

THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



THE CONFLICT BETWEEN AN ATHLETE'S RIGHT OF PUBLICITY AND THE FIRST AMENDMENT

EDWARD KUESTER

ABSTRACT

The recent rise of fantasy sports has created a conflict between an athlete's right of publicity and the First Amendment of the Constitution. The legal question being discussed is whether athletes have a right of publicity in their identity, specifically their performance statistics and biographical information. If a right of publicity violation does exist, courts will have to determine whether a fantasy provider's First Amendment privilege can prevail against an athlete's publicity rights. This comment examines recent litigation surrounding athletes' identities and the problems courts have in balancing the conflict between an athlete's right of publicity and the First Amendment. This comment proposes the creation of a federal right of publicity statute for equity and continuity.

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Cite as Edward Kuester, *The Conflict Between an Athlete's Right of Publicity and the First Amendment*, 15 J. MARSHALL REV. INTELL. PROP. L. 117 (2015).

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I. INTRODUCTION

Throughout time athletes have always been revered as symbols of strength, precision, and perfection. The fame of their symbol represents that individual athlete's commercial value. Traditionally that value relates to a player's skill level. Technology has evolved quickly to where each athlete's identity can be used as a part of a whole system, such as the expanding industry of fantasy football.¹

Recent litigation surrounding this topic raises questions of the strength of a First Amendment defense when violating an athlete's right of publicity.² This debate has been made economically relevant by the expansion of the fantasy football industry and its promotion of athletes as individual performers.³ Also, courts have issued conflicting holdings regarding the use of collegiate athletes' identities in video games.⁴

The legal question being debated is whether athletes have a right of publicity in their identity, including their performance statistics and biographical information.⁵ Then the issue becomes whether fantasy providers or other companies can use a player's name and statistics without violating that player's right of publicity.⁶ Finally, if a right of publicity violation does exist, courts will have to determine whether a user's First Amendment privilege can prevail against an athlete's publicity rights.⁷

This article will discuss the history and rise of fantasy sports in conjunction with the right of publicity. Next, it will outline right of publicity under the common law and its intersection with the First Amendment. The article will additionally analyze recent litigation surrounding athletes' identities and the problems courts have in balancing the right of publicity with the First Amendment. Finally, this article will propose the creation of a federal right of publicity statute and further protection for athletes having

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¹ See generally Richard T. Karcher, *The Use of Players' Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 PENN ST. L. REV. 557 (2007).

² See *id.*

³ See Complaint, *CBS Interactive Inc. v. Nat'l Football League Players Ass'n*, 259 F.R.D. 398 (D. Minn. filed Sept. 3, 2008).

⁴ See, Gina Ilardi, *First Amendment v. The Right Of Publicity: The Game Is On!*, The Metropolitan Corporate Counsel, Aug. 20, 2012, <http://www.metrocorpocounsel.com/articles/20189/first-amendment-v-right-publicity-game>.

⁵ Richard T. Karcher, *The Use of Players' Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 PENN ST. L. REV. 557 (2007).

⁶ See *id.*

⁷ See *id.*

their identities misappropriated without their consent to another's significant commercial advantage.

II. BACKGROUND

A. History of Fantasy Football

In 1980, Daniel Okrent and some friends founded the first fantasy league and it was focused on the sport of baseball.⁸ The birth of the Internet led to an exponential social and economic growth of the fantasy industry.⁹ Online fantasy sports providers have since expanded the industry to include football, basketball, hockey and other sports.¹⁰ A member of a fantasy league acts as a manager for his team.¹¹ A manager is likely to select athletes who are valuable members in their professional leagues, such as a baseball player with a high batting average or a football player who scores touchdowns.¹² Since fantasy leagues directly relate to their respective professional leagues, the scoring can uniformly be based off a player's game-time statistics.¹³

Players' unions recognized the commercial opportunity being created by the expanding fantasy industry and they negotiated licensing agreements that granted fantasy providers use of the unions' professional athletes' information.¹⁴ The fantasy

⁸ Gary P. Quiming, *Playing by the Rules of Intellectual Property: Fantasy Baseball's Fight to Use Major League Baseball Players' Names and Statistics*, 29 U. HAW L. REV. 301, 304 (2006) (citing Chris Colston, *Revisiting Roto's Roots*, USA Today Baseball Weekly, Dec. 8, 1999, <http://www.usatoday.com/sports/bbw/2001-04-04/2001-04-04-archive-roto.htm>). See also, Allan M. Johnson, *The Right of Publicity Gets Left out in CBC Distribution & Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*, 14 Sports L.J. 71, 72 (2007) (claims there are different stories about where Okrent got the idea from, but attributes him as the founder).

⁹ Press Release, Fantasy Sports Trade Ass'n, *Fantasy Sports Conference Demographic Survey Shows Continued Growth* (Aug. 2, 2007), available at <http://www.prweb.com/releases/2007/08/prweb543818.htm>.

¹⁰ See generally *CBS Interactive Inc. v. Nat'l Football League Players Ass'n*, 259 F.R.D. 398 (D. Minn. 2009); see also Ben Klayman, *Technology Spurs Growth of Fantasy Sports in U.S.*, REUTERS, (Sept. 25, 2008) (<http://www.reuters.com/article/us-fantasysportsussports-idUSTRE48002L20080925#i3FZOLtxPrA5iYvW.97>).

¹¹ See, e.g., Yahoo! Help Page, <https://help.yahoo.com/kb/fantasy-football/play-yahoo-sports-fantasy-football-sln24152.html>. Essentially, you join a league with a select group of friends. Then as manager, you make decisions that affect the outcome of your team. It begins with a draft, where each manager takes turns selecting from a pool of available players based on the athlete's projected statistical output. Then through the season you make decisions as a manager to start, sit, drop, add, or even trade the athletes on your team. In effect, you own control over that player's relevance to your team. Managers compete in head-to-head match ups and winner has the highest point total based on their players' performances. Players score points based on their statistical outputs, which are valued differently depending on your league's scoring system. Finally at the end of the year there is a playoff, and a winner of the league is determined for bragging rights and even sometimes prize money.

¹² *Id.*

¹³ See Adam L. Sheps, *Swinging for the Fences: The Fallacy in Assigning Ownership to Sports Statistics and its Effect on Fantasy Sports*, 38 CONN L. REV. 1113, 1114 (2006).

¹⁴ See *CBS Interactive Inc. v. Nat'l Football League Players Ass'n*, 259 F.R.D. 398 (D. Minn. 2009) (decided athlete information was an athlete's name, likeness, pictures, voices, or biographical information).

providers sell advertising space on their websites to cover the cost of licensing fees and costs of operating.¹⁵

The industry generates nearly two billion dollars for fantasy providers and even increases revenue on merchandise such as video games and television packages.¹⁶ Fantasy providers pay the licensing fees to players' unions in exchange for the right to use the players' names and statistics.¹⁷ In 2006, Yahoo! paid the Major League Baseball Players Association three million dollars in licensing fees.¹⁸ The professional athletes are then given a direct portion of the licensing income received by the association.¹⁹ Players' associations have threatened to sue fantasy providers in the past for using athlete information without the consent of the association or the athlete.²⁰

The associations have argued that misuse of their athletes' information clearly violates the athletes' right of publicity.²¹ Recently, litigation on the right of publicity has led to the allowance of some fantasy providers to use athlete information without fulfilling a licensing agreement.²²

B. Right of Publicity

The main issue at hand is whether athletes have a right of publicity in their name, likeness, performance statistics and biographical information.²³ The right of publicity stems from the common law right of privacy²⁴ and is governed by state statute and

¹⁵ See *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007).

¹⁶ See Allan M. Johnson, *The Right of Publicity Gets Left out in CBC Distribution & Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*, 14 SPORTS L.J. 71, 72 (2007).

¹⁷ See Richard T. Karcher, *The Use of Players' Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 PENN ST. L. REV. 557 (2007). Fantasy providers pay the players' unions instead of the players because typically the professional athletes have assigned their licensing rights to the players' association.

¹⁸ Jeff Passan, *The Reality of Fantasy*, YAHOO SPORTS, (April 20, 2006) (reporting that "Yahoo!, which runs free and pay leagues and is the Internet's largest fantasy sports site, pays MLBAM a licensing fee of around \$3 million per year.").

¹⁹ *Major League Baseball Players Ass'n: Licensing*, <http://mlbplayers.mlb.com/pa/info/licensing.jsp> (last visited Dec. 5, 2015).

²⁰ See, e.g., Morgan Bettex, *CBS Tackles NFL Rights To Player Statistics*, LAW 360, (Oct. 7, 2008) (<http://www.law360.com/articles/71805/cbs-tackles-nfl-rights-to-player-statistics>) (reporting that NFL Players participated in a lawsuit against CBS over the right of players' publicity rights were being violated by a fantasy sports operator).

²¹ See *CBS Interactive Inc. v. Nat'l Football League Players Ass'n*, 259 F.R.D. 398 (D. Minn. 2009).

²² See *id.*; see also *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir. 2007).

²³ See Karcher, *supra* note 17.

²⁴ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977). The court discusses how the right of publicity came to be formed through the right of privacy and the four interests that were tied together by common name. Each represents an interference with the rights of the plaintiff. Appropriation of another's name or likeness is one of the base rights of privacy that has evolved into the common day right of publicity.

common law.²⁵ The definitions vary by state, but in general the right of publicity is an individual's right to control how his identity is used for commercial purposes.²⁶

Primarily, right of publicity allows people to control their identities and allows for compensation when their identities are used commercially.²⁷ The elements of a typical right of publicity claim are: (1) use of identity; (2) commercial purpose; (3) lack of the individual's consent; and (4) resulting injury.²⁸

A plaintiff claiming a right of publicity violation must prove the defendant used his identity for commercial purposes without his consent.²⁹ Identity is shown by use of expressions of a personality or name to denote likeness.³⁰ Identity also consists of any attribute portraying an individual's personality.³¹

The other dissectible prong of a right of publicity claim is commercial purpose, the public use of an individual's identity for profit.³² The resulting damages must be commercial in nature to the plaintiff, which gave the defendant unjust enrichment.³³ Most courts have stated that the damages requirement only needs the defendant to have intended to obtain a commercial advantage and not necessarily to have intended to injure the plaintiff.³⁴ Finally, the First Amendment protects some uses that would otherwise be a violation of an individual's right of publicity.³⁵

In *CBS Interactive, Inc.*, the court analyzed professional athletes' rights of publicity in balance with First Amendment free speech rights.³⁶ They concluded that the fantasy provider's First Amendment right to use the names and statistics of individual players supersedes any association's right of publicity on behalf of the players.³⁷ This decision is currently on appeal and will drastically affect the culture of fantasy sports for generations to come.³⁸

C. First Amendment Fair Use Defense

The inherent issue in allowing an individual total control over his identity is that it restricts the free expression of others that the First Amendment is supposed to

²⁵ See *id.* at 566; Patrick Whitman, *Everyone's a Critic: Tiger Woods, The Right of Publicity and the Artist*, 1 HOUS. BUS. & TAX. L.J. 41, 48-56 (2001).

²⁶ *Newcombe v. Adolf Coors Co.*, 157 F.3d 686, 694 (9th Cir. 1998) (holding use of a Major League Baseball player's image in a beer advertisement without his consent, violated his right of publicity).

²⁷ *Id.* at 578.

²⁸ *Cardtoons v. Major League Baseball Players Ass'n.*, 95 F.3d 959, 968 (10th Cir. 1996); See also *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992).

²⁹ *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 929 (6th Cir. 2003).

³⁰ *Carson v. Here's Johnny Portable Toilets, Inc.* 698 F.2d 831, 835 (6th Cir. 1983) (allowed Johnny Carson's identity to be used because his name and picture were not used).

³¹ *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993).

³² *Id.*

³³ *Cardtoons v. Major League Baseball Players Ass'n.*, 95 F.3d 959, 968 (10th Cir. 1996).

³⁴ *Doe (Tony Twist) v. TCI Cablevision*, 110 S.W. 3d 363, 371 (Mo. 2003).

³⁵ Patrick Whitman, *Everyone's a Critic: Tiger Woods, The Right of Publicity and the Artist*, 1 HOUS. BUS. & TAX. L.J. 41, 57-60 (2001).

³⁶ See *CBS Interactive Inc.*, 259 F.R.D. 398.

³⁷ *Id.*; *C.B.C. Distrib. & Mktg., Inc.*, 505 F.3d 818. The Court in CBS granted summary judgment because the case was indistinguishable from the facts of CBC.

³⁸ *Id.*

protect.³⁹ The First Amendment's protection of free speech and expression apply only to claims against government actors.⁴⁰ However, courts have allowed First Amendment claims and defenses between two private entities if common law or a state statute apply.⁴¹

In *Cardtoons*, the United States Court of Appeals for the Tenth Circuit deliberated over whether the absence of a government actor could bar a First Amendment defense.⁴² The court reasoned that although this was a civil action with private entities, the application of the state statute satisfies the state action requirement because it imposes restrictions on *Cardtoons*' right of free expression.⁴³

The Supreme Court has clarified that freedom of speech is of paramount importance to society, but it should not come with the deprivation of another's control over their intellectual property rights.⁴⁴ A balancing test was implemented to consider if a right given by a state law conflicts with another's constitutional right.⁴⁵

The First Amendment aims to protect communicative speech, which is the reporting of news to educate and inform the public.⁴⁶ In contrast, commercial speech does not receive the same level of First Amendment protection.⁴⁷ Commercial speech is expression related solely to the speaker's economic interests and generally advertises a product or service.⁴⁸ Some forms of expression generate a profit, but are not wholly commercial speech and therefore still entertain First Amendment protection.⁴⁹

In *Zacchini*, the Supreme Court mandated the balancing test be used to consider First Amendment protection in relation to the plaintiff's right of publicity by state statute.⁵⁰ However, the Supreme Court did not provide a standard for other courts, leaving those courts to create tests to navigate this issue.⁵¹ The use of an athlete's

³⁹ *Gionfriddo v. Major League Baseball*, 94 Cal. App. 4th 400, 409 (2001); *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003).

⁴⁰ *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 968(10th Cir. 1996).

⁴¹ *Id.*

⁴² *Id.* at 968. The plaintiff was a company selling baseball trading cards that depicted caricatures of famous Major League Baseball players. *Id.* at 959. The company sought declaration that the use on the cards did not violate the players' right of publicity. *Id.* The Major League Baseball Association held a license on the players' right of publicity. *Id.*

⁴³ *Id.* at 968.

⁴⁴ *Cohen v. Cowles Media Co.*, 501 U.S. 663, 669 (1991).

⁴⁵ *Id.* at 668. The court decided that statute or common law can act as the state actor requirement.

⁴⁶ *Cardtoons*, 95 F.3d at 968. The Court held that communicative speech includes a wide range of speech intending to inform the public. Political discussion, news reporting, and historical records are examples of speech given the highest level of deference in First Amendment protection.

⁴⁷ *Id.* at 970.

⁴⁸ *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 561 (1980).

⁴⁹ *ETW Corp.*, 332 F.3d at 924. The court concluded that forms of expression that are sold for profit do not prohibit a First Amendment protection defense. *Id.*

⁵⁰ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 566 (1977). The Supreme Court's decision expanded the protection offered by the First Amendment. The Court decided that using an individual's identity for entertainment purposes deserves protection because of the expressive nature of entertainment. Therefore, appropriation of another's identity for entertainment purposes is considered communicative speech and deserves the same protection as political commentary or news reporting.

⁵¹ *See, e.g., ETW*, 332 F.3d at 931; *see also C.B.C.*, 443 F. Supp. 2d at 1089; J. Thomas McCarthy, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 8:23 (2d ed. 2007). The related use, transformative and predominate purpose tests have all been used to try to balance an individual's right of publicity with

identity in fantasy sports is both expressive and commercial, which creates a grey area for fantasy providers and players' associations to draw arguments that impact athletes on every level.⁵²

D. Collegiate Level

The emergence of technology in entertainment has created more conflicts between athletes and companies attempting to create a creative expression through sports video games.⁵³ Even college athletes, who, unlike professionals, are not being compensated in licensing fees for the use of their identities, have been drawn into the conflict.⁵⁴ In particular, Electronic Arts, Inc. has recently been involved in two contradicting cases.⁵⁵

In *In re NCAA Student-Athlete Name & Likeness Licensing Litig* (hereinafter "*NCAA Student-Athlete litigation*"), the Ninth Circuit defined a successful right of publicity claim as a misappropriation of likeness without consent or compensation for the use.⁵⁶ The court went on to implement the transformative test to analyze whether the athlete's likeness is one of the "raw materials" from which an original work is

another's First Amendment protection of their expression. These tests typically apply to artistic expression and have little effect on the fantasy debate. However, they do have application in the sports video game world and the use of athletes' identities on a grander scale to denote artistic expression and transformation.

⁵² *CBS Interactive Inc.*, 259 F.R.D. 398; see also *C.B.C. Distrib. & Mktg., Inc.*, 505 F.3d 818. See generally Karcher, *supra* note 1. Karcher states that courts are hesitant to develop a rule setting a standard for other courts to reason. Fantasy sports providers' use of athletes' statistics and information need an individualized analysis of the factors. Only once this analysis has been completed on the use of the athletes' information can the court determine if the use deserves First Amendment protection from violation of state right of publicity statutes.

⁵³ See, e.g., *Keller v. Electronic Arts, Inc.*, 2010 WL 530108 (N.D. Cal 2010) (holding that "[a] video game creator's depiction of a former college football player in a video game was not sufficiently transformative to bar his California right of publicity claims.>").

⁵⁴ See Gina Ilardi, *First Amendment v. The Right Of Publicity: The Game Is On!*, The Metropolitan Corporate Counsel, Aug. 20, 2012,

<http://www.metrocorpocounsel.com/articles/20189/first-amendment-v-right-publicity-game>. National Collegiate Athletic Association's rules state that college athletes are not allowed to profit from their exposure. These rules govern all college athletes and their respective educational institutions.

⁵⁵ See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013) *cert. dismissed sub nom.* Elec. Arts Inc. v. Keller, 135 S. Ct. 42, 189 L. Ed. 2d 894 (2014); See also *Hart v. Electronic Arts, Inc.*, 808 F.Supp 2d 757 (D.N.J. 2011). In the Third and Ninth Circuit, Electronic Arts is facing separate claims of misappropriation of collegiate athletes' identities. Electronic Arts pays licensing fees the National Collegiate Athletic Association and to each institution Electronic Arts wishes to feature in its video game.

⁵⁶ See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013) *cert. dismissed sub nom.* Elec. Arts Inc. v. Keller, 135 S. Ct. 42, 189 L. Ed. 2d 894 (2014). Electronic Arts was using collegiate athletes' characteristics in their college football game. The complaint references the precise replication of all the teams, including logos, uniform, mascots, and stadiums. The game even depicts athletes preferred gear, such as visors, face masks, back plates, or arm bands.

synthesized or if the use is for the very “sum and substance” of the work.⁵⁷ The analysis concluded that Electronic Arts did not sufficiently transform the athletes’ likenesses.⁵⁸

On the other hand, a Third Circuit district court criticized the Ninth Circuit’s holding in *NCAA Student-Athlete Litigation*.⁵⁹ In *Hart*, the court also used the transformative test, but additionally implemented the test from *Rogers*.⁶⁰ The court decided Electronic Art’s use was sufficiently transformative.⁶¹

NCAA Student-Athlete litigation currently has an appeal pending that will drastically alter the entertainment industry and *Hart* was recently reversed on appeal, continuing the ongoing conflict between the First Amendment and an individual’s right of publicity.⁶²

III. ANALYSIS

The commercial expansion of the sports entertainment industry has inspired litigation surrounding an athlete’s right to control the use of his identity.⁶³ Courts have looked at whether athletes have a right of publicity in their identities, including

⁵⁷ *Id.* at 1274.

⁵⁸ *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013) *cert. dismissed sub nom.* Elec. Arts Inc. v. Keller, 135 S. Ct. 42, 189 L. Ed. 2d 894 (2014); *Comedy III Prods., Inc.*, 25 Cal. 4th 387; *Winter v. DC Comics*, 30 Cal. 4th 881, 890 (2003); *Kirby v. Sega of Am., Inc.*, 144 Cal App. 4th 47, 59 (2006). The court in *Keller* breaks down these three cases using the transformative test. *Keller*, 724 F.3d 1268. *Comedy III* is a case where the defendant made a literal depiction of the three stooges in charcoal and it was determined to not be transformative in its use. 25 Cal. 4th 387. In *DC Comics*, the comic book depicted two musicians as half human and half worm. 30 Cal. 4th 881, 890 (2003). The court decided this was transformative and only used the musicians’ identities for “raw materials.” *Id.* In *Kirby* the defendant used a musician’s likeness in a video game but the use was determined transformative because she was much taller, made a different form of living, and the setting was drastically different. *Keller*, 724 F.3d 1268

⁵⁹ *Hart*, 808 F.Supp 2d 757 at 786. The court says that the court in *Keller* failed to take the expressive nature of the interactive features into account. *Id.* The *Hart* court says that the analysis needs to be focused on the game as a whole and not purely on the use of likeness. *Id.* They suggested the *Keller* court took in the setting of the character but not the remainder of the game’s aspects. *Id.*

⁶⁰ *Id.* at 774-777. The court uses the *Rogers* test, which was typically reserved for trademark law. *Hart*, 808 F.Supp 2d at 774-777. The test looks to see if an infringing work has “artistic relevance to the underlying work whatsoever.” *Id.* If there is relevance, then the test looks to see if the use attempts to mislead as to the source. *Id.* The court also applied the transformative test and decided that Electronic Arts encourages players to use features to alter athlete characteristics and not to actually be that player. *Id.*

⁶¹ *Id.* The district court reasoned that Electronic Art’s use of the athletes’ identities was just the “raw materials” by which the game was synthesized. It decided the depiction of the players was not the sum of the substance of the game and that the game had creative artistic expression.

⁶² See *Keller*, 724 F.3d 1268; see *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3rd Cir. N.J. 2013); see Gina Iardi, *First Amendment v. The Right Of Publicity: The Game Is On!*. All athletes will be effected by the results of these appeals. If the *Keller* holding wins out, then athletes will be entitled to damages and the right to make money from the NCAA and their respective schools. If Electronic Arts wins, then they may not have to continue to pay lucrative licensing fees for the depiction of athletes’ identities in its video games. Also, there is the possibility that the court decisions will differ and the debate will continue until the Supreme Court makes a decision or federal legislation occurs.

⁶³ Richard T. Karcher, *The Use of Players’ Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 PENN ST. L. REV. 557 (2007).

their biographical information and performance statistics.⁶⁴ The issue is whether a company's First Amendment privilege exceeds an athlete's right of publicity.⁶⁵ This article will analyze these recent cases in sports entertainment and the problems courts have in balancing the First Amendment with the right of publicity.

A. State Right of Publicity Statutes

The debate surrounds whether athletes have a right of publicity in their name, likeness, biographical information and performance statistics.⁶⁶ Right of publicity is governed by state statute or common law and is described in the third restatement under unfair competition.⁶⁷ Currently, the right of publicity lacks a definite test and jurisdictions will continue to have differing results until there is federal legislation created.⁶⁸

⁶⁴ See generally *CBS Interactive Inc.*, 259 F.R.D. 398; see generally *C.B.C. Distrib. & Mktg., Inc.*, 505 F.3d 818; see generally *Cardtoons*, 95 F.3d 959. Each case discussed the use of an athlete's biographical information or game-time statistics. The courts have had conflicting reasoning concerning the commercial use of an athlete's identity and its correlation with the First Amendment fair use defense. Similar cases have led to drastically different holdings in separate jurisdictions.

⁶⁵ Patrick Whitman, Comment, *Everyone's a Critic: Tiger Woods, The Right of Publicity and the Artist*, 1 HOUS. BUS. & TAX. L.J. 41, 57-60 (2001); see *Gionfriddo*, 114 Cal. Rptr. 2d 307; *Parks*, 329 F.3d 437. Whitman explains that an individual's control over his intellectual property rights should be protected, even at the expense of free speech. These two paramount societal values conflict with one another. Courts have attempted to protect communicative speech due to its role in educating the public. However, they have consistently held against the use of another's identity for purely commercial speech.

⁶⁶ See Karcher, *supra* note 65.

⁶⁷ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46-47. The restatement breaks down use of unfair competition for purposes of trade. It goes on to comment on the right of publicity. For instance:

[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 communication 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 a 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 other's identity in advertising.

RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46-47. This section breaks down the right of publicity and its intersection with freedom of expression given by the Constitution.

⁶⁸ RESTATEMENT (SECOND) OF TORTS § 652C (1977); J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1:7 (2d ed. 2000).

The two most important elements of a right of publicity claim are the use of the plaintiff's identity and the defendant's commercial purpose.⁶⁹ In sports entertainment, courts have generally held that an athlete's performance statistics and biographical information are a representation of his identity.⁷⁰ The commercial purpose element is usually the main factor weighed against the First Amendment freedom of expression.⁷¹

Athletes may not want to be associated with a company's product or service because it may cause consumers to create a false connection between the athlete and the product.⁷² These associations can damage an athlete's commercial influence on the market and future endorsements.⁷³ The excessive use or exposure of an athlete suggests a dilution of his identity's commercial value and puts his reputation and public image at risk.⁷⁴ The right of publicity was meant to protect athletes and celebrities from the misappropriation of their identities to a commercial advantage.⁷⁵

B. The First Amendment Excuse

Fantasy sports providers have claimed a fair use defense under the First Amendment, which is meant to protect free expression of artistic ideas.⁷⁶ The Supreme Court has stated that freedom of speech is crucial for society, but it should not come with the deprivation of another's control over their right of publicity.⁷⁷ Courts have handled the analysis of the First Amendment and the right of publicity in separate ways.⁷⁸

1. Cardtoons

The absence of a government actor usually bars a First Amendment defense.⁷⁹ In *Cardtoons*, The United States Court of Appeals for the Tenth Circuit reasoned that although it was a civil action, the state statute satisfied the government actor

⁶⁹ *ETW Corp.*, 332 F.3d 915, 928.

⁷⁰ See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013) *cert. dismissed sub nom.* Elec. Arts Inc. v. Keller, 135 S. Ct. 42, 189 L. Ed. 2d 894 (2014); See *Hart*, 808 F.Supp 2d 757 (There is little actual debate between courts on the identity element of an athlete's right of publicity claim.).

⁷¹ See *Gionfriddo*, 114 Cal. Rptr. 2d 307; *Parks*, 329 F.3d 437 (explaining that commercial purpose is the primary element weighed in these types of conflicts).

⁷² Patrick Whitman, *Everyone's a Critic: Tiger Woods, The Right of Publicity and the Artist*, 1 HOUS. BUS. & TAX. L.J. 41, 57-60 (2001).

⁷³ *Id.*

⁷⁴ Maureen C. Weston, *Publicity Rights in Sports: The Fantasy of Player Statistics Ownership: The Fantasy of Athlete Publicity Rights: Public Fascination and Fantasy Sports' Assertion of Free Use Place Athlete Publicity Rights on an Uncertain Playing Field*, 11 CHAP. L. REV. 581, 585 (2008).

⁷⁵ *Id.* At 582

⁷⁶ Whitman, *supra* note 72.

⁷⁷ *Cohen v. Cowles Media Co.*, 501 U.S. 663, 669 (1991).

⁷⁸ See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 962 (10th Cir. 1996); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003); *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977); *Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307 (Ct. App. 2001).

⁷⁹ *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 968 (10th Cir. 1996).

requirement.⁸⁰ The appellate court additionally discussed the balance between the defendant's publicity rights and the plaintiff's freedom of expression.⁸¹

The First Amendment protects speech that entertains or informs because the two can overlap and be indistinguishable.⁸² The *Cardtoons* court reasoned that although the trading cards could be presented as commercial merchandise, that did not render the First Amendment inapplicable.⁸³ The *Cardtoons* court also attempted to balance the athletes' right of publicity with the artists' freedom of expression by directly factoring the extent of speech restriction against the government interest in protecting intellectual property rights.⁸⁴ The holding in *Cardtoons* gave a voice to artists or even fantasy sports providers attempting to assert First Amendment protection when using an individual's identity in their work.⁸⁵

2. *Zacchini*

The Supreme Court of the United States attempted to shed light on the debate between the First Amendment and the right of publicity in *Zacchini v. Scripps-Howard Broad Co.*⁸⁶ The Court was split, but the majority reversed because the First Amendment did not provide the broadcast company immunity from liability when producing an entire event.⁸⁷ The broadcasting of a petitioner's entire performance presents a threat to the economic worth of that work.⁸⁸

The dissenting members of The Supreme Court argued that the First Amendment protects from a right of publicity claim, unless there is a strong showing of commercial exploitation.⁸⁹ The dissent suggests this decision could lead to media censorship because it restricts the scope of reporting, which disadvantages the public.⁹⁰ The focus

⁸⁰ *Id.* The court decided that the state right of publicity statute restricted the plaintiff's right of free expression. *Id.* At 968. This should qualify it as a state actor even with entirely civil litigants.

⁸¹ *Id.* First the court decided if the cards infringed on The Major League Baseball Players Association's intellectual property rights, which was fairly evident. *Id.* at 968. However, the court quickly moved to ascertaining whether the infringing cards were protected by the First Amendment. *Id.* at 968.

⁸² *Winters v. New York*, 333 U.S. 507, (1948); see *Zacchini*, 433 U.S. at 562, 578.

⁸³ *Cardtoons*, 95 F.3d 959; *Lakewood v. Plain Dealer Publishing Co.*, 486 U.S. 750, 756 (1988) (holding that selling materials does not create unprotected speech or alter the level of protection under the First Amendment).

⁸⁴ *Cardtoons*, 95 F.3d at 972 (explaining the importance of Cartoon's free speech and the effects of limiting its constitutional right). The court also considers the consequences of the infringement on the Major League Baseball players' right of publicity). *Id.*

⁸⁵ *Id.* at 976. The court held that little was gained by protecting the players' publicity rights in "parody trading cards." *Id.* The cards were a social commentary and were accordingly afforded First Amendment protection. *Id.*

⁸⁶ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 564 (1977).

⁸⁷ *Id.* at 574-75.

⁸⁸ *Id.* The court reasoned that the economic value for an artist lies in the right to control his publicity. *Id.* Specifically after the artist's work was created from his own talent or skill, which is being devalued by the recreation. *Id.*

⁸⁹ *Id.* at 581.

⁹⁰ *Id.* at 580-81. News sources will be forced to film only partial events for fear of a right of publicity violation. *Zacchini*, 433 U.S. at 580-81. The First Amendment was meant to foster open and expansive commentary on the world we live in. *Id.*

of the dissent is on the newsworthiness of the broadcast and the lack of attempted commercial advantage.⁹¹

In *Zacchini*, the Supreme Court declined the opportunity to create a standardized test for all jurisdictions to use, which has forced lower courts to speculate and adopt differing tests.⁹² The case is an older precedent and more recent cases have delved specifically into the fantasy sports industry.⁹³ However, this debate would be simpler if the Supreme Court in *Zacchini* had provided a clear test for balancing the right of publicity with freedom of expression.⁹⁴

3. *CBC and CBS*

Recently, the expanding industry of fantasy sports has attracted more litigation.⁹⁵ In *C.B.C. Distribution & Marketing, Inc.*, the court reasoned that Major League Baseball athletes' statistics were clearly being used to CBC's commercial advantage.⁹⁶ However, athlete statistics are widely available in the public domain and players would not be impacted by the loss of revenue from fantasy licensing fees.⁹⁷ The court sided with the fantasy providers and the First Amendment, because the information was already available to everyone and the economic balance weighed in favor of CBC.⁹⁸ This case continues to be used by the entertainment industry to support its First Amendment fair use defense.⁹⁹

Courts in similar jurisdictions are constrained by the precedent set before them.¹⁰⁰ In *CBS Interactive, Inc.*, the Eighth Circuit faced another fantasy sports case that emulated its predecessor.¹⁰¹ The two cases only differed in the type of sport, and the court similarly concluded that CBS was protected under the First Amendment.¹⁰² These two court decisions provide a greater scope of protection for fantasy sports providers attempting to expand their product. Despite the novel and prevalent Constitutional issues, the Supreme Court had declined the opportunity to weigh in on the fantasy sports debate.¹⁰³

Some legal scholars have criticized the Eighth Circuit's holdings and assert professional athletes should not yield to the First Amendment freedom of

⁹¹ *Zacchini*, 433 U.S. at 582.

⁹² See Richard T. Karcher, *The Use of Players' Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 Penn St. L. Rev. 557 (2007). Karcher explains how the *Zacchini* decision impacted the lower courts' decisions.

⁹³ See *CBS Interactive Inc.*, 259 F.R.D. 398; see also *C.B.C. Distrib. & Mktg., Inc.*, 505 F.3d 818.

⁹⁴ John Grady, Steve McKelvey and Annie Clement, *A New "Twist" for "The Home Run Guys"?: An Analysis of the Right of Publicity Versus Parody*, 15 J. LEGAL ASPECTS OF SPORT 267, 271 (2005).

⁹⁵ See *CBS Interactive Inc.*, 259 F.R.D. 398; see also *C.B.C. Distrib. & Mktg., Inc.*, 505 F.3d 818.

⁹⁶ *C.B.C. Distrib. & Mktg., Inc.*, 505 F.3d 818 at 822.

⁹⁷ *Id.*

⁹⁸ *Id.* The court suggests that if baseball players had a harder time reaping wealth, then they would more strongly consider the economic impact against them. *Id.*

⁹⁹ See *CBS Interactive Inc.*, 259 F.R.D. 398.

¹⁰⁰ *Id.*

¹⁰¹ See *Id.*

¹⁰² *Id.* at 404. Fantasy football and fantasy baseball were indistinguishable and the court was forced to follow precedent from the CBC decision. *Id.*

¹⁰³ See *C.B.C. Distrib. & Mktg., Inc.*, 505 F.3d 818.

expression.¹⁰⁴ These articles attempt to distinguish the speech employed by fantasy providers from the information published in newspapers without licensing fees.¹⁰⁵ They contend that if clothing manufacturers have to pay licensing fees to attach an athlete to their product, then fantasy providers should also pay licensing fees for placing the athlete on their product-website.¹⁰⁶ The continuing expansion of the fantasy industry will eventually favor publicity rights, because the commercial advantage and extent of use will only increase.¹⁰⁷ It is becoming more crucial to have a federal legislative framework to properly adjudicate right of publicity claims in the future.

C. Collegiate Considerations

Entertainment companies have even used collegiate athletes' identities when creating their sports video games.¹⁰⁸ These amateurs are not being compensated in licensing fees for this use, which has led to continued debate and contradictory court holdings.¹⁰⁹

1. Electronic Arts Failure to Transform

The first of two claims against Electronic Arts came from Samuel Keller, a former college football player.¹¹⁰ In *NCAA Student-Athlete Litigation*, Keller's claim was that Electronic Arts misappropriated his identity, without his consent or compensation.¹¹¹ The court in *NCAA Student-Athlete Litigation* followed precedent laid out by the California Supreme Court, which implemented the transformative test.¹¹² Electronic

¹⁰⁴ Gustavo A. Otalvora, *Alfonso Soriano is Getting Robbed: Why the Eighth Circuit Court of Appeals Made a Bad Call in CBC Distribution and Marketing v. Major League Baseball*, 2008 U. ILL. J.L. TECH. & POLY 383 (2008); Richard T. Karcher, *The Use of Players' Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 Penn St. L. Rev. 557 (2007).

¹⁰⁵ Otalvora, *supra* note 104.

¹⁰⁶ *Id.* at 391.

¹⁰⁷ See Karcher, *supra* note 92. Karcher explains that the current trend only suggests that the element of commercial purpose will only increase.

¹⁰⁸ See Gina Ilardi, *First Amendment v. The Right Of Publicity: The Game Is On!*, The Metropolitan Corporate Counsel, Aug. 20, 2012, <http://www.metrocorpocounsel.com/articles/20189/first-amendment-v-right-publicity-game>.

¹⁰⁹ *Id.*; see *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013) *cert. dismissed sub nom.* Elec. Arts Inc. v. Keller, 135 S. Ct. 42, 189 L. Ed. 2d 894 (2014); See *Hart*, 808 F.Supp 2d 757 at 775. The *O'Bannon* case was consolidated with the *Keller* case in the Northern District of California because they had substantially similar subject matter. The two cases are both on appeal, but currently their split decision emulates the conflicting debate.

¹¹⁰ See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, (9th Cir. 2013) *cert. dismissed sub nom.* Elec. Arts Inc. v. Keller, 135 S. Ct. 42, 189 L. Ed. 2d 894 (2014).

¹¹¹ See *Id.*

¹¹² *Id.* at 1271. The Supreme Court held that video games are entitled to protection under the First Amendment. However, the court reasoned the protection is not absolute and must be balanced with an athlete's right of publicity.

Arts attempted to import the more lenient “*Rogers Test*”, but the court rejected that idea.¹¹³

The court in *NCAA Student-Athlete Litigation* recognized that other districts have made use of the *Rogers Test*.¹¹⁴ The *Rogers Test* essentially removes the consideration of the title of a work, and simply focuses on the artistic expression.¹¹⁵ Nonetheless, the court in *NCAA Student-Athlete Litigation* sided with courts that have solely employed the transformative test—the test with more flexibility for an individualized analysis.¹¹⁶ This decision is still on appeal, but the outcome could potentially support the compensation of collegiate athletes.¹¹⁷

2. A Successful Appeal and Trend for Athletes

A second claim against Electronic Arts came from Ryan Hart, a former Rutgers quarterback, for the company’s use of his likeness and biographical information.¹¹⁸ At the district level, the court found in favor of Electronic Arts and the First Amendment fair use defense, adopting the *Rogers Test* and looking at the artistic work as a whole.¹¹⁹

Recently, however, the appellate court overturned this decision, reasoning that adopting the *Rogers Test* would “immunize a broad swath of tortious activity.”¹²⁰ Currently, both the *NCAA Student-Athlete Litigation* and *Hart* courts agree that the transformative test is appropriate when analyzing freedom of expression against right

¹¹³ *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1280 (9th Cir. 2013) *cert. dismissed sub nom.* Elec. Arts Inc. v. Keller, 135 S. Ct. 42, 189 L. Ed. 2d 894 (2014); The court disagrees with Electronic Arts because it reasons that the “*Rogers Test*” was designed to simply protect consumers from risk of confusion. The court describes the right of publicity as a protectable social utility. It held that the transformative test was sufficient in determining if there was a misuse of identity.

¹¹⁴ *See, e.g.*, *Parks v. LaFace Records*, 329 F.3d 437, 444 (6th Cir. 2003); *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). The court in *Rogers* attempted to balance free expression under the First Amendment and claims under the Lanham Act. *Id.* The court further recognized that many forms of artistic expression deserve protections but a consumer has a right not to be misled by the source of the product. *Id.* Under this test, it is easier for works to be considered protected by the First Amendment fair use exception.

¹¹⁵ *Id.*

¹¹⁶ *See In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1280 (9th Cir. 2013) *cert. dismissed sub nom.* Elec. Arts Inc. v. Keller, 135 S. Ct. 42, 189 L. Ed. 2d 894 (2014). The transformative test does a sufficient job of being flexible for consideration. It takes into account a celebrity’s interest in retaining his right of publicity and the public’s interest in free expression.

¹¹⁷ *See Id.*

¹¹⁸ *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 145 (3d Cir. N.J. 2013).

¹¹⁹ *Hart v. Electronic Arts, Inc.*, 808 F.Supp 2d 757 (D.N.J. 2011) at 793 (reasoning that Hart was a very partial unit to a whole artistic work). The court described the use as more statistical and fact based. *Id.*

¹²⁰ *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 155 (3d Cir. N.J. 2013). The appellate court said the *Rogers Test* looks simply to the relationship between the celebrity image and work as a whole. *Id.* The court reasons that this is too vague a test under these considerations. *Id.*

of publicity.¹²¹ Clearly these cases, and other similar ones, will drastically alter the scope of unlicensed use of athletes' identities in the sport entertainment industry.¹²²

D. The Potential Future of the Conflict

Providers of fantasy sports games currently have First Amendment protections to use player statistics without paying licensing fees.¹²³ The continued expansion and evolution of the industry in the marketplace will lead to future claims that are distinguishable from *C.B.C.*¹²⁴ *NCAA Student-Athlete Litigation* and *Hart* exemplify the direction courts are going on the subject, but for now the First Amendment still provides protection to the fantasy industry.¹²⁵

Right of publicity is still controlled by common law or state statute, but with continued debate the intellectual property right could see federal legislation.¹²⁶

IV. PROPOSAL

America needs a federal right of publicity statute. Advancements in technology have modernized American society and have interconnected citizens across all 50 states. We live in a country that has continued to evolve since its founding and the drafting of the Constitution.¹²⁷ In 1953, when the right of publicity began its development, individual state laws probably made sense.¹²⁸ However, the "Internet Age" has arrived and state laws cannot effectively govern publicity rights on a national scale.¹²⁹ Currently, commercial enterprises are allowed to make use of celebrities' identities pursuant to the laws of the state in which they reside. One way to address this problem is for Congress to pass a federal right of publicity statute and for the federal courts to implement a test for deciphering the act.

Fantasy sports providers are nationwide enterprises that make use of athletes' identities from all across America. However, publicity rights are governed by state law, which leads to confusion and forum shopping for greater strategic legal advantage.¹³⁰ When an athlete or celebrity garners national fame, he shouldn't be

¹²¹ See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1280 (9th Cir. 2013) *cert. dismissed sub nom. Elec. Arts Inc. v. Keller*, 135 S. Ct. 42, 189 L. Ed. 2d 894 (2014); *Hart*, 717 F.3d 141, 145. Both courts implemented the transformative test and rejected the Rogers Test.

¹²² See Ilardi, *supra* note 108.

¹²³ See *C.B.C. Distrib. & Mktg., Inc.*, 505 F.3d 818, 823.

¹²⁴ *CBS Interactive Inc.*, 259 F.R.D. 398.

¹²⁵ *Id.*; *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1280 (9th Cir. 2013) *cert. dismissed sub nom. Elec. Arts Inc. v. Keller*, 135 S. Ct. 42, 189 L. Ed. 2d 894 (2014); *Hart*, 717 F.3d 141, 145.

¹²⁶ Richard T. Karcher, *The Use of Players' Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 PENN ST. L. REV. 557 (2007).

¹²⁷ See Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 202 (1954).

¹²⁸ *Id.*

¹²⁹ *Id.* Nimmer suggests that publicity rights of the Internet Age in the 21st century wouldn't be satisfactorily governed by this state law concept.

¹³⁰ See *White v. Samsung Elecs. Am.*, 989 F.2d 1512 (9th Cir. 1993).

constricted by differing factors in each state.¹³¹ There is even a dormant commerce clause problem that arises with the athlete's business crossing state lines and being governed by multiple state laws.¹³² Judge Kozinski reasoned that:

[t]he right of publicity isn't geographically limited. A right of publicity created by one state applies to conduct everywhere, so long as it involves a celebrity domiciled in that state. . . . The broader and more ill-defined one state's right of publicity, the more it interferes with the legitimate interests of other states.¹³³

Currently, if an athlete were to bring suit in a California federal court against an Internet fantasy sports provider for violating the player's rights of publicity, the athlete could prevail under the Ninth Circuit's interpretation of California right of publicity law.¹³⁴ Yet, in Missouri, the fantasy sports provider would be likely to prevail under the fair use exception of the First Amendment.¹³⁵ However, if the case were decided in a state without precedent, the issue could easily be decided either way. A federal right of publicity statute with a fair use exception would provide uniformity for publicity rights across the nation and give guidance to courts on a matter of constitutional rights.

A federal right of publicity statute would bring consistency to the right of publicity in America and would be easier for federal courts to apply than the current potpourri of state laws. A federal statute would also be justified under the Commerce Clause, because it would alleviate the dormant commerce clause problem arising from any conflicting state right of publicity laws.¹³⁶ Congress has previously used the Commerce Clause to pass the first federal trademark statute—another area that, up to that point, had been exclusively governed by state common law.¹³⁷ A federal right of publicity law would avoid both the problem of federal courts expanding state law and the problem of federal courts applying the wrong state's laws.

Lawsuits claiming right of publicity violations are often brought in federal court, despite the fact that only state law governs publicity rights.¹³⁸ To accomplish this,

¹³¹ See *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 936 (6th Cir. 2003) (explaining that different jurisdictions will have different outcomes based on the district they are litigated).

¹³² *White v. Samsung Elecs. Am.*, 989 F.2d 1512, 1518 (9th Cir. 1993) (Kozinski, J., dissenting from denial of petition for rehearing en banc) ("Under the dormant Copyright Clause, state intellectual property laws can stand only so long as they don't 'prejudice the interests of other States.'" (quoting *Goldstein v. California*, 412 U.S. 546, 558 (1973))). Judge Kozinski raised a concern in his dissent against the Ninth Circuit's expansion of California's common law right of publicity.

¹³³ *Id.* at 1519.

¹³⁴ See *Id.* The court gives less weight to the First Amendment defense. *Id.* This position could require the fantasy sports provider to pay a licensing fee for any use of an athlete's name or performance statistics.

¹³⁵ See *C.B.C. Distrib. & Mktg., Inc.*, 505 F.3d 818. The Missouri district court and the Eighth Circuit found that C.B.C.'s First Amendment rights outweighed the state publicity rights of the baseball players.

¹³⁶ Karcher, *supra* note 126.

¹³⁷ *Id.*

¹³⁸ *E.g.*, *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996); *Groucho Marx Prods., Inc. v. Day & Night Co.*, 689 F.2d 317 (2d Cir. 1982).

parties to a suit will typically use diversity of citizenship to get a case in federal court.¹³⁹ Plaintiffs also might claim that a federal law was violated, such as § 43 of the Lanham Act, to get federal jurisdiction.¹⁴⁰ More fantasy sports providers will file complaints in federal court and the current lack of a consistent precedent will lead to confusion when trying to resolve the conflict between the right of publicity and the First Amendment.

Should Congress create a federal right of publicity statute, it would need to consider adding a fair use exception. Fair use exceptions are in both the Copyright Act and the Trademark Act.¹⁴¹ The Copyright Act's legislative history shows that Congress' purpose was to preserve the judicial doctrine of fair use, "one of the most important and well-established limitations on the exclusive right of copyright owners."¹⁴² The problem with introducing a fair use exception—similar to the copyright exception—into a federal right of publicity statute is the difficulty in applying this fair use justly.¹⁴³ Another possibility would be the nominative fair use concept employed in the Lanham Act.¹⁴⁴ Nominative fair use traditionally allows a defendant to fairly use "the plaintiff's mark to describe the defendant's own product."¹⁴⁵ A federal right of publicity statute could use an explicit fair use exception

¹³⁹ See 28 U.S.C. § 1332(a)(1)(2012) (federal district courts have jurisdiction over civil court actions between "Citizens of different States" as long as the amount "in controversy exceeds the sum or value of \$75,000").

¹⁴⁰ *E.g.*, *ETW*, 332 F.3d 915; *Cardtoons*, 95 F.3d 959; *Groucho Marx*, 689 F.2d 317; 15 U.S.C. § 1125 (2012). Federal district courts have jurisdiction over civil actions that arise "under the Constitution, laws or treaties of the United States." Preemption by the federal Copyright Act and the First amendment are usually offered as affirmative defenses to the claimed violations. Federal trademark law is governed by the Trademark Act of 1946, the Lanham Act. The Lanham Act states that "any person who believes that he or she is or is likely to be damaged by" the use of "any word, term, name, symbol, or device . . . which is likely to cause confusion . . . or misrepresents the nature, characteristics, quality, or geographic origin of . . . goods, services, or commercial activities" has a civil cause of action.

¹⁴¹ 17 U.S.C. § 107 (2012); 15 U.S.C. § 1115(b)(4) (2012).

¹⁴² See H.R. REP. NO. 94-1476, at 65 (1976). The congressional intentions were to codify the judicial doctrine of fair use, which excuses copyright infringement when the use of the copyrighted material is "fair" as determined on an individual basis. Four factors must be considered by a court when determining whether or not a use is fair:

- (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.

H.R. REP. NO. 94-1476, at 65. The first and fourth factors can be related to the right of publicity and should be useful in drafting a fair use exception for the federal right of publicity statute.

¹⁴³ See *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661, 662 (2d Cir. 1939) (calling the fair issue use "the most troublesome in the whole law of copyright . . .").

¹⁴⁴ 15 U.S.C. § 1115 (2012). Section 33 of the Lanham Act outlines potential defenses to trademark infringement. "[U]se of a name . . . otherwise than as a mark . . . in good faith only to describe the goods or services of such party" is a defense to trademark infringement. 15 U.S.C. § 1115.

¹⁴⁵ *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992). The Ninth Circuit has applied this to situations in which the defendant used the plaintiff's mark to refer to the plaintiff's product. *Id.* Three conditions had to be met:

to prevent confusion over the balance between a defendant's First Amendment right to expression and an individual's right of publicity.¹⁴⁶ The court should implement the predominant use test, which is especially helpful where a product contains both expressive and commercial elements.¹⁴⁷ When Congress creates a federal right of publicity statute, it should consider adopting a nominative fair use exception and employ the predominant use test to weigh constitutional rights.

Legislation can help avoid judicial uncertainty and resolve multiple problems. First, it would create a clear standard for courts to look to when adjudicating right of publicity claims. Congress could look to the common law and other intellectual property statutes when creating a clear test for courts to determine precisely when the First Amendment fair use defense should apply. Clear legislation would prevent frivolous litigation as well as forum shopping. The "Internet Age" has arrived and state laws can no longer effectively govern publicity rights on a national scale.¹⁴⁸ Based on location, commercial enterprises are allowed to make use of celebrities' identities. The best way to combat these problems is for Congress to pass a federal right of publicity statute with a clear test for when the First Amendment fair use defense should apply.

First, the product or service in question must be one not readily identifiable without the use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.

Id.

¹⁴⁶ *White*, 971 F.2d 1395, 1401; *ETW Corp.*, 332 F.3d 915, 936 (agreeing more with the dissent in *White*). According to Judge Kozinski:

[Federal courts are] in a unique position. . . . State courts are unlikely to be particularly sensitive to federal preemption, which, after all, is a matter of first concern to the federal courts. The Supreme Court is unlikely to consider the issue because the right of publicity seems so much a matter of state law. . . . It's our responsibility to keep the right of publicity from taking away federally granted rights . . . from the public at large or a copyright holder.

White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1518 (9th Cir. 1993)

¹⁴⁷ Gloria Franke, *The Right of Publicity vs. The First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CAL. REV. 945, 980 (2006); *White*, 971 F.2d 1395. This case suggests adopting the primary motivation test, which is similar to the predominant use test. The primary motivation test examines the motivating factors behind the defendant's use. If the interests are predominantly motivated by expression, then they would be protected under the First Amendment fair use defense. However, if the motivating factors leaned towards commercial nature, then the plaintiff would have a valid claim for misappropriation of their identity. The primary motivation test has several factors including: (1) expressive element to the user's content; (2) prominence and pervasiveness of advertisements; (3) presence of other individuals with less fame; and (4) user's presence of unrelated information.

¹⁴⁸ See Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 202 (1954).

V. CONCLUSION

A celebrity's fame is a valuable commodity.¹⁴⁹ Celebrities, including professional athletes, have used that commodity in conjunction with modern technology and the media to become brand names.¹⁵⁰ Fantasy sports providers have been licensing athletes' publicity to promote their own product and gain a commercial advantage within their respective businesses.¹⁵¹ Recently, however, these providers began claiming they have a First Amendment fair use exception that allows them to use the athletes' identities.¹⁵² Courts must determine whether fantasy sports providers should have to pay lucrative licensing agreements and clearly define the scope of First Amendment protection in these cases. The courts should consider implementing a test that factors in the First Amendment defense, but still considers a purely commercial use as infringement.

However, these fantasy sports cases are mere illustrations of the problems inherent in allowing disparate state laws to govern actions that take place on a national scale.¹⁵³ The major branches of intellectual property have each implemented federal statutes to govern them.¹⁵⁴ Congress should recognize the conflict between the First Amendment and state publicity laws. Federal law would avoid both the problem of federal courts expanding state law or even applying the wrong state's laws. Hopefully, Congress will consider these problems and pass a federal right of publicity statute to settle this national debate.

¹⁴⁹ See *White*, 971 F.2d 1395.

¹⁵⁰ See *ETW*, 332 F.3d 915, 936.

¹⁵¹ See *C.B.C. Distrib. & Mktg., Inc.*, 505 F.3d 818; *CBS Interactive Inc.*, 259 F.R.D. 398. The scope of exploitation is bound to increase with the proliferation of fantasy leagues and now mobile access to the league websites.

¹⁵² *Id.* The increasingly extensive exploitation of athletes' identities may effectively decide the issue on First Amendment protection.

¹⁵³ *Id.*

¹⁵⁴ 17 U.S.C. §§ 101-810 (2012); 15 U.S.C. §§ 1051-1129 (2012); 35 U.S.C. §§ 1-376 (2012). The Trademark Act, Copyright Act, and Patent Act have all been created to keep national based concerns from being decided in state forums.