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THE TERMINATOR AS ERASER: HOW ARNOLD SCHWARZENEGGER USED THE RIGHT OF PUBLICITY TO TERMINATE NON-DEFAMATORY POLITICAL SPEECH*

David S. Welkowitz** and Tyler T. Ochoa***

I. INTRODUCTION

While it is no longer unusual for a politician to have been a recent celebrity in the commercial world of entertainment,¹ the Schwarzenegger bobblehead case is one of the rare cases in which a politician has filed a lawsuit asserting a right of publicity claim.² However, the Schwarzenegger case and its

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1. California seems to have been on the cutting edge here, with Ronald Reagan (Governor, President), George Murphy (Senator), Sonny Bono (U.S. Representative), and Clint Eastwood (Mayor), among others. An example of the opposite move—from politician to actor (actually, from lawyer to actor to politician and back to actor)—is former Tennessee Senator Fred Dalton Thompson, currently playing the role of District Attorney Arthur Branch on NBC's television series *Law and Order*.

2. The most prominent, albeit indirect, example was when the New York Metropolitan Transportation Authority, asserting then-Mayor Rudy Giuliani's right of publicity, denied New York Magazine the right to advertise on city buses using the slogan "Possibly the only good thing in New York Rudy hasn't taken credit for." *New York Magazine v. Metro. Transp. Auth.*, 136 F.3d 123, 125 (2d Cir. 1998). Recognizing that "protecting the right to express skeptical attitudes toward the government ranks among the First Amendment's most important functions," *id.* at 131, the Second Circuit ruled that the MTA's action was an impermissible prior restraint, *id.* at 131-32.

Conversely, there have been some recent cases in which political candidates have been sued by companies who claimed that the candidates' advertisements infringed their trademarks. *See, e.g., MasterCard Int'l, Inc. v. Nader 2000 Primary Comm., Inc.*, 70 U.S.P.Q.2d 1046 (S.D.N.Y. 2004) *available at*

settlement exposed some basic flaws in the analysis of celebrity rights problems, flaws that are not unique to its political context. Two of those flaws converged in this case and are the main subjects of this article. First, rights of publicity claims frequently are used as a “stealth” alternative to defamation claims, in order to circumvent the constitutional limitations on defamation claims. Second, the analysis promulgated by the California Supreme Court in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*³ and its progeny,⁴ though recognizing some of the First Amendment problems posed by these cases, has serious faults that undermine its assertedly protective sphere. Both of these problems lead to the suppression of free speech and were at the root of the settlement in the Schwarzenegger bobblehead case.

II. USING RIGHTS OF PUBLICITY IN LIEU OF DEFAMATION

Ever since the landmark case of *New York Times Co. v. Sullivan*,⁵ it has been understood that the First Amendment creates a substantial hurdle for politicians and other public figures seeking to sue those who criticize and disparage them.⁶ A public figure suing for defamation must show that the criticism was false and defamatory *and* that it was made with “actual malice”—that is, there must be clear and convincing evidence that the false statements were made with knowledge of their falsity or with reckless disregard for their truth or falsity.⁷ Since *New York Times*, public figures have sought ways to avoid these strict requirements for a success-

2004 WL 434404 (parody of MasterCard’s “Priceless” campaign); *American Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682 (N.D. Ohio 2002) (parody of the AFLAC duck). In both cases, the candidates prevailed.

3. 25 Cal. 4th 387, 21 P.3d 797, 106 Cal. Rptr. 2d 126 (2001).

4. *See Winter v. DC Comics*, 30 Cal. 4th 881, 69 P.3d 473, 134 Cal. Rptr. 2d 634 (2003), discussed *infra* at notes 26-31 and accompanying text.

5. 376 U.S. 254 (1964).

6. Technically, *New York Times* only involved a public official. The Court extended the holding to other public figures in *Curtis Publ’g Co. v. Butts*, 388 U.S. 130, 164 (1967) (Warren, C.J., concurring), *id.* at 170 (opinion of Black, J., joined by Douglas, J., concurring in Parts I and II of Warren’s opinion); *id.* at 172 (opinion of Brennan, J., joined by White, J., concurring in Parts I and II of Warren’s opinion).

7. *New York Times*, 376 U.S. at 279-80 (holding that actual malice is required); *id.* at 285-86 (stating that the evidence “lacks the convincing clarity which the constitutional standard demands”).

ful defamation suit. In *Hustler Magazine, Inc. v. Falwell*,⁸ for example, the Rev. Jerry Falwell sued Hustler for both defamation and intentional infliction of emotional distress for publishing a parody advertisement lampooning him.⁹ The jury held for Hustler on the defamation claim,¹⁰ but it awarded Falwell \$200,000 in compensatory and punitive damages on the emotional distress claim.¹¹ The Supreme Court prevented this “end run” by holding that the advertisement must be judged by the standard set forth in *New York Times*; thus, changing the nomenclature from defamation to intentional infliction of emotional distress did not change the constitutional test.¹² As the Schwarzenegger bobblehead case and other recent cases have shown, however, public figures often turn to rights of publicity to avoid the *New York Times* standard. Although such suits are not always successful, courts are often more sympathetic to right of publicity claims than to defamation claims.

The complaint in the Schwarzenegger bobblehead case did not contain any allegations of defamation,¹³ and, on its face, it did not look like a defamation claim. The complaint alleged that the defendants’ unauthorized manufacture and sale of a bobblehead doll featuring Governor Schwarzenegger’s likeness was a violation of his right of publicity,¹⁴ actionable under California’s statutory and common-law causes of action for misappropriation of a person’s identity for commer-

8. 485 U.S. 46 (1988).

9. *Id.* The advertisement was a take-off on advertisements for Campari liqueur, which featured celebrities reminiscing about their “first time”—a double entendre meant to suggest sex, but which actually referred to their first time drinking the liqueur. *Id.* at 48. In *Falwell*, the parody advertisement depicted Falwell’s “first time” as “a drunken incestuous rendezvous with his mother in an outhouse.” *Id.*

10. The jury specifically found that the advertisement could not “reasonably be understood as describing actual facts about [respondent] or actual events in which [he] participated.” *Id.* at 49.

11. *Id.*

12. *See id.* at 56 (applying *New York Times* test); David S. Welkowitz, *Trademark Parody after Hustler Magazine v. Falwell*, 11 COMM. & THE L. 65 (Dec. 1989).

13. *See* Complaint, *Oak Prods., Inc. v. Ohio Disc. Merch., Inc.*, No. SC081563 (Los Angeles Super. Ct. filed Apr. 30, 2004).

14. *See id.* ¶¶ 17-21. The complaint also asserted a claim for unfair competition. *Id.* ¶¶ 22-25. *See The Schwarzenegger Bobblehead Case: Introduction and Statement of Facts*, 45 SANTA CLARA L. REV. 547, 552-53 & n.46 (2005).

cial purposes.¹⁵ But the settlement of the case revealed the true nature of the claim. The doll in question featured Schwarzenegger clothed in a business suit (befitting a public official), carrying an assault rifle with a bandolier around his shoulder.¹⁶ The settlement permitted the defendants to make and sell a bobblehead doll of Schwarzenegger, but without the assault rifle and bandolier.¹⁷ Belying the complaint's allegation that Schwarzenegger does not allow merchandising of his likeness except in connection with his movies,¹⁸ the settlement demonstrates that what Schwarzenegger objected to was not really the use of his image; it was the use of his image *in a particular way* that was the problem. Governor Schwarzenegger was offended (or at least politically concerned) about being portrayed as a real-life lover of military-style weapons (in the manner of several of his action-movie characters, such as the Terminator). Whether this was defamatory is beside the point; the focal point of the lawsuit was an *unflattering* portrait of a public official. This is precisely the type of criticism that the *New York Times* rule was designed to protect. Had a newspaper published a caricature of Schwarzenegger in a business suit with an assault rifle, it is clear that the caricature would have been protected by the First Amendment under the *New York Times* standard.¹⁹ But because the same caricature was sold in three-dimensional form, Schwarzenegger was able to use the right of publicity to censor criticism of his political persona.²⁰

15. See *Eastwood v. Superior Court*, 149 Cal. App. 3d 409, 416-17, 198 Cal. Rptr. 342, 346-47 (Cal. Ct. App. 1983) (recognizing common-law cause of action for appropriation of plaintiff's name or likeness, in addition to statutory remedy); CAL. CIV. CODE § 3344(a) (West 2005) ("Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.")

16. See *Introduction and Statement of Facts*, *supra* note 14, at 551 & *Appendix A*. The plaintiff's complaint did not describe or depict the doll; only the defendant's "cross complaint" describes the doll's appearance. See *Cross-Complaint for Declaratory Relief* ¶ 5, *Oak Prods., Inc. v. Ohio Discount Merchandise, Inc.*, No. SC081563 (Los Angeles Super. Ct. filed May 27, 2004).

17. See *Introduction and Statement of Facts*, *supra* note 14, at 554.

18. *Id.* at 549 & n.16.

19. See *Falwell*, 485 U.S. at 53-55 (discussing the important role played by caricature and political cartoons in public and political debate).

20. Ironically, it was only the presence of the assault rifle and bandolier

Some of these “stealth defamation” right of publicity claims are not so stealthy. In *Eastwood v. Superior Court*,²¹ for example, Clint Eastwood sued the National Enquirer for both false-light invasion of privacy and violation of the right of publicity over an allegedly false story about his love life.²² While the false-light claim included allegations of knowledge or reckless disregard of falsity sufficient to satisfy the *New York Times* standard, the right of publicity claim did not.²³ The court blocked this transparent attempt to recover damages for reputational harm without having to prove “actual malice” by holding that a “deliberate fictionalization” violates the right of publicity only “when it is presented to the reader as if true with the requisite scienter.”²⁴ The requisite scienter is the same as actual malice: “that the article was published with knowledge or in reckless disregard of its falsity.”²⁵

Another fairly transparent attempt to use the right of publicity as a substitute for a defamation claim is *Winter v. DC Comics*,²⁶ in which rock musicians Johnny and Edgar Winter claimed that defendant’s “Jonah Hex” comic book misappropriated their likenesses when it depicted them as grotesque half-worm, half-human creatures. The complaint alleged that the comic book “falsely portrayed [the Winters] as ‘vile, depraved, stupid, cowardly, sub-human individuals who engage in wanton acts of violence, murder and bestiality for pleasure and who should be killed,’”²⁷ and it included claims for defamation and invasion of privacy.²⁸ The Califor-

that gave the defendants a fighting chance of winning the case, because those were the elements that arguably made the doll “transformative” under the *Saderup* standard. See *infra* notes 77-93 and accompanying text. Without the assault rifle and bandolier, the doll almost certainly would have been enjoined under the *Saderup* standard, because it would have been only a “literal depiction or imitation of a celebrity.” See *infra* note 93 and accompanying text.

21. *Eastwood*, 149 Cal. App. 3d 409, 198 Cal. Rptr. 342.

22. *Id.* at 413-14, 198 Cal. Rptr. at 344-45.

23. *Id.* at 415, 198 Cal. Rptr. at 345. The U.S. Supreme Court had previously held that claims for false-light invasion of privacy must also meet the *New York Times* “actual malice” standard. See *Time, Inc. v. Hill*, 385 U.S. 374 (1967).

24. *Eastwood*, 149 Cal. App. 3d at 426, 198 Cal. Rptr. at 352.

25. *Id.* Because Eastwood did not allege the requisite scienter in the right of publicity claim, it was dismissed with leave to replead. *Id.*

26. 121 Cal. Rptr. 2d 431 (Cal. Ct. App. 2002), *rev’d*, 30 Cal. 4th 881, 69 P.3d 473, 134 Cal. Rptr. 2d 634 (2003).

27. 121 Cal. Rptr. 2d at 435.

28. *Id.*

nia Court of Appeal affirmed the dismissal of the defamation and privacy claims on the ground that “no reasonable reader would believe any portion of the depiction arguably relating to appellants as factual,”²⁹ but it reversed the dismissal of the right of publicity claim.³⁰ The California Supreme Court reversed, recognizing that “the right of publicity cannot, consistent with the First Amendment, be a right to control the celebrity’s image by censoring disagreeable portrayals.”³¹

But even when it is fairly obvious that the right of publicity is being used as an alternative to defamation, many courts have permitted such claims to go forward. The facts of *Doe v. TCI Cablevision*,³² for example, are almost identical to those in *Winter*. In *Doe*, Tony Twist, a former professional hockey player known for being an “enforcer,” sued Todd McFarlane, creator of the comic book series *Spawn*, for including in his comic book a fictional Mafia don named Antonio “Tony Twist” Twistelli.³³ McFarlane stated publicly that many of his characters, including Tony Twist, were named after professional hockey players.³⁴ As in *Winter*, the complaint included a defamation claim.³⁵ In an effort to ward off the defamation claim, the defendant argued that no reasonable person would view the comic book as an assertion (factual or otherwise) about the real Tony Twist.³⁶ That argument came back to haunt McFarlane when the Missouri Supreme Court reversed the trial court’s grant of McFarlane’s motion for judgment notwithstanding the verdict and ordered a new trial:

[T]here is . . . an expressive component in the use of [Twist’s] name and identity as a metaphorical reference to tough-guy “enforcers.” And yet, respondents agree (per-

29. *Id.* at 438.

30. *Id.* at 442-43.

31. 30 Cal. 4th at 889, 69 P.3d at 478, 134 Cal. Rptr. 2d at 640 (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 403, 21 P.3d 797, 807, 106 Cal. Rptr. 2d 126, 139 (2001)).

32. 110 S.W.3d 363 (Mo. 2003).

33. *Id.* at 366. The Missouri Supreme Court incorrectly stated that the first name of the character was “Anthony” (Tony Twist’s actual first name) rather than “Antonio.”

34. *Id.* at 366-67.

35. *Id.* at 365.

36. *See Doe v. TCI Cablevision*, 2002 WL 1610972 (Mo. App. 2002), at *3, *rev’d on other grounds*, 110 S.W.3d 363, 367 (Mo. 2003) (“McFarlane denied that the comic book character was ‘about’ the real-life Tony Twist despite the fact that the names were the same.”).

haps to avoid a defamation claim) that the use was not a parody or other expressive comment or a fictionalized account of the real Twist. As such, the metaphorical reference to Twist, though a literary device, has very little literary value compared to its commercial value [U]nder these circumstances, free speech must give way to the right of publicity.³⁷

On retrial the jury awarded Twist \$15 million,³⁸ an amount far in excess of any lost commercial value in the Tony Twist name.³⁹ That the real purpose of Twist's suit was to recover for his loss of dignity and reputational harm is demonstrated by his attorney's statement after the retrial: "They made Tony into a Mafia boss. He was involved in murders and kidnappings and rapes."⁴⁰ McFarlane might have been better off risking the defamation claim, with its well-developed constitutional protections, than being stuck with a right of publicity claim, where the defenses are far more limited.⁴¹

37. 110 S.W.3d at 374. This reasoning places the defendant in a combined defamation and right of publicity suit in a no-win situation: if the use is viewed as an assertion of fact, the defamation claim may survive summary judgment; but if the use is not viewed as an assertion at all, the defendant loses his First Amendment defense to the right of publicity claim.

38. See Peter Shinkle, *Tony Twist Wins \$15 Million Verdict*, ST. LOUIS POST-DISPATCH, July 10, 2004, at 13, available at 2004 WL 84634558. The original jury verdict had been for \$24.5 million. 110 S.W.3d at 365.

39. Indeed, the trial judge had ruled that when McFarlane first used the name, Tony Twist "had no market recognition and 'was earning precisely zero income from endorsements.'" Kevin Strickland, *You Can Call Me Lex*, PICKENS COUNTY HERALD, July 21, 2004, available at <http://theherald.pickens.net/sports/side072104.htm> (last visited Mar. 17, 2004). In the words of one commentator:

McFarlane creates a fictional comic book character who shares a name with a nobody from St. Louis. . . . A few years later, Mr. Nobody becomes a low-watt star, barely known in his own town and completely invisible to most of the nation. The character created by McFarlane is part of an empire that reaches worldwide. For every one person who has heard of Tony Twist the hockey player, there are a thousand who know Tony Twist the Spawn villain. And the courts give millions to the hockey guy? McFarlane should sue the hockey player for degrading the worth of his character by being such a complete whiner.

Id.

40. See Shinkle, *supra* note 38.

41. If the defamation claim had gone forward, Twist would have had to prove that McFarlane's readers understood the comic book to be a statement of fact, that the statements were false, and that they were made with knowledge or in reckless disregard of falsity. By misusing the right of publicity, Twist was able to obtain the same result without having to prove *any* of those elements.

Similarly, in *Newcombe v. Adolph Coors Co.*,⁴² Don Newcombe, a former major league pitcher and recovering alcoholic, sued when a drawing based on a photograph of him pitching in the 1949 World Series was used in a beer advertisement.⁴³ The complaint included claims for defamation, false-light privacy, and intentional infliction of emotional distress.⁴⁴ The Ninth Circuit affirmed summary judgment for the defendants on the merits of those claims,⁴⁵ but it permitted the right of publicity claim to go forward,⁴⁶ despite the lack of any evidence that the defendants were intentionally attempting to capitalize on Newcombe's fame.⁴⁷

Other cases are truly "stealth" defamation claims, in which the reputational interest of the celebrity is less obvious. Vanna White sued when an advertisement for Samsung Electronics poked fun at her by implying that she could be replaced by a robot.⁴⁸ Major League Baseball players sued over parody baseball cards that made fun of their egos and other characteristics.⁴⁹ Muhammad Ali sued when a drawing of him sitting naked in a boxing ring was published in *Playgirl* magazine.⁵⁰ Johnny Carson sued the maker of a portable toilet called "Here's Johnny."⁵¹ None of these cases involved defamatory criticism of the celebrity; but in each case, the defendant used the cultural associations denoted by the

42. 157 F.3d 686 (9th Cir. 1998).

43. *Id.* at 689-90.

44. *Id.*

45. *Id.* at 694-96.

46. *Id.* at 692-94.

47. *Id.* at 696 ("we cannot say that Cassidy copied the photograph with an intent to harm Newcombe. Furthermore, there is no evidence that anyone else associated with the production of the advertisement intended that it portray Newcombe, nor that they were aware that the drawing closely resembled Newcombe.").

48. *See White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir. 1993) (opinion of Kozinski, J., joined by O'Scannlain & Kleinfeld, JJ., dissenting from denial of rehearing en banc). For commentary, *see* David S. Welkowitz, *Catching Smoke, Nailing Jell-O to a Wall: The Vanna White Case and the Limits of Celebrity Rights*, 3 J. INTELL. PROP. L. 67 (1995).

49. *See* *Cardtoons, L.C. v. Major League Baseball Players' Ass'n*, 95 F.3d 959 (10th Cir. 1996).

50. *See Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978).

51. *See Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983). Carson's claim strongly resembled a trademark dilution claim, because Carson used the phrase "Here's Johnny" as an unregistered trademark for restaurants and men's clothing.

celebrity to make a point—a sort of commercial commentary. In each case, what was really at stake was a dignity interest, rather than a strictly commercial interest;⁵² and in all but one of these cases, the celebrity was successful.⁵³

Why are courts as protective as they are of celebrity rights, even when it is fairly obvious that the impetus for the complaint is to control a perceived disparagement, rather than to stop a purely “commercial” exploitative use of the celebrity likeness? In *Doe*, for example, although the defendants disclaimed any intent to comment on the hockey player,⁵⁴ it is obvious that the defendants’ intent was to draw a parallel between the “enforcers” in hockey and those in the Mafia. If the portrayal was defamatory, then *New York Times* should be in the forefront of the analysis, because the plaintiff was a public figure. If it was not defamatory, but merely disparaging, then shouldn’t the First Amendment values guiding *New York Times* protect the right of the defendant to criticize the plaintiff—even unfairly?

The problem in *Doe* and similar cases is that courts have separated the “property” right that the celebrity claims in his or her image from the actual human being whose image is used. Courts too often view these cases as a misappropriation of a plaintiff’s property right solely for commercial purposes, as if the “property” was a copyrighted work that was being duplicated for profit, rather than as a commentary about a person whose celebrity status is legitimately the subject of public scrutiny. In *White*, for example, the court dismissed the First Amendment argument almost out of hand, because Vanna White’s “persona” had been used to help sell a product.⁵⁵ The reality is more complicated. The advertisement in

52. For example, in a subsequent appeal involving *Cardtoons*’ claims for tortious interference with contractual relations and libel, the Tenth Circuit stated that “*Cardtoons* may well be correct in asserting that part of MLBPA’s motivation in threatening legal action was to prevent the production of cards that they believed to be unflattering.” *Cardtoons, L.C. v. Major League Baseball Players’ Ass’n*, 335 F.3d 1161, 1166 (10th Cir. 2003).

53. The exception is *Cardtoons*, in which the Tenth Circuit affirmed a judgment for the creator of the parody baseball cards. *Cardtoons* was unsuccessful, however, in recovering damages from the players for tortious interference with *Cardtoons*’ business. See *Cardtoons*, 335 F.3d at 1164-68.

54. As the Missouri Supreme Court noted, this may have been an attempt to avoid a defamation claim. See *supra* notes 36-37 and accompanying text.

55. See *White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395, 1401 (9th Cir. 1992) (“The ad’s spoof of Vanna White and Wheel of Fortune is subservient

question did not use a picture of Vanna White—it used a robot dressed in a wig and evening gown.⁵⁶ It was making fun of her, saying in effect that a robot could do her job. Isn't it likely that at least part of her motivation in bringing suit was to avenge this perceived slight? Similarly, in the Schwarzenegger case, isn't it obvious from the settlement that his motivation in bringing suit was to remove an unflattering caricature of him from the marketplace?⁵⁷

Certainly the makers of the Schwarzenegger bobblehead doll hoped to make a profit; but the idea behind the doll was also to make a comment about the actor-turned-politician.⁵⁸ Likewise, Samsung hoped to make a profit selling VCRs, but in doing so it took a part of our cultural landscape, poked fun at it, and used it as part of an advertisement. We ought to celebrate, or at least tolerate, such creativity; but instead we allow courts to punish such conduct because it is a “commercial” use. All too often, as soon as something is characterized as a “commercial” use, the court forgets about other aspects of the use and brushes off First Amendment concerns. In cases like *White*, that is a serious error. To characterize that case simply as a commercial misappropriation is too facile. What courts need to recognize is that a celebrity image conjures up the celebrity (and all of his or her attendant personality traits and connotations) as a subject for legitimate comment; it is not just some separable, tangible creation of the celebrity.

One may argue, as the *Doe* court held, that the Supreme Court recognizes differences between the right of publicity and defamation that make the former not subject to the same constitutional restrictions as the latter. But that argument, based on the Court's sole right of publicity case—*Zacchini v. Scripps-Howard Broadcasting Co.*⁵⁹—ignores the language and context of *Zacchini*. As the majority repeatedly emphasized, *Zacchini* involved a claim that the broadcaster appropriated the plaintiff's “entire act” by broadcasting it on a news

and only tangentially related to the ad's primary message: ‘buy Samsung VCRs.’ Defendants' parody arguments are better addressed to non-commercial parodies. The difference between a ‘parody’ and a ‘knock-off’ is the difference between fun and profit.”)

56. *Id.* at 1396.

57. *See supra* notes 13-20 and accompanying text.

58. *See Introduction and Statement of Facts, supra* note 14, at 551 & n.34.

59. 433 U.S. 562 (1977).

program.⁶⁰ The majority explained its holding almost entirely in terms of economic harm:

[T]he broadcast of petitioner's entire performance, unlike the unauthorized use of another's name for purposes of trade . . . goes to the heart of petitioner's ability to earn a living as an entertainer. Thus, in this case, Ohio has recognized what may be the strongest case for a "right of publicity" involving, not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.⁶¹

It is true that the Court distinguished its defamation cases (notably *New York Times, Co. v. Sullivan*⁶² and *Time, Inc. v. Hill*⁶³); but the Court's distinction was based on an understanding of the role of rights of publicity that does not fit the "commercial commentary" or "stealth defamation" cases. The Court in *Zacchini* described the state interests in providing different forms of protection to plaintiffs as follows:

The interest protected in permitting recovery for placing the plaintiff in a false light is clearly that of reputation, with the same overtones of mental distress as in defamation. By contrast, 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. . . . [This] interest 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 *and having little to do with protecting feelings or reputation*. Second, the two torts differ in the degree to which they intrude on dissemination of information to the public. In [defamation and] false light cases the only way to protect the interests involved is to attempt to minimize publication of the damaging matter, while in right of publicity cases the only

60. *Id.* at 569 ("His complaint is that respondent filmed his entire act and displayed that film on television for the public to see and enjoy. This, he claimed, was an appropriation of his professional property."); *see also id.* at 575 ("[t]he First and Fourteenth Amendments do not immunize the media when they broadcast a performer's entire act without his consent."); *id.* at 575 ("The broadcast of a film of petitioner's entire act poses a substantial threat to the economic value of that performance.").

61. *Id.* at 576.

62. 376 U.S. 254 (1964).

63. 385 U.S. 374 (1967).

question is who gets to do the publishing.⁶⁴

Even if that accurately described Mr. Zacchini's situation, it surely is not an accurate description of the cases brought in *Winter* or *Doe*, nor the case brought by Governor Schwarzenegger. In each of those cases, the principal purpose of the suit was to enjoin and punish publication of speech that offended the plaintiff, rather than to vindicate primarily commercial interests. Even cases such as *White*, *Carson*, and *Newcombe*, while based on a "commercial" use of the individual's identity, cannot be said to have little to do with protecting feelings or reputation. The additional element of critical commentary and/or dignity, whether denominated "commercial" or "expressive," makes these cases distinguishable from *Zacchini* and demands a higher level of scrutiny than the minimal levels often seen in these cases.

III. WHY EXISTING FIRST AMENDMENT STANDARDS ARE FLAWED

In the past fifteen years, courts have propounded various tests for "balancing" rights of publicity and the First Amendment. Three principal tests have emerged, all of which purport to allow sufficient breathing room for free expression while protecting celebrity rights. But even these relatively sophisticated analyses are flawed, because they allow celebrities, politicians and other public figures to censor non-defamatory speech without any corresponding public benefit.

A. *The Rogers Standard*

In *Rogers v. Grimaldi*,⁶⁵ the Second Circuit considered a claim by actress Ginger Rogers against the producers of a movie entitled *Ginger and Fred*.⁶⁶ The movie was not a documentary about the famous dancing partnership of Rogers and Fred Astaire; it was a fictional film about a pair of Italian cabaret dancers who had acquired the nicknames "Ginger and Fred" because in their heyday they had imitated Rogers and Astaire.⁶⁷ The Second Circuit held that "[i]n the context of al-

64. 433 U.S. at 573 (internal quotations and citations omitted) (emphasis added).

65. 875 F.2d 994 (2nd Cir. 1989).

66. GINGER AND FRED (MGM/UA 1986) (directed by Federico Fellini, starring Giulietta Masina and Marcello Mastroianni).

67. 875 F.2d at 996-97.

legedly misleading titles using a celebrity's name," neither the Lanham Act nor Oregon's right of publicity law was violated "unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work."⁶⁸

The *Rogers* standard can be justified for titles of artistic works on the ground that the public has an interest in avoiding consumer confusion that must be balanced against the public interest in free expression.⁶⁹ It is well-settled that non-defamatory books and movies about celebrities may be made without the celebrity's permission,⁷⁰ so the mere presence of a celebrity's name in the title of a work does not by itself falsely suggest endorsement of that work by the celebrity.⁷¹ However, the presence of a celebrity's name in the title of a work probably does lead to a reasonable expectation that the work has *something* to do with the celebrity, so enforcing that expectation serves the government's interest in avoiding consumer deception.⁷²

68. *Id.* at 999 (Lanham Act); *see also id.* at 1004 (finding no violation of the right of publicity "unless the title was wholly unrelated to the movie or was 'simply a disguised commercial advertisement for the sale of goods or services.'").

69. *Id.* at 999 (Lanham Act), 1004 (right of publicity).

70. *See, e.g.,* Guglielmi v. Spelling-Goldberg Prods., 25 Cal. 3d 860, 862, 603 P.3d 454, 455, 160 Cal. Rptr. 352, 353 (1979) (Bird, C.J. concurring) (concerning a fictionalized television biography of actor Rudolph Valentino); Hicks v. Casablanca Records, 464 F. Supp. 426 (S.D.N.Y. 1978) (concerning a fictionalized book and movie about mystery writer Agatha Christie); Taylor v. National Broadcasting Co., 22 Media L. Rep. (BNA) 2433, 1994 WL 780690 (Cal. Super. Ct. 1994) (unpublished) (concerning a television biography of actress Elizabeth Taylor); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47, cmt. c (1995) ("[T]he 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."); *see also* Tyne v. Time Warner Entm't Co., 901 So.2d 802 (Fla. 2005) (concerning a right of publicity claim on behalf of heirs of persons depicted in motion picture THE PERFECT STORM (Warner Bros. 2000); construing Florida statute narrowly to avoid First Amendment difficulties).

71. *Rogers*, 875 F.2d at 999-1000. The Court stated that "[i]n these circumstances, the slight risk that such use of a celebrity's name might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression." *Id.* at 1000 (citing "the hit song 'Bette Davis Eyes' and the recent film 'Come Back to the Five and Dime, Jimmy Dean, Jimmy Dean.'").

72. *See, e.g.,* Parks v. LaFace Records, 329 F.3d 437, 451-58, 461 (6th Cir. 2003) (concerning a suit by civil rights icon Rosa Parks against rap group that

The problem arises when the *Rogers* standard is applied not to the use of a celebrity's name in the title of an artistic work, but to the use of the celebrity's likeness in the work itself. For example, in *ETW Corp. v. Jireh Publishing, Inc.*,⁷³ the Sixth Circuit analyzed a claim that making and selling lithographs of a painting of Tiger Woods violated his right of publicity in part by asking whether "the presence of Woods' image in Rush's painting . . . [had] artistic relevance to the underlying work."⁷⁴ In such a situation, the phrase "artistic relevance" is devoid of meaning. Relevance is a relational concept; it is used to describe the relationship between one thing and another.⁷⁵ In the context of titles, "artistic relevance" describes the relationship of the title to the underlying work. But asking whether part of a work has artistic relevance to the work itself is nonsensical: the work is what it is, and removing any portion of it would create a different work. Such a test is also an invitation to censorship, as it invites the judge to choose a single "meaning" from among the myriad of possible meanings of an artistic work and to excise those portions of the work which in his or her own view are not sufficiently related to that meaning.⁷⁶

B. *The Saderup Standard*

In *Comedy III Prods. v. Gary Saderup, Inc.*,⁷⁷ the Califor-

used her name as the title of one of its songs; finding triable issue of fact as to whether her name had any artistic relevance to the song); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47, cmt. c (1995) ("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 the use of the other's identity in advertising.").

73. 332 F.3d 915 (6th Cir. 2003). For background on the case, see Tyler T. Ochoa, *Introduction: Tiger Woods and the First Amendment*, 22 WHITTIER L. REV. 381 (2000); Diane Leenheer Zimmerman, *Amicus Curiae Brief of Seventy-Three Law Professors in Support of Jireh Publishing, Inc.*, 22 WHITTIER L. REV. 391 (2000).

74. 332 F.3d at 937.

75. See, e.g., FED. R. EVID. 401 advisory committee's notes ("Relevancy is not an inherent characteristic of any item of evidence but exists only as a relation between an item of evidence and a matter properly provable in the case.").

76. Modern artistic theory holds that a work of art does not have any objective meaning, but only whatever subjective meaning that it stimulates in the mind of the beholder; and that the subjective intention of the artist is neither possible to determine nor meaningful in assessing the artistic success of the work. See Tyler T. Ochoa, *Dr. Seuss, The Juice and Fair Use: How the Grinch Silenced a Parody*, 45 J. COPYRIGHT. SOC'Y U.S. 546, 557 & nn.53-54 (1998).

77. 25 Cal. 4th 387, 21 P.3d 797, 106 Cal. Rptr. 2d 126 (2001).

nia Supreme Court was faced with a claim that reproductions of a charcoal drawing of the Three Stooges violated their post-mortem right of publicity. The court first considered and rejected several proffered reasons why the First Amendment should not be deemed to protect the defendant's work. First, the court held that "although [Saderup's] work was done for financial gain, the First Amendment is not limited to those who publish without charge. An expressive activity does not lose its constitutional protection because it is undertaken for profit."⁷⁸ Second, "[n]or do Saderup's creations lose their constitutional protections because they are for purposes of entertaining rather than informing."⁷⁹ Third, "[n]or does the fact that expression takes a form of nonverbal, visual representation remove it from the ambit of First Amendment protection."⁸⁰ Fourth, "a work of art is protected by the First Amendment even if it conveys no discernable message"⁸¹ Fifth, "[n]or does the fact that Saderup's art appears in large part on a less conventional avenue of communications, T-shirts, result in reduced First Amendment protection."⁸² Sixth, the court held that "a reproduction . . . is entitled to as much First Amendment protection as an original work of art."⁸³

Nonetheless, the court held that Saderup's lithographs and t-shirts were not protected by the First Amendment because of a countervailing government interest:

[S]ociety may recognize . . . that a celebrity's heirs and assigns have a legitimate protectible interest in exploiting the value to be obtained from merchandising the celebrity's image, whether that interest be conceived as a kind of natural property right or as an incentive for encouraging creative work. Although critics have questioned whether the right of publicity truly serves any social purpose, there is no question that the Legislature has a *rational basis* for permitting celebrities and their heirs to

78. *Id.* at 396, 21 P.3d at 802, 106 Cal. Rptr. 2d at 133 (internal brackets, quotes, and ellipses omitted).

79. *Id.* at 398, 21 P.3d at 804, 106 Cal. Rptr. 2d at 134.

80. *Id.*, 21 P.3d at 804, 106 Cal. Rptr. 2d at 134.

81. *Id.*; *see* *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston, Inc.*, 515 U.S. 557, 569 (1995) ("[a] narrow, succinctly articulable message is not a condition of constitutional protection").

82. 25 Cal. 4th at 399, 21 P.3d at 804, 106 Cal. Rptr. 2d at 135.

83. *Id.* at 408, 21 P.3d at 810, 106 Cal. Rptr. 2d at 142.

control the commercial exploitation of the celebrity's likeness.⁸⁴

The fact that the Legislature may have a rational basis for protecting rights of publicity, however, does not explain why the state's interest should overcome the expressive interest in a work of art such as that at issue in *Saderup*. In particular, the court made no attempt to explain why the traditional content-based tests of the First Amendment should not apply.⁸⁵ In other contexts, of course, it is hornbook law that a court must subject a content-based speech restriction to strict scrutiny,⁸⁶ meaning the law must be the least restrictive means necessary to accomplish a compelling government interest.⁸⁷ Even content-neutral speech restrictions must meet intermediate scrutiny: the restriction must be narrowly tailored to further a substantial government interest.⁸⁸ Instead of applying one of these speech-protective tests, the court ignored the First Amendment interest almost entirely and gave the right of publicity the deferential review applicable to ordinary economic regulation of conduct that does not have an expressive component.

The standard the court adopted to "distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity"⁸⁹ was a "transformative use" test,⁹⁰ borrowed from case law ap-

84. *Id.* at 400, 21 P.3d at 805, 106 Cal. Rptr. 2d at 136 (internal citations omitted) (emphasis added).

85. When the right of publicity is used to preclude particular expression (e.g., a particular likeness of a celebrity), it should be deemed a "content-based" restriction. It is difficult to describe such a case as simply a content-neutral "time, place, and manner" restriction, unless the word "manner" is defined rather expansively. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 971 (10th Cir. 1996) ("Restrictions on the words or images that may be used by a speaker . . . are quite different than restrictions on the time, place, or manner of speech.") (quoting *Rogers*, 875 F.2d at 999).

86. See *Turner Broad. Sys. v. F.C.C.*, 512 U.S. 622, 642 (1994).

87. See *Los Angeles v. Alameda Books, Inc.*, 535 U.S. 425, 455 (2002); *Perry Education Ass'n v. Perry Local Educators' Ass'n*, 460 U.S. 37, 45 (1983).

88. *Turner*, 512 U.S. at 662.

89. *Comedy III Prods.*, 25 Cal. 4th at 403, 21 P.3d at 807, 106 Cal. Rptr. 2d at 139.

90. *Id.* at 404-07, 21 P.3d at 807-10, 106 Cal. Rptr. 2d at 139-42. The Court repeated the word "transformative" thirteen times in those three pages (and three more times in subsequently applying the test), both by itself and in such phrases as "transformative work," "significant transformative elements," and "transformative test."

plying the fair use doctrine in copyright law⁹¹:

As the Supreme Court has stated, the central purpose of the inquiry . . . is to see . . . whether the new work merely supersedes 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 message⁹²

Elaborating on this standard, the court opined:

When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain . . . the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.⁹³

The *Saderup* court's conclusion is flawed for at least two reasons. First, in uncritically adopting a standard from copyright law, the court ignored the fact that copyright has a specific Constitutional authorization,⁹⁴ adopted only four years before the Bill of Rights, leading to the reasonable inference that the Framers must have believed copyright was consistent with the First Amendment.⁹⁵ The right of publicity, by contrast, has no such pedigree; rather, it was invented more than 160 years after the First Amendment was adopted,⁹⁶ is

91. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

92. *Comedy III Prods.*, 25 Cal. 4th at 404, 21 P.3d at 808, 106 Cal. Rptr. 2d at 139 (internal quotes and brackets omitted).

93. *Id.* at 405, 21 P.3d at 808, 106 Cal. Rptr. 2d at 140.

94. See U.S. CONST. art. I, § 8, cl. 8 ("The Congress shall have Power . . . To Promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."). For the historical background of the Clause, see Tyler T. Ochoa & Mark Rose, *The Anti-Monopoly Origins of the Patent and Copyright Clause*, 49 J. COPYRIGHT SOC'Y U.S. 675 (2002).

95. See generally L. Ray Patterson & Craig Joyce, *Copyright in 1791: An Essay Concerning the Founders' View of the Copyright Power Granted to Congress in Article I, Section 8, Clause 8 of the U.S. Constitution*, 52 EMORY L.J. 909 (2003). As numerous authors have pointed out, however, in 1791 copyright consisted only of a right to prohibit reproduction, and it is the broad right to prepare derivative works, added later, that creates serious First Amendment problems. See, e.g., Jed Rubenfeld, *The Freedom of Imagination: Copyright's Constitutionality*, 112 YALE L.J. 1, 48-59 (2002); Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 38 (2001); Lawrence Lessig, *Copyright's First Amendment*, 48 U.C.L.A. L. REV. 1057, 1061-62 (2001).

96. See *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2nd Cir. 1953). The right of publicity evolved from the right of privacy, which was first recognized approximately fifty years earlier. See *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190, 50 S.E. 68 (1905). However, prior to *Haelan Labs*, the right of privacy was generally not deemed to outweigh the

not enshrined in the Constitution, and should not be deemed to have reduced the First Amendment's scope of protection.⁹⁷ Second, and more importantly, *Saderup's* "transformative use" standard contradicts two of the First Amendment principles that the court had endorsed earlier in its opinion. The *Saderup* court stated that "a work of art is protected by the First Amendment even if it conveys no discernable message,"⁹⁸ yet its standard expressly inquires whether the defendant added "new expression, meaning, or message."⁹⁹ The court also correctly stated that "[a]n expressive activity does not lose its constitutional protection because it is undertaken for profit,"¹⁰⁰ yet its standard expressly turns on whether the "artistic expression takes the form of a literal depiction or

First Amendment in cases involving public figures. See *O'Brien v. Pabst Sales Co.*, 124 F.2d 167 (5th Cir. 1941). Note that there was a preexisting exception for false endorsement cases in which the government's interest in preventing consumer deception was also implicated. See, e.g., *Edison v. Edison Polyform Mfg. Co.*, 73 N.J. Eq. 136, 67 A. 392 (N.J. Ch. 1907).

97. While we may tolerate some limits on freedom of speech in order to enjoy the speech-generating incentive provided by copyright law, the right of publicity does not provide a similar public benefit, except in advertising cases involving false endorsement. See *Cardtoons*, 95 F.3d at 973-76 (criticizing and limiting various rationales for the right of publicity); see also Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 178-215 (1993). This is evidenced by the fact that countries such as the United Kingdom that lack a right of publicity have no shortage of celebrities. See *Irvine v. Talksport, Ltd.*, 2 All E.R. 414 (Ch. 2002) (holding that an action for "passing off" is available in a false endorsement case, but not in a character merchandising case), *aff'd*, 2 All E.R. 881 (C.A. 2003); cf. *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013, 1023-24 (C.D. Cal. 1998) (finding there is no right of publicity in U.K.), *aff'd mem.* 216 F.3d 1082 (9th Cir. 2000), *on appeal after remand*, 292 F.3d 1139 (9th Cir. 2002) (affirming denial of relief against sale of merchandise featuring likeness of Diana, Princess of Wales). Moreover, even if a state legislature were to decide otherwise, that judgment should not be free from the heightened scrutiny applied in other First Amendment contexts. See *supra* discussion at notes 85-88 and accompanying text.

98. *Comedy III Prods.*, 25 Cal. 4th at 399, 21 P.3d at 804, 106 Cal. Rptr. 2d at 135.

99. *Id.* at 404, 21 P.3d at 808, 106 Cal. Rptr. 2d at 139. While "expression" is not necessarily synonymous with "meaning or message," the court explained that "when we use the word 'expression,' we mean expression of something other than the likeness of the celebrity," *id.* at 406, 21 P.3d at 809, 106 Cal. Rptr. 2d at 141 and the examples the court gave of protected expression all involved works with a discernable message. *Id.* ("We emphasize that the transformative elements or creative contributions . . . are not confined to parody and can take many forms, from factual reporting to fictionalized portrayal, from heavy-handed lampooning to subtle social criticism.") (citations omitted).

100. *Id.* at 396, 21 P.3d at 802, 106 Cal. Rptr. 2d at 133 (internal brackets and quotes omitted).

imitation of a celebrity *for commercial gain*.”¹⁰¹

In a society that values freedom of speech, the government has no business telling artists that they are forbidden to depict a public figure (and to sell such depictions to others) without that person’s permission.¹⁰² While *Saderup* is more protective of speech than many previous cases, its self-contradictory opinion relegates drawings, photographs, and sculptures of celebrities to the category of non-expressive commercial conduct, subject to regulation at the whim of the Legislature, instead of treating them as artistic speech protected against censorship by the First Amendment.

C. *The Doe Standard*

In *Doe v. TCI Cablevision*,¹⁰³ (the “Tony Twist” case¹⁰⁴), the Missouri Supreme Court reversed a trial court ruling in favor of the defendants. In doing so, the Court expressly rejected both the “relatedness” test endorsed by the Restatement¹⁰⁵ (a test similar to the “artistic relevance” standard of *Rogers*¹⁰⁶) and the “transformative use” test of *Saderup*,¹⁰⁷ because “they give too little consideration to the fact that many uses of a person’s name and identity have both expressive and commercial components.”¹⁰⁸ Instead, the court endorsed a “predominant use” test borrowed from a law review article¹⁰⁹ (written by a litigator who represents celebrities and celebrity

101. *Id.* at 405, 21 P.3d at 808, 106 Cal. Rptr. 2d at 140 (emphasis added).

102. The exception to this principle is advertising in which the unauthorized use of a celebrity image creates a likelihood of confusion as to sponsorship or endorsement by the celebrity. It is well-established that government may prohibit false and misleading commercial speech without running afoul of the First Amendment. But a lithograph or a bobblehead doll is not commercial speech, which is defined as speech that “does no more than propose a commercial transaction.” *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001) (quoting *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66 (1983)). Certainly no reasonable person would have believed that the Schwarzenegger bobblehead doll was sponsored or endorsed by the Governor.

103. 110 S.W.3d 363 (Mo. 2003).

104. For the facts of the case, see *supra* notes 32-41 and accompanying text.

105. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47, cmt. c (1995) (“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.”).

106. See discussion *supra* Part III.A.

107. See discussion *supra* Part III.B.

108. 110 S.W.3d at 374.

109. Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity—Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471 (2003).

estates¹¹⁰):

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.¹¹¹

This test is even more flawed than the *Saderup* standard. The U.S. Supreme Court has held that whether speech is sold for profit is legally irrelevant to whether it receives protection under the First Amendment,¹¹² yet *Doe* holds that a profit motive can disqualify speech from First Amendment protection.¹¹³ Under this standard, a movie biography of a celebrity could be enjoined, because the "predominant" purpose of most movies is simply to make money for the movie studio. The *Doe* test also expressly permits a court to enjoin speech *even if* it finds that the speech has expressive content. Virtually all published speech has both an expressive and a commercial component, so this test would in effect give a court *carte blanche* to censor speech at the behest of a celebrity, based solely on the court's personal view of the relative value of the speech.

IV. CONCLUSION

Rights of publicity create difficult problems for freedom of expression. All too often, the use of a non-traditional medium of expression (in the First Amendment sense) and the existence of a "commercial" motive have caused many courts to lose sight of the core values at stake. As we have seen, the tests that courts have devised to account for the value of free

110. See profile of Mark S. Lee, Manatt, Phelps & Phillips, <http://www.manatt.com/showresume.asp?id=1334> (last visited Mar. 16, 2005). Lee has represented management companies for, among others, Elvis Presley, John Wayne, Jimi Hendrix, Arnold Palmer, Gene Autry, and Diana, Princess of Wales. *Id.*

111. 110 S.W.3d at 374 (*quoting* Lee, *supra* note 109, at 500).

112. See *e.g.*, Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495, 501-02 (1952); Time, Inc. v. Hill, 385 U.S. 374, 397 (1967).

113. See 110 S.W.3d at 375 (requiring a jury instruction that defendant "intended to obtain a commercial advantage" from the use of the plaintiff's name).

expression in right of publicity cases range from the somewhat protective, yet flawed (*Saderup*¹¹⁴), to the confusing (*ETW's* use of *Rogers v. Grimaldi*¹¹⁵), to the excessively indulgent of a celebrity's assertion of the "commercial" motive of the expression (*Doe*¹¹⁶ and *White*¹¹⁷). The defects in these tests have larger implications that resonate in the Schwarzenegger bobblehead case. First, they create uncertainty and inconsistency about the ability to make unauthorized expressive uses of a celebrity's image or "persona."¹¹⁸ Second, the generally looser First Amendment scrutiny given to right of publicity claims has encouraged celebrities to attempt to censor uses of their images that the celebrities deem less than positive—leading to the problem of "stealth defamation" claims. The combination of these two problems ultimately has a stultifying effect on freedom of expression concerning a celebrity.

One of the few unsuccessful stealth defamation, or commercial commentary, cases is instructive here. *Cardtoons, L.C. v. Major League Baseball Players Ass'n*¹¹⁹ involved parody baseball trading cards featuring caricatures of major league players and humorous, though often critical, commentaries on the caricatures on the reverse side of the cards. The players sued, alleging violations of their rights of publicity under Oklahoma law.¹²⁰ The district court dismissed the claim, and the Tenth Circuit affirmed.¹²¹ In its opinion, the court of appeals wrote that:

elevating the right of publicity above the right to free ex-

114. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 21 P.3d 797, 106 Cal. Rptr. 2d 126 (2001); discussion *supra* Part II.B.

115. See 332 F.3d 915 (6th Cir. 2003); discussion *supra* Part II.A.

116. See 110 S.W. 3d 363 (Mo. 2003); discussion *supra* Part II.B.

117. See 971 F.2d 1512 (9th Cir. 1993); discussion *supra* pp. 658-59.

118. This uncertainty is exacerbated by the choice of law problem for an expressive work that is being sold nationwide. While most courts now agree that the *existence* of a right of publicity is determined by the law of the plaintiff's domicile, *see, e.g.*, *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1146-47 (9th Cir. 2002), it is far from clear that a single state's law should govern *infringement* of the right of publicity in every state. See *Factors, Etc. Inc. v. Pro Arts, Inc.*, 652 F.2d 278, 281 (2nd Cir. 1981) (expressing doubt on this issue); *Schumann v. Loew's, Inc.*, 135 N.Y.S.2d 361 (N.Y. Sup. Ct. 1954) (discussing sixty-one causes of action, one for each state and several territories and foreign countries).

119. 95 F.3d 959 (10th Cir. 1996).

120. The complaint also alleged a violation of the Lanham Act. The court easily dismissed that claim, finding no likelihood of confusion between the parody cards and actual, authorized cards. *Id.* at 966-67.

121. *Id.* at 962.

pression would likely prevent distribution of the parody trading cards. This would not only allow [the Players' Association] to censor criticism of its members, but would also have a chilling effect upon future celebrity parodies. Such a result is clearly undesirable, for "the last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them."¹²²

Surely this is what the Supreme Court had in mind in *New York Times v. Sullivan* when it said:

A rule compelling the critic of official conduct to guarantee the truth of all his factual assertions . . . leads to . . . 'self censorship.' . . . Under such a rule, would-be critics of official conduct may be deterred from voicing their criticism The rule thus dampens the vigor and limits the variety of public debate. It is inconsistent with the First and Fourteenth Amendments.¹²³

The consequences of using a lax and inconsistent standard are at the heart of the Schwarzenegger bobblehead case. The most serious problem exposed by the Schwarzenegger lawsuit is that it was brought at all. Although Governor Schwarzenegger faced an uphill battle under California law,¹²⁴ the California Supreme Court has thus far only decided cases near the edges of its test—the fairly unembellished likeness in *Saderup* and the grotesque transformation in *Winter*—and the bobblehead fell somewhere in between. In *Winter*, the California Supreme Court admonished lower courts to dismiss obvious cases at the pleading stage.¹²⁵ However, as the bobblehead case demonstrates, where a celebrity has sufficient resources, a colorable, if perhaps weak, lawsuit can still be filed, and a commercial commentator or detractor may be deterred from litigating (factoring in the inevitable expense of

122. *Id.* at 972-73, (quoting *White v. Samsung Elecs. America, Inc.*, 989 F.2d 1512, 1519 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc)).

123. *New York Times v. Sullivan*, 376 U.S. 254, 279 (1964).

124. A California state court would have applied the "transformative" test of *Saderup* and *Winter*. Under this test, the defendants would have had a strong argument that the gun and bandolier "transformed" the Governor's image from a straightforward celebrity image (such as that in *Saderup*) to a critical commentary (such as that in *Winter*). But because the *Saderup* test is an interpretation of the First Amendment, a federal district court would not be bound to apply *Saderup*, even to a case arising under California law.

125. *Winter*, 30 Cal. 4th at 892, 69 P.3d at 480, 134 Cal. Rptr. 2d at 642.

an appeal, regardless of the outcome in the trial court). Thus, even the transformative use test does not send a sufficiently clear message that a celebrity cannot control unwanted commentary. The settlement, which permitted the sale of the doll *sans* weapons, suppressed the very expression that led to the doll's creation.¹²⁶ As the Supreme Court noted in another context, it is not just the successful suit that can chill desirable activity; the threat of a suit can be equally effective, even if the suit would likely lose.¹²⁷

The ultimate failure of the legal framework in the Schwarzenegger case is that the settlement "transformed" a piece of political satire (the original bobblehead doll) into something far more akin to an item of commerce by removing its most transformative expressive elements. A test designed to protect freedom of speech was instead used to subvert it. It should be apparent that a legal standard that effectively allows a political figure to censor non-defamatory political speech is hardly an appropriate role for the First Amendment.

126. As noted in the Statement of Facts, the alleged creator of the doll did not participate in the settlement because of the elimination of the expression, and he is now using a different Schwarzenegger doll to criticize the Governor. *Introduction and Statement of Facts*, *supra* note 14, at 554.

127. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000), in which the Supreme Court stated: "Competition is deterred, however, not merely by successful suit but by the plausible threat of successful suit." The same could be said of speech.
