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Comment on “Groove is in the *Hart*”: A Workable Solution for Applying the Right of Publicity to Video Games

Christopher B. Seaman*

The right of publicity is increasingly important to the multibillion-dollar video game industry.¹ In particular, many sports-related video games, including Electronics Arts’ popular NCAA® Football and NCAA® Basketball franchises, incorporate the likenesses and personas of professional and amateur athletes as an integral part of gameplay.

Not surprisingly, some athletes depicted in these games have demanded compensation for the commercial exploitation of their likenesses and personas.² However, their claims are in tension with the First Amendment,³ which safeguards freedom of speech and expression, including expressions that implicate the right of publicity.⁴ Federal and state courts have split regarding how to

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1. See ENTMT SOFTWARE ASS’N, 2014 ESSENTIAL FACTS ABOUT THE COMPUTER AND VIDEO GAME INDUSTRY 13 (2014), http://www.theesa.com/wp-content/uploads/2014/10/ESA_EF_2014.pdf (stating that over \$15 billion was spent on video game content in the United States in 2013).

2. See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1276 (9th Cir. 2013) (concluding that a video game developer’s use of athlete’s likeness in video games was not entitled to a First Amendment defense as a matter of law); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 146–47, 170 (3d Cir. 2013) (holding that the district court erred in granting summary judgment in defendants’ favor in a lawsuit instituted on behalf of college athletes who alleged violations of their right of publicity by appropriation of their likeness in college football video games).

3. U.S. CONST. amend. I.

4. See Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 67 (1994) (discussing the “inherent conflict between the right of publicity and the First Amendment”); Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the*

resolve this tension, adopting a variety of judicially created tests that legal scholars have criticized as creating “massive confusion”⁵ and uncertainty about the scope of First Amendment protection.⁶

In his Note “*Groove is in the Hart*”: *A Workable Solution for Applying the Right of Publicity to Video Games*,⁷ Garrett Rice seeks to address this important issue by proposing a new approach, which he labels the “readily identifiable” standard.⁸ I believe that Mr. Rice’s well-researched and clearly written Note makes a valuable contribution in the ongoing debate on how to balance appropriately these competing interests in the video game context. I am grateful to have the opportunity to participate in a scholarly dialogue regarding his Note.

The recognition of a property right in one’s name, likeness, and persona is a relatively recent development in American law.⁹ The right of publicity grew out of the common law right to privacy,¹⁰ but it was only first recognized as an independent cause of action in 1953.¹¹ In *Haelan Laboratories, Inc. v. Topps*

Portrayal of Real People by the Media, 88 YALE L.J. 1577, 1590 (1979) (“The First Amendment inevitably defines the operation and extent of the right of publicity . . .”).

5. Kwall, *supra* note 4, at 48; see also Gloria Franke, Note, *The Right of Publicity vs. the First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CAL. L. REV. 945, 965 (2006) (arguing that there is a “lack of a principled and consistent method of resolving the conflict between the right of publicity and the First Amendment”) (internal quotation marks omitted).

6. Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903, 916–92 (2003); see also 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, 63 (2013) (explaining that “[e]ven when courts apply the same test to the same facts, results are inconsistent”).

7. 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).

8. *Id.* Part V.

9. See *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 928 (6th Cir. 2003) (“The right of publicity is an intellectual property right of recent origin . . .”).

10. J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:2 (2d ed. 2014).

11. See *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (determining that professional baseball players had “the right to grant the exclusive privilege of publishing [their] picture[s]”).

Chewing Gum, Inc., the parties were rival chewing gum sellers who sought to obtain rights from professional baseball players to use their pictures on baseball cards.¹² The plaintiff, Haelan, negotiated exclusive licenses with a number of baseball players, but the defendant, Topps, included pictures of some of the same players in its own baseball cards.¹³ The Second Circuit held that New York's privacy law did not cover such uses.¹⁴ However, the court recognized "that, in addition to and independent of that right of privacy . . . , a man has a right in the publicity value of his photograph the exclusive privilege of publishing his picture," which it termed "a right of publicity."¹⁵ Today, a majority of states recognize the right of publicity as a separate cause of action, either under common law or by statute.¹⁶

The essence of a property right is the ability to exclude others.¹⁷ However, the property right embodied in the right of publicity is circumscribed by the First Amendment, which protects "the free flow of ideas and opinions on matters of public interest and concern."¹⁸ First Amendment protection is particularly robust for expression about celebrities and other public figures.¹⁹ And "[b]ecause celebrities take on public meaning, the appropriation of their likenesses may have

12. *Id.* at 867.

13. *Id.* at 868.

14. *Id.*

15. *Id.*

16. MCCARTHY, *supra* note 10, at § 6:3; Rice, *supra* note 7, at 330–32.

17. See *Kaiser Aetna v. United States*, 444 U.S. 164, 176 (1979) (describing the "right to exclude others" as "one of the most essential sticks in the bundle of rights that are commonly characterized as property"); see also Thomas W. Merrill, *Property and the Right to Exclude*, 77 NEB. L. REV. 730, 730 (1998) (arguing that "the right to exclude others is more than just one of the most essential constituents of property—it is the sine qua non"); Adam Mossoff, *What Is Property? Putting the Pieces Back Together*, 45 ARIZ. L. REV. 371, 389 (2003) ("[T]he right to exclude is a necessary characteristic of the concept of property.").

18. *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 50 (1988).

19. See *id.* at 51 ("The sort of robust political debate encouraged by the First Amendment is bound to produce speck that is critical of . . . public figures who are intimately involved in the resolution of important public questions or, by reason of their fame, shape events in areas of concern to society" (internal quotation marks omitted)); see also *Baumgartner v. United States*, 322 U.S. 665, 673–74 (1944) ("One of the prerogatives of American citizenship is the right to criticize public men and measures . . .").

important uses in uninhibited debate on public issues, particularly debates about culture and value.”²⁰ Thus, an unfettered property interest in a person’s name, image, and likeness would limit and impoverish the scope of expression about public figures. At its extreme, as Professor Michael Madow has explained, the right of publicity could facilitate private censorship of popular culture.²¹

Mr. Rice’s Note addresses a contemporary variation of the issue encountered in *Haelan Laboratories*—whether the depiction of highly skilled athletes without their permission violates the right of publicity. Of course, the relevant medium is different; at issue here is a digital, interactive version of the athletes’ likeness in a video game rather than an “analog” still photograph on a baseball card. But the bottom line question—what limits does the First Amendment impose on the rights of individuals to control their image and likeness in a commercial context—remains the same. And the potential impact of this issue is economically significant; the U.S. video game market is estimated to be over \$20 billion annually,²² greater than the domestic box office²³ and the music industry combined.²⁴

In the more than sixty years since the Second Circuit first recognized a right to publicity, courts have yet to definitively determine the proper standard to balance the scope of this right

20. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 803 (Cal. 2001).

21. Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 127, 138 (1993); see also *Comedy III Prods.*, 21 P.3d at 803 (“[T]he very importance of celebrities in society means that the right of publicity has the potential of censoring significant expression by suppressing alternative versions of celebrity images that are iconoclastic, irreverent, or otherwise attempt to redefine the celebrity’s meaning.”).

22. See ENTMT’T SOFTWARE ASS’N, *supra* note 1, at 13.

23. See *Yearly Box Office*, BOX OFFICE MOJO, <http://boxoffice.mojo.com/yearly> (last visited Jan. 27, 2015) (showing total domestic gross movie tickets sales of \$10.4 billion for 2014) (on file with the Washington and Lee Law Review).

24. See Randy Lewis, *Music Industry Revenue in 2013 Stayed Flat at \$7 Billion, RIAA Says*, L.A. TIMES, (Mar. 18, 2014, 12:32 PM), <http://www.latimes.com/entertainment/music/posts/la-et-ms-music-industry-revenue-riaa-report-streaming-digital-20140318-story.html> (last visited Feb. 16, 2015) (stating that overall revenue in the U.S. for the music industry was \$7 billion in 2013) (on file with the Washington and Lee Law Review).

against the guarantees enshrined in the First Amendment. This is not entirely surprising. As the California Supreme Court has recognized, “it is not a simple matter to develop a test that will unerringly distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity.”²⁵

In his Note, Mr. Rice identifies and explains the three most prominent tests articulated to date—the *Rogers* test,²⁶ the transformative use test,²⁷ and the predominant use test²⁸—and finds all of them wanting.²⁹ As a new alternative,³⁰ he proposes a “readily identifiable” standard for resolving the conflict between the right to publicity and the First Amendment in the realm of video games, which is described as follows: “A video game violates an individual 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.”³¹ Conversely, if the individual depicted is not immediately and definitely identifiable, then the representation is deserving of First Amendment protection.³²

Mr. Rice’s proposed “readily identifiable” standard has several apparent benefits. First, the standard appears

25. *Comedy III Prods.*, 21 P.3d at 807.

26. *See Rogers v. Grimaldi*, 875 F.2d 994, 1003–04 (2d Cir. 1989) (“The common law right of publicity . . . grants celebrities an exclusive right to control the commercial value of their names and to prevent others from exploiting them without permission.”).

27. *See Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001) (holding that an “inquiry into whether a work is ‘transformative’ appears to us to be necessarily at the heart of any judicial attempt to square the right of publicity with the First Amendment”).

28. *See Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (en banc) (holding that a “predominant use test” should be employed to determine whether the exploitation of a person’s identity violates that person’s right of publicity).

29. Rice, *supra* note 7, at 333–34, 337–39, 340–42.

30. According to Mr. Rice, this test is based in part on Judge Alarcon’s dissent in *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395, 1404 (9th Cir. 1992) (contending that “[i]t is patently clear to anyone viewing the commercial advertisement that [plaintiff] was not being depicted”). Rice, *supra* note 7, at 367.

31. Rice, *supra* note 7, at 366.

32. *Id.*

straightforward and easy to administer. By articulating a clear rule as to when the right of publicity is implicated, the parties know what conduct transgresses the rule and can order their affairs, including the licensing of that right, accordingly.³³

Second, the standard avoids an overbreadth problem by narrowly construing the scope of the right to publicity, requiring that the digital representation is both “*immediately*” recognizable and “*definitively* based on the real individual.”³⁴ This would avoid liability for highly transformative representations, such as the depiction of a robot with blond hair acting as a game show hostess, which the Ninth Circuit found implicated plaintiff Vanna White’s right of publicity.³⁵

Third, the standard takes a holistic view of the allegedly improper representation, considering not only the digital likeness of the person allegedly depicted but also the setting and other relevant information (including sounds, biographical information, and other unique characteristics).³⁶ This will help avoid situations where video game manufacturers strongly suggest an individual by using personally identifiable information (such as a collegiate player’s school, year(s) of enrollment, and jersey number), but evade liability by making minor changes to the digital representation of the individual’s image and likeness.

I also have several areas of potential concern regarding Mr. Rice’s proposed standard. First, the “readily identifiable”

33. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730 (2002) (“[All property right] boundaries should be clear.”); Stewart E. Sterk, *Property Rules, Liability Rules, and Uncertainty About Property Rights*, 106 MICH. L. REV. 1285, 1285 (2008) (“Clarity can be a considerable virtue in property rights.”); J.E. Penner, *The “Bundle of Rights” Picture of Property*, 43 UCLA L. REV. 711, 742 (1996) (“The right to property is the right to determine the use or disposition of an alienable thing . . . and includes the right to . . . license it to others (either exclusively or not) . . .”).

34. Rice, *supra* note 7, at 366.

35. See *White*, 971 F.2d at 1399 (reversing the district court’s grant of summary judgment in defendants’ favor on Ms. White’s right of publicity claim regarding the depiction of a “female-shaped robot . . . wearing a long gown, blond wig, and large jewelry” that “is in the process of turning a block letter on a game-board” in defendants’ advertisement); see also *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing *en banc*) (contending that the panel majority’s decision that Ms. White’s right of publicity was implicated by defendants’ advertisement was “a classic case of overprotection”).

36. Rice, *supra* note 7, at 368–70.

standard is platform dependent; as the Note explains, the test “appl[ies] specifically to the video game context.”³⁷ But platform-neutral tests have been effectively used to balance property and First Amendment rights in other areas of the law, most notably copyright. In copyright, the fair use defense “balances expressive freedoms by permitting one to use another’s copyright expression under certain circumstances.”³⁸ The fair use inquiry, which turns on four broad, nonexclusive factors,³⁹ has been applied to permit expressive speech across variety of platforms, including recording and subsequent playback (time shifting) of television programs;⁴⁰ reverse engineering and copying of software to achieve interoperability on multiple consoles;⁴¹ altering the visual display and game play of video games;⁴² and copying, searching, and display of images by Internet search engines.⁴³ Although sometimes criticized for its unpredictability,⁴⁴ the fair use defense has proven a crucial bulwark against overbroad assertions of copyright rights that impinge on First Amendment interests. One potential downside of a context-specific test like the “readily identifiable” standard is that it could not rely on analogous rulings involving other media platforms.

37. *Id.* Part V.A.

38. Michael W. Carroll, *Fixing Fair Use*, 85 N.C. L. REV. 1087, 1090 (2007).

39. See 17 U.S.C. § 107 (2012) (listing as relevant factors “(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;” “(2) the nature of the copyrighted work;” “(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole;” and “(4) the effect of the use upon the potential market for or value of the copyrighted work”).

40. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

41. *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992).

42. *Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc.*, 964 F.2d 965 (9th Cir. 1992).

43. *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2002).

44. See, e.g., LAWRENCE LESSIG, *FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY* 187 (2004) (characterizing fair use as “the right to hire a lawyer”); David Nimmer, *“Fairest of Them All” and Other Fairy Tales of Fair Use*, 66 LAW & CONTEMP. PROBS. 263, 280 (2003) (noting the “malleability” of fair use factors). *But see* Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537, 2541 (2009) (arguing that “fair use law is both more coherent and more predictable than many commentators have perceived”).

A second issue is the relevant audience for application of the “readily identifiable” standard. As Professors Mark Lemley and Jeanne Fromer have recently explained, the relevant audience “is critical to understanding how [intellectual property] regimes define infringement.”⁴⁵ Under the “readily identifiable” standard, identification is gauged from the perspective of “a person familiar with the individual.”⁴⁶ But such an audience might result in overbroad protection because it depends on someone who already knows the plaintiff and thus who would be more capable of “immediately” and “definitively” identifying him or her. For instance, the only people likely to be familiar with the backup punter for a team depicted in the NCAA[®] Football game are the punter’s family, friends, and teammates—a very limited “audience” for purposes of measuring the right to publicity. Other areas of intellectual property law, such as copyright and trademark, assess the question of infringement from the viewpoint of an ordinary person who consumes the product in question.⁴⁷ This difference may be outcome determinative; the average 19-year-old playing NCAA[®] Football may recognize Sam Keller or Ryan Hart, the former quarterbacks for Arizona State and Rutgers, respectively, and plaintiffs in right-to-publicity litigation, but he or she almost certainly will not be familiar with the backup punter (if one exists) for these schools.⁴⁸

45. Jeanne C. Fromer & Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 MICH. L. REV. 1251, 1251 (2014).

46. Rice, *supra* note 7, at 366.

47. See *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) (explaining infringement is judged from “the response of the ordinary lay hearer”); *Dawson v. Hinshaw Music Inc.*, 905 F.2d 731, 736 (4th Cir. 1990) (explaining that in determining infringement, “a district court must consider the nature of the intended audience of the plaintiff’s work. If, as will most often be the case, the lay public fairly represents the intended audience, the court should apply the . . . ordinary observer test”); Fromer & Lemley, *supra* note 45, at 1258–59 (in trademark law, “the law focuses on consumers . . . as its audience for infringement”).

48. In contrast, one advantage of using the perspective of audience familiar with the person in question is that it may afford protection for “niche” celebrities with a geographically or topically limited audience—e.g., an anchor on local evening TV news show, or a prominent Jai Alai player—whereas an ordinary consumer standard would not. See Rice, *supra* note 7, at 366–67 (discussing the benefits of a “readily identifiable” standard).

The final, and perhaps most significant, issue with the “readily identifiable” standard is that the mere accurate depiction of an individual’s image or likeness in a video game would automatically create liability, even if the depiction is used in an expressive, transformative, or noncommercial contest. For instance, a parody of a person in a video game would appear to violate the “readily identifiable” standard if the parody’s target was readily identifiable. As the Supreme Court has explained, a “parody must be able to ‘conjure up’ at least enough of th[e] original [target] to make the object of its critical wit recognizable.”⁴⁹ Indeed, if the target of a parody was *not* identifiable, then the parody would be ineffective.⁵⁰ But a rule that creates liability for parodies in most cases would raise serious constitutional concerns, as parody is generally protected by the First Amendment.⁵¹ To avoid this problem, I suggest that the “readily identifiable” test is better conceived of as the first part of a two-part test. If the plaintiff in a right of publicity claim is readily identifiable, then courts should ask whether the defendant has used the plaintiff’s image or likeness in a way that is primary expressive, transformative, or noncommercial. If so, then no liability should attach.

In sum, despite these critiques, Mr. Rice’s Note is an excellent piece of student scholarship—it is clearly written, well organized, and makes a valuable contribution to the resolution of a difficult problem that has perplexed courts and scholars alike for decades. If legal scholarship is evaluated based on whether “readers can find something professionally valuable in it,” as one of my distinguished colleagues has suggested,⁵² then Mr. Rice has certainly risen to the challenge with his Note.

49. *Campbell v. Acuff–Rose Music, Inc.*, 510 U.S. 569, 588 (1994).

50. *See Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260 (4th Cir. 2007) (“A parody must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is *not* the original and instead is a parody.” (citation omitted)).

51. *See Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 775 (8th Cir. 1994) (“Parody does implicate the First Amendment’s protection of artistic expression.”).

52. Sarah K. Wiant, *Comment: 3D Printing*, 71 WASH. & LEE L. REV. 699, 705 (2014).