th Cir. 2010) (greeting card using image of Paris Hilton); *Kirby v. Sega of Am., Inc.*, 144 Cal. App. 4th 47 (2006) (video game); *No Doubt v. Activision Publ’g, Inc.*, 192 Cal. App. 4th 1018 (2011) (video game); *Martin Luther King, Jr. Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., Inc.*, 296 S.E.2d 697 (Ga. 1982) (bust of Martin Luther King, Jr.); *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915 (6th Cir. 2003) (lithograph of Tiger Woods); John Broder, *Schwarzenegger Files Suit Against Bobblehead Maker*, N.Y. Times, May 18, 2004, at <http://www.nytimes.com/2004/05/18/national/18arnold.html>.



when they broadcast a performer’s entire act without his consent.” *Id.* at 574-75.

The expressive work at issue in this case is Petitioner’s college football video game, which was alleged to include a realistic depiction of former college football player Respondent Ryan Hart. The Third Circuit (and the Ninth Circuit, in an essentially identical case also before this Court on petition for writ of certiorari)<sup>3</sup> held that the First Amendment offered no defense to Hart’s right-of-publicity claim, because the game’s depiction of Hart was *too realistic* and showed him engaged in the same activity—college football—in which he had gained his fame.

The Third and Ninth Circuits recognized that Petitioner’s video game was an expressive work, under this Court’s holding in *Brown v. Entertainment Merchants Ass’n*, 131 S. Ct. 2729 (2011). Nonetheless, they held that the game’s depiction of the plaintiffs did not enjoy First Amendment protection. According to the Third and Ninth Circuits, the depiction of a person’s image or likeness in an expressive work enjoys First Amendment protection against a right-of-publicity claim only if the depiction sufficiently alters or “transforms” the plaintiff’s image or likeness. That rule is constitutionally perverse: it affords First Amendment protection only to fanciful or distorted portrayals, not accurate or realistic ones. The rule also

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<sup>3</sup> *Keller v. Elec. Arts Inc. (In re NCAA Student-Athlete Names & Likeness Litig.)*, No. 10-15387, 724 F.3d 1268, U.S. App. LEXIS 15649 (9th Cir. July 31, 2013).

chills expression, both because it is hard to predict what a court will decide is sufficiently “transformative,” and because such an inquiry inevitably requires a court to make a subjective judgment about whether a depiction is “artistic,” thus warranting protection, or “literal,” and thus subject to liability.

The test adopted by these two circuits, moreover, conflicts with various other tests adopted by other circuits and state supreme courts, which do not focus on transformation at all. Some of these courts engage in case-by-case balancing of First Amendment interests and right-of-publicity interests—an approach that raises its own constitutional problems. Others give appropriate respect to the First Amendment by confining the right-of-publicity tort to circumstances in which the challenged depiction falsely claims a celebrity commercial endorsement or is unrelated to any other expression and thus gratuitous.

The lower courts’ various and conflicting constitutional tests have resulted in numerous irreconcilable outcomes. For example, the Sixth Circuit has held that the First Amendment protects the inclusion of a professional golfer’s realistic image, prominently displayed in a painted montage including other golfers, *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 931 (6th Cir. 2003), but the Third and Ninth Circuits now have held that the First Amendment does *not* protect an accurate digital depiction of a former college football player in a video game. As the judicial confusion has mounted, scholars, writers, and artists

have begun to recognize a major threat to free expression.<sup>4</sup> This Court’s guidance is urgently needed.

### A. Factual Background

Petitioner Electronic Arts’ enormously popular *NCAA Football* video game series, first unveiled in 1993, artistically creates a fictional interactive college football gaming experience. In each annual edition of *NCAA Football*, users can play individual games or entire seasons, selecting from among thousands of unnamed virtual players and over 100 virtual college teams. Pet. App. 4a. The virtual football games occur in virtual stadiums filled with virtual fans, coaches, cheerleaders, mascots, and referees, all meticulously crafted by Electronic Arts’ video game designers.

The virtual players (“avatars”) are clothed in their teams’ uniforms and logos. The unnamed avatars are identified only by position and jersey number (*e.g.*, QB

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<sup>4</sup> See, *e.g.*, Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 *Stan. L. Rev.* 1161 (2006); F. Jay Dougherty, *All the World’s Not a Stooge: The ‘Transformativeness’ Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 *Colum. J.L. & Arts* 1 (2003); Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 *Hous. L. Rev.* 903 (2003); Diane Leenheer Zimmerman, *Money as a Thumb on the Constitutional Scale: Weighing Speech Against Publicity Rights*, 50 *B.C. L. Rev.* 1503 (2009); Adam Liptak, *When it May Not Pay To be Famous*, *N.Y. Times*, June 1, 2013, available at <http://www.nytimes.com/2013/06/02/sunday-review/between-the-first-amendment-and-right-of-publicity.html>; Andrea Peterson, *U.S. Court Limits How Art Can Imitate Life*, *Wash. Post*, Aug. 2, 2013, available at <http://www.washingtonpost.com/blogs/the-switch/wp/2013/08/02/us-court-limits-how-art-can-imitate-life/>.

#7) but are meant to evoke real players. Thus, for example, an avatar may have an appearance (*e.g.*, height, weight, skin-tone, and throwing arm) and biographical information (*e.g.*, class year) that match those of a real player. *Id.* at 5a.

Within this realistic setting, the game fosters the user’s creativity and interactivity. As Judge Ambro put it in his dissenting opinion in this case, “*NCAA Football* involves myriad original graphics, videos, sound effects, and game scenarios. . . . Users are not reenacting real games, but rather are directing the avatars in invented games and seasons.” Pet. App. 69a. The game also includes a mode in which the user “coaches” a college team for up to thirty seasons to develop a school’s football program over time. *Id.* at 4a. Another mode allows users to control a single virtual player from high school through college, directing the virtual player’s choices regarding practices, academics, and social life—all of which affect the virtual player’s performance in a game. *Id.* at 4a-5a. “At its essence, EA’s *NCAA Football* is a work of interactive historical fiction.” *Keller v. Elec. Arts Inc. (In re NCAA Student-Athlete Names & Likeness Litig.)*, No. 10-15387, 724 F.3d 1268, \_\_\_, U.S. App. LEXIS 15649, at \*48 (9th Cir. July 31, 2013) (Thomas, J. dissenting).

## **B. Procedural Background**

1. Respondent Ryan Hart played quarterback for Rutgers University from 2002 to 2005. Pet. App. 2a. In June 2009, Hart filed this putative class action lawsuit against Electronic Arts in New Jersey state court, alleging violation of the right of publicity and other claims, and seeking hundreds of millions of dollars in

damages on behalf of the putative class and an injunction prohibiting the use of players' identities in the future and mandating the destruction of all copies of *NCAA Football* in Electronic Arts' possession. C.A. App. 93, 104-05. Electronic Arts removed the lawsuit to the United States District Court for the District of New Jersey on diversity grounds, pursuant to 28 U.S.C. § 1332. Pet. App. 6a.

Hart's right-of-publicity claim was based on the alleged use of his biographical information and likeness in the 2004, 2005, 2006, and 2009 editions of *NCAA Football*. *Id.* at 6a, 57a. Specifically, he claimed that two aspects of the game were tortious: First, the game included an animated avatar of a quarterback wearing a Rutgers uniform with Hart's physical and biographical attributes and career statistics, though not his name or photographic image. Second, in the 2009 edition, a photograph of Hart appeared in a montage when users selected Rutgers as their team. *Id.* at 57a.

In September 2011, the District Court granted summary judgment for Electronic Arts, holding that the First Amendment barred Hart's right-of-publicity claim. *Id.* at 146a.

2. In May 2013, the Third Circuit reversed and remanded. *Id.* at 59a. The court acknowledged that, under this Court's decision in *Brown*, 131 S. Ct. 2729, video games receive "the full force of First Amendment protections." Pet. App. 9a-10a. Nevertheless, the court rejected Petitioner's First Amendment defense. *Id.* at 58a-59a.

The Third Circuit surveyed the myriad legal standards that courts have applied in different

jurisdictions to determine whether the First Amendment bars a right-of-publicity claim. Among them is the test announced in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), under which an expressive work enjoys First Amendment protection against a right-of-publicity claim, unless the use of the individual's likeness is unrelated to the work or merely serves to create a false impression that the individual has endorsed the product. *See* Pet. App. 23a-31a.

The Third Circuit rejected the *Rogers* test on the ground that it was too protective of speech. In the court's view, it was "unfit for widespread application in cases that require a carefully calibrated balancing of two fundamental protections: the right of free expression and the right to control, manage, and profit from one's own identity." *Id.* at 30a.

The court also rejected the Missouri Supreme Court's "predominant use" test, enunciated in *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003). That test asks whether the "predominant purpose" of expressive speech "is to make an expressive comment on or about a celebrity," or instead whether expressive speech "predominantly exploits the commercial value of an individual's identity." Pet. App. 21a-22a (quoting *Doe*, 110 S.W.3d at 374) (quotation marks omitted).

The Third Circuit settled on a version of the transformative-use test, which it derived from *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001). The Third Circuit's transformative-use test "singular[ly] focus[es] on whether the work sufficiently transforms the celebrity's identity or likeness." Pet. App. 43a. In the Third Circuit's view, that test

“appears to strike the best balance” between the interests protected by the right of publicity and the interests protected by the First Amendment “because it provides courts with a flexible—yet uniformly applicable—analytical framework.” *Id.* at 42a.

Applying this test, the Third Circuit held that the First Amendment did not protect *NCAA Football* against Hart’s right-of-publicity claim because the game did not sufficiently “transform” Respondent’s likeness. *See id.* at 58a. The court noted that the avatar matched Hart “in terms of hair color, hair style, and skin tone,” and that the avatar’s “accessories mimic those worn by [Hart] during his time as a Rutgers player.” *Id.* at 49a. The court also emphasized the biographical information associated with the avatar, which “accurately tracks [Hart’s] vital and biographical details.” *Id.* The court summarized:

The digital Ryan Hart does what the actual Ryan Hart did while at Rutgers: he plays college football, in digital recreations of college football stadiums, filled with all the trappings of a college football game. This is not transformative; the various digitized sights and sounds in the video game do not alter or transform [Hart’s] identity in a significant way.

*Id.* at 50a.

At the same time, the court concluded that the use of an actual photo of Hart as part of a montage within the video game *was* protected by the First Amendment because the image appeared fleetingly and because “the context of [Hart’s] photograph—the montage—imbues

the image with additional meaning beyond simply being a representation of the player.” *Id.* at 58a.

Judge Ambro issued a forceful dissent. He observed that the majority misapplied the transformative-use test in its “narrow focus on an individual’s likeness, rather than how that likeness is incorporated into and transformed by the work as a whole.” *Id.* at 65a. He explained that “[t]o determine whether an individual’s identity has been ‘transformed,’ . . . it is necessary to review the likeness in the context of the work in its entirety, rather than focusing only on the individual’s likeness.” *Id.* at 62a. And here, he found, Hart’s “likeness is transformed by the artistry necessary to create a digitally rendered avatar within the imaginative and interactive world” of the video game. *Id.* at 70a.

Judge Ambro further pointed out that “[t]he protection afforded by the First Amendment to those who weave celebrities into their creative works and sell those works for profit applies equally to video games,” *id.* at 67a (citing *Brown*, 131 S. Ct. at 2733), and that the “use of real-life likeness as ‘characters’ in . . . *NCAA Football* . . . should be as protected as portrayals (fictional or nonfictional) of individuals in movies and books,” *id.* By focusing on Hart’s likeness without regard to the context of the game as a whole, the majority in effect created “a medium-specific metric that provides less protection to video games than other expressive works,” contrary to this Court’s decision in *Brown*. *Id.* at 68a-69a.



On June 25, 2013, the Third Circuit denied Electronic Arts’ petition for rehearing and rehearing *en banc*, with two judges dissenting. *Id.* at 175a.

### REASONS FOR GRANTING THE PETITION

This Court’s review is urgently needed to resolve conflicting authority concerning First Amendment protection against right-of-publicity claims. Since its invention in the second half of the twentieth century,<sup>5</sup> the right of publicity increasingly has been used in litigation against creators of expressive works—including filmmakers, authors, musicians, and others—whose expression includes the depiction of a real person. In this case, the Third Circuit applied a transformative-use test that makes First Amendment protection depend upon whether the depiction distorts

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<sup>5</sup> The precise formulation of the tort varies from state to state. See J. Thomas McCarthy, *The Rights of Publicity and Privacy* § 6.6-6.133 (2d ed. 2000) (describing varying state-law formulations). For example, some states, such as New Jersey, see Pet. App. 15a, follow the *Restatement (Second) of Torts* (1977), which provides that “[o]ne who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of privacy.” *Id.* at § 652C. Other states follow the more narrow formulation of the *Restatement (Third) of Unfair Competition* (1995), under which “[o]ne 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.” See *id.* § 46 (emphasis added). The phrase “for purposes of trade” means “used in advertising the user’s goods or services, or . . . placed on merchandise marketed by the user,” and “does not ordinarily include the use of a person’s identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.” *Id.* § 47.

reality enough to be deemed “transformative.” The more accurate and realistic the depiction, the greater the likelihood of liability. Other courts use a different legal test, extending First Amendment protection to expressive depictions of people regardless of whether they are realistic or “transformed,” unless those uses amount to commercial endorsements. Still other courts engage in case-by-case balancing of First Amendment interests against the economic interests protected by the right of publicity.

This disarray and conflict has real-world consequences: without this Court’s guidance, artists, musicians, and other content creators will be unsure what standards apply to their expression and, in particular, whether the realistic depiction of real individuals is tortious. If the realistic portrayal of a person in an expressive work can strip the work of First Amendment protection, then countless creative works are at risk of suit, including films like *The Social Network*, *42*, *A Beautiful Mind*, and *All the President’s Men*; documentaries like Ken Burns’ *Baseball* and *Jazz*; works of historical fiction like E.L. Doctorow’s *Ragtime* and Thomas Pynchon’s *Gravity’s Rainbow*; and “unauthorized biographies” like those by Kitty Kelley. All of these works realistically portray actual individuals in the contexts that made them famous and use their biographical details. The effect of this uncertainty is to chill protected expression, all in the name of a tort with questionable underlying purposes. This Court should grant review to resolve the conflicts and provide clear direction.

I. The Lower Courts Are In Disarray Concerning the First Amendment Limits on Right-of-Publicity Claims.

A. The Third and Ninth Circuits' Transformative-Use Test Protects an Expressive Work Only if the Plaintiff's Likeness Is "Transformed."

This case is the first time a court other than the Ninth Circuit or a California state court has adopted transformative use as the definitive test separating protected expressive speech from unprotected expressive speech. The Third Circuit held that, to enjoy First Amendment protection against a right-of-publicity claim, an expressive depiction must "sufficiently transform[] the celebrity's identity or likeness." Pet. App. 43a. The Ninth Circuit in *Keller*, likewise adopted this version of the transformative-use test, see *Keller*, 2013 U.S. App. LEXIS 15649, at \*43-44, and held that *NCAA Football* failed that test because it "realistically portrays college football players in the context of college football games." *Id.* at \*28.

The transformative-use test was first articulated in 2001, when the California Supreme Court addressed a right-of-publicity claim based on a charcoal drawing of The Three Stooges. *Comedy III*, 21 P.3d at 799. That court borrowed from copyright fair-use doctrine and adopted what it described as "essentially a balancing test . . . 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." *Id.* Applying that test to the facts at hand,

the court found the Three Stooges drawing, sold as a lithograph and on t-shirts, to be insufficiently transformative. *Id.* at 811. It explained that the artist’s “undeniable skill is manifestly subordinated to the overall goal of creating literal, conventional depictions of The Three Stooges so as to exploit their fame.” *Id.*

In so holding, the California Supreme Court distinguished the drawing at issue from Andy Warhol’s portraits of celebrities such as Marilyn Monroe, Elizabeth Taylor, and Elvis Presley. It explained: “Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself.” *Id.* Underscoring the unpredictability of its test, the court acknowledged that the difference between works that enjoy constitutional protections (like Warhol’s depictions of Marilyn Monroe) and those that do not (like the Three Stooges sketch) will “sometimes be subtle.” *Id.*<sup>6</sup>

#### **B. The Constitutional Test Adopted Below Is Inconsistent With Tests Applied By Other Courts.**

Other circuits and state supreme courts have adopted a different constitutional approach, applying

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<sup>6</sup> See Aaron Moss, *When It Comes to the Right of Publicity, Yes, Doubt* (February 18, 2011) [http://www.lawlawlandblog.com/2011/02/when\\_it\\_comes\\_to\\_the\\_right\\_of.html](http://www.lawlawlandblog.com/2011/02/when_it_comes_to_the_right_of.html) (displaying the Marilyn Monroe painting and the Three Stooges sketch side by side).

different First Amendment tests that do not depend on a depiction's transformative character—albeit tests that themselves conflict with one another.

*1. Four Circuits and Two State Supreme Courts Have Held that the First Amendment Protects Non-Commercial Speech Depicting Well-Known People, Even if the Depiction Is Not “Transformed.”*

The Second, Fifth, Sixth, and Eleventh Circuits, along with the Florida and Kentucky Supreme Courts, all have held that the First Amendment protects the depiction of an individual within an expressive work, unless the depiction amounts to an unauthorized commercial endorsement or is unrelated to any other expression and thus gratuitous.

In *Rogers*, the Second Circuit considered a federal Lanham Act claim and a state right-of-publicity claim brought by Ginger Rogers against the makers of a Federico Fellini film entitled “Ginger and Fred”—a film not about Ginger Rogers and Fred Astaire, but instead about a fictional Italian duo who imitated them, becoming known in Italy as “Ginger and Fred.” 875 F.2d at 996-97. The Second Circuit ruled in favor of the filmmaker, holding first that the First Amendment protects the use of a person's name in a film title from a Lanham Act claim unless the use was “‘wholly unrelated’ to the movie or was ‘simply a disguised commercial advertisement for the sale of goods or services.’” *Id.* at 1004; *see id.* at 998-1000. The court then applied essentially the same standard in rejecting Rogers' right-of-publicity claim under Oregon law. *Id.* at 1004-05.

Other courts have applied the *Rogers* standard or a similar test in describing the First Amendment limits to right-of-publicity claims. For example, in *Matthews v. Wozencraft*, 15 F.3d 432, 440 (5th Cir. 1994), the Fifth Circuit cited *Rogers* in concluding that the First Amendment barred a right-of-publicity claim based on a fictionalized, but accurate, account of an undercover police officer’s experiences. Similarly, in *Parks v. LaFace Records*, 329 F.3d 437, 461 (6th Cir. 2003), the Sixth Circuit adopted *Rogers* and remanded for a factual determination concerning whether the use of the plaintiff’s name in a song title was a “disguised commercial advertisement” that would remove it from First Amendment protection.<sup>7</sup> And in *Valentine v. C.B.S., Inc.*, 698 F.2d 430 (11th Cir. 1983), the Eleventh Circuit construed the Florida right-of-publicity statute to allow the use of a person’s name except “to directly promote a product or service,” in order to avoid “grave questions” about the constitutionality of any broader interpretation. *Id.* at 433.

The Kentucky Supreme Court also has adopted this constitutional line, holding that a right-of-publicity

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<sup>7</sup> Shortly after *Parks*, the Sixth Circuit decided *ETW*, which involved a right-of-publicity claim challenging an artist’s use of Tiger Woods’ image in a painting celebrating Woods’ golfing achievements. 332 F.3d at 918-19. The Third Circuit below stated that *ETW* applied the transformative-use test. Pet. App. 28a-29a. In fact, *ETW* confirmed that, in *Parks*, the Sixth Circuit had “applied the *Rogers* test to . . . right-of-publicity claims,” *ETW*, 332 F.3d at 936 n.17. After applying that test to the facts before it, *ETW* went on to analyze the case under a case-specific balancing of interests, *id.* at 937-38 (citing *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir. 1996)), and the transformative-use test, *id.* at 938, as well.

claim may proceed only if the “use of a person’s name or likeness or other interest[s]” “is not sufficiently related to the underlying work, or, if the otherwise constitutionally-protected work is simply disguised commercial advertisement for the sale of goods or services.” *Montgomery v. Montgomery*, 60 S.W.3d 524, 529 (Ky. 2001) (footnote omitted; internal quotation marks omitted). And the Florida Supreme Court recently adopted a similar rule, stating that, in light of First Amendment constraints, the state’s right of publicity does not bar the use of a name or likeness except to “directly promote a product or service.” *Tyne v. Time Warner Entm’t Co. L.P.*, 901 So. 2d 802, 810 (Fla. 2005); see also *Bullard v. MRA Holding, LLC*, 740 S.E.2d 622, 627 (Ga. 2013) (holding that the use of the plaintiff’s image on the cover of a *College Girls Gone Wild* video was actionable under Georgia’s right of publicity, and did not violate the defendant’s “freedoms of speech and press” because the image was used “as a part of an advertisement”) (quotation marks omitted).

The *Restatement (Third) of Unfair Competition* encourages the adoption of this test as well, explaining that the right of publicity is “fundamentally constrained by the public and constitutional interest in freedom of expression,” and the First Amendment ought to provide a defense against a right-of-publicity claim unless “the name or likeness is used solely to attract attention to a work that is not related to the identified person.” *Restatement (Third) of Unfair Competition*, § 47 cmt. c (1995).

2. *Other Courts Engage in Case-Specific Balancing.*

Still other courts engage in various forms of balancing, weighing the expressive interests protected by the First Amendment against the economic interests protected by the right of publicity based on the particular facts of the case before them. In so doing, none of these courts has focused on whether a likeness has been sufficiently “transformed.”

Thus, in *C.B.C. Distribution & Marketing, Inc. v. Major League Baseball Advanced Media, LP*, 505 F.3d 818 (8th Cir. 2007), the Eighth Circuit held that the First Amendment protected fantasy baseball products that used the names of real players, their biographical data, and their performance statistics. In reaching that conclusion, the court emphasized “the public value of information about the game of baseball and its players,” *id.* at 823, noted that “the information used in CBC’s fantasy baseball games is all readily available in the public domain,” *id.*, and reasoned that “it would be strange law that a person would not have a [F]irst [A]mendment right to use information that is available to everyone,” *id.* By contrast, it continued, “the facts in this case barely, if at all implicate the interests that states typically intend to vindicate by providing rights of publicity to individuals.” *Id.* at 824. Specifically, the court reasoned that publicity rights to one’s name and performance statistics were not needed to encourage baseball players to play the sport, and that there was little risk of consumer confusion, because the defendant’s game included all players. *Id.*



The Third Circuit below attempted to harmonize its outcome with *C.B.C.* on the ground that *C.B.C.* did not involve “[t]he presence of a digital avatar that recreates [the players] in a digital medium.” Pet. App. 48a n.37. That distinction is not persuasive: if the First Amendment protects the use of someone’s name and publicly available performance and biographical data, then it also protects the creation of an avatar reflecting publicly available information about a player’s appearance and playing style. Indeed, the Eighth Circuit itself made clear that *C.B.C.*’s expressive interests would have been no different had it used actual photos of the players, *see* 505 F.3d at 823; nor would the use of photos have changed the court’s balancing of interests.

The Tenth Circuit in *Cardtoons* likewise applied a case-specific balancing test to reject a right-of-publicity claim against the creator of parody baseball cards featuring recognizable caricatures of real baseball players. 95 F.3d at 962-63. The court held that the trading cards were expressive speech “subject to full First Amendment protection,” *id.* at 970, and emphasized that “[c]elebrities . . . are an important element of the shared communicative resources of our cultural domain,” and that “[r]estricting the use of celebrity identities restricts the communication of ideas.” *Id.* at 972. It further held that these interests outweighed any purported justification for the right of publicity. *See id.* at 973-76.

In *Doe*, the Missouri Supreme Court took a markedly different approach, holding that speech receives First Amendment protection against a right-of-publicity claim only if its “*predominant* purpose . . .

is to make an expressive comment on or about a celebrity.” 110 S.W.3d at 374 (quotation marks omitted) (emphasis added). If, on the other hand, the speech “predominantly exploits the commercial value of an individual’s identity,” it is subject to liability under the right of publicity, “even if there is some ‘expressive’ content in it.” *Id.* (quotation marks omitted). In devising that test, the court specifically rejected the transformative-use test. *Id.*<sup>8</sup>

## II. This Case Presents an Ideal Vehicle For Addressing the Constitutional Question.

Plainly, the lower courts need guidance from this Court delineating the scope of First Amendment protection against a right-of-publicity claim. This case presents an excellent vehicle for providing such guidance. The Third Circuit not only acknowledged the wide-ranging circuit conflict on the issue, but also recognized that its decision to apply the transformative-use test, as opposed to the more speech-protective *Rogers* test, was outcome-determinative.

The court acknowledged that the *NCAA Football* video game is an expressive work, Pet. App. 9a-10a, and that Petitioner’s alleged use of Hart’s likeness and

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<sup>8</sup> Other courts, applying state common law or statutory exceptions designed to accommodate constitutional concerns, have drawn the line between protected and unprotected celebrity depictions by focusing on whether the publication is “newsworthy” or in the “public interest.” *See, e.g., Toffoloni v. LFP Publ’g Group, LLC*, 572 F.3d 1201, 1208 (11th Cir. 2009) (applying Georgia law); *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790, 793-94 (1995) (applying California law).

biographical information plainly was related to the work and not merely a “disguised commercial advertisement for the sale of goods or services.” *Rogers*, 875 F.2d at 1004-05; *see* Pet. App. 30a-31a. Accordingly, if the Third Circuit had applied *Rogers* and limited the right of publicity to situations involving a false suggestion of commercial endorsement or purely gratuitous depictions unrelated to other expression, Electronic Arts would have prevailed. The Third Circuit declined to do so, however, because it believed that *Rogers* did not give sufficient weight to “the right to control, manage, and profit from one’s own identity” as against a speaker’s First Amendment rights. Pet. App. 30a.

The Ninth Circuit’s opinions in two other lawsuits, also involving claims challenging the depiction of football players in Electronic Arts football video games, illustrate how the choice of test is outcome-determinative. In *Keller*, involving a right-of-publicity claim against *NCAA Football* essentially identical to Respondent’s, the Ninth Circuit adopted the same the transformative-use test as the Third Circuit and rejected Electronic Arts’ First Amendment defense. *Keller*, 2013 U.S. App. LEXIS, at \*26-27. Yet on the same day, the same Ninth Circuit panel issued an opinion in *Brown v. Electronic Arts Inc*, No. 09-56675, 724 F.3d 1235, U.S. App. LEXIS 15647 (9th Cir. July 31, 2013), in which it held that former NFL star Jim Brown’s Lanham Act claim, based on the use of Brown’s likeness in Electronic Arts’ *Madden NFL*, was *barred* by the First Amendment. Because the *Brown* case involved a Lanham Act claim, the panel applied the *Rogers* test. *Id.* at \*13. As these two decisions

illustrate, the choice of test made all the constitutional difference.

### **III. The Third Circuit's Holding Is Wrong and Conflicts with This Court's First Amendment Jurisprudence.**

This Court's review also is warranted because the Third Circuit's decision—which allows a state to impose tort liability for non-commercial expression that portrays a person realistically—is both wrong and dangerous. The decision cannot be squared with this Court's precedents, and it threatens to chill the exercise of First Amendment rights.

#### **A. The Adopted Transformative-Use Test Does Not Adequately Respect First Amendment Rights.**

The Third and Ninth's Circuits' transformative-use test does not properly limit the right of publicity so that it becomes consistent with the First Amendment.

The right of publicity penalizes fully protected and valuable speech based on its content: the tort proscribes expression because it includes another's name or likeness within its content. *Bartnicki v. Vopper*, 532 U.S. 514, 521 (2001).<sup>9</sup> This Court repeatedly has held, however, that “[c]ontent-based regulations” of speech “are presumptively invalid” and must be subjected to strict constitutional scrutiny. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 382 (1992);

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<sup>9</sup> See also *Volokh*, *supra* n.4 at 912 n.35 (2003) (“The right of publicity is clearly content-based: It prohibits the unlicensed use of particular content (people’s name or likenesses).”).

accord, e.g., *Ashcroft v. ACLU*, 535 U.S. 564, 573 (2002) (“[A]s a general matter . . . government has no power to restrict expression because of . . . its content.”) (quotation marks omitted; bracket in original); *Regan v. Time, Inc.*, 468 U.S. 641, 648 (1984) (holding unconstitutional a statute prohibiting accurate depictions of U.S. currency unless for educational, historic, or newsworthy purposes because those determinations “cannot help but be based on the content of the photograph and the message it delivers”).

The limited exceptions to this rule consist of a few “historic and traditional categories” of expression, *United States v. Stevens*, 559 U.S. 460, 468-69 (2010) (quotation marks omitted), which are “of such slight social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and morality.” *R.A.V.*, 505 U.S. at 383 (quoting *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942)). These include obscenity, defamation, fraud, fighting words, true threats, and speech integral to criminal conduct, see *United States v. Alvarez*, 132 S. Ct. 2537, 2544 (2012) (collecting cases), and “represent ‘well-defined and narrowly limited classes of speech, the prevention and punishment of which have never been thought to raise any Constitutional problem.” *Brown*, 131 S. Ct. at 2733 (quoting *Chaplinsky*, 315 U.S. at 571-72). This Court repeatedly has refused to expand these well-defined and historical categories or to add new categories of speech that the government may proscribe. See, e.g., *Alvarez*, 132 S. Ct. at 2544; *Stevens*, 559 U.S. at 482; *Brown*, 131 S. Ct. at 2741.

An expressive work does not fall into any of these traditional exceptions merely because it includes a portrayal of an actual person. To the contrary, the right-of-publicity tort penalizing such speech is a modern innovation, not recognized in New Jersey itself until 1967. See *Palmer v. Schonhorn Enters., Inc.*, 232 A.2d 458, 462 (N.J. Super. Ct. Ch. Div. 1967). As a leading commentator has put it, the right of publicity is “still a relatively raw and brash newcomer,” 1 J. Thomas McCarthy, *The Rights of Publicity and Privacy* (2d ed. 2000).

Because the right of publicity penalizes speech based on its content and does not fall into one of the recognized exceptions to full First Amendment protection, it is invalid, unless its application can be limited so as to avoid unconstitutional applications of the tort. *Brown*, 131 S. Ct. at 2738 (“It is rare that a regulation restricting speech because of its content will ever be permissible.” (quoting *United States v. Playboy Entm’t Group, Inc.*, 529 U.S. 803, 818 (2000)); *id.* (explaining that content-based regulations of speech are impermissible unless they can survive strict scrutiny). The transformative-use test applied here does not do that.

To the contrary, a test that protects fanciful depictions of a person but imposes liability for realistic depictions cannot be a suitable First Amendment standard. Realistic depictions within expressive works do not constitute a category of speech, like defamation or obscenity, that warrants anything less than full First Amendment protection against content-based restrictions. Indeed, many valuable works, including

biographies, documentaries, and historical fiction, include realistic portrayals or references to real people.

A transformative-use test also does not sufficiently limit the right of publicity to circumstances where its application can survive strict scrutiny. There is no compelling state interest in stamping out realistic portrayals of people. According to the Third Circuit, the right of publicity serves both to protect “the property interest that an individual gains and enjoys in his identity through his labor and effort” and to “encourage further development of this property interest.” Pet. App. 16a.<sup>10</sup> However, neither of those interests is sufficiently compelling to justify penalizing non-commercial expression.<sup>11</sup> A person’s appearance

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<sup>10</sup> The Third Circuit, in the course of justifying the transformative-use test, compared the right of publicity to copyright law. Pet. App. 33a. That analogy is strained. Copyright protects *expression* and does so for the purpose of preserving incentives to create new expressive works. See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985). However, a person’s likeness, or biographical facts about a person, are not *expression*; rather, they are facts, and facts do not warrant any copyright protection. “This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.” *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350 (1991).

<sup>11</sup> Many question the validity of the justifications for the right of publicity altogether. See, e.g., Dogan & Lemley, *supra* note 4, at 1188 (“Even if celebrities would make such an additional investment, it is not at all clear that society should want to encourage fame for fame’s sake.”); Michael Madow, *Private Ownership of Public Image: Popular Culture & Publicity Rights*, 81 Cal. L. Rev. 127, 238 (1993) (“[T]he standard justifications are not nearly as compelling as is commonly supposed.”); Volokh, *supra* note 4, at 911 (“If the law’s goal is encouraging the

and biography—here, for example, Hart’s height, weight, throwing arm, and visor—are facts in the public domain. The First Amendment does not allow the state to control or penalize another’s use of facts. See *N.Y. Times Co. v. Sullivan*, 376 U.S. 254 (1964); *C.B.C.*, 505 F.3d at 823 (“[T]he information used in CBC’s fantasy baseball games is all readily available in the public domain, and it would be strange law that a person would not have a [F]irst [A]mendment right to use information that is available to everyone.”).

Indeed, the transformative-use test as applied here is particularly perverse, because it assumes that the state has a *stronger* interest in penalizing *accurate* speech than in penalizing speech that is “transformative.” That has things backwards: this Court has repeatedly held that truthful and accurate expression warrants maximum First Amendment protection. Cf. *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 52 (1988) (“False statements of fact are particularly valueless; they interfere with the truth-seeking function of the marketplace of ideas, and they cause damage to an individual’s reputation that cannot easily be repaired by counterspeech, however persuasive or effective.”); *The Florida Star v. B.J.F.*, 491 U.S. 524, 534 (1989) (criticizing a Florida law making it unlawful to publicize the name of the victim of a sexual offense because it “punish[ed] truthful publication”); *Time, Inc. v. Hill*, 385 U.S. 374, 388 (1967) (prohibiting false light liability even for false speech on “matters of public interest in the absence of proof that

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production of new works, the right of publicity will likely disserve the interest more than it serves it.”).



the defendant published the report with knowledge of its falsity or in reckless disregard of the truth”).

**B. The Transformative-Use Test Will Chill Protected Speech Because It Is Overbroad and Unpredictable.**

The Third Circuit’s decision is not only wrong but also dangerous. Its transformative-use test is too vague and unpredictable, and too susceptible to a court’s subjective artistic judgments, to be a workable First Amendment standard.

This Court repeatedly has emphasized the importance of ensuring that restrictions on the content of speech are “well-defined.” *Stevens*, 559 U.S. at 468. Predictability is important because speakers otherwise will “steer far wider of the unlawful zone’ . . . than if the boundaries of the forbidden areas were clearly marked,” *Baggett v. Bullitt*, 377 U.S. 360, 372 (1964) (quoting *Speiser v. Randall*, 357 U.S. 513, 526 (1958)), thereby causing an “obvious chilling effect on free speech,” *Reno v. ACLU*, 521 U.S. 844, 871-72 (1997).

The Third Circuit’s transformative-use test fails these requirements. If taken literally, the transformative-use test would allow states to subject biographers, filmmakers, singers, photographers, and other artists to tort liability whenever they include realistic images of, or references to, famous people. Yet many expressive works routinely use a real person’s actual name or likeness, including, for example, films like *The Social Network*, *Moneyball*, *42*, and *The King’s Speech*; documentaries like Ken Burns’ critically acclaimed series on the history of baseball; and best-selling biographies, like those by Kitty Kelley.

Indeed, a key element of the artistry in these works is the realism or accuracy of the portrayal. For example, the genius of Daniel Day-Lewis' portrayal of Abraham Lincoln was his ability to imitate, with great realism, the likeness, mannerisms, and attributes of the president doing what Lincoln actually did. It would be disturbing if the artistic success of such a portrayal were precisely what would make it actionable. *Cf. Estate of Presley v. Russen*, 513 F. Supp. 1339, 1359 (D.N.J. 1981) (rejecting Elvis impersonator's First Amendment defense to a right-of-publicity claim brought by Presley's estate; "entertainment that is merely a copy or imitation, even if skillfully and accurately carried out, does not really have its own creative component and does not have a significant value as pure entertainment" (cited with approval by the Third Circuit, *see* Pet. App. 46a)).

To avoid absurd and dangerous outcomes, courts applying the transformative-use test will have little choice but to draw distinctions among expressive works reflecting their own subjective judgments about whether a particular work is sufficiently "artistic" or "creative" that it warrants protection. Thus, the California Supreme Court in *Comedy III* determined that a sketch of The Three Stooges was not creative enough to receive First Amendment protection, but an Andy Warhol portrait of Marilyn Monroe did deserve such protection because it presented "a form of ironic social comment on the dehumanization of celebrity itself." 21 P.3d at 811. Courts should not place themselves in the role of art critic and make First Amendment freedoms turn on subjective judgments of this kind. *Cf. Bleistein v. Donaldson Lithographing*

*Co.*, 188 U.S. 239, 251 (1903) (Holmes, J.) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”).

A legal regime turning on such “subtle” distinctions among expressive works, *Comedy III*, 21 P.3d at 812, is inherently unpredictable and will chill expression. This case presents a good example of such unpredictability. The Third Circuit concluded that an avatar portraying a college football player in an animated and interactive fictional college football game was actionable because the player’s image was not sufficiently transformed; yet, in the same decision, the court held that placement, in a later edition of the same video game, of an actual *photograph* of Respondent in a montage of other photographs of Rutgers football players was not actionable, because the context made the depiction transformative. Pet. App. 57a-58a (citing *ETW*, 332 F.3d at 938).

It is hard rationally to reconcile these two rulings. According to the dissent, the majority simply treated video games as less worthy of constitutional protection than other types of expressive works, such as photomontages—despite this Court’s clear preclusion of such a First Amendment double standard in *Brown*. Pet. App. 65a, 68a-69a (Ambro, J., dissenting) (expressing concern about “a medium-specific metric that provides less protection to video games than other expressive works”). The majority did not respond to Judge Ambro’s concerns at all, except to claim that it faithfully followed *Brown*’s admonition that video

games “enjoy the full force of First Amendment protections.” Pet. App. 9a-10a (majority opinion).

Speakers need certainty about whether their speech will subject them to liability, or they will self-censor. The transformative-use test cannot provide that predictability.

### **C. Case-Specific Balancing Is Equally Problematic.**

Decisions calling for ad hoc balancing of First Amendment interests and the interests protected by the right of publicity present just as many constitutional problems. *See, e.g., Cardtoons*, 95 F.3d at 973-76; *C.B.C.*, 505 F.3d at 824. This Court has rejected any notion of a “free-floating test for First Amendment coverage.” *Stevens*, 559 U.S. at 470; *see also Brown*, 131 S. Ct. at 2734. As this Court has explained, “[t]he First Amendment's guarantee of free speech does not extend only to categories of speech that survive an ad hoc balancing of relative social costs and benefits. The First Amendment itself reflects a judgment by the American people that the benefits of its restrictions on the Government outweigh the costs. Our Constitution forecloses any attempt to revise that judgment simply on the basis that some speech is not worth it.” *Stevens*, 559 U.S. at 470.

Moreover, here, ad hoc balancing requires a court to weigh apples against oranges. There is no principled way to determine, case by case, whether the *economic* interest of a person in preventing a given portrayal outweighs the *social* value of a given expressive work. The two interests being compared are too different to

enable judges to reach consistent and predictable results.

**D. The *Rogers* Test Confines the Right of Publicity to Circumstances Where Its Application Does Not Violate the First Amendment.**

Unlike the transformative-use test and case-by-case balancing, the *Rogers* test confines the right-of-publicity tort to situations in which speakers have used a depiction of, or reference to, a celebrity to sell something—either by falsely claiming a celebrity commercial endorsement or by including a celebrity image in a publication gratuitously, just to attract attention.

Confined to these circumstances, the right of publicity does not raise constitutional concerns. Speech that falsely claims a commercial endorsement is akin to the category of fraudulent speech that the government has long regulated without any First Amendment concerns. *See, e.g., Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771 (1976) (noting that fraudulent speech generally falls outside the protections of the First Amendment). And the gratuitous use of a celebrity’s image to attract attention, unrelated to any expressive content in the work, likewise falls outside First Amendment protection altogether. Thus confined, the right-of-publicity tort raises little constitutional concern.

\* \* \*

This Court’s review is sorely needed. Because so many expressive works are distributed nationwide, the rule created by the Third and Ninth Circuits effectively

has set the constitutional rule for the rest of the country. But that rule makes no sense constitutionally. Moreover, the rule is so vague and unpredictable in its application that speakers will not know whether their speech is constitutionally protected or tortious. Given the potentially ruinous financial consequences of guessing wrong (here, Respondent seeks hundreds of millions of dollars on behalf of a class that could have thousands of members), speakers will go too far in their self-censorship. Unless and until this Court intervenes, a great deal of valuable and protected expression will be chilled.

### CONCLUSION

This Court should grant the petition for a writ of certiorari.

Respectfully submitted,

Alonzo Wickers IV  
DAVIS WRIGHT TREMAINE LLP  
865 S. Figueroa Street  
Suite 2400  
Los Angeles, CA 90017  
(213) 633-6800

Elizabeth A. McNamara  
DAVIS WRIGHT TREMAINE LLP  
1633 Broadway, 27th Floor  
New York, NY 10019  
(212) 489-8230

Paul M. Smith  
*Counsel of Record*  
Kenneth L. Doroshov  
Katherine A. Fallow  
Matthew E. Price  
Mark P. Gaber  
JENNER & BLOCK LLP  
1099 New York Ave. NW  
Suite 900  
Washington, DC 20001  
(202) 639-6000  
psmith@jenner.com

## **APPENDIX**

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**Appendix A**

United States Court of Appeals  
Third Circuit

Ryan HART, individually and on behalf of all others  
similarly situated

v.

ELECTRONIC ARTS, INC., a Delaware Corporation;  
Does 1–50.

Ryan Hart, Appellant.

No. 11–3750.

Argued: Sept. 19, 2012.

Opinion Filed: May 21, 2013.

Before: AMBRO, GREENAWAY, JR., and  
TASHIMA\* Circuit Judges.

**OPINION**

GREENAWAY, JR., Circuit Judge.

In 2009, Appellant Ryan Hart (“Appellant” or “Hart”)<sup>1</sup> brought suit against Appellee Electronic Arts, Inc. (“Appellee” or “EA”) for allegedly violating his right of publicity as recognized under New Jersey law. Specifically, Appellant’s claims stemmed from

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\* Honorable A. Wallace Tashima, Senior United States Circuit Judge for the Ninth Circuit, sitting by designation.

<sup>1</sup> Appellant’s action purports to be a class action on behalf of similarly situated individuals. Because the putative class members all face the same issues with regard to the First Amendment we will focus our attention and analysis on Appellant in particular.



Appellee's alleged use of his likeness and biographical information in its *NCAA Football* series of videogames. The District Court granted summary judgment in favor of Appellee on the ground that its use of Appellant's likeness was protected by the First Amendment. For the reasons set forth below, we will reverse the grant of summary judgment and remand the case back to the District Court for further proceedings.

## I. FACTS

Hart was a quarterback, player number 13, with the Rutgers University NCAA Men's Division I Football team for the 2002 through 2005 seasons. As a condition of participating in college-level sports, Hart was required to adhere to the National Collegiate Athletic Association's ("NCAA") amateurism rules as set out in Article 12 of the NCAA bylaws. *See, e.g., NCAA, 2011–12 NCAA Division I Manual* § 12.01.1 (2011) ("Only an amateur student-athlete is eligible for inter-collegiate athletics participation in a particular sport."). In relevant part, these rules state that a collegiate athlete loses his or her "amateur" status if (1) the athlete "[u]ses his or her athletics skill (directly or indirectly) for pay in any form in that sport," *id.* § 12.1.2, or (2) the athlete "[a]ccepts any remuneration or permits the use of his or her name or picture to advertise, recommend or promote directly the sale or use of a commercial product or service of any kind," *id.* § 12.5.2.1.<sup>2</sup> In comporting with these bylaws, Hart

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<sup>2</sup> The NCAA Manual also states that where a collegiate athlete's name or picture appears on commercial items ... or is used to promote a commercial product sold by an individual or

purportedly refrained from seizing on various commercial opportunities.<sup>3</sup> On the field, Hart excelled. At 6'2", weighing 197 pounds, and typically wearing a visor and armband on his left wrist, Hart amassed an impressive list of achievements as the Scarlet Knights' starting quarterback. As of this writing, Hart still holds the Scarlet Knights' records for career attempts, completions, and interceptions.<sup>4</sup> Hart's skill brought success to the team and during his senior year the Knights were invited to the Insight Bowl, their first Bowl game since 1978.

Hart's participation in college football also ensured his inclusion in EA's successful *NCAA Football* videogame franchise. EA, founded in 1982, is "one of the world's leading interactive entertainment software companies," and "develops, publishes, and distributes interactive software worldwide" for consoles, cell phones, and PCs. (App. at 529–30.) EA's catalogue

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agency without the student-athlete's knowledge or permission, the student athlete (or the institution acting on behalf of the student-athlete) is required to take steps to stop such an activity in order to retain his or her eligibility for intercollegiate athletics.

NCAA, 2011–12 *NCAA Division I Manual* § 12.5.2.2 (2011).

<sup>3</sup> NCAA bylaws limit college athletes like Hart to receiving only non-athletic financial aid, either through academic scholarships or need-based aid, or athletic scholarships, which cover only tuition and various school-related expenses. See NCAA, 2011–12 *NCAA Division I Manual* § 15 (2011).

<sup>4</sup> Until his recent displacement by Mike Teel, Hart also held the team records for career yards and touchdowns.

includes *NCAA Football*, the videogame series at issue in the instant case. The first edition of the game was released in 1993 as *Bill Walsh College Football*. EA subsequently changed the name first to *College Football USA* (in 1995), and then to the current *NCAA Football* (in 1997). New editions in the series are released annually, and “allow[] users to experience the excitement and challenge of college football” by interacting with “over 100 virtual teams and thousands of virtual players.” (*Id.* at 530.)

A typical play session allows users the choice of two teams. “Once a user chooses two college teams to compete against each other, the video game assigns a stadium for the match-up and populates it with players, coaches, referees, mascots, cheerleaders and fans.”<sup>5</sup> (*Id.*) In addition to this “basic single-game format,” EA has introduced a number of additional game modes that allow for “multi-game” play. (*Id.* at 530–31.) Thus, with the release of *NCAA Football 98*, EA introduced the “Dynasty Mode,” which allows users to “control[] a college program for up to thirty seasons,” including “year-round responsibilities of a college coach such as recruiting virtual high school players out of a random-generated pool of athletes.” (*Id.* at 531.) Later, in *NCAA Football 2006*, EA introduced the “Race for the Heisman” (later renamed “Campus Legend”),

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<sup>5</sup> Appellee licenses, from the Collegiate Licensing Company (the NCAA’s licensing agent), “the right to use member school names, team names, uniforms, logos, stadium fight songs, and other game elements.” (App. at 532.) Unlike certain of its other videogame franchises, EA does not license the likeness and identity rights for intercollegiate players.

which allows users to “control a single [user-made] virtual player from high school through his collegiate career, making his or her own choices regarding practices, academics and social activities.” (*Id.* at 531–32.)

In no small part, the *NCAA Football* franchise’s success owes to its focus on realism and detail—from realistic sounds, to game mechanics, to team mascots.<sup>6</sup> This focus on realism also ensures that the “over 100 virtual teams” in the game are populated by digital avatars that resemble their real-life counterparts and share their vital and biographical information. Thus, for example, in *NCAA Football 2006*, Rutgers’ quarterback, player number 13, is 6’2" tall, weighs 197 pounds and resembles Hart. Moreover, while users can change the digital avatar’s appearance and most of the vital statistics (height, weight, throwing distance, etc.), certain details remain immutable: the player’s home state, home town, team, and class year.

Appellant filed suit against EA in state court for, among other things, violation of his right of publicity. Appellant’s first amended complaint, filed in October 2009, alleged that Appellee violated his right of publicity by appropriating his likeness for use in the *NCAA Football* series of videogames. Appellee

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<sup>6</sup> For example, an article on the EA Sports blog explained that “[e]ach year, *NCAA Football* playbook designer Anthony White strives to make each team’s playbook accurately represent their system and play style .... [E]ach year, Anthony adds in actual plays run by teams that can only be found in specific playbooks.” (App. At 663.).

subsequently removed the action to federal court, and the District Court subsequently dismissed all but one of the claims.<sup>7</sup> Thereafter, on October 12, 2010, Appellant filed his second amended complaint, again alleging a claim pursuant to the right of publicity based on Appellee's purported misappropriation of Appellant's identity and likeness to enhance the commercial value of *NCAA Football*. Specifically, Appellant alleges that (1) Appellee replicated his likeness in *NCAA Football 2004*, *2005*, and *2006* (complete with biographical and career statistics)<sup>8</sup> and that (2) Appellee used Appellant's image "in the promotion for [*NCAA Football*] wherein [Appellant] was throwing a pass with actual footage from Rutgers University's Bowl Game against Arizona State University."<sup>9</sup> (App. at 370.)

On November 12, 2010, Appellee filed a motion to dismiss the claim pursuant to Federal Rule of Civil

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<sup>7</sup> The District Court had diversity jurisdiction over the case pursuant to 28 U.S.C. § 1332(a)(1).

<sup>8</sup> Appellant alleges that the physical attributes exhibited by the virtual avatar in *NCAA Football* are his own (i.e., he attended high school in Florida, measures 6'2" tall, weighs 197 pounds, wears number 13, and has the same left wrist band and helmet visor) and that the avatar's speed, agility, and passer rating reflected actual footage of Appellant during his tenure at Rutgers. (App. at 369–71.).

<sup>9</sup> It is unclear from the complaint what exactly this allegation covers. However, Appellee concedes that "[a] photograph of [Appellant] is included in a photo montage of actual players within *NCAA Football 09* which is visible only when the game is played on certain game platforms by those users who select Rutgers as their team." (App. at 475.).

Procedure 12(b)(6) or, in the alternative, summary judgment pursuant to Federal Rule of Civil Procedure 56(c). While conceding, for purposes of the motion only, that it had violated Appellant's right of publicity, Appellee argued that it was entitled to dismissal or summary judgment on First Amendment grounds. *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 766 (D.N.J.2011). The motion was accompanied by a Statement of Undisputed Fact and various supporting materials, including declarations. Appellant opposed the motion, arguing that "discovery [was] still in it's [sic] infancy." (App. at 9.) The court below rejected this argument, noting that Appellant had "fail[ed] to identify how discovery would assist the Court in deciding this speech-based tort case." *Hart*, 808 F. Supp. 2d at 764. The District Court then construed the motion as one for summary judgment, citing its intent to "rely on the affidavits and exhibits submitted by the parties," *id.*, and ruled in favor of Appellee, holding that *NCAA Football* was entitled to protection under the First Amendment. Appellant timely appealed, arguing that the District Court erred in granting summary judgment prematurely and, in the alternative, erred in holding that *NCAA Football* was shielded from right of publicity claims by the First Amendment. The matter is now before us for review.

## II. JURISDICTION AND STANDARD OF REVIEW

We have jurisdiction to hear this appeal pursuant to 28 U.S.C. § 1291. Our review of the District Court's order granting summary judgment is plenary. *Azur v. Chase Bank, USA, Nat'l Ass'n*, 601 F.3d 212, 216 (3d

Cir. 2010). “To that end, we are ‘required to apply the same test the district court should have utilized initially.’” *Chambers ex rel. Chambers v. Sch. Dist. of Phila. Bd. of Educ.*, 587 F.3d 176, 181 (3d Cir. 2009) (quoting *Oritani Sav. & Loan Ass’n v. Fidelity & Deposit Co. of Md.*, 989 F.2d 635, 637 (3d Cir. 1993)).

Summary judgment is appropriate “where the pleadings, depositions, answers to interrogatories, admissions, and affidavits show there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law.” *Azur*, 601 F.3d at 216 (quoting *Nicini v. Morra*, 212 F.3d 798, 805–06 (3d Cir. 2000) (en banc) (citing Fed. R. Civ. P. 56(c))).<sup>10</sup> To be material, a fact must have the potential to alter the outcome of the case. *See Kaucher v. Cnty. of Bucks*, 455 F.3d 418, 423 (3d Cir. 2006). “Once the moving party points to evidence demonstrating no issue of material fact exists, the non-moving party has the duty to set forth specific facts showing that a genuine issue of material fact exists and that a reasonable factfinder could rule in its favor.” *Azur*, 601 F.3d at 216. In determining whether summary judgment is warranted “[t]he evidence of the nonmovant is to be believed, and all justifiable inferences are to be drawn in his favor.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986); *see also Chambers ex rel.*

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<sup>10</sup> Fed. R. Civ. P. 56 was revised in 2010. The standard previously set forth in subsection (c) is now codified as subsection (a). The language of this subsection is unchanged, except for “one word—genuine ‘issue’ bec[ame] genuine ‘dispute.’” Fed. R. Civ. P. 56 advisory committee’s note, 2010 amend.

*Chambers*, 587 F.3d at 181. “Further, [w]e may affirm the District Court on any grounds supported by the record.” *Kossler v. Crisanti*, 564 F.3d 181, 186 (3d Cir. 2009) (en banc) (internal quotation marks omitted).

In connection with Appellant’s request for additional discovery, we review “[w]hether a district court prematurely grant[ed] summary judgment ... for abuse of discretion.” *Radich v. Goode*, 886 F.2d 1391, 1393 (3d Cir. 1989) (citing *Dowling v. City of Phila.*, 855 F.2d 136 (3d Cir. 1988)). “To demonstrate an abuse of discretion, [an appellant] must show that the District Court’s decision was arbitrary, fanciful or clearly unreasonable.” *Moyer v. United Dominion Indus., Inc.*, 473 F.3d 532, 542 (3d Cir. 2007) (internal quotation marks omitted); *see also Hanover Potato Prods., Inc. v. Shalala*, 989 F.2d 123, 127 (3d Cir. 1993) (“An abuse of discretion arises when ‘the district court’s decision rests upon a clearly erroneous finding of fact, an errant conclusion of law or an improper application of law to fact.’” (internal quotation marks omitted)).

### III. DISCUSSION

We begin our analysis by noting the self-evident: video games are protected as expressive speech under the First Amendment. *Brown v. Entm’t Merchs. Ass’n*, — U.S. —, 131 S. Ct. 2729, 2733, 180 L. Ed. 2d 708 (2011). As the Supreme Court has noted, “video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player’s interaction with the virtual world).” *Id.* As a result, games enjoy the full force of First Amendment



protections. As with other types of expressive conduct, the protection afforded to games can be limited in situations where the right of free expression necessarily conflicts with other protected rights.

The instant case presents one such situation. Here, Appellee concedes, for purposes of the motion and appeal, that it violated Appellant's right of publicity; in essence, misappropriating his identity for commercial exploitation. (Appellant's Br. at 8, 34; Tr. at 50:12–:16.) However, Appellee contends that the First Amendment shields it from liability for this violation because *NCAA Football* is a protected work. To resolve the tension between the First Amendment and the right of publicity, we must balance the interests underlying the right to free expression against the interests in protecting the right of publicity. See *Zacchini v. Scripps–Howard Broad. Co.*, 433 U.S. 562, 574–75, 97 S. Ct. 2849, 53 L. Ed. 2d 965 (1977).<sup>11</sup>

Courts have taken varying approaches in attempting to strike a balance between the competing interests in right of publicity cases, some more appealing than others. In our discussion below, we first consider the nature of the interests we must balance and then analyze the different approaches courts have taken to resolving the tension between the First Amendment and the right of publicity.

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<sup>11</sup> While it is true that the right of publicity is a creature of state law and precedent, its intersection with the First Amendment presents a federal issue, and, thus, permits us to engage in the sort of balancing inquiry at issue here. See, e.g., *Zacchini*, 433 U.S. at 566–68, 97 S. Ct. 2849.

## A. The Relevant Interests at Issue

Before engaging with the different analytical schemes, we first examine the relevant interests underlying the rights of free expression and publicity.

### 1. *Freedom of Expression*

Freedom of expression is paramount in a democratic society, for “[i]t is the function of speech to free men from the bondage of irrational fears.” *Whitney v. California*, 274 U.S. 357, 376, 47 S. Ct. 641, 71 L. Ed. 1095 (1927) (Brandeis, J., concurring). As Justice Louis Brandeis wrote nearly a century ago:

Those who won our independence believed that the final end of the state was to make men free to develop their faculties. . . . They valued liberty both as an end and as a means. They believed liberty to [be] the secret of happiness and courage to be the secret of liberty. They believed that freedom to think as you will and to speak as you think are means indispensable to the discovery and spread of political truth; that without free speech and assembly discussion would be futile; that with them, discussion affords ordinarily adequate protection against the dissemination of noxious doctrine; that the greatest menace to freedom is an inert people; that public discussion is a political duty; and that this should be a fundamental principle of the American government.

*Id.* at 375, 47 S. Ct. 641.

In keeping with Justice Brandeis' eloquent analysis, the great legal minds of generations past and present have recognized that free speech benefits both the individual and society. The Supreme Court in *Procunier v. Martinez* noted that the protection of free speech serves the needs "of the human spirit—a spirit that demands self-expression," adding that "[s]uch expression is an integral part of the development of ideas and a sense of identity." 416 U.S. 396, 427, 94 S. Ct. 1800, 40 L. Ed. 2d 224 (1974), *overruled on other grounds by Thornburgh v. Abbott*, 490 U.S. 401, 109 S. Ct. 1874, 104 L. Ed. 2d 459 (1989). Suppressing such expression, therefore, is tantamount to rejecting "the basic human desire for recognition and [would] affront the individual's worth and dignity." *Id.* Indeed, First Amendment protections have been held applicable to not only political speech, but to "entertainment [including, but certainly not limited to,] motion pictures, programs broadcast by radio and television, and live entertainment, such as musical and dramatic works." *Tacyne v. City of Phila.*, 687 F.2d 793, 796 (3d Cir. 1982). Thus, "[t]he breadth of this protection evinces recognition that freedom of expression is not only essential to check tyranny and foster self-government but also intrinsic to individual liberty and dignity and instrumental in society's search for truth." *Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*, 472 U.S. 749, 787, 105 S. Ct. 2939, 86 L. Ed. 2d 593 (1985) (Brennan, J., dissenting).

The interest in safeguarding the integrity of these protections therefore weighs heavily in any balancing inquiry. Still, instances can and do arise where First

Amendment protections yield in the face of competing interests. *See, e.g., Eldred v. Ashcroft*, 537 U.S. 186, 219–20, 123 S. Ct. 769, 154 L. Ed. 2d 683 (2003) (discussing the interplay between copyright law and First Amendment protections); *Dun & Bradstreet, Inc.*, 472 U.S. at 757–61, 105 S. Ct. 2939 (determining that a state may allow recovery of damages in certain defamation cases after balancing “the State’s interest in compensating private individuals for injury to their reputation against the First Amendment interest in protecting this type of expression”). Ultimately, we must determine whether the interest in safeguarding the right of publicity overpowers the interest in safeguarding free expression.

## 2. *The Right of Publicity*<sup>12</sup>

The right of publicity grew out of the right to privacy torts, specifically, from the tort of “invasion of privacy by appropriation.” J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:23 (2d ed. 2012). Thus, when New Jersey first recognized the concept in 1907, its analysis looked to the “so-called right of privacy” and the limits on that concept. *Edison v. Edison Polyform Mfg. Co.*, 73 N.J.Eq. 136, 67 A. 392, 394 (N.J. Ch. 1907) (enjoining a company from using the name or likeness of Thomas

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<sup>12</sup> As we have noted, Appellee concedes that *NCAA Football* infringes on the right of publicity as recognized in New Jersey. Our inquiry, therefore, does not concern the elements of the tort or whether Appellee’s actions satisfy this standard. Rather, we are concerned only with whether the right to freedom of expression overpowers the right of publicity.

Edison to promote its products). Additionally, we note that, even at this early stage the New Jersey court recognized that an individual enjoyed a property interest in his or her identity. *Id.* (“[I]t is difficult to understand why the peculiar cast of one’s features is not. . . one’s property, and why its pecuniary value, if it has one, does not belong to its owner, rather than to the person seeking to make an unauthorized use of it.”).

However, this early conceptualization had limitations, particularly when it came to protecting the property interests of celebrities and people already in the public eye. *See id.* (“It is certain that a man in public life may not claim the same immunity from publicity that a private citizen may.”); *see also* MCCARTHY, *supra*, at § 1:25. Faced with this limitation on the legal doctrine, courts began to recognize a “right of publicity,” which protected publicly known persons from the misappropriation of their identities. The first case to describe this protection as a “right of publicity” was *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953) (concerning baseball cards in gum packages). There, the Second Circuit held that “in addition to and independent of that right of privacy. . . , a man has a right in the publicity value of his photograph. . . . This right might be called a ‘right of publicity.’” *Id.* at 868. New Jersey courts, which had long recognized a “right of privacy [and] a right of property,” were not far behind in voicing their support for this concept. *Ettore v. Philco Television Broad. Corp.*, 229 F.2d 481, 491 (3d Cir. 1956).

In the seminal case of *Palmer v. Schonhorn Enters., Inc.*, the Superior Court of New Jersey noted that

[p]erhaps the basic and underlying theory is that a person has the right to enjoy the fruits of his own industry free from unjustified interference. It is unfair that one should be permitted to commercialize or exploit or capitalize upon another's name, reputation or accomplishments merely because the owner's accomplishments have been highly publicized.

96 N.J. Super. 72, 232 A.2d 458, 462 (Ch. Div. 1967) (citations omitted) (finding an infringement of property rights where a golfer's name was used in connection with a golf game); *see also Canessa v. J.I. Kislak, Inc.*, 97 N.J. Super. 327, 235 A.2d 62, 76 (Law Div. 1967) (“[T]he reality of a case such as we have here is, in the court's opinion, simply this: plaintiffs' names and likenesses belong to them. As such they are property. They are things of value.”).

The current incarnation of the right of publicity in New Jersey is that set forth in the RESTATEMENT (SECOND) OF TORTS (1977). *See, e.g., Bisbee v. John C. Conover Agency, Inc.*, 186 N.J. Super. 335, 452 A.2d 689, 690–91 (App. Div. 1982) (looking to the Restatement (Second) of Torts for the “four areas of invasion of privacy,” including “appropriation of the other's name or likeness”); *see also G.D. v. Kenny*, 205 N.J. 275, 15 A.3d 300, 311 (2011). According to the Restatement, “[o]ne who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of privacy.” RESTATEMENT (SECOND) OF TORTS § 652 C. The

comments also make clear that “the right created by [the rule in § 652 C] is in the nature of a property right.” *Id.* § 652 C cmt a.<sup>13</sup>

New Jersey law therefore recognizes that “[t]he right to exploit the value of [an individual’s] notoriety or fame belongs to the individual with whom it is associated,” for an individual’s “name, likeness, and endorsement carry value and an unauthorized use harms the person both by diluting the value of the name and depriving that individual of compensation.” *McFarland v. Miller*, 14 F.3d 912, 919, 923 (3d Cir. 1994). As such, the goal of maintaining a right of publicity is to protect the property interest that an individual gains and enjoys in his identity through his labor and effort. Additionally, as with protections for intellectual property, the right of publicity is designed to encourage further development of this property interest. *Accord Zacchini*, 433 U.S. at 573, 97 S. Ct. 2849 (“[T]he State’s interest in permitting a ‘right of publicity’ . . . is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors. . .”).

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<sup>13</sup> In 1995 the RESTATEMENT (THIRD) OF UNFAIR COMPETITION set forth the elements of a free-standing right of publicity claim, unconnected to the right of privacy torts. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46–49 (1995). While we discuss this version of the tort further below, we decline to address it here because New Jersey has yet to adopt the Restatement (Third)’s version of the tort and the accompanying comments. *Accord Castro v. NYT Television*, 370 N.J.Super. 282, 851 A.2d 88, 96–97 (App. Div. 2004) (citing to RESTATEMENT (SECOND) OF TORTS § 652 C (1977) in discussing a right of publicity claim).

Since neither the New Jersey courts nor our own circuit have set out a definitive methodology for balancing the tension between the First Amendment and the right of publicity, we are presented with a case of first impression. We must therefore consult the approaches of other courts in the first instance.

## **B. How Courts Balance the Interests**

We begin our inquiry by looking at *Zacchini v. Scripps-Howard Broadcasting Co.*, the only Supreme Court case addressing the First Amendment in a right of publicity context. In this case, the Court called for a balancing test to weigh the interest underlying the First Amendment against those underpinning the right of publicity. 433 U.S. at 574–75, 97 S. Ct. 2849. This decision sets the stage for our analysis of three systematized analytical frameworks that have emerged as courts struggle with finding a standardized way for performing this balancing inquiry.

### *1. Zacchini and the Need for Balance*

In *Zacchini*, an Ohio television news program recorded and subsequently broadcast Mr. Hugo Zacchini’s entire “human cannonball” act from a local fair. The daredevil brought suit alleging a violation of his right of publicity as recognized by Ohio law. *Id.* at 563–66, 97 S. Ct. 2849. The Ohio courts held that Zacchini’s claim was barred on First Amendment grounds, and the case then came before the Supreme Court.

In setting out the interests at issue in the case, the Supreme Court noted (as we did above) that “the State’s interest in permitting a ‘right of publicity’ is in



protecting the proprietary interest of the individual in his act in part to encourage such entertainment.” *Id.* at 573, 97 S. Ct. 2849. This aspect of the right, the Court noted, was “analogous to the goals of patent and copyright law,” given that they too serve to protect the individual’s ability to “reap the reward of his endeavors.” *Id.* In *Zacchini*, the performance was the “product of [Zacchini’s] own talents and energy, the end result of much time, effort and expense.” *Id.* at 575, 97 S. Ct. 2849. Thus much of its economic value lay “in the right of exclusive control over the publicity given to his performance.” *Id.* Indeed, while the Court noted that “[a]n entertainer such as petitioner usually has no objection to the widespread publication of his act as long as [he] gets the commercial benefit of such publication,” *id.* at 573, 97 S. Ct. 2849, the claim at issue in the *Zacchini* concerned “the strongest case for a ‘right of publicity,’ ” because it did not involve the “appropriation of an entertainer’s reputation to enhance the attractiveness of a commercial product,” but instead involved “the appropriation of the very activity by which the entertainer acquired his reputation in the first place,” *id.* at 576, 97 S. Ct. 2849.

Ultimately, the Court ruled in favor of the human cannonball, and held that

[w]herever 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 do not immunize the media when they broadcast a performer’s entire act without his consent. The Constitution no more prevents a State from

requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner.

*Id.* at 574–75, 97 S. Ct. 2849. Thus, while the Court did not itself engage in an explicit balancing inquiry, it did suggest that the respective interests in a case should be balanced against each other.

In the wake of *Zacchini*, courts began applying a balancing inquiry to resolve cases where a right of publicity claim collided with First Amendment protections. While early cases approached the analysis from an ad hoc perspective, *see, e.g., Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal.3d 860, 160 Cal.Rptr. 352, 603 P.2d 454 (1979) (en banc), courts eventually began developing standardized balancing frameworks. Consequently, we now turn our attention to more standardized balancing tests to see whether any of them offer a particularly compelling methodology for resolving the case at hand and similar disputes.<sup>14</sup>

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<sup>14</sup> We reject as inapplicable in this case the suggestion that those who play organized sports are not significantly damaged by appropriation of their likeness because “players are rewarded, and handsomely, too, for their participation in games and can earn additional large sums from endorsement and sponsorship arrangements.” *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 824 (8th Cir. 2007) (discussing Major League Baseball players); *see also, e.g., Cartoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 974 (10th Cir. 1996) (“[T]he additional inducement for achievement produced by publicity rights are often

## 2. *The Modern Balancing Tests*

Following *Zacchini*, courts began developing more systematized balancing tests for resolving conflicts between the right of publicity and the First Amendment. Of these, three tests are of particular note: the commercial-interest-based Predominant Use Test, the trademark-based *Rogers* Test, and the copyright-based Transformative Use Test. The *Rogers* and Transformative Use tests are the most well-established, while the Predominant Use Test is addressed below only because Appellant argues in favor of its adoption. We consider each test in turn, looking at its origins, scope of application, and possible limitations. For the reasons discussed below, we adopt the Transformative Use Test as being the most appropriate balancing test to be applied here.

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inconsequential because most celebrities with valuable commercial identities are already handsomely compensated.”). If anything, the policy considerations in this case weigh in *favor* of Appellant. As we have already noted, intercollegiate athletes are forbidden from capitalizing on their fame while in school. Moreover, the NCAA most recently estimated that “[l]ess than one in 100, or 1.6 percent, of NCAA senior football players will get drafted by a National Football League (NFL) team.” NCAA, Estimated Probability of Competing in Athletics Beyond the High School Interscholastic Level, available at <http://www.ncaa.org/wps/wcm/connect/public/ncaa/pdfs/2012/estimated+probability+of+competing+in+athletics+beyond+the+high+school+interscholastic+level>. Despite all of his achievements, it should be noted that Ryan Hart was among the roughly ninety-nine percent who were not drafted after graduation.

**a. Predominant Use Test**

Appellant urges us to adopt the Predominant Use Test, which first appeared in *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003) (en banc), a case that considered a hockey player's right of publicity claim against a comic book publishing company. In *TCI*, Anthony "Tony" Twist, a hockey player, brought suit against a number of individuals and entities involved in producing and publishing the *Spawn* comic book series after the introduction of a villainous character named Anthony "Tony Twist" Twistelli.

In balancing Twist's property interests in his own name and identity against the First Amendment interests of the comic book creators, the *TCI* court rejected both the Transformative Use and *Rogers* tests, noting that they gave "too little consideration to the fact that many uses of a person's name and identity have both expressive and commercial components." *Id.* at 374. The Supreme Court of Missouri considered both tests to be too rigid, noting that they operated "to preclude a cause of action whenever the use of the name and identity is in any way expressive, regardless of its commercial exploitation." *Id.* The court instead applied what it called a "sort of predominant use test":

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.

*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. V. 471, 500 (2003)). The *TCI* court considered this to be a “more balanced balancing test [particularly for] cases where speech is both expressive and commercial.” *Id.* After applying the test, the court ruled for Twist, holding that “the metaphorical reference to Twist, though a literary device, has very little literary value compared to its commercial value.” *Id.*

We decline Appellant’s invitation to adopt this test. By our reading, the Predominant Use Test is subjective at best, arbitrary at worst, and in either case calls upon judges to act as both impartial jurists and discerning art critics. These two roles cannot co-exist. Indeed, Appellant suggests that pursuant to this test we must evaluate “what value [Appellee is] adding to the First Amendment expressiveness [of *NCAA Football* ] by appropriating the commercially valuable likeness?” (Tr. at 14:15–:18.) Since “[t]he game would have the exact same level of First Amendment expressiveness if [Appellee] didn’t appropriate Mr. Hart’s likeness,” Appellant urges us to find that *NCAA Football* fails the Predominant Use Test and therefore is not shielded by the First Amendment. (Tr. at 7:10–12.) Such reasoning, however, leads down a dangerous and rightly-shunned road: adopting Appellant’s suggested analysis would be tantamount to admitting that it is proper for courts to analyze select elements of a work

to determine how much they contribute to the entire work's expressiveness. Moreover, as a necessary (and insidious) consequence, the Appellant's approach would suppose that there exists a broad range of seemingly expressive speech that has no First Amendment value.<sup>15</sup>

Appellee rightly argues that the Predominant Use Test is antithetical to our First Amendment precedent, (Tr. at 25:2–:9), and we likewise reject the Test.<sup>16</sup> We instead turn our attention to the *Rogers* Test, which was proposed by Appellee and which draws its inspiration from trademark law.

#### b. The *Rogers* Test

The *Rogers* Test looks to the relationship between the celebrity image and the work as a whole.<sup>17</sup> As the following discussion demonstrates, however, adopting

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<sup>15</sup> This concept is almost wholly foreign to free expression save for *highly circumscribed* categories of speech: obscenity, incitement, and fighting words. See *Brown v. Entm't Merchs. Ass'n*, — U.S. —, 131 S. Ct. 2729, 2733, 180 L. Ed. 2d 708 (2011).

<sup>16</sup> We also agree with Chief Justice Bird's rejection of an identical argument: "The right of publicity derived from public prominence does not confer a shield to ward off caricature, parody and satire. Rather, prominence invites creative coment." *Guglielmi*, 160 Cal.Rptr. 352, 603 P.2d at 460.

<sup>17</sup> The various cases and scholarly sources refer to this test in three different ways: the Relatedness Test, the Restatement Test, and the *Rogers* Test. The "Relatedness" moniker should be self-explanatory even at this early point in our discussion; the propriety of the other two names will become clear shortly. For our purposes, we will refer to the test as the *Rogers* Test.

this test would potentially immunize a broad swath of tortious activity. We therefore reject the *Rogers* Test as inapposite in the instant case.

**i. Origins and Scope of the *Rogers* Test**

Various commentators have noted that right of publicity claims—at least those that address the use of a person’s name or image in an advertisement—are akin to trademark claims because in both instances courts must balance the interests in protecting the relevant property right against the interest in free expression. *See, e.g., ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003) (noting that “a Lanham Act false endorsement claim is the federal equivalent of the right of publicity” (citing Bruce P. Keller, *The Right of Publicity: Past, Present, and Future*, 1207 PLI CORP. LAW & PRAC. HANDBOOK 159, 170 (2000))). It is little wonder, then, that the inquiry championed by Appellee originated in a case that also focused upon alleged violations of the trademark-specific Lanham Act. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

In that case, Ginger Rogers brought suit against the producers and distributors of, *Ginger and Fred*, a film that was alleged to infringe on Rogers’ right of publicity and confuse consumers in violation of the Act. (Despite its title, the film was not about either Ginger Rogers or Fred Astaire.) In analyzing the right of publicity claim under Oregon law, the Second Circuit noted Oregon’s “concern for the protection of free expression,” and held that Oregon would not “permit the right of publicity to bar the use of a celebrity’s name in a movie title unless the title was wholly

unrelated to the movie or was simply a disguised commercial advertisement for the sale of goods or services.” *Id.* at 1004 (internal quotation marks omitted).<sup>18</sup> After applying this test, the *Rogers* court concluded that the right of publicity claim merited dismissal because “the title ‘Ginger and Fred’ is clearly related to the content of the movie and is not a disguised advertisement for the sale of goods and services or a collateral commercial product.” *Id.* at 1004–05.<sup>19</sup>

But while the test, as articulated in *Rogers*, arguably applied only to the use of celebrity identity in a work’s title, Appellee suggests that the test can—and should—be applied more broadly. For support, Appellee looks to the Restatement (Third) of Unfair

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<sup>18</sup> For support, the *Rogers* court looked to California and New York case law. *Frosch v. Grosset & Dunlap, Inc.*, 75 A.D.2d 768, 427 N.Y.S.2d 828, 829 (1980) (“It is enough that the book is a literary work and not simply a disguised commercial advertisement for the sale of goods or services.”); *Guglielmi v. Spelling–Goldberg Prods.*, 25 Cal.3d 860, 160 Cal.Rptr. 352, 603 P.2d 454, 457 n.6 (1979) (“Such statements establish that this is not a case in which the use is wholly unrelated to the individual. . . . [T]his is not a case in which a celebrity’s name is used to promote or endorse a collateral commercial product or is otherwise associated with a product or service in an advertisement.”).

<sup>19</sup> Still, it bears noting that while the *Rogers* Test was arguably forged in the crucible of trademark law—and the *Rogers* court appeared to consult trademark principles for inspiration—the court also pointed out that “the right of publicity, unlike the Lanham Act, has no likelihood of confusion requirement” and is therefore “potentially more expansive than the Lanham Act.” *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989).



Competition, released in 1995, which characterizes the tort as follows:

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 [appropriate relief].

RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46. In explaining the term "use for purposes of trade," the Restatement notes that it does not "ordinarily include the use of a person's identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses." *Id.* § 47.

Moreover, the comments to Section 47 of the Restatement also note that:

[t]he right of publicity as recognized by statute and common law is fundamentally constrained by *the public and constitutional interest in freedom of expression*. The use of a person's identity primarily for purpose of communicating information or expressing ideas is not generally actionable as a violation of the person's right of publicity. . . . Thus the 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. . . . *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.*

*Id.* at § 47 cmt. c (emphasis added). Appellee argues that the above language adopts the *Rogers* Test and applies it to right of publicity claims dealing with any part of a work, not only its title. Appellee also cites to a number of cases purportedly supporting its position. *See, e.g., Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003); *Matthews v. Wozencraft*, 15 F.3d 432 (5th Cir. 1994). We do not find any of these cases particularly persuasive.

In *Matthews*, for example, the Fifth Circuit considered whether a fictional novel incorporating events from the life of an undercover narcotics officer violated the officer's right of publicity. In setting out the legal standard for a right of publicity claim, the court noted that it made no difference "whether [the book] is viewed as an historical or a fictional work, so long as it is not simply a disguised commercial advertisement for the sale of goods or services." *Matthews*, 15 F.3d at 440 (quotation marks and internal

citations omitted). This single, cryptic quotation notwithstanding, the court ultimately held in favor of the book’s author after applying a wholly different—and seemingly inapposite—First Amendment analysis: actual malice.<sup>20</sup> *See id.* (“[A]bsent a showing of actual malice . . . [the book] is protected by the First Amendment.”).

But where *Matthews* took an ambivalent position, the Sixth Circuit seemed—at least for a short time—to embrace the *Rogers* Test. In *Parks v. LaFace Records*, the Sixth Circuit was asked to determine whether a rap song entitled *Rosa Parks* infringed on the Civil Rights icon’s right of publicity. *Parks*, 329 F.3d at 441–42. After noting that *Rogers* was decided in the context of a movie, the Sixth Circuit held that an expansion of the test to “the context of other expressive works [was supported] by comment c of § 47 of the Restatement (Third) of Unfair Competition.” *Id.* at 461. Consequently, the Sixth Circuit ruled that there was an issue of material fact as to whether the title of the song (“Rosa Parks”) was “wholly unrelated” to the lyrics. *Id.* We find *Parks* to be less than persuasive given that just over a month later another panel of the Sixth Circuit decided *ETW Corp. v. Jireh Publishing, Inc.*, a right of publicity case where the Circuit applied the

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<sup>20</sup> In *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 108 S. Ct. 876, 99 L. Ed. 2d 41 (1988), the Supreme Court clarified its holding in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 97 S. Ct. 2849, 53 L. Ed. 2d 965 (1977), as standing for the proposition that “the ‘actual malice’ standard does not apply to the tort of appropriation of a right of publicity.” *Hustler*, 485 U.S. at 52, 108 S. Ct. 876.

Transformative Use Test. *See* 332 F.3d 915, 937 (6th Cir. 2003).<sup>21</sup>

Interestingly, this is not the first time that we have considered the proper scope of the *Rogers* Test. Indeed, we expressed doubt (albeit in dicta) over whether the Test could apply beyond the title of a work in *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3d Cir. 2008), a case centering on a suit by the estate of a well-known sports narrator against a sports film production company for Lanham Act violations and breach of the narrator's right of publicity. In analyzing the trademark claim, we expressed hesitation at extending the *Rogers* Test beyond the title of a work, adding that few other courts had done so at the time of our decision. *Id.* at 1018. Nothing in Appellee's argument has swayed us from this position and we thus remain skeptical that the *Rogers* Test applies to the general contents of a work when analyzing right of publicity claims.

#### ii. Analysis of the *Rogers* Test

Ultimately, we find that the *Rogers* Test does not present the proper analytical approach for cases such as the one at bar. While the Test may have a use in trademark-like right of publicity cases, it is inapposite

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<sup>21</sup> To be fair, the *ETW* court did briefly mention the *Rogers* decision before engaging in a lengthy discussion of the RESTATEMENT (THIRD) OF UNFAIR COMPETITION, ultimately concluding that the Restatement stood for the rather mundane principle that a right of publicity implicates a balancing test. *ETW Corp.*, 332 F.3d at 930–36. As we noted above, the balancing utilized by the *ETW* court was the Transformative Use Test.

here. We are concerned that this test is a blunt instrument, unfit for widespread application in cases that require a carefully calibrated balancing of two fundamental protections: the right of free expression and the right to control, manage, and profit from one's own identity.

The potential problem with applying the *Rogers* Test in this case is demonstrated by the following statement from Appellee's brief:

Because, as a former college football player, Hart's likeness is not 'wholly unrelated' to *NCAA Football* and the game is not a commercial advertisement for some unrelated product, Hart ... does not try to meet the ... test.

(Appellee's Br. at 24.) Effectively, Appellee argues that Appellant should be unable to assert a claim for appropriating his likeness as a football player precisely because his likeness was used for a game about football. Adopting this line of reasoning threatens to turn the right of publicity on its head.

Appellant's career as a college football player suggests that the target audience for his merchandise and performances (e.g., his actual matches) would be sports fans. It is only logical, then, that products appropriating and exploiting his identity would fare best—and thereby would provide ne'er-do-wells with the greatest incentive—when targeted at the sports-fan market segment. Given that Appellant played intercollegiate football, however, products targeting the sports-fan market would, as a matter of course, relate to him. Yet under Appellee's approach,

all such uses would be protected. It cannot be that the very activity by which Appellant achieved his renown now prevents him from protecting his hard-won celebrity. We decline to endorse such a conclusion and therefore reject the *Rogers* test as inapplicable.<sup>22</sup>

On the other hand, we do agree with the *Rogers* court in so far as it noted that the right of publicity does not implicate the potential for consumer confusion and is therefore potentially broader than the protections offered by the Lanham Act. *Rogers*, 875 F.2d at 1004. Indeed, therein lies the weakness of comparing the right of publicity to trademark protections: the right of publicity is broader and, by extension, protects a greater swath of property interests. Thus, it would be unwise for us to adopt a test that hews so closely to traditional trademark principles. Instead, we need a broader, more nuanced test, which helps balance the interests at issue in cases such as the one at bar. The final test—the Transformative Use Test—provides just such an approach.

### c. The Transformative Use Test

Looking to intellectual property law for guidance on how to balance property interests against the First Amendment has merit. We need only shift our gaze

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<sup>22</sup> We recognize that in *Brown v. Elec. Arts*, No. 2:09-cv-01598-FMC-RZ, 2009 WL 8763151 (C.D. Cal. Sept. 23, 2009), the District Court applied the *Rogers* test in analyzing another EA sports game: *Madden NFL*. Note, however, that the case did not involve a right of publicity claim, but a claim under the Lanham Act. *Id.* at \*1-2.

away from trademark, to the broader vista of copyright law. Thus, we come to the case of *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, which imported the concept of “transformative” use from copyright law into the right of publicity context. 25 Cal.4th 387, 106 Cal.Rptr.2d 126, 21 P.3d 797, 804–08 (2001). This concept lies at the core of a test that both Appellant and Appellee agree is applicable to this case: the Transformative Use Test.<sup>23</sup>

#### **i. Genesis of the Transformative Use Test**

The Transformative Use Test was first articulated by the Supreme Court of California in *Comedy III*.

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<sup>23</sup> Unlike in New Jersey, California’s right of publicity is a matter of both the state’s statutory law and its common law. *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134, 1138 (9th Cir. 2006) (discussing both the statutory and the common law cause of action); *see also* Cal. Civ.Code § 3344; *Eastwood v. Superior Court*, 149 Cal.App.3d 409, 198 Cal.Rptr. 342, 347 (1983). This difference notwithstanding, the laws are strikingly similar—and protect similar interests. Under California law, “any person who knowingly uses another’s name . . . or likeness, in any manner, or in any products, merchandise, or goods, or for the purposes of advertising or selling, or soliciting purchases of . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.” Cal. Civ. Code § 3344(a). In the words of the California Supreme Court, “the right of publicity is essentially an economic right. What the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity’s fame. . . .” *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 807. This is analogous to the conceptualization of the right of publicity in New Jersey, and we consequently see no issue in applying balancing tests developed in California to New Jersey.

That case concerned an artist's production and sale of t-shirts and prints bearing a charcoal drawing of the Three Stooges. The California court determined that while "[t]he right of publicity is often invoked in the context of commercial speech," it could also apply in instances where the speech is merely expressive. *Id.*, 106 Cal.Rptr.2d 126, 21 P.3d at 802–803. The court also noted, however, that when addressing expressive speech, "the very importance of celebrities in society means that the right of publicity has the potential of censoring significant expression by suppressing alternative versions of celebrity images that are iconoclastic, irreverent or otherwise attempt to redefine the celebrity's meaning." *Id.*, 106 Cal.Rptr.2d 126, 21 P.3d at 803. Thus, while the "the right of publicity cannot, consistent with the First Amendment, be a right to control the celebrity's image by censoring disagreeable portrayals," *id.*, 106 Cal.Rptr.2d 126, 21 P.3d at 807, the right, like copyright, nonetheless offers protection to a form of intellectual property that society deems to have social utility, *id.*, 106 Cal.Rptr.2d 126, 21 P.3d at 804.

After briefly considering whether to import the "fair use" analysis from copyright, the *Comedy III* court decided that only the first fair use factor, "the purpose and character of the use," was appropriate. *Id.*, 106 Cal.Rptr.2d 126, 21 P.3d at 808. Specifically, the *Comedy III* court found persuasive the Supreme Court's holding in *Campbell v. Acuff–Rose Music, Inc.* that

the central purpose of the inquiry into this fair use factor 'is to see . . . whether the new work



merely “supercede[s] the objects” of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is “*transformative*.”

*Id.* (emphasis added) (citing *Campbell v. Acuff–Rose Music, Inc.*, 510 U.S. 569, 579, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994)).

Going further, the court explained that works containing “significant transformative elements” are less likely to interfere with the economic interests implicated by the right of publicity. For example, “works of parody or other distortions of the celebrity figure are not, from the celebrity fan’s viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect.” *Id.* The court was also careful to emphasize that “the transformative elements or creative contributions” in a work may include—under the right circumstances—factual reporting, fictionalized portrayal, heavy-handed lampooning, and subtle social criticism. *Id.*, 106 Cal.Rptr.2d 126, 21 P.3d at 809 (“The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.”).<sup>24</sup>

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<sup>24</sup> The court in *Comedy III* also added an ancillary question to its inquiry: “does the marketability and economic value of the challenged work derive primarily from the fame of the celebrity

Restating its newly-articulated test, the Supreme Court of California held that the balance between the right of publicity and First Amendment interests turns on

[w]hether the celebrity likeness is one of the “raw materials” from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, *whether the 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.

*Id.* (emphasis added).

Applying this test, the court concluded that charcoal portraits of the Three Stooges did violate the Stooges’ rights of publicity, holding that the court could “discern no significant transformative or creative contribution” and that “the marketability and economic value of [the work] derives primarily from the fame of the celebrities depicted.” *Id.*, 106 Cal.Rptr.2d 126, 21 P.3d at 811.

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depicted?” *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 810. If not, then “there would generally be no actionable right of publicity.” *Id.* However, the inverse is not necessarily true: even if the work does derive its value principally from the celebrity’s depiction, “it may still be a transformative work.” *Id.*

## ii. Application of the Transformative Use Test

Given its relative recency, few courts have applied the Transformative Use Test, and consequently there is not a significant body of case law related to its application. Nonetheless, a handful of cases bear mention as they help frame our inquiry.

In 2003, the Supreme Court of California revisited the Transformative Use Test when two musicians, Johnny and Edgar Winter, who both possessed long white hair and albino features, brought suit against a comic book company over images of two villainous half-man, half-worm creatures, both with long white hair and albino features, named Johnny and Edgar Autumn. *Winter v. DC Comics*, 30 Cal.4th 881, 134 Cal.Rptr.2d 634, 69 P.3d 473, 476 (2003). As the brothers' right of publicity claims necessarily implicated DC Comics' First Amendment rights, the *Winter* court looked to the Transformative Use Test. In summarizing the test, the court explained that “[a]n artist depicting a celebrity must contribute something more than a ‘merely trivial’ variation, [but must create] something recognizably ‘his own,’ in order to qualify for legal protection.” *Id.*, 134 Cal.Rptr.2d 634, 69 P.3d at 478 (alteration in original) (quoting *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 810–11). Thus, in applying the test, the *Winter* court held that

[a]lthough the fictional characters Johnny and Edgar Autumn are less-than-subtle evocations of Johnny and Edgar Winter, the books do not depict plaintiffs literally. Instead, plaintiffs are merely part of the raw materials from which the

comic books were synthesized. To the extent the drawings of the Autumn brothers resemble plaintiffs at all, they are distorted for purposes of lampoon, parody, or caricature. And the Autumn brothers are but cartoon characters—half-human and half-worm—in a larger story, which is itself quite expressive.

*Id.*, 134 Cal.Rptr.2d 634, 69 P.3d at 479. The court therefore found that “fans who want to purchase pictures of [the Winter brothers] would find the drawing of the Autumn brothers unsatisfactory as a substitute for conventional depictions.” *Id.*<sup>25</sup> Consequently, the court rejected the brothers’ claims for a right of publicity violation.

Also in 2003, the Sixth Circuit decided *ETW*, a case focusing on a photograph of Tiger Woods set among a collage of other, golf-related photographs. As we previously noted, while *ETW* mentioned both the *Rogers* case and the Restatement (Third) of Unfair Competition, the test it ultimately applied was a combination of an ad-hoc approach and the Transformative Use Test. *See ETW*, 332 F.3d at 937–38. In holding that the collage “contain[ed] significant transformative elements,” *id.* at 938, the court compared it to the Three Stooges portraits from

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<sup>25</sup> The *Winter* court also found unpersuasive arguments that the comic books were marketed by “trading on [the brothers’] likenesses and reputations to generate interest in the comic book series.” *Winter v. DC Comics*, 30 Cal.4th 881, 134 Cal.Rptr.2d 634, 69 P.3d 473, 479 (2003). The court held that considerations of marketing strategy were “irrelevant” because the “question is whether the work is transformative, not how it is marketed.” *Id.*

*Comedy III*, and noted that the collage “does not capitalize solely on a literal depiction of Woods.” *Id.* Instead, 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.” *Id.*; *see also Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 809 (noting that “transformative elements or creative contributions . . . can take many forms”).

*ETW* presents an archetypical example of a case falling somewhere in the middle of Transformative Use Test jurisprudence, given that it focuses on the use of photographs (literal depictions of celebrities), but adds a transformative aspect to the work, thereby altering the meaning behind the use of the celebrity’s likeness. Arguably, the *Comedy III* and *Winter* decisions bookend the spectrum of cases applying the Transformative Use Test. Where *Comedy III* presents a clear example of a non-transformative use (i.e., mere literal depictions of celebrities recreated in a different medium), *Winter* offers a use that is highly transformative (i.e., fanciful characters, placed amidst a fanciful setting, that draw inspiration from celebrities). As with *ETW*, however, most of the cases discussed below (along with the instant case), fall somewhere between these two decisions. This same analytical approach—focusing on whether and how the celebrity’s likeness is transformed—appears in decisions by courts applying the Transformative Use Test to video games, an area of law which we consider next.

### iii. The Transformative Use Test and Video Games

In mid-2006, the California Court of Appeal decided *Kirby v. Sega of America, Inc.*, 144 Cal.App.4th 47, 50 Cal.Rptr.3d 607 (2006), which addressed a musician's right of publicity claim against a video game company. Specifically, the musician (Kierin Kirby) had claimed that Sega misappropriated her likeness and signature phrases for purposes of creating the character of Ulala, a reporter in the far flung future. In applying the Transformative Use Test, the court noted that not only did Kirby's signature phrases included "ooh la la" but that both she and the videogame character would often use phrases like "groove," "meow," "dee-lish," and "I won't give up." *Id.* at 613. The court also found similarities in appearance between Kirby and Ulala, based on hair style and clothing choice. *Id.* At the same time, the court held that differences between the two did exist—both in appearance and movement—and that Ulala was not a mere digital recreation of Kirby. *Id.* Thus, the court concluded that Ulala passed the Transformative Use Test, rejecting Kirby's argument that the differences between her and the character added no additional meaning or message to the work. *Id.* at 616–17 ("A work is transformative if it adds 'new expression.' That expression alone is sufficient; it need not convey any 'meaning or message.' "); *see also id.* at 617 ("[A]ny imitation of Kirby's likeness or identity in Ulala is not the sum and substance of that character.").

Several years later, in early 2011, the California courts again confronted the right of publicity as it related to video games in *No Doubt v. Activision*

*Publishing, Inc.*, 192 Cal.App.4th 1018, 122 Cal.Rptr.3d 397 (2011). The case centered on *Band Hero*, a game that allows player to “simulate performing in a rock band in time with popular songs” by selecting digital avatars to represent them in an in-game band. *Id.* at 401. Some of the avatars were digital recreations of real-life musicians, including members of the band No Doubt.<sup>26</sup> After a contract dispute broke off relations between the band and the company, No Doubt sued, claiming a violation of their rights of publicity. The California Court of Appeal applied the Transformative Use Test.

The *No Doubt* court began by noting that “in stark contrast to the ‘fanciful creative characters’ in *Winter and Kirby*,” the No Doubt avatars could not be altered by players and thus remained “at all times immutable images of the real celebrity musicians.” *Id.* at 410. But this fact, by itself, did not end the court’s inquiry since “even literal reproductions of celebrities can be ‘transformed’ into expressive works based on the

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<sup>26</sup> According to the decision,

members of No Doubt participated in a full-day motion capture photography session at Activision’s studios so that the band members’ Band Hero avatars would accurately reflect their appearances, movements, and sounds. No Doubt then closely reviewed the motion capture photography and the details related to the appearance and features of their avatars to ensure the representations would meet with approval. The end results are avatars that closely match the appearance of each of the No Doubt band members.

*No Doubt*, 122 Cal.Rptr.3d at 402.

context into which the celebrity image is placed.” *Id.* (citing *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 811). Looking to the context of the *Band Hero* game, the court found that “no matter what else occurs in the game *during the depiction of the No Doubt avatars*, the avatars perform rock songs, the same activity by which the band achieved and maintains its fame.” *Id.* at 410–11 (emphasis added). The court explained:

[T]he avatars perform [rock] songs as literal recreations of the band members. That the avatars can be manipulated to perform at fanciful venues including outer space or to sing songs the real band would object to singing, or that the avatars appear in the context of a videogame *that contains many other creative elements*, does not transform the avatars into anything other than the exact depictions of No Doubt’s members doing exactly what they do as celebrities.

*Id.* at 411 (emphasis added).<sup>27</sup> As a final step in its analysis, the court noted that Activision’s use of highly realistic digital depictions of No Doubt was motivated

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<sup>27</sup> For support, the *No Doubt* court relied on the Ninth Circuit’s decision in *Hilton v. Hallmark Cards*, where our sister court held that a greeting card depicting Paris Hilton’s head on a cartoon waitress accompanied by the line “that’s hot” was not transformative and thus infringed on Hilton’s right of publicity. 599 F.3d 894, 911 (9th Cir. 2010) (“While a work need not be phantasmagoric as in *Winter* or fanciful as in *Kirby* in order to be transformative, there is enough doubt as to whether Hallmark’s card is transformative under our case law that we cannot say Hallmark is entitled to the defense. . .”).



by a desire to capitalize on the band’s fan-base, “because it encourages [fans] to purchase the game so as to *perform as, or alongside, the members of No Doubt.*” *Id.* (emphasis added). Given all this, the court concluded that Activision’s use of No Doubt’s likenesses did infringe on the band’s rights of publicity. *Id.* at 411–12.<sup>28</sup>

#### iv. Analysis of the Transformative Use Test

Like the Predominant Use and *Rogers* tests, the Transformative Use Test aims to balance the interest protected by the right of publicity against those interests preserved by the First Amendment. In our view, the Transformative Use Test appears to strike the best balance because it provides courts with a flexible—yet uniformly applicable—analytical framework. Specifically, the Transformative Use Test seems to excel precisely where the other two tests

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<sup>28</sup> Before moving on, it behooves us to mention a pair of cases decided in the Northern District of California: *Davis v. Elec. Arts Inc.*, No. 10–cv–03328, 2012 WL 3860819 (N.D. Cal. Mar. 29, 2012); *Keller v. Elec. Arts, Inc.*, No. 09–cv–01967, 2010 WL 530108 (N.D. Cal. Feb. 8, 2010). Both cases concern right of publicity claims asserted against EA for use of football players’ likenesses in their game franchises. *Davis* related to EA’s *Madden NFL* games while *Keller* is simply our own case incarnated in California. In both disputes the court applied the Transformative Use Test, and in both instances the court decided that EA’s use of the players’ likenesses failed the Test. *Davis*, 2012 WL 3860819, at \*5–6; *Keller*, 2010 WL 530108, at \*3–5. We note these cases in passing only because they are both currently on appeal before the Ninth Circuit and we feel it imprudent to rely too heavily on decisions that our sister court is still considering.

falter. Unlike the *Rogers* Test, the Transformative Use Test maintains a singular focus on whether the work sufficiently transforms the celebrity's identity or likeness, thereby allowing courts to account for the fact that misappropriation can occur in any market segment, including those related to the celebrity.

On the other hand, unlike the Predominant Use Test, applying the Transformative Use Test requires a more circumscribed inquiry, focusing on the specific aspects of a work that speak to whether it was merely created to exploit a celebrity's likeness. This test therefore recognizes that if First Amendment protections are to mean anything in right of publicity claims, courts must *begin* by considering the extent to which a work is the creator's own expression.<sup>29</sup>

Additionally, the Transformative Use Test best comports with the cautionary language present in various right of publicity cases. Specifically, we believe that an initial focus on the creative aspects of a work helps address our own concern from *Facenda*, where we noted that "courts must circumscribe the right of publicity." *Facenda*, 542 F.3d at 1032. As our discussion below demonstrates, the Transformative Use Test effectively restricts right of publicity claims to a very

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<sup>29</sup> While we acknowledge that the test in *Comedy III* included a question as to whether the "marketability and economic value of [the work] derive primarily from the fame of the celebrities depicted," *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 810, we note that this is a secondary question. The court in *Comedy III* rightly recognized that the balancing inquiry suggested by the Supreme Court in *Zacchini* cannot start and stop with commercial purpose or value.

narrow universe of expressive works. Moreover, we believe that the Transformative Use Test best exemplifies the methodology suggested by Justice Powell’s dissent in *Zacchini*:

Rather than begin with a quantitative analysis of the performer’s behavior—is this or is this not his entire act?—we should direct initial attention to the actions of the news media: what use did the station make of the film footage? When a film is used, as here, for a routine portion of a regular news program, I would hold that the First Amendment protects the station from a “right of publicity” or “appropriation” suit, absent a strong showing by the plaintiff that the news broadcast was a subterfuge or cover for private or commercial exploitation.

*Zacchini*, 433 U.S. at 581, 97 S. Ct. 2849 (Powell, J., dissenting). Consistent with Justice Powell’s argument, the Transformative Use Test begins by asking “what use did the [defendant] make of the [celebrity identity]?” *Id.*<sup>30</sup>

Finally, we find that of the three tests, the Transformative Use Test is the most consistent with other courts’ ad hoc approaches to right of publicity cases. For example, a majority of the Supreme Court of California in *Guglielmi v. Spelling-Goldberg*

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<sup>30</sup> While the Predominant Use Test may appear to accomplish the same task, we think it does not. In point of fact, it merely looks to the expressive “value” of a celebrity’s identity, not its use, vis-à-vis the challenged work.

*Productions* argued<sup>31</sup> that the “fictionalized version” of a late actor’s life, “depicting the actor’s name, likeness and personality without obtaining ... prior consent” was entitled to protection from a right of publicity claim. 160 Cal.Rptr. 352, 603 P.2d at 455, 457–59.<sup>32</sup> In essence, the actor’s identity was sufficiently transformed by the fictional elements in the book so as to tip the balance of interests in favor of the First Amendment. *See id.*, 160 Cal.Rptr. 352, 603 P.2d at 457 (Bird, C.J., concurring).

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<sup>31</sup> The Supreme Court of California affirmed the lower court’s decision to dismiss the case without engaging with the right of publicity claim beyond noting that the right “expires upon the death of the person so protected.” *Guglielmi*, 160 Cal.Rptr. 352, 603 P.2d at 455. The Chief Justice’s concurring opinion, joined by a majority of the court, provided a full analysis of the issue, and in subsequent years has been treated as the Court’s majority opinion. *See Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 803 (citing the *Guglielmi* concurrence while noting that “[a] majority of this court” had agreed to its reasoning); *see also Guglielmi*, 160 Cal.Rptr. 352, 603 P.2d at 464 (Newman, J., concurring) (“I concur in the discussion in the Chief Justice’s opinion that sets forth principles for determining whether an action based on the invasion of an individual’s right of publicity may be maintained in the face of a claim that the challenged use is an exercise of freedom of expression.”).

<sup>32</sup> After noting that the movie was protected despite being a work of fiction that was made for profit, *Guglielmi*, 160 Cal.Rptr. 352, 603 P.2d at 458–59, Chief Justice Bird rejected the contention that defendants “could have expressed themselves without using [the actor’s] name and likeness,” arguing that “[n]o author should be forced into creating mythological worlds or characters wholly divorced from reality. The right of publicity derived from public prominence does not confer a shield to ward off caricature, parody and satire. Rather, prominence invites creative comment.” *Id.*, 160 Cal.Rptr. 352, 603 P.2d at 459–60.

Likewise, in *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981), the United States District Court for the District of New Jersey held that an Elvis impersonator’s act was subject to right of publicity claims because “entertainment that is merely a copy or imitation, even if skillfully and accurately carried out, does not really have its *own creative component* and does not have a significant value as pure entertainment.” *Id.* at 1359 (emphasis added). Seen through the lens of the Transformative Use Test, the *Russen* decision demonstrates that where no additional transformative elements are present—i.e., the work contains “merely a copy or imitation” of the celebrity’s identity—then there can be no First Amendment impediment to a right of publicity claim.<sup>33</sup> Additionally, in *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir. 1996), which focused on the use of baseball players’ identities for parody trading cards, the transformative nature of the caricatures on the cards (and the parodic text about the players’ “statistics”) was sufficient to quash any right of publicity claim. *Id.* at 972–73 (“Because celebrities are an important part of our public vocabulary, a parody of a celebrity does not merely lampoon the

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<sup>33</sup> The court’s “recognition that defendant’s production has some [First Amendment] value,” did not diminish its conclusion that “the primary purpose of defendant’s activity [was] to appropriate the commercial value of the likeness of Elvis Presley.” *Russen*, 513 F. Supp. at 1360. In this regard the court analogized the case to *Zacchini*, holding that the Elvis impersonator had “appropriated the ‘very activity [live stage show] by which [Presley initially] acquired his reputation.’” *Id.* at 1361 (alteration in original).

celebrity, but exposes the weakness of the idea or value that the celebrity symbolizes in society.”).<sup>34</sup>

It is little wonder, then, that the *Comedy III* decision looked to all three of these cases for guidance in defining the Transformative Use Test. *See Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 806–09.<sup>35</sup> The fact that such prior holdings can be reconciled with the Test not only bolsters our views as to its propriety, but also ensures that adopting the Transformative Use Test does not result in the sort of backward-looking jurisprudential revision that might disturb prior protections for expressive speech.<sup>36</sup> Quite to the

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<sup>34</sup> The Tenth Circuit also considered the economic incentives underlying the right of publicity. *See Cardtoons*, 95 F.3d at 973–74. After a close examination, the court recognized only one principal benefit for celebrities from having control over works of parody: “control over the potential effect the parody would have on the market for nonparodic use of one’s identity.” *Id.* at 974. However, the court quickly added that parody “rarely acts as a market substitute for the original.” *Id.* As a consequence, the court ruled in favor of the card manufacturer.

<sup>35</sup> We note here that, by our reading, the Transformative Use Test best comports with the language in RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c. While we acknowledge that other courts have read the Restatement as adopting the *Rogers* Test, we believe that the various examples listed in Comment C all exemplify the sort of transformative uses that would generally pass the analysis set forth in *Comedy III*.

<sup>36</sup> Indeed, in compiling its non-exhaustive list of “transformative elements or creative components,” the *Comedy III* court looked for examples from previous decisions—including *Guglielmi*, *Cardtoons*, and even *Parks*. *See Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 809–10.

contrary, adopting the Test ensures that already-existing First Amendment protections in right of publicity cases apply to video games with the same force as to “biographies, documentaries, docudramas, and other expressive works depicting real-life figures.” (Dissent Op. at 173.)

In light of the above discussion, we find that the Transformative Use Test is the proper analytical framework to apply to cases such as the one at bar. Consequently, we now apply the test to the facts of the instance case.

### C. Application

In applying the Transformative Use Test to the instant case, we must determine whether Appellant’s identity is sufficiently transformed in *NCAA Football*. As we mentioned earlier, we use the term “identity” to encompass not only Appellant’s likeness, but also his biographical information. It is the combination of these two parts—which, when combined, identify the digital avatar as an in-game recreation of Appellant—that must be sufficiently transformed.<sup>37</sup>

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<sup>37</sup> This joint focus on both likeness and identifying information avoids a conflict with *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007), which held that use of major league baseball players’ records in a fantasy baseball game was protected by the First Amendment even against right of publicity claims because such information was publicly available. *Id.* at 823–24. The presence of a digital avatar that recreates Appellant in a digital medium differentiates this matter from *C.B.C.*

Having thus cabined our inquiry to the appropriate form of Appellant's identity, we note that—based on the combination of both the digital avatar's appearance and the biographical and identifying information—the digital avatar does closely resemble the genuine article. Not only does the digital avatar match Appellant in terms of hair color, hair style and skin tone, but the avatar's accessories mimic those worn by Appellant during his time as a Rutgers player. The information, as has already been noted, also accurately tracks Appellant's vital and biographical details. And while the inexorable march of technological progress may make some of the graphics in earlier editions of *NCAA Football* look dated or overly-computerized, we do not believe that video game graphics must reach (let alone cross) the uncanny valley to support a right of publicity claim.<sup>38</sup> If we are to find some transformative element, we must look somewhere other than just the in-game digital recreation of Appellant.<sup>39</sup> Cases such as *ETW*

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<sup>38</sup> It remains an open question, however, whether right of publicity claims can extend into the bygone days of 8-bit graphics and pixilated representations.

<sup>39</sup> It is no answer to say that digitizing Appellant's appearance in and of itself works a transformative use. Recreating a celebrity's likeness or identity in some medium other than photographs or video cannot, without more, satisfy the test; this would turn the inquiry on its head—and would contradict the very basis for the Transformative Use Test. *See, e.g., Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 809 (applying the Transformative Use Test to charcoal drawings of the Three Stooges); *see also Estate of Presley v. Russen*, 513 F. Supp. 1339, 1359 (D.N.J. 1981) (“[E]ntertainment that is merely a copy or imitation, even if skillfully and accurately



and *No Doubt*, both of which address realistic digital depictions of celebrities, point to the next step in our analysis: context.

Considering the context within which the digital avatar exists—effectively, looking at how Appellant’s identity is “incorporated into and transformed by” *NCAA Football*, (Dissent Op. at 173)—provides little support for Appellee’s arguments. The digital Ryan Hart does what the actual Ryan Hart did while at Rutgers: he plays college football, in digital recreations of college football stadiums, filled with all the trappings of a college football game. This is not transformative; the various digitized sights and sounds in the video game do not alter or transform the Appellant’s identity in a significant way. *See No Doubt*, 122 Cal.Rptr.3d at 410–11 (“[N]o matter what else occurs in the game during the depiction of the No Doubt avatars, the avatars perform rock songs, the same activity by which the band achieved and maintains its fame.”). Indeed, the lack of transformative context is even more pronounced here than in *No Doubt*, where members of the band could perform and sing in outer space.

Even here, however, our inquiry is not at an end. For as much as the digital representation and context evince no meaningful transformative element in *NCAA Football*, a third avatar-specific element is also present: the users’ ability to alter the avatar’s appearance. This distinguishing factor ensures that we cannot dispose of this case as simply as the court in *No Doubt*. *See No*

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carried out, does not really have its own creative component and does not have a significant value as pure entertainment.”).

*Doubt*, 122 Cal.Rptr.3d at 410 (noting that the digital avatars representing No Doubt were “at all times immutable images of the real celebrity musicians”). Indeed, the ability for users to change the avatar accounted, in large part, for the District Court’s deciding that *NCAA Football* satisfied the Transformative Use Test. See *Hart*, 808 F. Supp. 2d at 785.<sup>40</sup> We must therefore consider to what extent the ability to alter a digital avatar represents a transformative use of Appellant’s identity.

At the outset, we note that the mere presence of this feature, without more, cannot satisfy the Transformative Use Test. True, interactivity is the basis upon which First Amendment protection is granted to video games in the first instance.<sup>41</sup> See *Brown*, 131 S. Ct. at 2733. However, the balancing test in right of publicity cases does not look to whether a

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<sup>40</sup> To be clear, the District Court focused specifically on the *ability* to alter the digital avatars, not on the alterations themselves:

[I]t is not the user’s alteration of Hart’s image that is critical. What matters for my analysis of EA’s First Amendment right is that EA created the mechanism by which the virtual player may be altered, as well as the multiple permutations available for each virtual player image.

*Hart*, 808 F. Supp. 2d at 785. That is, the court below did not look to the users’ creations as proxies for Appellee’s expression. While we disagree with its final decision, we agree with the District Court’s careful navigation of this point.

<sup>41</sup> We note, too, that all games are interactive—that is a product of the medium. Identifying an interactive feature that acts upon the celebrity’s likeness, therefore, is only the *first step* in the analysis.

particular work *loses* First Amendment protection. Rather, the balancing inquiry looks to see whether the interests protected by the right of publicity are sufficient to *surmount* the already-existing First Amendment protections. *See, e.g., Guglielmi*, 160 Cal.Rptr. 352, 603 P.2d at 458 (considering whether right of publicity protections “outweigh [ ] any protection [the] expression would otherwise enjoy under the [First Amendment]”). As *Zacchini* demonstrated, the right of publicity can triumph even when an essential element for First Amendment protection is present. In that case, the human cannonball act was broadcast *as part of the newscast*. *See Zacchini*, 433 U.S. at 563, 97 S. Ct. 2849. To hold, therefore, that a video game should satisfy the Transformative Use Test simply because it includes a particular interactive feature would lead to improper results. Interactivity cannot be an end unto itself.<sup>42</sup>

Moreover, we are wary of converting the ability to alter a digital avatar from mere feature to talisman, thereby opening the door to cynical abuse. If the mere presence of the feature were enough, video game companies could commit the most blatant acts of misappropriation only to absolve themselves by including a feature that allows users to modify the digital likenesses. We cannot accept that such an

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<sup>42</sup> The other side of this coin is equally true: interactivity is not the sine qua non of transformative use. Works involving video games may still be transformative even where no specific interactive features affect the celebrity likeness. *See, e.g., Kirby v. Sega of Am., Inc.*, 144 Cal.App.4th 47, 50 Cal.Rptr.3d 607 (2006).

outcome would adequately balance the interests in right of publicity cases. As one amicus brief noted:

[U]nder [Appellee's] application of the transformative test [sic], presumably no infringement would be found if individuals such as the Dalai Lama and the Pope were placed within a violent "shoot-em-up" game, so long as the game include[d] a "mechanism" by which the user could manipulate their characteristics.

(Screen Actors Guild, Inc. et al., Amicus Br. at 21.<sup>43</sup>) With this concern in mind, therefore, we consider whether the type and extent of interactivity permitted is sufficient to transform the Appellant's likeness into the Appellee's own expression. We hold that it does not.

In *NCAA Football*, Appellee seeks to create a realistic depiction of college football for the users. Part of this realism involves generating realistic representations of the various college teams—which includes the realistic representations of the players. Like Activision in *No Doubt*, therefore, Appellee seeks to capitalize on the respective fan bases for the various teams and players. Indeed, as the District Court recognized, "it seems ludicrous to question whether video game consumers enjoy and, as a result, purchase more EA-produced video games as a result of the heightened realism associated with actual players."

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<sup>43</sup> We do not discount the possibility that such a game—given the juxtaposition of spiritual leaders and the hyper violence of certain modern video games—could still pass the Transformative Use Test on other grounds.

*Hart*, 808 F. Supp. 2d at 783 (quoting James J.S. Holmes & Kanika D. Corley, *Defining Liability for Likeness of Athlete Avatars in Video Games*, *L.A. Law.*, May 2011, at 17, 20). Moreover, the realism of the games—including the depictions and recreations of the players—appeals not just to home-team fans, but to bitter rivals as well. Games such as *NCAA Football* permit users to recreate the setting of a bitter defeat and, in effect, achieve some cathartic readjustment of history; realistic depictions of the players are a necessary element to this.<sup>44</sup> That Appellant’s likeness is the *default* position only serves to support our conclusion that realistic depictions of the players are the “sum and substance” of these digital facsimiles.<sup>45</sup> See *Kirby*, 50 Cal.Rptr.3d at 617–18. Given that Appellant’s unaltered likeness is central to the core of the game experience, we are disinclined to credit users’ ability to alter the digital avatars in our application of the Transformative Use Test to this case.

We are likewise unconvinced that *NCAA Football* satisfies the Transformative Use Test because

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<sup>44</sup> We set aside the “Dynasty” and “Campus Legends” game modes in this inquiry. We see no legally significant difference between these modes and the ability in *Band Hero* to select alternative avatars to represent the players or to allow members of *No Doubt* to play with other bands or sing other musicians’ songs. See *No Doubt*, 122 Cal.Rptr.3d at 401.

<sup>45</sup> Admittedly, just as the presence of a photorealistic depiction of a celebrity cannot be the end of the inquiry, the mere fact that Appellant’s likeness is the default appearance of the avatar cannot, without more, end our analysis. It is merely another factor to consider in the balancing exercise.

Appellee created various in-game assets to support the altered avatars (*e.g.*, additional hair styles, faces, accessories, et al.). In the first instance, the relationship between these assets and the digital avatar is predicated on the users' desire to alter the avatar's appearance, which, as we have already noted, is insufficient to satisfy the Test. The ability to make minor alterations—which substantially maintain the avatar's resemblance to Appellant (*e.g.*, modifying only the basic biographical information, playing statistics, or uniform accessories)—is likewise insufficient, for “[a]n artist depicting a celebrity must contribute something more than a ‘merely trivial’ variation.” *Winter*, 134 Cal.Rptr.2d 634, 69 P.3d at 478–79. Indeed, the ability to modify the avatar counts for little where the appeal of the game lies in users' ability to play “as, or alongside” their preferred players or team. *See No Doubt*, 122 Cal.Rptr.3d at 411. Thus, even avatars with superficial modifications to their appearance can count as a suitable proxy or market “substitute” for the original. *See Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 808; *Winter*, 134 Cal.Rptr.2d 634, 69 P.3d at 479; *Cardtoons*, 95 F.3d at 974. For larger potential changes, such as a different body type, skin tone, or face, Appellant's likeness is not transformed; it simply ceases to be. Therefore, once a user has made major changes to the avatar, it no longer represents Appellant, and thus it no longer qualifies as a “use” of the Appellant's identity for purposes of our inquiry. Such possibilities therefore fall beyond our inquiry into how *Appellant's likeness* is used in *NCAA Football*. That the game may lend itself to uses wholly divorced from the appropriation of Appellant's identity is

insufficient to satisfy the Transformative Use Test. *See No Doubt*, 122 Cal.Rptr.3d 397 (focusing on the use of the No Doubt avatars, not alternative avatars or custom-made characters).

In an attempt to salvage its argument, Appellee suggests that *other* creative elements of *NCAA Football*, which do not affect Appellant’s digital avatar, are so numerous that the videogames should be considered transformative. We believe this to be an improper inquiry. Decisions applying the Transformative Use Test invariably look to how the *celebrity’s identity* is used in or is altered by other aspects of a work. Wholly unrelated elements do not bear on this inquiry. Even *Comedy III*, in listing potentially “transformative or creative contributions” focused on elements or techniques that affect the celebrity identity. *See Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 809 (discussing factual reporting, fictionalized portrayal, heavy-handed lampooning, and subtle social criticism); *see also Winter*, 134 Cal.Rptr.2d 634, 69 P.3d at 478–79 (noting that “[a]n artist depicting a celebrity must contribute something more than a ‘merely trivial’ variation” before proceeding to discuss how the Winter brothers’ likenesses were altered directly and through context); *Kirby*, 50 Cal.Rptr.3d at 616–18. To the extent that any of these cases considered the broader context of the work (e.g., whether events took place in a “fanciful setting”), this inquiry was aimed at determining whether this context acted upon the celebrity identity in a way that transformed it or imbued it with some added creativity

beyond providing a “merely trivial variation.”<sup>46</sup> Thus, while we recognize the creative energies necessary for crafting the various elements of *NCAA Football* that are not tied directly to reality, we hold that they have no legal significance in our instant decision.

To hold otherwise could have deleterious consequences for the state of the law. Acts of blatant misappropriation would count for nothing so long as the larger work, on balance, contained highly creative elements in great abundance. This concern is particularly acute in the case of media that lend themselves to easy partition such as video games. It cannot be that content creators escape liability for a work that uses a celebrity’s unaltered identity in one section but that contains a wholly fanciful creation in the other, larger section.

For these reasons, we hold that the broad application of the Transformative Use Test represents an inappropriate application of the standard. Consequently, we shall not credit elements of *NCAA Football* that do not, in some way, affect the use or meaning of Appellant’s identity.

As a final point, we note that the photograph of Appellant that appears in *NCAA Football 2009* does not bear on our analysis above. On that subject, we agree with the District Court that the photograph is

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<sup>46</sup> As we have already discussed, the broader context of *NCAA Football* does not transform Appellant’s likeness into anything other than a digital representation of Appellant playing the sport for which he is known, while surrounded by the trappings of real-world competition.



“but a fleeting component part of the montage” and therefore does not render the entire work nontransformative. *Hart*, 808 F. Supp. 2d at 786. The reasoning from *ETW* is sufficiently applicable: the context of Appellant’s photograph—the montage—imbues the image with additional meaning beyond simply being a representation of the player. See *ETW*, 332 F.3d at 938 (holding that the photographs in a collage were “combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of [Tiger] Woods’s achievement in that event”). Consequently, this particular use of Appellant’s likeness *is* shielded by the First Amendment and therefore can contribute nothing to Appellant’s claim for violation of his right of publicity.

#### IV. CONCLUSION

We therefore hold that the *NCAA Football 2004*, *2005* and *2006* games at issue in this case do not sufficiently transform Appellant’s identity to escape the right of publicity claim and hold that the District Court erred in granted summary judgment in favor of Appellee.<sup>47</sup> While we do hold that the only apparent use

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<sup>47</sup> There can be no doubt that video games such as *NCAA Football* are the product of great effort, skill, and creative and technical prowess. As the Supreme Court noted in *Brown*, video games convey messages and expressive content in a way that is similar to prior media for expression. *Brown v. Entm’t Merchs. Ass’n*, — U.S. —, 131 S. Ct. 2729, 2733, 180 L. Ed. 2d 708 (2011). At the same time, games open new avenues through which artists and speakers can express their opinions and observations—by playing the game, a user is integrated into the expressive work in a way that has never before been achieved. Surely, then, the First

of Appellant's likeness in *NCAA Football 2009* (the photograph) is protected by the First Amendment, Appellant's overall claim for violation of his right of publicity should have survived Appellee's motion for summary judgment. Consequently, we need not address Appellant's desire for additional discovery. We shall reverse the District Court's grant of summary judgment and remand this case back to the court below for further proceedings consistent with this opinion.

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Amendment protects video games in the first instance, and nothing in our decision today should be read to diminish this fact. Rather, our inquiry looked to whether other interests may surmount the First Amendment protection—as they can surmount protections for other modes of expression. In finding that *NCAA Football* failed to satisfy the Transformative Use Test, we do not hold that the game loses First Amendment protection. We merely hold that the interest protected by the right of publicity in this case outweighs the Constitutional shield.

AMBRO, Circuit Judge, dissenting.

My colleagues and I take the same road but read the signs differently. Hence we stop at different places. I wish I was with them; I am not. I recognize that Electronic Arts, Inc. (“EA”) has taken for the 2005 version of *NCAA Football* what most good Rutgers fans during Ryan Hart’s playing days know—the Rutgers quarterback is Hart—and parlayed that recognition into commercial success.<sup>1</sup> A key to the profitability of *NCAA Football* is consumers’ desire to experience a realistic football playing experience with their favorite teams. EA’s use of actual college athletes’ likenesses motivates buyers to purchase a new edition each year to keep up with their teams’ changing rosters. The burn to Hart and other amateur athletes is that, unlike their active professional counterparts, they are not compensated for EA’s use of their likenesses in its video games. Were this case viewed strictly on the public’s perception of fairness, I have no doubt Hart’s position would prevail.<sup>2</sup>

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<sup>1</sup> That said, most outside Rutgers do not know that quarterback # 13 is Ryan Hart. They did not know that in 2005, and even today many, if not most, Rutgers fans no longer connect # 13 with Hart. Fame fades so quickly we call it fleeting. Even nostalgic memories nod off. For example, name the BYU quarterback when it was college football’s national champion in 1984. (Hint: it wasn’t Ty Detmer.).

<sup>2</sup> See generally Taylor Branch, *The Shame of College Sports*, *The Atlantic*, Oct. 2011, at 80–110 (lambasting NCAA “amateurism” and “student-athlete” policies as “legalistic confections propagated by the universities so they can exploit the skills and fame of young athletes,” and discussing lawsuits challenging these policies); see

Hart claims that he has under New Jersey law a right of publicity to prevent others from unfairly appropriating the value of his likeness for their commercial benefit, and that the First Amendment does not shield EA's infringement of this right. This claim requires us to balance the competing interests implicated by the right of publicity and the First Amendment. I agree with my colleagues that the Transformative Use Test is the preferred approach for balancing these interests, but we part ways on its interpretation and application. The result is that they side with Hart, and I with EA.

The Transformative Use Test gives First Amendment immunity where, in an expressive work, an individual's likeness has been creatively adapted in some way. Correctly applied, this test strikes an appropriate balance between countervailing rights—the publicity interest in protecting an individual's right to benefit financially when others use his identifiable persona for their own commercial benefit versus the First Amendment interest in insulating from liability a creator's decision to interweave real-life figures into its expressive work.

My colleagues limit effectively their transformative inquiry to Hart's identity alone, disregarding other features of the work. This approach, I believe, does not find support in the cases on which they rely. Further,

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*also* Alexander Wolff, *When Worlds Collide*, Sports Illustrated, Feb. 11, 2013, at 18; Joe Nocera, *Pay Up Now*, N.Y. Times Mag., Jan. 1, 2012, at 30–35 (advocating payment of college athletes to alleviate “[t]he hypocrisy that permeates big-money college sports” arising from amateurism rules).

my colleagues penalize EA for the realism and financial success of *NCAA Football*, a position I find difficult to reconcile with First Amendment protections traditionally afforded to true-to-life depictions of real figures and works produced for profit. Because I conclude that the Transformative Use Test protects EA's use of Hart's likeness in *NCAA Football*, I respectfully dissent.

#### I. FORMULATION OF THE TRANSFORMATIVE INQUIRY

To determine whether an individual's identity has been "transformed" for purposes of the Transformative Use Test, I believe it is necessary to review the likeness in the context of the work in its entirety, rather than focusing only on the individual's likeness. This interpretation is in line with the approach taken in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal.4th 387, 106 Cal.Rptr.2d 126, 21 P.3d 797 (2001), in which the Supreme Court of California first put in play the Transformative Use Test. Per *Comedy III*, the right of publicity prevails over competing First Amendment interests "[w]hen artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain." *Id.*, 106 Cal.Rptr.2d 126, 21 P.3d at 808 (citing *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575-76, 97 S. Ct. 2849, 53 L. Ed. 2d 965 (1977)). To determine whether a work qualifies as "transformative" and not simply "literal," the *Comedy III* Court explained that "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 the celebrity is the very sum

and substance of *the work in question.*” *Id.*, 106 Cal.Rptr.2d 126, 21 P.3d at 809 (emphases added).

Likewise, when applying the Transformative Use Test two years later in *Winter v. DC Comics*, 30 Cal.4th 881, 134 Cal.Rptr.2d 634, 69 P.3d 473 (2003), the California Supreme Court explained that the defendant’s use was transformative because it could “readily ascertain that [the portrayals] are not just conventional depictions of plaintiffs but contain *significant expressive content other than plaintiffs’ mere likenesses.*” *Id.*, 134 Cal.Rptr.2d 634, 69 P.3d at 479 (emphasis added). The Court also observed that the characters were placed in a “larger story, which is itself quite expressive.” *Id.*<sup>3</sup> The repeated focus on the use of an individual’s likeness in the context of the work as a whole leaves me little doubt that we must examine the creative work in the aggregate to determine whether it satisfies the Transformative Use Test and merits First Amendment protection.

My colleagues correctly recite the Transformative Use Test set out in *Comedy III* and *Winter* [Majority Op. at 158–61], but later disregard that recitation.

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<sup>3</sup> While the *Winter* decision makes several references to the physical differences between the plaintiffs and their likenesses, these statements were made with respect to the Court’s conclusion that “the portrayals do not greatly threaten plaintiffs’ right of publicity” insofar as they were unlikely to decrease their commercial value. 134 Cal.Rptr.2d 634, 69 P.3d at 479. Similarly, there is no real contention that *NCAA Football* is harming ticket sales of college football games or decreasing Hart’s commercial value; if anything, it seems more likely that both have been augmented by the popularity of EA’s video games.

When addressing Hart’s claim, their analysis proceeds by analyzing, on a step-by-step basis, the digital avatar based on Hart, the context in which that avatar is set in *NCAA Football*, and the users’ ability to alter the avatar’s appearance, concluding at each step that Hart’s likeness is not sufficiently changed to qualify as “transformative.” In the last instance, my colleagues reject as immaterial the myriad other creative elements of the video game on the ground that “[d]ecisions applying the Transformative Use Test invariably look to how the *celebrity’s identity* is used,” and that “[w]holly unrelated elements do not bear on this inquiry.” [Majority Op. at 169 (emphasis in original).] But by cabining their inquest to Hart’s likeness alone, their approach is at odds with California Supreme Court decisions on the Transformative Use Test.<sup>4</sup>

The infirmity of this approach is highlighted by *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915 (6th Cir. 2003), in which the Sixth Circuit Court of Appeals concluded that an artist’s use of several photographs of

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<sup>4</sup> The majority opinion relies heavily on two lower court decisions in California considering the right of publicity in the video game context, *No Doubt v. Activision Publishing, Inc.*, 192 Cal.App.4th 1018, 122 Cal.Rptr.3d 397 (2011), and *Kirby v. Sega of America, Inc.*, 144 Cal.App.4th 47, 50 Cal.Rptr.3d 607 (2006). I do not consider these cases particularly instructive, as they were not decided by the architect of the Transformative Use Test, the Supreme Court of California. Thus, I do not attempt to explain or distinguish their holdings except to note that I believe *No Doubt*, which focused on individual depictions rather than the work in its entirety, was wrongly decided in light of the prior precedent in *Comedy III* and *Winter*.

Tiger Woods in a commemorative collage was “transformative,” and thus shielded from Woods’ right-of-publicity suit. My colleagues do not—and, in my view, cannot—explain how the photographic images of Woods were transformed if they limit their analysis to “how the *celebrity’s identity* is used.” [Majority Op. at 169 (emphasis in original).] Instead, their discussion of *ETW* recognizes that the Sixth Circuit held that the artist’s use qualified for First Amendment protection under the Transformative Use Test because “*the collage* ‘contain[ed] significant transformative elements,’” and the *combination of images* “describe[d], in artistic form, a historic event in sports history[—the 1997 Masters golf tournament—]and ... convey[ed] a message about the significance of Woods’ achievement in that event.” [Majority Op. at 161 (first alteration in original) (emphasis added) (quoting *ETW*, 332 F.3d at 938; citing *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 809).] No doubt the use at issue here—creating digital avatars of football teams and placing them in an interactive medium designed for user interaction and manipulation—is significantly more “transformative” than the use in *ETW*, which simply combined several photographs into a photomontage.

To me, a narrow focus on an individual’s likeness, rather than how that likeness is incorporated into and transformed by the work as a whole, is a flawed formulation of the transformative inquiry. The whole—the aggregate of many parts (including, here, many individuals)—is the better baseline for that inquiry.



## II. HARMONIZATION OF THE TRANSFORMATIVE USE TEST WITH FIRST AMENDMENT PRECEDENT

Transformative use must mesh with existing constitutional protections for works of expression. The First Amendment extends protection to biographies, documentaries, docudramas, and other expressive works depicting real-life figures, whether the accounts are factual or fictional. *See, e.g., Matthews v. Wozencraft*, 15 F.3d 432, 439–40 (5th Cir. 1994) (biographical novel); *Ruffin–Steinback v. dePasse*, 82 F. Supp. 2d 723, 730–31 (E.D. Mich. 2000) (television miniseries), *aff'd*, 267 F.3d 457, 461–62 (6th Cir. 2001); *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 337 (E.D. Pa. 1996); *Hicks v. Casablanca Records*, 464 F. Supp. 426, 433 (S.D.N.Y. 1978) (docudrama and novel); *Guglielmi v. Spelling–Goldberg Prods.*, 25 Cal.3d 860, 160 Cal.Rptr. 352, 603 P.2d 454, 458–59 (1979) (docudrama).<sup>5</sup> “That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment.” *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501, 72 S. Ct. 777, 96 L. Ed. 1098 (1952). Accordingly, courts have rejected as counter to free expression the claim that constitutional protection is diminished because a celebrity’s name or likeness was used to increase a

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<sup>5</sup> While my colleagues acknowledge the need for uniform First Amendment treatment of different mediums in the abstract [Majority Op. at 165], it is difficult to reconcile their actual application of the Transformative Use Test to the video game here with the above-cited cases.

product's value and marketability. *See Guglielmi*, 160 Cal.Rptr. 352, 603 P.2d at 460–62 (Bird, C.J., concurring).<sup>6</sup>

The protection afforded by the First Amendment to those who weave celebrities into their creative works and sell those works for profit applies equally to video games. *See Brown v. Entm't Merchs. Ass'n*, — U.S. —, 131 S. Ct. 2729, 2733, 180 L. Ed. 2d 708 (2011). Thus EA's use of real-life likenesses as “characters” in its *NCAA Football* video game should be as protected as portrayals (fictional or nonfictional) of individuals in movies and books. I do not suggest that all digital portrayals of an individual are entitled to First Amendment protection. Rather, the work should be protected if that likeness, as included in the creative composition, has been transformed into something more or different than what it was before. And in any event the profit that flows from EA's realistic depiction of Hart (and the myriad other college football players portrayed in *NCAA Football* ) is not constitutionally significant, nor even an appropriate consideration, when applying the Transformative Use Test.<sup>7</sup>

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<sup>6</sup> As recognized by my colleagues, then-Chief Justice Bird's views in *Guglielmi* commanded the support of the majority of the California Supreme Court, and were relied on by the *Comedy III* Court to guide its definition of the Transformative Use Test. [Majority Op. at 164 n.31.].

<sup>7</sup> In devising the Transformative Use Test, the California Supreme Court borrowed from “the purpose and character of the use” factor relevant to a copyright fair use defense, *see* 17 U.S.C. § 107(1), yet it rejected “a wholesale importation of the fair use doctrine into right of publicity law,” *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at

My colleagues' understanding of the Transformative Use Test underplays the creative elements of *NCAA Football* by equating its inclusion of realistic player likenesses to increase profits with the wrongful appropriation of Hart's commercial value. This approach is at odds with the First Amendment protection afforded to expressive works incorporating real-life figures. That protection does not depend on whether the characters are depicted realistically or whether their inclusion increases profits. *See Guglielmi*, 160 Cal.Rptr. 352, 603 P.2d at 460–62 (Bird, C.J., concurring) (concluding that acceptance of this argument would chill free expression and mean “the creation of historical novels and other works inspired by actual events and people would be off limits to the fictional author”).

In sum, applying the Transformative Use Test in the manner done by my colleagues creates a medium-specific metric that provides less protection to

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807. Nonetheless, it appears my colleagues permit another fair use factor to creep into their transformative analysis. Namely, their focus on the marketability of *NCAA Football* seems colored by the factor considering “the effect of the use upon the potential market for or value of the copyrighted work,” *see* 17 U.S.C. § 107(4), notwithstanding that this element was expressly excluded from *Comedy III*'s articulation of the Transformative Use Test, *see* 106 Cal.Rptr.2d 126, 21 P.3d at 808 n.10. Further, even if consideration of “market effect” were appropriate in a transformative analysis, I do not believe this factor would weigh in favor of finding an infringing use here because, as pointed out *supra* note 3, there is no contention that EA's inclusion of Hart's likeness in *NCAA Football* has caused a decline in the commercial value of his identity or persona.

video games than other expressive works. Because the Supreme Court's decision in *Brown* forecloses just such a distinction, *see* 131 S. Ct. at 2740, my colleagues' treatment of realism and profitability in their transformative use analysis puts us on a different course.

### III. APPLICATION TO HART'S CLAIM

With this understanding of the Transformative Use Test, I conclude EA's use of avatars resembling actual players is entitled to First Amendment protection. *NCAA Football* transforms Hart's mere likeness into an avatar that, along with the rest of a digitally created college football team, users can direct and manipulate in fictional football games. With the many other creative features incorporated throughout the games, sufficient expressive transformation takes place to merit First Amendment protection.

*NCAA Football* involves myriad original graphics, videos, sound effects, and game scenarios. These artistic aspects permit a user to direct the play of a college football team whose players may be based on a current roster, a past roster, or an entirely imaginary roster comprised of made-up players. Users are not reenacting real games, but rather are directing the avatars in invented games and seasons. Further, the "Campus Legend" and "Dynasty Mode" features permit users to control virtual players and teams for multiple seasons, creating the means by which they can generate their own narratives. Such modes of interactive play are, I submit, imaginative transformations of the games played by real players.

As noted by the District Court, it is not only the user that contributes to the interactivity; EA has created “multiple permutations available for each virtual player image.” *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 785 (D.N.J. 2011). This furthers the game’s transformative interactivity. In fact, the majority opinion expressly approves the District Court’s analysis on this point. [Majority Op. at 167 n.40.].

By limiting their inquiry to the realistic rendering of Hart’s individual image, my colleagues misapply the Transformative Use Test. Contrary to their assertion that the other creative elements of *NCAA Football* are “[w]holly unrelated” [Majority Op. at 169], those elements are, in fact, related to EA’s use of Hart’s likeness. If and when a user decides to select the virtual 2005 Rutgers’ football team as a competitor in a game, and to the extent that user does not alter the characteristics of the avatar based on Hart’s likeness, the numerous creative elements of the video games discussed above are part of every fictional play a user calls. Any attempt to separate these elements from the use of Hart’s likeness disregards *NCAA Football*’s many expressive features beyond an avatar having characteristics similar to Hart. His likeness is transformed by the artistry necessary to create a digitally rendered avatar within the imaginative and interactive world EA has placed that avatar.

I am thus convinced that, as used in *NCAA Football*, Hart’s “likeness is one of the ‘raw materials’ from which [the] original work is synthesized . . . [rather than] the very sum and substance of the work

in question.” *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 809. EA bases its *NCAA Football* characters on countless real-life college football players, and it certainly seeks to depict their physical and biographical characteristics realistically. Yet these “are not just conventional depictions of [Hart] but contain significant expressive content other than [his] mere likeness[.]” *Winter*, 134 Cal.Rptr.2d 634, 69 P.3d at 479. *NCAA Football* uses creative means to achieve its overall goal of realistically replicating a college football experience in which users may interact, direct, and control the players’ avatars, including the one based on Hart’s likeness. I find this use transformative.

\* \* \* \* \*

The Transformative Use Test I support would prevent commercial exploitation of an individual’s likeness where the work at issue lacks creative contribution that transforms that likeness in a meaningful way. I sympathize with the position of Hart and other similarly situated college football players, and understand why they feel it is fair to share in the significant profits produced by including their avatar likenesses into EA’s commercially successful video game franchise. I nonetheless remain convinced that the creative components of *NCAA Football* contain sufficient expressive transformation to merit First Amendment protection. Thus I respectfully dissent, and would affirm the District Court’s grant of summary judgment in favor of EA.

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**Appendix B**

United States District Court  
D. New Jersey  
Ryan HART, individually and on: behalf of all others  
similarly situated, Plaintiff,

v.

ELECTRONIC ARTS, INC., a Delaware Corporation;  
and Does 1–50, Defendants.

Civil Action No. 09–cv–5990 (FLW).  
Sept. 9, 2011.

**OPINION**

WOLFSON, District Judge:

This matter comes before the Court on a motion by Defendant Electronic Arts, Inc. (“Defendant” or “EA”) to dismiss Plaintiff Ryan Hart’s Second Amended Complaint (“Plaintiff” or “Hart”) pursuant to Federal Rule of Civil Procedure 12(b)(6), or, in the alternative, for summary judgment pursuant to Federal Rule of Civil Procedure 56(c). The allegations giving rise to Plaintiff’s putative class action lawsuit stem from Defendant’s purported misappropriation of the likeness and identity of Plaintiff, a former college football athlete, as well as those similarly situated, for a commercial purpose in connection with four of Defendant’s NCAA Football video games. Defendant contends that Plaintiff’s claims under New Jersey law for misappropriation of his likeness, which claims the Court treats as a single right of publicity claim, are barred by the First Amendment. For the reasons set forth below, the Court treats Plaintiff’s motion as one

for summary judgment. The Court, further agrees that, on balance, on the facts of this case, Defendant's First Amendment right to free expression outweighs Plaintiff's right of publicity. Accordingly, the Court grants Defendant's motion for summary judgment.

## I. BACKGROUND

### A. NCAA Football Games

EA produces a video game series annually called *NCAA Football*. *NCAA Football* video games permit users to manipulate the actions of over 100 college football teams and thousands of virtual players in a virtual world with simulated games that "allows users to experience the excitement and challenge of college football." Def.'s R. 56.1 Stat. at 1.<sup>1</sup> The college football teams represented in the game are identifiable by name, as well as through the use of trademarks such as uniform designs and logos.<sup>2</sup> *Id.* at 21. The virtual players are identified by jersey number and position,

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<sup>1</sup> Plaintiff failed to comply with Local Rule 56. 1, which requires a response to Defendant's Statement of Material Facts Not in Dispute to be filed. Loc. Civ. R. 56.1(a). Plaintiff included a list of "Material Facts" in his brief in opposition, Opp. at 3-7, but wholly failed to respond to Defendant's purported facts, which is required by Local Rule 56.1. Loc. Civ. R. 56.1(a). As a result, for the purpose of this summary judgment motion, the facts submitted by Defendant are admitted and deemed undisputed. *Malik v. Hannah*, 799 F. Supp. 2d 355, 356, 2011 WL 2580454, \*1 (D.N.J. 2011) (citing Loc. Civ. R. 56.1(a)).

<sup>2</sup> Trademarks such as school names, team names, uniforms, logos, and stadium fight songs appear in the game through licensing agreements between EA and the NCAA's licensing agent, the Collegiate Licensing Company. Def.'s R. 56.1 Statement at 21.



although a user can edit game data to give the player a surname, which then appears on the player's jersey. *See* Supp. Decl. of Strauser, Ex. E; Second Am. Compl. at 59. Each virtual player's unique attributes, including personal characteristics (height, weight, athletic ability), accessories (helmet visor, wristband), physical abilities (speed and agility, throwing arm, passing accuracy), and biographical details (place of origin) can also be edited by the user.<sup>3</sup> Def.'s R. 56.1 Statement at 14–15. Additionally, users with an Internet connection can modify entire teams by downloading custom rosters that have been created and uploaded by video game consumers, including a section of EA's website called Teambuilder. Second Am. Compl. at 59. Some rosters available on these websites seek to replicate actual current and former football team rosters. *See id.* at 59–61.

These video games are interactive, and users “most directly influence the games' outcome through their own play-calling and their ability to use their hand-held controllers to manipulate the actions of the virtual players.” *Id.* at 11. For example, each time during gameplay that a user has the option of throwing a football, the user can control the virtual player's throw distance and accuracy. *Id.* at 12. Users can choose to play a single game against a game-controlled opponent, a second player connected to the same system, or another person connected to the Internet. *Id.* at 5.

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<sup>3</sup> Certain biographical data may be altered, *i.e.*, the virtual player's First Name, Last Name, Position, Number, and Hand (right or left-handed). The virtual player's Home State, Hometown, Team, and Year (freshman, senior, etc.) may not be altered.

Multi-game options are also available for users. *Id.* at 18. One of these options is “Dynasty” mode, in which the “user controls a college program for up to thirty seasons, creating his own story of the program’s development.” *Id.* at 19. Users in “Dynasty” mode are tasked with the “year-round responsibilities of a college coach, such as recruiting virtual high school players out of a random-generated pool of athletes.” *Id.*

### **B. Plaintiff’s First Amended Complaint**

Plaintiff filed his First Amended Complaint in the Superior Court of New Jersey, Law Division, Somerset County, on October 27, 2009. In that complaint, on behalf of himself and similarly situated athletes, Plaintiff asserted, among other claims, that Defendant had violated his right of publicity based on its use of Plaintiff’s likeness as a virtual player on the Rutgers University football team in EA’s 2004, 2005, 2006, and 2009 editions of *NCAA Football*.<sup>4</sup> First Am. Compl. at 22.

On November 24, 2009, EA removed Plaintiff’s action to this Court, and then moved to dismiss all counts of the First Amended Complaint pursuant to Federal Rule of Civil Procedure 12(b)(6). In connection with its motion to dismiss, EA attached copies of the video games for the Court’s review since the games were referenced in Hart’s initial complaint. In arguing for dismissal of the right of publicity claim, EA

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<sup>4</sup> As New Jersey and federal courts applying New Jersey law interchangeably refer to these claims as appropriation or misappropriation of commercial likeness, and “right of publicity,” this Court will do the same.

contended that Plaintiff's claim failed as a matter of law under both New Jersey state law and the First Amendment. *See* Docket. No. 8 at 10–23. Moreover, EA argued that Plaintiff had not stated a claim for right of publicity because the First Amended Complaint did not identify the attributes of Plaintiff that had been incorporated into the *NCAA Football* games. *Id.* at 11.

Plaintiff submitted a brief in opposition to EA's motion to dismiss, as well as a Declaration. Both submissions averred misappropriation of specific attributes of Plaintiff into EA's *NCAA Football* games. *See* Court's Sept. 22, 2010 Opinion, Docket No. 23 ("Court's Opinion"), 740 F. Supp. 2d 658 at 660–62 (D.N.J. 2010). In his Declaration, Plaintiff asserted that the disputed games depicted a "virtual" player that had been designed to replicate Plaintiff's physical attributes, as well as his football skills. *Id.* at 660–62. Further, Plaintiff contended that Defendant had used video footage of him playing in a Rutgers University Football game "in promotion for . . . EA's NCAA game." *Id.* at 661. Plaintiff described Defendant's games as allowing consumers "to simulate the college football playing experience by stepping into the shoes of Rutgers' QB Ryan Hart, and other college football players, where fans can mimic Plaintiff's style and movements and play against Plaintiff's actual opponents." *Id.* at 662 (citation omitted).

On September 22, 2010, the Court granted Defendant's motion to dismiss the First Amended Complaint with prejudice on all counts with the exception of Plaintiff's right of publicity claim, which it dismissed without prejudice. *Id.* at 668, 671. The Court

determined that it could not consider allegations presented by Plaintiff outside of its pleadings on a motion to dismiss, and subsequently determined that because the First Amended Complaint did not contain allegations “as to what aspects of [Plaintiff’s] likeness [were] appropriated” by EA, the Court was unable to decide, as a matter of law, whether Plaintiff could state a right of publicity claim under New Jersey law. *Id.* at 662–63, 664–65. Nonetheless, the Court did undertake an analysis of New Jersey right of publicity law as it related to the facts alleged in Plaintiff’s Declaration and opposition brief, and found that the allegations “appear to state a right of publicity claim under New Jersey law.” *Id.* at 665. Thus, the Court granted Plaintiff’s request for an opportunity to amend his Complaint for the second time, and informed EA that the Court would consider its First Amendment defense if Plaintiff filed a Second Amended Complaint. *Id.* at 664–65.

### C. Plaintiff’s Second Amended Complaint

On October 12, 2010, Plaintiff filed his Second Amended Complaint (“Complaint”), in which he alleges that EA violated his right of publicity under New Jersey law by misappropriating and incorporating his identity and likeness for a commercial purpose in connection with EA’s video games.<sup>5</sup> As discussed

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<sup>5</sup> The two-count Complaint asserts “Invasion of Privacy–Misappropriation of Identities and Likenesses” (Count I) and “Electronic Arts’ Misappropriation of Plaintiff and Class Members’ Identities and Likenesses is for a Commercial / Trade Purpose–(Infringement).” EA argues, and Plaintiff does not dispute, that Plaintiff’s second “count” is a legal conclusion, and that both counts should be treated as a single right of publicity claim because Plaintiff is seeking “redress for an appropriation of the

herein, Plaintiff incorporated the proposed allegations that the Court addressed in its September 22, 2010 Opinion. The Complaint states that Hart's likeness is found in *NCAA Football 2004*, *NCAA Football 2005*, *NCAA Football 2006*, and *NCAA Football 2009*, in violation of his right of publicity. *See* Second Am. Compl. at 32. Thereafter, by way of example of the alleged misappropriation of Hart's image, the Complaint makes specific factual allegations about the *NCAA Football 2006* game.

With respect to the *NCAA Football 2006* video game, the Complaint alleges that “[t]he attributes of the ‘virtual’ player . . . are Plaintiff Ryan Hart’s physical attributes as referenced in the Rutgers University Football Media Guide.” *Id.* at ¶ 34. In addition, the Complaint alleges, that “in its NCAA Football 2006 video game, Defendant lists the . . . ‘virtual’ player quarterback as hailing from Florida . . .,” *id.* at ¶ 35, “standing six (6) feet and two (2) inches tall,” *id.* at ¶ 36, and “weigh[ing] one hundred ninety-seven (197) pounds (lbs.) . . .,” *id.* at ¶ 37. The Complaint further alleges that the virtual player wears “Hart’s jersey number . . . thirteen (13),” *id.* at ¶ 38, a “left wrist band,” *id.* at ¶ 39, and “a helmet visor,” *id.* at ¶ 40. Finally, Hart’s “speed and agility rating . . . passing accuracy rating [and] arm strength” all reflect actual footage of Hart during his 2005 college season, according to the Complaint. *Id.* at ¶¶ 41–43. Based on the language of the Complaint, it appears that Hart

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commercial value of [his] identity.” Def. Mot. to Dismiss Br. at 16 (quoting J. Thomas McCarthy, *RIGHTS OF PUBLICITY AND PRIVACY* § 1:35 (2d ed. 2010)). The Court agrees.

intends for the allegations related to *NCAA Football 2006* to be imputed to *NCAA Football 2004* and *NCAA Football 2005*.

Attached to the Complaint are copies of screenshots taken from *NCAA Football* games, and a copy of the 2004 Rutgers University Football Media Guide. *See* Second Am. Compl., Exh. A–E. The media guide lists biographical facts about Hart, such as his hometown and his physical attributes, such as height and weight. *See id.* at Exh. A. It, further, describes his football statistics, such as his number of attempts, total offense, and passing yards. *Id.* The screenshots show images of the virtual player that have been allegedly modeled after Hart. However, Plaintiff did not label the screenshots to link each screenshot to a particular game.

Plaintiff's allegation concerning *NCAA Football 2009* is similarly unclear on the face of the Complaint. For one, the Complaint does not allege that the virtual character that purportedly mimics Plaintiff is featured in *NCAA Football 2009*. Instead, Plaintiff alleges that his "image was used in the promotion for ... EA's *NCAA Football* game wherein [Plaintiff] was throwing a pass with actual footage from Rutgers University's Bowl Game against Arizona State University." *Id.* at 45. Plaintiff does not expressly identify the video game in dispute, nor any details about the promotion, but based on allegations found in his First Amended Complaint and Defendant's responses, this allegation appears to be referencing *NCAA Football 2009*. EA does not dispute that a photo of Plaintiff "throwing a pass appears in a photo montage inside *NCAA Football*

[2009] that can only be seen when a user selects Rutgers as his or her favorite team,” Supp. Decl. of Strauser, Ex. E at 16, Ex. I, but EA contends that it has never used an image of Plaintiff in any advertisement. Def.’s R. 56.1 Statement at 24.

Plaintiff avers that these instances of misappropriation of his identity and likeness were “committed with the full intent of increasing the sales and profits for Defendant(s) since [EA’s] heightened realism in NCAA Football videogames translates directly into increased sales and revenues for EA.” Second Am. Compl. at 48. According to Plaintiff, video game consumers demand that these games “simulate actual college football matches in the most realistic manner possible, including the use of the ‘virtual’ players that are modeled after real-life NCAA Football players such as [Plaintiff].” *Id.* Further, in regards to the users’ ability to upload and download team rosters with names of real-life players, Plaintiff, while not alleging that EA has itself made this information available, does fault EA for “tak[ing] no courses of action to prevent” users from uploading rosters that use real players’ names without authorization. *Id.* at 59–63. Plaintiff contends that EA’s “courses of action and in-action” on this issue have allowed users to “effectively heighten [] the authenticity and realism of a true NCAA football experience.” *Id.* at 64–65.

#### **D. Instant Motion**

EA filed the instant motion on November 12, 2010, arguing that the First Amendment to the United States Constitution mandates dismissal of the Complaint pursuant to Federal Rule of Civil Procedure

12(b)(6), or, in the alternative, summary judgment pursuant to Federal Rule of Civil Procedure 56(c). Plaintiff has opposed this motion, and both parties have filed declarations, affidavits, and exhibits. For the reasons explained herein, the Court elects to treat EA's motion as one for summary judgment, and finds that summary judgment is appropriate.

## II. STANDARD OF REVIEW

As noted, Defendant has moved for dismissal, or, in the alternative, summary judgment. Defendant opposes consideration under either standard on the basis that discovery is not complete. *See* Opp. at 8–9. However, Plaintiff fails to identify how discovery would assist the Court in deciding this speech-based tort case.<sup>6</sup> Indeed, discovery is irrelevant to a motion to dismiss under Rule 12(b)(6), which is limited to the complaint allegations. And, for summary judgment purposes, it is Plaintiff's obligation to identify why disposition by way of summary judgment requires discovery. Fed. R. Civ. P. 56(d) (permitting a court to defer considering a motion "if a nonmovant shows by affidavit or declaration that, *for specified reasons*, it cannot present facts essential to justify its opposition") (emphasis added).

Moreover, the question of whether the First Amendment limits Plaintiff's right of publicity claim is

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<sup>6</sup> Plaintiff states that he "intends to show Defendant's sales records and anticipate [sic] that the sales of each year's *NCAA Football* release remain relatively steady." Pl. Opp. at 19. This "discovery" would have no bearing on the Court's analysis of EA's First Amendment defense.



one of law, and courts answer this type of question by independently reviewing the disputed speech at the summary judgment stage. *See Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1016 (3d Cir. 2008) (“[T]he categorization of speech is a question of law that we must resolve through independent review of the program.”); *see e.g., id.* at 1016 (rejecting First Amendment defense to Lanham Act trademark claims on motion for summary judgment); *Hoepker v. Kruger*, 200 F. Supp. 2d 340, 344, 347–354 (S.D.N.Y.2002) (under summary judgment standard, examining a challenged work of art and dismissing New York statutory right of privacy claim based on First Amendment defense). In that connection, as indicated *supra*, EA has provided the Court with copies of the video games for the Court’s review. Furthermore, because the Court will further rely on the affidavits and exhibits submitted by the parties, this motion will be treated as one for summary judgment as opposed to a motion to dismiss.

“Summary judgment is proper if there is no genuine issue of material fact and if, viewing the facts in the light most favorable to the non-moving party, the moving party is entitled to judgment as a matter of law.” *Pearson v. Component Tech. Corp.*, 247 F.3d 471, 482 n. 1 (3d Cir. 2001) (*citing Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986)); *accord* Fed. R. Civ. P. 56(c). For an issue to be genuine, there must be “a sufficient evidentiary basis on which a reasonable jury could find for the non-moving party.” *Kaucher v. County of Bucks*, 455 F.3d 418, 423 (3d Cir. 2006); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986). In determining whether a genuine issue of

material fact exists, the court must view the facts and all reasonable inferences drawn from those facts in the light most favorable to the nonmoving party. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587, 106 S. Ct. 1348, 89 L. Ed. 2d 538 (1986); *Curley v. Klem*, 298 F.3d 271, 276–77 (3d Cir. 2002). For a fact to be material, it must have the ability to “affect the outcome of the suit under governing law.” *Kaucher*, 455 F.3d at 423. Disputes over irrelevant or unnecessary facts will not preclude a grant of summary judgment.

Initially, the moving party has the burden of demonstrating the absence of a genuine issue of material fact. *Celotex Corp.*, 477 U.S. at 323, 106 S. Ct. 2548. Once the moving party has met this burden, the nonmoving party must identify, by affidavits or otherwise, specific facts showing that there is a genuine issue for trial. *Id.*; *Monroe v. Beard*, 536 F.3d 198, 206–07 (3d Cir. 2008). Thus, to withstand a properly supported motion for summary judgment, the nonmoving party must identify specific facts and affirmative evidence that contradict those offered by the moving party. *Anderson*, 477 U.S. at 256–57, 106 S. Ct. 2505. The nonmoving party “must do more than simply show that there is some metaphysical doubt as to material facts.” *Id.* at 206, 106 S. Ct. 2505 (quoting *Matsushita*, 475 U.S. at 586, 106 S. Ct. 1348). Moreover, the non-moving party must present “more than a scintilla of evidence showing that there is a genuine issue for trial.” *Woloszyn v. County of Lawrence*, 396 F.3d 314, 319 (3d Cir. 2005). Indeed, the plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon

motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial. *Celotex Corp.*, 477 U.S. at 322, 106 S. Ct. 2548.

Additionally, in deciding the merits of a party's motion for summary judgment, the court's role is not to evaluate the evidence and decide the truth of the matter, but to determine whether there is a genuine issue for trial. *Anderson*, 477 U.S. at 249, 106 S. Ct. 2505. The nonmoving party cannot defeat summary judgment simply by asserting that certain evidence submitted by the moving party is not credible. *S.E.C. v. Antar*, 44 Fed.Appx. 548, 554 (3d Cir. 2002).

### III. ANALYSIS

For the purposes of this motion, Defendant concedes that Plaintiff has stated a prima facie right of publicity claim under New Jersey law. Mot. at 1. Despite this concession, in its moving papers, EA expresses disagreement with statements of New Jersey law made in this Court's September 22, 2010 Opinion. In that opinion, which granted EA's motion to dismiss Plaintiff's complaint for failure to sufficiently plead a right of publicity claim under New Jersey law, the Court interpreted New Jersey's right of publicity law and concluded that Hart's proposed allegations "appear[ed] to state a right of publicity claim under New Jersey law." Court's Opinion at 665.

To the extent that some of EA's comments suggest that the Court's interpretation of New Jersey case law is inconsistent with First Amendment principles, EA

misreads the September 22nd Opinion.<sup>7</sup> That opinion focused on the scope of New Jersey's right of publicity

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<sup>7</sup> For example, in footnote 12 of its moving brief, EA takes issue with this Court's discussion of *Castro v. NYT Television*, 370 N.J.Super. 282, 296, 851 A.2d 88 (App. Div. 2004), which held that a right of publicity claim could not be lodged by patrons at the emergency room of a public hospital who were videotaped and, later, shown on a reality-based television program. As explained in the opinion, EA relied upon the following language from *Castro*, to argue that *NCAA Football* was entitled to First Amendment protection: "it is irrelevant whether a videotape is broadcast in connection with a television story about important public events or a subject that provides only entertainment and amusement...." 370 N.J.Super. at 298, 851 A.2d 88. Def. Mov. Br. on Mot. to Dismiss at 13.

*Castro* did not discuss the First Amendment in its analysis of the plaintiffs' claim in that case, however. Rather, *Castro* held that the plaintiffs in that case failed to "allege that any of the videotape footage taken of them ... has been used for 'trade purposes' and, therefore, that the 'plaintiffs' complaints [did] not state causes of action for commercial appropriation of their likenesses." 370 N.J.Super. at 298, 851 A.2d 88. EA now takes issue with the Court's comment in the September 22nd Opinion that cases interpreting *Castro* have limited its holding to news-related entities. Court's Opinion at 667-68 (discussing *Liebholz v. Harriri*, Civil Action No. 05-5148, 2006 WL 2023186 (D.N.J. Jul. 12, 2006)). Reading that comment out of context, EA argues that *Castro*, and other cases discussed by this Court in that opinion, do not stand for the proposition that the First Amendment distinguishes between media and non-media defendants. Read in context, it is clear that this Court was not discussing the First Amendment nor opining on whether a ruling that distinguishes between media and non-media defendants would be appropriate. Indeed, the paragraph following the Court's discussion of how *Castro's* holding has been interpreted explains that the "the touchstone of the *commercial purpose requirement* is whether the publication uses the plaintiff's likeness 'for the purpose of capitalizing upon the name by using it in connection with a commercial project . . . ." Court's Opinion at

claim as expressed by state and federal New Jersey decisional law at that time. The opinion did *not* address the scope of federal constitutional principles that might affect a New Jersey court's interpretation of such a claim. Rather, the Court dismissed Hart's complaint and granted him leave to amend. In so doing, the Court provided an overview of New Jersey's right of publicity law in ascertaining whether granting leave to amend would be futile. The Court was careful to explain that, in granting Hart leave to amend, "the Court is not holding that Plaintiff's proposed allegations are sufficient as a matter of law. Rather, the Court merely concludes that the sort of allegations Plaintiff proposes

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667–68 (emphasis added). For EA to now argue that the Court suggested that " 'non-media' expressive speech is entitled to less First Amendment protection than 'media' speech," Def. Mov. Br. in Supp. Mot. to Dismiss at 22, is unfounded.

This is not to say that the *Castro* court's distinction between media and non-media defendants in its trade purposes analysis may reflect the century-old "newsworthiness" exception to misappropriation claims, which was an early attempt by courts to take into account First Amendment concerns as they related to freedom of the press. *See generally* Amicus Brief of 73 Law Professors in Support of Defendant/Appellee Jireh Publishing, Inc., For Affirmance, *ETW Corp. v. Jireh Publishing, Inc.*, No. 00–3584 at 6–8, 2000 WL 35456243 (6th Cir. 2000) *available at* [http://jurist.law.pitt.edu/amicus/etw\\_v\\_jireh.pdf](http://jurist.law.pitt.edu/amicus/etw_v_jireh.pdf) (arguing that "The Definition of Commercial Use in Publicity Law Reflects Understandings of the First Amendment from the Early Twentieth Century"). While more recent cases make clear that non-newsworthy works are likewise entitled to First Amendment protection, as discussed herein, the *Castro* court did not explicitly address First Amendment concerns. Moreover, as EA recognizes, the defendant in that case was a media defendant, thus, the *Castro* court did not address the applicability of its holding to non-media defendants.

suggest that an amendment may not be futile.” *Id.* at 668. Without a fully articulated amended complaint before it, the Court chose not to define the precise contours of the misappropriation doctrine, including all potential interpretive effects of First Amendment doctrine.<sup>8</sup>

Indeed, at the time the Court issued its September 22, 2010 Opinion, the New Jersey Supreme Court had not addressed the misappropriation tort and the First Amendment in one case. A decision by the New Jersey Supreme Court rendered after this Court’s September 22, 2010 opinion, and after the parties’ initial briefing in this case, jointly considers the prima facie misappropriation elements and First Amendment principles.<sup>9</sup>

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<sup>8</sup> This approach of focusing first on whether a prima facie case misappropriation claim is properly pled before ruling on a First Amendment defense to that claim is the approach taken by a recent California district court decision that EA cites to in a supplemental memorandum to this Court. *See* EA Supp. Memo dated Sept. 6, 2011. That case, *Arenas v. Shed Media US, Inc.*, No. CV 11–05279, Slip Op. (C.D. Cal. Aug. 22, 2011), involved a NBA player’s motion for a preliminary injunction against the producers of *Basketball Wives*, a reality television show starring current and former significant others of professional basketball players. The *Arenas* court first held that the NBA player sufficiently pled a prima facie misappropriation case, under California law, for the use of his identity. Slip Op. at 6. Only after concluding that the prima facie case was properly pled did the court consider the producer’s First Amendment defense. *Id.* at 8.

<sup>9</sup> EA’s reply brief for the instant motion was filed on January 20, 2011, and *G.D.* was decided on January 31, 2011.

In *G.D. v. Kenny*, 205 N.J. 275, 15 A.3d 300 (2011), the New Jersey Supreme Court held that the use of a political aide's criminal history in a campaign flyer, created by a public relations and marketing firm at the request of a political opponent, failed to satisfy the commercial purpose element of the misappropriation tort. *Id.* at 311. In reaching that conclusion, the Court reasoned:

That the . . . defendants are in the business of public relations and marketing and prepared the campaign flyers does not make publication of the flyers a publication in the commercial sense. The campaign flyers represented political speech attacking the judgment of a candidate running for public office. This is the type of speech that is at the heart of First Amendment guarantees. That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment. [Plaintiff] cannot show that the use of his name and image constitutes the tort of misappropriation of one's name and image for a wrongful purpose.

*Id.* at 311–12 (internal quotation marks and citations omitted). While the *G.D.* Court did not explicitly define the relationship between the misappropriation tort and the First Amendment, nonetheless, by including First Amendment rationale in its analysis of the plaintiff's prima facie case, the Court construed the tort in a manner to avoid conflict with First Amendment principles.

Because of EA’s decision not to challenge the sufficiency of Hart’s right of publicity allegations for the purpose of this motion, the Court will focus solely upon EA’s assertion of the First Amendment defense—rather than upon how a New Jersey court might construe the prima facie elements of the right of publicity. For this reason, the Court finds EA’s inclusion of its disagreement with the Court’s interpretation of New Jersey right of publicity law in several footnotes throughout its brief not only irrelevant to the motion but also a distraction from the issue at hand—the scope of EA’s First Amendment defense.

Turning now to the First Amendment defense, the parties dispute whether the First Amendment trumps Plaintiff’s claim. In EA’s opening brief, it argued that the First Amendment bars Plaintiff’s right of publicity claim because *NCAA Football* video games constitute protected expressive works. Plaintiff disagreed, in its opposition papers, contending that the NCAA Football games constitute speech made for commercial purposes that is not afforded extensive First Amendment protections.

While the motion was under consideration, the United States Supreme Court decided *Brown v. Entertainment Merchants Ass’n*, — U.S. —, 131 S. Ct. 2729, 180 L. Ed. 2d 708 (2011). That suit involved a First Amendment challenge to a California statute that “prohibits the sale or rental of ‘violent video games’ to minors, and requires their packaging to be labeled ‘18.’” *Id.* at 2732. Violation of the statute was punishable by civil fine. *Id.* In light of *Brown*’s potential applicability



to the instant motion, the Court directed the parties to file supplemental briefs discussing that decision.

In ruling that the statute was unconstitutional, the Supreme Court confirmed that video games are entitled to First Amendment protection:

Like the protected books, plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player’s interaction with the virtual world). That suffices to confer First Amendment protection.

*Id.* at 2733.<sup>10</sup>

Plaintiff argues, in his supplemental briefing, that *Brown* is of no help to EA here. In Plaintiff’s view, *Brown* is distinguishable because it involved a content-based statute deserving of strict First Amendment scrutiny whereas a New Jersey right of publicity claim, in contrast, is not content-based. EA agrees, in its supplemental briefs, that the statute in *Brown* was content-based, but further argues that the right of publicity claim asserted here also operates as a

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<sup>10</sup> Prior to *Brown*, several appellate and lower court decisions had similarly concluded that video games are entitled to First Amendment protection. *See e.g., E.S.S. Entert. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008); *Interactive Digital Software Ass’n v. St. Louis County, Mo.*, 329 F.3d 954, 957 (8th Cir. 2003); *American Amusement Machine Association v. Kendrick*, 244 F.3d 572, 576 (7th Cir. 2001); *Dillinger, LLC v. Electronic Arts Inc.*, 795 F. Supp. 2d 829, 835–36, 2011 WL 2446296, \*5 (S.D. Ind. Jun. 15, 2011).

content-based restriction because the claim “turns on the particular content of the defendant’s work and, in particular, whether the defendant used the plaintiff’s name, likeness, or other attribute within the defendant’s work.” Def. Supp. Br. at 4. EA, further, focuses on *Brown*’s confirmation that video games are entitled to full First Amendment protection, and construes *Brown* as suggesting that video games are not commercial speech entitled to less than full First Amendment protection.

A content-based speech restriction is one that regulates “speech when the specific motivating ideology or the opinion or perspective of the speaker is the rationale for the restriction.” *Galena v. Leone*, 638 F.3d 186, 199 (3d Cir. 2011). While EA cites to a law review article to support its contention that a New Jersey right of publicity claim operates as a content-based restriction, *see* Thomas F. Cotter, et al., *Integrating the Right of Publicity with First Amendment and Copyright Preemption Analysis*, 33 Colum. J. of Law & the Arts 165 (Winter 2011), that article acknowledges that most courts have not adopted the argument it advocates that the “exercise of state publicity rights is a content-based regulation of speech.”<sup>11</sup> *Id.* at 169; *id.* at 167–68 (describing court

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<sup>11</sup> The authors’ “argument that the right of publicity is a form of content-based regulation rests on two premises. The first is that the right of publicity regulates words, sounds and visual images that clearly qualify as ‘speech.’ The second is that, because the right of publicity cannot be ‘justified without reference to the content of the speech,’ it is content-based, not content-neutral. *Id.* at 190–91 (internal footnotes omitted).

opinions applying the First Amendment to right of publicity claims as “all over the map” resulting in “confusion reflected in the differing approaches.”). In addition, the article’s thesis turns on whether the speech is commercial or non-commercial; in the authors’ view, commercial speech implicating the right of publicity must be judged under intermediate scrutiny and noncommercial speech under strict scrutiny.

Contrary to the article’s proposal, courts apply one of several tests, referred to in the legal discourse as “balancing tests,” that are unique to intellectual property-related cases, to determine whether the First Amendment limits a right of publicity claim in that context. Courts do not tend to apply strict or intermediate scrutiny tests when addressing a First Amendment defense to intellectual property-related claims, such as the right of publicity. Accordingly, this Court’s analysis will focus on the tests actually applied by courts, which tests are explained in more detail *infra*.

As to EA’s latter argument regarding commercial speech, *Brown* does not explicitly discuss commercial speech. However, another recent decision of the Supreme Court, *Sorrell v. IMS Health Inc.*, — U.S. —, 131 S. Ct. 2653, 180 L. Ed. 2d 544 (2011), does so. In that case, the Supreme Court made clear that challenges to content-based restrictions on both commercial and noncommercial speech are generally subject to heightened scrutiny. *Id.* at 2664 (“The First Amendment requires heightened scrutiny whenever the government creates ‘a regulation of speech because

of disagreement with the message it conveys.’ . . . Commercial speech is no exception.”).

*Sorrell* was not an intellectual-property related case, however. Moreover, *Sorrell* did not explicitly overrule *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of New York*, 447 U.S. 557, 100 S. Ct. 2343, 65 L. Ed. 2d 341 (1980), which recognized a “commonsense distinction between speech proposing a commercial transaction, which occurs in an area traditionally subject to government regulation, and other varieties of speech,” *Central Hudson*, 447 U.S. at 562, 100 S. Ct. 2343, and applied intermediate scrutiny to restrictions on commercial speech. And, *Sorrell* acknowledges that “the government’s legitimate interest in protecting consumers from ‘commercial harms’ explains ‘why commercial speech can be subject to greater governmental regulation than noncommercial speech.’” (citation omitted). 131 S. Ct. at 2672. Thus, even after *Sorrell*, commercial speech may still be entitled to less First Amendment protection than that afforded non-commercial speech, in certain contexts.

In any event, whatever First Amendment protection is afforded to commercial speech, *NCAA Football* is not commercial speech. The Third Circuit’s decision in *Facenda, supra*, explains that courts are to consider three factors in determining whether speech is commercial or noncommercial:

- (1) is the speech an advertisement; (2) does the speech refer to a specific product or service; and
- (3) does the speaker have an economic motivation for the speech. An affirmative

answer to all three questions provides ‘strong support’ for the conclusion that the speech is commercial.

*Id.* at 1017 (internal citations and quotation marks omitted). In conducting this inquiry, courts are to make “a commonsense distinction between speech proposing a commercial transaction . . . and other varieties of speech.” *Id.*

Applying *Facenda* here, Plaintiff cannot reasonably contend that the *NCAA Football* games constitute commercial speech. The speech at issue in *Facenda* was a video that the court characterized as a “late-night, half-hour-long ‘infomercial’ [for the *Madden Football* video game, that was] only broadcast eight times in a three-day span immediately before the release of the video game to retail stores—much like an advertisement for an upcoming film.” *Id.* at 1017. The “infomercial” referred specifically, and solely, to the *Madden Football* video game. And, the defendant-producer of the game had a financial interest in the sales of the game. *Id.* at 1017–18. In short, the video “aim[ed] to promote another creative work, the video game.” *Id.* at 1018. Here, by contrast, the speech *is* the video game that is being sold. It is not a separate instance of speech that promotes the purchase of another work.

Similarly, in *Tellado v. Time-Life*, 643 F. Supp. 904, 914 (D.N.J.1986), a court in this district found that the First Amendment did not insulate the defendant from a right of publicity claim by a Vietnam veteran whose photograph was used in an advertisement for a book series the defendant produced about the Vietnam War.

The *Tellado* court distinguished between use of the plaintiff's photograph in an advertisement for a book and the hypothetical use of the photograph in the book itself, noting that in the latter case, "defendant's use clearly would have been protected by the First Amendment, regardless of what type of profit defendant expected to make with its book series." *Id.*

Further, as courts have long recognized, the First Amendment's guarantee of free speech extends not only to political and ideological speech, but also to "[e]ntertainment . . . motion pictures, programs broadcast by radio and television, and live entertainment, such as musical and dramatic works." *Tacyne v. City of Philadelphia*, 687 F.2d 793, 796 (3d Cir. 1982) (First Amendment protects Mummies-type string band performance) (quoting *Schad v. Borough of Mount Ephraim*, 452 U.S. 61, 65, 101 S. Ct. 2176, 68 L. Ed. 2d 671 (1981)) (citations omitted) (live entertainment, including non-obscene nude dancing, is protected by First Amendment); accord *United States v. Stevens*, — U.S. —, 130 S. Ct. 1577, 1585, 176 L. Ed. 2d 435 (2010) (videos showing animal cruelty not categorically unprotected by the First Amendment); *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 97 S. Ct. 2849, 53 L. Ed. 2d 965 (1977) ("There is no doubt that entertainment, as well as news, enjoys First Amendment protection."); *Kaplan v. California*, 413 U.S. 115, 119–120, 93 S. Ct. 2680, 37 L. Ed. 2d 492 (1973) ("[P]ictures, films, paintings, drawings, and engravings . . . have First Amendment protection."). The Supreme Court's recent ruling in *Brown* confirms that video games are entitled to the same treatment. 131 S. Ct. at 2733.

For these reasons, the Court finds no support for Plaintiff's contention that EA's NCAA Football video games are not expressive works entitled to the same protections afforded to other expressive works. Plaintiff's only allegation that appears to make a commercial speech argument is that his "image was used in the promotion for . . . EA's NCAA Football game wherein [Plaintiff] was throwing a pass with actual footage from Rutgers University's Bowl Game against Arizona State University." Second Am. Compl. at 45. Yet, Plaintiff has produced no evidence that his likeness was ever used in an advertisement for a NCAA Football video game, nor has he suggested that discovery would reveal such evidence. In addition, Defendant denies ever using Plaintiff's image in any advertisement for the games, but has submitted a photograph of Plaintiff "throwing a pass [that] appears in a photo montage inside NCAA Football [2009] that can only be seen when a user selects Rutgers as his or her favorite team." See Def.'s R. 56.1 Statement at 24; Supp. Decl. of Strauser, Ex. E at 16, Ex. I. Because this photograph is part of the video game itself, the commercial transaction has already taken place, and because Plaintiff's photo does not advertise another product or service, the Court finds no basis for concluding that *NCAA Football 2009*—or any other *NCAA Football* video game—is commercial speech.<sup>12</sup>

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<sup>12</sup> To be sure, this commercial speech inquiry differs from my analysis of New Jersey's interpretation of the "commercial purpose" element in *Castro*, *supra*, and other decisions, in the September 22nd Opinion. As explained above, at the time of that ruling, there was no New Jersey Supreme Court case that considered First

Having concluded that *NCAA Football* is not commercial speech, the Court now turns to the more thorny question of whether the First Amendment grants EA the right to impinge upon Plaintiff's New Jersey common law right of publicity. The Court begins by discussing the competing interests protected by the right of publicity and the First Amendment, as well as the tests used by courts in balancing those competing interests. Therefore, the Court considers the party's arguments regarding what test the Court should employ to balance Defendant's First Amendment rights against Plaintiff's right of publicity—the transformative test or the *Rogers* test.<sup>13</sup> Finally, the Court performs both balancing tests in light of the parties' arguments, and concludes that, in this case, the First Amendment serves as a defense to Plaintiff's right of publicity claim under either test.

**A. Competing Interests of the Right of Publicity and the First Amendment**

“The area of interrelated torts encompassed by the umbrella term ‘invasion of privacy’ is largely an American contribution to the common law, which is usually said to have its origins in the seminal law review article by Samuel Warren and Louis Brandeis published in 1890.” Rodney A. Smolla, 3 *SMOLLA & NIMMER ON FREEDOM OF SPEECH* § 24:2 (2011)

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Amendment principles in construing the elements of the right of publicity tort.

<sup>13</sup> For reasons explained below, the Court will not engage in an analysis under the “predominance test,” an additional test that Hart urges the Court to adopt.



(“Smolla”).<sup>14</sup> New Jersey first recognized this common law right in 1907, in a case holding that an individual has the “right to prevent the unauthorized, commercial appropriation of his name or likeness.” See *Edison v. Edison Polyform Mfg. Co.*, 73 N.J.Eq. 136, 67 A. 392 (Ch. Div. 1907) cited in Brent A. Olson, Esq., et al., *The Right of Publicity*, 49 N.J. Prac. § 16:3 n. 9 (2010–2011 ed.) (“*Right of Publicity*”). Years later, in a 1960 article, Dean William Prosser proposed four distinct privacy torts, including one for the “appropriation, for the defendant’s benefit, of the plaintiff’s name or likeness.” *Canessa v. J.I. Kislak, Inc.*, 97 N.J.Super. 327, 334, 235 A.2d 62 (Law Div.1967) (citing W. Page Keeton, et al., PROSSER AND KEETON ON THE LAW OF TORTS § 117 (5th ed.1984)). See William L. Prosser, *Privacy*, 48 Cal. L. Rev. 383, 389 (1960).

Despite its early characterization as a privacy right, by 1967, New Jersey cases treated the tort as a property right. See *Canessa*, 97 N.J.Super. at 352, 235 A.2d 62 (“We therefore hold that, insofar as plaintiffs’ claim is based on the appropriation of their likeness and name for defendant’s commercial benefit, it is an action for invasion of their ‘property’ rights and not one for ‘injury to the person.’”).<sup>15</sup> To be sure, the privacy-based

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<sup>14</sup> A New Jersey court notes that “[i]t was first discussed in an essay published in a law journal in 1860 but it never gained prominence until the article written by former U.S. Supreme Court Justice Brandeis, in collaboration with Frank Warren, was published in 4 Harv. L. Rev. 193 (1890).” *Palmer v. Schonhorn Enterprises, Inc.*, 96 N.J.Super. 72, 75, 232 A.2d 458 (Ch. 1967).

<sup>15</sup> The distinction between a privacy-based versus a property-based tort is that

appropriation tort, as envisioned by Prosser, encompassed “both personal and commercial interests caused by an unauthorized exploitation of the plaintiff’s identity.” Restatement (Third) of the Law of Unfair Competition § 46, comment b.

Throughout the tort’s development, its underlying purpose has been to protect a person’s name, likeness, voice, and biographical data from exploitation by others who seek economic or other benefit from that use. See *Bisbee v. John C. Conover Agency, Inc.*, 186 N.J. Super. 335, 343, 452 A.2d 689 (App. Div. 1982); *Tellado v. Time-Life Books, Inc.*, 643 F. Supp. 904, 909–10 (D.N.J. 1986). As explained in this Court’s September 22, 2010 Opinion granting EA’s motion to dismiss without prejudice,

Underlying this right is the theory that “a celebrity has the right to capitalize on his persona, and the unauthorized use of that

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[t]he privacy-based action is designed for individuals who have not placed themselves in the public eye. It shields such people from the embarrassment of having their faces plastered on billboards and cereal boxes without their permission. The interests protected are dignity and peace of mind, and damages are measured in terms of emotional distress. By contrast, a right of publicity action is designed for individuals who have placed themselves in the public eye. It secures for them the exclusive right to exploit the commercial value that attaches to their identities by virtue of their celebrity. The right to publicity protects that value as property, and its infringement is a commercial, rather than a personal tort.

*Jim Henson Productions, Inc. v. John T. Brady & Associates, Inc.*, 867 F. Supp. 175, 188–89 (S.D.N.Y. 1994).

persona for commercial gain violates fundamental notions of fairness and deprives the celebrity of some economic value in his persona.” Because celebrity status often translates to economic wealth, the unauthorized use of one’s persona “harms the person both by diluting the value of the name and depriving that individual of compensation.”

*Hart v. Electronic Arts, Inc.*, 740 F. Supp. 2d 658, 664 (D.N.J. 2010) (internal citations omitted).

The term “right of publicity” made its first appearance in a federal court opinion in 1953, in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953). That case concerned the use of player images on baseball cards, and the opinion described the right of publicity as an economic, as opposed to personal, right. See Marshall Leaffer, *The Right of Publicity: A Comparative Perspective*, 70 Albany L. Rev. 1357, 1360 (2007) (“Publicity”). The opinion explained: “a man has a right in the publicity value of his photograph . . . [and] to grant the exclusive privilege of publishing his picture . . . .” *Haelan*, 202 F.2d at 868. The court did not characterize this right as a property right because “[w]hether it [was] labelled [sic] a ‘property right’ [was] immaterial.” *Id.* What mattered was that “courts enforce a claim which has pecuniary worth.” *Id.*

Following *Haelan*, states began to recognize a common law right of publicity and some states even enacted statutes protecting such a right. The right, effectively, became a property right, with some statutes providing that the right might be transferred

through will or intestacy. *Publicity, supra* at 1360.<sup>16</sup> The right of publicity is now recognized by a majority of the states in the United States, though the scope of the right and its transferability varies by state.

New Jersey has adopted the Restatement of Torts 2d (1977), thereby incorporating the common law privacy right of appropriation into its state law. Unlike other states, such as California and New York, New Jersey has not enacted a right of publicity statute. Nonetheless, given the similarity between the two doctrines, and that New Jersey treats its misappropriation tort as a property-based rather than privacy-based right, the Third Circuit has used the terms appropriation and right of publicity, interchangeably, to refer to the common law right in New Jersey. See *McFarland v. Miller*, 14 F.3d 912, 917 (3d Cir. 1994) (“In New Jersey, the right of publicity is a property right.”) Examples of New Jersey right of publicity claims upheld by courts include the misappropriation of professional golfers’ names and playing profiles, *Palmer v. Schonhorn Enterprises, Inc.*, 96 N.J.Super. 72, 232 A.2d 458 (Ch. 1967), and the use of a photograph of a former Vietnam veteran in a

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<sup>16</sup> In recent years, the appropriation tort has “shifted towards being a property protection similar to the right of publicity.” Daniel J. Solove, et al., *INFORMATION PRIVACY LAW* at 207 (3d ed.2009). See also Jonathan Kahn, *Bringing Dignity Back to Light: Publicity Rights and the Eclipse of the Tort of Appropriation of Identity*, 17 *Cardoza Arts & Ent. L.J.* 213, 213–14 (1999) (“[O]ver the years, the privacy-based tort of appropriation has receded into the background as its flashier cousin, publicity, has risen to prominence. Such is perhaps to be expected in a world where seemingly everything has become a saleable commodity.”)

letter advertising a non-fiction book on the Vietnam War, *Tellado*, 643 F. Supp. at 909–10.

Recently, one federal district court in California assumed, without expressly deciding the issue, that a former collegiate football athlete, like Hart, was entitled to pursue a right of publicity claim for EA's use of his image in *NCAA Football*. See *Keller v. Electronics Arts, Inc.*, No. C 09–1967, 2010 WL 530108 (N.D. Cal. Feb. 6, 2010).<sup>17</sup> Here, as noted, EA also assumes for the sake of argument that Hart has properly asserted a right of publicity claim.

When an author or creator uses another individual's image in a work, the First Amendment rights of the author or creator are implicated. There are several theories or policies underlying the First Amendment, including the marketplace of ideas, human dignity and self-fulfillment, and democratic self-governance. See Smolla, *supra* at § 2:3; McCarthy, THE RIGHTS OF

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<sup>17</sup> Relatedly, another suit recounts that a jury awarded over \$35 million in damages to a group of retired professional football players whose names and likenesses were used in an EA game. James J.S. Holmes, et al., *Defining Liability for Likeness of Athlete Avatars in Video Games*, 34 L.A. Lawyer 17, 18 (May 2011). That suit was not against EA directly, but was against the former players' union for its breach of contract and breach of fiduciary duties. See *Parrish v. Manatt, Phelps & Phillips, LLP*, 2010 WL 5141848 at \*3 (N.D. Cal. Dec. 13, 2010) (describing the "Adderley" litigation). While that verdict was on appeal, the case settled for \$26.25 million. *Id.* See also ESPN, *NFLPA settles Adderley suit*, [www.espn.com](http://www.espn.com) (Jun. 4, 2009) attached as McIlwain Cert., Exh. D. Underlying this suit was the premise that the former players held a right of publicity that entitled them to share in licensing fees that EA paid to the players' union for the use of the players' names and likenesses.

PUBLICITY AND PRIVACY §§ 7:3, 8:16, 8:18 (2d ed. 2008). Important here is the human dignity and self-fulfillment theory, which views the right of free expression as central to the dignity and self-realization of the individual author or creator. Smolla, *supra* at § 2:5.

While it is clear that the right of publicity may encroach upon First Amendment rights, there is little clarity as to how to balance the competing interests that each set of rights protects. As one scholar has noted, “[m]ost would acknowledge that the right of publicity needs to be reigned in when it burdens free expression, but no one convenient legal format has been found to set those limits . . . The fact is that no judicial consensus has been reached on the contours of the First Amendment vis-a-vis the right of publicity.” *Publicity, supra* at 1363. Indeed, this body of law can be aptly described as “disordered and incoherent.” *Id.*

For example, “New Jersey recognizes a robust First Amendment constitutional defense to right of publicity claims: if the speech is newsworthy and informative, it may be protected even if it incidentally implicates the right of publicity; if, on the other hand, the speech is primarily commercial, the privilege may be lost.” *Right of Publicity, supra* at § 16:3. New Jersey, further, recognizes First Amendment protection for entertainment-based, news-related works. As the Third Circuit stated in *Jenkins v. Dell Pub. Co.*, 251 F.2d 447 (3d Cir. 1958), cert. denied, 357 U.S. 921, 78 S. Ct. 1362, 2 L. Ed. 2d 1365 (1958) (en banc), “it is neither feasible nor desirable to make a distinction between *news* for information and *news* for

entertainment in determining the extent to which a publication is privileged.” *Id.* at 451 (emphasis added).

This Court is not constrained by First Amendment analysis employed by New Jersey courts in this context because just as state courts are not limited by federal court interpretations of the U.S. Constitution, so too is this Court not bound by state court interpretations of the U.S. Constitution. *See Surrick v. Killion*, 449 F.3d 520, 535 (3d Cir. 2006); *Kermani v. New York State Bd. of Elections*, 487 F. Supp. 2d 101, 114 (N.D.N.Y. 2006) (“Federal District Courts are not bound to adopt or follow the decisions of State courts when the State courts interpret Federal constitutional principles, even when those principles are applied to state statutes.”).<sup>18</sup> *See also Zacchini*, 433 U.S. at 567, 97 S. Ct. 2849 (describing First Amendment limitation as a “federal” issue).

Moreover, neither New Jersey nor the Third Circuit has explicitly adopted a test that reconciles First Amendment interests with the state right of publicity. Accordingly, I look to decisional law throughout the country that has attempted such reconciliation, as well as secondary sources, for guidance. As noted, many decisions and sources refer to the attempt to reconcile

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<sup>18</sup> This is not a case involving undecided questions of state law that would require the exercise of *Pullman* abstention in order to afford New Jersey courts the opportunity to first interpret a state law “in a way that alters or eliminates the federal question.” *McMullen v. Maple Shade Tp.*, 643 F.3d 96, 100 (3d Cir. 2011). Rather, New Jersey courts have already recognized that the right of publicity is subject to First Amendment limitations.

the competing interest of publicity rights and First Amendment rights as a type of “balancing test.”

Courts throughout the United States have utilized up to eight “balancing” tests that attempt to weigh the First Amendment rights of an author/creator against the right of publicity. Michael D. Scott, 1 SCOTT ON MULTIMEDIA LAW § 11.49– § 11.52 (3d ed.2006). It is important to note, before describing the various tests, that the Supreme Court in *Zacchini*, the only Supreme Court case addressing a First Amendment defense to the right of publicity, did *not* engage in a balancing of the competing interests.

*Zacchini* involved a television station’s broadcast, in its news programming, of a stunt performer’s entire cannonball act without the performer’s permission. Ruling in favor of the performer’s publicity right, and against the broadcaster’s reliance on the First Amendment in defense of its airing of the performance, the *Zacchini* Court reasoned that the First Amendment “does not immunize the media when they broadcast a performer’s entire act without his consent.” *Id.* at 575, 97 S. Ct. 2849. And, the Court added, “the rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.” *Id.* at 576, 97 S. Ct. 2849.

Since *Zacchini* was decided in 1977, however, many courts have limited its application to its facts; only when a performer’s entire act is appropriated do courts find it unnecessary to engage in any balancing. *See*



*ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 956 (6th Cir. 2003) (“*Zacchini* has been criticized as being very ‘narrowly drawn’ in that it involved the wholesale reproduction of a live ‘entire act’ . . . .”); McCarthy, *supra* at § 8:27. See also *Wisconsin Interscholastic Athletic Ass’n v. Gannett Co., Inc.*, 658 F.3d 614, 624, 2011 WL 3773844, \*10 (7th Cir. 2011) (reasoning that *Zacchini* “distinguishes between the media’s First Amendment right to “report on” and “cover” an event and its lack of rights to broadcast an “entire act.””); *id.* at 625, at \*11 (“ . . . *Zacchini* makes clear [that] the newspapers do not have the underlying right to broadcast an entire event . . . .”).<sup>19</sup>

The two key tests followed by courts today are the transformative test, which is borrowed from the copyright fair use doctrine, and the *Rogers* test, which is most often applied in Lanham Act trademark actions. Here, Hart advocates for the former and EA for the latter. The United States Supreme Court, the Third Circuit, and the New Jersey Supreme Court have not explicitly endorsed either test.

Hart further urges the Court to adopt a third test he describes as “the predominance test.” This test, Hart argues, was utilized by a district court in this district in *Estate of Presley v. Russen*, 513 F. Supp.

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<sup>19</sup> See also *C.B.C. Distrib. and Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 443 F. Supp. 2d 1077, 1098 (E.D. Mo. 2006) *aff’d* 505 F.3d 818 (2007); *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal.4th 387, 401, 106 Cal.Rptr.2d 126, 21 P.3d 797 (2001).

1339, 1356 (D.N.J. 1981).<sup>20</sup> That decision, however, predates both the transformative test and the *Rogers* test. More importantly, the court in *Presley* was not fashioning a “test,” but applied First Amendment principles to the Elvis impersonation act at issue in that case, and courts have since limited *Presley* to its unique facts. See e.g., *Romantics v. Activision Publ’g, Inc.*, 574 F. Supp. 2d 758, 766 n.3 (E.D. Mich. 2008) (distinguishing *Presley* as involving “merely a copy or imitation” of a performance); *Bosley v. Wildwett.com*, 310 F. Supp. 2d 914, 928 (N.D. Ohio 2004) (relying on *Presley* where images, in that case, were “mere copies”).

Notably, *Presley* suggested that the copyright fair use doctrine serves as an appropriate analogy for balancing First Amendment interests with right of publicity concerns. In this way, *Presley* predicted a transformative-style test. *Presley*, 513 F. Supp. at 1359 (“[While] entertainment . . . enjoys First Amendment protection ..., entertainment that is merely a copy or imitation, even if skillfully and accurately carried out, does not really have its own creative component and does not have a significant value as pure entertainment.”). As the *Presley* court reasoned:

Unlike a copier, a parodist or satirist adds his own new and creative touches to the original work, which, in this case, would be the likeness

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<sup>20</sup> Hart’s “predominance test” should not be confused with the test adopted by the Missouri Supreme Court in *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo.2003), a test that has received some attention in the legal literature but has not been adopted by many courts. That test is referred to as the “predominant use test.” *Id.*

of Elvis Presley as he is performing. The original work basically becomes part of a new and different work which derives its popularity from the added creative elements. The original work, or the likeness of Elvis Presley, is being used in a different manner and for a different purpose.

*Id.* at 1360 n.21. Accordingly, this Court does not view Presley as espousing an independent test that requires separate analysis, and I will focus my analysis on the transformative test that Presley appears to have foreseen, as well as the *Rogers* test.<sup>21</sup>

In my view, and as explained in more detail herein, the transformative test is more refined than the *Rogers* test and better balances the competing interests of the right of publicity and the First Amendment. The transformative test's incorporation of copyright's fair use doctrine not only reflects the common underlying principles shared by the right of publicity and copyright doctrine, but properly takes into account the extent of a defendant's use of a plaintiff's image. In this way, the transformative test captures the intricacies involved in deciphering whether a challenged work is a "new" work entitled to First Amendment protection or merely a blanket attempt to profit from another's property without due compensation. That said, I need not explicitly adopt either test because, for the reasons explained herein, EA's First Amendment defense prevails under both tests.

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<sup>21</sup> To be sure, the first California decision to adopt the transformative test, *Comedy III, supra*, referenced *Presley. Comedy III*, 25 Cal.4th at 402, 106 Cal.Rptr.2d 126, 21 P.3d 797.

**B. Transformative Test**

The tension between copyright interests and the First Amendment is apparent. The First Amendment provides that “Congress shall make no law ... abridging the freedom of speech. . . .” Yet the Copyright Act, enacted by Congress under the authority of the U.S. Constitution’s Copyright Clause, grants individuals monopoly-like power to preclude others from expressing copyrighted material. It is this “paradox,” Smolla, *supra* at § 21:2, that creates tension between the two legal doctrines. The copyright laws grant a copyright owner the right to suppress another person’s freedom of speech, when that person seeks to express copyrighted material.

In 2003, the Supreme Court commented on this apparent tension in *Eldred v. Ashcroft*, 537 U.S. 186, 123 S. Ct. 769, 154 L. Ed. 2d 683 (2003). In that case, the Supreme Court observed that both the First Amendment and the Copyright Clause were adopted close in time, suggesting that “in the Framers’ view, copyright’s limited monopolies are compatible with free speech principles. Indeed, copyright’s purpose is to promote the creation and publication of free expression.” *Id.* at 788. Importantly, the Court concluded thereafter, “copyright law contains built-in First Amendment accommodations.” *Id.* This is because the Copyright Act protects only expression, not ideas, and thereby “strikes a definitional balance between the First Amendment and copyright law by permitting free communication of facts while still protecting an author’s expression.” *Id.* at 788–89 (citation omitted). “Due to this [idea/expression dichotomy],” the Court continued,

“every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication.” *Id.*

Additionally, the Court noted, the fair use defense codified in the Copyright Act “allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances.” *Id.* at 789. Per that defense, “[t]he fair use of a copyrighted work, including such use by reproduction in copies . . ., for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.” *Id.* Notably, the Court held that there is no need to apply a strict scrutiny test to First Amendment defenses to a copyright infringement claim in light of the aforementioned, built-in First Amendment protections. *Id.* at 788 (“We reject petitioners’ plea for imposition of uncommonly strict scrutiny on a copyright scheme that incorporates its own speech-protective purposes and safeguards.”).

I briefly turn to a description of the idea/expression dichotomy and the fair use doctrine for context. The idea/expression dichotomy serves as one means of alleviating the tension between copyright protection and First Amendment goals. While scholars debate the precise contours of what constitutes an “idea,” *see generally* Smolla, *supra* at § 21:5, copyright law protects the “expression of the idea.” *Id.* This expression represents the “selection and arrangement of ideas, as well as a given specificity in the form of their expression which warrants protection under the

law of copyright.” *Id.*; *see also* Melville Nimmer, et al., NIMMER ON COPYRIGHT § 13.03[A][1].

The contours of the fair use doctrine are more clear. As codified at 17 U.S.C. § 107, the fair use doctrine is comprised of a list factors for courts to consider:

- (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.

*Id.*

Transformative use was first coined, as a phrase, by Judge Pierre N. Leval in a 1990 Harvard Law Review article on the copyright doctrine of fair use. In that article, Judge Leval argued that the fair use doctrine is best effectuated if individuals are permitted to appropriate another’s expression as “raw material” that the individual then “transform[s] in the creation of new information, new aesthetics, new insights and understandings . . . .” Pierre N. Leval, Commentary, *Toward a Fair Use Standard*, 103 Harv. L.Rev. 1105, 1111 (1990). Just four years following Judge Leval’s suggestion, the Supreme Court employed the transformative use analysis in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994). Quoting from Judge Leval’s article, the Court reasoned that “whether and to what extent [a] new work is ‘transformative’ ” informs the Court’s analysis as to the first factor of the fair use analysis,

*i.e.*, the purpose and character of the use. *Id.* at 579, 114 S. Ct. 1164.

Post- *Campbell*, California state court decisions have been credited with shaping the development of the transformative use doctrine in right of publicity cases. The doctrine was adopted by the California Supreme Court in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal.4th 387, 106 Cal.Rptr.2d 126, 21 P.3d 797 (2001), in 2001. In that case, the California Supreme Court held that an artist's sale of lithographed t-shirts of the likenesses of The Three Stooges, which likenesses were reproduced from a charcoal drawing, were undeserving of First Amendment protection because the likenesses were insufficiently transformed. That court recognized that "creative appropriation of celebrity images can be an important avenue of individual expression . . . [because the celebrities] symbolize individual aspirations, group identities, and cultural values." *Id.* at 397, 106 Cal.Rptr.2d 126, 21 P.3d 797. Nonetheless, the California Supreme Court cautioned, First Amendment rights may not trample without bounds the right of publicity.

Viewing the right of publicity as akin to an intellectual property right, designed to protect the "considerable money, time, and energy . . . needed to develop one's prominence in a particular field," *id.* at 399, 106 Cal.Rptr.2d 126, 21 P.3d 797 (quoting *Lugosi v. Universal Pictures*, 25 Cal.3d 813, 160 Cal.Rptr. 323, 603 P.2d 425 (1979)),<sup>22</sup> the Court concluded that a test

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<sup>22</sup> The court continued: "Years of labor may be required before one's skill, reputation, notoriety or virtues are sufficiently devel-

incorporating elements of the copyright fair use doctrine most appropriately balanced the competing First Amendment and right of publicity interests. *Id.* at 404, 106 Cal.Rptr.2d 126, 21 P.3d 797. The California Supreme Court adopted the U.S. Supreme Court's language in *Campbell* that "whether and to what extent the new work is 'transformative' " should frame the court's balancing test inquiry. *Id.* (quoting *Campbell*, 510 U.S. at 579, 114 S. Ct. 1164).

The *Comedy III* Court reasoned that the transformative test best protects the competing interests of protecting the celebrity while preserving First Amendment rights. The Court explained:

[w]hen artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity *without adding significant expression beyond that trespass*, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.

*Id.* at 405, 106 Cal.Rptr.2d 126, 21 P.3d 797 (emphasis added). A transformative work, in contrast:

is not only especially worthy of First Amendment protection, but is also less likely to interfere with the economic interest protected by the right of publicity [because] distortions of

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oped to permit an economic return through some medium of commercial promotion. For some the investment may eventually create considerable commercial value in one's identity." *Id.* (internal citations omitted).



the celebrity figures are not, from the celebrity fan's viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect. Accordingly, First Amendment protection of such works outweighs whatever interest the state may have in enforcing the right of publicity.

*Id.* Ultimately, the California Supreme court concluded, “the right-of-publicity holder continues to enforce the right to monopolize the production of conventional, more or less fungible, images of the celebrity.” *Id.*

In addition, the *Comedy III* Court provided another (oft-quoted) formulation of the transformative test:

Another way of stating 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 the celebrity is the very sum and substance of the work in question.

*Id.* at 406, 106 Cal.Rptr.2d 126, 21 P.3d 797. In using the word “expression,” the court meant “something other than the likeness of the celebrity.” *Id.* And, the inquiry is a qualitative rather than quantitative one, “asking whether the literal and imitative or the creative predominate in the work.” *Id.*<sup>23</sup> Because the t-shirt

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<sup>23</sup> The court further noted that, in close cases, “courts may find useful a subsidiary inquiry . . . : does the marketability and economic value of the challenged work derive primarily from the name of the celebrity depicted?” *Id.* at 407, 106 Cal.Rptr.2d 126, 21

lithograph depictions of The Three Stooges were nothing more than portraits that lacked any creative contribution by the artist, the court concluded that the t-shirts were not transformative expressions. *Id.*

Since *Comedy III*, many courts have adopted and applied the transformative test. See e.g., *Hilton v. Hallmark Cards*, 580 F.3d 874 (9th Cir. 2009); *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Adv. Media, L.P.*, 505 F.3d 818 (8th Cir. 2007); *Reyes v. Wyeth Pharmaceuticals, Inc.*, 603 F. Supp. 2d 289 (D. Puerto Rico 2009); *Romantics v. Activision Publ'g, Inc.*, 574 F. Supp. 2d 758 (E.D. Mich. 2008); *Bosley v. Wildwett.com*, 310 F. Supp. 2d 914 (N.D. Ohio 2004); *World Wrestling Fed. Entert. Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413 (W.D. Pa. 2003); *Mine O'Mine, Inc. v. Calmese*, No. 2:10-cv-00043, 2011 WL 2728390, \*8–9 (D. Nev. Jul. 12, 2011).

The transformative test, however, has been subject to some criticism. As explained by one scholar, the test lacks clear, objective guidelines and, thus, “can encourage judges to be art critics or base decisions on external factors like the fame of the artist.” David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment*, 2 Harv. J. Sports & Ent. L. 1, 25–26 (2011). Tan further explains:

In addition, the cryptic judicial comments that literal depictions like Andy Warhol’s silkscreens

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P.3d 797. However, even if this question is answered in the affirmative, “it does not necessarily follow that the work is without First Amendment protection—it may still be a transformative work.” *Id.*

of celebrities may also be transformative if they carry a particular social message lend little guidance to how a court may meaningfully determine what constitutes the criteria for transformative use. As shown by recent California decisions, the test is focused on visual transformation which can be overprotective of art and entertainment that contribute little to the discussion of public issues, but underprotective of political speech which may be contextually transformative (because of its recoding) though not visually transformative . . . . In summary, the usefulness of this test appears confined to visual depictions of the plaintiff, and the extent to which the defendant's use has departed from a realistic rendition of the plaintiff's likeness.

*Id.* at 26. Moreover, Tan notes, the copyright fair use doctrine, from which the transformative test was crafted, "has been criticized as one of copyright's 'most nebulous and unpredictable aspects' and should only be 'invoked as a last resort [in publicity claims] after all other solutions have been tried and found wanting.'" *Id.* (quoting McCarthy, *supra* at § 8:38).

While some may question the vagueness of the fair use doctrine, it nonetheless remains the statutory law for copyright matters and the U.S. Supreme Court found it appropriate in *Zacchini* to analogize the right of publicity to federal copyright law. *See Zacchini*, 433 U.S. at 573, 97 S. Ct. 2849. Moreover, the Supreme Court has described the fair use copyright doctrine as embodying First Amendment principles, thereby

dispensing with the need for a strict scrutiny test. See *Eldred v. Ashcroft*, 123 S. Ct. at 788–89. Still, Tan’s point that the transformative test may encourage judges to be art critics has some merit. It is clear from reviewing some of the decisions applying the transformative test, including those discussed below, that courts must engage in a degree of artistic interpretation in order to determine whether a work contains additional expressive elements. Even considering that the test may have some indeterminate qualities, I find that the test’s rooting in the fair use doctrine and its consideration of the extent to which an image is copied fairly takes into account the competing right of publicity and First Amendment interests.

There are several decisions applying the transformative test that deserve mention here. In 2003, the California Supreme Court held in *Winter v. DC Comics*, 30 Cal.4th 881, 134 Cal.Rptr.2d 634, 69 P.3d 473 (2003), that a comic book’s use of two musicians as inspiration for comic book characters was a transformative use. The comic book series features “Jonah Hex,” an “anti-hero” in the context of a five volume miniseries that involved, *inter alia*, singing cowboys and an emporium patterned after the life of Oscar Wilde. *Id.* at 886, 134 Cal.Rptr.2d 634, 69 P.3d 473. Also included in the series were two worm-like creatures in a volume entitled “Autumns of Our Discontent.” *Id.* These worm-like creatures, which are half-worm and half-human, are ultimately killed by Jonah Hex in the final volume of the series. The creatures were named Johnny and Edgar Autumn, and had long white hair and albino features.

Plaintiffs Johnny and Edgar Winter, two musician brothers with long white hair and albino features, sued the creator of the comic books, asserting that the worm-like creatures were appropriations of their likenesses. Rejecting their claim, the California Supreme Court reasoned that it “reviewed the comic books ... [and] can readily ascertain that they are not just conventional depictions of plaintiffs but contain significant expressive content other than plaintiffs’ mere likenesses.” *Id.* at 890, 134 Cal.Rptr.2d 634, 69 P.3d 473. While acknowledging the similar hair and features, the Court concluded that the plaintiffs were “merely part of the raw materials from which the comic books were synthesized,” and in the Court’s view, the drawings were “but cartoon characters—half-human and half-worm—in a larger story, which is itself quite expressive.” *Id.* The Court further reasoned that the plaintiffs’ fans would not find the comic books a substitute for the musicians’ work. *Id.*

Several years later, and drawing upon *Winter*, the Ninth Circuit in *Hilton, supra*, applied the transformative test to a Hallmark® greeting card that contained Paris Hilton’s image and quoted her famous statement “that’s hot.” As described by that court, the card

contains a picture above a caption that reads, “Paris’s First Day as a Waitress.” The picture depicts a cartoon waitress, complete with apron, serving a plate of food to a restaurant patron. An oversized photograph of Hilton’s head is superimposed on the cartoon waitress’s body. Hilton says to a customer, “Don’t touch that, it’s

hot.” The customer asks, “what’s hot?” Hilton replies, “That’s hot.” The inside of the card reads, “Have a smokin’ hot birthday.”

*Hilton*, 580 F.3d at 891.

The question before the Ninth Circuit was whether Hallmark was entitled to strike and, thereby dismiss, the plaintiff’s right of publicity claim based upon its First Amendment defense; the court applied the transformative test to conclude that Hallmark was not so entitled.<sup>24</sup> After comparing Paris Hilton to the character on the Hallmark card, the court reasoned that “[d]espite [some] differences . . . the basic setting is the same: we see Paris Hilton born to privilege, working as a waitress.” *Id.* at 891. This mimics Paris Hilton’s role on the popular television show, *Simple Life*, where Ms. Hilton worked as a waitress.<sup>25</sup>

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<sup>24</sup> *Hilton*’s procedural posture differs from that present in this case. In *Hilton*, the Ninth Circuit ruled on a motion to strike under California’s anti-SLAPP statute. The anti-SLAPP (Strategic Lawsuit Against Public Participation) statute is a law “designed to bar meritless lawsuits filed merely to chill someone from exercising his First Amendment rights on a matter of public interest.” 580 F.3d at 880 n.1. The standard of review on a motion to strike brought under California’s anti-SLAPP statute differs in some way from the summary judgment standard applicable to this case. *See id.* at 882 (“Such test is similar to the one courts make on summary judgment, though not identical.”). Therefore, in light of the distinct standard of review at work in *Hilton*, I rely primarily on *Hilton*’s statement of the law as opposed to its application.

<sup>25</sup> In addition, *Hilton* states that the *Comedy III* Court “envisioned the application of the [First Amendment] defense as a question of fact.” 580 F.3d at 890. *Hilton* quotes the following language from *Comedy III*, to support its statement: “Although the distinction

Two cases applying the transformative test to video games are particularly instructive. In *Kirby v. Sega of America, Inc.*, 144 Cal.App.4th 47, 50 Cal.Rptr.3d 607 (Cal. App. 2006), a California court ruled that a video game character fashioned after the plaintiff, a celebrity singer was a transformative use protected by the First Amendment. The plaintiff-singer was a 90's artist who was known for the phrase "ooh la la." The video game character was named "Ulala," and shared some similarities with the singer. *Id.* at 59, 50 Cal.Rptr.3d 607. Like Kirby, the character wore platform shoes, had similar facial features and hair color, and wore attire like that worn by Kirby. *Id.* at 55, 50 Cal.Rptr.3d 607. The character also used phrases known to be used by Kirby, such as "groove," "meow," and "dee-lish." *Id.*

However, the *Ulala* character differed from Kirby in physique, and was based, in part, on the Japanese-style animation form of anime. While the character's hairstyle and primary costume mimics one of Kirby's hair colors and outfits, Kirby often varied her hair color and clothing, the court reasoned.

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between protected and unprotected expression will sometimes be subtle, it is no more so than other distinctions *triers of fact* are called on to make in First Amendment jurisprudence." *Hilton*, 580 F.3d at 890 (emphasis in original) (quoting *Comedy III, supra* at 409, 106 Cal.Rptr.2d 126, 21 P.3d 797). To the extent *Hilton* suggests that applicability of the transformative defense is a jury question, I disagree with that reading of *Comedy III*. Read in context, the quote simply clarifies that courts and juries are capable of determining whether or not a particular work of art is sufficiently transformative to be worthy of First Amendment protection, even where the distinction between protected and unprotected expression is a subtle one. *See Comedy III*, 25 Cal.4th at 409, 106 Cal.Rptr.2d 126, 21 P.3d 797.

Importantly, the court noted, the setting for the game was unique—in the game, the character was a space-age reporter in the 25th Century. *Id.* at 59, 50 Cal.Rptr.3d 607. And, the character’s dance movements were unlike Kirby’s. Altogether, the court concluded, the video game character was transformative. *Id.*

Recently, another California court applied the transformative test to the *Band Hero* video game that included computer-generated avatars designed to look like the members of the rock band *No Doubt*. In that case, *No Doubt v. Activision, Inc.*, 192 Cal.App.4th 1018, 122 Cal.Rptr.3d 397 (Cal. App. 2011), the avatars were literal recreations of the band members, who had posed for photography to enable the video game developer to reproduce the band members’ likenesses with great detail. The *No Doubt* band members sued the developer for exceeding the bounds of the parties’ license agreement, and relied on their right of publicity as one basis for their suit. The developer of the video game asserted the First Amendment as a defense.

Ruling in favor of the band members, the court reasoned that the video game was not transformative. The court reasoned:

[The developer] intentionally used . . . literal reproductions so that players could choose to “be” the No Doubt rock stars. The game does not permit players to alter the No Doubt avatars in any respect; they remain at all times immutable images of the real celebrity musicians  
....

*Id.* at 1033, 122 Cal.Rptr.3d 397. The court contrasted these depictions to those in *Kirby*, noting that the



depictions here were not “fanciful, creative characters.”  
*Id.*<sup>26</sup>

Here, *NCAA Football*'s use of Hart's image presents a closer call than that in *Kirby* and *No Doubt*. The *Ulala* character was placed in an entirely different setting in the video game, although her characteristics relied heavily on the singer. Hart's *NCAA Football* virtual player, on the other hand, plays college football—just like Hart did.<sup>27</sup> In contrast to the transformative *Ulala* character, the avatars in *No Doubt* were exact replicas of the *No Doubt* band members who could not be altered in any way by the video game user. Hart's image in *NCAA Football* differs from the images in *No Doubt* because his image can be altered in many ways—from his personal

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<sup>26</sup> One of the justices in *No Doubt* filed a concurring opinion, disagreeing with the majority that it was necessary to decide the First Amendment question. *Id.* at 416. However, the justice made clear that she “[did] not dispute the majority’s reasoning on that issue.” *Id.*

<sup>27</sup> For this reason, I do not find EA's citation to the *Arenas* case helpful. As noted, *Arenas* involved an NBA player's challenge to the potential use of his name and likeness on the *Basketball Wives* reality television program. On a motion for preliminary injunction, the *Arenas* court concluded that the television program's potential use of the player's name was transformative because

it appears that any references in [*Basketball Wives* ] will be incidental to the show's plot as a whole. At its core, the show is about the women who have or have had relationships with basketball players rather than the players themselves. Thus, the show appears to be transformative.

Slip Op. at 9. *NCAA Football*, in contrast, is about college football players like Hart.

characteristics (height, weight, athletic ability), to his accessories (helmet visor, wristband). In addition, the image's physical abilities (speed and agility, throwing arm, passing accuracy), attributes, and certain biographical details (right handed/left handed) can also be edited by the user.

On the other hand, that Hart's image is placed in a college football game is problematic for EA's assertion of a transformative defense. Placing present and former college athletes, including Hart, into the fittingly-titled *NCAA Football* game setting strongly suggests that the goal of the game is to capitalize upon the fame of those players. Indeed, "[i]t seems ludicrous to question whether video game consumers enjoy and, as a result, purchase more EA-produced video games as a result of the heightened realism associated with actual players." Holmes, *supra* at 20. This, alone, however, does not mean that EA's use of Hart's image was not transformative. See *Winter, supra* at 889, 134 Cal.Rptr.2d 634, 69 P.3d 473 ("[i]f it is determined that a work is worthy of First Amendment protection because added creative elements significantly transform the celebrity depiction, then independent inquiry into whether or not that work is cutting into the market for the celebrity's images . . . appears to be irrelevant.") (citation omitted). Nevertheless, a game developer that bases its work on real players, in the context of the games that bring them notoriety, may walk a fine line between using reality as a building block for the developer's own creative work and exploiting the hard-earned reputations of college players for its own profit.

For this reason, the Court appreciates the plight of college players who are prohibited by NCAA bylaws from entering into licensing agreements and other “commercial opportunities” during their playing years. Hart Decl., ¶ 5. In this connection, Hart argues that EA has a practice of paying professional football players for the use of their images in EA’s professional football video games, suggesting that it is disingenuous for EA to refuse to pay college athletes for the use of their images. In support of this proposition, he attaches the Declaration of Katrina Yu, a law student who avers that she attended a seminar in which Ondraus Jenkins and Michael Shaffer, EA employees, stated that EA licensed professional player images from the players and the NFL. Yu Decl., ¶¶ 1–7. However, the Court may not consider this hearsay evidence for the truth of the matter asserted on summary judgment. *See Smith v. City of Allentown*, 589 F.3d 684, 693 (3d Cir. 2009). That said, EA states that it “does not dispute that it licenses publicity rights from certain NFL players for its *Madden NFL* game . . . .” Def. Resp. Pl. Stat. Mat. Facts ¶¶ 2, 5.

Hart further states, in a declaration, that EA has a practice of entering into license agreements with Collegiate Licensing Company, “the nation’s leading collegiate trademark licensing and marketing company,” The Collegiate Licensing Company, About CLC, [http:// www. clc. com/ clcweb/ publishing. nsf/ Content/ aboutclc. html](http://www.clc.com/clcweb/publishing.nsf/Content/aboutclc.html) (Sept. 2, 2011), for use of team trademarks, uniforms, and logos, that are included in the *NCAA Football* video game. Hart Decl. at ¶ 9. As noted, EA admits that it has licensing agreements with

the Collegiate Licensing Company. Def. Resp. Pl. Stat. Mat. Facts ¶ 15.

That EA may license professional player images, as well as team intellectual property from the N.C.A.A., yet refuse to license former college athlete images may suggest an element of unfairness. Nevertheless, it bears not on the question before this Court here—whether or not EA’s use of Hart’s image is protected by the First Amendment.

Viewed as a whole, there are sufficient elements of EA’s own expression found in the game that justify the conclusion that its use of Hart’s image is transformative and, therefore, entitled to First Amendment protection. For one, the game includes several creative elements apart from Hart’s image. Similar to the *Madden NFL* video game, as described in a case dismissing a former professional football player’s Lanham Act claim, *Brown v. Electronic Arts, supra*, the *NCAA Football* game contains “virtual stadiums, athletes, coaches, fans, sound effects, music, and commentary, all of which are created or compiled by the games’ designers.” Slip Op. at 7. Furthermore, as explained by Jeremy Strauser, an Executive Producer at EA responsible for the development of *NCAA Football*,

[t]he virtual world of *NCAA Football* is constructed from a vast array of graphics, sound and other material. Once a user chooses two college teams to compete against another, the video game assigns a stadium for the match-up and populates it with players, coaches, referees, mascots, cheerleaders and fans—all designed

and rendered by EA's artists. Each game has over 100 virtual teams and thousands of virtual players.

Strauser Decl., ¶ 4. The Court's own review of the video games confirms Mr. Strauser's description.

Even focusing on Hart's virtual image alone, it is clear that the game is transformative. It is true that the virtual player bears resemblance to Hart and was designed with Hart's physical attributes, sports statistics, and biographical information in mind. However, as noted, the game permits users to alter Hart's virtual player, control the player's throw distance and accuracy, change the team of which the player is a part by downloading varying team names and rosters, or engage in "Dynasty" mode, in which the user incorporates players from historical teams into the gameplay. *See id.* at ¶¶ 6–8. That the user is able to change the image's features, statistics, and teammates distinguishes *NCAA Football* from the game at issue in *No Doubt*, where the characters were immutable.<sup>28</sup>

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<sup>28</sup> Moreover, one court persuasively reasons that the use of player names, statistics, and biographical data is entitled to First Amendment protection because that data is in the public domain. *C.B.C.*, 505 F.3d at 823. The same reasoning applies to the public facts connected to Hart's image. While those public facts are relevant to Hart's prima facie case that his right of publicity was impinged, a legal conclusion assumed for the sake of argument here, "it would be strange law that a person would not have a first amendment right to use information that is available to everyone." *Id.* The *C.B.C.* court's rationale is consistent with the copyright idea/expression dichotomy that the Supreme Court views as properly balancing First Amendment freedoms with intellectual-property like interests. *See Eldred*, 123 S. Ct. at 789 (noting that, by virtue of the idea/expression dichotomy, "every idea,

These aspects also distinguish the video game from the greeting card in *Hilton*, where Paris Hilton's photograph was used in a single, static setting.

To be clear, it is not the user's alteration of Hart's image that is critical. What matters for my analysis of EA's First Amendment right is that EA created the mechanism by which the virtual player may be altered, as well as the multiple permutations available for each virtual player image. Since the game permits the user to alter the virtual player's physical characteristics, including the player's height, weight, hairstyle, face shape, body size, muscle size, and complexion, *see e.g.*, Strauser Decl., Exh. F at 4 (Part I) (displaying "Edit Player–Appearance" screenshot), it follows that EA's artists created a host of physical characteristic options from which the user may choose. For example, EA artists created the several different hairstyles that can be morphed onto the image. *See id.* The Court's review of the game revealed eight such hairstyle options: fade 1, fade 2, close crop, buzzout 1, buzzout 2, afro, balding 1, and balding 2.<sup>29</sup> In my view, the creation of these varied potential formulations of each virtual player

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theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication").

<sup>29</sup> Similarly, there are 24 "face" options from which a user may choose to alter the appearance of the virtual player's face, as well as 16 "face shape" options. EA artists, further, created the options for all types of equipment, the virtual player's sports ratings, and the player's "player info." The only data that may not be altered is the virtual player's home state, hometown, team, and year (e.g., senior, freshman).

alone makes the game a transformative use of Hart's image.

One could argue that the use of Hart's unaltered image as the starting point for the virtual player suggests that EA's use of Hart's image is not transformative. The problem with this argument is that it fails to fully take into account the distinctive interactive nature of video games. As noted by the United States Supreme Court in *Brown v. Entert. Merch.*, *supra*,

[l]ike the protected books, plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (*such as the player's interaction with the virtual world*). That suffices to confer First Amendment protection.

131 S. Ct. at 2733 (emphasis added). This language from *Brown* recognizes that a user's interaction with a video game is one of the means by which video games communicate ideas and social messages. To deny *NCAA Football* First Amendment protection because the game initially displays the virtual player in an unaltered form would not give due accord to this expressive aspect of video games.

That *NCAA Football 2009* includes a photograph of Hart throwing a pass, in a photo montage that can be seen when a user selects Rutgers as his or her favorite team, does not alter my conclusion. Having viewed the montage, it is clear that the photograph is but a fleeting component part of the montage and the video game as a

whole. Because the photograph comprises such a small portion of the entire work, it cannot be said that the work itself fails to incorporate transformative elements.

This leaves only the screenshot images from the game that Hart attached to his Second Amended Complaint and his opposition to the instant motion. As noted, those images are taken from *NCAA Football*, though Hart has not explained in his papers from which game or game(s) the screenshots were taken. In his Complaint exhibit, Hart juxtaposed, next to the screenshots, photographs of himself taken during his college career. In comparing the screenshots to the photographs, it is clear that the screenshots reflect his image. Hart further argues that the screenshots show the virtual player “in the same position” as in the photographs. McKenna Cert., ¶ 7.

While the screenshots reflect Hart’s image, in my view, the screenshots do not depict the virtual player in the exact position as Hart appears in the photographs. There are variations. Even if the screenshots did replicate the photographs, that would not end the inquiry—the question here is whether EA’s use of Hart’s image in the game is transformative. That a few still screenshots in the context of a larger video game reflect his image does not undercut the existence of the additional creative elements of the game, discussed above, and the variable permutations of his image, created by EA’s artists, for use in the game.

In this connection, Hart points to a statement from EA’s website indicating that the goal of *NCAA Football* (no pun intended) is to create “the most



realistic authentic [football] performance [so that the user may] feel what it's like to cover the field and play at the most elite level in college football." McKenna Cert., Exh. I. He, further, attaches statements from online articles that also describe the video game as a realistic experience. *See id.* at Exh. H, J, K. Whether EA has attempted to create a realistic experience, however, is not the focus of my inquiry. The pertinent question is whether EA's use of Hart's image is transformative and, for the reasons expressed above, I conclude that the use is transformative.<sup>30</sup>

My analysis is in contrast to that in *Keller, supra*, cited by Plaintiff. In that case, the District Court for the Northern District of California held that *NCAA Football* is not sufficiently transformative. Looking solely at the image of the former college player-plaintiff in that case, who had previously played for Arizona State University, the court reasoned:

the quarterback for Arizona State University shares many of Plaintiff's characteristics. For example, the virtual players wears the same jersey number, is the same height and weight and hails from the same state. EA's depiction of

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<sup>30</sup> Lastly, Hart states in his declaration that, "[i]n addition to my image being used in the video game, my image was used in the promotion for Defendant EA's NCAA game wherein I was throwing a pass with actual video footage from Rutgers' bowl game against Arizona State." Hart Decl., ¶ 20. However, Hart does not point to any evidence in support of this assertion, he does not explain where or when his image was purportedly used, nor does he attach a copy of this use. Accordingly, the Court does not consider this ostensible promotional use of his image.

Plaintiff is far from the transmogrification of the Winter brothers. EA does not depict Plaintiff in a different form; he is represented as he [sic] what he was: the starting quarterback for Arizona State University. Further, unlike in *Kirby*, the game's setting is identical to where the public found Plaintiff during his collegiate career, on the football field.

2010 WL 530108 at \*5.<sup>31</sup> EA argued to the *Keller* court that the court should consider the video game as a whole, and not focus solely on the former player's image. The court rejected this argument, reasoning that *Winter* and *Kirby* did just that. *Id.*

As an initial matter, EA's motion before the *Keller* court was a motion to dismiss. As such, the court considered only "those documents whose contents [were] alleged in [the] complaint," 2010 WL 530108 at \*5 n. 2, and it did not take into account declarations, submitted by EA, that described the games. Nor did the court consider other materials submitted by the parties, although it did take "judicial notice" of the content of the games. *Id.* That this Court considers EA's motion as one for summary judgment, taking into account declarations and other materials, as well as the games themselves, distinguishes my ruling from *Keller*.

With regard to *Keller's* substantive analysis, that court fails to address that the virtual image may be altered and that the EA artists created the various formulations of each player. As noted, I find this aspect

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<sup>31</sup> This aspect of *Keller's* ruling is currently on appeal to the Ninth Circuit.

of the game significant because it suggests that the goal of the game is not for the user to “be” the player, as in *No Doubt*, where the virtual player could not be altered. The malleability of the player’s image in *NCAA Football* suggests, instead, that the image serves as an art-imitating-life starting point for the game playing experience. In this way, while the player image may not be fanciful, like the worm-like characters in *Winter*, it is one of the “raw materials” from which an original work is synthesized, [and] the depiction or imitation of the celebrity is [not] the very sum and substance of the work in question.” *Comedy III, supra* at 406, 106 Cal.Rptr.2d 126, 21 P.3d 797. Moreover, one could argue that even the technology that permits users to alter a player’s image is itself a noteworthy, expressive attribute of the game. None of these facts were considered by the *Keller* court.

Finally, I disagree with *Keller’s* approach of focusing solely on the challenged image, as opposed to the work as a whole. Contrary to *Keller’s* reasoning, I read *Kirby* as looking at the video game in that case, as a whole. By focusing on the setting in which the *Ulala* character appeared, *Kirby* considered the entire game. Similarly, the *Winter* court considered that the purported images of the Winter brother musicians were “cartoon characters—half-human and half-worm—in a larger story, which is itself quite expressive.” *Id.* at 890, 134 Cal.Rptr.2d 634, 69 P.3d 473 (emphasis added). While the *Winter* Court did focus most of its attention on the fanciful worm-like characters, it also considered the larger story of which the characters were a part. Moreover, in my view, it is logically inconsistent to consider the setting in which

the character sits, which *Keller* does in its analysis, yet ignore the remainder of the game.

For the aforesaid reasons, I conclude that, under the transformative test, EA is entitled to assert the First Amendment as a defense to Hart's appropriation claim.

### C. Rogers Test

The *Rogers* test was developed by the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Courts have determined that application of the *Rogers* test makes sense "in the context of commercial speech when the appropriation of a celebrity likeness creates a false and misleading impression that the celebrity is endorsing a product." *ETW*, 332 F.3d at 956 (quoting *Comedy III*, 25 Cal.4th at 396, 106 Cal.Rptr.2d 126, 133, 21 P.3d 797). Like the transformative test, it is created to balance the competing interests of intellectual property rights and First Amendment freedom-of-expression rights. In contrast to the transformative test, it was developed in the context of trademark law rather than copyright.

In *Rogers*, the Second Circuit was faced with a Lanham Act, 15 U.S.C. § 1125(a), false-endorsement claim by Ginger Rogers, of the famous film duo of Fred Astaire and Ginger Rogers, against the creators of a film titled "Ginger and Fred." 875 F.2d at 996. This section of the Lanham Act, 15 U.S.C. § 1125(a), creates civil liability for "[a]ny person who shall affix, apply, annex, or use in connection with any goods or services . . . a false designation of origin, or any false description or representation . . . and shall cause such goods or services to enter into commerce . . . ."

The *Rogers* court fashioned a “relevance” test, which mandates that Lanham Act liability should not be imposed unless the title to the challenged work has no relevance to the underlying work, or, if the title bears some relevance, whether the title misleads the public as to the content or source of the work. 875 F.2d at 999. In the *Rogers* court’s view, this test is useful because “[a] misleading title with no artistic relevance cannot be sufficiently justified by a free expression interest.” *Id.* This is because

if a film-maker placed the title “Ginger and Fred” on a film to which it had no artistic relevance at all, the arguably misleading suggestions as to source or content implicitly conveyed by the title could be found to violate the Lanham Act as to such a film.

*Id.* If there is some modicum of relevance, the court further reasoned, a title that was “explicitly misleading” could still be found to violate the Lanham Act.<sup>32</sup> Applying its newly minted test, the Second Circuit held that “Ginger and Fred” was entitled to First Amendment protection because the film bore some relevance to the film’s story and because the title

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<sup>32</sup> By way of example, the court applied its relevance test to the song title “Bette Davis Eyes,” and concluded that such a use of Bette Davis’ name would be protected by the First Amendment despite the “slight risk that such use of a celebrity’s name might implicitly suggest endorsement or sponsorship to some people....” *Id.* at 999–1000. That slight risk, in the court’s view, was “outweighed by the danger of restricting artistic expression....” *Id.* at 999. In contrast, the court reasoned, the title “The True Life Story of Ginger and Fred” would be an “explicitly misleading description of content.” *Id.*

contained no explicit indication that Ginger Rogers endorsed or had a role in developing the film. *Id.* at 1001.

Noticeably, the *Rogers* court does not explain the genesis of its Lanham Act, “relevance test.” *See id.* It appears, however, that this test may have been borrowed from a doctrine developed under New York state law that is referred to as the “real relationship” test. That test was first applied in a 1957 decision by a New York appellate court in *Dallesandro v. Henry Holt & Co.*, 4 A.D.2d 470, 166 N.Y.S.2d 805 (1957). In that decision, the court applied the “real relationship” test to a right of publicity claim, brought under the New York statute, by a priest who alleged that a book based on his life, and that featured him on the book cover, violated his right of publicity. The court ruled that the book and cover did not violate the New York statute because the statute does not bar uses connected to matters of public interest. *Id.* at 807.

The *Dallesandro* court described the “real relationship” test as a newsworthiness exception to the statutory right of publicity:

A picture illustrating an article on a matter of public interest is not considered used for the purpose of trade or advertising within the prohibition of the statute *unless it has no real relationship to the article, or unless the article is an advertisement in disguise.* It makes no difference whether the article appears in a newspaper; a magazine; a newsreel; on television; in a motion picture; or in a book. The test of permissible use is not the currency of the

publication in which the picture appears but whether it is illustrative of a matter of legitimate public interest.

*Id.* at 806–07 (internal citations omitted) (emphasis added). The purpose of the test is to exclude from the New York right of publicity statute those uses of an individual’s image that are not commercial in nature or “used for the purpose of trade.” *Id.*<sup>33</sup> This test has been criticized because the result reached may be manipulated depending on what level of generality is employed by a reviewing court.<sup>34</sup>

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<sup>33</sup> The real relationship test continues to be applied by courts interpreting the new York statute’s “used for the purpose of trade” element. See *Messenger v. Gruner Jahr Printing and Pub.*, 208 F.3d 122, 126–27 (2d Cir. 2000) (“[W]here a plaintiff’s picture is used to illustrate an article on a matter of public interest, there can be no liability under sections 50 and 51 unless the picture has no real relationship to the article or the article is an advertisement in disguise . . . .”); *Finger v. Omni Publications Intern., Ltd.*, 77 N.Y.2d 138, 564 N.Y.S.2d 1014, 566 N.E.2d 141, 144–45 (1990) (“[Q]uestions of ‘newsworthiness’ are better left to reasonable editorial judgment and discretion; judicial intervention should occur only in those instances where there is “no real relationship” between a photograph and an article or where the article is an “advertisement in disguise””) (internal citation omitted). In addition, the test has been applied by a federal court interpreting District of Columbia law as well. See *Lane v. Random House, Inc.*, 985 F. Supp. 141, 146 (D.D.C. 1995) (“A plaintiff cannot recover for misappropriation based upon the use of his identity or likeness in a newsworthy publication unless the use has “no real relationship” to the subject matter of the publication.”).

<sup>34</sup> For example, in *Finger*, the New York Court of Appeals held that a photograph of a large family, with multiple children, used in a magazine article about caffeine and in vitro fertilization, did not violate the family’s right of publicity. 77 N.Y.2d at 144–45, 565

Like the *Rogers* test, the “real relationship” test does not apply to a use that “has no real relationship to the article, or unless the article is an advertisement in disguise.” *Id.* Yet *Rogers* expands upon the “real relationship” test by not requiring that the substance of the challenged work be related to newsworthy matters of public interest. Important here is that, while *Rogers* was addressing a First Amendment defense to a Lanham Act claim, it apparently imported the New York “real relationship” test without explaining why that test was helpful in the Lanham Act context.

In addition to its Lanham Act analysis, *Rogers* engages in a separate legal analysis of Ms. Rogers common-law right of publicity claim. In addressing that claim, the Second Circuit noted that “the right of publicity, unlike the Lanham Act, has no likelihood of confusion requirement [and is, therefore,] potentially more expansive than the Lanham Act.” *Id.* at 1004. After clarifying a choice-of-law question as to which state law applied to her claim, the court determined that an Oregon court would determine that Ms. Roger’s right of publicity claim failed. Referencing the Oregon state constitution’s free speech clause, which Oregon courts have interpreted more broadly than the federal constitution, *Rogers* then turned to Oregon decisional law, holding that a celebrity’s name may be used in a

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N.Y.S.2d 434, 566 N.E.2d 633. The family-plaintiffs argued that the article was not related to their photograph because none of the children were conceived by in vitro fertilization. Rejecting the family’s focus on the precise topic explored in the article, the court reasoned that the photograph was related to the article’s more general topic of fertility because the picture included several children. *See Solove, supra* at 221 (questioning *Finger’s* rationale).



movie title unless the title was “wholly unrelated” to the movie or the title was “simply a disguised commercial advertisement . . . .” *Id.* at 1004. This “wholly unrelated” and “disguised commercial advertisement” language is strikingly similar to the Lanham Act relatedness test, but comes from a distinct body of law. Ultimately, it is not clear from my reading of *Rogers*’ language whether it disposed of the right of publicity claim on state law, as opposed to federal constitutional grounds, but other courts have read *Rogers* as resting on federal constitutional grounds. *See e.g., Parks v. LaFace Records*, 329 F.3d 437, 460 (6th Cir. 2003) (discussing *Rogers*).

EA properly acknowledges in its briefing that *Rogers* actually involves the application of two separate tests—the Lanham Act test, and the right of publicity test. Some courts have described the Lanham Act as the federal equivalent of a state right of publicity, *see Kirby, supra* at 57, 50 Cal.Rptr.3d 607 (citing *ETW*, 332 F.3d at 924), and have applied the Lanham Act test to appropriation claims like that presented here. The court in *ETW* is one example.<sup>35</sup> In that 2003 case, the Sixth Circuit applied the Lanham Act test to conclude that an artist who depicted Tiger Woods in a painting

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<sup>35</sup> EA points to *Arenas, supra*, as an example of a court implicitly applying the *Rogers* Lanham Act test to a misappropriation claim. The language EA cites in *Arenas* consists of one paragraph in the “Transformative Use Defense” section of the opinion, which states, in pertinent part, that “there is an obvious connection between *Arenas* and [*Basketball Wives*].” Slip Op. at 9. I do not find the *Arenas* analysis useful here because *Arenas* did not explicitly apply the *Rogers* test and, apparently, viewed its “connection” reasoning as related to the transformative test instead.

was entitled to a First Amendment defense for his work. *Id.* at 937–38.<sup>36</sup>

Other courts have applied the right of publicity claim test to misappropriation claims. For example, in *Parks v. LaFace Records*, *supra*, the Sixth Circuit applied the right of publicity test in denying summary judgment on a claim brought by the civil rights icon Rosa Parks against a rap group that used her name in a song title. The Sixth Circuit held that genuine issues of material fact existed as to whether the song title was “wholly unrelated” to the song and whether the use of her name was a “disguised commercial advertisement.” *Id.* at 461. These courts may have chosen to apply the right of publicity test because right of publicity claims do not embody the same likelihood-of-confusion concerns that the *Rogers* Lanham Act test is designed to protect. *See Parks*, 329 F.3d at 460 (“[A] right of publicity claim does differ from a false advertising claim in one crucial respect; a right of publicity claim does not require any evidence that a consumer is likely to be confused.”) (citing *Herman Miller, Inc. v. Palazzetti Imports*, 270 F.3d 298, 319–20 (6th Cir. 2001); *Rogers*, 875 F.2d at 1004; *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013, 1030 (C.D. Cal. 1998)).

Similarly, in *Romantics*, *supra*, a district court applied the right of publicity test to conclude that the use of a band’s distinctive sound in the *Guitar Hero* video game was not unrelated to the game or a disguised advertisement. 574 F. Supp. 2d at 766. While

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<sup>36</sup> The *ETW* court also applied the transformative test to reach the same conclusion. *Id.*

this holding is technically dicta, because the *Romantics* court first determined that the plaintiffs in that case failed to adequately assert a publicity claim under state law, it further illustrates that several courts have applied the right of publicity test as opposed to the Lanham Act test. In any event, the Lanham Act and right of publicity tests are very similar and EA argues that it is entitled to a First Amendment defense under either test. *See* Def. Mov. Br. at 32 (discussing both tests simultaneously).

EA's argument as to why I should apply *Rogers* here is convoluted, yet easily addressed. According to EA, because New Jersey follows the Restatement, and the Restatement (Third) mirrors New York's statutory appropriation tort which a New Jersey court has described as "essentially the same" as New Jersey's common law tort, *Tellado*, 643 F. Supp. at 912, and because the *Rogers* test appears to track the Restatement (Third) of Unfair Competition, I should adopt that test.<sup>37</sup> Underlying EA's argument is the

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<sup>37</sup> It is true that the Restatement (Third) of Unfair Competition promotes a new trend of treating right of publicity claims as competition-based claims, as opposed to property-right-based claims. However, even if this Court were bound by New Jersey's approach to a federal constitutional issue, New Jersey has yet to formally adopt this particular Restatement. That said, there is an historic rationale for applying a test that treats right of publicity actions as akin to unfair competition claims. In the early U.S. Supreme Court opinion of *International News Service v. Associated Press*, 248 U.S. 215, 39 S. Ct. 68, 63 L.Ed. 211 (1918) *superseded by* *Erie Railroad Co. v. Tompkins*, 304 U.S. 64, 58 S. Ct. 817, 82 L. Ed. 1188 (1938), the Court analyzed one news service's almost verbatim copying of another news service's newspaper articles as violating unfair competition laws as opposed to copyright or other

assumption that I should follow New Jersey law. However, as explained *supra*, I am bound by federal law interpretation of the constitutional defenses—not state law interpretations thereof.

Moreover, as explained above, courts have noted that right of publicity claims do not embody the same likelihood-of-confusion concerns that the *Rogers* Lanham Act test is designed to protect. *See Parks*, 329 F.3d at 460 (“[A] right of publicity claim does differ from a false advertising claim in one crucial respect; a right of publicity claim does not require any evidence that a consumer is likely to be confused.”) (citing *Herman Miller, Inc. v. Palazzetti Imports*, 270 F.3d 298, 319–20 (6th Cir. 2001); *Rogers*, 875 F.2d at 1004; *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013, 1030 (C.D. Cal. 1998)). And, the *Rogers* right of publicity test mirrors the Lanham Act test. For this reason, I question the wisdom of applying a trademark-based test to right of publicity claims without accounting for this difference. The *Rogers* court did not explain the genesis of its Lanham Act test, yet it appears that the test was borrowed from New York’s “real relationship”

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property-based laws. *Id.* at 235–36, 39 S. Ct. 68 (“We need spend no time, however, upon the general question of property in news matter at common law, or the application of the copyright act, since it seems to us the case must turn upon the question of unfair competition in business . . . . [T]his does not depend upon any general right of property analogous to the common-law right of the proprietor of an unpublished work to prevent its publication without his consent; nor is it foreclosed by showing that the benefits of the copyright act have been waived . . . . [T]he news of current events may be regarded as common property. What we are concerned with is the business of making it known to the world, in which both parties to the present suit are engaged.”).

test. If that is the case, *Rogers* fails to explain why it imported that newsworthiness-based test into the Lanham Act context.<sup>38</sup>

Arguably, one benefit of applying either of the *Rogers* tests (the Lanham Act or right of publicity tests) is that they are both straightforward, and do not require courts to engage in as much artistic interpretation as required by the transformative test. However, like the “real relationship” test, the *Rogers* tests may be manipulated depending upon the level of generality employed by the parties or the reviewing court.

It is important to note that the Third Circuit has not adopted the *Rogers* test in the context of either a Lanham Act claim or a right of publicity claim. In *Facenda*, the Third Circuit declined to rule on the test’s applicability to a Lanham Act claim. *See* 542 F.3d at 1018. In addition to the Sixth Circuit, two other circuits, however, have adopted the test for use in the Lanham Act context. *See Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 & n. 7 (5th Cir. 1999). And, in *E.S.S. Entert. 2000, Inc. v. Rock Star*

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<sup>38</sup> Others may argue that the *Rogers* Lanham Act test derives solely from trademark law. A dissenting justice in *ETW* explains that the Second Circuit decision issued shortly after *Rogers*, *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490 (2d Cir. 1989), clarified that application of the “the *Rogers* balancing approach” must “take[ ] into account the ultimate test in trademark law, namely, the likelihood of confusion as to source of the goods in question” by also applying the “the eight-factor likelihood of confusion test . . . .” *ETW*, 332 F.3d at 948 (quoting *Cliffs Notes*, 886 F.2d at 495).

*Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008), the Ninth Circuit applied the *Rogers* test to a Lanham Act claim relating to the content of a video game that incorporated the use of a night club’s name into the game scenery.

Notably, in *Brown v. Electronic Arts*, No. 2:09-cv-1598 (C.D. Cal. Sept. 23, 2010) (Slip Op.), the Central District of California applied the *Rogers* test to conclude that the use of a former professional football player’s likeness in EA’s *Madden NFL* video game was protected by the First Amendment. In that Lanham Act action, the court concluded that “the mere use of [the plaintiff’s] likeness in the game, without more, is insufficient to make the use explicitly misleading.” *Id.* at 8. A similar holding was reached in another Lanham Act video game case brought against EA, albeit not a sports-related game.<sup>39</sup> That court had already dismissed the plaintiff’s right of publicity claim on other grounds,

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<sup>39</sup> A recent Lanham Act case applies *Rogers* to EA’s *The Godfather* video games. That case, *Dillinger, LLC v. Electronic Arts, Inc.*, No. 1:09-cv-1236, 2011 WL 2457678 (S.D. Ind. Jun. 16, 2011), involved the video game’s use of the image of John Dillinger, a gun-slinging bandit from the 1930’s era who was a flashy womanizer. Dillinger was also known for his use of the Tommy Gun submachine gun. *Id.* at \*2. In *The Godfather* video game, which is fashioned after Francis Ford Coppola’s *The Godfather* films, users may choose a Tommy Gun weapon out of seventeen weapon options. The weapon is identified, in the game, as the “Dillinger Tommy Gun.” *Id.* at \*3. Ruling in favor of EA, the court reasoned that EA’s use of the “Dillinger Tommy Gun” name in its video game is (1) related to the *Godfather* world where flashy gangsters spray their enemies with such guns, and (2) does not explicitly mislead purchasers into believing that Dillinger sponsored or endorsed the game. *Id.* at \*6.

but noted that “it would have analyzed that claim under *Rogers* also . . . .,” *Dillinger, LLC v. Electronic Arts, Inc.*, No. 1:09-cv-1236, 2011 WL 2457678, \*4 n.1 (S.D. Ind. Jun. 16, 2011), at the parties’ request.

In short, although the Third Circuit has not adopted the *Rogers* test to either Lanham Act or right of publicity claims, there is some precedent for applying the *Rogers* test to misappropriation actions like that presented in this case. Accordingly, although I am not convinced by EA’s arguments as to the applicability of the *Rogers* test, and, in my view, the transformative test better balances First Amendment and right of publicity interests, I will assume for the sake of argument that the test applies. Applying the test here, I conclude that, under either the *Rogers* Lanham Act test or the strikingly similar right of publicity test, *NCAA Football* is entitled to First Amendment protection.

As noted, the *Rogers* Lanham Act test is a two-prong test that asks: (1) whether the challenged work has relevance to the underlying work; and (2) if the challenged work is relevant, whether the title misleads the public as to the source of content of the work. *Rogers*, 875 F.2d at 999. The use of Hart’s image in the video game has great relevance to the game itself, which is set on a college football field and revolves around the playing of virtual football. In addition, the use of Hart’s image in the game cannot reasonably be said to mislead the public as to the content or source of the video game. Hart has not suggested, in his opposition brief, that the use of his image leads the public to believe that he has endorsed

the *NCAA Football* product. Indeed, in his opposition brief, Hart fails to adequately address the *Rogers* test altogether. He merely cites the case in one footnote, and provides no analysis of the *Rogers* test factors.

Under the *Rogers* right-of-publicity test, the two queries are: (a) whether the challenged work is wholly unrelated to the underlying work; or (b) whether the use of the plaintiff's name is a disguised commercial advertisement. *Rogers*, 875 F.2d at 1004. One cannot reasonably argue that Hart's image is wholly unrelated to the game, for the same reasons expressed under my analysis of the Lanham Act test. Nor is the use of Hart's image a "disguised commercial advertisement." *Id.* Instead, the use of his image is part of an expressive act by EA that might draw upon public familiarity with Hart's college football career but does not explicitly state that he endorses or contributes to the creation of the game.

As explained by the court in *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996), applying *Rogers* to a Pennsylvania right of publicity claim, "[i]f 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." *Id.* at 336 (quoting Restatement (Third) Unfair Competition § 47, cmt c.). On the other hand, the "use of a person's name and likeness to advertise a novel, play, or motion picture concerning that individual is not actionable as an infringement of the right of publicity." *Id.* (citing Restatement (Third) Unfair Competition § 47, cmt a.) Here, EA's use of Hart's image is clearly related to the



video game and is not simply an advertisement for an unrelated product.<sup>40</sup> Therefore, I conclude that EA is entitled to First Amendment protection under the *Rogers* right of publicity test.

#### IV. CONCLUSION

In sum, it is my view that the transformative test best encapsulates the type of nuanced analysis required to properly balance the competing right of publicity and First Amendment interest. Nonetheless, having concluded that EA is entitled to First Amendment protection under either the transformative test or either of the *Rogers*' tests, the Court need not decide which test should generally apply to misappropriation cases. On the facts of this case, EA is entitled to assert the First Amendment defense and its motion for summary judgment must, therefore, be granted.

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<sup>40</sup> Otherwise put, “[c]ourts long ago recognized that a celebrity’s right of publicity does not preclude others from incorporating a person’s name, features or biography in a literary work, motion picture, news or entertainment story. Only the use of an individual’s identity in advertising infringes on the persona.” George M. Armstrong, Jr., *The Reification of Celebrity: Persona as Property*, 51 La. L. Rev. 443, 467 (1991) (citing *Rogers v. Grimaldi*, 695 F. Supp. 112, 121 (S.D.N.Y. 1988), *aff’d*, 875 F.2d 994 (2d Cir. 1989)) *cited in Matthews v. Wozencraft*, 15 F.3d 432, 439 (5th Cir. 1994).

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**Appendix C**

United States District Court

D. New Jersey

Ryan HART, individually and on behalf of all others  
similarly situated, Plaintiff,

v.

ELECTRONIC ARTS, INC., and John Does, 1–50,  
Defendants.

Civil Action No. 09–5990.

Sept. 22, 2010.

**OPINION**

WOLFSON, District Judge.

In this putative class action lawsuit, Plaintiff Ryan Hart filed suit on behalf of himself and all others similarly situated against Defendant Electronic Arts, Inc. (“Defendant”), alleging, *inter alia*, that Defendant appropriated Plaintiff’s likeness and used his likeness for commercial purposes in connection with Defendant’s *NCAA Football* video games. The suit was initially filed in the Superior Court of New Jersey, Law Division, Somerset County, and then removed by Defendant to this Court. Defendant now moves to dismiss Plaintiff’s Amended Complaint pursuant to Federal Rule of Civil Procedure 12(b)(6), arguing that each count of the Amended Complaint—invasion of privacy-right of publicity (appropriation of commercial

likeness),<sup>1</sup> New Jersey Consumer Fraud Act (“NJCFA”), unjust enrichment, and conspiracy—fails to state a claim. For the following reasons, Defendant’s motion is granted. Plaintiff’s right of publicity claim is dismissed without prejudice and Plaintiff is granted leave to amend that claim. His remaining claims are dismissed with prejudice.

### I. FACTUAL BACKGROUND AND PROCEDURAL HISTORY

Plaintiff filed the original complaint in this action in the Superior Court of New Jersey, Law Division, Somerset County, on June 15, 2009. In that complaint, Plaintiff alleged that, without his consent, Defendant advertised and sold products bearing his identity and likeness from the years in which he played as a quarterback on the Rutgers University football team.<sup>2</sup> Compl. at ¶¶ 1, 6. Shortly thereafter, on July 28, 2009, Defendant moved for a more definite statement. In that motion, Defendant argued that the Complaint failed to identify which games depicted Plaintiff’s likeness and “what attributes ... of plaintiff[ ] constitute[s his] likeness...” Notice of Removal, Exh. B, Def. Mot. More Definite Statement at 2. That motion was heard in state court on September 11, 2009. At the hearing, the

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<sup>1</sup> As New Jersey and federal courts applying New Jersey law interchangeably refer to these claims as appropriation or misappropriation of commercial likeness, and “right of publicity,” this Court will do the same.

<sup>2</sup> Troy Taylor was a co-plaintiff in the original Complaint in this action. He is no longer party to this suit, however, and Plaintiff Ryan Hart proceeds as the sole plaintiff.

parties placed a settlement, with respect to that motion only, on the record. *Id.*, Rosen Ltr. dated September 17, 2009 at 1. Per their agreement, Plaintiff was to file an amended complaint that included “the names of the video game(s) and the version/year of those game(s) upon which plaintiff [is] seeking relief.” *Id.* Thereafter, Defendant withdrew its motion. On October 24, 2009, Plaintiff filed an Amended Complaint. Defendant then removed the suit to this Court, on November 24, 2009, and this motion to dismiss followed.

In his Amended Complaint, Plaintiff asserts right of publicity, NJCFA, unjust enrichment, and conspiracy claims based on Defendant’s use of Plaintiff’s image in its *NCAA Football* video game series for the years of 2004, 2005 and 2009. Am. Compl. at ¶ 22. In connection with the 2009 game, he alleges that a photograph of him appears in a photo montage of actual college players. He asserts two invasion of privacy claims, one titled “Appropriation of Likeness” and one titled “Appropriation of Likeness for Commercial Purposes.” *See id.* at pp. 5–6. In connection with these claims, he asserts that Defendant “incorporat[ed] Plaintiff’s identify [sic] and likeness into its video games.” *Id.* at ¶ 20; *see also id.* at ¶ 25 (“Defendant ... invaded Plaintiff’s right to privacy by appropriating Plaintiff’s likeness by including him in its video games.”). Plaintiff clarifies, in his opposition papers, that these two claims should be construed as one claim instead. Pl. Opp. at 13.

In connection with his NJCFA claim, Plaintiff alleges that Defendant violated the NJCFA’s prohibition against unlawful, unfair, or fraudulent acts by: (a) failing to disclose to its customers that Plaintiff

has not consented to the use of his image, (b) appropriating Plaintiff's likeness in order to enhance its sales; and (c) engaging in deceptive practices by "misleading the public that Plaintiff endorsed the use of his likeness." *Id.* at ¶ 34. His unjust enrichment claim alleges that Defendant has been unjustly enriched by Defendant's use of his likeness, *id.* at ¶ 39–42, and his conspiracy claim alleges that Defendant and JOHN DOES 1–50 conspired to utilize Plaintiff's image in "disregard of the rights of Plaintiff." *Id.* at ¶ 45.

The Amended Complaint does not address what attributes of Plaintiff appear in the *NCAA Football* games; however, in opposition to this motion, Plaintiff submitted a Declaration in which he avers additional facts. Specifically, Plaintiff's Declaration avers that *NCAA Football* depicts a "virtual" player in screen shots that replicate photos taken of Plaintiff while playing as a Rutgers University quarterback from 2002 through 2005. Pl. Decl. at ¶ 12, Exh. A–E. Plaintiff, further, points to the *NCAA Football 2006* game, which "lists the Rutgers University 'virtual' QB as hailing from Florida," and avers that he was "the only Rutgers QB during this time from Florida." *Id.* at 14. Regarding physical attributes, Plaintiff asserts that:

- a. I was listed as standing six (6) feet and two (2) inches tall, the same height as the "virtual" Rutgers QB in the *NCAA Football* game versions in question;
- b. I weighed one hundred ninety-seven pounds (197 lbs.), the same weight as the "virtual" Rutgers QB in the *NCAA Football* game versions in question;

c. My Jersey number was 13, the same as the “virtual” Rutgers QB in the *NCAA Football* game versions in question;

d. I wore a left wrist band, the same as the “virtual” Rutgers QB in the *NCAA Football* game versions in question; and

e. I wore a helmet visor, the same as the “virtual” Rutgers QB in the *NCAA Football* game versions in question.

*Id.* at ¶ 15. In addition, Plaintiff avers, the *NCAA Football 2006* game used the same “speed and agility rating,” “passing accuracy,” and “arm strength in the video [g]ame compared to actual footage.” *Id.* at ¶ 17. Similarly, the game “shows my contribution to the team and importance to total team success as identical to the actual season,” he asserts. *Id.* at ¶ 18. Finally, Plaintiff avers in his declaration that actual video footage of him was “used in the promotion for Defendant EA’s NCAA game wherein I was throwing a pass [in a] Rutgers’ bowl game against Arizona State.” *Id.* at ¶ 19.

In his opposition brief, Plaintiff asserts additional facts not found in his declaration. Specifically, he asserts that, while playing at Rutgers, he agreed to be bound by the NCAA rules, regulations and bylaws, including NCAA “Bylaw 12.5 [which] prohibits the commercial licensing of the ‘name, picture or likeness’ of a student athlete while he/she attends an NCAA-member institution.” Pl. Opp. at 1–2. Further, he states, that “[d]uring [his] college career in 2002, 2003, 2004 and 2005, [he] had forgone commercial opportunities in order to maintain his eligibility as an

NCAA student athlete at Rutgers University.” *Id.* at 2. In terms of the role of his likeness in the game, Plaintiff asserts that the game “allows the public to simulate the college football playing experience by stepping into the shoes of Rutgers’ QB Ryan Hart, and other college football players, where fans can mimic Plaintiff’s style and movements and play against Plaintiff’s actual opponents.” *Id.* at 3.

Defendants filed the instant motion on January 12, 2010, seeking to dismiss the Amended Complaint pursuant to Federal Rule of Civil Procedure 12(b)(6). As noted, Plaintiff has opposed the motion and filed a Declaration in support thereof. Having reviewed all the parties’ motion papers, the motion is now ripe for decision.

## II. STANDARD OF REVIEW

When reviewing a motion to dismiss on the pleadings, courts “accept all factual allegations as true, construe the complaint in the light most favorable to the plaintiff, and determine whether, under any reasonable reading of the complaint, the plaintiff may be entitled to relief.” *Phillips v. County of Allegheny*, 515 F.3d 224, 233 (3d Cir. 2008) (citation and quotations omitted). In *Bell Atlantic Corporation v. Twombly*, 550 U.S. 544, 127 S. Ct. 1955, 167 L. Ed. 2d 929 (2007), the Supreme Court clarified the 12(b)(6) standard. Specifically, the Court “retired” the language contained in *Conley v. Gibson*, 355 U.S. 41, 45–46, 78 S. Ct. 99, 2 L. Ed. 2d 80 (1957), that “a complaint should not be dismissed for failure to state a claim unless it appears beyond doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to

relief.” *Id.* at 561, 127 S. Ct. 1955 (quoting *Conley*, 355 U.S. at 45–46, 78 S. Ct. 99). Instead, the factual allegations set forth in a complaint “must be enough to raise a right to relief above the speculative level.” *Id.* at 555, 127 S. Ct. 1955. As the Third Circuit has stated, “[t]he Supreme Court’s *Twombly* formulation of the pleading standard can be summed up thus: ‘stating . . . a claim requires a complaint with enough factual matter (taken as true) to suggest the required element.’ This ‘does not impose a probability requirement at the pleading stage,’ but instead ‘simply calls for enough facts to raise a reasonable expectation that discovery will reveal evidence of the necessary element.’” *Phillips*, 515 F.3d at 234 (quoting *Twombly*, 550 U.S. at 556, 127 S. Ct. 1955).

In affirming that *Twombly* standards apply to all motions to dismiss, the Supreme Court recently explained the principles. “First, the tenet that a court must accept as true all of the allegations contained in a complaint is inapplicable to legal conclusions.” *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949, 173 L. Ed. 2d 868 (2009); *Fowler v. UPMC Shadyside*, 578 F.3d 203, 210–11 (3d Cir. 2009). “Second, only a complaint that states a plausible claim for relief survives a motion to dismiss.” *Iqbal*, 129 S. Ct. at 1950. Therefore, “a court considering a motion to dismiss can choose to begin by identifying pleadings that, because they are no more than conclusions, are not entitled to the assumption of truth.” *Id.* Ultimately, “a complaint must do more than allege the plaintiff’s entitlement to relief. A complaint has to ‘show’ such an entitlement with its facts.” *Fowler*, 578 F.3d at 211.



On a Rule 12(b)(6) motion to dismiss, a court must limit its review to the pleadings. A court may not consider matters extraneous to the pleadings without treating the motion as one for summary judgment and giving all parties reasonable opportunity to present materials pertinent to such a motion under Rule 56. An exception is made, however, for a “document integral to or explicitly relied upon in the complaint,” and it has been long established that “a court may consider an undisputedly authentic document that a defendant attaches as an exhibit to a motion to dismiss if the plaintiff’s claims are based on the document.” *In re Burlington Coat Factory Sec. Litig.*, 114 F.3d 1410, 1426 (3d Cir. 1997) (internal citations omitted) (emphasis omitted).

Based on this doctrine, Defendants argue that the Court may consider the 2004, 2005, and 2009 *NCAA Football* video games it submitted to the Court in connection with its motion. The Court agrees that the video games may be considered in the context of this motion. However, the Court may not consider the other declarations and exhibits that Defendant attached to its motion, including the license agreement between it and the National Collegiate Athletics Association (“NCAA”), *see* Strauser Decl., Exh. F, because those documents/materials are not integral to or referenced in the plaintiff’s pleadings.

Furthermore, a party may not amend his pleadings by making factual assertions in a brief. *Penn ex rel. Zimmerman v. PepsiCo, Inc.*, 836 F.2d 173, 181 (3d Cir. 1988); *Cardiology Consultants of North Morris v. UFCW Local*, Civil Action No. 06–5557, 2007 WL

4570160, \*3 n.5 (D.N.J. Dec. 21, 2007) (citations omitted). Nor may he amend his complaint through a declaration or certification. *Del Sontro v. Cendant Corp., Inc.*, 223 F. Supp. 2d 563, 581 (D.N.J. 2002). See also *McArdle v. Tronetti*, 961 F.2d 1083, 1089 (3d Cir. 1992) (“[D]efects in [a] complaint clearly [can] not be remedied by [an] affidavit.”). Accordingly, the Court may not consider the allegations made in Plaintiff’s opposition papers or declaration.

That said, “if a complaint is vulnerable to [Federal Rule of Civil Procedure] 12(b)(6) dismissal, a district court must permit a curative amendment, unless an amendment would be inequitable or futile.” *Travelers Indem. Co. v. Dammann & Co., Inc.*, 594 F.3d 238, 256 n.14 (3d Cir. 2010) (quoting *Phillips*, 515 F.3d at 236) (citation omitted). This rule applies “even if the plaintiff does not seek leave to amend.” *Id.* (citing *Phillips*, 515 F.3d at 245 (citation omitted)). Futility “means that the complaint, as amended, would fail to state a claim upon which relief could be granted.” *Id.* (quoting *In re Burlington Coat Factory*, 114 F.3d at 1434). Thus, the Court may consider the allegations made in Plaintiff’s opposition papers and declaration to determine whether a second amendment of his complaint would be futile.

### III. DISCUSSION

Defendant makes specific challenges to each of Plaintiff’s causes of action.<sup>3</sup> As to Plaintiff’s right of publicity claim, Defendant argues that Plaintiff has

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<sup>3</sup> The parties agree that New Jersey law governs their dispute.

failed to point to specific attributes that belong to Plaintiff, which are misappropriated in the video game. In addition, and in the alternative, Defendant argues that the video game's use of Plaintiff's height, weight, and home state do not impinge upon Plaintiff's right to publicity.

Furthermore, Defendant argues that the *NCAA Football* games are expressive works entitled to full First Amendment protection. In response, Plaintiff urges this Court to adopt the transformative test employed by the court in *Keller v. Electronics Arts, Inc.*, No. C 09-1967, 2010 WL 530108 (N.D. Cal. Feb. 6, 2010), a factually similar case brought by a former college football player against Defendant. That case ruled in favor of the plaintiff, holding that the Defendant was not entitled to First Amendment protection for its use of the plaintiff's likeness in its *NCAA Football* video games.

With regard to Plaintiff's NJCFA claim, Defendant argues that Plaintiff has failed to allege, *inter alia*, that he does not have standing under the NJCFA because he is not a consumer. Defendant argues, with respect to Plaintiff's unjust enrichment claims, that they must be dismissed because there is no direct relationship between it and Plaintiff. And, lastly, Defendant argues that Plaintiff's civil conspiracy claim must be dismissed for failure to allege an agreement.

#### **A. Right of Publicity**

The right to publicity is one of four invasion of privacy torts recognized in the Restatement (Second) of Torts, § 652. *Castro v. NYT Television*, 370

N.J.Super. 282, 296, 851 A.2d 88 (App. Div. 2004).<sup>4</sup> Succinctly put, “[New Jersey’s] right of publicity signifies the right of an individual, especially a public figure or celebrity, to control the commercial value and exploitation of his name and picture or likeness and to prevent others from unfairly appropriating this value for commercial benefit.” *McFarland v. Miller*, 14 F.3d 912, 918 (3d Cir. 1994) (citations omitted) *quoted in Prima v. Darden Rest.*, 78 F. Supp. 2d 337, 348 (D.N.J. 2000); *see also Jarvis v. A & M Records*, 827 F. Supp. 282, 297 (D.N.J. 1993) (“The right of publicity generally applies to situations where the plaintiff’s name, reputation or accomplishments are highly publicized and the defendant used that fact to his or her advantage.”). Underlying this right is the theory that “a celebrity has the right to capitalize on his persona, and the unauthorized use of that persona for commercial gain violates fundamental notions of fairness and deprives the celebrity of some economic value in his persona.” *Prima*, 78 F. Supp. 2d at 349 (citing *McFarland*, 14 F.3d at 919); *Castro*, 370 N.J.Super. at 297, 851 A.2d 88 (“The foundation for this tort is recognition that a person has an interest in their name or likeness ‘in the nature of a property right.’”) (quoting Restatement (Second) of Torts, § 652C comment a.). Because celebrity status often translates to economic wealth, the unauthorized use of one’s persona “harms the person both by diluting the value of

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<sup>4</sup> “The others are invasion of privacy by an unreasonable intrusion upon the seclusion of another, § 652B, giving unreasonable publicity to another’s private life, § 652D, and publicity that unreasonably places a person in a false light in the public eye, § 652E.” *Id.*

the name and depriving that individual of compensation.” *Prima*, 78 F. Supp. 2d at 349 (citing *McFarland*, 14 F.3d at 919).

As an initial matter, the Court addresses Defendant’s preemption argument relating to Plaintiff’s allegations regarding the use of his photograph in a photo montage of actual college players in *NCAA Football 2009*. Defendant concedes that this image was used without Plaintiff’s consent, but argues that Plaintiff’s claim is preempted by the Copyright Act because Defendant licensed that photograph from Collegiate Images, LLC, citing *Laws v. Sony Music Entertainment, Inc.*, 448 F.3d 1134, 1139 (9th Cir. 2006), in support of its argument. Because Defendant’s argument relies upon the license agreement, and that agreement may not be properly considered on a motion to dismiss, the Court denies without prejudice Defendant’s preemption argument at this juncture.

With respect to Plaintiff’s remaining right of publicity allegations, Plaintiff’s Amended Complaint fails to put forth sufficient facts detailing the attributes Plaintiff believes are appropriated in the *NCAA Football* game. As explained above, Plaintiff included the attributes in a declaration attached to this opposition papers but that declaration may not be properly considered on a motion to dismiss. In addition, Plaintiff makes further factual assertions in his opposition papers, such as stating that his weight was listed in the game as “one hundred ninety-seven pounds (197 lbs.),” which corresponds to his actual weight at the time. *See* Pl. Opp. at 4. However, Plaintiff may not amend his pleadings through his briefing. Looking

solely to the Amended Complaint, Plaintiff's failure to plead any allegations regarding the attributes found in the games does not meet the *Twombly* pleading standard. "[A] complaint must do more than allege the plaintiff's entitlement to relief. [It] has to 'show' such an entitlement with its facts." *Fowler*, 578 F.3d at 211. Here, the Court cannot determine whether Plaintiff has a claim that the *NCAA Football* games appropriate Plaintiff's likeness when there are no allegations in the Amended Complaint as to what aspects of his likeness have been appropriated.

Apparently recognizing the need for additional detail, Plaintiff states that he is "willing to file an amended complaint to set forth the statements" made in his brief and declaration. *Id.* at 1, n.1. Although Plaintiff already had one opportunity to amend at the state court level, the Court will grant Plaintiff's request because the facts alleged in Plaintiff's Declaration and in his opposition appear to state a right of publicity claim under New Jersey law. Should Plaintiff decide to file a Second Amended Complaint in order to include the proposed facts and any additional ones he chooses to assert, the Court will then consider any subsequent motion by Defendant based on a First Amendment defense.

Plaintiff's proposed allegations, found in his declaration and opposition, are of the sort recognized by New Jersey courts as stating a prima facie right of publicity claim. Courts have explained the prima facie case for infringement of the right of publicity as a two-fold requirement, including allegations of validity

and infringement.<sup>5</sup> *See id.* (citing McCarthy, *The Rights of Publicity and Privacy* § 3.1[B] ). Validity relates to whether the plaintiff “owns an enforceable right in the identity or persona,” the likeness of which he alleges was misappropriated. *Id.* Infringement relates to whether the defendant “without permission, . . . used some aspect of identity or persona in such a way that [plaintiff] is identifiable from defendant[s]’ use,” and that the “defendant[‘s] use is likely to cause damage to the commercial value of that persona.” *Id.*

Here, in terms of validity, Plaintiff proposes to assert that he played for Rutgers as a quarterback during the 2002–2005 college seasons. This assertion could sufficiently allege that he has a persona as a Rutgers quarterback. As to likeness, Plaintiff proposes to aver that the video games depict a “virtual” player in screen shots that replicate photos taken of Plaintiff while playing at Rutgers. Plaintiff further proposes to assert that the virtual player hails from the same home town, has the same height and weight as he did while a quarterback, wears the same jersey number, wrist band, and helmet visor. In addition, he asserts that the 2006 game used the same speed and agility rating,

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<sup>5</sup> Another formulation of the prima facie case is: “1) the defendant appropriated the plaintiff’s likeness, 2) without the plaintiff’s consent, 3) for the defendant’s use or benefit, and 4) damage.” *Jeffries v. Whitney E. Houston Academy P.T.*, Docket No. L-1389-07, 2009 WL 2136174, \*3 (App. Div. Jul. 20, 2009) (citing *Faber v. Condecor, Inc.*, 195 N.J.Super. 81, 86–90, 477 A.2d 1289 (App. Div.), certif. denied, 99 N.J. 178, 491 A.2d 684 (1984)). While this formulation contains four elements, the test described in *Prima* collapses the same elements into only two parts.

passing accuracy, and arm strength, mirroring statistics from Plaintiff's actual game footage. These sorts of allegations could provide enough factual matter, if taken as true as they must be on a motion to dismiss, to suggest that the virtual player in the video games depicts Plaintiff's likeness. Consistent with *Twombly's* pleading standard, these facts could "raise a reasonable expectation that discovery will reveal evidence of th[is] element" of Plaintiff's right of publicity claim. 550 U.S. at 556, 127 S. Ct. 1955.

Regarding the allegations of infringement, Plaintiff's Declaration and statements in his opposition brief allege that, without Plaintiff's permission, Defendant used Plaintiff's likeness in such a way that Plaintiff is identifiable, and that Defendant's use caused damage to the commercial value of Plaintiff's persona. As noted, he alleges that the virtual player has the same physical characteristics, uniform, and game-related statistics as he did while playing at Rutgers, such as Plaintiff's speed and agility rating. These assertions are similar to those in a Ninth Circuit case referenced by a New Jersey treatise. That case, *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) *cited in* Brent A. Olson, et al., *The Right of Publicity in New Jersey*, 49 N.J. Prac., Business Law Deskbook § 16:4 (2009–2010 ed.), involved allegations that the Defendant R.J. Reynolds Tobacco Co., owner of the "Winston" name, televised a commercial

utilizing a color photograph of a professional racing driver's car *in which the driver's facial features were not visible*. Furthermore, in



producing the commercial, defendants slightly altered the photograph by changing the numbers on plaintiff's car from "11" to "71," attaching a wing-like spoiler to plaintiff's car, and by adding the word "Winston" to that spoiler. All other familiar characteristics of the car were retained.

*Id.* at 826 (emphasis added). Ruling in favor of the plaintiff in that case, the Ninth Circuit reasoned that the "distinctive decorations appearing on the car . . . were not only peculiar to the plaintiff's car, but they caused some persons to think the car in question was plaintiff's and to infer that the person driving the car was the plaintiff." *Id.* at 827. Similarly, here, the proposed allegations aver that virtual player's physical attributes and statistics are peculiar to Plaintiff and invoke his likeness, even if his exact facial features are not replicated. Finally, in terms of economic damage, Plaintiff's proposed allegations aver that Defendant's video game sales, for all of its sports-related games, including *NCAA Football*, generate over 4 billion dollars in revenue for Defendant. The implication of Plaintiff's allegations is that he would now be entitled to sell his own likeness and recover a portion of those monies for himself.

Altogether, Plaintiff's proposed allegations suggest that he may be able to state a right to publicity claim. *Accord Palmer v. Schonhorn Enterprises, Inc.*, 96 N.J.Super. 72, 232 A.2d 458 (Ch. Div. 1967) (ruling in favor of professional golf athletes whose name and playing profiles were included in board game); *Presley's Estate v. Russen*, 513 F.Supp. 1339 (D.N.J. 1981) (granting preliminary injunction enjoining Elvis

impersonator from using Elvis' likeness in products or merchandise connected with the impersonator's stage show). This includes Plaintiff's allegations regarding the use of his video footage in promotional materials related to a version of the video game. *Accord Tellado v. Time-Life Books, Inc.*, 643 F. Supp. 904, 909–910 (D.N.J. 1986) (holding that use of photograph of former Vietnam veteran in letter advertising non-fiction Vietnam book violated veteran's right to publicity).

Defendant's key challenge to Plaintiff's proposed allegations is that they fail to demonstrate that Defendant's use of Plaintiff's likeness was for a commercial purpose. Defendant is correct that, under New Jersey law,

defendant[s] would be liable for the tort of misappropriation of likeness only if defendant's use of plaintiff's likeness was for a predominantly commercial purpose, *i.e.*, if defendant was seeking to capitalize on defendant's likeness for purposes other than the dissemination of news or information.

*Tellado*, 643 F. Supp. at 909–10. Thus, to determine if granting leave to amend would be futile, the Court considers Defendant's argument.

In support of its argument, Defendant relies upon *Castro v. NYT Television, supra*. *Castro* involved an appropriation of likeness claim asserted by plaintiff emergency-room patients who had been videotaped after executing a consent form. The plaintiffs claimed that the videotapers misrepresented that they were part of the hospital when, in fact, they were media

employees seeking footage for a reality television show. Because the plaintiffs did nothing more than assert that “[d]efendants appropriated plaintiffs’ likenesses, images and/or names for commercial profit and advantage,” the *Castro* Court dismissed their claim for failure to allege that the videotape footage had been used for trade purposes. 370 N.J.Super. at 289, 851 A.2d 88. In reaching its conclusion, the *Castro* Court reasoned that “it is irrelevant whether a videotape is broadcast in connection with a television story about important public events or a subject that provides only entertainment and amusement . . . .” *Id.*

Defendant focuses its argument on *Castro*’s broad language; however, courts interpreting *Castro* have limited its holding to media defendants. For example, the court in *Liebholz v. Harriri*, Civil Action No. 05–5148, 2006 WL 2023186 (D.N.J. Jul. 12, 2006), held that a biotechnology corporate defendant who fraudulently displayed on its website that a scientist was affiliated with the company could not rely on *Castro* to shield it from liability. That court reasoned:

Leibholz cannot rely on cases like *Castro* ... because those were cases in which the mere use of a person’s likeness by a media defendant, without use of the likeness to encourage more viewership or sell more magazines, was held to be incidental and therefore not actionable. Not every use of one’s image or likeness by a magazine is considered a “commercial use,” since otherwise almost any publication of a name or likeness would be misappropriation. Use of

names and likenesses by non-media parties are different.

*Id.* at \*4. Indeed, language in *Castro* suggests this interpretation is correct in that the decision speaks of “enlightening the public,” and that there is no distinction between “*news* for information” and “*news* for entertainment,” 370 N.J.Super. at 298, 851 A.2d 88 (emphasis added). Other decisions applying New Jersey law, such as *Tellado*, contain similar news-related language. 643 F.Supp. at 914 (discussing *Zacchini v. Scripps–Howard Broadcasting Co.*, 433 U.S. 562, 97 S. Ct. 2849, 53 L. Ed. 2d 965 (1977)).

That said, case law and commentaries discussing New Jersey law make clear that the touchstone of the commercial purpose requirement is whether the publication uses the plaintiff’s likeness “for the purpose of capitalizing upon the name by using it in connection with a commercial project . . . .” *Palmer*, 96 N.J.Super. at 79, 232 A.2d 458; *see Castro*, 370 N.J.Super. at 297, 851 A.2d 88 (“defendant[s] would be liable for the tort of misappropriation of likeness only . . . if defendant was seeking to capitalize on defendant’s likeness”) (quoting *Tellado*, 643 F. Supp. at 909–10); 49 N.J. Prac., Bus. Law Deskbook § 16:4 (2009–2010 ed.) (“In New Jersey, an advantage or benefit accruing to the defendant is a *sine qua non* for a successful claim: mere publicity is not actionable; it must be shown that defendant acted with a commercial purpose or otherwise sought some benefit from revealing information about plaintiffs.”) (emphasis in original) (internal quotation marks omitted). As the Restatement puts it, “[u]ntil the *value* of the name has

in some way been appropriated, there is no tort.” Restatement (Second) of Torts, § 652C c (emphasis added).

Thus, in my view, to show that the commercial purpose requirement is met here, Plaintiff would have to allege that Defendant used his likeness to increase its sales of the video games, for example. Plaintiff proposes to assert that “[w]ith its NCAA Football video game, Defendant ... allows the public to simulate the college football playing experience by stepping into the shoes of Rutgers’ QB Ryan Hart, and other college football players, *where fans can mimic Plaintiff’s style and movements and play against Plaintiff’s actual opponents.*” Pl. Opp. Br. at 3 (emphasis added). This allegation, though inartfully plead, may evoke the notion that Defendant has utilized Plaintiff’s image in order to increase sales of its video game. *Accord Presley’s Estate*, 513 F. Supp. at 1360 (concluding Elvis impersonator’s use of Elvis’ likeness in his stage show was primarily to appropriate the commercial value of Elvis’ likeness even though the impersonator’s show had some independent, creative, entertainment value).

In sum, “[w]hile the Court could ignore [Plaintiff’s Declaration] and test the sufficiency of the allegations in the [Amended Complaint] without reference to [the Declaration or briefs],” I find it more efficient and in the interest of justice to “grant Plaintiff leave to amend the Complaint . . . and to permit Defendants to refile their dismissal motions following Plaintiff[’s] amendment.” *Liberty and Prosperity 1776, Inc. v. Corzine*, Civil Action No. 08-2642, 2009 WL 537049, \*7 (D.N.J. Mar. 3, 2009) (“the court should freely give

leave [to amend the complaint] when justice so requires”) (quoting Fed. R. Civ. P. 15(a)(2)). The Court, thus, grants Defendant’s motion to dismiss without prejudice, so to afford Plaintiff the opportunity to file a Second Amended Complaint. In so ruling, the Court is not holding that Plaintiff’s proposed allegations are sufficient as a matter of law. Rather, the Court merely concludes that the sort of allegations Plaintiff’s proposes suggest that an amendment may not be futile.

With regard to Defendant’s First Amendment defense, applicability of the defense depends upon whether the video game is considered commercial speech or an artistic work. *See Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008) (discussing first amendment defense in trademark context). Indeed, the Third Circuit noted in *Facenda* that sports-related video games may contain both noncommercial and commercial elements. *Id.* at 1017.<sup>6</sup> Accord Scott Jon Shagin, *Celebrity Rights in New Jersey*, 231 N.J. Lawyer 15, 17 (2004) (“The First Amendment defense analysis becomes especially thorny in circumstances where the use of the celebrity’s identity may serve dual purposes: as

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<sup>6</sup> Defendant attempts to rely on *Facenda* for the proposition that a video game is an expressive work entitled to First Amendment protection; however, the speech at issue in *Facenda* was a thirty-minute video program describing a video game, which the Third Circuit held (on summary judgment) to be in the nature of an infomercial. Thus, any language suggesting that a video game is, by its nature, an expressive work is *dicta*. That said, the Court questions whether Plaintiff will be able withstand the First Amendment defense at a later stage in the proceedings.

expressive speech designed to entertain or newsworthy speech designed to inform, but also as speech that is designed to help sell products or services.”) Typically, this sort of defense is heard on a motion for summary judgment in light of the intricate facts that the Court must consider in divining the nature of the speech. *See e.g., Id.* at 1011; *see In re Orthopedic Bone Screw Products Liability Litigation*, 193 F.3d 781, 793–94 (3d Cir. 1999) (explaining a number of key facts that must be assessed in ruling on First Amendment claim involving potentially commercial speech). For this reason, the Court will not consider Defendant’s First Amendment defense at this juncture.<sup>7</sup> If Plaintiff chooses to file a Second Amended Complaint, the Court will consider the First Amendment defense by way of an appropriate motion brought by Defendant.

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<sup>7</sup> Defendant cites *Castro* for the proposition that the First Amendment defense may be decided on a motion to dismiss. *Castro*, however, did not address the First Amendment defense but held that the plaintiffs did not state a prima facie case for misappropriation because they failed to allege a commercial purpose. 370 N.J.Super. at 298–99, 851 A.2d 88. The Court is aware of *Castro*’s comment that “a member of the general public who is subject to videotaping for a television program cannot reasonably expect that he or she will receive payment from the producer of the show. In fact, a substantial First Amendment issue would be raised if a court were to find a right of compensation in such circumstances.” *Id.* at 300, 851 A.2d 88. In the context of the entire opinion, however, that phrase does not indicate that the *Castro* Court ruled on First Amendment grounds.

## B. Remaining Claims

### 1. *New Jersey Consumer Fraud Act*

Defendant is correct that Plaintiff's NJCFA claim must be dismissed because he is not a "consumer" and, therefore, does not have standing to bring that claim. In response, Plaintiff argues that this Court should follow a line of cases holding that competitors have standing to sue under the NJCFA. While Plaintiff is correct that some cases have held that competitors have standing under the statute, those cases refer to direct competitors of the defendant, *i.e.*, "competitors in a commercial sense." *General Development Corp. v. Binstein*, 743 F. Supp. 1115, 1131 (D.N.J. 1990); *see Feiler v. New Jersey Dental Ass'n*, 191 N.J. Super. 426, 431, 467 A.2d 276 (Ch. Div. 1983) ("A practicing New Jersey dentist has standing to complain that another dentist gains an unfair competitive advantage over him by fraudulent billing practices that enable him to promise and deliver cost savings to patients that are unavailable to patients of an honest practitioner.").

Plaintiff is not a direct, commercial competitor of Defendant; he does not produce and sell video games. *See 800-JR Cigar, Inc. v. GoTo.com, Inc.*, 437 F. Supp. 2d 273, 296 (D.N.J. 2006) ("As a cigar retailer, JR cannot be considered a commercial competitor of GoTo's search engine."). Moreover, he has not pointed to any cases in which a non-direct competitor was held to have standing, and the Court sees no reason to presume that the New Jersey Supreme Court would extend the NJCFA to such plaintiffs. *Accord IDT Telecom, Inc. v. CVT Prepaid Solutions, Inc.*, Civil Action No. 07-1076, 2009 WL 5205968, \*6 (D.N.J. Dec.



28, 2009) (declining to extend NJCFA to cover complaint brought by phone card distributor against phone card provider); *Conte Bros. Auto., Inc. v. Quaker State-Slick 50*, 992 F. Supp. 709, 716 (D.N.J. 1998) *aff'd on other grounds* 165 F.3d 221 (3d Cir. 1998) (noting that “commercial resellers such as plaintiffs do not qualify as ‘consumers’ and declining plaintiffs’ invitation to construe the [NJCFA] to permit non-consumers such as plaintiffs to assert claims thereunder.”). Therefore, the Court concludes that Plaintiff is not a consumer under the NJCFA and dismisses his NJCFA claim with prejudice.

## 2. *Unjust Enrichment*

Defendant argues that Plaintiff may not proceed under the unjust enrichment theory because he has no direct relationship with Defendant, upon which basis he could assert that he reasonably expected to be compensated for Defendant’s use of his likeness. While conceding that he “has no direct relationship with Plaintiff to create a reasonable expectation of benefit,” Plaintiff’s argues that he may nonetheless recover under an unjust enrichment theory because “had [he] known that [Defendant] intended to use his likeness ..., he had a right to be compensated for such use [and] a jury could determine that Plaintiff had a right of remuneration [sic].” Pl. Opp. at 23. He, further, argues that his filing of the instant suit “reveals an expectation of remuneration [sic].” *Id.*

This sort of argument has been explicitly rejected by New Jersey courts. In *Fasching v. Kallinger*, 211 N.J.Super. 26, 510 A.2d 694 (App. Div. 1986), the Appellate Division rejected an unjust enrichment claim

by survivors of a murder victim who alleged that the defendant author and publisher of a book about the victim profited from the victim's story without first seeking their permission. The court based its ruling on two facts, that the plaintiffs did not confer any benefit on the defendants and that the plaintiff did not expect any remuneration at the time the victim's story was misappropriated. While the "Plaintiffs contend[ed] that had they known defendants were publishing a book they would have expected remuneration," the Court reasoned that "this fact lacks legal significance in the absence of any benefit conferred by plaintiffs." *Id.* at 36, 510 A.2d 694. Fittingly, this is the case upon which *Castro, supra*, relies in rejecting an unjust enrichment claim based on misappropriation of one's image. 370 N.J.Super. at 299–300, 851 A.2d 88.

Here, because Plaintiff alleges in his Amended Complaint that Defendant did not seek his permission before using his likeness or photograph, Plaintiff clearly did not confer any benefit upon Defendant. Accordingly, for the same reasons expressed in both *Castro* and *Fasching*, Plaintiff's unjust enrichment claim fails and is dismissed with prejudice.

### 3. *Civil Conspiracy*

As to Plaintiff's civil conspiracy claim, Defendant argues that it must be dismissed for failure to allege that two parties agreed to conspire. Plaintiff's Amended Complaint asserts that Defendant conspired, and actively participated in, "utiliz[ing] [Plaintiff's] image for the sale of products bearing the identity and likeness of Plaintiff in disregard of the rights of Plaintiff." Am. Compl. at ¶¶ 44–45. There is no mention

in the pleading of a second party with whom the Defendant conspired. Plaintiff argues in his opposition papers that this claim refers to a conspiracy between Defendant, the NCAA, and the Collegiate Licensing Company (“CLC”), which serves as the NCAA’s licensing entity. In this connection, his proposed allegations aver that NCAA rules govern the use of players’ images and that Defendant entered into an agreement with CLC to license NCAA member “teams’ trademarks, uniforms, logos, etc., licensing all elements except collegiate athletes’ likenesses.” Pl. Opp. at 1–2.

Even if the Court permitted Plaintiff to file a Second Amended Complaint to incorporate his proposed allegations regarding the NCAA and CLC, those allegations make no mention of a conspiratorial agreement between Defendant and those parties to utilize his image in disregard of his rights. Because an agreement is essential to his cause of action, his proposed allegations could not resurrect his claim. *See Morgan v. Union County Bd. of Chosen Freeholders*, 268 N.J.Super. 337, 364, 633 A.2d 985 (App. Div. 1993) (“A civil conspiracy is ‘a combination of two or more persons acting in concert to commit an unlawful act, or to commit a lawful act by unlawful means, *the principal element of which is an agreement between the parties to inflict a wrong against or injury upon another,*’ and ‘an overt act that results in damage.’”). Plaintiff is correct that an agreement may be proven by circumstantial evidence, *see id.* at 364–65, 633 A.2d 985, but he has failed to allege any agreement to inflict a wrong or injury. His only allegation is that Defendant, the NCAA, and the CLC agreed not to license his likeness. For this reason, granting Plaintiff leave to

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amend his conspiracy claim would be futile and his claim is, therefore, dismissed with prejudice.

#### **IV. CONCLUSION**

For the foregoing reasons, Defendant's motion is granted. Plaintiff's right of publicity claims are dismissed without prejudice, and Plaintiff is granted leave to file a Second Amended Complaint asserting such a claim within twenty (20) days. Plaintiff's remaining claims are dismissed with prejudice.

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**Appendix D**

UNITED STATES COURT OF APPEALS  
FOR THE THIRD CIRCUIT

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No. 11-3750

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RYAN HART, individually and on  
Behalf of all others similarly situated

v.

ELECTRONIC ARTS, INC.,  
A Delaware Corporation;  
DOES 1-50

Ryan Hart, Appellant

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APPEAL FROM THE UNITED STATES  
DISTRICT COURT FOR THE DISTRICT  
OF NEW JERSEY

(D.C. Civ. Action Number 3:09-cv-05990)

District Judge: Honorable Freda L. Wolfson

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Present: McKEE, Chief Judge, SLOVITER,  
SCIRICA, RENDELL, AMBRO, FUENTES,  
SMITH, FISHER, CHAGARES, JORDAN,  
GREENAWAY, JR., VANASKIE, SHWARTZ,  
and TASHIMA, Circuit Judges.

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SUR PETITION FOR REHEARING  
WITH SUGGESTION FOR REHEARING EN  
BANC

The petition for rehearing filed by Appellee and briefs in support by amici having been submitted to all judges who participated in the decision of this court, and to all other available circuit judges in active service, and a majority of the judges who concurred in the decision not having asked for rehearing, and a majority of the circuit judges of the circuit in regular active service not having voted for rehearing by the court en banc, the petition for rehearing by the panel and the Court en banc is hereby DENIED. Judges Ambro and Fuentes voted for rehearing.

BY THE COURT:

/s/ Joseph A. Greenaway, Jr.  
Circuit Judge

Dated: June 25, 2013