

4-1-2019

Transformative Variations: The Uses and Abuses of the Transformative Use Doctrine in Right of Publicity Law

Matthew D. Bunker

Emily Erickson

Follow this and additional works at: <https://digitalcommons.law.uw.edu/wjlta>



Part of the [First Amendment Commons](#)

Recommended Citation

Matthew D. Bunker & Emily Erickson, *Transformative Variations: The Uses and Abuses of the Transformative Use Doctrine in Right of Publicity Law*, 14 WASH. J. L. TECH. & ARTS 138 (2019). Available at: <https://digitalcommons.law.uw.edu/wjlta/vol14/iss2/4>

This Article is brought to you for free and open access by the Law Reviews and Journals at UW Law Digital Commons. It has been accepted for inclusion in Washington Journal of Law, Technology & Arts by an authorized editor of UW Law Digital Commons. For more information, please contact lawref@uw.edu.

**TRANSFORMATIVE VARIATIONS: THE USES AND
ABUSES OF THE TRANSFORMATIVE USE DOCTRINE IN
RIGHT OF PUBLICITY LAW***

*Matthew D. Bunker and Emily Erickson***

CITE AS: 14 WASH. J.L. TECH. & ARTS 138 (2019)

<http://digital.law.washington.edu/dspace-law/bitstream/handle/1773.1/1878/14WJLTA138.pdf>

ABSTRACT

In 2001, the California Supreme Court embarked upon a novel experiment in its right of publicity jurisprudence. The court imported a single element from copyright's fair use analysis. That element—transformative use—has since become an enormously important defense for publicity defendants. Unfortunately, the transformative use doctrine is notoriously protean, and has resulted in significant confusion in publicity law that almost certainly chills protected speech. Many courts seem to lack a clear idea of what a sophisticated transformative use analysis should even look like. This article unpacks these issues and proposes improvements to this difficult legal area.

TABLE OF CONTENTS

Introduction.....	139
I. The Transformation of Fair Use Law	141
II. Transformative Use Colonizes Publicity Doctrine	144
III. Identifying the Locus of Transformation.....	146
IV. Atomistic Approaches to Transformation	148

* © 2018 Matthew D. Bunker and Emily Erickson

** Matthew D. Bunker, Reese Phifer Professor of Journalism Emeritus, University of Alabama College of Communication and Information Sciences.

Emily Erickson, Associate Professor of Communications, California State University, Fullerton, College of Communications.

V. Holistic Approaches to Transformation.....	151
VI. The <i>De Minimis</i> Model.....	154
VII. Sidestepping the Transformative Test	156
Analysis and Conclusion.....	159

INTRODUCTION

In 2001, the California Supreme Court embarked upon a novel experiment in its right of publicity jurisprudence. The right of publicity, which grants celebrities and others the ability to control certain uses of their identities,¹ had always had a contested relationship with First Amendment free speech principles. By allowing publicity plaintiffs to punish various uses of their personae, the free expression of speakers who wished to celebrate, critique, comment on, or remix celebrity identity² was unquestionably threatened to some degree. Although there were a variety of extant judicial doctrines designed to ameliorate this tension between publicity rights and free expression, the California high court in *Comedy III Productions, Inc. v. Saderup*³ chose to strike out into uncharted doctrinal territory, importing from copyright law a single element of copyright's fair use analysis. This element, transformative use, has since become an enormously important defense for publicity defendants. Transformative use essentially means that a borrower adds new insights or aesthetic variation when borrowing expressive materials from others.⁴

But the transformative doctrine—plucked from copyright law and deposited into the alien domain of right of publicity law—has proven to be an ineffective carrier of First Amendment values. For a variety of reasons, transformative use is not a particularly good fit as a stand-in for free expression interests. But beyond this basic

¹ JENNIFER E. ROTHMAN, *THE RIGHT OF PUBLICITY: PRIVACY REIMAGINED FOR A PUBLIC WORLD* 1 (2018).

² Although right of publicity law is primarily the province of celebrities, ordinary people can succeed in publicity suits as well in many jurisdictions.

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

⁴ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

problem of fit, the doctrine is notoriously protean.⁵ In fact, many courts don't seem to have a clear idea of what a transformative use analysis should even look like, as this Article will demonstrate. As noted I.P. commentator J. Thomas McCarthy put it, the transformative test is "subjective in application, unpredictable in outcome, and fraught with ambiguity. Difficulty of application and incertitude of result are the hallmarks of the court's 'transformative' test."⁶ Unfortunately, this unpredictability can lead to an analysis that is so slippery and sometimes arbitrary that speakers (and their counsel) simply lack a clear idea of how the courts might treat their particular appropriations in the event of litigation. This lack of clarity, in turn, can produce chilling effects on what might otherwise be protected speech.

This Article unpacks these issues and proposes possible improvements to the transformative use doctrine.⁷ First, we chronicle the origins of transformative use analysis in copyright doctrine. Next, we explore the California Supreme Court's importation of the transformative test from copyright into right of publicity law. We then provide a taxonomy of the various modes of transformative use that courts have adopted in publicity cases in the wake of *Comedy III*. Finally, we offer suggestions for an improved analysis in this difficult area of the law.

⁵ Matthew D. Bunker & Clay Calvert, *The Jurisprudence of Transformation: Intellectual Incoherence and Doctrinal Murkiness Twenty Years After Campbell v. Acuff-Rose Music*, 12 DUKE L. & TECH. REV. 92 (2014).

⁶ J. THOMAS MCCARTHY, 2 THE RIGHTS OF PUBLICITY AND PRIVACY 264 (2017).

⁷ Other works that have explored related aspects of right of publicity doctrine include: Justin L. Rand, *Case Comment: Transformative Use and the Right of Publicity: A Relationship Ready for Revision*, 37 HASTINGS COMM. & ENT. L.J. 335 (2014-2015); Matthew R. Grothouse, *Collateral Damage: Why the Transformative Use Test Confounds Publicity Rights Law*, 18 VA. J.L. & TECH. 474 (2014); Stacy L. Dogan & Mark Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161 (2006); F. Jay Dougherty, *All the World's Not a Stooge: The "Transformativeness" Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 COLUM. J.L. & ARTS 1 (2003); Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903 (2003).

I. THE TRANSFORMATION OF FAIR USE LAW

Although the origins of what became the transformative use doctrine in copyright law go back some years,⁸ the *locus classicus* of the doctrine is a 1990 *Harvard Law Review* article by federal judge and legal scholar Pierre N. Leval.⁹ Judge Leval, who as of this writing serves on the U.S. Court of Appeals for the Second Circuit, sought in the article to provide a more precise grounding for fair use doctrine. Fair use is designed to allow individuals to borrow some unspecified amount of copyrighted expression without permission or payment under certain circumstances.¹⁰ As one commentator put it, fair use “is an important safety valve that acts as a bulwark against the monopoly power that inheres in an exclusive right [for copyright owners] and which leads owners of such rights to act in ways contrary to the public interest.”¹¹

Leval’s approach was driven by the uncertainty that he claimed inhered in the fair use caselaw of the time. Although the fair use statute,¹² part of the federal Copyright Act, already contained a four-part test for determining whether a particular use was fair (including such factors as how much of the work the borrower appropriated and whether the borrower’s work affected the market value of the original), Leval was concerned that fair use decisions by courts were wildly inconsistent. “Earlier decisions provide little basis for predicting later ones,” Leval wrote. “Reversals and divided courts are commonplace. . . . Decisions are not governed by consistent principles, but seem rather to result from intuitive reactions to individual fact patterns.”¹³

To repair this Babelian state of affairs, Leval proposed that fair use analysis should be aligned with the central purpose of copyright

⁸ Prior to the creation of the transformative use rubric, courts had at times applied a doctrine of “productive use” that had some similar properties. See Laura G. Lape, *Transforming Fair Use: The Productive Use Factor in Fair Use Doctrine*, 58 ALB. L. REV. 677 (1995).

⁹ Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990).

¹⁰ See WILLIAM F. PATRY, *PATRY ON FAIR USE* (2011).

¹¹ *Id.* at 6.

¹² 17 U.S.C. § 107 (2018).

¹³ Leval, *supra* note 9, at 1106-1107.

law itself, which was to incentivize authors to create original works that stimulated artistic and intellectual progress.¹⁴ The same concern for progress that was the underpinning of copyright writ large should drive fair use analysis as well—successful fair users should, Leval wrote, engage in transformative uses of the material they appropriated rather than simply engaging in verbatim borrowing. Leval argued that:

[i]f . . . the secondary use adds value to the original—if the quoted material is used as raw material, transformed in the creation of new information, new aesthetics, new insights or understandings—this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society.¹⁵

Leval's proposed transformative use analysis was, with surprising alacrity, adopted by the U. S. Supreme Court in 1993's *Campbell v. Acuff-Rose Music, Inc.*¹⁶ The dispute in *Campbell* arose when rap group 2 Live Crew borrowed a few musical and lyrical elements from the popular Roy Orbison hit song, "Oh, Pretty Woman," and created a crude rap parody that quickly drew a copyright infringement suit from the song's publisher.¹⁷ The U.S. Court of Appeals for the Sixth Circuit ruled that the rappers' commercial purpose in creating the parody weighed against a finding of fair use, but a unanimous Supreme Court, in an opinion by Justice David Souter, reversed.¹⁸

Justice Souter acknowledged that commercial use by a putative fair user had at times been regarded as a black mark under the "purpose and character of the use" factor from the statute.¹⁹ However, following Judge Leval, the Court reasoned that the

¹⁴ *Id.* at 1110; *See* U.S. Const. art. 1, sec. 8, cl. 8 (authorizing Congress to pass copyright and patent statutes "To promote the Progress of Science and the useful arts . . .").

¹⁵ Leval, *supra* note 10, at 1111.

¹⁶ 510 U.S. 569 (1994).

¹⁷ *Id.* at 573.

¹⁸ *Id.* at 594.

¹⁹ *Id.* at 583-584.

inquiry should instead focus on whether the borrowing work was transformative, that is, whether it added “something new with a further purpose or different character, altering the first with new expression, meaning, or message.”²⁰ This “new expression, meaning or message” formulation was the heart of the Court’s explication of the nascent doctrine of transformative use. Although there was reasonable evidence to conclude that 2 Live Crew’s use of “Oh, Pretty Woman” indeed met this standard, the Court declined to so find. Rather the Court remanded the case to the Sixth Circuit with the tepid observation that “it is fair to say that 2 Live Crew’s song reasonably could be perceived as commenting on the original, or criticizing it, to some degree.”²¹

Notably, 2 Live Crew did not alter the relatively small amount of musical and lyrical materials borrowed from the original song. Instead, the rappers reproduced those items verbatim and added various other elements to the mix that the Court ultimately suggested might be transformative, since the entire work, rife with crude sexual references, seemed to critique or comment on the innocent naivete of the original song.²²

In the wake of *Campbell*, and with no further guidance from the high court, lower federal courts created an assortment of differing conceptions of transformative use, some of which contradicted each other.²³ One model, dubbed “new insights,” seemed to require that the borrowing work provide some comment on or critique of the original work²⁴—absent that connection, the use was not transformative. Another conception, “creative metamorphosis,” required no connection between the borrowing work and the original, but simply asked whether sufficient aesthetic variation (however that might be operationalized) could be observed when comparing the borrowing work to the original.²⁵ If so, the use was

²⁰ *Id.* at 573.

²¹ *Id.* at 583.

²² *Id.* at 581-582.

²³ For further explanation and development of the three models, see Bunker & Calvert, *supra* note 5, 102-125.

²⁴ See, e.g., *Liebovitz v. Paramount Pictures Corp.*, 137 F.3d 109 (2d Cir. 1998).

²⁵ See, e.g., *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013).

transformative. The borrowing work did not need to evince any link to the original in any particular way, or even at all. A third strand, the “new purpose” approach, found that even verbatim borrowings could be labeled transformative, as long as the borrowing work was employed for a different purpose or function than the original.²⁶ For example, this “new purpose” conception could support as transformative a borrower taking a work that was created for marketing purposes and reproducing it, unaltered, for use in a news or information context.²⁷

As these differing conceptions of transformative use were being refined in copyright law, courts also began applying the doctrine in right of publicity cases. It is to that act of judicial appropriation that we now turn.

II. TRANSFORMATIVE USE COLONIZES PUBLICITY DOCTRINE

In 2001, the California Supreme Court for the first time imported transformative use analysis into a tort case sounding in right of publicity law. The state high court’s opinion in *Comedy III Productions v. Saderup*,²⁸ while not particularly convincing at a theoretical level, soon led to other courts following suit.²⁹ *Comedy III* arose when Saderup created a drawing, reproduced and sold on t-shirts and lithographs, of The Three Stooges, an iconic comedy ensemble. The entity entrusted with licensing for the Stooges then filed suit, alleging a publicity violation.³⁰

On appeal, the California Supreme Court recognized that Saderup’s likeness of the Stooges was an expressive work eligible for First Amendment protection, even though it was created and marketed for commercial gain.³¹ The court also recognized that expressive uses of celebrity identity often serve important First Amendment purposes: “[b]ecause celebrities take on public meaning, the appropriation of their likenesses may have important

²⁶ See, e.g., *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87 (2d Cir. 2014).

²⁷ See, e.g., *Nunez v. Caribbean Int’l News Corp.*, 235 F.3d 18 (1st Cir. 2000).

²⁸ 21 P.3d 797 (Cal. 2001).

²⁹ See cases cited and discussed in remaining sections of this Article.

³⁰ *Comedy III*, 21 P.3d 797 at 800.

³¹ *Id.* at 802.

uses in uninhibited debate about public issues, particularly debates about culture and values.”³² Nonetheless, the court reasoned, all expressive works are not insulated from the reach of the publicity tort.³³ In striking a balance between publicity rights and First Amendment free expression interests, the California Supreme Court pointed out that other courts had produced a variety of tests, none of which the court found sufficient.³⁴ Noting that some academic commentators had proposed borrowing the fair use standard from copyright law, the state high court reasoned that the entire fair use test was not a good fit in publicity cases, but that one element, transformative use, was the appropriate inquiry.³⁵ The court, drawing from *Campbell*, found the appropriate test to be whether “the work in question adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.”³⁶

Applying its new First Amendment standard, the court ruled that a straightforward, accurate rendition of a plaintiff’s persona, as Saderup had produced, was not transformative and thus not protected against a right of publicity claim.³⁷ However, when the defendant creates a transformative use involving the plaintiff’s identity, that additional expressive content strengthens the First Amendment interests involved.³⁸ In addition, the transformative use of a persona is “less likely to interfere with the economic interest protected by the right of publicity.”³⁹ The court restated the transformativeness test as “whether the celebrity likeness is one of the ‘raw materials’ from which the original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.”⁴⁰

³² *Id.* at 803.

³³ *Id.* at 804-805.

³⁴ For a survey of some of these tests, *see, e.g.*, Hart v. Elec. Arts, Inc., 717 F.3d 141, 153-161 (3d Cir. 2013).

³⁵ Comedy III, 21 P.3d 797 at 807-08.

³⁶ Comedy III, 21 P.3d at 808 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)).

³⁷ *Id.* at 811.

³⁸ *Id.* at 808.

³⁹ *Id.*

⁴⁰ *Id.* at 809.

The *Comedy III* court also provided a “subsidiary inquiry” that asked whether the marketability of the work in question derived primarily from the plaintiff’s fame or from the creativity and reputation of the defendant.⁴¹ In the latter case, the First Amendment should protect the work.

Several points are worth noting from *Comedy III*. First, unlike fair use in copyright, which is a statutory limit on the exclusive rights of copyright holders, the *Comedy III* court was employing the transformative use doctrine as a *constitutional* First Amendment standard. This was not the purpose for which Judge Leval had synthesized the doctrine, nor the use to which it was put by the Court in *Campbell*. Second, by declining to consider the other parts of the copyright fair use analysis, the California Supreme Court had plucked a single element from that complex, multi-factor determination and installed it as the *exclusive* route to First Amendment protection for right of publicity defendants. In copyright law, the *Campbell* Court had made clear, the absence of a transformative use was not the death knell of a fair use claim. In the *Comedy III* publicity regime, First Amendment protection rose or fell based on that factor alone. Rather than an incremental development in standard legal doctrine, as the opinion seemed to imply, *Comedy III* was in fact a radical and undertheorized departure from traditional First Amendment analysis.

III. IDENTIFYING THE LOCUS OF TRANSFORMATION

After *Comedy III*, Courts both inside and outside of California, including influential federal courts,⁴² began applying the transformative use test in publicity cases. However, the test appears to mean different things to different courts. One of the key divisions is on the question of the required *locus* of any transformative changes wrought by the defendant. In other words, must the defendant transform the borrowed persona itself or can it claim a transformative use if it places the unaltered persona into a work that, as a whole, has transformative elements? To shed more light on this, consider transformative doctrine as applied in the *Campbell* case in

⁴¹ *Id.* at 810.

⁴² *E.g.*, *ETW Corp. v. Jireh Publ’g Co.*, 332 F.3d 915 (6th Cir. 2003).

the copyright context. 2 Live Crew did not transform the borrowed materials from “Oh, Pretty Woman.” Instead, the rappers appropriated verbatim musical phrases and lyrics from the song and surrounded those with other expressive elements that resulted in an entirely new work. That is often how transformative use is applied in copyright doctrine—the defendant need not engage in creative metamorphosis with the *borrowed materials themselves*, but can instead place the unaltered, appropriated elements into the context of a new work that, as a whole, offers new meaning, message, or expression.

Interestingly, and perhaps unfortunately, *Comedy III* itself did not address this question since the facts of the case did not offer any opportunity to do so. The *Comedy III* court did not make entirely clear exactly where the requisite transformation needed to occur—did the celebrity persona itself need to be transformed, or could the celebrity persona, unaltered, be situated in the context of a larger transformative work and still be protected? This confusion was somewhat understandable, since the personae of the Stooges was in fact the *entirety* of the work in *Comedy III*—the “work” consisted solely of the likenesses of The Three Stooges on t-shirts and lithographs. Thus, there was no occasion to consider a contextual transformative work in which the persona was reproduced unchanged within a work that featured other transformative elements. Nonetheless, there is language in *Comedy III* that suggests that an appropriation can be transformative without performing any alteration on the persona itself. At one point, the court, in elaborating its distinction between the persona being one of the “raw materials” of the defendant’s work versus the “sum and substance” of the work, states that “we ask . . . whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness. And when we use the word ‘expression,’ we mean expression of something other than the likeness of the celebrity.”⁴³

Later publicity cases applying the transformative doctrine appear to have split into at least three camps. This paper refers to the approach requiring alteration of the persona itself as “atomistic”

⁴³ *Comedy III*, 21 P.3d 797 at 809.

decisions, and the approach allowing broader contextual transformation as “holistic” decisions.⁴⁴ As well, other courts have focused primarily on the quantity of the taking in relation to the defendant’s work, without significant attention to the amount the second work transforms the persona.⁴⁵

IV. ATOMISTIC APPROACHES TO TRANSFORMATION

A clear example of the atomistic approach is found in the Third Circuit case *Hart v. Electronic Arts, Inc.*,⁴⁶ in which a majority found the appropriation to be non-transformative. *Hart* arose after video game company Electronic Arts used elements of college football players’ personae in its *NCAA Football* game series.⁴⁷ Ryan Hart, a quarterback for the Rutgers University football team, objected to the creation of virtual players (avatars) that resembled real-life college football players and shared playing stats and biographical details with their real-life counterparts.⁴⁸ After a federal district court granted summary judgment to EA on First Amendment grounds, the Third Circuit reversed.

In reviewing the lower court decision, the Third Circuit majority was clear that video games are entitled to First Amendment protection as expressive works.⁴⁹ Nonetheless, that protection was not unlimited when in conflict with other competing interests, including the right of publicity. The majority then canvassed judicial

⁴⁴ See cases cited and discussed in Parts IV and V, *infra*.

⁴⁵ See cases cited and discussed in Part VI, *infra*.

⁴⁶ 717 F.3d 141 (3d Cir. 2013), *cert. denied* 573 U.S. 989 (2014). Alongside *Hart*, an almost identical analysis of a nearly identical fact pattern can be found in *Keller v. Elec. Arts Inc.*, 724 F.3d 1268 (9th Cir. 2013). The two cases are strikingly similar in that both feature a two-judge majority applying an atomistic approach, with a single dissenting judge urging a broader and more contextual consideration of transformativeness. Other largely atomistic court decisions include *Davis v. Elec. Arts, Inc.*, 775 F.3d 1172 (9th Cir. 2015); *Mine O’ Mine, Inc. v. Calmese*, 2011 U.S. Dist. LEXIS 75236 (D. Nev. 2011); *Diller v. Barry Driller, Inc.*, 2012 U.S. Dist. LEXIS 133515 (C.D. Cal. 2012); *Mitchell v. Cartoon Network, Inc.*, 2015 U.S. Dist. LEXIS 157737 (D. N.J. 2015).

⁴⁷ *Hart*, 717 F.3d at 146.

⁴⁸ *Id.*

⁴⁹ *Id.* at 147 (citing *Brown v. Entm’t Merchs. Ass’n*, 131 U.S. 2729, 2733 (2011)).

tests designed to balance free expression interests against the right of publicity, including “the commercial-interest-based Predominant Use Test, the trademark-based Rogers test, and the copyright-based Transformative Use Test,”⁵⁰ ultimately concluding that the latter was the court’s preferred mode of analysis.

In applying the transformative test, the majority focused almost exclusively on whether EA transformed Hart’s persona itself. As the court put it, “we must determine whether [Hart’s] identity is sufficiently transformed in *NCAA Football*.”⁵¹ This singular focus on the persona itself led the majority to reason that because the digital avatar closely resembled Hart, and because the biographical and statistical information on Hart was accurate, there was nothing transformative about EA’s use of those items.⁵² The majority did briefly consider the world into which the avatar was placed, but found insufficient transformation since the context was a digitally recreated football game, the very same activity the real-life Hart gained fame in pursuing.

The majority also rejected EA’s argument that an interactive feature that allowed users to alter the appearances of the avatars was sufficiently transformative. Such a finding would open the door to “cynical abuse,” the court reasoned, since “video game companies could commit the most blatant acts of misappropriation only to absolve themselves by including a feature that allows users to modify the digital likenesses.”⁵³ The Third Circuit also rejected EA’s claim that other creative features of the game amounted to a transformative use, since those features, “do not affect Appellant’s digital avatar.”⁵⁴ The majority’s analysis here is roughly equivalent to the “new insights” paradigm in copyright fair use cases, in which, to be transformative, the borrower must comment on or in some way offer new understandings of the borrowed expression.⁵⁵ In other words, the creative context into which the borrowed material is placed must interact with or operate upon it sufficiently to affect the reader or viewers’ perception of the borrowed expression.

⁵⁰ 717 F.3d at 153.

⁵¹ *Id.* at 165.

⁵² *Id.* at 167.

⁵³ *Id.* at 167.

⁵⁴ *Id.* at 169.

⁵⁵ See note 24 and related text, *supra*.

Although the *Hart* court did make a brief, half-hearted detour into contextual aspects of the game, its analysis is overwhelmingly atomistic. Transformation must occur, if at all, in the use of the persona itself, or, possibly, in other expressive features of the work that have a significant impact on the persona. In dissent, Judge Thomas L. Ambro objected that “[his] colleagues limit effectively the transformative inquiry to Hart’s identity alone, disregarding other features of the work.”⁵⁶ Judge Ambro pointed out that this approach penalized realistic depictions of actual persons that were routinely protected in other media.⁵⁷ The dissent also made clear that this methodology is inconsistent with the one advocated for by the California Supreme Court in *Comedy III* and later cases. Instead of the majority’s cramped approach, Ambro reasoned, “we must examine the creative work in the aggregate to determine whether it satisfies the Transformative Use Test and merits First Amendment protection.”⁵⁸

In his own analysis, Judge Ambro found that not only did EA’s video game offer “myriad original graphics, videos, sound effects,” and the like, but it also allowed players to create game scenarios in which players who had never competed against each other in real life competed in the virtual world of the game.⁵⁹ Moreover, certain game modes allowed game players to direct multiple seasons of play with unique virtual player combinations. “Such modes of interactive play,” Ambro wrote, “are imaginative transformations of the games played by real players.”⁶⁰

The atomistic approach seems misguided in light of the transformative use doctrine’s origin. In copyright law, no court requires the borrowed portion of plaintiff’s expression be altered in some way to produce a transformative use. Rather, the expectation is that unaltered borrowed materials will be combined into to a larger work that is itself transformative.⁶¹ The atomistic approach in

⁵⁶ *Id.* at 171 (Ambro, J., dissenting).

⁵⁷ *Id.* at 173 (Ambro, J., dissenting).

⁵⁸ *Id.* at 172 (Ambro, J., dissenting).

⁵⁹ *Id.* at 175 (Ambro, J., dissenting).

⁶⁰ *Id.* at 175 (Ambro, J., dissenting).

⁶¹ *See, e.g.,* Cariou v. Prince, 714 F.3d 694 (2d Cir. 2013) (appropriation artist’s use of defendant’s photographs was transformative since the defendant’s

publicity cases completely ignores the creative work of the defendant if the persona itself is not transmogrified in some fashion. The approach is also at odds with language in *Comedy III* suggesting that if the persona is one of the raw materials in the creation of a larger expressive work, the use is therefore transformative.⁶²

V. HOLISTIC APPROACHES TO TRANSFORMATION

A holistic approach to the transformative inquiry is found in a 2013 California court of appeals decision, *Ross v. Roberts*.⁶³ In *Ross*, defendant, a rapper, appropriated the name and persona of a celebrated drug dealer, Rick Ross. Ross had achieved notoriety as a high-volume cocaine distributor in the 1980s. The defendant, William Leonard Roberts II, was apparently inspired by Ross' felonious exploits and began a career as a rapper under the name Rick Ross. Some of Roberts' songs bragged about cocaine trafficking and other illicit deeds. When the real Rick Ross learned about Roberts' appropriation of his name and persona, he commenced a lawsuit alleging violation of his right of publicity and related claims.

On the question of transformative use, the California appellate

work, as a whole, was quite different in character from plaintiff's work).

⁶² This point was seemingly reinforced in *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003), although the case is not entirely clear since it did in fact involve significant alterations to the personae of the plaintiffs, rock musicians Johnny and Edgar Winter, who were presented as evil half-human, half-worm characters in a comic book. Nonetheless, the court alluded to a holistic view when it pointed out that "plaintiffs are merely part of the raw materials from which the comic books were synthesized [and were contained in] a larger story, which is itself quite expressive." *Id.* at 479. The latter statement seems to suggest that more than just changes in a plaintiff's persona are salient in the transformative determination. For another primarily atomistic analysis that nonetheless gestured in the direction of holism, see *No Doubt v. Activision Publishing, Inc.*, 192 Cal. App. 4th 1018 (Cal. Ct. App. 2d Div. 2011).

⁶³ *Ross v. Roberts*, 222 Cal. App. 677 (Ca. Ct. App., 2013). In addition to the holistic cases discussed in the text, see, e.g., *Hilton v. Hallmark Cards*, 599 F.3d 894 (9th Cir. 2010); *Daniels v. Wayans*, 8 Cal. App. 5th 367 (Cal. Ct. App. 2017); *Washington v. Take-Two Interactive Software*, 2012 Cal. App. Unpub. LEXIS 7975 (Cal. Ct. App. 2012); *Bosley v. WildWetT.com*, 310 F.Supp.2d 924 (N.D. Ohio 2004).

court had little difficulty concluding that the use was transformative, even though the plaintiff's name was taken verbatim. Citing *Comedy III*, the court reasoned that even though the defendant adopted the name "Rick Ross" and wrote songs about cocaine trafficking, these elements were merely the "raw material" from which Roberts' music career was synthesized.⁶⁴ But these are not the 'very sum and substance' of Roberts' work."⁶⁵

Rather than focus on the verbatim taking of the plaintiff's name, as an atomistic court might, the court examined the rapper/defendant's entire oeuvre and determined that the artistic universe into which the name and persona of Ross had been transported was highly transformative, since it added new expression to the plaintiff's story. "Using the name and certain details of an infamous criminal's life as its basic elements, he created original artistic works," the court wrote.⁶⁶

Critically, the *Ross* court was not fixated on whether the appropriated materials *themselves* were altered, as was the court in *Hart*. The *Ross* court looked beyond the borrowed material itself and asked whether the entire work (or works) into which the borrowed material is placed add "new expression, meaning, or message" as a whole. Accordingly, the use was transformative and thus protected by the First Amendment.

The *Ross* court also briefly explored the "subsidiary inquiry" from *Comedy III* that asks whether the economic value of the defendant's work is primarily derived from the plaintiff's fame.⁶⁷ The court answered this question in the defendant's favor as well, reasoning that "when individuals purchase music, they generally do so in order to listen to music that they enjoy. It defies credibility to suggest that Roberts gained success primarily from appropriation of plaintiff's name and identity, instead of from the music and professional persona that he (and other defendants) created."⁶⁸ It's worth noting that this analysis is also holistic in that it focuses on the overall rationale for plaintiff's success, rather than the simple

⁶⁴ *Ross v. Roberts*, 222 Cal. App. 677 at 688.

⁶⁵ *Id.* at 687 (quoting *Comedy III* (citations omitted)).

⁶⁶ *Id.* at 687-88.

⁶⁷ *Id.* at 688.

⁶⁸ *Id.* at 688.

fact that he appropriated another's persona and may as a result have gotten some initial attention from the public.

Another strongly holistic opinion is the Sixth Circuit's 2003 decision in favor of an artist who painted Tiger Woods in *ETW Corp. v. Jireh Publ'g Inc.*⁶⁹ In *ETW Corp.*, sports artist Rick Rush had painted a work titled "The Masters of Augusta" commemorating Woods' remarkable win at the 1997 Masters Tournament.⁷⁰ In addition to Woods' record 12-stroke victory, the win at the previously exclusionary tournament by a golfer of color was also considered a landmark. Rush's painting featured three standard images of Woods going about his business on the course, with a ghostly pantheon of golf demigods, including Arnold Palmer, Bobby Jones, and others, looking on.⁷¹ *ETW*, the corporate arm of Woods' empire, filed suit alleging right of publicity violations, trademark infringement, and other related claims.

The court applied various tests to the publicity claim, but the transformative analysis is particularly interesting for purposes of this paper. The Sixth Circuit majority ruled that despite the unaltered depiction of Woods, the entirety of the painting was transformative.⁷² "Rush's work does not capitalize solely on a literal depiction of Woods," the court reasoned.⁷³ "Rather, Rush's work consists of a collage of images in addition to Woods's image which are combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods's achievement."⁷⁴ The court thus concluded that the "substantial transformative elements"⁷⁵ involved in the painting meant that the work was protected by the First Amendment.

The Sixth Circuit's approach in *ETW Corp.* is unquestionably a holistic one, since the court paid little attention to the fact that the Woods' likeness was unaltered and focused exclusively on the transformativeness of entire expressive work.

⁶⁹ *ETW Corp. v. Jireh Publ'g Co.*, 332 F.3d 915 (6th Cir. 2003).

⁷⁰ *Id.* at 918.

⁷¹ *Id.*

⁷² *Id.* at 938.

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ *Id.*

VI. THE *DE MINIMIS* MODEL

One 2018 California publicity case seemed to focus less on transformative use as some sort of aesthetic reconfiguration (either of the persona or of the larger work) and more on the quantitatively minor role the plaintiff's persona played in the entire work. In *De Havilland v. FX Networks LLC*,⁷⁶ screen legend Olivia de Havilland objected to a television miniseries, *Feud: Bette and Joan*. The production, which was centered on the enmity between actresses Joan Crawford and Bette Davis, included Catherine Zeta-Jones portraying de Havilland.⁷⁷ As the court of appeals noted, the de Havilland character was featured for fewer than 17 minutes of the entire series' 392-minute run.⁷⁸ De Havilland was portrayed giving an interview in which she discusses Hollywood's treatment of women and in a segment interacting with Bette Davis.⁷⁹ As the court pointed out, de Havilland was portrayed positively as "beautiful, glamorous, self-assured, and considerably ahead of her time in her views on the importance of equality and respect for women in Hollywood."⁸⁰

Nonetheless, the real de Havilland was unhappy with the portrayal, including one scene in which the de Havilland character refers to her sister as a "bitch."⁸¹ De Havilland brought a variety of privacy-related claims, including one for violation of California's statutory right of publicity. In the trial court, FX filed a motion to strike under California's anti-SLAPP law, which the trial court denied.⁸²

On appeal, the court of appeals made short work of the publicity claim, since it found the docudrama to be fully protected by the First Amendment against the right of publicity claim.⁸³ The court

⁷⁶ *De Havilland v. FX Networks LLC*, 21 Cal. App. 5th 845 (Ca. Ct. App., 2018).

⁷⁷ *Id.* at 850.

⁷⁸ *Id.* at 851.

⁷⁹ *Id.*

⁸⁰ *Id.*

⁸¹ *Feud: Bette and Joan* (FX television broadcast March 5, 2017).

⁸² *De Havilland*, 21 Cal. App. 5th at 851.

⁸³ *Id.* at 861-862.

nonetheless also engaged in a transformativeness analysis, which appeared to be a kind of alternative holding on the publicity question.⁸⁴

The trial court had ruled that a docudrama that attempted to make its characters as close to reality as possible could not be transformative.⁸⁵ The appellate court disagreed, pointing out that “the fictitious, ‘imagined’ interview in which Zeta-Jones talks about the Hollywood’s treatment of women and the Crawford/Davis rivalry is a far cry from T-shirts depicting a representational, pedestrian, uncreative drawing of The Three Stooges.”⁸⁶ Moreover, the court focused on the fact that the de Havilland role merely amounted to around 4 percent of *Feud*.⁸⁷ The docudrama told many stories that had no connection to de Havilland, the court reasoned, and the de Havilland story arc was but a tiny segment of the entire work.⁸⁸ The appeals court also cited the “subsidiary inquiry” from *Comedy III* and found that the marketability and economic value of *Feud* was derived mainly from the skill and reputation of its creative team and not from de Havilland’s fame.⁸⁹

Interestingly, the overall transformativeness determination focused very little on any creative use of the plaintiff’s persona, either atomistically or holistically. Instead, it sounds as if the court is applying a sort of *de minimis* analysis.⁹⁰ The court’s approach also bears a resemblance to the “amount and substantiality of the portion used” factor from copyright’s fair use provision, although here the California court inverted it by focusing not on the proportion used in relation to the size of the plaintiff’s work (as in copyright), but on the proportion of the persona used in relation to the size of the defendant’s work.⁹¹

De Havilland is thus something of an outlier in the existing opinions that apply transformative use analysis. It certainly bases its

⁸⁴ *Id.* at 864.

⁸⁵ *Id.* at 863.

⁸⁶ *Id.*

⁸⁷ *Id.*

⁸⁸ *Id.* at 863-864.

⁸⁹ *Id.*

⁹⁰ For a useful look at the *de minimis* doctrine in copyright law, see Julie D. Cromer, *Harry Potter and the Three-Second Crime: Are We Vanishing the De Minimis defense from Copyright Law?* 36 N. M. L. REV. 261 (2006).

⁹¹ 17 U.S.C. § 107 (2018).

analysis on the *Comedy III* subsidiary test about the “marketability and economic value” of the work, but it engages in almost no attention to any actual transformation by the defendant. Instead, it focuses heavily on the quantitative dimension of the persona’s appearance in the entire work. Had the *Hart* court adopted a similar analysis, it seems entirely possible that Ryan Hart’s persona was deployed in a tiny percentage of the all virtual games played by *NCAA Football* fans. Thus, under this kind of approach, EA might have succeeded in demonstrating a transformative use, since it the collection of all the avatars that made the game valuable to players. Any one player was insignificant in this sense.

Is the quasi *de minimis* style of analysis employed in *De Havilland* even something that can be characterized as a “transformative use” inquiry? It certainly bears no resemblance to the transformative concept as deployed in copyright doctrine. It has the virtue of permitting realistic portrayals of human identity to be treated as transformative—something the atomistic approach eschews. At least two other cases have relied heavily on this analytic approach.⁹²

VII. SIDESTEPPING THE TRANSFORMATIVE TEST

At least one recent case, decided by the Ninth Circuit in 2016, managed to avoid applying the transformative test entirely. In *Sarver v. Chartier*,⁹³ the Ninth Circuit considered an army sergeant’s claim that the makers of the Oscar-winning film *The Hurt Locker* violated his right of publicity in creating the film’s main character, an Army bomb disposal technician in Iraq. The film’s screenwriter had previously written a profile of Sarver that appeared

⁹² *Arenas v. Shed Media*, 881 F.Supp.2d 1181, 1191 (C.D. Cal. 2011) (writing that references to professional basketball player in television show were “incidental to the show’s plot as a whole.”); *Noriega v. Activision Blizzard*, BC 551747, L.A. County Superior Court at p. 5 (Oct. 27, 2014) (writing that the video game in question was, as a whole, “complex and multi-faceted” and only used the persona of deposed Panamanian strongman Manuel Noriega in a *de minimis* fashion, thus making his persona one of the “raw materials” of the game, but not its “sum and substance.”), decision found at http://online.wsj.com/public/resources/documents/2014_1028_noriega.pdf.

⁹³ 813 F.3d 891 (9th Cir. 2016).

in a national publication, and Sarver claimed that the film's main character was based upon his life and experiences.⁹⁴

The Ninth Circuit, on an anti-SLAPP motion, rejected Sarver's publicity claim not by applying the transformative test, but by deploying a much more potent constitutional standard—First Amendment strict scrutiny. The Ninth Circuit's analysis⁹⁵ stated that it had upheld publicity claims against First Amendment challenges in situations in which a defendant "appropriates the economic value that the plaintiff has built in an identity or performance."⁹⁶ As one example of this type of case, the court noted that in *Keller v. Electronic Arts, Inc.*⁹⁷, (discussed earlier in this work in connection with the *Hart* case) it had upheld the right of a college football player to recover for use of his likeness in EA's video game. A second line of cases in which publicity rights had trumped free speech rights, the Ninth Circuit reasoned, involved use of plaintiffs' personae in advertisements, since commercial speech is a less-protected category of expression. "In sum," the court stated, "our precedents have held that speech which either appropriates the economic value of a performance or persona or seeks to capitalize off a celebrity's image in commercial advertisements is unprotected by the First Amendment against a California right-of-publicity claim."⁹⁸

The Ninth Circuit panel reasoned that Sarver's claim did not fit either of those categories. First, *The Hurt Locker* was not commercial speech, but rather a fully protected expressive work.⁹⁹ Moreover, unlike plaintiffs in cases such as *Keller*, Sarver did not "invest time and money to build up economic value in a marketable

⁹⁴ *Id.* at 896.

⁹⁵ The Ninth Circuit panel devoted significant discussion to *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977), the U.S. Supreme Court's sole intervention into the First Amendment status of right of publicity doctrine. *Zacchini* is regarded by some commentators as *sui generis*, since it involved a complete appropriation of the plaintiff's 15-second act, rather than being a more standard publicity claim involving name or likeness. Thus, its precedential force in a run-of-the-mill right of publicity suit may be limited.

⁹⁶ Sarver, 813 F.3d at 904.

⁹⁷ 724 F.3d 1268 (9th Cir. 2013).

⁹⁸ Sarver, 813 F.3d at 905.

⁹⁹ *Id.* at 906.

performance or identity. Rather, Sarver is a private person who lived his life and worked his job.”¹⁰⁰ Thus, there was no appropriation of economic value or free-riding on Sarver’s public persona, since he had never even attempted to create one. As a result, in Sarver’s case, the right of publicity was appropriately categorized as a content-based restriction on fully protected speech, which therefore required strict scrutiny.¹⁰¹ As is generally the case when strict scrutiny is deployed,¹⁰² the Ninth Circuit found that Sarver could not demonstrate a compelling interest in penalizing the speech of the defendant filmmakers.¹⁰³ Thus, his right of publicity claim failed.

Sarver may be the only reported federal circuit case in which strict scrutiny was applied to a right of publicity claim. The application of strict scrutiny did indeed avoid the need for a transformative analysis, although the uses of strict scrutiny were nonetheless sharply circumscribed by the Ninth Circuit panel. In cases in which a plaintiff worked in some way to create an economically valuable persona or performance, or where the use involved commercial speech, strict scrutiny would not apply under the *Sarver* formulation. Oddly, *Sarver* barely mentioned the transformative test, instead characterizing *Keller* not as a case in which the use was nontransformative, but as simply a case in which the use was unprotected by the First Amendment. In a footnote, the *Sarver* court noted that a transformative use test was “an affirmative defense formulated by the California Supreme Court which aims to strike a balance between First Amendment interests and a plaintiff’s asserted right of publicity. We need not and do not reach the question of whether such defense applies in this case.”¹⁰⁴

Does this indicate that the Ninth Circuit is moving away from

¹⁰⁰ *Id.* at 905.

¹⁰¹ The Ninth Circuit cited the Supreme Court’s controversial recent decision in *Reed v. Town of Gilbert*, 135 S. Ct. 2218 (2015), a case in which Justice Clarence Thomas’s majority opinion seemingly expanded the concept of content-based restrictions on speech, which, however defined, have long been subject to strict scrutiny review. See Minch Minchin, *A Doctrine at Risk: Content Neutrality in a Post-Reed Landscape*, 22 COMM. L. & POL’Y 123 (2017).

¹⁰² For an empirical look at the operation of strict scrutiny in the federal courts, see Adam Winkler, *Fatal in Theory and Strict in Fact: An Empirical Analysis of Strict Scrutiny in the Federal Courts*, 59 VAND. L. REV. 793 (2006).

¹⁰³ *Sarver*, 813 F.3d at 906.

¹⁰⁴ *Id.* at 904 note 6.

Comedy III's transformative test? As a federal court sitting in a diversity case, the Ninth Circuit is bound to apply the substantive law of the state in which the district court sits (although the federal constitution of course remains supreme). The Ninth Circuit did this when it applied California's anti-SLAPP statute. However, the transformative use doctrine was relegated to a footnote. This may call into question the legal status of transformative use, since the *Comedy III* court seemed to present it as not merely a creature of state law, but as a rule of constitutional dimension to sort out conflicts between the First Amendment and the right of publicity. In copyright's version of fair use (of which the transformative doctrine is a key aspect), fair use serves as a statutory proxy for free speech interests that obviates the need for the application of the First Amendment scrutiny structure, including strict scrutiny.¹⁰⁵ However, *Sarver* suggests that, whatever the juridical status of transformative use in publicity law, it does not similarly substitute for First Amendment scrutiny, at least in cases not involving commercial speech or an economically valuable persona. Thus, by almost completely ignoring the transformative test, *Sarver* places its status in some doubt.

At least one commentator has attributed the strict scrutiny approach in *Sarver* to the sweeping language of the Supreme Court's *Reed* case.¹⁰⁶ Professor Genevieve Lakier cited *Sarver* as one example of "*Reed's* effects across the country, as courts apply strict scrutiny to—and strike down—laws that previously were, or likely would have been, upheld as content-neutral prior to *Reed*."¹⁰⁷

ANALYSIS AND CONCLUSION

The state of the law at the intersection of the First Amendment and the right of publicity is in considerable disarray. Not all courts accept the transformative use test, but among those that do, very different conceptions of transformation drive the case law. The

¹⁰⁵ *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003) (writing that "copyright's built-in free speech safeguards are generally adequate" when copyright interests conflict with free speech values).

¹⁰⁶ See discussion of *Reed*, *supra* note 60.

¹⁰⁷ Genevieve Lakier, *Reed v. Town of Gilbert, Arizona, and the Rise of the Anticlassificatory First Amendment*, 2016 SUP. CT. REV. 233, 235 (2016).

atomistic analysis seems the least defensible, since that approach all but rules out realistic portrayals of human identity. The more holistic analysis is certainly a step in the right direction. At least under the holistic model, which is more consistent with transformative use as applied in copyright doctrine, defendants can point to a variety of expressive efforts in their works to justify their appropriations rather than engage in a forced and perhaps artificial alteration of the plaintiff's persona itself in order to find protection under the First Amendment.

On the other hand, the *de minimis* version of transformative use, while still very much a minority position, has some potential in a certain class of cases. One advantage of this version is that courts are not forced to make artistic judgments about the worth of the transformative effort put in by the defendant. Instead, a more quantitative judgment can be made based on how much of the new work consists of the disputed persona. For a work like the one in *De Havilland*, a lengthy television series, it may not be that difficult for a potential defendant to meet the test, since many story arcs can take place that don't necessarily involve the plaintiff. On the other hand, the *de minimis* model may be more difficult to operationalize if employed in the case something less than a sprawling epic—say, a painting or a photograph—works without vast expanses of narrative space. Even in the setting of a film, how would a filmmaker create a work that focused one particular individual (such as a biopic) without having that individual's persona occupy a great deal of the narrative real estate? As a version of *Comedy III's* "subsidiary inquiry" it may have its uses, but it certainly could not successfully subsume the transformative inquiry as a whole.

From a free expression perspective, *Sarver* represents the most radical approach—jettisoning the transformative use doctrine in favor of First Amendment strict scrutiny. The *Sarver* court, of course, limited the application of strict scrutiny to cases involving essentially unknown plaintiffs in which the persona wasn't being used in a commercial speech context. The latter stipulation makes constitutional sense, since strict scrutiny is routinely applied only to fully protected speech. However, the notion that strict scrutiny should only be applied in the case of purely private figures and not deployed in cases in which celebrity plaintiffs seek to punish makers of expressive works seems odd. If anything, the First Amendment

interest in depictions of the famous and powerful in expressive works would be higher rather than lower. As one appellate brief expressed this principle:

Indeed, the more important or famous a person is, the more imperative that the First Amendment protects the right of others to tell her story, including the right to assess and criticize her free from the threat of litigation. The First Amendment means nothing if it does not protect the rights of artists to create controversial, even unflattering, works about our leaders and celebrities.¹⁰⁸

The *Sarver* approach essentially reverses the First Amendment hierarchy established in cases such as *New York Times Co. v. Sullivan*¹⁰⁹ in which public official and public figure plaintiffs are subject to a higher First Amendment burden than are private figures. Of course, *Sullivan* was a defamation case, which features different interests on the plaintiff's side of the equation than the right of publicity, but the inherent value of the defendant's speech under the First Amendment seems quite similar in either scenario.

Transformative use analysis has proven problematic in publicity law. Because important expressive rights are at stake, it is imperative that courts take steps to improve and clarify the doctrine, most effectively by emphasizing the holistic approach described here. Giving more attention to free expression interests that intersect with publicity law is a critical step toward improved doctrine in this area.

¹⁰⁸ *Amicus curiae* brief of Motion Picture Association of America et al., in support of FX Networks in *De Havilland v. FX Networks LLC*, B285620, Cal. Ct. App., 2d Div. (Jan. 25, 2018) at 44, located at https://law.yale.edu/system/files/area/center/isp/documents/odh.v.fx_mpaam_amicus.1.25.18.pdf (last viewed Oct. 23, 2018); *see also, e.g.*, ROTHMAN, *supra* note 1, at 153 (writing that “the analysis in *Sarver* gets things backward. The court gives the least protection to anonymous, fungible individuals, while boosting protection for the very individuals we most need to refer to and comment on in expressive works.”).

¹⁰⁹ *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964).