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What's Mine is Mine but What's Yours is Ours: IP Imperialism, the Right of Publicity, and Intellectual Property Social Justice in the Digital Information Age

Lateef Mtima*

“THAT the individual shall have full protection in person and in property is a principle as old as the common law; but it has been found necessary from time to time to define anew the exact nature and extent of such protection. Political, social, and economic changes entail the recognition of new rights, and the common law, in its eternal youth, grows to meet the demands of society.”¹

PART I: INTRODUCTION

The classic conflict over enforcement of intellectual property rights continues today as a struggle between the “IP haves” and the so-called “IP have-nots.”² Those nations that have canonized the products of their creative and innovative endeavors as forms of property insist that these boundaries be held sacrosanct by all others.³ The societies and communities that have not applied such status to their cultural and inventive output, however, often regard such restrictions as incomprehensible, unreasonable, or simply unfair.⁴ While there can be many reasons for hostility toward intellectual property protection, a frequent cause is that intellectual property characterization and

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1. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 193 (1890).
2. Peter K. Yu, *The Copyright Divide*, 25 CARDOZO L. REV. 331, 403 (2003); *See, e.g.*, Llewellyn Joseph Gibbons, *Do as I Say (Not as I Did): Putative Intellectual Property Lessons for Emerging Economies from the Not So Long Past of the Developed Nations*, 64 SMU L. REV. 923, 924–25 (2011); Beryl R. Jones, Symposium, *An Introduction to the European Economic Community and Intellectual Properties*, 18 BROOK. J. INT'L L. 665, 687 (1992); Geoffrey R. Scott, *A Comparative View of Copyright as Cultural Property in Japan and the United States*, 20 TEMP. INT'L & COMP. L.J. 283, 357–58 (2006); Peter K. Yu, *Three Questions That Will Make You Rethink the U.S.-China Intellectual Property Debate*, 7 J. MARSHALL REV. INTELL. PROP. L. 412, 412 (2008).
3. *See* Jones, *supra* note 2, at 665.
4. *See, e.g.*, Alexandra G. Watson, Note, *International Intellectual Property Rights: Do TRIPS' Flexibilities Permit Sufficient Access to Affordable HIV/AIDS Medicines in Developing Countries?*, 32 B.C. INT'L & COMP. L. REV. 143 (2009).

rights enforcement seem to be promoted and respected only when it serves the interests of those invested in particular intellectual property regimes.⁵

While some scholars and commentators attempt to analyze and pose solutions to these conflicts as problems of technological and cultural incompatibility (*i.e.*, technologically and economically advanced societies naturally appreciate the need for strong intellectual property (“IP”) rights; unsophisticated, developing societies do not get it, but with education they can be uplifted into the fold),⁶ the issue is really not that complex. Many contemporary IP rights conflicts are simply the result of enduring attitudes of

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5. See Yu, *Three Questions That Will Make You Rethink the U.S.-China Intellectual Property Debate*, *supra* note 2, at 414 n.8.
 6. See Peter K. Yu, *Intellectual Property Rulemaking in the Global Capitalist Economy*, in *THE INTELLECTUAL PROPERTY RIGHT DOMAIN IN CONTEMPORARY CAPITALISM* 1, 3 (Birgitte Andersen ed., Routledge forthcoming 2012) (adapted from Peter K. Yu, *The International Enclosure Movement*, 82 *IND. L.J.* 827 (2007).), available at www.peteryu.com/andersen.pdf; Cynthia M. Ho, *Biopiracy and Beyond: A Consideration of Socio-Cultural Conflicts with Global Patent Policies*, 39 *U. MICH. J. L. REFORM* 433, 533 (2006) (“[B]ecause [non-Western] objections to patents sometimes stem from misunderstanding the underlying science, as well as a misunderstanding of patent rights, providing patent owners with the ability to clarify issues would be in the best interests of all.”); Chidi Oguamanam, *Beyond Theories: Intellectual Property Dynamics in the Global Knowledge Economy*, 9 *WAKE FOREST INTELL. PROP. L.J.* 104, 119 (2009); Mark Schultz & Alec van Gelder, *Creative Development: Helping Poor Countries by Building Creative Industries*, 97 *KY. L.J.* 79, 81 (2009) (“Most discussions about intellectual property and development tend to center on high-level, somewhat abstract debates about technology transfer, relations between rich and poor countries, the fairness of the international intellectual property system, and concerns about distributive justice.”); Yu, *The Copyright Divide*, *supra* note 2, at 402 (“Copyright law has always been about stakeholders. In the late nineteenth century, Anthony Trollope blamed American book piracy on ‘the book-selling leviathans.’ A century later, Professor Jessica Litman told us that ‘[t]he only way that copyright laws get passed in this country is for all of the lawyers who represent the current stakeholders to get together and hash out all of the details among themselves.’ Since then, commentators have discussed at length the gaps between the ‘copyright-rich’ and ‘copyright-poor’ and between the haves and have-nots in the copyright system. . . . Today, a *copyright divide* exists between those who have stakes in the existing copyright regime and those who do not. On one side of the divide are the stakeholders, who are eager to protect what they have under the existing regime. . . . On the other side of the divide are the nonstakeholders. These nonstakeholders neither understand nor believe in the copyright system. . . . Unless the nonstakeholders understand why copyright needs to be protected and until they become stakeholders or potential stakeholders, they will not be eager to abide by copyright laws or to consent to stronger copyright protection.” (emphasis added)).

Western Imperialism.⁷ Summarily put: that which I possess, and which incidentally provides me some measure of power, dominance, or other advantage, should be afforded protected, property-right status, and that status should be recognized and revered by universal law. On the other hand, that which *you* possess, should I desire it, should be ecumenically acknowledged as freely available to any and all who are capable of developing and applying it to “productive” use (such as the use that I intend to undertake).⁸

In other words, what’s mine is mine; what’s yours is ours.

Today, such attitudes and policies of Western “IP Imperialism” not only account for many international clashes over intellectual property rights and protections, but also fuel many domestic IP controversies in the American digital information society.⁹ Although the vested, corporate purveyors of intellectual property commodities consistently call for stronger IP protections whenever their property interests are at stake, when it comes to outsider in-

7. See Doris Estelle Long, *Traditional Knowledge and the Fight for the Public Domain*, 5 J. MARSHALL REV. INTELL. PROP. L. 617, 620 (2006) (“One of the interesting things in talking to indigenous peoples about the public domain is the response they provide. The concept of the public domain does not currently exist in many indigenous communities except in the form of ‘your public domain’ versus ‘my cultural heritage.’ When asked, indigenous peoples often respond with the same question. ‘How come “public domain” is my stuff? Yours is copyrightable and mine is in the public domain. How did that happen?’ The answer, of course, is that we have developed a nice approach to protection. New works get protected. Their works have been around too long. Therefore, we all get to use them.”); *Imperialism Definition*, DICTIONARY.COM, <http://dictionary.reference.com/browse/imperialism> (last visited Oct. 8, 2012) (“[T]he policy of extending the rule or authority of an empire or nation over foreign countries, or of acquiring and holding colonies and dependencies.”).
8. See Christopher May, *Commodifying the ‘Information Age’: Intellectual Property Rights, the State and the Internet*, 1 SCRIPT-ED, no. 3, 2004, at 408, 411 (U.K.), available at <http://www.law.ed.ac.uk/ahrc/script-ed/issue3/May.doc> (“[W]hile the [TRIPs] agreement imposes a complex and wide ranging set of requirements on signatories, at the core is a particular set of norms regarding the treatment of knowledge as property. These norms underpin the entire agreement and are based on the notion that the private ownership of knowledge as property is a major spur to continued economic development and social welfare. They further emphasise the development of knowledge as an individualised and proprietorial endeavour, and the legitimate reward of such individualised effort. Most obviously TRIPs includes a robust norm of commodification of knowledge and information, which in itself should alert us to the fact that the ‘information age’ is capitalist business-as-usual, utilising previously established legal structures to ensure that capitalists’ ability to commodify important and profitable assets and resources continues into the so-called ‘information age.’”).
9. Long, *Traditional Knowledge and the Fight for the Public Domain*, *supra* note 7, at 617-18.

ventive or expressive endeavors, they typically take the opposite position.¹⁰ Public engagement in new technological uses for traditional, corporate-controlled intellectual properties should be restricted and curtailed; unauthorized commercial development and exploitation of newer and non-traditional intellectual properties should be unrestricted and encouraged. And, if intellectual property protection is to be extended into new areas, any attendant property rights and interests should be made subordinate to the IP rights and other interests that sustain and perpetuate the entrenched IP establishment.¹¹

Some current conflicts in the still-developing field of publicity rights provide illustrative examples of the IP Imperialist viewpoint. As a relatively new and innately personal kind of intellectual property, publicity rights are usually beyond the immediate reach of corporate IP entities. Consequently, it is in the best interest of these entities for publicity rights to be narrowly construed. The more narrow the scope of the right of publicity, the more likely that many new and existing means for commercially misusing individ-

10. See Patrick Fogarty, *Major Record Labels and the RIAA: Dinosaurs in a Digital Age?*, 9 Hous. Bus. & Tax L.J. 140, 141 (2008); Neil Weinstock Netanel, *Impose a Noncommercial Use Levy to Allow Free Peer-to-Peer File Sharing*, 17 HARV. J.L. & TECH. 1, 26 (2003); Ankur Srivastava, *The Anti-Competitive Music Industry and the Case for Compulsory Licensing in the Digital Distribution of Music*, 22 TOURO L. REV. 375, 384–85 (2006); Sara M. Ford, Note & Comments, *Compulsory Licensing Provisions under the TRIPS Agreement: Balancing Pills and Patents*, 15 AM. U. INT'L L. REV. 941, 946 (2000); Michael Cieply, *Support for Antipiracy Bill*, N.Y. TIMES (May 15, 2011, 8:23 PM), available at <http://mediadecoder.blogs.nytimes.com/2011/05/15/support-for-antipiracy-bill/>; David Leonhardt, *The Real Problem With China*, N.Y. TIMES, Jan. 11, 2011, at B1, available at <http://www.nytimes.com/2011/01/12/business/economy/12leonhardt.html>; *Microsoft Calls for Stronger IP Protection*, THOMASNET (May, 23 2011), <http://news.thomasnet.com/companystory/Microsoft-Calls-for-Stronger-IP-Protection-847229> (last visited Oct. 8, 2012). Many of these efforts have resulted in various amendments to American intellectual property laws. See, e.g., Anticybersquatting Consumer Protection Act (ACPA), 15 U.S.C. § 1125(d) (2006); Trademark Dilution Revision Act of 2006 (TDRA), Pub. L. No. 109–312, 120 Stat. 1730 (2006) (codified as amended in scattered sections of 15 U.S.C.); Digital Millennium Copyright Act (DMCA), Pub. L. No. 105–304, 112 Stat. 2860 (1998) (codified as amended in scattered sections of 5, 17, 28, & 35 U.S.C.); See also Preventing Real Online Threats to Economic Creativity and Theft of Intellectual Property (PROTECT IP) Act of 2011, S.968, 112th Cong. (2011) (as introduced in Senate, May 12, 2011); Patent Reform (America Invents) Act of 2011, S.23, 112th Cong. (2011) (as passed in Senate, Mar. 8, 2011).
11. See, e.g., *Laws v. Sony Music Entm't, Inc.*, 448 F. 3d 1134, 1140-41 (9th Cir. 2006) ; See also *Jules Jordan Video, Inc. v. 144942 Canada Inc.*, 617 F.3d 1146, 1154-55 (9th Cir. 2010); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460, 462-63 (9th Cir. 1988); *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 717-718 (9th Cir. 1970).

ual personas and images will be held outside the parameters of the right, and thus available for exploitation by anyone with the means to develop and commercialize these uses.¹² When new technological uses are introduced in connection with intellectual property under corporate dominion, however, it is vehemently argued that these uses should be relegated to the province and control of the IP rights holder.¹³

This article discusses how IP Imperialism is a socially and politically pernicious policy that contravenes the social utility and social justice objectives underlying American intellectual property law,¹⁴ including those mores advanced through the right of publicity. Part II briefly discusses the origins and evolution of IP Imperialism in the American intellectual property psyche and its historical role in the formation of American IP law and policy.¹⁵ Part III focuses specifically on the right of publicity, its doctrinal facets and social

12. Anastasios Kaburakis, et al., *NCAA Student-Athletes' Rights of Publicity, EA Sports, and the Video Game Industry: The Keller Forecast*, 27 ENT. & SPORTS Law. no. 2, 2009, at 30, available at <http://www.kaburakis.com/wp-content/uploads/2009/09/kaburakis.pdf>; Pete Thames, *N.C.A.A. Fails to Stop Licensing Lawsuit*, N.Y. TIMES, Feb. 9, 2010, at B4, available at <http://www.nytimes.com/2010/02/09/sports/ncaabasketball/09ncaa.html>; Katie Thomas, *Ex-Players Join Suit vs. N.C.A.A.*, N.Y. TIMES, Mar. 11, 2010, at B15, available at <http://www.nytimes.com/2010/03/11/sports/ncaabasketball/11colleges.html>.
13. Of course, this is not a new trend. See *Fortnightly Corp. v. United Artists TV, Inc.*, 392 U.S. 390, 395 (1968); *Teleprompter Corp. v. Columbia Broad. Sys., Inc.*, 415 U.S. 394, 402–03 (1974); *Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316, 1318 (9th Cir. 1998), holding modified by *Yahoo! Inc. v. La Ligue Contre Le Racisme Et L'Antisemitisme*, 433 F.3d 1199, 1207 (9th Cir. 2006); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 420 (1984); *Sony Computer Entm't Am., Inc. v. Gamemasters*, 87 F. Supp. 2d 976, 977 (N.D. Cal. 1999); *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1013 (9th Cir. 2001); *i4i Ltd. P'ship v. Microsoft Corp.*, 598 F.3d 831, 839 (Fed. Cir. 2010) cert. granted, 131 S. Ct. 647 (2010) and *aff'd*, 131 S. Ct. 2238 (2011).
14. See, e.g., Netanel, *supra* note 10, at 77–78 (“[C]opyright industries have repeatedly exhibited a path-dependent resistance to licensing or engaging in new technological methods of exploitation that might endanger their traditional profit centers. Indeed, they have a long history of Seeking to reap monopoly rents through anticompetitive collusion, blocking new entrants, and paying off gatekeepers for consumer attention. In the multimedia and Internet contexts, copyright industries have also engaged in protracted cross-sectoral turf battles, leaving would-be licenSees with the highly complex, costly task of Seeking multiple, overlapping permissions. This institutional conservatism and balkanization does not inspire confidence that, if only given control, the industries would make their full store of cultural expression readily available at reasonable prices.”).
15. See *infra* Part II.

utility/social justice functions, and its potential to be utilized as a counterweight to the IP Imperialist agenda.¹⁶

In Part IV, four cases are analyzed as presenting important opportunities to further IP social justice through the right of publicity.¹⁷ The first three cases demonstrate how such opportunities can be lost when courts fail to consider the IP social utility and social justice functions of publicity rights.¹⁸ The fourth case, however, illustrates how IP social utility/social justice cognizance can lead to more socially balanced (and counter-imperialistic) outcomes.¹⁹

Finally, Part V attempts to construct an IP social justice framework for evaluating and resolving right of publicity claims.²⁰ This Part delineates a right of publicity social justice analytical spectrum, and identifies important IP social justice issues and opportunities that courts should be sensitive to in adjudicating right of publicity conflicts and disputes.²¹

PART II: THE RISE OF AMERICAN IP IMPERIALISM

A. Early American IP Policies: What's Yours is Ours

In America's nascent years, quasi-imperialistic attitudes²² toward intellectual property rights were seen as serving the country's immediate interests as a developing nation. The colonial pioneers did not have much intellectual property of their own to protect,²³ but there was a storehouse of pre-existing

16. *See infra* Part III.

17. *See infra* Part IV.

18. *See Brown v. Elec. Arts, Inc.*, Case No. 2:09-cv-01598-FMC-RZx, 2009 U.S. Dist. LEXIS 131387 (C.D. Cal. Sept. 23, 2009) (citation to original unpublished order available from District Court; version available at 722 F. Supp. 2d 1148 not available at the time of authorship); *Brooks v. Topps Co.*, 86 U.S.P.Q.2d (BNA) 1361 (S.D.N.Y. 2007); *Laws v. Sony Music Entm't*, 448 F.3d 1134 (9th Cir. 2006).

19. *See Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3d Cir. 2008).

20. *See infra* Part V.

21. *See infra* Part V.

22. While America's IP policies were certainly self-serving at this point, they were only "quasi-imperialistic" given that (i) there was no "what's mine is mine" element to those policies at this juncture, and (ii) the imperialistic element of conquest was absent. Given the historical relationship between America and her former colonial rulers, the misappropriation in this instance was more akin to underage teens taking the keys to the family car without permission.

23. BILL IVEY, ARTS, INC.: HOW GREED AND NEGLECT HAVE DESTROYED OUR CULTURAL RIGHTS 3 (2008) ("Before 1900 the American extension of [its] cultural mainstream, when measured against its European antecedents, came up short—a thin trickle compared to its Old World headwaters. In the eighteenth and nineteenth centuries the artistic achievements dotted across our hardscab-

protected material that could be critical to the new nation's cultural advancement and technological development.²⁴ The great works of literature and innovative technological achievements of the day were considered to emanate from Europe, and the colonists did not see anything wrong with appropriating these achievements in the cause of American national progress.²⁵ Having fought a war to gain independence from British control, America's leaders and populace were not overly concerned with the trivialities of foreign rights in intangible property, especially if such rights stood in the way of nation building.²⁶ And surely if it seemed reasonable to capture, enslave, and otherwise subjugate and degrade other people in the cause of American agricultural and industrial "progress," the misappropriation of a few stories and songs was hardly an affront to the national conscience.²⁷

ble frontier didn't add up to anything approximating the scope and quality found in Europe. True, colonial artisans designed a few gracefully rendered utilitarian objects—well-crafted furniture and elegantly understated silverware and serving pieces; in addition, some notable buildings executed in the classical revival style were scattered through Washington, DC, and other big cities. A few master painters of landscapes and portraits had emerged but not a unique New World vision. America still measured itself against European leadership in the visual arts.”).

24. See, e.g., Gibbons, *supra* note 2, at 936–40 (discussing widespread American IP piracy during the nation's formative era.); Yu, *The Copyright Divide*, *supra* note 2, at 336–44 (same).
25. Such misappropriation policies, however, were a double-edged sword. See IVEY, *supra* note 23, at 3 (“By the mid-1800s an indigenous American literary voice could be heard, but even writers who had been at work for decades had only begun to achieve recognition that approached that of their European and English counterparts. (This situation was abetted by the widespread piracy of English titles by U.S. publishers. By ignoring copyright and paying no royalties to European and British authors, prices of U.S. editions of foreign works were consistently lower than their homegrown counterparts.)”); Yu, *The Copyright Divide*, *supra* note 2, at 345.
26. See Charles H. Norchi, Symposium, *The Legal Architecture of Nation-Building: An Introduction*, 60 ME. L. REV. 281, 289 (2008) (“Nation-builders drafting constitutional texts and codified laws must sift through both the myth system and the operational code in order to determine which processes of community decisions are both authoritative and controlling. A newly drafted constitution may be a myth while what people actually do in informal settings is the accepted code of operation.”).
27. See, e.g., KENNETH M. STAMPP, *THE PECULIAR INSTITUTION: SLAVERY IN THE ANTE-BELLUM SOUTH 196-97* (1956) (“In the customary phraseology of the ante-bellum codes, South Carolina's slaves were ‘deemed, held, taken, reputed and adjudged in law to be chattels personal, in the hands of their owners and possessors and their executors, administrators and assigns, to all intents, constructions and purposes whatsoever.’ Slaves had the attributes of personal property everywhere, except in Louisiana (and Kentucky before 1852) where

Thus, notwithstanding the fact that the Founding Fathers provided for the granting of intellectual property rights in the very first article of the Constitution,²⁸ American disregard for the intellectual property rights of others prevailed throughout the nineteenth century.²⁹ As American inventors and authors became increasingly prolific in their own inventive and creative output, however, the attitudes toward protection for domestic innovative and expressive works evolved and the social benefit of providing secular incentives and rewards to authors and inventors began to be appreciated. With the advent of revolutionary means of mass production and distribution of such creations, the commoditization perception of intellectual property began to take root in the American socio-economic psyche:

To bring the lively arts to an increasingly eager public, a new American arts system and new “arts industries” grew dramatically during the first three decades of the twentieth century. . . . Music of all kinds made its way onto molded shellac 78 rpm discs, introduced by Columbia Records in 1904; by 1921 record sales totaled \$16 million, a figure that would increase tenfold over the next decade. In 1920 there were 20,000 silent movie theaters operating across the country, screens fed, in mid-decade, by fifteen film stu-

they had the attributes of real estate.”). Indeed, even as America began to appreciate the need for protecting her own intellectual property, her domestic intellectual property policies reflected the nation’s imperialistic ancestry. *See also* Keith Aoki, *Distributive and Syncretic Motives in Intellectual Property Law (With Special Reference to Coercion, Agency, and Development)*, 40 U.C. DAVIS L. REV. 717, 740–41 (2007) (“[T]he American patent system encouraged a more diverse composition of inventors through broadened access to opportunities for investing in, exploiting, and deriving income from inventive activity. However, because of the historical realities of race and slavery, the extent of this beneficial distributive impact on black inventors was illusory at best. . . . The early American patent system beckoned many poor white inventors to achieve wealth and recognition through a quasi-egalitarian patent system that facilitated investment in their lucrative ideas. The same opportunities did not await black inventors, whose contributions white society tended to ignore when the commercial value of a black invention was uncertain. In cases where commercial promise was more readily apparent, black inventions were subject to appropriation without attribution. State laws governing property and contract expressly precluded slaves from applying for or holding property. Presumably, this proscription included slaves being precluded from owning patents.”).

28. U.S. CONST. art. I, § 8, cl. 8 (bestowing upon Congress the authority “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”).
29. *See, e.g.*, Steven Wilf, *Copyright and Social Movements in Late Nineteenth-Century America*, 12 THEORETICAL INQUIRIES L. 123, 125 (2011). Indeed the United States politely declined participation in the Berne Convention and similar international intellectual property treaties and agreements.

dios. . . . But cultural change always exacts a price. The rise of vernacular art made possible by technology enriched America's expressive life, but the market-driven system producing films, records, and broadcasts evolved with little attention to the way the creation and distribution of art in America linked up to "Life, Liberty, and the Pursuit of Happiness." The problem lay not with these transforming technologies, and certainly not with the blues musicians, movie stars, and vaudevillians who provided early cultural "content." Instead, the public interest was subverted by the business practices that made up the rules and laid out the playing field for producing and consuming our modern mainstream culture.³⁰

Intellectual property protection became recognized as vital to American technological and cultural progress,³¹ and, moreover, safeguarding the means of production and distribution of IP commodities would soon be regarded as equally important as stimulating the production of intellectual property output.³² And thus the American IP Commoditization Precept was born. American intellectual property law and policy would become dominated by attitudes that regarded intellectual property works primarily as commodities to be invested in and commercially exploited for profit.³³ The aspirations and innovations of human hearts and minds were reduced to mere chattel.

30. Ivey, *supra* note 23, at 7, 9.

31. Wilf, *supra* note 29, at 125–26.

32. Ivey, *supra* note 23, at 11–12 ("Movies, records, and broadcasts became America's dominant expressive forms, but in most instances there was no single 'author' of these new arts products. So who would own the musical or dramatic content? The obvious answer was to place ownership and control of the finished product—the film, radio show, or disc—with the corporation that had assembled the creative team, financed the project, and distributed it to audiences. . . . The groundwork was firmly in place to permit corporations to, in effect, create and own the rights to new works of art. . . . Because corporations own or control some of the most representative and influential American art products of the past one hundred years, it should be no surprise that questions of ownership, access, gatekeeping, and price continually challenge any effort to understand and advance our cultural rights.").

33. See, e.g., Doris Estelle Long, "Democratizing" *Globalization: Practicing the Policies of Cultural Inclusion*, 10 *CARDOZO J. INT'L & COMP. L.* 217, 218 (2002) ("Culture and intellectual property appear to have gotten a divorce during the latter decades of the Twentieth Century."); Victoria F. Phillips, Symposium, *Commodification, Intellectual Property and the Quilters of Gee's Bend*, 15 *AM. U. J. GENDER SOC. POL'Y & L.* 359, 370–75 (2007); May, *supra* note 8, at 411 ("The rights of capitalists to commodify information and knowledge as they *See* fit are . . . regarded as the naturally 'just' rights of ownership. This attempts to raise commercial rights to exploit information and knowledge to the same level as human rights. Although this may be legitimate it is hardly un-

B. America as IP Super-Power: What's Mine is Mine

Germinated in the latter years of the nineteenth century, the American IP Commoditization Precept flowered into full-blown IP Imperialism in the twentieth century. In the global market place, the United States not only took its place in the international IP community,³⁴ but became a staunch advocate for the recognition of strong intellectual property rights, particularly as the nation shifted from a goods-based economy to an information-based one.³⁵

controversial, given that sometimes the exercise of these commercial rights is at the cost of the human rights of users.”). These attitudes and policies directly contradict the express social utility mandates of the Constitutional Intellectual Property Clause. *See, e.g.*, Lateef Mtima & Steven D. Jamar, *Fulfilling the Copyright Social Justice Promise: Digitizing Textual Information*, 55 N.Y.L. SCH. L. REV. 77, 80–86 (2010); David S. Olson, *Taking the Utilitarian Basis for Patent Law Seriously: The Case for Restricting Patentable Subject Matter*, 82 TEMP. L. REV. 181, 183 (2009); Edward T. Saadi, *Sound Recordings Need Sound Protection*, 5 TEX. INTELL. PROP. L.J. 333, 335–36 (1997) (“The United States Constitution explicitly grants to Congress the power to pass laws governing copyright. The purpose behind this grant of authority is to encourage the creation of works of artistic and scientific value by providing the incentive of an exclusive monopoly over the benefits of that creation for a limited time. The congressional purpose in granting these exclusive rights was purely utilitarian; it was not based upon the natural rights of authors in their works.”); Stacy F. Michelle Fowler, Note, *To Protect and . . . To Profit: The Trademarking of the LAPD as an Example of Expanding Intellectual Property Rights*, 74 S. CAL. L. REV. 1623, 1627, 1632 (2001); McDonald, Comment, *Copyright for Sale: How the Commodification of Intellectual Property Distorts the Social Bargain Implicit in the Copyright Clause*, 50 HOW. L.J. 541, 543 (2007).

34. *See, e.g.*, May, *supra* note 8, at 410.

35. *See, e.g.*, SHAYERAH ILIAS & IAN F. FERGUSON, CONG. RESEARCH SERV., RL 34292, *INTELLECTUAL PROPERTY RIGHTS AND INTERNATIONAL TRADE 10–12* (2011), available at <http://www.ieceusa.org/policy/eyeonwashington/2011/documents/iptradeagreements.pdf>; PETER DRAHOS, COMM’N ON INTELL. PROP. RIGHTS, DEVELOPING COUNTRIES AND INTERNATIONAL INTELLECTUAL PROPERTY STANDARD-SETTING, at 10, available at http://www.iprcommission.org/papers/pdfs/study_papers/sp8_drahos_study.pdf (“The disappointments of the 1970s in intellectual property standard-setting led the US in the 1980s to adopt a strategy of forum-shifting. . . . In fora such as WIPO, UNCTAD and UNESCO, the US faced the problem that developing country blocs could defeat its proposals on intellectual property or advance their own. The US began to argue the issue of intellectual property protection should become the subject of a multilateral trade negotiation within the General Agreement on Tariffs and Trade (GATT). The GATT was a forum in which the US was the single most influential player. Largely due to the efforts of the US and the US big business community the Ministerial Declaration, which in 1986 launched the Uruguay Trade Round, listed the trade-related aspects of intellectual property rights as a subject for negotiation.”); Anita B. Frohlich, *Copyright Infringement in the Internet Age—Primetime for Harmonized Conflict-of-Laws Rules?*, 24 BERKELEY

Recognition of and respect for the expressive and innovative endeavors of others, however, especially those of non-Western cultures, did not keep pace.³⁶ Most incendiary to many third world and other developing nations

TECH. L.J. 851, 856 (2009) (noting that “[t]he accession of the United States to the Berne Convention initiated a gradual reconsideration of international copyright law while contemporaneously creating new challenges when foreign copyright law was involved.”); Marshall Leaffer, *International Copyright from an American Perspective*, 43 ARK. L. REV. 373, 383 (1990); May, *supra* note 8, at 410 (“In addition to the advantages to be gained by having a tougher multilateral enforcement mechanism, the US government (alongside allies in the EU) wanted to move the international regulation of IPRs into the new WTO (from the WIPO) because their negotiators felt that they were more likely to gain agreements to their advantage by linking these issues to the international trade regime.”); Peter S. Menell, *Intellectual Property and the Property Rights Movement*, 30 REG. MAG., no. 5, 2007, at 36, 37, available at <http://www.cato.org/pubs/regulation/regv30n3/v30n3-6.pdf>.

36. See ILIAS, *supra* note 35, at 28; DRAHOS, *supra* note 28, at 2 (“[With regard to] developing countries[‘] [ability to] influence outcomes in the international intellectual property standard-setting process . . . [developing countries] have comparatively little influence. The main reason lies in the continued use of webs of coercion by the US and EU, both of which remain united on the need for strong global standards of intellectual property protection.”); Marci A. Hamilton, *The TRIPS Agreement: Imperialistic, Outdated, and Overprotective*, 29 VAND. J. TRANSNAT’L L. 613, 615–16 (1996); Long, *Traditional Knowledge and the Fight for the Public Domain*, *supra* note 7, at 617, 619 (2006) (“If you were to ask me what the role of the United States is in the protection of the traditional knowledge, I would essentially say ‘not a whole lot.’”); J. H. Reichman, *Intellectual Property in International Trade: Opportunities and Risks of a GATT Connection*, 22 VAND. J. TRANSNAT’L L. 747, 813 (1989), available at http://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=1400&context=faculty_scholarship; Steve Lohr, *New Economy: The Intellectual Property Debate Takes a Page from 19th-Century America*, N.Y. TIMES, Oct. 14, 2002, available at <http://www.nytimes.com/2002/10/14/business/new-economy-intellectual-property-debate-takes-page-19th-century-america.html>. Various commentators have explored this problem as one of “cultural imperialism,” which is generally understood to denominate the externally imposed prioritization of Western cultural values over competing values held by non-Western cultures. See, e.g., Ho, *supra* note 6, 467-70 (employing the term “patent imperialism” to reference the issue in the biopiracy context). While cultural imperialism (and of course racism) provide the collective foundation for Western colonialism and Post-War political imperialism, IP imperialism is only partially derived from a false sense of racial and cultural superiority. IP imperialism stratagems are further “legitimized” by unabashed self-interest coupled with a deliberate cognizance of the concomitant power and resources to fuel those interests. See, e.g., Rosemary J. Coombe, Symposium, *The Recognition of Indigenous Peoples’ and Community Traditional Knowledge in International Law*, 14 ST. THOMAS L. REV. 275, 281 (2001) (“To the extent that patents on innovations derived from traditional knowledge may only be challenged after

was the fact that the United States and the former Colonial Powers sought to define unilaterally what would qualify as protectable intellectual property.³⁷ At the same time, they showed little respect for the sovereign and national rights in the properties the West desired, such as the natural and indigenous cultural resources they continued to pilfer from many non-Western countries without even the pretense of fair compensation.³⁸

they have been granted, an enormous financial and administrative burden is put upon indigenous people and the NGOs that represent community interests. For example, it took organized international ecofeminists five years and hundreds of thousands of dollars to successfully challenge the Grace Company's neem-based patents and they were dealing with a very clear case of appropriation of widely known, published prior art. Although litigation serves an important symbolic role in helping to focus the public's attention on this issue, continuous monitoring and challenging of patents requires resources that are well beyond the capacities of all but the most well-funded NGOs."). From this perspective, IP imperialism is not "inherently evil," but rather a quasi-aristocratic principle of privilege and entitlement, perpetrated behind a façade of public interest and global uplift.

37. See Long, "Democratizing" Globalization: Practicing the Policies of Cultural Inclusion, *supra* note 33, at 220–22, 224 ("[S]ince at least the negotiation of the Agreement on Trade Related Aspects of Intellectual Property (TRIPS) as part of the Uruguay Round under GATT, a growing divide between the forces of 'traditional' copyright and those who seek broader protection for all cultural works has opened. Debates over the right to protect works of cultural patrimony or indigenous art or literature under 'traditional' copyright, or even its desirability continue with no clear indication of when a satisfactory conclusion might be expected. This division is merely one example of a much broader rift between developed and developing countries regarding the standards and scope of works which should be subject to protection under domestic intellectual property laws. . . . The North-South debates are also more problematic because behind this division is a history of economic, political and cultural imperialism that makes the power imbalance seem not only unfair, but, more importantly, an unfortunate continuation of past practices, albeit in a different guise."); Jo Recht, *Intellectual Property in Indigenous Societies: Culture, Context, Politics, and Law*, 6 DARTMOUTH L.J. 277, 282–83 (2008), ("Western assumptions about ownership and authorship, and the assignment of most indigenous knowledge to the 'public domain,' allow non-indigenous actors to create their own protectable [sic], derivative subject matter from indigenous raw materials. IPR is double-edged, and both edges cut off indigenous protections and rights. Thus, a Western pharmaceutical company may appropriate indigenous knowledge about a medicinal plant that is deemed by Western intellectual property law to be in the 'public domain,' and then create commercial products to which it has exclusive rights. The royalties go to the Western company rather than to the indigenous keepers of the knowledge, and the exclusive rights that the company might apply for under Western patent law will make the end products inaccessible to the indigenous population.").
38. See Recht, *supra* note 37, at 283 ("[W]hen non-technological products are considered, such as songs, images, paintings, or other forms of traditional cultural

Domestically there was little challenge to the IP Commoditization aspects of American IP Imperialism. For one thing, the American public seemed to have access to as much IP products as it desired at affordable prices.³⁹ Additionally, there were few options available for interacting with

expression, outside actors, whether individual or corporate, can take indigenous products deemed by Western law to be free to the public, and establish exclusive rights in the derivative works created from them. This is not an accident: the intellectual property system was expanded and developed in the nineteenth century by the European imperial powers, who used it to preserve for themselves the resources of their colonies. In the contemporary context, one commentator has noted that ‘WIPO and TRIPS have focused on teaching the poor how to protect the intellectual property of the West.’ Conventional intellectual property law, therefore, provides neither a sword nor a shield to protect indigenous subject matter.”); May, *supra* note 5, at 419 (“While the powerful states continue to ensure their capitalists’ (intellectual) property is safe-guarded, others will be increasingly threatened by the information age’s commodification of their remaining national resources by international Capital (through bio-piracy and the ‘theft’ of traditional knowledge, for instance). Thus, the ‘information age’ both enhances the power of states that can effectively control their jurisdiction, *and* contributes to the weakness of those that do not.”); See also DRAHOS, *supra* note 35, at 8 (“The Berne system was run to suit the interests of copyright exporters. Each successive revision of the Berne brought with it a higher set of copyright standards. By the time many countries shed their colonial status, they were confronted by a Berne system that was run by an Old World club of former colonial powers to suit their economic interests. Former colonial powers continued to watch over their former colonies. When eleven Sub-Saharan states joined Berne they were ‘so totally dependent economically and culturally upon France (and Belgium) and so inexperienced in copyright matters that their adherence was, in effect, politically dictated by the ‘mother country’ during the aftermath of reaching independence.’”); Ho, *supra* note 6, at 433, 505–06 (“Although there is technically no intellectual property infringement in a country that does not have intellectual property laws—for one cannot break a law that does not exist—industry advocates nonetheless successfully claimed that piracy of intellectual property rights was occurring and depriving the U.S. of its just profits. In other words, the piracy argument underlying enactment of TRIPS ignored the strict legal parameters of intellectual property laws.”); Penny Hess, *All Diamonds are Blood Diamonds: The Truth About the Diamond Trade*, AFRICAN PEOPLE’S SOLIDARITY COMM. at 1-2 (2006), available at http://apscuhuru.org/analysis/diamonds/diamonds_web.pdf; Moyiga Nduru, *Avocados, Diamonds at Core of Anti-Israel Trade Campaign*, INTER PRESS SERV. NEWS AGENCY, Jan. 26, 2007, available at <http://ipsnews.net/africa/nota.asp?idnews=36331>.

39. IVEY, *supra* note 23, at 7–9 (“[N]ew ‘arts industries’ grew dramatically during . . . the twentieth century. . . . Today, DVDs, movies-on-demand, satellite radio, the iPod, and ring-tones top off the transition begun a century ago: Americans can engage the performing arts on our own terms, on our own timetable, at home, in the car, or while strolling or jogging in the park. . . . And today DVDs are released mere weeks—sometimes only a few days—after a

IP products other than as pre-packaged, static commodities. Books, movies, and music recordings were entertaining and often even inspiring; pharmaceuticals were inexpensive and cured most routine ills; even the public's favorite celebrities were "manufactured," managed, and marketed by entertainment conglomerates.⁴⁰ As with most mass-produced commodities in the industrial age, the public had little say in how intellectual property products were manufactured or what products would be made available, nor could it "tweak" or customize that which was offered to suit their individual likings. Like children at the end of a hyperactive summer day, the public happily consumed what was put in front of it, so long as it was familiar, or at least superficially gratifying, unconcerned with either the ultimate cost or process involved in the preparation of the intellectual property repast. Nor did there seem to be any cause for alarm over growing corporate claims of absolute dominion over the IP to which they held legal rights. In possession of an ever-growing bundle of legal titles to IP works, what was theirs was theirs and the right of control over their property was to be respected by all.⁴¹

C. Digital Information Technology: The Challenge to IP Imperialism and Commoditization

The advent of digital information technology presented the first major challenge to both American IP Imperialism policies and the American IP Commoditization Precept. Through the Internet and related technological advances, people in many non-Western and developing nations gained unprecedented access to American intellectual property and began utilizing this material as the building blocks for further expressive and innovative works.⁴²

film has opened on the big screen. The cache of live theater and music on tour persists, but *most* citizens consume *most* performing arts through some form of technology—usually technology that delivers music, drama, and dance right into the living room or the family car.”).

40. *The Hollywood Studio System in the Golden Age*, HOLLYWOODMOVIE MEMORIES.COM, <http://www.hollywoodmoviememories.com/articles/hollywood-history/hollywood-studio-system-golden.php> (last visited Oct. 8, 2012).
41. In this regard, American IP Imperialism arguably grew to be even more socially pernicious than its European progenitor, in that, in addition to its one way nation state/cultural biases, the added feature of the IP Commoditization Precept further serves to stagnate American cultural and innovation developmental interests. See, e.g., Steven D. Jamar, Symposium, *Crafting Copyright Law to Encourage and Protect User-Generated Content in the Internet Social Networking Context*, 19 WIDENER L.J. 843, 845 (2010).
42. See, e.g., Menell, *Intellectual Property and the Property Rights Movement*, *supra* note 35, at 36, 42; Ruth Okediji, *Givers, Takers, and Other Kinds of Users: A Fair Use Doctrine For Cyberspace*, 53 FLA. L. REV. 107, 108 (2001) (“[I]nformation technology has empowered ordinary users to become part of the creative process both by its interactive nature and the very architecture of the pennon of the information society, the Internet.”).

Concededly, this new access was sometimes abused to undertake unauthorized commercial exploitation and other acts of IP piracy.⁴³ For American and other Western IP stakeholders, the “what’s mine is mine” imperialist bastion was no longer an unassailable rampart.⁴⁴ Moreover, some non-West-

43. ILIAS, *supra* note 35, at 12–15; Long, “Democratizing” Globalization: Practicing the Policies of Cultural Inclusion, *supra* note 33, at 229 (“E-commerce, or at least the promise of electronic commerce, has become the new paradigm for globalization. While figures on Internet growth and its global penetration remain subject to dispute, the reality is that the growth of the Internet as a global communication and marketing medium is unprecedented. Moreover, such penetration is not limited to the so-called developed countries. To the contrary, of the ten fastest growing countries for Internet penetration for the year 2001, almost all of them are so-called developing countries.”); Wendy M. Pollack, Note, *Tuning In: The Future of Copyright Protection for Online Music in the Digital Millennium*, 68 *FORDHAM L. REV.* 2445, 2445–46 (2000) (“Digitization of copyrighted materials permits instantaneous, simplified copying methods that produce nearly perfect copies of originals. These copies can be digitally delivered to thousands of Internet users. Decentralization and anonymity in cyberspace have allowed for the widespread dissemination of copyrighted materials without permission from their owners.”); *China’s Piracy Hurting Its Own Industries*, *NBCNEWS.COM* (July 7, 2006), http://www.msnbc.msn.com/id/13617619/ns/business-world_business/t/chinas-piracy-hurting-its-own-industries/.
44. See, e.g., Stephen M. Pinkos, *Piracy of Intellectual Property: Hearing Before the S. Comm. on the Judiciary Subcomm. on Intellectual Property*, 112th Cong. (2012), available at http://www.uspto.gov/smallbusiness/pdfs/USPTOTestimony-Judiciary_Subcommittee_on_Intellectual_Property.pdf; Michael Wines, *China to Begin Crackdown on Pirated Software in 2011*, *INT’L HERALD TRIB.*, Jan. 8, 2011, available at <http://www.nytimes.com/2011/01/08/business/global/08piracy.html>; Editorial, *Internet Piracy and How to Stop It*, *N.Y. TIMES*, June 9, 2011, at A26, available at <http://www.nytimes.com/2011/06/09/opinion/09thu1.html>. Moreover, some commentators have argued that such developing-nation unauthorized uses are not only equitable but a more effective means of technology transfer when compared to policies of direct foreign aid. See Gibbons, *supra* note 2, at 952, 954 (“[A] free marketplace in unlicensed intellectual property is more likely to promote economic development in developing countries than either direct foreign aid or incentivized technology transfer. Further, one lesson that may be drawn from history is that those countries that have successfully transitioned from developing or agricultural economies to developed or industrial economies all did so during periods of lax or no transnational enforcement of intellectual property rights. In fact, the development norm in history was not the enforcement of intellectual property rights but, instead, the positive flouting of the intellectual property rights of non-citizens as an aid to national development. . . . The question to be asked may be whether unlicensed uses are more efficient in promoting developmental goals than direct foreign aid or incentives for technology transfer. A market-driven policy for intellectual property or technology transfer that permits access to and use of intellectual property in response to market demand for technology or

ern nations and various marginalized groups and communities would seize upon Western “digital vulnerability” to gain bargaining leverage with which to redress the “what’s yours is ours” part of the IP Imperialism equation,⁴⁵ and to otherwise explore digital information technology as a means for addressing other intellectual property social deficiencies and injustices.⁴⁶

information in a local developing country’s markets will promote development more efficiently than either direct foreign aid or technology transfers. History teaches that uncompensated intellectual property transfers (piracy) as a developmental policy may have much to commend it because uncompensated transfers may mark an attempt to return to the well-worn paths that led to past successful economic development.”).

45. See K.J. Greene, “Copynorms,” *Black Cultural Production, and the Debate Over African-American Reparations*, 25 *CARDOZO ARTS & ENT. L.J.* 1179, 1180–81 (2008) (“The institutional music industry has resorted to copyright infringement lawsuits to stem massive Internet piracy in recent years. . . . [T]he ‘copynorms’ rhetoric the entertainment industry espouses shows particular irony in light of its long history of piracy of the works of African-American artists, such as blues artists and composers. For many generations, black artists as a class were denied the fruits of intellectual property protection—credit, copyright royalties and fair compensation. Institutional discrimination teamed with intellectual property and contract law resulted in the widespread underprotection of black artistic creativity. Similarly, black inventors created technical and scientific works that impacted early American industries. Evidence exists that black inventors also faced similar divestiture in the industrial marketplace. The mass appropriation of the work of black artists and inventors reflects the systemic subordination based on race that characterized most of U.S. history.”). The full meaning of the adage “those who seek equity must do equity” is beginning to resonate within the Western IP Imperialist’s regimes. See, e.g., Long, *Traditional Knowledge and the Fight for the Public Domain*, *supra* note 7, 617, 628 (2006) (“[E]xplor[ing] the imperialism of the 19th century and the imperialism that is being applied to traditional knowledge today[,] [t]he rhetoric of the two is frightening[ly] similar. We can avoid some of the pitfalls of those earlier years if we consider diverse approaches. Access to knowledge, human rights, intellectual property rights, etc. take the best of those approaches and devise a regime that makes sense for all parties.”).
46. See, e.g., Steven D. Jamar, Symposium, *A Social Justice Perspective on the Role of Copyright in Realizing International Human Rights*, 24 *PAC. MCGEORGE GLOBAL BUS. & DEV. L. J.* 289, 289 (2012); Mtima, *Fulfilling the Copyright Social Justice Promise: Digitizing Textual Information*, *supra* note 33, at 101–06; Lateef Mtima, Symposium, *Copyright Social Utility and Social Justice Interdependence: A Paradigm for Intellectual Property Empowerment and Digital Entrepreneurship*, 112 *W. VA. L. REV.* 97, 141–47 (2009); Lateef Mtima, Symposium, *Introduction*, 48 *HOW. L.J.* 571, 572 (2005) (“[T]he digital revolution and similar technological advances present unheralded opportunities through which to confront [intellectual property social inequity] from a socially redeeming vantage point. . . . [T]he new technologies can provide the apparatus through which to achieve a more equitable distribution of the benefits of creative endeavor.”); Robert Sullivan, *Indigenous Culture and Intellectual Property*

Just as the developing nations began to challenge American IP Imperialism, the American public began to question the IP Commoditization Precept: for the first time, private individuals gained the ability to interact with commercially produced IP product in non-passive ways.⁴⁷ With digital information technology liberating many expressive works from static formats and offering new methods for using and re-using existing works to produce new works and even new forms of intellectual property, the American public became unwilling to forego these creative and pedagogical boons solely on the say-so of the IP Commoditization establishment.⁴⁸ A national grassroots movement to restore the public interest to the core of American IP policy began to take hold, and a growing cross-section of IP stakeholders demanded that the IP Commoditization Precept give way to the Constitution's intellectual property mandates of cultural and innovative progress.⁴⁹

Rights, 8 D-LIB MAG. no.5, 2002 (N.Z.), available at <http://www.dlib.org/dlib/may02/sullivan/05sullivan.html>.

47. See, e.g., Peter S. Menell, Symposium, *Envisioning Copyright Law's Digital Future*, 46 N.Y.L. Sch. L. Rev. 63, 66 (2002); Lateef Mtima, *The Changing Landscape of Internet Use and Dissemination of Copyrighted Works: New Tools, New Rules, or the Same Old Regime?*, 24 THE COMPUTER & INTERNET L., no. 10, 2007, at 4; Netanel, *supra* note 10, at 1, 3 ("P2P file sharing is not just downloading music and movies for free. It is a vehicle for finding works that are otherwise not available, discovering new genres, making personalized compilations, and posting creative remixes, sequels, and modifications of popular works. By engaging in such activities, people who might previously have been passive consumers now assert a more active, self-defining role in the enjoyment, use, and creation of cultural expression."); Pamela Samuelson, *Fair Use for Computer Programs and Other Copyrightable Works in Digital Form: The Implications of Sony, Galoob and Sega*, 1 J. INTELL. . PROP. L. 49, 67–73 (1993).
48. See, e.g., Samuelson, *Fair Use for Computer Programs and Other Copyrightable Works in Digital Form: The Implications of Sony, Galoob and Sega*, *supra* note 47, 102–03 ("[There is an] extraordinary array of electronic information tools now available . . . that permit users to experiment with the plastic nature of works in digital form. By plasticity, I mean the ease with which such works can be manipulated, transformed, and/or inserted into other works. Although many authors might prefer for their works to remain as fixed as they have traditionally been in printed form, the genie of plasticity cannot be pushed back into the bottle. Digital manipulation is here to stay, for the manipulability of digital data is one of the key advantages of the digital medium.").
49. See, e.g., Menell, *Envisioning Copyright Law's Digital Future*, *supra* note 47, at 133–38; Mtima, *Copyright Social Utility and Social Justice Interdependence: A Paradigm for Intellectual Property Empowerment and Digital Entrepreneurship*, *supra* note 46, at 119–36; Note, *Spare the Mod: In Support of Total-Conversion Modified Video Games*, 125 HARV. L. REV. 789, 796 (2012) ("The social utility theory of intellectual property argues that lawmakers ought to craft property rights to maximize net social welfare. Ideally, lawmakers will grant enough exclusive rights to stimulate innovation but will not expand the

Predictably, the American Digital Cultural Revolution has been met with demands for even greater IP protections from the entrenched IP corporate community; predictably, but not *consistently*.⁵⁰ Because digital information technology not only provides new uses for traditional intellectual property product, but has also engendered new kinds and forms of intellectual property outside of IP conglomerate control, in the unwavering tradition of American IP Imperialism many members of that community would prefer that little or no “IP law and order” be extended to these new frontiers. Consequently, it is not unusual to find some of the most ardent corporate supporters of stronger IP rights as the means for incorporating digital information technology into the global IP framework actually arguing *against* strong IP protection when it comes to regulating digital information IP interests currently outside their control.⁵¹

Some recent right-of-publicity disputes provide good examples of this IP Imperialist ambidexterity. As a relatively new form of intellectual property, the parameters and contours of these rights were still being charted as digital information technology disrupted a plethora of timeworn IP pretexts and assumptions.⁵² Consequently, much of the right of publicity law terrain, both within and outside of the digital information context, is plainly unsettled, and like the robber barons of old, many IP Imperialists are eager to preserve this “Oklahoma land-grab” state of affairs until they can stake their claims to these new IP territories. However, as discussed in the next Part, the right of publicity offers much more than new opportunities for IP Imperialist expansion. Particularly in the digital information context, it can instead be utilized to achieve important IP social utility and social justice goals. A brief examination of the development of the right, and the application of IP social justice tenets in its interpretation and application, elucidates its full social utility/social justice potential.

PART III: THE RIGHT OF PUBLICITY: A DIGITAL AGE OPPORTUNITY FOR IP SOCIAL JUSTICE

A. The Origins of the Right of Publicity

In many ways, the right of publicity is something of the IP bastard child, the unplanned progeny of the intersection of tort right of privacy with trade-

scope of such rights to an extent that would prevent society’s enjoyment of those innovations.”).

50. See, e.g., Stop Online Piracy Act, H.R. 3261, 112th Cong., (2011) (as introduced in House, Oct. 26, 2011); PROTECT IP Act, S 968; Graeme McMillan, *Will ‘PROTECT IP’ Act Stop Piracy or Doom Online Innovation?*, TIME, June 24, 2011, available at <http://techland.time.com/2011/06/24/will-protect-ip-act-stop-piracy-or-doom-online-innovation/>.

51. See, e.g., *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134, 1139 (9th Cir. 2006).

52. See *infra* Part III.

mark, which is itself the “black sheep” of federal intellectual property law.⁵³ The genesis of publicity rights can be traced to the landmark law review article by two jurisprudential Young Turks, Samuel D. Warren and Louis D. Brandeis, who defied convention and called for judicial recognition of “a right to be let alone.”⁵⁴ Perturbed with the press’s growing encroachment upon private matters and the consequential public fascination with sensationalism, Warren and Brandeis’ observations could well have been made in the present day:

Of the desirability—indeed of the necessity—of some such protection, there can, it is believed, be no doubt. The press is overstepping in every direction the obvious bounds of propriety and of decency. Gossip is no longer the resource of the idle and of the vicious, but has become a trade, which is pursued with industry as well as effrontery. To satisfy a prurient taste the details of sexual relations are spread broadcast in the columns of the daily papers. To occupy the indolent, column upon column is filled with idle gossip, which can only be procured by intrusion upon the domestic circle. The intensity and complexity of life, attendant upon advancing civilization, have rendered necessary some retreat from the world, and man, under the refining influence of culture, has become more sensitive to publicity, so that solitude and privacy have become more essential to the individual; but modern enterprise and invention have, through invasions upon his privacy, subjected him to mental pain and distress, far greater than could be inflicted by mere bodily injury.⁵⁵

Although the right of privacy was not immediately welcomed by the courts,⁵⁶ gradually courts began to accept the principle that individuals were entitled to some protection from intrusion upon their lives and personas, culminating in a pivotal decision by the Second Circuit Court of Appeals, wherein the right of publicity was recognized as a distinct species of the right of privacy. In *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, the

53. Although trademark rights and interest have been recognized for centuries, American courts and legislators had great difficulty finding a comfortable place for trademark law in the federal IP regime. See, e.g., *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37–38 (2003); See also Fowler, *supra* note 33, at 1638–39. As to its influence upon the right of privacy, the latter right is often said to manifest the propertization of tortious protections and interests. However, the kind of property interest involved is essentially that of a right to control the marketing of one’s persona, particularly as a source identifier. *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193 (1985); *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97–98 (1918); *Canal Co. v. Clark*, 80 U. S. 311, 320 (1871).

54. See Warren, *supra* note 1, 193, 195.

55. *Id.* at 196.

56. See J. THOMAS MCCARTHY, 1 RIGHTS OF PUBLICITY AND PRIVACY § 6.3 (2d ed. 2006); See, e.g., *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442, 451 (N.Y. 1902).

plaintiff entered into an exclusive contract with a professional baseball player to place his photograph on trading cards.⁵⁷ The defendant, however, induced the baseball player to allow it to also use his photograph on trading cards and thereby breach his exclusive agreement.⁵⁸ The defendant argued that the baseball player had no legally recognized property interest in his image that he could have assigned to the plaintiff, and consequently the plaintiff had no legal interest that the defendant could have invaded.⁵⁹ The Court of Appeals disagreed:

We think that in addition to and independent of [a] right of privacy . . . a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture. . . . 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, popularizing their countenances, displayed in newspapers, magazines, buses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.⁶⁰

Finally, in 1960 Dean Prosser published a seminal article charting the various judicial conceptions of privacy rights in which he outlined four categories of judicially accepted privacy interests,⁶¹ describing the latter-most interest as the right to protect one's image or likeness from misappropriation.⁶² Thereafter, both the Restatement (Second) of Torts and the Restate-

57. 202 F.2d 866, 867 (2d Cir. 1953).

58. *Id.*

59. *Id.* at 867.

60. *Id.* at 868. See also Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 203-04 (1954), available at <http://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=2596&context=lcp> ("Well known personalities. . . do not seek the 'solitude and privacy' which Brandeis and Warren sought to protect. . . . However, although the well known personality does not wish to hide his light under a bushel of privacy, neither does he wish to have his name, photograph, and likeness reproduced and publicized without his consent or without remuneration to him.").

61. William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960), available at http://www.californialawreview.org/assets/pdfs/misc/prosser_privacy.pdf. Dean Prosser enumerated the following four categories of invasion of privacy: "[i]ntrusion upon the plaintiff's seclusion or solitude, or into his private affairs;" "[p]ublic disclosure of embarrassing private facts about the plaintiff;" "[p]ublicity which places the plaintiff in a false light in the public eye;" and "[a]ppropriation, for the defendant's advantage, of the plaintiff's name or likeness." *Id.*

62. *Id.* This is the interest the *Haelan* court denominated as the right of publicity. 202 F.2d at 868.

ment (Third) of Unfair Competition included the right of publicity, enumerating the elements of the cause of action.⁶³

B. Enforcing the Right of Publicity

In general, the right of publicity assures individuals the right to determine when or if others may utilize or exploit their images or personas, as well as the right to participate in the commercial benefits that might be derived from such uses:

The right of publicity is an intellectual property right of recent origin which has been defined as the inherent right of every human being to control the commercial use of his or her identity. [It] is a creature of state law and its violation gives rise to a cause of action for the commercial tort of unfair competition.⁶⁴

63. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995); RESTATEMENT (SECOND) OF TORTS § 652C (1977).

64. *ETW Corp. v. Jireh Publ'g, Inc.* 332 F.3d 915, 928 (6th Cir. 2003) (citing *MCCARTHY, RIGHTS OF PUBLICITY AND PRIVACY*, *supra* note 56, § 1:3); *See also Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956, 957 (6th Cir. 1980) (“The famous have an exclusive legal right during life to control and profit from the commercial use of their name and personality.”). Particularly insofar as celebrities are concerned, the right to control use and exploitation of one’s image or persona can also be asserted under the Lanham Act, through the cause of false endorsement. False endorsement occurs where a person’s image or persona is used in association with a product in a way that is likely to mislead the consuming public as to that person’s sponsorship or approval of the product:

A false endorsement claim based on the unauthorized use of a celebrity’s identity is a type of false association claim, for it alleges the misuse of a trademark, *i.e.*, a symbol or device such as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic, which is likely to confuse consumers as to the plaintiff’s sponsorship or approval of the product.

Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1110 (9th Cir. 1992). “When . . . a celebrity brings a false endorsement suit under Section 43(a), his ‘celebrity persona’ functions as the ‘mark.’” *Brown v. Elec. Arts, Inc.* Case No. 2:09-cv-01598-FMC-RZx, 2009 U.S. LEXIS 131387, at *7 (C.D. Cal. Sept. 23, 2009); *See also White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992). Likelihood of confusion is generally the controlling issue. *See Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1186 (6th Cir. 1988) (enumerating an eight factor false endorsement likelihood of confusion test: (1) the level of recognition that the plaintiff has among the segment of the society for whom the defendant’s product is intended; (2) the relatedness of the fame or success of the plaintiff to the defendant’s product; (3) the similarity of the likeness used by the defendant to the actual plaintiff; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; (7) defendant’s intent in selecting the mark; and (8) likelihood of expansion of the product lines (cit-

Although the right of publicity is now widely recognized,⁶⁵ identifying its parameters continues to be difficult. This is partly due to varying regional privacy customs and values, but the fact that publicity rights often seem to conflict with some of society's most cherished and respected legal and social mores also causes difficulty. The most obvious of these conflicts is with the First Amendment. American society has a revered interest in promoting the accurate discourse of historic and public events, including the roles of public and private individuals in such events. If individuals were to possess an absolute right to determine when their images or personas could be used or referenced by others, they could effectively censor public discussion and even historical accounts of actual events.⁶⁶

Consequently, the right of publicity is often said to end where the First Amendment begins:

[T]he right of publicity cannot be used to prevent someone's name or picture in news reporting. It cannot be used to prevent the use of identity in an unauthorized biography. It cannot prevent use of identity in an entertainment parody or satire, such as that of Rich Little or Saturday Night Live.⁶⁷

ing AMF, Inc., v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979)). Because right of publicity and false endorsement claims are often raised simultaneously and substantively overlap, the disposition of the one is often difficult to segregate from the resolution of the other. Nonetheless, the principal distinctions between false endorsement and right of publicity claims are (i) "trademark status" for the plaintiff's persona, and (ii) the requirement of a likelihood of confusion of the public as to the plaintiff's endorsement of the defendant's product.

65. See MCCARTHY, RIGHTS OF PUBLICITY AND PRIVACY, *supra* note 56, at § 6:3; See also Gregory L. Curtner et al. *Show and Tell: Misappropriation of the Right of Publicity*, in COUNSELING CLIENTS IN THE ENTERTAINMENT INDUSTRY 2011, at 263, 271 (PLI Intell. Prop. Course Handbook Ser. No. 1040, 2011).
66. *Time, Inc. v. Hill*, 385 U.S. 374, 389 (1967); *Mason v. Jews for Jesus*, No. 06 Civ. 6433 (RMB), 2006 WL 3230279 (S.D.N.Y. Nov. 8, 2006); *Arrington v. New York Times Co.*, 434 N.E.2d 1319, 1322-23 (N.Y. 1982); *Nussenzweig v. diCorcia*, 832 N.Y.S.2d 510 (N.Y. App. Div.), *aff'd*, 878 N.E.2d 589 (N.Y. 2007).
67. J. Thomas McCarthy, *The Spring 1995 Horace S. Manges Lecture—The Human Persona as Commercial Property: The Right of Publicity*, 19 COLUM.-VLA J.L. & ARTS 129, 130-31 (1995); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 969 (10th Cir. 1996) ("[P]arody trading cards receive full protection under the First Amendment. The cards provide social commentary on public figures, major league baseball players, who are involved in a significant commercial enterprise, major league baseball. While not core political speech . . . this type of commentary on an important social institution constitutes protected expression."); See also *Vinci v. Am. Can Co.*, 591 N.E.2d 793, 794 (Ohio Ct. App. 1990) (*per curiam*) (permitting unauthorized use of

In addition to preserving public discourse and historical accuracy, First Amendment concerns also tend to prioritize freedom of artistic expression over publicity interests. For example in *Rogers v. Grimaldi*, the Second Circuit Court of Appeals affirmed dismissal of both the right of publicity and the false endorsement claims brought by film legend Ginger Rogers, as precluded by First Amendment interests.⁶⁸ Rogers brought suit in connection with the use of her name in the title of a film, *Ginger and Fred*.⁶⁹ The gist of Rogers's claims was that, even though the film was not about the famous Rogers and Astaire dance team, the phrase "Ginger and Fred" invoked her famous persona when used as the title of a film and therefore falsely traded upon her persona to market a work to which she had no connection.⁷⁰

In dismissing Rogers' claims, the court ruled that any invocation of her persona in this instance was artistically relevant to the film because, while the movie was not about Rogers or her former co-star, the title did have some artistic, expressive relationship to the content of the film—a satiric social commentary on the Hollywood Glamour Age—and was not merely a disguised attempt by the defendant to trade upon Rogers's celebrity as a means to promote his product.⁷¹ Consequently, the use was protected by the First Amendment:

In light of the [state's] concern for the protection of free expression, [the court] would not expect [the state] to permit the right of publicity to bar the use of a celebrity's name in a movie title unless the title was "wholly unrelated" to the movie or was "simply a disguised commercial advertisement for the sale of goods or services." Here . . . the title "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.⁷²

athletes' personas where "the mention of the athletes' names within the context of accurate, historical information was incidental to the promotion of the . . . partnership . . . [and] reference to the athletes and their accomplishments was purely informational."). First Amendment interests similarly curtail false endorsement claims under the Lanham Act. Thus, where a plaintiff raises a false endorsement claim, the interposition of the First Amendment as a defense requires that concerns regarding public confusion be counterbalanced against society's interest in promoting free expression. See *ETW Corp.*, 332 F.3d at 928, 936–37.

68. 875 F.2d 994, 1004–05 (2d Cir. 1989).

69. *Id.* at 996.

70. *Id.* at 1000–01.

71. *Id.* at 1005.

72. *Id.* at 1004–05. In addition to First Amendment issues, the use of a person in literary expression can also implicate, and potentially conflict with, the copyright exclusive rights. See, e.g., *Dastar Corp. v. Twentieth Century Fox Film*

If it seems that, in a “battle of social utilities,” the First Amendment will always prevail over publicity rights, perhaps one reason for this impression is that whereas the social function of freedom of speech is obvious, the social utility underlying the right of publicity may seem comparatively obscure. The First Amendment promotes democratic discourse and liberty, as well as the unfettered expressive use of facts and ideas; in comparison, what lofty social goals does the right of publicity promote? Indeed, some scholars have found it difficult to find *any* social utility justification for the right of publicity.⁷³ Thus, prescribing the right of the publicity can be challenging because courts seem to delineate the right by negative implication, often construing the right as only covering whatever is “left over” after the important social utilities underlying the First Amendment and higher pecking order social mores have been satisfied.

Unsurprisingly, this difficulty in definition leads to difficulty in enforcement. Not only do varying regional values make it difficult to discern what publicity interests will be recognized in a particular case, but even where the right of publicity interests are relatively concrete, courts appear eager to subjugate such interests in favor of competing social utilities, and consequently the outcomes of right-of-publicity disputes can be extremely difficult to predict.

The subjugation, and resulting obfuscation, of right-of-publicity interests, however, is not ineluctable. While at first blush the right of publicity may not seem an especially socially relevant form of intellectual property,⁷⁴

Corp., 539 U.S. 23, 31-33 (2003); *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 636 F.3d 1115, 1119 (9th Cir. 2011). The problem of copyright/right of publicity overlaps and conflicts is discussed in Part IV, *infra*.

73. See, e.g., K.J. Greene, *The Right of Publicity: Is the Rent “Too Damn High”?*, in COUNSELING CLIENTS IN THE ENTERTAINMENT INDUSTRY 2011, at 279, 282 (PLI Intell. Prop. Ser. No. 1040, 2011); Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1162 (2006); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 178–215 (1993). One explanation for the less than charitable attitudes toward the right of publicity is of course the overreaching and often baseless suits brought by some celebrities seeking to profit from even the most remote associations with their personas. See, e.g., *Lindsay Lohan & E-Trade Settle Milkaholic Baby Lawsuit*, THE HUFFINGTON POST, Sept. 21, 2010, available at http://www.huffingtonpost.com/2010/09/21/lindsay-lohan-etrade-sett_n_733657.html. While the dissatisfaction with such abuses is understandable, in the present era of copyright and patent trolls, and the emerging issue of trademark bullying, the problem is by no means restricted to the right of publicity. Just as these abuses do not give rise to calls for the repeal of the copyright, patent, and trademark laws, however, right of publicity misuse is an insufficient basis upon which to do away with publicity rights altogether.

74. See, e.g., Greene, *The Right of Publicity: Is the Rent “Too Damn High”?*, *supra* note 73, at 282 (“[T]he right of publicity does not deliver the goods the

upon closer analysis it becomes clear that the right of publicity can service important social functions. To identify these functions, however, one must adjust the analytical lens to account for a social justice perspective of the intellectual property law.

C. The Social Utility and Social Justice Objectives of the Right of Publicity

A social justice interpretation of intellectual property law begins with the identification of social injustices and inequities relevant to a particular area of intellectual property protection. For example, IP Imperialistic exploitation of the expressive output of a marginalized sub-community can be assessed for its impact on copyright law's objective to "promote the progress of the arts and sciences." Such exploitation at best nullifies the economic incentive to create, and, at worst, affirmatively discourages such acts as fixation and dissemination by members of exploited groups who have cause to view such activities as rendering their works more vulnerable to misappropriation.⁷⁵ Such instances illustrate intellectual property social utility/social justice interdependence,⁷⁶ a concept that has been explored in various important intellectual property contexts.⁷⁷ The social justice implications appurtenant

way copyright and patent regimes do—copyright gives us movies, books, music, and patent gives us everything from BMW engine components to little blue pills for men of a certain age. Even trademark law's harshest detractors concede the efficacy of trademark law's prevention of consumer confusion in the marketplace of goods. In contrast . . . publicity rights seem to do little more than to enrich already rich artists and athletes, and to provide a lucrative platform for reality television stars such as Snooki and Paris Hilton.”).

75. See, e.g., Mtima, *Copyright Social Utility and Social Justice Interdependence: A Paradigm for Intellectual Property Empowerment and Digital Entrepreneurship*, *supra* note 46, at 126–27 (“The social engineering aspirations which underlie American copyright law were of sufficient importance to the Framers that they provided for their satisfaction in the very first Article of the Constitution. Included among those goals is a system for author incentives, intended to help fuel artistic output. . . . When the author incentive function is so widely corrupted that authors from significant segments of the population are systematically deprived of their copyright property rights and incentives, it is not only a problem of copyright social injustice, it also constitutes an assault upon the function of copyright social utility. Creative authors who do not benefit from the copyright regime have little incentive to participate in it. When marginalized groups and communities have no expectation of reward from copyright protection, their members lose the institutional incentive to produce artistic works.”).

76. *Id.*

77. Indeed, the advent of digital information technology has sparked a general refocus of scholarly, policy, and professional attention toward social utility and social justice obligations of the intellectual property law as a whole. See, e.g., Rita Heimes, *Trademarks, Identity, and Justice*, 11 J. MARSHALL REV. INTELL.

to mass-digitization of copyrighted text and Internet file sharing have been explored by copyright scholars and in major copyright controversies.⁷⁸ Similar issues have been analyzed in the context of global health crises and pandemics, and other problems relevant to the development of patentable inventions,⁷⁹ and enforcement of patents and trademarks in connection with pharmaceutical drugs.⁸⁰

PROP. L. 133, 148 (2011) (“One measure of development and distributive justice, then, is in the mechanisms by which opportunities and access to capabilities are made available to all, means by which inequalities ‘in the distribution of substantive freedoms and capabilities’ are reduced. These freedoms and capabilities could well include property interests in intangibles such as intellectual property. Access to them could certainly assist with improved self-help, self-reliance, and self-confidence, the deprivation of which is a form of poverty.” (quoting AMARTYA SEN, *DEVELOPMENT AS FREEDOM* 119 (Alfred A. Knopf, Inc. 1999))); Long, “*Democratizing Globalization: Practicing the Policies of Cultural Inclusion*, *supra* note 33, at 252 (“[J]ust as human rights and the protection of culture have been raised to an area of international social justice, so too, the protection of the expressions of humankind’s cultural creativity (intellectual property) is worthy of being protected as a matter of social justice, with all the requirements of access and fairness that such social justice requires.”).

78. *See, e.g.*, *Authors Guild v. Google, Inc.*, 770 F. Supp. 2d 666, 679 n. 15 (S.D.N.Y. 2011) (discussing the social justice impact of the proposed Google Books settlement, stating that “supporters of the proposed settlement argue that it would ‘serve[] copyright law’s central purpose of advancing knowledge and culture by furthering copyright’s social utility and social justice goals through inclusion of those who have been excluded. The Google Books Project furthers these goals by using an accepted copyright mechanism (i.e., a private, court-supervised settlement) to address the novel copyright problems presented by the new technologies, while still preserving the rights of copyright holders.” (quoting Mtima, *Fulfilling the Copyright Social Justice Promise: Digitizing Textual Information*, *supra* note 33, at 79–80); *See also* James Grimmelman, *The Elephantine Google Books Settlement*, 58 J. COPYRIGHT SOC’Y U.S.A. 497, 506–10 (2011) (discussing the terms of the *Authors Guild* settlement); Pamela Samuelson, Symposium, *Google Book Search and the Future Books in Cyberspace*, 94 MINN. L. REV. 1308, 1319–51 (2010) (discussing potential effects of *Authors Guild* settlement on various aspects of society and economy).
79. *See, e.g.*, MADHAVI SUNDER, *FROM GOODS TO A GOOD LIFE: INTELLECTUAL PROPERTY AND GLOBAL JUSTICE* 175–78 (2012); *Bd. of Tr. of Leland Stanford Junior Univ. v. Roche Molecular Sys.*, 583 F.3d 832, 841 (Fed. Cir. 2009), *aff’d*, 131 S. Ct. 2188 (2011).
80. *See, e.g.*, PETER MAYBARDUK, PROGRAM ON INFORMATION JUSTICE AND INTELLECTUAL PROPERTY, ACTA AND PUBLIC HEALTH, *available at* <http://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=1011&context=research>; Simone A. Rose, Symposium, *On Purple Pills, Stem Cells, and Other Market Failures: A Case for a Limited Compulsory Licensing Scheme for Pat-*

As is the case with other intellectual property rights, the right of publicity can be and has been invoked in the cause of concrete social utility objectives. Even the right's harshest critics would acknowledge that the right has been invoked for the socially cognizant purpose of protecting individual privacy and personal dignity.⁸¹ In this regard, practitioners and the courts have yet to mine the full social potential of the right of publicity. For example, the problem of negative racial, ethnic, and gender stereotypes implemented through the unauthorized use of individual images or personas could be brought within the ambit of the right. Uses that result in depictions or representations that are not negative per se, but may be culturally offensive or sacrilegious, might also be analytically accessible through right of publicity doctrine.

It is possible to redress, or at least curtail, these and similar social inequities through the right of publicity. The social utility objectives that undergird the right of publicity can be interpreted to encompass pertinent remedial social justice goals, such as eradicating negative stereotypes and depictions, and culturally offensive representations, at least where individually recognizable personas are involved. Thus, the right to control the use and exploitation of one's persona can be an instrument wielded to achieve a social as well as individual monetary benefit. In such cases, an analytical interdependence between right-of-publicity social utility and remedial social justice is identified, and the law can be responsively utilized and shaped to advance socially propitious goals.⁸² In this way, socially progressive and equitable policies

ent Property, 48 How. L.J. 579, 582 (2005). For an analysis of the social justice opportunities and obligations arising in connection with trademark rights See Heimes, *supra* note 77, at 148, 149, 152 (“[T]he best arguments to support a social justice foundation in trademark and identity law rest on notions of preventing unfair competition and unjust enrichment. These policy goals for recognizing enforceable publicity rights in persona or identity protect the individual as effectively as the corporation. Few scholars have applied this analysis to trademark law, although as a feature of commercial activity trademarks are naturally connected to entrepreneurship and, logically, to personal empowerment. Because trademarks and publicity rights can serve as strong personal property interests, it bears considering, in examination of social and distributive justice principles, whether there is a justice-based argument to be made for helping individuals acquire and protect trademarks and publicity rights.”).

81. See *Parks v. LaFace Records*, 329 F.3d 437, 443 (6th Cir. 2003), wherein the civil rights icon brought an action *Seeking* to prevent the use of her name in a rap record using profanity and offensive language. Indeed, this was one of Warren and Brandeis's specific objectives in arguing for recognition of that right. See Warren, *supra* note 1, at 196.
82. See, e.g., Jennifer L. Carpenter, *Internet Publication: The Case for an Expanded Right of Publicity for Non-Celebrities*, 6 VA. J.L. & TECH. 3, 11, 14 (2001) (“Scholars and courts have isolated four primary policy justifications for the right of publicity: providing incentives for creativity, allowing those who achieve notoriety to enjoy the fruits of their own labor, guarding against con-

can be pursued and achieved through strategic invocation and application of right-of-publicity law and doctrine.

In fact, the United States Supreme Court has articulated an extremely important and time-honored social utility/justice function in connection with the right of publicity.⁸³ As the Court has observed, the right of publicity provides an incentive to individuals to invest effort and resources in the development and stylization of personal attributes and innovations, and to pursue activities and accomplishments of public and popular interest, with the possibility of celebrity, public renown, and attendant commercial reward.⁸⁴

Moreover, the Court observed that social objectives of the right of publicity are as important as those promoted by patent and copyright laws, and are not always outweighed by those underlying the First Amendment.⁸⁵ This

sumer deception, and preventing unjust enrichment. . . . The fourth . . . rationale . . . for recognizing the right of publicity is that it prevents publishers from unfairly profiting from a celebrity's public reputation without sharing some of that profit with the celebrity who worked for that reputation. This moral argument reflects a basic societal belief that it is wrong for 'free-riders' or 'parasites' to appropriate (and profit from) another person's hard work."); Heimes, *supra* note 77, at 157 ("The philosophical reasons for promoting individual ownership of identity complement the economic ones, at least from a social justice perspective. One is morally entitled to self-define and even to commercialize one's own persona. At the same time, the opportunity to exploit identity for commercial gain . . . by taking advantage of accidental fame—is one additional opportunity for empowerment through entrepreneurship. . . . In the social justice context, supporting these individual interests and values is warranted provided the broader societal interests in cultural development and freedom of expression are taken into consideration."); Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 55–56 (1994) ("[T]he right of publicity has the potential for safeguarding from unauthorized use any marketable and publicly recognizable attribute of any individual, regardless of whether that person is a celebrity. Moreover, whatever the means through which an individual's persona comes to have value, that value should be attributable to the persona of the publicity plaintiff who has a right to participate in decisions about how her persona is utilized by others. This is the overall objective which the right of publicity tries to fulfill."); *Spare the Mod: In Support of Total-Conversion Modified Video Games*, *supra* note 49, at 801 ("The personality theory of intellectual property protection posits that the artist defines herself through art. The creation of artistic works binds the artist to her products. Accordingly, the artist ought to have moral rights over the use of her works.").

83. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

84. *Id.* ("[T]he State's interest in permitting a 'right of publicity' is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment. . . . [T]he State's interest is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors.").

85. *Id.* at 576.

is especially true where an individual's publicity interest would be completely eviscerated by a purported First Amendment use:

Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the *First* and *Fourteenth Amendments* do not immunize the media when they broadcast a performer's entire act without his consent. The Constitution no more prevents a State from requiring respondent to compensate petitioner for broadcasting his act on television than it would privilege respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner.⁸⁶

When considered in the context of IP social utility, the social justice function of publicity rights becomes even more significant. Consistent with the Supreme Court's observations, subsequent courts have recognized that in instances of a conflict between the First Amendment rights and the right of publicity, free speech interests are not the only social utilities to be protected:

[H]aving recognized the high degree of First Amendment protection for noncommercial speech about celebrities, we need not conclude that all expression that trenches on the right of publicity receives such protection. The right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility. "Often considerable money, time and energy are needed to develop one's prominence in a particular field. Years of labor may be required before one's skill, reputation, notoriety or virtues are sufficiently developed to permit an economic return through some medium of commercial promotion. For some, the investment may eventually create considerable commercial value in one's identity."

[A state's] decision to protect [a performer's] right of publicity . . . rests on more than a desire to compensate the performer for the time and effort invested in his act; the protection provides an economic incentive for him to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright laws long enforced by this Court.

Id.; See also Melissa B. Jacoby & Diane Leenheer Zimmerman, *Foreclosing on Fame: Exploring the Uncharted Boundaries of the Right of Publicity*, 77 N.Y.U. L. REV. 1322, 1330 (2002) ("[C]elebrities 'create' their valuable personas in much the same way that a novelist creates a work of fiction or an inventor a new device. Thus, giving the famous individual a property right in this form of intellectual property has been explained as an incentive to promote future creativity, as a reward for a valuable service to the public, or as a means of preventing unjust enrichment."); Kwall, *supra* note 82, at 74 ("As a society, we can suffer two general types of harms from the toleration of unauthorized uses of an individual's persona. One type of harm focuses on the increased potential for consumer deception, and the other focuses on the increased potential for diminished incentives.").

86. *Zacchini*, 433 U.S. at 574–74 (emphasis added).

The present case exemplifies this kind of creative labor. Moe and Jerome (Curly) Howard and Larry Fein fashioned personae collectively known as The Three Stooges, first in vaudeville and later in movie shorts, over a period extending from the 1920's to the 1940's. The three comic characters they created and whose names they shared—Larry, Moe, and Curly—possess a kind of mythic status in our culture. Their journey from ordinary vaudeville performers to the heights (or depths) of slapstick comic celebrity was long and arduous. Their brand of physical humor—the nimble, comically stylized violence, the “nyuk-nyuks” and “whoop-whoop-whoops,” eye-pokes, slaps and head conks—created a distinct comedic trademark. Through their talent and labor, they joined the relatively small group of actors who constructed identifiable, recurrent comic personalities that they brought to the many parts they were scripted to play.⁸⁷

Resourceful ingenuity and creativity exercised under challenging socio-economic conditions often spur the development, refinement, and stylization of personal attributes and individual innovations, which can in turn engender enormous popular culture interest and concomitant commercial potential.⁸⁸ However, institutionalized barriers to information, financial capital, and legal support often preclude marginalized innovators from taking a full advantage of commercial exploitation while facilitating exploitation by majority enterprises and concerns.⁸⁹ The misappropriation or other inequitable exploitation of the publicity rights of members of marginalized groups, which have fewer entrepreneurial/access to wealth opportunities⁹⁰ presents an especially inviting opportunity for a social justice oriented application of the right of publicity, since such unfair exploitation undermines the enunciated social utility/

87. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 804–05 (Cal. 2001). As discussed in Part IV, *infra*, the *Comedy III* court promulgated its own test for balancing right of publicity and First Amendment interests, the “transformative test”. *Id.* at 808. Under the transformative test, a court examines the extent of the user’s expressive transformation of the plaintiff’s image or persona, to determine whether the user is trading upon the plaintiff’s recognizable image or has transformed that image into a new expressive work. *Id.* Also in Part IV, the *Rogers* and *Comedy III* tests measure different social utilities, and selecting the appropriate test is critical to a proper balancing of right of publicity and First Amendment interests.

88. *See Heimes, supra* note 77, at 151.

89. *Id.* at 148–49.

90. *See* Lateef Mtima, Symposium, *African-American Economic Empowerment Strategies for the New Millennium – Revisiting the Washington-Du Bois Dialectic*, 42 How. L.J. 391, 428–29 (1999); W. Sherman Rogers, *The Black Quest for Economic Liberty: Legal, Historical, and Related Considerations*, 48 How. L.J. 1, 59 (2004).

justice goals of the right of publicity as well as ecumenical principles of justice.⁹¹

To properly assess and balance right-of-publicity interests against other important societal goals, and thereby delineate socially productive parameters for publicity rights, it is necessary to identify important social utility functions underlying the right of publicity. Invocation of the overarching social utility goals of intellectual property law is a cogent mechanism for resolving IP disputes in the digital information age and balancing constituent interests and competing social objectives.⁹² Moreover, when courts evaluate intellectual property disputes within the context of social productivity and efficacy, their reasoning typically illuminates a functional interdependence between IP social utility and IP social justice: socially propitious mecha-

91. See, e.g., K.J. Greene, *Right of Publicity, Identify, and Performance*, 28 SANTA CLARA COMPUTER & HIGH TECH. L.J. 865 (2011). The social utility goals that underlie the Lanham Act, including protection against unfair competition and consumer confusion, also resonate with the above-enumerated right of publicity social justice objectives. See Heimes, *supra* note 77, at 149. Not only should marginalized individuals derive the commercial benefits from the “persona properties” they develop, but the consuming public should not be misled into supporting products and business unaffiliated with individuals whom they admire and revere. Thus, right-of-publicity social justice can also be pursued and enforced through the companion federal false endorsement cause of action.
92. See, e.g., *Id.* at 144 (“The relevance of protecting identity from misuse is heightened exponentially by technological advancements in digital communication. Images can be copied from one location, edited, and reposted to another in myriad new ways—some flattering but many not—by anonymous Internet users generally beyond the reach of the law.”). Of course, advances in digital information technology also offer new and socially beneficial opportunities for the development, dissemination, and exploitation of information and ideas, innovative advances, and individual creative expression. The parameters of intellectual property protection must be continuously reassessed to ensure that they complement the immediate and potential boons of such advances, so that technological options and opportunities for social good are not impeded by legal sub-structures incompatible with unanticipated kinds and uses of intellectual property. See generally Jamar, *Crafting Copyright Law to Encourage and Protect User-Generated Content in the Internet Social Networking Context*, *supra* note 41, at 848–49 (advocating to modify the Copyright Act and codify current practice in the social media. Among other things, the author proposes to allow “noncommercial social network users to post links to and portions of copyrighted work without permission” and a “broad right to create and disseminate derivative works online for noncommercial purposes.”); Lateef Mtima, *Tasini and its Progeny: The New Exclusive Right or Fair Use on the Electronic Publishing Frontier?* 14 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 369, 409–13 (2004); Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright*, 125 HARV. L. REV. 683, 687–88 (2012) (discussing “un-governability of images in copyright law” and advocating adopting the true “reproduction right” against the standard of exact or near-exact copying).

nisms also tend to be socially just ones (and vice versa). Accordingly, the proper adjudication of right-of-publicity claims can achieve a beneficial social utility/social justice balance—one that is disrupted where the assessment is “IP social justice insensitive” or outright IP Imperialist in perspective.⁹³

Some courts have found it difficult to achieve proper social utility balance in publicity disputes because they fail to accord proper weight to the social justice attributes of the right of publicity or to otherwise assess the full range of social utility interests at issue.⁹⁴ The failure to appreciate these social justice objectives and concerns has caused some courts to needlessly and unfairly restrict right-of-publicity interests and sometimes inadvertently service IP Imperialistic agendas.⁹⁵

93. IP Imperialist stratagems thus have the same deleterious effect in both the indigenous culture and marginalized communities contexts. *See, e.g.*, Drahos, *supra* note 35, at 5 (“Does it matter if the capacity of [developing countries] to influence the [IP] standard-setting process remains weak? . . . Since intellectual property rights are but one micro-tool of national policy it is difficult to isolate their importance as a variable in development. If, as the World Bank has suggested, development is about expanding the ability of people “to shape their own futures” then we have a prima facie normative reason to be concerned about the loss of national sovereignty of developing countries over standards that impact on sectors such as agriculture, food, environment, health and education.”); Recht, *supra* note 37, at 284, (“Protection of intellectual property in indigenous societies implicates issues of human rights, cultural survival, and physical subsistence of those societies. ‘Primarily . . . when we talk about protecting traditional knowledge we are talking about protecting the livelihoods of the poor.’ In 1993, the UN Subcommittee on the Prevention of Discrimination and Protection of Minorities and its Working Group on Indigenous Populations produced ‘The Study on the Protection of the Cultural and Intellectual Property of Indigenous Peoples,’ which placed protection of indigenous knowledge into the context of human rights.” (quoting Coombe, *supra* note 36, at 278)); *See also* Coombe, *supra* note 36, at 277–78 (discussing “international law-making efforts with respect to indigenous and traditional environmental knowledge”).

94. *Doe v. TCI Cablevision of Mo.*, No. ED 78785, 2002 WL 1610972, at *12 (E.D. Mo. 2002).

95. For example some courts have observed that certain social utility objectives that underlie the right of publicity are less important where celebrity interests and incentives are involved. *See, e.g.*, *Cardtoons, L.C. v. Major League Baseball Players Ass’n.*, 95 F.3d 959, 969 (10th Cir. 1996).

“[E]ven without the right of publicity the rate of return of stardom in the entertainment and sports fields is probably high enough to bring forth a more than ‘adequate’ supply of creative effort and achievement.” . . . [C]elebrities would still be able to reap financial reward from authorized appearances and endorsements. The extra income generated by licensing one’s identity does not provide a necessary inducement to enter and achieve in the realm of sports and entertainment. Thus, while publicity

The next Part discusses four cases involving analyses relevant to creating a more socially cognizant application of publicity laws. In the first three cases, courts' uninformed perceptions of the social utility objectives of the right of publicity led to unduly narrow, and in some instances patently unjust, applications of the law. In the final case, however, the court's analysis demonstrates how these issues can be assessed in a more socially efficacious manner.

PART IV: THE RIGHT OF PUBLICITY AND JUDICIAL "SOCIAL JUSTICE MYOPIA"

As discussed in Part III, a significant challenge to proper enforcement of publicity rights is a persistent misperception that certain, hallowed social objectives, such as those promoting free and open discourse, in disputes over the unauthorized exploitation of publicity rights. While these social interests are obviously important, there can also be competing and equally important publicity-based social utility and social justice interests at stake. Society's interest in promoting notable achievements, social equity, and economic empowerment (particularly in connection with marginalized members of society) through innovative undertakings and/or the development and exploitation of individualized styles and personas can be just as important as society's interest in unbridled expression. Consequently, to preserve social utility objectives of the right of publicity, it is essential that right-of-publicity practitioners and commentators assist the courts in identifying the full range of social utility and social justice interests involved in right of publicity cases.

The four cases discussed in this Part explore the issue of heightening judicial awareness of social utility/social justice functions of the right of publicity. The first case explores the issue of judicial insensitivity to the right of publicity social utility and social justice as a threshold matter.⁹⁶ Where a court all but fails to acknowledge the important social function of publicity rights, virtually any competing social interest will appear to outweigh the publicity right holder's interests and can lead to inequitable and unjust results. The remaining cases analyze the problem of balancing the acknowl-

rights may provide some incentive for creativity and achievement, the magnitude and importance of that incentive has been exaggerated.

Id. at 974 (quoting Madow, *supra* note 73, at 210). While this is true in some cases, it overlooks the realities faced by some members of marginalized communities. It is the prospect of attendant compensation that motivates an inner city youth to pursue a career as a professional athlete in the face of overwhelming statistics that she will likely not have a professional career. And even if she never makes it to the "majors" endorsement opportunities and other exploitation of personal celebrity can provide a path out of poverty, especially for those who also face institutionalized racial impediments.

96. See *Brooks v. Topps Co.*, 86 U.S.P.Q.2d (BNA) 1361 (S.D.N.Y. 2007).

edged social utilities of the right of publicity against other social interests.⁹⁷ In these cases, the issue is according proper weight to the social function of the right of publicity, so as to ensure an achievement of appropriate balance of all the pertinent social interests and objectives.

A. Identifying Opportunities for the Right of Publicity Social Justice: *Brooks v. Topps Co.*⁹⁸

The dispute in *Brooks v. Topps Co.* presented a prime opportunity for a social justice application of the right of publicity.⁹⁹ However, the decision is a paradigm of judicial insensitivity to the social utility function of the right of publicity. In *Brooks*, Connie Brooks, the daughter of deceased African-American Baseball Hall of Famer James Bell, brought right of publicity and false endorsement claims in connection with the unauthorized use of her father's image on baseball trading cards.¹⁰⁰ Before his death, Bell had actively exploited his celebrity persona:

Bell granted the National Baseball Hall of Fame permission to use his name and likeness on various products. In 1989, he contracted with Gartlan USA, Inc., to autograph cards that the company would sell along with figurines in his likeness. Following Bell's death, [the plaintiff] granted commercial licenses to use Bell's name and images of him. In or around 1994 and 2001, Brooks licensed Bell's name to the Upper Deck Company . . . for use on baseball cards. . . . From approximately September 17, 1993 through June 1, 1994, she licensed Bell's name and a particular image of him to Rodrigues Studio for use on clothing and prints. She also entered into a licensing agreement with General Mills to permit it to print Bell's name and likeness on Wheaties Boxes sold around February 1996. Around mid-1996, she licensed Bell's "name and likeness" to a company called Crown Crafts, for use on throw blankets.¹⁰¹

Subsequent to Bell's death, Brooks discovered that The Topps Trading Company ("Topps"), a well-known purveyor of sports trading cards and memorabilia, had engaged in various unauthorized uses of her father's image, whereupon she undertook extensive efforts to determine the full scope of Topps' unauthorized activities:

97. See *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3d Cir. 2008); *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134 (9th Cir. 2006); *Brown v. Elec. Arts, Inc.*, Case No. 2:09-cv-01598-FMC-RZx, 2009 U.S. Dist. LEXIS 131387 (C.D. Cal. Sept. 23, 2009).

98. 86 U.S.P.Q.2d (BNA) 1361.

99. *Id.*

100. *Id.* at 1364.

101. *Id.* at 1363.

Topps's first contact with Brooks occurred in late 2004. Brian Koeberle ("Koeberle"), acting on behalf of Topps, contacted Brooks by telephone to ask if she would license her father's name and likeness for baseball cards to be published in 2005. At this time Brooks did not know, and Koeberle did not mention, that Topps had previously published seven cards depicting Bell. After several telephone conversations, Koeberle sent Brooks an unsolicited proposed license agreement. Under this draft, dated December 17, 2004, Topps would have paid Brooks \$ 5,000 for the non-exclusive right to use Bell's name and image on its trading cards for the year 2005. *Koeberle stated in the cover letter that Brooks had agreed in the telephone call to this offer, but she had not done so.* Brooks rejected this agreement.

In early 2005, a friend told Brooks that Topps might have sold a Bell card. Brooks asked Topps about this. On February 15, 2005, she received a letter from Philip J. Carter ("Carter"), Director of Sports/Player Licensing at Topps, enclosing the 2004 eTopps card and one of the 2004 Tribute Hall of Fame cards and saying that Carter was still looking for other cards Topps may have published depicting Bell. Brooks called Carter and told him she wanted Topps to stop engaging in any conduct relating to Bell, requested compensation for the two cards Topps had printed in 2004, and asked if Topps had printed any other Bell cards.

In mid-2005, a friend of Brooks showed her one of the 2001 Topps Bell cards. Brooks immediately contacted Carter, who asked questions about the card and said he knew nothing about it but would look into it. In response to further inquiries from Brooks, Carter said he was unable to find any information about the 2001 card or any other Bell card.

On June 26, 2005, Topps offered Brooks \$ 35,000 to sign a settlement agreement and release of liability ("Settlement Agreement"). She refused and asked again for an accounting of all of the Bell cards Topps had published.

On December 27, 2005, Brooks wrote a letter to Carter demanding a retraction of the erroneous Nickname Statement, a luncheon in her father's honor, and full information about all of the Bell cards Topps had published. Carter responded by offering to publish a correction of the Nickname Statement and to discuss publishing another Bell card on condition that Brooks sign the Settlement Agreement.

By letter dated January 31, 2006, Adam Zucker, Carter's successor, provided Brooks with a list of "all cards of Cool Papa Bell produced by Topps from 2001-2005."¹⁰²

102. *Id.* at 1364 (emphasis added). In addition to producing the trading cards, Topps also affirmatively marketed that Bell endorsed the use of his name and image:

Topps issued promotional materials for both the 2001 and 2004 cards. The 2004 promotional materials contained two statements that Brooks notes in her opposition papers. One footnote in those materials stated in miniscule print that "[a]lthough these players have agreed to provide these cards for

Although there was no dispute as to Topps' unauthorized conduct, Topps moved for summary judgment on the grounds that the statute of limitations had run.¹⁰³ The motion was granted by the court:

The relevant New York cause of action, an action for right of publicity claims . . . has a one-year statute of limitations. . . . Under the single publication rule, this limitations period runs from the date of an offending item's publication, and "the dissemination of that same offending item thereafter does not give rise to a new cause of action, nor does it refresh the running of the statute of limitations."

The first publication of the most recent baseball card at issue. . . occurred on November 1, 2004. Brooks filed her lawsuit more than one year later, on March 27, 2006.¹⁰⁴

The court was unmoved by Brooks' arguments that the limitations period should be tolled in light of Topps' evasive actions:

[Brooks] argues that the discovery rule, under which the statute of limitations would run from the date on which she discovered or reasonably could have discovered the defendant's actions, should apply here. Brooks does not contend that New York courts have ever found that a right of publicity claim accrues upon discovery, but argues that it should be adopted here in order to avoid depriving her of "a reasonable chance to assert a valid claim."

. . . .

. . . Brooks' request for such an extension is rejected. Under New York law, statutes of limitations "cannot be deemed arbitrary or unreasonable solely on the basis of a harsh effect."

Brooks next argues that Topps should be estopped from asserting a statute of limitations defense because it concealed the existence of certain cards from her.

. . . .

December 7, 2005 was at least arguably within the limitations period for the non-disclosed 2004 cards. There is no evidence, however, that Topps made affirmative misrepresentations to Brooks within one year of the date the cards were published.¹⁰⁵

Topps, we cannot guarantee that all autographs . . . will be received in time for inclusion in this product.

Id.

103. *Id.* at 1362.

104. Brooks, 86 U.S.P.Q.2d (BNA) at 1365 (citations omitted).

105. *Id.* at 1365, 1366 (citations omitted). The court also went out of its way to dismiss plaintiff's federal claims:

The court's latter finding seems not only cursory, but also social utility/justice blind. A reasonable fact-finder could have concluded that Topps had indeed engaged in a well-timed subterfuge, which conveniently came to a halt (and with a comprehensive listing of all unauthorized uses of Bell's image) just weeks after the limitations period ran. In addition, Bell's daughter had commenced the litigation as a pro se litigant. These facts would seem to indicate that a weighing of the relevant equities strongly supported the tolling of the statute.¹⁰⁶

Unfortunately, the court seemed concerned only with the social utilities underlying the limitation rules, which is particularly unsatisfying because few, if any, of these utilities were actually implicated in the litigation. For example, the operative facts covered a relatively short and recent time period, and thus the typical concerns over stale evidence, faulty memories, or unavailable witnesses were not an issue.¹⁰⁷ Moreover, not only does the court's

Personal names and photographs are not inherently distinctive, and therefore are "protected only if, through usage, they have acquired distinctiveness and secondary meaning."

"'Secondary meaning' is a term of art referencing a trademark's ability to identify the source of the product rather than the product itself." . . . Factors that may be considered in determining whether a mark has developed secondary meaning include "(1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and (6) length and exclusivity of the mark's use."

Brooks has presented no evidence relating to four of these six factors. With respect to the fourth and sixth factors, she has described several commercial licensing arrangements, has offered documentary evidence corroborating the existence of one of them, but has provided no evidence of any sales made to the public by the licenses. While Brooks licensed Bell's name commercially on scattered occasions in 1993, 1994, 1996, and 2003, Brooks licensed the image of Bell at issue here on a single occasion. Given this record, no reasonable juror could find that "the public is moved in any degree to buy an article" displaying Bell's name or image based on the belief that it implies endorsement by his estate, Brooks, or by any unknown source.

Id. at 1367–68 (citations omitted). *Id.* it implies endorsement by his estate, Brooks, or by any unknown source.

106. For an in-depth discussion of the court's disposition of Topps' limitations defense and an alternative analysis of the issue, see Ritu Narula, "Wait, I Didn't Even Know My Picture Was Taken!": Application of the Discovery Rule to a Right of Publicity Claim, 53 *How. L.J.* 859, 860-61 (2010).
107. *Id.* at 879-81; see also *Christoff v. Nestlé USA, Inc.*, 62 *CAL. RPTR.* 3d 122, 144 (Cal. Ct. App. 2007), *aff'd in part, rev'd in part*, 47 Cal. 4th 468 (2011) (wherein, in addressing the application of the statute of limitations, the court directed that on remand the trial court should instruct the jury to determine "whether a reasonable person in [the plaintiff's] position had a meaningful abil-

decision fail to promote statute of limitations' objectives, it undermines the policies underlying the right of publicity, as well as general notions of social justice, and further promotes IP imperialist overreaching. Defendant Topps is a major purveyor of IP products that aggressively protects its own IP rights¹⁰⁸ but apparently has no qualms about engaging in the brazenly illegal use of an African American baseball legend's image and persona. The result here is a paradigmatic reinforcement of the "what's mine is mine but what's your is ours" robber baron view of IP rights.

One explanation for the court's narrow approach may be insensitivity to the social utilities underlying Bell's publicity rights, of which the court seems to take no notice. There was little societal benefit in allowing the pirated use of Bell's image. However, there were important social utilities to be served in protecting the rights of a socially marginalized African-American sports figure, who achieved a successful baseball career and developed a celebrity persona despite being denied many social and legal rights and advantages.¹⁰⁹ As the Supreme Court observed in *Zacchini*, providing encouragement for this kind of social productivity is one of the central purposes underlying publicity rights.¹¹⁰

The *Brooks* decision demonstrates the need for threshold sensitivity to the social utility/justice bases of the right of publicity. In this case, where the countervailing social utilities were virtually non-existent, recognition of these important functions of publicity rights would almost certainly have resulted in the opposite outcome.

**B. Balancing First Amendment and Right of Publicity Social Utility:
*Brown v. Electronic Arts, Inc.*¹¹¹**

Even when courts acknowledge the social utility of the right of publicity, they often fail to afford it an appropriate weight, when measured against competing social objectives. Arguably, the most challenging balancing problems are those involving First Amendment rights. Despite the Supreme

ity to discover the [unauthorized] use of his likeness."'). A possible reason for the reluctance of the *Brooks* court to consider the tolling issue may be the lack of a framework through which to determine when publicity limitations periods should (or should not) be tolled. A proposal for such a framework is offered in Part V, *infra*.

108. Indeed, the irony that the leading right of publicity case was brought by a trading card company seems to have escaped the court. *See Haelan Labs., Inc., v. Topps Chewing Gum, Inc.*, 202 F.3d 866 (2d Cir. 1953).

109. William C. Rhoden, Sports of the Times: Cool Papa's Stolen Moments, N.Y. TIMES, Aug. 7, 1990, available at <http://www.nytimes.com/1990/08/07/sports/sports-of-the-times-cool-papa-s-stolen-moments.html>.

110. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

111. Case No. 2:09-cv-01598-FMC-RZx, 2009 U.S. LEXIS 131387 (C.D. Cal. Sept. 23, 2009).

Court's admonitions in *Zacchini*, many courts demonstrate almost Pavlovian deference to free speech claims, when confronted with a First Amendment defense to a claim of misappropriation of publicity rights.¹¹²

Brown v. Electronic Arts, Inc., provides a recent example.¹¹³ In *Brown*, NFL Hall of Famer Jim Brown brought a suit claiming both Lanham Act false endorsement and state law invasion of privacy (publicity) in connection with the use of his likeness in the *Madden NFL* video game series.¹¹⁴ "Brown allege[d] that [the defendant] misappropriated his name, identity, and likeness by including him in the games as a player on two 'historic' teams."¹¹⁵ Although the company did not use Brown's name and jersey number in the games, Brown argued that the defendant had merely made superficial changes to the subject avatar to avoid liability:

In the games, virtual players on current NFL teams wear the names and numbers of real-life players, whereas players on historical teams are anonymous, represented by numbers and roster positions. . . .

. . . The character who purportedly represents Brown in the game is anonymous, and wears jersey number 37; Brown wore number 32. . . . Brown and his doppelgänger have "nearly identical" statistics.¹¹⁶

In its defense, the defendant argued, *inter alia*, that its unauthorized use constituted a literary expression protected by the First Amendment.¹¹⁷ In resolving the dispute, the court predicated its analysis on *Rogers v. Gri-*

112. *Rogers v. Grimaldi*, 875 F.2d 944, 1004 (2d Cir. 1989) (citations omitted). It has been observed that First Amendment concerns play a special role in the judicial curbing of publicity rights:

Because the right of publicity, unlike the Lanham Act, has no likelihood of confusion requirement, it is potentially more expansive than the Lanham Act. Perhaps for that reason, courts delineating the right of publicity, more frequently than in applying the Lanham Act, have recognized the need to limit the right to accommodate First Amendment concerns.

In particular, three courts, citing their concern for free expression, have refused to extend the right of publicity to bar the use of a celebrity's name in the title and text of a fictional or semi-fictional book or movie. . . .

. . . .
Commentators have also advocated limits on the right of publicity to accommodate First Amendment concerns.

Id. at 1004 & n.11 (citations omitted) (emphasis added). See also James M. Treece, Commercial Exploitation of Names, Likenesses, and Personal Histories, 51 *Tex. L. Rev.* 637, 671-72 (1973).

113. See 2009 U.S. Dist. LEXIS 131387.

114. *Id.* at *2, *4.

115. *Id.* at *4.

116. *Id.* at *3-4.

117. *Id.* at *7.

maldi.¹¹⁸ The court began by noting that the defendant's use was a "literary expression" under the First Amendment.¹¹⁹ "It is well established that 'video games are a form of expression protected by the First Amendment.'"¹²⁰ Having found the use to be an expressive one, the court then applied the *Rogers* "relevance of the use to the work" standard, noting that, in its view, the level of relevance of the persona to the subject work need merely be "above zero" to sustain the unauthorized use.¹²¹ Finally, the court observed that, in a game involving manipulation of virtual athletes and franchises, "[u]se of a legendary NFL player's likeness in a game about NFL football is clearly relevant."¹²² Consequently, having found the use of Brown's persona relevant to the video game (and not merely a contrived invocation of Brown's celebrity to market or advertise the game) the court (i) ruled for defendant on Brown's false endorsement claim¹²³ and allowed the use,¹²⁴ and (ii) declined

118. *Rogers v. Grimaldi*, 875 F.2d 994, 1004–05 (2d Cir. 1989).

119. *Brown*, 2009 U.S. Dist. LEXIS 131387, at *11–12.

120. *Id.* at *8. (quoting *Video Software Dealers Ass'n v. Schwarzenegger*, 556 F.3d 950, 958 (9th Cir. 2009)). Such automatic bestowal of literary expression status to video games, however, is not without criticism. See Ronald S. Katz, Courts, Sports and Video Games: What's In A Game?, *Law360*, Jan. 4, 2012, available at http://www.manatt.com/uploadedFiles/News_and_Events/Newsletters/ManattSports/Courts,%20Sports%20and%20Videogames.pdf ("[The Supreme Court's] sweeping references to character, plot and social messages [in connection with video games] are completely irrelevant to such videogames as Pong, which has as its only object getting a moving dot past a moving line. Pong expresses nothing. It's just a game and, as such, has no claim to First Amendment protection."). Video games run the gamut from Pong and Pac Man to World of Warcraft and involve differing degrees of expressive content. Moreover, as discussed below, focusing on the expressive value of the subject work misses the point in right of publicity disputes. The issue is not whether the work contains sufficient creative elements so as to be considered expressive, but rather to what extent has the defendant's expressive contributions transformed the plaintiff's image or persona. See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001).

121. *Brown*, 2009 U.S. LEXIS 131387, at *10–11; *Rogers*, 875 F.2d 994.

122. *Brown*, 2009 U.S. Dist. LEXIS 131387, at *8.

123. *Id.* at *13–14. In connection with Brown's false endorsement claim, the court further found that, under *Rogers*, an unauthorized but relevant use of a persona could still be prohibited if the prospect of consumer confusion (as to whether Brown had in fact endorsed the video game) outweighed the public interest in free expression. *Id.* at *13. The court concluded that there was no such likelihood of confusion in the case before it. *Id.* at *14.

124. *Id.* at *15.

The *Madden NFL* character that Brown alleges bears his likeness is one of thousands of virtual athletes in the games. Unlike most of the other characters, this virtual athlete is anonymous: he is identified only by a jersey

jurisdiction over Brown's state law publicity claim and dismissed the complaint.¹²⁵

Although the *Brown* court resolved only the false endorsement claim, its findings regarding the relevance of Jim Brown's persona to the subject work is also key to balancing First Amendment and publicity rights interests under the *Rogers* test. In fact, under *Rogers*, the assessment of the relevance of the plaintiff's persona is dispositive in resolving First Amendment/publicity disputes because, unlike false endorsement claims, there is no secondary assessment as to whether the use is also prohibitively confusing.¹²⁶ In this regard, publicity rights are narrower than false endorsement rights, since if the unauthorized use is found expressively relevant, the right of publicity analysis is over and the use is allowed.

While the *Brown* court invokes established mechanisms¹²⁷ in assessing the plaintiff's claims, its selection and application of these mechanisms reflects a misunderstanding of the social utility interests implicated in the dispute. To start, the *Brown* court misstates, and arguably misapplies, the *Rogers* test. Whereas the *Rogers* court sought to determine whether the use of Ginger Rogers' name in the title of a movie was "'wholly unrelated'" to the film,¹²⁸ the *Brown* court rearticulates the *Rogers* test as calling for a level of relevance that is only "'above zero.'"¹²⁹ Not only does such a standard essentially eliminate the relevance assessment, it all but guarantees that the unauthorized use of any notable individual's persona will always be permit-

number and his roster position as a running back. The character, and Brown's name, are not depicted on the games' packaging or in their advertising. . . . Brown has not pointed to any *Madden NFL* promotional materials that feature his name or likeness.

Id. at *13.

125. *Id.* at *15.

126. *Rogers*, 875 F.2d at 999.

127. *Brown*, 2009 U.S. Dist. LEXIS 131387, at *12. There is no shortage of tests for evaluating the parameters of the right of publicity as against the First Amendment. See *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 775 (D.N.J. 2011) ("Courts throughout the United States have utilized up to eight 'balancing' tests that attempt to weigh the First Amendment rights of an author/creator against the right of publicity."). The variety of tests, their differing assessment emphases, and their derivation from other areas of intellectual property law suggest a compelling need for an overarching right of publicity social utility schema that retrofits the right into the intellectual property social utility regime.

128. *Rogers*, 875 F.2d at 1004.

129. *Brown*, 2009 U.S. LEXIS 131387, at *9–10 (quoting *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008)); *c.f. Grimaldi*, 875 F.2d at 1004 (quoting *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 457 n.6 (Cal. 1979)).

ted on First Amendment grounds.¹³⁰ Under the *Brown* re-interpretation of *Rogers*, the use of Jim Brown's persona in any work concerning football, sports, movie stars, or even popular trends of the 1960s or 1970s would be permissible under the First Amendment because Jim Brown's personal accomplishments are "relevant" to each of those subjects (and many others). Even the personas of non-celebrities would be vulnerable to boundless unauthorized exploitation under *Brown*, as any notable achievement will have more than "zero relevance" to any work or product which involves the same subject matter.¹³¹

The *Brown* court seems to miss the point of the *Rogers* test. In *Rogers*, the defendant's parody-like use of Ginger Rogers's name infused the defendant's use with the kind of relevance to the defendant's film that negated any inference that the invocation of Ginger Rogers's persona was merely a "disguised advertisement" to promote the movie.¹³² Indeed, with only minimal investigation, Ginger Rogers's fans would quickly discover that the film had nothing to do with the iconic movie star, and thus the title "Ginger and Fred" is not likely to induce Ginger Rogers's fans to buy tickets to the film. By contrast, the key "relevance" of Jim Brown's persona to *Madden NFL* is that its inclusion fulfills the game's promise that players will have the opportunity to "compete" against Jim Brown. While this use is certainly "relevant" to the work, it is principally "relevant" to generating consumer interest in purchasing and playing *Madden NFL*. Unlike *Rogers*, *Brown* does not appear to distinguish between expressive/artistic relevance and commercial/promotional relevance.

In reducing the *Rogers* relevance test to an "above zero" standard, the *Brown* court failed to account for the fact that, although Jim Brown's football exploits are indeed an important and "relevant" part of football history, not

130. In *Rogers*, the relevance of Ginger Rogers' persona to the expressive work at issue was akin to that of parody: the film was about two fictional and unglamorous Italian dancer contemporaries of the Rogers and Astaire team, and was intended as a social commentary on Hollywood and television facades and hypocrisies. *Rogers*, 875 F.2d at 996–97. By comparison, a film on the history of dance throughout the world entitled *Ginger and Fred* should not satisfy the *Rogers* test merely because Rogers and Astaire's accomplishments are important in the field; such a result would conflate "historical" and "relevant" and render inert the *Rogers*' relevance requirement. *See id.* at 1001.

131. *See Nature's Way Prods., Inc. v. Nature-Pharma, Inc.*, 736 F. Supp. 245, 253 (D. Utah 1990) (mem. op.) ("[Defendants] are using an historical fact to market a different product. . . . Defendants' historical exception argument, if granted, would work to cause essentially every right of publicity case to fail on the basis that every truthful reference to a famous person in connection with an advertised product could be considered to be 'historical information.' Because 'historical information' is being used in the instant case to market a product that is independent of the information itself, defendants' argument is without merit and is rejected."); *supra* text accompanying note 107.

132. *Rogers*, 875 F.2d at 1004–05.

every invocation of Brown's accomplishments or attributes is undertaken for its historical value. The replication of Jim Brown's "statistical attributes" as an avatar in a commercially distributed video game or similar product might otherwise be undertaken primarily for its commercial marketing appeal, or perhaps even for a combination of promotional and expressive purposes.¹³³ In such cases, an "above zero" relevance standard overlooks any exploitative purpose or effects arising from the use of the persona, and all but the most blatant misappropriations of an individual's publicity rights become permis-

133. The *Rogers* court made this observation in connection with the unauthorized use of a persona in the title of an artistic work. "Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker's expression as well as a significant means of marketing the film to the public." *Rogers*, 875 F.2d at 998. Other courts have reached similar conclusions. See *Parks v. LaFace Records*, 329 F.3d 437, 447, 453–54, 561 (6th Cir. 2003) (discussing use of plaintiff's name as a song title and holding that "the First Amendment cannot permit anyone who cries 'artist' to have *carte blanche* when it comes to naming and advertising his or her works, art though it may be. . . . If the requirement of 'relevance' is to have any meaning at all, it would not be unreasonable to conclude that the title *Rosa Parks* is *not* relevant to the content of the song in question. The use of this woman's name unquestionably was a good marketing tool—*Rosa Parks* was likely to sell far more recordings than *Back of the Bus*—but its use could be found by a reasonable finder of fact to be a flagrant deception on the public regarding the actual content of this song and the creation of an impression that Rosa Parks . . . had also approved or sponsored the use of her name on Defendants' composition. . . . [W]e believe that Parks' right of publicity claim presents a genuine issue of material fact regarding the question of whether the title to the song is or is not 'wholly unrelated' to the content of the song. A reasonable finder of fact . . . upon consideration of all the evidence, could find the title to be a 'disguised commercial advertisement' or adopted 'solely to attract attention' to the work." (citations omitted) (some emphasis added)). In sum, *Rogers* and *Parks* would not allow a promotional use of a publicity persona to provide the kind of connection to the defendant's work that would enable the unauthorized use to pass the "wholly unrelated" test. Moreover, these cases do not preclude the possibility of a mixed expressive/promotional use. There is no reason that aspects of a legendary football Hall of Famer persona could not be used in a similar hybrid manner in a football video game, thereby rendering the expression at least partially commercial speech in nature and diluting its First Amendment status. See McCarthy, *The Spring 1995 Horace S. Manges Lecture—The Human Persona as Commercial Property: The Right of Publicity*, *supra* note 67, at 137 ("[C]ommercial speech . . . is a form of free speech but is not given nearly as much protection as traditional political or entertainment speech."). In mixed expressive/promotional use situations, the issue may not be that of the plaintiff's publicity interests being at odds with a compelling societal interest in free speech, but rather simply one of deciding as between the plaintiff and the defendant how the fruits of the commercial exploitation of the plaintiff's persona should be allocated.

sible.¹³⁴ Thus, the social utilities underlying the right of publicity are unduly diminished under *Brown*.

As troubling as the *Brown* court's misapplication of *Rogers* is, however, it is not the most problematic deficiency in the court's analysis. The court's most significant error is the fact that it relied upon the *Rogers* test in the first place. *Rogers* involved the use of a person's name in the *title* of a work; *Brown* concerns the use of aspects of an individual's persona *in the expressive work itself*. The appropriate test for assessing a purported First Amendment use of a persona within an expressive work is not *Rogers*, but rather is the transformative test first enunciated in *Comedy III Productions, Inc., v. Gary Saderup, Inc.*¹³⁵

In *Comedy III*, the defendant reproduced the photographic likenesses of the Three Stooges onto t-shirts, which he sold commercially.¹³⁶ In response to claims for infringement upon the Three Stooges' publicity rights, defendant argued that he had a First Amendment right to engage in his use—in essence, a right to “express himself” by reproducing and disseminating the Three Stooges' images.¹³⁷ In balancing the defendant's asserted First Amendment claims against the plaintiffs' publicity rights, the court delineated the property interests and social utilities encompassed by the right of publicity:

What the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity's fame through the merchandising of the “name, voice, signature, photograph, or likeness” of the celebrity.

. . . .

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.

134. See *Brown*, 2009 U.S. Dist. LEXIS 131387, at *12. “Zero relevant” commercial uses of an individual's persona, such as using Jim Brown's picture to sell cars or cookies would of course be actionable even under *Brown*. Limiting publicity claims to such infractions, however, improperly narrows the right and disregards its broader social benefits.

135. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 798 (Cal. 2001) (formulating “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.”).

136. *Id.* at 800–01.

137. *Id.* at 802.

....

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.¹³⁸

Given that the defendant had reproduced exact replicas of the Three Stooges' likenesses, the court held that the images had been in no way "transformed" and that "the marketability and economic value of [the defendant's] work derives primarily from the fame of the celebrities depicted. While that fact alone does not necessarily mean the work receives no First Amendment protection, we can perceive no transformative elements in [the defendant's] works that would require such protection."¹³⁹

Recently, in *No Doubt v. Activision Publishing, Inc.*, the court applied the *Comedy III* test to facts analogous to those at issue in *Brown*.¹⁴⁰ In *No Doubt*, a computer-generated likeness of the rock band No Doubt was used in certain ways in a video game without the band's permission.¹⁴¹ Since the use of No Doubt's persona was within the subject work, the court did not apply the *Rogers* test for evaluating titles, but instead applied the *Comedy III* transformative test.¹⁴² The defendant argued that it satisfied the *Comedy III* test because it made various expressive contributions in creating the video game, but the court disagreed with that interpretation of the transformative test.¹⁴³ Notwithstanding the defendant's expressive contributions to the game as a whole, the court found that the defendant had not altered or transformed *No Doubt's image*, and thus the video game simply depicted the band "doing what they do" (performing rock music):

In [the video game] *Band Hero* . . . 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 videogame that contains many other creative elements, does not transform the avatars into anything other

138. *Id.* at 807–09 (citations omitted) (footnotes omitted).

139. *Id.* at 811.

140. 122 Cal. Rptr. 3d 397, 400–01, 409 (Cal. Ct. App. 2011).

141. *Id.* at 400, 402. No Doubt had agreed that their likenesses could be used in the game, but complained that Activision went beyond the parties' agreement and used their likenesses in ways they did not and would never consent to. *Id.*

142. *Id.* at 406.

143. *Id.* at 410.

than exact depictions of No Doubt's members doing exactly what they do as celebrities.¹⁴⁴

Comedy III and *No Doubt* therefore hold that where the use of an individual's persona in a work merely depicts the individual "as she is," the defendant has not undertaken any expressive transformation of the persona and is merely exploiting the individual's recognizable likeness, i.e., the marketability and commercial value derives from the fame of the depicted celebrity.¹⁴⁵

144. *Id.* at 410–11; *accord* *Keller v. Elec. Arts, Inc.*, 94 U.S.P.Q.2d (BNA) 1130, 113 (N.D. Cal. 2010) (“[Defendant’s] depiction of Plaintiff in ‘NCAA Football’ is not sufficiently transformative to bar his California right of publicity claims as a matter of law. In the game, the quarterback for Arizona State University shares many of Plaintiff’s characteristics. For example, the virtual player wears the same jersey number, is the same height and weight and hails from the same state. EA’s depiction of Plaintiff is far from the transmogrification [in prior cases]. EA does not depict Plaintiff in a different form; he is represented as he what he was: the starting quarterback for Arizona State University. Further . . . the game’s setting is identical to where the public found Plaintiff during his collegiate career: on the football field.”) (footnote omitted). In *Hart v. Elec. Arts, Inc.*, the New Jersey District Court applied the transformative test to another EA video game but reached a different result. 808 F. Supp. 2d 757, 787 (D.N.J. 2011). The court found a “transformation” despite the fact that the plaintiff’s likeness was presented unaltered and in his professional/celebrity setting (the football field). *Id.* at 783. In arriving at this conclusion, the court focused on the defendant’s contributions to the video game as a whole, including the fact that users can alter the plaintiff’s image using “add-ons” designed by the defendant. *Id.* at 785. While the court acknowledged that “[i]t Seem[ed] ludicrous to question whether video game consumers enjoy and, as a result, purchase more EA-produced video games as a result of the heightened realism associated with actual players,” it nonetheless concluded that the use was transformative and entitled to First Amendment protection. *Id.* at 783, 787. The problem with this analysis is that it seems to reach for some kind of “copyright gestalt,” allowing the copyrightable elements of the game to color its ultimate characterization of the defendant’s use of the plaintiff’s image. However, the issue is not whether the game contains creative contributions. Nor is the issue whether the defendant provides users with the tools such that they might transform the plaintiff’s image (whose image the court concedes is one of the reasons that users purchase the game in the first place). Rather, the issue is whether the defendant transformed the plaintiff’s image in developing and marketing the game—which as the court expressly notes—the defendant did not do. *Id.* at 783. Therefore, under the *Hart* analysis, a celebrity-image coloring book would pass the transformative test, provided it included ancillary aesthetics and was sold complete with crayons.

145. *See No Doubt*, 122 Cal. Rptr. 3d at 410–11, 415; *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001); *see also Keller*, 94 U.S.P.Q.2d (BNA) at 1135 (holding that the court’s “focus must be on the depiction of Plaintiff in [the video game,] not the game’s other elements.”).

Activision's use of life-like depictions of No Doubt performing songs is motivated by the commercial interest in using the band's fame to market *Band Hero*, because it encourages the band's sizeable fan base to purchase the game so as to perform as, or alongside, the members of No Doubt. Thus, insofar as the depiction of No Doubt is concerned, the graphics and other background content of the game are secondary, and the expressive elements of the game remain "manifestly subordinated to the overall goal of creating a conventional portrait of [No Doubt] so as to commercially exploit [its] fame."¹⁴⁶

Such were also the circumstances *Brown*: the plaintiff was simply depicted "doing what he does"¹⁴⁷ in order to generate consumer interest in the video game. As the Supreme Court noted in *Zacchini*, however, "[n]o social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay."¹⁴⁸

146. *No Doubt*, 122 CAL. RPT.R. 3d at 411 (quoting *Comedy III*, 21 P.3d at 810); see also *Comedy III*, 21 P.3d at 807 ("It is admittedly not a simple matter to develop a test that will unerringly distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity. . . . What the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity's fame through the merchandising of the 'name, voice, signature, photograph, or likeness' of the celebrity."); Heimes, *supra* note 77, at 158 ("An individual's interests in identity protection should not be lesser than—or greater than—First Amendment interests or other social and cultural norms law seeks to foster and protect. They are central to the individual's rights to self-determination and freedom. Indeed, although courts are not as likely to recognize for non-celebrities the powerful publicity rights granted to [prominent individuals and celebrities], there is no justification under social justice theories to deprive other individuals of the right to prevent misappropriation of their identities or commercial exploitation by others. If we are to allow commodification of identity we should give universal access to such rights.").

147. See *Brown v. Elec. Arts, Inc.*, Case No. 2:09-cv-01598-FMC-RZx, 2009 U.S. Dist. LEXIS 131387, *3 (C.D. Cal. 2010).

148. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (citing Harry Kalven, Jr., *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966), available at <http://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=3112&context=lcp>); See also McCarthy, *The Spring 1995 Horace S. Manges Lecture – The Human Person as Commercial Property: The Right of Publicity*, *supra* note 67, at 131 ("While some criticize the right of publicity as posing the danger of invading our free speech rights, in fact, for all practical purposes, the only kind of speech impacted by the right of publicity is commercial speech—advertising. Not news, not stories, not entertainment and not entertainment satire and parody—only advertising and similar commercial uses.").

Finally, the *Brown* decision also demonstrates how a “knee-jerk” First Amendment categorization of a mixed promotional/expressive use of a persona in an unauthorized work can inadequately address the societal and constituent interests implicated in such a use.¹⁴⁹ Moreover, the failure to employ a more socially nuanced approach tends to promote IP imperialist overreaching. Whereas the NFL and its licensees aggressively protect their copyright and trademark interests, but it seems publicity rights of others are fair game—or, at least, subject to narrow interpretation and application.¹⁵⁰ Aiding and abetting such IP Imperialist stratagems may serve IP conglomerate interests, but contravenes right-of-publicity social utility and undermines pervasive respect for the IP regime.¹⁵¹

C. Reconciling Competing Intellectual Property Social Utilities: *Laws v. Sony Music Entertainment, Inc.*¹⁵²

Courts are increasingly confronted with another difficult social-utility balancing problem in resolving right-of-publicity disputes: preserving any authorized copyright interests that favor allowing the unauthorized use of publicity rights subsumed within the copyrighted work. A wholly unauthorized expressive work may require the invocation of the First Amendment to insulate the unauthorized publicity use. However, an authorized expressive

149. See *Keller*, 94 U.S.P.Q.2d (BNA) at 1136 (holding that even where First Amendment protections are relevant to an unauthorized use, “it does not follow that these protections are absolute and always trump the right of publicity.”). *But cf. Hart*, 808 F. Supp. 2d at 769–71 (wherein the court appears to offer a Hobson’s choice of “either commercial speech or expressive use,” overlooking the possibility a hybrid commercial motivation and result).

150. Kaburakis, *supra* note 12; Thomas, *supra* note 12 (describing suit against the N.C.A.A. and its affiliates for allegedly “usurping the rights of former players to earn royalties when their likenesses and images are licensed by the N.C.A.A. for use in television advertisements, video games, apparel and other products”); see also *Keller*, 94 U.S.P.Q.2d (BNA) at 1132–33 (in which plaintiff alleges that the NCAA prohibits student athletes from commercially exploiting their personas, and, in turn, takes advantage of that prohibition to exploit their personas for its own pecuniary benefit).

151. See, e.g., *Comedy III*, 21 P.3d at 811 (disallowing unauthorized use where “the marketability and economic value of [the resulting] work derives primarily from the fame of the celebrities depicted.”); see also *Spare the Mod: In Support of Total-Conversion Modified Video Games*, *supra* note 49, at 800 (“A more fruitful approach within [the labor theory of intellectual property protections] may be to move away from traditional Lockean labor theory and toward an analysis based on equity theory. This approach focuses on distributive justice based on individual contributions to a joint venture. Equity theory essentially says that what is fair is what is proportional. When determining how to divide surpluses, individuals rely on a complex social index comprising empathetic preferences and a natural sense of fair play.”) (footnotes omitted).

152. 448 F.3d 1134 (9th Cir. 2006).

work will implicate traditional copyright interests, such as the right to reproduce or distribute the work, which may conflict with any legitimate publicity rights also present in the work. Similar to the First-Amendment-versus-right-of-publicity cases, courts seem to have difficulty placing publicity interests on par with copyright interests, often displaying a “knee-jerk” deference to copyright claims.

Laws v. Sony Music Entertainment, Inc., provides a particularly interesting example of the problem. The publicity interests involved in the case, although subtle, are extremely significant from an IP social justice perspective. The plaintiff, Debra Laws, was an Elektra recording artist and Elektra held the copyrights in Laws’ sound recordings.¹⁵³ When Laws initially signed with Elektra, however, the company expressly agreed that “‘we or our licensees shall not, without your prior written consent, sell records embodying the Masters hereunder for use as premiums or in connection with the sale, advertising or promotion of any other product or service.’”¹⁵⁴

Elektra subsequently granted Sony a license to sample a segment from one of Laws’ recordings into a song by singer artist Jennifer Lopez, whereupon Laws brought suit against Sony for misappropriation of her name and voice.¹⁵⁵ Sony ultimately moved for summary judgment on the grounds that Laws’ suit was essentially one for unauthorized reproduction of her copyrighted sound performance, which Sony argued was preempted by copyright law.¹⁵⁶ Laws argued, however, that her misappropriation claims were substantively different from claims for copyright infringement:

Laws . . . contends that the subject matter of a copyright claim and a right of publicity claim are substantively different. She argues that a copyright claim protects ownership rights to a work of art, while a right of publicity claim concerns the right to protect one’s persona and likeness. Sony, by contrast, contends that the subject matter of a right of publicity in one’s voice is not different from a copyright claim when the voice is embodied within a copyrighted sound recording. Sony argues that once a voice becomes part of a sound recording in a fixed tangible medium it comes within the subject matter of copyright law.¹⁵⁷

153. *Id.* at 1136.

154. *Id.* (emphasis added).

155. *Id.* at 1137. Laws also commenced a breach of contract action against Elektra. *Id.* at 1143 n.5.

156. *Id.* at 1136. Having assigned her copyrights to Elektra, Laws lacked standing to assert a copyright infringement claim against Sony. *Id.* at 1147.

157. *Id.* at 1139.

Sony reasoned that, because it had used a copyrighted recording of Laws' voice, her state misappropriation rights were subsumed within the copyrights attendant to that recording.¹⁵⁸ The court agreed:

[W]e think it is clear that federal copyright law preempts a claim alleging misappropriation of one's voice when the entirety of the allegedly misappropriated vocal performance is contained within a copyrighted medium. . . .

. . . .
. . . [Moreover] Sony did not use Laws's image, name, or the voice recording in any promotional materials. Her state tort action challenges control of the artistic work itself and could hardly be more closely related to the subject matter of the Copyright Act.¹⁵⁹

The court further held that, to the extent that Laws' state law claims required an "extra element" beyond those that constitute a claim for copyright infringement, these elements were insufficiently distinctive to avoid copyright preemption:

Laws contends that her right of publicity claim under California Civil Code § 3344 requires proof of a use for a "commercial purpose," which is not an element of a copyright infringement claim. She concedes that a right which is the "equivalent to copyright" is one that is infringed by the mere act of reproduction; however, she argues that her claim is not based on Sony's mere act of reproduction, but "is for the use of . . . Laws'[s] voice, the combination of her voice with another artist, and the commercial exploitation of her voice and name in a different product without her consent."

. . . .
[However,] the mere presence of an additional element ([in this case] "commercial use") . . . is not enough to qualitatively distinguish Laws's right of publicity claim from a claim in copyright. The extra element must transform the nature of the action. Although the elements of Laws's state law claims may not be identical to the elements in a copyright action, the underlying nature of Laws's state law claims is part and parcel of a copyright claim.¹⁶⁰

158. *Id.*

159. *Laws*, 448 F.3d at 1141–42.

160. *Id.* at 1144 (citations omitted). For a similar copyright preemption analysis, see *Toney v. L'Oreal U.S.A., Inc.*, 384 F.3d 486, 491–92 (7th Cir. 2004) (holding that "because the exercise of the [defendant copyright holder's] rights to reproduce, adapt, publish, or display the photos would also infringe upon [the plaintiff's] right to publicity in her likeness in photographic form, her publicity right is equivalent to the rights encompassed by copyright listed in § 106.>").

While *Laws* is in some ways a close analytical case, the *Laws* court, much like the *Brown* court, seems unduly deferential to the copyright interests implicated in the case—almost to the point of ignoring settled federal intellectual property law preemption precedent.¹⁶¹ Once again a court has failed to give proper weight to the full range of social utilities that support the plaintiff's right of publicity interests.

With respect to the defendant's copyright claims, the court's preemption analysis certainly leaves something to be desired. The court's reading of the additional-element test is unduly constrained. Moreover, the court seems to presume that the presence of a copyright in the original sound recording used by Sony completely negates the possibility of additional, alternative intellectual property rights and interests in, as well as non-copyright uses for, the work. Courts and commentators have long recognized the possibilities for co-existing intellectual property rights in a single work, and have afforded due consideration to each such interest.¹⁶² In a reactionary effort to protect the sanctity of copyright, the court overlooks the fact that a copyrighted work can be used for a primarily promotional purpose unrelated to the work itself or its expressive message.¹⁶³

While Sony's sampling use of *Laws*' recording certainly involved some expressive intentions and effects, it was also arguably a use undertaken to provide "street cred" to the Jennifer Lopez recording and thereby to promote it (and Lopez) to the "urban" and R&B commercial markets. As in *No Doubt* and *Brown*, the plaintiff's persona is incorporated in to the work depicting plaintiff "doing what she does" in order to enhance consumer interest in the work. From this perspective, the right of publicity social utilities seem at least as important as the copyright-expressive social utilities at issue. Moreover, when considering the issue of intellectual property social justice, the

161. See, e.g., *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 491 (1974) (holding that state trade secret law is not preempted by federal patent law); Leonard A. Wohl, Note, *Federal Preemption of the Right of Publicity in Sing-Alike Cases*, 1 FORDHAM INTELL. PROP. MEDIA & ENT. L.J., 47, 50 (1990), available at <http://ir.lawnet.fordham.edu/cgi/viewcontent.cgi?article=1003&context=IPIj> (concluding that "federal copyright law does not preempt state law rights of publicity when such rights are infringed by imitation of a performer's voice within the context of a copyrighted musical work").

162. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (suggesting that plaintiff's film footage could have been protected both by copyright and by trademark law); *Kewanee Oil*, 416 U.S. at 470; *Mazer v. Stein*, 347 U.S. 201, 217 (1954) (holding that patentability of statuettes for use as bases for table lamps did not bar simultaneous copyright of the statuettes as works of art).

163. One common example is the use of vintage, classic, or "art house" cinema posters to promote a specific movie theater. The theater may have no plans to actually show the subject films, but rather is attempting to promote itself as a venerable purveyor of important, high-quality cinematic entertainment.

Lopez promotional impact becomes a critical factor in balancing the interests at stake in the dispute. Consistent with the tradition of American IP Imperialism, the recording industry has a long history of using the creative talents, innovations, and stylizations of African-American artists to promote the records and careers of white artists.¹⁶⁴ This may well have been the reason

164. See, e.g., JOHN COLLIS, *THE STORY OF CHESS RECORDS* 117 (1998); NELSON GEORGE, *THE DEATH OF RHYTHM AND BLUES* 108 (1988) (“Blacks create and then move on. Whites document and then recycle. In the history of popular music, these truths are self-evident.”); JAMES LINCOLN COLLIER, *THE MAKING OF JAZZ: A COMPREHENSIVE HISTORY* 106 (1978); see also Olufunmilayo B. Arewa, *Copyright on Catfish Row: Musical Borrowing, Porgy and Bess, and Unfair Use*, 37 RUTGERS L.J. 277, 350–51 (2006); Leslie Espinoza & Angela P. Harris, Symposium, *Afterword: Embracing the Tar-Baby—LatCrit Theory and the Sticky Mess of Race*, 10 LA RAZA L.J. 499, 512–13 (1998); Greene, “Copynorms,” *Black Cultural Production, and the Debate over African-American Reparations*, *supra* note 45, at 1184–85, 1188–89 (“In the context of cultural production, Ellisonian invisibility is concrete in all its bitter irony. In the face of prolific and innovative Black musical creativity, ‘[W]hites [in the 1920s] often vehemently denied that AfricanAmericans [sic] had made any contribution to the creation of jazz. New Orleans “Dixieland” musicians . . . made it a point of honor never to mix with Black musicians or acknowledge their talents.’ In later years, it was widely conceded that ‘though African-Americans had certainly invented ragtime and jazz, these musical styles were being brought to their highest levels by [White] outsiders.’”) (quoting BURTON W. PERETTI, *JAZZ IN AMERICAN CULTURE* 42–43 (1993)); Evans C. Anyanwu, Note & Comment, *Let’s Keep it on the Download: Why the Educational Use Factor of the Fair Use Exception Should Shield Rap Music from Infringement Claims*, 30 RUTGERS COMPUTER & TECH. L.J. 179, 181–82 (2004); Neela Kartha, Comment, *Digital Sampling and Copyright Law in the Social Context: No More Colorblindness!!*, 14 U. MIAMI ENT. & SPORTS L. REV. 218, 219–23, 232–34 (1997) (“The compulsory license made it possible for white artists to shanghai the African-American songbook. Pat Boone was notorious for covering Little Richard’s music, and eventually, songs ‘by niggers’ realized a catalog value as great as those of Tin Pan Alley tunesmiths. Another unfortunate reality was that the Black songwriters and performers did not always understand the value of publishing rights which ended up being owned by white record companies. A great deal of revenue was generated by white groups covering Black hits. . . . Eric Clapton is an excellent example of an artist who reached long term fame using a lot of unoriginal music and styles taken from Black artists. . . . When he was with John Mayall’s Bluesbreakers he recorded (blues artist) Freddie King’s ‘Hideaway,’ Otis Rush and Willie Dixon’s ‘All Your Love,’ Robert Johnson’s ‘Ramblin’ On My Mind,’ and later, with the rock group Cream, he recorded ‘Crossroads,’ another Robert Johnson song. When he was with Derek and the Dominos he recorded Willie Dixon’s ‘Evil,’ Elmore James’s ‘The Sky Is Crying,’ and later in his solo career he imitated reggae music. He recorded some music in Jamaica (not including ‘I Shot the Sheriff’) where he recorded Peter Tosh’s ‘Whatcha Gonna Do.’ How would Eric Clapton’s career fare a ‘total concept and feel’ analysis like that set

Laws negotiated the “no promotional use in connection with other artists” clause of her contract.¹⁶⁵ As a “cross-over” recording artist, Jennifer Lopez has been marketed to majority audiences and has enjoyed a multifaceted entertainment career in the recording, television, movie, and now fragrance industries.¹⁶⁶ To the extent that Lopez’s mega-celebrity is fueled by the vocal stylings of a lesser-known African-American R&B recording artist, the right of publicity social justice implications warrant serious consideration—certainly more consideration than that given by the *Laws* court.

While the problem of mixed “expressive/promotional” use of publicity rights is as challenging here as in the First Amendment context, once again it is not intractable. In the next case, the Third Circuit Court of Appeals also confronts the problem and demonstrates a right-of-publicity social utility/social justice sensitivity more highly attuned than that demonstrated in the cases discussed thus far.

D. Assessing the “Social Utility Authenticity” of Publicity Defenses: *Facenda v. N.F.L. Films, Inc.*¹⁶⁷

In *Facenda v. N.F.L. Films, Inc.*, the court confronted the same intersection of copyright and right of publicity problem that was at issue in *Laws*.¹⁶⁸ However, this court employed a more nuanced analysis and reached a very different outcome.¹⁶⁹ In this case, the estate of well-known football commentator John Facenda brought suit when the NFL used portions of Facenda’s voice-over work from previously authorized copyrighted programs in a new, unauthorized program concerning the football video game *Madden NFL 06*.¹⁷⁰ In essence, the NFL “sampled” portions of Facenda’s voice-over recordings from one program into another. Facenda’s Estate claimed that the “use of Facenda’s voice falsely suggested that Facenda endorsed the video game” and also violated Facenda’s right of publicity under Pennsylvania law.¹⁷¹ Just as Sony argued in *Laws*, the NFL argued that the copyrights it

forth in *Roth Greeting Cards v. United Card Co.*” (citing 429 F.2d 1106, 1110 (9th Cir. 1970)); Henry Self, Comment, *Digital Sampling: A Cultural Perspective*, 9 UCLA ENT. L. REV. 347, 352–53 (2002).

165. *Laws*, 448 F.3d at 1136.

166. Nicole La Porte, *J. Lo, The Sequel*, N.Y. TIMES, May 15, 2011, at ST1, available at <http://www.nytimes.com/2011/05/15/fashion/jennifer-lopez-the-peoples-pop-star.html?pagewanted=all>.

167. 542 F.3d 1007 (3d Cir. 2008).

168. *Id.*

169. *Id.* at 1032.

170. *Id.* at 1012–13.

171. *Id.* at 1011–13.

held in the original NFL programs that Facenda narrated gave it the right to reuse portions of those works in subsequent expressive works.¹⁷²

As did the court in *Brown*, the *Facenda* court began its false endorsement analysis by invoking the *Rogers* test.¹⁷³ It first considered the threshold question as to whether the unauthorized use was in fact expressive, as opposed to merely promotional:

Before considering whether either prong of the *Rogers* test applies, however, we must decide whether the television production is a “work[] of artistic expression,” as understood in the context of construing the [plaintiff’s persona rights] narrowly to avoid a conflict with the First Amendment

. . . .
The Estate contends that the [new] program is commercial speech, and we agree. Our Court has “three factors to consider in deciding whether speech is commercial: (1) is the speech an advertisement; (2) does the speech refer to a specific product or service; and (3) does the speaker have an economic motivation for the speech.”¹⁷⁴

In short, the court did not presume that, because Facenda’s voice was reproduced in an expressive work, the defendant’s use of Facenda’s voice was expressive. Instead, upon finding the NFL’s subsequent use to be more promotional than expressive in nature, the court distinguished the facts from those in *Rogers* (which involved a parody-like use of the plaintiff’s persona), and instead applied the traditional, trademark likelihood-of-confusion analysis (as tailored to false-endorsement claims).¹⁷⁵ Finding it likely that con-

172. *Id.* at 1011. Just as Laws had, Facenda had expressly preserved his publicity rights, notwithstanding his assignment of any copyrights in the original programs:

Facenda signed a “standard release” contract stating that NFL Films enjoys “the unequivocal rights to use the audio and visual film sequences recorded of me, or any part of them . . . in perpetuity and by whatever media or manner NFL Films . . . Sees fit, provided, however, such use does not constitute an endorsement of any product or service.”

Id. at 1012.

173. *Facenda*, 542 F.3d at 1016.

174. *Id.* at 1016–17 (citation omitted). Thus, although the work at issue was a narrative video program, unlike the court in *Brown*, the court here acknowledged that an expressive work can have a promotional purpose. Not only did this permit the court to distinguish between promotional and expressive relevance in a manner consistent with *Rogers*, the *Facenda* approach further allows for the recognition of mixed promotional/expressive uses of publicity personas.

175. *Id.* at 1018 (citing 15 U.S.C. § 1125(a)(1)(A)). The court weighed the following factors: the level of recognition that the plaintiff has among the segment of

sumers would believe that Facenda had endorsed *Madden NFL 06*, the court held in favor of Facenda's estate.¹⁷⁶

With regard to plaintiff's right of publicity claim, the court acknowledged that:

By using the sound clips of Facenda's voice . . . the NFL was exercising its exclusive right to make derivative works of those sound clips under § 106(2). In effect, it was "sampling" itself, making a collage, taking a small piece of an old work and using it in a new work—as when a hip-hop group samples the drum part from James Brown's "Funky Drummer."¹⁷⁷

Nonetheless, if the right of publicity is qualitatively different from the derivative work right, it is not preempted. "In other words, for a state-law claim to be preempted by copyright law, it must protect (1) an exclusive right in (2) a work within copyright's subject matter."¹⁷⁸

In direct contrast to the findings in *Laws*, the *Facenda* court concluded that Facenda's publicity rights were distinct from copyright because:

The requirement under the [state] statute that Facenda's voice have "commercial value," provides an additional element beyond what a copyright-infringement claim requires. . . .

. . . [In addition,] does Facenda's voice fall under the subject matter of copyright? The Court of Appeals for the Ninth Circuit has stated, in the context of vocal imitations, that "[a] voice is not copyrightable. . . ." We hold that Facenda's voice is outside the subject matter of copyright.¹⁷⁹

the society for whom the defendant's product is intended; the relatedness of the plaintiff's fame or success to the defendant's product; the similarity of the likeness used by the defendant to the actual plaintiff; evidence of actual confusion; marketing channels used; likely degree of purchaser care; defendant's intent in selecting the plaintiff; and likelihood of expansion of the product lines. *Id.* at 1019.

176. *Id.* at 1024-25. While the fact that the plaintiff's persona was used in the work itself and not in its title suggests that the *Comedy III* test would be applied, here the court found that the work was an infomercial and thus as a primarily promotional work, the *Rogers* test seemed the most appropriate. To the extent that the sampling in *Laws* was undertaken for promotional (urban marketing) and not artistic purposes, the use is promotional as well as expressive. While not an easy hair to split in a music sampling case, the *Facenda* court, unlike the *Laws* court, at least considered this a possibility. *Id.* at 1030.

177. *Id.* at 1026.

178. *Id.*

179. *Facenda*, 542 F.3d at 1027-28 (citations omitted).

Finally, having distinguished Facenda's publicity rights from the NFL's copyright claims, the court directly addressed the apparent conflict between the competing rights:

[I]n some situations . . . the right of publicity clashes with the exploitation of a defendant's copyright. Unlike the plaintiffs in cases involving vocal imitations, Facenda collaborated with the NFL to create the copyrighted sound recordings at issue. . . . this gives the NFL a stronger preemption defense than the vocal-imitation defendants. . . . Where a defendant in a right-of-publicity claim obtained a copyright in a work featuring the plaintiff, courts must separate legitimate exploitations of what Congress intended to be a copyright holder's exclusive rights from particular uses that infringe the right of publicity.¹⁸⁰

Thus, even where the right of publicity is qualitatively different from a copyright exclusive right (and therefore not automatically preempted), enforcement of the publicity right may interfere with the copyright holder's exploitation and use of one or more of her exclusive rights. In such a case, the right of publicity *might* be preempted on that basis. To determine whether Facenda's publicity rights conflicted with the NFL's exclusive copyrights in the original program, the court set forth an analytical road map:

First, we look to how the copyrighted work featuring the plaintiff's identity is used. Surveying the case law, [David] Nimmer finds that when defendants use the work "for the purposes of trade," such as in an advertisement, plaintiffs' right-of-publicity claims have not been held to be preempted.

. . . .

The second part of Nimmer's framework addresses the way that contracts affect the preemption analysis. Nimmer proposes that courts should examine the purpose of the use to which the plaintiff initially consented when signing over the copyright in a contract. He argues that the proper question in cases involving advertising and a contract between the plaintiff and the defendant—such as our case—is whether the plaintiff "collaborated in the creation of a copyrighted advertising product." If the plaintiff did collaborate in that fashion, then the party holding the copyright is in a very strong position to contend that allowing the plaintiff to assert a right of publicity against use of its likeness in advertising would interfere with the rights it acquired. If, on the other hand, the plaintiff did not collaborate specifically in the creation of advertising content, then the plaintiff is in a strong position to assert continuing control over the use of his image.¹⁸¹

180. *Id.* at 1028 (citations omitted).

181. *Id.* at 1028–30 (citations omitted).

Just as was the case in *Laws*, (i) Facenda had not collaborated in the creation of the subsequent program, and (ii) he expressly reserved his publicity rights when he agreed to narrate the original NFL programs.¹⁸² Moreover, the court had already determined, in connection with the disposition of Facenda's false endorsement claim, that the NFL's later use was more promotional than expressive in nature.¹⁸³ Accordingly, the court concluded that the NFL did not have a legitimate copyright expectation that it would be able to use Facenda's voice work in the original program for subsequent promotional purposes unrelated to the original program.¹⁸⁴ Consequently, the court held that Facenda's right of publicity was not preempted by the NFL's copy-rights in the original programs.¹⁸⁵

182. *Id.* at 1031.

183. *Id.* at 1030.

184. *Id.* at 1031–32. Under David Nimmer's analysis, the NFL would probably be able to use Facenda's voice work to promote the *original program itself*, as an anticipated use of the NFL's exclusive rights to reproduce, distribute, and display the program.

185. *Facenda*, 542 F.3d 1032; *accord*, *Alberghetti v. Corbis Corp.*, 713 F. Supp. 2d 971 (C.D. Cal. 2010), *aff'd in part, rev'd in part*, Nos. 10-56311, 10-56400, 2012 WL 3646341 (9th Cir. Aug. 27, 2012). Interestingly, the *Facenda* court nonetheless expressed agreement with the ultimate decision in *Laws*, despite the fact that it differed in its disposition of virtually every substantive issue. *Compare Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1143 (9th Cir. 2006) (dismissing the plaintiff's intellectual property claims and holding that “[t]o the extent that *Laws* has enforceable, contractual rights regarding the use of Elektra's copyright, her remedy may lie in a breach of contract claim against Elektra for licensing ‘Very Special’ without her authorization.”), *with Facenda*, 542 F.3d at 1031–32 (“The NFL argues that Facenda's only remedy should lie in contract. While we agree that Facenda could state a claim for breach of contract, we believe that he also retained his tort-derived remedy for violation of Pennsylvania's right-of-publicity statute. Parties may waive tort remedies via contract. It follows that they may also preserve them.”). Indeed, the proffered basis for the court's approval of *Laws* presents a factual mismatch.

[W]e believe that *Laws* was rightly decided—Debra Laws sought to enforce a right that she had contracted away. We do not intend to express any disagreement with the Ninth Circuit Court of Appeals by distinguishing the facts of our case from those of *Laws*. Our case simply presents a different scenario than *Laws*. Just as Facenda did not, in the standard release contract, waive the right to bring a false-endorsement claim . . . he did not grant the NFL the right to use his voice in a promotional television program. This contrasts with the situation in *Laws*. Debra Laws' voice was not used in an endorsement, but in a work of artistic expression.

. . . .
[Moreover,] [h]aving one's voice used as a sample in someone else's song may implicate a musician's identity. But listeners are probably less likely to assume that the sampled musician vouches for or approves of a new

**PART V: PROMOTING SOCIAL JUSTICE THROUGH THE
RIGHT OF PUBLICITY: A FRAMEWORK FOR ENFORCING THE
RIGHT AND BALANCING COUNTERVAILING
SOCIAL UTILITIES**

Although the court in *Facenda* does not expressly rest its decision on a social justice interpretation and application of right-of-publicity law, its reasoning is consistent with intellectual property social justice mandates and illustrates the benefits of a socially balanced approach to right-of-publicity disputes. Unlike the courts in *Brown* and *Laws*, the *Facenda* court did not presume that the social utility interests that appeared to conflict with the plaintiff's publicity rights were superior to the social utility objectives which underlie the right of publicity, or, for that matter, that these competing interests were even socially significant. Instead the court endeavored to assess the social utility authenticity of the asserted copyright claims and then weighed it against the plaintiff's publicity interests. This careful approach restores the right of publicity to its proper place in the intellectual property pantheon:

[A] defendant's ownership of copyright or a license of copyright in a particular photograph, motion picture or phonorecord of plaintiff should not be a defense to assertion of infringement of plaintiff's right of publicity. A copyright, no more than any other property right, cannot be a license to trample on other people's rights. A copyrighted book or motion picture is certainly capable of defaming people, yet no one seriously argues that because the book or film is copyrighted, its contents are free from claims of libel under state law. . . .

All of these sorts of liability for violation of state law in one way or another "interfere" with the federal "rights" of a copyright owner. That an owner of property is not completely free to do as he or she wishes with the property should be no news to the owner of any property right.¹⁸⁶

By pausing to determine the nature and extent of the copyright legal and social interests at issue and then carefully considering whether they are, in fact, directly in conflict with the plaintiff's publicity interests, the *Facenda*

creative work that samples her work than consumers are likely to assume that an individual's presence in an advertisement reflects an active choice to endorse a product.

Facenda, 542 F.3d at 1032 & n.16. While the court initially appears to compare the respective contracts in the different cases, it ultimately distinguishes *Laws* on an entirely different basis.

186. McCarthy, *The Spring 1995 Horace S. Manges Lecture—The Human Persona as Commercial Property: The Right of Publicity*, *supra* note 67, at 143–44 (footnote omitted).

court uncovered the true tension between the parties' respective intellectual property rights. The defendant's desire to use its copyright to commercially exploit aspects of Facenda's persona was at direct odds with the plaintiff's desire to obtain compensation for the promotional (non-copyright) use of that persona. Once the presumption of "copyright social superiority" was removed from the equation, a more accurate and equitable balancing of the parties' interests could be achieved—and the right of publicity's social justice objectives more properly served. Equity favors that plaintiffs benefit from the commercial exploitation of their personas:

[T]he right of publicity is not restricted to superstar, nationally known athletes and entertainers. It applies to everyone. For example, it applies to the long distance runner who won an Olympic medal twenty years ago, is now selling insurance in Iowa and whose name and accomplishments are printed today on a box of breakfast cereal to help sell the cereal. Who is more entitled to that commercial value? The former Olympian or the breakfast cereal conglomerate? . . .

Look at the recent cases involving well-known celebrities. How would you decide which party is most deserving and whether the award of damages distributed wealth "upwards"? Would you pick Samsung Electronics, a Korean electronics firm with \$10 billion in annual sales as more deserving than letter turner Vanna White? Would you pick Frito-Lay, with \$4.4 billion a year in sales and which is owned by Pepsi Cola, with \$25 billion of sales a year, as more deserving of the marketing value of Tom Waits' voice than Tom Waits himself? I would not.¹⁸⁷

187. *Id.* at 141 (footnote omitted). The choice is especially poignant where members of marginalized groups have developed highly valuable publicity personas. *See, e.g.,* Jacoby, *supra* note 85, at 1330–31 ("Tiger Woods is primarily a professional golfer and clearly is well-compensated for his performance on the golf course. But he reportedly earned an additional fifty to sixty million dollars in 2000 alone by licensing out the use of his face and his name to companies that want to use them to promote products. He has a contract with Nike, for example, to license sports gear and merchandise, like posters of Woods, to his fans and admirers. Woods, in fact, has set up a corporation, ETW, for the sole purpose of managing his publicity rights. Michael Jordan, before his last 'retirement' from professional basketball, was reported to have earned forty million dollars in a single year by allowing his name to be used in connection with sneakers, underwear, and telephone service.") (footnote omitted). The corporations that utilize the personas of these athletes earn billions through these marketing mechanisms, and it is difficult to see why the athletes themselves should not share in this wealth.

A. A Right of Publicity Social Justice Framework

A social-justice sensitive-interpretation of the right of publicity not only promotes the IP social objectives of inclusion and empowerment, it also invigorates the doctrinal foundations of the right such that it stands on par with the other rights that comprise the American IP regime. As illustrated by *Facenda*, appreciation for publicity right social utility/social justice interdependence removes the stigma of “IP Illegitimacy” and grants publicity rights a status equal to that enjoyed by its IP forbears. Many right-of-publicity adjudications, however, often indicate a lack of effective social justice divination tools essential to achieving such results.

Right-of-publicity jurisprudence could benefit from the development of an analytical framework through which the social utilities that undergird publicity rights might be more concretely identified and assessed, particularly where competing social objectives are involved. Based upon the analyses of the litigation disputes discussed herein, as well as other publicity cases, courts should consider following four evaluative steps:

Identify and evaluate the specific publicity social utilities and social justice interests at issue;

Identify and evaluate any competing social utility/social justice interests;

Select and properly apply an appropriate social balancing test; and

Consider the equities and the rule of *eBay vs. Mercexchange, L.L.C.*¹⁸⁸ in balancing the respective rights and social interests.

B. Identifying the Pertinent Right of Publicity Social Utility and Social Justice Concerns

While the identification and evaluation of publicity right social utilities may seem an obvious initial step in adjudicating publicity disputes, many courts seem to overlook it, especially when the publicity defendant raises the First Amendment banner. Courts routinely review the legal elements of the right of publicity cause of action and typically end their analysis of the plaintiff’s interests there. Once potentially contrary social considerations are introduced, some courts seem to simply take for granted that any analogous publicity interests are comparatively inferior. This is one reason why the right of publicity fares so poorly when courts undertake to “balance” the competing social interests in these disputes. Given the at best perfunctory review of the publicity social function, especially as compared with the almost pious analysis generally afforded even nominal First Amendment arguments, it should come as no surprise that the publicity social interest weighs in as a bantam-class amateur facing off against a heavy-weight champion—the fight is over before the first bell rings.

Right-of-publicity advocates should assist courts in becoming more cognizant of any relevant publicity social utility and social justice interests that

188. 547 U.S. 388 (2006).

could affect publicity litigation outcomes. The court in *Parks* did not have to look far to find an important right of publicity social utility/social justice interest in the case before it: she was sitting in the plaintiff's chair.¹⁸⁹ However, not all right-of-publicity plaintiffs have the status of a Civil Rights icon, and there is a need for greater social insight, intuition, and common sense in the adjudication of these disputes.¹⁹⁰ Disregard for right of publicity social justice increases the likelihood of miscarriages of justice both as a matter of intellectual property rights enforcement and as a matter of general fairness, justice, and equality before the law. Proper appreciation for the social functions of publicity rights will better enable courts to avoid patently unjust outcomes such as that in *Brooks* and similar cases. Moreover, it will enhance judicial capability to fulfill the overarching policy objectives supporting the inclusion of publicity rights in the intellectual property positive law regime.¹⁹¹

C. Identifying and Evaluating Competing Social Utilities and Interests

Unlike right of publicity social utilities, courts almost always afford serious weight to the First Amendment and non-publicity IP social utilities which arise in publicity disputes. The problem is that great deference is

189. See 329 F.3d 437 (6th Cir. 2003).

190. See Danielle M. Conway, *Intellectual Property: Implicit Racial and Gender Bias in Right of Publicity Cases and Intellectual Property Law Generally*, in *IMPLICIT RACIAL BIAS ACROSS THE LAW* 179, 180 (Justin D. Levinson & Robert J. Smith eds., 2012) (arguing that, due to implicit racial biases, many courts devalue the right-of-publicity interests of minorities and women when compared with the interests of majority defendants who commercially exploited such interests without permission); Heimes, *supra* note 68, at 155 ("Some economically-based objections [to unauthorized use of publicity rights] can be remedied through monetary payment and perhaps injunctive relief. But morally based objections arise when the plaintiff's image or persona is used in a context or manner that conflicts with the plaintiff's own values and interests.") (footnote omitted).

191. Of course, consideration of social justice imperatives will sometimes militate in favor of sustaining an authorized use of publicity rights. See Heimes, *supra* note 77, at 162 ("By putting image and language control in the hands of celebrities, their estates or assignees . . . critics of expanded publicity rights worry that the rest of society will be deprived of 'our collective cultural heritage and the ability to reflect upon the historical significance of the celebrity aura.' The valid social justice concerns identified here relate to the ability of members of American society, at least, to exercise rights in speech and expression that are embedded in our rich culture and expressly protected in our Constitution. To allow individual private property interests in words, designs, and names—especially ones that have acquired universal recognition and thus have inherent expressive meaning—to chill creativity disserves social and cultural enhancement in the aggregate.") (footnote omitted).

sometimes afforded to such interests with little assessment as to the extent of their actual presence or vulnerability in a specific publicity conflict. All assertions of the First Amendment do not raise identical sets of policy questions and concerns. As demonstrated by the analyses undertaken in cases such as *Parks* and *Facenda*, it is important that courts resist the urge to react viscerally to invocations of free speech or “superior” intellectual property rights and policies, and instead strive to uncover the precise nature and extent of the non-publicity social utilities actually implicated by the specific facts and equities before them.

D. Applying an Appropriate Balancing Test

Even when a court has properly considered all of the pertinent social utilities and interests in a publicity dispute, it can still reach an erroneous decision if it fails to select and properly apply an appropriate balancing-of-the-interests test. As discussed in connection with the *Brown* case, the various judicial balancing tests are not interchangeable.¹⁹²

While many of the leading balancing tests were conceived with First Amendment concerns in mind, courts must be mindful that these tests are also intended to protect legitimate publicity interests.¹⁹³ The task is not limited to assessing the impact on free speech if the unauthorized use is precluded; it also entails assessing the impact on publicity rights if the unauthorized use is allowed.¹⁹⁴

The importance of this point becomes evident in considering judicial interpretations and applications of the leading publicity-balancing test, the *Comedy III* transformative test.¹⁹⁵ The purpose of the transformative test is just as its name implies: to assess the extent the plaintiff’s image or persona is transformed in the defendant’s work.¹⁹⁶ Accordingly, the court’s inquiry should focus on any expressive embellishments that the defendant has added to the plaintiff’s image or persona to determine whether the result is more the defendant’s expressive creation (permissible) than it is merely a depiction or replication of the plaintiff (impermissible). Some courts, however, employ the transformative test to evaluate and weigh the overall expressive quality of the defendant’s work, which misconstrues the purpose of the test. While an overall assessment of the defendant’s expressive contributions may be relevant to analyzing whether the work is copyrightable, it says little or nothing about the impact of those contributions on the plaintiff’s image and concomitant publicity interests. For example, today it is possible to insert the image

192. See *infra* Part IV.

193. See Gloria Franke, Notes, *The Right of Publicity v. the First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CAL. L. REV. 945, 946 (2006).

194. *Id.*

195. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 797 (Cal. 2001); Franke, *supra* note 193, at 963.

196. *Comedy III*, 21 P.3d at 808; Franke, *supra* note 193, at 970–71.

of Ginger Rogers and Fred Astaire dancing in to a variety of new settings and contexts, some of which may be highly creative. Unless these new settings transform Rogers and Astaire's individual images, however, it is their publicity interests that are being traded upon, notwithstanding the fact that defendant's work may be highly creative and artistic as a whole.¹⁹⁷ The issue is particularly troublesome when courts are called upon to apply existing tests to unauthorized publicity persona uses that are mixed promotional/expressive uses. *Facenda* meets this challenge by applying the *Rogers* tests to expressive works that are advertisements. Where the work is not an advertisement, however, it seems appropriate to apply the *Comedy III* test to assess whether the defendant has so transformed the plaintiff's persona such that the commercial value or appeal of the result is not derived from plaintiff's persona. In this regard, *Comedy III*, *No Doubt*, and *Keller*, properly focus on changes to the plaintiff's image, as opposed to defendant's creative contributions to the work as a whole.

Courts misapply right-of-publicity balancing tests when they use them only to evaluate the First Amendment or other expressive merits of a defendant's unauthorized work. Again, it is an undue emphasis on these countervailing social utilities that is the source of the confusion. Regardless of how highly expressive a work is, the court must still consider the other side of the balance—the impact of defendant's use on the plaintiff's publicity interests—even if only to affirm that these interests are ultimately outweighed by the competing social concerns.¹⁹⁸

197. Recently the New Jersey District Court made this error in *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757 (D.N.J. 2011). In deciding whether the purveyor of a football video game had misappropriated the persona of a former college player, the court applied the transformative test to the game as whole, despite its conclusion that the plaintiff's image therein was readily recognizable and presented in his usual setting "doing what he does": playing football. *Id.* at 783, 787. The court thus confused the issue. The point of the transformative test is not to determine whether the defendant has made expressive, copyrightable contributions *in general*, but rather, whether the defendant's expressive contributions have so transformed the plaintiff's image so as to preclude a viable publicity claim.

198. A notable weakness of the transformative test is that although it is derived from the copyright Fair Use test, which weighs four interdependent factors, the transformative test imports only one of its factors. Franke, *supra* note 193, at 968–69, 970. While the *Comedy III* court expressed skepticism towards reliance on the remaining three factors, they need not be imported verbatim. Borrowing further from the Fair Use test, those additional factors might be the nature of defendant's work (*i.e.*, is it expressive or promotional), the extent that the plaintiff's image is used (whether the plaintiff is recognizable), and the impact on the market for the plaintiff's own use of her image.

E. Balancing the Legal Rights and Social Equities

Finally, in balancing the competing interests, it is important that the relevant equities be included on the scales. Particularly where a weighing of the competing social utilities presents a close case, consideration of the relevant equities should tip the scales toward the side of social justice. Had the social equities been considered in *Brooks*, the plaintiff's undeniably unclean hands in its willful violation of Brooks' publicity rights, and subsequent acts to conceal its misconduct, would have supported a tolling of the limitations period to allow the plaintiff to proceed with an indisputably valid claim.¹⁹⁹

Courts must also become more vigilant toward disguised IP Imperialist maneuvers to annex individual publicity interests (as well as other intellectual property rights) into their IP empires. A thorough assessment of the social utility authenticity of a publicity defendant's claims is particularly critical when the defendant is a major purveyor of IP commodities and the plaintiff is a member of a marginalized group for whom right of publicity incentives and benefits can provide a vital avenue for economic empowerment and social advancement.²⁰⁰

199. *See Brooks v. Topps Co.*, 86 U.S.P.Q.2d (BNA) 1361 (S.D.N.Y. 2007). The question of equitable tolling of limitations periods presents a prime example of the need to view publicity disputes through a socially equitable lens. Where the publicity interests of non-celebrities or members of marginalized groups are at stake, acts of misappropriation can be difficult to uncover. While the wealthy and influential celebrity may be well poised to police the exploitation of her persona, the law should not be fashioned or interpreted with only these kinds of publicity plaintiffs in mind. Many celebrities from marginalized groups, persons of historical significance, and the heirs and descendants of same simply lack the resources to monitor the media and commercial market place to protect their publicity interests—assuming that they are even fully aware that such interests exist. With respect to right of publicity limitations periods, the failure to consider the relevant equities can prove tantamount to a de facto license to misappropriate—steal now and pay later, *but only if you get caught in time*. In deciding whether to toll a publicity limitations period, a court could consider the ability of the plaintiff to police her publicity rights and/or uncover the specific misappropriation at issue; the extent of the defendant's efforts to obtain authorization for the unauthorized use or the basis for her belief that authorization was unnecessary; how open and notorious the unauthorized use was; and the amount of time that has passed since the unauthorized use was undertaken. These considerations could be weighed against evidence that the use was calculated to be undiscovered or that defendant took affirmative steps to prevent plaintiff's discovery of the unauthorized use.

200. *See Heimes, supra* note 77, at 1 ("In 2010, Kevin Antoine Dodson, a resident of a housing project in Hunstville, Alabama, agreed to be interviewed by the local television news after an intruder entered the home he shared with his sister and her children. The news broadcasted quickly and went viral online, as Mr. Dodson's look, style, and unique manner of speaking attracted the attention of millions of people worldwide. Shortly thereafter, musicians and humorists

A weighing-of-the-equities approach not only promotes IP social justice by restraining IP Imperialist overreaching and supporting socially valuable encroachments upon publicity rights, it is also consistent the Supreme Court's directive in *eBay v. Mercexchange, L.L.C.*,²⁰¹ that infringement upon intellectual property rights does not automatically mandate injunctive relief.²⁰² This approach not only preserves an individual publicity plaintiff's interests, but also serves to protect society's social interests as a whole. Unless the weighing of the equities mandates injunctive relief, the fact that the equities in a particular case favor the right of the publicity plaintiff will not preclude the unauthorized use of her persona altogether. Instead, consistent with the Supreme Court's observations in *Zacchini*, it will merely assure her a portion of the revenues generated by the unauthorized use.²⁰³

calling themselves The Gregory Brothers created a song known as the "Bed Intruder Song" with an accompanying music video using clips from the television broadcast. The song was one of the most viewed videos on YouTube, quickly became a top iTunes download, and even rose to the *Billboard* magazine's top 100 list. According to The Gregory Brothers, they agreed to share some of the proceeds from their song's commercial success with Mr. Dodson. Mr. Dodson obviously acquired instant fame and notoriety. He set up his own website to receive donations and garner additional publicity, and as a result has purportedly raised enough money to move his family to a better house in a safer neighborhood.").

201. 547 U.S. 388, 391–92 (2006).

202. See e.g., Menell, *Intellectual Property and the Property Rights Movement*, *supra* note 35, at 42 ("[E]ven the Supreme Court's most stalwart property rights defenders resisted the effort to pull intellectual property into the traditional property tent. In a unanimous decision . . . the Court ruled that injunctions should not be presumed in patent cases; rather courts should exercise equitable discretion in determining relief."); see also Paul M. Janicke, *Implementing the "Adequate Remedy at Law" for Ongoing Patent Infringement After eBay v. MercExchange*, 51 IDEA 163 (2011).

203. See Kwall, *supra* note 82, at 65 (arguing for a monetary damages-only remedy for certain right-of-publicity infringements).

In light of the substantial support for the imposition of a liability rule approach in other areas of the law, it is surprising that this approach has never been invoked in the context of adjudicating conflicts between the right of publicity and the First Amendment. Indeed, resolution of this conflict is particularly suited to the imposition of a liability rule system since many situations will arise in which the defendant's use is in the public interest, but the plaintiff and defendant will be unable to negotiate privately an agreement permitting such use. The failure of these negotiations may be attributable to factors such as the plaintiff's adamant refusal to sell her persona, or the ability of the plaintiff to extract economic rents from the buyer due to the relative uniqueness of the desired commodity. In such instances, the adoption of a liability rule approach yields the most economically efficient result.

Id.

PART VI: CONCLUSION

It is high time that the bench and bar revisit the social mandate of the Constitution that the intellectual property law promote the progress of the arts and sciences and thereby serve the greater societal good:

Intellectual property rights are not merely technical matters. They increasingly involve crucial questions not only of economic interest, competitiveness, and market power, but also of environmental sustainability, human development, ethics and international human rights. We need to start using intellectual property to reduce and eliminate hunger and poverty, to safeguard the environment, to halt the loss of biodiversity, to empower women, and to ensure food and social security.²⁰⁴

Courts adjudicating right-of-publicity disputes should carefully consider the social utility goals underlying these rights, as they serve important social goals and promote social justice as an element of the intellectual property regime. Judicial recognition of the functional interdependence of right of publicity social utility and social justice not only restrains socially unproductive IP Imperialism, but also promotes inclusion and participation in the IP regime. The pursuit of such socially balanced applications of the intellectual property law will only enhance the social benefits to be obtained through the development of new intellectual properties and their exploitation in the digital information age.

204. Coombe, *supra* note 36, at 284.