

**Constitutional Law****Freedom of Speech**

The Ninth Circuit's new rule granting videogames more limited protection than other expressive works is a dangerous precedent, the authors assert. The *Keller* majority said that realistically depicting college athletes in videogames showing them playing football is not sufficiently transformative to avoid liability for using their likenesses. But the authors, siding with the dissent, argue that the holding puts the ability to produce realistic but unauthorized expressive works based on historical events and people at risk.

**Ninth Circuit Fumbles the Ball in Videogame Likeness Cases**

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**C**reating a new rule that gives videogames much more limited protection than other expressive works, the Ninth Circuit has ruled that realistically depicting college athletes in videogames showing them

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doing what they became famous for doing—in this case, playing football—is not sufficiently transformative to avoid liability for using their likenesses.

On July 31, 2013, the Ninth Circuit in *In re NCAA Student-Athlete Name & Likeness Licensing Litigation (Keller)*<sup>1</sup> held that Keller, a former college athlete prohibited by NCAA rules from commercializing his name and likeness rights, could pursue a right of publicity claim based on the use of his likeness in a football videogame—a work admittedly protected by the First Amendment—despite the game producer's assertion of First Amendment defenses. This decision, following on the heels of the Third Circuit's May 21, 2013 opinion in *Hart v. Electronic Arts, Inc.*,<sup>2</sup> heavily relied on by the *Keller* decision, sets a dangerous precedent.

As the *Keller* dissent points out, the Ninth Circuit now puts the ability to produce realistic but unauthorized expressive works based on historical events and people at risk. Moreover, it sets up a strange set of cir-

<sup>1</sup> *In re NCAA Student-Athlete Name & Likeness Licensing Litigation (Keller)*, 2013 BL 203083, 82 U.S.L.W. 164 (9th Cir. July 31, 2013).

<sup>2</sup> *Hart v. Electronic Arts, Inc.*, 717 F.3d 141, 81 U.S.L.W. 1689 (3rd Cir. 2013).

cumstances where an expressive work could be considered protected speech for purposes of a Lanham Act false endorsement claim, but not for a right of publicity claim, even though the two claims are highly similar, a fact that the Ninth Circuit itself acknowledged in its 1992 decision in *Waits v. Frito-Lay, Inc.*<sup>3</sup>

This article assesses the impact of the Ninth Circuit's rejection in *Keller* of the transformative use and *Rogers v. Grimaldi*<sup>4</sup> First Amendment defenses. With respect to the transformative use defense, this article argues that the majority opinion erred in rejecting its application to the facts in *Keller*, and that the dissent's analysis of the defense is more in line with First Amendment protections for expressive works. As to the *Rogers* defense, this article argues that both the majority and dissenting opinions too quickly dismiss its applicability altogether to right of publicity claims, and that application of the *Rogers* test or a similar defense is necessary to protect First Amendment rights.

## 1. Keller Case

Samuel Keller ("Keller"), a former college football quarterback for Arizona State and Nebraska, sued Electronic Arts ("EA") for right of publicity violations arising from the use of his likeness in its *NCAA Football* videogame series.

*NCAA Football* is a highly realistic football videogame that tries to portray each college football team as accurately as possible. It does not automatically include players' names on their jerseys, but players may, using third-party sources, include names on the back of the players' jerseys. Apart from that, the game matches everything it can about the athletes portrayed—from their physiques down to any "highly identifiable playing behaviors." It similarly attempts to recreate the stadiums in which college games are played, including the coaches, cheerleaders, and even fans.<sup>5</sup>

Videogame players also have the ability to alter the players' physical appearances, abilities, and characteristics "at will," along with the structure of the game. As the dissent explains, an athlete's "impressive physical likeness can be morphed by the gamer into an overweight and slow virtual athlete, with anemic passing ability. And the gamer can create new virtual players out of whole cloth. Players can change teams." Players can similarly control "not only the conduct of the game,

<sup>3</sup> *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992). See also *Hart*, 717 F.3d at 155 ("[A] Lanham Act false endorsement claim is the federal equivalent of the right of publicity," taken from the Tiger Woods right of publicity case, *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003)).

<sup>4</sup> *Rogers v. Grimaldi*, 875 F.2d 994 (2nd Cir. 1989), adopted by the Ninth Circuit in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

<sup>5</sup> *Keller*, at \*1.

but the weather, crowd noise, mascots, and other environmental factors."<sup>6</sup>

Keller complained that the 2005 and 2008 versions of *NCAA Football* contained an avatar of him playing quarterback for Arizona State and Nebraska, respectively.<sup>7</sup> EA filed an anti-SLAPP special motion to strike, which the district court denied. The Ninth Circuit affirmed, rejecting EA's transformative use and *Rogers* defenses.

## 2. Transformative Use Defense

As the majority recognized, the transformative use defense is "a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation."<sup>8</sup> Note, for purposes of analyzing the impact of the Ninth Circuit's decision, further discussed below, that the court then essentially ignored that statement of the defense by foregoing an analysis of the overall work (i.e., the *NCAA Football* videogame), instead limiting its review to the treatment of a single celebrity likeness (i.e., Keller) in that work. That very restricted focus now leads to a rule that gives videogames much more restricted First Amendment protection than other expressive works, or is precedent for a more restrictive protection for over expressive works.

In determining whether the transformative use test applies, the Ninth Circuit itself noted that courts often consider five factors:

- whether the depiction of a celebrity is a "raw material" used in a larger expressive work, or whether the depiction of the celebrity "is the very sum and substance of the work";
- whether the work in question is "primarily the defendant's own expression," i.e., whether the primary motivation for a purchaser of the work is to buy the defendant's expressive content or a mere reproduction of the celebrity;
- "whether the literal and imitative or the creative elements predominate in the work";
- whether "the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted"; and

- whether "an artist's skill and talent is manifestly subordinated to the overall goal of creating a conven-

<sup>6</sup> *Keller*, at \*16.

<sup>7</sup> *Keller*, at \*3.

<sup>8</sup> *Keller*, at \*4 (emphasis added) (quoting *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 391 (2001)).

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tional portrait of a celebrity so as to commercially exploit his or her fame.”<sup>9</sup>

But the majority focused almost exclusively on the third factor listed above—the realistic depiction of Keller, who is just one of many players in the game—ignoring the other considerations. Based exclusively on the realistic nature of the videogame, it held that the transformative use defense could not apply.

The dissent, by contrast, holistically focused on *NCAA Football* as an entire expressive work, and criticized the majority for focusing exclusively on Keller’s relatively limited appearance in the game. The dissent would have held that the transformative use defense applies, and indeed recognized the danger of not applying it: namely, the risk that works accurately portraying historical events would fall outside the scope of the transformative use defense, jeopardizing the ability to make works of historical fiction and documentaries, among others. The dissent likely has it right.

### a. Majority Rejects Transformative Use

In rejecting the transformative use defense, the majority noted relevant precedent—*Comedy III* (the use of a realistic charcoal drawing of The Three Stooges on t-shirts and lithographs was not transformative because the drawing contained no significant transformative elements), *Winter v. DC Comics* (the depiction of famous rockers Johnny and Edgar Winter in a comic book as half-worm, half-human creatures was transformative because it contained significant expressive content beyond mere likenesses of the brothers),<sup>10</sup> *Kirby v. Sega of America, Inc.* (the depiction in a videogame of “Ulala,” a reporter from outer space allegedly based on singer Kierin Kirby was transformative because Kirby was not literally depicted and the avatar was presented in the context of elements beyond what she did in her career),<sup>11</sup> *Hilton v. Hallmark Cards* (the depiction of celebute Paris Hilton on a greeting card was not transformative because it fell far short of the kind of expressive content contained in a videogame such as that in the *Kirby* case),<sup>12</sup> and *No Doubt v. Activision Publishing, Inc.*, (discussed further below)<sup>13</sup>—and determined that the use of Keller’s likeness in the football game was not transformative.<sup>14</sup>

In so holding, the court did not appear to consider the five factors it had earlier laid out, particularly whether the primary motivation for a purchaser of the game is the “reproduction” of Keller’s likeness or whether its value derives primarily from Keller’s fame.

Instead, the court relied heavily on a California Court of Appeal’s decision in *No Doubt*. That case involved the videogame *Band Hero*, where “users simulate performing in a rock band in time with popular songs. Users choose from a number of avatars, some of which

represent actual rock stars, including the members of the rock band No Doubt.”<sup>15</sup>

The California Court of Appeal held in *No Doubt* that the transformative use defense did not apply because “the video game characters were ‘literal recreations of the band members,’ doing ‘the same activity by which the band achieved and maintains its fame.’”<sup>16</sup> The Ninth Circuit then applied the case to the *NCAA Football* game as follows:

The facts of *No Doubt* are very similar to those here. EA is alleged to have replicated Keller’s physical characteristics in *NCAA Football*, just as the members of No Doubt are realistically portrayed in *Band Hero*. Here, as in *Band Hero*, users manipulate the characters in the performance of the same activity for which they are known in real life—playing football in this case, and performing in a rock band in *Band Hero*. The context in which the activity occurs is also similarly realistic—real venues in *Band Hero* and realistic depictions of actual football stadiums in *NCAA Football*. As the district court found, Keller is represented as “what he was: the starting quarterback for Arizona State” and Nebraska, and “the game’s setting is identical to where the public found [Keller] during his collegiate career: on the football field.”<sup>17</sup>

In other words, the Ninth Circuit rejected the transformative use defense because *NCAA Football* presented videogame players with a realistic college football experience.

The court rejected EA’s argument that “the district court erred in focusing primarily on Keller’s likeness and ignoring the transformative elements of the game as a whole”—a point advocated by the dissent and discussed in more detail below—again based on *No Doubt*, which the majority quoted for the proposition that the fact “that the avatars appear in the context of a videogame that contains many other creative elements[] does not transform the avatars into anything other than exact depictions of No Doubt’s members doing exactly what they do as celebrities.”<sup>18</sup> The Ninth Circuit discounted the fact that the avatars in *NCAA Football*, unlike those in *Band Hero*, could be altered because “[t]hough *No Doubt* certainly mentioned the immutability of the avatars, we do not read the California Court of Appeal’s decision as turning on the inability of users to alter the avatars. The key contrast with *Winter* and *Kirby* was that in those games [sic] the public figures were transformed into ‘fanciful, creative characters’ or ‘portrayed as . . . entirely new character[s].’”<sup>19</sup>

### b. Transformative Use Defense Should Apply

The dissent diverged from the majority because it viewed the *NCAA Football* game as a whole, instead of focusing only on the treatment of Keller’s image therein as did the majority. As the dissent explains, the “salient question is whether the entire work is transformative, and whether the transformative elements predominate, rather than whether an individual persona or image has been altered.” In *Keller* the dissent would ask whether

<sup>9</sup> *Keller* at \*5 (quoting from *Comedy III*, 25 Cal. 4th at 406-08).

<sup>10</sup> *Winter v. DC Comics*, 30 Cal. 4th 881 (2003).

<sup>11</sup> *Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47 (2006).

<sup>12</sup> *Hilton v. Hallmark Cards*, 599 F.3d 894 (9th Cir. 2009).

<sup>13</sup> *No Doubt v. Activision Publishing, Inc.*, 192 Cal. App. 4th 1018 (2011).

<sup>14</sup> *Keller*, at \*7.

<sup>15</sup> *Keller*, at \*6.

<sup>16</sup> *Keller*, at \*6 (quoting *No Doubt*, 192 Cal. App. 4th at 1034).

<sup>17</sup> *Keller*, at \*7.

<sup>18</sup> *Keller*, at \*6 (quoting *No Doubt*, 192 Cal. App. 4th at 1034).

<sup>19</sup> *Keller*, at \*8 (quoting *No Doubt*, 192 Cal. App. 4th at 1033-34).

“[a]t its essence, EA’s *NCAA Football* is a work of interactive historical fiction.”<sup>20</sup>

Although it cautioned against treating the five factors listed but not applied in the majority opinion as “analytical factors,” the dissent applied each as follows:

The athletic likenesses are but one of the raw materials from which the broader game is constructed. [Factor 1] The work, considered as a whole, is primarily one of EA’s own expression. [Factor 2] The creative and transformative elements predominate over the commercial use of likenesses. [Factor 3] The marketability and economic value of the game comes from the creative elements within, not from the pure commercial exploitation of a celebrity image. [Factor 4] The game is not a conventional portrait of a celebrity, but a work consisting of many creative and transformative elements. [Factor 5]<sup>21</sup>

The dissent distinguished *No Doubt* on the ground that “[t]he literal representations in *No Doubt* were not, and could not be, transformed in any way,” and criticized the majority for misreading *No Doubt*: “The majority places great reliance on *No Doubt* as support for its proposition that the initial placement of realistic avatars in the game overcomes the First Amendment’s protection, but the Court of Appeal in *No Doubt* rejected such a cramped construction, noting that ‘even literal reproductions of celebrities may be “transformed” into expressive works based on the context into which the celebrity image is placed.’”<sup>22</sup>

The dissent’s attempt to distinguish *No Doubt* may have fallen flat because almost immediately after recognizing that even literal depictions of celebrities may be transformed into expressive works based on the context into which the images are placed, the *No Doubt* court held that the use of the likenesses of members of the band *No Doubt* was not transformative because,

In *Band Hero*, by contrast, no matter what else occurs in the game during the depiction of the *No Doubt* avatars, the avatars perform rock songs, the same activity by which the band achieved and maintains its fame. Moreover, the avatars perform those songs as literal recreations of the band members. That the avatars can be manipulated to perform at fanciful venues including outer space or to sing songs the real band would object to singing, or that the avatars appear in the context of a video game that contains many other creative elements, does not transform the avatars into anything other than exact depictions of *No Doubt*’s members doing exactly what they do as celebrities.<sup>23</sup>

The better way to distinguish *No Doubt* may be to follow the lead of the dissenting opinion in *Hart* and to acknowledge that the California Court of Appeal’s *No Doubt* decision (1) is not binding on the Ninth Circuit, and (2) was likely wrongly decided.<sup>24</sup>

Finally, the dissent pointed out the danger in the majority’s failure to apply the transformative use test:

The stakes are not small. The logical consequence of the majority view is that all realistic depictions of actual persons, no matter how incidental, are protected by a state law

right of publicity regardless of the creative context. This logic jeopardizes the creative use of historic figures in motion pictures, books, and sound recordings. Absent the use of actual footage, the motion picture *Forrest Gump* might as well be just a box of chocolates. Without its historical characters, *Midnight in Paris* would be reduced to a pedestrian domestic squabble. The majority’s holding that creative use of realistic images and personas does not satisfy the transformative use test cannot be reconciled with the many cases affording such works First Amendment protection.<sup>25</sup>

This is a real risk that the majority all but writes off in a footnote: “We reject the notion that our holding has such broad consequences. As discussed above, one of the factors identified in *Comedy III* ‘requires an examination of whether a likely purchaser’s primary motivation is to buy a reproduction of the celebrity, or to buy the expressive work of that artist.’”<sup>26</sup>

As noted above, however, the majority does not appear to have analyzed that factor, but rather follows *No Doubt*. Moreover, if it had analyzed the factor, it is difficult to imagine that a consumer would buy the *NCAA Football* game merely to obtain a reproduction of *Keller* himself, as opposed to the expressive work, *i.e.*, a videogame enabling the player to immerse him or herself in a college football game.

As additional examples, consider the films *Malcolm X*, *The Perfect Storm*, *Zero Dark Thirty*, *The Bling Ring* or *Argo*, all of which are based on realistic depictions of historical events. The majority’s opinion would permit individuals depicted in these or similar films to sue for violation of the right of publicity—which would have an undeniable chilling effect on speech.

It is hard to imagine that the majority would have reached the same result had it been presented with a historical film or other expressive work about *Keller*’s performance as a college athlete instead of a videogame of that activity in light of a long line of cases protecting unauthorized but truthful biographies and similar works in the face of right of publicity claims. *See, e.g.*, *Frosch v. Grosset & Dunlap, Inc.* (Marilyn Monroe’s right of publicity claims concerning Norman Mailer’s book about her);<sup>27</sup> *Loft v. Fuller* (the use of the name and likeness of the deceased captain of a flight that crashed into the Everglades in a non-fiction book and subsequent film entitled *The Ghost of Flight 401*);<sup>28</sup> *Rosemont Enterprises, Inc. v. Random House, Inc.* (Howard Hughes’ publicity rights asserted against defendant publishers creating their own, unauthorized biography of Hughes);<sup>29</sup> *Ruffin-Steinback v. De Passe* (right of publicity claims by a member of The Temptations over his depiction in an NBC docudrama);<sup>30</sup> *Seale v. Gramercy Pictures* (publicity claims of Bobby Seale, a founder of the Black Panther Party, over his portrayal in a film);<sup>31</sup> *Tyne v. Time Warner Entertainment Company, LP* (right of publicity claims asserted by the family of deceased captain of a fishing boat that vanished

<sup>20</sup> *Keller*, at \*15.

<sup>21</sup> *Keller*, at \*16.

<sup>22</sup> *Keller*, at \*17 (quoting *No Doubt*, 192 Cal. App. 4th at 1033). *See also No Doubt*, at 1034 (“[W]hen the context into which a literal celebrity depiction is placed creates ‘something new, with a further purpose or different character, altering the first [likeness] with new expression, meaning, or message,’ the depiction is protected by the First Amendment.”).

<sup>23</sup> *No Doubt*, 192 Cal. App. 4th at 1034.

<sup>24</sup> *Keller*, at \*9 (quoting *Hart*, 717 F.3d at 176).

<sup>25</sup> *Keller*, at \*\*19-20.

<sup>26</sup> *Keller*, at \*9 n. 10.

<sup>27</sup> *Frosch v. Grosset & Dunlap, Inc.*, 427 N.Y.S.2d 828 (N.Y. App. Div. 1980).

<sup>28</sup> *Loft v. Fuller*, 408 So. 2d 619 (Fla. Dist. Ct. App. 1981).

<sup>29</sup> *Rosemont Enterprises, Inc. v. Random House, Inc.*, 58 Misc. 2d 1, 294 N.Y.S.2d 122 (N.Y. Sup. Ct. 1968).

<sup>30</sup> *Ruffin-Steinback v. De Passe*, 82 F. Supp. 2d 723 (E.D. Mich. 2000).

<sup>31</sup> *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996).

with the death of all on board dramatized in the film *The Perfect Storm*).<sup>32</sup>

At best, the *Keller* majority appears to have ignored its own precedent and decided to deem videogames less worthy of First Amendment protection than other expressive works; at worst, it has endangered First Amendment protection for all expressive works that try to depict historical events.

### 3. Rogers Defense

In *Rogers v. Grimaldi*, the Second Circuit, based on First Amendment protection of freedom of speech, held that Ginger Rogers could not assert a false endorsement claim over the film title *Ginger and Fred* unless (1) the use of her name has “no artistic relevance” to the film, or (2) even if it has some artistic relevance to the film, the film nevertheless “explicitly misleads as to [its] source or the content.”<sup>33</sup>

In *Keller*, EA argued that the *Rogers* test should apply to right of publicity claims, a proposition flatly rejected by both the majority and dissenting opinions because the Lanham Act protects against consumer confusion, whereas the right of publicity purportedly only protects the right of a celebrity to control the use of his or her image.

*Rogers*, according to *Keller*, is specifically tailored to protect the Lanham Act’s interest in protecting against consumer confusion. Neither the majority opinion nor the dissenting opinion acknowledges, however, that *Rogers* itself dealt with a claim for false endorsement, which, under Ninth Circuit precedent, protects rights remarkably similar to the property-like rights protected by the right of publicity. Thus, the purported distinction between Lanham Act claims and right of publicity claims is an artifice, and the *Rogers* test should apply to right of publicity claims.

#### a. Ninth Circuit Rejects Rogers Defense

The Ninth Circuit rejected EA’s argument that *Rogers* should apply because:

As the history and development of the *Rogers* test makes clear, it was designed to protect consumers from the risk of consumer confusion—the hallmark element of a Lanham Act claim. The right of publicity, on the other hand, does not primarily seek to prevent consumer confusion. Rather, it primarily “protects a form of intellectual property [in one’s person] that society deems to have some social utility.”<sup>34</sup>

In other words:

The right of publicity protects the *celebrity*, not the *consumer*. Keller’s publicity claim is not founded on an allegation that consumers are being illegally misled into believing that he is endorsing EA or its products . . . Instead, Keller’s claim is that EA has appropriated, without permission and without providing compensation, his talent and years of hard work on the football field. The reasoning of the *Rogers* and *Mattel* courts—that artistic and literary works should be protected unless they explicitly mislead

consumers—is simply not responsive to Keller’s asserted interests here.<sup>35</sup>

The dissenting opinion reached a similar conclusion.<sup>36</sup>

#### b. Rogers-Like Test Is Necessary

Both the majority and dissenting opinions found *Rogers* inapplicable to right of publicity claims because Lanham Act claims, where *Rogers* still applies, are primarily concerned with consumer confusion, whereas right of publicity claims involve a property right in oneself.<sup>37</sup> Both opinions, however, all but ignore that *Rogers* was not a traditional trademark infringement case, but rather a false endorsement case.

As the Ninth Circuit itself has recognized, there is more to a false endorsement claim than consumer confusion. As it explained in *Waits v. Frito-Lay, Inc.*,<sup>38</sup> a false endorsement case, the injury protected against is not just consumer confusion, but also the right of the celebrity to control the use of his or her image.<sup>39</sup>

In *Waits*, the defendants argued that singer Tom Waits, who notoriously refused to do endorsements, did not have standing to bring a Lanham Act claim because he did not compete with the defendants. The Ninth Circuit rejected that argument because the alleged false endorser “is in a sense a competitor of the celebrity, even when the celebrity has chosen to disassociate himself or herself from advertising products as has Waits. They compete with respect to the use of the celebrity’s name or identity. *They are both utilizing or marketing that personal property for commercial purposes.*”<sup>40</sup> Moreover, the court explained that standing is “established by the likelihood that the wrongful use of [Waits’] professional trademark, his unique voice, would injure him commercially.”<sup>41</sup>

In this sense, a false endorsement claim then is remarkably similar to a claim for violation of the right of publicity—in fact, it appears that one must essentially assert a right of publicity claim to establish standing under the Lanham Act. The same broad protections that apply to Lanham Act false endorsement claims thus should also apply to right of publicity claims.

The Third Circuit in *Hart* also declined to apply the *Rogers* test. It argued that such a broad rule that would bar a publicity claim any time the use of a likeness can be related to the underlying work would lead to the most exploitative products—those “appropriating and exploiting [a player’s] identity” and “targeted at the sports-fan market segment”—faring best under a First Amendment defense and thereby incentivize infringers to exploit an athlete’s publicity rights.<sup>42</sup>

*Hart* ignores a critical point. Videogames are not merely “products” like can openers or baseballs. They

<sup>35</sup> *Id.* (emphasis in original).

<sup>36</sup> *Id.* at \*20.

<sup>37</sup> *Keller*, at \*11 and \*15 n. 1 (dissent).

<sup>38</sup> *Waits*, 978 F.2d at 1110.

<sup>39</sup> See also *Hart*, 717 F.3d at 151 (“[T]he goal of maintaining a right of publicity is to protect the property interest that an individual gains and enjoys in his identity through his labor and effort. Additionally, *as with protections for intellectual property*, the right of publicity is designed to encourage further development of this property interest.” (emphasis added)).

<sup>40</sup> *Waits*, 978 F.2d at 1110 (emphasis added).

<sup>41</sup> *Id.*

<sup>42</sup> *Hart*, 717 F.3d at 155-58.

<sup>32</sup> *Tyne v. Time Warner Entertainment Company, LP*, 425 F.3d 1363 (11th Cir. 2005).

<sup>33</sup> *Rogers*, 875 F.2d at 998-99.

<sup>34</sup> *Keller*, at \*11.

are expressive works protected by the First Amendment, as the Third Circuit itself recognized.<sup>43</sup> Thus, the *Rogers* test would apply *only* where “product” at issue is itself protected First Amendment expression, which arguably would not immunize the many “product” or merchandizing uses that gave rise to the Third Circuit’s concerns.

It makes little sense for the same work to be protected by the First Amendment for purposes of a federal claim, but not for purposes of a state law that aims to protect similar rights.

This potential for conflict is borne out in the companion case to *Keller*, *Brown v. Electronic Arts, Inc.*,<sup>44</sup> issued on the same day by the same panel. In *Brown*, former famous professional NFL football player Jim Brown sued EA under Section 43(a) the Lanham Act, and asserted state law claims law for right of publicity violations and unlawful business practices based on EA’s use of his likeness in EA’s *Madden NFL* videogame series.<sup>45</sup> The district court applied the *Rogers* test and dismissed Brown’s Lanham Act claim. It then declined to exercise supplemental jurisdiction over his parallel state law claims.<sup>46</sup>

On appeal, the Ninth Circuit affirmed the dismissal of the Lanham Act claim, which is not surprising given its precedent in *Mattel, Inc. v. MCA Records, Inc.*<sup>47</sup> and *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*,<sup>48</sup> which broadly applied the *Rogers* test to Lanham Act claims. Citing *Keller*, the Ninth Circuit in *Brown*, however, then stated, “We emphasize that this appeal relates only to Brown’s Lanham Act claim. Were the

state causes of action [e.g., Brown’s right of publicity claims] before us, our analysis may be different and a different outcome may obtain.”<sup>49</sup> This statement starkly illustrates that there is indeed no doctrinal consistency in the Ninth Circuit’s position. The Ninth Circuit would permit a right of publicity claim to go forward in the face of a First Amendment defense, even though it would not permit the analogue Lanham Act false advertising claim to proceed based on the same First Amendment concerns.

The *Rogers* test is preferable to the transformative use test because it is simple and straightforward to apply. Either the use of a celebrity’s identity has minimal relation to the underlying expressive work, or it does not. Either the use of a celebrity is explicitly misleading as to source or content, or it is not.

While the dissent in *Keller* contends that “the transformative use test—if correctly applied to the work as a whole—provides the proper analytical framework,” it also acknowledges that the transformative use test is “more nuanced,” i.e., more difficult, to apply.<sup>50</sup> Given the importance of the expressive rights at stake, the simpler *Rogers* test is warranted to avoid a patchwork of decisions, where some expressive uses are protected, others are not, and it is nearly impossible to predict into which category a work will fall.

Finally, the need for the broad and easily applied *Rogers* test is even more apparent when one considers the rights at stake. The Lanham Act, as described in *Keller*, protects the right of consumers—millions of people—to be free from misleading information. The right of publicity, by contrast, “protects the *celebrity*, not the *consumer*.”<sup>51</sup> It makes little sense that a broad right of the population at large would cede to the First Amendment, but a right that is admittedly available to a select and elite few would not.

<sup>43</sup> *Id.* at 148.

<sup>44</sup> *Brown v. Electronic Arts, Inc.*, 2013 BL 203099, 82 U.S.L.W. 164 (9th Cir. July 31, 2013).

<sup>45</sup> See *Brown v. Electronic Arts, Inc.*, 2009 BL 289614, at \*3 (C.D. Cal. 2009).

<sup>46</sup> *Id.* at \*2.

<sup>47</sup> *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002).

<sup>48</sup> *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008).

<sup>49</sup> *Brown*, at \*3 n. 2.

<sup>50</sup> *Keller*, at \*15 n. 1 (dissent).

<sup>51</sup> *Keller*, at \*11 (emphasis in original).