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## Frank Miller's Sin City College Football: A Game to Die For And Other Lessons About the Right of Publicity and Video Games

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# Frank Miller’s Sin City College Football: A Game to Die For And Other Lessons About the Right of Publicity and Video Games

Jordan M. Blanke\*

## *Abstract*

*The challenge of finding a workable solution for applying the right of publicity is a formidable one because it implicates not only a delicate balance between First Amendment rights and the rights of publicity, but also the complications of varying state laws. The best of the tests developed by the courts so far—the transformative use test—was borrowed from copyright law and itself reflects a careful balance between First Amendment and copyright interests. Additionally, because of dramatic progress in technology, it is likely that in the near future this balancing will often involve not only the rights of publicity and the First Amendment but also copyright law as well.*

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### I. Introduction

In his excellent Note, Garrett Rice proposes a simple one-sentence test as a solution for applying the right of publicity to video games.<sup>1</sup> He outlines the history of the right of publicity and discusses the seminal cases, both those prior to and during the video game era.<sup>2</sup> He examines the three most commonly used tests, the *Rogers* test, the predominant use test, and the transformative use test and appropriately rejects the first two outright.<sup>3</sup> The *Rogers* test just was not designed nor intended to apply to something as complex as a video game, and the predominant factors test has been correctly described as “subjective at best, arbitrary at worst.”<sup>4</sup>

The transformative use test, developed by the California Supreme Court in *Comedy III Productions v. Gary Saderup, Inc.*,<sup>5</sup> (*Comedy III*) is “essentially a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness

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1. See generally R. Garrett Rice, Note, “Groove is in the Hart:” A Workable Solution for Applying the Right of Publicity to Video Games, 72 WASH. & LEE L. REV. 317 (2015).

2. See *id.* (providing a thorough discussion of the relevant history of the right and seminal case law animating it).

3. See *id.* at 333–40 (maintaining that the application of these tests has produced inconsistent and unpredictable results).

4. *Id.* at 362.

5. 21 P.3d 797 (Cal. 2001).

or imitation.”<sup>6</sup> This test has been the most commonly used one, but as Rice notes, it “is subjective and difficult to apply consistently as . . . contradicting district court rulings . . . highlight.”<sup>7</sup>

Rice proposes a “readily identifiable” standard: “A video game violates an individual’s right of publicity if a person familiar with the individual would look at a video game character and know *immediately* that the character is *definitively* based on the real individual.”<sup>8</sup> Application of the test compares favorably with existing precedent. Rice applies it to five of the more recent video game cases with good results, yielding the same results as those found by the courts.<sup>9</sup>

There remain, however, some larger issues that cast shadows on this still-developing area of law. I believe that there are four major challenges that still plague the balancing between and among the rights of publicity, the First Amendment, and copyright law.

There is a great deal of First Amendment protection for both news reporting about public events, like football games, and for publicly available information, like the statistics generated by a football game.<sup>10</sup> How will this federal protection be balanced against state right of publicity laws?

State right of publicity laws vary greatly.<sup>11</sup> Will a federal standard be able to apply to all the variations in these laws?

Most right of publicity laws protect one’s “name and likeness,” and courts have traditionally treated it as one interest. Will courts continue the trend towards considering “name” and “likeness” as separate interests?<sup>12</sup>

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6. *Id.* at 799.

7. *See* Rice, *supra* note 1, at 363.

8. *Id.* at 366.

9. *See id.* at 373–77 (indicating that the proposed test produces the same results with greater predictability and ease).

10. *See infra* Part III.A (noting that First Amendment protection exists because these are matters in the public interest and are not subject to copyright protection).

11. *See infra* Part III.B (pointing out that some states protect more characteristics than other states).

12. *See infra* Part III.C (indicating that courts sometimes discuss “name and likeness” as an interest without distinguishing between the two).

Tests that attempt to balance interests involving the First Amendment and the right of publicity (or the First Amendment and copyright) generally look at how much transformation there is between the original work and the second work. Just how much transformation is *enough* transformation to warrant independent protection for the second item?<sup>13</sup>

## II. Frank Miller's *Sin City College Football: A Game to Die For*

Before addressing these issues in more detail, let me first present a hypothetical example. Suppose that Arts Electronic, Inc. (AE) releases a new video game called *Frank Miller's Sin City College Football: A Game to Die For*. The graphics in the game are quite beautiful—very stylized—just like a carefully drawn graphic novel. Most of the game is in black and white, although there are some brief bursts of color—mostly red. The field upon which the game is played is not your typical football field. The sidelines change continually. Sometimes there are cliffs, sometimes there are brick walls, and sometimes there are just dark, open spaces. The coach for one of the teams is Woody Hayes, of Ohio State fame—the other coach is Bear Bryant, of Alabama.

One of the quarterbacks looks just like Ryan Hart<sup>14</sup> and another one just like Sam Keller.<sup>15</sup> The Hart character is interesting—with the pointer finger of his right hand he can levitate opposing players for fractions of a second. And the Keller character has the ability to become invisible for split seconds at a time. Both of these skills come in very handy on dashes to those

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13. *Infra* Part III.D.

14. Ryan Hart played quarterback at Rutgers University from 2004 to 2005. He brought suit against EA, alleging that his right of publicity had been violated because of his depiction in EA's *NCAA Football* video game. The district court found for EA, *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757 (D.N.J. 2011), but the circuit court reversed, finding for Hart, 717 F.3d 141 (3d Cir. 2013). See Rice, *supra* note 1, at 320–21.

15. Sam Keller played quarterback at Arizona State University from 2003 to 2005. He brought a similar action against EA and won at both the district court and circuit court level, *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 WL 530108 (N.D. Cal. Feb. 8, 2010), *affirmed sub nom.*, *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013). See Rice, *supra* note 1, at 320–21.

sidelines. There are two other characters in the game worth mentioning. First, there is a very large and brutal defensive lineman called Tony Twist—he is quite the enforcer. Second, there is a wide receiver named Ulala, who has quite an array of very tricky moves.

Obviously, there would be some major trademark and copyright obstacles. Absent a license agreement from Frank Miller, Robert Rodriguez, or Dimension Films, trademark law would almost certainly prevent the use of either “Frank Miller” or “Sin City” in the title of the game.<sup>16</sup> Similarly, there would probably be a successful copyright action if the expression in the game is as “substantially similar,” as the description above suggests, to the film and graphic novels upon which the film is based.<sup>17</sup> Beyond that, however, some interesting questions remain.

### III. Four Challenges

#### A. How Will Federal First Amendment Protection Be Balanced Against State Right of Publicity Laws?

There is a great deal of First Amendment protection for public events, including sporting events.<sup>18</sup> The statistics

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16. While it might be difficult for Frank Miller to claim trademark protection in his name itself, the fact that it has been used in connection with *Sin City* several times would be important. See Brandon Johansson, Note, *Pause the Game: Are Video Game Producers Punting Away the Publicity Rights of Retired Athletes?*, 10 NEV. L.J. 784, 806 (2010); Anthony M. Verna III, *www.whatisina.name*, 14 SETON HALL J. SPORTS & ENT. L. 153 (2004).

17. See *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1406 (9th Cir. 1997) (holding that an author had mimicked the very distinctive style of Dr. Seuss and that the work was not a parody, was not transformative, and was not a fair use).

18. See generally Jordan M. Blanke, *No Doubt About It—You’ve Got to Have Hart: Simulation Video Games May Redefine the Balance Between and Among the Right of Publicity, the First Amendment, and Copyright Law*, 19 B.U. J. SCI. & TECH. L. 26 (2013). See also *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639, 641–43 (Cal. Ct. App. 1995) (holding that not only were newspaper accounts and photographs of Joe Montana’s performances in the Super Bowl entitled to First Amendment protection because they were matters in the public interest, but so were posters containing those same photographs).

generated by performance of a game are readily available in newspapers, protected by the First Amendment, and not subject to copyright protection.<sup>19</sup> The fantasy sports cases from a few years ago plainly spell that out. In *C.B.C. Distribution & Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*,<sup>20</sup> (CBC) there was a question as to whether a licensing agreement was required in order for a fantasy sports league to use the names and biographical information of baseball players, along with the statistics generated by their performances on the field. The Eighth Circuit held that the players did have rights of publicity in that information under Missouri law, but that CBC's First Amendment rights outweighed those rights of publicity.<sup>21</sup> The court held that because the information used by CBC in its fantasy games was already in the public domain, its use was clearly protected by the First Amendment.<sup>22</sup> The court noted how important statistics and records had become in baseball and how it was part of the appeal of the game.<sup>23</sup> Because the court held that First Amendment rights outweighed rights of publicity, it did not address whether federal copyright law would preempt state rights of publicity.<sup>24</sup>

A district court in the Eighth Circuit took this holding even further. In *CBS Interactive Inc. v. NFL Players Ass'n, Inc.*,<sup>25</sup> (CBS) the District Court for the District of Minnesota held, as a matter of law, that CBS could use in its fantasy football game not only the names and statistics of the players but also the entire "package" of information about the players, including "names, player profiles, up-to-date statistics, injury reports, participant blogs, pictures, images, and biographical information."<sup>26</sup>

The environment for fantasy sports changed dramatically after these cases. For example, in the video game *MVP Baseball*

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19. See generally *Blanke*, *supra* note 18, at 47–50.

20. 505 F.3d 818 (8th Cir. 2007). The Supreme Court denied a petition for writ of certiorari, *MLB Adv. Media v. C.B.C. Distribution & Mktg., Inc.*, 553 U.S. 1090 (2008).

21. *C.B.C.*, 505 F.3d at 822–24.

22. *Id.* at 823.

23. *Id.*

24. *Id.* at 824.

25. 259 F.R.D. 398 (D. Minn. 2009).

26. *Id.* at 417.

2005, the slugging right fielder of the San Francisco Giants was named Jon Dowd, rather than Barry Bonds, because Bonds had not signed the Major League Players Association Licensing Agreement, and it was not clear whether the gaming companies could use Bonds's name in the game without his consent. The performance of the Jon Dowd character in the game was identical to how the Bonds character would have performed because the programmers used Bonds's statistics to generate the character. Certainly after the *CBC* and *CBS* cases, it is clear that fantasy sports games can include use of both the names of players and the statistics generated by the players.

Many video games contain what is often called a career mode or a franchise mode. Rather than playing a game in which the user simulates the action of a sport by manipulating a keyboard or control pad to pitch, hit, throw, run, catch, kick or tackle, the user becomes, in effect, a general manager of the team. He or she drafts players, makes trades, sets starting lineups and rotations, and selects plays. Individual games or seasons of games can then be simulated, producing wins, losses and all the statistics a user cares to generate. These modes typically do not contain, nor do they need to contain, in order to be realistic, any images or likenesses of the players.

It certainly follows from the *CBC* and *CBS* cases that all of the information used and generated in these career or franchise modes are protected by the First Amendment. Under the *CBS* holding, even pictures and images of the players would be protected.<sup>27</sup> Even for the action modes of these video games, the *CBS* holding would suggest that the First Amendment would protect pictures and images of the players.<sup>28</sup>

To a large extent, this issue goes beyond the test proposed by Rice. While he states about his test that "a video game deserves

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27. See *id.* ("Thus, like in *C.B.C. Distribution*, the package of information used here comes within the ambit of the First Amendment.").

28. It is certainly still the case that copyrighted photographs or images would not be able to be used in a video game without proper licensing; and it is certainly still the case that the logos of teams or leagues would not be able to be used without proper licensing. Even the *CBS* holding did not go as far as to include logos within the "package" of information that could be used without licensing. *Id.* However, just like the names of players, the names of teams and leagues should be fully protected by the First Amendment for use in a reality-based sports game as they are readily and publicly available.

First Amendment protection if the individual's likeness is not both immediately and definitely obvious," there may be certain situations, like those in a career mode of a video game and possibly even in an action mode—certainly according to *CBS*—where First Amendment interests will simply outweigh rights of publicity, and whether a character is readily identifiable is irrelevant.<sup>29</sup>

*B. How Will a Federal Standard Apply to the Variety of State Publicity Laws?*

Thirty-one states recognize the right of publicity either by statute or by common law.<sup>30</sup> The laws vary greatly from state to state.<sup>31</sup> Some protect more characteristics of a person than others. For example, New York protects only one's "name, portrait, picture or voice,"<sup>32</sup> while California protects one's "name, voice, signature, photograph, or likeness,"<sup>33</sup> and Indiana protects one's "name, voice, signature, photograph, image, likeness, distinctive appearance, gesture, or mannerisms."<sup>34</sup> Certainly, under Indiana law, one could allege that a unique batting stance or a particular way of celebrating a touchdown has been misappropriated by a video game's realistic portrayal of that activity.

Even more troubling are the issues surrounding post-mortem rights of publicity and jurisdictional ramifications.<sup>35</sup> Some states

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29. See Rice, *supra* note 1, at 366–73 (advocating for a readily identifiable test).

30. See *id.* at 330 nn.82–83.

31. See Blanke, *supra* note 18, at 61–65 ("Among the . . . variations . . . are: (1) the scope of the right; (2) the rights of the deceased; (3) the duration of the right; (4) the jurisdictional domiciliary requirements; and (5) whether or not the right is to be applied retroactively."); see also Brittany A. Adkins, Comment, *Crying Out for Uniformity: Eliminating State Inconsistencies in Right of Publicity Protection Through a Uniform Right of Publicity Act*, 40 CUMB. L. REV. 499, 501 (2010) ("[M]ost . . . states vary substantially in the methods chosen to protect one's right to control the commercial exploitation of his or her persona . . .").

32. N.Y. CIV. RIGHTS LAW § 51 (McKinney 2002).

33. CAL. CIV. CODE § 3344(a) (West 2012).

34. IND. CODE ANN. § 32-36-1-7 (West 2002).

35. See Blanke, *supra* note 18, at 61–65 (noting that states' laws vary greatly on this issue, which can entirely foreclose relief for plaintiffs).

provide for descendible and assignable rights of publicity after one's death.<sup>36</sup> Under California law, this right can last for 70 years after death, in Indiana and Oklahoma, 100 years, and in Tennessee, forever.<sup>37</sup> Cases have already dealt with complex issues pertaining to place of domicile, place of death, and whether the statutory or common law right of publicity existed at the time and place of death.<sup>38</sup>

In my *Frank Miller's Sin City College Football* example, Woody Hayes and Bear Bryant were domiciliaries of and died in Ohio and Alabama, respectively. Even if the laws of those two states do not provide for protection as broad as Indiana law or for as long as Indiana law, it may not matter to their heirs or assignees. Indiana law "applies to an act or event that occurs within Indiana, regardless of a person's domicile, residence, or citizenship."<sup>39</sup> Both Hayes and Bryant no doubt played some big games against Notre Dame and Purdue within the state of Indiana. Furthermore, as long as a t-shirt with their image or a video game with their name or likeness or distinctive appearance or mannerism was sold in Indiana, an action may exist under Indiana law.

There is, however, a big question as to whether states that do not have as broad a right of publicity will respect such reach. In *Shaw Family Archives Ltd. v. CMG Worldwide, Inc.*,<sup>40</sup> the District Court for the Southern District Of New York refused to recognize a right of publicity interest under Indiana law because at the time of her death, the deceased (Marilyn Monroe), was not an Indiana domiciliary nor did a post-mortem interest even exist under Indiana law.<sup>41</sup>

In *Experience Hendrix L.L.C. v. Hendrixlicensing.com Ltd.*,<sup>42</sup> the Ninth Circuit decided a case involving a Washington state

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36. *Id.* at 62–63; see Adkins, *supra* note 31, at 500–01 (describing differences in state law).

37. CAL. CIV. CODE § 3344.1(g); IND. CODE ANN. § 32-36-1-8; OKLA. STAT. ANN. tit. 12, § 1448(G) (West 2010); Tenn. Code Ann. § 47-25-1104(b)(2) (2012).

38. See generally Blanke, *supra* note 18, at 62–64; Adkins *supra* note 31, at 505–29.

39. IND. CODE ANN. § 32-36-1-1 (West 2002).

40. 486 F. Supp. 2d 309 (S.D.N.Y. 2007).

41. *Id.* at 314–16.

42. 742 F.3d 377 (9th Cir. 2014).

right of publicity statute that applied “regardless of place or domicile or place of domicile at time of death.”<sup>43</sup> The court stated that “Washington’s approach to post-mortem personality rights raises difficult questions regarding whether another state must recognize the broad personality rights that Washington provides.”<sup>44</sup> While deciding that the statute was applicable in the instant case and that it need not address that broader issue, the court noted that a New York case had found to the contrary in *Shaw*.<sup>45</sup>

While there have been arguments for a uniform right of publicity<sup>46</sup> and for a federal right of publicity,<sup>47</sup> I believe that the more likely resolution and the more practical approach will come from First Amendment or copyright preemption jurisprudence from the circuit courts and, eventually, from the Supreme Court.

*C. Will Courts Continue to Treat “Name” and “Likeness”  
Differently than “Name and Likeness?”*

Most right of publicity laws protect, among varying other things, one’s “name and likeness.”<sup>48</sup> We are starting to see—and I think will continue to see—some distinctions being made between the two separate terms and the whole. In the *CBC* fantasy stats case, the Eighth Circuit held that the names of the players and

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43. WASH. REV. CODE ANN. § 63.60.010 (West, Westlaw through 2013 legislation).

44. *Experience Hendrix*, 742 F.3d at 384.

45. *Id.* at 385 n.6.

46. See Adkins, *supra* note 31, at 524–53 (explaining that states vary on the right of publicity); Rice, *supra* note 1, at 353–54 nn.242–47 (proposing a readily identifiable standard).

47. See Susannah M. Rooney, Note, *Just Another Brown-Eyed Girl: Toward a Limited Federal Right of Publicity Under the Lanham Act in a Digital Age of Celebrity Dominance*, 86 S. CAL. L. REV. 921, 944–57 (2013) (determining that Congress has this authority through the Commerce Clause); Sean D. Whaley, “*I’m a Highway Star*”: *An Outline for a Federal Right of Publicity*, 31 HASTINGS COMM. & ENT. L.J. 257, 260–66 (2009) (providing economic, moral, and federal authority justifications); Rice, *supra* note 1, at 354–57 nn.248–69 (proposing a unique federal standard); Blanke, *supra* note 18, at 64 n.332 (analyzing copyright law).

48. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46–49 (1995) (providing an overview of right of publicity laws); Rice, *supra* note 1, at 330 nn.82–83 (listing state right of publicity laws, either codified or in common law).

the statistics generated by their performances in a game were protected by the First Amendment.<sup>49</sup> In the *CBS* case, a district court in Minnesota extended that holding significantly, including within that “package” of information, pictures, and images of the players.<sup>50</sup> Obviously, this issue will be significant for video games, particularly those that are reality-based.

In the *Keller* case, the Ninth Circuit held that “[u]nder California’s transformative use defense, EA’s use of the *likenesses* of college athletes like Samuel Keller in its video game is not, as a matter of law, protected by the First Amendment.”<sup>51</sup> In *O’Bannon v. National Collegiate Athletic Ass’n*,<sup>52</sup> which dealt with several issues besides rights of publicity, the court spoke many times throughout its decision about “name and likeness,” but when it discussed the *Keller* holding, it not insignificantly referred to “likenesses” rather than “names and likenesses.”<sup>53</sup>

Somewhat ironically, the *NCAA Football* games included everything *but* the names of the players.<sup>54</sup> They included detailed biographical and physical information, player uniform numbers, performance ratings based upon actual game data, and accurate graphical depictions of the players.<sup>55</sup> Certainly, in the context of the game, it was clear to a user who the characters in the game were because of the likenesses and the other biographical and statistical information. Users could add the names of the players if they so desired, and apparently, there were files available for

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49. See *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F. 3d 818, 822–23 (8th Cir. 2007) (discussing the First Amendment claims brought by plaintiffs).

50. See *CBS Interactive Inc. v. Nat’l Football League Players Ass’n, Inc.*, 259 F.R.D. 398, 417 (D. Minn. 2009) (explaining that the package of information at issue in the case falls under First Amendment protection).

51. *In re NCAA Student–Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1284 (9th Cir. 2013).

52. 7 F. Supp. 3d 955 (N.D. Cal. 2014). For a thorough discussion of *O’Bannon*, see Marc Edelman, *O’Bannon: A Small Step Forward for College-Athlete Rights, and a Gateway for Far Grander Change*, 71 WASH. & LEE L. REV. 2319 (2014).

53. See *O’Bannon*, 7 F. Supp. 3d at 977 n.13 (discussing *Keller’s* holding regarding the use of college athletes’ likenesses).

54. See, e.g., *NCAA FOOTBALL 2005* (Electronic Arts, Inc. 2004) (depicting athletes but not including their names).

55. See, e.g., *id.* (providing many biographical details on players).

download that would add the names of all the players to the game.<sup>56</sup>

A simple explanation for why the *O'Bannon* court may have referred to “likenesses” is that the *NCAA Football* game did not include the players’ names. However, in the context of the game, there was no doubt who the characters were. Furthermore, a better argument could be made by the players that they have a stronger right of publicity interest in their likenesses than in their names. As discussed above, the names and numbers of the players, along with the statistics generated by their on-field performances, would almost certainly be protected in both the career mode and the action mode of the game by the First Amendment.<sup>57</sup> It still remains to be seen whether the holding of the *CBS* case will be extended to also protect pictures and images of players in the game.

*D. How Much Transformation is Enough Transformation to Warrant Independent Protection for a Second Work?*

The last challenge may be the most difficult: just how much transformation is enough transformation for a derivative item to warrant independent protection? This issue is not new to video games.<sup>58</sup> It has been at the heart of the controversy in attempting to balance the interests protected by the First Amendment and by rights of publicity—and sometimes, also, by copyright.<sup>59</sup> The

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56. See, e.g., *id.* (allowing game users to add the names of players).

57. See, e.g., *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media*, 505 F.3d 818, 822–23 (8th Cir. 2007) (discussing First Amendment protection of player information).

58. See *Blanke*, *supra* note 18, at 33–46 (addressing right of publicity for baseball cards and other images).

59. In *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001), a case decided around the same time as *Comedy III*, the court held that there was First Amendment protection for a computer-altered photograph of actor Dustin Hoffman in a scene reminiscent of his role as a woman in the film *Tootsie*. It is one of the first times that a court recognized that the balancing might involving *three* important interests: “We evaluate this defense aware of the careful balance that courts have gradually constructed between the right of publicity and the First Amendment and federal intellectual property laws.” See *id.* at 1183–84 (quoting *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000)). See generally *Blanke*, *supra* note 18 (covering First Amendment protection and rights of publicity).

problem is probably best exemplified by the discussion in *Comedy III* about the difference between an Andy Warhol rendition of Marilyn Monroe and a Gary Saderup rendition of the Three Stooges.<sup>60</sup>

Gary Saderup is an artist.<sup>61</sup> He created a drawing of the Three Stooges.<sup>62</sup> When his company began selling t-shirts with this image, he was sued by another company that held the descendible rights of publicity of the Three Stooges, claiming an interest under California law.<sup>63</sup> One of the toughest issues the court had to grapple with—and one I do not think it satisfactorily resolved—was how is a court supposed to determine when an “artist” adds enough “significant transformative or creative contribution” to a work to warrant First Amendment (or copyright) protection.<sup>64</sup>

In attempting to distinguish the work of Gary Saderup from the work of Andy Warhol, the *Comedy III* court stated:

[W]e do not hold that all reproductions of celebrity portraits are unprotected by the First Amendment. The silkscreens of Andy Warhol, for example, have as their subjects the images of such celebrities as Marilyn Monroe, Elizabeth Taylor, and Elvis Presley. Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself. Such expression may well be entitled to First Amendment protection.<sup>65</sup>

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60. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001) (“Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself.”).

61. See *id.* at 800 (“Saderup is an artist with over 25 years’ experience in making charcoal drawings of celebrities.”).

62. See *id.* at 801 (describing the charcoal lithograph Saderup made of the Three Stooges).

63. See *id.* (providing an overview and claims of the lawsuit).

64. See *id.* at 811 (addressing the issue of when a work of art can receive First Amendment protection).

65. *Id.* (internal citation and footnote omitted). Andy Warhol’s famous silkscreens of Marilyn Monroe were created in 1962 and based upon a publicity shot taken by photographer Gene Korman for the film *Niagra* in 1953. I have not been able to determine whether Korman gave permission to Warhol to use

Gary Saderup has available for sale on a web site,<sup>66</sup> a portrait he made of Marilyn Monroe. How does a court determine whether this work is worthy of First Amendment protection? How does the court assess the “artistic” merit of the sketch? Does it compare the relative “artistry” of the work to his Three Stooges drawing or maybe to the Warhol depiction of Marilyn? Does the decision hinge upon the fame of the artist? Would Warhol’s Marilyn automatically get more protection than Saderup’s Marilyn because Warhol is more famous than Saderup? How and when does a court determine who will be tomorrow’s Andy Warhol?<sup>67</sup>

There are no satisfactory answers to these questions. The determinations will be necessarily chock-full of subjectivity.

This same quandary was involved in a dispute between Tiger Woods and a company that created a montage painting containing various images of Woods, the Masters’ Tournament, and other past champions of the Masters’ Tournament.<sup>68</sup> The district court found that the painting violated Woods’s right of publicity under Ohio law.<sup>69</sup> The Court of Appeals for the Sixth Circuit reversed, and citing *Comedy III*, held that “when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the

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the photograph or whether he was compensated for it, but it presents an interesting question: What if Korman had claimed a copyright interest in his photograph? Today this would involve a fair use or transformation analysis under copyright law, which would be very similar to the analysis involved in the right of publicity cases using the transformative use test from *Comedy III*. I believe that we will begin to see more and more of these balances involving all three of these interests.

66. See *Marilyn Monroe*, GALLERY4COLLECTORS, <http://gallery4collectors.com/GarySaderup-MarilynMonroe.htm> (last visited Jan. 24, 2015) (listing a portrait of Marilyn Monroe for sale and providing a short biography on her) (on file with the Washington and Lee Law Review).

67. See generally William K. Ford & Raizel Liebler, *Games Are Not Coffee Mugs: Games and the Right of Publicity*, 29 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1 (2012) (discussing how courts should decide rights of publicity in gaming).

68. See Blanke, *supra* note 18, at 38–39 (explaining the Tiger Woods dispute with a company over his image).

69. See *ETW Corp. v. Jireh Publ’g, Inc.*, 99 F. Supp. 2d 829, 836 (N.D. Ohio 2000) (dismissing a motion for summary judgment because the painting had violated the right of publicity).

right of publicity.”<sup>70</sup> The court continued, “[a]ccordingly, First Amendment protection of such works outweighs whatever interest the state may have in enforcing the right of publicity.”<sup>71</sup>

Another way to view this issue is from the vantage point of the right of publicity. If its purpose is to protect—and potentially monetize—the fame and celebrity of an individual, is there anything that can outweigh this interest? Basically, in the context of video games, it may come from First Amendment protection for newsworthiness or from First Amendment protection for information that is publicly available and in the public domain (and not protected by copyright law).<sup>72</sup>

Courts have had a difficult time trying to determine how much transformation is enough, or in the words of the *Comedy III* court, “whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.”<sup>73</sup> The California Supreme Court, which created the transformative use test in *Comedy III*, found enough transformation a few years later when a comic book depicted two brothers, Johnny and Edgar Autumn, as half-worm and half-human, with long white hair and albino features, based upon famous musician brothers Johnny and Edgar Winter.<sup>74</sup> The California Court of Appeal also found enough transformation in a video game character, who like the lead singer of a retro-funk-dance band popular in the 1990s wore platform shoes, brightly colored clothes, often with a number written on her chest, bare midriff, a blue backpack, red/pink hair, and pigtails and had a musical introduction with the words “ooh la la.”<sup>75</sup> But the

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70. *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 935 (6th Cir. 2003) (citing *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001)).

71. *Id.*

72. *See supra* notes 18, 20 (regarding the *Montana* case and the fantasy stat case).

73. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 799, 808 (Cal. 2001); *see Blanke, supra* note 18, at 39–46 (discussing the *Comedy III* transformative test).

74. *See Winter v. DC Comics*, 69 P.3d 473, 479–80 (Cal. 2003) (explaining that the comic book characters transformed enough to not violate right of publicity); *see also Blanke, supra* note 18, at 39–42 (discussing *Winter*); Rice, *supra* note 1, at 339–40 (same).

75. *See Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 615–17 (Cal. Ct.

Supreme Court of Missouri, using the predominant factors test, rather than the transformative use test, did not find enough transformation in a comic book character named Tony Twist, whose name was admittedly borrowed from a tough hockey player known as an “enforcer,” but whose character was a Mafia don who looked nothing like the hockey player.<sup>76</sup> The court noted how similar the facts were to the *Winter* case, but decided completely opposite.<sup>77</sup>

Similarly, in the two cases involving exactly the same facts—and the same *NCAA Football* video game—the district courts in California and New Jersey came to opposite conclusions.<sup>78</sup> The Northern District of California held that the depiction of quarterback Sam Keller was not sufficiently transformative to bar his right of publicity claim;<sup>79</sup> while the District Court for the District of New Jersey held that the depiction of quarterback Ryan Hart was sufficiently transformative and warranted First Amendment protection.<sup>80</sup> The Third and Ninth Circuit Courts of Appeal, however, did reach the same conclusion on review, holding that there was not enough transformation in the depiction of the quarterbacks.<sup>81</sup>

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App. 2006) (discussing the transformative test and its application to the current case); see also Blanke, *supra* note 18, at 43–44 (discussing the transformative test); Rice, *supra* note 1, at 342–43 (covering *Kirby*).

76. See *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (using the predominant factors test); see also Blanke, *supra* note 18, at 41–43 (discussing the transformative test in *TCI Cablevision*); Rice, *supra* note 1, at 340–42 (same).

77. See *Doe*, 110 S.W.3d at 373 (describing *Winter* as “a case with a remarkably similar fact situation”).

78. See *infra* notes 67–68 (discussing these cases).

79. See *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 794 (D.N.J. 2011) (concluding “that EA is entitled to First Amendment protection under either the transformative test or either of the *Rogers*’ tests”).

80. *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 U.S. Dist. LEXIS 10719, at \*34 (N.D. Cal. Feb. 8, 2010) (“Assuming that the challenged causes of action arise from protected activity, Plaintiff makes a sufficient showing of his probability of success on the merits.”).

81. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 170 (3d Cir. 2013) (“We therefore hold that the *NCAA Football 2004*, *2005* and *2006* games at issue in this case do not sufficiently transform Appellant’s identity to escape the right of publicity claim . . . .”); *In re NCAA Student–Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1284 (9th Cir. 2013) (“EA’s use of the likenesses of college athletes like Samuel Keller in its video games is not, as a matter of law,

Basically the bottom line with applying these tests—and the nearly impossible determination of just how much transformation is enough—or alternatively, when a “work” becomes a “work of art”—is that different courts using *different tests* have come to different conclusions, and that different courts using the *same test* have come to different conclusions.

In my *Frank Miller's Sin City College Football* example,<sup>82</sup> it would seem that the more different the Ryan Hart and Sam Keller avatars are from their real-life persona, the less likely that there would be a successful right of publicity claim. Certainly, that appears to be the case under the transformative use test—at least in most of the cases.<sup>83</sup> Having the ability to levitate opposing players or to disappear may be the beginning of a sufficient enough transformation to warrant First Amendment protection. That surely seems to be the lesson from the *Winter* and *Kirby* cases.

This becomes similar to using the “substantial similarity” test in copyright law in order to determine whether there is infringement. In *Atari, Inc. v. North American Philips Consumer Electronics Corp.*,<sup>84</sup> the designer of a PAC-MAN-like knock-off video game had instructed his designers to make the characters in the game a little *less* like the original PAC-MAN characters in order to avoid a finding of “substantial similarity.”<sup>85</sup> Even with these changes, however, the court held that the modified game still captured the “total concept and feel’ of [the game and was] substantially similar to PAC-MAN.”<sup>86</sup> While a game designer might want to transform his characters just enough to avoid a finding of substantial similarity—or enough to warrant First Amendment protection as a transformative independent creation—the goal of a reality-based video game is to make the characters and the game as realistic and true to life as possible.

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protected by the First Amendment.”).

82. See *supra* Part II (discussing this video game).

83. See Blanke, *supra* note 18, at 39–41, 43–44 (discussing *Winter* and *Kirby*); Rice, *supra* note 1, at 339–40, 342–43 (same).

84. 672 F.2d 607 (7th Cir. 1982).

85. See *id.* at 618 (describing the characters in the knock-off video game).

86. *Id.* at 619–20.

According to Rice's readily identifiable standard, it is a person familiar with the individual who would have to know immediately that the character is definitively based on the real person.<sup>87</sup> This would cover the situation where an obscure offensive lineman, familiar possibly only to his family and friends, might not be readily identifiable to an average game player. To the person familiar with the lineman, however, he may be readily identifiable.<sup>88</sup>

Another possible wrinkle to this standard is particularly relevant to football. How readily identifiable are the characters when they have their helmets on? It might be difficult even for someone familiar with a player to recognize him with a helmet. It would probably be easier to identify a baseball player, who typically wears only a hat or maybe a batting helmet, and easier yet in a basketball or soccer game, where a player typically wears no hat or helmet, thus making him more readily identifiable. Should this play a role in the determination?

#### IV. Conclusion

While the readily identifiable standard may do a good job of identifying a possible violation of a right of publicity, there are several larger issues which may make this determination moot if more important issues outweigh that right in the first place. Just because one's name or likeness is readily identifiable in a video game, it does not necessarily follow that one will (or should be) successful in a right of publicity claim.

In a strong dissenting opinion in the Ninth Circuit *Keller* case, Judge Thomas states that the "essence of *NCAA Football* is founded on publicly available data, which is not protected by any individual publicity right."<sup>89</sup> He notes that the personal vital

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87. See Rice, *supra* note 1, at 366 ("A video game violates an individual's right of publicity if a person familiar with the individual would look at a video game character and know *immediately* that the character is *definitively* based on the real individual.").

88. This may also be relevant to the discussion about whether a right of publicity protects only those who are famous, as it is more likely the quarterbacks, rather than the offensive linemen, will be well known. See *generally* Rice, *supra* note 1.

89. *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724

statistics of the players in the video game and the statistical data generated by their on-field performances are easily available and indistinguishable from the information used in fantasy sports leagues.<sup>90</sup> “An athlete’s right of publicity simply does not encompass publicly available statistical data.”<sup>91</sup>

Manuel Noriega, former military dictator of Panama, recently brought suit against Activision for his inclusion in the video game *Call of Duty*.<sup>92</sup> His suit alleges a violation of his right to publicity under California law.<sup>93</sup> The game depicts Noriega as a character in a reality-based history and war game.<sup>94</sup> The situation is not much different than a reality-based sports game.<sup>95</sup>

Judge Thomas recognized the potential elephant in the room in his *Keller* dissent, addressing the importance of the First Amendment when balanced against rights of publicity:

The stakes are not small. The logical consequence of the majority view is that all realistic depictions of actual persons, no matter how incidental, are protected by a state law right of publicity regardless of the creative context. This logic jeopardizes the creative use of historic figures in motion pictures, books, and sound recordings. Absent the use of actual footage, the motion picture *Forrest Gump* might as well be just

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Footnote 3d 1268, 1288 (9th Cir. 2013) (Thomas, J., dissenting).

90. *See id.* (“[P]laying statistics are easily available.”).

91. *Id.*

92. *See* Eugene Volokh, *Can Manuel Noriega Really Win his “Right of Publicity” Lawsuit Against Activision?*, WASH. POST (July 17, 2014), <http://www.washingtonpost.com/news/volokh-conspiracy/wp/2014/07/17/can-manuel-noriega-really-win-his-right-of-publicity-lawsuit-against-activision> (last visited Jan. 24, 2015) (describing the lawsuit) (on file with the Washington and Lee Law Review); Leo Kelion, *Manuel Noriega Sues Activision Over Call of Duty*, BBC (July 16, 2014, 7:51 AM), <http://www.bbc.com/news/technology-28326670> (last visited Jan. 24, 2015) (same) (on file with the Washington and Lee Law Review).

93. *See* Volokh, *supra* note 92 (describing the possibilities of Noriega winning the right of publicity lawsuit).

94. *See id.* (“[T]he Noriega character is likewise represented in a realistic context, as someone quite similar to what he was . . .”).

95. *See* Blanke, *supra* note 18, at 57–60 (discussing reality-based video games and their potential legal consequences). Reality-based music games also present similar questions, although there may be some additional copyright interests that make those situations even more difficult to resolve. *Id.* at 60–61 (providing scenarios revolving around reality-based music games).

a box of chocolates. Without its historical characters, *Midnight in Paris* would be reduced to a pedestrian domestic squabble. The majority's holding that creative use of realistic images and personas does not satisfy the transformative use test cannot be reconciled with the many cases affording such works First Amendment protection.<sup>96</sup>

The right of publicity provides a person with the potential to benefit financially from his or her fame or celebrity. But just like every other right in a legal system, it is not an absolute. It must be balanced against other rights and interests. Balancing a right of publicity against the First Amendment is difficult to begin with. Add to that mix the very different protections afforded by varying state laws and it becomes even harder. Introducing a copyright interest makes it even more difficult. It is important for scholars and courts to experiment with different tests, but ultimately, this is an area of the law screaming for resolution by the Supreme Court.

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96. *In re NCAA Student–Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1290 (9th Cir. 2013) (Thomas, J., dissenting).