

HOFFMAN V. CAPITAL CITIES/ABC, INC.

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Fame is valued. Consumers want to feel close to and identify with celebrities.¹ As a result, businesses pay high fees to acquire celebrity endorsements.² Because of the value attached to their fame, celebrities often sue to enjoin unauthorized and commercial uses of their names and likenesses.³ They do so by exercising their rights of publicity, rights the law grants to every individual to protect the commercial value in his or her identity.

To celebrities' delight, the Ninth Circuit has consistently granted famous plaintiffs expansive publicity rights.⁴ These rights empower individuals to control whether and how others can use information about public figures, and thereby trigger First Amendment concerns.⁵ But Ninth Circuit jurisprudence has yet to directly clash with the First Amendment. That is because the court's publicity cases have dealt mostly with appropriations of identity that function solely as a means of commercial exploitation—appropriations that implicate minimal First Amendment interests.⁶ Not all appropriations are this one-dimensional; many seek to simultaneously exploit identities and communicate information. How should a court deal with an appropriation that consists of both commercial and communicative elements?⁷

The Ninth Circuit recently faced this question in a case brought by actor Dustin Hoffman against Los Angeles Magazine, after the magazine

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1. John Gibeaut, *Image CONSCIOUS*, 85 A.B.A. J. 47 (1999).

2. Eleanor Johnson, *Henley v. Dillard Department Stores: Don Loves His Henley, And Has a Right to It Too*, 45 VILL. L. REV. 169 (2000).

3. *See id.*

4. Erika Paulsruide, *Not the Last Dance: Astaire v. Best Film & Video Corp. Proves California Right of Publicity Statutes and the First Amendment Can Co-Exist*, 18 LOY. L.A. ENT. L.J. 395, 397 (1998).

5. Alicia M. Hunt, *Everyone Wants to be a Star: Extensive Publicity Rights for Noncelebrities Unduly Restrict Commercial Speech*, 95 NW. U. L. REV. 1605, 1616 (2001).

6. *See White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (1992) (advertisements for electronic product); *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407 (1996) (television commercials for automobiles); *Midler v. Ford Motor Co.*, 849 F.2d 460 (1988) (television commercials for automobiles).

7. Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47(1994).

used Hoffman's likeness in an article.⁸ In its decision, the court ruled against Hoffman on First Amendment grounds.⁹ The core of the Ninth Circuit's holding was its characterization of the magazine's appropriation of identity as "communicative" rather than "commercial."¹⁰ This characterization is crucial because "communicative speech" receives maximum First Amendment protection, while "commercial speech" receives only minimum protection.¹¹ Thus, the validity of a First Amendment defense to publicity rights depends on whether an appropriation of identity is categorized as communicative or commercial. Unfortunately, courts have not clearly delineated the line between these two categories.¹²

A line-drawing device does exist in the often-used "primary message"—or "primary nature of the use"—test.¹³ This test weighs the commercial and communicative elements of speech to determine its primary or predominant message.¹⁴ It takes a case-by-case and fact-specific approach, giving judges moderate guidance and considerable discretion. Instead of drawing a clear line, the test aims for a careful balancing of relevant interests.

The *Hoffman* court followed the general contours of the primary message approach. But its terse opinion also suggested (or alluded to) concepts not explicitly associated with the primary message test: the inextricably entwined doctrine and a focus on the medium in which identities are appropriated. It is unclear whether the court intended to incorporate these new concepts into the line-drawing process. Regardless of that fact, this Note will consider whether these concepts may in fact serve as useful additions—guidelines or parameters—to the primary message test.

This Note will take the form of a comparative analysis. Instead of selecting the best line-drawing method, it aims to show the strengths and weaknesses of various concepts and approaches. Furthermore, it seeks to highlight the fundamental problems afflicting attempts to resolve the inherent conflict between free speech and publicity rights.

The discussion is divided into three parts. First, the primary message test is evaluated to see if it does need additional guidelines or parameters.

8. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (2001).

9. *Id.* at 1189.

10. *See id.* at 1184-86.

11. *See* J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* 7-3, 8-16, 8-17 (2d ed. 2001).

12. *Hoffman*, 255 F.3d at 1184.

13. MCCARTHY, *supra* note 11, at 8-149, 8-150.

14. *Id.*

The discussion then turns to the strengths and weaknesses of the two concepts raised by the *Hoffman* opinion. Lastly, the discussion concludes with a brief analysis of the proposal to import an element of the fair use doctrine into the right of publicity regime. In conclusion, this Note will suggest that none of these concepts or approaches can alone solve the problem at issue. Rather than prematurely devising a definitive test or drawing a bright line, courts should apply a combination of factors in each case to accommodate the relevant interests at issue.

I. BACKGROUND

A. Right of Publicity

1. Historical Development

The right of publicity is the inherent right of every human being to control the commercial use of her or his identity.¹⁵ This right developed within privacy law,¹⁶ a field that initially revolved around the right to prevent intrusive and embarrassing disclosures by the press.¹⁷ A considerably different variation on this theme soon developed in the *Roberson* and *Pavesich* cases.¹⁸ This variation concerned lawsuits challenging unauthorized uses of a person's name or likeness for advertising or trade purposes.¹⁹

At first, only unknown people complained in courts about uses of their identities in advertising.²⁰ Thus, courts focused on traditional privacy concepts of personal injury to dignity and state of mind, measured by mental distress damages.²¹ But then "famous plaintiffs" began to sue too.²² They did not want to forbid the commercialization of their identities; they just wanted the right to control their use.²³ But judges could not see how public figures could suffer mental distress when their identities were already in

15. *Id.* at 1-2.

16. *Id.* at 1-9.

17. *Id.* at 1-11.

18. *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442 (N.Y. 1902); *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905).

19. *Id.*

20. MCCARTHY, *supra* note 11, at 1-7.

21. *Id.*

22. *Id.*

23. *Id.*

widespread use in the media.²⁴ Thus, the claims of public figures were rejected.²⁵

But one maverick judge soon realized that the right at issue in these new cases was commercial in nature and could not be confined by traditional privacy law. Breaking the "privacy" mold of thinking, Judge Jerome Frank coined the term "right of publicity" in the *Haelan* decision.²⁶ He used the term to denote a property right in a person's identity, which is a purely commercial interest, as distinct from a "mental distress" interest.²⁷ Such a property right can be infringed by the use of a person's identity, without permission, in a commercial context. Building on the foundation set by Judge Frank, scholars like William Prosser and Melville Nimmer further refined the right and developed policy rationales for its existence.²⁸

Today, the right of publicity has been recognized at common law or by statute in half of the states.²⁹ It is an intellectual property right under state law, the infringement of which is the commercial tort of unfair competition.³⁰ California courts have recognized a common law right of publicity for living persons.³¹ Moreover, California Civil Code section 3344 provides a statutory right separate and distinct from the common law right.³² Because section 3344 only covered living persons, section 990 (renumbered as 3344.1 in 1999) was later enacted to recognize a postmortem right of publicity.³³

2. Policy Justifications

Three policy considerations stand behind the right of publicity given to celebrities. First, the right "vindicates the economic interests of celebrities, enabling those whose achievements have imbued their identities with pecuniary value to profit from their fame."³⁴ Second, the right provides financial incentives for individuals to expend time and resources to produce

24. *Id.* at 1-38.

25. *Id.*

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

27. MCCARTHY, *supra* note 11, at 1-41.

28. *Id.* at 1-25, 1-47.

29. *Id.* at 6-5.

30. *Id.* at 1-2.

31. *See* *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 820 (1979).

32. CAL. CIV. CODE § 3344 (1971).

33. *Id.* at § 3344.1 (1999) (originally enacted as Civ. Code § 990 (1984)).

34. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 838 (6th Cir. 1983).

intellectual and creative works.³⁵ Third, the right prevents unjust enrichment and deceptive trade practices.³⁶

B. The First Amendment

As vital as these policies are, they may conflict with societal interests in free speech.³⁷ Thus, the First Amendment is a defense against a right of publicity claim.

1. *Hierarchy of First Amendment Protection*

As an initial matter, it is important to understand that the First Amendment does not fully protect all speech. Courts give different types of “speech” different levels of protection.³⁸ A major distinction is made between “commercial” and “communicative” speech.

a) Commercial Speech

“Commercial speech” has been narrowly defined as speech that “does ‘no more than propose a commercial transaction.’”³⁹ Courts have consistently placed commercial speech at the bottom of the First Amendment hierarchy. It is entitled to little constitutional protection.⁴⁰ In fact, the First Amendment usually does not shield pure commercial speech from liability for an infringement of publicity rights.⁴¹

b) Communicative Speech

On the other hand, “communicative” speech—speech dealing with matters in the public interest, like news and fiction—receives full First Amendment protection.⁴² Courts have consistently stated that “[p]ublication of matters in the public interest . . . cannot . . . be actionable.”⁴³ Despite its special status, “communicative” speech encompasses a broad range of expressions. The Supreme Court has broadly defined the scope of “matters in the public interest” to include “expression about phi-

35. *Id.*

36. *Id.*

37. *Id.* at 839.

38. MCCARTHY, *supra* note 11, at 8-16.

39. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) (quoting *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations*, 413 U.S. 376, 385 (1973)).

40. MCCARTHY, *supra* note 11, at 7-3.

41. *See id.* at 7-10.1, 7-38 (impermissible use of identity in advertisement and on merchandise, forms the core acts that trigger liability).

42. *See id.* at 8-16.

43. *Eastwood v. Superior Court*, 149 Cal. App. 3d 409, 421 (1984).

losophical, social, artistic, economic, literary, or ethical matters.”⁴⁴ A New York Court has stretched the scope even further to include “articles of interest to consumer groups and fashion.”⁴⁵

2. *Inherent Conflict Between the First Amendment and Publicity Rights*

In protecting communicative speech, the First Amendment serves two vital goals. First, “to preserve an uninhibited marketplace of ideas and repel efforts to limit . . . debate on public issues.”⁴⁶ Second, “to foster fundamental respect for individual development and self-realization.”⁴⁷ The right of publicity may frustrate these goals because it authorizes individuals “to control whether and how information about [them] can be used by other people.”⁴⁸ More specifically, it may inhibit public debate and censor creative expressions.⁴⁹ Because celebrities take on public meaning, some uses of their names or likenesses may serve vital functions in debates on public issues.⁵⁰ On the other hand, celebrities also take on personal meaning for individuals and the creative appropriation of their images can be an important avenue of individual expression.⁵¹

3. *“Mixed Speech”—Exacerbating the Conflict*

The potential for a direct conflict between First Amendment and publicity rights is heightened by the existence of “mixed speech.” As previously explained, the categorization of a speech as either commercial or communicative determines the fate of a First Amendment defense. But not all speech is easily categorized. Some speech is “mixed”—embodying both commercial and communicative elements. Thus, the method used to categorize mixed speech stands squarely in the middle of the conflict between the two opposing rights; an inadequate method will hasten a direct clash, while a satisfactory method will resolve the conflict.

44. *Abood v. Detroit Bd. of Educ.*, 431 U.S. 209, 231 (1977).

45. *Welch v. Group W. Prods, Inc.*, 525 N.Y.S.2d 466, 468 (1987).

46. *Comedy III Prods., Inc. v. Saderup, Inc.*, 25 Cal. 4th 387, 397 (2001) (quoting *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal. 3d 860, 866 (1979)).

47. *Id.*

48. *Hunt*, *supra* note 5, at 1616.

49. *See id.*

50. Michael I. Rudell, *Reconciling Right of Publicity with the First Amendment*, N.Y. L.J., June 22, 2001, at 3.

51. *Id.*

4. *Fundamental Problems in Resolving the Conflict*

Two major problems afflict attempts to resolve the conflict between First Amendment and publicity rights. The first problem has long affected other legal areas: should courts engage in a case-by-case inquiry or draw a clear and predictable line? The former sacrifices predictability for accuracy, while the latter sacrifices flexibility for consistency. If courts decide to draw a line, a second problem arises: how does one avoid drawing an arbitrary line? As the following discussion will show, a myriad of nearly irreconcilable interests are at stake in these problems. None of the concepts or approaches to be discussed below can alone address all of them. The *Hoffman* opinion by no means resolves these problems, but it does illuminate the vital issues and suggest possible solutions.

II. CASE SUMMARY

A. Facts

Plaintiff, Dustin Hoffman (“Hoffman”), is a famous actor.⁵² Defendant, ABC, Inc., owns Defendant, Los Angeles Magazine, Inc.⁵³ In March 1997, Los Angeles Magazine (“LAM”) published an article entitled “Grand Illusions,” which used computer technology to merge photographs of actors and actresses from classic films with photographs of body models wearing Spring 1997 fashions.⁵⁴ The article also referenced a “shopping guide” that provided price and store information for the clothing used in the photographs.⁵⁵

The final photograph in the article was an altered still from the movie “Tootsie,” which starred Hoffman.⁵⁶ The original still showed Hoffman wearing a red evening dress and posing in front of an American flag.⁵⁷ Only Hoffman’s head and the American flag remained in the new photograph published by LAM.⁵⁸ A model’s body wearing a gown designed by Richard Tyler and shoes designed by Ralph Lauren replaced Hoffman’s body and his red evening dress.⁵⁹

52. *Hoffman v. Capital Cities/ABC, Inc.*, 33 F. Supp. 2d 867, 869 (1999).

53. *Id.* at 870.

54. *Id.*

55. *Id.*

56. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1183 (2001).

57. *Id.*

58. *Id.*

59. *Id.*

LAM did not seek Hoffman's permission to publish the altered photograph.⁶⁰ Consequently, Hoffman filed a complaint in California State Court against LAM's parent company, ABC. The complaint alleged that LAM's publication of the altered photograph misappropriated Hoffman's identity in violation of: (1) the California common law and statutory right of publicity; (2) the California unfair competition statute, Business and Professions Code § 17200; and (3) the federal Lanham Act, 15 U.S.C. § 1125(a).⁶¹ Subsequently, ABC removed the case to federal court and Hoffman added LAM as a defendant.⁶²

B. The District Court Decision

The district court found for Hoffman on all of his claims.⁶³ Only the court's rejection of LAM's First Amendment defense is relevant to our discussion. The court held that LAM's use of Hoffman's identity was commercial speech and therefore was not protected under the First Amendment.⁶⁴ In the court's view, no significant editorial message or purpose existed in LAM's use of Hoffman's identity.⁶⁵ Moreover, it found that the use of Hoffman's identity was not reasonably related to whatever editorial message LAM claimed the article at issue contained.⁶⁶

C. The Ninth Circuit Decision

The Ninth Circuit reversed the district court's decision. Refusing to characterize LAM's use of Hoffman's identity as "commercial speech," the court granted LAM full First Amendment protection.⁶⁷ It found that LAM did not use Hoffman's image in a traditional advertisement printed merely for the purpose of selling a product.⁶⁸ In fact, the court saw the article as a combination of fashion photography, humor, and visual and verbal editorial comment on classic films and famous actors.⁶⁹ Discounting the commercial elements presented by the designer apparel and the "shopper's guide," the court stated that "any commercial aspects are 'inextricably entwined' with expressive elements, and so they cannot be separated

60. *Id.*

61. *Id.*

62. *Id.*

63. *Id.*

64. *Id.* at 1184.

65. *Id.*

66. *Hoffman v. Capital Cities/ABC, Inc.*, 33 F. Supp. 2d 867, 874-75 (1999).

67. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1186-89 (2001).

68. *Id.* at 1185.

69. *Id.*

out ‘from the fully protected whole.’”⁷⁰ Absent commercial speech, Hoffman had to prove actual malice on the part of LAM to prevail. The Ninth Circuit thwarted his effort on this front and ultimately rejected all of his claims.⁷¹

III. DISCUSSION

The Ninth Circuit refused to categorize LAM’s use of Hoffman’s identity as commercial. Although it followed the general contours of the primary message test, the court’s opinion suggests two concepts that may serve as additional guidelines in applying the test. This discussion will analyze the strengths and weaknesses of the primary message test and the concepts suggested by the Ninth Circuit opinion. Also, it will examine another line-drawing approach—the “transformative” test, imported from copyright’s fair use doctrine.

A. The “Primary Message” Test

The primary message test determines whether the “primary” or “predominant” message of speech is commercial or communicative.⁷² The *Hoffman* opinion referred to the test when it asserted that LAM’s article did not “simply advance a commercial message” or when it inquired into LAM’s purpose for using Hoffman’s identity.⁷³ The test measures and compares the weight of the free speech interest and the publicity right interest raised by each particular case. Two methods are used to accomplish this task.

1. Method I - Primary Impact

This method determines whether the “primary” or “predominant” impact of speech is commercial or communicative.⁷⁴ Two key publicity rights cases—*White v. Samsung Elecs. Am., Inc.*⁷⁵ and *Cardtoons, L.C. v. Major League Baseball*⁷⁶—nicely illustrate this method.

70. *Id.* (quoting *Gaudiya Vaishnava Soc’y v. City & County of San Francisco*, 952 F.2d 1059, 1064 (9th Cir. 1991)).

71. *Id.* at 1188 (concluding that LAM did not intend to suggest to the ordinary reader that he or she was seeing Hoffman’s body in the altered “Tootsie” photograph).

72. MCCARTHY, *supra* note 11, at 8-149, 8-150.

73. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (2001).

74. MCCARTHY, *supra* note 11, at 8-149, 8-150.

75. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992).

76. *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir. 1996).

White involved a dispute over a Samsung VCR advertisement, which depicted “a robot, dressed in a wig, gown, and jewelry . . . consciously selected to resemble [Vanna White].”⁷⁷ The advertisement was part of a series that expressed a common theme.⁷⁸ Each part of the series “depicted a current item from popular culture and a Samsung electronic product;” each was “set in the twenty-first century and conveyed the message that the Samsung product would still be in use by that time.”⁷⁹ By “hypothesizing outrageous future outcomes for the cultural items, the ads created humorous effects.”⁸⁰

The Ninth Circuit rejected Samsung’s First Amendment defense—Samsung claimed its use of White’s identity was a parody.⁸¹ The court determined that the advertisement’s primary impact was commercial: “The ad’s spoof of Vanna White . . . is subservient . . . to the ad’s [commercial] message: ‘buy Samsung VCRs.’”⁸² In other words, the commercial message so completely dominated its communicative counterpart as to render that counterpart irrelevant.

In contrast, the Tenth Circuit in *Cardtoons* upheld a defendant’s First Amendment defense for baseball cards that parodied prominent athletes.⁸³ The cards featured caricatures of baseball players on the front and humorous commentaries about their careers on the back.⁸⁴ Despite their unique content, they were produced and formatted just like normal trading cards.⁸⁵ In its decision, the court found the primary impact in the cards to be the parody and not their commercial message.⁸⁶ In other words, the communicative elements in the cards outweighed the commercial elements to render this consumer product noncommercial.

2. *Method 2—Primary Purpose/Reasonable Relationship*

This method singles out the “primary” or “predominant” purpose for an appropriation of identity. A First Amendment defense against publicity

77. *White*, 971 F.2d at 1396. Vanna White is the hostess of “Wheel of Fortune,” a popular television game show.

78. *Id.*

79. *Id.*

80. *Id.* One advertisement “lamponed current popular notions of an unhealthy diet by depicting a raw steak with the caption: ‘Revealed to be health food. 2010 A.D.’” *Id.*

81. *Id.* at 1401.

82. *Id.*

83. *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir. 1996).

84. *Id.* at 962.

85. *Id.* at 963.

86. *Id.* at 968-970.

rights requires a reasonable relationship between the appropriated identity and the communicative expression it serves.⁸⁷ A defendant loses the defense if it uses an identity as a mere vehicle to attract attention to its communicative expression.⁸⁸ The *Hoffman* opinion used this method when it inquired into LAM's purpose for using Hoffman's identity and cited several pertinent facts: LAM did not receive any consideration from the designers featured in the article and Hoffman's identity indeed served viable editorial—as opposed to commercial—purposes.⁸⁹ The court concluded that unlike defendants previously found liable, LAM did not use a celebrity's identity *entirely and directly* for the purpose of selling a product.⁹⁰

This method was also used in two other noteworthy cases. In *Duncan v. New York Magazine Co.*, the court validated a First Amendment defense after finding a close relationship between a photograph of plaintiff taken at the St. Patrick's Day Parade and an article that "referred to the . . . festivities and included comments about the parade."⁹¹ In contrast, the court in *Grant v. Esquire, Inc.*, deemed a use of identity to be commercial and unprotectable.⁹² In the absence of his permission, Esquire magazine featured actor Cary Grant's photograph with his body digitally replaced by that of a model wearing current fashions.⁹³ Store and price information were printed below the picture in a caption.⁹⁴ In contrast to the facts in *Hoffman*, Grant's picture was not part of an article or of an issue of a magazine devoted to him or anything reasonably related to him.⁹⁵ His picture surfaced in the middle of the magazine for no apparent reason and outside of a communicative context—just like an advertisement. Thus, the court concluded that "Mr. Grant's face serve[d] no [purpose] but to attract attention" to the magazine.⁹⁶

3. *Arguments Against the Test*

The test's main weakness resides in its case-by-case and fact-specific nature. This open-ended approach gives judges great discretion in measur-

87. See *Delan v. CBS, Inc.*, 458 N.Y.S.2d 608, 613 (1983) ("[T]here must have existed a legitimate connection between the use of plaintiff's name and picture and the matter of public interest sought to be portrayed.").

88. MCCARTHY, *supra* note 11, at 8-83.

89. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (2001).

90. *Id.*

91. *Murray v. New York Magazine Co.*, 27 N.Y.2d 406, 409 (1971).

92. *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 883-86 (1973).

93. *Id.* at 877.

94. *Id.* at 878.

95. *See id.*

96. *Id.*

ing and weighing the relative importance of the interests at issue; thus, judges have wide leeway in determining the contents of speech. Such measurements and comparisons may be difficult to perform; subjectivity may intrude and mistakes may result. Consequently, the test may overprotect or underprotect First Amendment interests under different circumstances.

Moreover, the test lacks explicit guidelines and parameters. Thus, it may produce inconsistent and unpredictable results. Although judges have much experience in performing balancing tests, the mere potential for inconsistency can be a problem. The Constitution frowns upon inconsistency when First Amendment rights are involved.⁹⁷ The void-for-vagueness doctrine requires rules affecting free speech to be predictable.⁹⁸ Unpredictable rules may “inhibit the exercise of [First Amendment] freedoms” by making speakers “steer far wider of the unlawful zone’ . . . than if the boundaries of the forbidden areas were clearly marked.”⁹⁹ A case-by-case inquiry may not be capable of clearly marking the boundary between commercial and communicative speech. This possibility bodes ill for people who create “mixed” works that are simultaneously communicative and commercial. Without knowing whether their speech will be protected, these “speakers” may refrain from fully exercising their First Amendment rights.

4. *Arguments for the Test*

The strengths of the test also reside in its case-by-case and fact-specific nature. Each application of the test carefully weighs the free speech and publicity right interests at issue. The test refrains from drawing arbitrary lines. Instead, it looks beyond the surface of a speech into the relative importance of the specific interests at issue. Nothing is presumptively commercial or communicative under the test. Consumer products and even advertisements may theoretically be protected if they convey a primarily communicative message; on the other hand, seemingly communicative speech may lose protection under certain circumstances. The test actively seeks out free speech interests and protects them when they exist. As a result, the test faithfully follows the literal and narrow definition of

97. RONALD D. ROTUNDA, TREATISE ON CONSTITUTIONAL LAW—SUBSTANCE & PROCEDURE §20.9 (3d ed. 1999).

98. *Id.*

99. *Id.* at 109 (quoting *Cramp v. Bd. of Pub. Instruction*, 368 U.S. 278, 287 (1961), and *Bagget v. Bullitt*, 377 U.S. 360, 372 (1964) (quoting *Speiser v. Randall*, 357 U.S. 513, 526 (1958)). See also Stephen R. Barnett, *First Amendment Limits on the Right of Publicity*, 30 TORT & INS. L.J. 635, 645 (1995).

commercial speech: speech that “does no more than propose a commercial transaction.”¹⁰⁰ Arguably, such a flexible approach better protects free speech than any method that draws a bright line.

Furthermore, the test’s refusal to draw a bright line doesn’t automatically translate into inconsistent and unpredictable results. In fact, courts applying the test have uniformly found liability in speech that directly proposes commercial transactions, while consistently excluding other speech from the reach of publicity rights. Instead of drawing lines, the test provides speakers with a spectrum for guidance. Speakers can usually be assured of First Amendment protection as long as they do not veer too close to the commercial end of the spectrum.

B. Concepts Suggested by the Hoffman Opinion—Useful Additions for the Test?

1. Concept I: The Inextricably Entwined Doctrine

a) The Doctrine

The Ninth Circuit drew on Supreme Court’s “inextricably entwined” doctrine in categorizing LAM’s speech. The Supreme Court devised the doctrine to deal with “mixed” speech whose commercial and communicative elements are intertwined and inseparable. The Court always treats such mixture as noncommercial, because “[it] cannot parcel out the speech, applying one test to one phrase and another test to another phrase”¹⁰¹ In other words, the Court will exercise judicial restraint and resolve uncertainties in favor of the First Amendment.

b) Arguments For and Against the Doctrine

This doctrine may effectively limit the judicial discretion granted by the primary message test and make the test more predictable. The doctrine forbids courts from arbitrarily singling out a primary message from a true mixture of commercial and communicative elements; it forces them to categorize such mixture as communicative.

But “inextricably entwined” can be an amorphous term. The doctrine may encourage abuses of discretion and produce unpredictability if it is applied without an explicit limit. Different judges may disagree about the

100. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) (quoting *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations*, 413 U.S. 376, 385 (1973)).

101. *Riley v. Nat’l Fed’n of the Blind, Inc.*, 487 U.S. 781, 796 (1988). *See also* *Board of Trs. v. Fox*, 492 U.S. 469 (1989); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1401 n.3 (9th Cir. 1992).

degree to which elements are “entwined.” The solution may be to grant “inextricably entwined” status to a speech as long as its communicative and commercial elements have some tenuous relationship; consequently, the doctrine will be inapplicable only in extreme situations. Courts seem to follow this formulation of the doctrine, since they have consistently held that the doctrine does not apply where the noncommercial element is simply tacked onto commercial speech that only proposes a commercial transaction—namely, when no reasonable relationship exists between the two components.¹⁰²

Note that this formulation of the doctrine renders most mixed speech protectable as long as their commercial elements are tangentially connected to communicative counterparts—even when the speech takes the form of an advertisement. In other words, the doctrine serves First Amendment interests by resolving uncertainties in favor of free speech. Furthermore, the doctrine, if added to the primary message test, can ensure that the test would never underprotect First Amendment interests. This fact will delight First Amendment advocates. On the other hand, proponents of publicity rights may argue that this doctrine is overly broad—it deprives plaintiffs of compensation even when the commercial and communicative elements in a speech are barely related. These arguments present a clear example of the inherent tension between free speech interests and economic/publicity interests.

2. *Concept II: A Focus on the Medium in Which an Identity is Used*

a) The Concept

The Ninth Circuit emphasized the medium in which LAM’s use of Hoffman’s identity appeared in. Much of its reasoning relies on the fact that the appropriation of Hoffman’s identity occurred in an article and in a magazine. In the court’s words: “LAM did not use Hoffman’s image in a traditional advertisement . . . ‘Grand Illusions’ appears as a feature article on the cover of the magazine . . . [it is] a part of the issue’s focus on Hollywood past and present.”¹⁰³ In a sense, the Ninth Circuit could not allow the article’s commercial attributes to trump the serious free speech interests implicated by the medium itself. Note that the court did not inquire deeply into the primary message or purpose of LAM’s use of Hoffman’s identity. Instead, it may have presumed that a magazine would contain

102. See *Board of Trs.*, 492 U.S. at 473-75; *White*, 971 F.2d at 1401 n.3 (9th Cir 1992).

103. *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (2001).

some communicative message or purpose. Though the court did not explicitly state this presumption, it's worth evaluating whether such a presumption might be a valuable addition to the primary message test.

Under this rebuttable presumption, courts will presume that mediums "traditionally" considered by the First Amendment to be in the public interest—news, books, magazines, films, etc.—cannot carry a predominantly commercial message or purpose. On the other hand, mediums such as consumer products or advertisements are presumed to be commercial because they do not "regularly" carry communicative messages or purposes.¹⁰⁴

b) Arguments for a "Presumption" Based on Medium

i) Enhances Predictability by Drawing a Definable Line

This presumption may effectively dilute the case-by-case and open-ended nature of the primary message test. The presumption arguably draws a definable line between protected and unprotected speech and limits courts' discretion in singling out a "primary" message. Creators working in mediums presumed to be communicative will be able to freely express themselves without fearing potential liability. This is desirable because the mediums protected under the presumption are ones commonly recognized to be instrumental in driving public discourse.

ii) Necessity for Incorporating First Amendment Limits

Because publicity rights may clash with the First Amendment, some courts and commentators have suggested that "First Amendment values should be integrated in some form directly into the cause of action for infringement of the right of publicity."¹⁰⁵ A medium presumption may serve as such a built-in First Amendment limit; it practically exempts certain mediums from liability because they implicate too many First Amendment interests.

Proposals for these limits are by no means novel. Numerous intellectual property regimes avoid collisions with speech rights by incorporating First Amendment principles into their frameworks. Copyright law offers a good example. Like the right of publicity, copyright law restrains what may be said and heard in public.¹⁰⁶ Despite this fact, the Supreme Court

104. See *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal. 3d 860 (1979).

105. MCCARTHY, *supra* note 11, at 8-53.

106. Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 984 (1970).

“has made clear that copyright law is substantively constitutional.”¹⁰⁷ Moreover, it suggested that First Amendment protections have been built into copyright law in the form of the idea-expression distinction and the fair use doctrine.¹⁰⁸ These “protections” allow public interests to trump copyrights in appropriate circumstances. Moreover, these “protections” enable copyright and the First Amendment to accommodate one another in spite of their conflicting interests.¹⁰⁹

iii) Numerous Legal Authorities Support Medium Presumptions and Exemptions

a) Case Law

The medium presumption may find support in existing judicial opinions. Certain media—books, films, magazines, music, fine art, etc.—have received broad immunity from the right of publicity.¹¹⁰ Courts have consistently distinguished certain “newsworthy” and “entertainment” mediums from consumer products and advertisements. One court has said that “[m]ore so than posters, bubble gum cards, or some other such ‘merchandise,’ books and movies are vehicles through which ideas and opinions are disseminated and, as such, have enjoyed certain constitutional protections, not generally accorded ‘merchandise.’”¹¹¹

Furthermore, some courts have implicitly considered medium as a factor in applying the “primary message” test. In *Guglielmi v. Spelling-Goldberg Prods.*, the court categorized a television film as communicative speech in rejecting a publicity claim brought by the estate of actor Rudolph Valentino.¹¹² In reaching this decision, the court distinguished motion pictures from “merchandise” such as pens and soaps.¹¹³ It stated that “[merchandise], unlike motion pictures, are not vehicles through which ideas and opinions are regularly disseminated.”¹¹⁴ Indeed, most infringing uses of identity have been found in advertisements or merchandise. Take for example some famous Ninth Circuit decisions in favor of celebrities—

107. Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L. J. 147, 166 (1998).

108. *Id.* at 166-67. *See also* Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 560 (1985).

109. Goldstein, *supra* note 106, at 988.

110. Hunt, *supra* note 5, at 1618.

111. *See* Hicks v. Casablanca Records, 464 F. Supp. 426, 430 (S.D.N.Y. 1978).

112. *See generally* Guglielmi v. Spelling-Goldberg Prods., 25 Cal. 3d 860 (1979).

113. *Id.* at 874.

114. *Id.*

White, Midler, and Abdul-Jabbar.¹¹⁵ All three cases involved advertisements.¹¹⁶ Courts have even denied protection to consumer products that featured strong communicative elements—for example, T-shirts and dishes with printed “messages.”¹¹⁷

b) State Statutes

Some state publicity statutes have language granting an exemption for uses of identity in certain media which the legislature felt should be immunized by the First Amendment.¹¹⁸ For example, such language shows up in California Civil Code Section 3344.1, which makes liable any person who, without consent, uses a deceased personality’s name or likeness “in any manner, *on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases . . .*”¹¹⁹ An express exemption within section 3344.1 precludes liability for the use of a deceased celebrity’s persona in: “a play, book, magazine, newspaper, musical composition, film, or radio or television program . . . material that has political or newsworthy value . . . [or a] work of fine art”¹²⁰

When express exemptions are absent, some courts have found ways to evade First Amendment problems by “interpret[ing] the common law or statute” to exempt certain mediums from liability.¹²¹ The practices of New York courts offer a good example. Although the New York statute prohibits the unauthorized use of identity “for the purposes of trade,”¹²² New York courts have interpreted the phrase “purposes of trade” to exclude for-profit media that contain informative or entertainment elements.¹²³

c) The Restatement of Unfair Competition

The Restatement of Unfair Competition also contains exemptions for certain media.¹²⁴ It phrases the kind of unauthorized use that causes infringement as use for “purposes of trade”—namely, in advertising, on merchandise, or in connection with commercial services.¹²⁵ The Restate-

115. See cases cited *supra* note 6.

116. *Id.*

117. See MCCARTHY, *supra* note 125 at 11, at 7-39; *Shamsky v. Garan, Inc.*, 167 Misc. 2d 149 (1995).

118. MCCARTHY, *supra* note 11, at 8-54.

119. CAL. CIV. CODE § 3344.1(a)(1) (1999); *Comedy III Prods., Inc. v. Saderup, Inc.*, 25 Cal. 4th 387, 395 (2001); Paulsruide, *supra* note 4, at 407.

120. CAL. CIV. CODE § 3344.1(a)(2) (1999).

121. MCCARTHY, *supra* note 11, at 8-53.

122. *Id.* at 8-54, 8-54.1.

123. *Delan v. CBS, Inc.*, 458 N.Y.S.2d 608, 613 (1983).

124. *Johnson, supra* note 2, at 197.

125. *Id.*

ment then proceeds to exclude uses of identity in news reporting, commentary, entertainment, or works of fiction and nonfiction from the category of commercial speech.¹²⁶

iv) The Presumption Creates an Acceptable Balance
Between the Conflicting Interests and Goals

The medium presumption may achieve an acceptable balance between the goals of the First Amendment and publicity rights. While the presumption provides favorable treatment to media that have “traditionally” implicated serious free speech interests, it nonetheless leaves the right of publicity intact. Celebrities can still vindicate the economic interests in their identities. The rules do allow finding for infringement in advertisements and consumer products under most circumstances. These findings will by no means be rare; most appropriations of identity occur in such media. In the end, the presumption still gives celebrities sufficient incentives to contribute their talents to society and prevents unjust enrichment on the part of exploiters.

d) Arguments Against a Presumption Based on Medium—Does
the Presumption Draw Arbitrary Lines and Deny Protection to
Speech that Deserve it?

It may be clear that “newsworthy” and “entertainment” speech deserve protection and commercial exploitations of identities do not. But what about that speech which falls between these two extremes? Who is entitled to profit from the depiction of celebrities in a variety of non-advertising, non-news reporting and nonnarrative contexts, such as baseball cards, collectible plates, T-shirts, figurines, calendars, and posters?¹²⁷ Should control rest with the creator of the work, or the celebrity who is being used? The medium presumption provides no certain answers. On the one hand, an application of the presumption to these “consumer products” may produce as much uncertainties as a case-by-case inquiry. Courts and statutes have yet to explicitly address all of these “intermediates.” Thus, the presumption is arguably an amorphous concept; drawing a line between commercial and communicative *media* can be a difficult task.

On the other hand, with its preference for media “traditionally” protected by the First Amendment, the presumption arguably excludes all “consumer products” from the category of communicative speech—recall the categorization of “merchandise” as commercial in statutes and case

126. *Id.*

127. Tyler Trent Ochoa, ETW Corp. v. Jireh Publishing Inc.: *Introduction: Tiger Woods and the First Amendment*, 22 WHITTIER L. REV. 381, 384 (2000).

law. But consumer products may do more than propose a commercial transaction. Are T-shirts and mugs intrinsically different from songs or art when they both convey vital messages? They are all mass-marked to consumers. Some commentators have argued that both may act as “equally legitimate . . . vehicles for First Amendment expression . . . [t]he content is the same, only the medium is different.”¹²⁸ In a sense, the medium presumption oversimplifies the problem by focusing on the medium, rather than the content—messages and purposes—behind it. As a result, it violates the literal definition of commercial speech by deeming speech to be commercial even if they do more than propose a commercial transaction.

Of course, the presumption may be extended to cover certain consumer products, like the baseball cards in *Cardtoons*. But what about figurines and calendars? Where should the extension stop? Not surprisingly, this line is as arbitrary as any other. Moreover, such extensions make the presumption seem like a stopgap measure rather than a real solution. In summary, a double-dilemma is at work here: If a bright line is not drawn, the medium presumption can be an unpredictable rule; but any line-drawing can be challenged as arbitrary.

D. The Transformative Test (Fair Use Approach)

Most courts have refused to provide protection for advertisements that contain communicative elements. This fact raises the troubling issue about the use of publicity rights to suppress criticism of the celebrity’s “image.”¹²⁹ Some courts and commentators have addressed this concern by suggesting the importation of the “transformative” factor from fair use doctrine into the right of publicity regime.¹³⁰ They argue that this factor better protects free speech interests.¹³¹ The transformative test measures the extent to which a use of an identity “adds something new, with a further purpose or different character” to the appropriated identity.¹³² The test, which requires a case-by-case and fact-specific inquiry, provides advantages similar to that of the primary message test. It does not draw arbitrary lines and carefully balances the free speech and publicity interests

128. *Id.* at 386.

129. See David S. Welkowitz, *Catching Smoke, Nailing Jell-O to a Wall: The Vanna White Case and the Limits of Celebrity Rights*, 3 J. INTELL. PROP. L. 67, 95-100 (1995) (arguing that celebrities sometimes use the right of publicity to bypass the limits on defamation imposed by *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964) and its progeny).

130. See *Comedy III Prods., Inc. v. Saderup, Inc.*, 25 Cal. 4th 387, 395 (2001); Barnett, *supra* note 99.

131. *Id.*

132. Barnett, *supra* note 99, at 21.

raised by each case. All uses of identity are potentially protectable, even advertisements.

Despite its strengths, the transformative test also suffers from the potential for unpredictable and inconsistent results. Furthermore, the test allows judges to act as critics in judging the content of works to determine their degree of “transformativeness.” The task is a difficult one and verges on literary and aesthetic value judgments for which courts are unsuited.¹³³ Perhaps the test will only introduce confusion into the legal framework of publicity rights.¹³⁴ But proponents of the test have pointed to the fact that courts have applied the test in copyright cases for years and have yet to abandon it. Regrettably, the *Hoffman* Court did not address these contrasting views—it only referred to the test in a footnote. Thus, the debate will surely continue as right of publicity litigation intensifies.

IV. CONCLUSION

The “mixed” speech found in LAM and other media presents “a stark example of the inherent conflict between two seemingly reasonable legal positions.”¹³⁵ On the one hand, if the magazine is making money from a celebrity’s image, shouldn’t the celebrity get a share of the profits? On the other hand, shouldn’t the First Amendment protect the magazine’s right to publish anything it wants? Four concepts or approaches have been presented in this Note; none are perfect. The primary message test may be accurate but unpredictable. The inextricably entwined doctrine ensures that the primary message test will not underprotect speech, but it may be a hard doctrine to define. The medium presumption provides a definable but potentially arbitrary line. The “transformative” test gives judges excessive discretion and may produce unpredictability. One dilemma shows up repeatedly in this analysis—a case-by-case inquiry is potentially unpredictable, but a bright line may be arbitrary. A perfect solution is hard to devise.

But it is worth noting that the right of publicity is a relatively recent legal invention; intense litigation on this right has only begun in the past few years. Instead of immediately drawing bright lines, one may argue that courts “would do better to feel their way from case to case, setting forth in each those factors that seem to bear on the resolution of that case

133. *Id.* at 21.

134. MCCARTHY, *supra* note 11, at 8-58 (“It seems strange to propose to bring clarity to right of publicity law by importing into it some undefinably [sic] modified version of one of the most obscure and unpredictable aspects of copyright law.”).

135. Ochoa, *supra* note 127, at 383.

. . . only to eventually arrive at a consensus of relevant factors on the basis of this accumulated experience.”¹³⁶ In other words, the approaches examined here might work together to address the relevant interests in different cases on an experimental basis. But it is clear that none of them can individually solve the problem on its own.

136. *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 227 (2d Cir. 1999) (commenting on the approach that should be taken toward the new federal antidilution statute).

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