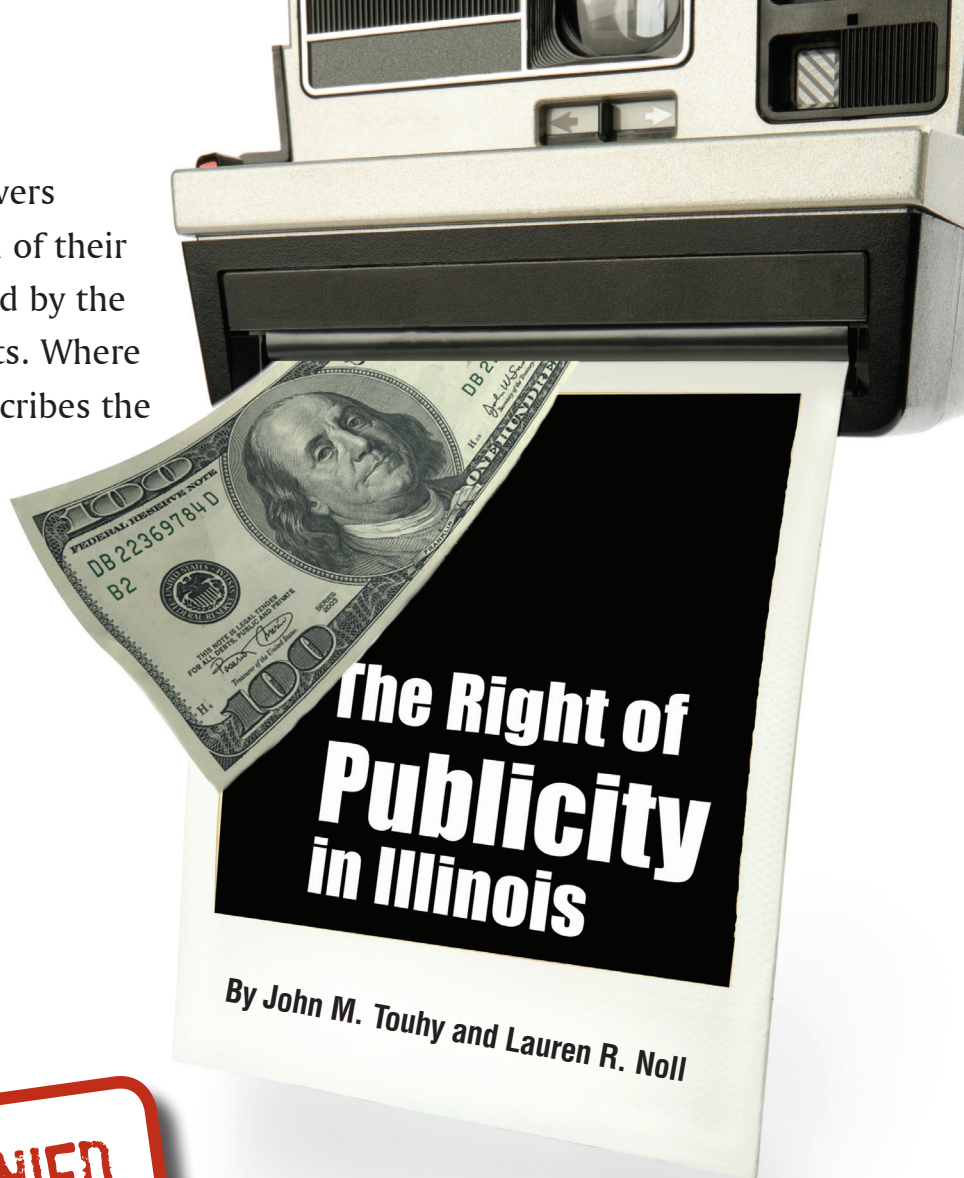


Illinois's right of publicity empowers people to limit the appropriation of their likeness, but that power is limited by the First Amendment – and the courts. Where to draw the line? This article describes the different tests courts around the country have used to balance these competing rights.



PERMISSION DENIED

Presidential candidate John McCain was sued by singer/songwriter Jackson Browne who claimed McCain had violated it.¹ Civil rights icon Rosa Parks successfully stopped a rap group from exploiting her name by relying on it.² The Romantics used it to file suit against the makers of *Guitar Hero*.³ Carol Burnett invoked it to sue the producers of *The Family Guy*.⁴

Despite its use by public figures and celebrities, the right of publicity – which protects the financial benefits that people can reap by lending their names or likeness to commercial endorsements – remains a little-known and even lesser-

understood tort. This is true even though the right also applies to ordinary people who want to protect their likeness from unauthorized use.

Originally one of the four branches

1. *Browne v McCain*, 612 F Supp 2d 1118 (CD Cal 2009).

2. *Parks v LaFace Records*, 329 F3d 437 (6th Cir 2003).

3. *The Romantics v Activision Publishing, Inc*, 532 F Supp 2d 884 (ED Mich 2008).

4. *Burnette v Twentieth Century Fox Film Corp*, 491 F Supp 2d 962 (CD Cal 2007).

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of the common law right to privacy,⁵ the right to publicity was codified in Illinois in 1999.⁶ Since the passage of the Illinois Right of Publicity Act ("Illinois Act"), a few Illinois courts have ruled on right of publicity cases featuring high-profile plaintiffs ranging from legendary singer James Brown to former boxer Jumbo Cummings, as well as people who are not in the public eye at all.⁷ Yet Illinois law is not settled. The question remains: what standard will Illinois courts follow to decide future cases?

The fifth circuit has described the right of publicity this way:

Protecting one's name or likeness from misappropriation...encourages people to develop special skills, which then can be used for commercial advantage....Without the artificial scarcity created by the protection of one's likeness, that likeness would be exploited commercially until the marginal value of its use is zero.⁸

The interest protected is easy enough to understand, but how to guard it is far more difficult. Any restrictions on a person commenting on or using another person's name will run squarely into the First Amendment. Thus, the issue becomes how to balance an individual's ability to limit the unauthorized commercial use of his or her name with the freedom of speech guaranteed by the First Amendment.

The Illinois Right of Publicity Act

The Illinois Act governs all violations of the right of publicity occurring after January 1, 1999, but does not affect an individual's rights as they existed beforehand, nor does it supplant the common law with respect to the other common law right to privacy torts.⁹

The Illinois Act prohibits the use of a person's identity "for commercial purposes...without having obtained previous written consent."¹⁰ "Commercial purpose" is defined as the "public use or holding out of an individual's identity (i) on or in connection with the offering for sale or sale of a product, merchandise, goods, or services; (ii) for purposes of advertising or promoting products, merchandise, goods or services, or (iii) for the purpose of fundraising."¹¹ Under the Illinois Act, the rights of the individual are property rights.

A person who is found to violate the Illinois Act is liable for the greater of either "(1) actual damages, profits derived from the unauthorized use, or both; or (2) \$1000."¹² Additionally, punitive damages

may be awarded for willful violations.¹³ The court also may award the prevailing party attorney's fees and costs.¹⁴

Because of the conflict with the First Amendment inherent in this regulation of expression, the Illinois Act specifically does not apply to

(1) use of an individual's identity in an attempt to portray, describe, or impersonate that individual in a live performance, a single and original work of fine art, play, book, article, musical work, film, radio, television, or other audio, visual, or audio-visual work, provided that the performance, work, play, book, article, or film does not constitute in and of itself a commercial advertisement for a product, merchandise, goods, or services.

* * * *

(4) promotional materials, advertisements, or commercial announcements for a use described under paragraph (1)...of this subsection.¹⁵

Sports broadcasts are also included among the exceptions to the Illinois Act.¹⁶

In many instances, these express exceptions will adequately protect First Amendment rights.¹⁷

In *Collier v Murphy*, for example, the plaintiff alleged that the comedian Eddie Murphy had appropriated his likeness for use in the cartoon "The PJs" because both he and the character "Sanchez" lived in the "projects," used a voice box to speak, and shared a "similar head-neck placement."¹⁸ Even accepting the allegations as true, the court held that defendant's use of the plaintiff's identity – as part of a television production – fell within the express statutory exceptions in the Illinois Act quoted above.¹⁹ The court held that it did not need to balance defendant's First Amendment rights with plaintiff's right to publicity as the statute barred the cause of action on its face.²⁰

However, in circumstances where an expressive work does not fall within a specific statutory exception, courts will be required to balance an individual's right of publicity with the First Amendment. To date, no Illinois court has expressly done so.²¹ What, then, will be the course that Illinois courts will take?

The following section examines the different tests that courts nationwide have employed to balance these competing interests.

Courts' attempts to balance the right of publicity and the First Amendment

The relatedness test. In 2007, a federal district court applying Illinois law addressed the relationship of the right to publicity and the First Amendment. That court applied what has become known as the relatedness test (the court did not refer to the test as the relatedness test or otherwise signal that it was choosing a specific test, but it is apparent from its analysis that it used that test).²² Taken from section 47 of the Restatement

The issue in a right-of-publicity case is how to balance an individual's ability to limit the unauthorized commercial use of his or her name with the freedom of speech guaranteed by the First Amendment.

5. The other three branches are intrusion upon seclusion, publicity given to private life, and placing a person in a false light. Restatement (Second) of Torts §§ 652B, 652C, 652D, 652E, at 378-94 (1977).

6. 765 ILCS 1075/1 et seq.

7. See *Brown v AMCI Pop Div*, 375 Ill App 3d 276, 873 NE2d 954 (1st D 2007); *Cummings v ESPN Classics, Inc*, 2009 WL 650559 (SD Ill 2009); *Christianson v Henry Holt & Co, LLC*, 2007 WL 2680822 (CD Ill).

8. *Matthews v Wozencraft*, 15 F3d 432, 437-38 (5th Cir 1994).

9. 765 ILCS 1075/60.

10. Id at 1075/30(a).

11. Id at 1075/5.

12. 765 ILCS 1075/40(a)(1), (a)(2).

13. Id at 1075/40(b).

14. Id at 1075/55.

15. Id at 1075/35(b).

16. See *Cummings*, 2009 WL 650559 (SD Ill 2009) (dismissing the suit of Boxer Floyd "Jumbo" Cummings against ESPN for airing his 1981 fight against Joe Frazier).

17. See, for example, *Collier v Murphy*, 2003 WL 1606637, at *2 (ND Ill 2003).

18. Id at *1.

19. Id at *2-3.

20. Id at *3.

21. See, for example, *Muzikowski v Paramount Pictures Corp*, 2003 WL 22872117, *6 (ND Ill 2003) (stating that to properly address the defendant's contention that the First Amendment bars the plaintiff's claim would require the court to "balance public interest in the free flow of ideas and creativity against [the plaintiff's] ability to control marketing of his claimed celebrity value. The time for such an inquiry has not yet come in this case."):

22. *Christianson v Henry Holt & Co, LLC*, 2007 WL 2680822 (CD Ill).

(Third) of Unfair Competition, the test permits the use of a public person's identity in a work that is "related to that person." Protected, "related" uses include

the use of a person's name or likeness in news reporting, whether in newspapers, magazines, or broadcast news...use in entertainment and other creative works, including both fiction and nonfiction....[t]he use...as part of an article published in a fan magazine or in a feature story broadcast on an entertainment program...dissemination of an unauthorized print or broadcast biography, [and use] of another's identity in a novel, play, or motion picture....²³

If, however, the "name or likeness is used solely to attract attention to a work

the relatedness test in the seminal case of *Parks v LaFace Records*,³⁰ brought by civil rights icon Rosa Parks. Parks sued the rap band "Outkast" over the use of her name as the title of the song "Rosa Parks." The lyrics do not mention Parks but contain a reference to "everybody move to the back of the bus."³¹ The district court initially granted summary judgment for Outkast on the grounds that the use of Parks' name in the song title was protected by the First Amendment.³²

The sixth circuit reversed. Quoting section 47 of the Restatement, that court held that Parks' common law right of publicity claim presented a genuine issue of material fact as to whether the title was "wholly unrelated" to the content of the song.³³ The court pointed out that although the phrase "move to the back of the bus" was repeatedly used in the chorus, when heard in context, it had "absolutely nothing to do with Rosa Parks":

Back of the Bus, for example, would be a title that is obviously relevant to the content of the song, but it also would not

have the marketing power of an icon of the civil rights movement. Choosing Rosa Parks' name as the title to the song unquestionably enhanced the song's potential sale to the consuming public.³⁴

The parties eventually settled the case.³⁵

Not all courts applying the relatedness test have taken as narrow a view of what constitutes the subject matter of the creative work as did the sixth circuit. In *Rogers v Grimaldi*,³⁶ the second circuit employed the relatedness test and concluded that Ginger Rogers, half of the famed dancing duo with Fred Astaire, could not prevent the use of the title "Ginger and Fred" for a fictional movie that only tangentially related to Rogers and Astaire.³⁷ The film told the story of two fictional cabaret dancers who imitated Rogers and Astaire and became known in Italy as "Ginger and Fred."³⁸

The second circuit, applying Oregon's common law right of publicity, held that the title of the movie was not barred by Rogers's right of publicity because the title was "clearly related to the content of the movie" and was not "simply a disguised commercial advertisement for the sale of goods or services."³⁹

California's transformative use test.

Not surprisingly, California courts have formulated their own test. In *Comedy III Productions, Inc v Gary Saderup, Inc*,⁴⁰ the defendant created a charcoal drawing of the Three Stooges and sold lithographs and t-shirts bearing the design.⁴¹ The plaintiff owned the rights to the Three Stooges comedy act and brought suit under California's right of publicity statute.⁴²

Under California Civil Code section 3344.1,

Any person who uses a deceased person'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 prior consent" shall be "liable for any damages sustained by the person or persons injured as a result thereof.

The statute provides a number of exemptions from the consent requirement, including use "in connection with any news, public affairs, or sports broadcast or account, or any political campaign."⁴³ Moreover, consent is not necessarily required solely because the use is "commercially sponsored or contains paid advertising. Rather, it shall be a question of fact whether or not the use...was so directly connected with the commercial sponsorship or with the paid advertising as to constitute a use for which consent is required."⁴⁴

In determining whether the Stooges lithographs and t-shirts violated the statute, the California court borrowed from copyright law and formulated the "transformative use" test.⁴⁵ The test hinges on

23. Restatement (Third) of Unfair Competition sec 47 cmt c.

24. Id.

25. *Christianson*, 2007 WL 2680822 at *3.

26. Id at *13.

27. Id at *3.

28. Id at *13.

29. Id at *12-13.

30. *Parks*, 329 F3d 437 (6th Cir 2003).

31. Id at 441-41.

32. Id at 444.

33. Id at 461.

34. Id at 452, 453.

35. New York Times, *Rap Group Settles Rosa Parks Lawsuit*, available at <http://www.nytimes.com/2005/04/15/business/media/15settle.html> (April 15, 2005).

36. *Rogers*, 875 F2d 994 (2d Cir 1989).

37. Id at 996.

38. Id at 996-97.

39. Id at 1005.

40. *Comedy*, 25 Cal 4th 387, 21 P3d 797 (2001).

41. Id at 393, 21 P3d at 800-01.

42. Id at 393, 21 P3d at 800.

43. Cal Civ Code § 3344.1(j).

44. Id at § 3344.1(k).

45. *Comedy* at 390, 21 P3d at 799.

While a few courts have ruled since the Illinois Right of Publicity Act was passed, the law is not settled. What standard will Illinois follow to decide future cases?

that is not 'related' to the identified person, the user may be subject to liability for a use of the other's identity in advertising."²⁴

The facts facing the court in the Southern District of Illinois seemed to make the application of the test easy. In *Christianson v Henry Holt & Co*, the defendant used the plaintiff's image as the cover for a book on the working poor.²⁵ Noting that the plaintiff was not mentioned in the book, the court found that the use was not protected by the First Amendment, relying on cases from other jurisdictions that involved the use of a plaintiff's likeness on a book or magazine cover.²⁶

As an initial matter, the court noted that "case law reflects a strong First Amendment interest in allowing authors and publishers to use images that reflect the free speech contained in a book."²⁷ However, a person's image must bear a "reasonable relationship" to the subject matter to warrant protection.²⁸ Because defendant's book did not even mention the plaintiff, the court held that the photo bore no reasonable relationship to the book and thus was not a protected use.²⁹

The sixth circuit expressly adopted

whether the new work “merely ‘supercedes the objects’ of the original creation or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.”⁴⁶ If the value of the work “comes principally from some source other than the fame of the celebrity – from the creativity, skill, and reputation of the artist – it may be presumed that sufficient transformative elements are present to warrant First Amendment protection.”⁴⁷

The court focused on whether the work had transformed a person’s likeness or identity and suggested that parody rarely violates the right of publicity. However, the court also noted that transformative elements deserving of First Amendment protection are not “confined to parody and can take many forms,” including factual reporting, fictionalized portrayal, some lampooning, and social criticism.⁴⁸ Yet the court could “discern no significant transformative or creative contribution” in the Three Stooges lithographs and t-shirts and held that the right of publicity trumped First Amendment concerns.⁴⁹

The California Supreme Court also applied the transformative use test in *Winter v DC Comics*, but reached the opposite result.⁵⁰ There, the court considered comic books containing characters that the plaintiffs – well-known rock star brothers Johnny and Edgar Winter – claimed invoked their likenesses.⁵¹ The defendants were accused of selecting the names Johnny and Edgar Autumn to signal to readers that the Winter brothers were being portrayed and then drawing the fictional brothers with features and attire that further evoked the plaintiffs’ image.⁵² The Winter brothers also alleged that the comics falsely portrayed them as “vile, depraved, stupid, cowardly, subhuman individuals who engage in wanton acts of violence, murder and bestiality for pleasure and who should be killed.”⁵³

Applying the transformative use test from *Comedy*, the California Supreme Court found that the comic books were not merely “conventional depictions of plaintiffs,” but, rather, contained “significant expressive content other than plaintiffs’ mere likenesses.” As a result, the court found that the comic books were protected expression.⁵⁴

The court distinguished the Three Stooges case: in *Comedy*, the artist “essentially sold...pictures of the Three

Stooges, not transformed expressive works by the artist;” here “by contrast, defendants essentially sold...DC comics depicting fanciful, creative characters, not pictures of the Winter brothers.”⁵⁵

Actual malice test. A third approach involves the application of the “actual malice” standard originally articulated by the U.S. Supreme Court in *New York Times Co v Sullivan*.⁵⁶ In *Hoffman v Capital Cities/ABC, Inc.*,⁵⁷ Los Angeles Magazine took the image of Dustin Hoffman’s head from the movie “Tootsie” and placed it on the body of a model wearing current fashions, and then identified the maker and price of the current clothes.⁵⁸

Although there were commercial aspects to the image and accompanying article, the ninth circuit determined that the publisher was entitled to the “full First Amendment protection accorded non-commercial speech” because the commercial aspects of the image were “‘inextricably entwined’ with expressive elements, and so they cannot be separated out ‘from the fully protected whole.’”⁵⁹

Borrowing from *Sullivan*, the court applied the actual malice test to the expressive work before it, explaining that a “public figure...can recover damages for noncommercial speech from a media organization...only by proving actual malice,”⁶⁰ defined by the U.S. Supreme Court as “reckless disregard for the truth” or a “high degree of awareness of probable falsity.”⁶¹ Because the publisher had not acted with actual malice in publishing the altered “Tootsie” photograph, Hoffman was not entitled to damages.⁶²

The Missouri “predominant use” test. The Missouri Supreme Court has crafted yet another test, one that looks at the predominant purpose behind the use of another’s identity, thus requiring the court to weigh the “artistic value” of the expressive work’s use against the publisher’s commercial benefit from that use. This test was applied in *Doe v TCI Cablevision*,⁶³ where the defendants created a comic book, *Spawn*, which featured a violent Mafia don named Anthony “Tony Twist” Twistelli.⁶⁴

The plaintiff, Anthony Twist – also known as Tony Twist – was a former professional hockey player. After losing an endorsement deal due to the association of his name with the fictitious Mafia don, Twist brought a right of publicity claim against the creators, publishers,

and marketers of *Spawn*.⁶⁵

The publisher of *Spawn* stated in an interview that he had used the names of real-life people to create the identities of *Spawn*’s characters.⁶⁶ Brief biographies and drawings of the *Spawn* characters were published along with the interview in a trade magazine for the comic book industry, and the Tony Twist character was described in the following manner: “The Mafia don...is named for former Quebec Nordiques hockey player Tony Twist, now a renowned enforcer (i.e. ‘Goon’) for the St. Louis Blues of the National Hockey League.”⁶⁷ Below the character description was a photo of a Tony Twist hockey trading card.⁶⁸

At trial, Twist won a \$24.5 million verdict, but the trial court entered judgment notwithstanding the verdict on the grounds that Twist had failed to establish that the defendants had used his name with intent to gain commercial advantage.⁶⁹

On appeal, the Missouri Supreme Court determined that the defendants’ intent to create the impression that Twist was associated with the *Spawn* comic book was sufficient to establish the commercial advantage element of a right of

46. Id at 404, 21 P3d at 808, citing *Campbell v Acuff-Rose Music, Inc.*, 510 US 569, 579 (1994).

47. *Comedy* at 407, 21 P3d at 810.

48. Id at 406, 21 P3d at 809.

49. Id at 409, 21 P3d at 811.

50. *Winter*, 30 Cal 4th 881, 891, 69 P3d 473, 480 (2003).

51. This statute, unlike the one at issue in *Comedy*, did not require that the person asserting the right of publicity be deceased.

52. *Winter* at 886, 69 P3d at 476.

53. Id.

54. Id at 890, 69 P3d at 479.

55. Id at 892, 69 P3d at 480.

56. *New York Times*, 376 US 254 (1964).

57. *Hoffman*, 255 F3d 1180 (9th Cir 2001).

58. Id at 1183.

59. Id at 1185 (internal citation omitted).

60. Id at 1186.

61. *Harte-Hanks Communications, Inc v Connaughton*, 491 US 657, 667 (1989).

62. *Hoffman*, 255 F3d at 1189. There is some question as to whether the actual malice test is valid in this context. In *Zacchini v Scripps-Howard Broadcasting Co.*, 433 US 562 (1977), the Supreme Court held that the “actual malice” standard does not apply to the tort of appropriation of a right of publicity. Yet the *Hoffman* court applied the test to a right of publicity claim, as have other courts since the *Zacchini* decision. For example, *Solano v Playgirl, Inc.*, 292 F3d 1078 (9th Cir 2002).

63. *Doe*, 110 SW3d 363 (Mo 2003).

64. Id at 363.

65. Id at 367.

66. Id at 366.

67. Id at 367.

68. Id.

69. Id at 369.

publicity action.⁷⁰ The court then turned to an analysis of whether Twist's common law right of publicity claim was prohibited by the First Amendment.

Taking issue with both the relatedness test and the transformative test, the court adopted what it described as a "predominant use" test it felt better addressed those cases where speech is both expressive and commercial:

If a product is being sold that predominantly exploits the commercial value of an individual's identity, that product should be held to violate the right of publicity and not be protected by the First Amendment, even if there is some "expressive" content in it that might qualify as "speech" in other circumstances. If, on the other hand, the predominant purpose of the product is to make an expressive comment on or about a celebrity, the expressive values could be given greater weight.⁷¹

Because the defendants had agreed that the use was not a parody, expressive comment, or fictionalized account of the real Twist, the "metaphorical reference to Twist...[had] very little literary value

compared to its commercial value."⁷² As the use of Twist's name was predominantly a ploy to sell comic books rather than an artistic or literary expression, "free speech must give way to the right of publicity."⁷³

Accordingly, the court reversed the trial court's judgment for defendants and remanded for a new trial.⁷⁴ Twist ultimately prevailed at the second trial and was awarded \$15 million in damages, which was affirmed on appeal.⁷⁵

What's next?

Although it appears that the district court in *Christianson* applied the relatedness test to balance the right of publicity and the First Amendment, the court did not specifically say it was doing so. Because no other Illinois-based courts have to date selected a standard to apply to cases brought under the Illinois Act, it is uncertain what test will be employed. Even if Illinois courts do use the relatedness test, there is no guarantee that they will take the same narrow view as did

the court in *Christianson*.

Illinois lawyers, in prosecuting or defending a right of publicity action, must recognize the issues raised by the Illinois Act and be ready to navigate the wide variety of approaches that courts have taken to reconcile the clash between the First Amendment and the right to publicity. More and more, plaintiffs are using the potentially powerful Illinois Act. By being aware of the different approaches taken by courts to ensure that both First Amendment and publicity rights are considered, lawyers will be better able to protect their clients from liability or protect their clients' valuable names. ■

70. Id at 371.

71. Id at 374, citing Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 Loy LA Ent L Rev 471, 500 (2003).

72. TCI, 110 SW3d at 374.

73. Id.

74. Id at 376.

75. *Doe v McFarlane*, 207 SW3d 52, 56 (Mo App 2006).

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