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By Kevin L. Chin*

Videogame technology has reached the point where characters can accurately mimic real-life individuals' faces, features, and expressions. This has prompted new issues in the conflict between the right of publicity and freedom of expression. While the common-law right of publicity prevents the use of one's identity or image without consent, the First Amendment limits this doctrine's reach. Courts agree that the right of publicity must be balanced with freedom of expression, but differ on how to do so.

A few recent cases, however, indicate that the issue may soon be resolved. The Third and Ninth Circuit Courts, as well as the State of California, have adopted the "transformative use test." Under this test, unauthorized use of an identity is permissible if the use adds significant creative elements and sufficiently transforms the likeness or identity into original expression. Courts have thus far only applied this test to football videogames using the likenesses of athletes, and none has found the use of these athletes' likenesses adequately transformative.

The transformative use test, although useful in some instances, is incomplete. The Third and Ninth Circuits have allowed football players to protect their likenesses in the football context because football players are primarily known and recognized for one thing—playing football. Actors, on the other hand, may be famous for playing a wide variety of roles. Although some actors are associated with certain characters, many actors assume various roles stretching across diverse genres. This makes it more difficult to determine which actions and environments are popularly associated with an actor. Videogames exacerbate this difficulty because videogames can put characters in any environment, performing any action imaginable.

Because videogame characters can now accurately resemble famous actors, a new question has arisen: how to apply the transformative use test to videogames that employ celebrity likenesses without consent. This Comment explains how this new situation highlights a major flaw in the transformative use test.

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I. INTRODUCTION

¶1 Videogame technology has reached the point where characters can accurately mimic real-life individuals' faces, features, and expressions. This has prompted new issues in the conflict between the right of publicity and freedom of expression. While the common-law right of publicity prevents the use of one's identity or image without consent, the First Amendment limits this doctrine's reach. Courts agree that the right of publicity must be balanced with freedom of expression, but differ on how to do so.

¶2 A few recent cases, however, indicate that the issue may soon be resolved. The Third and Ninth Circuit Courts, as well as the State of California, have adopted the "transformative use test." Under this test, unauthorized use of an identity is permissible if the use adds significant creative elements and sufficiently transforms the likeness or identity into original expression.[1] Courts have thus far only applied this test to football videogames using the likenesses of athletes, and none has found the use of these athletes' likenesses adequately transformative.[2] The courts reasoned that the digital football players were doing the same thing that made the real-life athletes famous: playing football. These rulings have taken away a major defense for videogame companies.

¶3 The transformative use test, although useful in some instances, is incomplete. The Third and Ninth Circuits have allowed football players to protect their likenesses in the football context because football players are primarily known and recognized for one thing—playing football. Actors, on the other hand, may be famous for playing a wide

[1] Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 808 (2001).

[2] *See In re* NCAA Student-Athlete Name & Likeness Licensing Litig., 724 F.3d 1268, 1271 (9th Cir. 2013), *aff'g* Keller v. Elec. Arts, Inc., 2010 WL 530108, *4–5 (N.D. Cal. Feb. 8, 2010); Hart v. Elec. Arts, 717 F.3d 141, 165–66 (3d Cir. 2013).

variety of roles. Although some actors are associated with certain characters, many actors assume various roles stretching across diverse genres. This makes it more difficult to determine which actions and environments are popularly associated with an actor. Videogames exacerbate this difficulty because videogames can put characters in any environment, performing any action imaginable.

¶4 Because videogame characters can now accurately resemble famous actors, a new question has arisen: how to apply the transformative use test to videogames that employ celebrity likenesses without consent. This Comment explains how this new situation highlights a major flaw in the transformative use test. Part I discusses the origins of the right of publicity. Part II compares the transformative use test to other tests and examines cases that applied the transformative use test to actors and videogames (but not both). Part III illustrates the flaws in the transformative use test through a hypothetical right of publicity case involving an actor portrayed in a videogame. Part IV analyzes continuing uncertainties and how courts might confront this issue in the future.

A. History of the Right of Publicity

¶5 The right of publicity is governed by state law and is typically defined as "the inherent right of every human being to control the commercial use of his or her identity."[3] This right bears some resemblance to trademark, copyright, and privacy rights, but is separate and distinct.[4] In the seminal case *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, the court explained: "[A] man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture . . . . [T]his right might be called a 'right of publicity.'"[5]

¶6 *Haelan* generated conflicting interpretations, leaving the right of publicity doctrine murky. William Prosser's highly influential law review article *Privacy* narrowly interpreted the "right of publicity" as a licensee's exclusive right to use one's own name, identity, and likeness.[6] In contrast, Joseph Grodin promoted a broader interpretation of *Haelan*'s impact on the right of publicity:

> [T]he *Haelan* case gave protection to persons' commercial interest in their personality independent of their privacy interest. . . . If courts wish to protect both interests to at least some extent, they should do so under separate doctrines, so that limitations appropriate to each interest may be imposed.[7]

¶7 Supporting this broader application, famed scholar Melville Nimmer argued that traditional law inadequately protected an individual's commercial interest in her identity due to modern cultural and technological realities.[8] Nimmer explained that with many technological advances in communication, advertising, and entertainment, "[celebrity]

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[3] 1 J. THOMAS MCCARTHY, RIGHTS OF PUBLICITY AND PRIVACY § 1:3 (2d ed. 2005).

[4] J. Thomas McCarthy & Paul M. Anderson, *Protection of the Athlete's Identity: The Right of Publicity, Endorsements and Domain Names*, 11 MARQ. SPORTS L. REV. 195, 198 (2001).

[5] Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953).

[6] William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 406 (1960); MCCARTHY, *supra* note 3, § 1:26.

[7] Joseph Grodin, Note*, The Right of Publicity: A Doctrinal Innovation*, 62 YALE L.J. 1123, 1127, 1130 (1953).

[8] *See* Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 204 (1954).

likeness [has taken] on a pecuniary value undreamed of at the turn of the century."[9] The right of publicity was thus adopted as a means of protecting this financial interest.[10] As of 2015, thirty-one states have recognized the right of publicity through either statute or common law.[11]

B. Freedom of Expression: Limits to the Right of Publicity

¶8 The Constitution, however, limits the right of publicity's reach. Specifically, the right must be balanced with First Amendment protection on a case-by-case basis.[12] In 1977, the U.S. Supreme Court decided *Zacchini v. Scripps-Howards Broadcasting Co.*, its first right of publicity case.[13] There, the plaintiff was an entertainer known for his human cannonball act.[14] A freelance reporter captured this fifteen-second act on video, and the local television station broadcasted it.[15] The plaintiff never gave any permission to distribute the video.[16] The news station raised freedom of expression as a defense, claiming that the First Amendment protected the broadcast.[17] However, the Court held that the freedom of expression defense was restricted in this case where a news station reproduced an entire act, because the performer had a right to be compensated for his performance.[18] Although *Zacchini*'s holding was limited in that it applied only to performers' rights in videos depicting entire commercial acts, for the first time a right of publicity claim trumped First Amendment protection.[19]

II. MODERN BALANCING TESTS

¶9 Since *Zacchini*, states have created various tests that balance freedom of expression with state right-of-publicity laws. While this Comment analyzes the transformative use test, the "*Rogers* test" and the "predominant use test" provide alternative approaches to balancing the First Amendment with the right of publicity.

A. The Rogers *Test*

¶10 In *Rogers v. Grimaldi*, famed actress Ginger Rogers sued the producers of the film "Ginger and Fred" for using her identity without permission.[20] The film, directed by Frederico Fellini, portrays a fictional pair of Italian cabaret dancers who model their act after the famous dancing duo Ginger Rogers and Fred Astaire. Though named Pippo and

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[9] *Id.*

[10] *See id.* at 222–23.

[11] Twenty-one states expressly recognize the right of publicity in common law. Ten states have statutes that embody most aspects of the right of publicity. MCCARTHY, *supra* note 3, § 6:3.

[12] *See* MCCARTHY, *supra* note 3, § 8:23.

[13] Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562 (1977); *see also* MCCARTHY, *supra* note 3, § 8:24.

[14] *Zacchini*, 433 U.S. at 563.

[15] *Id.* at 563–64.

[16] *Id*.

[17] *Id*.

[18] *Id.* at 575–76.

[19] *See* MCCARTHY, *supra* note 3, § 8:27.

[20] Rogers v. Grimaldi, 875 F.2d 994, 996–97 (2d Cir. 1989).

Amelia, the film depicts the two as being popularly known in Italy as Ginger and Fred.[21] Many years later, the Italian dancers emerge from retirement for a televised reunion.[22]

¶11 The *Rogers* test aims to prevent consumer confusion.[23] The first step of the *Rogers* test is to determine whether the use of the plaintiff's name or likeness is at least minimally relevant to the underlying work.[24] If not, then the First Amendment does not protect the work, and the defense fails.[25] If it is at least minimally relevant, the court determines whether the work is simply a disguised advertisement.[26] If so, then the First Amendment does not protect the work.[27] In sum, under the *Rogers* test, the use of an individual's name is prohibited if either the plaintiff's name is not minimally relevant to the underlying work, or the use is "simply a disguised commercial advertisement for the sale of goods or services."[28]

¶12 The *Rogers* court held that the title—"Ginger and Fred"—was clearly relevant to the movie because the character names—"Ginger" and "Fred"—were selected to add significance to the story.[29] And because the movie was not a disguised advertisement, the court held the use of the performers' names in the title did not violate the right of publicity under Oregon law.[30]

B. The Predominant Use Test

¶13 In *Doe v. TCI Cablevision*, the Missouri Supreme Court adopted the "predominant use test" to analyze competing First Amendment and right of publicity interests.[31] In *Doe*, former professional hockey player Tony Twist challenged a character from the *Spawn* comic book that he believed was modeled after him.[32] The comic featured a fictional character named "Anthony Twistelli," referred to as "Tony Twist," who was an evil Mafia Don.[33] The real-life Twist had a reputation as one of hockey's toughest players, but bore no physical similarity to the comic character.[34]

¶14 The Missouri Supreme Court chose not to adopt the transformative use test largely because it seemed to overextend First Amendment protection.[35] The court criticized the transformative use test, stating that a commercial work could receive First Amendment protection if a court could find any amount of personal expression in it, regardless of the commercial exploitation.[36] The court explained that if a product is primarily exploiting the commercial value of an individual's identity, "that product should be held to violate the

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[21] *Id.*
[22] *Id.* at 997.
[23] *Id.* at 999.
[24] *Id.*
[25] *Id.*
[26] *Id.*
[27] *Id.*
[28] *Id.* at 1004.
[29] *Id.* at 1001.
[30] *Id.* at 1004–05.
[31] MCCARTHY, *supra* note 3, § 8:72.
[32] Doe v. TCI Cablevision, 110 S.W.3d 363, 365 (Mo. 2003).
[33] *Id.* at 366.
[34] *Id.*
[35] *Id.* at 375.
[36] *Id.*

right of publicity and not be protected by the First Amendment, even if there is some 'expressive' content in it that might qualify as 'speech' in other circumstances."[37] However, the court acknowledged that if "the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight."[38]

¶15 Unable to find a legitimate literary reason for the similarities, the court held that the predominant use of the retired hockey player's name was to attract attention to the defendant's commercial product.[39] Thus, the court rejected the free speech defense since the use of the plaintiff's name was primarily commercial and not expressive.[40]

C. The Transformative Use Test

¶16 In 2001, the California Supreme Court created the transformative use test by borrowing from the fair use doctrine in copyright law.[41] In *Comedy III Products, Inc. v. Gary Saderup, Inc.*, Gary Saderup had created charcoal drawings of the Three Stooges and sold the drawings as lithograph prints and tee shirts without permission.[42] The actors' estates sued Saderup, claiming the sale of the prints and tee shirts violated their rights of publicity.[43] The court held that because the artworks were literal depictions of the Three Stooges, the works were not sufficiently "transformative" to afford First Amendment protection.[44] The court stated that the transformative use test asks whether the piece "adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation."[45] In other words, a product is "transformative," and thus protected by the First Amendment, if it is "so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness."[46]

¶17 The court noted that uses such as parody are acceptable because they do not directly challenge the celebrity's economic interests.[47] Parodies of a celebrity's image, for example, are "not good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect."[48] Further, the transformative use test allows various expressions other than parody.[49] The court explained that the transformative elements protected by the First Amendment "are not confined to parody and can take many forms, from factual reporting to fictionalized portrayal, from heavy-handed lampooning to subtle social criticism."[50] Ultimately, the court concluded that any balancing test must recognize that a celebrity cannot restrict all uses of her likeness or image, and that the "right to comment on, parody,

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[37] *Id.* at 374.
[38] *Id.*
[39] *Id.* at 372.
[40] *Id.*
[41] Comedy III Prods., Inc. v. Gary Saderup, Inc., 21 P.3d 797, 807–08 (2001).
[42] *Id.* at 393.
[43] *Id.*
[44] *Id.* at 409.
[45] *Id.* at 391.
[46] *Id.* at 406.
[47] *See id.* at 405.
[48] *Id.*
[49] *See id.*
[50] *Id.* at 406.

lampoon, and make other expressive uses of the celebrity image must be given broad scope."[51]

¶18 California recognizes the right of publicity under both state statute and common law.[52] A common-law claim requires the plaintiff to show: "(1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury."[53] A statutory claim requires proof of the previous four elements, plus two more: defendant's (5) "*knowing* use of the plaintiff's identity" and (6) "a direct connection between the alleged use and the commercial purpose."[54]

¶19 In 2003, the California Supreme Court applied the transformative use test to a new medium—a comic book.[55] In *Winter v. DC Comics*, Johnny and Edgar Winter, two rock musicians with distinctive, long, white hair and pale skin, sued DC Comics for allegedly infringing their rights of publicity.[56] In one of its comic books, DC Comics included two characters that were villainous, half-worm, half-human brothers named Johnny and Edgar Autumn.[57] The plaintiffs claimed the comic book's Autumn brothers had the distinctive, long, white hair and pale skin similar to the real-life Winter brothers.[58] The court decided that the cartoonish portrayal of the Winter brothers was so wildly twisted that it was transformative and thus afforded First Amendment protection.[59] The court also clarified that the transformative use test focuses on whether the use is transformative, not whether the use falls neatly into a category such as parody or satire.[60]

¶20 These cases helped shape the contours of the transformative use test and define the boundary between the right of publicity and freedom of expression. In many cases, determining whether a work is transformative seems straightforward.[61] Specifically, when the activities of the depicted character and the setting of the allegedly infringing work substantially differ from their real-world counterpart's activities and related setting, its

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[51] *Id.* at 403.

[52] The terminology for right of publicity claims varies across states. In this Comment, the right of publicity refers to this right as a subset of the more encompassing right to privacy. Though the right of publicity technically falls within the contours of privacy law, it "may be regarded as the reverse side of the coin of privacy." MELVIN B. NIMMER, THE RIGHT OF PUBLICITY, 19 LAW & CONTEMP. PROBS. 293 (1954), *reprinted in* NIMMER ET AL., CASES AND MATERIALS ON COPYRIGHT AND OTHER ASPECTS OF ENTERTAINMENT LITIGATION INCLUDING UNFAIR COMPETITION, DEFAMATION, PRIVACY 1249 (8th ed., 2012).

[53] Browne v. McCain, 611 F. Supp. 2d 1062, 1069 (C.D. Cal. 2009).

[54] CAL. CIV. CODE § 3344.

[55] Winter v. DC Comics, 69 P.3d 473 (Cal. 2003).

[56] *Id.* at 476.

[57] *Id*.

[58] *Id*.

[59] *Id*. at 479.

[60] *Id.* ("It does not matter what precise literary category the work falls into. What matters is whether the work is transformative, not whether it is parody or satire or caricature or serious social commentary or any other specific form of expression.").

[61] For instance, in *Hilton v. Hallmark Cards*, Paris Hilton sued Hallmark Cards for creating a birthday card that used her identity. 599 F.3d 894, 899 (9th Cir. 2010). Titled "Paris's First Day as a Waitress," the birthday card superimposed Paris Hilton's face on a cartoon waitress's body saying "that's hot," her famous catch phrase. *Id*. The Ninth Circuit held that the use was not sufficiently transformative because the card showed Paris Hilton as a person "born to privilege," a setting in which she is often associated. *Id.* at 911. This case illustrates how the activity and setting of the individual's identity in the work is a significant factor when applying the transformative use test.

transformative nature likely affords the work First Amendment protection. But when a plaintiff's public identity potentially encompasses a broad range of activities and settings, the transformative use test becomes less suitable. Indeed, devising an adequately transformative portrayal of someone who is famously recognized for myriad non-distinct roles poses various difficulties under this test.

D. Transformative Use Test Applied to Videogames

¶21 In 2006, California applied the transformative use test to videogames in *Kirby v. Sega of America, Inc.*[62] Keirin Kirby, who had gained fame in the early 1990s as the lead singer of a dance-musical group, sued a videogame producer for a character named "Ulala," whose dress-style, distinctive bright hair, and catchphrases were allegedly similar to hers.[63] Set in the 25th century during an alien invasion,[64] the videogame depicts a news reporter named Ulala who must mimic certain dance moves.[65] The court held that although there were similarities between the plaintiff and the character, there were enough differences to be transformative.[66] The court pointed to the futuristic setting and differences in Ulala's appearance and dance moves.[67] Since the activity and setting of the digital look-alike differed from the activity and setting of the real-life individual, the digital character constituted a transformative use of the real-life individual's image. In sum, *Kirby* further establishes that the activity and setting of the work play a significant role when applying the transformative use test.

1. No Doubt*: Musicians in Videogames*

¶22 As technology continues to develop, videogames become better at accurately mimicking real-life people. In turn, these realistic portrayals have increased the prevalence of right of publicity claims stemming from videogames. In *No Doubt v. Activision Publishing, Inc.*, the defendant created the game *Band Hero*, which allows players to simulate playing in a band to the timing of select songs.[68] In the videogame, a player chooses a song and an "avatar,"[69] which performs on stage in sync with the music.[70] While some avatars were fictional, the game included members of the band "No Doubt."[71] No Doubt agreed to license three songs[72] and allowed the game to use their likenesses, as long as these avatars only performed No Doubt songs.[73] But No Doubt later discovered that *Band Hero* had an "unlocking" feature, allowing players to use the No Doubt avatars for

[62] Kirby v. Sega of Am., Inc., 144 Cal. App. 4th 47 (2006).
[63] *Id*. at 52.
[64] *Id.*
[65] *Id.*
[66] *Id*. at 59–60.
[67] *See id.*
[68] No Doubt v. Activision Publ'g, Inc., 192 Cal. App. 4th 1018, 1022–24 (2011).
[69] *Id.* at 1023.
[70] *Id*.
[71] *Id*.
[72] Though No Doubt agreed to license three songs, it ultimately only licensed two. *Id.* at 1024.
[73] *Id*.

any song on *Band Hero*.[74] No Doubt claimed they neither consented to nor were they compensated for these additional uses.[75]

¶23 The court held that Activision's use of the No Doubt avatars was not sufficiently transformative because the avatars played rock music in a concert setting, which is exactly what made No Doubt famous.[76] While the avatars could sing non-No Doubt songs and players could select fanciful venues, this "[did] not transform the avatars into anything other than exact depictions of No Doubt's members doing exactly what they do as celebrities."[77] Thus, *No Doubt* reinforces the rule that differences in actions and context are vitally important in determining whether a use is transformative.

2. Keller v. Electronic Arts: *Sports Videogames*

¶24 In a class-action lawsuit—*In re NCAA Student-Athlete Name & Likeness Licensing Litigation* (*Keller*)—college athletes sued Electronic Arts (EA) for violating their rights of publicity.[78] EA's videogame series *NCAA Football* allowed players to select football teams and play simulated games.[79] Every character in the game represented an actual college-football player, and EA tried to model the avatars as closely as possible to the real-world athletes.[80] One of those athletes was the plaintiff Samuel Keller, a former quarterback at Arizona State University and the University of Nebraska.[81]

¶25 The court held the avatars were not transformative.[82] The court pointed to the various similarities between the avatars and real-life players, such as height, weight, skin tone, hair color, team, and jersey number.[83] Further, the context of the game mirrored the context that made the athletes famous—college football.[84]

E. *Hope for Agreement:* Hart v. Electronic Arts

¶26 In 2013, the circuit courts appeared to move toward agreement. The Third Circuit applied the transformative use test in *Hart v. Electronic Arts*, a case with facts virtually identical to those in *Keller*.[85] EA released a new version of its *NCAA Football* series, which, like the version challenged in *Keller*, used the likenesses of NCAA football players.[86] These avatars included Ryan Hart, a quarterback at Rutgers University[87] who sued EA in the District of New Jersey alleging a violation of his common-law right of publicity.[88]

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[74] *Id*.
[75] *Id*.
[76] *Id*. at 1034–35.
[77] *Id.* at 1034.
[78] *In re* NCAA Student-Athlete Name & Likeness Licensing Litig., 724 F.3d 1268 (9th Cir. 2013), *aff'g* Keller v. Elec. Arts, Inc., 2010 WL 530108, *4–5 (N.D. Cal. Feb. 8, 2010).
[79] *Id.* at 1271.
[80] *Id*.
[81] *Id*.
[82] *Id*. at 1276–77.
[83] *Id*. at 1272.
[84] *Id*. at 1276–77.
[85] Hart v. Elec. Arts, 717 F.3d 141, 165 (3d Cir. 2013).
[86] *Id.* at 146.
[87] *Id*. at 145.
[88] Hart v. Elec. Arts, Inc., 808 F. Supp. 2d 757, 760 (D.N.J. 2011).

¶27 New Jersey had not yet established a First Amendment balancing test, leaving the Third Circuit with discretion to create its own.[89] The court considered using the predominant use test, the *Rogers* test, and the transformative use test.[90] First, the court rejected the *Rogers* test fearing it would "immunize a broad swath of tortious activity."[91] Hart, as a football player, was not "wholly unrelated" to the work, which would negate his right of publicity claims under the *Rogers* test.[92] The court feared this high bar to right of publicity claims would create perverse results, preventing nearly all of such claims.[93] After all, the primary reason to use a football player's identity is to profit off his fame in the football context, and the *Rogers* test would immunize this use.[94] The court also rejected the predominant use test, fearing it would require judges to place value on discrete portions of a work and compare them to the expressiveness as a whole.[95] This would be "subjective at best, arbitrary at worst, and in either case call[] upon judges to act as both impartial jurists and discerning art critics."[96] The court ultimately applied the transformative use test, holding that EA's use of Hart's identity in the football context did not create additional significant expression for it to be considered sufficiently transformative.[97]

¶28 The defendant argued that the use of Hart's likeness was transformative because, unlike in *No Doubt*, videogame users had the option to alter the avatars' features, such as hair and skin colors.[98] However, the court determined these modifications were too minimal to transform Hart's likeness sufficiently.[99] EA also claimed that the game was transformative as a whole,[100] but the court found this approach improper, stating that the only relevant question pertained to how the celebrity's identity was used, not the work's overall transformative nature.[101]

¶29 But the court was not without its doubts. For instance, the court acknowledged this could open the door to many forms of abuse, stating, "[T]his concern is particularly acute in the case of media that lend themselves to easy partition such as video games."[102] Further, writing in dissent, Judge Thomas Ambro took a broader view of the transformative use test,[103] arguing that the entire game, including the graphics, sound effects, and game scenarios, was transformative enough to warrant First Amendment protection.[104]

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[89] *Id.* at 165.
[90] *Id.* at 153.
[91] *Id.* at 157.
[92] *Id.* (explaining that, under the *Rogers* test, Hart would be "unable to assert a claim for appropriating his likeness as a football player precisely because his likeness was used for a game about football").
[93] *Id.*
[94] *Id.*
[95] *Id.* at 154.
[96] *Id.*
[97] *Id.* at 166.
[98] *Id.* at 168–69.
[99] *Id.* at 168.
[100] *Id.* at 169.
[101] *Id.*
[102] *Id.*
[103] *Id.* at 174–75.
[104] *Id.*

III. TRANSFORMATIVE USE TEST APPLIED TO ACTORS

¶30 As videogame producers become increasingly adept at replicating human features and movement, the growing number of rights of publicity violations is unlikely to abate. The cases discussed *supra* Part II involved musicians and athletes, but what about actors? Musicians are generally associated with specific songs or sounds. Athletes are usually recognized for a single sport or team. But actors are not limited to distinct roles. The importance of context in the transformative use test suggests that courts may encounter new problems when applying the test to characters modeled after actors.

A. Example 1: "Ellie" in The Last of Us

¶31 In 2013, Naughty Dog, a videogame developer, released *The Last of Us*,[105] which depicts a 14-year-old girl named "Ellie" living in a post-apocalyptic world.[106] After reviewing this "third-person-shooter" videogame, some commentators noted that the face and voice of Ellie looked and sounded similar to that of Ellen Page, a real-life actress.[107] In response, Naughty Dog preemptively revised these problematic features,[108] curtailing any potential legal controversy. Nevertheless, this scenario illustrates how the transformative use test, despite prior applications to musicians and athletes, does not adequately address a situation involving the unauthorized use of an actor's likeness in a videogame.

¶32 When applying the transformative use test, courts first determine the celebrity's identity, and then compare it with the defendant's use of that identity to decide whether the defendant has sufficiently transformed the identity to create an original expression. This process is simple for musicians and athletes: musicians gain recognition for playing music in a certain stage setting and athletes gain recognition for performing sports in a certain athletic setting. With musicians and athletes, a court can use these recognized actions and settings as a baseline from which a defendant may or may not have sufficiently transformed the celebrity's identity to afford First Amendment protection. Actors and actresses, however, play a variety of roles in virtually any setting. Determining an actor's identity presents many challenges, making the transformative use test more difficult in this context. Returning to *The Last of Us* as an example, the next section assumes that the game developer used the actress–celebrity's likeness in its videogame without consent.

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[105] *The Last of Us*, IGN.COM, http://www.ign.com/games/the-last-of-us/ (last visited Feb. 1, 2014).

[106] *The Last of Us*, THELASTOFUS.COM, http://www.thelastofus.playstation.com/characters.html (last visited Jan. 17, 2014).

[107] Tamoor Hussain, *The Last of Us Gets Enslaved Lead Designer, Doesn't Star Ellen Page*, COMPUTERANDVIDEOGAMES.COM (Dec. 12, 2011, 2:24 PM), http://www.computerandvideogames.com/329270/the-last-of-us-gets-enslaved-lead-designer-doesnt-star-ellen-page/.

[108] *"The Last of Us" Developer Calls Ellen Page-Likeness Reaction "Overblown,"* EXAMINER (June 25, 2013), http://www.examiner.com/article/the-last-of-us-developer-calls-ellen-page-likeness-reaction-overblown.

1. *Transformative Use Test Applied to "Ellie"*[109]

¶33 In the case of "Ellie," it is unclear what the Third Circuit would hold after *Hart*. But the manner in which courts usually apply the transformative use test suggests that a court would first focus on whether Naughty Dog used Ellen Page's identity. When applying the transformative use test, the court must identify the celebrity's identity, including the associated actions and settings, and compare those to the defendant's use. Therefore, before adequately comparing the fictional Ellie with the real-life Ellen Page, the court must determine which recognizable actions or features make Ellen Page famous.

¶34 Ellen Page is famous for multiple audio-visual works, including movies such as *Juno*, released in 2007, and *Inception*, released in 2010.[110] Although some actors have certain mannerisms, humor, or other features causing them to be cast as certain character types, many actors play a wide variety of roles. Thus, the results of the transformative use test in this scenario depend on the court's interpretation of (1) what actions and settings are associated with the actor, and (2) the actions and setting of the digital look-alike.

¶35 A preliminary issue is whether the similar facial features between fictional Ellie and actress Ellen Page indicate the use of Page's likeness. Besides facial features and voice, the similarities between Ellen Page and Ellie are minimal. Ellen Page was not involved in the production of the videogame, and Ellie was voiced and otherwise "played" by voice-actress Ashley Johnson.[111] The game never overtly references Ellen Page, and Naughty Dog has not represented or implied that Ellen Page is connected to the game.[112] Still, the facial and vocal similarities were enough to stir public commentary. If a court were to find that the character Ellie copied Ellen Page's likeness, the transformative use test would weigh heavily against Naughty Dog.

¶36 As for actions and setting, Ellie fights infected "zombies" and other survivors in a zombie-apocalypse environment. Page has never acted in a zombie film, play, or television program, distinguishing this scenario from *Hart*. However, she has acted in action-thriller movies, such as *Inception* and *X-Men: The Last Stand*, and most of her fans would likely be unsurprised to find Ellen Page in a zombie movie or videogame. While it is perfectly plausible that Ellen Page could be a character in *The Last of Us*, nothing about the setting specifically points to Page, illustrating the difficulty of applying the transformative use test to actors. Ultimately, the decision would likely depend on whether the court initially found that Naughty Dog used Ellen Page's likeness.

2. *Predominant Use Test Applied to "Ellie"*

¶37 Under the predominant use test, a court finding infringement is doubtful. Unlike the use of a famous hockey player's name in *Doe v. TCI Cablevision*, there is little evidence that Naughty Dog primarily employed the similar facial features to garner a commercial

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[109] This Comment assumes that Naughty Dog did not change the appearance of the "Ellie" character, and thus her appearance is still similar to actress Ellen Page.

[110] *Ellen Page*, IMDB, http://www.imdb.com/name/nm0680983/ (last visited Feb. 1, 2014).

[111] Danny Gallagher, *E3 2012: The Last of Us Doesn't Want You to Think Ellen Page Is Ellie, Announces Changes*, GAME TRAILERS (June 8, 2012, 10:27 AM), http://www.gametrailers.com/side-mission/16989/e3-2012-the-last-of-us-doesnt-want-you-to-think-ellen-page-is-ellie-announces-changes.

[112] David McLaughlin, *Using Images in Video Games: Potential Issues*, LAWAPART.COM (July 1, 2013), http://lawapart.com/posts/video-games/using-images-video-games-potential-issues.

advantage. In fact, the resemblance appears unintentional.[113] Thus, courts relying upon the predominant use test would likely dismiss any right of publicity claims in this scenario.

3. The Rogers *Test Applied to "Ellie"*

¶38 Under the *Rogers* test, Ellie's resemblance to Page could arguably meet the low threshold that asks whether the use is minimally relevant to the work. One could argue the face is an essential artistic element to the character's expression and recognition. Perhaps, Page's celebrity identity evinces characteristics that are emblematic of the videogame creator's intended artistic expression. But at the same time, the storyline did not depend on the person's similarity to any particular actor. Naughty Dog could have used someone else's face for Ellie to the same effect; in fact, Naughty Dog did ultimately revise the face before the game's public release.[114] Ultimately, a court might deem the use relevant because the test only requires that "the level of relevance merely must be above zero."[115]

¶39 The next step considers whether the use is merely a disguised advertisement. Individuals might purchase a zombie-survival game because of its association with a famous actress. Further, Naughty Dog changed Ellie's similar features, suggesting there was some confusion about Ellen Page's involvement in the game. But while directly applying the *Rogers* test prompts certain questions, First Amendment protection likely extends in this context because, looking to precedent, applying the *Rogers* test here is likely inappropriate. In the first place, courts often limit the *Rogers* test only to instances involving titles of works.[116] Moreover, the *Rogers* test derives from trademark law,[117] which the Third Circuit explained would "turn the right of publicity on its head" in the videogame context.[118] Unlike the right of publicity, which is akin to a property right, trademark law aims to prevent consumer confusion.[119] Because of this shifted focus, the *Rogers* test in many ways ignores the magnitude of misappropriation in a work. In fact, the *Rogers* test would penalize celebrities by not allowing them to protect their identities in works that most effectively exploit their public renown for commercial gain. For instance, in *Hart*, the court rejected the *Rogers* test because a plaintiff would be "unable to assert a claim for appropriating his likeness as a football player precisely because his likeness was used for a game about football."[120] Thus, as long as a videogame producer refrains from using a specific character to market the videogame to consumers, any right of publicity claim will be dismissed by the *Rogers* test if the misappropriation occurs in a videogame

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[113] Gallagher, *supra* note 111.

[114] *Id.*

[115] E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1100 (9th Cir. 2008) (holding use of trademark of a business in a videogame is exempt from liability under the *Rogers* balancing test).

[116] *See, e.g.,* Hart v. Elec. Arts, Inc., 717 F.3d 141, 157 (3d Cir. 2013); Facenda v. N.F.L. Films, Inc., 542 F.3d 1007, 1018 (3d Cir. 2008). *But see* ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 937 (6th Cir. 2003).

[117] Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989).

[118] *Hart,* 717 F.3d at 157 (rejecting the *Rogers* test because a plaintiff would be "unable to assert a claim for appropriating his likeness as a football player precisely because his likeness was used for a game about football. Adopting this line of reasoning threatens to turn the right of publicity on its head")

[119] *See* J. Schiffres, Annotation, *Invasion of Privacy by Use of Plaintiff's Name or Likeness in Advertising*, 23 A.L.R. 3d 865 (1969) (discussing how the "publicity tort seeks to protect property interest that celebrity has in his or her name").

[120] *Id.*

that is related to the celebrity's source of fame. In short, beyond instances involving the use of a celebrity's name in a videogame title, the *Rogers* test likely fails to provide a reasonable solution.

B. Example 2: Jodie in Beyond: Two Souls

¶40 In 2013, game developer Quantic Dream released *Beyond: Two Souls*, an action-adventure videogame.[121] The main character is "Jodie Holmes," who has been raised and studied by researchers because of her connection with a supernatural entity named "Aiden."[122] In the game, the user controls Jodie through different chapters of her life, including childhood interactions and assassination missions in service to the military.[123] The player can also control, to a limited extent, the Aiden character.[124]

¶41 Quantic Dream developed the videogame with the help of two established actors. Quantic Dream modeled Jodie Holmes's appearance and movement after actress Ellen Page, who also voiced the character.[125] Nathan Dawkins, a researcher and Jodie's surrogate father, is voiced by and modeled after actor Willem Dafoe.[126] The actors fully consented to the use of their bodies and voice, which the videogame mimics remarkably. Examining how the transformative use test, and others, would apply to both Ellen Page and Willem Dafoe in this scenario, wherein the real-life actors and their videogame counterparts appear almost entirely identical, leaving no room for doubt as to their connection, highlights potential future issues in this ever-evolving technological landscape. For this exercise, focusing on Ellen Page specifically, this Comment assumes neither Defoe nor Page consented to such use and that Quantic Dream did not overtly advertise any relationship with the actors.

1. Transformative Use Test

¶42 Although it is unclear what the transformative use test would determine in this scenario, it again likely boils down to whether the court would find that the character was modeled after Ellen Page. Quantic Dream designed the main character's facial features and body type to resemble Ellen Page. However, the multiple environments in which the character finds herself, along with her wildly different actions, differentiate her from any role Ellen Page has ever played. Still, Page is an actress who has played many roles across many genres, and because the character is identical to Page, similar to *No Doubt* and *Hart*, a court may find the use not to be sufficiently transformative. After finding use of her likeness, the character's actions and the game's setting are not so different from Page's roles to pass the transformative use test.

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[121] *Beyond: Two Souls*, GAMESPOT, http://www.gamespot.com/beyond-two-souls/ (last visited Feb. 1, 2014).
[122] *Id.*
[123] *Id.*
[124] *Id.*
[125] *Id.*
[126] *Id.*

2. Predominant Use Test

¶43 The predominant use test looks at whether the use of the celebrity's likeness is meant to exploit the person's identity for commercial gain. In contrast, if a work is predominantly expressive in that it posits a particular opinion about the celebrity, then First Amendment protection more likely applies.[127] The court would first need to decide whether Quantic Dream used Page's likeness. The developers could argue that they chose the character's features to reflect youth and innocence, and Page coincidentally shares those same characteristics. If the court found that Page's likeness had been used, the predominant use test would mostly likely favor Page. The game does not use the Jodie character as anything other than a protagonist. It does not present any opinions about Page or her films. Nothing in the game could be considered an expression pertaining to Page in the slightest. Without anything to suggest a reason for using Ellen Page's likeness, the only conclusion is that Quantic Dream sought to capitalize on Ellen Page's fame, which is exactly what the right of publicity is meant to prevent.

3. The Rogers *Test*

¶44 Under the *Rogers* test, a court must first assess whether the use of the plaintiff's image is minimally relevant to the underlying work.[128] As discussed *supra* Part III(A)(3), a court will likely consider the use relevant since the test has a very low bar, requiring that "the level of relevance merely must be above zero."[129]

¶45 After finding a work is minimally relevant, the court must determine whether the work is simply a disguised advertisement.[130] Judging whether a videogame character was intended to be a disguised advertisement is more difficult than determining the same for celebrities' names in production titles, as was the case in *Rogers*.[131] For instance, this likely requires considering the degree to which any marketing materials suggest the celebrity's involvement and whether a reasonable person would ascertain from an advertisement that the celebrity endorsed the product. And even assuming that Quantic Dream did not overtly advertise the similarities between characters and celebrities, consumers might nevertheless believe Ellen Page was involved in the videogame's production and be more likely to purchase the game.[132] Again, extending the *Rogers* test in the videogame context seems antithetical to the right of publicity's underlying purpose.

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[127] Hart v. Elec. Arts, Inc., 717 F.3d 141, 154 (3d Cir. 2012) (citing Doe v. TCI Cablevision, 110 S.W.3d 363, 374 (Mo. 2003)).

[128] Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989).

[129] E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1100 (9th Cir. 2008).

[130] *Rogers,* 875 F.2d at 1004.

[131] *Rogers,* 875 F.2d at 996–97 (comparing Ginger Rogers and Fred Astaire to the movie characters "Italian Ginger and Fred"). *See supra* Part III(A)(3) for similar analysis.

[132] Hart v. Elec. Arts, Inc., 717 F.3d 141, 157 (3d Cir. 2013) (explaining that, under the *Rogers* test, Hart would be "unable to assert a claim for appropriating his likeness as a football player precisely because his likeness was used for a game about football").

IV. CRITICISM AND ALTERNATIVES

¶46 Courts have applied the right of publicity not only to actors, but also to characters associated with certain actors.[133] For instance, if the actor is "inextricably identified" with the character that was used without consent, the Third Circuit has allowed actors to assert rights of publicity over such character personas.[134]

¶47 The transformative use test can turn on the court's determination of what an actor-celebrity has done to gain recognition. For right of publicity purposes, an actor's claim to fame cannot be defined as simply "acting" because that could be both over and under inclusive. For example, one could argue that, as an actor, the celebrity can claim any role that actors play, even if the celebrity herself has not played the role. On the other hand, defining the celebrity as an "actor" could be used to limit the right of publicity to situations in which the videogame character itself plays an actor. Such a narrow definition would virtually eliminate right of publicity claims in videogames.

¶48 The transformative use test requires the judge to make decisions concerning the artistic value and expressions of artwork. A major criticism of this test is that it creates a very subjective, and therefore unpredictable, analysis of artwork. Stated differently, the "hallmarks" of the transformative use test are its "[d]ifficulty of application and incertitude of result."[135]

¶49 One alternative would be to distinguish the medium used by the defendant, as opposed to the content.[136] Perhaps, a court could find that art reproductions of celebrity images on tee shirts are "commercial speech," thus granting the celebrity licensing rights.[137] But this approach poses separate challenges. For instance, while courts could impose different standards for videogames, this approach likely complicates things further because it would require judges to decide which artwork qualifies for different categories.

¶50 Although the courts in *Doe* and *Hart* ultimately disagreed on the appropriate test, their reasoning indicates certain consistencies that are fundamental to any balancing test. In *Doe*, the Missouri Supreme Court rejected the transformative use test largely because it overextended First Amendment protection.[138] The Missouri court's main criticism of the transformative use test was that a commercial work could receive First Amendment protection upon the slightest finding of personal expression, even if the work's sole purpose was commercial.[139] Both the *Doe* and *Hart* courts realized the subjective and complicated nature of any test that balances First Amendment protection with the right of publicity.

¶51 A second and more suitable alternative is to allow a defendant to use the celebrity's identity through a compulsory licensing scheme, which forces the defendant to pay a portion of any profits to the celebrity.[140] Third-party intervention is necessary in this

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[133] MCCARTHY, *supra* note 3, § 4:69 ("Some actors create a performing persona and are always closely linked in the public mind with their stage appearance and mannerisms. In these cases, the unpermitted commercial use of such a performing persona is an infringement of the actor's right of publicity.").

[134] McFarland v. Miller, 14 F.3d 912, 921 (3d Cir. 1994) ("We hold only that there exists at least a triable issue of fact as to whether [plaintiff] McFarland had become so inextricably identified with Spanky McFarland that McFarland's own identity would be invoked by the name Spanky.").

[135] MCCARTHY, *supra* note 3, § 8:72.

[136] *Id.*

[137] *Id.*

[138] Doe v. TCI Cablevision, 110 S.W.3d 363, 374 (Mo. 2003).

[139] *Id.*

[140] *See* David Frankly & Adam Kuhn, *Owning Oneself in a World of Others: Towards a Paid-for First*

context because of transaction costs and misaligned interests. First, requiring individuals to negotiate the terms of these agreements with individual celebrities would merely maintain the status quo. For any solution to be effective, it must account for modern realities, namely that the line between commercial exploitation and artistic expression is opaque. Second, courts should administer the proper royalty fee because prohibitively costly licensing rates would negate these arrangements' efficacy. Although all involved would technically benefit, the disparate bargaining power between the parties would likely preclude these relationships from forming in a cost effective manner. Specifically, the judge or jury should decide the proportion; perhaps, taking into account how much the product relies on the use of the celebrity's identity or likeness. In *Zacchini*, the Supreme Court emphasized that the plaintiff merely wished to be compensated for his talents; he was not attempting to censor speech.[141] While this test would still be selective, it would also be fair because the judge or jury can adjust the outcome to account for the varying degrees of "transformation" of the celebrity identity. As the law currently stands, the transformative use test results in a binary outcome. The defendant is either free to use the plaintiff's identity in a product or he is not.

¶52 However, if the judiciary continues to apply the transformative use test, courts should attempt to define the scope of the inquiry focusing on whether a work is truly transformative. Indeed, some argue that this inquiry, along with its nebulous contours, is what caused the Third and Ninth Circuits to adopt such different stances.[142] And these circuit courts are not alone. Though later reversed, a district court initially held that EA's use of Hart's identity in the *NCAA Football* videogame series was transformative enough to afford First Amendment protection.[143] Agreeing with the lower court's determination on appeal, Judge Ambro, writing in dissent, believed that EA's use of Hart's identity was sufficiently transformative because he looked at the videogame as a whole, including the graphics, sound effects, and game scenarios.[144] Although the Third and the Ninth Circuits seem to have settled on narrowing the scope of the inquiry to only the use of the celebrity's identity and the immediate surroundings thereof, alternative interpretations nevertheless remain salient, illustrating the need to define the scope of the inquiry.

V. CONCLUSION

¶53 As exemplified by *Hart* and *Keller,* balancing the right of publicity with First Amendment rights has frustrated courts and practitioners alike. As videogame technology progresses, videogames will continue to test the reach of the transformative use test. Some courts were able to agree, such as in *Hart*, *Keller*, and *No Doubt*, barring videogame companies from using individuals' identities in virtually the same settings for which the individuals had gained recognition. Moreover, when videogames add extraordinary details, such use is more likely to be transformative, as seen in *Kirby* and *Winter*.[145]

Amendment, 49 WAKE FOREST L. REV. 977, 1012 (2014).

[141] Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 578 (1977).

[142] Michael Schoeneberger, *Unnecessary Roughness: Reconciling* Hart *and* Keller *with a Fair Use Standard Befitting the Right of Publicity*, 45 CONN. L. REV. 1875, 1916 (2013).

[143] Hart v. Elec. Arts, Inc., 808 F. Supp. 2d 757, 770 (D.N.J. 2011).

[144] Hart v. Elec. Arts, Inc., 717 F.3d 141, 174–75 (3d Cir. 2013).

[145] *See* Kirby v. Sega of Am., Inc., 144 Cal. App. 4th 47, 59–60 (2006); Winter v. DC Comics, 69 P.3d 473, 479 (Cal. 2003).

¶54 However, it is unclear whether the use of celebrity identities in videogames satisfies the transformative use test in a manner that also provides adequate First Amendment protection. The examples discussed *supra* highlight the issues stemming from judicial overreliance on the setting of or the celebrity's actions in a videogame to determine right of publicity claims. Depending on the character portrayed, an actor's environment and actions may differ wildly between roles. The fact that videogame developers can use an actor's persona in virtually any setting magnifies the transformative use test's inherent flaws—specifically, that judges are in no position to make qualitative decisions on what is, in essence, a piece of art.

¶55 In the unique videogame context, courts must tailor the transformative use test to handle the unauthorized use of an actor's identity or name. Because EA has settled with the plaintiffs in *Hart* and *Keller*, the transformative use test remains in its current form, protecting celebrities' rights of publicity. Perhaps the best solution lies in splitting profits without censoring the speech, allowing judicial discretion for what is quantitatively, not qualitatively, fair on a case-by-case basis.