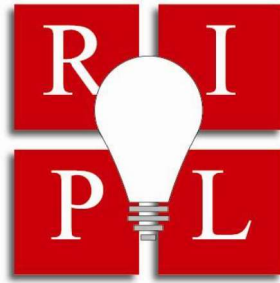


THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



IF IT'S IN THE GAME: IS THERE LIABILITY FOR USER-GENERATED CHARACTERS THAT APPROPRIATE A PLAYER'S LIKENESS?

JASON ZENOR

ABSTRACT

In cases like *Keller* and *No Doubt v. Activision*, the federal courts held that the use of celebrity's likeness was a violation of the right of publicity. In response, EA Sports suspended production of college sports games. But most games still allow for gamers to create their own avatars. With game systems now being connected, gamers can download user-created content—many of which will have the likeness of famous people, thus circumventing the holdings in *Keller* and *No Doubt*. Accordingly, this article examines how this type of user generated content fits within the law of appropriation. First, this article discusses how “modding” is changing gaming content and use. This article then outlines the law of misappropriation. Next, the article argues that these mods might be a violation of the right to publicity and that producers may be vicariously liable for creating the software. Finally, the paper extends this theory into virtual technology and how user generated content may refocus the law of misappropriation to likenesses of non-celebrities.

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JASON ZENOR*

I. INTRODUCTION

Over the last few years, there have been a series of decisions which held that video games' producers cannot program avatars which are recognizable as celebrities without their consent, if their likeness is the instrumental to the game.¹ As a result, video game producer EA Sports has suspended the production of its college sports video games.² Currently, the video game producer is considering how it is going to produce this profitable sports genre again.³ Most likely this will happen by paying the players whose identities it uses.⁴

However, games that rely on celebrity images to make a realistic game may have a way to circumvent this restriction. Today, users are connected and games can be modified allowing for users to create their own avatars and share them with each other.⁵ This feature can allow for users to create and share avatars that resemble the likeness of celebrities, thus making the game realistic again.⁶ But does this creation generate liability for the users who create such content? Does including such features in a game open up the producers to vicarious liability for violating right of publicity?

Moreover, users could modify a game in order to create avatars that resemble private individuals.⁷ Recently, there has been a rise of 'catfishing' through social media, where people have taking on different likenesses in order to exploit others.⁸ Could gamers similarly create avatars for purposes of exploitation, thus opening up

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¹ Keller v. Electronic Arts Inc., 724 F.3d 1268 (9th Cir. 2013); *In re* NCAA Student-Athlete Name & Likeness Licensing Litig., 724 F.3d 1268 (9th Cir. 2013), *cert. denied*, 135 S.Ct 42 (2014); O'Bannon v. Nat'l Collegiate Athletic Ass'n, 7 F. Supp. 3d 955, 962-63 (N.D. Cal. 2014), *cert. denied*, 137 S.Ct. 277 (Mem) (2016). Davis v. Elec. Arts, Inc., 775 F.3d 1172 (9th Cir. 2015); Hart v. Elec. Arts, Inc., 717 F.3d 141 (3d Cir. 2013), *cert denied*, 35 S. Ct. 43 (2014); No Doubt v. Activision Publ'g, Inc., 702 F. Supp. 2d 1139 (C.D. Cal. 2010).

² See Darrin Rovell, *EA Sports Settles With Former Players*, ESPN (Sept. 26, 2013), http://www.espn.com/college-football/story/_id/9728042/ea-sports-stop-producing-college-football-game.

³ Ben Kerchevell, *EA Sports Executive: NCAA Football Video Game Will Return Sooner or Later*, CBS SPORTS, (August 3, 2016), <http://www.cbssports.com/college-football/news/ea-sports-executive-ncaa-football-video-game-will-return-sooner-or-later/>

⁴ *Id.*

⁵ See *infra* Part II.

⁶ *Id.*

⁷ See *infra* Part IV.

⁸ See generally, Colleen M. Koch, *To Catch A Catfish: A Statutory Solution for Victims of Online Impersonation*, 88 U. COLO. L. REV. 233, 263 (2017).

the users to liability for misappropriation of likeness? Would this come back on the game producers who allowed for game modding to begin with?⁹

Misappropriation law seems to be slowly encroaching on First Amendment rights¹⁰ as more and more courts are allowing video games, which are protected works of expressions, to be balanced against the right of publicity¹¹. With newer technology allowing people to create photorealistic avatars who embody the likeness of real people, ranging from celebrities to friends to any one of whom you can get a picture, there is a possibility that misappropriation torts will be further expanded. Moreover, if virtual reality does not receive the same protection as a work of expressions any time soon, then it is foreseeable that producers will face further liability in this area.

Accordingly, this article posits how future advances in gaming technology may create a vulnerability for both professional and amateur content creators who use people's likenesses. First this article outlines the development of user-generated content and modding in gaming.¹² Next, it details the law of appropriating likeness and right of publicity.¹³ Finally, this article discusses the legal issues when likenesses of celebrities or private individuals are generated by users, both in contemporary gaming and in future virtual reality technology.¹⁴

II. EVOLUTION OF GAME MODDING

Home computing and video games began in the 1970s.¹⁵ The video games of this era had 'characters' who consisted of several pixels at most.¹⁶ One of the earliest games to use real identities was *One-on-One: Dr. J v. Larry Bird* for the Commodore 64, but the game still had small pixels as the representation.¹⁷ It would take another two decades before the technology would develop to point where digital representations were recognizable without names attached.¹⁸ Today, sports games are filled with close to photorealistic representations of athletes and many other games use characters

⁹ Modding is the term used to describe changes made to the game at the code level. See *Spare the Mod: In Support of Total-Conversion Modified Video Games*, 125 HARV. L. REV. 789 (2012) (discussing the effects that modding has on the game industry).

¹⁰ Jennifer E. Rothman, *The Other Side of Garcia: The Right of Publicity and Copyright Preemption*, 39 COLUM. J.L. & ARTS 441, 443 (2016).

¹¹ See *Brown v. Entertainment Merchants Assoc.*, 564 U.S. 786 (2012) (holding that a California law that restricted sales of violent video games to minors was unconstitutional).

¹² See *infra* Part II.

¹³ See *infra* Part III.

¹⁴ See *infra* Part IV.

¹⁵ The first home console was called the 'Brown Box' built by Sanders Associates in 1967. See *A History of Video Game Consoles*, TIME.COM, <http://content.time.com/time/interactive/0,31813,2029221,00.html>

¹⁶ Michael Larkey, *Cooperative Play: Anticipating the Problem of Copyright Infringement in the New Business of Live Video Game Webcasts*, 13 RUTGERS J.L. & PUB. POL'Y 1, 11 (2015)

¹⁷ ONE-ON-ONE: JULIUS ERVING V. LARRY BIRD, EA SPORTS (1983). Other games of the era included Chuck Norris Suprkciks, *Journey Escape*. See Staff, *11 Crazy Celebrity Video Game Appearances*, IGN.COM (May 14, 2014), <http://www.ign.com/articles/2014/05/14/11-crazy-celebrity-video-game-appearances>.

¹⁸ See *id.*

from film franchises who were played by real actors or in some cases, actors are hired to portray characters unique to the game.¹⁹

Today's games also allow users to generate content. They create their own characters and avatars.²⁰ The create-a-player function has been around for a couple of decades.²¹ The built-in function allowed users to create players based on limited set of choices (faces, skin color, hair color, etc.).²² In some games, the designers would put in secret characters that could be accessed by putting in a code.²³ Many games today have the same create-a-player function, but the user is offered many more choices and has a lot more precision (e.g., tattoos, facial features, body shape, etc.).²⁴ Some systems allow users to upload photos from which avatars will be designed.²⁵ Newer game systems are also connected to the internet, which allow users to download other user-created players.²⁶ The ownership right in these characters are usually transferred to the game producer when the consumer agree to the end-user license agreement.²⁷

The 'create-a-player' function is a built-in function and is ultimately controlled by the choices provided by the designer.²⁸ But games can be altered at the code level- this is called 'modding.'²⁹ Mods are the fan fiction of video games as they allow people to create original scenarios within a world built by a game company.³⁰ The process can be an innocuous addition such as changing an appearance of a character,³¹ or it can be

¹⁹ *Id.* Kevin Spacey was hired to provide the face and voice of a character in *Call of Duty: Advanced Warfare* (2014). *Id.*

²⁰ *Second Life* has long allowed users to create virtual worlds and users based on whatever inspiration they may find. Patrick McKay, *Culture of the Future: Adapting Copyright Law to Accommodate Fan-Made Derivative Works in the Twenty-First Century*, 24 REGENT U. L. REV. 117, 135 (2012).

²¹ See generally, Sonny Tawari, *10 Greatest Video Game Basketball Players of all Time*, THE MEDIUM (October 27, 2014), <https://medium.com/ten-pens/the-greatest-video-game-basketball-players-of-all-time-abf38678601f#a2v23z92u>.

²² *Id.*

²³ *NBA Jam* allowed a player to unlock AL Gore and Bill Clinton. See Staff, *The Coolest Secret Codes in Video Game History*, THE GRUNGE, <http://www.grunge.com/16445/coolest-secret-codes-video-game-history/>

²⁴ Brian Mazique, *NBA 2K 17 Massive Patch 1.05 Details and Early Impressions*, FORBES (Nov.6 2016), <http://www.forbes.com/sites/brianmazique/2016/11/06/nba-2k17-massive-patch-1-05-details-and-early-impressions/#1686669985ab3>.

²⁵ Avatar generators like these are quite common on the internet as well. See, e.g., AVATAR MAKER, available at <https://avatarmaker.net/>. *NBA 2K 17* allows users to upload a photo from their phone to use as an avatar. Kevin Wong, *You Can Scan Your Face Into 'NBA 2K17' With Your Phone*, MOTHERBOARD (Sept. 23, 2016), https://motherboard.vice.com/en_us/article/nba-2k17-facial-scanning-mobile-app.

²⁶ Greg Lastowka, *User Generated Content and Virtual Worlds*, 10 VAND. J. ENT. & TECH. L. 893, 911 (2008).

²⁷ Oliver A. Khan, *Me, Myself, and My Avatar: The Right to the Likeness of Our Digital Selves*, 5 I/S: J.L. & POL'Y FOR INFO. SOC'Y 447, 455 (2010).

²⁸ If the game producer provides the choices, then may be considered the creator of the information. See *Fair Housing Council of San Fernando Valley v. Roommates.com, LLC*, 521 F.3d 1157 (9th Cir. 2008) (holding that drop menu created by website made them a publisher not protected by immunity pursuant to Sec. 230 of Communication Decency Act).

²⁹ Ryan Wallace, *Modding: Amateur Authorship and How the Video Game Industry Is Actually Getting It Right*, 2014 B.Y.U. L. REV. 219 (2014).

³⁰ *Id.* at 220.

³¹ *Id.* This is referred to as reskinning. *Id.*

a fundamental change to the games such as new levels or new objectives.³² Mods can also completely change the game altogether.³³ Game producers will often open games up to modification for purposes of exciting consumers, selling games, testing games, and crowdsourcing content creation.³⁴

Whatever modifications are made belong to the user who modified it.³⁵ Gamers may be using a licensed tool provided by the original game producer (e.g., Skyrim Mod Kit)³⁶ or they may be using unlicensed modding kits created by a third party—but these mods would most likely be condemned by the original producer.³⁷ Nonetheless, game companies can stop users from distributing any mods because the creative content belongs to the game producer and is protected.³⁸ Ultimately, like fan fiction, modding is a derivative work protected under copyright law.³⁹

Virtual Reality, which was once a science fiction, is now a commercial reality.⁴⁰ Oculus Rift and Samsung VR are now widely available to consumers. There are plans to produce a multitude of VR games in all genres.⁴¹ It is safe to assume that the VR games will have most of the same features as traditional video games including the ability to create characters and situations.⁴² Moreover, soon avid gamers will be able to mod VR games and further create an alternative world not only to play in, but arguably to exist within.⁴³

III. MISAPPROPRIATE OF LIKENESS

The development of privacy law paralleled the development of photography as the concept of an ownership right in identity did not arise until there was ability to lose it through the spreading of pictures.⁴⁴ Prior to this point, there was no prominent celebrity culture.⁴⁵ But with the rise of mass media and the people it made famous,

³² *Id.*

³³ This is known as 'total conversion modding.' *Id.* One of the earliest game mods was the Game Genie which could Nintendo NES games, such as giving a player unlimited lives. *Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc.*, 964 F.2d 965 (9th Cir. 1992). *See also, History of Modding*, FROM PAC MAN TO POOL: RESEARCH ON USER GENERATED CONTENT, <http://mediaindustries1.wordpress.com/modmoddermodding/history-of-modding/>.

³⁴ *See* Wallace, *supra* note 29, at 221.

³⁵ *Id.*

³⁶ Jason Dunn, *Bethesda Talks Skyrim Mods and their PS4 Limitations*, PLAYSTATION LIFESTYLE (Oct. 13, 2016), <http://www.playstationlifestyle.net/2016/10/13/bethesda-talks-skyrim-mods-ps4-limitations/>.

³⁷ *See* Wallace, *supra* note 29, at 221.

³⁸ *Micro Star v. Formgen Inc.*, 154 F.3d 1107 (9th Cir. 1998).

³⁹ *Id.* at 1112-13.

⁴⁰ Rachel Metz, *Four Important Things to Expect in Virtual Reality in 2016*, TECHNOLOGY REVIEW, (December 28, 2015), <https://www.technologyreview.com/s/545011/four-important-things-to-expect-in-virtual-reality-in-2016/>.

⁴¹ *Id.*

⁴² *See* Joel Lee, *7 Games you can Mod to Add VR Support Right Now*, MUO (March 22, 2016), <http://www.makeuseof.com/tag/mods-provide-vr-support/>.

⁴³ *See* Khan, *supra* note 27, at 455.

⁴⁴ Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 195 (1890).

⁴⁵ *See* Michael Maddow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 156- 162 (1993) (outlining the development of advertising and celebrities in the late 19th century-early 20th century).

the concept of misappropriation of likenesses came into the law.⁴⁶ The legal concept of privacy began in 1890⁴⁷ with Samuel Warren and Louis Brandeis' seminal article in the Harvard Law Review.⁴⁸ In 1906, New York was the first state to adopt a privacy law that protected the unlawful use of a person's image for commercial gain.⁴⁹ The initial law protected private citizens who were exploited.⁵⁰

Today there are two causes of action: (1) misappropriation of likeness; and (2) right to publicity.⁵¹ The two torts are similar in that they protect the exploitation of a person's name or likeness.⁵² They are also often confused because of their similarity.⁵³ But there are differences in who can sue and what injury they must show.⁵⁴

In misappropriation, a private person can sue and they must show emotional harm.⁵⁵ This tort is more aligned with privacy law.⁵⁶ With right of publicity, a celebrity sues and must show an economic loss.⁵⁷ This tort is more aligned with copyright law.⁵⁸ Furthermore, right to publicity cases are much more prevalent because of the economic incentive for celebrities and difficulty in proving mental anguish in misappropriation cases.⁵⁹ Some states only allow for cause of action if the use was in a commercial setting,⁶⁰ but most states allow for a cause of action for any exploitation.⁶¹

Generally, the right to privacy dies with the individual. Since misappropriation of likeness is more aligned with privacy interests, a family of the deceased cannot

⁴⁶ Samantha Barbas, *From Privacy to Publicity: The Tort of Appropriation in the Age of Mass Consumption*, 61 BUFF. L. REV. 1119, 1131-32, 1142-45 (2013).

⁴⁷ Dean Prosser delineated four sub-torts of privacy, which the American Law Institute placed in the Restatement of Torts: (1) Intrusion; (2) Publication of Private Facts; (3) Right of Publicity; and (4) False Light. See Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960); RESTATEMENT (SECOND) OF TORTS § 652B (1977).

⁴⁸ Samuel Warren & Louis Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890)

⁴⁹ The law reads: "[N]ame, portrait or picture of any living person for advertising purposes, or for the purposes of trade." N.Y. CIVIL RIGHTS CODE §§ 50-51 (2000); *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442, 447 (N.Y. 1902).

⁵⁰ *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68, 79-81 (Ga. 1905).

⁵¹ In 1953, the term 'right of publicity' was coined in the case *Haelan Laboratories Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2nd Cir. 1953).

⁵² RESTATEMENT (SECOND) OF TORTS § 652D (Westlaw 2016).

⁵³ Kathryn Riley, *Misappropriation of Name or Likeness Versus Invasion of Right of Publicity*, 12 J. CONTEMP. LEGAL ISSUES 587 (2001).

⁵⁴ See *id.* at 587.

⁵⁵ RESTATEMENT (SECOND) OF TORTS § 652D (Westlaw 2016).

⁵⁶ See Riley, *supra* note 53, at 587.

⁵⁷ RESTATEMENT (SECOND) OF TORTS § 652D (Westlaw 2016). Some courts are reluctant to withhold right to publicity to only celebrities. So long as the plaintiff can show an economic value in his or her identity then he or she can bring a claim. Kristina M. Sesek, *Twitter or Tweeter: Who Should Be Liable for A Right of Publicity Violation Under the CDA?*, 15 MARQ. INTELL. PROP. L. REV. 237, 240 (2011). Cf. *Haelan Laboratories*, 202 F.2d at 868.

⁵⁸ *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P. 3d 797, 804 (Cal. 2001).

⁵⁹ There is a "difference between the personal, injured-feelings quality involved in the appropriation, privacy tort and the property, commercial value quality involved in the right of publicity tort." *People for the Ethical Treatment of Animals v. Bobby Berosini, Ltd.*, 111 Nev. 615, 636 (Nev. 1995) (holding that a secret recording by PETA did not invade the privacy of a zookeeper).

⁶⁰ RESTATEMENT (SECOND) OF TORTS § 652 cmt. b. The states that limit liability to commercial uses are New York, Oklahoma, Utah, and Virginia. See *id.* at Reporter's Note.

⁶¹ The Restatement only uses the word "exploitation." *Id.* See also Jennifer E. Rothman, *Commercial Speech, Commercial Use, and the Intellectual Property Quagmire*, 101 VA. L. REV. 1929, 1950 (2015).

usually bring a cause of action.⁶² But right to publicity, which is more aligned with copyright law, is an economic interest and is descendible to heirs.⁶³ State right to publicity laws vary greatly⁶⁴ and range from 20 to 100 years after the death of the celebrity.⁶⁵

A. *The Elements of Misappropriation*

Today, the laws of misappropriation of likeness generally require a plaintiff to show three elements: (1) use of plaintiff's identity; (2) use was exploitative; and (3) use was without consent.⁶⁶ First, the plaintiff must prove that the use was identifiable as the plaintiff.⁶⁷ This can be an explicit use such as a name or picture. In these instances, it is clear that it was the plaintiff being identified.⁶⁸ But other uses may rise to the level of identity. An identity can also be recognizable due to the totality of circumstances.⁶⁹ When precise descriptions, such as hometown, occupation, demographics are combined, then it would begin to pinpoint certain individuals.⁷⁰ For example, in *Keller v. Electronic Arts Inc.*,⁷¹ the athletes' names were not used. But, the game did give positions, jersey numbers, height, weight, etc. These combined descriptions ruled out the possibility that it was a random, fictional character.⁷²

When it comes to right to publicity cases, courts have expanded what is considered to be identity.⁷³ In *White v. Samsung*,⁷⁴ the Ninth Circuit held that a VCR advertisement that included a gold colored robot standing before a board of letters, similar to the gameshow *Wheel of Fortune*, misappropriated the likeness of Vanna

⁶² The exception is when the family continues a case that was started before the plaintiff passed.

⁶³ See *Presley's Estate v. Russen*, 513 F. Supp. 1339 (D. N.J. 1981).

⁶⁴ Jennifer E. Rothman, *The Other Side of Garcia: The Right of Publicity and Copyright Preemption*, 39 COLUM. J.L. & ARTS 441, 443 (2016). Note, there is no federal misappropriation of likeness law. Rachel A. Purcell, *Is That Really Me?: Social Networking and the Right of Publicity*, 12 VAND. J. ENT. & TECH. L. 611, 626 (2010).

⁶⁵ *Id.*

⁶⁶ See, e.g., *Eastwood v. Superior Court*, 149 Cal. App. 3d 409, 417 (1983).

⁶⁷ *Johnny Carson v. Here's Johnny Portable Potty, Inc.*, 698 F.2d 831 (6th Cir.1983) (holding that Johnny Carson's slogan was so recognizable that it consumers would identify him as an endorser).

⁶⁸ Names such as John Smith are prevalent, so in cases such as those the plaintiff would need to show more. But a name like Lady Gaga is unique to the singer. See generally, *Abdul-Jabbar v. General Motors*, 85 F.3d 407 (9th Cir. 1996) (holding that the NBA Hall of Famer had property rights in Lew Alcindor and Kareem Abdul Jabbar).

⁶⁹ EA Sports did not use the athlete's names, but did use "same height, weight, skin tone, hair color, hair style, handedness, home state, play style (pocket passer), visor preference, facial features, and school year." *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1272.

⁷⁰ *Id.*

⁷¹ *Id.*

⁷² Of course, the users had to know the history of the games to discover to whom the references were made. What's more, the information could be discovered through a quick online search. See generally, *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003).

⁷³ *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 137 (Wis. 1979) (holding that plaintiff NFL Hall of Famer 'Crazy Legs' Hirsch had a property right in his nickname even if the use was not concerning him).

⁷⁴ *White v. Samsung Elec. Am. Inc.*, 971 F.2d 1395 (9th Cir. 1992).

White because she was so recognized in that role.⁷⁵ In *Wendt v. Host*,⁷⁶ the court ruled that the use of a fictional character may be considered the likeness of the actor if the actor is so associated with that character.⁷⁷ Since misappropriation is state law, legislatures can restrict what is considered identity from just being explicit use of names or pictures to any construction of identity.⁷⁸

The second element that the plaintiff must prove is that the use was exploitative—usually an unjust enrichment.⁷⁹ This is most often found when the likeness was used for commercial purposes, including advertising, marketing or trade dress.⁸⁰ Other uses such as news, commentary and parody are protected as expression under the First Amendment, despite the fact the defendant may make money off of them.⁸¹ But in *Zacchini v. Scripps Howard*,⁸² the Supreme Court held that a news story which aired the entirety of the plaintiff's 'human cannonball' act violated his right of publicity because it destroyed his ability to make revenue off the act.⁸³

Some states will allow for a cause of action for any exploitation, even if it is not monetary, which allows for non-celebrities to sue.⁸⁴ Examples of exploitation include vendettas,⁸⁵ ideology, and defaming competition.⁸⁶ In these cases, the defendant used the person's identity to gain an advantage—a mere mentioning of a name in order to spread an opinion would not qualify as a misappropriation.⁸⁷

The third element that the plaintiff must prove is that the defendant did not have consent to use this likeness.⁸⁸ An explicit form of consent, such as a release form, is a complete defense so long as the use is within the parameters of the contract.⁸⁹ But a derivative work may not have protection if it is not covered in the contract.⁹⁰ An

⁷⁵ *Id.*

⁷⁶ *Wendt v. Host Inter., Inc.*, 125 F.3d 806 (9th Cir. 1997) (holding that two actors in television series were so identifiable as the characters).

⁷⁷ *Id.* See also *McFarland v. Miller*, 14 F.3d 912 (3d Cir. 1994).

⁷⁸ See, e.g. N.Y. CIV. RIGHTS LAW § 51 (Westlaw 2016); CAL. CIV. CODE § 3344(a) (Westlaw 2016).

⁷⁹ See, e.g. *Newcombe v. Adolf Coors Co.*, 157 F.3d 686 (9th Cir. 1998).

⁸⁰ In *Michaels v. Internet Entertainment Group*, a website was found to have received unjust enrichment by distributing a celebrity sex tape to customers who paid a monthly membership. 5 F. Supp. 2d 823 (C.D. Cal. 1998). There does not need to be proof of monetary gain in right of publicity cases. See *Henley v. Dillard Dept. Stores*, 46 F.Supp.2d 587, 595-597 (N.D. Tex. 1999); *Petty v. Chrysler Corp.*, 799 N.E.2d 432 (Ill. App. Ct. 2003).

⁸¹ See e.g. *Cardtoons L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996) (holding that baseball card caricatures were protected as parody).

⁸² 433 U.S. 562 (1977).

⁸³ *Id.*

⁸⁴ *Faegre & Benson, LLP v. Purdy*, 447 F. Supp. 2d 1008 (D. Minn. 2006).

⁸⁵ *Felsher v. University of Evansville*, 755 N.E.2d 589 (Ind. 2001) (holding that former employee imitating management to create websites which supported the defendant).

⁸⁶ *Id.*

⁸⁷ *McMann v. Doe*, 460 F. Supp. 2d 259, 269-70 (D. Mass. 2006) (holding that plaintiff's website stating his opinion about real estate, along with a picture, was not misappropriation).

⁸⁸ *Welch v. Christmas*, 440 N.E. 2d 1317, 1319 (N.Y. 1982).

⁸⁹ *National Football League v. The Alley, Inc.* 624 F. Supp. 6 (S.D. Fla. 1983) (holding that broadcast television contract gave consent to use likeness even if it did not specify satellite platform).

⁹⁰ See *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1032(3d Cir. 2008); Federal copyright may not preempt state right of publicity law despite the fact that it treated much like intellectual property law. See, e.g., *id.* at 1029-1033. Cf. *Dryer v. National Football League*, 55 F. Supp. 3d 1181, 1200 (D. Minn. 2014), *aff'd*, 814 F. 3d 938 (8th Cir. 2016).

implicit form of consent, such as positive remarks on the use, may also be a defense.⁹¹ Nonetheless, the defendant does not have to be negligent or have knowledge of the misappropriation in order for there to be lack of consent.⁹²

B. Balancing First Amendment with Misappropriation of Likeness

Like other forms of media, video games have first amendment protections despite the fact that they are profitable.⁹³ Generally, courts have held that the First Amendment protected works of expression against right of publicity cases.⁹⁴ One such First Amendment defense is transformative use.⁹⁵ In *Noriega v. Activision*, former Panamanian dictator Manuel Noriega sued video producer Activision for using his name and likeness for a murderous character in the game *Call of Duty: Black Ops II*.⁹⁶ A Superior Court of California in the County of Los Angeles dismissed the case holding that the game was a transformative use as it was one aspect of a larger artistic creation.⁹⁷ In *Sarver v. Chartier*, the Ninth Circuit held the producers of *The Hurt Locker* were protected by the First Amendment because it was not a commercial use and the plaintiff did not have public persona of economic value.⁹⁸ The Second, Fifth and Sixth Circuits will also protect free speech unless the use was not related to the work or was essentially an advertisement.⁹⁹

In other cases, the courts have not been as protective of speech. In *Doe v. TCI Cablevision*,¹⁰⁰ a Missouri court rejected the transformative test and applied a 'predominant purpose' test, holding that a comic book primarily exploited the commercial value of a professional athlete, even if much of the work was expressive

⁹¹ "When a person sits voluntarily for a photograph and his picture is taken by the photographer gratuitously for his or his principal's sole use and benefit, the sitter, simply because the picture is of himself, acquires no greater property right therein than does a stranger." *Cont'l Optical Co. v. Reed*, 119 Ind. App. 643, 652, 86 N.E.2d 306, 310 (1949).

⁹² *Welch*, 440 N.E. 2d at 1319.

⁹³ See *Brown*, 564 U.S. at 790 (holding that a California law that restricted sales of violent video games to minors was unconstitutional). The U.S. Supreme Court has yet to speak upon virtual reality. One can assume that they would extend the *Brown* precedent to VR games, but there are arguments that this may not be the case. See Jason Zenor, *Sins of the Flesh? Obscenity Law in the Era of Virtual Reality*, 19 COMM. L. & POL'Y 563 (2014)

⁹⁴ See *Comedy III*, 21 P. 3d at 810. Right to publicity law is aligned with copyright with similar defenses. Though it may be more accurate to that it is aligned with trademark law. Jennifer E. Rothman, *Commercial Speech, Commercial Use, and the Intellectual Property Quagmire*, 101 Va. L. Rev. 1929, 1950 (2015).

⁹⁵ There are other defenses which are less of an issue because they either do not apply as strongly or automatically protects the producer when it comes to UCG avatars: incidental use, consent, news reporting, commentary, and parody. See Kathryn Riley, *Misappropriation of Name or Likeness Versus Invasion of Right of Publicity*, 12 J. CONTEMP. LEGAL ISSUES 587 (2001).

⁹⁶ *Noriega v. Activision/Blizzard, Inc. et al.*, No. BC 551747, 2014 WL 5930149, at *5 (Cal. Super. Ct., Los Angeles County, July 15, 2014).

⁹⁷ *Id.*

⁹⁸ 813 F.3d 891, 905 (9th Cir. 2016).

⁹⁹ See generally, Michael Feinberg, *A Collision Course Between the Right of Publicity and the First Amendment: The Third and Ninth Circuit Find Ea Sports's NCAA Football Video Games Infringe Former Student-Athletes Right of Publicity*, 11 SETON HALL CIRCUIT REV. 175, 201 (2014) (detailing lower court application of right to publicity law and its defenses).

¹⁰⁰ 110 S.W.3d 363 (Mo. 2003)

speech.¹⁰¹ In *Keller v. EA Sports*,¹⁰² as well as *O'Bannon*¹⁰³ and *Davis*,¹⁰⁴ the Ninth Circuit rejected EA Sports' argument that the use of athletes as avatars was transformative.¹⁰⁵ The court applied its ruling from *No Doubt v. Activision Publishing, Inc.*¹⁰⁶ holding that literal recreations are not transformative, even if there are many other elements of creative expression.¹⁰⁷ The court held that the use was not incidental, but was instrumental in the making of the realistic product.¹⁰⁸ In *Hart*,¹⁰⁹ the Third Circuit followed suit and applied the Ninth Circuit precedent when another former college football player sued EA Sports for using his likeness in college football game.¹¹⁰

IV. USER GENERATED CONTENT AND PRIVACY RIGHTS

Game modding allows users to generate new content which can be shared with other users.¹¹¹ Contemporary games also allow users to upload anyone's photo which can be used to create avatars.¹¹² The following paragraphs analyze the potential liability when it comes to users creating avatars based on celebrities or private individuals.

A. Modding and the Right of Publicity

Video games may receive First Amendment protection,¹¹³ but pursuant to a line of right of publicity cases, producers can be held liable.¹¹⁴ As a result, EA Sports has suspended the production of its college games because it has not figured out a way to produce the games without having to pay the amateur athletes for the use of their likeness, which would be expensive and also would violate current NCAA rules.¹¹⁵ But,

¹⁰¹ *Id.* at 374. If the expressive is predominantly a comment about the celebrity than it may be protected. *Id.* The predominant test was rejected by the Third Circuit in *Hart* where they applied transformative test. *Hart*, 717 F.3d at 163.

¹⁰² *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268.

¹⁰³ *O'Bannon*, 7 F. Supp. 3d at 962-63.

¹⁰⁴ *Davis*, 775 F.3d 1172.

¹⁰⁵ *See supra* notes 102-104.

¹⁰⁶ 192 Cal. App. 4th 1018 (2011).

¹⁰⁷ *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d at 1277-79; *Davis*, 775 F.3d at 1177-79.

¹⁰⁸ The courts applied the same rationale in *O'Bannon* and *Davis*. *See id.*; *O'Bannon*, 7 F. Supp. 3d at 962-63.

¹⁰⁹ *Hart*, 717 F.3d at 161-70

¹¹⁰ *Id.*

¹¹¹ *See supra* Part II.

¹¹² Kevin Wong, *You Can Scan Your Face Into 'NBA 2K17' With Your Phone*, MOTHERBOARD (Sept. 23, 2016), https://motherboard.vice.com/en_us/article/nba-2k17-facial-scanning-mobile-app.

¹¹³ *Brown*, 564 U.S. at 790.

¹¹⁴ *See supra* notes 102-104.

¹¹⁵ Ben Kerchevell, *EA Sports Executive: NCAA Football Video Game Will Return Sooner or Later*, CBS SPORTS, (August 3, 2016), <http://www.cbssports.com/college-football/news/ea-sports-executive-ncaa-football-video-game-will-return-sooner-or-later/>.

there is still a way to circumvent the precedent from the EA Sports' cases¹¹⁶ as users can modify the games.

The games usually have a built-in player modifier which allows users to create the personas of athletes.¹¹⁷ Also, game producers may create mod kits which can allow users to create the missing personas at the code level.¹¹⁸ With both of these uses, gamers may be able to share created characters or mods through connected systems.¹¹⁹ Certainly, this is a use of a celebrity's likeness without consent, but the question remains whether it would be considered commercial.

In *Hart*,¹²⁰ the Third Circuit held that the producer's use of the likeness was not protected because it was not transformative.¹²¹ The game producer argued that since users could edit the characters, it was now transformative.¹²² But the court did not accept that argument as being sufficient.¹²³ But what was not at issue, was the reverse argument—if the game producer allowed the user to create the entire character would that then be transformative.¹²⁴ Complete control in the hands of the consumer would seem to then be sufficient as there would be so many variations that could be made to the likeness that it would not necessarily be exact.¹²⁵

But this type of modding may still create a threat of liability.¹²⁶ Right to publicity is aligned with copyright law and much of the concepts are similar.¹²⁷ First, a mod is a derivative of the original copyrighted work which is often sanctioned by game producers who make mod kits.¹²⁸ Even, if a celebrity gives permission for the use of the likeness in the original game, they may not have given permission for use in all derivatives.¹²⁹ Also, a derivative work has to be mindful of a use of a licensed copyrighted character, because the actor may have a separate publicity right in that likeness.¹³⁰

¹¹⁶ See *supra* Part III.B.

¹¹⁷ See *supra* Part III.

¹¹⁸ *Id.*

¹¹⁹ *Id.*

¹²⁰ *Hart*, 717 F.3d at 167.

¹²¹ *Id.*

¹²² *Id.*

¹²³ “[U]nder [Appellee’s] application of the transformative test [sic], presumably no infringement would be found if individuals such as the Dalai Lama and the Pope were placed within a violent ‘shoot-em-up’ game, so long as the game include[d] a ‘mechanism’ by which the user could manipulate their characteristics.” *Id.*

¹²⁴ “Given that Appellant’s unaltered likeness is central to the core of the game experience; we are disinclined to credit users’ ability to alter the digital avatars in our application of the Transformative Use Test to this case.” *Id.* at 168.

¹²⁵ *Cf. Noriega*, No. BC 551747, 2014 WL 5930149, at *5 (holding that using public figure’s name and likeness was incidental to overall expressive speech).

¹²⁶ The possibility of liability moves beyond economic and privacy infringement to also include negligence and incitement. See Jennifer Jones, *Evolving Entertainment Technology: Can New Types of Fun Lead to New Types of Liability?*, 13 YALE J. L. & TECH. 188 (2011).

¹²⁷ Jennifer E. Rothman, *Commercial Speech, Commercial Use, and the Intellectual Property Quagmire*, 101 VA. L. REV. 1929, 1950 (2015).

¹²⁸ *Micro Star*, 154 F.3d at 1112-13.

¹²⁹ *Facenda*, 542 F.3d at 1032.

¹³⁰ *Wendt*, 125 F.3d at 811.

Next, in copyright law there can be secondary liability.¹³¹ This of course depends on the constructive knowledge of the game producers.¹³² If we extend this doctrine to right of publicity infringement, it would be hard for producers to argue that they are not aware that gamers can modify games to create such likenesses.¹³³ This alone may rise to the level of constructive knowledge.¹³⁴ Certainly, if the game producers advertised somewhere in their marketing literature that users could create such avatars, then the celebrity plaintiffs could establish that the producers had knowledge and should be considered to have vicarious liability.¹³⁵ A court could then find that such a scheme was a clear attempt to circumvent *Keller*.¹³⁶ Ultimately, it would be best for game producers to take steps to limit liability by issuing a warning in end user license agreements about the use of celebrity likenesses in user generated content.¹³⁷

B. User Generated Content and Misappropriate of Likeness

Just as users may be inspired to create avatars who resemble celebrities, they may model avatars after non-celebrities as well.¹³⁸ They may make avatars who look like themselves.¹³⁹ They can then share these avatars with other users who are connected through game systems or sites.¹⁴⁰ Gamers may also choose to model their

¹³¹ Seth Ascher, *Will Sony's Fourth PlayStation Lead to A Second Sony v. Universal?*, 12 DUKE L. & TECH. REV. 231, 244-245 (outlining secondary liability for connected gaming consoles). In copyright law, secondary liability is meant to be enforced against who financially benefitted from the infringement but who did not employ the infringer. *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 259 (9th Cir. 1996).

¹³² *Id.*

¹³³ Create-a-player function and the connectedness of systems is often advertised by game producers. In *Keller*, the player's name was never used, but the users could add them to the characters. Patrick Vint, *The NCAA Knew EA Sports had Real Players 'Hidden' in College Football Games*, SB NATION (Feb. 28, 2014), <http://www.sbnation.com/college-football/2014/2/28/5455374/obannon-vs-ncaa-football-ea-sports-video-games>.

¹³⁴ See Ascher, *supra* note 131.

¹³⁵ See *Doe v. TCI Cablevision*, 110 S.W.3d 363, 371 (Mo. 2003) (arguing that comic book producers were liable because they targeted the product towards hockey fans who would recognize the subtlety of the likeness). In *Grokster v. MGM*, the Court added inducement to secondary liability in copyright law, when a third party "distributes a device with the object of promoting its use to infringe copyright, as shown by clear expression or other affirmative steps taken to foster infringement." 545 U.S. 913 (2005).

¹³⁶ *Keller*, 724 F. 3d 1268 (9th Cir. 2013); *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013); 135 S.Ct 42 (2014) (denying cert); *O'Bannon v. Nat'l Collegiate Athletic Ass'n*, 7 F. Supp. 3d 955, 962-63 (N.D. Cal. 2014); 137 S.Ct. 277 (Mem) (2016) (denying cert).

¹³⁷ See *Grokster v. MGM*, 545 U.S. 913 (2005); see generally Rebecca Giblin, *A Bit Liable? A Guide to Navigating the U.S. Secondary Liability Patchwork*, 25 SANTA CLARA COMPUTER & HIGH TECH. L.J. 7, 15-16 (2009).

¹³⁸ See *supra* Part II.

¹³⁹ Kevin Wong, *You Can Scan Your Face Into 'NBA 2K17' With Your Phone*, MOTHERBOARD (Sept. 23, 2016), https://motherboard.vice.com/en_us/article/nba-2k17-facial-scanning-mobile-app

¹⁴⁰ The Nintendo Wii allowed users to connect and share their created Mii characters. The Nintendo Switch will not have the Miiverse. See Matt Peeckham, *19 Things Nintendo President told us about Switch and More*, TIME (Feb. 2nd, 2017), <http://time.com/4662446/nintendo-president-switch-interview/>.

avatars off of other people—family, friends, acquaintances, or any one of whom they can get a picture—even if they do not know them.¹⁴¹

Certainly, if users share avatars embodying their own likeness, then they have given consent for others to use it.¹⁴² But they may not have given a complete license for any use or waived any liability for third party use.¹⁴³ It is foreseeable that in a game such as *Grand Theft Auto*, where characters are murdered, raped or otherwise abused, the avatar creator may still have a cause of action if they did not give a blanket license allowing for such use.¹⁴⁴ More unsettling is if the avatar that resembles you was not created by you.¹⁴⁵

When your avatar is put through emotionally distressing events such as ridicule, torture, crime or sexual abuse, there is a stronger claim to a misappropriation as it causes emotional distress and is done without consent.¹⁴⁶ This type of claim is more foreseeable with virtual reality where the distinction between the two worlds is blurred and the reactions could be much stronger.¹⁴⁷ A user may be able to create a world where they play out deviant sexual fantasies with an avatar based on your likeness without your knowledge or consent.¹⁴⁸ Unbeknownst to you, a user could download a current picture of you from social media or even go back to a photo from years earlier to create an avatar that he or she controls in this virtual world.¹⁴⁹ In a case such as this, it is easy to imagine why a person would suffer emotional distress (once it is discovered).¹⁵⁰

When it comes to the use of private identities, it is more difficult to find game producers liable for such action. Game producers would not be able to control every individual user, but, it is not totally unforeseeable that such a use would occur.¹⁵¹ Nonetheless, it would be a very broad policy to have strict liability for the third-party game producer in these cases as it would be harder to show that they received any unjust enrichment from this exact use.¹⁵² But if game producers were receiving complaints, then they should act.¹⁵³

¹⁴¹ See *supra* Part II.

¹⁴² See *id.*

¹⁴³ End User License Agreements usually state that a user gives a license for the producer to use avatars.

¹⁴⁴ See Oliver A. Khan, *Me, Myself, and My Avatar: The Right to the Likeness of Our Digital Selves*, 5 I/S: J.L. & POL'Y FOR INFO. SOC'Y 447 (2010).

¹⁴⁵ See generally Koch, *supra* note 8, at 263.

¹⁴⁶ Jaclyn Seelagy, *Virtual Violence*, 64 UCLA L. REV. DISCOURSE 412 (2016) (arguing that harms perpetrated in virtual worlds can have psychological effects in the real world). See *supra* Part III. May also rise to the level of harassment or infliction of emotional distress.

¹⁴⁷ See *id.* at 421-26.

¹⁴⁸ See Zenor, *supra* note 93, at 570-71.

¹⁴⁹ *Id.* There is currently no precedent that holds that VR technology will receive first amendment protection.

¹⁵⁰ See *Haith v. Model Cities Health Corp. of Kansas City*, 704 S.W.2d 684, 688 (Mo. App. 1986) (explaining that misappropriation of likeness requires a showing of mental anguish).

¹⁵¹ See Koch, *supra* note 8, at 263.

¹⁵² See Veronica Corsaro, *From Betamax to Youtube: How Sony Corporation of America v. Universal City Studios, Inc. Could Still Be A Standard for New Technology*, 64 FED. COMM. L.J. 449, 455-56 (2012).

¹⁵³ NCAA knew about EA Sports using the likenesses of NCAA Athletes and did nothing. See Vint, *supra* note 133.

The real liability would be with individual users who created the avatars.¹⁵⁴ In states that allow for causes of action for any exploitation, not just commercial,¹⁵⁵ it is possible that such a use would rise to that level. Certainly, it is foreseeable that a jury would find such a use repulsive and seek a way to make the plaintiff whole again.¹⁵⁶

But, a transformative use defense may be available to the producer of the avatar, even in cases where the likeness is of a private individual.¹⁵⁷ The use would have to be not predominant- maybe just a face or name and the rest of the character would have to be something more.¹⁵⁸ So, an avatar that uses a real person's face, but the character is wizard with purple skin who can fly,¹⁵⁹ the avatar's creator could argue that he or she has added additional creativity to make it transformative. Moreover, it would be difficult to argue that such a use caused emotional distress.¹⁶⁰

V. CONCLUSION

Right of publicity law is expanding with courts forcing speech protected by the First Amendment to be balanced with tort liability for misappropriation of likeness. Most of these cases have involved celebrities. Thus, game producers can no longer use their likeness without consent if the likeness is the predominant selling point for the game. In these situation, the companies have to pay the celebrities or not use the likeness.

However, with contemporary gaming technology these seem like incomplete answers for celebrities. Users can easily modify games in order misappropriate likeness and producers are often the ones providing the tools to do so. Unfortunately, celebrities will have difficulty defending this protected right of publicity once the infringement is widespread and dispersed amongst the consumers.

Moreover, when it comes to private individuals, many jurisdictions do not recognize a separate misappropriation tort when there is not a commercial value to the likeness. But with virtual reality technology, maybe courts should begin to refocus this area of the law on the private person plaintiff rather than the celebrity plaintiff.

When ordinary persons pose for a picture, they are not consenting to have their identity taken from them. Certainly, they are not consenting for it to be shared by complete strangers on social media, though it is legal for people to do so. They are certainly not consenting for it to be used in advertising, though it may appear there anyway. And it has probably never crossed their mind that a picture such as this could be used to make an avatar which embodies their likeness in a virtual world.

¹⁵⁴ See Corsaro, *supra* note 152, at 474 (arguing that courts are reluctant to punish third-parties' ISPs for the acts of users).

¹⁵⁵ There is a "difference between the personal, injured-feelings quality involved in the appropriation, privacy tort and the property, commercial value quality involved in the right of publicity tort." *Berosini*, 111 Nev. at 636.

¹⁵⁶ See Koch, *supra* note 8, at 263.

¹⁵⁷ See *Sarver v. Chartier*, 813 F.3d 891, 905 (9th Cir. 2016).

¹⁵⁸ *Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47, 50 (2006) (holding that an avatar who was extremely tall, slender, with a computer-generated physique and worked as a space-age reporter in the 25th century was not a likeness of a popular recording artist).

¹⁵⁹ *Id.*

¹⁶⁰ *Id.* at 609-10 (arguing that a mere likeness used in an otherwise 'fanciful' character is not considered a use for right of publicity).

But this is the technology that is available today and such appropriating is certainly happening. Game modding allows for people to change constructed virtual worlds. Soon virtual reality technology will allow people to essentially live in these worlds. At that point, ordinary pictures will become the tools from which other people will be able to create an alternate you that they control.