

ARTICLE

FREEDOM OF SPEECH AND THE RIGHT OF PUBLICITY

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I. INTRODUCTION

Speakers often use others' names and likenesses in their expression, and often do so without the subject's permission. Biographers do this; so do journalists, novelists, sculptors, painters, T-shirt designers, and advertisers. When does the First Amendment protect the speaker's right to engage in such speech, and when may the right of publicity lawfully constrain speakers?

This Article will make a few observations about this question. Part II will suggest that, though the right of publicity is often analyzed using the First Amendment commercial speech dichotomy, the analysis would be more helpfully conducted by dividing speech into four different categories:

- (1) "noncommercial speech" genres that right of publicity law favors, such as news, movies, and the like;
- (2) commercial advertisements for those noncommercial speech genres;
- (3) other kinds of commercial advertisements; and
- (4) "noncommercial speech" genres that right of publicity law disfavors, such as sculptures, prints, T-shirts, and the like.

Categories (1) and (2), it turns out, are exempted from the right of publicity (though one is treated by First Amendment law as noncommercial speech and the other as commercial speech). Categories (3) and (4) are covered by the right of publicity, though again one is commercial speech and the other isn't.

Part III will then argue that the restriction of category (4) speech, and the distinction between categories (1) and (4)—a distinction that the right of publicity generally draws—is inconsistent with the First Amendment. Part IV will discuss one recently proposed way of supporting this distinction, the "transformative use" test set forth by the California Supreme Court in *Comedy III Productions v. Gary Saderup, Inc.*;¹ while this distinction may seem appealing, I'll argue that it's too vague and otherwise unsound. Finally, Part V will discuss how the distinction between categories (1) and (3) may run afoul of the growing constitutional protection of commercial advertising, and especially the California Supreme Court's recent decision in *Gerawan Farming, Inc. v. Lyons*.²

I generally oppose the right of publicity, especially outside

1. 21 P.3d 797, 808–10 (Cal. 2001).

2. 12 P.3d 720, 751–52 (Cal. 2000).

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the core commercial advertising zone in category (3). I hope, though, that these observations may be helpful to those who are looking for a way to better define a broader right of publicity, as well as to those who are looking for ways to challenge the right of publicity's breadth.

II. THE SCOPE OF THE RIGHT

The right of publicity, in the words of the *Restatement (Third) of Unfair Competition* section 46, bars people from "appropriat[ing] the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade."³ Similarly, statutes such as California Civil Code section 3344 bar "us[ing] another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services."⁴

Under standard First Amendment doctrine, this definition can't be accepted at face value—and in fact many lower courts have held that the First Amendment precludes right of publicity liability in many cases.⁵ For instance, an unauthorized biography is certainly a "product" and an item in "trade" that benefits from the "commercial value of [its subject's] identity";⁶ it uses the subject's name and often his photograph in goods (the biography itself); and yet unauthorized biographies are constitutionally protected from liability.⁷ Likewise for magazine or newspaper articles that focus on or mention unconsenting subjects,⁸ and that may often even include the subject's name and likeness on the front page as a means of capitalizing on the "commercial value" of the subject's identity.⁹

3. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

4. CAL. CIV. CODE § 3344(a) (West 1997). Refer to notes 14–16 *infra* for citations to some other such statutes.

5. See, e.g., *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185–86 (9th Cir. 2001) (holding that the First Amendment lets magazines use celebrities' names and likenesses in feature articles); *Comedy III*, 21 P.3d at 808 ("First Amendment protection of . . . [sufficiently transformative] works outweighs whatever interest the state may have in enforcing the right of publicity.");

6. See CAL. CIV. CODE § 3344; RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46.

7. See *Matthews v. Wozencraft*, 15 F.3d 432, 439–40 (5th Cir. 1994); *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 337–38 (E.D. Pa. 1996); *Taylor v. NBC*, No. BC110922, 1994 WL 780690, at *2 (Cal. Super. Ct. Sept. 12, 1994).

8. See, e.g., *Hoffman*, 255 F.3d at 1185–86 (holding that such an article was constitutionally protected against a right of publicity claim).

9. See *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639, 640–41 (Ct.

Nor does *Zacchini v. Scripps-Howard Broadcasting Co.*,¹⁰ the Court's one "right of publicity" case, authorize liability here. *Zacchini* focused only on the unusual right of publicity scenario where a defendant broadcasts the plaintiff's entire act, a claim that the Court pointed out is much like a copyright claim, though applicable under state law to unfixed works.¹¹ The Court twice stressed that it was *not* deciding the broader question of when a plaintiff may sue the defendant for using plaintiff's name, likeness, or other attributes of identity—the standard right of publicity claim.¹²

This is why, based in large part on First Amendment considerations,¹³ section 47 of the *Restatement* dramatically limits the scope of section 46:

The name, likeness, and other indicia of a person's identity are used "for purposes of trade" under the rule stated in § 46 if they are used in advertising the user's goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user. However, use "for purposes of trade" does not ordinarily include the use of a person's identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.¹⁴

Similarly (though more narrowly), California Civil Code section 3344(d) limits section 3344(a), excluding uses "in connection with any news, public affairs, or sports broadcast or account, or any political campaign,"¹⁵ and some other state statutes do the same.¹⁶ Those states would thus impose statutory

App. 1995); see also *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 351 (Ct. App. 1983) (so concluding, but also concluding that if the statements about the plaintiff were knowingly false, they may be punished under the false statements of fact exception to First Amendment protection).

10. 433 U.S. 562 (1977).

11. *Id.* at 576–77.

12. *Id.* at 573 n.10, 576.

13. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (1995) ("The right of publicity as recognized by statute and common law is fundamentally constrained by the public and constitutional interest in freedom of expression.").

14. *Id.* § 47; see also, e.g., IND. CODE ANN. § 32-36-1-1(c) (Michie 2002) (providing a similarly broad exception); OHIO REV. CODE ANN. § 2741.09 (Anderson 2000) (likewise); 42 PA. CONS. STAT. ANN. § 8316(e) (West 1998) (likewise); WASH. REV. CODE ANN. § 63.60.070(1) (West Supp. 2003) (exempting any "matters of cultural, historical, political, religious, educational, newsworthy, or public interest").

15. CAL. CIV. CODE § 3344(d) (West 1997).

16. See, e.g., OKLA. STAT. ANN. tit. 12, § 1449(D) (West 1993) (adopting the same limited exclusion); TENN. CODE ANN. § 47-25-1107(a) (2001) (same); see also FLA. STAT. ANN. § 540.08(3)(a) (West 2002) (excluding only "bona fide news report[s] or presentation[s] having a current and legitimate public interest"); NEB. REV. STAT. § 20-202 (1997) (excluding only news reports and noncommercial advertisements); cf. 765 ILL.

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liability for commercially distributed movies, plays, novels, songs, and jokes (except ones that are treated as “news” or “public affairs”) that mention real people by name,¹⁷ though such liability may often be preempted by the First Amendment.¹⁸

The common-law and statutory rights of publicity, then, don’t simply distinguish commercial uses in the sense of uses sold in commerce (which would include biographies and newspaper articles) from noncommercially distributed uses. Neither do they simply distinguish uses that constitute “commercial speech” (which would likely include advertisements for biographies, but exclude T-shirts, prints, and the like¹⁹) from uses that are “noncommercial speech.” Rather, they generally divide publications into four categories, and cover the latter two and not the first two:

Type of Speech	Commercial Speech?	Infringement?
1. Certain kinds of works that refer to a person but fall within certain <i>favored genres</i> , defined as “news reporting, commentary, entertainment, works of fiction or nonfiction” (Restatement) or “news, public affairs, or sports . . . , or any political campaign” (California Civil Code)	No	No
2. Advertisements for the items in category 1	Yes	No
3. Advertisements for other products (VCRs, cars, snacks, and whatever else) that refer to a person	Yes	Yes

COMP. STAT. ANN. 1075/35(b) (West 2003) (excluding a broad range of portrayals of people, but covering uses of people’s names in songs or books that are outside the scope of “portray[al], descri[ption], or impersonat[ion],” for instance as with the mention of Joe DiMaggio in Simon & Garfunkel’s *Mrs. Robinson*).

17. Dead people’s names, likenesses, and other attributes might be more broadly usable; California law, for instance, provides that the right to control the use of dead people’s identities doesn’t extend to any “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, . . . if it is fictional or nonfictional entertainment, or a dramatic, literary, or musical work.” CAL. CIV. CODE § 3344.1(a)(2) (West Supp. 2003).

18. Refer to Part IV *infra*.

19. Refer to note 25 *infra* and accompanying text.

4. Works, other than advertisements, that refer to a person and <i>fall outside the favored genres</i> in item 1, such as sculptures, T-shirts, or prints, or, in California, songs, movies, and other entertainment	No	Yes
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III. THE DISFAVORED GENRES AND THE FIRST AMENDMENT

Lower courts have consistently held—correctly, in my view—that the right of publicity may not restrict, as the California statute purports to do, movies, novels, plays, or songs that use people's names or likeness.²⁰ The movie *Forrest Gump*, in which the title character meets various famous people, or any novel that contains real people as named characters, or Simon & Garfunkel's *Mrs. Robinson*, which mentions Joe DiMaggio, are all constitutionally protected. Real people, dead or alive, are important subjects of discussion, in fiction as well as in news reporting.²¹ Today's debates about the disfavored genres therefore have to do not with movies, novels, or songs, but with sculptures, prints, and T-shirts: An early 1980s Georgia Supreme Court case, for instance, held that the Martin Luther King, Jr. estate could bar the distribution of unauthorized busts of King, and the 2001 California Supreme Court *Comedy III Productions v. Saderup* decision held the same for the distribution of unauthorized T-shirts and prints of the Three Stooges.²²

And yet even here the First Amendment issue remains. The Supreme Court's First Amendment jurisprudence provides no support for distinguishing visual art depicting a person (a bust or a print) from literary or audiovisual works that use a person's name or likeness (a movie, a novel, a news story, a joke in a

20. See, e.g., *Rogers v. Grimaldi*, 875 F.2d 994, 1004–05 (2d Cir. 1989); *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003); cases cited *supra* note 7. Cf. *Parks v. LaFace Records*, 329 F.3d 437, 461 (6th Cir. 2003) (acknowledging this general principle, but concluding that the use of someone's name or likeness may be prohibited if it is “wholly unrelated” to the rest of the work). But see *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003) (disagreeing with *Winter*, and holding that comic book author might be liable to famous person after whom he named a character).

21. See *Winters v. New York*, 333 U.S. 507, 510 (1948) (refusing to draw a First Amendment distinction between entertainment and political advocacy).

22. *Martin Luther King, Jr. Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., Inc.*, 296 S.E.2d 697, 706 (Ga. 1982); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001). But see *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003) (holding that prints depicting Tiger Woods are protected by the First Amendment against Woods's right of publicity lawsuit).

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comedian's routine).²³

Both kinds of work may be sold for money, but are protected despite that.²⁴ Both are considered noncommercial speech, because the commercial speech doctrine is generally limited to commercial advertising.²⁵ Both, when they refer to a famous person, involve speakers (sculptors, artists, filmmakers, biographers, journalists) creating something that wouldn't have any value but for its subject's fame.²⁶ And First Amendment law also hasn't distinguished, and shouldn't distinguish, high art (e.g., "serious" sculpture or painting) from low (e.g., prints or sculptures made for decorating a wall or a mantelpiece), just as it hasn't distinguished high literature from low.²⁷

First Amendment law has also never distinguished "high information content" works such as books or movies from "low information content" works, a category into which some might place sculptures, prints, and T-shirts. The First Amendment protects your right to wear a jacket with a three-word slogan;

23. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 969 (10th Cir. 1996) (holding, in a right of publicity case, that the First Amendment protects parody baseball cards, and reasoning that "[t]he protections afforded by the First Amendment . . . have never been limited to newspapers and books. . . . Thus, even if the trading cards are not a traditional medium of expression, they nonetheless contain protected speech"); Diane Leenheer Zimmerman, *ETW Corp. v. Jireh Publishing, Inc.: Amicus Curiae Brief of Seventy-Three Law Professors in Support of Jireh Publishing, Inc.*, 22 WHITTIER L. REV. 391, 410–12 (2000).

24. See *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105 (1991) (holding that the First Amendment protects the right to sell speech).

25. See, e.g., *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 759, 761 (1976); Eugene Volokh, *Freedom of Speech and Information Privacy: The Troubling Implications of a Right to Stop People from Speaking About You*, 52 STAN. L. REV. 1049, 1080–81 (2000).

26. Some have argued that, to quote *Zacchini* (though outside the specific context in which *Zacchini* made this statement),

The rationale for [protecting the right of publicity] is the straight-forward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.

433 U.S. at 576 (alteration in original). But Martin Luther King, Jr.'s life story would also have market value, and would-be biographers often do pay for such life stories. We conclude that the biographers may nonetheless write unauthorized biographies, without paying any money to their subjects, presumably because we think that some "social purpose is served" by such biographies. Why then wouldn't a "social purpose" be served by people being able to distribute busts, prints, or T-shirts?

27. See *Winters v. New York*, 333 U.S. 507, 510 (1948) ("What is one man's amusement, teaches another's doctrine. Though we can see nothing of any possible value to society in these magazines, they are as much entitled to the protection of free speech as the best of literature."). The one exception is obscenity law, which distinguishes works that have "serious" scientific, literary, artistic, or political value from works that lack serious value, *Miller v. California*, 413 U.S. 15, 26 (1973), but that has fortunately proven to be a narrow exception, applicable only to highly sexually explicit materials—it would be a mistake, I think, to extend the judge's role as art critic further.

your right to display a sign containing just the words “For Peace in the Gulf”; your right to display symbols, such as black armbands or burning flags, that convey a fairly simple (and often not even very precisely defined) message; and your right to create purely abstract works, such as abstract art, instrumental music, or absurdist poetry that don’t convey many ideas at all.²⁸

Creating a bust of Martin Luther King, Jr. seems at least as much part of the sculptor’s self-expression as are these works; and it is at least as valuable to its consumers (who will display it proudly on the mantelpiece to express their support for King) as a jacket with a short slogan would be. Moreover, short and symbolic messages, whether “Fuck the Draft,” a burning flag, or a famous person’s likeness, are often more persuasive than longer and more explicit messages, because people are more likely to pay attention to them: That’s why, for better or worse, phrases that can fit on bumper stickers are important in politics.

Nor is the government interest at stake here especially weighty. If the law may not suppress even short profanity-laden messages to prevent offense to listeners or deterioration of civil discourse, then it’s not clear why it should be able to suppress T-shirts or busts to provide more money to celebrities.

Copyright law can at least be justified by its specific constitutional authorization, and by the concern that without the financial incentive secured by copyright law, many fewer works (especially expensive works) would be created.²⁹ But the Constitution does not similarly mention the right of publicity; and it’s hard to believe that people would stop wanting to become political leaders, actors, or athletes if they were told that they would get less income from sales of T-shirts or prints. Virtually all such uses depict people who are already famous, and who have likely already earned a lot of money from the activity that made them famous.³⁰

One can imagine someone for whom the marginal incentive provided by the exclusive rights to control T-shirt sales makes the difference between staying obscure and working to become

28. See *Cohen v. California*, 403 U.S. 15, 25–26 (1971); *City of Ladue v. Gilleo*, 512 U.S. 43, 54–55 (1994); *Tinker v. Des Moines Indep. Cmty. School Dist.*, 393 U.S. 503, 514 (1969); *Texas v. Johnson*, 491 U.S. 397 (1989); *Hurley v. Irish-Am. Gay, Lesbian & Bisexual Group, Inc.*, 515 U.S. 557, 569 (1995).

29. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558–59 (1985).

30. See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 973–74 (10th Cir. 1996) (rejecting the economic arguments in favor of the right of publicity); Michael Madow, *Private Ownership of Public Image: Popular Culture & Publicity Rights*, 81 CAL. L. REV. 125, 137, 184 (1993) (likewise); Zimmerman, *supra* note 23, at 417 (likewise).

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famous, or between staying moderately famous and working to become more famous—but this would be a rare person indeed.³¹ So right of publicity law certainly prohibits the creation of some new works (prints, sculptures, and the like) in order to provide a small speculative increase in the incentive to create other works (the works that would make a person famous). If the law's goal is encouraging the production of new works, the right of publicity will likely disserve the interest more than it serves it.³²

31. See *Cardtoons*, 95 F.3d at 974 (reasoning that the right of publicity provides some marginal incentive, but only a small amount). But see *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 804–05 (Cal. 2001) (quoting *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979) (Bird, C.J., dissenting)) (arguing that “[y]ears of labor may be required before one’s skill . . . [is] sufficiently developed to permit an economic return through some medium of commercial promotion,” and that the law may thus recognize “a legitimate protectible interest in exploiting the value to be obtained from merchandising the celebrity’s image, whether that interest be conceived as a kind of natural property right or as an incentive for encouraging creative work”). If studios insist that stars assign their rights of publicity to them, then the prospect of the extra income from merchandising might conceivably provide some extra incentive to make the movie. But since studios already have the exclusive rights to merchandising that copies parts of their copyrighted works—such as photographs of scenes from the movie, or T-shirts depicting characters in costume—this marginal incentive should be very small.

32. Some have also argued that giving celebrities a property right in their name and likeness prevents “congestion externalities”:

Associating one’s goodwill with a product transmits valuable information to consumers. Without the artificial scarcity created by the protection of one’s likeness, that likeness would be exploited commercially until the marginal value of its use is zero.

[footnote:] If the appropriation of an individual’s goodwill were left untrammelled, it soon would be overused, as each user will not consider the externality effect his use will have on others. Each use of the celebrity’s name or face will reduce the value that other users can derive from it. The use of a name or face, therefore, is analogous to the overuse of a public highway: In deciding whether to use the road, each user does not consider the increased congestion that his use will inflict on others.

We can ration the use of highways by imposing tolls. We grant celebrities a property right to ration the use of their names in order to maximize their value over time.

Matthews v. Wozencraft, 15 F.3d 432, 437–38 & 438 n.2 (5th Cir. 1994) (citations omitted); see also WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* ch. 8 (2003); Richard A. Posner, *The Right of Privacy*, 12 GA. L. REV. 393, 412–13 (1978); Mark F. Grady, *A Positive Economic Theory of the Right of Publicity*, 1 UCLA ENT. L. REV. 97, 103–04, 126 (1994).

It is far from clear, though, that this would happen, especially as to uses other than commercial advertising. As the *Cardtoons* court pointed out, “the frequent appearance of a celebrity’s likeness on t-shirts and coffee mugs” may not “reduce its value” but might rather increase it “precisely because ‘everybody’s got one.’” *Cardtoons*, 95 F.3d at 975; Madow, *supra* note 30, at 221–25. Moreover, if more people can get more works that contain the celebrity’s name or likeness—either because there are more different sorts of such works, which appeal to a broader range of tastes, or because competition makes the works cheaper—then this will likely increase the aggregate value of the works to users. (This is similar to the way competition among producers of other goods, such as fruits and vegetables, yields cheaper and more varied products and increases the aggregate value of the products to consumers.) This increase may well

And under orthodox First Amendment doctrine, mere conjecture that this speech restriction might do some amount of good in some cases generally isn't enough.³³ Whatever "balancing,"³⁴ the First Amendment tolerates is generally channeled by First Amendment doctrine through certain fairly demanding tests. When speech is otherwise presumptively protected (i.e., it doesn't fall within the narrow exceptions, such as obscenity, false statements of fact, or threats), content-based restrictions on such speech—not just viewpoint-based restrictions, but content-based ones—are constitutional only if they are narrowly tailored to a compelling government interest.³⁵ In free speech cases, this test has been interpreted in a very demanding fashion, requiring more than just a guess that restricting speech will provide some benefit;³⁶ it's hard to see the test being satisfied as to the right of publicity.

Of course, maybe the deeper reason for the right of publicity isn't the desire for a (likely superfluous) incentive to become famous. Rather, it's the sense that your creating things with *my* name or face on them is taking what is *mine*. Wouldn't there be a

outweigh any "reduc[tion] in the value that other users can derive from" the works. *Wozenkraft*, 15 F.3d at 438; see also Madow, *supra* note 30, at 222 n.445.

But more broadly, the mere possibility that unrestricted speech may in some situations cause some economic problems should not be enough to justify speech restrictions. For such restrictions to be constitutional, it seems to me, the government interest behind the restriction should be considerably stronger and more certainly implicated. Refer to note 33 *infra* and accompanying text.

33. See, e.g., *Eu v. S.F. County Democratic Cent. Comm.*, 489 U.S. 214, 226, 228–29 (1989); *Meyer v. Grant*, 486 U.S. 414, 426 (1988); *FEC v. Mass. Citizens for Life, Inc.*, 479 U.S. 238, 262 (1986); *Globe Newspaper Co. v. Superior Court*, 457 U.S. 596, 608–10 (1982); *First Nat'l Bank v. Bellotti*, 435 U.S. 765, 789–90 (1978); *Buckley v. Valeo*, 424 U.S. 1, 45–47, 53–54 (1976).

34. See 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* at 2-5 to -6 (2d ed. 2000) (arguing that "[b]alancing free speech against the [r]ight of [p]ublicity should be no more, or less, difficult here than in any other area of the law").

35. *Austin v. Mich. Chamber of Commerce*, 494 U.S. 652, 654–55, 660 (1990); *Boos v. Barry*, 485 U.S. 312, 329 (1988); see also *Burson v. Freeman*, 504 U.S. 191, 198, 199–200, 206–12 (1992) (plurality opinion); *Bd. of Airport Comm'rs v. Jews for Jesus, Inc.*, 482 U.S. 569, 573 (1987); *Cornelius v. NAACP Legal Def. & Educ. Fund, Inc.*, 473 U.S. 788, 800 (1985); *United States v. Grace*, 461 U.S. 171, 177, 183–84 (1983); *Perry Educ. Ass'n v. Perry Local Educators' Ass'n*, 460 U.S. 37, 45 (1983). The right of publicity is clearly content-based: It prohibits the unlicensed use of particular content (people's names or likenesses). See Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 *Liquormart*, and Bartnicki, 40 *HOUS. L. REV.* 697, 703–09 (2003). But even if it's seen as content-neutral, strict scrutiny is still the proper test, because the right of publicity doesn't leave open ample alternative channels for the speaker to convey the content that he wishes to convey. *Id.* at 711–12.

36. See Eugene Volokh, *Freedom of Speech, Permissible Tailoring and Transcending Strict Scrutiny*, 144 *U. PA. L. REV.* 2417, 2452–55 (1996).

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strong enough interest, after all, in protecting my property against your theft of this property?³⁷

But “my” is being used here in two different senses, “relating to me” (my name) and “belonging to me so that I can keep others from using it” (my property), and it’s not clear why those senses should be identical—why the name by which I am called or the face that people see should be my exclusive property, which others can’t refer to without my permission. We reject this with regard to biography; Elizabeth Taylor’s life is not Elizabeth Taylor’s intellectual property, in the sense that she can exclude others from making movies about it.³⁸ Elizabeth Taylor’s name and face are likewise not her property vis-à-vis newspapers or filmmakers who want to write about her. Why then should it be her property vis-à-vis sculptors, printmakers, or T-shirt creators?³⁹

The question, then, remains: Even if state law says that the right of publicity is a sort of property, why should First Amendment law tolerate a state law that uses the term “property” to bar people from expressing themselves in certain ways? For copyright law, the answer may be “because the Constitution authorizes it, and because the resulting incentive to produce new works justifies it.” But for right of publicity law, this answer doesn’t work.

IV. THE DISFAVORED GENRES AND THE “TRANSFORMATIVE USE” TEST

A. *The Comedy III Decision*

In 2001, the California Supreme Court offered an answer to this question, in *Comedy III Productions, Inc. v. Gary Saderup*,

37. See 1 MCCARTHY, *supra* note 34, at 2-2 to -8 (making this argument).

38. See, e.g., *Taylor v. NBC*, No. BC110922, 1994 WL 780690, at *2 (Cal. Super. Ct. Sept. 12, 1994); see also *Matthews v. Wozencraft*, 15 F.3d 432, 439 (5th Cir. 1994); *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 338 (E.D. Pa. 1996).

39. Some have tried to defend intellectual property law from First Amendment challenge by analogizing to real property law; “you can’t use my front lawn—my real property—for your speech,” the argument goes, “so you shouldn’t be able to use my intellectual property for your speech, either.” But this is an unsound analogy: My property right in my front lawn only gives me the right to physically exclude people from it; it doesn’t give me the right to keep people from talking about it, or to prevent their photographing it from a public place. Likewise with my name or face, as the newspaper article and biography examples show. Reporters may not write stories about me by breaking into my house (my real property); but they may write stories that use my name and likeness, notwithstanding any intellectual property rights that state law might try to interpose. See generally Mark Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 183–85 (1998) (explaining why intellectual property rules are very different for First Amendment purposes from real property rules).

Inc.,⁴⁰ which tried to limit and justify the right of publicity. This decision will likely be fairly influential both because it was quite carefully reasoned (compare, for instance, its thorough discussion with the cursory aside provided by the Georgia Supreme Court in the case involving the Martin Luther King, Jr. bust⁴¹), and because so many prominent entertainers live in California.⁴²

The *Comedy III* court acknowledged that the right of publicity is limited by the First Amendment.⁴³ It acknowledged that works (in that case, T-shirts and lithographs) aren't "commercial speech" even when they are sold commercially.⁴⁴ It acknowledged that art and entertainment, and not just news or political opinion, are constitutionally protected.⁴⁵ Nonetheless, it concluded that the First Amendment defense is limited to works that are "transformative,"⁴⁶ which the court defined at various times as works that:

- "add[] something new, with a further purpose or different character, altering the first with new expression, meaning or message";⁴⁷
- "add[] significant expression beyond" the "literal depiction or imitation of a celebrity for commercial gain";⁴⁸
- use the celebrity's likeness as "one of the 'raw materials' from which an original work is synthesized," as opposed to having "the depiction or imitation of the celebrity [be] the very sum and substance of the work in question";⁴⁹

40. 21 P.3d 797, 799 (Cal. 2001).

41. *Martin Luther King, Jr. Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., Inc.*, 296 S.E.2d 697, 700, 701, 705 (Ga. 1982).

42. Under the choice of law rules of many states, right of publicity cases should apply the law of the rights holder's domicile (or, if the claim arises from the use of a dead person's name or likeness, the law of the place where the person was domiciled when he died). See, e.g., *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1147 (9th Cir. 2002); *Rogers v. Grimaldi*, 875 F.2d 994, 1002 (2d Cir. 1989). But see *Newton v. Thomason*, 22 F.3d 1455, 1459–60 (9th Cir. 1994) (applying instead the Illinois choice of law rules, which mandate the "most significant contacts" test).

Comedy III has already played a major role outside California in *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 934–38 (6th Cir. 2003), which contained another quite detailed discussion of the First Amendment issues raised by the right of publicity.

43. *Comedy III*, 21 P.3d at 803 (reasoning that the tension between the First Amendment and the right of publicity is resolved in favor of the First Amendment, thereby limiting the right of publicity, much as speech about public figures is granted heightened protection in defamation law).

44. *Id.* at 800, 802.

45. *Id.* at 804.

46. *Id.* at 810.

47. *Id.* at 808 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)).

48. *Id.*

49. *Id.* at 809.

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- “so transform[a likeness] that it has become primarily the defendant’s own expression rather than the celebrity’s likeness,” with the term “expression” “mean[ing] expression of something other than the likeness of the celebrity”;⁵⁰
- involve “the creative elements predominat[ing] in the work” rather than “the literal and imitative”;⁵¹
- involve the artist “contribut[ing] something more than a ‘merely trivial’ variation, [but creating] something recognizably ‘his own.’”⁵²

Applying this analysis, the court concluded that Saderup’s charcoal sketches of the Three Stooges, as reproduced on T-shirts and in lithographs, were not transformative because the “artist’s skill and talent [were] manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame.”⁵³

The California Supreme Court actually spent fairly little time justifying the transformative/nontransformative distinction, or justifying the right of publicity more broadly. It said that “the Legislature has a rational basis for permitting celebrities and their heirs to control the commercial exploitation of the celebrity’s likeness”;⁵⁴ but of course a rational basis generally isn’t enough to justify speech restrictions. It then said that, given *Zacchini*, “the state law interest and the interest in free expression must be balanced, according to the relative importance of the interests at stake,” and cited some past cases that did this balancing; but it didn’t really explain why the state law interest is so weighty, even as to nontransformative copying.⁵⁵ It did, however, identify two reasons for the transformative/nontransformative distinction:

1. Transformative uses don’t interfere as much with the celebrity’s income because “works of parody or other distortions of the celebrity figure are not, from the celebrity fan’s viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia

50. *Id.*

51. *Id.*

52. *Id.* at 810 (quoting *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976) (some internal quotation marks omitted)) (stating the test for when a work becomes copyrightable).

53. *Id.*

54. *Id.* at 805.

55. *Id.* at 805–07.

that the right of publicity is designed to protect.”⁵⁶ (Presumably this rests on an implicit judgment that the celebrity is only entitled to the income from “conventional” celebrity memorabilia, and isn’t entitled to the entire market for all works that trade on the celebrity’s fame, including transformative ones.)

2. The nontransformative uses will be created anyway, by the celebrity or his licensees, so there is little lost to the public if the right of publicity covers them: “[W]e are concerned not with whether conventional celebrity images should be produced but with who produces them and, more pertinently, who appropriates the value from their production.”⁵⁷

These arguments suggest that limiting the right to nontransformative uses would (1) adequately serve the government interest in protecting a celebrity’s right to profit from “markets for celebrity memorabilia,” while (2) not much burdening speech.⁵⁸

B. *The Uncertainty About What Is “Transformative”*

1. *What Sense of “Transformative” Was the Court Proposing?* It’s not clear, though, that this transformative use test will really work. To begin with, consider three ways that the court itself defines “transformative”:

- (a) “contribut[ing] something more than a ‘merely trivial’ variation, [but creating] something recognizably ‘[the speaker’s] own,’”⁵⁹ a definition borrowed from a case that defined the copyrightability threshold for works derived from public domain works;
- (b) using the celebrity’s likeness as “one of the ‘raw materials’ from which an original work is synthesized,” as opposed to having “the depiction or imitation of the celebrity [be] the very sum and substance of the work in question”;⁶⁰

56. *Id.* at 808.

57. *Id.* at 811; *see also* *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977) (arguing that the right of publicity “intrude[s] on dissemination of information to the public” less than does the false light tort, because “in ‘right of publicity’ cases the only question is who gets to do the publishing”).

58. *See Comedy III*, 21 P.3d at 808 (explaining that parodies and transformative uses generally do not appeal to fans of celebrities, and therefore do not pose a threat to the market for authentic memorabilia).

59. *Id.* at 810 (quoting *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976) (some internal quotation marks omitted)).

60. *Id.* at 809.

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- (c) “add[ing] something new, with a further purpose or different character, altering the first with new expression, meaning, or message,” a definition borrowed from a case that defined when a work became a fair use.⁶¹

The first definition would be much easier to satisfy than the second and the third; the test for copyrightability is quite lax, even for derivative works. A charcoal sketch taken from a public-domain photograph, or a bust made from a public-domain photograph, would surely be independently copyrightable, because both contribute “something more than a ‘merely trivial’ variation,” and create “something recognizably ‘[the artist’s] own.’”⁶²

The third definition would be much harder to satisfy than the first and the second: Even substantial additions aren’t seen as transformative under the fair use doctrine unless they seek to say something new about the original work itself. Verse about O.J. Simpson in the style of *The Cat in the Hat*, for instance, was found to be nontransformative of the Dr. Seuss original, because it didn’t comment on the original.⁶³ And yet the rewriting of the poem certainly “contribut[ed] something more than a ‘merely trivial’ variation,” and likely used the poem just as “one of the ‘raw materials’ from which an original work [was] synthesized.”⁶⁴

Thus, even while defining its test, *Comedy III* used three quite different definitions; and in applying the test, it didn’t do much better. By rejecting Saderup’s claim, the court implicitly rejected definition (a), but the court’s citing (a) favorably, without even noticing that (a) did not work in this very case, shows how unclear the term “transformative” is. And in any event, the question whether (b) or (c) should apply still remains.

2. *Is “Transformative” Too Vague?* Let’s say, though, that the California courts settle on some definition—for instance, that

61. *Id.* at 808 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)).

62. *Id.* at 810; *see, e.g.*, *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 489 (9th Cir. 2000) (“[The] definition of originality is broad: ‘All that is needed to satisfy both the Constitution and the statute is that the ‘author’ contributed something more than a ‘merely trivial’ variation, something recognizably ‘his own.’ Originality in this context means ‘little more than a prohibition of actual copying.’” (some internal quotation marks and citations omitted) (quoting *N. Coast Indus. v. Jason Maxwell, Inc.*, 972 F.2d 1031, 1033 (9th Cir. 1992))).

63. *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1399–1401 (9th Cir. 1997). *See generally* Tyler T. Ochoa, *Dr. Seuss, The Juice and Fair Use: How the Grinch Silenced a Parody*, 45 J. COPYRIGHT SOC’Y USA 546 (1998).

64. *See Comedy III*, 21 P.3d at 809–10 (some internal quotation marks omitted).

a work is protected if “the creative elements predominat[e] in the work,” but not if “the literal and imitative” elements predominate.⁶⁵ How could artists know what is allowed?

The court says that Andy Warhol’s Mao silkscreen was transformative because “[t]hrough distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself.”⁶⁶ In *Saderup*’s charcoal drawing, though, the court could “discern no significant transformative or creative contribution.”⁶⁷

Even assuming the court was right about both these works, how can an artist know how much transformation is necessary? Would Jeffrey Koons’s sculpture of Michael Jackson and Jackson’s chimpanzee Bubbles be transformative enough? (The right of publicity might apply to commercial sales of the original, as well as to commercial sales of copies.⁶⁸) How about Rick Rush’s “The Masters of Augusta,” which shows Tiger Woods in the foreground but with various other figures alongside him, in a sort of collage?⁶⁹

65. See *id.* at 809.

66. *Id.* at 811.

67. *Id.* (classifying *Saderup*’s drawing as a “literal, conventional depiction[] of The Three Stooges so as to exploit their fame”).

68. Though some state right of publicity statutes exempt single-copy works, other definitions focus only on the use being commercial, and not whether it is sold in one copy or many. See, e.g., CAL. CIV. CODE § 3344 (West 1997) (stating that one who “uses another’s name, voice, signature, photograph, or likeness . . . for purposes of advertising or selling or soliciting purposes . . . without such person’s prior consent . . . shall be liable”); RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46, 47 (1995).

69. See *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 938 (6th Cir. 2003). The two-judge majority concluded that Rush’s print was protected by the First Amendment, because it “has substantial transformative elements.” *Id.* Applying *Comedy III*, the court held that

[u]nlike the unadorned, nearly photographic reproduction of the faces of the Three Stooges . . . , Rush’s work does not capitalize solely on a literal depiction of Woods. 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 in that event.

Id. Not so, said the dissent: “[I]t is difficult to discern any appreciable transformative or creative contribution in Defendant’s prints Rush’s [artistic skill] is ‘subordinated to the overall goal of creating literal, conventional depictions of [Tiger Woods] so as to exploit his . . . fame’” *Id.* at 959 (Clay, J., dissenting) (fourth and fifth alterations in original) (quoting *Comedy III*, 21 P.3d at 811). Who’s applying the “transformative use” standard correctly? With such an indeterminate test, it’s hard to tell.

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Jeffrey Koons's *Michael Jackson and Bubbles*



Rick Rush's *The Masters of Augusta*



Gary Saderup's 3 Stooges

An exclusive memorial — "for those who care"
and an opportunity to support the Martin Luther King, Jr. Center for Social Change.

- Handsome bust of Dr. Martin Luther King, Jr. individually molded from an original work of art.
- Each permanent floral arrangement is hand designed, signed and numbered — no two are exactly alike.
- Your choice of four floral color schemes with either gold-tone or silver-tone base.
- A contribution from your order goes to the King Center for Social Change.

In 1964 the world honored Martin Luther King, Jr. with its highest award—the Nobel Peace Prize. Today you can honor Dr. King in your home or office with this lasting memorial. The remarkable likeness captured by sculptor Shirley Jeckerling brings you daily inspiration in a fine work of art, commissioned especially for this memorial.

The hand-made floral arrangement reflects Dr. King's dedication to peace and love. Your family and associates will cherish this elegant creation for years to come. And a donation from your purchase will be sent to the Center which perpetuates Dr. King's dream!

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FREE! An exclusive collector's edition, this memorial volume tells the story of Dr. King's non-violent struggle for freedom through love. Over 50 historical pages and dozens of memorable photographs. Not available anywhere in the world! Yours free with each Memorial.

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☐ A check or money order payable to American Heritage Products is enclosed. Charge to ☐ Master Charge ☐ VISA. Expires _____

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☐ I prefer your Layaway Plan. A down payment of 50% (\$15.25) is enclosed to reserve my Memorial, which will be shipped when the balance is paid.

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☐ If your order is a gift, check here and give us the complete shipping address on a separate sheet.

BONUS GIFT! Order within 15 days and receive a commissioned, signed lithographic illustration of Dr. King — suitable for framing. Guaranteed to become one of your most prized possessions. ORDER TODAY!

MONEY-BACK GUARANTEE: If you are not completely satisfied, return your Memorial to us within ten days for a full refund.

King Memorial AMERICAN HERITAGE PRODUCTS
Post Office Box 7
Franklin, Ohio 45005
Lithographic Illustration
Code KM 1128

American Heritage
PRODUCTS
"The Quality You Want"

Martin Luther King, Jr. bust, as presented in an ad in *Ebony*

Likewise, presumably a T-shirt containing a derogatory comment on a celebrity—say, a picture of O.J. Simpson golfing with the text “Still looking for the real killer”—would be “transformative,” in the sense that it “comment[s] on” the celebrity image and “adds something new, with a further purpose or different character, altering the first with new expression,

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meaning, or message.”⁷⁰ What about a T-shirt containing a picture of O.J. with the text “Not guilty,” or the text “I ♥ O.J.”? Is there enough “new” there, enough “alter[ation]”? How can people know what is allowed and what is forbidden?

The *Winter v. DC Comics* case illustrates this problem.⁷¹ *Winter* should have been an easy case for transformative use: A series of comic books that parodied “the genre of singing Wild West cowboys” included characters that were clearly based on a pair of musicians, the Winter brothers.⁷² The “Autumn brothers” characters shared the Winter brothers’ names and certain physical features, though unlike the real Winter brothers, they were “villainous half-worm half-human characters.”⁷³

This might not be great literature, but it’s closely analogous to fiction writers’ including real characters in their works (such as the famous people whom *Forrest Gump* meets, or Picasso, Einstein, and Elvis in Steve Martin’s play *Picasso at the Lapin Agile*); if anything, the characters here were even more transformed than they were in, say, *Forrest Gump*. Under any of *Comedy III* definitions of “transformative,” the comic book should have qualified.

Nonetheless, the Court of Appeal concluded that there was a jury question as to transformativeness, because “there does not appear to be any parody attributed to appellants, their musical talent, or their works or performances,” and because DC Comics was “trading on [the Winters’] likenesses and reputations to generate interest in the upcoming releases and to garner sales.”⁷⁴ The California Supreme Court recently unanimously reversed this decision;⁷⁵ but the fact that a unanimous Court of Appeal panel made this error suggests the difficulties caused by the indefinite “transformativeness” standard.

The *Comedy III* court dismissed these vagueness concerns by saying that though “the distinction between protected and unprotected expression will sometimes be subtle, it is no more so than other distinctions triers of fact are called on to make in First Amendment jurisprudence,” and cited as an example the “lacks serious literary, artistic, political, or scientific value” prong

70. *Comedy III*, 21 P.3d at 811, 808 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 501 U.S. 569, 579 (1994)).

71. 121 Cal. Rptr. 2d 431 (Ct. App. 2002), *rev’d*, 69 P.3d 473 (Cal. 2003).

72. *Id.* at 432.

73. *Id.* at 432–33.

74. *Id.* at 442.

75. *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003). I should note that I signed on to an amicus brief in the case, which argued on behalf of DC Comics.

of the obscenity test.⁷⁶

This, though, is a curious example. The “serious value” test in obscenity law is constitutionally troublesome, which is why it isn’t used in free speech law across the board. (The Court did not ask about serious value in *Cohen v. California*⁷⁷ and *Hustler Magazine v. Falwell*,⁷⁸ for example.) If obscenity law weren’t limited to sexually themed speech, but generally prohibited speech that was found to be patently offensive and lacking in serious value, the vagueness of the test would deter a huge amount of potentially protected speech. In fact, the Supreme Court has held that even if the three-prong obscenity test is constitutional, each prong might well be too vague if it were applied in the absence of the other prongs.⁷⁹

Moreover, obscenity law has in practice been applied pretty narrowly, especially in the last few decades. Had it been applied more broadly, we might well be more worried about its vagueness, vagueness that led four Justices to reject the obscenity exception in *Miller v. California* itself.⁸⁰ “The transformative use test is no vaguer than one prong of the obscenity test” is thus hardly a great recommendation. And this is especially so if the test is one of the court’s own devising: Even if the Constitution might barely tolerate such a vague restriction, it is still bad policy for courts to create indefinite rules like this. Perhaps a closer analogy would have been not obscenity law, but copyright itself, which does incorporate the “transformative use” analysis in its notoriously vague “fair use” test. But the reasons for tolerating that vagueness seem fairly compelling, and not obviously applicable to right of publicity law.⁸¹ That we live with this vagueness in copyright doesn’t mean that we should extend it elsewhere.⁸²

Finally, note how one exception—the obscenity exception—is being used to justify another, very different one. This is the slippery slope that First Amendment maximalists often complain about, and with good reason. Recognizing new exceptions and new areas of permissible vagueness would legitimize still more in

76. *Comedy III*, 21 P.3d at 811.

77. 403 U.S. 15, 22–23, 26 (1971).

78. 485 U.S. 46, 56 (1988).

79. *Reno v. ACLU*, 521 U.S. 844, 873 (1997).

80. 413 U.S. 15, 47 (1973) (Brennan, J., dissenting); *id.* at 39 (Douglas, J., dissenting).

81. See Volokh, *Freedom of Speech and Intellectual Property*, *supra* note 35, at 713.

82. See generally Diane Leenheer Zimmerman, *The More Things Change the Less They Seem “Transformed”*: *Some Reflections on Fair Use*, 46 J. COPYRIGHT SOC’Y USA 251 (1998) (critiquing the “transformative use” test even in copyright law).

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the future.⁸³ Future courts will be able to say, in defense of vague speech restrictions: “Though the proposed distinction will sometimes be subtle, it is no more so than other distinctions triers of fact are called on to make in First Amendment jurisprudence, such as whether a work has serious value or whether it’s transformative.”

C. What’s So Bad About Nontransformative Uses?

But even setting aside the vagueness objection, why should unlicensed nontransformative uses—such as the prints involved in *Comedy III* itself—be prohibitible? Why should such uses be treated worse than transformative ones, such as Warhol’s “ironic social comment” on Mao?⁸⁴

Comedy III’s answer seems to be that the celebrity would create or license such uses himself, so “we are concerned not with whether conventional celebrity images should be produced but with who produces them and, more pertinently, who appropriates the value from their production.”⁸⁵ There are, however, two First Amendment difficulties with this reasoning.

First, the Constitution protects speakers, including publishers and artists, as well as listeners. You are entitled to write (and sell) your own unauthorized biography of Arnold Schwarzenegger, whether or not there’s already an authorized biography that adequately covers the territory. Why shouldn’t you be equally entitled to sculpt (and sell) your own bust of Martin Luther King, Jr., which expresses your own particular esthetic vision?

Second, even focusing only on what is available to consumers, rather than on the rights of the speakers/producers, not all nontransformative “conventional celebrity images” are mutually interchangeable. I may not want to see a standard print of Elvis hanging on my wall; I may want to see a Gary Saderup charcoal drawing of Elvis, or someone’s impressionist Elvis or pointillist Elvis. Or I may want to see an absurd or subversive Elvis, perhaps not subversive enough to qualify as clearly “transformative” and thus clearly open to others to create,⁸⁶ but

83. See Eugene Volokh, *The Mechanisms of the Slippery Slope*, 116 HARV. L. REV. 1026, 1093–1100 (2003).

84. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001).

85. See *id.*; see also *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (arguing that the right of publicity “intrude[s] on dissemination of information to the public” less than the false light tort, because “in ‘right of publicity’ cases the only question is who gets to do the publishing”).

86. See, e.g., *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403 n.11 (9th Cir. 1997) (finding that a humorous book about the O.J. Simpson trial,

different enough that the Elvis estate might not authorize it.

Protecting celebrities' exclusive rights to control images of themselves may not always affect "whether conventional celebrity images are produced"; but it will affect which conventional celebrity images are produced. And just as "I Strongly Resent the Draft"⁸⁷ or "F*** the Draft" doesn't have quite the same meaning as "Fuck the Draft," many nontransformative unauthorized renderings of a celebrity may not have quite the same meaning as the authorized ones. The right of publicity, even limited to nontransformative uses, thus diminishes the range of artistic expression that people can view, as well as the range that they can create.⁸⁸

I do not want to overstate the problem here. I think artists' rights to create what they want, and consumers' rights to get a wide variety of works, are important—but I can't claim that the Republic will fall because people can't buy busts of Martin Luther King, Jr. or unauthorized prints of the Three Stooges.

Nonetheless, in a legal system built on analogy and precedent, new First Amendment exceptions can have consequences considerably outside their literal scope. The more exceptions there are and the broader they are, the easier it is to argue for the creation of other exceptions in other contexts; and this is especially so if the exceptions are justified by relatively weakly defended claims of government interest, because then future analogies can be based on similarly weak claims of government interest.⁸⁹ The more the courts are allowed to treat some otherwise protected speech as being less valuable than other speech, the more calls there will be for creating new zones of diminished protection.⁹⁰ Perhaps a First Amendment exception

called *The Cat Not in the Hat* and done in the style of Dr. Seuss's *The Cat in the Hat*, didn't qualify as "transformative" under copyright law).

87. The "I Strongly Resent the Draft" hypothetical is Judge Kozinski's. See Int'l Olympic Comm. v. S.F. Arts & Athletics, 789 F.2d 1319, 1321 (9th Cir. 1986) (Kozinski, J., dissenting from the denial of rehearing en banc).

88. Also, in some cases the right of publicity does affect whether even conventional celebrity images are produced. Like other property rights, the right of publicity lets the owner leave his property unexploited. The Martin Luther King, Jr. estate, for instance, did not authorize the production of Martin Luther King memorabilia until 1996, nearly fifteen years after it managed to stop others from producing Martin Luther King, Jr. busts. See Hollis R. Towns, "Tasteful" Marketing of MLK: Heirs Agree to License the Words, Image of Martin Luther King Jr., ATLANTA J.-CONST., Feb. 4, 1996, at G6 ("In a major departure from the past, guardians of the Rev. Martin Luther King Jr.'s legacy have approved the licensing of merchandise that could put King's image and words on products ranging from compact discs to a Hollywood movie.").

89. See Volokh, *The Mechanisms of the Slippery Slope*, supra note 83, at 1093–98 (discussing the slippery slope effect that exceptions to the general rule tend to create).

90. *Id.* at 1059–61 (discussing "censorship envy").

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for “nontransformative” visual art that uses another’s name or likeness ought to exist. But it should be defined narrowly, and justified carefully, with an eye toward preventing such unintended consequences.

V. THE RIGHT OF PUBLICITY, COMMERCIAL ADVERTISING, AND THE ERODING COMMERCIAL SPEECH DOCTRINE

The right of publicity has generally been applied more forcefully to commercial advertising (except commercial advertising for books, movies, and the like, which is category 2 in the table on page 105) than to other material,⁹¹ even when the advertising is unlikely to mislead anyone as to the sponsorship of the product. And this seems like a sensible compromise: Even if using “Here’s Johnny” as a slogan for toilets violates Johnny Carson’s right of publicity,⁹² or using a song sung by a Bette Midler soundalike in a General Motors ad violates Midler’s right,⁹³ using the slogan in a joke or the soundalike in a movie or a song should be protected by the First Amendment. Commercial advertising, after all, is (so the Court has told us) less valuable and more easily restrictable than noncommercial speech.⁹⁴

But is it really? In California, it turns out, “truthful and nonmisleading messages about lawful products and services” are now ostensibly treated as fully protected speech, rather than being governed by the *Central Hudson* intermediate scrutiny test.⁹⁵ The California Supreme Court held this in *Gerawan Farming Inc. v. Lyons*, applying the California Constitution⁹⁶—and it held this just five months before *Comedy III*, in an opinion by Justice Mosk, the same Justice who wrote the *Comedy III* decision.⁹⁷

91. See, e.g., *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1401 n.3 (9th Cir. 2002).

92. See *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 836 (6th Cir. 1983).

93. See *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988).

94. See *White*, 971 F.2d at 1401 n.3; 2 MCCARTHY, *supra* note 34, at 7-3 (“Does the highly attenuated constitutional protection given ‘commercial speech’ ever justify an infringement of the right of publicity? The answer seems to be ‘hardly ever, almost never.’”).

95. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 564 (1980).

96. *Gerawan Farming, Inc. v. Lyons*, 12 P.3d 720, 736–37 (Cal. 2000) (interpreting California’s Free Speech Clause more broadly than the First Amendment).

97. The Oregon Constitution has been interpreted the same way. See *Moser v. Frohnmayer*, 845 P.2d 1284, 1286–87 (Or. 1993); *Zackheim v. Forbes*, 895 P.2d 793, 796 (Or. Ct. App. 1995).

Karen Frederiksen & A.J. Thomas, *Celebrities Testing Limits of Right of Publicity Laws*, 20 No. 2 COMPUTER & INTERNET LAW. 11, 15 (2003), also spotted this

If *Gerawan* does apply to the right of publicity—and nothing in *Gerawan* casts doubt on this⁹⁸—then the scope of the right would have to change quite dramatically. After all, a short film containing, among other things, someone's name or likeness would be protected by the First Amendment; so would Simon & Garfunkel's *Mrs. Robinson*, which prominently refers to Joe DiMaggio; so would a comedian delivering a joke that mentions a famous figure (even if the joke doesn't try to criticize or parody the figure). All three necessarily "add[] something new, with a further purpose or different character, altering the first with new expression, meaning, or message,"⁹⁹ "add[] significant expression beyond" the "literal depiction or imitation of a celebrity for commercial gain,"¹⁰⁰ involve "the creative elements predominat[ing] in the work" rather than "the literal and imitative,"¹⁰¹ and involve the artist "contribut[ing] something more than a 'merely trivial' variation, [but creating] something recognizably 'his own.'"¹⁰²

Under the logic of *Gerawan*, it would therefore follow that analogous commercial advertisements—which would include nearly any thirty-second TV commercial, advertising jingle, or stretch of dialogue—would also be constitutionally protected. Each of those, after all, is just as transformative as its nonadvertising equivalent.

issue; I haven't seen it mentioned anywhere else.

98. *Comedy III*, which came a few months after *Gerawan*, did say in passing that "[b]ecause the First Amendment does not protect false and misleading commercial speech, and because even nonmisleading commercial speech is generally subject to somewhat lesser First Amendment protection, the right of publicity may often trump the right of advertisers to make use of celebrity figures." *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 802 (Cal. 2001) (citations omitted). This, though, is consistent with *Gerawan*, because *Gerawan* acknowledged that the First Amendment provides less protection to nonmisleading commercial speech than it provides to other speech. *Gerawan*, 12 P.3d at 732.

Gerawan expressly rested on the California Free Speech Clause, which the California Supreme Court analyzed separately from the First Amendment. The *Gerawan* court discussed the federal and the state claims in separate sections; specifically held that the law at issue there did not violate the First Amendment, because nonmisleading commercial speech got less First Amendment protection than noncommercial speech; and specifically held that the law might violate the California Free Speech Clause, because that Clause does protect nonmisleading commercial speech as much as noncommercial speech. *Compare* 12 P.3d at 739–46 (discussing the First Amendment), *with* 12 P.3d at 746–50 (discussing the California Free Speech Clause). And *Comedy III* said nothing about the California Free Speech Clause; *Gerawan* continues to express the California law on the California Free Speech Clause issue.

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

100. *Id.*

101. *Id.* at 809.

102. *Id.* at 810 (quoting the test for when a work becomes copyrightable).

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Prints and T-shirts may sometimes depict just a person, because people often want these works precisely to put a conventional depiction on their walls or their chests. Advertisements, though, hardly ever just show a person (unless they're selling that person's work or performances). First, simply showing a famous person's likeness isn't a good way to sell other products. Second, simply showing a famous person's likeness will probably confuse viewers into thinking that the person endorses the product, which would violate false advertising law. That's why the classic commercial advertising right of publicity cases involve ads that contain much more than a person's name, likeness, or voice, and that do indeed add "significant expression beyond" the "literal depiction or imitation of a celebrity," "contribut[ing] something more than a 'merely trivial' variation."¹⁰³

So *Gerawan* has the potential to largely eliminate the right of publicity as to commercial advertising. And if the California courts avoid this by setting the "transformative use" bar high enough to make the typical television ad "nontransformative," then this bar would equally apply to noncommercial speech, and suppress much more such speech than *Comedy III* seemed to suggest.

This, of course, is based on what is now only California (and Oregon¹⁰⁴) constitutional doctrine, and it may be unpersuasive to the courts of other states; and perhaps the California Supreme Court will retreat from *Gerawan*, which was a 4-3 decision. But *Gerawan* might be a taste of what is coming under the U.S. Supreme Court's commercial speech jurisprudence.

To begin with, in the early 1990s, the Court handed down *City of Cincinnati v. Discovery Network, Inc.*, which struck down a ban on newsracks that contained commercial-only newspapers.¹⁰⁵ The city argued that it was proper for the law to apply only to commercial speech, because commercial speech is less valuable than noncommercial speech; but the Court rejected this, saying that:

In the absence of some basis for distinguishing between "newspapers" and "commercial handbills" that is

103. *Id.* at 808, 810. Compare, e.g., the advertisements in *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 2002) (an ad for Samsung that contained a robot posed in a context that intentionally reminded viewers of Vanna White), *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (an ad for cars that had a Bette Midler song on its soundtrack), and *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (an ad for Fritos in which the voiceover sounded like Tom Waits), with *Comedy III*, 21 F.3d at 811 (giving Warhol's silkscreen picture of Mao Tse-Tung as an example of a clearly transformative work).

104. Refer to note 97 *supra*.

105. 507 U.S. 410, 430-33 (1993).

relevant to an interest asserted by the city [in beautifying the streets], we are unwilling to recognize Cincinnati's bare assertion that the "low value" of commercial speech is a sufficient justification for its selective and categorical ban on newsracks dispensing "commercial handbills."¹⁰⁶

Thus, so long as commercial speech and noncommercial speech cause the same sort of harm to the government interest (in *Discovery Network*, both kinds of newsracks were equally ugly), the government may not restrict just the commercial speech on the grounds that commercial speech has less value. The same applies to the right of publicity, at least where the use of a person's name or likeness is not misleading: Both commercial speech and noncommercial speech that uses people's appearance without their consent is equally harmful, both to the subjects' economic interests and their dignity.¹⁰⁷ Different treatment of commercial and noncommercial advertising thus seems as unjustified as the different treatment in *Discovery Network*.

The reasoning of *Discovery Network* is not entirely persuasive—after all, if the Court treats commercial speech as less protected partly because it is less valuable, why not legislatures?—and the doctrine's boundaries are not entirely clear. It is possible, for instance, that the decision is limited to situations where the commercial speech is responsible for only a small fraction of the harm to the government interest, and the right of publicity might not be such a situation.¹⁰⁸ One can also argue that using someone's name in advertising (even nonmisleading advertising) is somehow more offensive or injurious than using his name in nonadvertising contexts, though that strikes me as a fairly conclusory assertion. It is hard to tell just how the Court will receive these arguments.

But even if a right of publicity that treats commercial advertising worse than other uses can survive *Discovery Network*, it may be up against an even more serious barrier: As Part IV discusses, the Court seems to be providing more and more protection to commercial advertising, perhaps approaching something like the *Gerawan* test. Justice Stevens, the author of *Discovery Network*, has long argued for rather broad commercial speech protection;¹⁰⁹ Justice Thomas has been hinting at that as

106. *Id.* at 428.

107. Such uses in commercial advertising may be especially harmful when they falsely suggest sponsorship, but the right of publicity covers nonconfusing uses as much as it covers confusing ones.

108. *Id.* at 426–27.

109. See, e.g., *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 491–98 (1995) (Stevens, J., concurring in the judgment) (recognizing the artificiality of any rigid distinction between

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well;¹¹⁰ and a four-Justice plurality in *44 Liquormart* seemed to be turning in this direction.¹¹¹

As I have argued elsewhere,¹¹² this broader protection need not apply to all restrictions: The Court could continue to stress simply the informational function of commercial advertising, and conclude that the government may not restrict the facts and ideas that commercial advertising communicates, but that it may restrict the way in which those ideas are presented, including the words and images that advertisements may use. Nonetheless, it isn't clear that the Court will take that view, especially given the difficulties of deciding when a restriction on words and images becomes in effect a restriction on facts and ideas.¹¹³

As a critic of the right of publicity, I wouldn't mind seeing the right of publicity eviscerated this way, even as to commercial advertising. But I am not sure that the Justices (either U.S. Supreme Court or California Supreme Court) would agree, even if they otherwise support broad protection for commercial advertising. If that's so, then perhaps the right of publicity might become a good example of why commercial speech and noncommercial speech should be treated differently, at least in some situations.

VI. CONCLUSION

The right of publicity may seem intuitively appealing to many people. The notion that my name and likeness are my property seems to make sense.

But, when applied to expression, "my property" is another way of saying "legally forbidden to be another's speech." Right of publicity law has long had to confront the First Amendment problems with such an approach, and in many areas, such as

commercial and noncommercial speech); *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 80–83 (1983) (Stevens, J., concurring in the judgment) (warning that a rigid classification between commercial and noncommercial speech may lead to the inadvertent suppression of constitutionally protected speech because speech often contains both commercial and noncommercial speech).

110. See, e.g., *Greater New Orleans Broad. Ass'n, Inc. v. United States*, 527 U.S. 173, 197 (1999) (Thomas, J., concurring in the judgment) (rejecting the government's interest as no more justifying a restriction on commercial speech than it would justify a restriction on noncommercial speech); *44 Liquormart v. Rhode Island*, 517 U.S. 484, 518–23 (1996) (Thomas, J., concurring in part and concurring in the judgment) ("I do not see a philosophical or historical basis for asserting that 'commercial' speech is of 'lower value' than 'noncommercial' speech.").

111. 517 U.S. at 501, 508–10 (criticizing the Court's 5-4 decision in *Posadas de Puerto Rico Associates v. Tourism Co. of Puerto Rico*, 478 U.S. 328 (1986), which allowed the legislature to choose to suppress gambling advertising rather than enact a less speech-restrictive policy).

112. See Volokh, *The Mechanisms of the Slippery Slope*, *supra* note 83, at 732–39.

113. Cf. *Cohen v. California*, 403 U.S. 15, 26 (1971).

biography, news reporting, fiction, and the like, it has rightly yielded. But there is good reason to think that it hasn't yielded far enough—that the right of publicity is unconstitutional as to all noncommercial speech, and perhaps even as to commercial advertising as well.