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# THE RIGHT-OF-PUBLICITY CHALLENGES FOR TATTOO COPYRIGHTS

Yolanda M. King\*

*This Article is the third and final piece of a series of articles that examine the applicability of intellectual property law to tattoos. The second article in the series, The Enforcement Challenges for Tattoo Copyrights, concluded that copyright owners can and should enforce their rights against users outside of the tattoo artist-customer relationship. This Article explores a different source of intellectual property protection for tattoos: the right of publicity. As tattooing has become increasingly prevalent among celebrities, tattoos have become “one” with the persona of the tattoo bearer. A tattoo that carries the meaning of a celebrity tattoo bearer serves as indicia of that celebrity’s identity. The Article proposes that when a tattoo becomes associated with the meaning of a celebrity’s identity, rather than solely retaining the message of the tattoo itself, the tattoo moves beyond mere protection under copyright law and acquires additional protections under the right-of-publicity laws. This transformation of intellectual property rights is the subject of the Article.*

*Right-of-publicity laws exist in more than thirty of the states in the United States, in common law, by statute, or both.<sup>1</sup> Therefore, assuming a state recognizes the right of publicity, and even if a celebrity (1) owns the identity at issue (validity) and (2) shows unauthorized third-party use of the identity in a way that is harmful to the commercial value of the identity (infringement),<sup>2</sup> the claim may conflict with First Amendment interests. This Article also considers the various*

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<sup>1</sup> J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 6:3 (Thomson Reuters 2015).

<sup>2</sup> See *Prima v. Darden Rests., Inc.*, 78 F. Supp. 2d 337, 349 (D.N.J. 2000) (“To allege a prima facie case for infringement of the right of publicity, the plaintiff must show both validity and infringement.”).

*tests employed by courts to accommodate the conflicting interests of the First Amendment and the right of publicity. The Article endorses the Predominant Use test, which properly recognizes the prevalence of mixed commercial and expressive uses for tattoos.*

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#### INTRODUCTION

*I am a canvas of my experiences, my story is etched in lines and shading, and you can read it on arms, my legs, my shoulders, and my stomach.*

—*Kat Von D, tattoo artist and television personality*<sup>3</sup>

Michael Gerard “Mike” Tyson is known for boxing.<sup>4</sup> He is one of the most famous heavyweight boxing champions, but he has also transitioned from a career in sports to a career in entertainment. Tyson is also well-known for the tattoo on the left side of his face, which he received during his boxing career in 2003.<sup>5</sup> The Maori-style tattoo has been described as “instantly recognizable”<sup>6</sup>

<sup>3</sup> *Quotes About Tattoos*, GOODREADS, <https://www.goodreads.com/quotes/tag/tattoos> [<https://perma.cc/8NHV-2GM8>] (last visited Feb. 18, 2015).

<sup>4</sup> See Ira Berkow, *Sports of the Times; He Rules the Planet*, N.Y. TIMES (June 28, 1988), <http://www.nytimes.com/1988/06/28/sports/sports-of-the-times-he-rules-the-planet.html> [<https://perma.cc/ZQ7S-GHPZ>]; Mike Tyson, IMDB, <http://www.imdb.com/name/nm0005512/> [<https://perma.cc/PWK9-JJW7>] (last visited Feb. 18, 2015).

<sup>5</sup> See Ray Glier, *With Luster Faded, Tyson Places Career on the Line Tonight*, N.Y. TIMES (Feb. 22, 2003), <http://www.nytimes.com/2003/02/22/sports/boxing-with-luster-faded-tyson-places-career-on-the-line-tonight.html> [<https://perma.cc/7ZV5-KR2S>]; David Whitley, *Tyson Tattoos Himself Instead of Opponents*, ORLANDO SENTINEL (Feb. 19, 2003), [http://articles.orlandosentinel.com/2003-02-19/sports/0302190202\\_1\\_tyson-tattoo-incredible-ink](http://articles.orlandosentinel.com/2003-02-19/sports/0302190202_1_tyson-tattoo-incredible-ink) [<https://perma.cc/6P3F-CKR5>].

<sup>6</sup> Noam Cohen, *On Tyson’s Face, It’s Art. On Film, a Legal Issue.*, N.Y. TIMES (May 20, 2011), <http://www.nytimes.com/2011/05/21/business/media/21tattoo.html>.

and “one of the most distinctive tattoos in the nation.”<sup>7</sup> As a result of Tyson’s transition from an athlete to an entertainer, the tattoo has not only appeared in boxing matches but also has been featured in films,<sup>8</sup> television programs,<sup>9</sup> and other media.<sup>10</sup>

Due in part to its notoriety and popularity, Tyson’s facial tattoo was the subject of the lawsuit *Whitmill v. Warner Bros. Entertainment, Inc.*<sup>11</sup> S. Victor Whitmill, a tattoo artist, claimed that Warner Bros. infringed his copyright in his creation, the “original and distinctive tattoo” applied to Tyson’s face, based upon the production company’s unauthorized<sup>12</sup> copying of the tattoo onto the face of the actor Ed Helms<sup>13</sup> in its motion picture *The Hangover Part II*,<sup>14</sup> as well as the reproduction, distribution, and display of the tattoo in connection with the advertising and promotion of the movie.<sup>15</sup> Warner Brothers argued that

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<sup>7</sup> Verified Complaint for Injunctive and Other Relief at 1, *Whitmill v. Warner Bros. Entm’t, Inc.*, No. 4:11-cv-752, 2011 WL 2038147 (E.D. Mo. Apr. 28, 2011), dismissed, No. 4:11-CV-752 CDP (E.D. Mo. June 22, 2011) [hereinafter *Whitmill Complaint*].

<sup>8</sup> *Mike Tyson Biography*, BIO., <http://www.biography.com/people/mike-tyson-9512980> [<https://perma.cc/A3FY-DLD6>] (last visited Feb. 18, 2015).

<sup>9</sup> *Id.*; *Mike Tyson*, *supra* note 4.

<sup>10</sup> Jon Swartz, *Mike Tyson Promises Knockout with New Interactive Boxing App*, USA TODAY: TECHNOLOGYLIVE (Mar. 14, 2011, 5:31 PM), <http://content.usatoday.com/communities/technologylive/post/2011/03/mike-tyson-promises-knockout-with-new-interactive-boxing-app-1/1> [<https://perma.cc/GJ8E-7HML>]. See generally Yolanda M. King, *The Challenges “Facing” Copyright Protection for Tattoos*, 92 OR. L. REV. 129 (2013) [hereinafter *Protection*]. This Article was the first of a series of articles to examine the applicability of copyright law to tattoos; it addressed the copyrightability of tattoos and concluded that tattoos are subject to copyright protection. *Id.* The second piece of a series of articles to examine the applicability of copyright law to tattoos analyzed the ownership and enforcement of tattoo copyrights. See generally Yolanda M. King, *The Enforcement Challenges for Tattoo Copyrights*, 22 J. INTELL. PROP. L. 29 (2014) [hereinafter *Enforcement*].

<sup>11</sup> *Whitmill Complaint*, *supra* note 7.

<sup>12</sup> *Id.* at 1–2. The court concluded that the facts were largely uncontested and that “[n]either Tyson nor Warner Brothers sought approval from Whitmill [to reproduce the tattoo] before either movie.” Transcript of May 24 Hearing on Motion for Preliminary Injunction at 2, *Whitmill v. Warner Bros. Entm’t*, 2011 WL 118119138 (E.D. Mo. June 21, 2011) (No. 4:11-CV-752-CDP) [hereinafter *Hearing Transcript*]. Further, the court determined that Whitmill had not granted Warner Bros. a license, implied or otherwise, to “use the tattoo.” *Id.* at 4.

<sup>13</sup> See Verified Answer to Verified Complaint for Injunctive and Other Relief at 6, *Whitmill v. Warner Bros. Entm’t*, No. 4:11-CV-752-CDP, (E.D. Mo. May 20, 2011) [hereinafter *Warner Bros. Answer*] (“Warner Bros. states that Mr. Tyson appeared, with Mr. Tyson’s tattoo, in the first HANGOVER movie, as well as in an advertising poster for the first HANGOVER movie, and that thousands of images of Mr. Tyson, with Mr. Tyson’s tattoo, have appeared in magazines, on television and on the internet since February 10, 2003.”). Warner Bros. admitted that Tyson’s tattoo and the tattoo appearing on actor Ed Helms’ face in *The Hangover Part II* are similar but denied that there was any copyrightable expression in Tyson’s tattoo or that the tattoo on Helm’s face was pirated. *Id.*

<sup>14</sup> See *Whitmill Complaint*, *supra* note 7.

<sup>15</sup> *Id.*

the use of the tattoo was a parody of the tattoo.<sup>16</sup> However, as I noted in my second article concerning the applicability of copyright law to tattoos, *The Enforcement Challenges for Tattoo Copyrights*, such use was not commentary on the tattoo itself but commentary on Mike Tyson.<sup>17</sup> The effectiveness of the parody hinged upon the audience's recognition of the meaning of Tyson's tattoo as a part of Tyson's personality—aggression, masculinity, and strength—and the juxtaposition of that meaning with the tattoo on the face of Ed Helms's character in *The Hangover Part II*. Warner Brothers chose to use the tattoo because the tattoo now conveyed qualities associated with Mike Tyson's likeness. This Article asserts that Mike Tyson's tattoo has now taken on the meaning of Mike Tyson's identity, and therefore, the tattoo has become a part of his persona. Thus, the copyrighted work of S. Victor Whitmill has been transformed into a protectable part of Mike Tyson's identity.

Further, this Article analyzes the potential enforcement of the rights, under state right-of-publicity laws (defined hereinafter), that would protect a tattoo associated with the identity of a celebrity. For example, what if an online vendor sold T-shirts, hats, and watches with a reproduction of the tattoo displayed on those products? What if a fragrance company decided to sell a perfume with the tattoo featured prominently on the bottle? Or, what if a film producer released a film featuring a male superhero that displayed Mike Tyson's tattoo on the front of his costume and sold promotional products featuring that same tattoo? These hypothetical scenarios are a few ways in which third parties might use a celebrity's tattoo in order to promote, advertise, and ultimately sell a product. Furthermore, this Article asserts that these instances of tattoo use, whether the use of an image of Tyson's face, which displays the tattoo, or the use of the facial tattoo alone, would infringe Tyson's right of publicity.

Generally, the author of a work is the owner of the copyright in that work.<sup>18</sup> Therefore, if a tattoo bearer is an author, or coauthor, of a tattoo, then the tattoo bearer owns, or co-owns, the copyright in the tattoo.<sup>19</sup> However, copyright ownership by tattoo bearers is less common than copyright ownership by tattoo artists because courts require the contribution of copyrightable subject matter

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<sup>16</sup> See Hearing Transcript, *supra* note 12, at 4 (noting that “[the reproduction] did not comment on the artist's work or have any critical bearing on the original composition.”).

<sup>17</sup> See *Enforcement*, *supra* note 10, at 60 n.180. While one might opine that Warner Brothers' use of Tyson's facial tattoo commented on the absurdity of tattooing an image on one's face, such use still did not comment on or parody the tattoo itself.

<sup>18</sup> 17 U.S.C. § 201 (2012) (“Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners of copyright in the work.”). An exception to the general rule is the work made for hire doctrine. Under the work made for hire doctrine, the author of the work is “the employer or other person for whom the work was prepared.” *Id.*

<sup>19</sup> *Id.*

by the copyright owner or co-owner.<sup>20</sup> In *The Enforcement Challenges for Tattoo Copyrights*, I encourage owners of copyrights in tattoos (who most often will be the tattoo artists who create and ink the tattoos on the celebrities' bodies) to vigilantly enforce their rights against parties outside of the tattoo artist-client relationship.<sup>21</sup> However, in many instances, copyright owners, especially tattoo artists, may not assert their rights in their works.<sup>22</sup> While tattoo artists/copyright owners may have copyright infringement claims against such third parties, there are other persons who may have other claims against third parties, notably right-of-publicity claims by someone like Mike Tyson. Even in the absence of a copyright-infringement claim, a celebrity should have a right-of-publicity claim, and the celebrity should be able to pursue a third party's violation of that right.<sup>23</sup>

The right of publicity "prevents the unauthorized commercial use of an individual's name, likeness or other recognizable aspects of one's persona."<sup>24</sup> The individual has the exclusive right to license the use of his or her identity for commercial purposes.<sup>25</sup> More than half of the states in the United States recognize the right of publicity, in common law, by statute, or both.<sup>26</sup> Generally,

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<sup>20</sup> See *Enforcement*, *supra* note 10, at 38 (citing *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1070–71 (7th Cir. 1994) (observing that the majority of courts have adopted the "copyrightability test," which requires that each contribution to the work be copyrightable, in evaluating whether one's contributions to a copyrighted work amount to authorship)).

<sup>21</sup> See *id.* at 33.

<sup>22</sup> See *Protection*, *supra* note 10, at 138 ("The paucity of tattoo copyright cases and the absence of a judicial recognition of the protectability of tattoos may further contribute to tattoo artists' reluctance to seek remedies in the courtroom."); Aaron Perzanowski, *Tattoos & IP Norms*, 98 MINN. L. REV. 511, 532 (2013) (observing that "on the whole, [tattoo artists] were reluctant to endorse reliance on the judicial system").

<sup>23</sup> Other scholars have contemplated whether right-of-publicity claims are preempted by federal copyright law. See, e.g., Thomas F. Cotter & Irina Y. Dmitrieva, *Integrating the Right of Publicity with First Amendment and Copyright Preemption Analysis*, 33 COLUM. J.L. & ARTS 165 (2010); David E. Shipley, *Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673, 673–74 (1981). The preemption issue is beyond the scope of this Article.

<sup>24</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 1995) ("One who appropriates 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 is subject to liability."); *Copyright Guidance*, JOHN F. KENNEDY PRESIDENTIAL LIBR. & MUSEUM, <http://www.jfklibrary.org/Research/Research-Services/Copyright-law.aspx> [https://perma.cc/58HZ-8FMQ] (last visited Feb. 18, 2016).

<sup>25</sup> See *Copyright Guidance*, *supra* note 24; RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46. This Article will interchangeably use the terms "persona" and "identity" to refer to the characteristics of an individual.

<sup>26</sup> MCCARTHY, *supra* note 1. ("At the time of this writing, courts have expressly recognized the right of publicity as existing under the common law of 21 states. Of those, eight also have statutory provisions broad enough to encompass the right of publicity. In addition, ten states have statutes which, while some are labeled 'privacy' statutes, are worded in such a way that most aspects of the right of publicity are embodied in those statutes. Thus, at the

state right-of-publicity laws allow a plaintiff to recover upon a showing that an item of commerce associated with his or her identity has economic value.<sup>27</sup> Right-of-publicity laws have been extended to cover references to a persona such as voice, name, photograph, likeness, signature phrase, and fictional character.<sup>28</sup> Other intellectual-property-law scholars have contemplated the possibility of a person's identity to encompass images incorporated into a work of art on a person's body.<sup>29</sup> Further, it has been recognized that the celebrity persona carries a meaning that enables the sale of products and services associated with that meaning.<sup>30</sup> Thus, it is plausible that a celebrity could bring a right-of-publicity claim based on appropriation of his or her identity, even if the exploited part of the identity is the celebrity's tattoo.

This Article is the third and final piece of a series that examines the applicability of intellectual-property law to tattoos. It will analyze the intersection of copyright and right-of-publicity laws in circumstances similar to the aforementioned hypothetical instances, and then it will weigh a celebrity's right-of-publicity interests against free-speech interests.

Part I of the Article begins with the conclusion reached in the first article in this series regarding the applicability of copyright law to tattoos—namely, tattoos meet the requirements of copyrightability under federal copyright law, the Copyright Act of 1976.<sup>31</sup> It also examines how tattoos are unique subject matter that moves from the protection of copyright law to the protection of right-of-publicity laws.

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time of this writing, under either statute or common law, the right of publicity is recognized as the law of 31 states.”)

<sup>27</sup> 4 LOUIS ALTMAN & MALLA POLLACK, *CALLMAN ON UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES* § 22.32 (Thomson Reuters 4th ed. 2015) (“According to much authority, in order to recover for a violation of the right of publicity, a plaintiff must show that associating an item of commerce with his or her identity has economic value.”); *see also* *Rogers v. Grimaldi*, 875 F.2d 994, 1003–04 (2d Cir. 1989) (“The common law right of publicity, where it has been recognized, grants celebrities an exclusive right to control the commercial value of their names and to prevent others from exploiting them without permission.”).

<sup>28</sup> ALTMAN & POLLACK, *supra* note 27.

<sup>29</sup> Thomas F. Cotter & Angela M. Mirabole, *Written on the Body: Intellectual Property Rights in Tattoos, Makeup, and Other Body Art*, 10 UCLA ENT. L. REV. 98, 137 (2003).

<sup>30</sup> Michael Madow, *Private Ownership of a Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 185 (1993). While Professor Madow recognizes the celebrity persona carries a meaning that enables the sale of commodities associated with that meaning, he concludes a celebrity is not solely responsible for cultivating that meaning, and therefore, criticizes a celebrity's exclusive ownership or control of the economic value in the persona. *Id.* at 185–96.

<sup>31</sup> *See Protection*, *supra* note 10, at 132 (concluding previously in *The Challenges “Facing” Copyright Protection for Tattoos* that tattoos can meet the 1976 Act's requirements of a copyrightable work—some tattoos are original, many, if not most, are fixed in a tangible medium of expression, and, the useful article doctrine does not preclude copyrightability of this type of pictorial work).

Part II first acknowledges the prevalence of tattooing among celebrities and professional athletes<sup>32</sup> and discusses the relevance of right-of-publicity laws in light of the growing number of high-profile tattoo bearers. It then considers the categorization of celebrities' tattoos as indicia of their identity. Tattoos fall under the broad scope of one's identity, and therefore, this Article posits they should be protected by some states under right-of-publicity or right-of-privacy laws.

In Part III, the Article examines the prevailing tests for balancing the right of publicity against the First Amendment—the *Rogers* test, which was first employed in the context of the use of a celebrity's name in the title of an expressive work in *Rogers v. Grimaldi*,<sup>33</sup> the “Transformative Use” test for expressive works under *Comedy III Prods., Inc. v. Saderup*,<sup>34</sup> the “Relatedness” test of the Restatement (Third) of Unfair Competition,<sup>35</sup> and the “Predominant Use” test adopted in *Doe v. TCI Cablevision*<sup>36</sup> from a balancing approach proposed by intellectual property practitioner Mark S. Lee,<sup>37</sup> and supported by the proposed “mixed or blended promotional/expressive uses” test articulated by Professor

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<sup>32</sup> This Article will refer to celebrities and professional athletes as “celebrities.” It acknowledges the ever-increasing possibility that non-professional athletes, such as collegiate athletes, may fall into this category too. Modern technology can transform anyone into a celebrity, but the “traditional” celebrity is the subject of this Article. See William K. Smith, *Saving Face: Adopting a Right of Publicity to Protect North Carolinians in an Increasingly Digital World*, 92 N.C. L. REV. 2065, 2066 (2014). A celebrity has been defined as a “famous or well-known person” or “merely a person whom ‘many’ people talk about or know about.” MCCARTHY, *supra* note 1, § 4:2.

<sup>33</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 1004–05 (1989) (employing a two-part test and concluding that the use of a celebrity's name in the title of the film “Ginger and Fred” is “clearly related to the content of the movie and is not a disguised advertisement for the sale of goods or services or a collateral commercial product.”).

<sup>34</sup> *Comedy III Prods., Inc. v. Saderup, Inc.*, 21 P.3d 797, 808–10 (Cal. 2001). (“In sum, when an artist is faced with a right of publicity challenge to his or her work, he or she may raise as affirmative defense that the work is protected by the First Amendment inasmuch as it contains significant transformative elements or that the value of the work does not derive primarily from the celebrity's fame.”)

<sup>35</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (AM. LAW INST. 1995) (“[I]f the name or likeness is used solely to attract attention to a work that is not related to the identified person, the user may be subject to liability for a use of the other's identity in advertising.”).

<sup>36</sup> *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (en banc).

<sup>37</sup> Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 485, 500 (2003). (“If a product is being sold that predominantly exploits the commercial value of an individual's identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some ‘expressive’ content in it that might qualify as ‘speech’ in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight. Such an approach does justice to both the expressive and property interests.”)



Lateef Mtima.<sup>38</sup> This Part also analyzes the application of those tests to existing and potential uses of tattoos and recommends the use of the Predominant Use test (or mixed or blended uses test, which is a different articulation of the Predominate Use test) when balancing right-of-publicity and First Amendment interests in cases concerning the publicity rights of a celebrity tattoo bearer. While advancing a right-of-publicity claim in connection with an expressive use of a copyrighted work raises First Amendment concerns,<sup>39</sup> courts should avoid an “either/or characterization”<sup>40</sup> of uses of “persona tattoos”<sup>41</sup> in the determination of whether the use of the tattoo is expressive or commercial.<sup>42</sup>

### I. COPYRIGHT PROTECTION FOR TATTOOS

Copyright law is exclusively federal law,<sup>43</sup> and tattoos appear to meet the requirements of copyrightability, as they are “original works of authorship fixed in a tangible medium of expression” as required by Section 102(a) of the Copyright Act of 1976.<sup>44</sup> Some tattoos meet the requisite originality of federal copyright law,<sup>45</sup> and most tattoos are fixed, either in the traditional form of paper, such as sketches or drawings, on the unconventional (at least under copy-

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<sup>38</sup> Lateef Mtima, *Protecting the Rights of Amateur Athletes: Transforming the Judicial Tests for Balancing Publicity Rights and the First Amendment*, SANTA CLARA SPORTS L. SYMP. 154, 161 (2012) (asserting that “a socially balanced assessment of the competing interests” requires that courts assess the social purposes at issue and balance the interests of the parties in order to determine whether there should any remuneration to the plaintiff). This Article agrees with Mtima’s position that the issue is one of allocation of rewards from exploitation of an individual’s persona. This type of assessment is preferred to an “all or nothing” approach that places the right of publicity at odds with the First Amendment and results in “all or nothing” recovery for the plaintiff (here, the tattoo bearer).

<sup>39</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 574–75 (1977) (recognizing individual’s right of publicity trumps media’s First Amendment concerns when television station broadcasts entertainer’s act, without his consent, in its entirety).

<sup>40</sup> Mtima, *supra* note 38, at 162 (“The technological advances of the past century have made possible a wide variety of new commercial uses for individual personas and other IP rights, and ‘either/or’ characterizations of such uses as publicity rights infringements or legitimate First Amendment expressions are increasingly unhelpful.”).

<sup>41</sup> For purposes of brevity, I will refer to a tattoo that has become “one” with the persona of the tattoo bearer as a “persona tattoo.” Such tattoos are distinguishable from tattoos that continue to solely represent a meaning independent of the tattoo bearers.

<sup>42</sup> Mtima, *supra* note 38, at 162.

<sup>43</sup> 17 U.S.C. § 301 (2012) (“On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright . . . are governed exclusively by this title.”).

<sup>44</sup> 17 U.S.C. § 102(a) (2012) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”).

<sup>45</sup> Perzanowski, *supra* note 22, at 525 (“A tattoo, like any other original work fixed in a tangible medium, is protected by copyright law.”).

right law) medium of human skin, or both.<sup>46</sup> Therefore, at least some tattoos are protectable subject matter under federal copyright law. In addition, as concluded in *The Challenges “Facing” Copyright Protection for Tattoos*, the fact that a tattoo artist’s work is conveyed through the medium of the human body does not preclude nor disqualify it from serving as a protectable medium of expression under copyright law.<sup>47</sup> Thus, this choice of medium does not affect the copyrightability of the work.<sup>48</sup>

However, when the medium is the body of a celebrity, and the tattoo becomes more associated with the celebrity tattoo bearer’s identity than the message, if any, of the work (whether it be aesthetic or political, for example), then the copyrighted work moves from the copyright realm into subject matter of the right of publicity. In such instances, the tattoo on a celebrity carries the meaning of the tattoo bearer, thereby serving as indicia of the celebrity’s identity. For a celebrity to establish unauthorized use of his or her recognizable identity, the use of the identity must be “sufficient to identify the person whose identity the defendant is alleged to have appropriated,”<sup>49</sup> and this requirement would be met in instances of commercial use of a tattoo prominently displayed on the body of a celebrity.<sup>50</sup> Thus, the tattoo itself, born out of copyright law, would now be subject to right-of-publicity laws. A celebrity could then file a lawsuit alleging infringement of his or her right of publicity based on a third party’s commercial use of the tattoo. Because the practice of tattooing among celebrities is commonplace,<sup>51</sup> such lawsuits are likely in the future.

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<sup>46</sup> *Id.* at 526 (“Tattooers occasionally ink an image freehand directly on a client’s skin. But more often, they create a detailed line drawing of the tattoo design on paper.”) (footnotes omitted).

<sup>47</sup> See *Protection*, *supra* note 10, at 151–52.

<sup>48</sup> Perzanowski, *supra* note 22, at 568 (“[T]attoo designs, whether fixed on paper or on human skin, are works embraced by copyright.”).

<sup>49</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. d (AM. LAW INST. 1995). The Restatement elaborates that “in the case of an alleged visual likeness, the plaintiff must be reasonably identifiable from the photograph or other depiction.” *Id.*

<sup>50</sup> It is less likely that a tattoo fixed on a covered or private part of a celebrity’s body would become an identifiable part of the celebrity’s persona because it would not be in public view. However, this Article posits that, even if a tattoo does not meet the requisite level of originality for copyright protection (such as a basic geometric shape or unoriginal arrangement of geometric shapes), it may become an identifiable part of a celebrity’s persona. Therefore, in such likely limited instances, an uncopyrightable tattoo could still be protected by right-of-publicity laws.

<sup>51</sup> Ramin Setoodeh, *Kat Von D: Are Celebrities Driving Tattoo Culture?*, NEWSWEEK (Nov. 8, 2010, 1:00 PM), <http://www.newsweek.com/kat-von-d-are-celebrities-driving-tattoo-culture-69897> [<https://perma.cc/MFS3-SF3W>] (discussing growth in popularity of tattoos among celebrities).

## II. APPLICATION OF RIGHT OF PUBLICITY TO TATTOOS

The right of publicity is a state-law intellectual-property right.<sup>52</sup> The right is now recognized by more than thirty states in the United States.<sup>53</sup> The Restatement (Third) of Unfair Competition defines the right of publicity:

Appropriation of the Commercial Value of a Person's Identity: The Right of Publicity

One who appropriates 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 is subject to liability for the relief appropriate under the rules stated in §§ 48 and 49.<sup>54</sup>

A succinct definition of the right of publicity is “the inherent right of every human being to control the commercial use of his or her identity.”<sup>55</sup> It has been characterized as “our last, best hope of preventing others from profiting our identities without our permission.”<sup>56</sup>

The right of publicity originates from the right of privacy,<sup>57</sup> and it was first recognized in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>58</sup> Judge Jerome Frank of the Second Circuit coined the term “right of publicity” in an effort to distinguish it from the right of privacy.<sup>59</sup> He stated:

We think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made “in gross,” i.e., without an accompanying transfer of a business or of anything else. . . .

This right might be called a “right of publicity.” For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements,

<sup>52</sup> MCCARTHY, *supra* note 1, § 1:3.

<sup>53</sup> *Id.* at § 6:3.

<sup>54</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 1995). Comment a further delineates the right of publicity: “The appropriation of another’s identity for purposes of trade can result in injury to both commercial and personal interests. This Restatement deals with rules affording relief against unfair methods of competition, and the rules stated in this Topic are therefore limited to the redress of commercial injuries. The interest protected by these rules is often described as the ‘right of publicity.’” *Id.* cmt. a; *see also* ETW Corp. v. Jireh Publ’g, Inc., 332 F.3d 915, 930 (6th Cir. 2003).

<sup>55</sup> MCCARTHY, *supra* note 1, § 1:3; *see also* MARK S. LEE, ENTERTAINMENT AND INTELLECTUAL PROPERTY LAW § 3:2 (Thomas Reuters 2015) (describing the right of publicity as “an individual’s right to control commercial exploitation of his or her identity”).

<sup>56</sup> LEE, *supra* note 55, § 3:1.

<sup>57</sup> MCCARTHY, *supra* note 1, § 1:7.

<sup>58</sup> *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

<sup>59</sup> *Id.*

popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways.<sup>60</sup>

Similar to the right of privacy, the right of publicity protects one's "interest in personal dignity and autonomy."<sup>61</sup> However, unlike the right of privacy, which is concerned with harm to an individual's personal interests,<sup>62</sup> the right of publicity protects against damage to the commercial value of an individual's identity.<sup>63</sup> The rationale for the right of publicity is the protection of the economic value of a person's identity, including the invested "time, effort, and expense" to cultivate such value.<sup>64</sup> As a result of such protection, an individual is incentivized to invest in the development of his or her identity, which ultimately benefits the public.<sup>65</sup> The Supreme Court likened its rationale behind right-of-publicity protection to the underlying bases for patent and copyright laws.<sup>66</sup> Other intellectual-property-law scholars have analyzed the additional rationale for the right of publicity—the natural or property rights in one's name and likeness.<sup>67</sup>

In order to establish a *prima facie* case of infringement of one's right of publicity, a plaintiff must show (1) ownership of the recognizable identity at issue (validity) and (2) unauthorized third party use of the identity in a way that is likely to cause damage to the commercial value of the celebrity's identity (infringement).<sup>68</sup> A plaintiff does not need to prove that the use caused damage to

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<sup>60</sup> *Id.*

<sup>61</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. c (AM. LAW INST. 1995).

<sup>62</sup> *See id.* cmt. a ("Relief is also generally available under the law of torts for injuries to personal interests caused by the unauthorized commercial use of another's identity. The protection of these personal interests is often described as an aspect of the 'right of privacy.'"); MCCARTHY, *supra* note 1, § 5:67 ("The critical difference is the nature of the right invaded: either psyche or pocketbook. Once this distinction is accepted, the 'personal' or 'property' label follows easily, with the 'right of privacy' being a 'personal right' and the 'right of publicity' being a 'property right.'").

<sup>63</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. a (AM. LAW INST. 1995) (explaining that while "[t]he appropriation of another's identity for purposes of trade can result in injury to both commercial and personal interests," the right of publicity rules are limited to protection of commercial interests).

<sup>64</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575–76 (1977).

<sup>65</sup> *Id.* at 576.

<sup>66</sup> *Id.*

<sup>67</sup> Daniel Gervais & Martin L. Holmes, *Fame, Property, and Identity: The Purpose and Scope of the Right of Publicity*, 25 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 181, 194 (2015).

<sup>68</sup> *Prima v. Darden Rests., Inc.*, 78 F. Supp. 2d 337, 349 (D.N.J. 2000) ("To allege a *prima facie* case for infringement of the right of publicity, the plaintiff must show both validity and infringement.").

his identity in order to establish a claim for liability and obtain injunctive relief; damage is presumed from the unauthorized use.<sup>69</sup>

While the right of publicity is not solely the right of a celebrity,<sup>70</sup> the majority of reported right-of-publicity decisions involve a celebrity.<sup>71</sup> The identity of a celebrity carries more significant commercial value than a private individual's identity, and therefore, third parties are more likely to use a celebrity's identity in advertising, merchandise, and even in expressive or artistic works.<sup>72</sup> The "associative value" of a celebrity's identity positively impacts the sale of goods and services, and such economic value is diminished by unauthorized use.<sup>73</sup> As a result, a celebrity must vigorously protect his right of publicity in order to preserve the economic value of his identity. Hence, a right of publicity lawsuit is often viewed as the "celebrity law suit."<sup>74</sup>

#### A. *Prevalence of Tattooed Celebrities*

The practice of tattooing has become commonplace in the entertainment and sports industries.<sup>75</sup> Tattooed celebrities have elevated the visibility and attractiveness of tattoos.<sup>76</sup> Consequently, celebrities have played a significant role in the growth of tattooing in popular culture.<sup>77</sup> The mainstreaming of tattooing has led to the commercialization of tattoos, transforming tattoo bearers and

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<sup>69</sup> *Petty v. Chrysler Corp.*, 799 N.E.2d 432, 441–42 (Ill. App. Ct. 2003) ("A claimant alleging misappropriation of identity need not prove actual damages, because the court will presume damages if someone infringes another's right to control his identity.").

<sup>70</sup> MCCARTHY, *supra* note 1, § 1:3 ("The right of publicity is not merely a legal right of the 'celebrity,' but is a right inherent to everyone to control the commercial use of identity and persona and recover in court damages and the commercial value of an unpermitted taking.").

<sup>71</sup> *Id.* § 4:2 (defining a celebrity as a "famous or well-known person" or "merely a person whom 'many' people talk about or know about").

<sup>72</sup> *Id.* § 4:3.

<sup>73</sup> Sheldon W. Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L.J. 853, 857 (1995); Lee, *supra* note 37, at 480 ("Allowing uncompensated third-party use also devalues the property and allows unjust enrichment in violation of the owner's property rights." (citing *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 837 (6th Cir. 1983)).

<sup>74</sup> Smith, *supra* note 32.

<sup>75</sup> Wendy Haywood et al., *Who Gets Tattoos? Demographic and Behavioral Correlates of Ever Being Tattooed in a Representative Sample of Men and Women*, 22 ANNALS EPIDEMIOLOGY 51, 51 (2012) ("Once the domain of gangs, prisoners, and specific subcultures, tattoos are now regularly seen on celebrities, athletes, and middle-class young people."); Mary Kosut, *An Ironic Fad: The Commodification and Consumption of Tattoos*, 39 J. POPULAR CULTURE 1035, 1037–38 (2006) (observing prevalence of tattooed persons in the entertainment industry, including television personalities in soap operas, sitcoms, and reality television shows, movie actors and actresses, musicians, and professional athletes); Setoodeh, *supra* note 51 (discussing growth in popularity of tattoos among celebrities).

<sup>76</sup> See Kosut, *supra* note 75, at 1038 ("At the very least, the celebrity tattoo phenomenon contributes to new understandings of tattoo and elevates tattoo's cultural status.").

<sup>77</sup> *Id.*

their accompanying tattoos into valuable products.<sup>78</sup> Tattoos are used in advertising to sell products,<sup>79</sup> and celebrities appear willing to be advertisements themselves, bearing tattoos of products names and logos.<sup>80</sup> For example, an advertising executive proposed the idea of professional basketball players wearing temporary tattoos to promote various products.<sup>81</sup> Although the National Basketball Association (“NBA”) officials rejected the proposal, NBA player Stephon Marbury expressed that he would have considered it.<sup>82</sup> Thus, celebrities, advertisers, and consumers alike recognize the economic value of celebrities and their tattoos.

### B. Tattoos as Indicia of Identity

At the inception of the right of publicity, the interpretation of identity was limited to one’s name and likeness.<sup>83</sup> The Restatement (Third) of Unfair Competition includes the appropriation of “other indicia of identity” as an infringement of the right of publicity.<sup>84</sup> It has been observed that certain people possess other indicia of personality,<sup>85</sup> and therefore, the right of publicity can be violated without the use of one’s name or likeness.<sup>86</sup> A number of celebrities possess other indicia of identity, and a tattoo prominently fixed on the body of one of those celebrities could become an identifiable part of the celebrity’s identity. Relevant evidence of identifiability “includes the nature and extent of the identifying characteristics used by the defendant, the defendant’s intent, the fame of

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<sup>78</sup> *Id.* at 1039; *see also Enforcement*, *supra* note 10, at 30 (noting that plaintiff tattoo artists filed lawsuits due to primary concerns about reproduction of their works by third-party companies for the commercialization of products, i.e. a film, athletic shoe, and video game).

<sup>79</sup> Kosut, *supra* note 75, at 1039 (“Whether designated as a sign of rebellion, youth, trendiness, or some amalgam of coolness, tattoos assist in selling products—from vodka to cars. Thus, tattoo is used to sell a product and is simultaneously a product to be consumed.”).

<sup>80</sup> *Id.*

<sup>81</sup> *Id.*; *see also* Stephen M. McKelvey, *Commercial “Branding”: The Final Frontier or False Start for Athletes’ Use of Temporary Tattoos as Body Billboards*, 13 J. LEGAL ASPECTS SPORT 1, 3 (2002); John Vukelj, *Post No Bills: Can the NBA Prohibit Its Players from Wearing Tattoo Advertisements?*, 15 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 507, 509 (2005).

<sup>82</sup> Kosut, *supra* note 75, at 1039; Vukelj, *supra* note 81, at 515.

<sup>83</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 2015); LEE, *supra* note 55; Halpern, *supra* note 73, at 859.

<sup>84</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 2015).

<sup>85</sup> *Id.* cmt. d (“The use of other identifying characteristics or attributes may also infringe the right of publicity, but only if they are so closely and uniquely associated with the identity of a particular individual that their use enables the defendant to appropriate the commercial value of the person’s identity.”); Halpern, *supra* note 74, at 860 (“But, of course, for certain people, there may be other indicia of the unique persona; certain traits, characteristics, mannerisms, or even paraphernalia may be peculiarly attached to the individual so as uniquely to evoke that individual.”).

<sup>86</sup> *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397–98 (9th Cir. 1992) (“[T]he case law has borne out his insight that the right of publicity is not limited to the appropriation of name or likeness.”).

the plaintiff, evidence of actual identification made by third persons, and surveys or other evidence indicating the perceptions of the audience.”<sup>87</sup> Courts have expanded the scope of identity to encompass a wide variety of characteristics of a person,<sup>88</sup> such as style,<sup>89</sup> voice and sound-a-like,<sup>90</sup> distinctive phrases,<sup>91</sup> and more.<sup>92</sup>

Tattoos are powerful visual images, and some are already associated with the identities of celebrities, such as Mike Tyson’s facial tattoo, Angelina Jolie’s arm tattoo of the geographical coordinates of the birth places of her children and husband Brad Pitt,<sup>93</sup> and Rasheed Wallace’s arm tattoo of an Egyptian-themed depiction of his family.<sup>94</sup> The unauthorized commercial use of tattoos will continue to grow not only due to the aforementioned increasing prevalence

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<sup>87</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. d (AM. LAW INST. 1995).

<sup>88</sup> ALTMAN & POLLACK, *supra* note 27 (observing that some jurisdictions have extended the right of publicity to “include many types of references to a persona including voice, name, photograph, likeness, business building, picture of a unique article, signature phrase, fictional character, etc.”) (citations omitted).

<sup>89</sup> *Id.*

<sup>90</sup> Midler v. Ford Motor Co., 849 F.2d 460, 463–64 (9th Cir. 1988) (holding that actress and singer Bette Midler made a sufficient showing to defeat summary judgment that defendants’ use of a sound-a-like singer in an automobile commercial appropriated part of Midler’s identity—her voice); *see also* Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1100 (9th Cir. 1992).

<sup>91</sup> Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831, 837 (6th Cir. 1983) (holding that defendant violated the right of publicity of former host of the television program “The Tonight Show” John Carson because defendant used the phrase “Here’s Johnny,” the opening statement for Carson’s introduction on the weekday nightly television program, in connection with the sale of portable toilets).

<sup>92</sup> Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 827 (9th Cir. 1974) (concluding that, even though the likeness of racing car driver Lothar Motschenbacher was not visible in the cigarette commercial and defendant made changes to the race car featured in the commercial, Motschenbacher had a protectable interest in his identity because the driver in the commercial was identifiable as Motschenbacher in light of the distinctive decorations on the car).

<sup>93</sup> Angelina Jolie is known for her films, her humanitarian work, and her tattoos. VANISHING TATTOO, [http://www.vanishingtattoo.com/tattoo\\_facts.htm](http://www.vanishingtattoo.com/tattoo_facts.htm) [https://perma.cc/ES2V-QTZ7] (last visited Feb. 18, 2015) (“Angelina’s number, choice, and types of tattoos rank the highest in the celebrity category [of tattoo searches].”). The tattoo on Angelina Jolie’s left arm has been referred to as “one of the most infamous celebrity tattoos.” *30 Celebrity Tattoos: Your Favorite Good, Bad & Ugly Ink*, HUFFINGTON POST: HUFFPOST CELEBRITY (Jul. 16, 2014, 3:59 PM), [http://www.huffingtonpost.com/2013/05/28/celebrity-tattoos\\_n\\_3348545.html](http://www.huffingtonpost.com/2013/05/28/celebrity-tattoos_n_3348545.html) [https://perma.cc/5BSF-DPJH] (displaying photographs of public’s favorite celebrity tattoos).

<sup>94</sup> Rasheed Wallace’s right arm tattoo was the subject of a lawsuit filed by tattoo artist Matthew Reed, who alleged that Nike and advertising agency Weiden + Kennedy directly infringed his copyright in the tattoo in the creation of a Nike advertising campaign on television and the internet. *See Protection*, *supra* note 10, at 142. “The advertisement included a close-up of the tattoo and featured the tattoo being created by a computerized simulation with a voice-over from Wallace describing and explaining the meaning of the tattoo.” *Id.* at 142–43. Arguably, the defendants in that lawsuit selected the tattoo, and Wallace’s explanation of it, as the centerpiece of the commercial, because it had become a part of his identity.

of tattooing among the entertainment and sports industries but also due to the ability of tattoos to conjure up the marketing power of their celebrity tattoo bearers.

### III. FIRST AMENDMENT AND RIGHT OF PUBLICITY TESTS

There is a tension between the expressive rights embodied in the First Amendment and the property rights embodied in right-of-publicity laws.<sup>95</sup> Courts often “weigh the state’s interest in protecting a plaintiff’s property right to the commercial value of his or her name and identity against the defendant’s right to free speech.”<sup>96</sup>

Courts have used various tests for balancing publicity rights against First Amendment interests when a plaintiff brings a right-of-publicity lawsuit, including the Transformative Use test, the *Rogers* test, and the Predominate Use test.<sup>97</sup> However, the majority of courts employ the Transformative Use test.<sup>98</sup> This Article asserts that the Predominant Use test is the proper balancing approach for the evaluation of blended expressive and commercial uses of an identity. The Predominant Use test will most effectively accommodate the conflicting publicity and free-speech interests in right-of-publicity cases, especially in cases concerning a “persona tattoo.”

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<sup>95</sup> *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 931 (6th Cir. 2003) (“There is an inherent tension between the right of publicity and the right of freedom of expression under the First Amendment.”); *Comedy III Prods., Inc., v. Saderup, Inc.*, 21 P.3d 797, 803 (Cal. 2001) (“The tension between the right of publicity and the First Amendment is highlighted by recalling the two distinct, commonly acknowledged purposes of the latter.”); *Lee*, *supra* note 37, at 479.

<sup>96</sup> *Parks v. LaFace Records*, 329 F.3d 437, 449 (6th Cir. 2003); *ETW Corp.*, 332 F.3d at 931; *Doe v. TCI Cablevision*, 110 S.W.3d 363, 372 (Mo. 2003) (en banc); *Comedy III Prods., Inc.*, 21 P.3d at 806; *Winter v. DC Comics*, 69 P.3d 473, 478 (Cal. 2003).

<sup>97</sup> I am indebted to Professor David Rubenstein, a participant in the 2014 Washington University Law School’s Junior Faculty Regional Workshop, for the valuable suggestion that perhaps the right of publicity/First Amendment balancing test might be viewed through a constitutional conflict preemption lens. This perspective is intriguing because it presents a novel means of scrutiny of the relationship between the right of publicity and First Amendment, but it is beyond the scope of this Article. However, an examination of the preemption of right-of-publicity claims in general, and this suggestion in particular, may be fitting for future analysis.

<sup>98</sup> *Gervais & Holmes*, *supra* note 67, at 212 (“The transformative use test is widely used by courts attempting to balance the right of publicity with the First Amendment.”); *see also* *No Doubt v. Activision Publ’g, Inc.*, 122 Cal Rptr. 3d 397, 400–01 (Ct. App. 2011). *See generally* *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268 (9th Cir. 2013); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013) (citing cases that also adopt the Transformative Use test).



*A. Transformative Use Test*

In *Comedy III Productions, Inc. v. Saderup*, defendants, artist Gary Saderup and Gary Saderup, Inc. (“Saderup”), sold lithographs and T-shirts bearing the likenesses of the Three Stooges, a former comedy act of deceased personalities whose postmortem rights were owned by plaintiff Comedy III Productions.<sup>99</sup> The image of the Three Stooges on the lithographs and T-shirts was based upon a charcoal drawing previously created by Saderup.<sup>100</sup> After the trial and appellate courts found for Comedy III, the California Supreme Court affirmed the judgment of the appellate court.<sup>101</sup> In doing so, the court articulated the “Transformative Use test.”<sup>102</sup>

The California Supreme Court derived the “Transformative Use” test from one of the fair use factors of federal copyright law.<sup>103</sup> It described its test:

When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.

On the other hand, when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity.<sup>104</sup>

The California Supreme Court elaborated that

[a]nother way of stating the inquiry is whether the celebrity likeness is one of the “raw materials” from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.<sup>105</sup>

This lengthy explanation of the test, combined with additional characterizations of the test set forth in the decision, has been interpreted to include five factors: (1) whether the literal or imitative depiction adds “significant expression,” (2) whether the celebrity image is one of the “raw materials from which an original work is synthesized,” (3) whether the work is “primarily the defendant’s own expression rather than the celebrity likeness,” (4) whether the “literal and imitative elements” or the “creative elements” predominate the work, and (5) whether the “marketability and economic value” of the work de-

<sup>99</sup> *Comedy III Prods.*, 21 P.3d at 800–01.

<sup>100</sup> *Id.*

<sup>101</sup> *Id.* at 801, 811.

<sup>102</sup> *Id.* at 808.

<sup>103</sup> *Id.* at 807; see also 17 U.S.C. § 107 (2012).

<sup>104</sup> *Comedy III Prods., Inc.*, 21 P.3d at 808 (citation omitted).

<sup>105</sup> *Id.* at 809.

rives primarily from the celebrity's fame.<sup>106</sup> The test is used for cases in which the plaintiff claims a defendant's expressive work,<sup>107</sup> which is protected by the First Amendment, infringes the plaintiff's right of publicity.

Under this test, courts analyze whether the defendant sufficiently transforms the plaintiff's identity in the visual artistic work. However, this question is an elusive one for courts to answer. Transformativeness is highly subjective—it is in the eye of the beholder.<sup>108</sup> The Court of Appeals of California found that the use of the likenesses of members of the rock band No Doubt in the Band Hero video game was not transformative.<sup>109</sup> In addition, the Third and Ninth Circuits found non-transformative uses of the likenesses of former college football athletes Ryan Hart and Samuel Keller, respectively, in the NCAA Football series video games.<sup>110</sup> The courts reached these conclusions based on the observations that the avatars in the video games were digital replicas of the celebrities.<sup>111</sup>

In *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, the Ninth Circuit distinguished the case (as well as *No Doubt* and *Hart*) from the California Supreme Court's decision in *Winter v. DC Comics*,<sup>112</sup> which concerned the use of comic book characters Johnny and Edgar Autumn based on famous rock star brothers Johnny and Edgar Winter.<sup>113</sup> The *In re NCAA* court also distinguished the facts of the Court of Appeals of California's decision in *Kirby v. Sega of America, Inc.*,<sup>114</sup> which concerned the use of the likeness of singer Kierin Kirby, professionally known as "Lady Miss Kier," as the basis for news reporter character Ulala (whose name Kirby alleged sounded similar to her "'signature' lyrical expression" "ooh la la") in a video game.<sup>115</sup> The Ninth Circuit concluded that the key distinction between these groups of cases was that the celebrities' likenesses in *Winter* and *Kirby* were transformed into crea-

<sup>106</sup> MCCARTHY, *supra* note 1, § 8.72.

<sup>107</sup> Expressive works range from traditional works of art, such as paintings and sculptures to more modern artistic works, such as photography, comic books, cartoons, and video games. *See id.*

<sup>108</sup> *See Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (en banc); Rebecca Tushnet, *A Mask that Eats into the Face: Images and the Right of Publicity*, 38 COLUM. J.L. & ARTS 157, 187 (2015) (noting Judge Ambro's dissent in *Hart* which agreed that the Transformative Use test was the proper test but disagreed that its interpretation and application "adds credence to the objection that transformativeness requires judges to become art critics.>").

<sup>109</sup> *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 410 (Ct. App. 2011).

<sup>110</sup> *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 170 (3d Cir. 2013); *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1271 (9th Cir. 2013).

<sup>111</sup> *Hart*, 717 F.3d at 161–62; *In re NCAA*, 724 F.3d at 1276; *No Doubt*, 122 Cal. Rptr. 3d at 409–10.

<sup>112</sup> *See generally Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003).

<sup>113</sup> *See generally In re NCAA*, 724 F.3d 1268.

<sup>114</sup> *See generally Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607 (2006).

<sup>115</sup> *In re NCAA*, 724 F.3d at 1276–77.

tive, new characters in the expressive works at issue.<sup>116</sup> The court further concluded that the NCAA Football video games at issue lacked transformative context.<sup>117</sup>

Other intellectual property law scholars have criticized the *No Doubt* line of cases, arguing that the courts have eviscerated First Amendment protection for video games and that, unlike the California Court of Appeals's application of the Transformative Use test in *No Doubt*, the overall transformativeness of the work should be considered.<sup>118</sup> This Article asserts that the courts' applications of the Transformative Use test are correct, but it is the wrong test for balancing First Amendment interests and right-of-publicity claims.

Even though the test is referred to as the "Transformative Use" test, the *Comedy III* court's expression of the test is unclear regarding whether the court should consider either the depiction of the celebrity, the overall context of the work, or both. It is clear, however, that the test is biased against a particular medium of expression—video games—because the typical goal of a video game creator is to depict the game content based on real people and their environments as literally as possible. If the additional "significant expression" is not present in the depiction of the celebrity, which usually will not be the case, or not present in the overall context of the game, which may not be the case, then the right of publicity likely trumps the First Amendment under the Transforma-

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<sup>116</sup> *Id.* at 1277.

<sup>117</sup> *Id.* at 1278 ("[T]he Third Circuit agreed with us that these changes ['the potentially transformative nature of the game as a whole' and 'the user's ability to alter avatar characteristics'] do not render the *NCAA Football* games sufficiently transformative to defeat a right-of-publicity claim.").

<sup>118</sup> See Tushnet, *supra* note 108, at 179–80.

Even though the avatars [in *No Doubt*] could be manipulated to perform at fanciful venues or to sing songs the real band wouldn't ever sing, and even though the game had many other creative elements, the avatars were still "exact depictions" of the musicians doing what had made them famous: performing music. The use of highly realistic digital depictions "was motivated by a desire to capitalize on the band's fan-base," so there was a violation of the right of publicity. This result can be compared to a hypothetical biography that is exact in every description and detail, the realism of which would plainly fail to justify liability.

*Id.* at 179. See F. Jay Dougherty, *All the World's Not a Stooge: The Transformativeness Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 COLUM. J.L. & ARTS 1, 32 (2003).

When transplanted to right of publicity cases involving a conflict between a persona claimant and a visual artist, transformativeness does not effect that goal. Instead, it could limit the creation of new expressive works of visual art by prohibiting the reproduction and sale of copies of artworks unless they are clearly transformative in the right of publicity sense. Saderup's drawing of the Three Stooges would clearly merit copyright protection—there was no evidence that his drawing did not reflect original creation. Because it was a realistic depiction of the Stooges, selling reproductions was held to be unlawful. Hence, unlike in the case of using transformativeness as a factor in a copyright fair use analysis, requiring transformativeness to protect visual art as speech may protect celebrity economic interests, but it does not further originality in the creation of new personae or in the creation of expressive works of authorship.

*Id.*

tive Use test. Even if the additional “significant expression” is present in the overall context of the game, but the court deems the overall context of the game as irrelevant, then the court would likely reach the same outcome.

The Transformative Use test is an unpredictable balancing approach.<sup>119</sup> Under the Transformative Use test, courts are more likely to reach disparate determinations in an analysis of the use of a celebrity’s tattoo in an expressive work. The multi-step test requires, among other things, an analysis of whether the artistic expression, or work, contains “transformative elements” or additional “significant expression” of the defendant.<sup>120</sup> An assessment of these factors necessitates an aesthetic critique of the work and the depiction of the celebrity’s likeness in it. This assessment will be particularly challenging for courts confronted with a persona tattoo use in light of (1) the likelihood that the use will be both expressive and commercial, (2) the uniqueness of the indicia of identity, and (3) the characterization of tattoos themselves as copyrightable works of art.

### B. Rogers Test

In *Rogers v. Grimaldi*, highly acclaimed actress, dancer, and singer Ginger Rogers, who performed with Hollywood star Fred Astaire, claimed the defendants violated her right of publicity and Lanham Act rights when they released a film entitled “Ginger and Fred”—a fictional tale of two Italian cabaret performers who imitated the famous duo.<sup>121</sup> The Second Circuit devised the *Rogers* test, which examines whether the use of one’s name in the title of an artistic work is wholly unrelated to the underlying work.<sup>122</sup> This test was used to balance First Amendment interests against a Section 43(a) Lanham Act claim<sup>123</sup> and a right-of-publicity claim. The court applied the following two-part test for balancing falsity claims against free speech:

In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the Act [1] unless the title has no artistic relevance to the underlying work whatsoever, or, [2] if it has some artis-

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<sup>119</sup> MCCARTHY, *supra* note 1, § 8.72 (“The California Supreme Court expressed the ‘transformative’ test in terms that will unfortunately prove extremely difficult to predict and apply because it requires a court to make an aesthetic judgment about the challenged artistic use.”).

<sup>120</sup> *Comedy III Prods., Inc. v. Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001).

<sup>121</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 996–97 (2d Cir. 1989).

<sup>122</sup> *Id.* at 1004.

<sup>123</sup> Section 43(a) of the Lanham Act creates civil liability for

[a]ny person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact.

15 U.S.C. § 1125(a) (2012).

tic relevance, unless the title explicitly misleads as to the source or the content of the work.<sup>124</sup>

The court applied the two-part test and concluded Ginger Rogers could not prevent the use of her name in the title of the fictional film.<sup>125</sup>

The *Rogers* test is the leading and most appropriate test in cases in which the court must balance First Amendment interests with protections of parties' rights under the Lanham Act. While courts continue to apply the *Rogers* test to the use of trademarks in the titles of artistic or expressive works,<sup>126</sup> courts have since extended the test to the uses of trademarks in the actual content of artistic works.<sup>127</sup> However, most courts have rejected this test for right-of-publicity cases because it includes a falsity element,<sup>128</sup> which is not a requirement under right-of-publicity laws,<sup>129</sup> and because it lacks any evaluative criteria.<sup>130</sup>

For the same reasons, it is an unavailing test for right-of-publicity cases concerning a persona tattoo. If the celebrity's tattoo is identifiable as indicia of the tattoo bearer and a third party commercially uses the celebrity's tattoo, then the relationship of the tattoo to the work in which it appears is irrelevant. If relevance was a factor in the balancing of the First Amendment and right-of-

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<sup>124</sup> *Rogers*, 875 F.2d at 999.

<sup>125</sup> *Id.* at 1005.

<sup>126</sup> *Parks v. LaFace Records*, 329 F.3d 437, 461 (6th Cir. 2003). In *Parks*, the Sixth Circuit held that hip-hop musical group OutKast's use of Rosa Parks' name in the title of a song was "trademark use" and defendant's use of the mark could cause consumers to falsely believe that Rosa Parks was affiliated with or approved of the song. *Id.* at 448–49. The court applied the *Rogers* test in this case. It identified the critical issue as "a determination of the artistic relevance of the title, Rosa Parks, to the content of the song," which required an analysis of the song's lyrics "in their entirety." *Id.* at 442. According to the court, apart from the line "move to the back of the bus" repeated throughout, the song otherwise was not intended to be and was not about Rosa Parks, thus reasonable persons could find no connection between the use of Rosa Parks's name in the title and the song itself. *Id.* at 452–53. The court chose the *Rogers* test, over "likelihood of confusion" test, the traditional test for trademark cases, and the "alternative avenues" test, as the proper approach for balancing First Amendment interests with the false advertising claim under the Lanham Act because the other two approaches did not give "adequate weight to the First Amendment interests in the case." *Id.* at 448–49. The court then applies the *Rogers* test to Parks's right-of-publicity claim as well, without any independent analysis of or reasoning for the application of the test to the publicity claim, and supplements the use of the *Rogers* test with support from the Restatement's relatedness test. *See id.* at 461.

<sup>127</sup> *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) ("Although this test traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why it ought not also apply to the use of a trademark in the body of the work."); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 495 (2d Cir. 1989) (holding that the *Rogers* test is "generally applicable to Lanham Act claims against works of artistic expression").

<sup>128</sup> MCCARTHY, *supra* note 1, § 4:53.

<sup>129</sup> *Parks*, 329 F.3d at 460 ("[A] right of publicity claim does differ from a false advertising claim in one crucial respect; a right of publicity claim does not require any evidence that a consumer is likely to be confused.").

<sup>130</sup> *Lee*, *supra* note 37, at 485.

publicity interests, then allowing commercial use of a celebrity's identity because it happens to be relevant would undermine a celebrity's (and a court's) ability to protect against the exploitation of the very subject matter that the right of publicity was created to preserve.<sup>131</sup> In addition, whether the public is misled or confused as to the source or content of the work, while critical to a Lanham Act claim, is unimportant to the analysis of a right-of-publicity claim.<sup>132</sup>

### C. *The Relatedness Test*

The Restatement (Third) of Unfair Competition prescribes the Relatedness test, which protects the use of one's identity in an expressive work unless the "name or likeness is used solely to attract attention to a work that is not related to the identified person."<sup>133</sup> This test is representative of the breadth of the scope of First Amendment protection set forth in the Restatement. For example, the Restatement first states that "[t]he use of a person's identity primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation of the person's right of publicity."<sup>134</sup> It then lists a multitude of uses of a person's identity that would not "generally" infringe the right of publicity: (1) news reporting, whether in newspapers, magazines, or broadcast news; (2) entertainment and other creative works, such as novels, plays, or motion pictures, both fiction and nonfiction; and (3) articles published in fan magazines or in feature story broadcasts on an entertainment program.<sup>135</sup> Such overgeneralizations are not helpful in an analysis where the use of a work is both expressive and commercial.<sup>136</sup> The Restatement's broad sweep of protected activities does not amount to much of a test and swings the pendulum too far away from right-of-publicity interests. Further, the singular criteria of "relatedness" would potentially favor exploitative uses of a persona tattoo if the third-party user even tangentially relates the work to the celebrity.

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<sup>131</sup> Gervais & Holmes, *supra* note 67, at 213 ("The *Rogers* test seems to protect First Amendment principles at the expense of the natural rights an individual possesses in her identity.").

<sup>132</sup> *Id.* at 199–200 ("Rationales that are used to justify trademark law should not be offered to justify the right of publicity simply because the two rights seem similar. . . . '[S]ome courts have failed to see the important distinctions and have unthinkingly imported certain inapplicable pieces of trademark doctrine into right of publicity cases . . . .'" (quoting *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 155 (3d Cir. 2013))); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. b (AM. LAW INST. 1995) ("Proof of deception or consumer confusion is not required for the imposition of liability under this Section.").

<sup>133</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (AM. LAW INST. 1995).

<sup>134</sup> *Id.*

<sup>135</sup> *Id.*

<sup>136</sup> *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (en banc).

The Relatedness test has been referred to as a version of, or another name for, the *Rogers* test.<sup>137</sup> However, courts typically have used the Relatedness test as support for the *Rogers* test or other balancing approaches instead of employing it as an independent test for balancing First Amendment and trademark interests.<sup>138</sup> The Relatedness test is not the equivalent of the *Rogers* test. Indeed, the sole criterion—whether the use is solely to attract attention to a work unrelated to the person—embodies the first prong of the *Rogers* test: relevance. The second prong—an examination of whether the relevant use is nevertheless an explicitly misleading use—is not present in the Restatement’s Relatedness test.

The Relatedness test alone is not the proper test for the balancing of First Amendment interests and right-of-publicity claims. It does not amount to much of a test; it protects “related” uses and lists broad categories of protected subject matter. Furthermore, the Relatedness test—whether applied as a duplicate or version of the *Rogers* test—is an inappropriate test for balancing the aforementioned competing interests for the same reasons that the *Rogers* test is ill-suited to do so.

#### D. *Predominant Use Test*

The Supreme Court of Missouri was the first to recognize and employ the “predominate use” test, adopted from the following proposed approach set forth

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<sup>137</sup> Thomas E. Kadri, Comment, *Fumbling the First Amendment: The Right of Publicity Goes 2–0 Against Freedom of Expression*, 112 MICH. L. REV. 1519, 1525 (2014) (“Sometimes called the *Rogers* test, sometimes the *Restatement* test, it usually appears in the context of trademark law.”). Kadri recommends the *Rogers* test over the Transformative Use test because it is a “bright-line test.” *Id.* However, Kadri’s recharacterization of the *Rogers* test for right-of-publicity claims mistakenly assumes that the speech at issue (or more appropriately, the use at issue) can be classified as “purely commercial” or expressive. *Id.* The refined *Rogers* test would be applied to expressive, or speech that is not purely commercial, but the test would still require inquiries regarding whether the use is “‘wholly unrelated’ to the content of the work or is ‘simply a disguised commercial advertisement for the sale of goods or services.’” *Id.* The pitfalls of this test’s application to right-of-publicity claims are the same as the current *Rogers* test. First, it requires judges to critique the artistry of the work in order to determine the relevance of the use to the work. Second, even if the use is relevant to the work, it continues to require a misleading element. The first prong raises the same concerns of subjectivity and unreliability as the Transformative Use test. The second prong, while appropriate for balancing First Amendment interests with Lanham Act claims, which protect against likelihood of confusion and false, misleading uses, is ill-suited to balance free speech interests with right-of-publicity claims.

<sup>138</sup> *Parks v. Laface Records*, 329 F.3d 437, 461 (6th Cir. 2003) (noting the *Rogers* test is supported “in the context of other expressive works by comment c of § 47 of the *Restatement (Third) of Unfair Competition*”); *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 936 (6th Cir. 2003) (concluding that it “look to” Ohio state law and the Third Restatement of Unfair Competition to determine whether Tiger Woods has a right-of-publicity claim but adopts the Transformative Use test as its balancing approach). *But see*, *Seale v. Gramercy Pictures*, 964 F. Supp. 918, 930 (E.D. Pa. 1997) (holding that the use of Seale’s likeness on the inside of a musical CD soundtrack was protected by the First Amendment under the Restatement’s Relatedness test).

in Mark S. Lee's article, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity—Free Speech Interface*:<sup>139</sup>

If a product is being sold that predominantly exploits the commercial value of an individual's identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some "expressive" content in it that might qualify as "speech" in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.<sup>140</sup>

In *Doe v. TCI Cablevision*, the court found that the use of the name and identity of professional hockey player Anthony "Tony" Twist for a character named Anthony "Tony Twist" Twistelli in the Spawn comic book series was "predominantly a ploy to sell comic books and related products rather than an artistic or literary expression."<sup>141</sup> In this case, the court rejected other balancing tests because of their failure to properly accommodate right-of-publicity interests.<sup>142</sup> After applying the Predominant Use test, the court concluded that the right-of-publicity interests outweighed First Amendment interests.<sup>143</sup> The court appropriately focused on the use of the celebrity's name and likeness in the comic book, not the comic book itself.<sup>144</sup>

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<sup>139</sup> Lee, *supra* note 37, at 500.

<sup>140</sup> *Doe*, 110 S.W. 3d at 374 (quoting Lee, *supra* note 37, at 500), *aff'd*, *Doe v. McFarlane*, 207 S.W. 3d 52, 56 (Mo. Ct. App. 2006) (affirming jury award for damages for use of name and identity of professional hockey player Anthony "Tony" Twist as comic book character Anthony "Tony Twist" Twistelli).

<sup>141</sup> *Id.*

<sup>142</sup> *Id.*

The weakness of the Restatement's 'relatedness' test and California's 'transformative' test is that they give too little consideration to the fact that many uses of a person's name and identity have both expressive and commercial components. These tests operate to preclude a cause of action whenever the use of the name and identity is in any way expressive, regardless of its commercial exploitation. Under the relatedness test, use of a person's name and identity is actionable only when the use is solely commercial and is otherwise unrelated to that person. Under the transformative test, the transformation or fictionalized characterization of a person's celebrity status is not actionable even if its sole purpose is the commercial use of that person's name and identity. Though these tests purport to balance the prospective interests involved, there is no balancing at all—once the use is determined to be expressive, it is protected.

*Id.*

<sup>143</sup> *Id.*

<sup>144</sup> *Id.* While there has been criticism of the application of the Predominant Use test in this particular instance (and the court's decision as a result of the application of the test), this Article does not agree with the basis of that criticism. See Tushnet, *supra* note 108, at 167 ("Remarkably, the court found that the entire comic book Spawn was predominantly an exploitation of Tony Twist (the hockey player), even though Tony Twist (the character) was a minor character in a story about an undead superhero who had been released from Hell."). Professor Rebecca Tushnet observes that the entire book was at issue and the Tony Twist character was a minor character in the Spawn story. *Id.* Yet, she goes on to assume that the Missouri Supreme Court was solely persuaded by the promotion of the comic book at hockey events. *Id.* at 167, n.53.



Twist made a submissible case that respondents' use of his name and identity was for a commercial advantage. Nonetheless, there is still an expressive component in the use of his name and identity as a metaphorical reference to tough-guy "enforcers." And yet, respondents agree (perhaps to avoid a defamation claim) that the use was not a parody or other expressive comment or a fictionalized account of the real Twist. As such, the metaphorical reference to Twist, though a literary device, has very little literary value compared to its commercial value.<sup>145</sup>

Ultimately, the court concluded that the predominant purpose for the use of the Tony Twist name was to sell comic books and promotional products, not make an expressive comment about the hockey player. Therefore, the *use* was not entitled to First Amendment protection.<sup>146</sup> The court did not hold that the comic book itself, which consisted of expression other than the Twist character, was not entitled to the protection of the First Amendment. The court was presented with evidence of commercial use of Twist's identity beyond the promotion of the comic book at hockey events: (1) Tony Twist, the hockey player, submitted evidence suggesting that the defendants marketed their hockey products, which included images of the Tony Twist character, to hockey fans and (2) defendants sponsored a "Spawn Night" at a hockey event, where defendant Todd McFarlane personally distributed such products. Finally, and probably most important, plaintiff submitted evidence of actual diminution of his commercial value as an endorser of products—a former executive of a sports nutrition company "testified that his company withdrew a \$100,000 offer to Twist to serve as the company's product endorser after [he] learned that Twist's name was associated with the evil Mafia don in the *Spawn* comic book."<sup>147</sup> While the Tony Twist character may have been a minor part of the comic book, the character was prominently featured in the promotion of the book and merchandise. Further, the promotion and sale of the products, which ultimately and purposefully drew greater attention to the Twist character in the comic book, negatively affected the economic value of Tony Twist the hockey player. Damage is presumed from unauthorized use,<sup>148</sup> but this is an instance in which the plaintiff actually had evidence of damage.<sup>149</sup> The prevention of damage to the economic value of a celebrity's image is the very purpose of right-of-publicity laws. Thus, the primary or predominant purpose of the comic book's use of the Twist character was a commercial use. This Article asserts that the court did not err in upholding the damages award for the comic book itself.<sup>150</sup>

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<sup>145</sup> *Doe*, 110 S.W. 3d at 374.

<sup>146</sup> *Doe v. McFarlane*, 207 S.W. 3d 52, 61 (Mo. Ct. App. 2006).

<sup>147</sup> *Doe*, 110 S.W. 3d at 367.

<sup>148</sup> MCCARTHY, *supra* note 1, § 3:2.

<sup>149</sup> *Id.* However, "[i]f plaintiff seeks the recovery of damages, then commercial damage must be proved and quantified." *Id.*

<sup>150</sup> *Doe*, 207 S.W. 3d at 76.

Even though Lee's conception of the test focuses on whether there should be First Amendment protection of the "product,"<sup>151</sup> here an expressive work, the Missouri Supreme Court appropriately narrowed its focus to the protection of the use within the product. This Article agrees with the application, particularly when the "product" is an expressive work. If the test is applied in this way, it is the most appropriate test for the accommodation of free speech and right-of-publicity interests. Unlike the Transformative Use test, it is clear that the relevant expressiveness to be analyzed under the Predominant Use test is the use, not the work itself. An examination of the context of the use in the balancing of First Amendment and right-of-publicity interests invites the subjective, unpredictable critique of the work itself, as evidenced in the multi-step process of the Transformative Use test.

In addition, the Predominant Use test properly inquires into the mixed expressive and commercial uses of a person's identity, rather than placing undue focus on the expressive context of the use. It is clear that the test is intended to address the complexities of the use of a celebrity's identity in modern media and prevent the First Amendment's trampling of the right of publicity.

The Predominant Use test has been criticized because the approach is "primarily concerned with . . . whether the use was commercial" and implicitly concludes "that at least some expressive speech has no First Amendment value."<sup>152</sup> To the contrary, this test properly recognizes that there are often both expressive and commercial uses of an identity. The originator of this approach stated that the proper inquiry is the subject of the exploitation—the commercial value of the celebrity's identity or expressive commentary on or about the celebrity.<sup>153</sup>

The *Doe* court's application of the Predominant Use test is the appropriate test for balancing First Amendment and right-of-publicity interests, including persona tattoo publicity cases. The case refines the Predominate Use test—viewing the use of indicia of the celebrity's identity (e.g., the tattoo in this case) in an expressive work as the potential violation of the right of publicity, not the work itself. This refinement best addresses the challenges of assessing mixed commercial and expressive uses of a celebrity's identity and preserves a true accommodation of the competing interests. If the predominant use of the tattoo is a commercial one, an exploitation of the associative value of the celebrity's identity, then the right of publicity should protect against such use. However, if

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<sup>151</sup> Lee confirmed that the term "product" set forth in the proposed balancing test set forth in his article, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity—Free Speech Interface*, refers to "the entirety of the work in which someone's right of publicity was used." E-mail from Mark S. Lee, Partner, Manatt, Phelps & Phillips, to Yolanda M. King, Assoc. Professor of Law, N. Ill. Univ. Coll. of Law (Mar. 9, 2015, 11:04) (on file with author).

<sup>152</sup> Smith, *supra* note 32, at 2091–92.

<sup>153</sup> Lee, *supra* note 37, at 500–01.

the predominant use of the tattoo is for an expressive purpose, then the First Amendment should prevail.

#### CONCLUSION

If a celebrity's tattoo becomes indicia of that celebrity's identity, then the tattoo is now a part of the protectable right of publicity of that celebrity. Thus, a tattoo is a rare instance of a publicity right born from a copyrightable work. A celebrity tattoo bearer should be able to bring a right-of-publicity claim based on the commercial use of his or her tattoo by a third party. The prevalence of tattooing among celebrities, coupled with the growing interest in the commercialization of tattoos, increases the likelihood of this type of right-of-publicity lawsuit in the future. Courts should employ the Predominant Use test in order to properly accommodate the mixed commercial and expressive uses of a celebrity's tattoo and prevent the First Amendment's eclipsing of the right of publicity.