

# NCAA Student-Athletes' Rights of Publicity, EA Sports, and the Video Game Industry

## The Keller Forecast

BY ANASTASIOS KABURAKIS, DAVID A. PIERCE, OLIVIA M. FLEMING, GALEN E. CLAVIO, HEATHER J. LAWRENCE, AND DAWN A. DZIUBA

The *Keller v. Electronic Arts, National Collegiate Athletic Association, and Collegiate Licensing Company*<sup>1</sup> class action complaint filed in May in the Federal District Court in San Francisco received considerable fanfare<sup>2</sup> among academic and legal practitioners, as well as controlled skepticism among intercollegiate athletic governing bodies and video game industry executives. As the factual scenario and class action prospects have been forecasted in prior scholarship,<sup>3</sup> this contribution will: (1) briefly pose related intercollegiate athletics amateurism policy considerations; (2) review major intellectual property theory points; (3) summarize the crucial questions for the court and each party, posing several possible answers; and (4) conclude with future research directions, with the embedded promise of forthcoming elaborate manuscripts on the same stream.

### BACKGROUND

The interaction between the National Collegiate Athletic Association (“NCAA”),<sup>4</sup> its member institutions, student-athletes (“SAs”), and commercial enterprises has a long history, rich present, and somewhat uncertain future.<sup>5</sup> The balance between “crass commercialism and unrealistic idealism”<sup>6</sup> is a constant battle; critics argue that, with respect to the major revenue-producing sports of football and men’s basketball, the scale has irreversibly leaned toward the professional model of crass commercialism. Proponents argue that without support from commercial entities, the modern model of college sports would not be sustainable. The present form of intercollegiate sports has evolved considerably from the traditional notion of amateurism.<sup>7</sup> Attaining that elusive balance between commercialism and amateurism is constantly sought after in policy drafting, academic exercises, as well as via (the threat of) litigation. That is the bird’s-eye view over the entangled plane of policy, law, and competing interests out of which *Keller* was born.

### BACKDROP OF NCAA AND VIDEO GAME INDUSTRY RELATIONSHIP

#### History of NCAA Sports Video Games

Video games based on college teams and rosters are a relatively recent phenomenon. Early sports games involved anonymous players and teams (i.e., Nintendo’s *10 Yard Fight* and *Goal*, Atari’s *Baseball* and *Pole Position*). It was not until EA Sports released the 1983 basketball game *Dr. J and Larry Bird Go One on One* that professional licensing entered the sports video game equation in the United States.

An early example of a college basketball game is XOR Corporation’s *Basketball Challenge*, released in 1988 for DOS-based computers. The text-based coaching simulation contained the actual names and physical characteristics of college players from the top 20 college teams of the day; however, the team names were altered, presumably to avoid lawsuits from the schools. Hence, the Indiana Hoosiers became the Bloomington Hoopsters, the Florida Gators became the Gainesville Caymen, and the Purdue Boilermakers became the West Lafayette Riveters. Why the manufacturer of *Basketball Challenge* used that format would be interesting, yet difficult, to investigate because the corporation vanished just a few years later.

Over the next decade, other games utilized college teams and players. The most successful of these games was the *Bill Walsh College Football* series, designed by EA Sports and based on the game engine utilized for the *Madden* professional football series. Designed primarily for the 16-bit Sega Genesis gaming system, *Bill Walsh College Football* did not feature player names, but it did have 24 teams with rosters that compared to their real-world

counterparts based on jersey numbers. The series also included “classic” teams, dating as far back as 1978.

With the arrival of the 32-bit Sony PlayStation in 1996, the *Bill Walsh* series eventually morphed into EA Sports’ *NCAA Football* series. The number of teams expanded from the original 24 to the entire Division I-A (“Football Bowl Subdivision”), as well as several teams from Division I-AA (“Football Championship Subdivision”). The game also grew to include more historical teams and added the ability for the user to edit the names of the players in the game. Accurate team logos, jerseys, mascots, and fight songs also were added. While never as popular as the National Football League (“NFL”)-based *Madden* series, *NCAA Football* has seen commercial success, with the game selling over 1 million copies in 2004.<sup>8</sup>

#### Playing and Feeling “In the Game”

The present-day video gamer can play these college-based games in a variety of ways. *NCAA Football* allows for single or multiplayer use, on either a specific machine or over the Internet. In most cases, the user manipulates the game via a hand-held controller. Also, the perspective of the game can be changed through a variety of camera angles.

The game has a variety of modes, which can change the experience for the player. In *NCAA Football*, players can participate in a single game between two teams. Also, they can use “dynasty” mode, which allows the player to become the de facto head coach. In this mode, the player is in charge of nearly every aspect of running a college football team, including recruiting and scheduling. In 2005, EA Sports added “program integrity” to dynasty mode.<sup>9</sup> Throughout the year, gamers are notified of their players’ discipline problems, the vast majority of which are academic in nature. The gamer is required to address these issues or risk NCAA-mandated penalties, including scholarship reductions.

NCAA-licensed basketball games have included many of the same features as football, with single-game and dynasty modes available. The now-defunct *College Hoops 2K* series included a “coach” mode where gamers could call plays and the computer-controlled players would run them.

#### Player Names

While games such as EA Sports’ *NCAA Football* and *NCAA Basketball* and the *2K*

Sports' *College Hoops* series do not come prepackaged with player names,<sup>10</sup> the process by which a video game user can add SAs' names to their physical likenesses is quite simple. In fact, the mechanisms included in the game make this process even easier today than a decade ago.

Although early versions of the games allowed players to modify the default roster files, the 2K Sports' *College Hoops* series increased the ease of such modifications by including a database of nearly every college basketball player's name for the year that the game was produced. This led to including uncommon last names, such as "Cummard," "Hansbrough," and "Mbah a Moute" in the game's naming list. In many cases, the newly modified name is spoken by the video game's broadcasting crew. One of the broadcasters for the *NCAA Football* game, an ABC/ESPN play-by-play broadcaster, Brad Nessler, stated that he and other broadcasters "record the names of the players, even though we know we're not supposed to."<sup>11</sup>

During the mid-2000s, a cottage industry of roster name alterations sprang up with Web sites such as PSXRosters.com offering to provide video game users with a completely updated and current roster for *NCAA Football* for a fee. These Web sites would normally obtain an advance copy of the video game and then manually enter SA names for each of the 110+ Division I-A football teams. Users were then instructed to mail a memory card or small portable storage device to the roster editor, who copied the modified roster onto the user's card and mailed it back.

The advent of the EA Locker<sup>12</sup> system, which allows *NCAA Football* and *NCAA Basketball* users to share roster and settings files, has made the process of changing names to match SA counterparts even easier. Through this system, users can share roster files remotely via an online server hosted by EA. This allows for distribution of the roster file but with a much wider reach and with far less work for the end user. Once the roster file is obtained, the user simply saves it onto a game system storage device, loads it into the game, and subsequently has access to a game where the names of the SAs almost exactly match their virtual likenesses.

### Questionable Practices or Natural Monopoly?

EA Sports and the various licensing agencies in certain college and profes-

sional sports have been accused of engaging in monopolistic behavior.<sup>13</sup> In late 2004, EA Sports began to sign exclusive licensing deals with sports entities, effectively shutting its competitors out of the marketplace due to an inability to include official player names and likenesses. The first such incident occurred when EA Sports signed an exclusive contract with both the NFL and the NFL Players Association ("NFLPA").<sup>14</sup> While this deal was signed in the wake of the commercial success of Take Two Interactive's *NFL 2K* series,<sup>15</sup> EA Sports demanded an exclusivity deal with the NFL.<sup>16</sup> EA Sports renewed the license, extending their deal with the NFL until 2012.<sup>17</sup>

EA Sports also holds the exclusive licenses to NCAA basketball and football. The most recent exclusivity deal between EA Sports and the Collegiate Licensing Company ("CLC") for college football occurred in 2005, when EA secured the rights to the "teams, stadiums, and schools"<sup>18</sup> for all video game consoles. Beforehand, EA Sports faced competition from Take Two Interactive's *College Football 2K* series.

EA faced competition in basketball from the 2K Sports series throughout the mid-2000s. However, in January of 2008, 2K Sports announced that it was canceling its NCAA basketball series after breaking off talks with the CLC.<sup>19</sup> While EA Sports' representatives claimed that 2K Sports "walked away from college basketball,"<sup>20</sup> media outlets reported that EA Sports influenced the CLC to increase the amount of money demanded for the college basketball license.<sup>21</sup> Take Two Interactive, the parent company of 2K Sports, commented at the time that, "We are committed to providing fans with high-quality, critically acclaimed sports games, but given our disciplined approach to the business, we do not believe the current discussions would result in an acceptable outcome."<sup>22</sup>

### NCAA AMATEURISM POLICY

Applicable bylaws to the use of SAs' images and likenesses in the video games next to the Association's Constitutional Principles in Bylaw 2 include:

12.1.2: Amateur status is lost if SA uses athletics skill for pay;

12.5.1.1: Institution may use SA name, picture, or appearance to support charitable, educational, and activities incidental to participation . . . provided . . .

(g) name, picture, or appearance not used to promote commercial ventures of non-profit agency;

(h) items with names, *likenesses*, or pictures of multiple SAs may be sold only at the institution or controlled outlets. Items with individual SA name, picture or *likeness* (name on jersey, likeness on doll) other than informational items, *may not be sold*; 12.5.2.1: SA is ineligible if compensated for advertisement, commercial promotion, endorsement;

12.5.2.2: Use of name or picture without knowledge or permission carries the simultaneous burden for the SA and the institution to take steps to stop use.<sup>23</sup>

In addition, a confirmation of the apparent loophole with respect to use of SAs' likenesses in video games is found in a staff interpretation from January 7, 2006.<sup>24</sup> Therein, the NCAA staff addressed a member institution question: Would this legislation preclude companies from using an SA's likeness in sports video games? Sadly, the interpretation did not provide significant clarification, as it merely recited Bylaw 12.5.2.2.<sup>25</sup> Moreover, an official interpretation dated July 15, 2008, states:

The committee confirmed that if a student-athlete's name is used, without the student-athlete's knowledge or permission, in a fantasy sports game operated by an outside entity or agency, the student-athlete (or the institution acting on his or her behalf) is required to take steps (e.g., issue a cease and desist letter) to stop the activity in order to retain his or her eligibility for intercollegiate athletics.<sup>26</sup>

In a nutshell, there is no treatment in present NCAA policy for the use of SAs' likenesses in EA Sports video games; rather, there are an amalgam of interpretations and variable applications. To that end, NCAA governing bodies have addressed the evident problems and attempted to find solutions.

Over the past five years, the NCAA's constituent groups have recognized that current NCAA amateur policies in Bylaw 12.5 do not account for new media technology that has altered the way in which marketers utilize SAs' names, images, and likenesses. Commercialization, amateurism, and policy change surrounding these is-

sues are complex processes that impact a number of stakeholders. Quoting Amateurism Cabinet Chair, Baylor Law Professor Mike Rogers, on the cabinet's work on SAs' likenesses, "We have been on this for three-four years now. . . . Once we conclude, we can tackle the War on Terror and Social Security Reform. . . ."27 The background of proposed legislation in this area and the divergent agendas represented by stakeholders provide a framework for Keller's ensuing legal analysis.

In 2006, the NCAA formed the Study Group on Names and Likenesses to examine the replacement of outdated legislation with contemporary rules that would provide greater flexibility to feature SAs in promotional material. The Study Group picked up where Proposal 2005-26 left off. If Proposal 2005-26 was not withdrawn, it would have permitted institutional, charitable, educational, and nonprofit organizations to display a logo or product description on promotions, provided it did not exceed 25 percent of the total promotion and athletes did not directly encourage the use of the product.

The Study Group, using Proposal 2005-26 as a starting point, created three proposals in 2007 for governing promotional usage of SAs by: (1) institutional, charitable, educational, and nonprofit entities (Proposal 2007-25); (2) commercial entities (Proposal 2007-26); and (3) media entities (Proposal 2007-28) (see Table 1). For example, Proposal 2007-26 would have allowed video, audio, and photographs of SAs with eligibility remaining (sub-

## THE OUTCOME OF THE *KELLER* SUIT WILL CERTAINLY PROVIDE DIRECTION, AND POSSIBLY MANDATES, ON WHAT CHANGES ARE MADE TO BYLAW 12.5 RELATED TO COMMERCIAL USE OF SAs' IMAGES AND LIKENESSES.

stantial deviation from past norm) to be featured in promotional material, provided the SA did not directly endorse the product. The Study Group's rationale was that showing video or pictures of athletes in competition did not create a direct endorsement of a product, as is common in professional sports. The Study Group also noted that "the increased flexibility may increase the ability of an institution to strengthen its relationship with commercial sponsors."<sup>28</sup> The three proposals were initially tabled for discussion on how to balance the proposals with the role of commercialism in higher education.

Discussion of the 2007 proposals ranged from formal NCAA Convention meetings, to popular press, to SA input. When proposals that impact SAs are considered by the NCAA, decision makers often look to the NCAA Student-Athlete Advisory Committee ("SAAC") to ascertain SAs' stances on the issue. In 2007, NCAA Division I SAAC Vice Chair Kerry Kenny indicated that the current rules needed updating<sup>29</sup> and that he and the Division I SAAC were "for any legislation or direction the NCAA was going to take."<sup>30</sup> In addition to the comments by Kenny, minutes from 2008 and 2009 NCAA Division I SAAC meetings indicate the group discussed commercialization.<sup>31</sup> Other SAAC groups discussed a need for more specific information. In 2008, the Southeastern Conference ("SEC") SAAC noted concerns that legislation might result in opportunities only for football and basketball SAs and might be considered "career development."<sup>32</sup> Beyond this concern, the group was in support of SAs serving as spokespeople for their schools.<sup>33</sup> Sports industry finance consultant, Marc Isenberg, saw an inherent problem in expanding the ability of companies to use athletes' images. Specifically, Isenberg felt that SAs will "retain little if any control over the athletic department's use of their likenesses."<sup>34</sup>

During this time, some SAs were quoted about their feelings on being in video games. Some recognized that their likenesses are used but do not have a problem with it. Chris Lofton, a high-profile former University of Tennessee men's basketball player, indicated

he enjoyed having his image used and that "[i]t's good for the school, it's good for the players, and good for the team."<sup>35</sup> But he said it would be nice to get paid.<sup>36</sup> Another former SA, Marvin Lewis (now an associate athletics director at Georgia State University), noted that he would be "excited to see [his] likeness and playing abilities in an EA Sports game."<sup>37</sup> The discussion generated by the tabled 2007 proposals was lively and productive; however, the proposals were ultimately defeated due to the NCAA's "use it or lose it" sunset provision.

The second formal NCAA group to address this issue was the Task Force on Commercial Activity in Division I Intercollegiate Athletics. The Task Force attempted to balance the need to protect amateurism with the need to attract commercial funds, which reduce reliance on allocated funding from the institution, student fees, and state appropriations. According to the Task Force's report, "The need for revenue gained through commercial activity associated with intercollegiate athletics is as essential to the successful future of the enterprise as is the continued integration of intercollegiate athletics with the values of higher education."<sup>38</sup> The Task Force created guiding principles for the use of names and likenesses, while explaining why Bylaw 12.5 needed to be redefined to attract additional commercial dollars. The Task Force Report delineated the principles regarding commercial activities involving SA names and likenesses that would constitute new legislation in Bylaw 12.5.

First, the Task Force identified practices that should not be allowed under NCAA legislation. Under these principles, SA names or likenesses may not promote or endorse the sale or use of a commercial product or service, and athletes may not be paid for the use of their names, likenesses, or reputations. Second, the Task Force identified acceptable practices. During coverage and representation of a competition, an SA's name or likeness can be used, with the exception of fabricated products, such as jerseys. The media is also able to broadcast and promote coverage in which SAs, teams, or conferences will compete. Finally, the Task Force identified the conditions under which the names or likenesses can be utilized that do not involve athletes endorsing the sale of a product. These conditions include consent by the SAs to the use of their names and likenesses, approval by the athletic director, and a "clear, official, and visibly referenced-association"

between the sponsor and the sport property.<sup>39</sup> Finally, the Task Force called for a Commercial Activities Oversight Committee to make binding determinations for questions regarding the use of SAs' names and likenesses and monitor national trends in marketing, sponsorship, and commercial activity.

While the Task Force wrestled with a move toward commercial activity, consumer demand for real player likenesses increased as technology advanced. EA Sports has been interested in the development and discussion of this legislation. Sean O'Brien, producer of EA Sports' *NCAA Basketball 2009*, argued that video games are different from everything else in the context of NCAA commercialization bylaws and should be treated as such.<sup>40</sup> He feels that the current NCAA rules hinder EA's ability to give fans what they want—real player likenesses and names integrated into the game.<sup>41</sup>

The Knight Commission, an intercollegiate athletics reform group, held a special meeting in October 2008 to discuss new media and college athletics. Co-chairman R. Gerald Turner recognized that, "[C]ollege athletes in fantasy games and video games may seem trivial to some, but these and other forms of new media pose new challenges to the long-held distinction between commercial activity featuring teams and those which focus on individual athletes."<sup>42</sup> The Knight Commission recognizes that college athletics are more commercial than in the past due to "consumer demand for interactivity and reality-based gaming."<sup>43</sup> However, it agreed that third parties should not be permitted to profit from SA images and likenesses.<sup>44</sup> The meeting provided another avenue for NCAA stakeholders to examine the current commercialization issues and add to the discussion.

In addition to the 2006 Study Group on Names and Likenesses and the 2009 Task Force on Commercial Activity, NCAA President Dr. Myles Brand addressed the issue of SA likenesses in his blog post and 2009 State of the Association Address. In his September 9, 2008, blog post, Brand disagreed with the *C.B.C. v. MLBAM*<sup>45</sup> decision, which impacted the use of SA names in college football fantasy leagues. Brand noted the NCAA cannot sue CBS, which produces the fantasy game, because the right of publicity is held by the SAs and not the NCAA. Thus, the NCAA "would find it difficult to bring suit over the abuse of a right [it doesn't] own."<sup>46</sup> Brand also noted in his 2009 State of the Association Address that the confluence of the Internet and reality animation has made it difficult for content providers, such as the NCAA, to control the use of athlete names and likenesses. The Task Force made the same observation regarding computer simulation (e.g., video games). According to the Task Force, "The concept of convergence, which will merge the interactivity of . . . computer simulation with television broadcast, will need to be interpreted as it relates to the appropriate uses of student-athlete names and likenesses."<sup>47</sup> Thus, the NCAA has recognized that it faces a challenge in creating a solution regarding convergence. Overall, the NCAA, SAs, EA Sports, and the Knight Commission recognize a need to adapt to new technologies. The outcome of the *Keller* suit will certainly provide direction, and possibly mandates, on what changes are made to Bylaw 12.5 related to commercial use of SAs' images and likenesses.

## REVIEW OF LITERATURE

Various scholarship samples<sup>48</sup> have either directly or circuitously referred to the legal problems posed by the use of NCAA SAs' images and likenesses by the video game industry. For the purposes of this review, we shall delimit reference to four particularly interesting manuscripts.

In a 1994 article published in the *Seton Hall Journal of Sport Law*, James S. Thompson dealt with the intellectual property problem of university trading cards. The author argues what was then permissible commercial production of college athletes' trading cards would violate prima facie the SAs' rights of publicity. However, he points out that, considering the nature of intercollegiate athletics participation, this violation would be preempted by an implied consent the SAs yield to their universities and the NCAA, thus forfeiting any common law rights of publicity claims.<sup>49</sup> This implied consent is construed as an inherent obligation of NCAA SAs to abide by all NCAA regulations, including policies favoring institutional use of SAs for promotional and commercial purposes. However, although the author expressly uses the word "likenesses,"<sup>50</sup> this operative word was not included in the body of the *NCAA DI Manual* until 2006.<sup>51</sup> Even in the present form, NCAA policies using the word (12.5.1.1(h) and 12.5.2.2) do not pertain to a precise treatment of EA Sports and the video game industry's current use of SA likenesses. Nonetheless, the implied consent element in Thompson's work is a significant contribution that needs to be revisited

for any rights of publicity discourse involving use of SAs' likenesses in present-day video games.

Next, in 2001, Matthew Matzkin published an article in the *Loyola of Los Angeles Entertainment Law Review* directly posing the problems at hand and describing "how the video game industry violates college athletes' rights of publicity by not paying for their likenesses."<sup>52</sup> The article identified the loophole posed above pertaining to NCAA policy not regulating contemporary use of SAs' likenesses in video games, and a conservative solution of scrambling SAs' images to avoid violating their rights of publicity.<sup>53</sup> There is a logical disconnect, nevertheless, in the author's rationale on the loophole that exists beyond question in Bylaws 12.5.2.1 and 12.5.2.2; he argues that the SA could receive compensation for articles bearing his name (and in extension, likeness) if the SA knew of the use but remained short of endorsing the product.<sup>54</sup> An official interpretation ensures names of SAs with eligibility remaining should not be used in sports video games.<sup>55</sup> Conversely, the authors of the research at hand encountered another interpretation dated January 7, 2006,<sup>56</sup> that dealt with the question of whether upcoming legislative proposals regulating amateurism and current legislation would preclude companies from using SAs' likenesses in sports video games. Unfortunately, the interpretation merely recited the Bylaw (12.5.2.2), offering no clarification, understandably due to the loophole in legislation. Matzkin's disconnect lies in the omission of the overarching principle of NCAA rules' compliance, including those on amateurism; that is, his argument is in direct contradiction to the basic premise of Bylaw 12.1.2(a), precluding SAs from earning pay in any form, even via an indirect use of their athletic skill. Notwithstanding this disconnect, his contribution is important, as is the scrambling option as a solution, albeit a dangerous one at this point in EA Sports' business practice.<sup>57</sup>

In 2004, Kristine Mueller, in her *DePaul Journal of Sports Law & Contemporary Problems* article, reached two important points with regard to possible defenses in cases such as *Keller*. One defense is consent, as was mentioned in Thompson's work. The other defense entails federal copyright preemption of state-based rights of publicity. Summing Mueller's and this research group's findings, the argument es-

establishes an employer-employee relationship, or in the most conservative assessment of this research, a “quasi employee” doctrine, under which SAs turn over the copyright of their works to the NCAA and institutions funding their performances (via athletic scholarships and related benefits). In that scenario, the National Labor Relations Act would be amended to recognize unionization prospects for college athletes<sup>58</sup> based on the benefits derived from their athletic performances. Of course, as has been recognized extensively in both scholarship and congressional hearings,<sup>59</sup> such an advent would question the tax-exempt status of the NCAA and athletic departments in member institutions; nonetheless, for the purposes of this research, the NCAA may successfully defend itself by claiming that the NCAA’s copyright of SAs’ performances preempts any rights of publicity they may claim, similar to the findings in *Baltimore Orioles v. Major League Baseball Players’ Association*.<sup>60</sup> In another contribution from this research, the “quasi work-for-hire” theorem is further established, considering recent legal fiction and an important NCAA settlement.<sup>61</sup>

Finally, Sean Hanlon and Ray Yasser published a thought-provoking and elaborate theoretical position in a 2008 *Villanova Sports and Entertainment Law Journal* article, entitled “‘J. Morrison’ and

His Right of Publicity Lawsuit Against the NCAA.” Their major conceptual contribution in this research stream is the analysis of the athletic scholarship as an unconscionable contract of adhesion, thus rendering the consent defense unsuccessful. This research agrees with the establishment of a contractual relationship between the SA and the educational institution, arguably not with the NCAA.<sup>62</sup> There are, however, serious hurdles a plaintiff must overcome before a court (especially in a more conservative jurisdiction, but even in California<sup>63</sup>) could establish that the National Letter of Intent (“NLI”) and the Grant-in-Aid (“GIA”) agreements are unconscionable, as the authors argue. Forgoing a lengthy diatribe, the procedural and substantive elements an SA must prove to establish an unconscionability claim include: (1) an inequality of bargaining power between the institution granting the athletic scholarship and the SA, (2) a lack of meaningful choice or alternative for the SA, (3) supposedly agreed-upon terms hidden or concealed in the contract, and (4) terms that unreasonably favor the institution.<sup>64</sup>

One may have no problem accepting the inherent inequality of bargaining power between the institution and the SA. The authors indicate that the SA can choose which school to attend but remark that the NLI and GIAs are uniform without any room for bargaining, leaving no meaningful choice for the SA. Alternatives include scholarship offers by, e.g., National Association of Intercollegiate Athletics (“NAIA”) or National Junior College Athletic Association (“NJCAA”) member institutions, or the progressively more available options for talented young athletes to play in semi-professional leagues both in the United States and overseas. Still, the critics protest that this is no alternative to the NCAA. The underpinning motive for attending an NCAA member institution, at least in principle, is the educational pursuit, with all contemporaneous benefits. Otherwise, why would hundreds of thousands of SAs decide to forgo another employment prospect for a four- or five-year academic and athletic career without any direct compensation? As we have seen recently,<sup>65</sup> the prospects exist in various ways for these SAs to pursue alternative life paths.

The supposedly agreed-upon terms that would be construed as hidden or concealed would be a problematic area for a plaintiff to succeed.<sup>66</sup> The nature of participation in intercollegiate athletics entails the overarching recognition of the prevalence of the student identity over that of the athlete. Thus, any obscure policies and interpretations that would affect the SA’s eligibility might not rise to the level of rendering the agreement unconscionable, as they are aligned with the overall mission of the Association, preserving amateurism, and maintaining the delicate balance between often conflicting principles

**TABLE 1**

PROPOSAL	APPLIES TO	INTENT	RATIONALE
2007-25	Institutional, charitable, educational, and nonprofit entities	<ul style="list-style-type: none"> <li>Promotion must clearly identify connection between sponsor and institution</li> <li>Promotion must not directly encourage use or sale of product</li> <li>Product may not be included in promotional activity (except athletics equipment)</li> </ul>	<ul style="list-style-type: none"> <li>Deregulate outdated and confusing standards</li> <li>Appearance of cosponsor no longer limited to reproduction of firm’s officially registered trademark</li> </ul>
2007-26	Commercial entities	<ul style="list-style-type: none"> <li>Promotion may feature competition video, audio, and photographs, provided they are approved by the athletic director, the affiliation with the organization is explained, and the student-athlete is not directly encouraging the purchase of product</li> </ul>	<ul style="list-style-type: none"> <li>SAs’ names, images, or likenesses in competition video/audio/photographs do not create direct endorsement of products</li> <li>Balances exploitation and increased revenue potential</li> </ul>
2007-28	Media entities	<ul style="list-style-type: none"> <li>Feature SAs’ names, images, or likenesses in promoting college sport competition, provided the use is limited to competition video, audio, or photographs</li> <li>Feature student-athlete images in coverage of news related to the SA</li> </ul>	<ul style="list-style-type: none"> <li>Restriction of video, audio, and photographs ensures that no additional SA time is spent on these promotional activities</li> </ul>

(e.g., competitive equity and institutional control, as well as other constitutional principles for the association under Bylaw 2). Moreover, the authors cite one compliance director for establishing that his position is difficult and he must rely on NCAA interpretations;<sup>67</sup> however, that does not mean that a term crucial (or certainly material) enough to negate the contractual relationship between SA and institution was concealed. Additionally, the SA and his/her family always have the opportunity for legal counsel (indeed, not an agent marketing the SA's ability with the goal of securing a particular institutional scholarship<sup>68</sup>), so any critical aspects of the SA's intercollegiate athletic participation may be clarified in advance. Rarely do SAs ask important questions and call for clarifications prior to signing the NLI and GIA; however, that does not amount to unconscionability of the contract and an attempt to conceal on the part of the offeror.

On the matter of terms unreasonably favoring the institution and the substantive aspect of unconscionability (i.e., overly harsh terms, the sum total of which "drives too hard a bargain"<sup>69</sup>), it is arguably a stretch to consider that the NCAA and its member institutions unilaterally exploit SAs who have no recourse, who are victims of this agreement, and so forth. To the contrary, one might establish that certain SAs actually exploit the system granting them athletically related financial aid, such as the basketball SAs who are talented enough to proceed to professional leagues after a year in college, prior to finishing their degrees. Depending on the timing and their academic statuses, their departures may mean loss of income and scholarships for the member institutions, and eventual sanctions by the NCAA. These athletes have both the talent and resources to sign a professional agreement (albeit overseas) instead of pursuing even a year of college athletics. Undoubtedly, institutions have a lot to gain from the presence of talented athletes on their intercollegiate teams, but the benefits flow both ways, and that is the unique nature of American "amateur" athletics.<sup>70</sup> Thus, it may be argued that it would be a big leap to render NLIs and GIAs as unconscionable contracts of adhesion, considering all aspects of the SA-institution relationship. It follows that one could argue there has been an implied consent via this relationship to use SAs' rights of publicity, albeit not expressly negotiated or included in the NLI or GIA agreements. The defense of consent is handled in the respective section below.

## INTELLECTUAL PROPERTY THEORY AND APPLICATION

### Right to Privacy

The right to privacy has its roots in legal scholarship and jurisprudence of the late nineteenth century. The first significant literature contribution that provided the seeds for a tort of invasion of privacy is found in Judge Cooley's<sup>71</sup> treatise on torts.<sup>72</sup> Therein, Judge Cooley coined the term "the right to be let alone."<sup>73</sup>

The most instrumental contribution to the formation and acknowledgment of the right to privacy was the landmark article by Samuel Warren and Louis Brandeis, "The Right to Privacy," published in 1890 in the *Harvard Law Review*.<sup>74</sup> The authors prophetically pontificate:

Recent inventions and business methods call attention to the next step which must be taken for the protection of the person, and for securing to the individual what Judge Cooley calls the right "to be let alone." Instantaneous photographs and newspaper enterprise have invaded the sacred precincts of private and domestic life; and numerous mechanical devices threaten to make good the prediction that "what is whispered in the closet shall be proclaimed from the house-tops."<sup>75</sup>

Courts were reluctant to assume the creation of the new right subsequent to Warren and Brandeis' publication. The first two landmark appellate-level cases, in New York and Georgia, had conflicting results. Whereas the latter unanimously decided the right had been established and violated, the former did not find a violation of the evolving right to privacy, which pertained to a right of publicity in these early cases.<sup>76</sup>

It took William L. Prosser's own influential article in 1960<sup>77</sup> for the right to be firmly established in American jurisprudence and legal theory. Prior to 1960, approximately 80 cases cited "The Right to Privacy." However, after Prosser's "Privacy," the citations rose to more than 400 by 2007.<sup>78</sup>

Prosser described the evolving tort as a "complex" of four distinct invasions of separate privacy interests that do not have much in common, other than the overarching principle of the plaintiff's right "to be let alone."<sup>79</sup> Prosser defines these four distinct invasions as:

1. Intrusion upon the plaintiff's seclusion or solitude, or into his private affairs.
2. Public disclosure of embarrassing private facts about the plaintiff.
3. Publicity which places the plaintiff in a false light in the public eye.
4. Appropriation, for the defendant's advantage, of the plaintiff's name or likeness.<sup>80</sup>

Further, Prosser remarks:

It is not impossible that there might be appropriation of the plaintiff's identity, as by impersonation without the use of either his name or his likeness, and that this would be an invasion of his right of privacy. No such case appears to have arisen.<sup>81</sup>

Decades after those lines were written, the Ninth Circuit would be inundated by such cases.<sup>82</sup> Several other courts have embarked on deciding the extent of privacy and publicity protection. Indeed, the fourth invasion Prosser posits refers to the de facto (and subsequently de jure) proprietary interest that yields value to the right owner, who could capitulate licenses for profit.<sup>83</sup> He then proceeds to directly cite *Haelan Laboratories v. Topps Chewing Gum, Inc.*<sup>84</sup> and *Nimmer*<sup>85</sup> as the seeds for a clear identification of the right of publicity.<sup>86</sup>

The latter, an extension of Prosser's work, was further seeded in the *Restatement (Second) of Torts*,<sup>87</sup> in which the four-tort model was adopted. Section 652C prescribes, "One who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of his privacy."<sup>88</sup> Eventually,<sup>89</sup> the right of publicity found its own recognition in the *Restatement (Third) of Unfair Competition*. Section 46 encapsulates the progress in legal scholarship and jurisprudence:

#### *The Right of Publicity:*

One who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability for the relief appropriate under the rules stated in §§ 48 and 49.<sup>90</sup>

There are significant distinctions between the narrow definition of Section 652C of the *Restatement (Second) of Torts* and the broad scope of the right of publicity under the definition in Section 46 of

the *Restatement (Third) of Unfair Competition*.<sup>91</sup> Namely, in the latter, the mere inclusion of “other indicia of identity” allows for plaintiffs, such as Motschenbacher and Vanna White, to claim that defendants impersonated them, although their names or direct likenesses were not used. They claim that defendants’ use encompassed indicia of their identities, thus violating their right of publicity. Consequently, NCAA SAs who want to claim violations of their right of publicity only have to show that their identities had been misappropriated in EA’s video games; they do not need to prove their names and likenesses were used without their permission.

### Right of Publicity Evolution

This section: (1) explores the connection between the right to privacy and the right of publicity, (2) examines case law pertaining to the right of publicity, (3) draws partial conclusions applicable to the *Keller* case, (4) investigates state right of publicity claims (including the challenging and particularly intriguing federal preemption issues), and (5) examines the federal Trademark Act claims.

The right of publicity has become accepted as the inherent right to control the commercial use of one’s identity.<sup>92</sup> It is mainly a creature of state law, although in many cases, plaintiffs use a false endorsement claim under Section 43(a) of the Federal Trademark (Lanham) Act.<sup>93</sup> In some instances, the latter may be the sole remedy, if there is no common law or statutory right of publicity within the respective jurisdiction. According to the most recent (2006) data by the National Conference of State Legislatures, there are 30 states with either a common law (11) or statutory (19) right of publicity.<sup>94</sup> The American Bar Association (“ABA”) and the International Trademark Association (“INTA”) have focused on a federal right of publicity<sup>95</sup> to discourage forum shopping.

In 1941, one of the first appropriation cases of a college athlete’s picture, likeness, or identity involved Pabst Beer Co. using a Texas Christian University (“TCU”) football SA’s picture in a promotional calendar.<sup>96</sup> The SA, David O’Brien, was a member of the Allied Youth of America, who promoted abstinence from alcohol. Thus, O’Brien filed suit claiming his right to privacy had been invaded and he had suffered damages. Two of the three judges deciding the case held that O’Brien had enjoyed his notoriety and fame through

success on the football field, so he could not claim that he should be shielded from use of his picture by Pabst.<sup>97</sup> The Fifth Circuit further established that O’Brien consistently consented to the use of his picture by the TCU Publicity Department.<sup>98</sup> The basic foundation of intercollegiate athletics, including amateurism and the academic focus, has remained unchanged from 1941 and 2009, so comparisons can be made between the eras.

In dissent, Judge Holmes vehemently disagreed with the notion that famous personalities should not be protected from commercial advertisers using their pictures and identities.<sup>99</sup> He argued that just because the plaintiff failed to claim lost revenue damages from the beer advertisement does not mean that he should be precluded from damages for a violation of his right to privacy. The judge concluded with a useful tort litigation lesson: “One who sues for damages for a tort does not endorse or condone the wrong, regardless of the form in which he may seek damages therefore.”<sup>100</sup>

In 1953, the Second Circuit became the first to officially develop the distinction between the right to privacy and the right of publicity.<sup>101</sup> In *Haelan Laboratories v. Topps Chewing Gum*, the competing chewing gum manufacturers made important arguments with regard to publication of baseball players’ pictures. The plaintiffs argued that they had an exclusive right to use the pictures through a contract with the players; thus, the defendants should be enjoined from using the pictures on their baseball cards. The defendants argued that “a man has no legal interest in the publication of his picture other than his right of privacy, i.e., a personal and non-assignable right not to have his feelings hurt by such a publication.”<sup>102</sup> The Second Circuit disagreed, with Judge Frank declaring:

This right might be called a “right of publicity.” For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.<sup>103</sup>

In 1974, the Ninth Circuit delivered an important decision, extending the scope of the right of publicity. In *Motschenbacher v. RJ Reynolds*, the defendant company went to great lengths “doctoring” the images of race cars and the surrounding environment, but the court held that the plaintiff’s identity was sufficiently identifiable and misappropriated by the defendants.<sup>104</sup> This decision has important ramifications for ensuing cases, including the pending one in *Keller*. Namely, given the commercial value of SAs’ identities, they may be shielded from misappropriation. The discussion below considers whether a manufacturer’s attempt to alter images (i.e., “scramble”<sup>105</sup>) may be sufficient to cover the identity of a plaintiff. In the environment where EA Sports’ video games take place, there is little doubt that the use of NCAA SAs in video games is protected under the *Motschenbacher* scope. Indeed, their right of publicity would withstand such broad protection not only in California, but in other jurisdictions as well.<sup>106</sup>

In 1978, in *Ali v. Playgirl*, Muhammad Ali sued *Playgirl* magazine under the New York right of privacy statute and further alleged a violation of his common law right of publicity. The magazine published a drawing of a nude, black male sitting on a stool in a corner of a boxing ring with hands taped and arms stretched on the ropes. The district court concluded that Ali’s right of publicity was invaded because the drawing sufficiently identified him despite the caption, “Mystery Man.” The district court found that the identification of Ali was made certain because the figure was captioned as “The Greatest,” the term coined by Ali.<sup>107</sup>

In *Carson v. Here’s Johnny Portable Toilets*, the Sixth Circuit favored the plaintiff with regard to a violation of his right of publicity via the use of the catch phrase “Here’s Johnny,” which was both broadly associated with Johnny Carson and used by his business ventures.<sup>108</sup> Even though Carson lost his Lanham Act (no likelihood of confusion) and invasion of privacy claims, the majority of the court believed that the use of the phrase violated Carson’s right of publicity:

[A] celebrity’s legal right of publicity is invaded whenever his identity is intentionally appropriated for commercial purposes. . . . It is not fatal to appellant’s claim that appellee did not use his “name.” Indeed, there would have been no violation of his right of

publicity even if appellee had used his name, such as “J. William Carson Portable Toilet” or the “John William Carson Portable Toilet” or the “J. W. Carson Portable Toilet.” The reason is that, though literally using appellant’s “name,” the appellee would not have appropriated Carson’s identity as a celebrity. Here there was an appropriation of Carson’s identity without using his “name.”<sup>109</sup>

Judge Kennedy’s elaborate dissenting opinion forecasted areas with which the law presently is attempting to grapple, including the policy considerations of federal monopolies, First Amendment protection in a public domain, and the limits of rights’ protection. The dissent argues:

The right of publicity, whether tied to name, likeness, achievements, identifying characteristics or actual performances, etc. conflicts with the economic and expressive interests of others. Society’s interests in free enterprise and free expression must be balanced against the interests of an individual seeking protection in the right of publicity where the right is being expanded beyond established limits. In addition, the right to publicity may be subject to federal preemption where it conflicts with the provisions of the Copyright Act of 1976.<sup>110</sup>

The majority of the Sixth Circuit decided that a phrase relating to the plaintiff’s identity should be encompassed in his right of publicity. The defendant had appropriated Carson’s identity and its commercial value by such use of the phrase without consent.

Amid federal circuits’ decisions and considerable controversy, the U.S. Supreme Court delivered its opinion in the “human cannonball” case in 1977.<sup>111</sup> The “Flying Zacchini” had not consented to an Ohio television station broadcasting his performance. The defendants claimed that the broadcast was protected free speech. A 5–4 majority disagreed, resolving the conflict between entertainment, newsworthiness, and individual proprietary rights in favor of the latter:

Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, the U.S. Const. amends. I and XIV do not immunize the media when they broadcast a performer’s entire act without his consent. The United States Constitution no more prevents a state from requiring a respondent to compensate a petitioner for broadcasting his act on television than it would privilege the respondent to film and broadcast a copyrighted dramatic work without liability to the copyright owner . . . , or to film and broadcast a prize fight, or a baseball game, where the promoters or the participants had other plans for publicizing the event. . . .<sup>112</sup>

The rationale for [protecting the right of publicity] is the straight-forward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.<sup>113</sup>

Thus, the baton was passed to federal circuits and state courts to decide on further rights of publicity. The message was rather clear from the U.S. Supreme Court majority: “Don’t use without consent.” Consent continues to be a popular defense in misappropriation claims and will be one of the most contentious areas litigated in the *Keller* case.

One case that has a significant chance of influencing judicial decision making in *Keller* is the *Vanna White* case.<sup>114</sup> The advertisement that spawned the litigation featured a robot dressed as Vanna White next to a Wheel of Fortune. The majority held that Samsung had violated White’s right of publicity. Citing Prosser’s footnote on the potential breadth of coverage for the right of publicity,<sup>115</sup> *Motschenbacher*,<sup>116</sup> and *Carson*,<sup>117</sup> the majority opined:

The impossibility of treating the right of publicity as guarding only against a laundry list of specific means of appropriating identity. A rule which says that the right of publicity can be infringed only through the use of nine different methods of appropriating identity merely challenges the clever advertising strategist to come up with the tenth. . . . Indeed, if we treated the means of appropriation as dispositive in our analysis of the right of publicity, we would not only weaken the right but effectively eviscerate it. . . . Viewed separately, the individual aspects of the advertisement in the present case say little. Viewed together, they leave little doubt about

the celebrity the ad is meant to depict.<sup>118</sup>

Furthermore, the majority proceeded with the “Michael Jordan” hypothetical, which is now popular in intellectual property academic scholarship. The following example particularly pertains to athletes’ right of publicity and direct correlation to *Keller* may be forthcoming in the pending case:

Consider a hypothetical advertisement which depicts a mechanical robot with male features, an African-American complexion, and a bald head. The robot is wearing black hightop Air Jordan basketball sneakers, and a red basketball uniform with black trim, baggy shorts, and the number 23 (though not revealing “Bulls” or “Jordan” lettering). The ad depicts the robot dunking a basketball one-handed, stiff-armed, legs extended like open scissors, and tongue hanging out. Now envision that this ad is run on television during professional basketball games. Considered individually, the robot’s physical attributes, its dress, and its stance tell us little. Taken together, they lead to the only conclusion that any sports viewer who has registered a discernible pulse in the past five years would reach: the ad is about Michael Jordan.<sup>119</sup>

However, Judge Alex Kozinski’s dissent<sup>120</sup> made important theoretical points regarding the scope of the right of publicity. Kozinski asserted:

Something very dangerous is going on here. Overprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain. Nothing today, likely nothing since we tamed fire, is genuinely new: Overprotection stifles the very creative forces it’s supposed to nurture. . . . Concerned about what it sees as a wrong done to Vanna White, the panel majority erects a property right of remarkable and dangerous breadth: Under the majority’s opinion, it’s now a tort for advertisers to remind the public of a celebrity. Not to use a celebrity’s name, voice, signature or likeness; not to imply the celebrity endorses a product; but simply to evoke the celebrity’s image in the public’s mind. This Orwellian notion withdraws far more from the public domain than prudence and common sense allow. It conflicts with the Copyright Act and the Copyright

Clause. It raises serious First Amendment problems. It's bad law, and it deserves a long, hard second look. . . . All creators draw in part on the work of those who came before, referring to it, building on it, poking fun at it; we call this creativity, not piracy. . . . The panel is giving White an exclusive right not in what she looks like or who she is, but in what she does for a living. . . . Intellectual property rights aren't free: They're imposed at the expense of future creators and of the public at large. . . . This is why intellectual property law is full of careful balances between what's set aside for the owner and what's left in the public domain for the rest of us.<sup>121</sup>

Although Judge Kozinski's views were not espoused by the "Hollywood Circuit,"<sup>122</sup> they were adopted by other federal circuits.<sup>123</sup> In *Cardtoons v. Major League Baseball Players Ass'n*, the Tenth Circuit followed Judge Kozinski's rationale and awarded First Amendment protection over parody cards depicting baseball players. In *ETW Corp. v. Jireh Publishing*, well-known sports artist, Rick Rush, created a painting of Tiger Woods during his first record-setting win at the Masters golf tournament, and adorned the painting's background with past golf stars. The Sixth Circuit cited Judge Kozinski and held that Woods' right of publicity was not violated by such an artistic, transformative, and First Amendment-protected use.

In *Montana v. San Jose Mercury News*,<sup>124</sup> the court held that posters of Joe Montana's triumphant moments, regardless of whether they were made for profit, were protected under the First Amendment. They were exempted from the statutory right of publicity in Section 3334(d) of the Civil Code<sup>125</sup> because Joe Montana was a major player in many newsworthy sporting events.

Moreover, in *Gionfriddo v. Major League Baseball*,<sup>126</sup> former professional baseball players argued their common law and statutory rights of publicity were violated by Major League Baseball's ("MLB") use of their names, photographs, and video images on Web sites, media guides, video clips, and game programs. In a decision that helped extend public domain borders in cases of factual data (i.e., names and statistics in fantasy sports),<sup>127</sup> the California court declared that the information posted by MLB was protected speech. MLB did not sell a product, so it did not provide a

typical commercial use. Yet, the court held that the public's interest in using the free information to bolster its fascination with baseball outweighed the players' proprietary rights. Due to the statutory exemption for sports figures discussed in *Montana*, the plaintiffs were not able to establish a violation of a right of publicity.

By considering a few key elements from the preceding examination, some conclusions can be drawn regarding the *Keller* case (refer to Table 2 for the most significant cases in right of publicity evolution). Considering the broad scope of the *Restatement (Third) of Unfair Competition* (with regard to "other indicia of identity"), *Motschenbacher*, *Carson*, *White*, and a significant body of related cases,<sup>128</sup> NCAA SAs do not appear to have too heavy a burden of proof with their right of publicity claims because their identities (i.e., team affiliation, roster number, height, weight, playing characteristics) appear to be established in the overall environment of college video games. Attempts to modify or scramble SAs' likenesses may not overcome the fact the images and identities are sufficiently identifiable. In cases where there was little doubt about to whom the advertisement referred, the decisions upheld the plaintiff's right of publicity. In contrast, judicial analysis assimilating Kennedy's dissent in *Carson*, in addition to Kozinski's theory, may lead to a decision that favors the interests of video game manufacturers. A richer public domain may form by controlling the scope of plaintiffs' right of publicity, particularly when a creation is deemed newsworthy, artistic, transformative, or protected by the First Amendment. The latter and several other federal preemption opportunities are elaborated on in later sections of this article.

### **State Right of Publicity Claims Application and Federal Preemption Issues**

**1. The State Right of Publicity Case.** Before applying California and Indiana statutes to the factual background of the *Keller* case, it is useful to refer to the *Restatement (Third) of Unfair Competition* for the burden of proof to establish a violation of SAs' right of publicity. The elements are:

1. NCAA and EA Sports' use of the plaintiff's identity;
2. Identity has commercial value;
3. Appropriation of commercial value for purposes of trade;
4. Lack of consent; and
5. Resulting commercial injury.<sup>129</sup>

For the second element, identity has to be established as commercially valuable and sufficiently recognizable. In *Pesina v. Midway Manufacturing*,<sup>130</sup> a martial artist had modeled for the manufacturers of the arcade game *Mortal Combat*. Thereafter, the manufacturers proceeded to use the footage and images for the home video game version. Pesina inter alia argued his common law right of publicity<sup>131</sup> had been violated. The court found no evidence to establish the plaintiff's identity had value prior to its association with the manufacturer. The latter was decisive for the federal Lanham Act claim as well, as the plaintiff could not prove consumer confusion with his identity and the game character. With regard to litigation strategy and necessary case management,<sup>132</sup> the court advises:

While Mr. Pesina offers nothing, the defendants present convincing evidence that the public does not recognize Mr. Pesina in the home version of *Mortal Kombat* and *Mortal Kombat II* and the related products. The video images of Mr. Pesina's movements were extensively altered prior to being incorporated into the games. Thus, after comparing Mr. Pesina and the game character, Johnny Cage, who allegedly resembles the plaintiff, only 6% of 306 *Mortal Kombat* users identified Mr. Pesina as the model. As to the defendants' use of Mr. Pesina's name, it appears only in *Mortal Kombat*, only for eight seconds, and only when a player wins the game. . . . Only one respondent actually knew that Mr. Pesina modeled for Johnny Cage. . . . Mr. Pesina could argue that he became so associated with Johnny Cage that the character invokes Mr. Pesina's identity. Thus, his right to publicity would be invaded by the defendants' use of Johnny Cage. . . . To prevail on this theory, however, Mr. Pesina would have to show that his identity became "inextricably intertwined" in the public mind with Johnny Cage. This Mr. Pesina cannot do since the evidence shows that Mr. Pesina is not a widely known martial artist and the public does not even recognize him as a model for Johnny Cage.<sup>133</sup>

Thus, if NCAA SAs, especially the ones termed "benchwarmers" with only sparse playing time, could not establish commercial value prior to the use of their likenesses and

identities in the video games, their common law right of publicity claims would fail. A legal team managing such a case would be well served with a commissioned consumer confusion survey.

One should note that plaintiffs claiming violations of their right of publicity need to use research-based financial data demonstrating the economic impact and loss suffered. Thus, e.g., NCAA SAs could summon the research recently conducted in related litigation with regard to loss suffered by retired NFL players.<sup>134</sup>

In Indiana, Code § 32-36-1-8 declares:

(a) A person may not use an aspect of a personality's right of publicity for a commercial purpose during the personality's lifetime or for one hundred (100) years after the date of the personality's death without having obtained previous written consent.<sup>135</sup>

The defense of consent is elaborated on in the ensuing section. It substantially pertains to the unique nature of intercollegiate athletics as an avocation and mainly an educational pursuit, as posited in the NCAA Bylaws.<sup>136</sup> *Keller* presupposes that neither express nor implied consent was ever submitted to the NCAA and the institutions.

In California, Section 3344 of the Civil Code contains the following:

(a) Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof. . . . Punitive damages may also be awarded.<sup>137</sup>

**2. Consent and Federal Preemption.** The NLI and institutional GIA agreements do not contain express permission to use NCAA SAs' likenesses,<sup>138</sup> and SAs do not waive their right of publicity under the parameters of the current use in EA Sports video games. The generic policies contained in the NCAA Manual (Bylaw 12.5 et seq.) provide no treatment for the legal problems posed by the current use by EA Sports. Although there are other express waivers regulated in the NCAA Manual (e.g., FERPA, HIPAA, and drug-testing releases),<sup>139</sup> there are none for SAs' intellectual property rights other than what is extended from Bylaw 12.5. One could extricate an implied consent encompassing any and all NCAA regulations as they are voted on by the membership and interpreted by NCAA governing bodies and staff. This implied consent lies within NCAA constitutional principle 2.8.1 on rules' compliance, which mandates SAs to comply with applicable association rules, including the bedrock principle of amateurism. Furthermore, Bylaw 14.01.3 makes intercollegiate athletic eligibility contingent upon SAs' compliance with all applicable rules of the association, academic institution, and conference.<sup>140</sup> The NCAA and EA could additionally use the consent defense as an extension of the generic releases in the form SAs sign (currently 08-3a), which declares they have read, understood, and complied with all applicable NCAA regulations.<sup>141</sup> Thus, one could argue the element of consent may be established.

Next to the defense of consent, plaintiffs in such cases need to go through possible federal preemption of any state law claims. Most, if not all, of the cases cited herein have dealt with federal preemption of common law and statutory rights of publicity. Federal preemption is grounded on several theories.<sup>142</sup> As Marr observes in his 2003 *Boston College Law Review* article:

The existing hodgepodge of state statutory and common law that makes up the right of publicity appears to be a minefield of constitutional hazards. Courts must consider a variety of First Amendment, Copyright Clause, Commerce Clause, Due Process Clause, and Full Faith and Credit Clause issues when resolving publicity rights cases.<sup>143</sup>

Important cases illustrate the conflicts under analysis and provide guidance for courts reviewing *Keller* and related cases. In *Cardtoons v. Major League Baseball Players Ass'n*,<sup>144</sup> the Tenth Circuit held that Cardtoons' First Amendment right to parody baseball players in a transformative, artistic way preempted the players' state-based rights of publicity. Although Cardtoons violates the players' rights, the statute allowed for newsworthy, noncommercial use, and thus, the comic use deemed "commentary on an important

social institution."<sup>145</sup> While attempting to balance celebrities' rights with the public interest and First Amendment protections, one problem with the courts' reasoning is that prominent figures "are already handsomely compensated."<sup>146</sup> If this becomes a decisive point in upcoming litigation, NCAA SAs may be considered under a different prism, as they do not receive compensation for their athletic performances.

*C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media*<sup>147</sup> has been extensively covered in recent legal scholarship. The landmark finding was that the combination of names and statistics used in fantasy leagues is protected by the First Amendment as factual data readily available in the public domain.<sup>148</sup> Disagreeing with the district court, the Eighth Circuit found that the elements for establishing a violation of the baseball players' rights of publicity had been met under Missouri common law. The First Amendment preemption over the common law rights of publicity was established even though the use had a commercial nature. Furthermore, in dissent, Judge Colloton argues that C.B.C. could agree to bargain away any tentative constitutional rights in exchange for a beneficial licensing contract.<sup>149</sup> Perhaps the most obscure item of the C.B.C. case is the disagreement between the majority and Judge Colloton on the contractual issue, particularly as it pertained to the doctrine of licensee estoppel.<sup>150</sup> The majority handles the question differently than the district court; the Eighth Circuit majority simply determines that the MLB Players Association ("MLBPA") materially breached the contract via its affirmation of holding "any right, title and interest";<sup>151</sup> thus, C.B.C. was relieved from the no-challenge and no-use provisions of the past license.

The alternative and intriguing approach by the district court was the application of *Lear, Inc. v. Adkins*.<sup>152</sup> In *Lear*, the U.S. Supreme Court declared that licensee estoppel yields to the "strong federal policy favoring the full and free use of ideas in the public domain."<sup>153</sup> Whereas *Lear* dealt with patent disputes, licensee estoppel preemption under the *Lear* doctrine is found in other areas of intellectual property law (e.g., *Idaho Potato Commission v. M&M Produce Farm & Sales*<sup>154</sup> [on certification marks], *Beer Nuts, Inc. v. King Nut*

Co.<sup>155</sup> [trademarks], and *Saturday Evening Post Co. v. Rumbleseat Press, Inc.*<sup>156</sup> [copyright]). As the majority opinion acknowledges, the district court's position on *Lear's* application to a state right of publicity was unique.<sup>157</sup> In his dissent, Judge Colloton also admonishes the district court's fiction, aptly planting the seeds for further federal legislation with respect to the right of publicity:

The *Lear* approach to preemption has been extended only to areas where there are comparable federal policies derived from federal statutes that justify the preemption of state law. In this case, there is no federal statute that addresses state-law contract obligations with respect to the right of publicity, and no indication that Congress sought to abrogate contracts in this area that are otherwise enforceable under state law. I would not fashion a rule of federal common law that abrogates these freely negotiated contractual provisions.<sup>158</sup>

C.B.C. undoubtedly has prospects of application on *Keller* and SAs' claims. Indeed, the most difficult challenge in forthcoming litigation is delineating the new frontiers to this expanded public domain.<sup>159</sup> Would it be prudent to argue that images, likenesses, and identities of both real people and their avatars,<sup>160</sup> artistic creations, expressive works, and so forth would all be within the realm of a limitless public domain, through the advent of new media, multiplayer online role-playing games ("MMORPGs"), and virtual interactive worlds where innovation and creativity are compensated in more than virtual money?<sup>161</sup> In light of *Keller*, would it be reasonable to assume that because SAs' names, likenesses, and identities are broadly available for use on the Internet, their images in video games would not be protected under the right of publicity? Finally, C.B.C.'s application of *Keller* may encompass the procedurally instrumental doctrine of licensee estoppel. Although, usually the doctrine would find application in cases of licensees wishing to challenge licensors whom they might have indemnified in contract, the parties in *Keller* present scholars and litigation strategists with a more theoretical prospect. The first question is whether EA is able to em-

TABLE 2

CASE	YEAR	WINNER	USAGE	RATIONALE
O'Brien	1941	D	Picture featured in calendar advertisement	O'Brien consents to use of picture by athletic department
Haelan	1953	P	Picture on baseball card	Identity sufficiently identifiable
Motschenbacher	1974	P	Altered image in advertisement	Identity sufficiently identifiable
Ali	1978	P	Likeness in form of drawing with features similar to Ali's	Identity sufficiently identifiable
Carson	1983	P	Catch phrase used to promote business	Appropriation of identity without using name
Flying Zacchini	1977	P	Television station broadcast of performance	No consent to use
Vanna White	1993	P	Advertisement featuring robot (persona) dressed as Vanna White next to a Wheel of Fortune	Celebrities protected from any use in which they are identifiable
Wendt	1999	P	Robotic look-alikes (persona) in airport bars	Substantially similar to constitute likeness
Cardtoons	1996	P	Image in parody cards	Protected use; free speech; parody; transformative and artistic
ETW Corp. v. Jireh (Tiger Woods in Augusta)	2003	D	Image in painting	Artistic, transformative, protected by First Amendment use
Montana	1995	D	Image in poster	Major player in contemporaneous newsworthy sports events
Gionfriddo	2001	D	Statistics	Statistical information is protected speech; public interest served by free communication of baseball information
C.B.C.	2009	D	Name and stats	Public domain
Uhlaender	1970	P	Name and stats	RoP violation; identifiable

ploy licensee estoppel doctrine in its defense; arguing that because it could not challenge the validity of the NCAA's license, it could not have violated SAs' rights of publicity, thus deferring liability to the NCAA. Additionally, in the scenario of EA suing the NCAA or vice versa (i.e., license breach, declaratory judgment to allow for/preempt use of SAs' images in present SAs' video games, and so forth), would licensee estoppel preemption under *Lear* allow for the challenge of the license, thus extending C.B.C.'s public domain theory coverage to video games and likenesses?<sup>162</sup>

In addition to First Amendment preemption, the Commerce Clause<sup>163</sup> and the dominant Copyright Clause<sup>164</sup> arguably contradict the right of publicity scope extensions.<sup>165</sup> In the *White* dissent, Judge Kozinski delves into due process territory as well, arguing that the unprecedented extent the majority recognized for the right of publicity may be held as too vague to satisfy the Fifth and the Fourteenth Amendment protections.<sup>166</sup>

Contrary to *Cartoons* and *C.B.C.*, some cases have not found federal preemption of state misappropriation claims or of statutory or common law rights of publicity. Two important decisions are *National Basketball Ass'n v. Motorola, Inc.*,<sup>167</sup> and *Facenda Jr. v. NFL Films, Inc.*<sup>168</sup> In the former, the preemption embedded in the federal Copyright Act<sup>169</sup> did not thwart state misappropriation claims because of "extra elements" often encountered in related intellectual property litigation. The case involved the creation of real-time score updates of pagers and an extensive monitoring system around NBA games, which Motorola implemented in an attempt to capture the market for live information and news. The court held that the NBA was unsuccessful in establishing the commercial misappropriation claim, as Motorola's product was not considered a substitute to NBA games, and it did not substantially threaten the NBA's quality or very existence. Conversely, *Keller* needs to investigate whether any extra elements exist for the state claims to survive federal preemption,

ONE OF THE BROADCASTERS FOR THE NCAA FOOTBALL GAME, AN ABC/ESPN PLAY-BY-PLAY BROADCASTER, BRAD NESSLER, STATED THAT HE AND OTHER BROADCASTERS "RECORD THE NAME OF THE PLAYERS, EVEN THOUGH WE KNOW WE'RE NOT SUPPOSED TO."

e.g., the NCAA's copyright preemption of NCAA SAs' state rights of publicity.

*Facenda Jr. v. NFL Films, Inc.* may provide some guidance for the California courts and possibly the Ninth Circuit. In *Facenda*, the Third Circuit concluded that John Facenda's (Estate's) statutory right of publicity under Section 8316 of Chapter 42 of the Pennsylvania Consolidated Statutes would not be preempted by the NFL's copyright of its games' telecasts, for which John Facenda had provided his epic baritone voice. The NFL used the popular defense of "derivative works" per Section 103 of Chapter 17 of the United States Code. The Third Circuit was not convinced, on two grounds. First, the commercial value in his voice, per Section 8316(e) of the Pennsylvania statute, added an extra element that goes beyond a copyright infringement burden of proof. Second, the Third Circuit posited that the focus should be on the precise subject matter, which was Facenda's voice, not its recordings.<sup>170</sup> Moreover, the Third Circuit's decision in *Facenda* serves as a significant contribution on the "conflict preemption" problem; e.g., "when does the right of individuals to avoid commercial exploitation of their identities interfere with the rights of copyright owners to exploit their works?"<sup>171</sup> The answer is twofold:<sup>172</sup> Where commercial use is the primary motive, state rights of publicity are not preempted;<sup>173</sup> they are preempted, however, where the plaintiff

has consented through a contract to the copyrighted use of his or her likeness, and such use is incorporated into expressive works by the copyright holder. *Facenda* did not consent to commercial endorsements in an NFL agreement summoned by the court. Similarly, NCAA SAs may argue that they did not consent to the particular use of their identities in EA's video games. Thus, their rights of publicity would not be preempted by NCAA's and EA's copyrights.

There is yet another twist in the federal copyright preemption of common law and statutory rights of publicity: the "work for hire" doctrine and its potential application to NCAA SAs' cases. According to Section 101 of Chapter 17 of the United States Code, "work for hire," is defined as:

- (1) a work prepared by an employee within the scope of his or her employment; or
- (2) a work specially ordered or commissioned for use as a contribution to a collective work . . . , as a supplementary work . . . , if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.<sup>174</sup>

Considering the aforementioned preemption of Section 301 of Chapter 17 of the United States Code, works for hire under Section 101 preempt any common law or statutory rights of publicity.<sup>175</sup> However, how could the "work for hire" doctrine apply to NCAA SAs when the latter are considered students rather than employees?

The NCAA recognized the threat posed by SAs being declared employees of a university. After the failure of the Sanity Code in the early 1950s, the NCAA crafted the term "student-athlete," engaging in a long-term public relations campaign to convince lawmakers, courts, media, and the public that athletes were students first and not employees of the athletic department.<sup>176</sup> While Congress and courts have generally sided with the NCAA, scholars have argued for classifying SAs as employees of the university.<sup>177</sup> Analysis of court decisions on workers' compensation, unionization attempts by students, and the option for SAs to receive certain employee benefits, such as health insurance, may lend support to those scholars' notions.

While various courts have denied workers' compensation benefits to college athletes because they were not considered employees of the university,<sup>178</sup> legal scholars<sup>179</sup> have argued that SAs are employees

by examining common law and statutory claims on which either the courts or the National Labor Relations Board (“NLRB”) ruled in the following manner: (1) SAs are university employees eligible for workers’ compensation;<sup>180</sup> (2) SAs are employees but not eligible for workers’ compensation;<sup>181</sup> (3) graduate assistants (“GAs”) are university employees;<sup>182</sup> and (4) GAs are not employees, but legal analysis leads to the conclusion that (certain) college athletes are employees under the NLRB’s statutory test in *Brown University*.<sup>183</sup>

In order for college athletes to be considered “employees,” they must meet the common law and statutory definitions of the term. Division I scholarship athletes in revenue-generating sports may be construed as “employees” under common law because they: (1) enter into an agreement in the form of a scholarship that determines their compensation and responsibilities, (2) are economically dependent upon their universities, and (3) are controlled on a daily basis by the university during the season and off-season.<sup>184</sup> College athletes may meet the statutory definition of the term “employee” as set forth in *Brown*. McCormick and McCormick<sup>185</sup> argued that the primary relationship between athletes and the university is economic, whereas between GAs and the university it is academic. First, the authors argue, GAs spend most of their time on academic endeavors, while athletes spend a majority of their time performing their athletic duties and not on academic pursuits. Second, unlike GAs who provide services directly related to their course of study, the services performed by athletes are entirely unrelated to their course work and degree requirements. Third, unlike GAs who are supervised by the academic faculty, athletes are supervised by the coaching staff, demonstrating that the work of athletes is not academic. Finally, McCormick and McCormick<sup>186</sup> posit that the university’s relationship with the athlete is economic in nature by documenting ways in which academic standards are marginalized to serve economic rather than legitimate academic values. These practices include enrolling under-qualified athletes, allowing for freshman athletic eligibility, utilizing rigorous playing and practice schedules, and observing bogus curricula. The authors also note the substandard academic performance among revenue-producing athletes, cases of academic fraud to keep athletes eligible,

and low graduation rates.

Moreover, the fact that SAs generally have a contractual relationship with the institution,<sup>187</sup> combined with the opportunity to receive employee benefits<sup>188</sup> and the prospect of multiyear scholarships, may compromise the effectiveness of an amateurism defense in cases for the NCAA. However, in a case such as *Keller*, it may prove a shrewd defensive tactic, as the “work for hire” theory impacts the federal copyright preemption of SAs’ rights of publicity. Of course, it does not appear logical for the NCAA to argue for employee status of the SAs, because this could jeopardize its tax-exempt status. It may also lead to changes in the dynamics between SAs, the institution, and the association, which could ultimately involve collectively bargaining a new series of rights for SAs. Currently, institutions would rather discontinue athletic programs than risk entering a new legal phase and a possibly insurmountable financial burden.

**3. Class Action Status.** To achieve class action status, the *Keller* case must satisfy Rule 23 of the Federal Rule of Civil Procedure, which states:

(a) Prerequisites.

One or more members of a class may sue or be sued as representative parties on behalf of all members only if:

1. the class is so numerous that joinder of all members is impracticable;
2. there are questions of law or fact common to the class;
3. the claims or defenses of the representative parties are typical of the claims or defenses of the class; and
4. the representative parties will fairly and adequately protect the interests of the class.<sup>189</sup>

There are two major motives for class actions: (1) to allow for judicial economy by avoiding multiple suits, and (2) to protect rights of plaintiffs who otherwise may not be able to bring claims on an individual basis.<sup>190</sup> The district court needs to decide whether the class may be maintained under Rule 23(b). Specifically, a class can be maintained if: (1) prosecuting separate actions would create a risk of incompatible decisions and standards of conduct;<sup>191</sup> (2) separate decisions would be dispositive of the interests of other members, nonparties to the individual adjudications, or would impair their abilities to protect their interests;<sup>192</sup> (3) the party opposing the class has acted in a way that applies generally to the class and final injunctive or corresponding declaratory relief is appropriately applied to the whole class;<sup>193</sup> or (4) if “the court finds that the questions of law or fact common to class members predominate over any questions affecting only individual members and that a class action is superior to other available methods for fairly and efficiently adjudicating the controversy.”<sup>194</sup>

These tests for class action certification in Rule 23(b)(3) attempt to determine whether the proposed class would be “sufficiently cohesive to warrant adjudication by representation.”<sup>195</sup> When determining superiority, the court also must consider the four factors under Rule 23(b)(3):

- (A) the class members’ interests in individually controlling the prosecution or defense of separate actions;
- (B) the extent and nature of any litigation concerning the controversy already begun by or against class members;
- (C) the desirability or undesirability of concentrating the litigation of the claims in the particular forum; and
- (D) the likely difficulties in managing a class action.<sup>196</sup>

Useful lessons in light of the pending class action status in *Keller* are derived from two recent class action suits in California: *White v. NCAA*<sup>197</sup> and *Adderley v. NFLPA*.<sup>198</sup> The latter was a breach of contract and fiduciary duty action, the former an antitrust complaint. In *White v. NCAA*, the plaintiffs challenged the cap on GIAs, covering only tuition, books, and room and board. They argued that absent such horizontal restraints, revenue-producing athletic programs (namely Division I football and men’s basketball) would compete for packages covering the full cost of attendance (“COA”). They defined the class as SAs having received GIAs from “major college football and basketball programs” from a particular point in time through the present.<sup>199</sup> It is prudent to draw some comparisons, as the

*Keller* case features the same revenue-producing programs for SAs and defines the class as:

All NCAA football and basketball players listed on the official opening-day roster of a school whose team was included in any interactive software produced by Electronic Arts, and whose assigned jersey number appears on a virtual player in the software.

While applying Rule 23(a) requirements to the *White v. NCAA* class action, the court held:<sup>200</sup>

1. Plaintiffs propose a class of more than 48,000. . . . Joinder is impracticable. The numerosity requirement is met.
2. The commonality requirement is generally construed liberally; the existence of only a few common legal and factual issues may satisfy the requirement . . . the class members' claims derive from a common core of salient facts, and share many common legal issues. . . . The commonality requirement is met.
3. Plaintiffs . . . allege they were affected by the GIA cap in the same way . . . [plaintiffs] met the typicality requirement.
4. The adequacy representation requirement . . . involves a two-part inquiry: (1) do the named plaintiffs and their counsel have any conflicts of interest with other class members; and (2) will the named plaintiffs and their counsel prosecute the action vigorously on behalf of the class.<sup>201</sup> . . . The NCAA argues plaintiffs . . . have an inherent conflict of interest . . . the quality of student-athlete varies widely in terms of athletic talent. Athletic talent translates into dollar value . . . if the GIA did not limit . . . aid then the variation in athletic talent would likely result in the variation of aid amounts. The result . . . is conflict among class members. . . . The NCAA's argument is logical. But given the specifics of plaintiffs' damages claim, the Court finds little danger of intra-class conflict. Plaintiffs argue . . . all or nearly all . . . would receive far more than the COA if schools had unfettered discretion . . . even the marginal<sup>202</sup> player commands a value greater than his COA. . . . The Court sees no actual conflict of interest . . . plaintiffs are adequate representatives.

The *Keller* case will also have to meet the Rule 23(a) requirements. Again, the contentious issues will be whether the plaintiffs have conflicts of interest and if they are adequate representatives for the class. On the same issue, the *Adderley* class action found that one of the initial class representatives, Parrish, was not adequate due to a personal vendetta with NFLPA head, Upshaw.<sup>203</sup> Absent any such entanglements, the court will decide on adequacy after reviewing the parties' submissions and deciphering terms, such as "marquee versus marginal players," "revenue versus nonrevenue producing teams," and so forth. It should be noted that *Keller* recommends the class include players ". . . on the official opening-day roster of a school whose team was included in any interactive software produced by Electronic Arts, and whose assigned jersey number appears on a virtual player." This appears to serve a few goals, ensuring that players who were cut, injured, and not playing, but still "in the game"<sup>204</sup> would join the class; that any school appearing in the video game would be included; and that all assigned jersey numbers in the game would be accounted for (conceivably EA Sports' video games would not create fictional players that would compromise realism for consumers<sup>205</sup>). However, it is not clear if "opening-day roster" refers to opening-day in 1960–61, as in 2008–09. Considering the *Adderley* settlement and the recent measure of EA to discontinue using legacy teams featuring retired players in new releases of the professional football video game,<sup>206</sup> it is prudent to include in the class any members whose *identities* as SAs have *ever* been featured in the video games.<sup>207</sup>

Further, with respect to Rule 23(b)(3), the challenge will be to concoct methods to apportion the financial impact and damages suffered by the class as a whole, as opposed to the court "setting a toe into the swamp of"<sup>208</sup> individual class members' inquiries. This is instrumental, as some class members would have a heavy burden of proof with respect to, for example, commercial value in their likenesses prior to the video games' use.<sup>209</sup> Procedurally, plaintiffs may wish to use potential claims by NCAA/EA as offensive weapons; e.g., where the NCAA argues that the NLI and GIA entail contracts with full compliance, including amateurism policy, the plaintiffs can exploit the common themes of the NLI/GIAs for the purposes of class certification under Rule 23(b)(3). Relevant common themes pertain to intellectual property rights' appropriation, lack of consent, consumer confusion of likenesses' use for commercial profit, and others. The rarity of intellectual property and right of public-

ity class action suits notwithstanding,<sup>210</sup> the cases above from the "Hollywood Circuit" and California assist in forecasting a possible certification of the class in the *Keller* case. However, as in *White v. NCAA*, it may be tenuous to calculate the economic impact and damages suffered by the class of SAs. Because there is no federal right of publicity,<sup>211</sup> one way to attend to the variations in state law that pose obstacles for class certification<sup>212</sup> may be the false endorsement claim in Section 43(a) of the Federal Lanham Act.<sup>213</sup>

### **The Federal Trademark (Lanham) Act Case**

Frequently plaintiffs select (or have to use) the false endorsement route and claim violations of Section 43 of the Federal Trademark (Lanham) Act.<sup>214</sup> A plaintiff using Section 43(a)(1)(A) must prove that: (1) the mark is legally protectable, (2) the plaintiff owns the mark, and (3) the defendant's use of the mark to identify its goods or services is likely to create confusion concerning the plaintiff's sponsorship. Courts have broadly interpreted "name, symbol, or device" to include any insignia of identity, such as a person's voice. For instance, in *Waits v. Frito-Lay, Inc.*, the Ninth Circuit held that "§ 43(a) claims based on voice are cognizable."<sup>215</sup> In *Waits*, Frito-Lay hired a Tom Waits impersonator to perform in a Doritos commercial. Waits successfully established false endorsement under Section 43(a)(1)(A), as well as appropriation of his voice in violation of the common law right of publicity. Similarly, in *Midler v. Ford Motor Co.*,<sup>216</sup> the Ninth Circuit held that when a distinctive voice of a singer (Bette Midler) is widely known and is deliberately imitated for commercial purposes, the sellers have committed a tort.

Applying Section 43(a)(1)(A), the first two prongs have been satisfied at the outset of the *Keller* case, with respect to the likenesses (or identities) of the SAs.<sup>217</sup> The likelihood of confusion aspect is traditionally problematic; hence, courts tend to require consumer confusion surveys<sup>218</sup> to establish the plaintiff's injury. Suggested questionnaires include sections on recognition of the plaintiff's identity, likeness, and so forth, as well as questions to decide whether the public was sufficiently confused by the endorsement and the particular role of the plaintiff in the game or advertisement.<sup>219</sup> There have been several tests developed according to each circuit's preference (e.g.,

in *Interpace Corp. v. Lapp, Inc.*,<sup>220</sup> or *AMF, Inc. v. Sleekcraft Boats*.<sup>221</sup> It is important to reiterate from *Facenda*<sup>222</sup> that unlike claims under Section 43(a)(1)(B), which require actual confusion and misleading statements, claims under Section 43(a)(1)(A) only require a “likelihood of confusion.” The major distinction between Federal Lanham Act and state right of publicity claims is that plaintiffs do not need to prove consumer confusion for the latter.

There are First Amendment preemption issues as well. In *Rogers v. Grimaldi*,<sup>223</sup> a balancing test attempts to weigh the public interest in avoiding consumer confusion against the public interest in free expression, with the latter superseding. For example, *ETW Corp. v. Jireh Publishing Inc.*<sup>224</sup> involved challenging the Rick Rush painting of Tiger Woods’ victory in Augusta, which was deemed transformative and artistic enough to achieve First Amendment protection. Basically, should a plaintiff decide to follow the Federal Trademark Act path, the answer may come from a consumer confusion survey. If the public had been sufficiently confused or had more chance of misinterpreting the contested use of plaintiff’s image/identity, then the Section 43(a)(1) claims may be successful.

## **NINTH CIRCUIT RESEARCH AND KELLER FORECAST—A PROMISING PROSPECT?**

### **Challenges to Filing Claims**

The litigation and jurisprudence detail of the Ninth Circuit helps determine whether *Keller* has positive or negative prospects on particular claims. The Ninth Circuit has held that the right of publicity “means in essence that the reaction of the public to name and likeness, which may be fortuitous or which may be managed or planned, endows the name and likeness of the person involved with commercially exploitable opportunities.”<sup>225</sup> Although this statement seems stunningly simple, the odds of a celebrity or athlete winning a right of publicity case (even) in the Ninth Circuit are not optimal. *Keller*’s case sets up the potential for the Ninth Circuit to deviate from a cautious path and start driving the law in a more technologically savvy direction.

By far, the Ninth Circuit in California has heard the most rights of publicity cases. However, plaintiffs may realize that there are many issues well-known figures face

when filing a right of publicity claim. First, plaintiffs must decide whether to sue under diversity jurisdiction or to find a federal question. Diversity cases can be complicated, and often state claims are thrown out due to Federal Copyright law preemption.<sup>226</sup> The second issue is stating claims in a way that will not get them dismissed under Rule 12(b)(6) of the Federal Rule of Civil Procedure for failure to state a claim upon which relief can be granted.<sup>227</sup> Third, the case might be dismissed for lack of personal jurisdiction because the defendant did not have enough contacts with the forum state.<sup>228</sup> Fourth is the problem of a fair use defense.<sup>229</sup> Fifth, First Amendment protection accorded noncommercial speech can play a role in quashing a plaintiff’s case.<sup>230</sup> Sixth, plaintiffs cannot seem to decide whether they have a Lanham Act claim, a Copyright Act claim, or both. Seventh, plaintiffs were dealing with the California right of publicity statute that further confused the courts in the several cases filed in the Ninth Circuit.

These are all obstacles plaintiffs face when filing their claims in the Ninth Circuit. Charts 1–3 present findings from Ninth Circuit right of publicity litigation. Chart 1 analyzes the total number of right of publicity and Federal Trademark Act false endorsement claims, the cases that applied diversity jurisdiction, and the outcomes in the district court and the Ninth Circuit. Chart 2 focuses on comparing results of cases between the district court and the Ninth Circuit. Chart 3 focuses on the Federal Trademark Act claims and their prospects, because such claims were not included in the first *Keller* complaint. As discussed previously, it appears that *Keller*’s legal team may wish to investigate that prospect carefully, considering the likelihood of consumer confusion possibilities and Ninth Circuit precedent in related cases depicted in Chart 3.

### **Sports Claims in General**

Sports right of publicity and likeness claims have not frequented the Ninth Circuit’s docket. However, there is one case that may be helpful to *Keller*’s claim. In *Abdul-Jabbar v. GMC*, the court found that there were sufficient facts to state a claim, reversed the judgment of the district court, and remanded for trial on the claims alleging violation of the California common law right of publicity, Section 3344, and the Lanham Act.<sup>231</sup> The facts of this case show that Kareem Abdul-Jabbar was named Ferdinand Lewis (“Lew”) Alcindor at birth and played basketball under that name throughout his college career and into his early years in the NBA.<sup>232</sup> While in college, he converted to Islam and began to use the Muslim name “Kareem Abdul-Jabbar” among friends. Several years later, in 1971, he opted to record the name “Kareem Abdul-Jabbar” under an Illinois name recordation statute and thereafter played basketball and endorsed products under that name.<sup>233</sup> He had not used the name “Lew Alcindor” for commercial purposes in over 10 years.<sup>234</sup> GMC used Abdul-Jabbar’s former name in a commercial. The Ninth Circuit held that reference to “name or likeness” is not limited to present or current use, and to the extent GMC’s use of the plaintiff’s birth name attracted television viewers’ attention, GMC gained a commercial advantage.

*Keller* can use this case as an example of how college sports video games’ use of SAs’ likenesses morph into loss of income for former collegiate athletes long after they have exhausted their collegiate athletic eligibilities. The implications go far beyond the “now.” There are many implications of EA (indeed under its NCAA license) using the likeness of college players and not compensating them that reach out far beyond amateurism discourse. *Keller* may proceed arguing that EA is potentially denying athletes compensation after or concurrent to a professional career, which may or may not yield sufficient funds. In addition, *Keller* could argue that if a college player is injured and cannot participate in collegiate-level athletics, that player is being denied compensation for his likeness in a video game when amateur status is no longer an issue. Furthermore, *Keller* may claim that if a player leaves college athletics prematurely to pursue a professional sport, the player is forgoing amateurism, yet the player’s likeness generates revenue for EA and NCAA member institutions with no further benefit to the player. These are all issues the Ninth Circuit may consider if *Keller* survives and does not settle.

The Ninth Circuit frequently held California common law right of publicity protects celebrities from appropriations of their identity not strictly definable as “name or picture.” Therefore, *Keller* may argue that just because EA did not use a player’s “name”<sup>235</sup> or their “picture,” that does not mean the court should find that there was no violation of the right of publicity. A video game falls into this hybrid category of likeness without using an exact likeness. *Keller* may challenge the Ninth Circuit not to rely on old interpretations or

explanations of right of publicity and likeness and embrace the realities of technology.

The Ninth Circuit also determined that GMC's unauthorized use of Abdul-Jabbar's birth name, Lew Alcindor, was likely to confuse consumers as to his endorsement of GMC's Olds 88, and thus violated the Lanham Act under Section 1125(a) of Chapter 15 of the United States Code.<sup>236</sup> This decision provides *Keller* the framework for a Lanham Act claim. And, as an extension to the pertinent likelihood of a confusion questionnaire, would consumers believe that no college athlete has ever been paid for his or her likeness being used in a game? Importantly, how many consumer confusion survey respondents would be so well-versed on NCAA policy matters that they would acknowledge consent on the part of the SAs and clearly understand that these college players do not endorse the products? It appears more likely that it would be obvious to the casual observer that such use is sponsored, agreed upon, and yields some form of compensation for the athletes involved. That could be a weapon Keller can use toward a claim of Section 43(a) of the Federal Lanham Act violation, which indeed appears reasonable to raise.

Keller also may use *Motschenbacher*<sup>237</sup> as leverage. Even in the case where players' features were not clearly visible, consumers might think the player "in question" is who they think he is. Considering the technology video game manufacturers incorporate to provide a sense of realism to the consumer, it appears logical that distinctive features of a Pixar creation would give rise to a reasonable inference of likeness. Technology has come a long way since 1974. If the court determined then that consumers could find a correlation, now that a game virtually mirrors the likeness of the player and provides the overall

## A RICHER PUBLIC DOMAIN MAY FORM BY CONTROLLING THE SCOPE OF PLAINTIFFS' RIGHT OF PUBLICITY, PARTICULARLY WHEN A CREATION IS DEEMED NEWSWORTHY, ARTISTIC, TRANSFORMATIVE, OR PROTECTED BY THE FIRST AMENDMENT.

atmosphere of the real college game, Keller may have a good case prima facie. Naturally, the defenses analyzed above would become the deciding factors.

Still, the likelihood of the Ninth Circuit embracing a new stance on right of publicity cases seems unlikely. Few entertainers, some of whom were very famous figures, won on their claims. Little-known college athletes might not make the cut. The obstacles that right of publicity cases face appear somewhat daunting; nevertheless, plaintiffs have achieved some success in the past. A decision by the Ninth Circuit in favor of Keller may conceivably lead other circuits to embrace a new vision on right of publicity cases.

### FUTURE RESEARCH

Fertile ground for further contributions exists and could yield significant theory, conceptual works, and legal practice guidelines encompassing, among other prospects, the following:

- Content analysis of video games with law and policy extensions. Such research projects can be combined with consumer confusion surveys that may be instrumental for courts to decide, for example, on Section 43(a) of the Federal Lanham claims.
- Federal circuits' comparisons, with regard to intellectual property and particularly right of publicity protection, absent a federal right. Useful knowledge for prospective plaintiffs' attorneys may be found therein.
- The scope of the *C.B.C.* case when tested against other parameters (e.g., fan-

tasy sports versus video games) and in other jurisdictions (e.g., Eighth Circuit versus Ninth Circuit). Would, for example, video games featuring identities of college players be held as violating rights of publicity, or would this use be constitutionally protected along the lines of an expansive public domain?

- Feasibility of legislative efforts toward the establishment of a federal right of publicity.
- Licensee estoppel doctrine in a case such as *Keller* (e.g., its defensive application prospect, next to the usual tests on licensee versus licensor).
- A "quasi employee" fiction and "quasi work for hire" doctrine conceptualization for SAs, who could then collectively bargain and negotiate on their rights, with the immediate effect of yielding copyright protection to their "quasi employer" (institution) and its associated representative (NCAA).
- Fifth and Fourteenth Amendment, due process, and related constitutional scrutiny over particular statutory provisions with regard to rights of publicity, considering Commerce and Copyright Clause tests.
- The potential existence of any "extra elements" in SAs' likenesses and identities (e.g., commercial value) that would lead to statutory rights of publicity surviving federal copyright preemption.
- Following Jon Garon's work on virtual worlds' intellectual property aspects and right of publicity protection, the limits and possible expansions of new versions of the World Wide Web.
- An extension to cases featuring the NCAA as defendant would be to study the concomitant strategic, risk, and litigation management, as well as the policy impact of such cases, considering a rich body of recent NCAA settlements.

### CONCLUSION

In sum, important conclusions are:

# Ninth Circuit Right of Publicity Jurisprudence

CASE NAME	CITATION	LOWER COURT DECISION	OVERVIEW	ROP CLAIM	STATE ROP (VIA DIV JS-DCT.)	FED. TM ACT
Perfect 10, Inc. v. Visa Int'l Serv. Ass'n	494 F.3d 788 (9th Cir. 2007)	The district court dismissed all causes of action under Federal Rule of Civil Procedure 12(b) (6) for failure to state a claim.	Instead of suing the direct infringers, Perfect 10 sued defendants, financial institutions that process credit card payments to the allegedly infringing websites.	L	California statutory and common law. The district court had original jurisdiction over the copyright and trademark claims pursuant to 28 U.S.C. §§ 1331 and 1338 and supplemental jurisdiction over the related state law claims pursuant to 28 U.S.C. § 1367.	
			To state a claim of contributory infringement, Perfect 10 must allege facts showing that defendants induce, cause, or materially contribute to the infringing conduct.		The Ninth Circuit had appellate jurisdiction pursuant to 28 U.S.C. § 1291.	
Laws v. Sony Music Entm't, Inc.	448 F.3d 1134 (9th Cir. 2006)	The district court found that Sony had obtained a license to use a sample of Laws's recording of "Very Special" and held that Laws's claims for violation of her common law right to privacy and her statutory right of publicity were preempted by the Copyright Act, 17 U.S.C. §§ 101-1332.		L	Sony removed the case to the U.S. District Court for the Central District of California	No.
Schwarzenegger v. Fred Martin Motor Co.	374 F.3d 797 (9th Cir. 2004)	The district court dismissed plaintiff's suit against Fred Martin Motor Company for lack of personal jurisdiction.	Fred Martin had run a series of five full-page color advertisements in the <i>Akron Beacon Journal</i> , a locally circulated Ohio newspaper. Each advertisement included a small photograph of Schwarzenegger, portrayed as the "Terminator," without his permission. Schwarzenegger brought suit in California, alleging, inter alia, that these unauthorized uses of his image infringed his right of publicity.	L	Yes. Defendants removed the action to federal district court in California.	No.
Mattel Inc. v. Walking Mt. Prods.	353 F.3d 792 (9th Cir. 2003)	On August 22, 2001, the Los Angeles federal district court granted Forsythe's motion for summary judgment. The district court held that Forsythe's use of Mattel's copyrighted work was fair use. The court found that Forsythe's use of Mattel's trademark and trade dress caused no likelihood of confusion as to Mattel's sponsorship of Forsythe's works. The court dismissed Mattel's trademark dilution claim because it found that Forsythe's use had been "noncommercial."	Mattel argues that Thomas Forsythe's production and sale of photographs containing Mattel's "Barbie" doll portrayed nude and in danger of being attacked by vintage household appliances infringed on their copyrights, trademarks, and trade dress.	L	No.	Mattel claimed that Forsythe misappropriated its trade dress in Barbie's appearance, in violation of the Lanham Act, 15 U.S.C. § 1125. However, the Ninth Circuit held that Forsythe's use of Mattel's Barbie qualified as nominative fair use. All three elements weigh in favor of Forsythe (see <i>Caïms v. Franklin Mint Co.</i> below). Barbie would not be readily identifiable in a photographic work without use of the Barbie likeness and figure. Forsythe used only so much as was necessary to make his parodic use of Barbie readily identifiable, and it is highly unlikely that any reasonable consumer would have believed that Mattel sponsored or was affiliated with his work.
		The court further found that Mattel's remaining state claims failed as a matter of law.				Mattel cannot use "trademark laws to . . . censor all parodies or satires which use [its] name" or dress. Forsythe's artistic and parodic work is considered noncommercial speech and, therefore, not subject to a trademark dilution claim.

CLAIMS/ISSUES	COMMENTARY	OUTCOME/WIN OR LOSE (CLAIM) N/A
<p>Perfect 10 alleges that Web sites based in several countries—and their paying customers—have directly infringed its rights under the Copyright Act, 17 U.S.C. § 101 et seq. Perfect 10 claimed contributory and vicarious copyright infringement; defendants processed credit card charges incurred by customers acquiring the infringing images.</p>	<p>The credit card companies cannot be said to materially contribute to the infringement in this case because they have no direct connection to that infringement.</p>	<p>Plaintiff Loses. Perfect 10 failed to state a claim upon which relief can be granted.</p>
<p>Misappropriation of voice and name in the song “All I Have” by Jennifer Lopez and L.L. Cool J.</p>	<p>In Napster, the court found the designer and distributor of a software program liable for contributory infringement.</p>	
<p>(1) A common law claim for invasion of privacy for the misappropriation of Laws’s name and voice, and (2) a claim for misappropriation of Laws’s name and voice for a commercial purpose under California Civil Code § 3344. The complaint sought injunctive and monetary relief.</p>	<p>Laws’s misappropriation claim is within the subject matter of the Copyright Act. California law recognizes an interest in the publicity associated with one’s voice. Federal copyright law preempts a misappropriation claim when the entire vocal performance is contained within a copyrighted medium.</p>	<p>The Ninth Circuit held that Laws’s cause of action is within the subject matter of copyright. The Ninth Circuit agreed with the district court’s conclusion that Laws’s right of publicity claims are preempted by the Copyright Act.</p>
<p>Schwarzenegger brought suit against Fred Martin and Zimmerman in Los Angeles County Superior Court alleging six state law causes of action arising out of the unauthorized use of his image in the advertisement. He claimed that the defendants caused him financial harm by use of his photograph to endorse Fred Martin.</p>	<p>No conduct by Fred Martin in California related to the advertisement that would be readily susceptible to a purposeful availment analysis. The conduct took place in Ohio. Fred Martin received no benefit, privilege, or protection from California in connection with the advertisement, and the traditional quid pro quo justification for finding purposeful availment thus does not apply.</p>	<p>Plaintiff Loses. Affirmed the district court’s dismissal for lack of personal jurisdiction. (Did not decide on the merits of the case.) To the extent that Fred Martin’s conduct might justify the exercise of personal jurisdiction in California, that conduct must have been purposefully directed at California.</p>
<p>(1) Whether the Los Angeles federal district court erred in granting Forsythe’s motion for summary judgment on Mattel’s claim of copyright infringement, and (2) whether the district court erred in granting summary judgment in favor of Forsythe on Mattel’s claims of trademark and trade dress infringement and dilution.</p>	<p>Having balanced the four § 107 fair use factors, the 9th Circuit held that Forsythe’s work constituted fair use under § 107’s exception. His work is a parody of Barbie and highly transformative. The amount of Mattel’s figure that he used was justified. His infringement had no discernable impact on Mattel’s market for derivative uses. Finally, the benefits to the public in allowing such use—allowing artistic freedom and expression and criticism of a cultural icon—are great. Allowing Forsythe’s use serves the aims of the Copyright Act by encouraging the very creativity and criticism that the Act protects.</p>	<p>Plaintiff Loses. Analysis of Mattel’s trademark and trade dress infringement claims indicates that Mattel’s claims may have been groundless or unreasonable. Forsythe’s use constituted nominative fair use and was protected by policy interests in free expression. Given the lack of reasoning provided by the district court, its denial of attorney’s fees was vacated and remanded, directing it to reassess the propriety of awarding Lanham Act fees to Forsythe.</p>
<p>In light of the 9th Circuit’s holding that Forsythe’s work was transformative, Mattel’s remaining state law claims were barred by the First Amendment.</p>	<p>The public interest in free and artistic expression greatly outweighs its interest in potential consumer confusion about Mattel’s sponsorship of Forsythe’s works.</p>	

CASE NAME	CITATION	LOWER COURT DECISION	OVERVIEW	ROP CLAIM	STATE ROP (VIA DIV JSDCT.)	FED. TM ACT
Cairns v. Franklin Mint Co.	292 F.3d 1139 (9th Cir. 2002)	(1) The district court denied the Fund's motion to reinstate its dismissed post-mortem right of publicity claim under California Civil Code § 3344.1(a)(1), (2) the district court granted summary judgment in favor of Franklin Mint on the Fund's Lanham Act claim for false endorsement under 15 U.S.C. § 1125(a)(1), and (3) the district court awarded attorneys' fees to Franklin Mint.	Since 1981, Franklin Mint has produced, advertised, and sold collectibles bearing Princess Diana's name and likeness. Princess Diana neither authorized nor objected to any of these products. The Fund was established in 1997 after Princess Diana's death to accept donations to be given to various charities with which Princess Diana was associated during her lifetime. The estate exclusively authorized the Fund to use Princess Diana's name and likeness for this purpose. The Fund in turn authorized about 20 parties—but not Franklin Mint—to use the name and likeness of Princess Diana in conjunction with products sold in the United States. Franklin Mint continued to market unauthorized Diana-related products.	L	No. Supplemental jurisdiction over state law claims.	Lanham Act's false endorsement provision, 15 U.S.C. § 1125(a)(1). Under the law of false endorsement, likelihood of customer confusion is the determinative issue.
						In the trademark context, nominative use becomes nominative fair use when a defendant proves three elements: First, the plaintiff's product or service in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the plaintiff's product or service; and third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.
Downing v. Abercrombie & Fitch	265 F.3d 994 (9th Cir. 2001)	Downing alleged that Abercrombie misappropriated their names and likenesses in violation of California's statutory and common law protections against commercial misappropriation and that the publication of the photograph in the catalog violated the Lanham Act; they alleged claims for negligence and defamation. Subsequently, appellants and Abercrombie both filed motions for summary judgment. The district court entered summary judgment for Abercrombie.	Abercrombie purchased a surfing photograph of the plaintiffs for \$100 each and handwrote the names of appellants at the bottom of the photograph. The appellants' photograph was used in an Abercrombie publication. Abercrombie did not obtain appellants' permission. Abercrombie also decided to create t-shirts, exactly like those worn by the appellants in the photograph, for sale. Abercrombie labeled the t-shirts "Final Heat Tees."		Yes. Hawaii law would not be applicable; thus, the Ninth Circuit opted for application of California Law, reversing the district court's handling of jurisdiction. There was no conflict of laws; Hawaii had no interest in applying its law and had not enacted a right of publicity statute.	Appellants contend that the district court erred in denying their claim under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).
		Abercrombie then filed a motion for attorneys' fees and other expenses. The district court granted the motion, awarding Abercrombie approximately one-fourth of the attorneys' fees that it sought.	The Spring 1999 quarterly <i>Spring Fever</i> contains a section entitled "Surf Nekkid." The "Surf Nekkid" section includes an article recounting the history of surfing. Abercrombie also included a 700-word story entitled "Your Beach Should Be This Cool," describing the history of Old Man's Beach at San Onofre, California. The following page exhibits the photograph of appellants.			

CLAIMS/ISSUES	COMMENTARY	OUTCOME/WIN OR LOSE (CLAIM) N/A
<p>The Fund brought suit against Franklin Mint and alleged (1) violations of the Lanham Act for false endorsement and false advertisement under 15 U.S.C. § 1125(a)(1), and (2) dilution of trademark under 15 U.S.C. § 1125(c)(1).</p>	<p>The district court found that the false advertisement claim was groundless and unreasonable because the statements in the advertisements at issue were true and the Fund had no reasonable basis to believe they were false. The court also found that the dilution of trademark claim was groundless and unreasonable because it had no legal basis, having been based on the “absurd” and “just short of frivolous” contention that the mark “Diana, Princess of Wales” has taken on a secondary meaning in the mind of the public and now primarily identifies “charitable and humanitarian services rather than Princess Diana the individual.”</p>	<p>(1) Violations of California’s post-mortem right of publicity statute: the Fund’s post-mortem right of publicity claim must fail because the law of Princess Diana’s domicile, Great Britain, governs and that law does not recognize a post-mortem right of publicity. (2) Lanham Act false endorsement: courts should use the New Kids nominative fair use analysis in cases where the defendant has used the plaintiff’s mark to describe the plaintiff’s product, even if the defendant’s ultimate goal was to describe his own product. By contrast, courts should use the traditional classic fair use analysis in cases where the defendant has used the plaintiff’s mark only to describe his own product, and not at all to describe the plaintiff’s product. Therefore, the Ninth Circuit held that Franklin Mint’s use of the name and likeness of Princess Diana was a permissible nominative fair use.</p>
<p>The complaint also alleged (1) violations of California’s post-mortem right of publicity statute, California Civil Code § 990(a) (now California Civil Code § 3344.1(a)), and (2) unfair competition and false and misleading advertisement under California Business and Professions Code §§ 17200 and 17500 et seq.</p>	<p>First, Franklin Mint did not use Princess Diana’s name and likeness “as a trademark,” but used them “fairly and in good faith, and only to describe its goods” as required by 15 U.S.C. § 1115(b). Second, “the weak association between [Princess Diana’s name and likeness] and [the Fund] weighs heavily against finding a likelihood of confusion” and is not outweighed by any Sleekcraft factors that weigh in favor of finding a likelihood of confusion. Franklin Mint’s use of Princess Diana’s name and likeness would therefore qualify as a permissible classic fair use without likelihood of confusion.</p>	<p>The Ninth Circuit affirmed (1) the district court’s denial of the Fund’s motion to reinstate its post-mortem right of publicity claim, (2) the district court’s grant of Franklin Mint’s motion for summary judgment on the Fund’s false endorsement claim, and (3) the district court’s award of \$ 2,308,000 in attorneys’ fees to Franklin Mint.</p>
<p>The plaintiffs allege (1) a violation of California’s common law and statutory prohibition against misappropriation of a person’s name and likeness for commercial purposes, (2) a violation of the Lanham Act for confusion and deception indicating sponsorship of Abercrombie goods, and (3) a claim for negligence and defamation.</p>	<p>Neither the California state law claims nor the Lanham Act claim is precluded by the First Amendment; the California state claims are not preempted by the federal Copyright Act; the proper choice of law to apply to these claims is California law; there is insufficient evidence to support the defamation claim; and the attorneys’ fee award is vacated.</p>	<p>(1) Because the subject matter of the appellants’ statutory and common law right of publicity claims is their names and likenesses, which are not copy-rightable, the claims are not equivalent to the exclusive rights contained in § 106. (2) Application of these factors, leads to the conclusion that the district court erred in rejecting appellants’ Lanham Act claim at the summary judgment stage. Viewing the evidence in the light most favorable to appellants, the Ninth Circuit concluded that appellants raised a genuine issue of material fact concerning a likelihood of confusion as to their endorsement.</p>
<p>More specifically, plaintiffs claim (1) Abercrombie’s use of the photograph is not protected under the First Amendment, (2) the state law publicity claims are not preempted by the Copyright Act, (3) California law is the proper choice of law for the claim under California Civil Code § 3344, (4) triable issues of fact exist with regard to the Lanham Act claims, (5) triable issues of fact exist with regard to the defamation claim, (6) the district court erred in denying the motion for a continuance, and (7) the district court erred in awarding attorneys’ fees and costs to Abercrombie.</p>	<p>California law is applicable to all of appellants’ claims.</p>	<p>(3) The Ninth Circuit held that the district court did not err in denying the appellants’ defamation claim because Downing did not submit any evidence demonstrating that they incurred special damages (defined as all damages that the plaintiff alleges and proves that he has suffered in respect to his property, business, trade, profession, or occupation, including such amounts of money as the plaintiff alleges and proves he has expended as a result of the alleged libel, and no other) due to Abercrombie’s publication of the photograph.</p>

CASE NAME	CITATION	LOWER COURT DECISION	OVERVIEW	ROP CLAIM	STATE ROP (VIA DIV JSDCT.)	FED. TM ACT
Hoffman v. Capital Cities/ABC, Inc.	255 F.3d 1180 (9th Cir. 2001)	After a bench trial, the district court found for Hoffman and against LAM on all of Hoffman's claims, rejecting LAM's defense that its use of the photograph was protected by the First Amendment. The court awarded Hoffman \$1,500,000 in compensatory damages, and held that Hoffman was entitled to punitive damages as well. Hoffman v. Capital Cities/ABC, Inc., 33 F. Supp. 2d 867 (C.D. Cal. 1999). After a hearing, the court awarded Hoffman \$ 1,500,000 in punitive damages. It also held that ABC was not liable for any of LAM's actions.	An article entitled "Grand Illusions" used computer technology to alter famous film stills to make it appear that the actors were wearing Spring 1997 fashions. The final shot was the <i>Tootsie</i> still. The American flag and Hoffman's head remained as they appeared in the original, but Hoffman's body and his long-sleeved red sequined dress were replaced by the body of a male model in the same pose, wearing a spaghetti-strapped, cream-colored, silk evening dress and high-heeled sandals. LAM did not ask Hoffman for permission to publish the altered photograph. Nor did LAM secure permission from Columbia Pictures, the copyright holder.		Yes. ABC removed the case to federal court.	No.
Wendt v. Host Int'l This disposition is not appropriate for publication and may not be cited to or used by the courts of this circuit except as provided by Ninth Circuit Rule 36-3.	197 F.3d 1284 (9th Cir. 1999)		Petition for rehearing en banc.	L		
Wendt v. Host Int'l	125 F.3d 806 (9th Cir. 1997)	Upon remand, the district court granted summary judgment for a second time after an in-court inspection of the robots. It held that it could not "find, by viewing both the robotics and the live persons of Mr. Wendt and Mr. Ratzenberger, that there is any similarity at all . . . except that one of the robots, like one of the plaintiffs, is heavier than the other . . . The facial features are totally different." The district court then awarded attorney's fees to Host and Paramount pursuant to Cal. Civ. Code § 3344.	The plaintiffs argued that Host violated their trademark and publicity rights by creating animatronic robotic figures (the "robots") based upon their likenesses without their permission and placing these robots in airport bars modeled upon the set from the television show <i>Cheers</i> .	L	No.	Lanham Act's false endorsement provision, 15 U.S.C. § 1125(a)(1). Under the law of false endorsement, likelihood of customer confusion is the determinative issue. "A false endorsement claim based on the unauthorized use of a celebrity's identity . . . alleges the misuse of a trademark, i.e., a symbol or device such as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic, which is likely to confuse consumers as to the plaintiff's sponsorship or approval of the product."
						California courts' test: In order to determine whether confusion is likely to occur, the well-settled eight-factor test is to be applied to celebrity endorsement cases. This test requires the consideration of (1) the strength of the plaintiff's mark, (2) relatedness of the goods, (3) similarity of the marks, (4) evidence of actual confusion, (5) marketing channels used, (6) likely degree of purchaser care, (7) defendant's intent in selecting the mark, and (8) likelihood of expansion of the product lines.

CLAIMS/ISSUES	COMMENTARY	OUTCOME/WIN OR LOSE (CLAIM) N/A
<p>(1) LAM argues that the “Grand Illusions” article and the altered <i>Tootsie</i> photograph contained therein are an expression of editorial opinion, entitled to protection under the First Amendment. (2) LAM argues against the \$ 269,528.50 awarded in attorney’s fees.</p>	<p>The totality of LAM’s presentation of the article and the <i>Tootsie</i> photograph does not provide clear and convincing evidence that the editors intended to suggest falsely to the ordinary reader that he or she was seeing Hoffman’s body in the altered <i>Tootsie</i> photograph.</p>	<p>(1) The Ninth Circuit found that LAM was entitled to the full First Amendment protection accorded noncommercial speech. (2) Award of attorney’s fees was reversed because Hoffman did not show by clear and convincing evidence that LAM acted with actual malice in publishing the altered <i>Tootsie</i> photograph. Because there is no clear and convincing evidence of actual malice, the Ninth Circuit had to reverse the district court’s judgment in Hoffman’s favor and the court’s award of attorney’s fees to Hoffman. Because the Ninth Circuit concluded that the First Amendment protects LAM’s use of the <i>Tootsie</i> photograph, they did not need to address LAM’s argument that Hoffman’s state law claims are preempted by the federal Copyright Act, 17 U.S.C. § 301.</p>
<p>The right of publicity, as defined by the state courts, is limited to using a celebrity’s name, voice, face or signature.</p>	<p>So who wins? The Copyright Act makes it simple, at least insofar as the plaintiffs interfere with Paramount’s right to exploit the Cheers characters. Section 301 of the Copyright Act preempts any state law “legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright[.]” 17 U.S.C. § 301(a).</p>	<p>The petition for rehearing is denied and the petition for rehearing en banc is rejected.</p>
<p>The question here is whether the three-dimensional animatronic figures are sufficiently similar to plaintiffs to constitute their likenesses and whether the district court dismissal was inappropriate because material issues of fact remained as to the degree to which the animatronic figures appropriate the appellants’ likenesses; further, plaintiffs argue that the likeness determination is an issue for the jury to decide in this case.</p>	<p>A party’s claims are not preempted by federal copyright statutes so long as the claims contain elements that are different in kind from copyright infringement.</p>	<p>(1) Appellants’ claims are not preempted by federal copyright law. Issues of material fact exist concerning the degree to which the robots are like the appellants, and the Ninth Circuit reversed the grant of summary judgment on the claim under Cal. Civ. Code § 3344. (2) The Ninth Circuit reversed the grant of summary judgment on the right of publicity claim because appellants raised genuine issues of material fact concerning the degree to which the figures look like them and issues of fact as to whether appellees sought to appropriate their likenesses for their own advantage and whether they succeeded in doing so. The ultimate issue for the jury to decide is whether the defendants are commercially exploiting the likeness of the figures to Wendt and Ratzenberger intending to engender profits to their enterprises.</p>
		<p>Trademark Claim: A reasonable jury could conclude that most of the factors weigh in appellants’ favor and that Host’s alleged conduct creates at least the likelihood of consumer confusion. Whether appellants’ Lanham Act claim should succeed, of course, is a matter for the jury. Accordingly, the Ninth Circuit reversed the dismissal of the unfair competition claim and remanded.</p>

CASE NAME	CITATION	LOWER COURT DECISION	OVERVIEW	ROP CLAIM	STATE ROP (VIA DIV JSDCT.)	FED. TM ACT
Astaire v. Best Film & Video Corp.	1997 U.S. App. LEXIS 41260 (9th Cir. 1997)	Although the district court concluded that Astaire's image was not used for the purpose of advertising, selling, or soliciting the purchase of the videotapes, the district court granted summary judgment in favor of Mrs. Astaire. The district court entered a judgment that made the following legal determinations: (1) Best's use of the Astaire film clips was covered by § 990(a)'s "on or in products, merchandise, or goods" language; (2) Best's use of the Astaire film clips was not a use for "advertising, selling, or soliciting" in violation of § 990(a); (3) Best's use of the Astaire film clips was not exempt under § 990(n); (4) Mrs. Astaire's § 990 claim was not preempted by the federal Copyright Act; and (5) Best's use of Astaire's likeness was not protected by the First Amendment. Both sides appealed.	In 1965, Fred Astaire granted the Ronby Corporation ("Ronby") an exclusive license to use his name in connection with the operation of dance studios, schools, and related activities, and the right to use certain pictures, photographs, and other likenesses of himself as had been used under a previous agreement, as well as any new photographs and likenesses that he approved in writing. Twenty-four years later, Best entered into an agreement with Ronby to produce a series of dance instructional videotapes using the Fred Astaire Dance Studios name and licenses. Since October 1989, Best had been manufacturing and distributing a series of five videotapes known as the "Fred Astaire Dance Series." Fred Astaire died in 1987. He was survived by his wife, Robyn, who had succeeded to all rights in his name, voice, signature, photograph, likeness, and persona under Cal. Civ. Code § 990.	L	Yes.	No.
Abdul-Jabbar v. GMC	85 F.3d 407 (9th Cir. 1996)	The district court based its judgment on all causes of action largely on its findings that Abdul-Jabbar had abandoned the name "Lew Alcindor," and that GMC's use of the name could not be construed as an endorsement of its product by Abdul-Jabbar.	Kareem Abdul-Jabbar was named Ferdinand Lewis ("Lew") Alcindor at birth, and played basketball under that name throughout his college career and into his early years in the National Basketball Association ("NBA"). While in college, he converted to Islam and began to use the Muslim name Kareem Abdul-Jabbar among friends. Several years later, in 1971, he opted to record the name "Kareem Abdul-Jabbar" under an Illinois name recordation statute, and thereafter played basketball and endorsed products under that name. He had not used the name "Lew Alcindor" for commercial purposes in over 10 years.	W	Yes. The court had jurisdiction pursuant to 28 U.S.C. § 1291.	Yes. Lanham Act, 15 U.S.C. § 1125(a). Abdul-Jabbar contended that GMC's unauthorized use of his birth name, Lew Alcindor, was likely to confuse consumers as to his endorsement of the Olds 88, and thus violated the Lanham Act.
			Abdul-Jabbar's action alleged violations of the Lanham Act, 15 U.S.C. § 1125(a), and California's statutory and common law right of publicity. Abdul-Jabbar argues that GMC violated his trademark and publicity rights by using his former name, Lew Alcindor, without his consent, in a television commercial aired during the 1993 NCAA men's basketball tournament.			
Newton v. Thomason	22 F.3d 1455 (9th Cir. 1994)	Appellees moved for summary judgment on the following grounds: (1) Newton consented to use of his name, (2) appellees did not "pirate" Newton's name and identity for commercial gain, and (3) There was no likelihood of confusion between Newton and the TV series character. The district court granted summary judgment in favor of appellees. The district court also sanctioned Newton's attorney Childress in the amount of \$10,000 for filing Newton's complaint in the Illinois district court and denied appellees' motion for attorneys' fees.	Appellant Newton is a country music songwriter and performer. In the country/western music industry, he is recognized by the name "Wood Newton." The main character in the television series <i>Evening Shade</i> [hereinafter the TV series], is also named "Wood Newton." Prior to the television show, which started airing in September 1990, Newton was the only person with that name in the entertainment field.	N/A	No. But removed from Illinois to California district court. Newton filed a complaint in the Northern District of Illinois, alleging that appellees misappropriated his name and likeness and engaged in unfair competition in violation of state and federal law. The Illinois court transferred the case to the Central District of California, under 28 U.S.C. § 1404(a).	Yes. Newton contends that a genuine issue of material fact exists on the likelihood of confusion between Newton and the TV series character. The Ninth Circuit disagreed. Newton failed to offer proof of a likelihood that customers may be confused as to the source or endorsement for the TV series.

CLAIMS/ISSUES	COMMENTARY	OUTCOME/WIN OR LOSE (CLAIM) N/A
<p>In 1989, Mrs. Astaire sued Best and others in federal district court, alleging inter alia that the Best videotapes violated her § 990 rights by using Astaire's image as it appears in the clips from <i>Second Chorus</i> and <i>Royal Wedding</i> without her permission. Although Mrs. Astaire originally contended otherwise, the parties no longer dispute that Best's use of Astaire's name and the still photographs are authorized under Astaire's agreement with Ronby. Thus, this case focuses entirely on whether § 990 provides Mrs. Astaire with a claim against Best's use of the Astaire film clips.</p>	<p>Section 990 provides, in relevant part: "(a) Any person who uses a deceased personality's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for the purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services, without prior consent from the person or persons specified in subdivision (c), shall be liable for any damages sustained by the person or persons injured as a result thereof. . . . (h) As used in this section, 'deceased personality' means any natural person whose name, voice, signature, photograph, or likeness has commercial value at the time of his or her death . . . . (i) As used in this section, 'photograph' means any photograph or photographic reproduction, still or moving, or any video tape or live television transmission, of any person, such that the deceased personality is readily identifiable. . . . (n) This section shall not apply to the use of a deceased personality's name, voice, signature, photograph, or likeness, in any of the following instances: (1) A play, book, magazine, newspaper, musical composition, film, radio or television program, other than an advertisement or commercial announcement not exempt under paragraph (4). (2) Material that is of political or newsworthy value. (3) Single and original works of fine art. (4) An advertisement or commercial announcement for a use permitted by paragraph (1), (2), or (3)." Cal. Civ. Code § 990 (West Supp. 1997).</p>	<p>Having considered what limited guidance the legislative history of SB 613 gave the court regarding the meaning of subsection (n), the Ninth Circuit concluded that the legislative history did not support Mrs. Astaire's contentions that the exception for use in a "play, book, magazine, newspaper, musical composition, film, radio or television program" was limited to "legitimate historical, fictional, and biographical accounts of deceased celebrities." The Ninth Circuit thus concluded that Best's use of the late Fred Astaire's likeness/photograph in its "How to Dance" videotapes was exempt from § 990 liability pursuant to subsection (n). Accordingly, the judgment of the district court was reversed and the court remanded with instructions to enter judgment in favor of Best.</p>
<p>Abdul-Jabbar brought suit in federal district court in May 1993, alleging claims under the Lanham Act and California's statutory and common law rights of publicity.</p>	<p>California's common law right of publicity protects celebrities from appropriations of their identity not strictly definable as "name or picture."</p>	<p>For the reasons below, the Ninth Circuit reversed the judgment of the district court and remanded for trial on the claims alleging violation of the California common law right of publicity and section 3344, as well as the claims alleging violation of the Lanham Act. (1) While the issue of whether GMC's use of the name Lew Alcindor constituted an endorsement of its product is far from clear, the Ninth Circuit held that GMC could not rely on abandonment as a defense to Abdul-Jabbar's Lanham Act claim. (2) Additionally, the Ninth Circuit held that Abdul-Jabbar had alleged sufficient facts to state a claim under both California common law and § 3344. The statute's [Cal. Civil Code § 3344(a)] reference to "name or likeness" is not limited to present or current use. To the extent GMC's use of the plaintiff's birth name attracted television viewers' attention, GMC gained a commercial advantage.</p>
		<p>(3) Had GMC limited itself to the "trivia" portion of its ad, GMC could likely defend the reference to Lew Alcindor as a nominative fair use. But by using Alcindor's record to make a claim for its car—like the basketball star, the Olds 88 won an "award" three years in a row, and like the star, the car is a "champ" and a "first round pick"—GMC arguably attempted to "appropriate the cachet of one product for another," if not also to "capitalize on consumer confusion." The Ninth Circuit held that there was a question of fact as to whether GMC is entitled to a fair use defense.</p>
<p>Newton alleges that the appellees appropriated his name for a character in the television show <i>Evening Shade</i> in violation of the common law right of publicity, various state statutes, and the Lanham Act, 15 U.S.C. § 1125(a).</p>	<p>Commercial purpose means more than merely using a name as part of a cast of characters in a television program advertisement that highlights the program's general plot. In this case, appellees did no more than use the name "Wood Newton" in the text of newspaper articles announcing Burt Reynolds's debut as a character in the TV series.</p>	<p>The Ninth Circuit held that filing in an inconvenient but proper forum is not a legitimate ground for Rule 11 sanctions. The choice of an inconvenient forum is sanctionable only where the choice is made for an "improper purpose" such as harassment. The court rejected appellees' attempt to characterize the Illinois filing as harassment: To constitute harassment, conduct "must do more than in fact bother, annoy or vex the complaining party. Harassment under Rule 11 focuses upon the improper purpose of the signer, objectively tested, rather than the consequences of the signer's act, subjectively viewed by the signer's opponent." Because there was no evidence of improper purpose, the court reversed the sanctions order.</p>
		<p>Appellees' TV series does not compete with Newton's music. The fact that the TV series concerns life in a small Southern town does not persuade us, as Newton urges, that its viewers are interested in country/western music or that Newton will lose fans due to the program's success.</p>

CASE NAME	CITATION	LOWER COURT DECISION	OVERVIEW	ROP CLAIM	STATE ROP (VIA DIV JSDCT.)	FED. TM ACT
White v. Samsung Elec. Am., Inc., cert. denied, 508 U.S. 951 (1993)	989 F.2d 1512 (9th Cir. 1993)		Held that the right of publicity extends not just to the name, likeness, voice and signature of a famous person, but to anything at all that evokes that person's identity.			
White v. Samsung Elec. Am., Inc.	1992 U.S. App. LEXIS 19253 (9th Cir. 1992)	The district court granted summary judgment against White on each of her claims: (1) Cal. Civ. Code § 3344, (2) the California common law right of publicity, and (3) § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).	The advertisement that prompted the current dispute was for Samsung videocassette recorders (VCRs). The ad depicted a robot dressed in a wig, gown, and jewelry that was consciously selected to resemble White's hair and dress. The robot was posed next to a game board that is instantly recognizable as the <i>Wheel of Fortune</i> game show set, in a stance for which White is famous. The caption of the ad read: "Longest-running game show. 2012 A.D." Defendants referred to the ad as the "Vanna White" ad. Unlike the other celebrities used in the campaign, White neither consented to the ads nor was she paid.	W	No.	Yes. Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). Looking at the series of advertisements as a whole, a jury could reasonably conclude that beneath the surface humor of the series lay an intent to persuade consumers that celebrity Vanna White, like celebrity Downey, was endorsing Samsung products.
Waits v. Frito-Lay, Inc.	978 F.2d 1093 (9th Cir. 1992)	In November 1988, Waits sued Tracy-Locke and Frito-Lay, alleging claims for voice misappropriation under California law and false endorsement under the Lanham Act. The case was tried before a jury in April and May 1990. The jury found in Waits' favor, awarding him \$375,000 compensatory damages and \$2 million punitive damages for voice misappropriation, and \$100,000 damages for violation of the Lanham Act. The court awarded Waits attorneys' fees under the Lanham Act.	Stephen Carter was among those who auditioned for a Dorito's commercial. A recording engineer who was acquainted with Carter's work had recommended him to Tracy-Locke as someone who did a good Tom Waits imitation. Carter had a nearly perfect imitation of Waits. At the recording session for the commercial, David Brenner, Tracy-Locke's executive producer, became concerned about the legal implications of Carter's skill in imitating Waits, and attempted to get Carter to "back off" his Waits imitation. The commercial was broadcast in September and October 1988 on over 250 radio stations located in 61 markets nationwide, including Los Angeles, San Francisco, and Chicago. Waits heard it during his appearance on a Los Angeles radio program, and was shocked. He realized "immediately that whoever was going to hear this and obviously identify the voice would also identify that [Tom Waits] in fact had agreed to do a commercial for Doritos."	W		Yes. This case posed the threshold issue of whether false endorsement claims are properly cognizable under § 43(a) of the Lanham Act. The Ninth Circuit concluded that false endorsement claims, including those premised on the unauthorized imitation of an entertainer's distinctive voice, are cognizable under § 43(a). Waits' claim, like Bette Midler's, was for infringement of voice, not for infringement of a copyrightable subject such as sound recording or musical composition. In challenging the judgment on Waits' false endorsement claim under § 43(a) of the Lanham Act, the defendants contended that Waits lacks standing to sue because he is not in competition with the defendants. They also argue that Waits did not establish his claim at trial, and that damages and attorney's fees were improperly awarded. Because it was duplicative, the Ninth Circuit vacated the district court's award of damages under the Lanham Act.
cert. denied, Frito-Lay, Inc. v. Waits, 506 U.S. 1080 (1993)						The evidence was sufficient to support the jury's finding that consumers were likely to be misled by the commercial into believing that Waits endorsed SalsaRio Doritos. The jury's verdict on Waits' Lanham Act claim stood. However, the jury awarded Waits \$100,000 on this claim. It also awarded Waits \$100,000 for the fair market value of his services on his voice misappropriation claim. The damages awarded under the Lanham Act were duplicative and vacated.

CLAIMS/ISSUES	COMMENTARY	OUTCOME/WIN OR LOSE (CLAIM) N/A
		Rehearing, en banc, denied
Following the circulation of the robot ad, White sued Samsung and Deutsch in federal district court under (1) Cal. Civ. Code § 3344; (2) the California common law right of publicity; and (3) § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).	In <i>Eastwood v. Superior Court</i> , 149 Cal. App. 3d 409 (1983), the California court of appeals stated that the common law right of publicity cause of action “may be pleaded by alleging (1) the defendant’s use of the plaintiff’s identity; (2) the appropriation of plaintiff’s name or likeness to defendant’s advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury.”	The Ninth Circuit held only that White has pleaded claims that can go to the jury for its decision. (1) The Ninth Circuit agreed with the district court that the robot at issue here was not White’s “likeness” within the meaning of § 3344. This is because Samsung and Deutsch used a robot with mechanical features, and not, for example, a manikin molded to White’s precise features. Without deciding for all purposes when a caricature or impressionistic resemblance might become a “likeness.” (2) the Ninth Circuit found that the district court erred by granting summary judgment on White’s common law right of publicity claim. The court found that considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity’s sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof.
		(3) Lanham Act claim: The Ninth Circuit determined that whether White’s Lanham Act claim should succeed is a matter for the jury, in light of the peculiar facts of this case. In particular, the robot ad identifies White and was part of a series of ads in which other celebrities participated and were paid for their endorsement of Samsung’s products.
On appeal, (1) the defendants attacked the legal underpinnings of voice misappropriation, arguing that <i>Midler</i> is no longer an accurate statement of California law. (2) They also found fault with the court’s formulation of the elements of voice misappropriation in its instructions to the jury. (3) Finally, they attacked both the compensatory and punitive damages awarded by the jury as legally inappropriate and unsupported by the evidence.	The court rejected copyright preemption in <i>Midler</i> because voice is not a subject matter of copyright: “A voice is not copyrightable. The sounds are not ‘fixed.’” The defendants argued that in right of publicity actions, only damages to compensate for economic injury are available. The Ninth Circuit disagreed. Although the injury stemming from violation of the right of publicity “may be largely, or even wholly, of an economic or material nature,” the court has recognized that “it is quite possible that the appropriation of the identity of a celebrity may induce humiliation, embarrassment, and mental distress.”	(1) Waits’ voice misappropriation claim, therefore, is not preempted by federal copyright law because it was “for infringement of voice, not for infringement of a copyrightable subject such as sound recording or musical composition.” Thus, the issues in Waits were “whether the defendants had deliberately imitated Waits’ voice rather than simply his style and whether Waits’ voice was sufficiently distinctive and widely known to give him a protectible right in its use. These elements are ‘different in kind’ from those in a copyright infringement case challenging the unauthorized use of a song or recording.” (2) The jury instructions were not misformulated and, read as a whole, the instructions were not misleading. (3) The central issue is not whether these damages were available, but whether the evidence was sufficient to establish injury to Waits’ reputation. Added to the evidence of Waits’ shock, anger, and embarrassment is the strong inference that, because of his outspoken public stance against doing commercial endorsements, the Doritos commercial humiliated Waits by making him an apparent hypocrite. This evidence was sufficient both to allow the jury to consider mental distress damages and to support their eventual award.
		Punitive damages: The Ninth Circuit affirmed the award of punitive damages. Viewed most favorably to Waits, the evidence was adequate to support a finding of high probability that Tracy-Locke and Frito-Lay acted with malice. A rational jury could have found the defendants’ conduct despicable because they knowingly impugned Waits’ integrity in the public eye. A rational jury also could have found that the defendants, in spite of their awareness of Waits’ legal right to control the commercial use of his voice, acted in conscious disregard of that right by broadcasting the commercial.

CASE NAME	CITATION	LOWER COURT DECISION	OVERVIEW	ROP CLAIM	STATE ROP (VIA DIV JSDCT.)	FED. TM ACT
Dworkin v. Hustler Magazine, Inc.	867 F.2d 1188 (9th Cir. 1989)	WYOMING: Inland Empire and Park Place filed a motion to dismiss for failure to state a claim upon which relief could be granted. The <i>Hustler</i> defendants filed a Rule 12(c) motion for judgment on the pleadings as to Dworkin's constitutional rights count, Moree and Fouts' count, and the obscenity count, also on the ground that the complaint failed to state a claim. The Wyoming district court granted both motions, dismissing the claims against Inland Empire and Park Place, and the three counts attacked by the <i>Hustler</i> defendants' Rule 12(c) motion.	The February feature in <i>Hustler</i> was a cartoon that depicted two women engaged in a lesbian act of oral sex with the caption, "You remind me so much of Andrea Dworkin, Edna. It's a dog-eat-dog world." The March feature was a 10-page pictorial consisting of photographs of women engaged in, among other things, acts of lesbianism or masturbation. Some of the photographs depicted obviously staged scenes that include posed violence and phony blood. One photograph, supposedly of a Jewish male, had a caption stating: "While I'm teaching this little shiksa the joys of Yiddish, the Andrea Dworkin Fan Club begins some really serious suck-'n'-squat. Ready to give up the holy wafers for matzoh, yet, guys?" The December feature was included in the "Porn from the Past" section of the magazine. It showed a man performing oral sex on an obese woman while he masturbated. A portion of the caption stated: "We don't believe it for a minute, but one of our editors swears that this woman in the throes of ecstasy is the mother of radical feminist Andrea Dworkin."	L	Yes. Dworkin originally filed her complaint in Wyoming state court. The defendants filed a timely petition for removal to the District Court for the District of Wyoming, asserting both federal question and diversity jurisdiction.	No.
		CALIFORNIA: Prior to the change of venue, the <i>Hustler</i> defendants had filed a motion for summary judgment. This motion had been fully briefed but was still pending at the time of the transfer. The California district court subsequently granted the motion in a Memorandum Opinion and Order and entered judgment in defendants' favor on all remaining claims.			The <i>Hustler</i> defendants also sought a change of venue from the District of Wyoming to the Central District of California, which the Wyoming district court granted.	
Brewer v. Hustler Magazine, Inc.	749 F.2d 527 (9th Cir. 1984)	Brewer received a jury verdict of \$14,500 on his copyright claim, but the district court dismissed his state law claims.	In 1974, Brewer created a photograph that, with the use of special effects, simulates Brewer shooting himself through the head. He later incorporated the photograph into a postcard entitled "You Drive Me Crazy." On April 30, 1980, he entered into an agreement with Americard Creations, Inc. for the commercial sale of the photograph in the form of a postcard. In August 1981, <i>Hustler</i> reproduced a portion of the postcard in the "Bits & Pieces" section of <i>Hustler</i> magazine.	L/W	Unknown.	No.
		Both parties appealed.				
Cher v. Forum Int'l, Ltd., cert. denied, 462 U.S. 1120 (1983)	692 F.2d 634 (9th Cir. 1982)	The trial court found for Cher and awarded general and punitive damages against all defendants.	Cher does not allege that the published text of the interview was false or defamatory. Nor does she contend that private facts were published without her consent. Instead her complaint charged breach of contract, unfair competition, misappropriation of name and likeness, misappropriation of right to publicity, and violations of the Lanham Act, all with reference to the publishers' use of headlines, cover promotions, and advertising in connection with the interview. The editors of <i>Us</i> magazine, at Cher's request, did not run the interview and returned it to Robbins, paying him a "kill" fee.	L/W	No.	Yes. However, the Ninth Circuit decided the case on grounds other than the Lanham Act and therefore expressed no opinion on its applicability to these facts.

CLAIMS/ISSUES	COMMENTARY	OUTCOME/WIN OR LOSE (CLAIM) N/A
<p>The district court complaint contained Dworkin's claims of libel, invasion of privacy, intentional infliction of emotional injury, "outrage," and joint and several liability, as well as a less typical civil rights claim that <i>Hustler</i> and Flynt deprived her of her constitutional rights. However, on appeal, the only matters before the Ninth Circuit relate to the substantive merits of the Rule 12(c) dismissal and the summary judgment in favor of the <i>Hustler</i> defendants.</p>		<p>Ludicrous statements are much less insidious and debilitating than falsities that bear the ring of truth. We have little doubt that the outrageous and the outlandish will be recognized for what they are. The Ninth Circuit has held that "the distinction between alleged fact or opinion is a question of federal law." The district court properly granted summary judgment on this ground.</p>
<p>Moree and Fouts claimed at the district court level that publication of the features "is tantamount to a direct assault upon the rights and interests" of Moree, Fouts, and the relevant chapters of <i>NOW</i>; "has caused actual damages" to those persons and their associational rights, and causes irreparable harm to those persons; and "makes other women afraid to exercise [political freedoms on behalf of women] for fear of an ugly, pornographic representation of them appearing in such a magazine."</p>		<p>The district court dismissed Dworkin's civil rights claim because "<i>Hustler Magazine</i> and Larry Flynt are simply not state actors, and a plaintiff must plead state action in order to pursue a constitutional claim." The Ninth Circuit agreed with the district court, and affirmed the dismissal of both Dworkin's claim and Moree and Fouts' claim on this ground. Additionally, Dworkin could not plausibly argue that the cartoons constitute an appropriation by <i>Hustler</i> of the commercial benefit of a performance in which Dworkin has a proprietary interest or that the cartoons indicate her endorsement of <i>Hustler</i>. Therefore, we hold that Dworkin cannot recover on any privacy theory recognized by New York.</p>
<p>Brewer sued <i>Hustler</i> for copyright infringement. Brewer also raised three pendent state law claims, alleging that <i>Hustler</i> violated (1) his right to privacy, (2) his right of publicity, and (3) his rights under § 3344 of the California Civil Code. (Prior to trial, the district court dismissed the right to privacy claim and granted summary judgment in <i>Hustler's</i> favor on the § 3344 claim.)</p>		<p>The Ninth Circuit determined that because Brewer had already published the photograph, he failed to state a cause of action for violation of his right of privacy. Also, the district court properly granted a directed verdict because, on Brewer's right of publicity claim, the right of publicity "means in essence that the reaction of the public to name and likeness, which may be fortuitous or which may be managed or planned, endows the name and likeness of the person involved with commercially exploitable opportunities." Brewer offered no evidence showing that the principle applied to the photograph.</p>
<p><i>Hustler</i> claimed that Brewer's pre-1978 use of the photograph constitutes a general publication, that its publication of the photograph was a fair use, and that the award of damages was excessive.</p>	<p>Congress has codified the fair use defense in 17 U.S.C. § 107. Section 107 sets forth four nonexclusive factors. First, "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes"; second, "the nature of the copyrighted work"; third, "the amount and substantiality of the portion used in relation to the copyrighted work as a whole"; and, finally, "the effect of the use upon the potential market for or value of the copyrighted work."</p>	<p>The Ninth Circuit concluded that there was sufficient evidence from which a jury could have found that <i>Hustler's</i> publication of the photograph was not a fair use (fair use being determined by considering all the evidence in the case). Additionally, the Ninth Circuit found that the jury was properly instructed not to award speculative damages, and the amount that they returned is within a range supported by the record. <i>Hustler's</i> contention that the damages were excessive was rejected.</p>
<p>Cher does not allege that the published text of the interview was false or defamatory. Nor does she contend that private facts were published without her consent. Instead her complaint charged breach of contract, unfair competition, misappropriation of name and likeness, misappropriation of right to publicity, and violations of the Lanham Act, all with reference to the publishers' use of headlines, cover promotions, and advertising in connection with the interview.</p>	<p>The evidence did not support the findings in their entirety, and the law does not support parts of the judgment.</p>	<p>Robbins had no part in the publishing, advertising, or marketing of the articles in question. Accordingly, the judgment against Robbins is clearly erroneous and must be vacated. The judgment against News Group was reversed. Neither do the words in question constitute a false claim that Cher endorsed <i>Star</i> magazine. The district court in effect imposed liability on the basis of earlier negotiations between Cher and News Group relating to a contract for commercial advertising and Cher's endorsement of <i>Star</i>, to be aired on television. These negotiations were never concluded, and were not relevant in this case, where no endorsement was in fact shown.</p>

CASE NAME	CITATION	LOWER COURT DECISION	OVERVIEW	ROP CLAIM	STATE ROP (VIA DIV JS-DCT.)	FED. TM ACT
			Cher apparently did not feel that the interview sufficiently emphasized her new band. Robbins sold the interview to two of the defendants, the publishers of a tabloid called <i>Star</i> , and the publishers of a pocket-sized magazine called <i>Forum</i> .			
Motschenbacher v. R. J. Reynolds Tobacco Co.	498 F.2d 821 (9th Cir. 1974)	The district court determined that the plaintiff's action failed because the plaintiff was not identified in the commercial either visually, aurally, explicitly, or inferentially, and therefore granted defendants' Motion for Summary Judgment	In 1970, the defendants, R. J. Reynolds Tobacco Company and William Esty Company, produced and caused to be televised a commercial that utilized a "stock" color photograph depicting several racing cars on a racetrack. Plaintiff's car appears in the foreground, and although plaintiff is the driver, his facial features are not visible.	W	The jurisdiction of the district court is founded on diversity of citizenship, 28 U.S.C. § 1332; appellate jurisdiction is predicated on 28 U.S.C. § 1291.	No.

CLAIMS/ISSUES	COMMENTARY	OUTCOME/WIN OR LOSE (CLAIM) N/A
		<p>However, against Forum International, Ltd., because of the First Amendment implications in this case, the Ninth Circuit had to examine the trier's findings with the extra care required in such cases. The court was satisfied that the trier could find, from the record as a whole, that no matter how carefully the editorial staff of <i>Forum</i> may have trod the border between the actionable and the protected, the advertising staff engaged in the kind of knowing falsity that strips away the protection of the First Amendment. Whether the court agreed with the trier's finding of knowing falsity, or fell back a step to reckless disregard for the truth, there was enough evidence to support the material findings under Fed R. Civ. P. 52 against Forum International, Ltd. The court sustained the findings against Penthouse International because there was enough participation in the false advertising to permit Penthouse International to share Forum International's liability.</p>
<p>Plaintiff sought injunctive relief and damages for the alleged misappropriation of his name, likeness, personality, and endorsement in nationally televised advertising for Winston cigarettes.</p>	<p>In a diversity case, a federal court followed the substantive law of the state in which it sat. A name was commercially valuable as an endorsement of a product or for financial gain only because the public recognized it and attributed goodwill and feats of skill or accomplishments of one sort or another to that personality. The California appellate courts afforded legal protection to an individual's proprietary interest in his own identity.</p>	<p>The judgment was vacated and the cause was remanded for further proceedings. The Ninth Circuit concluded that the California appellate courts would, in a case such as this one, afford legal protection to an individual's proprietary interest in his own identity. The court did not need to decide whether the California courts would do so under the rubric of "privacy," "property," or "publicity"; they only determined that they would recognize such an interest and protect it.</p>
	<p>Although the likeness of the driver was unrecognizable, the distinctive decorations were not only peculiar to the driver's cars but caused some persons to think the car in question was the driver's and to infer that the person driving the car was the plaintiff. The addition of a spoiler did not necessarily render the automobile impersonal because the driver's cars frequently used spoilers but could be taken as contributing to the inference of sponsorship or endorsement. The alteration in numbering did not preclude a finding of identifiability by the trier of fact.</p>	<p>Having viewed a film of the commercial, the Ninth Circuit agreed with the district court that the "likeness" of the plaintiff was itself unrecognizable; however, the court's further conclusion of law to the effect that the driver was not identifiable as the plaintiff was erroneous in that it wholly failed to attribute proper significance to the distinctive decorations appearing on the car. As pointed out earlier, these markings were not only peculiar to the plaintiff's cars but they caused some persons to think the car in question was the plaintiff's and to infer that the person driving the car was the plaintiff. The car under consideration clearly has a driver and displays several uniquely distinguishing features.</p>

- NCAA SAs possess common law and statutory rights of publicity, and absent consent and other defenses, they can argue these rights are protectable. Defendants in *Keller* have acknowledged the existence of these rights and argued that the NCAA does not hold the right; rather, the SAs do.
- SAs' names are easily accessible and used in video games. Although EA does not officially sponsor such use, it condones it through EA Locker use by the gaming consumers. Moreover, the loophole in NCAA policy and EA's obligation not to use names of SAs in the official release of video games has created a successful para-economy, in third parties creating and selling NCAA team rosters to be incorporated in the game, achieving greater realism.
- Even without direct reference to names, likenesses, jersey numbers, and the respective teams' rosters each year, identities of SAs are good indicators of the relationships between SAs, institutions, NCAA, and commercial partners within video games. Through content analysis research streams, statistical correlations, and data, adjudicating bodies may decide the scope and validity of use of SAs in video games.
- EA is dominant in the college sports video game market. Under *Noerr-Pennington*, it may be relieved from any unfair practices claims and antitrust liability, absent malevolent intent and bad faith, while approaching standard-setting bodies with rules' changes recommendations.
- There is a clearly established *vacuum legis* in NCAA policy that does not attend to such uses of SAs by commercial partners in the video game industry. This loophole has been acknowledged by NCAA governance bodies, which have endeavored to evolve policy during the past three to four years. The *Keller* case may be an additional motivating factor for regulatory amendments in Bylaw 12 with regard to amateurism exceptions for such use and the creation of a

new fund from which SAs can gain substantial benefits.

- If the case proceeds in litigation before the federal courts in California, the defense of consent will be a highly contested and possibly instrumental factor toward resolution of the inherent conflicts *Keller* poses. The findings of this research show that there is no express consent by SAs for use of their images, likenesses, and identities in video games, absent individual institution's agreements. The implied consent will arguably be the most difficult part of the case. Considering the broad scope of consent that SAs submit to the NCAA and institutions when entering intercollegiate athletics, the NCAA stands a good chance of upholding the defenses of maintaining amateurism, self-governance, and exemption from constitutional scrutiny.
- Should SAs be considered either employees, or via a new fiction "quasi-employees," with the concurrent acknowledgment of their unique status in federal labor standards and legislation, they could engage in negotiating rights, and eventually submit copyright protection to the NCAA and institutions that use their identities in video games. In the advent of such collective licensing, the NCAA and CLC may follow the path of professional players' unions establishing licensing arms that control the rights to players' intellectual property. This could be an NCAA SAs' licensing entity, under the auspices of either CLC or a separate entity.
- The argument that NLI/GIAs emulate unconscionable contracts of adhesion remains to be tested by a court. *Keller*, at this point, however, presented a sixth cause of action for breach of contract by the NCAA, which can be defeated on several grounds.
- *C.B.C.*'s scope may be tested by the Ninth Circuit, although the nature of the alleged violation of plaintiffs' rights of publicity is not the same (names and statistics in *C.B.C.*, likenesses and identities in *Keller*). If the judges on the Ninth Circuit side with *Kozinski's* opinions and render SAs' likenesses and identities as used by video game manufacturers not protectable, *C.B.C.*'s scope would be extended, affording public domain theory and First Amendment protection to a vast array of commercial uses of intellectual property rights.
- The doctrine of licensee estoppel may impact the case, should it be held that the NCAA's license cannot be challenged; alternatively, interested entrepreneurs may wish to follow this case closely, in light of expanded free use of SAs' likenesses and identities. It has not been established whether EA can use any defensive weapons from the estoppel, indemnification, and pertinent arsenal from the NCAA licensing contract in its defense of *Keller*.
- Scrambling or significantly modifying SAs' images in future video games does not appear logical, either as a business practice or as a line of defense for EA.
- Although there has been some likelihood of success on a Section 43(a) Federal Lanham Act claim in past cases, this potential claim remains idle.
- Certification of *Keller* as a class action remains to be tested, under the above analysis. However, considering recent class action suits and eventual settlements, its prospects are good.
- Considering NCAA policy, congressional scrutiny, strategic management of past litigation, and a host of others, the potential for a mutually beneficial settlement are significant and may influence immediate litigation strategies in *Keller* and future cases.

Contemporary intellectual property theory and law practice dealing with rights of publicity protection teeter along a continuum. Practitioners are called to balance between protecting every form of an identity's commercial value in the entertainment business and the freedom to use names, data, images, and likenesses from a rich public domain ad nauseam. *White* and *Motschenbacher* reside on one end of the spectrum, while *C.B.C.* and the *Kozinski* school of thought are on the other. *Keller* may provide further clarification and modern interpretation of where the law stands today. The major issue in *Keller*, which may confirm or refute currently established intellectual property norms, is that proposed class members are unlike usual right of publicity plaintiffs. Indeed, they are students. Yet they are more than just students. They generate revenue, and through the opportunities provided by their institutions, they are the gears that turn a sports entertainment industry unlike any other. The foundation of intercollegiate athletics is that it is amateur-based and education-

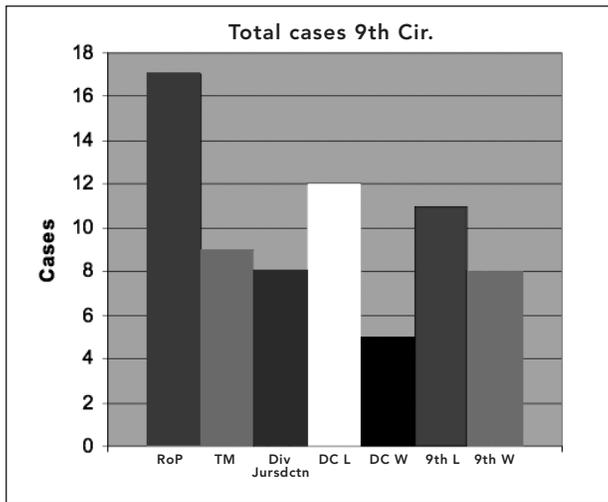


CHART 1

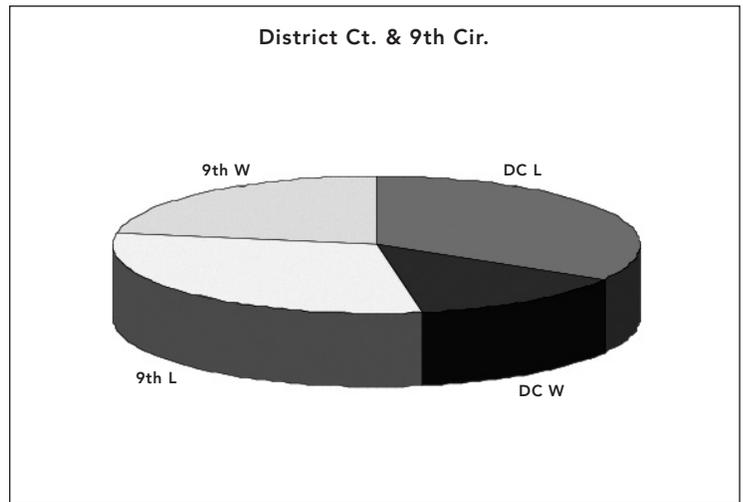


CHART 2

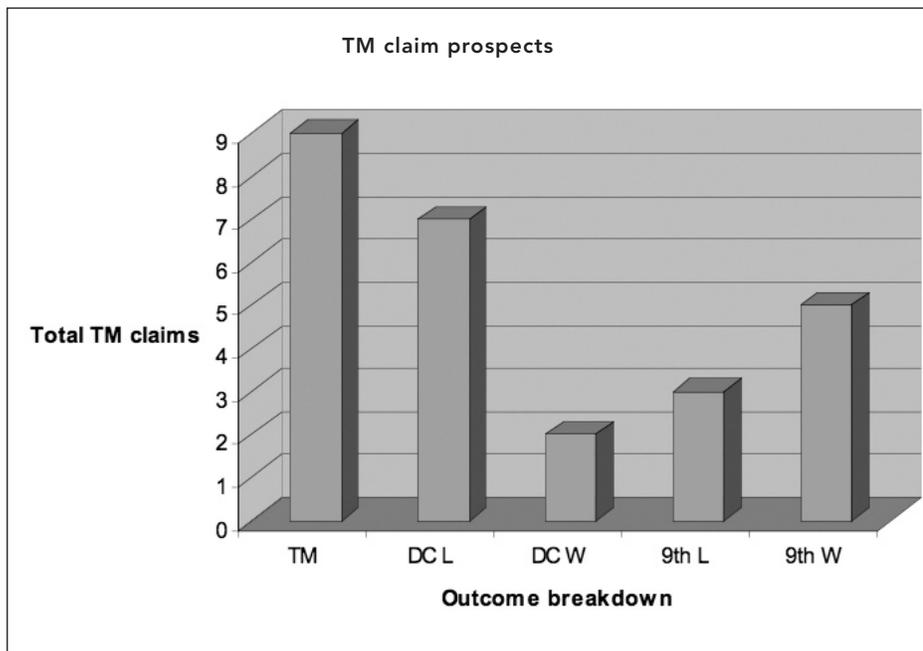


CHART 3

driven. America has turned college athletics into an impressively competitive, commercialized, and opportunity-providing field for hundreds of thousands of sports-loving workers. The fact remains that NCAA law does not allow these talented SAs to receive pay by using their athletic skills, with exceptions only provided by NCAA and institutional policies. These amateurism exceptions test boundaries, but also attend to contemporary reality, which begs institutions to constantly find new sources of revenue. Revenue is needed to maintain the intercollegiate athletics paradigm, with a multitude of sports offered, funded mostly by the performances and commercial value of the Keller class members. Beyond the discussion of revisiting the tax-exempt status of intercollegiate athletics programs, changing paradigms, and conflicts in the association's bylaws lays the fact that economic considerations greatly decide future management of cases. Should NCAA institutions' presidents and key stakeholders find that it is too dangerous to test NCAA amateurism in court, they will opt for a mutually beneficial settlement. Settlement may be prudent as long as it does not compromise bedrock principles of the NCAA (i.e., amateurism, student-athlete welfare, institutional control, and competitive equity). Lessons from the past teach that there may be common ground, and more prerequisites for athletes to maintain their student identities under the auspices of the NCAA. As long as this mutual ground does not jeopardize the ability of most institutions to provide the range of athletic programs they strive to

maintain in the face of financial adversity, it will enjoy broad acceptance. Thus, policy gaps would be treated in an acceptable fashion, and justice would be served by addressing intellectual property and rights of publicity for these students and athletes. ❖

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Anastasios Kaburakis is an assistant professor of sport law and sport management, and director of the graduate program in sport management at Southern Illinois University, Edwardsville, Illinois. He can be reached at [akabura@siue.edu](mailto:akabura@siue.edu).

David A. Pierce is an assistant professor of sport administration and coordinates the undergraduate sport administration program at Ball State University in Muncie, Indiana. He can be reached at [dapierce@bsu.edu](mailto:dapierce@bsu.edu).

Olivia M. Fleming is currently a third-year law student at Indiana School of Law—Indianapolis, and is expected to graduate in May 2010. She can be reached at [omfleming@yahoo.com](mailto:omfleming@yahoo.com).

Galen E. Clavio is a professor of sport management at Indiana University, where his research focuses on new media and communication in sport. He can be reached at [gclavio2@indiana.edu](mailto:gclavio2@indiana.edu).

Heather J. Lawrence is an assistant professor of sport management at Ohio University. She can be reached

Dawn A. Dziuba is working on an LL.M. in intellectual property at Washington University in St. Louis and will graduate in December 2009. She can be reached at ddziuba@wustl.edu.

## ENDNOTES

1. CV 09-1967 (N.D. Cal., filed May 5, 2009).
2. See, e.g., *Ex-Quarterback Sues NCAA and Video Game Company over Alleged Misuse of Likenesses*, CHRON. HIGHER EDUC. (May 8, 2009), [http://chronicle.com/news/article/6448/ex-quarterback-sues-ncaa-and-video-game-company-over-alleged-misuse-of-likenesses?utm\\_source=at&utm\\_medium=en](http://chronicle.com/news/article/6448/ex-quarterback-sues-ncaa-and-video-game-company-over-alleged-misuse-of-likenesses?utm_source=at&utm_medium=en); Hustler Locker, *Sam Keller Takes on the Man*, [http://www.huskerlocker.com/blogs/view/bid/1190/i/sam\\_keller\\_takes\\_on\\_the\\_man/o/0](http://www.huskerlocker.com/blogs/view/bid/1190/i/sam_keller_takes_on_the_man/o/0) (May 6, 2009); Phil Miller, *Another College Football Player Takes a Stab at the NCAA*, <http://thesportseconomist.com/2009/05/another-college-football-player-takes.htm> (May 8, 2009, 4:29 EST); Elie Mystal, *College Athletes Finally Sue Electronic Arts/NCAA for Misappropriation of Their Likenesses*, ABOVE THE LAW—A LEGAL TABLOID (May 7, 2009), [http://abovethelaw.com/2009/05/college-athletes-finally-sue\\_e.php?show=comments#comments](http://abovethelaw.com/2009/05/college-athletes-finally-sue_e.php?show=comments#comments); Darren Rovell, *Former College QB Has Strong Case Against NCAA & EA*, CNBC SPORTS BIZ (May 6, 2009), available at <http://www.cnbc.com/id/30605723?userid=1f230ff6ff959ecc8bf4a0c8be5b904&messageid=380>; Aaron Stringer, *Former NCAA QB Sues for Use of Players' Images*, WILLAMETTE (May 8, 2009), [http://blog.willamette.edu/wucl/journals/sportslaw/2009/05/former\\_ncaa\\_qb\\_sues\\_for\\_use\\_of.php](http://blog.willamette.edu/wucl/journals/sportslaw/2009/05/former_ncaa_qb_sues_for_use_of.php); The Nat'l Sports & Ent. L. Soc'y, *Former College QB Takes on the NCAA and EA Sports*, <http://nationalsportsandentertainment.wordpress.com/2009/05/06/former-college-qb-takes-on-the-ncaa-and-ea-sports/#respond> (May 6, 2009, 11:53 EST); The Ultimate Sports Insider, *What Color Is the NCAA's Laundry?* <http://www.ultimatesportsinsider.com/2009/05/what-color-is-ncaas-laundry.html> (May 10, 2009, 11:15 EST); Eugene Volokh, *Graduate Student Dissertation Advisor Relationship Doesn't Give Rise to a Fiduciary Duty*, <http://volokh.com/posts/1241817948.shtml> (May 8, 2009, 5:25 EST); Steve Wieberg, *Ex-QB Sues NCAA, EA Sports over Use of Athletes' Likenesses*, USA TODAY (May 7, 2009), available at [http://www.usatoday.com/sports/college/2009-05-07-keller-ncaa-easports-lawsuit\\_N.htm](http://www.usatoday.com/sports/college/2009-05-07-keller-ncaa-easports-lawsuit_N.htm).
3. E.g., Anastasios Kaburakis, David A. Pierce, Heather J. Lawrence & Galen Clavio, *NCAA Student-Athletes Rights of Publicity and the Video Game Industry. Compromising Amateurism?* Proceedings of the Sport and Recreation Law Association 22nd Annual Conference, San Antonio, TX (Mar. 2009). See also Sean Hanlon & Ray Yasser, "J.J. Morrison" and His Right of Publicity Lawsuit Against the NCAA, 15 VILL. SPORTS & ENT. L.J. 241 (2008).
4. The Divisional membership of the NCAA and the differentiation between Divisions I, II, and III will not be elaborated herein. For purposes of this manuscript, and as the Keller case delimits class to football and men's basketball SAs (omits Division, although presumed referring to Division I, as those are the teams featured in the video games), where reference is made to NCAA SAs, the term will refer to the SAs involved in the class action, unless otherwise specified.
5. See NAT'L COLLEGIATE ATHLETIC ASS'N ("NCAA") FINAL REPORT OF THE NCAA TASK FORCE ON COMMERCIAL ACTIVITY IN DIVISION I INTERCOLLEGIATE ATHLETICS (2009), [http://web1.ncaa.org/web\\_files/](http://web1.ncaa.org/web_files/)

- DI\_Amateurism\_Cab/2009/February/Supplement%20No.%207-a.pdf [hereinafter NCAA FINAL REPORT]; DR. MYLES BRAND, NCAA, STATE OF THE ASSOCIATION 2009: THE CHALLENGES OF COMMERCIAL ACTIVITY (2009), [http://web1.ncaa.org/web\\_files/DI\\_Amateurism\\_Cab/2009/February/Supplement%20No.%207-b.pdf](http://web1.ncaa.org/web_files/DI_Amateurism_Cab/2009/February/Supplement%20No.%207-b.pdf).
6. NCAA FINAL REPORT, *supra* note 5, at 8.
7. See *infra* note 70 (on amateurism references).
8. EA Sports, EA SPORTS NCAA Football 2005 Sets Franchise Sales Record; College Game Is #1 Football Title of the Season, [http://news.ea.com/portal/site/ea/index.jsp?ndmViewId=news\\_view&ndmConfigId=1013894&newsId=20040727005377&newsLang=en](http://news.ea.com/portal/site/ea/index.jsp?ndmViewId=news_view&ndmConfigId=1013894&newsId=20040727005377&newsLang=en) (last visited June 13, 2009).
9. *Id.*
10. 2008–2009 NCAA DIVISION I MANUAL, Bylaws art. 12.5.
11. Beth A. Cianfrone & Thomas A. Baker, The Use of Student-Athlete Likeness in Sport Video Games: An Application of the Right of Publicity, Presentation at the North American Society for Sport Management 2009 Conference, Columbia, S.C. (May 28, 2009), abstract available at [http://www.nassm.com/files/conf\\_abstracts/2009-021.pdf](http://www.nassm.com/files/conf_abstracts/2009-021.pdf).
12. TrickyD, Free College Rosters (July 6, 2008), [http://www.freecaa09rosters.com/index.php/what\\_is\\_the\\_ea\\_locker/](http://www.freecaa09rosters.com/index.php/what_is_the_ea_locker/); see also FreeNCAA09rosters, *What Is the EA Locker*, [http://www.freecaa09rosters.com/index.php/what\\_is\\_the\\_ea\\_locker/](http://www.freecaa09rosters.com/index.php/what_is_the_ea_locker/) (last visited June 13, 2009).
13. See, e.g., *Spirited Courtroom Argument Highlights Madden Monopoly Case*, GAMEPOLITICS.COM (Feb. 18, 2009), <http://www.gamepolitics.com/2009/02/18/spirited-courtroom-argument-highlights-madden-monopoly-case>; Ben Kuchera, *Lawsuit Flags EA for Illegal Procedure on Football Monopoly*, ARSTECHNICA.COM, <http://arstechnica.com/gaming/news/2008/06/lawsuit-flags-ea-for-illegal-procedure-on-football-monopoly> (June 12, 2008, 6:20 PM CST); Pete Holiday, *EA Sports Sued over Exclusive Licenses*, FANHOUSE, <http://ncaafanhouse.com/2008/06/19/ea-sports-sued-over-exclusive-licenses> (June 19, 2008, 3:15 PM EST).
14. Tim Surette & Curt Feldman, *Big Deal: EA and NFL Ink Exclusive Licensing Agreement*, GAMESPOT.COM, [http://www.gamespot.com/news/2004/12/13/news\\_6114977.html](http://www.gamespot.com/news/2004/12/13/news_6114977.html) (Dec. 13, 2004, 2:53 PM PST). Note that under the *Noerr-Pennington* doctrine (*Eastern R. Conf. v. Noerr Motors*, 365 U.S. 127 (1961), and *United Mine Workers v. Pennington*, 381 U.S. 657 (1965)), an individual or organization can petition a standard-setting organization (application to private entities is contested, as initially the doctrine referred to public and governmental actions; see also Mary L. Azcuenaga, Commissioner, Federal Trade Commission, Private Standard-Setting and the *Noerr-Pennington* Doctrine, 23rd Annual Symposium on Trade Association Law and Practice (Mar. 4, 1987); and Angela Gomes, *Noerr-Pennington: Unocal's Savior—or Is It?* 11 B.U. J. SCI. & TECH. L. 102 (2005)) toward action that may eventually affect a competitor negatively via restraint of trade, but will be considered immune from antitrust liability, unless the petition is a "sham" (i.e., if the action "... ostensibly directed toward influencing governmental action, is a mere sham to cover what is actually nothing more than an attempt to interfere directly with the business relationships of a competitor [then] the application of the Sherman Act would be justified." *Noerr*, 365 U.S. at 144). In the case of EA (if sport governing bodies such as the NFL and the NCAA were considered standard setting organizations), EA executives may have influenced the

- NFL and NCAA toward regulatory action that might detrimentally impact, e.g., major competitor Take Two, but barring a "sham" case, EA would be shielded from antitrust liability.
15. Darren Rovell, *All Madden, All the Time*, ESPN.COM (Dec. 14, 2004), <http://sports.espn.go.com/espn/sportsbusiness/news/story?id=1945691>.
16. Nate Ahearn, *EA Sports Locks up NFL License . . . Again*, IGN.COM (Feb. 12, 2008), <http://xbox360.ign.com/articles/851/851316p1.html>.
17. *Id.*
18. Press Release, Stage Select.com, CLC Grants EA Exclusive College Football Videogame License, <http://www.stageselect.com/N1109-press-release-clc-grants-ea-exclusive-college-foot.aspx> (Apr. 11, 2005, 2:43 PM EST).
19. *College Hoops Canned as EA NCAA Rumors Swirl*, EDGE-ONLINE.COM (Jan. 14, 2008), <http://www.edge-online.com/news/college-hoops-canned-ea-ncaa-rumors-swirl>.
20. John Gaudiosi, *Interview: EA Sports Talks Exclusive NCAA Basketball*, GAMEDAILY.COM (Sept. 17, 2008), <http://www.gamedaily.com/articles/features/interview-ea-sports-talks-exclusive-ncaa-basketball>.
21. Tom Magrino, *College Hoops 2K9 Ejected*, GAMESPOT.COM (Jan. 14, 2008), <http://www.gamespot.com/xbox360/sports/collegehoops2k8/news.html?sid=6184658>.
22. *Id.* at 3.
23. 2008–2009 NCAA DIVISION I MANUAL.
24. NCAA, Educational Column, Jan. 7, 2006.
25. *Id.*
26. NCAA, Official Interpretation, July 15, 2008.
27. Michael Rogers, Chair, NCAA Division I Amateurism Cabinet, Address at the 2009 NCAA Convention, NCAA Division I Issues Forum (Jan. 16, 2009).
28. NCAA Division I Legislative Proposal 2007-26. Available under the Legislative Database for the Internet, <https://web1.ncaa.org/LSDBI/exec/homepage>.
29. Lauren Smith, *Controversial NCAA Proposal Would Allow Colleges to Cash in on Players' Images*, CHRON. HIGHER EDUC. (May 8, 2008), available at <http://chronicle.com/daily/2007/09/2007092604n.htm>.
30. *Id.*
31. REPORT OF THE NCAA DIVISION I STUDENT-ATHLETE ADVISORY COMMITTEE (Nov. 2008 & 2009).
32. Memorandum from Torie A. Johnson, 2008 SEC Student-Athlete Advisory Committee Meeting Notes (Nov. 18, 2008), available at [http://www.secsports.com/doc\\_lib/saac\\_meeting\\_fall08.pdf](http://www.secsports.com/doc_lib/saac_meeting_fall08.pdf).
33. *Id.*
34. See Smith, *supra* note 29.
35. *Id.* at 28 (quoting Lofton).
36. *Id.*
37. Maya T. Prabhu, *Officials Huddle on Use of Athletes' Images: Video Games, Fantasy Leagues Raise Huge Questions for College Athletics*, ESCHOOLNEWS.COM (Oct. 31, 2008), <http://www.eschoolnews.com/news/top-news/index.cfm?&i=55837>.
38. See NCAA FINAL REPORT, *supra* note 5, at 1.
39. *Id.* at 10.
40. Prabhu, *supra* note 37.
41. *Id.*
42. Press Release, Knight Commission of Intercollegiate Athletics, Knight Commission Criticizes Commercialization of College Athletes in Fantasy Sports, New Media (Oct. 27, 2008), [http://knightcommission.org/index.php?option=com\\_content&view=article&id=242:knight-commission-criticizes-commercialization-of-college-athletes-in-fantasy-sports-new](http://knightcommission.org/index.php?option=com_content&view=article&id=242:knight-commission-criticizes-commercialization-of-college-athletes-in-fantasy-sports-new)

media&catid=1:content&Itemid=11.

43. *Id.* at 3.

44. *Id.*

45. See C.B.C. Distrib. & Mktg, Inc. v. Major League Baseball Advanced Media, L.P., 505 F.3d 818 (8th Cir. 2007); *infra* note 147 et seq.

46. Myles Brand, *Fantasy Leagues May Be Less Than They Seem*, NCAA DOUBLE-A ZONE, [http://www.doubleazone.com/2008/09/fantasy\\_sports\\_ncaa\\_president\\_myles\\_brand.php#comments](http://www.doubleazone.com/2008/09/fantasy_sports_ncaa_president_myles_brand.php#comments) (Sept. 9, 2008, 3:34 PM EST).

47. See NCAA FINAL REPORT, *supra* note 5, at 11.

48. E.g., Jon M. Garon, *Playing in the Virtual Arena: Avatars, Publicity, and Identity Reconceptualized Through Virtual Worlds and Computer Games*, 11 CHAP. L. REV. 465 (2008); Hanlon & Yasser, *supra* note 3, at 241; Richard T. Karcher, *The Use of Players' Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 PENN ST. L. REV. 557 (2007); Robert Lattinville, *Logo Cops: The Law and Business of Collegiate Licensing*, 5 KAN. J.L. & PUB. POL'Y 81 (1996); Matthew G. Matzkin, *Gettin' Played: How the Video Game Industry Violates College Athletes' Rights of Publicity by Not Paying for Their Likenesses*, 21 LOY. L.A. ENT. L. REV. 227 (2001); Amy Christian McCormick & Robert A. McCormick, *The Emperor's New Clothes: Lifting the NCAA's Veil of Amateurism*, 45 SAN DIEGO L. REV. 495 (2008); Kristine Mueller, *No Control over Their Rights of Publicity: College Athletes Left Sitting on the Bench*, 2 DEPAUL J. SPORTS L. CONTEMP. PROBS. 70 (2004); Christopher M. Parent, *Forward Progress? An Analysis of Whether Student-Athletes Should Be Paid*, 3 VA. SPORTS & ENT. L.J. 226 (2004); James S. Thompson, *University Trading Cards: Do College Athletes Enjoy a Common Law Right to Publicity?* 4 SETON HALL J. SPORTS L. 143 (1994); Maureen C. Weston, *The Fantasy of Athlete Publicity Rights: Public Fascination and Fantasy Sports' Assertion of Free Use Place Athlete Publicity Rights on an Uncertain Playing Field*, 11 CHAP. L. REV. 581 (2008).

49. Thompson, *supra* note 48, at 176.

50. *Id.*

51. See 2008–2009 NCAA DIVISION I MANUAL, Bylaw art. 12.5.1.1(h), at 71 (in parentheses, the adoption, revision, and effective dates).

52. Matzkin, *supra* note 48.

53. Admittedly, scrambling could be a major problem for EA should it be assumed as a preemptive strategy, among other factors, considering the “smoking gun” scrambling finding in the National Football League retired players’ class action suit of *Parrish, Adlerley, Roberts III et al. v. NFL Players Inc.*, C 07-00943 (N.D. Cal., post-trial motions order Jan. 13, 2009). It was established therein that the NFL Players Association and EA had conspired to scramble the images of retired players for whose likenesses they did not have authorization to use in the Madden NFL video game. For measure, the jury verdict totaled \$28.1 million in damages awarded to the plaintiffs. EA was not a party in the suit.

54. Matzkin, *supra* note 48, at 238.

55. *Id.* at n.101.

56. NCAA, Educational Column, *supra* note 24.

57. See Matzkin, *supra* note 48. Matzkin also offers the more prudent solution to the problem (considering scrambling the images of SAs in the video games would be undesirable to both SAs and customers) being a change in NCAA regulations to allow the use of names of SAs. That, of course, would reduce the efficiency of any potential defense in rights of publicity claims, unless there is express consent for the use of SAs’ names; stated otherwise, plaintiffs would have an

even greater likelihood of success on the merits of their rights of publicity claims if their likenesses were used in conjunction with their names without their consent. Of course, all these options pertain to monetary considerations, and, at this point, we may witness a shift in the traditionally established norms of amateurism with more exceptions (i.e., *White* settlement), which could, at a more fiscally feasible time, allow institutions and the NCAA to create means for compensation, albeit indirect, for the use of SAs’ (names and) likenesses in video games.

58. E.g., the National College Players Association (“NCPA”) would collectively bargain benefits for college athletes. See NCPA, <http://www.ncpanow.org> (last visited June 4, 2009).

59. See *infra* note 70. See also Knight Commission, *supra* note 42.

60. 805 F.2d 663 (7th Cir. 1986) (finding that the copyright of MLB clubs over games’ telecasts, which were deemed works-for-hire, preempted players’ rights of publicity in performances).

61. *White v. Nat’l Collegiate Athletic Ass’n*, CV 06-0999 VBF (C.D. Cal., settlement filed Jan. 29, 2008; final approval of settlement Aug. 5, 2008). See also *infra* notes 174 et seq.

62. Even severely critical court decisions of the NCAA’s regulations do not argue that there is a contract between the SA and the NCAA, instead focusing on the (contractual) relationship between the institution and the SA, the contract between the institution and the association, and the latter contract’s impact on the SA as a third-party beneficiary. See, e.g., *Oliver v. NCAA*, 2008-CV-0762 (C.P. Erie Cty, Ohio, Feb. 12, 2009). This finding is problematic, observing *Keller’s* Sixth Cause of Action on Breach of Contract as against the NCAA. *Keller v. Elec. Arts, Nat’l Collegiate Athletic Ass’n & Collegiate Licensing Co.*, CV 09-1967, at \*20 (N.D. Cal., filed May 5, 2009).

63. *Ferguson v. Countrywide Credit Indus.*, 298 F.3d 778 (9th Cir. 2002). Indeed, the burden of proof is set considerably higher as the court remarks that terms would render a contract unconscionable if they “shock the conscience.” *Id.* at 784. Moreover, the RESTATEMENT (SECOND) OF CONTRACTS § 208 (1981) declares unconscionable a contract “such as no man in his senses and not under delusion would make on the one hand, and as no honest and fair man would accept on the other.”

64. Hanlon & Yasser, *supra* note 3, at 291.

65. For example, both Brandon Jennings (forgoing college basketball) and Jeremy Tyler (forgoing completion of high school in the United States) have pursued their basketball education in Europe. See MONEY PLAYERS, <http://www.moneyplayersblog.com/blog/2009/06/jeremy-tyler-just-might-be-whats-right-with-basketball.html#more> (June 03, 2009, 11:37 PM EST).

66. See *Bragg v. Linden Research, Inc.*, 487 F. Supp. 2d 593 (E.D. Pa. 2007). The mandatory provision for arbitration, and one that unreasonably favored the service provider, was construed as unconscionable and a contract of adhesion. What is useful to recall is that this case entitled property rights in a virtual world (“Second Life”), and although not the only related MMORPG (*infra* note 160, et seq.), “Second Life was the first and only virtual world to specifically grant its participants property rights in virtual land.” *Id.* at 606.

67. Hanlon & Yasser, *supra* note 3, at 293.

68. 2008–2009 NCAA DIVISION I MANUAL, Bylaw art. 12.3.3.

69. Hanlon & Yasser, *supra* note 3, at 294.

70. The fact that SAs receive athletically related financial aid is arguably deviating from the original

meaning of the term, hence the quotation marks; for a more elaborate analysis, see L. ALLISON, AMATEURISM IN SPORT: AN ANALYSIS AND DEFENSE (Frank Cass Publishers 2001); JOHN BALE, THE BRAWN DRAIN: FOREIGN STUDENT-ATHLETES IN AMERICAN UNIVERSITIES (Univ. of Illinois Press 1991); WALTER BYERS, UNSPORTSMAN-LIKE CONDUCT: EXPLOITING COLLEGE ATHLETES (Univ. of Michigan Press 1995); JOSEPH N. CROWLEY, IN THE ARENA: THE NCAA’S FIRST CENTURY (The National Collegiate Athletic Ass’n 2005); ALLEN L. SACK & ELLEN J. STAUROWSKY, COLLEGE ATHLETES FOR HIRE: THE EVOLUTION AND LEGACY OF THE NCAA’S AMATEUR MYTH (Praeger Publishers 1998); Ellen J. Staurowsky, *Piercing the Veil of Amateurism: Commercialization, Corruption, and U.S. College Sports* 143–63 in THE COMMERCIALIZATION OF SPORT (Trevor Slack ed., Routledge 2004); Ronald A. Smith, *History of Amateurism in Men’s Intercollegiate Athletics: The Continuance of a 19th-Century Anachronism in America*, 45:4 QUEST 430–47 (1993); Stanton Wheeler, *Rethinking Amateurism and the NCAA*, 15:1 STAN. L. & POL’Y REV. 213–35 (2004); A. Kaburakis, NCAA Division I Amateurism and International Prospective Student Athletes: The Professionalization Threshold (2005) (Ph.D. dissertation, Indiana University), DISSERTATION ABSTRACTS INT’L 67(01), DAI-B. AAT 32904289.

71. Justice Cooley served on the Michigan Supreme Court.

72. THOMAS M. COOLEY, A TREATISE ON THE LAW OF TORTS OR THE WRONGS WHICH ARISE INDEPENDENTLY OF CONTRACT (Callaghan & Co. 1878).

73. *Id.* at 192.

74. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 195 (1890). See also Amy Gajda, *What If Samuel D. Warren Hadn’t Married a Senator’s Daughter?: Uncovering the Press Coverage That Led to the Right to Privacy*, Illinois Public Law and Legal Theory Research Papers Series Research Paper No. 07-06, November 1, 2007, Social Science Research Network Electronic Paper Collection, <http://papers.ssrn.com/abstract=1026680> (attempting to pinpoint newspaper sources that provoked Warren’s disdain for the media, eventually leading to the seminal article; the author concludes that it was the marriage of Warren into a political family that led to Warren and Brandeis drafting their Right to Privacy theory manuscript).

75. Warren & Brandeis, *supra* note 74, at 195.

76. See *Roberson v. Rochester Folding Box Co et al.*, 171 N.Y. 538, 64 N.E. 442, 1902 N.Y. LEXIS 881 (N.Y. 1902) (The plaintiff alleged the corporations, without the individual’s knowledge or consent, made, printed, sold, and circulated lithographic likenesses of the individual for the purpose of profit. The New York Court of Appeals, in a 4–3 decision, decided against the establishment of the right, as it would “result in a vast amount of litigation, and in litigation bordering upon the absurd. The right of privacy could not be confined to the restraint of the publication of a likeness but must necessarily embrace as well the publication of a word-picture, a comment upon one’s looks, conduct, domestic relations, or habits. . . . [T]he mischief that would result would be incalculable under a system that made a decision in one case a precedent for decisions in all future cases that were akin to it in the essential facts.”) *But see* *Pavesich v. New England Life Ins. Co.*, 122 Ga. 190, 50 S.E. 68, 1905 Ga. LEXIS 156 (Ga. 1905) (Plaintiff alleged invasion of the right of privacy due to unauthorized publication of picture in a life insurance advertisement. The Supreme Court of Georgia unanimously agreed the right had been established and, in this case, indeed violated.).

77. William L. Prosser, *Privacy*, 48 CAL. L. REV. 383,

384 (1960).

78. See Gajda, *supra* note 74, at 4 n.8.

79. Prosser, *supra* note 77, at 389.

80. *Id.*

81. *Id.* at 401 n.155. This footnote oft-cited by courts and scholars extricates a broad scope of privacy and eventually publicity protection. It could be regarded as an outstanding intellectual sample of forecasting future right of publicity litigation, especially in Prosser's adopted state of California (he was originally from Indiana).

82. *E.g.*, *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001) (elaborated below, precisely pertaining to Prosser's footnote description); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992); *White v. Samsung Elec. Am.*, 971 F.2d 1395, 1399 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988); *Motschenbacher v. RJ Reynolds*, 498 F.2d 821 (9th Cir. 1974).

83. Prosser, *supra* note 77, at 406.

84. 202 F.2d 866 (2d Cir. 1953).

85. Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

86. Prosser, *supra* note 77, at 406 n.193, 407 n.194.

87. RESTATEMENT (SECOND) OF TORTS § 652A (1977).

88. *Id.* at § 652C.

89. Particularly after cases such as *O'Brien v. Pabst Sales Co.*, 124 F.2d 167 (5th Cir. 1941), and *Haelan Labs.*, 202 F.2d 866.

90. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995). See also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, comment d (1995): "[I]n the case of . . . visual likeness, the plaintiff must be reasonably identifiable. . . . Whether the plaintiff is identified by the defendant's use is a question of fact. Relevant evidence includes the nature and extent of the identifying characteristics used by the defendant, the defendant's intent, the fame of the plaintiff, evidence of actual identification made by third persons, and surveys or other evidence indicating the perceptions of the audience. . . . [U]nauthorized use of other indicia of a person's identity can infringe the right of publicity. . . . The use of other identifying characteristics or attributes may also infringe the right of publicity, but only if they are so closely and uniquely associated with the identity of a particular individual that their use enables the defendant to appropriate . . ."; RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47, comment d (1995): "In an effort to balance the personal and proprietary interests recognized by the right of publicity with the public interests in free expression and in the creation of original works, some courts have engaged in an analysis analogous to the determination of fair use in copyright law. The substantiality and market effect of the appropriation have been analyzed in light of the informational or creative content of the defendant's use. In cases of imitation, the public interest in competition and in avoiding the monopolization of successful styles, together with the interest in the production of new works including parody and satire, will ordinarily outweigh any adverse effect on the plaintiff's market. . . ." Thus, the commentary seeks a balance between the acknowledged broad coverage of rights' protection and the freedom of expression allowing for creativity, artistic works, and entertainment.

91. See HANLON & YASSER, *supra* note 3, at 259–66 [for the transition from the Right to Privacy to the Right of Publicity through case law and the American Law Institute's *Restatements of the Law*. The authors, in footnote 148, opt for the *Restatements* as sources of legal theory, considering the diverse statutory recogni-

tion of the right of publicity among states. Considering the impact of particular cases, as well as the breadth of common law and statutory treatment of the right of publicity (see also Anastasios Kaburakis & Steven McKelvey, *Facenda Jr. v. NFL Films, Inc.*: "Voice of God" Case Settled After Third Circuit Ruling, 18 SPORT MKTG. Q. 2, at 108 (2009)), this article delimits and focuses on particular jurisdictions, considering the advent of the *Keller* case and California courts' precedent. At the same time, the approach the authors of this article select leans toward an analysis of the more difficult burden for the plaintiff to achieve a more prudent examination of the issues involved in the *Keller* case and others forthcoming].

92. J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* (West Pub. 1987). See also J. THOMAS MCCARTHY, *TRADEMARKS & UNFAIR COMPETITION* (West Pub. 1996).

93. Moreover, federal courts may apply diversity jurisdiction in cases where a certain state's common law or precise statutory provisions would not be appropriate or do not exist to provide resolution. *E.g.*, *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001) (Hawaii law would not be applicable; thus, the Ninth Circuit opted for application of California law, reversing the district court's handling of jurisdiction; there was no conflict of laws; Hawaii had no interest in applying its law and had not enacted a right of publicity statute).

94. Nat'l Conference of State Legislatures ("NCSL"), *State Right of Publicity*, available at <http://www.ncsl.org/programs/lis/privacy/publicity04.htm> (last visited June 5, 2009).

95. Int'l Trademark Ass'n ("INTA"), *Federal Right of Publicity* (Mar. 3, 1998), [http://www.inta.org/index.php?option=com\\_content&task=view&id=285&Itemid=153&getcontent=3](http://www.inta.org/index.php?option=com_content&task=view&id=285&Itemid=153&getcontent=3) (last visited June 14, 2009) (especially important and prudent in cases featuring, e.g., fantasy sports and interactive video games, triggering interstate commerce analysis).

96. *O'Brien v. Pabst Sales Co.*, 124 F.2d 167 (5th Cir. 1941).

97. *Id.* at 170.

98. *Id.* at 169.

99. *Id.* at 171.

100. *Id.* at 171.

101. *Haelan Labs. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir. 1953).

102. *Id.*

103. *Id.*

104. *Motschenbacher v. RJ Reynolds*, 498 F.2d 821, 822 (9th Cir. 1974).

105. See Parrish, Adderley, Roberts III et al. v. NFL Players Inc., C 07-00943 (N.D. Cal., post-trial motions order Jan. 13, 2009), *supra* note 53.

106. See also Palmer v. Schonhorn Enters., 232 A.2d 458 (N.J. Super. 1967) (use of golf players' names without consent); Uhlender v. Hendriksen, 316 F. Supp. 1277 (D. Minn. 1970) (use of baseball player's name and stats violated right of publicity); *Ali v. Playgirl*, 447 F. Supp. 723 (S.D.N.Y. 1978) (drawing of nude boxer resembling the facial characteristics of Muhammad Ali amounted to a wrongful appropriation of the market value of his likeness); *Hersch v. S.C. Johnson & Sons*, 90 Wis. 2d 379 (1979) (use of baseball player's nickname, "Crazy Legs," in a commercial for moisturizing shaving gel for women constituted a violation of the right of publicity); *Hillerich & Bradsky v. Christian Bros.*, 943 F. Supp. 1136 (Minn. 1996) (unauthorized manufacturer of hockey equipment unlawfully used the name "Messier" to create associations to NHL superstar Mark Messier).

107. *Ali*, 447 F. Supp. at 727.

108. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 833 (6th Cir. 1983).

109. *Id.* at 837.

110. *Id.* at 839, 840.

111. *Zacchini v. Scripps Howard Broad.*, 433 U.S. 562 (1977).

112. *Id.* at 574, 575.

113. *Id.* at 576 (quoting Harry Kalven Jr., *Privacy in Tort Law—Were Warren and Brandeis Wrong?* 31 LAW & CONTEMP. PROBS. 326, 331 (1966)).

114. *White v. Samsung Elec. Am.*, 971 F.2d 1395, 1399 (9th Cir. 1992).

115. Prosser, *supra* note 77.

116. *Motschenbacher v. RJ Reynolds*, 498 F.2d 821, 822 (9th Cir. 1974).

117. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 833 (6th Cir. 1982).

118. *White*, 971 F.2d at 1398, 1399 (which is precisely why "scrambling" would not shield the appropriator, i.e., EA, as the totality of the environment in the video game depicting college sports games would establish a sufficiently clear connection to the identity whose publicity is appropriated). As a matter of fact, defendants themselves referred to the ad as the "Vanna White ad." *Id.* at 1399.

119. *Id.*

120. *White v. Samsung Elec. Am.*, 989 F.2d 1512 (9th Cir. 1993).

121. *Id.* at 1513–19.

122. *Id.* at 1521. See also *Wendt v. Host Int'l Inc.*, 197 F.3d 1284 (9th Cir. 1999) (court siding with TV series *Cheers* characters claiming violations of federal Trademark Act and their statutory right of publicity for the use of robotic look-alikes in airport bars). In *Wendt*, Judge Kozinski again dissents in a denial to rehear *en banc*, and further comments: "As I noted in *White*, 'No California statute, no California court has actually tried to reach this far. It is ironic that it is we who plant this kudu in the fertile soil of our federal system.' 989 F.2d at 1519. We pass up yet another opportunity to root out this weed. Instead, we feed it Miracle-Gro."

123. *E.g.*, *C.B.C. Distrib. & 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); *Allison v. Vintage Sports Plaques*, 136 F.3d 1443 (11th Cir. 1998); *Cardtoons v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996).

124. 34 Cal. App. 4th 790 (1995).

125. CAL. CIV. CODE § 3344(d) (2009). "For purposes of this section, a use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account . . . shall not constitute a use for which consent is required under subdivision (a)." *Id.*

126. 94 Cal. App. 4th 400 (2001).

127. *C.B.C. Distrib. & Mktg.*, 505 F.3d 818.

128. *Supra* note 106.

129. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995). Also see RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, comment d (1995): ". . . [T]he identity of even an unknown person may possess commercial value . . . Thus, an evaluation of the relative fame of the plaintiff is more properly relevant to the determination of appropriate relief. . . ."

130. 948 F. Supp. 40 (N.D. Ill. 1996).

131. Approximately two years after *Pesina*, the Illinois legislature passed the Right of Publicity Act. See Illinois General Assembly, <http://www.ilga.gov/legislation/ilcs/ilcs3.asp?ActID=2241&ChapAct=765%26nbsp%3BILCS%26nbsp%3B1075%2F&ChapterID=62&Ch>

apterName=PROPERTY&ActName=Right+of+Publi  
city+Act.#top (last visited June 14, 2009).

132. See Int'l Trademark Ass'n, Adverse Infer-  
ence for Failure to Conduct Likelihood of Confusion  
Survey (Sept. 22, 2008), [http://www.inta.org/index.  
php?option=com\\_content&task=view&id=1920&Itemid=153&getcontent=3](http://www.inta.org/index.php?option=com_content&task=view&id=1920&Itemid=153&getcontent=3) (last visited Mar. 10, 2009).  
Note that the American Law Institute in the *Restate-  
ment (Third) of Unfair Competition* (1995), INTA,  
and the ABA have argued courts should not require  
consumer confusion surveys as a condition precedent  
for any plaintiffs' claims. Stated otherwise, the lack of a  
confusion survey should not be the (sole) determining  
factor to draw an adverse inference. See also *Facenda Jr.  
v. NFL Films, Inc.*, et al., 542 F.3d 1007 (3d Cir. 2008);  
*Kaburakis & McKelvey*, *supra*, note 91.

133. *Pesina*, 948 F. Supp. 40, at 42.

134. See *Parrish, Adderley, Roberts III et al. v.  
NFL Players Inc.*, C 07-00943 (N.D. Cal., post-trial  
motions order Jan. 13, 2009), *supra* note 53 (although  
the object of the class action suit was the agreement  
for representation with the players' union, and not  
any right of publicity claims against EA; however, the  
apportionment of damages by the California jury is  
somewhat indicative of class damages and may be use-  
ful to assist the *Keller* court in determinations.).

135. IND. CODE § 32-36 (2009).

136. 2008-2009 NCAA DIVISION I MANUAL,  
Bylaw art. 2.9.

137. CAL. CIV. CODE § 3344.

138. See NCAA, DI Form 08-3a, [http://web1.ncaa.  
org/web\\_files/compliance\\_forms/d1/DI%20Form%2008-3a.pdf](http://web1.ncaa.org/web_files/compliance_forms/d1/DI%20Form%2008-3a.pdf) (last visited June 14, 2009). Therein,  
the only consent submitted is as follows: "You authorize  
the NCAA [or a third party acting on behalf of the  
NCAA (e.g., host institution, conference, local  
organizing committee)] to use your name or picture  
to generally promote NCAA championships or other  
NCAA events, activities or programs."

139. See NCAA, HIPPA/Buckley Amendment  
Consent/Waiver Form, [http://web1.ncaa.org/web\\_files/  
compliance\\_forms/d1/DI%20HIPPA%202008.pdf](http://web1.ncaa.org/web_files/compliance_forms/d1/DI%20HIPPA%202008.pdf), and  
Drug-Testing Consent, [http://web1.ncaa.org/web\\_files/  
compliance\\_forms/d1/DI%20Form%2008-3d.pdf](http://web1.ncaa.org/web_files/compliance_forms/d1/DI%20Form%2008-3d.pdf) (last  
visited June 6, 2009).

140. See 2008-2009 NCAA DIVISION I MANUAL,  
Bylaw art. 14.01.3: "To be eligible to represent an  
institution in intercollegiate athletics competition,  
a student-athlete shall be in compliance with all  
applicable provisions of the constitution and bylaws  
of the Association and all rules and regulations of the  
institution and the conference(s), if any, of which the  
institution is a member."

141. See NCAA, DI Form 08-3a, *supra* note 138.  
The pertinent releases are:

- You affirm that your institution has provided you a copy of the Summary of NCAA Regulations or the relevant sections of the Division I Manual and that your director of athletics (or his or her designee) gave you the opportunity to ask questions about them.
- You affirm that you meet the NCAA regulations for student-athletes regarding eligibility, recruitment, financial aid, amateur status and involvement in gambling activities.
- You affirm that you have read and understand the NCAA amateurism rules.
- By signing this part of the form,

you affirm that, to the best of your knowledge, you have not violated any amateurism rules.

These releases are uniform across DI mem-  
ber institutions, and one may argue that they are  
overbroad and do not capture each aspect of, e.g.,  
intellectual property use of SAs' names, images,  
likenesses, and identities. See, e.g., *Hanlon & Yasser*,  
*supra* note 3 et seq. (arguing athletic scholarships  
and such releases are unconscionable contracts of  
adhesion and the ensuing counterpoints).

See also University of Maine Farmington,  
Returning Paperwork, [http://athletics.umf.maine.edu/  
Sports\\_Medicine/forms/returningpaperwork.doc](http://athletics.umf.maine.edu/Sports_Medicine/forms/returningpaperwork.doc) (last  
visited June 14, 2009), for a more precisely drafted  
release of SAs' rights of publicity. In this document,  
a DIII institution not only receives a complete in-  
demnification, but it also reserves an expansive scope  
of intellectual property rights. For example, the SA  
authorizes use and sublicensing of:

... [I]mage, appearance, likeness, voice and/  
or photograph, and other reproductions of  
any of these, in still photographs, videotapes,  
publications, audio, sound recordings, Web  
sites, electronic and other media and/or mo-  
tion pictures . . . and to do so with or without  
mention of my name . . .

The SA also declares:

I understand and agree that I am to receive  
no compensation of any kind, monetary or  
otherwise, on account of or arising from the  
production, publication, recording, rebroad-  
casting, or other use of such material. . . .  
The University of Maine System shall have  
complete ownership of the material produced  
or published and shall have the exclusive right  
and license to make such use of that material  
as it wishes, including, but not limited to the  
right of performance, display, reproduction,  
and distribution in all media, and the right to  
create, perform, display, and distribute deriva-  
tive works of the material.

142. See Jeremy T. Marr, *Constitutional Restraints  
on State Right of Publicity Laws*, 44 B.C. L. REV. 863  
(2003).

143. *Id.* at 864. Marr, *id.* at 898-99, further reiter-  
ates the aforementioned efforts for a preemptive federal  
right of publicity, *supra* note 95.

144. 95 F.3d 959 (10th Cir. 1996).

145. *Id.* at 969.

146. *Id.* at 974. See also C.B.C. Distrib. & Mktg.,  
Inc. v. Major League Baseball Advanced Media, L.P.,  
505 F.3d 818, 824 (8th Cir. 2007).

147. 505 F.3d at 818.

148. *Id.* at 823.

149. *Id.* at 826 (citing *Paragould Cablevision  
v. City of Paragould*, 930 F.2d 1310, 1315 (8th Cir.  
1991)).

150. According to which a licensee enjoying the  
benefits of a license is not allowed to challenge its  
validity. See, e.g., *Lear, Inc. v. Adkins*, 395 U.S. 653  
(1969).

151. C.B.C. Distrib. & Mktg., 505 F.3d at 825.

152. 395 U.S. 653. An important notion therein  
is that, frequently, the optimum control mechanism  
for violations, abuses of licenses, and monopolistic  
tendencies comes from licensees with the direct eco-  
nomic incentive to challenge such practices; hence,  
the preemption. *Id.* at 670-71. See also *MedImmune  
Inc. v. Genentech Inc.*, 549 U.S. 118 (2007), for the

most recent examination at the Supreme Court of  
licensee estoppel preemption extensions.

153. *Lear, Inc.*, 395 U.S. at 674, 675.

154. 335 F.3d 130, 135 (2d Cir. 2003).

155. 477 F.2d 326, 328-29 (6th Cir. 1973).

156. 816 F.2d 1191, 1200-01 (7th Cir. 1987).

157. C.B.C. Distrib. & Mktg., Inc. v. Major  
League Baseball Advanced Media, L.P., 505 F.3d  
818, 825 (8th Cir. 2007).

158. *Id.* at 826-27.

159. See also *Eldred v. Ashcroft*, 537 U.S. 186  
(2003); *Golan v. Gonzales*, 501 F.3d 1179 (10th  
Cir. 2007).

160. For the first registered trademark for a Sec-  
ond Life avatar, see [http://tarr.uspto.gov/servlet/tar  
r?regser=serial&entry=77110299](http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=77110299) (last visited June  
13, 2009). Also see Benjamin Duranske, "Aimee  
Weber" (TM) Gets USPTO Stamp of Approval for  
*Pigtails, Tutu, Wings, Tights, and Stompy Boots*,  
VIRTUALLY BLIND (Sept. 7, 2007), [http://virtually-  
blind.com/2007/09/21/aimee-weber-trademark/](http://virtually-blind.com/2007/09/21/aimee-weber-trademark/).

161. See, e.g., (for recent cases in gaming and  
virtual worlds-related litigation) *Bragg v. Linden  
Research, Inc.*, 487 F. Supp. 2d 593 (E.D. Pa. 2007);  
*E.S.S. Entm't 2000, Inc. v. Rockstar Videos, Inc.*,  
444 F. Supp. 2d 1012 (C.D. Cal. 2006); *Kirby  
v. Sega of Am.*, 50 Cal. Rptr. 3d 607 (Ct. App.  
2006); *BlackSnow Interactive v. Mythic Entm't,  
Inc.*, No. 02-00112 (C.D. CA, 2002).

162. C.B.C.'s coverage (as expected under  
Eighth Circuit jurisdiction) was recently confirmed  
in *CBS Interactive Inc. v. Nat'l Football League  
Players Ass'n*, Civil No. 08-5097 ADM/SRN (D.  
Minn., Apr. 28, 2009). Further, on June 1, 2009,  
Yahoo filed a similar suit in the same venue (U.S.  
District Ct. Minn.), wishing the same protection  
C.B.C. and CBS were awarded. See *Yahoo! Inc. v.  
Nat'l Football League Players Ass'n*, 09-cv-01272-  
PJS-FLN (D. Minn., June 1, 2009).

163. U.S. CONST. art. I, § 8, cl. 3 (the Com-  
merce Clause gives Congress the power "to regu-  
late Commerce . . . among the several States . . .").

164. *Id.* at cl. 8 (the Copyright Clause gives Con-  
gress the power "to promote the Progress of . . . useful  
Arts, by securing for limited Times to Authors . . . the  
exclusive Right to their respective Writings . . ."). Note  
that the use of the adjective "dormant" has tradition-  
ally been attributed to the Commerce Clause, in regard  
to an embedded preemption of state legislation that  
would run afoul of congressional intent regulating  
interstate commerce or compromise other states' leg-  
islative intentions. As an extension, the adjective also  
has been aligned with the Copyright Clause discussed  
herein, containing the underpinning preemption of  
state intellectual property law that would prejudice  
other states' interests. See *White v. Samsung Elec.  
Am.*, 989 F.2d 1512, 1518 (9th Cir. 1993); *Wendt v.  
Host Int'l Inc.*, 197 F.3d 1284, 1288 (9th Cir. 1999);  
and Marr, *supra* note 142, at 891.

165. See *White*, 989 F.2d at 1519. The *Kozinski*  
dissent posits: "The broader and more ill-defined one  
state's right of publicity, the more it interferes with the  
legitimate interests of other states. A limited right that  
applies to unauthorized use of name and likeness prob-  
ably does not run afoul of the Copyright Clause, but  
the majority's protection of 'identity' is quite another  
story."

166. *Id.* at 1519-20. There are other aspects of  
analysis in regard to due process preemption of rights  
of publicity statutes and common law extensions by  
courts, i.e., in the California courts' cases above where  
the scope has extended far beyond what is included

in the state statute or where a state imposes its rules extraterritorially (see *Wendt*, 197 F.3d at 1288). See also *Winters v. New York*, 333 U.S. 507, 509 (1948) (“It is settled that a statute so vague and indefinite, in form and as interpreted, as to permit within the scope of its language the punishment of incidents fairly within the protection of the guarantee of free speech is void, on its face, as contrary to the Fourteenth Amendment.”). A more elaborate analysis, however, goes beyond the scope of this paper and would be an outstanding focus of a manuscript solely devoted to federal preemption issues.

167. 105 F.3d 841 (2d Cir. 1997).

168. 542 F.3d 1007 (3d Cir. 2008).

169. 17 U.S.C. § 301 (1997).

170. See also *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (for the protection of singers’ characteristic voices). California is one of the six states (as of 2006, per Nat’l Conference of State Legislatures, *supra* note 94) expressly protecting “voice” under the respective statutory right of publicity.

171. *Facenda*, 542 F.3d at 1028–32.

172. For a more elaborate analysis, refer to *Kaburakis & McKelvey*, *supra* note 91.

173. See, e.g., *Midler*, 849 F.2d 460; *Waits*, 978 F.2d 1093; and *White v. Samsung Elec. Am.*, 971 F.2d 1395, 1399 (9th Cir. 1992).

174. 17 U.S.C. § 101 (1997).

175. See, e.g., *Baltimore Orioles v. Major League Baseball Players’ Ass’n*, 805 F.2d 663 (7th Cir. 1986).

176. See *supra* note 70.

177. See Frank P. Tiscione, *College Athletics and Workers’ Compensation: Why the Courts Get It Wrong in Denying Student-Athletes Workers’ Compensation Benefits When They Get Injured*, 14 SPORTS LAW. J. 137 (2007); Amy Christian McCormick & Robert A. McCormick, *The Emperor’s New Clothes: Lifting the NCAA’s Veil of Amateurism*, 45 SAN DIEGO L. REV. 495 (2008); Jason Gurdus, Note, *Protection off the Playing Field: Student Athletes Should Be Considered University Employees for Purposes of Workers’ Compensation*, 29 HOFSTRA L. REV. 907, 919 (2001); Rohith A. Parasuraman, *Unionizing NCAA Division I Athletes: A Viable Solution?* 57 DUKE L.J. 727 (2007).

178. See *State Comp. Ins. Fund v. Indus. Comm’n*, 135 Colo. 570, 314 P.2d 288 (1957); *Rensing v. Indiana State Univ. Bd. of Trustees*, 444 N.E.2d 1170 (Ind. 1983); *Coleman v. W. Michigan Univ.*, 336 N.W.2d 224 (Mich. Ct. App. 1983); *Waldrep v. Texas Employers Ins. Ass’n*, 21 S.W.3d 692 (Ct. App. Tex., 3d Dist., 2000).

179. *Supra* note 177.

180. See *Univ. of Denver v. Nemeth*, 257 P.2d 423 (Colo. 1953); *Van Horn v. Indus. Accident Comm’n*, 33 Cal. Rptr. 169 (Cal. Dist. Ct. App. 1963).

181. *Cheatham v. Workers’ Comp. Appeals Bd.*, 49 Cal. Comp. Cases 54 (Ct. App. 1984). Worth noting, however, is that the court acknowledged, “The student-athlete brings the school measurable and tangible benefits, including money, sufficient to establish an employer-employee relationship.”

182. *Boston Med. Ctr.*, 330 N.L.R.B. 152 (1999); *New York Univ.*, 332 N.L.R.B. 1205 (2000).

183. 342 N.L.R.B. 483 (2004). In this manuscript, the authors refrain from an elaborate analysis of the conceptualization of SAs as “quasi-employees” and the creation of a “quasi-work-for-hire” doctrine, which may be used along the parameters of the Copy-

right Act’s 17 U.S.C. § 301 preemption for § 101 work-for-hire (and any expansions of § 101 scope in future legislation). Suffice it to note, this is the focus of an ensuing contribution.

184. McCormick & McCormick, *supra* note 177.

185. *Id.* at 499, 500.

186. *Id.*

187. See, e.g., *Oliver v. NCAA*, 2008-CV-0762 (C.P. Erie Cty, Ohio, Feb. 12, 2009).

188. *White v. Nat’l Collegiate Athletic Ass’n*, CV 06-0999 VBF, at 12 (C.D. Cal., settlement filed Jan. 29, 2008; final approval of settlement Aug. 5, 2008).

189. FED. R. CIV. P. 23(a) (2009).

190. See *Crown, Cork, & Seale Co. v. Parking*, 462 U.S. 345 (1983).

191. FED. R. CIV. P. 23(b)(1)(A).

192. FED. R. CIV. P. 23(b)(1)(B).

193. FED. R. CIV. P. 23(b)(2).

194. FED. R. CIV. P. 23(b)(3).

195. *Hanlon v. Chrysler Corp.*, 150 F.3d 1011, 1023 (9th Cir. 1998).

196. FED. R. CIV. P. 23(b)(3).

197. *White v. Nat’l Collegiate Athletic Ass’n*, CV 06-0999 VBF (C.D. Cal., settlement filed Jan. 29, 2008; final approval of settlement Aug. 5, 2008); see also *White v. NCAA*, Order granting class certification, <http://www.ncaaclassaction.com/granting.pdf> (last visited June 14, 2009).

198. See *Parrish, Adderley, Roberts III et al. v. NFL Players Inc.*, C 07-00943 (N.D. Cal., post-trial motions order Jan. 13, 2009). See also *Adderley v. NFLPA*, Order granting class certification, [http://www.manatt.com/uploadedfiles/News\\_and\\_Events/Newsletters/ManattSports/Order%20Granting%20Class%20Certification,%20Case%20No.%20C07-0943%20WHA.pdf](http://www.manatt.com/uploadedfiles/News_and_Events/Newsletters/ManattSports/Order%20Granting%20Class%20Certification,%20Case%20No.%20C07-0943%20WHA.pdf) (last visited June 14, 2009).

199. *White*, CV 06-0999 VBF, at 2. In the eventual settlement, available under <http://www.ncaaclassaction.com/index.php3> (last visited June 14, 2009), the class was defined as “. . . all persons who received athletic-based GIAs from any of the (1) football programs sponsored by colleges and universities included in NCAA Division I-A; or (2) men’s basketball programs sponsored by colleges and universities in the ACC, Big East, Big 10, Big 12, Pac-10, SEC, Mountain West, WAC, Atlantic 10, Conference USA, Mid-American, Sun Belt, West Coast, Horizon League, Colonial Athletic Association, or Missouri Valley Conferences, at any time between February 17, 2002 and the entry of Judgment in the Action, which period shall include the entire academic year 2007–2008.”

200. The NCAA did not challenge that the proposed class met the numerosity, commonality, or typicality requirements. See *White*, Order granting class certification, *supra* note 197, at 2.

201. *Hanlon v. Chrysler Corp.*, 150 F.3d 1011, 1020 (9th Cir. 1998).

202. Defined by the court as “the last person at each school who actually receives a scholarship and thus the person at the margin of the proposed class”; *White*, Order granting class certification, *supra* note 197, at 3.

203. *Adderley*, Order granting class certification, *supra* note 198, at 11–14.

204. Per EA Sports motto.

205. Still, for reasons of virtual team rosters’ completion, there occasionally are some added numbers and randomly generated players.

206. See *Kris Pigna, No Legacy Teams in Any*

*Version of Madden NFL 10*, LUP.COM (May 16, 2009), <http://www.lup.com/do/newsStory?cid=3174252>.

207. Indeed, statutory rights of publicity in various states do not pertain to protection subsequent to the death of the right holder, and others extend to 100 years post death. See *NCSL*, *supra* note 94.

208. *White*, Order granting class certification, *supra* note 197, at 4.

209. See *Pesina v. Midway Mfg. Co.*, 948 F. Supp. 40 (N.D. Ill. 1996) (similarly, SAs who would be considered “marginal” players would have difficulties establishing commercial value in their likenesses for common law/statutory right of publicity and Federal Lanham Act protection).

210. One more challenge, of course, in such cases is the applicability of the law of the respective forum, here California law. In this respect, Keller may have the opportunity to make a case for California Law, as EA is based in California, and NCAA/CLC business is also taking place consistently in California; in the *Keller* complaint, it is argued that a substantial amount of actions and decisions leading to the appropriation of SAs’ likenesses for the video games took place in California. That remains to be established, although possibly not the deciding factor in determining class action status. As a final thought, it would assist if class representatives were California residents and had participated in intercollegiate athletics for a California-based school. See also the criticism for forum selection in *Adderley*, Order granting class certification, *supra* note 198, at 8.

211. See *INTA*, *supra* note 95.

212. See *Phillips Petroleum Co. v. Shutts*, 472 U.S. 797, 821–22 (1985).

213. Hence, it is somewhat puzzling that in the first *Keller* complaint there was no mention of a false endorsement claim under Federal Lanham Act § 43(a).

214. 15 U.S.C. §§ 1114–27, at 1125.

215. 978 F.2d 1093, 1106–07 (9th Cir. 1992).

216. 849 F.2d 460 (9th Cir. 1988).

217. Considering the aforementioned jurisprudence, especially the Ninth Circuit’s positions subsequent to *White v. Samsung*.

218. See *INTA*, *supra* note 132 (adverse inference on absence of consumer confusion surveys).

219. See WALLACE D. LOH, *SOCIAL RESEARCH IN THE JUDICIAL PROCESS* 409–12 (Russell Sage Foundation, 1984).

220. 721 F.2d 460 (3d Cir. 1983).

221. 599 F.2d 341 (9th Cir. 1979). The eight-factor test in *AMF* has governed *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001), and is useful to consider in view of *Keller*; the eight factors the court considers in respect to potential confusion are

- (1) strength of the plaintiff’s mark;
- (2) relatedness of the goods;
- (3) similarity of the marks;
- (4) evidence of actual confusion;
- (5) marketing channels used;
- (6) likely degree of purchaser care;
- (7) defendant’s intent in selecting the mark;
- (8) likelihood of expansion of the product lines.

222. *Facenda Jr. v. NFL Films, Inc., et al.*, 542 F.3d 1007, 1015 (3d Cir. 2008).

223. 875 F.2d 994 (2d Cir. 1989).

224. 332 F.3d 915 (6th Cir. 2003).

225. *Brewer v. Hustler Magazine, Inc.*, 749 F.2d 527 (9th Cir. 1984).

226. See, i.e., *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134 (9th Cir. 2006) (the Ninth Circuit agreed

with the district court's conclusion that Laws' right of publicity claims were preempted by the Copyright Act).

227. FED. R. CIV. P. 12(b)(6) (2009). See *Perfect 10, Inc. v. Visa Int'l Serv. Ass'n*, 494 F.3d 788 (9th Cir. 2007) (Perfect 10 failed to state a claim upon which relief could be granted).

228. For personal jurisdiction to stick, the alleged conduct must have been purposefully directed at California. See *Schwarzenegger v. Fred Martin Motor Co.*, 374 F.3d 797 (9th Cir. 2004) (affirming the district court's dismissal for lack of personal jurisdiction [did not decide on the merits of the case]).

229. 17 U.S.C. § 107 (2009). See *Mattel Inc. v. Walking Mt. Prods.*, 353 F.3d 792 (9th Cir. 2003) (The court found that Forsythe's use of Mattel's trademark and trade dress caused no likelihood of confusion as to Mattel's sponsorship of Forsythe's works. The court dismissed Mattel's trademark dilution claim because it found that Forsythe's use had

been "noncommercial."); *Cairns v. Franklin Mint Co.*, 292 F.3d 1139 (9th Cir. 2002) (finding that Franklin Mint did not use Princess Diana's name and likeness "as a trademark," but used them "fairly and in good faith" and "only to describe its goods" as required by 15 U.S.C. § 1115(b)); *Abdul-Jabbar v. GMC*, 85 F.3d 407 (9th Cir. 1996) (the Ninth Circuit held that there was a question of fact as to whether GMC is entitled to a fair use defense); *Brewer*, 749 F.2d 527 (the Ninth Circuit concluded that there was sufficient evidence from which a jury could have found that *Hustler's* publication of the photograph was not a fair use).

230. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001) (finding that LAM was entitled to the full First Amendment protection accorded noncommercial speech after LAM argued that Hoffman's likeness in the altered *Tootsie* photograph contained an expression of editorial opinion).

231. *Abdul-Jabbar v. GMC*, 85 F.3d 407 (9th Cir. 1996).

232. *Id.*

233. *Id.*

234. *Id.*

235. See also the aforementioned analysis under I.B.3. on SAs' names' use in college sports video games.

236. *Abdul-Jabbar*, 85 F.3d 407. "Had GMC limited itself to the 'trivia' portion of its ad, GMC could likely defend the reference to Lew Alcindor as a nominative fair use. But by using Alcindor's record to make a claim for its car—like the basketball star, the Olds 88 won an 'award' three years in a row, and like the star, the car is a 'champ' and a 'first round pick'—GMC has arguably attempted to 'appropriate the cachet of one product for another,' if not also to 'capitalize on consumer confusion.'" *Id.*

237. *Motschenbacher v. RJ Reynolds*, 498 F.2d 821, 822 (9th Cir. 1974).