

LAW REVIEW

RECENT RIGHT OF PUBLICITY REVELATIONS: PERSPECTIVE FROM THE TRENCHES

*Jonathan L. Faber**

“Nothing anyone can do is going to enhance my father’s reputation, but they certainly can detract from it.”^Ω

I. Introduction

The Right of Publicity is tailor-made for headlines with the help of famous people,¹ unlikely fact patterns,² tectonic developments occurring at a pace that

* Founder, Managing Partner, and General Counsel of Luminary Group LLC, the exclusive representative of Babe Ruth, Vince Lombardi, Jesse Owens, and other iconic individuals. I am also an attorney with the Indiana law firm, McNeely Stephenson, where I handle trademark and business matters. I have negotiated thousands of transactions with advertising agencies, manufacturers, professional sports leagues and teams. I frequently serve as an expert witness, including in cases involving Nikki Sixx and Vans, Zooey Deschanel and Kohl’s, and Uma Thurman and Lancôme. I also teach *The Right of Publicity* at IU McKinney School of Law, and I am the administrator of www.RightOfPublicity.com. Prior to founding Luminary Group, I was President of CMG Worldwide. I publish and speak regularly on licensing, Right of Publicity, and expert valuations, and was responsible for the 2012 amendment to Indiana’s Right of Publicity statute. Thank you to: my parents, Dr. J. Arthur Faber and Professor Trudy Faber, for their input and review of this Article; Meg, Sebastian, Leonardo, Dayne, and Muskoka Faber for their encouragement; and Alison Slagowitz, Senior Articles Editor of *Savannah Law Review*, for inviting me to contribute to *The Walking Dead* Colloquium and for her assistance with this Article. Lastly, thanks to *Savannah Law Review* and its entire staff.

^Ω Interview with Vince Lombardi Jr., in Green Valley, Ariz. (Nov. 18, 2014); *see also* Mark Hyman, *Dead Men Don’t Screw Up Ad Campaigns*, BUSINESS WEEK (Mar. 9, 1997), <http://www.bloomberg.com/bw/stories/1997-03-09/dead-men-dont-screw-up-ad-campaigns>.

¹ *See* Eriq Gardner, *Katherine Heigl Lawsuit to Explore Nature of Corporate Tweets*, HOLLYWOOD REP. (Apr. 10, 2014 7:08 AM), <http://www.hollywoodreporter.com/thr-esq/analysis-katherine-heigl-duane-reade-lawsuit-695029> (reporting Katherine Heigl’s lawsuit against Duane Reade for an unauthorized Twitter post); Benjamin Lee, *Robin Williams Restricted Use of His Image for 25 Years After His Death*, GUARDIAN (Mar. 31, 2015, 4:26 PM), <http://www.theguardian.com/film/2015/mar/31/robin-williams-restricted-use-of-his-image-for-25-years-after-his-death>; Selim Algar, *Hall & Oates Sue Brooklyn Company Over Hipster ‘Haulin’ Oats’ Granola*, PAGE SIX (Mar. 4, 2015, 8:00 PM), <http://pagesix.com/2015/03/04/hall-oates-sue-brooklyn-company-over-hipster-haulin-oats-granola/>; *see also* Complaint for Breach of Oral Contract at 2–4, *Deschanel v.*

entrenched areas of law rarely exhibit,³ and the very idea that deceased individuals have intellectual property rights in their personae.⁴ The Right of Publicity also draws torrents of criticism from legal commentators, in large part because of these characteristics. In this Article, I focus on three pivotal events—a line of video game cases involving avatars of real people, the enactment of Indiana’s current Right of Publicity statute, and Michael Jordan’s litigation against two Chicago-area grocery stores—that reflect the headline-grabbing nature of the Right of Publicity and illuminate how criticism of the Right of Publicity often misses the mark. Along the way, I also share some of the perspective I have gained from contributing to various legislative efforts and working on behalf of hundreds of Right of Publicity owners over the last two decades.⁵

II. A Clear Case for the Right of Publicity

The Right of Publicity is not a form of trademark, copyright, false advertising, or right of privacy.⁶ The Right of Publicity also is not as ubiquitous, widely-practiced, or as well-understood as its intellectual property siblings.⁷

Steven Madden Ltd., No. BC451472 (Cal. Super. Ct. Dec. 17, 2010) (alleging that Steven Madden Ltd., Kohl’s Department Store, and other defendants breached an endorsement agreement and violated Deschanel’s Right of Publicity). I served as an expert witness in the *Deschanel* case.

² See Dominic Pattern, *Fox News’ Harris Faulkner Sues Hasbro for \$5M over Harris Faulkner Hamster*, DEADLINE (Sept. 1, 2015), <http://deadline.com/2015/09/fox-news-harris-faulkner-hasbro-lawsuit-trademark-1201511871/>; *Russian Lawyers Say Harry Potter Character Dobby is Based on Putin*, GUARDIAN (Jan. 30, 2003, 6:13 AM), <http://www.theguardian.com/film/2003/jan/30/harrypotter.news>; Sam Ford, *Marion Barry’s Widow Sues Husband’s Kidney Donor over Use of His ‘Celebrity Image’*, WJLA WASH., D.C. (Apr. 8, 2015), <http://wjla.com/news/local/marion-barry-s-widow-sues-her-late-husband-s-kidney-donor-113011>.

³ State legislatures recently enacting Right of Publicity legislation include Alabama, Hawaii, Indiana, Washington, and California, and bills have been introduced in the last few years in Arkansas, Connecticut, Illinois, Louisiana, Maryland, Massachusetts, Michigan, Mississippi, Missouri, New Hampshire, New York, and North Carolina. See *Statutes & Interactive Map*, RIGHT OF PUBLICITY (July 31, 2015), <http://www.rightofpublicity.com/statutes>.

⁴ See Zack O’Malley Greenburg, *The 13 Top-Earning Dead Celebrities of 2015* (Oct. 27, 2015, 9:15 AM), <http://www.forbes.com/sites/zackomalleygreenburg/2015/10/27/the-13-top-earning-dead-celebrities-of-2015/> (ranking Michael Jackson first at \$115 million, Elvis Presley second at \$55 million, and others like Marilyn Monroe at \$17 million and Albert Einstein at \$11 million).

⁵ These include the Babe Ruth League, Inc., and the Family of Babe Ruth, the Diana, Princess of Wales Memorial Fund, the Raymond and Rosa Parks Institute for Self-Development, Marilyn Monroe LLC, the Family of General Patton, the Family of Vince Lombardi, Sophia Loren, Chuck Berry, Don McLean, the Ella Fitzgerald Charitable Foundation, the Jackie Robinson Foundation, and the Jesse Owens Trust.

⁶ J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:3 (2d ed. 2014).

⁷ These factors underscore why the Right of Publicity needs stronger advocacy and educational efforts. Even copyright, trademark, and patent often are referred to casually as if they are interchangeable terms. See generally Jonathan L. Faber, “*Trade-Wrongs*”:

And, thus, the Right of Publicity declares its mandate, because no other area of the law addresses the needs and issues it encompasses. Despite this eloquent, self-evident rationale, the Right of Publicity gets labeled as controversial, a means of “private censorship” of popular culture,⁸ even “seemingly unlimited.”⁹ This occurs more often than it deserves, especially considering that the Right of Publicity has been: (1) affirmed strongly by the Supreme Court of the United States,¹⁰ (2) recognized by an ever-increasing number of state legislatures as well as over half the United States via common law, and (3) accepted by secondary sources like the American Law Institute’s *Restatement (Third) of Unfair Competition*.¹¹ Most draft legislation in the last two decades reflects increasing consistency with existing statutes that are consulted as models, and the majority of Right of Publicity statutes include significant limitations and broad exemptions for First Amendment purposes.¹² Commentators seem to ignore these points when proclaiming that the Right of Publicity is a threat to the First Amendment, a sword of censorship, or a mess of contradictory laws; but “[a]s much intellectual fun as it may be to assail right of publicity law as philosophically incongruous or incomprehensible, it is quite

Misadventures in Un-Intellectual Property, 48 RES GESTAE 3, 25 (2004) (recounting instances in which those unfamiliar with intellectual property law distinctions have broadcast misused terminology very publicly).

⁸ Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 125, 137–38 (1993).

⁹ Marshall Leaffer, *The Right of Publicity: A Comparative Perspective*, 70 ALB. L. REV. 1357, 1357 (2007).

¹⁰ In *Zacchini v. Scripps-Howard Broadcasting Co.*, the United States Supreme Court provided critical guidance for policy justification supporting the Right of Publicity, and ruled that the Right of Publicity does not inherently conflict with the First Amendment. 433 U.S. 564 (1977). The facts involved a “human cannonball” who did not want his entire performance televised on the local news. *Id.* at 564. The Court rejected the Broadcasting Company’s First Amendment defense, noting that the decision was not merely to ensure compensation for the performer; rather, it was to provide “an economic incentive for him to make the investment required to produce a performance of interest to the public.” *Id.* at 576. The incentive rationale buttresses various forms of intellectual property.

¹¹ Twenty-one states recognize the Right of Publicity via statute (Arizona, California, Florida, Hawaii, Illinois, Indiana, Kentucky, Massachusetts, Nebraska, Nevada, New York, Ohio, Oklahoma, Pennsylvania, Rhode Island, Tennessee, Texas, Utah, Virginia, Washington, and Wisconsin). See *A Brief History of the Right of Publicity*, RIGHT OF PUBLICITY (July 31, 2015), <http://rightofpublicity.com/brief-history-of-rop>. Thirty-eight states have common law precedent. WESTON ANSON, RIGHT OF PUBLICITY: ANALYSIS, VALUATION, AND THE LAW (2015); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46–49 (1995).

¹² See, e.g., CAL. CIV. CODE § 3344.1(a)(2) (West 2016) (“For purposes of this subdivision, a play, book, magazine, newspaper, musical composition, audiovisual work, radio or television program, single and original work of art, work of political or newsworthy value, or an advertisement or commercial announcement for any of these works, shall not be considered a product, article of merchandise, good, or service if it is fictional or nonfictional entertainment, or a dramatic, literary, or musical work.”).

possible to analyze it in an organized, straightforward fashion that has practical value.”¹³

The Right of Publicity¹⁴ refers to every individual’s¹⁵ inherent right to control the commercial use of his or her persona, which can include name, voice, signature, photograph, image, likeness, distinctive appearance, gestures, or mannerisms.¹⁶ The most critical function of the Right of Publicity is *control*. The Right of Publicity is not merely a property asset, like a painting or real estate, for estate tax purposes. The Right of Publicity ensures that if a person, or that person’s heir, does not seek to commercialize the right, they are not compelled to do so. For infringement purposes, the analytical key is *identifiability*, such that if a person is identifiable from the context of a use, it quite likely implicates the Right of Publicity. That the Right of Publicity remains state based, as opposed to federal law,¹⁷ is a fact that undoubtedly contributes to the perception that the right is difficult to understand. But no one can claim that the Right of Publicity rivals the complexity of the Copyright Code, even though the latter is primarily both federal and singular in source.¹⁸

Other common criticisms are that the Right of Publicity is capable of being abused or that passage of statutes would lead to tidal waves of litigation;¹⁹

¹³ Joel S. Lind, *The Right of Publicity in New York: A Practical Analysis*, 7 COLUM. J.L. & ARTS 355, 371 (1982).

¹⁴ The term “Right of Publicity” was first articulated in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953). In *Haelan*, the court focused on the right of a person to license his likeness for profit. *Id.* “We think that, in addition to and independent of that right of privacy . . . 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 . . .” *Id.* at 868. Judge Jerome Frank determined that this right is necessary: “it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likeness, would feel sorely deprived if they no longer received money for authorizing advertisements[and] popularizing their countenances . . .” *Id.*

¹⁵ MCCARTHY, *supra* note 6, at § 4:3. While everyone possesses a Right of Publicity, Right of Publicity contracts and litigation almost always involve celebrities because advertising agencies and merchandise companies seek out the familiarity, goodwill, social media audiences, accomplishments, and even controversy that famous people bring to the equation. See Jonathan L. Faber & Mark Roesler, *Celebrity Licensing*, in THE LICENSING DESK BOOK 52–60 (Gregory J. Battersby & Charles Grimes eds., 2001) (instructing on the customs and practices pertaining to celebrity licensing and the Right of Publicity).

¹⁶ See IND. CODE ANN. § 32-36-1-7 (West 2015) (defining the Right of Publicity to mean “a personality’s property interest in the personality’s: (1) name; (2) voice; (3) signature; (4) photograph; (5) image; (6) likeness; (7) distinctive appearance; (8) gestures; or (9) mannerisms”).

¹⁷ For discussion on the possibility of federalizing the Right of Publicity, see Jonathan L. Faber & Wesley A. Zirkle, *Spreading Its Wings and Coming of Age: With Indiana’s Law as a Model, the State-Based Right of Publicity is Ready to Move to the Federal Level*, 45 RES GESTAE 4, 31–41 (2001).

¹⁸ Copyright Act of 1976, 17 U.S.C.A. §§ 101–1332 (West 2015).

¹⁹ Such hyperbole does make effective talking points for lobbyists seeking to scare legislators or sway media coverage. See MOTION PICTURE ASS’N. AM., MEMORANDUM IN OPPOSITION TO INDIANA HOUSE BILL 1133, at 2 (2012).

however, no area of the law is immune to abuse, and frivolous lawsuits occur in almost every practice area. None of these criticisms justify refusing recognition of a legal doctrine. Those in the legal profession navigate the perils of abuse with dismissals, counterclaims, attorneys' fees, malicious prosecution claims, and sanctions always in play. Applicable statutes of limitations generally limit how far back an infringement claim can reach.²⁰ Additionally, the judiciary has a good track record for making case-specific determinations when First Amendment concerns legitimately trump the Right of Publicity, as demonstrated by the cases I discuss in the following sections of this Article.

Various rationales buttress the Right of Publicity, but the most direct policy rationale for the Right of Publicity is the "natural rights of property justification," arguing that "nothing is so strongly intuited as the notion that my identity is *mine*—it is my property to control as I see fit."²¹ If Occam's razor applies to the law, this simple justification should suffice.²² Consider the indirect debate of two intellectual property scholars on this topic. Professor Marshall Leaffer states that the Right of Publicity "with its ever expanding contours and . . . lack of sound theoretical justification, has been the object of much controversy and scholarly criticism."²³ By contrast, the foremost Right of Publicity scholar, Professor J. Thomas McCarthy, acknowledges that some legal commentators do not back the natural rights theory because it rests more on "visceral impulses of 'fairness' than upon hard-edged logical syllogisms."²⁴ "However," Professor McCarthy continues, "to ignore widely held perceptions of unfair conduct is to ignore a great deal of what created and continues to inform most of our legal system."²⁵ Professor McCarthy also states:

The rebuttal most often given by critics of the right of publicity is that it is inconsistent with First Amendment policies of free speech and a free press. This concern has been repeated with regard to both the right of privacy and the right of publicity with unceasing vigor for over 80 years. Critics never seem to tire of using the free speech argument over and over again as a broad-based criticism of the very existence of both a right of privacy and a right of publicity. . . . If First Amendment policies demand total nonrecognition of *any* right of publicity in *any* case, then consistency demands that we similarly wipe out huge bodies of law, such as copyrights, trademarks, defamation and antitrust Balancing

²⁰ This point defuses another popular accusation against the Right of Publicity, that its descendibility unfairly imposes costs on society and individuals due to the duration of its protections. RAY D. MADOFF, *IMMORTALITY AND THE LAW: THE RISING POWER OF THE AMERICAN DEAD* 136–41 (2010).

²¹ MCCARTHY, *supra* note 6, § 2:1.

²² The general tenet that the simplest answer is usually the correct one, as attributed to English Franciscan Friar William of Ockham (1285–1347/49). Brian Duignan, *Occam's Razor*, *ENCYCLOPÆDIA BRITANNICA* (June 4, 2015), <http://www.britannica.com/topic/Occams-razor>.

²³ Leaffer, *supra* note 9, at 1359.

²⁴ MCCARTHY, *supra* note 6, § 2:2.

²⁵ *Id.*

free speech against the right of publicity should be no more, or less, difficult here than in any other area of the law.²⁶

Such debate is nothing new. Even at the dawn of the twentieth century, when the Right of Publicity had not yet been named, the Supreme Court of Georgia in *Pavesich v. New England Life Insurance Company*²⁷ intuited the balancing of these interests without fear that doing so might, at times, be difficult:

Liberty of speech and of the press is and has been a useful instrument to keep the individual within limits of lawful, decent, and proper conduct; and the right of privacy may be well used within its proper limits to keep those who speak and write and print within the legitimate bounds of the constitutional guaranties of such rights. One may be used as a check upon the other, but neither can be lawfully used for the other's destruction.²⁸

Pavesich provides a stark contrast to *Roberson v. Rochester Folding Box Co.*,²⁹ in which New York seemed lost without the guidance of a statute. Even sensing the plaintiff had been wronged, the *Roberson* court announced that it could find no basis to rule for the plaintiff, prompting the *Pavesich* court to admonish New York:

[W]e think the conclusion reached by [the majority in *Roberson*] was the result of an unconscious yielding to the feeling of conservatism which naturally arises in the mind of a judge who faces a proposition which is novel. . . . [B]ut this conservatism should not go to the extent of refusing to recognize a right which the *instincts of nature prove to exist*, and which nothing in judicial decision, legal history, or writings upon the law can be called to demonstrate its nonexistence as a legal right.³⁰

Nevertheless, the debate likely will continue. Professor Leaffer states, “I believe, as do many others, that the law must balance the celebrity’s interest in

²⁶ *Id.* at § 2:4. Professor Leaffer defends copyright on a similar basis. “Copyright appears to encroach on the freedom of speech and First Amendment values because it prohibits the right to reproduce the expression of others. Does this produce an irreconcilable tension between the two constitutional provisions: the Patent and Copyright Clause and the First Amendment?” MARSHALL A. LEAFFER, UNDERSTANDING COPYRIGHT LAW § 10.15 (6th ed. 2014).

It has now been universally accepted that copyright’s idea-expression dichotomy supplies the necessary definitional balance, allowing access to and dissemination of ideas and facts while protecting the author’s expression. . . . Copyright law does not impede the flow of information per se, and is not an obstacle to the free flow of ideas, but provides positive incentives to encourage the flow.

Id.

²⁷ 50 S.E. 68 (Ga. 1905).

²⁸ *Id.* at 74.

²⁹ 64 N.E. 442, 450 (N.Y. 1902).

³⁰ *Pavesich*, 50 S.E. at 78 (emphasis added).

controlling their image with the public's interest in using those images as a means of communication."³¹ Few would disagree, though "using" and "means of communication" are precisely the details in which the devil hides. I submit that the law *is* balancing those interests in case after case already, and Professor McCarthy and Professor Melville Nimmer provide sufficient commentary to lay this existential debate to rest. Professor McCarthy contends that "[p]erceptive legal commentators do not shy away from defending the right to control commercial use of identity as a self-evident natural right of every person."³² Similarly, Professor Nimmer states: "It would seem to be a first principle of Anglo-American jurisprudence, an axiom of the most fundamental nature, that every person is entitled to the fruit of his labors unless there are important countervailing public policy considerations."³³

III. Transformation or Appropriation: Dictators, Athletes, and Rock Stars

*"I can transform ya, I can transform ya"*³⁴

Video game content has presented a wellspring of Right of Publicity activity in the last few years. Video game companies are accustomed to securing licenses for the use of people in game programming,³⁵ so it is a relatively new development that the video game industry now routinely lobbies for a video game exemption in most states considering Right of Publicity legislation. As a rule, blanket exemptions should only be considered in the rarest of instances. Additionally, they are unnecessary because the judiciary has done a good job considering Right of Publicity issues presented in video games through application of the Transformative Use Test.³⁶

³¹ Leaffer, *supra* note 9, at 1358.

³² MCCARTHY, *supra* note 6, at § 2.2.

³³ Melville B. Nimmer, *The Right of Publicity*, 189 L. & CONTEMP. PROBS. 203, 216 (1954). It is tempting to test the courage of a critic's convictions. Perhaps if the critic was used commercially without permission, his or her position on the Right of Publicity would be tempered. As the plaintiff in *Roberson* later wrote to the judge who ruled against her (after the judge objected to persistent photographers during his presidential campaign) "it makes a lot of difference whose ox is gored." *Parker Taken to Task by Indignant Woman: If I Can Be Photographed, Why Not You?*, N.Y. TIMES, July 27, 1904, at 1 (quoting Abigail Roberson's letter of July 26, 1904, to Judge Alton B. Parker).

³⁴ CHRIS BROWN, *I Can Transform Ya*, on GRAFFITI (JIVE Records 2009).

³⁵ The licensing companies I have been affiliated with have handled numerous agreements for use of famous personalities in video games.

³⁶ The Transformative Use Test was developed for copyright infringement cases to test whether the alleged infringing expression meets the fair use exemption regarding "the purpose and character of the use." 17 U.S.C. § 107(1); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578-79 (1994). The inquiry is "whether the new work merely 'supersede[s] the objects' of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression meaning, or message." *Campbell*, 510 U.S. at 578-79 (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841) (No. 4901)) (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985)).

The Transformative Use Test came to life in the Right of Publicity context in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*³⁷ At issue in *Comedy III* was an artist's faithful depiction of the Three Stooges, which was being sold on t-shirts and lithographs. The case did not concern the plaintiff's original artwork, but its application to consumer products. The court held that when a celebrity is the subject of a work of art that is not an original single work of art, the celebrity's publicity rights are outweighed by the artist's First Amendment right to commercially produce his art *only* when the work is "sufficiently transformative."³⁸ In determining whether a work is sufficiently transformative, the relevant inquiry is whether "the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted."³⁹ Stated differently: "when an artist's skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist's right of free expression is outweighed by the right of publicity."⁴⁰

In late 2014 and early 2015, a state court and a federal court in California issued two contrasting rulings involving the Transformative Use Test. In *Noriega v. Activision/Blizzard, Inc.*,⁴¹ a California Superior Court ruled in favor of the defendant because the use was held to be transformative.⁴² However, in *Davis v. Electronic Arts, Inc.*,⁴³ a Ninth Circuit Court of Appeals ruled in favor of the plaintiffs because the use was not transformative.⁴⁴ *Noriega* centered on inclusion of former Panamanian military dictator Manuel Noriega as a character in *Call of Duty: Black Ops II*.⁴⁵ While one may wonder if the outcome may have related to an unsympathetic complainant or the different treatment political figures receive in relation to defamation, fair use, and parody,⁴⁶ the context of the use did not center on Panama or Noriega's time in power, and Noriega was only an incidental character in the game.⁴⁷ Contrastingly, in *Davis v. Electronic*

³⁷ 21 P.3d 797 (Cal. 2001).

³⁸ *Id.* at 810.

³⁹ *Id.*

⁴⁰ *Id.*

⁴¹ No. BC 551747, 2014 WL 5930149 (Cal. Super. Ct. Oct. 27, 2014).

⁴² *Id.* at *4.

⁴³ 775 F.3d 1172 (9th Cir. 2015).

⁴⁴ *Id.* at 1178. The legal issue in these bookend cases of *Noriega* and *Davis* mirror that of *Comedy III Productions, Inc.* (decided in favor of plaintiffs as a non-transformative use), as well as *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003) (decided in favor of defendants as a transformative use of the musicians Johnny and Edgar Winter's likenesses in a comic book depicting the worm-like, repugnant "Autumn brothers").

⁴⁵ Former New York Mayor Rudy Giuliani served as co-counsel for Activision, who himself possesses a potentially valuable Right of Publicity. Eriq Gardner, 'Call of Duty': Can Rudy Giuliani Beat Manuel Noriega, the Three Stooges and Gwen Stefani?, HOLLYWOOD REP. (Sept. 22, 2014, 1:54 PM), <http://www.hollywoodreporter.com/thr-esq/call-duty-can-rudy-giuliani-734737>.

⁴⁶ Jonathan Faber, *The Latest Interpretation of the Transformative Use Test*, RIGHT OF PUBLICITY (Jan. 8, 2015), <http://rightofpublicity.com/the-latest-interpretation-of-the-transformative-use-test>.

⁴⁷ *Noriega*, No. BC 551747, 2014 WL5930149, at *3.

Arts, Inc.—a claim brought by various former NFL athletes for the unauthorized use of their likenesses in Electronic Arts’s *Madden NFL* games under California’s Civil Code § 3344 and California’s common law—the players were *essential* characters in the game.⁴⁸ The *Davis* court rejected the Transformative Use defense, holding that the *Madden NFL* game “replicates players’ physical characteristics and allows users to manipulate them in the performance of the same activity for which they are known in real life—playing football for an NFL team.”⁴⁹

Unlike the fanciful, fleeting and fictional context of *Noriega*, the use of plaintiffs’ likenesses in *Davis* directly linked to the exact activities and attributes for which they are known, in as realistic a depiction as technology allows, and in a way that is central to the premise of the game.⁵⁰ This makes perfect sense, as the very objective in sports video game programming is to make the environment and experience of gameplay as realistic as possible.⁵¹ The authentic players are

⁴⁸ On September 3, 2015, Electronic Arts’s bid to extend a stay was denied by a California federal judge. Daniel Langhorne, *EA Takes ‘Madden NFL’ Publicity Rights Row to High Court*, LAW360 (Oct. 8, 2015, 8:02 PM), <http://www.law360.com/articles/712344/ea-takes-madden-nfl-publicity-rights-row-to-high-court>.

⁴⁹ *Davis*, 775 F.3d at 1178.

⁵⁰ Former Nebraska and Arizona State quarterback Sam Keller also brought suit against Electronic Arts and the NCAA. *See Keller v. Electronic Arts, Inc.*, No. C 09-1967CW, 2010 WL 530108 (N.D. Cal. Feb. 8, 2010). Later, the U.S. Court of Appeals ruled in favor of plaintiffs, deeming the use of Keller’s likeness non-transformative. *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268, 1284 (9th Cir. 2013). Electronic Arts petitioned the U.S. Supreme Court for certiorari, arguing that the Court should adopt the test used in *Rogers v. Grimaldi*, 875 F.2d 994 (1989) (a trademark case surrounding the title of a feature film) as opposed to the Transformation Test, thereby reframing the inquiry as whether Electronic Arts’s use of student athletes’ likenesses in the video game either was protected by the First Amendment, or whether the use was “unrelated to the work or [was] used in a manner that falsely indicates that the celebrity has endorsed the product.” Brief for Petitioner at 10, 35, *Electronic Arts Inc. v. Keller*, 135 S. Ct. 42 (2014) (No. 13-377). Since the *Rogers* test was devised as an analysis only for whether *titles* of expressive works misled consumers, it would have been the wrong test for the facts under *Keller*. It is surprising the *Rogers* test was even suggested, except of course that switching the analytical test when already losing a case may have been deemed worth a shot. The Supreme Court denied certiorari in any event. *Electronic Arts, Inc. v. Keller*, 135 S. Ct. 42 (2014). Luminary Group LLC joined SAG-AFTRA in submitting an amicus brief to the U.S. Court of Appeals in *Keller*. Brief for Screen Actors Guild, Inc. et al. as Amici Curiae supporting Appellees, *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268 (No. 10-15387), 2010 WL 5079225 (9th Cir. 2013).

⁵¹ *Contra Brown v. Electronic Arts, Inc.*, 724 F.3d 1235, 1248 (9th Cir. 2013) (ruling that Jim Brown’s inclusion in the *Madden NFL* video game was not an infringement of § 43(a) of the Lanham Act). In *Brown*, the court *did* employ the *Rogers* test to determine that the video game was entitled to First Amendment protection but *only* in relation to Brown’s Lanham Act claim. *Id.* at 1240 n.2. The court held that under the *Rogers* test, Jim Brown’s likeness was artistically relevant to the game, also noting that there were no facts showing that his inclusion misled consumers about his involvement with the game. *Id.* at 1243. “We emphasize that this appeal relates only to Brown’s Lanham Act claim. Were the state [Right of Publicity] causes of action before us, our analysis may be different and a different outcome may obtain.” *Id.* at 1240 n.2. The court’s caveat was reinforced the

essential and indispensable to that objective, thus, transformation is antithetical.⁵²

In early 2011, the ska-rock band No Doubt secured a video game-related ruling against Activision.⁵³ No Doubt had entered into contract with Activision for a limited license of the band's Right of Publicity to Activision for inclusion in its popular *Band Hero* video game;⁵⁴ however, Activision programmed the game to allow users the ability to manipulate the No Doubt avatars into performing songs that were not the band's, nor approved by the band, and were not within the rights granted in the contract.⁵⁵ The court rejected Activision's First Amendment and Transformative Use defenses because, like the sports-related video game cases of *Davis*, *Keller*, and *Hart*, there was no transformation of the band's members in the game—again, the goal was to be as non-transformative as possible.⁵⁶

As much as video game companies might like the windfall from a Right of Publicity exemption, thereby receiving the same treatment as books or news reporting, regardless of the nature of the use in the video game, these rulings confirm that video games do not warrant a blanket exemption. Video games are an entertainment product. If the use of an actual person's name, image, likeness, or elements of persona makes a video game more appealing or valuable, and the game is programmed to represent a specific person as accurately as possible (or is otherwise capitalizing on that person's Right of Publicity), then the use *should* require permission from the rights holder.

same day and by the same judge and on very similar facts in *Keller*, holding that the video game at issue in that case was not protected by the First Amendment in the Right of Publicity context. *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d at 1284.

⁵² See *Hart v. Electronic Arts, Inc.* 717 F.3d 141 (3rd Cir. 2013). In mid-May 2013, a ruling from the Third Circuit found in favor of former Rutgers quarterback Ryan Hart in his claim against Electronic Arts. *Id.* at 170. The *Hart* court determined that use of Hart in the NCAA football video game was not transformative. *Id.* The court also explained that the *Rogers* test is not the best fit for the situation presented in *Hart* and confirmed that the First Amendment does not trump the Right of Publicity in a non-transformative, commercial use. *Id.* at 155–58.

⁵³ *No Doubt v. Activision Publishing, Inc.*, 122 Cal. Rptr. 3d 397 (Cal. Ct. App. 2011).

⁵⁴ *Id.* at 1022–24.

⁵⁵ *Id.* at 1024.

⁵⁶ *Id.* at 1034–35. *But see Kirby v. Sega of America, Inc.*, 50 Cal. Rptr. 3d 607 (Cal. Ct. App. 2006). In *Kirby*, the singer of the band Deee-Lite sued video game producer Sega because a character called Ulala in *Space Channel 5* was similar to elements of plaintiff's persona. *Kirby*, 50 Cal. Rptr. 3d at 609. The court analyzed the similarities and differences between the plaintiff and Ulala and held that the *character* to be transformative, because “[t]aken together, these differences demonstrate Ulala is ‘transformative,’ and respondents added creative elements to create a new expression.” *Id.* at 616.

IV. Indiana Sets the Pace⁵⁷

Indiana's Right of Publicity law was enacted in 1994 on the strength of testimony from, among others, Ryan White's mother, Jeanne White-Ginder.⁵⁸ Ryan White became a national figure as a child during the mid-1980s, because he was one of the first children to die after contracting AIDS from hemophilia complications.⁵⁹ White died in 1990.⁶⁰ A few years later, his mother was in front of the Indiana legislature testifying about extremely distasteful commercial products being sold with Ryan's name and likeness on them, and the need for a law that would provide a response to such activity.⁶¹ The statute was understood to protect everyone from Indiana legend James Dean to Ryan White (both of whom died before passage of the Indiana statute) from unauthorized commercial uses.⁶² Indiana's statute is a codification of Indiana's common law.⁶³ Indiana's statute was not passed to create something new or to retroactively grant rights that did not previously exist.

Yet another video game case proved pivotal when, in 2009, a ruling in a case concerning a series of video games by Electronic Arts that were based on *The Godfather* novel and film franchise threatened to undermine Indiana's status as a "celebrity-friendly jurisdiction."⁶⁴ Within the game's programming were two weapons—out of two dozen that a user could access—called the "Dillinger Level Three Tommy Gun" and the "Modern Dillinger Tommy Gun."⁶⁵ The claim was brought by Dillinger, LLC, which is owned by the closest living heir of the Depression-Era bank robber, John Dillinger (who was born in Indiana), for

⁵⁷ The majority of the following account of the events and arguments surrounding the enactment of Indiana's Right of Publicity legislation is from personal, first-hand involvement and observations as the primary and foremost advocate of the legislation outside of Indiana's legislature. Thus, the footnotes in this Section will illuminate the text by referring to first-hand observations, and will also cite to documents privately held in my files.

⁵⁸ IND. CODE ANN. §§ 32-36-1-0.2-20 (2015); Telephone Interview with Dean Barnhard, Partner, Barnes & Thornburg LLP (Feb. 8, 2016) (recounting how Ryan White's mother testified regarding offensive commercial uses of her son's persona and the need for the proposed Indiana Right of Publicity legislation).

⁵⁹ *Ryan's Story*, RYAN WHITE 1971-1990, http://www.ryanwhite.com/Ryans_Story.html.

⁶⁰ *Id.*

⁶¹ Interview with Dean Barnhard, *supra* note 58.

⁶² See J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* §§ 6:58-60 (2008) (discussing the Indiana statute predating the ruling in *Dillinger, LLC v. Electronic Arts*, 795 F. Supp. 2d 829, 831 (S.D. Ind. 2011)).

⁶³ See *Continental Optical Co. v. Reed*, 86 N.E.2d 306, 308 (Ind. Ct. App. 1949). The court recognized the tort of appropriation claim of a lens grinder whose image was used without authorization in an advertisement for a lens manufacturer. *Id.* at 310.

⁶⁴ *Dillinger, LLC v. Electronic Arts*, 795 F. Supp. 2d 829 (S.D. Ind. 2011); see Jonathan Faber, *Indiana: A Celebrity-Friendly Jurisdiction*, 43 RES GESTAE 9, 24-30 (2000).

⁶⁵ *Dillinger, LLC*, 795 F. Supp. 2d at 831; see also *The Godfather: The Game/Weapons*, STRATEGYWIKI, http://strategywiki.org/wiki/The_Godfather:_The_Game/Weapons (last visited May 31, 2016).

violating John Dillinger's Right of Publicity.⁶⁶ *The Godfather* video games are not set in the Depression Era and do not center on bank robbery.⁶⁷ There are no occurrences in the game of a character named John Dillinger, nor was Dillinger's name or image used in promotion for the game.⁶⁸ The only use at issue was the existence of the Dillinger Tommy Gun reference.⁶⁹

The judge could have ruled for the defendant in *Dillinger* on the basis that either the use was *de minimis*, editorial in nature, the word "Dillinger" did not implicate the Right of Publicity of John Dillinger, or, perhaps, that the use was transformative. Despite all of these available avenues to support a ruling for the defendant, the judge determined that Indiana's statute does not protect those who died before the passage of the statute, regardless of the legislative intent behind the statute or prior rulings confirming that the statute applies to those who predeceased the statute's enactment.⁷⁰

The *Dillinger* ruling necessitated HB1133 in 2012, a bill co-sponsored by Senators Luke Kenley and Richard Bray, who also sponsored the original Right of Publicity bill, and Representative Sean Eberhard.⁷¹ Opposition primarily came from the Motion Picture Association of America (MPAA).⁷² While the amendment could have been accomplished through a single clause stating that the Right of Publicity applies "to those who died prior to the effective date of the statute," attempts were made by the opposition to rework significant portions of the statute which were not part of the proposed amendment language.⁷³ The opposition rapidly changed the issues it raised during the legislative process, which increasingly seemed like an effort simply to frustrate the process.⁷⁴ Nevertheless, the amendment was signed into law by Governor Mitch Daniels in June 2012.⁷⁵

⁶⁶ *Dillinger, LLC* 795 F. Supp. 2d at 831.

⁶⁷ *The Godfather: The Game*, STRATEGYWIKI, http://strategywiki.org/wiki/The_Godfather:_The_Game (last visited May 31, 2016).

⁶⁸ *Dillinger, LLC*, 795 F. Supp. 2d at 831.

⁶⁹ *Id.* at 831-32.

⁷⁰ *Id.* at 833-35; *c.f.*, *Continental Optical Co. v. Reed*, 86 N.E.2d 306 (1949) (recognizing posthumous Rights of Publicity prior to statute's enactment); *Donovan v. Bishop*, No. 1:09-cv-0275-WTL-TAB, 2010 WL 4062370, at *1, *5 (S.D. Ind. Oct. 10, 2011) ("Although Indiana case law regarding the Statute is sparse, there appears to be no question that the Statute applies retroactively and protects the rights of personalities who died before the statute took effect.").

⁷¹ *Action List: House Bill 1133*, IND. GEN. ASSEMB., <http://www.ai.org/apps/lsa/session/billwatch/billinfo?year=2012&request=getActions&doctype=HB&docno=1133>.

⁷² MOTION PICTURE ASS'N AM., *supra* note 19.

⁷³ See MOTION PICTURE ASS'N AM., *supra* note 19.

⁷⁴ It would have been striking if the MPAA had achieved more success in opposing the clarification of Indiana's law than it achieved in opposing the same clarification of California's law a few years earlier, given that California is where the movie industry overall is based. See *infra* note 60 and accompanying text.

⁷⁵ California's legislature encountered a similar situation because of a ruling concerning Marilyn Monroe. *Milton H. Greene Archives, Inc. v. CMG Worldwide, Inc.*, 568 F. Supp. 2d 1152 (C.D. Cal. 2008), *aff'd*, 692 F.3d 983 (9th Cir. 2012). California's Right of Publicity law did not specifically address those who died prior to the statute's passage, yet it had been applied in such manner in case after case. See *Comedy III*

Recent Right of Publicity Revelations

The movie industry generally enjoys considerable latitude through exemptions in most Right of Publicity statutes, which are generally followed in states that do not have such express provisions.⁷⁶ The impulse to oppose Right of Publicity legislation may source from the same motivation behind the efforts of Warner Bros. Pictures in the early 1990s to claim James Dean's Right of Publicity based on a broad interpretation of a clause in Dean's Warner Bros. contract.⁷⁷ A 1993 ruling in the ensuing litigation, which predated Indiana's Right of Publicity statute, confirmed that James Dean's Right of Publicity existed separately from any contractual rights of Warner Bros. in Dean's contract, and that Dean's Right of Publicity belonged to the Indiana-based James Dean Foundation.⁷⁸

The MPAA is a natural champion of intellectual property rights because of the studio interests they exist to serve. In a February 9, 2015, entry on the MPAA's website, Senator Chris Dodd, Chairman and CEO of the MPAA, stated:

There is no denying that intellectual property rights are vital in today's world. . . . [T]hrough our creations, particularly our movies and TV shows, intellectual property helps shape America's national image in the eyes of the world. Underpinning all of this, however—and the reason why it is so important to protect intellectual property, including

Productions, Inc. v. Gary Saderup, Inc., 21 P.3d 797 (Cal. 2001). Following the Monroe ruling, California passed a simple amendment to § 3344.1 in 2007 to “abrogate and nullify such a view of California law.” MCCARTHY, *supra* note 6, § 6:39. Notably, in the Monroe ruling, it was determined that because Monroe's executor represented in 1966 that Monroe was domiciled in the State of New York for tax purposes, the beneficiaries of her rights were judicially estopped from claiming California as Monroe's domicile. *Id.* at 1199. The court continued that because New York does not recognize a postmortem Right of Publicity, no Right of Publicity passed through Monroe's will. *Id.* There are various problems with these determinations. Domicile is supposed to be determined by the decedent's intent, and the weight of evidence supports that Monroe would have claimed California as her state of domicile (it is also possible to have more than one domicile for tax purposes). See *In re Dorrance's Estate*, 163 A. 303 (Pa.), *cert. denied*, 287 U.S. 660 (1932), *and cert. denied*, 288 U.S. 617 (1933); *In re Estate of Dorrance*, 170 A. 601 (N.J. Prerog. Ct. 1934), *aff'd*, 184 A. 743 (N.J.), *cert. denied*, 298 U.S. 678 (1936). Furthermore, at the time of Marilyn Monroe's death in 1962, New York *did* recognize a postmortem Right of Publicity through common law, so such rights could have passed through her will. See MCCARTHY, *supra* note 6, § 6:96 (citing *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975)).

⁷⁶ MCCARTHY, *supra* note 6, § 8:36 (“Some state privacy and publicity statutes have language expressly exempting some media uses which the legislature felt would be immunized by the First Amendment. Other statutes which have no such express media exceptions have been so construed as to accomplish the same result. . . . The same type of . . . construction of state law so as to avoid a First Amendment conflict is followed in common law cases as in statutory cases.”).

⁷⁷ Warner Bros., Inc. v. Curtis Mgmt. Grp., Inc., No. CV 91-4016-WMB, 1995 WL 420043 at *1, *2 (C.D. Cal. Mar. 31, 1993).

⁷⁸ *Id.* at *10, *15.

copyright—are the millions of American jobs that it creates and supports.⁷⁹

It seems disingenuous, then, for the MPAA to oppose legislation that provides important intellectual property recognition for the talent appearing in the movies and TV shows of the studios that the MPAA seeks to protect.⁸⁰ Certainly, having unilateral control and ownership of licensing and merchandising of films and TV shows, unburdened by the Right of Publicity, would be a great windfall to the copyright owners of such works. A message on the Screen Actors Guild–American Federation of Television and Radio Artists’ (SAG-AFTRA) website, while not specific to the Right of Publicity, provides a fitting counterpoint:

Actors are facing many new challenges that threaten their ability to make a living doing what we love. Although many actors love their work so much they might do it for free, the fact is that when producers are making money from an actor’s performance that actor deserves to be paid their fair share . . . it’s only right.⁸¹

Simultaneous to Indiana’s 2012 amendment effort, New Hampshire was engaged in a similar effort that reached the opposite result.⁸² The son of author J.D. Salinger led the effort and spoke of instances such as when a photographer ambushed his father late in his life, manipulated the image, and used the image on T-shirts:

“A photographer literally jumped out of the bushes on top of him . . . then took this picture as my father was recoiling,” he said. “My father looked terrified, looked angry, looked startled and looked a bit haunted. It’s a terrible photograph, but that wasn’t enough for this person who made these T-shirts. He then went in . . . and made his eyes bright red, and made his face yellow[—]just made him look more freakish and wild.”⁸³

Such accounts, like the testimony of Ryan White’s mother in Indiana, would seem to have presented a clear case for New Hampshire to pass Right of

⁷⁹ Chris Dodd, *Intellectual Property Is Vital to the Future of American Workers*, MOTION PICTURE ASS’N AM. (Feb. 9, 2015), <http://www.mpa.org/intellectual-property-is-vital-to-the-future-of-american-workers/#.VfGpO5eGM8I>.

⁸⁰ Among the MPAA’s members are Walt Disney Studios Motion Pictures, Paramount Pictures Corporation, Sony Pictures Entertainment Inc., Twentieth Century Fox Film Corporation, Universal City Studios LLC, and Warner Bros. Entertainment Inc. *Our Story*, MOTION PICTURE ASS’N AM., INC., <http://www.mpa.org/our-story/> (last visited May 31, 2016).

⁸¹ *Organizing*, SAG-AFTRA, <http://www.sagaftra.org/content/organizing> (last visited May 31, 2016).

⁸² S.B. 175, 162nd Gen. Ct., Reg. Sess. (N.H. 2011) (proposing regulating the commercial use of a person’s identity).

⁸³ Holly Ramer, *Salinger’s Son Stunned by Veto of NH Bill*, WASH. TIMES (June 13, 2012) (first and second alteration in original), <http://www.washingtontimes.com/news/2012/jun/13/salingers-son-stunned-by-veto-of-nh-bill/?page=all>.

Publicity legislation. As in Indiana, New Hampshire has recognized a common law tort of “invasion of privacy by appropriation.”⁸⁴ Nevertheless, in vetoing New Hampshire Senate Bill 175 (SB 175), Governor John Lynch said:

SB 175 would codify a New Hampshire citizen’s right to control and transfer to beneficiaries the commercial use of his or her identity for 70 years after death. Because I believe that this legislation is overly broad, would potentially have a chilling effect on legitimate journalistic and expressive works that are protected by the New Hampshire and United States constitutions, and would invite rather than diminish litigation over legitimate journalistic and expressive use of a person’s identity, I have decided to veto this bill.⁸⁵

The last version of SB 175 presented to Governor Lynch for signature certainly should have included more express allowances for First Amendment purposes,⁸⁶ but it is hard to imagine that the passage of SB 175 would have chilled legitimate journalistic and expressive works. Other states have Right of Publicity statutes that are even sparser than SB 175’s provisions,⁸⁷ and those states can hardly be said to have experienced a chilling of journalism or expressive works. Passage of a meaningful Right of Publicity statute would have aligned with New Hampshire’s heritage of valuing individual rights, ensuring control of commercial use of its native sons and daughters.

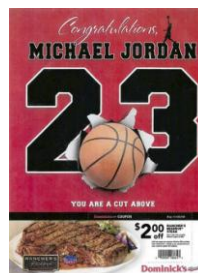
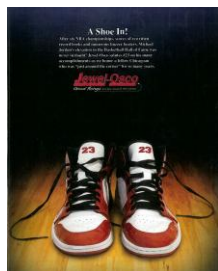
The disparity of means between those seeking Right of Publicity and those opposing it is substantial. The beneficiaries of Right of Publicity legislation in a given state generally are in no position to duplicate the effort of supporting legislation in jurisdictions that do not directly concern them. Contrastingly, the lobbying of entire industries (like that of the film and video game industries) is well-funded and coordinated, moving from state to state opposing such legislation. While SAG-AFTRA often provides critical support in favor of these legislative efforts, the fact remains that those opposing such legislation have an easier time achieving the desired result (since there are more ways to get legislation tabled than passed) and significantly greater means and coordination in pursuing such ends than the individuals who rely on Right of Publicity recognition.

⁸⁴ *Remsburg v. Docusearch, Inc.*, 816 A.2d 1001, 1009 (N.H. 2003).

⁸⁵ Governor John H. Lynch, *Governor’s Veto Message Regarding SB 175*, VOTE SMART (June 12, 2012), https://votesmart.org/public-statement/706876/governors-veto-message-regarding-sb-175#.Vq_DJvkrKhc.

⁸⁶ Earlier drafts did have such provisions, which were removed later in the process, thus increasing the likelihood of the Governor’s veto. *See New Hampshire Senate Bill 175*, MEDIA COAL., <http://mediacoalition.org/new-hampshire-sb175/> (last updated Aug. 21, 2015).

⁸⁷ *See, e.g.*, KY. REV. STAT. ANN. § 391.170 (West 2015); MASS. GEN. LAWS ANN. ch. 214, § 3A (West 2016); VA. CODE ANN. § 8.01-40 (West 2016).



V. Michael Jordan: Court Legend

In 2009, Michael Jordan was inducted into the Basketball Hall of Fame.⁸⁸ As one of the most celebrated basketball players of all time, Jordan's induction generated considerable attention. Since Jordan had played for the Chicago Bulls, two Chicago-area grocery stores, Jewel and Dominick's, decided to run advertisements congratulating Jordan on his Basketball Hall of Fame induction.⁸⁹ The Dominick's advertisement featured Michael Jordan's name, Jordan's Chicago Bulls jersey number (twenty-three), Chicago Bulls coloration (red, black, and white), a silhouette reminiscent of Jordan's Jumpman logo, and the statement "You are a cut above" over a steak coupon.⁹⁰ The Jewel advertisement featured red, black, and white basketball shoes with Jordan's jersey number on the tongues,⁹¹ and *congratulated* the "fellow Chicagoan who was 'just around the corner' for so many years," thereby echoing Jewel's service mark: "Good things are just around the corner."⁹² Jordan filed two lawsuits against these grocery stores in Cook County, Illinois.⁹³

Certainly, there is a massive and apparently often irresistible incentive for businesses to associate with Michael Jordan due to his fame and incredible success on the basketball court, but Jordan does not have the same incentive to permit unauthorized usage of his Right of Publicity. Jordan is also a successful businessman, who is very careful and deliberate regarding authorizing his Right of Publicity.⁹⁴ For instance, Jordan has a signature steakhouse restaurant and an online steak company based on his namesake; therefore, Jordan's complaint

⁸⁸ *About Michael Jordan*, THE REAL JORDAN.COM, <http://www.therealjordan.com/en/About-Michael-Jordan.aspx> (last visited May 31, 2016).

⁸⁹ Matt Bartosik, *Michael Jordan Sues Two Grocery Stores*, NBC CHICAGO (Dec. 22, 2009, 6:05 AM), <http://www.nbcchicago.com/news/local/Michael-Jordan-Sues-Jewel-and-Dominicks.html>.

⁹⁰ *Id.*

⁹¹ *Id.* Jordan's complaint noted that the basketball sneakers displayed in the Jewel advertisement were "an inaccurate and misleading copy of [Nike] Air Jordan basketball shoes." *Id.*

⁹² *Id.*

⁹³ *Id.* Is it telling that two competing grocery stores in the same region launched advertisements on the same premise, while no other businesses did?

⁹⁴ Michael Tarm, *Jordan in Court, Not on It, for Trial on His Brand Value*, YAHOO! SPORTS (Aug. 11, 2015, 10:09 PM), http://sports.yahoo.com/news/Jordan-court-not-court-trial-brand-value-140627482--spt.html;_ylt=A0LEVvHlcpVkJSoAt71jmolQ.

against Dominick's specified that he would not have agreed to such an advertising campaign, "especially not to sell steaks in direct conflict with his restaurants."⁹⁵ The value of such an association with Jordan has been consistently demonstrated through his licensed uses and endorsements.⁹⁶ The starting fee for an authorized association with Jordan, based on testimony provided on August 12, 2015, is \$10 million.⁹⁷

Although Jordan's image does not directly appear in these advertisements, they certainly rely on the targeted Chicago audiences' familiarity with Jordan's basketball sneakers, the Chicago Bulls team coloration, Jordan's Chicago Bulls jersey number, as well as the context and timing of the advertisement in proximity to Jordan's Basketball Hall of Fame induction. In both advertisements, identifiability of Jordan's persona is the key draw to them. No matter how one plays with these optics, Michael Jordan is unequivocally identifiable from these advertisements. In February 2014, the Seventh Circuit Court of Appeals in Illinois ruled in favor of Michael Jordan in his case against Jewel Food Stores, holding that a grocery store's "congratulatory ad" was not constitutionally protected speech, and remanded the case back to the District Court for further evaluation of the false-endorsement claim.⁹⁸ The case was set to go to trial on those issues beginning on December 8, 2015, but a settlement was reached just two weeks before the scheduled trial.⁹⁹ Jordan also won his case against Dominick's in August 2015, when a judge decided that Dominick's was liable for running the ad without Jordan's permission, and a jury determined how much the Safeway subsidiary would pay.¹⁰⁰

⁹⁵ Bartosik, *supra* note 89.

⁹⁶ Tarm, *supra* note 94. Jordan is no stranger to protecting the value of his intellectual property rights, including in China, where in the summer of 2015, a Chinese court refused to rule against a Chinese-based company that was using trademarks, which Jordan asserted violated his rights. Jeff Zalesin, *Michael Jordan Can't Block Sportswear Co. IP in China*, LAW360 (July 30, 2015, 3:32 PM), http://www.law360.com/articles/685194?utm_source=rss&utm_medium=rss&utm_campaign=articles_search.

⁹⁷ Jessica Corso, *Jordan's Name Comes With a \$10M Price Tag, Jury Hears*, LAW360 (Aug. 12, 2015 5:25 PM), http://www.law360.com/ip/articles/689920?nl_pk=bb8aeb3e-4ab9-4ba4-a0af-b895a107fd8a&utm_source=newsletter&utm_medium=email&utm_campaign=ip; see also Dan Carson, *Court Dispute Reveals Michael Jordan's Name to Be Worth \$480 Million or More*, BLEACHER REPORT (Aug. 13, 2015), <http://bleacherreport.com/articles/2546920-court-dispute-reveals-michael-jordans-name-to-be-worth-480-million-or-more/>; Tarm, *supra* note 94.

⁹⁸ *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 522 (7th Cir. 2014).

⁹⁹ Jon Seidel, *Michael Jordan Settles with Jewel, Dominick's*, CHI. SUN TIMES (Nov. 22, 2015, 5:26 PM), <http://chicago.suntimes.com/news/7/71/1122975/grocery-chain-says-michael-jordan-settling-jewel-dominicks>.

¹⁰⁰ Kim Janssen, *Jordan Says 'It Was Never About the Money' After \$8.9M Jury Award*, CHI. TRIB. (Aug. 21, 2015, 9:46 PM), <http://www.chicagotribune.com/business/ct-michael-jordan-dominicks-case-0822-biz-20150821-story.html>.

A popular sentiment is to express bewilderment over Jordan suing for being congratulated.¹⁰¹ This miscasts the dynamics, just as illegally downloading a song can hardly be excused on the basis that it is a compliment to the artist. A congratulatory message in a paid advertisement and coupon for a grocery store is not the same as a person on the street congratulating Jordan in person. Were the advertisements simply a gesture of goodwill? Or were they professionally designed, expensive promotional campaigns by businesses seeking to associate with Michael Jordan at a time when he was in the news for a career-defining accomplishment?¹⁰² Perhaps it is telling that the advertisements went to great lengths to skirt around the edges of Jordan's identity, implying it through imagery clearly associated with Jordan. If the grocery stores believed they had a legal right to *congratulate* Jordan without permission, why not use Jordan's image more directly?

VI. Conclusion

*“Law must be stable and yet it cannot stand still.”*¹⁰³

Just as the doctrine of the Right of Publicity has been refined by well over a century of jurisprudence and legislation, the implications of Michael Jordan's litigation, the aforementioned video game avatar cases, and recent legislative activity will shape the doctrine for years to come. That refinement is likely to accelerate as challenging issues appear on the horizon. So-called hologram technology is generating previously unimaginable opportunities and disputes,¹⁰⁴ as is seamless digital manipulation of existing content to create new works.¹⁰⁵

¹⁰¹ See, e.g., Sarah L. Cronin, *Michael Jordan Testifies He Doesn't Do Deals for Less Than \$10 Million: Jury Awards Him \$8.9 Million in Lawsuit Over Use of his Likeness in Ad for \$2 Coupon Off Steak*, LEXOLOGY (Aug. 28, 2015), [http://www.lexology.com/library/detail.aspx?g=c2372203-a45a-4afb-aa0b-02a25dde1b31&utm_source=Lexology+Daily+Newsfeed&utm_medium=HTML+email+++Body+++General+section&utm_campaign=Lexology+subscriber+daily+feed&utm_content=Lexology+Daily+Newsfeed+2015-09-01&utm_term=Cronin's+article+title+suggests+a+correlation+between+a+two-dollar+steak+coupon,+Jordan's+minimum+Right+of+Publicity+licensure+value,+and+the+jury+award,+providing+a+somewhat+misleading+metric+for+the+valuation+of+the+infringement.+See+also+Darren+Rovell,+Jordan+Ruling+Could+Set+Precedent,+ESPN+\(Feb.+20,+2014\),+http://espn.go.com/chicago/nba/story/_/id/10491664/michael-jordan-wins-appeal-endorsement-case-jewel-food-stores](http://www.lexology.com/library/detail.aspx?g=c2372203-a45a-4afb-aa0b-02a25dde1b31&utm_source=Lexology+Daily+Newsfeed&utm_medium=HTML+email+++Body+++General+section&utm_campaign=Lexology+subscriber+daily+feed&utm_content=Lexology+Daily+Newsfeed+2015-09-01&utm_term=Cronin's+article+title+suggests+a+correlation+between+a+two-dollar+steak+coupon,+Jordan's+minimum+Right+of+Publicity+licensure+value,+and+the+jury+award,+providing+a+somewhat+misleading+metric+for+the+valuation+of+the+infringement.+See+also+Darren+Rovell,+Jordan+Ruling+Could+Set+Precedent,+ESPN+(Feb.+20,+2014),+http://espn.go.com/chicago/nba/story/_/id/10491664/michael-jordan-wins-appeal-endorsement-case-jewel-food-stores).

¹⁰² The argument that the advertisements were nothing more than benign congratulations might carry more weight if the advertisements had not included the grocery stores' names, logos, mottos, or coupons.

¹⁰³ ROSCOE POUND, INTERPRETATIONS OF LEGAL HISTORY 1 (1923).

¹⁰⁴ See, e.g., Eriq Gardner, *Hollywood Hologram Wars, Vicious Legal Feud Behind Virtual Mariah, Marilyn and Mick*, HOLLYWOOD REP. (May 28, 2015, 9:00 AM), <http://www.hollywoodreporter.com/thr-esq/hollywood-hologram-wars-vicious-legal-798401>. The 2012 *Coachella Festival* featured an encore performance of deceased rapper Tupac Shakur, who appeared with stunning realism. Chenda Ngak, *Tupac Coachella Hologram: Behind the Technology*, CBS NEWS (Nov. 9, 2012, 12:36 PM), <http://www.cbsnews.com/news/tupac-coachella-hologram-behind-the-technology/>.

¹⁰⁵ Similarly, Lionsgate completed Philip Seymour Hoffman's scenes and was able to release *The Hunger Games: Mockingjay, Part 2*, although Hoffman died before production

Without meaningful Right of Publicity recognition, what is to stop a new movie from being created in which Robin Williams is made to perform in a feature role? Or prevent an adult-entertainment producer from creating new *expressive works* featuring a hologram of Princess Diana?¹⁰⁶ In addition to demonstrating the imperative for Right of Publicity protection, these hypotheticals and the technology behind them demonstrate the danger of creating sweeping statutory exemptions for entire mediums.¹⁰⁷ Furthermore, Facebook advertising policies,¹⁰⁸ social media (especially as a channel for advertising), facial recognition technology,¹⁰⁹ big data,¹¹⁰ and advancements in virtual reality,¹¹¹ all raise Right of Publicity implications, and not just for the rich or famous.

[E]veryone's persona and identity has *some* "commercial value" during life and at the time of death. That value may be large or small, but it cannot be said to be nonexistent, no matter how "obscure" the person. The absurdity of any other reading . . . is revealed by an example: suppose that "noncelebrity" factory worker Joe dies. During life, Joe's picture could not have been used without permission as "typical Joe coffee drinker" in an advertisement for Brand X coffee without a clear invasion of Joe's privacy and publicity rights. Now that Joe is dead, should Brand X be permitted to freely use Joe's picture because at the time of Joe's death his picture had no "commercial value"?¹¹²

If the policies and purposes underlying the Right of Publicity were not critically important, the Right of Publicity would have been dismissed long ago as an esoteric intellectual property footnote. The doctrine is in no such danger because the Right of Publicity is not about ensuring that the rich get richer or stopping transformative original works. Rather, the doctrine serves the critical function of ensuring that a person, or the person's heirs, for a period time

of the film was complete. Kim Masters, *Philip Seymour Hoffman Death Leaves One Major 'Hunger Games' Scene Unfilmed*, HOLLYWOOD REP. (Feb. 3, 2014, 6:36 PM), <http://www.hollywoodreporter.com/news/philip-seymour-hoffman-death-leaves-676836>.

¹⁰⁶ See Jenny Montgomery, *Hologram Performance by Tupac Creates Legal Questions for IP Lawyers*, IND. LAW. (May 9, 2012), <http://www.theindianlawyer.com/-hologram-performance-by-tupac-creates-legal-questions-for-ip-lawyers/PARAMS/article/28758>.

¹⁰⁷ Ted Johnson, *Virtual Lines Blurry for Estates*, VARIETY (June 22, 2012, 5:00 AM), <http://variety.com/2012/film/news/virtual-lines-blurry-for-celeb-estates-1118055844/>; see also Jonathan Faber, *Celebrity Licensing and the Right of Publicity: Navigating New Frontiers of Opportunity and Liability*, 32 LICENSING J. 1, 1 (2012).

¹⁰⁸ Jonathan Faber, *Facebook's "Expanded Premium Ads" Bring Hidden Right of Publicity Issues*, RIGHT OF PUBLICITY (Nov. 17, 2011), <http://rightofpublicity.com/facebook-expanded-premium-ads>.

¹⁰⁹ Brian Wassom, *Publicity Rights in Facial Recognition and Other Biometric Data*, WASSOM.COM (Oct. 4, 2013), <http://www.wassom.com/publicity-rights-in-facial-recognition-and-other-biometric-data.html>.

¹¹⁰ David J. Walton, *Big Data Raises Big Legal Issues*, INSIDE COUNSEL (Mar. 28, 2014), <http://www.insidecounsel.com/2014/03/28/big-data-raises-big-legal-issues>.

¹¹¹ See generally Joel Stein, *Inside the Box*, TIME, Aug. 17, 2015, at 40 (exploring current virtual-reality innovations).

¹¹² MCCARTHY, *supra* note 6, § 6:39.

proportionate to copyright duration, has the right to determine the terms upon which that person is commercialized, if at all.

In dealing with these issues on a daily basis, I have the opportunity to consult with rights owners, understand their unique priorities and concerns, and navigate the challenges involved in developing a business around licensing these rights and protecting a loved one's legacy. I also see market forces at work and how multi-million dollar businesses, international advertising agencies, and media companies seek to exploit these rights—sometimes with permission, and sometimes without permission. “[T]he real policy choice is not between rich celebrities and the needy public, but between celebrities and corporate advertisers who want to use the aura of celebrity to help sell products.”¹¹³ Indeed, the view from the trenches confirms that the need for the Right of Publicity has never been greater.

*“Our destiny exercises its influence over us even when, as yet, we have not learned its nature: it is our future that lays down the law to our today.”*¹¹⁴

¹¹³ MCCARTHY, *supra* note 6, § 2:2 (citing Sheldon W. Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L.J. 853, 871 (1995)).

¹¹⁴ FRIEDRICH WILHELM NIETZSCHE, HUMAN, ALL TOO HUMAN: A BOOK FOR FREE SPIRITS 7 (1878).