

A COPYRIGHT RIGHT OF PUBLICITY

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What would Brian Boitano do / if he were here today?

—*South Park: Bigger, Longer & Uncut*¹

This Article identifies a striking asymmetry in the law’s disparate treatment of publicity-rights holders and copyright holders. State-law publicity rights generally protect individuals from unauthorized use of their name and likeness by others. Publicity-claim liability, however, is limited by the First Amendment’s protection for expressive speech embodying a “transformative use” of the publicity-rights holder’s identity. This Article examines for the first time a further limitation imposed by copyright law: when a publicity-rights holder’s identity is transformatively depicted in a copyrighted work without consent, the author’s copyright can produce the peculiar result of enjoining the publicity-rights holder from using or engaging in speech about her own depiction. This Article offers novel contributions to the literature on copyright overreach and: (1) identifies a legal asymmetry produced in the interplay of publicity rights, copyright law, and the First Amendment; (2) examines the burdens on constitutionally protected speech, autonomy, and liberty interests of publicity-rights holders when copyright law prevents or constrains use of their own depiction; and (3) outlines a framework for recognizing a “copyright right of publicity” to exempt the publicity-rights holder’s use from copyright infringement liability. Notably, this Article contributes uniquely to the literature by revealing new insights gained from an exclusive first-hand perspective of an internationally recognized celebrity whose persona was prominently depicted without prior notice or consent in a wide-release feature film.

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1. TREY PARKER & MARC SHAIMAN, *What Would Brian Boitano Do?*, on *SOUTH PARK: BIGGER, LONGER & UNCUT—MUSIC FROM AND INSPIRED BY THE MOTION PICTURE* (Atlantic 1999).

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INTRODUCTION

The right of publicity generally protects individuals from unauthorized use of their name and likeness by others.² Debate and discussion of publicity rights loom large in the academic literature, which has grown to include more than 3700 works of published scholarship.³ Despite this massive outpouring of interest, however, no scholarship to date has taken into account the first-hand perspective of a celebrity who has lived through the extraordinary experience of having one's identity prominently depicted and widely published without prior notice or consent.⁴ This Article fills that void by presenting an exclusive, first-hand celebrity narrative that reveals new and significant insight about a previously overlooked intersection of publicity rights, copyright law, and the First Amendment. In particular, this insight expounds upon a previously overlooked implication of the First Amendment's protection of an author's expressive speech that depicts a publicity-rights holder's identity in a "transformative use."⁵ The First Amendment freedom of speech generally overrides the personality's publicity rights in this context, but, significantly, because the author's transformative depiction is automatically entitled to copyright protection

2. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 1995).

3. A search of the Westlaw journal and law review database for "right /2 publicity" returned 3710 results on June 2, 2015.

4. A review of every author who published legal scholarship containing the terms "right /2 publicity" in the Westlaw journal and law review database as of June 2, 2015, revealed no works published by an author of discernable fame or prominence outside the sphere of legal academia, except for a short essay on the need for national uniformity of publicity-rights law by American actor Richard Masur. See generally Richard Masur, *Right of Publicity from the Performer's Point of View*, 10 DEPAUL J. ART & ENT. L. 253 (2000).

5. See *infra* note 55 (explaining the transformative use doctrine).

upon its rendering in a fixed medium, the author's copyright protection can produce the peculiar, if not anomalous, outcome of enjoining the appropriated personality from using or engaging in speech about her own depiction in the copyrighted work.⁶ This arguably counterintuitive outcome reveals a marked legal asymmetry favoring the interests of copyright holders over publicity-rights holders, an asymmetry that, I argue, harmfully contributes to a broader undesirable trend toward the overreach of modern American copyright law.⁷ Before beginning our interstitial analysis of publicity rights, copyright law, and the First Amendment, however, let us set the stage for this inquiry by recounting the cinematic depiction of Olympic figure skating gold medalist Brian Boitano.⁸

In 1999, comedy writers Trey Parker and Matt Stone wrote, directed, and produced the suggestively titled animated feature film, *South Park: Bigger, Longer & Uncut*,⁹ based on their successful television series, *South Park*.¹⁰

6. See *infra* Part I.C.

7. For a sampling of the literature on copyright overreach, see NEIL WEINSTOCK NETANEL, *COPYRIGHT'S PARADOX* 54–80 (2008) (chronicling “[c]opyright’s [u]ngainly [e]xpansion”); Yochai Benkler, *Free As the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354 (1999); Jed Rubenfeld, *The Freedom of Imagination: Copyright’s Constitutionality*, 112 YALE L.J. 1, 5 (2002); Pamela Samuelson, *Is Copyright Reform Possible?*, 126 HARV. L. REV. 740 (2013) (reviewing JASON MAZZONE, *COPYFRAUD AND OTHER ABUSES OF INTELLECTUAL PROPERTY LAW* (2011)) (“Complaints have been legion that copyright industry groups and corporate copyright owners have sought and too often obtained extremely strong and overly long copyright protections that interfere with downstream creative endeavors and legitimate consumer expectations.”); Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535 (2004). For the contours of this debate, compare JOHN TEHRANIAN, *INFRINGEMENT NATION: COPYRIGHT 2.0 AND YOU* (2011) (criticizing the trend toward increasing copyright scope and infringement liability), with Peter S. Menell, *Infringement Conflation*, 64 STAN. L. REV. 1551 (2012) (reviewing TEHRANIAN, *supra*) (asserting the legitimate role of copyright law in combating unauthorized file sharing).

8. Brian Boitano won the Olympic gold medal for figure skating at the 1988 Winter Games in Calgary, Canada, and was appointed by President Barack Obama to the United States Olympic Delegation to the 2014 Winter Olympic Games in Sochi, Russia. In total, Boitano, a three-time Olympian, has won more professional titles than any other skater in the history of the sport, including twenty-three international gold medals, two world titles, two Pro/AM titles, sixteen professional titles, four U.S. national titles, and the Olympic gold medal. The first male figure skater to appear on the cover of *Sports Illustrated*, Boitano single-handedly changed the face of professional figure skating and has produced and starred in more than thirty network television skating specials, including *Canvas of Ice* (ABC) and *The Brian Boitano Skating Spectacular* (NBC). Mr. Boitano received a Primetime Emmy Award for Outstanding Performance in Classical Music/Dance Programming for *Carmen on Ice* and was inducted into the U.S. and World Figure Skating Halls of Fame. Off the ice, Mr. Boitano has created and starred in televised lifestyle programming on the Food Network, *What Would Brian Boitano Make?* (2009 and 2010), and HGTV, *The Brian Boitano Project* (2014). Mr. Boitano’s HGTV series garnered the highest ratings ever for a home improvement series. Boitano’s book, *BOITANO’S EDGE: INSIDE THE REAL WORLD OF FIGURE SKATING* (1997), currently in its third printing, is considered one of the finest written works on figure skating. See Biographical Memorandum on Brian Boitano (on file with the *Fordham Law Review*).

9. *SOUTH PARK: BIGGER, LONGER & UNCUT* (Comedy Central Films et al. 1999) [hereinafter *SOUTH PARK*].

10. *South Park* (Comedy Central).

The film, distributed in wide release by Paramount Pictures domestically and Warner Brothers internationally,¹¹ holds the box office record for gross receipts generated by a fully animated R-rated movie¹² and received an Academy Award nomination for Best Original Song.¹³ The film depicts an outlandish dispute between a cast of precocious school-age children and their paternalistic parents, who seek to ban and boycott an obscenity-laced Canadian film, “*Terrance and Phillip: Asses of Fire*,” much beloved by the kids.¹⁴ *South Park*’s fantastical storyline portrays conflict over the film’s censorship, escalating into military hostilities between the United States and Canada after the United States threatens to execute Canadians Terrance and Phillip.¹⁵ The turning point in the plot occurs when the children band together and vow to rescue Terrance and Phillip.¹⁶ In that scene, the children perform a song written by Trey Parker and composer Marc Shaiman titled, “What Would Brian Boitano Do?,” parodying both Brian Boitano and the evangelical religious phrase, “What would Jesus do?”¹⁷

The song’s lyrics recount Boitano’s figure skating performance at the 1988 Olympic Winter Games in Calgary, Canada, in which American Brian Boitano famously defeated Canadian Brian Orser to win the Olympic gold medal. In approximately two minutes of film, the singing children invoke Boitano’s name fifteen times while fantasizing about his heroic quest to save humanity. The song portrays Boitano as possessing superhuman traits, traits that the film depicts Boitano using to rescue victims of persecution at various landmark moments in history (and the future). During the song, the film’s animation visually depicts Boitano’s clearly identifiable likeness, moving about the screen on figure skates while dressed in distinctive figure skating performance attire. Inspired by Boitano’s valor, the children conclude by marching into the sunset to save Terrance and Phillip from execution, “[c]ause that’s what Brian Boitano [would] do.”¹⁸

Despite his prominent depiction in the film, Boitano first saw his animated portrayal only after its public release. The film’s producers, undoubtedly well-advised by legal counsel and familiar with the First

11. *South Park: Bigger, Longer & Uncut: Company Credits*, IMDB, http://www.imdb.com/title/tt0158983/companycredits?ref_=tt_ql_10 (last visited Apr. 29, 2016) [<https://perma.cc/E4DD-MA3G>].

12. In 2012, *Ted*, an R-rated live-action film featuring computer generated animation, surpassed *South Park*’s box office receipts, but *South Park* remains the highest grossing fully animated R-rated movie. See, e.g., Amid Amidi, “*Ted*” Is the Highest-Grossing R-Rated Animated Feature of All-Time, CARTOON BREW (July 1, 2012, 2:40 PM), <http://www.cartoonbrew.com/cgi/ted-is-the-highest-grossing-r-rated-animated-feature-of-all-time-65666.html> [<https://perma.cc/N7G5-PXY8>].

13. See *The 72nd Academy Awards, 2000*, OSCARS, <https://www.oscars.org/oscars/ceremonies/2000> (last visited Apr. 29, 2016) (noting that “Blame Canada” was nominated for Best Original Song) [<https://perma.cc/8MKH-8DVQ>].

14. See SOUTH PARK, *supra* note 9.

15. *Id.*

16. *Id.*

17. *Id.*

18. *Id.*; *What Would Brian Boitano Do? Lyrics*, METROLYRICS, <http://www.metrolyrics.com/what-would-brian-boitano-do-lyrics-south-park.html> (last visited Apr. 29, 2016) [<https://perma.cc/4ZYV-G7D4>].

Amendment's protection of speech and creative works of expression, safely assumed they had no legal obligation to obtain prior consent from Boitano for use of his name and likeness; nor were they likely to have any legal obligation under the right of publicity to compensate Boitano for the film's use of his persona in this context. Under the First Amendment, an individual generally cannot assert the right of publicity to withhold permission or demand payment for the use of one's name or likeness where the depicted persona is embodied in a "transformative use."¹⁹ The First Amendment's abridgment of publicity rights, while subject to continuing debate about its scope and application, largely is settled as a first principle.²⁰

In an exclusive statement prepared for this Article, Boitano submits the following narrative recounting his experience learning about and reacting to his depiction in the *South Park* film:

I first heard about the *South Park* film from a friend of mine with Hollywood connections, and I was a little nervous about how the creators, Matt Stone and Trey Parker, would treat me in their movie. They were known for controversial parodies and brilliant satires that often skewered their subjects. So I was relieved to see that I was portrayed in a light-hearted spirit.

As a result of the film, I gained many new young-adult fans who associated me with *South Park*. The film itself was very successful, and it became part of pop culture. My portrayal as the savior of the world was very funny, and I embraced it from the very beginning.

Later I obtained permission from the owners of the *South Park* song, *What Would Brian Boitano Do?*, to use that phrase on merchandise which was sold in support of my charity, *Youth Skate*. In addition, they granted me the right to use a version of the song as a lead in to my cooking series on the Food Network, *What Would Brian Boitano Make?* To this day my role in *South Park* comes up in half the interviews I do whether for skating or food-related subjects.²¹

Boitano's experience, while notably positive, reveals a stark asymmetry in the law. In the interplay of publicity rights, copyright law, and the First Amendment freedom of expression, authorial-rights holders receive markedly preferential legal treatment compared to publicity-rights holders. When a personality's name or likeness is transformatively depicted in a creative work of expression, the First Amendment precludes that personality from asserting publicity rights to withhold permission or demanding compensation for the depiction; but under copyright law, the copyright owner of the depiction acquires the right to both withhold permission and demand compensation for the personality's use of his own depiction in the copyrighted work.²² This asymmetry has the potential for sweeping implications in a host of intellectual contexts, such as the genre of unauthorized biography, where a person depicted without consent may be

19. See *infra* Part I.

20. See *infra* Part I.

21. Statement of Brian Boitano (Sept. 24, 2015) (on file with the *Fordham Law Review*).

22. See *infra* Part I.B.

foreclosed from using her own depiction without a license from the copyright holder of the biography.²³

This Article, the primary objective of which is to expound upon this peculiar interaction of publicity rights and copyright law, proceeds as follows: Part I recounts the historical development of publicity rights, describes the liability limitations imposed by the First Amendment on the right of publicity, and explains how the intersection of publicity rights, copyright law, and the First Amendment yields preferential treatment for copyright holders at the expense of publicity-rights holders. In particular, I argue that the First Amendment provides a stronger speech-based affirmative defense for the unauthorized use of a publicity-rights holder's identity than for the unauthorized use of a copyright holder's work of authorship, a legal asymmetry exacerbated by market factors chilling incentives for publicity-rights holders to test the merits of a colorable copyright fair use defense in court. These subtle distinctions between the two affirmative defenses adversely affect the economic value of publicity rights as compared to copyright protection, but more interestingly, they impose arguably anomalous constraints on the publicity-rights holder's freedoms of speech, autonomy, and liberty.

Part II expands upon this anomalous treatment by examining the Constitution's protection of the publicity right holder's speech, liberty, and autonomy interests under the First Amendment's Freedom of Speech Clause and the Fifth and Fourteenth Amendments' substantive due process provisions. However, upon considering the limited scope of constitutional protection in these contexts, I conclude that reform providing copyright exemption for the publicity-rights holder should not directly invoke the Constitution.

Part III draws upon the broader legal principles underlying the constitutional protections of speech, liberty, and autonomy to propose a framework for recognizing a "copyright right of publicity" on normative policy grounds through a more expansive interpretation of the copyright fair use doctrine or, alternatively, a statutory categorical exemption from copyright infringement liability affording greater leeway for the publicity-rights holder's use of his own depiction.

I. THE RIGHT OF PUBLICITY AND THE PREDOMINANCE OF AUTHORIAL RIGHTS

This part surveys the development of state-law publicity rights, liability limitations imposed by the First Amendment, and the intersection of publicity rights and copyright law. It then explains how these interacting principles produce markedly preferential treatment for authorial-rights holders as compared to publicity-rights holders.

23. For a normative legal and literary theory of biography, see Mary Sarah Bilder, *The Shrinking Back: The Law of Biography*, 43 STAN. L. REV. 299, 342-60 (1991).

A. The Right of Publicity

The right of publicity traces its roots to early commentary on privacy by Samuel Warren and Louis Brandeis, as published in their canonic 1890 *Harvard Law Review* article, *The Right to Privacy*.²⁴ Warren and Brandeis argued that unwelcome publicity had the potential to inflict psychological harm, and so, to keep apace with evolving legal protection for the infliction of physical harm, the law also should protect at least a minimal threshold of emotional equilibrium for persons who wish “to be let alone.”²⁵ The right to privacy, as Warren and Brandeis conceived it, protected private individuals from the spectacle of unwanted exposure and publicity in the press, but it did not apply to matters of public interest.²⁶ According to Warren and Brandeis, “There are persons who may reasonably claim as a right, protection from the notoriety entailed by being made the victims of journalistic enterprise. There are others who, in varying degrees, have renounced the right to live their lives screened from public observation.”²⁷ This construction of privacy gave individuals who otherwise were private in their routine affairs the right to opt-out of unwanted publicity, but it did not explicitly contemplate the possibility that public figures could assert such a right, let alone hold an exclusive right to control, exploit, and profit from fame in a public setting.

Following the turn of the twentieth century, the earliest identity appropriation cases involved claims by private individuals for mental anguish resulting from the unauthorized use of their likenesses in commercial advertisements.²⁸ But as the privacy doctrine meandered and evolved over the ensuing decades, public figures began asserting privacy claims that, in essence, sought remuneration for the unauthorized commercial appropriation of their persona, rather than damages for mental anguish arising from unwanted publicity.²⁹ Courts initially viewed such

24. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

25. *Id.* at 195 (quoting COOLEY ON TORTS 29 (2d ed. 1888)).

26. *See id.* at 214–15 (“The design of the law must be to protect those persons with whose affairs the community has no legitimate concern, from being dragged into an undesirable and undesired publicity and to protect all persons, whatsoever; their position or station, from having matters which they may properly prefer to keep private, made public against their will.”).

27. *Id.* at 215.

28. *See, e.g.*, *Pavesich v. New Eng. Life Ins. Co.*, 50 S.E. 68, 68–69 (Ga. 1905) (recognizing a right of privacy where the defendant appropriated the plaintiff’s likeness on an advertisement for life insurance and featured a quotation falsely attributable to the plaintiff); *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442 (N.Y. 1902) (finding no liability where defendant appropriated plaintiff’s likeness on a poster advertisement for flour).

29. *Cf.* James Q. Whitman, *The Two Western Cultures of Privacy: Dignity Versus Liberty*, 113 YALE L.J. 1151, 1210 (2004) (“As critics complain, the ‘right of publicity’ has tended to lose all of its moorings in the Warren and Brandeis idea of privacy, becoming essentially a vehicle for protecting the enterprises of celebrities like Bette Midler and Vanna White.”).

claims by public figures as incongruous with privacy doctrine,³⁰ but commentators later distinguished privacy rights—which protect the right to be free from unwanted publicity—from publicity rights—which grant an exclusive right to control and exploit one’s name and likeness.³¹ Soon enough, courts, too, began to accept publicity rights as doctrinally distinct from privacy rights.³²

By the 1960s, legal scholarship began to endorse the distinction between privacy and publicity rights more fully, as influential commentary by Harold Gordon and Professor William Prosser sought to situate the right of publicity as a property interest.³³ Meanwhile, other scholars, such as Professor Edward Bloustein,³⁴ continued to adhere to the Warren-Brandeis notion of privacy by characterizing publicity rights as an integral aspect of human dignity, not as a property interest. Under Bloustein’s view (and critique of Prosser’s proprietary theory), publicity rights protected the right to demand a commercial price for relinquishing one’s privacy.³⁵ But the proprietary view generally has prevailed,³⁶ with courts, including the U.S. Supreme Court, likening publicity rights to intellectual property and recognizing that protection for publicity rights creates economic incentives for individuals to engage in socially useful activities that enhance the market value of their identity.³⁷ The proprietary view of publicity rights

30. See, e.g., *O’Brien v. Pabst Sales Co.*, 124 F.2d 167, 170 (5th Cir. 1941) (finding no claim for invasion of privacy where the plaintiff athlete’s image was used on a beer advertisement, because “the publicity he got was only that which he had been constantly seeking and receiving”).

31. See generally, e.g., Melville B. Nimmer, *The Right of Publicity*, 19 L. & CONTEMP. PROBS. 203 (1954) (arguing that publicity rights should be distinct from privacy rights).

32. See, e.g., *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (recognizing a right of publicity).

33. Harold R. Gordon, *Right of Property in Name, Likeness, Personality and History*, 55 NW. U. L. REV. 553, 554 (1960) (arguing that the doctrine “became confused” when public figures began resorting to privacy rights to redress appropriation of one’s persona for commercial purposes); William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 406 (1960) (characterizing “appropriation” as “not so much a mental as a proprietary [interest], in the exclusive use of the plaintiff’s name and likeness as an aspect of his identity”).

34. From 1971 to 1989, Professor Bloustein also served as President of Rutgers University, the institution where my faculty appointment resides. *Edward J. Bloustein*, RUTGERS, <http://www.rutgers.edu/about/history/past-presidents/edward-j-bloustein> (last visited Apr. 29, 2016) [<https://perma.cc/2X4H-DN3F>].

35. See Edward J. Bloustein, *Privacy As an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U. L. REV. 962, 989 (1964); see also *supra* notes 24–27 and accompanying text (discussing the Warren-Brandeis notion of privacy). But see Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1181–82 (2006) (arguing that publicity rights cannot be justified on theories of human dignity).

36. Cf. Whitman, *supra* note 29, at 1210 (noting that “an American interest in one’s ‘publicity’ is an interest in one’s property, not an interest in one’s honor”).

37. See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (“Ohio’s decision to protect petitioner’s right of publicity here 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.”); *Matthews v. Wozencraft*, 15 F.3d 432, 437 (5th Cir. 1994) (“Protecting one’s name or likeness from misappropriation is socially beneficial because it

also has led to the recognition of descendible postmortem publicity rights in a number of jurisdictions.³⁸

Under the modern right of publicity, as articulated by the Restatement (Third) of Unfair Competition, “[o]ne who appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade is subject to liability for the [appropriate] relief.”³⁹ Although the Constitution has been interpreted to imply a limited array of fundamental liberty interests, some of which involve elements of privacy,⁴⁰ the right of publicity is not among them.⁴¹ Publicity rights therefore arise under state law, which is based on the common law in twenty-one states and statutory law in eighteen states where legislatures have acted to protect publicity rights.⁴² A complementary area of federal law, section 43(a) of the Lanham Act,⁴³ supplements state-law publicity rights by providing a civil action for false affiliation, designation of origin, or endorsement in connection with goods or services used in interstate commerce.⁴⁴ Under the Lanham Act, a personality whose depiction has been used without permission may recover damages where the contested depiction falsely implies an affiliation or endorsement by the personality of the goods or services promoted in connection with the misappropriated persona.⁴⁵

B. First Amendment Limitations on Publicity-Claim Liability

Natural tension resides at the intersection of publicity rights and free speech.⁴⁶ On the one hand, the value of publicity rights is almost always enhanced by the public’s use of and speech about the persona because the commercial value of and demand for a persona is often a direct function of the overall volume of speech in the public discourse about the personality.

encourages people to develop special skills, which then can be used for commercial advantage.”).

38. See David Horton, *Indescendibility*, 102 CAL. L. REV. 543, 561–63 (2014).

39. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. LAW INST. 1995).

40. Cf. *Zablocki v. Redhail*, 434 U.S. 374, 384 (1978) (noting that cases have “routinely categorized the decision to marry as among the personal decisions protected by the right of privacy”).

41. This perhaps reflects the implicit acceptance of the doctrinal distinction between noneconomic aspects of privacy protected by the Constitution and the proprietary interests of publicity rights more aptly situated along a branch of unfair competition law.

42. See 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 6:3 (2d ed. 2015). States with statutory protection for publicity rights include California, Florida, Illinois, Indiana, Kentucky, Massachusetts, Nebraska, Nevada, New York, Ohio, Oklahoma, Pennsylvania, Rhode Island, Tennessee, Texas, Utah, Virginia, Washington, and Wisconsin. See *id.* § 6:3 nn.8–9.

43. Lanham Act § 43(a), 15 U.S.C. § 1125(a) (2012).

44. *Id.*

45. See *id.*

46. Almost fifty years ago, Professor Melville Nimmer described a similar tension between speech and copyright protection as a “largely ignored paradox.” Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180, 1181 (1970). Nimmer’s characterization of this tension likely served as inspiration for the title of Professor Neil Netanel’s recent monograph, *Copyright’s Paradox*, cited *supra* note 7.

For example, setting aside the political merits, the fact that, as of this writing, more than six months of the entire national discourse concerning the 2016 presidential election has been wholly consumed by media coverage and discussion of Donald Trump *has* to have had a positive effect on the commercial value of Mr. Trump's publicity rights.⁴⁷ On the other hand, publicity rights operate by granting the owner exclusionary rights, thus allowing the personality to enjoin or charge for use of her persona.⁴⁸ Exclusionary rights may be waived or not asserted, so the right of publicity operates by allowing the right holder to decide whether to permit the use of her persona. The very existence of publicity rights, therefore, tends to chill speech about the personality because the right creates at least the threat of possible liability for use of the persona. Given this tension, for both interests to coexist, the law must strike a balance between publicity rights and free speech; without a legal standard to determine when one interest should trump⁴⁹ the other, publicity rights would untenably constrain speech, and the freedom of speech would obliterate publicity rights.

In striking a balance between these oft-competing interests, the law generally favors speech over publicity rights.⁵⁰ Unlike publicity rights, which arise under preemptable state law, the freedom of speech is expressly and supremely protected under the First Amendment.⁵¹ Thus, an individual's publicity rights generally end—full stop—when another individual's free speech begins.⁵² The right of publicity inhibits the

47. See, e.g., Nicholas Confessore & Karen Yourish, *Measuring Donald Trump's Mammoth Advantage in Free Media*, N.Y. TIMES (Mar. 15, 2016), http://www.nytimes.com/2016/03/16/upshot/measuring-donald-trumps-mammoth-advantage-in-free-media.html?_r=0 [<http://perma.cc/ED4Y-SNTJ>].

48. See, e.g., N.Y. CIV. RIGHTS LAW § 51 (McKinney 2016). The New York Civil Rights Law provides:

Any person whose name, portrait, picture or voice is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained as above provided may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait, picture or voice, to prevent and restrain the use thereof; and may also sue and recover damages for any injuries sustained by reason of such use and if the defendant shall have knowingly used such person's name, portrait, picture or voice in such manner as is forbidden or declared to be unlawful by section fifty of this article, the jury, in its discretion, may award exemplary damages.

Id.

49. Pun intended.

50. See generally, e.g., C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P., 505 F.3d 818 (8th Cir. 2007); ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996); *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001); *Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307 (Cal. Ct. App. 2001).

51. U.S. CONST. amend. I ("Congress shall make no law . . . abridging the freedom of speech.").

52. Cf. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (AM. LAW INST. 1995) ("The right of publicity as recognized by statute and common law is fundamentally constrained by the public and constitutional interest in freedom of expression. The use of a

freedom of expression when it prevents or constrains speech concerning a person's identity, but not all forms of expression are protected under the First Amendment in this context.⁵³ Courts therefore have developed various balancing tests to demarcate the boundary between publicity rights and First Amendment speech interests,⁵⁴ chief among them the influential "transformative use" test adapted from the copyright fair use doctrine.⁵⁵

Under the transformative use test, courts evaluate whether the challenged work depicting the celebrity's persona "merely 'supersede[s] the objects' of the original creation . . . or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is 'transformative.'"⁵⁶ In *Comedy III Products, Inc. v. Gary Saderup, Inc.*,⁵⁷ the California Supreme Court described the test as assessing

whether the celebrity likeness is one of the "raw materials" from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question. We ask, in other words, whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness. And when we use the word "expression," we mean expression of something other than the likeness of the celebrity.⁵⁸

Under this test, an individual, whether or not a celebrity, cannot recover damages for a violation of the right of publicity when the depicted identity has been transformed into a new creative work of expression. At bottom, the transformative test evaluates a challenged depiction by ascertaining

person's identity primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation of the person's right of publicity.").

53. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 578 (1977) (finding that the First Amendment did not immunize defendant's wholesale broadcast of plaintiff's human cannonball stunt on the local news from plaintiff's state-law publicity claim).

54. See, e.g., *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 152–65 (3d Cir. 2013) (surveying the various judicial tests for demarking the boundary between publicity rights and protected speech).

55. Pursuant to federal statute, courts must balance the following four factors in determining whether the secondary use is a "fair use" of the copyrighted work:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107 (2012).

The transformative use test in copyright law is based on the first statutory factor. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (citing Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990)).

56. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001) (alteration in original) (emphasis added) (quoting *Campbell*, 510 U.S. at 579).

57. 21 P.3d 797 (Cal. 2001).

58. *Id.* at 809.

whether the use embodies speech worthy of constitutional protection apart from its replication of the persona. Notably, this constitutional limitation on publicity-claim liability applies even when the transformative depiction is, itself, sold for profit by the secondary user.⁵⁹

In *Comedy III Products*, the landmark case recognizing the transformative use test in a publicity-rights claim, the court went on to hold that the challenged charcoal depictions of the Three Stooges sold by the defendant on T-shirts and lithographs for a profit of \$75,000 did not sufficiently transform the images of the late celebrities because the charcoal drawing represented mere “literal, conventional depictions of the Three Stooges.”⁶⁰ In permitting the plaintiff’s assertion of publicity rights, the court also noted that “the marketability and economic value of [the artwork] derive[d] primarily from the fame of the celebrities depicted.”⁶¹ Subsequently, courts applying the transformative use test have held as sufficiently transformed—and, therefore, entitled to First Amendment protection—a comic book depiction of recording artists Johnny and Edgar Winter⁶² and a painting of golfer Tiger Woods commemorating his win at the 1997 Masters Tournament.⁶³ By contrast, in recent class action

59. See *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003) (noting that First Amendment speech protection applied where the defendant “published and marketed two hundred and fifty 22 1/2” x 30” serigraphs and five thousand 9” x 11” lithographs of *The Masters of Augusta* at an issuing price of \$700 for the serigraphs and \$100 for the lithographs”); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996) (“The fact that expressive materials are sold neither renders the speech unprotected nor alters the level of protection under the First Amendment.”); cf. *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501–02 (1952) (“That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment.”).

60. *Comedy III Prods., Inc.*, 21 P.3d at 811.

61. *Id.*

62. *Winter v. DC Comics*, 69 P.3d 473, 476 (Cal. 2003). The court in *Winter* described the five-volume miniseries of Jonah Hex comics at issue as follows:

The series contains an outlandish plot, involving giant worm-like creatures, singing cowboys, and the “Wilde West Ranch and Music and Culture Emporium,” named for and patterned after the life of Oscar Wilde. The third volume ends with a reference to two new characters, the “Autumn brothers,” and the teaser, “Next: The Autumns of Our Discontent.” The cover of volume 4 depicts the Autumn brother characters, with pale faces and long white hair. . . . One brother wears a stovepipe hat and red sunglasses, and holds a rifle. The second has red eyes and holds a pistol. This volume is entitled, *Autumns of Our Discontent*, and features brothers Johnny and Edgar Autumn, depicted as villainous half-worm, half-human offspring born from the rape of their mother by a supernatural worm creature that had escaped from a hole in the ground. At the end of volume 5, Jonah Hex and his companions shoot and kill the Autumn brothers in an underground gun battle.

Id.

63. *ETW Corp.*, 332 F.3d at 918. Here, the court described the painting at issue as follows:

In the foreground of Rush’s painting are three views of Woods in different poses. In the center, he is completing the swing of a golf club, and on each side he is crouching, lining up and/or observing the progress of a putt. To the left of Woods is his caddy, Mike “Fluff” Cowan, and to his right is his final round partner’s caddy. Behind these figures is the Augusta National Clubhouse. In a blue background behind the clubhouse are likenesses of famous golfers of the past looking down on Woods. These include Arnold Palmer, Sam Snead, Ben Hogan,

litigation involving claims by college and professional athletes against producers of video games depicting the athletes as interactive, lifelike, ball-playing avatars, both the Third and Ninth Circuit Courts of Appeals have held that the avatars were insufficiently transformative to warrant First Amendment protection.⁶⁴

Not unlike its copyright fair use counterpart, the transformative use test in the publicity-claim context has been criticized by scholars for yielding subjective, inconsistent, and arbitrary results.⁶⁵ At its core, however, the test attempts to resolve tension between speech and publicity rights by allowing First Amendment speech interests to prevail over state-law publicity interests. When a challenged depiction is sufficiently transformative, First Amendment principles prevail absolutely over publicity rights, thereby granting the author nearly unfettered free use of the personality's name and likeness.⁶⁶ Upon sufficient transformation, the depicted personality surrenders entirely the right to withhold permission or to demand compensation for the use of his name and likeness. In this regard, the transformative use test produces binary outcomes: either the challenged use is transformative (and the author prevails absolutely) or it is not transformative (and the personality prevails absolutely).⁶⁷ There are no outcomes in between.

Walter Hagen, Bobby Jones, and Jack Nicklaus. Behind them is the Masters leader board.

Id.

64. *Davis v. Elec. Arts Inc.*, 775 F.3d 1172 (9th Cir. 2015) (ruling on defendants' Anti-SLAPP motion to dismiss and finding that the defendants did not have a reasonable probability of prevailing on their claim that the First Amendment immunized liability for infringing football players' publicity rights); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141 (3d Cir. 2013).

65. See, e.g., F. Jay Dougherty, *All the World's Not a Stooge: The "Transformativeness" Test for Analyzing a First Amendment Defense to a Right of Publicity Claim Against Distribution of a Work of Art*, 27 COLUM. J.L. & ARTS 1, 73 (2003); Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903, 916–17 (2003). For a searing critique of the copyright transformative use test, see Amy Adler, *Fair Use and the Future of Art*, 91 N.Y.U. L. REV. (forthcoming 2016).

66. See *supra* note 50 (citing cases).

67. An interesting counterproposal to the winner-take-all system, described by its proponents as a "radical solution," seeks to

fundamentally change our approach to the First Amendment as a necessarily winner-take-all device for which compensation is never required. In its place, one can imagine a "paid-for" First Amendment in the form of a compulsory publicity license. Under this model, the plaintiff [i.e., the appropriated personality] would not be able to censor the defendant's speech, but likewise, even the expressive and creative defendant (that is, a transformative user) could not free ride on the plaintiff's celebrity fame without having to pay fair-market-value compensation for its profit-driven use. In essence, the fact finder could find that the challenged use is sufficiently creative to continue but that a reasonable royalty must be paid. The royalty would be based on the value of the celebrity image and could be offset to the extent to which the transformative use derives substantial economic value from the creativity of the defendant instead of merely or mostly from the fame of the celebrity.

David Franklyn & Adam Kuhn, *Owning Oneself in a World of Others: Towards a Paid-For First Amendment*, 49 WAKE FOREST L. REV. 977, 979–80 (2014).

*C. First Amendment Speech Defenses and the
Asymmetrical Treatment of Copyright and Publicity Rights*

Copyright law is almost always implicated by operation of law in the interplay between publicity and authorial rights. With rare exception, nearly every unauthorized depiction of a name or likeness challenged in a publicity claim is, itself, embodied in a fixed work of authorship—such as a book, film, television show, song, or image. This is significant because copyright protection subsists, by operation of law, from the creation of a work of authorship, so the author’s rendering of a personality’s depiction in a fixed medium automatically grants the author exclusionary rights in the work under copyright law as to all the world, including the depicted personality.⁶⁸ Conversely, because a person’s name and likeness is not treated as a work of authorship for copyright purposes, the publicity-rights holder’s persona is not itself entitled to copyright protection, even though depictions of the person’s identity are copyrightable.⁶⁹ As explained below, this interplay between copyright protection and publicity-claim liability, in turn, creates asymmetry between publicity and authorial rights favoring the interests of authors and copyright holders over those of publicity-rights holders.

Before examining the particulars of legal doctrine contributing to this asymmetry, it may be useful to articulate and exemplify the broader contrast in scope between the speech-based liability exemptions in the publicity-claim and copyright-infringement contexts. Consider the Tony Award-winning *Forbidden Broadway*, a popular musical revue performed (and periodically updated) off-Broadway since 1982, which is well-known for its comedic parody of theatrical performers and performances.⁷⁰ In its signature irreverently parodic technique, *Forbidden Broadway* productions frequently include a musical skit titled “Chita and Rita,” in which two female performers depict the distinctive personas of actresses Rita Moreno and Chita Rivera engaged in a fictitious (but ferociously sung) argument

68. See 17 U.S.C. § 302(a) (2012) (“Copyright in a work created on or after January 1, 1978, subsists from its creation”); *id.* § 101 (“A work is ‘created’ when it is fixed in a copy or phonorecord for the first time”); *id.* § 106 (outlining a copyright holder’s exclusive rights).

69. See *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1004 (9th Cir. 2001). Copyright protection is not generally a defense to a publicity-rights claim. See MCCARTHY, *supra* note 42, § 11.61; *cf.* *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1183, 1186 (9th Cir. 2001) (noting that free speech rights prevailed over an actor’s publicity-rights claim notwithstanding the defendant’s failure to obtain consent for use of copyrighted photograph of the actor). Because name and likeness are not copyrightable, federal copyright law does not preempt state law publicity rights. See, e.g., *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 623–24 (6th Cir. 2000); *Wendt v. Host Int’l, Inc.*, 125 F.3d 806, 810 (9th Cir. 1997); *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 651 (1996); see also Madeline O’Connor, Comment, “*It’s a Little Known Fact*” That Copyright Law Is in Conflict with the Right of Publicity, 26 *TOURO L. REV.* 351 (2010) (discussing the preemption interplay between copyright law and publicity rights in the context of *Wendt*).

70. Jennifer Schuessler, *Broadway Just Got More Dangerous*, N.Y. TIMES (Aug. 26, 2012), http://www.nytimes.com/2012/08/27/theater/forbidden-broadway-alive-kicking-shaping-a-spoof.html?_r=1&adxnnl=1&pagewanted=all&adxnnlx=1346852505-KcvubO0p9Fco3fdpFS5iHw [http://perma.cc/DXP2-NTA7].

over who has a more authentic claim to the role of Anita in Leonard Bernstein and Stephen Sondheim's *West Side Story*.⁷¹ Evaluated under the First Amendment-based transformative use test, "Chita and Rita" would almost certainly be exempt from publicity-claim liability because, without question, it "adds something new, with a further purpose or different character"⁷² through its creative and satirical comment, particularly when compared to the raw underlying personalities targeted by the depiction.⁷³ By contrast, the leading copyright law treatise, *Nimmer on Copyright*, opines that, had Shakespeare's *Romeo and Juliet* not reverted to the public domain, *West Side Story* itself could have been adjudged "substantially similar" to the canonic work on which it was based under the "pattern test" for copyright infringement.⁷⁴

Closer examination and comparison of legal doctrines reveal a primary source of this legal asymmetry arises from differing standards for asserting speech-based affirmative defenses to copyright infringement and publicity-claim liability. The copyright fair use doctrine, an equitable doctrine with notoriously wide give,⁷⁵ generally imposes a heavier burden on alleged copyright infringers asserting fair use as an affirmative defense than the Constitution imposes on publicity-claim defendants asserting an affirmative defense of First Amendment free speech. The differing standards for establishing speech-based or speech-related liability exemptions create legal asymmetry by making it easier for a defendant to override a personality's publicity rights than an author's copyright.

Under copyright law, affirmative defenses based on First Amendment speech rights generally are subsumed under the statutory speech protections built into the copyright fair use doctrine; thus, copyright-infringement defendants largely are limited to asserting the copyright fair use doctrine because courts generally reject direct invocation of the First Amendment as

71. See Dorothy Kiara, *Dorothy Kiara & Christine Pedi—Chita & Rita*, YOUTUBE (Apr. 5, 2014), https://www.youtube.com/watch?v=ycAVkas_qoc [<https://perma.cc/RVL9-YN2V>]. Note that the *Forbidden Broadway* depiction portrays Rivera and Moreno acting as Rivera and Moreno, not as the character, Anita. See *id.* Rivera originated the role on the Broadway stage in 1957, while Moreno starred as Anita in the 1961 motion picture. *West Side Story*, INTERNET BROADWAY DATABASE, <http://www.ibdb.com/Production/View/2639> (last visited Apr. 29, 2016) (Broadway) [<https://perma.cc/UQ2S-27XA>]; *West Side Story: Full Cast and Crew*, IMDB, http://www.imdb.com/title/tt0055614/fullcredits?ref_=tt_ov_st_sm (last visited Apr. 29, 2016) (film) [<https://perma.cc/CW6B-8LUP>].

72. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001).

73. Cf. *Nurmi v. Peterson*, No. 88-CV-5436 (WMB), 1989 U.S. Dist. LEXIS 9765, at *7 (C.D. Cal. Mar. 31, 1989) (dismissing publicity claim asserted against Cassandra Peterson, who portrayed Elvira, a darkly dressed horror movie hostess, allegedly created to look exactly like Vampira, the plaintiff's character from the 1950s); *Guglielmi v. Spelling-Goldberg Prods.*, 603 P.2d 454, 460 (Cal. 1979) (Bird, C.J., concurring) ("The right of publicity derived from public prominence does not confer a shield to ward off caricature, parody and satire. Rather, prominence invites creative comment.").

74. 4-13 NIMMER ON COPYRIGHT § 13.03 (2015).

75. See, e.g., *Iowa State Univ. Research Found., Inc. v. Am. Broad. Cos.*, 621 F.2d 57, 62 (2d Cir. 1980) (noting that "the fair use doctrine 'is entirely equitable'" (quoting *Time Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 144 (S.D.N.Y. 1968))).

an affirmative defense to copyright infringement.⁷⁶ By contrast, under state-law rights of publicity, a speech-based affirmative defense asserting exemption for transformative use of a personality's name or likeness arises directly under the First Amendment because there is no statutory affirmative defense comparable to the copyright fair use statute.⁷⁷ This difference between the affirmative defenses is significant because the First Amendment, when asserted in defense of a publicity-rights claim, tends to provide a broader scope of speech protection than the copyright fair use defense against copyright infringement.

The comparably narrower copyright fair use defense derives its narrowness, at least in part, from categorical limitations on fair use enumerated by six illustrations in the statutory preamble: "for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research."⁷⁸ Courts have interpreted the preamble's illustrations as categorical examples that, while neither exclusive nor exhaustive of potential fair use applications, require an alleged infringer to show that the challenged use bears at least nontrivial similarity of purpose.⁷⁹ In comparison, under the right of publicity, the First Amendment-based affirmative defense is categorically broader than the copyright fair use doctrine because the First Amendment shields from liability nearly all but "core" commercial speech—that is, speech which does nothing more than propose a commercial transaction.⁸⁰ Thus, to invoke the First Amendment as a defense to publicity-claim liability, the defendant need not establish that the challenged use meets or is similar to one of the statutorily enumerated copyright fair use illustrations (e.g., criticism, comment, news reporting, etc.). Rather, and more simply, the defendant need only show that the challenged use is transformative and does not implicate the narrow category of core commercial speech, specially interpreted under the First Amendment speech doctrine.⁸¹ Stated otherwise, it is easier for a publicity-claim defendant to avoid liability by proving that the challenged depiction is more than a bare invitation to a commercial transaction than it is for a copyright infringement defendant to avoid liability by proving that the challenged secondary use meets or is

76. *See* *Roy Exp. Co. Establishment of Vaduz, Liech. v. Columbia Broad. Sys., Inc.*, 672 F.2d 1095, 1100 (2d Cir. 1982) (restating "the general rule that '[c]onflicts between interests protected by the [F]irst [A]mendment and the copyright laws thus far have been resolved by application of the fair use doctrine'" (quoting *Wainwright Sec., Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91, 95 (2d Cir. 1977))).

77. *See* *Davis v. Elec. Arts, Inc.*, 775 F.3d 1172, 1177 (9th Cir. 2015) (describing the transformative use test as a balancing test between the First Amendment and the right of publicity).

78. 17 U.S.C. § 107 (2012).

79. *See* *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70, 78 (2d Cir. 1997) (noting "that the District Court gave no explicit consideration to whether the defendants' use was within any of the categories that the preamble to section 107 identifies as illustrative of a fair use, or even whether it was similar to such categories").

80. *See* *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 422 (1993); *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 563 (1980).

81. *See* *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (9th Cir. 2001).

equivalent to one of the statutorily enumerated purposes, such as news reporting.

To better isolate the subtle but significant distinction between these speech-based affirmative defenses, a contrast that may be more readily discernable in application than recitation, consider the following two counterpoised examples that illustrate differences in the categorical breadth of liability exemptions and resulting outcomes under the two standards.

- (1) Copyright fair use defense—*Roy Export Co. v. CBS*⁸²: In a 1977 public broadcast, the national CBS network televised a biographical film retrospective shortly after the death of legendary screen actor Charlie Chaplin.⁸³ The retrospective contained unlicensed copyrighted excerpts from Chaplin’s films, and, when sued for infringement by the films’ copyright holders, CBS argued that the First Amendment protected its unauthorized use for the exempt purpose of news reporting.⁸⁴ The Second Circuit, affirming the jury’s verdict of copyright infringement against CBS, held that the First Amendment’s protection for unauthorized use of copyrighted work is limited to the fair use doctrine, and, because CBS could not prove that its use of the film excerpts was necessary for the purpose of news reporting, its commercial broadcast incorporating the copyrighted excerpts did not constitute fair use.⁸⁵
- (2) First Amendment publicity rights defense—*Mitchell v. Cartoon Network*⁸⁶: In 2015, Billy Mitchell, a personality well-known in video gaming communities, brought a publicity rights claim against Cartoon Network, a basic cable television network, for its depiction of an animated character resembling Mitchell in a commercially broadcast televised cartoon featuring a scene involving a video game contest.⁸⁷ Invoking the First Amendment directly as an affirmative defense, Cartoon Network argued that its depiction was sufficiently transformative to avoid liability under Mitchell’s publicity-right claim.⁸⁸ The federal district court in New Jersey granted Cartoon Network’s motion to dismiss, observing that “[t]he First Amendment protects freedom of expression in entertainment”⁸⁹ and that, as a matter of law, the animated depiction was sufficiently transformative for the First Amendment to override Mitchell’s state-law publicity-rights claim.⁹⁰

Comparison of these cases brings into sharper relief differences in the categorical scope of the more restrictive copyright fair use affirmative defense and the broader First Amendment affirmative defense to publicity

82. 672 F.2d 1095 (2d Cir. 1982).

83. *Id.* at 1098.

84. *Id.*

85. *Id.*

86. Civ. No. 15-5668, 2015 U.S. Dist. LEXIS 157737, at *1 (D.N.J. Nov. 20, 2015).

87. *Id.* at *2–3.

88. *Id.* at *7.

89. *Id.* at *9.

90. *Id.* at *18.

claim liability. In *Roy Export Co.*, the court expressly limited CBS's defense to the copyright fair use doctrine—not the broader First Amendment speech protection—affirming the jury verdict imposing copyright infringement liability, because CBS failed to establish that its use resided within the fair use exemption category of news reporting.⁹¹ Notably, the Second Circuit concluded that CBS had failed to establish its claimed categorical fair use exemption (news reporting) without reaching an analysis of the copyright fair use balancing test factors, thus demonstrating the significance of the statutory preamble's enumeration of fair use illustrations.⁹² In *Mitchell*, by contrast, the Cartoon Network successfully asserted a First Amendment defense to publicity-claim liability where the unauthorized depiction of the plaintiff's identity was used for the purpose of commercial entertainment.⁹³ This challenged use would seem, at least arguably if not actually, beyond the more restrictive parameters of the six copyright fair use exemption illustrations enumerated in § 107's statutory preamble.⁹⁴

A further asymmetry revealed upon comparison of the speech-based affirmative defenses is a difference in the degree of weight attributed by courts to the individual balancing factors used to evaluate liability-exemption claims. Most notably, the defenses differ in the degree of weight attributed to the challenged use's economic impact on the market for the infringed right. Under the copyright fair use doctrine, the fourth fair use factor requires consideration of “the effect of the use upon the potential market for or value of the copyrighted work.”⁹⁵ Courts have given substantial weight to this factor in the copyright fair use balancing test. Indeed, in a recent copyright opinion, the Seventh Circuit described this consideration of economic and market effects as “usually” the “most important” fair use factor and explained that when a challenged use serves as a market substitute for the copyrighted work, the factor weighs strongly against a finding of fair use.⁹⁶

In the publicity-claim context, by contrast, courts applying First Amendment speech doctrine appear to attribute comparably less weight to the challenged depiction's impact on the market for or value of the asserted publicity right; instead, courts focus more heavily on the transformativeness

91. *Roy Exp. Co. v. CBS*, 672 F.2d 1095, 1099 (2d Cir. 1982) (“No Circuit that has considered the question, however, has ever held that the First Amendment provides a privilege in the copyright field distinct from the accommodation embodied in the ‘fair use’ doctrine.”).

92. *See id.* at 1100.

93. *See Mitchell*, 2015 U.S. Dist. LEXIS 157737, at *17.

94. *See* 17 U.S.C. § 107 (2012).

95. *Id.* § 107(4).

96. *Kienitz v. Sconnie Nation LLC*, 766 F.3d 756, 758 (7th Cir. 2014), *cert. denied*, 135 S. Ct. 1555 (2015); *see also Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 566 (1985) (stating that the secondary use's effect on the market for the copyrighted work “is undoubtedly the single most important element of fair use”); NIMMER, *supra* note 74, § 13.05 (“If one looks to the fair use cases, if not always to their stated rationale, [the economic effect on the copyrighted work] emerges as the most important, and indeed, central fair use factor.”).

of the secondary use in deciding whether to exempt the defendant from publicity-claim liability. For example, in *Comedy III Products*, although the California Supreme Court acknowledged that courts might occasionally consider the challenged depiction's market impact on the value of the publicity-rights holder's economic interests, it downplayed the factor by noting that economic considerations affecting the market for the asserted publicity right were relevant in only "particularly . . . close cases."⁹⁷ The *Comedy III Products* court observed that the presence of "significant transformative elements" generally tends to lessen the depiction's potential to interfere with the publicity holder's economic interests, but the court stopped short of adopting market impact as an essential factor in its balancing test.⁹⁸ In another example discussed above, *Hart v. Electronic Arts*,⁹⁹ the Third Circuit reversed the grant of summary judgment in favor of the defendant video game producer upon finding that the avatar depictions were insufficiently transformative—and not because the video game interfered with the economic value of the plaintiffs' names and likenesses otherwise protected under the right of publicity.¹⁰⁰

Thus, whereas the copyright fair use doctrine generally devotes substantial weight to evidence of economic interference or adverse market impact from the challenged use on the copyright holder's exclusive rights, courts applying the First Amendment (and transformative use test, in particular) in the publicity-rights context sometimes consider this factor but devote comparably lesser weight in balancing the factor against transformativeness.¹⁰¹ By weighing the economic impact factor differently under the two balancing tests, the transformative use test more readily exempts unauthorized persona depictions from publicity-claim liability than the copyright fair use doctrine exempts unauthorized uses of copyrighted work from infringement liability. To avoid liability, an unauthorized copyright user often will have to prove both transformativeness *and* a lack of market impact, whereas the unauthorized persona depicter will, in most circumstances, have to prove only transformativeness. This distinction between the speech-based affirmative defenses further contributes to the legal asymmetry favoring copyright holders over publicity-rights holders.

Another source of asymmetry arises from structural features within the modern marketplace for intellectual property that further widens this imbalance of treatment. During the twentieth century, the predominant

97. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001). In *Comedy III Products*, the California Supreme Court stated that "in determining whether a work is sufficiently transformative, courts may find useful a subsidiary inquiry, particularly in close cases: does the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted?" *Id.*

98. *Id.* at 808.

99. 717 F.3d 141 (3d Cir. 2013).

100. *Id.* at 165–70. The court did, however, note in passing that the lack of transformation added to the appeal of the video game to users by contributing to the realism of the game, thus allowing the defendant to capitalize more directly on the plaintiffs' likenesses. *Id.* at 168.

101. See *supra* notes 95–100 and accompanying text.

mode of copyright ownership shifted from individual authors and small publishers to the large corporate enterprises that now dominate and occupy a powerful “copyright industry.”¹⁰² By contrast, ownership of publicity rights for living individuals, by and large (although not exclusively¹⁰³), has been retained by individual publicity-rights holders themselves. In the absence of empirical data suggesting otherwise, one would expect corporate ownership of publicity rights to be rare for living personalities because it is difficult, if not impossible, for a corporate owner, post-acquisition, to protect the long-term value of a celebrity’s publicity rights.¹⁰⁴ A celebrity’s sale of publicity rights to a corporate owner, depending on the terms of sale, should tend to weaken the celebrity’s incentive to maximize the commercial value of her persona. Worse yet, the sale of publicity rights also allows the celebrity to externalize the cost of behaving in a manner that diminishes or eliminates commercial demand for the acquired persona (see, for example, Tiger Woods).¹⁰⁵ By way of anecdotal observation consistent with this hypothesis, it is unsurprising that a review of the client roster of CMG Worldwide, one of the largest corporate owners of publicity rights, reveals that CMG manages the vast majority of its publicity rights portfolio on behalf of, or acquired from, estates of deceased celebrities; only a small handful of CMG’s clients are alive, let alone “available for personal appearances.”¹⁰⁶

Diverging ownership trends in the copyright and publicity-rights settings are salient because these differences in modes of ownership may asymmetrically affect a copyright holder’s willingness to assume litigation and liability risk from a publicity claim as compared to a celebrity’s willingness to assume litigation and liability risk from a copyright infringement claim. Admittedly, the individuals most likely to assert a publicity claim are often celebrities who possess an enviable quantum of wealth and enjoy a comfortable station in life. But corporate conglomerate

102. See NETANEL, *supra* note 7, at 92–93 (“Today’s ‘copyright industries’—publishers, motion picture studios, and record labels—are, for the most part, large business concerns, typically under the roof of global media and entertainment conglomerates. Those copyright-supported commercial mass media enjoy an agenda-setting power rivaling that of public officials.”).

103. In *ETW Corp. v. Jireh Publishing, Inc.*, the court noted that “Plaintiff–Appellant ETW Corporation (‘ETW’) is the licensing agent of Eldrick ‘Tiger’ Woods (‘Woods’), one of the world’s most famous professional golfers. Woods, chairman of the board of ETW, has assigned to it the exclusive right to exploit his name, image, likeness, and signature, and all other publicity rights.” 332 F.3d 915, 918 (6th Cir. 2003). The corporate licensing of publicity rights by Tiger Woods, however, involves the transfer of rights to a corporate entity, but not a disinterested third party. ETW was a closely held corporation controlled by Tiger Woods, and, until 2009, Woods was its sole shareholder. See Jennifer E. Rothman, *The Inalienable Right of Publicity*, 101 GEO. L.J. 185, 221 n.172 (2012).

104. See Rothman, *supra* note 103, at 227.

105. See *id.* Tiger Woods, whose persona soared in commercial value at the height of his golfing career but was later beset by scandal involving his self-proclaimed “sex addiction,” exemplifies the risk inherent in acquiring publicity rights from living personalities. *Id.* at 221.

106. See *Clients*, CMG WORLDWIDE, http://www.cmgworldwide.com/clients/clientList/Printed_Client_List_Domestic.pdf (last visited Apr. 29, 2016) [<http://perma.cc/ZN9E-TY33>].

copyright holders are in most cases so vastly and comparatively richer in assets and economic power that the mere possibility of a copyright infringement suit against an individual celebrity, regardless of the potential viability of her fair use defense, is likely to have a chilling effect on experimental use of copyrighted work: one would expect the personality's fear of triggering cost-prohibitive, if not vexatious, litigation brought by a large corporate copyright owner might deter celebrities from using a copyrighted depiction of herself in reliance on the fair use doctrine. Holding constant the merits of any given copyright infringement or publicity claim, in a litigation war of attrition between an individual celebrity and a corporation, the outsized resources available to an aggressive corporate litigant often will pose an untenably expensive risk even for wealthy celebrities because the downside exposure of subjecting personal assets to litigation costs and a potential liability judgment may present too great a risk in return for the celebrity's attempted fair use of copyrighted work.

By contrast, corporate copyright owners, even though often sensitive to risk management concerns, are comparatively less likely to be deterred by the cost of asserting or defending litigation or incurring a potential liability judgment from an unauthorized celebrity depiction because of their disproportionately superior economic position. The limited liability protection for individual corporate managers arising from the corporate form should further diminish the risk sensitivity of corporate intellectual property owners. Unlike celebrities who generally sue and respond to lawsuits in an individual capacity, corporate managers who decide whether to initiate copyright litigation or whether to permit the corporation's unauthorized use of a celebrity depiction at the risk of publicity-claim liability generally do not make such decisions at the risk of exposing their own personal assets to the cost of litigation or a liability judgment.

Given this imbalance in the treatment of publicity-rights holders and copyright holders, Part II discusses whether the Constitution may provide a basis for tempering the asymmetry by providing greater protection for the speech and autonomy interests of publicity-rights holders to use their own depictions embodied in a copyrighted work owned by someone else.

II. CONSTITUTIONAL CONSIDERATIONS

This part examines two constitutional considerations implicated by the burden of copyright law on publicity-rights holders: (1) First Amendment principles and the tendency of copyright law to inhibit the publicity-rights holder's speech in relation to the copyrighted depiction; and (2) substantive due process principles and the burden imposed by copyright law on the publicity-rights holder's identity-based liberty interest in using the copyrighted depiction. Upon surveying these considerations, I conclude that, although there are compelling constitutional considerations favoring the publicity-rights holder, any path toward copyright reform in this context might best be achieved through legal principles that draw upon, but do not directly invoke, constitutional doctrine.

A. *Copyright Burden on the
Publicity-Rights Holder's Speech Interests*

An important line of scholarship has examined the extent to which publicity rights abridge the First Amendment right of authors seeking to use or incorporate celebrity personae in creative works of expression.¹⁰⁷ In this section, I consider the next (and inverse) iteration of this inquiry: Under what circumstances, if any, should the *personality's* First Amendment right to engage in speech about himself prevail over the author's interest in enforcing a copyright for a work (or portion of a work) depicting the personality's name or likeness?

For purposes of this inquiry, I accept as settled that the First Amendment cabins publicity rights by allowing authors to engage in creative works of expression incorporating a transformed use of the personality's name or image. I am not concerned here with questions about whether the First Amendment goes too far¹⁰⁸ or not far enough¹⁰⁹ in limiting the publicity-rights holder's ability to control or profit from transformative uses of his name or image. Rather, I limit my discussion to the personality's right, free from the specter of an injunction order and infringement liability, to engage in speech about his own persona as depicted in a copyrighted work. In other words, does the First Amendment permit a copyright holder to enjoin a personality from engaging in speech and expression about himself where the personality's name or likeness is embodied in the copyrighted work, and how, if at all, is the commercial nature of the personality's use of the copyrighted depiction relevant?

The First Amendment conflict between copyright and speech rights has concerned scholars for decades because the exclusionary rights conferred by copyright law necessarily curtail the speech rights of would-be infringers seeking to use a copyrighted work for speech-related purposes.¹¹⁰ In

107. See, e.g., Dougherty, *supra* note 65, at 7 (criticizing the right of publicity for lacking mechanisms to protect First Amendment values and for inadequately protecting speech by relying on transformativeness); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127, 134 (1993) (arguing that “publicity rights exact a higher cost in important competing values (notably, free expression and cultural pluralism) than has generally been appreciated”).

108. See, e.g., Roberta Rosenthal Kwall, *A Perspective on Human Dignity, the First Amendment, and the Right of Publicity*, 50 B.C. L. REV. 1345 (2009) (arguing that the right to self-expression and identity should prevail over the First Amendment right to appropriate a personality when injury is inflicted upon the dignity interests of the individual whose identity was appropriated).

109. See, e.g., Rebecca Tushnet, *A Mask That Eats into the Face: Images and the Right of Publicity*, 38 COLUM. J.L. & ARTS 157, 206 (2015) (arguing that the speech protection against publicity claim liability is too narrow and “allows the suppression of substantial amounts of non-advertising speech”).

110. As Professor Nimmer explained:

The [F]irst [A]mendment tells us that “Congress shall make no law . . . abridging the freedom of speech, or of the press.” Does not the Copyright Act fly directly in the face of that command? Is it not precisely a “law” made by Congress which abridges the “freedom of speech” and “of the press” in that it punishes expressions by speech and press when such expressions consist of the unauthorized use of material protected by copyright? But surely, many will conclude, the [F]irst

grappling with this tension, courts have construed copyright law's protection of authors who invest time and resources in developing creative work not as an end in itself, but as instrumental in promoting the public's enjoyment of creative labor.¹¹¹ This construct implicitly acknowledges that the method chosen by Congress for protecting the author's economic stake in creative labor has a speech-inhibiting effect of regulating expression by others (i.e., would-be infringers) seeking use of the copyrighted work without permission or payment.¹¹² As the scope, duration, and technological protection of copyright has grown dramatically since the enactment of the Copyright Act of 1976, scholars have become increasingly critical of the expansion of copyright law as overly burdensome of speech.¹¹³

Partially mitigating the tension between speech and copyright protection, the copyright fair use doctrine is considered a First Amendment safeguard because it permits limited use of copyrighted work without infringement liability.¹¹⁴ In theory, the fair use doctrine's transformative use test should protect the copier's freedom of expression by immunizing uses that creatively repurpose the original copyrighted work,¹¹⁵ but, in the conflict between publicity- and authorial-rights holders, the fair use doctrine does not live up to its promise as a free speech safeguard.

First, as noted above, it is more difficult to assert the affirmative defense of copyright fair use than the First Amendment defense, and copyright ownership now is dominated by a formidable copyright industry with vastly greater economic and market power compared to that of publicity-rights holders. An author is therefore more likely willing to rely on the transformative use test at the risk of infringing publicity rights than a publicity-rights holder is willing to rely on the fair use doctrine at the risk of infringing a copyright. The economic resources of large copyright owners render them more suitably situated to assume the risk and expense

[A]mendment does not apply to copyright infringers. Yet, is such a conclusion justified?

Nimmer, *supra* note 46, at 1181; *see also* Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 988 (1970).

111. *See, e.g.*, *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) ("The immediate effect of our copyright law is to secure a fair return for an 'author's' creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good. 'The sole interest of the United States and the primary object in conferring the monopoly,' this Court has said, 'lie in the general benefits derived by the public from the labors of authors.'" (quoting *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932))); *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 820 (9th Cir. 2003).

112. Interestingly, the right of publicity, rationalized on grounds similar to copyright law, itself has been criticized for imposing unreasonable burdens on speech interests and the public's interest in cultural pluralism and self-determination. *See, e.g.*, Madow, *supra* note 107; Tushnet, *supra* note 109.

113. *See, e.g.*, NETANEL, *supra* note 7, at 54–80 (cataloging and critiquing "copyright's ungainly expansion"); Benkler, *supra* note 7, at 446 (criticizing copyright's regulation of information); Rubinfeld, *supra* note 7, at 5 (arguing "that copyright's prohibition of unauthorized derivative works is unconstitutional").

114. *See, e.g.*, *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) (describing the fair use doctrine as a "built-in First Amendment accommodation[']").

115. *See, e.g.*, Leval, *supra* note 55, at 1111.

of protracted infringement litigation than publicity-rights holders. The net effect of differences in the affirmative defenses and the disparity of market power serves to facilitate copyright holders in making transformative uses of personality depictions, while deterring personalities from attempting transformative uses of copyrighted works containing their own depictions.

Second, the copyright fair use doctrine does not provide relief for most forms of *nontransformative* copying, even when such copying furthers legitimate First Amendment speech objectives. Professor Rebecca Tushnet, for example, convincingly argues that copyright law constrains important speech-enhancing forms of nontransformative copying that would otherwise advance First Amendment goals of self-expression, persuasion, and affirmation.¹¹⁶ Professor Tushnet's critique of copyright law argues against intellectual property constraints on the right to use copyrighted work when engaging in noncommercial acts of self-definition and participation in cultural phenomena embodied in a copyrighted work.¹¹⁷ For example, when individuals engage with copyrighted work by reciting poetry, performing a musical composition, or putting on a play, their engagement with the copyrighted work almost always involves nontransformative copying under the current fair use doctrine. However, the act of staging someone else's work can be fundamentally self-expressive through the reflection and manifestation of important qualities of the copier's personality.¹¹⁸ Nontransformative copying also can play an important role in allowing the speaker to use the words of someone else for the purpose of affirmation.¹¹⁹ Tushnet argues that the speech-enhancing value of nontransformative copying warrants broadening the fair use doctrine to permit certain forms of copying and an expansion of compulsory licensing of copyrighted work.¹²⁰

On this matter of nontransformative copying, by way of brief digression, I note that speech constraints imposed by copyright law may not be entirely inconsistent with the goal of promoting creative expression. In an interesting recent corollary to Professor Tushnet's theory favoring a more expansive right to copy, Professor Joseph Fishman argues that,

116. Tushnet, *supra* note 7, at 562–82.

117. *Id.* at 564.

118. *Id.* at 568–74 (“Symphony patrons debate the merits of one recording of the same piece over another because, although each copies the same musical work, the performances differ in ways both subtle and overt. Recordings can even spark political controversy: Peter Breiner’s 1994 arrangement of *The Star-Spangled Banner*, which was used at the Athens Olympics, has been interpreted as a ‘blue-state’ version of the anthem, full of ‘nuance’ and ‘local variation and possibility’ as compared to the traditional arrangements that emphasize ‘primary colors’ and more aggressive music. Musicians fill concert venues because fans enjoy live performances of the same musical works they can hear at home. Each new performance produces a different effect on the audience because each one represents the artist’s self-expression; the copy bears the unique marks of its copying.”).

119. *See id.* at 568 (“We would probably accept, for example, the proposition that all fifty-six signers of the Declaration of Independence adopted the words as their own—and it was thereby a more powerful document than a collection of fifty-six different explanations of the colonies’ plight.”).

120. *Id.* at 589.

“paradoxically,” restrictions on copying often yield *more* creativity, not less, because the copyright prohibition requires would-be copiers to innovate and engage in creative processes to avoid infringement.¹²¹ But Professor Fishman’s observations about the tendency of copyright constraints to spawn creative noninfringing uses may fall short of answering critics, like Tushnet, who contend that the First Amendment protects the right to engage in nontransformative uses of copyrighted work. On that point, Professor Fishman expressly demurs.¹²² Tushnet, for example, contends that copyright restrictions on nontransformative copying may result in distortion of the secondary user’s message rather than new creativity, thereby harming not only the speaker’s interest in free speech but also the audience for creative works.¹²³

Drawing on Professor Fishman’s model of the creative upside of copyright constraints, one might argue that the fair use doctrine already allows a personality to use a copyrighted depiction of himself, provided that he engages in further transformation of the depiction. But, in addition to the affirmative-defense differences and speech-chilling effects of the market power disparity noted above, the personality’s right to engage in transformative use of the copyrighted depiction does not address Professor Tushnet’s persuasive argument that the First Amendment should also protect *nontransformative* copying as inherently valuable self-expressive speech:

Copying can serve as self-expression, using the most apt words to explain and define beliefs and thoughts; it can assist persuasion, using the best words to reach a particular audience; and it can work as affirmation, a way of connecting to a larger group. Many uses serve more than one of those functions.¹²⁴

Thus, Tushnet argues that the First Amendment provides a basis for protecting self-expressive speech notwithstanding its nontransformative use of copyrighted work. She contends that nontransformative copying is necessary to preserve a level of free expression conducive to preserving a “democratic culture” in which “everyone will have the resources to

121. Joseph P. Fishman, *Creating Around Copyright*, 128 HARV. L. REV. 1333, 1336–37 (2015) (arguing that creativity “thrives best not under complete freedom, but rather under a moderate amount of restriction”).

122. *Id.* at 1335 n.4 (declining to address “the rights-based argument that the First Amendment entitles downstream creators the liberty to express themselves using elements of others’ copyrighted works”).

123. Professor Tushnet describes such an example:

For example, *Who Built America?* is an award-winning historical CD-ROM series for high school and college students that uses numerous primary sources. Owners of the sources’ copyrights often wanted large payments for use of historically significant works, payments the authors couldn’t afford. They substituted federal government and public domain works, altering the way students will understand the past; the materials now overemphasize the federal government’s role in Depression-era society and culture.

Tushnet, *supra* note 7, at 565–66.

124. *Id.* at 566–67.

participate in culture and the freedom to debate and disagree about meaning.”¹²⁵

Tushnet’s theory of nontransformative copying would seem to support an even stronger First Amendment case for protecting self-expressive speech where the copyrighted work contains a depiction of the would-be copyright infringer’s own identity. If we ascribe constitutional value to nontransformative copying for the purpose of self-expression, then, arguably, we should ascribe even greater constitutional value to the speaker’s use of his own depiction in a copyrighted work to engage in self-expression. To frame this assertion more concretely, if Professor Weisbord has a First Amendment right to copy or use the song “What Would Brian Boitano Do?” in self-expressive speech, then would Mr. Boitano not have a stronger claim to copy or use “What Would Brian Boitano Do?” in self-expressive speech about his own depiction? Given the song’s depiction, who would have greater authority or interest in discussing the meaning and cultural implications of “What Would Brian Boitano Do?” than Brian Boitano himself? The depicted personality’s free speech interest in using the copyrighted depiction would seem especially salient given the copyright holder’s right to seek injunctive relief as a remedy for copyright infringement because a court-ordered injunction against the personality’s use of his own depiction would create the constitutionally tenuous scenario of prohibiting the personality from engaging in speech about himself.¹²⁶

An identity-based First Amendment distinction, if accepted by courts, might provide support for allowing a personality to use a copyrighted depiction of himself while denying other persons a speech-based copyright exemption to use the depiction without a license. The scholarly literature contains occasional support for identity-based distinctions under the First Amendment. For example, Professor Edwin Baker argued that the First Amendment protects an identity-based autonomy interest in self-expression.¹²⁷ According to Professor Baker, the need to protect fundamental human values associated with speech implied a rationale for drawing an identity-based distinction between actual human beings, who have a direct individual interest in autonomy, and press-promoting institutional corporate entities that exercise speech rights instrumentally in service of free-press goals but not as a “direct human value.”¹²⁸ And indeed, there are contexts in which the First Amendment has been construed to permit distinctions based on the speaker’s identity. For example, under the Hatch Act, certain federal employees are prohibited

125. *Id.* at 539–40.

126. 17 U.S.C. § 502 (2012) (authorizing injunctive relief as a remedy for copyright infringement); *see also, e.g.*, *Worldwide Church of God v. Phila. Church of God, Inc.*, 227 F.3d 1110, 1119 (9th Cir. 2000) (“Even an author who had disavowed any intention to publish his work during his lifetime was entitled to protection of his copyright, first, because the relevant consideration was the ‘potential market’ and, second, because he has the right to change his mind.” (citing *Salinger v. Random House, Inc.*, 811 F.2d 90, 99 (2d Cir. 1987))).

127. C. Edwin Baker, *First Amendment Limits on Copyright*, 55 VAND. L. REV. 891, 897 (2002).

128. *Id.* at 898.

from engaging in political activities while on duty,¹²⁹ a prohibition the Supreme Court has upheld as constitutional.¹³⁰

Courts, however, have not fully embraced identity-based distinctions under the First Amendment.¹³¹ In *Citizens United v. FEC*,¹³² albeit in a different context, the Supreme Court held that First Amendment speech principles do not turn on the speaker's identity.¹³³ *Citizens United* does not directly address the particular speech interests at stake here, but a First Amendment analysis that would treat the personality differently from other potential speakers would seem at least inconsistent with the principle that "the Government may not suppress political speech on the basis of the speaker's corporate identity."¹³⁴

Assuming for the moment that there is a personal First Amendment interest in using one's own depiction in a copyrighted work, how, if at all, does the commercial use of the copyrighted depiction alter the equation? Some scholarship suggests that nontransformative uses of copyrighted work should be confined to noncommercial settings. For example, in Professor Jessica Litman's influential work on "personal use" exemptions from copyright enforcement,¹³⁵ she argues that "reading, listening, viewing, watching, playing, and using copyrighted works is at the core of the copyright system,"¹³⁶ so such uses should not trigger copyright enforcement mechanisms for infringement where the use is "private, noncommercial, or incidental [to other lawful uses]."¹³⁷ In contrast, she contends that "[p]ersonal uses that are public, that are commercial, or that compete with copyright owner exploitation seem like attractive candidates to bring within the realm of copyright owner control" because those uses tend to undermine the incentive for authors to engage in creative labor.¹³⁸ Tushnet, in her model of nontransformative copying, agrees with Litman in drawing a distinction between commercial and noncommercial uses.¹³⁹ These proposed limitations on fair use of copyrighted work for commercial

129. See 5 U.S.C. § 7324 (2012).

130. See *United Pub. Workers of Am. (C.I.O.) v. Mitchell*, 330 U.S. 75, 103 (1947).

131. See Jennifer E. Rothman, *Liberating Copyright: Thinking Beyond Free Speech*, 95 CORNELL L. REV. 463, 469 (2010) ("One possible reason for this failure [of courts to recognize identity-based distinctions] is that the broad claim of a general right to self-expression does not provide a basis for distinguishing or limiting uses, making use claims more easily dismissed.").

132. 558 U.S. 310 (2010).

133. *Id.* at 365.

134. *Id.*

135. See Jessica Litman, *Lawful Personal Use*, 85 TEX. L. REV. 1871, 1879 (2007) (arguing that copyright law is too protective of authorial rights because it fails to properly account for and allow personal use of copyrighted work).

136. *Id.*

137. *Id.* at 1918.

138. *Id.*

139. Tushnet, *supra* note 7, at 587 (noting that "the law might exempt noncommercial or at least small-scale noncommercial copying (private use) along with transformative uses").

purposes are consistent with the doctrine's general preference for noncommercial and nonprofit uses.¹⁴⁰

A categorical limitation prohibiting commercial secondary usage, however, is not required under the current fair use standard. The Supreme Court considered and expressly rejected the contention that commerciality, standing alone, should be entitled to a presumptive finding against fair use because most instances of copyright fair use, including most of the enumerated illustrations in § 107's statutory preamble, involve profit-seeking activities.¹⁴¹ Rather, courts apply the doctrine's preference against commercial use dynamically by weighing commerciality against other factors, in particular, the transformative nature of the challenged use.¹⁴² Courts often balance the degree of transformativeness against commerciality because the unauthorized commercial sale of copyrighted material, devoid of any showing of transformation, begins to resemble outright theft of intellectual property for which the copyright holder has a legal right to demand a price.¹⁴³ Indeed, an overly broad interpretation of fair use to permit reproduction of copyrighted work for the pure purpose of commercial exploitation would undermine the entire premise of copyright protection.

Here, it may be possible to interpret the current fair use doctrine in a way that accommodates a First Amendment interest in nontransformative copying even where the copyrighted material is used for a commercial purpose. Such an interpretation might give greater weight and salience to the second fair use factor, "the nature of the copyrighted work,"¹⁴⁴ to offset the publicity-rights holder's commercial use of the copyrighted depiction. When the First Amendment curtails publicity claims to protect the author's freedom of expression, it does so notwithstanding the author's right to sell

140. *See, e.g.*, 17 U.S.C. §§ 107(1), (4) (2012); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) ("[T]he more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.").

141. *Campbell*, 510 U.S. at 584 ("If, indeed, commerciality carried presumptive force against a finding of fairness, the presumption would swallow nearly all of the illustrative uses listed in the preamble paragraph of § 107, including news reporting, comment, criticism, teaching, scholarship, and research, since these activities 'are generally conducted for profit in this country.'" (quoting *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 592 (1985) (Brennan, J., dissenting))).

142. *See, e.g.*, *Cariou v. Prince*, 714 F.3d 694, 708 (2d Cir. 2013) ("[T]he more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.' Although there is no question that Prince's artworks are commercial, we do not place much significance on that fact due to the transformative nature of the work." (quoting *Campbell*, 510 U.S. at 584)).

143. *Cf. Harper & Row Publishers, Inc.*, 471 U.S. at 562 ("The crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price."); *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 922 (2d Cir. 1994) ("[C]ourts will not sustain a claimed defense of fair use when the secondary use can fairly be characterized as a form of 'commercial exploitation,' i.e., when the copier directly and exclusively acquires conspicuous financial rewards from its use of the copyrighted material.").

144. 17 U.S.C. § 107(2).

for profit the work containing the personality's unauthorized depiction.¹⁴⁵ If, under Tushnet's framework, the First Amendment should be construed to protect the personality's self-expressive right to engage in nontransformative copying of his own depiction in a copyrighted work, why should the personality's use of the copyrighted depiction be limited to private noncommercial settings when the author's creation of the work depicting the persona was not similarly limited? If there is a First Amendment basis for protecting the speech-enhancing benefits generated by the personality's nontransformative use of his own depiction in a copyrighted work, then it would seem constitutionally anomalous (or, at least inconsistent) to deny those speech-enhancing benefits simply because the personality's nontransformative use might return a profit.

There may be compelling speech-based justifications for protecting the right of personalities to use their own depiction in a copyrighted work, but as a practical matter, prospects appear inauspicious for convincing courts that the First Amendment requires a special copyright exemption in this context. Although the Supreme Court rejected the notion that copyright law is categorically immune from First Amendment scrutiny in a recent First Amendment challenge to statutory extension of the copyright term,¹⁴⁶ Professor Neil Netanel observes that "the [Supreme] Court [has] almost entirely closed the door on further First Amendment challenges to traditional copyright law."¹⁴⁷ Writing for a 7-2 majority in *Eldred v. Ashcroft*,¹⁴⁸ Justice Ginsburg observed, "The First Amendment securely protects the freedom to make—or decline to make—one's own speech; it bears less heavily when speakers assert the right to make other people's speeches."¹⁴⁹ In summarizing the First Amendment jurisprudence in this area, Professor Jennifer Rothman identifies three synthesizing reasons for why courts generally have declined to construe the First Amendment as a defense to copyright enforcement: First, the constitutional speech protection is not absolute and is therefore subject to numerous exceptions, copyright among them.¹⁵⁰ Second, copyright law both embodies speech-protective features and, as an engine of free expression, furthers First Amendment objectives.¹⁵¹ Third, courts tend to view copyright piracy as misappropriation rather than a form of self-expression.¹⁵²

On balance, therefore, although the publicity-rights holder's interest in using a copyrighted depiction of himself implicates important and legitimate speech interests that warrant protection, it does not appear that

145. See, e.g., *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952) ("That books, newspapers, and magazines are published and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment.").

146. See generally *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

147. NETANEL, *supra* note 7, at 172.

148. 537 U.S. 186 (2003).

149. *Id.* at 221.

150. See Rothman, *supra* note 131, at 480–81.

151. See *id.* at 484.

152. See *id.* at 485.

the First Amendment itself would provide the most suitable source of law on which to base recognition of such a right.

*B. Copyright Burden on the
Publicity-Rights Holder's Liberty Interests*

The Supreme Court has interpreted the Constitution to protect, implicitly, certain dignity and autonomy interests in defining one's personal identity as a matter of substantive due process.¹⁵³ This section considers whether this liberty interest should be extended to protect the innately human need for individual autonomy and dignity associated with controlling one's own identity as depicted in a copyrighted work. Ultimately, however, while intrigued by recent scholarship in this area, I conclude that treating the publicity-rights holder's copyright exemption as a fundamental right for purposes of substantive due process would attempt to stretch constitutional doctrine protecting liberty interests beyond the realm of judicial credulity.

In Rothman's recent work in this area, she argues that, because First Amendment challenges to the overbreadth of copyright law have been largely unsuccessful, courts should consider grounding an exemption for "[i]dentity-based uses of copyrighted works . . . integral to constructing personal identity" in the Fifth and Fourteenth Amendment protection of liberty and substantive due process.¹⁵⁴ According to Rothman, "[A] liberty analysis demonstrates that one should have a right to use someone else's copyrighted work to engage with one's own-lived experiences"¹⁵⁵ because "[t]he zones of rights considered fundamental in a substantive due process analysis center on issues of identity and personhood."¹⁵⁶ As Rothman explains:

Identity at its heart revolves around our sense of self and our ability to define and situate ourselves in the world around us—it includes our understanding of ourselves both individually and in the context of the broader sociocultural groups to which we belong. At a minimum, our identity is composed of our life history, important life-changing or psychologically altering experiences, and our beliefs and values. Each

153. See *Obergefell v. Hodges*, 135 S. Ct. 2584, 2598 (2015) (finding that substantive due process protects "liberties extend[ing] to certain personal choices central to individual dignity and autonomy, including intimate choices that define personal identity and beliefs"); *Lawrence v. Texas*, 539 U.S. 558, 574 (2003) ("[O]ur laws and tradition afford constitutional protection to personal decisions relating to marriage, procreation, contraception, family relationships, child rearing, and education."); *Planned Parenthood of Se. Pa. v. Casey*, 505 U.S. 833, 851 (1992) ("At the heart of liberty is the right to define one's own concept of existence, of meaning, of the universe, and of the mystery of human life."); *Griswold v. Connecticut*, 381 U.S. 479, 484 (1965) (observing that the Bill of Rights contains penumbras that form a zone of privacy).

154. Rothman, *supra* note 131, at 465. Consistent with her position on the identity-based liberty interest in using copyrighted work, Professor Rothman argues elsewhere that the right of publicity is also identity based and should therefore not be freely alienable. See generally Rothman, *supra* note 103.

155. Rothman, *supra* note 131, at 475.

156. *Id.* at 495.

person's life, both past and present, is not only intertwined with copyrighted materials but *constructed* with these copyrighted works.

....
Our memories, life experiences, and cultural and religious ties are often bound up with copyrighted works.¹⁵⁷

Rothman argues that when an individual forms or perceives a deep connection to a copyrighted work, the law should recognize the individual's right to "inhabit" the work free from infringement liability:

Each of us interacts with and "inhabits" copyrighted works. Sometimes a story that we read is affecting, . . . and sometimes that story becomes so interwoven with our own lives that it is difficult to describe or engage with our own lives without reference to that story. . . . When copyrighted works enter an individual's world they sometimes become so intertwined with that person's identity that to deny the use of that work would seriously impair that person's ability to control her own "destiny."

....
Copyrighted works play a crucial constitutive role in constructing our identities, and the degree of our personal entanglements with such works should determine how much latitude we should have to use those works.¹⁵⁸

Under Rothman's creative and innovative proposal, substantive due process would require an exemption from copyright enforcement whenever the secondary use implicates the user's right to mental integrity, intimate relations, connection to a cultural or linguistic artifact, or right to practice religion.¹⁵⁹ Rothman describes several applications of her theory, one of which involves a celebrity's identity-based liberty interest in blogging about and posting a copyrighted photograph of herself without a license from the photograph's copyright holder.¹⁶⁰

A liberty interest in this context might also find support in a related line of scholarship advocating for a "personhood" theory of property, in which

157. *Id.* at 496–98.

158. *Id.* at 498–500.

159. *Id.* at 514–28.

160. Professor Rothman explains:

Consider Samantha Ronson's posting to her MySpace page of the photograph of her and her girlfriend kissing at a party. Ronson violated the photographer's copyright by posting the picture to her MySpace page if she did so without permission. Neither the fair use doctrine nor the First Amendment provides Ronson a dependable defense, but a liberty-interest approach establishes Ronson's right to post a picture documenting her own life on her own webpage even if she was not the one who took the photograph. This is true in part for the reasons set forth [earlier]—Ronson's mental integrity demands her ability to accurately describe her experiences (in this case both that she was at the event and that a photograph was taken of her, a fact that she might wish to comment on for its intrusiveness into a personal moment). The photograph is also intimacy promoting—she may have posted it to show her then-girlfriend Lindsey Lohan how important she was to Ronson, how important the moment itself was, or perhaps to share her affection for Lohan with her friends. Such intimacy-driven uses of copyrighted works deserve robust constitutional protection from infringement actions.

Id. at 521–22.

proponents argue that the law should recognize a person's constitutive need to establish connections to the external world in which the person lives.¹⁶¹ This scholarship invokes the philosophical work of Hegel, who observed that the need for actualization of the individual implies a right of persons to exercise control over material objects in his external world.¹⁶² Professor John Tehranian explains:

Formation of personhood takes place internally as an individual's identity is shaped through interaction with objects in the external world. Meanwhile, the expression of personhood occurs when the individual communicates some aspect of her (already formed) identity to others as a way of contextualizing herself, through her relationship with objects, within the broader community.

Individual consumption of property therefore serves as a powerful tool for both identity formation and expression.¹⁶³

Tehranian cites this strand of philosophy to critique the growing role of copyright law in regulating private use and possession of intellectual property, and copyrighted material in particular.¹⁶⁴ He argues further that expansion of copyright protection adversely affects "the formation and expression of cultural and nationalistic identities."¹⁶⁵ If, under the personhood theory of property, a person is deemed to acquire property interests by consuming and appropriating elements of intellectual property with which he personally identifies, then it seems to follow that such an interest would be most salient with respect to the use of intellectual property that appropriates the individual's own identity.

Recognition of a substantive due process right to control one's own identity and personhood likely would have met the approval of Professor Bloustein who, as noted in Part I.A, argued that privacy is an essential aspect of human dignity and requires that a person retain the right to decide when, and at what price, to abandon it.¹⁶⁶ Under this rationale, depriving a person of the right to decide when and under what conditions to abandon

161. See Margaret Jane Radin, *Property and Personhood*, 34 STAN. L. REV. 957, 960 (1982) ("Once we admit that a person can be bound up with an external 'thing' in some constitutive sense, we can argue that by virtue of this connection the person should be accorded broad liberty with respect to control over that 'thing.'").

162. GEORG WILHELM FRIEDRICH HEGEL, *PHILOSOPHY OF RIGHT* ¶ 44, at 41 (T.M. Knox trans., Clarendon Press 1952) (1821) ("A person has as his substantive end the right of putting his will into any and every thing and thereby making it his, because it has no such end in itself and derives its destiny and soul from his will. This is the absolute right of appropriation which man has over all 'things.'").

163. John Tehranian, *Parchment, Pixels, & Personhood: User Rights and the IP (Identity Politics) of IP (Intellectual Property)*, 82 U. COLO. L. REV. 1, 23 (2011).

164. See *id.*

165. *Id.* at 83. Professor Tehranian notes that his proposals for copyright reform, based on the personhood theory of property, are confined to the four corners of copyright law and do not rely on a constitutional basis for copyright exemption. *Id.* at 19.

166. Bloustein, *supra* note 35, at 989 ("[A person's] name and likeness can only begin to command a commercial price in a society which recognizes that there is a right to privacy, a right to control the conditions under which name and likeness may be used. Property becomes a commodity subject to be bought and sold only where the community will enforce an individual's right to maintain use and possession of it as against the world.").

privacy would represent an involuntary commodification of the person's identity, an outcome inconsistent with respect for human dignity. Bloustein explained:

Every man has a right to prevent the commercial exploitation of his personality, not because of its commercial worth, but because it would be demeaning to human dignity to fail to enforce such a right.

....
As I view the matter, using a person's name or likeness for a commercial purpose without consent is a wrongful exercise of dominion over another even though there is no subjective sense of having been wronged, even, in fact, if the wrong was subjectively appreciated, and even though a commercial profit might accrue as a result. This is so because the wrong involved is the objective diminution of personal freedom rather than the infliction of personal suffering or the misappropriation of property.¹⁶⁷

For these reasons, Bloustein recharacterized the right of publicity as a limited right "to command a commercial price for abandoning privacy."¹⁶⁸ Echoing Professor Bloustein's call for respecting human dignity, Professor Daniel Solove more recently characterized the appropriation of one's persona without consent as "exploitation."¹⁶⁹ These arguments, however, apart from suggesting a copyright exemption on substantive due process grounds, might instead augur for lesser First Amendment protection for an author's unauthorized use of a personality's name and likeness.¹⁷⁰

167. *Id.* at 989–90.

168. *Id.* at 989.

169. Daniel J. Solove, *A Taxonomy of Privacy*, 154 U. PA. L. REV. 477, 549 (2006). Professor Solove explains:

The interest safeguarded by protections against appropriation is control of the way one presents oneself to society. The products and causes people publicly endorse shape their public image. When people are associated with products, they become known in terms of these products. Many public figures take great care with their endorsements because these endorsements shape their public image. Thus, appropriation can be harmful even if it is not humiliating, degrading, or disrespectful. Being unwillingly used to endorse a product resembles, in certain respects, being compelled to speak and to represent certain viewpoints.

Protection against appropriation establishes what society considers appropriate for others to do in shaping a person's identity. The harm, then, is an impingement on the victim's freedom in the authorship of her self-narrative, not merely her loss of profits.

Id. at 548–49.

170. In resituating publicity rights within the framework of liberty and privacy, comparative law considerations might offer helpful guidance. In Germany, for example, where the history of Nazi subjugation of individuality, self-determination, and autonomy greatly influenced its post-World War II legal system, the German Basic Law explicitly protects human dignity interests, including respect for individuals as independent personalities. See Paul M. Schwartz & Karl-Nikolaus Peifer, *Prosser's Privacy and the German Right of Personality: Are Four Privacy Torts Better than One Unitary Concept?*, 98 CAL. L. REV. 1925, 1948 (2010). The extension of these dignity-based principles in Germany has led to a different formulation of protection for publicity rights compared to the protections offered by American law. On the one hand, Germany recognizes a far broader newsworthy exception to publicity rights, which, as a result, facilitates broader commercial use of celebrity depictions. *Id.* at 1971. On the other hand, in contexts where the newsworthy exception does not apply, German law is generally more protective of publicity rights on privacy grounds. *Id.* at 1974 ("Nonetheless, even celebrities in Germany can enjoy

While a theory of identity-based substantive due process rights is intriguing, and, in the abstract, the idea that individuals might have a liberty or autonomy interest in constructing their own identities through the use of copyrighted depictions of themselves is appealing, I have reservations about the potentially unwieldy breadth of such a broad framework for copyright exemption. Rothman, herself, has noted this concern.¹⁷¹ My particular reservations are two-fold: First, the Supreme Court is less likely to recognize a substantive due process right in the absence of evidence that the right in question is “deeply rooted in this Nation’s history and tradition.”¹⁷² Although Rothman points out that copyright law is, itself, founded on a constitutional provision predating the First Amendment, a liberty interest in using copyrighted work as expansively as she posits likely will encounter judicial skepticism.¹⁷³ At bottom, a right to inhabit copyrighted work based on one’s personal connection to the work would not appear to rise in stature or importance to other fundamental rights recognized by the Supreme Court, such as same-sex marriage, abortion, or contraception.

Second, in perhaps a more basic critique of this theory, a framework for copyright exemption based on the user’s self-proclaimed assertion about his personal connection to the copyrighted work seems to lack a governable limiting principle. Rothman acknowledges that “[c]ourts will need to carefully evaluate the facts of a specific case to confirm that a defendant is not pretending to attach some important personal meaning when there is none,” though she also argues that “[s]uch determinations of motive are made elsewhere in IP cases and throughout the law, and there is no reason to think they will be any more difficult to make in the context of copyright

the protection of privacy in a public place when there is no newsworthy interest in describing or photographing the situation and there is a justifiable expectation of being free from observation.”). Interestingly, under the doctrine of Markenverunglimpfung, German law even protects the “personality rights” of corporate firms from the disparaging misappropriation of commercial logos and slogans. *See* Whitman, *supra* note 29, at 1210. Paralleling the modern German view of publicity rights, Professor Alice Haemmerli observes that Kantian principles also fashion the right of publicity as a “property right grounded in human autonomy.” Alice Haemmerli, *Whose Who? The Case for a Kantian Right of Publicity*, 49 DUKE L.J. 383, 385 (1999).

171. Rothman, *supra* note 131, at 474 (“I am also concerned that any broad exclusion for private, noncommercial copying would significantly damage many major commercial markets given that uses of copyrighted works are increasingly made in private spaces, such as in homes and dorm rooms, albeit over the arguably public medium of the Internet.”).

172. *Washington v. Glucksberg*, 521 U.S. 702, 721 (1997) (quoting *Moore v. City of E. Cleveland*, 431 U.S. 494, 503 (1977)); *id.* at 728 (finding that the purported right to assisted suicide is not protected by substantive due process, while noting that “[t]he history of the law’s treatment of assisted suicide . . . has been and continues to be one of the rejection of nearly all efforts to permit it”); *cf.* *Obergefell v. Hodges*, 135 S. Ct. 2584, 2598–99 (2015) (finding that the right to marry is fundamental under the Due Process Clause, while noting that “the Court has long held the right to marry is protected by the Constitution”).

173. *See, e.g.,* Tehranian, *supra* note 163, at 19–21 (“[I]t is entirely possible (and even likely) that the judiciary would reject arguments that user rights to copyrighted property are deeply rooted in our country’s history and tradition[] and involve fundamental liberty interests on the same grand scale as choices involving abortion, contraception, sexual conduct, medical treatment, child rearing, and marriage.”).

cases.”¹⁷⁴ Those determinations elsewhere in intellectual property law, however, are based on a binary inquiry into whether the defendant acted in good or bad faith.¹⁷⁵ It would seem that a test requiring courts to assess qualitatively the veracity of a defendant’s representations—knowable only by the defendant—about his association between a copyrighted work and his sentiments about his own mental integrity, intimacy, culture, or religion would pose substantial, if not insurmountable, adjudicatory challenges.

The need for a more governable limiting principle might imply that an identity-based copyright exemption could be limited to circumstances in which there is an objective manifestation of the identity-based connection, perhaps on the face of the copyrighted work itself. Rather than relying on the defendant’s nearly unverifiable assertions about his identity-based use, the defendant could be required to establish objective proof of his connection to the copyrighted work. One way of satisfying such an objective test might be to show that the user’s identity is depicted in the copyrighted work, thereby establishing a more reliable basis on which to protect a liberty interest in interacting with and inhabiting a copyrighted work. But even this form of objective test tenuously presupposes the willingness of courts to recognize the underlying liberty interest in using copyrighted work as a fundamental right.

C. *Lack of Constitutional Mandate and the Doctrine of Constitutional Avoidance*

I appreciate the constitutional dimensions implicated by a personality’s use of a copyrighted depiction and believe that copyright law encroaches too far on the personality’s speech and liberty interests in this context. I acknowledge, however, that the invocation of constitutional doctrine raises a host of difficult questions about competing rights and interests that, when taken together, do not point clearly in the direction of mandating such an exemption as a matter of federal constitutional law. Furthermore, under the doctrine of constitutional avoidance, where possible, courts avoid construing subconstitutional rules as conflicting with the Constitution where an alternative interpretation provides adequate legal grounds for resolving the controversy.¹⁷⁶ Here, the availability of alternative grounds and the attenuated nature of a constitutionally based copyright exemption

174. Rothman, *supra* note 131, at 530.

175. *See id.* at 530 n.336 (citing cases involving allegations of bad faith).

176. *See* Ashwander v. Tenn. Valley Auth., 297 U.S. 288, 347 (1936) (Brandeis, J., concurring); *cf.* Eldred v. Ashcroft, 537 U.S. 186, 221 n.24 (2003) (noting that “it is appropriate to construe copyright’s internal safeguards to accommodate First Amendment concerns” (citing *United States v. X-Citement Video, Inc.*, 513 U.S. 64, 78 (1994) (“It is . . . incumbent upon us to read the statute to eliminate [serious constitutional] doubts so long as such a reading is not plainly contrary to the intent of Congress.”))). Professor Netanel, however, observes that, even if the Constitution does not directly constrain copyright law, “copyright’s internal safeguards *do* have constitutional import: even if the First Amendment imposes no external constraints on copyright, First Amendment principles must animate our understanding and application of copyright law.” NETANEL, *supra* note 7, at 190 (emphasis added).

would render the doctrine of constitutional avoidance particularly apt.¹⁷⁷ Thus, even if aspects of constitutional doctrine could be construed to imply support for recognizing such a copyright exemption, it would be better founded on judicial interpretation of, or statutory amendment to, copyright law rather than on the Constitution itself.

III. A COPYRIGHT RIGHT OF PUBLICITY: A THEORY OF COPYRIGHT EXEMPTION

Although I conclude that the Constitution does not mandate a copyright exemption for a personality's use of a copyrighted depiction, I believe the constitutional considerations described in Part II constitute a compelling policy justification for recognizing such a right under copyright law. This part therefore begins to explore ways in which copyright law might be construed or amended to recognize a limited right of publicity exempting a personality's use of a copyrighted depiction of himself from infringement liability, a novel doctrine which I will refer to as a "copyright right of publicity." A carefully delineated copyright right of publicity would provide greater protection for the speech, liberty, and property interests of publicity-rights holders, while simultaneously establishing a more reciprocal relationship under the law between authors and personalities.¹⁷⁸ In this part, I seek to present neither a comprehensive nor exhaustive treatment of the copyright law considerations necessary to implement a copyright right of publicity; rather, I seek merely to initiate a dialogue about copyright reform framed within the context of the scholarly critique of copyright overreach.

Consistent with the constitutional considerations discussed above,¹⁷⁹ I rest the normative foundation for a copyright right of publicity on the speech, autonomy, and property interests of the publicity-rights holder. I believe that individuals should have the right to engage in speech and creative expression about themselves without the possibility of infringement liability or the speech-chilling specter of expensive copyright infringement litigation. I believe that individuals have an autonomy interest in being able to define themselves and their identities as they wish, including the right to use depictions of themselves embodied in a copyrighted work. And I believe that, to the extent that a personality's property interest in perfecting his publicity rights is curtailed by the First Amendment, that property interest should not be impaired further by an application of copyright law that prevents the personality's use of his own depiction in a copyrighted work.

177. I acknowledge, however, that scholars have questioned the supposed justification of courts for invoking the avoidance doctrine. *See, e.g.*, Richard L. Hasen, *Constitutional Avoidance and Anti-Avoidance by the Roberts Court*, 2009 SUP. CT. REV. 181, 188; Neal Kumar Katyal & Thomas P. Schmidt, *Active Avoidance: The Modern Supreme Court and Legal Change*, 128 HARV. L. REV. 2109 (2015).

178. *Cf.* Guy Pessach, *Toward a New Jurisprudence of Copyright Exemptions*, 55 IDEA 287, 306 (2015) (arguing that copyright exemptions should be reciprocal).

179. *See supra* Part II.

A copyright right of publicity might be most feasibly implemented through heightened protection under the copyright fair use doctrine.¹⁸⁰ For example, courts might apply an objective test in which an individual's use of his own depiction in a copyrighted work would be treated as a presumptively noninfringing fair use of the copyright. Under this rendition of fair use, because the "nature of the copyrighted work" embodies a depiction of the individual's name or likeness,¹⁸¹ the right of the individual to use the copyrighted depiction might presumptively be deemed to outweigh the copyright holder's interest in the other three fair use factors.¹⁸²

My proposal for expanding the fair use doctrine finds support in the literature on copyright overreach. For example, in the concluding chapter of his book, *Copyright's Paradox*, Professor Netanel develops a nonconstitutional framework for reining in copyright law's encroachment on First Amendment speech rights through fair use reform.¹⁸³ In particular, Netanel offers three proposals to promote First Amendment principles and enhance protective safeguards for speech already embodied in copyright law.

First, courts could adopt a "First Amendment-animated fair use doctrine" by relaxing the limitation on secondary uses that "compete[] in an actual or potential market for derivative works based on the original."¹⁸⁴ Netanel argues that First Amendment principles suggest that the doctrine's focus should be on the transformative use of the secondary work, not the potential for the secondary work to compete in the market for the original.¹⁸⁵ This proposal would deemphasize the market impact of the secondary use as a fair use factor, but would retain (indeed, redouble) the restriction of the fair use defense to transformative works. It would give the personality greater leeway in making commercial use of the copyrighted depiction, but would require that the personality further transform the copyrighted depiction.

Second, Netanel proposes that courts apply a burden-shifting standard, such that, upon establishing a "colorable claim of fair use," the copyright holder would bear the burden of proving that the defendant has copied too much of the original work, or that the use unreasonably impacts the market for the original work.¹⁸⁶ Netanel contends that such a burden-shifting system would avoid the speech-chilling effect of requiring the accused infringer to prove a negative, namely, "that the allegedly infringing use—and other possible uses like it—will not even harm a market, including a

180. 17 U.S.C. § 107 (2012) (enumerating the fair use factors).

181. *Id.* § 107(2).

182. *Id.* § 107(1) (factor one: "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes"); *id.* 107(3) (factor two: "the amount and substantiality of the portion used in relation to the copyrighted work as a whole"); *id.* § 107(4) (factor three: "the effect of the use upon the potential market for or value of the copyrighted work").

183. See NETANEL, *supra* note 7, at 195–218.

184. *Id.* at 191.

185. *Id.* at 191–92.

186. *Id.* at 192.

market for derivative works, that the copyright holder has no concrete plans to exploit.”¹⁸⁷

Third, Netanel suggests that courts temper infringement liability by limiting damages to a reasonable licensing fee in cases where the defendant has established a colorable (although unsuccessful) claim of fair use.¹⁸⁸ Netanel observes that, under current law, copyright holders are entitled to “what amount[s] to punitive or expropriative damages” through the imposition of both actual damages from infringement as well as the disgorgement of profits earned by the infringer attributable to infringement.¹⁸⁹ Professor Netanel has elsewhere described this proposal as, “in effect, issuing a compulsory license to further the ‘strong public interest in the publication of the secondary work.’”¹⁹⁰

Professor Netanel’s proposal for reshaping the fair use doctrine to deemphasize consideration of the secondary use’s market impact provides an especially helpful starting point for establishing a copyright right of publicity, but would require the personality to engage in further transformation of the copyrighted depiction. However, if one were to accept Professor Tushnet’s arguments about the speech-enhancing benefits of nontransformative copying, then perhaps there should be room for protecting the personality’s nontransformative commercial use of his own depiction in the copyrighted work as well. To the extent the right to engage in nontransformative copying derives from the need to engage in self-expressive speech, the case for exempting nontransformative copying from infringement liability would seem strongest in the context of a personality’s speech about his own depiction in a copyrighted work, regardless of the commercial nature of the use. This is particularly true given that the copyright holder acquired, for free, the right to depict the personality in the copyrighted work and to sell that work for profit.

Furthermore, a depicted personality’s nontransformative commercial use of the copyrighted depiction would not necessarily adversely affect the market for the original copyrighted work. Indeed, it is entirely possible (and, in many cases, likely) that the personality’s commercial use of his own depiction would have the effect of *enhancing* rather than detracting from the value of the copyright. The personality’s act of publically using the copyrighted depiction can provide a unique and special form of publicity for the original work that often cannot be attained through traditional avenues of paid marketing and advertising. Of course, this value-enhancing potential also suggests that copyright holders have an economic incentive to willingly permit the nontransformative use absent a mandatory legal exemption from copyright enforcement.

In situating the fair use proposal above within Netanel’s First Amendment-animated fair use framework, judicial reform of the doctrine

187. *Id.*

188. *Id.*

189. *Id.*

190. Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 84 (2001) (quoting Leval, *supra* note 55, at 1132).

might involve a reevaluation of the relationship between the second statutory factor, “the nature of the copyrighted work,” and the fourth factor, “the effect of the use upon the potential market for or value of the copyrighted work.”¹⁹¹ Where the nature of the copyrighted work involves a depiction of the personality, the personality should be entitled to greater leeway in making commercial secondary use of the copyrighted depiction regardless of the transformative character of that use. Greater leeway in this regard would also help to scale back the overexpansion of exclusionary rights associated with derivative works.¹⁹²

Expanding upon Netanel’s proposal to reform damage awards in cases where the would-be infringer establishes a colorable claim of fair use, a legislative reform might draw on the existing statutory copyright system of compulsory licensing. This system allows for use of certain statutorily covered copyrighted material by right, provided that the user pay a fee to the copyright holder in accordance with a licensing schedule established by the federal Copyright Royalty Board.¹⁹³ Granting a compulsory license to personalities depicted in a copyrighted work would alleviate the inhibition of speech arising from a copyright holder’s withholding permission even when offered a licensing fee by the personality. Under a compulsory licensing system, a personality would never be prohibited from using his own depiction in a copyrighted work, but would have to pay a presumptively reasonable licensing fee set by the government. If, however, there is dignity value associated with the right to engage in expression about one’s own life experience, including the right to use a copyrighted depiction of oneself, then it might be offensive to that notion to allow a copyright holder who has appropriated a person’s name and likeness without permission to charge that person for use of the copyrighted depiction.

Another path toward recognizing a copyright right of publicity might involve expanding the statutory categorical exemptions from copyright enforcement. Over time, the copyright statutes have become replete with categorical exemptions from copyright enforcement.¹⁹⁴ Some categorical

191. 17 U.S.C. §§ 107(2), (4) (2012).

192. *See, e.g.*, Tushnet, *supra* note 7, at 545 (“The derivative works right thus threatens to give copyright owners power to control interesting, creative, and culturally significant reuses of their works. Even a successful fair use defense is expensive, and the risk of such a lawsuit deters publishers from investing in potentially infringing works; that kind of self-censorship is traditionally a matter of concern to the First Amendment. As a result, a number of scholars have suggested that the derivative works right should be sharply cut back to provide some free speech breathing room for writers building on prior works (as we all must do, in one way or another).”).

193. *See, e.g.*, Robert Kirk Walker, *Negotiating the Unknown: A Compulsory Licensing Solution to the Orphan Works Problem*, 35 *CARDOZO L. REV.* 983, 1005–06 (2014) (“The Copyright Act provides for several different compulsory licenses: For the reproduction of non-dramatic musical compositions (so-called ‘mechanical rights’), public broadcasting, retransmission by cable TV systems, subscription audio transmission, and non-subscription digital audio transmissions, such as Internet radio. The Copyright Royalty Board sets compulsory licensing fees.”).

194. *See, e.g.*, 17 U.S.C. §§ 109, 110, 115, 120.

exemptions reflect reasonable accommodation for the public's speech interest in using the copyrighted work. For example, under 17 U.S.C. § 120(a), the public has an absolute right to produce, display, and distribute visual depictions of a copyrighted architectural work for free and without permission where the architectural work is manifested in a building visible to the public. This type of exemption furthers First Amendment speech-promoting goals by granting the public unqualified latitude to use this type of copyrighted work in visual depictions. Other categorical exemptions appear more random and selective in scope and application,¹⁹⁵ thus demonstrating a willingness by Congress to establish special exemptions from copyright enforcement in settings it deems appropriate. For the reasons described in this Article, Congress would be justified in enacting a statutory categorical exemption recognizing a copyright right of publicity along these lines.

The judicial and legislative reforms proposed above represent only a few of the ways through which copyright law might provide limited recognition for a copyright right of publicity. I leave to others the task of building upon this analysis to implement reforms that grant individuals the right to use copyrighted depictions of themselves without infringement liability.

CONCLUSION

I conclude with a final illustrative hypothetical: In March 2015, playwright John Strand mounted a Washington, D.C., production of *The Originalist*, a play portraying the judge-clerk relationship between the late United States Supreme Court Associate Justice Antonin Scalia and a fictionalized liberal law clerk.¹⁹⁶ Of the three characters in Strand's play, the fictional Justice Scalia dominates the stage work. In an interview with the *New York Times*, Strand stated that he did not write the play to mock Justice Scalia, but conceded that his portrayal of a sitting Supreme Court

195. Section 110(6), for example, provides that "performance of a nondramatic musical work by a governmental body or a nonprofit agricultural or horticultural organization, in the course of an annual agricultural or horticultural fair or exhibition conducted by such body or organization" is categorically not an infringement of copyright. *Id.* § 110(6). In another example, § 109(e) provides:

Notwithstanding the provisions of sections 106(4) and 106(5), in the case of an electronic audiovisual game intended for use in coin-operated equipment, the owner of a particular copy of such a game lawfully made under this title, is entitled, without the authority of the copyright owner of the game, to publicly perform or display that game in coin-operated equipment, except that this subsection shall not apply to any work of authorship embodied in the audiovisual game if the copyright owner of the electronic audiovisual game is not also the copyright owner of the work of authorship.

Id. § 109(e).

196. See *World-Premiere Political Drama The Originalist*, ARENA STAGE, <http://www.arenastage.org/shows-tickets/the-season/productions/the-originalist/> (last visited Apr. 29, 2016) [<https://perma.cc/7VE4-ZQGU>]; Adam Liptak, "The Originalist," a New Play About Justice Antonin Scalia by John Strand, N.Y. TIMES (Mar. 11, 2015), <http://www.nytimes.com/2015/03/12/theater/the-originalist-a-new-play-about-justice-antonin-scalia-by-john-strand.html> [<https://perma.cc/75ZX-ADY7>].

justice was risky and “probably crossing a line.”¹⁹⁷ But because *The Originalist*’s depiction of Justice Scalia manifests a transformative use of Scalia’s persona, the First Amendment protects Strand’s right to disseminate the depiction in his play without obtaining permission from or paying Justice Scalia’s estate, which would, but for the First Amendment, otherwise have the right to assert a state-law right of publicity in states that recognize post-mortem publicity rights. Suppose, however, that Justice Scalia were still alive¹⁹⁸ and wished to internalize and self-actualize Strand’s play, not by critiquing or commenting on it, but by mounting his own publicly staged competing production of the work starring himself as Justice Scalia. Under copyright law, Strand would have the right to enjoin Justice Scalia from portraying himself in such a production of *The Originalist* as unlawful infringement, or, alternatively, charge a licensing fee. This constraint on Justice Scalia’s ability to engage in self-expression about a copyrighted depiction of himself reflects an asymmetrical and normatively unfair preference for Strand’s freedoms of expression and autonomy over the same freedoms of expression and autonomy to which Justice Scalia, were he still living, should also have been entitled.

The First Amendment overrides state-law publicity claims to protect the right of authors to engage in creative expression depicting an individual’s name and likeness, but constitutional doctrine provides a lesser degree of protection for the speech and autonomy interests of individuals whose depiction has been appropriated in a copyrighted work. I believe, however, that, once an individual’s name or likeness has been appropriated without consent in a copyrighted work, that individual should have greater leeway in using his own copyrighted depiction without incurring infringement liability or the specter of costly infringement litigation. This normative claim is consistent with a growing critique of copyright law and its overreaching burden on the speech and liberty interests of would-be infringers seeking to engage in speech not otherwise protected by the safe harbor of the current fair use doctrine. That a person could be enjoined from engaging in speech about his own depiction in a copyrighted work vividly illustrates the speech-inhibiting effects of contemporary copyright law.

In this context, copyright law imposes significant burdens on the depicted personality’s speech and liberty interests, but I conclude that the Constitution itself does not mandate a copyright exemption in this context. This Article therefore proposes a statutory and judicial framework for reform to protect a person’s speech about herself, even though not mandated by the Constitution, on normative grounds that favor enhancement of speech protection.

My proposal for “a copyright right of publicity” would create a limited copyright exemption providing greater leeway for an individual to use a depiction of herself embodied in a copyrighted work. This reform might be

197. Liptak, *supra* note 196.

198. Justice Scalia died shortly before the publication of this Article.

achieved through judicial expansion of the fair use doctrine, or statutory reform providing a compulsory license or categorical exemption from copyright enforcement.