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Product Placement or Pure Entertainment? Critiquing A Copyright-Preemption Proposal

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Product Placement or Pure Entertainment? Critiquing A Copyright-Preemption Proposal

Keywords

Copyright, Copyright Preemption, Nimmer's Preemption Framework, Trademark Jurisprudence

PRODUCT PLACEMENT OR PURE ENTERTAINMENT? CRITIQUING A COPYRIGHT-PREEMPTION PROPOSAL

KRISTEN E. RICCARD *

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INTRODUCTION

He wears an Omega watch,¹ drives an Aston Martin car,² drinks Smirnoff vodka,³ and toasts with Bollinger Champagne. As the image of the suave James Bond comes to mind, consider: are James Bond films purely entertainment, or are they another form of commercial advertisement?⁴ These films show just one example of how our modern media environment blurs the line between commercial advertisements and entertainment works.⁵

Technological advancements in media and the rise of product placement advertising⁶ make it nearly impossible to determine whether media producers are feeding us information for advertising

1. See Derrick Daye & Brad VanAuken, *James Bond Brand Shaken By Product Placement*, BRANDING STRATEGY INSIDER, Oct. 23, 2008, <http://www.brandingstrategyinsider.com/2008/10/james-bond-shak.html> (noting that James Bond "has been wearing an Omega watch since 1995's *Goldeneye*, when the brand started paying for product placement").

2. See *id.* (explaining that consumers link the James Bond character to Aston Martin automobiles).

3. See Lacey Rose, *James Bond: Licensed to Sell*, FORBES.COM, Nov. 16, 2006, http://www.forbes.com/2006/11/16/bond-movie-advertising-tech-media-cx_lr_1116bond.html (pointing out that Smirnoff vodka is just one of many product placement advertisements associated with the James Bond films).

4. See 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01[B][3][b][iv][I], at 1-88.2(11) (rev. ed., 2009) (attempting to distinguish works that are commercial from works that are "entertainment works used for their own sake").

5. See Rose, *supra* note 3 (explaining that Sony's focus on highlighting a few key products throughout the James Bond film, *Casino Royale*, "reflects a larger trend in Hollywood" to find increasingly more creative ways to promote products in their entertainment works); see also *id.* (highlighting that companies were likely to spend 3.07 billion dollars in paid placement advertising in 2006, which was up thirty-nine percent from 2005).

6. See Stephanie Clifford, *Bravo Shows Move Further Into Licensing Products*, N.Y. TIMES, Apr. 13, 2009, at B3 (revealing that Bravo will increase the amount of products it includes in its shows and will begin to receive a percentage of the sales of those products).

purposes or creative expression for our thoughtful consideration.⁷ Despite this difficulty, the ability to separate entertainment from commercial advertising is a critical element in a recently proposed solution to a long-standing dilemma in copyright law⁸ put forth by copyright expert David Nimmer.⁹

Nimmer relies on this entertainment and commercial distinction in his framework for deciding when a federal copyright claim should preempt¹⁰ a competing state right of publicity claim.¹¹ Right of publicity laws allow celebrities to retain a property interest in the commercial use of their personalities, an interest that can conflict with the rights of copyright owners.¹² However, as the James Bond films demonstrate, it is increasingly difficult to determine whether a work is made for a commercial or entertainment purpose.

Neither Congress nor the Supreme Court has a clear standard to determine when a federal copyright claim should trump a state right of publicity claim.¹³ The ongoing failure to clarify preemption in

7. See Amit M. Schejter, *Product Placement as an International Practice: Moral, Legal, Regulatory and Trade Implications*, 3 (Oct. 2004), <http://web.si.umich.edu/tprc/papers/2004/304/product%20placement%20tprc.pdf> (mentioning that “[t]he Center for Media & Democracy calls it a ‘[f]orm of advertisement, without disclosing it to the receiving party’”).

8. See *infra* Part I.C (discussing David Nimmer’s proposed test for solving copyright preemption by categorizing copyrighted works as those used for entertainment purposes or those used merely for commercial advertisements).

9. See, e.g., Schuyler Moore, *Straightening Out Copyright Preemption*, 9 UCLA ENT. L. REV. 201, 203 (2002) (explaining that “[t]he treatise *Nimmer on Copyright* is the bible of copyright law . . . [and] it is rare to find a decision dealing with copyright where that treatise is not cited.”). David Nimmer is the son of the late Melville B. Nimmer who first published the *Nimmer on Copyright* Treatise in 1963. Irell & Manella LLP, David Nimmer, <http://www.irell.com/professionals-51.html> (last visited Dec. 1, 2009). Since 1985, David Nimmer has continued to update and revise the treatise created by his father. *Id.*

10. See 16A AM. JUR. 2D *Constitutional Law* § 243 (1998) (equating the term preempting with superseding, and explaining that the Supreme Court sets forth multiple tests to determine if a federal law should supersede a competing state law claim).

11. See *infra* Part I.C (outlining Nimmer’s preemption test, which asks courts to distinguish between commercial and entertainment uses of a copyrighted work).

12. See, e.g., *Toney v. L’Oreal USA, Inc.*, 406 F.3d 905, 907 (7th Cir. 2005) (weighing the right of a celebrity to control the use of her photograph with the right of the copyright owner of the photo to use it on a bottle of hair care product); *Wendt v. Host Int’l, Inc.*, 197 F.3d 1284, 1288 (9th Cir. 1999) (Kozinski, J., dissenting) (disputing the right of George Wendt to limit production of copyrighted animatronic figures of his *Cheers* character); *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) (allowing Bette Midler’s right of publicity interest to defeat a copyright owner’s interest in producing a song that mimicked her voice).

13. See Joseph P. Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976*, 10 VAND. J. ENT. & TECH. L. 1, 2 (2007) (“[T]here are literally hundreds of federal and state decisions interpreting this [copyright preemption] provision, which can charitably be described as inconsistent and even incoherent.”).

copyright law threatens to undermine the uniform application of federal copyright law,¹⁴ and it may reduce the incentive for individuals to produce copyrighted works.¹⁵

Despite the need for clarity in the copyright-preemption debate,¹⁶ this Comment will argue that courts should not rely on Nimmer's preemption framework because it does not promote the objectives of the Constitution or provide a consistent method to determine when a federal copyright claim should defeat an opposing right of publicity claim. Instead, courts should incorporate elements from trademark law's test for similarity to resolve copyright-preemption disputes.

This Comment will demonstrate the problems with Nimmer's framework by focusing on the United States Court of Appeals for the Third Circuit's decision in *Facenda v. NFL Films, Inc.*¹⁷ Given the ambiguous state of preemption in copyright law¹⁸ and the discrepancy across courts,¹⁹ the Third Circuit could not turn to consistent case precedent when it faced this duel between the state and federal claims.²⁰ The court, therefore, relied primarily on Nimmer's proposed solution to this preemption issue to decide if a copyright claim should withstand the competing state right of publicity claim.²¹

14. See *id.* at 23 (explaining that the Copyright Act seeks to provide uniform rights to all copyright owners, but the conflicting outcomes across circuit courts with relation to preemption claims serve to undermine this goal).

15. Cf. Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 212 (2002) (arguing that upholding right of publicity claims severely harms copyright holders because it undermines their ability to produce derivative works, which, in turn, "limits both their creative potential and their ability to fund their work").

16. See Bauer, *supra* note 13, at 23 (noting that the different outcomes courts reach when applying the preemption doctrine is contradictory to the purpose of the Copyright Act).

17. 542 F.3d 1007 (3d Cir. 2008).

18. See *infra* Part I.A.3 (explaining how the lack of clarity within the language of the preemption clause of the Copyright Act leads to conflicting ideas of when state rights should be preempted).

19. See Trotter Hardy, *Contracts, Copyright and Preemption in a Digital World*, 1 RICH. J.L. & TECH. 2, ¶ 24 (1995), <http://law.richmond.edu/jolt/v1i1/hardy.html> (pointing out that, even though the authors of the Copyright Act included the preemption clause in an effort to avoid any confusion as to preemption, the preemption doctrine "has experienced at best an inconsistent interpretation by the courts").

20. See *Facenda*, 542 F.3d at 1029 (beginning the analysis of the conflict preemption claim by outlining Nimmer's framework rather than relying on case law).

21. The court reasoned:

Does a contract acknowledging a right-of-publicity for defendant's copyright in a work containing a plaintiff's identity mean that the defendant may use that work in any way it sees fit? David Nimmer has proposed a two-part framework for handling cases at the intersection of copyright, the right of publicity, and contract.

Nimmer proposes that copyrights used for commercial advertising purposes, and not for pure entertainment, should not preempt a state right of publicity claim.²² Using Nimmer's structure, the Third Circuit held that a sports broadcaster's right of publicity claim trumped the National Football League's (NFL) competing copyright claim because the NFL used its copyrighted film for commercial benefit.²³

Part I of this Comment describes the development of federal copyright law and state right of publicity laws and further explains the failed attempt of the federal preemption clause to provide a clear standard for copyright preemption. It then discusses Nimmer's solution to this ambiguous area of the law. Part II examines the goals of the Federal Copyright Act, federalism, and First Amendment law to argue that Nimmer's test both fails to fulfill these goals and is difficult to apply to preemption disputes in our modern media-saturated society. Finally, Part III proposes a more pragmatic solution to resolve preemption issues by adopting a test for similarity from trademark law. This Comment concludes that copyright-preemption disputes can be resolved by considering the consumer's perspective on the reasonable expectations of celebrities and copyright owners.

I. BACKGROUND

A. *Development of Copyright Preemption*

The conflict that arises between a right of publicity claim and a copyright claim stems from a larger debate about the balance between state and federal powers.²⁴ This section explains the fundamental tension between the state and federal legislatures in the specific area of copyright law. Examining the development of federal copyright protection and state right of publicity laws helps explain

Id.

22. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(10)–(11), (14)–(15) (explaining that there should not be any issue of conflict preemption if the courts simply distinguish between utilizations that are commercial or “for the purposes of trade,” and those uses that are entertainment, and therefore, part of the exclusive rights of copyright owners).

23. See *Facenda*, 542 F.3d at 1030 (deciding that the 22-minute NFL film was promotional in nature and “akin to advertising,” and therefore concluding that preemption was inappropriate according to Nimmer's framework).

24. See Rothman, *supra* note 15, at 204 (noting that “[t]he right of publicity conflicts . . . with explicit provisions of the Copyright Act”).

this preemption debate and reveals why the preemption dispute in *Facenda* prompted the Third Circuit to rely on Nimmer's framework.

1. *The creation of a federal copyright system*

The Federal Copyright Act of 1976 (Copyright Act)²⁵ grants authors copyright protection for their works in order to incentivize the production of new creative works.²⁶ The goal of the Copyright Act is to promote public knowledge and awareness by increasing the production of "original works of authorship"²⁷ available for the public's consideration.²⁸ Such "original works of authorship"²⁹ include a wide range of media, such as movies, literature, architecture, television shows, and sound recordings.³⁰

However, Congress recognized the need to provide some reward to creators, authors, and producers in exchange for their investment in order to encourage individuals to spend time and money producing original works for public access.³¹ Therefore, the Copyright Act

25. See 17 U.S.C. §§ 101-1332 (1976) (amending the first Federal Copyright Act enacted in 1790).

26. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991) (opining that the goal of copyright law is not to merely reward authors for their labor, but rather "[t]o promote the Progress of Science and useful Arts" (quoting U.S. CONST. art. I, § 8, cl. 8)).

27. 17 U.S.C. § 102 (2006) ("Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.").

28. See U.S. CONST. art. I, § 8, cl. 8 (noting that the purpose of creating a federal system of copyright and patent law was "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries").

29. 17 U.S.C. § 102; see also *Feist*, 499 U.S. at 345 (explaining that, in order for a work of authorship to qualify as original, it must be "independently created by the author . . . [and] possess[] at least some minimal degree of creativity").

30. See 17 U.S.C. § 102 (setting forth eight categories of works that are considered the subject matter of copyright: (1) literary works, (2) musical works, (3) dramatic works, (4) pantomimes and choreography, (5) pictorial, graphic, and sculptural works, (6) motion pictures and audiovisual works, (7) sound recordings, and (8) architectural works).

31. See Bauer, *supra* note 13, at 11 (explaining that "[a] principal reason for affording copyright protection" is to encourage the creation of original works of authorship); Rothman, *supra* note 15, at 204 (explaining that copyright "strive[s] to protect creative artists and to provide incentives for them to create"). The Association of Research Libraries notes that:

[T]he law was meant to provide an incentive to authors, artists, and scientists to create original works by providing creators with a monopoly. At the same time, the monopoly was limited in order to stimulate creativity and the advancement of science and the useful arts through wide public access to works in the public domain.

grants copyright owners exclusive rights in their copyrighted works.³² These exclusive rights allow the copyright holder to control the current and future uses of the work.³³ This control creates a system of economic rewards for copyright owners because they can charge others for access to, and use of, the work.³⁴ Examples of economic benefit include: licensing fees for radio stations, ticket sales to theatrical productions, and purchases of film scripts.³⁵ Thus, the Copyright Act maintains an economic framework that rewards the copyright owner and the public.³⁶

Not only does the copyright owner have incentives to share the original work with the public, but the Copyright Act also provides incentives for the creation of derivative works,³⁷ which are based upon the original copyrighted work.³⁸ Derivative works may qualify for their own copyright protection,³⁹ and in such cases the copyright

Association of Research Libraries, *Copyright Timeline: A History of Copyright in the United States* (2007), <http://www.arl.org/pp/ppcopyright/copyresources/copyrighttimeline.shtml> (internal quotations omitted).

32. See 17 U.S.C. § 106 (2006) (granting exclusive rights to copyright owners for a limited time, such as the right to display, perform, distribute, reproduce, and prepare derivative works of the original copyrighted work).

33. See, e.g., *Gracen v. Bradford Exch.*, 698 F.2d 300, 302 (7th Cir. 1983) (asserting that the copyright holder has the right to control and produce derivative works). In that case, the owners of the copyright in the *Wizard of Oz* character, Dorothy, could maintain an action for copyright infringement if the plaintiff did not authorize the defendant's production of plates painted with the image of Dorothy. *Id.* at 303.

34. See Rothman, *supra* note 15, at 204 (explaining that one rationale for copyright protection is that it combines artistic and economic values, including the right to license the work, convey it to others, and gain remedies against others who inappropriately use the work without consent of the copyright owner); see also Hardy, *supra* note 19, ¶ 5 (asserting that copyright owners can only make a profit from their work if they can be assured that only a minimal amount of copying of their works will occur if they release them to the public domain).

35. Cf. Christian Copyright Licensing International, The Church Copyright License Annual Fee-U.S., <http://www.ccli.com/WhatWeOffer/LicenseFees.aspx> (last visited Dec. 1, 2009) (listing the various fees that are charged to churches for access to the copyrighted sermons available for broadcast).

36. See Robert A. Kreiss, *Accessibility and Commercialization in Copyright Theory*, 43 UCLA L. REV. 1, 14 (1995) ("The copyright system seeks to promote the public benefit of advancing knowledge and learning by means of an incentive system . . . [and t]he economic rewards of the marketplace are offered to authors in order to stimulate them to produce and disseminate new works.").

37. See 17 U.S.C. § 106 (2006) (providing the copyright owner with the exclusive right "to prepare derivative works based upon the [original] copyrighted work").

38. See *id.* (defining a derivative work as "a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted").

39. See *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 909 (2d Cir. 1980) (clarifying that the original aspects of a derivative work can receive copyright

owner maintains exclusive rights over the derivative and the original work.⁴⁰ This exclusive control over the production of derivative works serves as an additional economic incentive for copyright owners to create new works.⁴¹

To keep pace with technological advancements,⁴² courts have broadened the scope of works that qualify for copyright protection.⁴³ For example, computer software,⁴⁴ videogames,⁴⁵ and movie clips⁴⁶ are eligible to receive copyright protection. Copyright protection extends to works that incorporate a high degree of technological processes, and the exclusive rights granted to authors are far-reaching.⁴⁷ The applicability of copyright law to a very broad range of

protection, but only if the originality is “more than trivial,” and the derivative work does not infringe on the scope of the exclusive copyrights in the original work).

40. See *Gracen v. Bradford Exch.*, 698 F.2d 300, 302 (7th Cir. 1983) (noting that a derivative work may qualify for copyright protection; however, it must have sufficient creativity and be based on a copyrightable work, and only the new creative aspects in the derivative work may be copyrighted). In that case, the defendant’s paintings of the Dorothy character from the *Wizard of Oz* were not sufficiently independently creative to qualify for their own copyright protection. *Id.* at 305.

41. See Rothman, *supra* note 15, at 210 (arguing that, because derivative works are a “major source of income” for copyright owners, the right to prepare derivative works is a “vital element in encouraging the production of new work”).

42. The House Report on the general subject matter of copyright explained that:

[T]he history of copyright law has been one of gradual expansion in the types of works accorded protection . . . [and] scientific discoveries and technological developments have made possible new forms of creative expression that never existed before. . . . Authors are continually finding new ways of expressing themselves, but it is impossible to foresee the forms that these new expressive methods will take.

H.R. REP. NO. 94-1476, at 51 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664.

43. See Association of Research Libraries, *supra* note 31 (stating that the Copyright Act was revised in 1976 due to the changes in technology that affected how works could be copied and “what constituted an infringement”).

44. See *Apple Computer, Inc., v. Franklin Computer Corp.*, 714 F.2d 1240, 1249 (3d Cir. 1983) (considering a computer program a type of “literary work” that should therefore receive protection under the Copyright Act of 1976).

45. See *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 435–36 (4th Cir. 1986) (expressly disagreeing with the lower court by holding that a video game based upon a copyrighted blackjack card game was within the subject matter of copyright—in the form of an audiovisual work—because of the creative expression that goes into creating the shape, sounds, format, and layout of the game).

46. See *Video Pipeline, Inc. v. Buena Vista Home Entm’t, Inc.* 342 F.3d 191, 194, 207 (3d Cir. 2003) (holding that Disney had an exclusive right to manage the clips from portions of its movies, and thus could prevent Video Pipeline from streaming segments of these movie clips online).

47. See generally Grant Gross, *IP conference: Copyright Has Gone Too Far*, THE REGISTER, Nov. 16, 2001, http://www.theregister.co.uk/2001/11/16/ip_conference_copyright_law_has/ (discussing how the Digital Millennium Copyright Act (DMCA) gives a handful of media companies “an enormous additional amount of control” because it allows for copyright owners to impose digital rights management

creative works means that copyright holders have a long chain of economic reward and control.⁴⁸

Although this incentive system in copyright law is not unique to the United States,⁴⁹ it deviates from some European countries in how much protection it affords to authors of a work.⁵⁰ In some European countries, the author is the only person that can originally own the copyright in the work, and the author maintains a right to receive royalties for any future uses of the tangible work.⁵¹ However, in the United States, the copyright owner can be distinct from the author of the work.⁵² In copyrighted works for hire or collaborative works, the individual author does not necessarily own the copyright for the entire work.⁵³ Furthermore, the owner can sell the copyright in the work separately from the tangible work.⁵⁴ As such, the copyright holder may have the power to control the fate of a work that derives from another author.⁵⁵ This distinction between artist and copyright

techniques and provides that copyright infringers might also be sentenced to jail time for hacking into protected internet web pages).

48. See, e.g., *Gracen v. Bradford Exch.*, 698 F.2d 300, 301 (7th Cir. 1983) (allowing the copyright holders of the *Wizard of Oz* to sue for infringement when replicas of its characters were painted on a series of plates); see also Brett Barrouquore, *Seuss Lawyers Stop Holiday Who-ville in Louisville*, SFGATE, Nov. 25, 2008, <http://www.sfgate.com/cgi-bin/article.cgi?f=/n/a/2008/11/25/national/a063325S99.DTL> (granting the copyright owners of Dr. Seuss's "Who-ville" characters an injunction against the city of Louisville to prevent the city from using the Seuss characters in a Christmas parade).

49. See, e.g., Association of Research Libraries, *supra* note 31 (mentioning that the federal system of copyright law in the United States is modeled after Great Britain's copyright system).

50. See generally Open Access to Scholarly Information: Copyright, http://open-access.net/de_en/general_information/legal_issues/copyright/ (last visited Dec. 1, 2009) (explaining the differences between the American legal framework and that employed by Germany).

51. See *id.* (detailing that, in Germany, copyright ownership vests with the author and seeks to protect "the economic and moral interests of the author"); see also 2 Nimmer & Nimmer, *supra* note 4, § 8C.04[A][1] (explaining that the copyright laws of France and other European countries recognize a right called *droit de suite*, which "is the right of an artist to 'follow' or participate in the proceeds realized from the resale of the tangible embodiment of her work").

52. See 17 U.S.C. § 202 (2006) (clarifying that "[o]wnership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied").

53. See, e.g., Recording Artist's Project at Harvard Law School, Copyright Basics, <http://cyber.law.harvard.edu/rap/copyright> (last visited Dec. 1, 2009) (warning artists that in a work for hire, the creator "owns nothing").

54. See 17 U.S.C. § 202 (explaining that transfer of ownership of the material work does not mean a transfer of ownership of the copyright—they are separate and distinct).

55. See, e.g., *Laws v. Sony Music Entm't Inc.*, 448 F.3d 1134, 1144–45 (9th Cir. 2006) (deciding that Sony owned the copyright to the song in which the artist sang, and thus Sony could use segments of the song in future sound recordings).

owner is important to keep in mind when discussing the right to control the distribution of copyrighted works.

2. *The rise of state right of publicity laws*

Despite this broad federal copyright system,⁵⁶ copyright owners do not maintain a monopoly over the use of their works.⁵⁷ Various legal claims, such as the fair use doctrine in copyright⁵⁸ and the application of state laws,⁵⁹ limit the ability of copyright owners to have absolute control over the use of their creative expressions.⁶⁰ In particular, the court-developed right of publicity doctrine limits, and arguably conflicts with, copyright owners' ability to fully exercise their exclusive rights.⁶¹

A right of publicity, now codified in many states,⁶² allows an individual to protect against the unauthorized commercial use of his

56. See H.R. REP. NO. 94-1476, at 51 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664 (recognizing that the coverage of subject matter of copyright in the current federal copyright statute is very broad and may be further broadened).

57. See Hardy, *supra* note 19, ¶ 5 ("Protection does not have to be, and will never be, absolute. That is, once a work of authorship is released to the public, as a practical matter some uncontrolled copying is possible and even likely.").

58. The fair use doctrine states that:

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.

17 U.S.C. § 107 (2006).

59. See, e.g., *Video Pipeline, Inc. v. Buena Vista Home Entm't, Inc.*, 210 F. Supp. 2d 552, 568-69 (D. N.J. 2002) (holding the exclusive rights to creative expression afforded by federal copyright law did not preempt the defendant's state law conversion and replevin claims seeking the return of tangible property).

60. See Bauer, *supra* note 13, at 46-88 (discussing how state law breach of contract claims, unjust enrichment claims, and right of publicity claims are not necessarily preempted by a competing federal copyright claim).

61. See *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (creating the term "right of publicity" in the opinion written by Judge Jerome Frank); see also Joseph R. Grodin, Note, *The Right of Publicity: A Doctrinal Innovation*, 62 YALE L.J. 1123, 1126-28 (1953) (explaining that the right of publicity, developed in the *Haelan* case, offers celebrities an additional remedy beyond breach of contract and tort in order to protect the commercial benefit of their personas).

62. See Cornell University Law School Legal Information Institute: Publicity, <http://topics.law.cornell.edu/wex/Publicity> (last visited Dec. 1, 2009) (noting that only around half the states have right of publicity statutes); see also *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 622 (6th Cir. 2000) (noting that "[t]he right of publicity is a creature of state common law and statute and originated as part of the common-law right of privacy").

or her identity.⁶³ This right of publicity derives from an individual's right of privacy in tort law.⁶⁴ However, as Judge Jerome Frank opined in 1953,⁶⁵ the right of publicity is separate and distinct from the right of privacy because the publicity right concerns the public exposure of an individual's identity for commercial benefit.⁶⁶ Today, this state right is similar to an intellectual property right because it details a right of control over an identity.⁶⁷ This state right is primarily claimed by celebrities to prevent the unauthorized use of their images for advertising purposes.⁶⁸ This Comment will refer to the right of publicity claimant as the "celebrity" because the individual must be an actor, singer, or other type of well-known entertainment figure.⁶⁹

The goal of the right of publicity is to prevent another person from benefitting from the unauthorized use of a celebrity's identity.⁷⁰ An infringement of this right is distinct from a false advertising claim arising under trademark law because it does not require that the

63. See, e.g., 42 PA. CONS. STAT. ANN. § 8316 (West 2007) (allowing any person whose "name or likeness has commercial value" to bring an action to prevent the unauthorized commercial use of such name or likeness).

64. See, e.g., James Chadwick & Roxana Vatanparast, *The Copyright Act's Preemption of Right of Publicity Claims*, 25 COMM. LAW. 3, 3 (2008) (mentioning that the law was "historically treated as a species of the tort of invasion of privacy").

65. See *Haelan*, 202 F.2d at 868 (announcing for the first time a right of publicity that is separate from a right of privacy).

66. See Grodin, *supra* note 61, at 1127 ("[*Haelan*] gave protection to persons' commercial interest in their personality [sic] independent of their privacy interest. [I]n so doing, *Haelan* implied that such commercial interest, aside from any privacy interest, might justify legal protection of an individual against unauthorized use of his name or picture.").

67. See Chadwick & Vatanparast, *supra* note 64, at 3 ("[Right of publicity] claims are now generally recognized as involving a form of intellectual property, particularly in connection with celebrities who assert not a 'right to be left alone,' but rather the right to control and profit from the use of their names and images.").

68. See Lee Goldman, *Elvis Is Alive, But He Shouldn't Be: The Right of Publicity Revisited*, 1992 BYU L. REV. 597, 597 (1992) ("The most common invocation of [the right of publicity] occurs when a third party appropriates a celebrity's name or likeness for endorsement purposes, for the sale of memorabilia, or in connection with artistic or literary works.").

69. See Grodin, *supra* note 61, at 1127 (noting that this right was developed particularly for famous persons due to the need to protect the monetary interest in their personalities).

70. The Supreme Court noted in *Zacchini v. Scripps-Howard Broadcasting Co.*:

The rationale for protecting the right of publicity is the straightforward one of preventing unjust enrichment by the theft of good will . . . [and] 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. 433 U.S. 562, 576 (1977) (quoting Harry Kalven, Jr., *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966)).

celebrity be falsely associated with a commercial product.⁷¹ Instead, the right of publicity is concerned with any use of a celebrity's identity, and it seeks to prevent others from unjustly benefitting from the use of that identity.⁷² In 1977, the Supreme Court recognized this right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*⁷³ by allowing a "human cannonball" performer to recover damages from a broadcasting company after the company videotaped the performer's entire act without authorization.⁷⁴ In addition to protecting the celebrities' identities from unauthorized use, the Court also noted other justifications for this state right, including the need to encourage celebrities to invest time and money to make their performances interesting to the public.⁷⁵

Courts' willingness to uphold a right of publicity claim is on the rise.⁷⁶ These claims do not necessarily require that any tangible aspect of the celebrity's identity was misused;⁷⁷ simply conjuring up the celebrity's identity may be enough to infringe a celebrity's right of publicity.⁷⁸ The Ninth Circuit went so far as to uphold Vanna

71. See *Parks v. LaFace Records*, 329 F.3d 437, 460 (6th Cir. 2003) (explaining that, unlike a claim for false advertising under trademark law, a right of publicity claim does not require evidence that a consumer is likely to be confused); see also 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 5:19, at 437 (2d ed. 2009) (pointing out that a false endorsement claim requires a false inference that the plaintiff approves of the product).

72. See *Zacchini*, 433 U.S. at 573–75 (explaining that a celebrity should have the right to benefit from his creative work, and another should not be able to share the performance with the public while denying the celebrity's right to commercial benefit).

73. 433 U.S. 562 (1977).

74. See *id.* at 563–64 (noting that the length of the entire clip was fifteen seconds).

75. See *id.* at 576 (highlighting that "the protection provides an economic incentive for him to make the investment required to produce a performance of interest to the public").

76. See Rothman, *supra* note 15, at 204–05 (mentioning that conflicts between copyright and right of publicity claims are on the rise because "right of publicity actions have proliferated and the right has expanded to cover 'persona'").

77. See *White v. Samsung Elecs. Am. Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992) (clarifying that a right of publicity claim does not require actual use of the individual's name, image, or likeness, but instead whether the facts taken together as a whole are sufficient to suggest the capture of the individual's identity).

78. See, e.g., *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 811 (9th Cir. 1997) (reversing and remanding a grant of summary judgment because issues of material fact existed as to whether the defendant's creation of animatronic characters of Wendt, based upon his character in the television show *Cheers*, violated his right of publicity); see also *White*, 971 F.2d at 1399 (ruling that a robot character wearing a long gown, blonde wig, and large jewelry and turning a wheel similar to that in *Wheel of Fortune* in a commercial advertisement sufficiently conjured up White's persona to raise issues of fact on whether her right of publicity was infringed, thereby making summary judgment inappropriate).

White's right of publicity claim against Samsung Electronics when Samsung's commercial included a robotic character that spun a wheel and wore a blonde wig.⁷⁹ With the strengthening of this right, celebrities now have some say in the fate of the works in which their personalities are captured, even if a copyright in the work is owned by another. Thus, the copyright owner's traditional power to control the original use, future use, and licenses of a copyrighted work is now sliding into the grip of the individual celebrity.⁸⁰ Where the celebrity and the copyright owner have different agendas and expectations for the copyrighted work, courts look to the purposes and interests served by the federal and state laws to decide which claim to uphold.⁸¹

3. *Preemption debate in copyright law*

Although the state right of publicity serves a valid purpose in protecting a celebrity from commercial exploitation, the execution of the right often conflicts with a copyright owner's attempt to exercise the exclusive rights afforded by the Copyright Act.⁸² This conflict usually arises when a copyright owner holds a valid copyright in a work that captures the celebrity's identity, and the owner uses the copyrighted work in a way that the celebrity does not approve.⁸³ This process includes the distribution of the copyright, the performance

79. See *White*, 971 F.2d at 1397–99 (rejecting White's right of publicity claim based upon a California statute, but allowing a common law right of publicity claim to proceed).

80. Cf. Goldman, *supra* note 68, at 600–01 (noting that prior to widespread court recognition of a right of publicity in *Zacchini*, the only claim available for celebrities was a right of privacy under tort law, which did not always apply in disputes related to copyrighted works).

81. See, e.g., *White*, 971 F.2d at 1398–99 (noting that the right of publicity was created to provide celebrities with an interest in the commercial use of their identities, and applying this interest to demonstrate that Vanna White deserved the right to enjoin Samsung from using her persona in a commercial advertisement for the company's products); see also *Midler v. Ford*, 849 F.2d 460, 463 (9th Cir. 1988) (opining that the unauthorized use in a song of a voice that sounded just like Bette Midler's was an attempt to circumvent the proper value that "the market would have paid for Midler to have sung the commercial in person").

82. One commentator argued that:

Both copyright and the right of publicity strive to protect creative artists and to provide incentives for them to create; however, the two rights . . . can come into serious conflict. . . . [because t]he right of publicity conflicts not only with the explicit provisions of the Copyright Act, but also with the implicit grant of affirmative rights to copyright holders and the public, as well as the purposes behind the copyright protection.

Rothman, *supra* note 15, at 204.

83. See *Balt. Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 677 (7th Cir. 1986) (deciding that a baseball player could not rely on a right of publicity to defeat the Major League Baseball's (MLB) exclusive right to broadcast the baseball games for which they owned a copyright).

of the copyrighted work,⁸⁴ and the preparation of derivative works that use segments of the original work.⁸⁵

The conflict often arises when the celebrity contracts to the use of his or her identity in the original work, but does not agree to have the identity captured in derivative works.⁸⁶ The conflict is especially problematic because the Copyright Act expressly grants the right to prepare derivative works to the copyright holder.⁸⁷ Thus, the Copyright Act forces various courts to decide which claim should triumph: the celebrity's state right of publicity or the copyright owner's federal rights.⁸⁸

Any conflict between a state law and a federal law inherently invokes the U.S. Constitution's Supremacy Clause.⁸⁹ In an effort to uphold the Supremacy Clause, the Copyright Act includes a preemption clause in section 301.⁹⁰ Section 301 explains that the

84. See *id.* (deciding that the players' right of publicity in their performances was equivalent to the MLB's exclusive right to perform the work when the MLB broadcasts the players' baseball performances).

85. See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1096 (9th Cir. 1992) (deciding that Tom Waits, a professional singer, songwriter, and actor, could prevent Frito-Lay from imitating and then broadcasting a commercial for Frito-Lay based on Frito-Lay's authorized license in the original sound recording of Waits's voice).

86. See, e.g., *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905, 907 (7th Cir. 2005) (summarizing that Toney was a model who contractually agreed to authorize the use of her image and likeness to the Johnson hair company between 1995–1998, but sued under a right of publicity claim when Johnson attempted to use Toney's image to promote L'Oreal products that were not explicitly agreed to and fell beyond the contractual time period).

87. See 17 U.S.C. § 106(2) (2006) (“[T]he owner of [a] copyright . . . has the exclusive right to do and to authorize . . . [the] prepar[ation of] derivative works based on the copyrighted work.”).

88. See 17 U.S.C. § 301 (2006) (noting that any legal or equitable rights that are the equivalent to those offered in the Copyright Act shall be preempted, but failing to clarify exactly which state rights should be considered an equivalent, as opposed to a superior, right).

89. See U.S. CONST. art. VI, § 2 (“This Constitution, and the Laws of the United States . . . shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any state to the Contrary notwithstanding.”); see also *Gibbons v. Ogden*, 22 U.S. 1, 24 (1824) (holding that, when Congress legislates within its powers, conflicting state laws must give way to the federal law).

90. The statute provides that:

On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

17 U.S.C. § 301(a) (2006); see also 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B], at 1-7 (arguing that “courts grappling with the tension between federal and state law may

federal Copyright Act will preempt any state laws that offer rights equivalent to any of the exclusive rights in the Copyright Act.⁹¹ The goal of section 301 is to foreclose any misinterpretation between state and federal law.⁹²

However, the preemption clause does not resolve all conflicts between a state right of publicity claim and a federal copyright claim.⁹³ Because state right of publicity claims do not afford rights that are precisely equivalent to those in the Copyright Act,⁹⁴ they are not expressly preempted by the Copyright Act.⁹⁵ Therefore, a problem arises in determining when a court should still preempt these state-law claims because they conflict with the overall goals of the Copyright Act.⁹⁶ Under the theory of conflict preemption,⁹⁷ a court may invalidate a state law that is “an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.”⁹⁸ Thus, when faced with a potential conflict between federal and state law, courts look to whether a statute expressly preempts state law and whether conflict preemption is present.⁹⁹

apply various tests to determine whether the Supremacy Clause requires pre-emption of state law”).

91. 17 U.S.C. § 301(a).

92. See Bauer, *supra* note 13, at 1–2 (quoting the legislative history of section 301 for the proposition that the preemption provision was “set forth in the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation . . . and to avoid the development of any vague borderline between State and Federal protection.” (internal quotations omitted)).

93. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][1][c], at 1-30 to 1-31 (clarifying that because the subject of a right of publicity claim is the claimant’s persona, which does not fall within the scope of the Copyright Act, the Act’s preemption clause does not resolve a conflict between state and federal law because it does not apply).

94. See 42 PA. CONS. STAT. ANN. § 8316 (West 2007) (allowing an individual to prevent the unauthorized “commercial” use of a name or likeness, which is not the equivalent of any of the exclusive rights offered in the Copyright Act).

95. See, e.g., *Facenda v. NFL Films*, 542 F.3d 1007, 1027 (3d Cir. 2008) (opining that the Pennsylvania right of publicity statute was not expressly preempted because *Facenda*’s voice itself was not within the subject matter of copyright and the statute did not offer a right equivalent to those listed in the Copyright Act); see also 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][a], at 1-77 (explaining that the Supreme Court has clarified that the existence of an express preemption clause does not mean that preemption is limited to express preemption cases; it may also arise under general conflict preemption, in which the state statute conflicts with the general goals of the federal law).

96. See *supra* Part I.A.1 (discussing the history and goals of the Copyright Act).

97. See *Facenda*, 542 F.3d at 1028 (noting that this conflict preemption may be referred to as “implied preemption”).

98. *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941).

99. See *Freightliner Corp. v. Myrick*, 514 U.S. 280, 288 (1995) (opining that the existence of an express preemption clause in a federal statute “does not mean that the express clause entirely forecloses any possibility of implied pre-emption”). The Supreme Court has traditionally distinguished between express preemption and

Unfortunately, the language of the preemption clause combined with legislative history creates a challenge for courts faced with conflict preemption in copyright.¹⁰⁰ In the original version of section 301, Congress explicitly listed the state laws that the Copyright Act would not preempt;¹⁰¹ however, for unclear reasons, Congress decided to eliminate the clear list in the final version of the statute.¹⁰² Some courts have reasoned that the deletion of this specific list means that Congress believed that the Copyright Act should never preempt certain state rights, including the right of publicity, while other courts have looked to other areas of the law to interpret section 301.¹⁰³ Lacking examples of the types of state laws that section 301 seeks to preempt, courts have applied the preemption clause with uncertainty and inconsistency.¹⁰⁴

Ultimately, the inclusion of a preemption clause in the Copyright Act far from resolves the conflict between right of publicity claims and copyright claims.¹⁰⁵ The Fifth Circuit upheld an individual's right of publicity claim when a copyrighted photograph of the individual appeared on a shampoo bottle,¹⁰⁶ yet it preempted baseball players'

implied preemption, understanding that cases in which a state law presents an actual conflict with federal law as an instance of "implied preemption." *Id.* at 288–89.

100. See Rothman, *supra* note 15, at 232–35 (describing how the language of the preemption clause and the legislative history in its enactment have confused courts when attempting to resolve preemption issues).

101. The original draft of section 301 explicitly stated that the Copyright Law would not preempt

any state [law] with respect to . . . activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by Section 106, including rights against misappropriation not equivalent to any of such exclusive rights, breaches of contract, breaches of trust, trespass, conversion, invasion of privacy, defamation, and deceptive trade practices such as passing off and false representation.

H.R. REP. NO. 94-1476, at 24 (1976) *reprinted in* 1976 U.S.C.C.A.N. 5659, 5746.

102. See Rothman, *supra* note 15, at 234–35 (arguing that "the deletion of language from the final version of the statute further confuses courts as to Congress' intent" and that "[t]here is a debate over why this language was deleted").

103. See *id.* at 235 (noting that some courts and scholars have found the legislative history of section 301 to be inconclusive, while others have argued that Congress deleted the language to "prove that the right of publicity can never be preempted").

104. See generally Hardy, *supra* note 19, ¶ 24 (arguing that the preemption clause has undergone an "inconsistent" interpretation at best).

105. See Bauer, *supra* note 13, at 2 (explaining that, even though there have been hundreds of cases relating to copyright preemption at the circuit court level, many of which have conflicting outcomes, the Supreme Court has yet to hear a case to clarify this area of the law).

106. See *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905, 909 (7th Cir. 2005) (allowing Toney to proceed on a claim of right of publicity when the defendant used her photo for an advertisement without her consent even though the defendant was lawfully entitled to use the photograph for other purposes).

right of publicity claim related to the copyrighted broadcast of their games.¹⁰⁷ In contrast, the Ninth Circuit preempted a celebrity's right of publicity claim in a photograph appearing in *L.A. Weekly*,¹⁰⁸ but allowed a celebrity's right of publicity to trump the copyright claim relating to the creation of animatronic characters of his image.¹⁰⁹ Even though the creation of the Copyright Act and its preemption provision sought to eliminate confusion and inconsistency in the law,¹¹⁰ many would agree that "it would not be an overstatement to describe this important provision in the Copyright Act as a 'legislative failure.'"¹¹¹

B. Preemption Issue in *Facenda v. NFL Films*

Given the uncertainty in this area of copyright law, the Third Circuit turned to Nimmer for guidance on the conflict preemption issue in *Facenda v. NFL Films*.¹¹² The preemption claim raised in *Facenda* involved the NFL's valid copyright interest in the sound recording of the voice of sports broadcaster John Facenda.¹¹³

Facenda was a Philadelphia sports broadcaster who worked with the NFL for many years to produce football documentaries.¹¹⁴ Specifically, Facenda worked on a session-by-session basis with the NFL to produce NFL films, which the NFL then advertised as

107. *Balt. Orioles v. Major League Baseball Players Ass'n*, 805 F.2d 663, 667 (7th Cir. 1986) (finding that the baseball players' right of publicity in their performance was equivalent to the MLB's right to audiovisual broadcast, rendering the players' claim of a right to publicity preempted under the Copyright Act).

108. *See Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184–85 (9th Cir. 2001) (holding that Dustin Hoffman's right of publicity claim was preempted by the First Amendment when his image was used for editorial expression and not for pure commercial purposes).

109. *See Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 810 (9th Cir. 1997) (concluding that Wendt's right of publicity claim was not preempted as a matter of law when defendant used animatronic characters to portray his likeness).

110. *See Sears, Roebuck & Co v. Stiffel Co.*, 376 U.S. 225, 231 n.7 (1964) (noting that Congress's intent to create uniformity can be seen in statutes where it vests exclusive federal jurisdiction to hear copyright cases and by the "section of the Copyright Act which expressly saves state protection of unpublished writings but does not include published writings"); *see also* Bauer, *supra* note 13, at 1 (claiming that, by federalizing copyright law, the Framers of the Constitution sought to "achieve uniformity and avoid the potential for state protection of infinite duration").

111. Bauer, *supra* note 13, at 2; *see also* Moore, *supra* note 9, at 201 (explaining that "case law is in chaos on these issues [of preemption] and there is, to date, no logical, rational analysis to determine the answers").

112. 542 F.3d 1007, 1029 (3d Cir. 2008) (turning directly to Nimmer's framework when discussing the conflict preemption issue between Facenda and the NFL).

113. *See id.* at 1026 (recounting that the copyright in the sound clips of Facenda's voice derived from a copyrighted production of NFL films in which Facenda expressly contracted to appear).

114. *Facenda*, 542 F.3d at 1012.

documentaries with the “[l]egendary [v]oice of John Facenda.”¹¹⁵ Football fans termed Facenda “the Voice of God,”¹¹⁶ and Facenda worked with the NFL to produce films for decades.¹¹⁷ While most of his contracts with the NFL were oral,¹¹⁸ shortly before he died from cancer in 1984, Facenda signed an express contract allowing the NFL to enjoy the use of his film sequences “provided, however, such use does not constitute an endorsement of any product or service.”¹¹⁹

In 2005, the NFL produced a short film entitled the “The Making of Madden NFL 06” (“Making of Madden”), which focused on the then-upcoming video game “Madden NFL 2006.”¹²⁰ In addition to interviews with players and the video game’s producers, the film included sound clips of Facenda’s voice.¹²¹ While Facenda did not personally work on this short film, the NFL included his voice in the film by using segments of the old NFL copyrighted films that featured Facenda’s commentary.¹²² In 2007, Facenda’s estate sued the league under a false endorsement claim and for unauthorized use of his name or likeness under Pennsylvania’s right of publicity statute.¹²³ The NFL denied that this film was a commercial endorsement in depositions, but the Third Circuit determined that the short film was an infomercial designed to promote sales of the “Madden NFL 06” video game.¹²⁴

C. Nimmer’s Preemption Test

Forgoing a discussion of case law,¹²⁵ the Third Circuit’s discussion of the conflict preemption dispute in *Facenda* relied exclusively on

115. *Id.*

116. *Id.*

117. *See id.* (explaining that Facenda was paid per each program he produced).

118. *Id.*

119. *Id.*

120. *See id.* (explaining that the 22-minute film appeared on the NFL network eight times during the three days leading up to the video game’s release).

121. *Id.*

122. *See id.* (highlighting that the documentary included three sentences read by Facenda which took approximately thirteen seconds of the program).

123. *Id.* at 1011; *see also* 42 PA. CONS. STAT. ANN. § 8316 (West 2007) (allowing a claim if one’s name or likeness is used for commercial purposes without consent).

124. *See Facenda*, 524 F.3d at 1012 (noting that, even though the NFL executives denied the commercial purpose of the film in their depositions, the record indicated various email messages that suggested that “NFL Films sought to create the program as promotion for Madden NFL 06, describing it as the ‘Madden Promo’ or as ‘the Advertisements’ in the actors’ release forms”).

125. *See Facenda*, 542 F.3d at 1029–32 (beginning its discussion of the state right of publicity claim by explaining Nimmer’s framework, rather than turning to case law). The court continued to discuss the framework and why Nimmer believes various

Nimmer's framework.¹²⁶ Nimmer developed this test as a means of reconciling the various court decisions dealing with copyright preemption of a right of publicity claim.¹²⁷ Nimmer determined that there is a pattern that involves distinguishing between a commercial advertisement and an entertainment work.¹²⁸ Based upon this pattern, Nimmer puts forth a framework that involves a two-step process to determine whether the right of publicity claim should overcome the competing copyright claim.¹²⁹

Under his test, courts should first determine whether the copyrighted work in dispute was used for an entertainment purpose¹³⁰ or a commercial advertising purpose.¹³¹ Nimmer directs courts to refrain from classifying works by their nature or medium because, under his test, there is no single type of work (e.g., movie, book, song) that will always be commercial or will always be entertainment.¹³² Rather, courts should look specifically to the use of

circuit courts allowed a right of publicity claim to stand in some cases and why the claim failed in other cases. *Id.*

126. *See id.* at 1030–32 (concluding that this was not an express preemption of the right of publicity because the Pennsylvania right of publicity statute did not have the same elements as a copyright claim; rather, it had an extra element requiring “commercial” use of the name or likeness).

127. *See* 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(11) (focusing on sixteen different “right of publicity” cases to explain his framework).

128. *See id.* (listing cases in which a right of publicity was upheld along with those where it was preempted, and then determining that the former were all “commercial” uses of a copyright, while the later were “expressive” uses of the copyrighted work).

129. *See id.* § 1.01[B][3][b][iv][I], at 1-88.2(15) (explaining that if a work is an expressive use, then it should not be preempted; however, if it is a commercial use, then it is necessary to look to the artist’s contract to see if the artist agreed to such a use). Nimmer applies this framework to *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645 (Cal. Ct. App. 1996), to explain that because Fleet contracted to act in a commercial film, he could not later complain when the film was broadcast on television. 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(18).

130. *See* 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(11) (failing to provide a clear definition of the term “expressive” as he uses it, and instead merely listing several examples of works that he considers expressive, including a movie, a docudrama, a character in a movie, a song, and a digitized image).

131. *See id.* § 1.01[B][3][b][iv][I], at 1-88.2(10)–(11) (placing a commercial advertisement into the general category of a work made “for the purposes of trade”) (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (1995)). Nimmer also quotes the Restatement:

The name, likeness, and other indicia of a person’s identity are used ‘for the purposes of trade’ . . . if they are used in advertising the user’s goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user.

Id. at 1-88.2(10) (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (1995)).

132. *See id.* § 1.01[B][3][b][iv][I], at 1-88.2(12) (demonstrating how a type of work, such as a film, can be “protected” as entertainment if it teaches how to dance,

the copyrighted work to determine whether the copyright owner used the work as a commercial advertisement for another product, or whether it was an expressive use for public entertainment.¹³³ Expressive uses of a copyright are likely to preempt a state right.¹³⁴ However, if a court determines that use of the copyright is for a commercial advertisement, it should then look to Nimmer's second prong.¹³⁵

Nimmer's second prong asks courts to look at the terms of the original contract to determine if the celebrity agreed to participate in commercial advertisements.¹³⁶ Nimmer explains that if the original work was a commercial advertisement for a product or concept courts have been likely to find that the celebrity implicitly authorized the copyright owner to create derivative works for commercial advertising purposes.¹³⁷ On the other hand, if the original work was completely unrelated to the promotion of a product or idea, courts have been much more willing to uphold the celebrity's right of publicity claim.¹³⁸ For example, when a celebrity sings a song for an album, she cannot prevent the copyright owner from creating another album song that uses the copyrighted portion of her voice.¹³⁹ However, where a

"but [it is] on the wrong side if it just glorifies a computer game that the NFL wants to sell").

133. See *id.* ("The distinction between those lists is not between categories, but between utilizations. A song can be on the right side if used to express Jennifer Lopez's artistic vision, but on the wrong if it hawks [sic] Cheetos and Cherokees.").

134. See *id.* § 1.01[B][3][b][iv][I], at 1-88.2(11) (noting that cases he deemed to be expressive uses turned out to be the ones in which the various courts preempted the right of publicity claim).

135. See, e.g., *Facenda v. NFL Films, Inc.*, 542 F.3d 1007, 1030 (3d Cir. 2008) (explaining that Nimmer directs the courts to look at the "purpose[s] of the use to which the plaintiff [celebrity] initially consented when signing over the copyright in a contract").

136. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][II], at 1-88.2(16) (citing *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645 (Cal. Ct. App. 1996), as an example in which the artists agreed to participate in the commercial production of a movie in contract, and thus failed to get an injunction to prevent the movie company from distributing a movie based on a right of publicity claim).

137. See *id.* § 1.01[B][3][b][iv][II], at 1-88.2(18) (asserting that an artist who "sang for a recording . . . could not complain when that very recording was later exploited, by being used as background [for a] Jennifer Lopez [song]").

138. See *id.* § 1.01[B][3][b][iv][I], at 1-88.2(11) (listing nine cases where the court upheld a right of publicity claim because the original copyrighted works had no relation to their derivative works, which were commercial advertisements for unrelated products, including the use of singer Tom Waits's voice in a Doritos commercial and the use of Vanna White's likeness to sell Samsung televisions).

139. See *Laws v. Sony Music Entm't, Inc.*, 294 F. Supp. 2d 1160, 1165 (6th Cir. 2003) (declaring that a singer's claim regarding the sampling of a previously recorded song being used in a new song by a different artist was preempted by federal law).

celebrity appears in a copyrighted artistic photograph, she may be able to prevent the copyright owner from placing that photo on a shampoo bottle.¹⁴⁰

Through this framework, Nimmer explains the conflicting outcomes in sixteen different right of publicity claims.¹⁴¹ Of these sixteen cases, nine courts allowed the state claim to stand, and seven courts upheld the copyright owner's claim.¹⁴² Nimmer proposes that when a celebrity agrees to participate in a copyrighted work knowing that it will be used for commercial advertisements, they should not later be able to deny the copyright owner the ability to exercise all of the exclusive federal rights, including the preparation of derivative works that use the celebrity's identity.¹⁴³ On the other hand, he instructs that a federal copyright claim should fail to preempt a state right of publicity claim when the copyrighted work is created for a commercial purpose that the celebrity has not explicitly agreed to in his or her contract.¹⁴⁴ Nimmer includes the district court's holding in *Facenda* as an example of the latter situation.¹⁴⁵

While Nimmer successfully rationalizes the outcomes of various copyright-preemption disputes through his framework, it is important to consider whether his framework will assist courts in future preemption claims. Therefore, this Comment will analyze (1) the

140. See *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905, 910 (7th Cir. 2005) (denying that a model's right of publicity claim was preempted by federal law when her photograph was used without her consent on the packaging for a hair care product).

141. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(11) (listing the various cases that he uses to advance his theory).

142. See *id.*

143. The court in *Facenda* discusses Nimmer's analysis of *Fleet* by explaining:

Fleet acted in a movie; for that reason, he could not complain when that very movie was later exploited, by being broadcast on television. Laws sang for a recording; for that reason, she could not complain when that very recording was later exploited, by being used as background for Jennifer Lopez.

Facenda v. NFL Films, Inc., 542 F.3d 1007, 1031 (3d Cir. 2008) (citing 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][II], at 1-88.2(18)).

144. See *id.* at 1030 (explaining that, under Nimmer's test, "[i]f . . . the plaintiff did not collaborate specifically in the creation of advertising content, then the plaintiff is in a strong position to assert continuing control over the use of his image"); see also 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][II], at 1-88.2(18) (contrasting the failed right of publicity claim in *Toney* with *Facenda* by arguing that in *Toney*, the copyright owners did not misappropriate the use of the work; rather, "they simply did exactly what she agreed to," which "stand[s] poles apart from the NFL" when it used *Facenda*'s commentary for a video game).

145. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][II], at 1-88.2(17) ("[I]n [the *Facenda*] case, 'a Philadelphia television news anchorman, and the narrator of NFL Films' game footage and highlight reels,' was allowed to maintain a publicity claim when the NFL repurposed recordings of his voice not for a new entertainment product, but instead for an elaborate infomercial." (citing *Facenda v. NFL Films, Inc.*, 488 F. Supp. 2d 491, 493 (E.D. Pa. 2007))).

goals of copyright law, (2) potential preemption disputes, and (3) the application of Nimmer's test in *Facenda*, to determine if Nimmer offers a viable solution to the copyright-preemption controversy. The following argument will detail this analysis and explain how Nimmer's test ultimately fails to provide any more clarity in copyright-preemption disputes.

II. NIMMER'S PREEMPTION FRAMEWORK DOES NOT PROPERLY PROMOTE THE GOALS OF THE STATE AND FEDERAL LEGISLATURES

An examination of a proposed preemption framework should scrutinize whether courts will be able to uphold the Constitution and promote the goals of the legislature when applying the test to individual cases.¹⁴⁶ The test should also be easily applicable and lead to consistent case precedent.¹⁴⁷ Because Nimmer's test is not easily applicable and does not promote constitutional objectives, courts should not adopt it as an acceptable solution to the copyright-preemption debate.

A. *Three Considerations in Evaluating Nimmer's Test*

As previously noted by legal scholars, a copyright-preemption framework should facilitate consistent application, protect creative expression, and balance the interests of state and federal legislatures.¹⁴⁸

First, the framework should promote a uniform and consistent method to determine the extent of a copyright owner's exclusive

146. See generally Bauer, *supra* note 13, at 6–11 (beginning his analysis of the preemption doctrine in the Copyright Act by first outlining the goals of the federal Copyright Act and the constitutional provisions related to copyright protection); Kreiss, *supra* note 36, at 6, 9–10 (analyzing the importance of accessibility in copyright law by first clarifying the goals of copyright law and then testing whether provisions related to copyright accessibility help to achieve the goals of the Copyright Act).

147. See generally Hardy, *supra* note 19, ¶ 24 (explaining that one of the fundamental complaints about the preemption provision in the Copyright Act is that it is "inconsistent" and leads courts to develop different interpretations for when a state law should be preempted).

148. See generally Bauer, *supra* note 13, at 3, 13 (discussing the role that preemption should play in upholding the goals of the Copyright Act and explaining the importance of upholding a uniform federal copyright system under the Supremacy Clause of the Constitution); Goldman, *supra* note 68, at 616–17 (arguing for the protection of the freedom of expression, as guaranteed by the First Amendment); Rothman, *supra* note 15, at 240–50 (describing the importance of the state interest and the federal interest served by right of publicity and copyright law respectively, and critiquing preemption tests that do not properly balance these competing interests).

rights.¹⁴⁹ The authors of the Copyright Act sought to create a uniform federal framework that would provide equal protection to copyright owners across all states.¹⁵⁰ The Supreme Court explained that the exclusive right of federal courts to hear copyright cases reveals the congressional goal of a uniform system.¹⁵¹ In 2002, the Ninth Circuit again reiterated this goal in *Syntek Semiconductor Co. v. Microchip Technology Inc.*,¹⁵² noting that the “Congressional intent to have national uniformity in copyright laws is clear.”¹⁵³ Standardizing the rights and benefits of copyright ownership is necessary to incentivize the creation of original expression,¹⁵⁴ which is the fundamental purpose of copyright protection.¹⁵⁵

A second consideration in evaluating a preemption framework is whether the test properly protects the freedom of expression,

149. See Michael Erlinger, Jr., *An Analog Solution in a Digital World: Providing Federal Copyright Protection for Pre-1972 Sound Recordings*, 16 UCLA ENT. L. REV. 45, 59 (2009) (asserting that the purpose of a unified federal system over a state system is to get rid of the “anachronistic, uncertain, impractical, highly complicated dual system” of common law copyright under state laws and federal law (quoting H.R. REP. NO. 94-1476, at 109 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5745)).

150. Congress detailed the reasoning for creating a uniform system for federal statutory copyright:

One of the fundamental purposes behind the copyright clause of the Constitution, as shown in Madison’s comments in *The Federalist*, was to promote national uniformity and to avoid the practical difficulties of determining and enforcing an author’s rights under the differing laws and in the separate courts of the various States.

H.R. REP. NO. 94-1476, at 129 (1976); see also Viva R. Moffat, *Super-Copyright: Contracts, Preemption, and the Structure of Copyright Policymaking*, 41 U.C. DAVIS L. REV. 45, 49 (2007) (arguing that there is a federal goal of balance and uniformity when creating policies and laws related to the federal Copyright Act).

151. See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 n.7 (1964) (“The purpose of Congress to have national uniformity in patent and copyright laws can be inferred from such statutes as that which vests exclusive jurisdiction to hear patent and copyright cases in federal courts . . .”).

152. 307 F.3d 775 (9th Cir. 2002).

153. *Id.* at 781.

154. See *Goldstein v. California*, 412 U.S. 546, 555 (1973) (describing the purpose of copyright as “to encourage people to devote themselves to intellectual and artistic creation” by “guarantee[ing] to authors and inventors a reward in the form of control over the sale or commercial use of copies of their works”); see also Dotan Oliar, *Making Sense of the Intellectual Property Clause: Promotion of Progress as a Limitation on Congress’s Intellectual Property Power*, 94 GEO. L.J. 1771, 1777–79 (2006) (arguing that the Framers’ intent in the copyright clause was based on a theory of encouragement, incentives, and progress).

155. See U.S. CONST. art I, § 8, cl. 8 (mandating protection for copyrights to “promote the Progress of Science and useful Arts”); see also H.R. REP. NO. 94-1476, at 129 (1976) (declaring that, because “the methods for dissemination of an author’s work are incomparably broader and faster than they were in 1789, national uniformity in copyright protection is even more essential than it was then to carry out the constitutional intent”).

regardless of whether that expression has a commercial purpose.¹⁵⁶ Commercial speech¹⁵⁷ is protected speech by the First Amendment.¹⁵⁸ While commercial speech does not necessarily receive the same level of protection as political speech,¹⁵⁹ courts still offer it constitutional protection.¹⁶⁰ The Supreme Court has recognized that distinguishing commercial speech from artistic speech can be an impossible task, and when in doubt, courts should err on the side of protecting the right to speak.¹⁶¹ Even Nimmer suggests that it is not always easy to draw a bright-line between commercial and non-commercial speech.¹⁶² This difficulty reveals that any preemption proposal should not call for a one-size-fits-all categorization of commercial and non-commercial expression.¹⁶³

Third, a preemption solution should balance the interests served by federal copyright law and state right of publicity laws.¹⁶⁴ Some

156. In discussing whether Congress may legislate copyright protection for facts, Nimmer states:

The First Amendment, as applied to the states via the Fourteenth Amendment, guarantees freedom of speech and press . . . [which] surely limits, in some degree, the extent to which the states, as well as the federal government, may confer a property status upon facts, or otherwise preclude their free dissemination.

1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][2][b], at 1-71.

157. See *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66-67 (1983) (explaining that in First Amendment jurisprudence, the Supreme Court employs a three prong test to determine if a speech is commercial: (1) is the speech an advertisement; (2) does the speech refer to a specific product or service; and (3) does the speaker have an economic motivation for the speech).

158. See *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001) (noting that commercial speech "is entitled to a measure of First Amendment protection").

159. See *id.* at 1184-85 (stating that pure commercial speech is not granted the full extent of First Amendment protection, and further explaining that false or misleading commercial speech is not protected at all and may be regulated).

160. See *Greater New Orleans Broad. Ass'n v. United States*, 527 U.S. 173, 183 (1999) (articulating that commercial speech may come within the provision of the First Amendment, but only if the speech is lawful, not misleading, and outweighs the government's interest in regulating the speech).

161. See *Riley v. Nat'l Fed'n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988) (stating, in dicta, "we do not believe that the speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech").

162. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(12) (admitting that "the line between intrinsic expression and commercial invocation can itself be difficult to draw at times").

163. See *Goldman*, *supra* note 68, at 617 (explaining that if courts attempt to draw a clear line between commercial and non-commercial speech, they threaten to "chill expressive conduct unquestionably protected by the First Amendment").

164. See *Bauer*, *supra* note 13, at 117-18 (explaining that under conflict preemption, a court "may also be required to balance the full range of interests and values of the federal and state governments in the copyright area."); see also *Chadwick & Vatanparast*, *supra* note 64, at 3 (beginning their argument about preemption

proposed solutions to the preemption issue call for eliminating the right of publicity all together.¹⁶⁵ However, a failure to recognize the distinct and necessary protection afforded by this state right would result in unfair exploitation of celebrities.¹⁶⁶ Therefore, preemption frameworks that call for federal preemption in all cases are overly simplistic and inappropriate solutions.¹⁶⁷ Similarly, an excessive limitation of federal copyright protection would hinder the creation of new works.¹⁶⁸ While Nimmer's test does not call for a sweeping elimination of either the state or federal right, it is still necessary to examine whether he properly balances the interests and goals of the conflicting laws.

B. Nimmer's Test Fails to Fulfill Constitutional Objectives Related to Creative Expression

Nimmer's framework does not adequately solve the copyright-preemption debate because it fails to promote the goals and legal precedent established by copyright law, First Amendment law, and state publicity laws. Moreover, the test is difficult to apply to modern copyrighted works, and thus will not help courts establish a clear standard in this area of the law.¹⁶⁹

1. The test conflicts with the goals of copyright law set forth in the Copyright Act and the Constitution

First, Nimmer's proposed copyright-preemption test fails to fulfill a primary goal of the Copyright Act because it does not promote a

proposals by noting the interaction between "interests protected by the right of publicity" and "interests protected by the Copyright Act").

165. See Goldman, *supra* note 68, at 628 (arguing that Congress should consider federal legislation that would preempt a right of publicity in all copyright cases, and that states which do not have right of publicity laws should refrain from creating them).

166. See Rothman, *supra* note 15, at 245 (arguing that eliminating the right of publicity would be a poor solution to this issue because this state right fills a void that is not covered by contract law, copyright law, the law relating to unfair competition, the law relating to false advertising, or any other area of the law).

167. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 565 (1977) (explaining that the right of publicity ensures that celebrities are not unfairly exploited); see also Rothman, *supra* note 15, at 245 (explaining that the right of publicity serves an important policy goal of preventing unjust enrichment, and it would be inappropriate to do away with these state laws in all situations).

168. See *supra* Part I.A.1 (explaining that the ability to reap monetary benefit from the production of derivative works is a major incentive for copyright owners to use their copyrights to produce new works for public enjoyment).

169. See Schejter, *supra* note 7, at 6 (asserting that in modern media society, which relies on product placement to advertise, it is becoming increasingly difficult to draw the line between an expressive work and a commercial advertisement).

uniform copyright system. In drafting the Copyright Act of 1976, the authors explicitly sought to avoid the inconsistent application of copyright protection across the states.¹⁷⁰ Yet, under Nimmer's framework, once a court determines that the work is an advertisement, it merely looks to the celebrity's original contract to see if the celebrity explicitly agreed to a commercial use of his or her identity.¹⁷¹ However, Nimmer admits that it is not always clear whether a work is expressive or commercial.¹⁷² Therefore, the Copyright Act might govern in some jurisdictions, whereas the unique terms of a contract may be decisive in other jurisdictions.¹⁷³

While contracts can play an important role in copyright law,¹⁷⁴ the problem in Nimmer's test lies with the inconsistency in determining whether a contract or the Copyright Act should govern a preemption dispute. By allowing for a potentially subjective interpretation of copyrighted use, Nimmer's test offers copyright owners a different measure of exclusive rights depending on the particular jurisdiction.¹⁷⁵

Nimmer's test also undermines the goals of copyright law because it will deter the creation of new copyrightable expression. Copyright

170. See Bauer, *supra* note 13, at 8 ("It is noteworthy that the first argument proffered, which referred to James Madison's comments in the Federalist Papers, was the importance of 'promot[ing] national uniformity and . . . avoid[ing] the practical difficulties of determining and enforcing an author's rights under the differing laws and in the separate courts of the various States.'" (quoting H.R. REP. NO. 94-1476, at 129 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5745)).

171. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(12) ("The basis of a right of publicity claim concerns the message—whether the plaintiff endorses, or appears to endorse the product in question.").

172. See *id.* (acknowledging that some utilizations, particularly those of a sexual nature, can be perceived as both expressive and commercial).

173. Compare *Facenda v. NFL Films*, 542 F.3d 1007, 1028 (3d Cir. 2008) (deciding the preemption issue in favor of *Facenda* because his contract did not explicitly agree to any commercial use of his name or likeness), with *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911, 1924 (Cal. App. Ct. 1996) (looking to CBS's interest in a copyrighted film to decide that *Fleet* could not prevent the distribution of the film based on a right of publicity claim).

174. See Hardy, *supra* note 19, ¶ 17 (asserting that contracts will play an increasingly important role in copyright disputes because the rapid pace of technological changes, the rise of the Internet, and attempts of copyright owners to place restrictions on digital infringements will prompt personal contracts "to take up where state-of-the-art restrictions on copying leave off"). Hardy then argues that contracts play an important role in copyright law because the Copyright Act cannot keep pace with the rapid rise of copyright disputes related to digital media; therefore, individual contracts try to fill in the gap. *Id.* However, this development will also lead to disputes related to the copyright preemption of state contracts. *Id.* ¶ 3.

175. See *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284, 1288 (9th Cir. 1999) (Kozinski, J., dissenting) (opining that allowing individual state courts to change the extent of copyright protection will undermine the purpose of a uniform copyright system).

protection seeks to increase public access to works of authorship by incentivizing individuals to produce new works.¹⁷⁶ However, Nimmer's test threatens this incentive system by placing a state right on par with a federal copyright and making it just as likely that a state claim will trump a federal copyright claim.¹⁷⁷ The Third Circuit warned in *Facenda* that an increased willingness of courts to uphold right of publicity claims could unfairly limit the ability of copyright owners to exercise their exclusive rights.¹⁷⁸

Furthermore, allowing a celebrity to succeed in a publicity claim based upon a brief appearance in a copyrighted work is likely to encourage litigation and make copyright owners fearful of preparing future derivative works.¹⁷⁹ With the risk of potential litigation from a myriad of celebrities who appear in any portion of the original work, copyright holders are likely to limit the extent to which they use the original copyright to create further derivative works for public dissemination.¹⁸⁰

2. *The test conflicts with First Amendment jurisprudence*

The application of First Amendment law to copyrighted expression reveals a second shortcoming of Nimmer's framework: it inappropriately limits freedom of expression.¹⁸¹ Nimmer's test

176. See *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 526–27 (1994) (“The immediate effect of our copyright law is to secure a fair return for an author’s creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.” (internal quotations omitted)).

177. Cf. 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I]–[II], at 1-88.2(9)–(21) (declining to give more weight to the copyright claim based on its federal status). Under Nimmer’s theory, if the commercial use of the copyrighted work was not explicit in the artist’s original contract, the state right should have the potential to defeat the federal right based upon contract principles. *Id.*

178. The court noted that:

Despite our holding, we emphasize that courts must circumscribe the right of publicity so that musicians, actors, and other voice artists do not get a right that extends beyond commercial advertisements to other works of artistic expression. If courts fail to do so, then every record contract or movie contract would no longer suffice to authorize record companies and movie studios to distribute their works.

Facenda v. NFL Films, 542 F.3d 1007, 1032 (3d Cir. 2008).

179. See *Chadwick & Vatanparast*, *supra* note 64, at 6 (arguing that the failure of courts to preempt right of publicity claims will lead to “increased litigation because those who use copyrighted works cannot predict the consequences of a particular course of conduct and adjust their conduct accordingly”).

180. Cf. *Goldman*, *supra* note 68, at 607 (highlighting that state right of publicity claims will undermine the incentive system that is established in copyright law).

181. Cf. *id.* at 616–17 (arguing that the attempt to draw a line between commercial and non-commercial speech in First Amendment jurisprudence is not easy and, “[c]onsequently, some expression that should be immune from liability goes unprotected”).

attempts to place all works with commercial elements in a category of copyrightable expression that merit less than the full extent of federal protection.¹⁸² The test requires courts to decide whether a work is an “expressive work promulgated for its own sake” or whether it is a work produced for a commercial advertising purpose.¹⁸³ Yet, the Supreme Court, as well as Nimmer, has recognized the difficulty in separating commercial expression from non-commercial expression.¹⁸⁴ Furthermore, Nimmer fails to give a clear definition of a “commercial use,” and he does not present a method to distinguish between an entertainment and commercial use.¹⁸⁵ While Nimmer rationalizes courts’ past decisions on preemption disputes by drawing a dichotomy between an expressive and a commercial use,¹⁸⁶ this rationale will not help courts decide cases where a work may have both a commercial and an expressive purpose.

3. *The test fails to properly balance the interests served by the federal copyright law and state publicity laws*

Finally, Nimmer’s test does not appropriately balance the strength of federal claims in the face of competing state claims. While Nimmer’s test allows for outcomes that favor both copyright claims and right of publicity claims, it does not properly consider the competing state and federal interests.¹⁸⁷ There are legitimate

182. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(11) (considering a video, images, photos, voice over, and a robotic cartoon that were used in commercial advertisements as clearly on the side of “commercial exploitations” rather than considering the potential that these works could also be “expressive works,” which should trigger preemption according to his framework).

183. *Id.* § 1.01[B][3][b][iv][I], at 1-88.2(15).

184. See *Riley v. Nat’l Fed’n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988) (explaining that commercial elements and artistic elements in a work are often intertwined, as was the case with a professional speech that was not necessarily purely commercial even though it related to a financial motivation); see also 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(12) (admitting that “some utilizations straddle the line” between expressive and commercial uses of a copyrighted work). But see 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(13) (arguing that very few cases “fall outside of this dichotomy” of expressive and commercial purposes).

185. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(11) (examining sixteen cases that courts have already decided and listing those cases in which the copyright succeeded as expressive uses of the copyright and those which the copyright claim failed as commercial uses; however, Nimmer does not provide a definition of what is an expressive work and what is a commercial work).

186. See *id.* (listing seven works that he considers commercial and then listing nine examples of works that he considers pure entertainment).

187. See *id.* at 1-88.2(11)–(12) (listing various cases where a right of publicity was both upheld and preempted, but failing to discuss the federal or state interests served in each of the cases).

interests in a state right of publicity claim,¹⁸⁸ but the facts of each case should be carefully considered to determine if the individual celebrity's interest should trump the public interest served by the federal copyright system.¹⁸⁹ The Copyright Act is an explicit extension of the Constitution's mandate to promote the development of science and art.¹⁹⁰ As the Constitution is the supreme law of the land, there should be a strong state interest asserted before a state law can curtail the constitutional interests served by copyright protection.¹⁹¹ While the right of publicity's interest in protecting an individual's rights against government interests is robust in our legal system,¹⁹² the constitutional goal of increasing public awareness through the creative arts should outweigh a celebrity's profit interest except in cases of obvious exploitation.¹⁹³

C. *Problems Applying Nimmer's Test to Current Media*

The application of Nimmer's test to modern media further reveals the flaws in his preemption framework. Advertisements are no longer purely in the form of short television commercials.¹⁹⁴ Our era of TiVo, DVR, and commercial fast forwarding leaves the traditional

188. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 565 (1977) (discussing the reasoning behind the creation of the right of publicity laws, including a protection against unjust enrichment).

189. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 974 (10th Cir. 1996) (arguing that "the inducements generated by publicity rights are not nearly as important as those created by copyright and patent law," and that there is an even smaller incentive effect in the right of publicity when it is claimed in the context of parodies).

190. See *Association of Research Libraries*, *supra* note 31 (asserting that the Constitution gives Congress the power to protect copyrights, and the "First Congress implemented the copyright provision of the U.S. Constitution in 1790" when it created the first Federal Copyright Act of 1790).

191. See *Goldman*, *supra* note 68, at 623 (noting that, according to the Supremacy Clause, "state law is preempted whenever it stands as an obstacle to the objectives of federal law," and that the interest afforded by the right of publicity directly conflicts with the interests in the Copyright Act to incentivize the creation of new or derivative works).

192. See, e.g., U.S. CONST. amend. I, XIV (explicitly listing what states shall not do to individuals who fall within the Constitution's protection).

193. See *Rothman*, *supra* note 15, at 250 (explaining that an additional reason to hold in favor of the copyright owner when a contract is silent on derivative works "is that it is more important to provide incentives for the creation of the original work than for the actors to perform in the project").

194. See *Schejter*, *supra* note 7, at 3 (arguing that "today's audiences are equipped with enough choice and new technological advances that allow them to ignore advertised messages by zapping to other channels or skipping them altogether with the help of digital video recorders," which sets the stage for a product placement to replace traditional commercial advertisements).

commercial advertisement less effective.¹⁹⁵ In response to this technological change, cable networks and film producers increasingly rely on product placement to gain financial benefit from their entertainment works.¹⁹⁶ The advertisement of “Tresemme” hair care products in *Project Runway* and the display of “T-Mobile Sidekick” phones in Bravo’s *Top Chef* demonstrate how entertainment works incorporate commercial advertisements.¹⁹⁷ Nimmer’s proposal to separate commercial uses from entertainment uses is difficult to apply to those media works that straddle the line.

Cable shows are not the only media outlets that clandestinely incorporate advertisements into entertainment. Literary works also highlight the difficulty in distinguishing between expressive and commercial uses of a work. For example, when an author worked with Bulgari Jewelry to write a detective novel about stolen Bulgari jewelry and subsequently sold it to bookstores,¹⁹⁸ the work arguably had both a commercial and an expressive purpose. Finally, subliminal advertising has recently begun to pervade broadcast news¹⁹⁹ through the display of products on the news anchors’ desks.²⁰⁰

The increased commingling of entertainment and commercial works in the media burdens the application of Nimmer’s framework. Nimmer fails to address how courts should resolve preemption

195. See *id.* (explaining that the ability to fast forward through traditional commercials has prompted cable networks to include advertising in the shows that they air); see also Rose, *supra* note 3 (asserting that “for the brands, [product placement] is a DVR-proof way of getting their message across and associating their name with an established franchise”).

196. See Product Placement News Staff, *TiVo Product Placement*, PRODUCT PLACEMENT NEWS, Mar. 14, 2007, <http://www.productplacement.biz/2007031473/News/Product-Placement/tivo-product-placement.html> (revealing that TiVo has led to “more insidious forms of marketing,” and even sells information about its subscribers to marketers).

197. See *Bravo Announces Sponsors for Project Runway Season 5*, THE FUTON CRITIC, Jul. 14, 2008, <http://www.thefutoncritic.com/news.aspx?id=20080714bravo02> (listing Tresemme, Bluefly, Saturn, and L’Oreal Paris as advertising sponsors whose products will appear throughout *Project Runway*).

198. See Richard Alan Nelson, *The Bulgari Connection: A Novel Form of Product Placement*, 10 J. PROMOTION MANAGEMENT 203, 203 (2004), available at <http://www.haworthpress.com/store/ArticleAbstract.asp?sid=CH4DRNNF1P819PC4Q3HK3K8S3CVS6AV1&ID=45825> (explaining that the jewelry store worked with an author to create a novel, which featured the Bulgari products).

199. See, e.g., Abigail Goldman, *Eye-Opener with a Pitch*, LAS VEGAS SUN, July 21, 2008, at 1 (explaining that news stations in Chicago, Seattle, New York and Las Vegas have been known to use product placement in their broadcasts, and journalism trainers worry that this practice could lead to a slippery slope in which advertising companies begin to control news coverage).

200. See *id.* (reporting that “[t]he anchors aren’t even supposed to acknowledge [the coffee drinks] . . . [so] . . . [t]hey get into your mind without you knowing it”).

disputes when a copyrighted work incorporates an entertainment use and commercial use.²⁰¹ This failure reveals that Nimmer's test will be increasingly difficult to apply as product placement becomes more prevalent in our society.²⁰²

D. Problems Applying Nimmer's Test to *Facenda*

Although it is easy to critique Nimmer's framework by posing hypothetical entertainment works, a reexamination of the facts of *Facenda* also reveals the inadequacies of his framework considering that the Third Circuit could have come down on either side of the preemption dispute based on Nimmer's framework. The title "Making of Madden," combined with the broadcast of the film directly before the release of the videogame, makes it difficult to deny the commercial purpose of the NFL's film.²⁰³ The Third Circuit agreed, calling it an "infomercial."²⁰⁴ However, the Third Circuit admitted that the film was not equivalent to a traditional commercial.²⁰⁵ A viewer could have looked to the length, information, and creative choices in the film to conclude that the film was similar to an artistic documentary or a "Docu-drama."²⁰⁶ Nimmer concedes that had the court accepted defendant's characterization of that 22-minute film as a documentary, it would have accorded the work protection and denied the publicity claim.²⁰⁷

Similarly, the Third Circuit might have seen the film's commentary from coaches and the game's producers as descriptive and informative. Under this perspective, the film could be likened to a

201. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(13) (recognizing that some cases would straddle the commercial and entertainment dichotomy, but concluding that these cases would be an exception to the general framework).

202. See Laura Petrecca, *Product Placement—You Can't Escape It*, USA TODAY, Oct. 11, 2006, at 1B-2B ("It's advertising ad nauseam. And it's getting worse. . . . [T]his year, marketers will spend a record \$175 billion on ads in major media, such as TV, radio, print, outdoor, movie theaters and the Internet . . . [u]p 5% over 2005.").

203. See *Facenda v. NFL Films*, 542 F.3d 1007, 1011-17 (3d. Cir 2008) (recounting that the NFL created the film just prior to the release of the videogame, and that the film had commentary from both the game's creators and players from the NFL).

204. See *id.* at 1017 (agreeing with the plaintiff's assertion that the film is similar to a "late night, half-hour-long 'infomercial'").

205. See *id.* (explaining that this infomercial "presents a novel issue, because the program is not a traditional 30- or 60-second television advertisement").

206. See *Davis v. Costa-Gavras*, 654 F. Supp. 653, 658 (S.D.N.Y. 1987) (explaining that a "Docu-drama" is an art form entailing the "dramatization of an historical event or lives of real people," and it "partakes of author's license—it is a creative interpretation of reality").

207. 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][ii], at 1-88.2(13).

movie editorial, such as the one in *Hoffman v. Capital Cities*,²⁰⁸ where the editorial nature of the copyrighted article about the film *Tootsie* preempted Dustin Hoffman's opposing right of publicity claim.²⁰⁹ However, the Third Circuit deferred to the district court's description of the film as an infomercial,²¹⁰ and because Facenda's contract did not agree to such uses of his voice, the NFL could not defeat litigation when it produced a derivative work based on the films.²¹¹

The issue is not that the Third Circuit was right or wrong, but rather that the court could have easily come out on either side of the debate using Nimmer's framework.²¹² Thus, this Comment adopts the same critique of Nimmer's test that he makes of other preemption frameworks: "[t]here has to be a better way."²¹³ This better solution requires looking beyond the paradigm of copyright law and proposing a new test that adequately details how courts can consistently determine when a state or federal infringement claim should prevail.

III. RECOMMENDING A MODIFIED PREEMPTION FRAMEWORK THAT DRAWS UPON TRADEMARK JURISPRUDENCE

To promote the goals of uniformity, clarity, and protection for original expression, a preemption test should allow celebrities and copyright holders to predict whether a derivative work is likely to receive the full extent of federal copyright protection.²¹⁴ Only if such parties can predetermine if their investments in future works are going to prove worthwhile,²¹⁵ rather than fail in litigation, will the

208. 255 F.3d 1180 (9th Cir. 2001).

209. See *id.* at 1189 (holding that Dustin Hoffman could not prevent the release of a periodical—containing mostly editorial commentary—related to the movie *Tootsie* merely because it contained a digitized image of Hoffman as Tootsie that the actor did not agree to in his movie contract).

210. See *Facenda*, 542 F.3d at 1017 (listing various factors that made the program appear like an infomercial).

211. See *id.* at 1012 (explaining that Facenda's written contract with NFL Films explicitly stated that the NFL could use the video recordings of him "by whatever media or manner NFL Films . . . sees fit, provided, however, such use does not constitute an endorsement of any product or service").

212. See, e.g., Goldman, *supra* note 68, at 617 (explaining that the attempt to distinguish between commercial and non-commercial speech is not an easy task and often leads to inadequate First Amendment protection for speech with some commercial elements).

213. 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(9).

214. See generally Kreiss, *supra* note 36, at 9 (explaining that copyright law seeks to provide a clear incentive system so that authors can be assured that they will be compensated for their efforts to produce new or derivative works).

215. See Bauer, *supra* note 13, at 6–11 (explaining how the copyright system is primarily based on financial incentives).

public continue to see the robust development of new creative works.²¹⁶

The recommended test helps fulfill these goals by providing specific factors that courts, celebrities, and copyright holders can apply to any potential use of an original or derivative copyrighted work. By incorporating a concern for a public consumer's response to a derivative work, this proposal will help all parties involved to determine whether a proposed use of derivative work is within the reasonable exercise of the copyright owner's exclusive rights and within the reasonable expectations of the celebrity appearing in the original work.

A. The Recommended Test Incorporates Trademark Law's Concern for a Consumer's Perspective

This recommended solution asks one question: is the derivative work so comparable to the original work that the copyright holder acted within the reasonable expectations of the celebrity?²¹⁷ If the derivative work is similar to the original work in which the celebrity agreed to participate, then the celebrity should not be able to denounce the derivative work as an unauthorized exploitation of his name or likeness.²¹⁸ In contrast, if the derivative work advances a substantially different form and message that the copyright holder should know the celebrity could not anticipate, then the copyright holder should not be able to exploit the celebrity through such a derivative work.²¹⁹

In determining the potential for unreasonable commercial exploitation of an artist, courts should not only make their own

216. See *supra* Part II.B.1 (noting that public benefit and public access to artistic works are the goals of the federal copyright system and the U.S. Constitution).

217. See generally 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][II], at 1-88.2(16)–(20) (agreeing that it is critical that a proposal for a preemption test should ensure that the derivative use of the celebrity's identity is similar to the original use). Thus, this proposed test, like Nimmer's test, seeks to protect the interests and expectations of the celebrity. *Id.* at § 1.01[B][3][b][iv][I], at 1-88.2(9)–(16).

218. Cf. *id.* at § 1.01[B][3][b][iv][II], at 1-88.7(17)–(20) (agreeing that it is reasonable that a copyright owner should be able to produce derivative works that are the type of work that the celebrity originally contracted to produce in the first place). Nimmer uses this rationale to explain why an actor who agreed to participate in a film should not be able to sue under a right of publicity claim when the very same film is broadcasted on television. *Id.*

219. See generally Chadwick & Vatanparast, *supra* note 64, at 6 (arguing that in order to establish a predictable preemption solution, a copyright claim should preempt a right of publicity claim, except in cases where the use goes beyond the mere right to distribute, perform, or display a copyrighted work).

determination of physical similarity between the works, but also consider a consumer's overall reaction to the works.²²⁰ This addition of a consumer focus is in line with copyright law's concern for the public interest and the right of publicity's presumption that the viewer perceives some aspect of the celebrity.²²¹ Trademark jurisprudence's test for the likelihood of confusion between two marks provides several specific factors that courts use to determine if viewers would perceive a substantial similarity between the original and derivative works.²²² Courts usually apply this trademark test to goods; nevertheless, it is possible to modify the test to compare copyrighted works.²²³ The incorporation of elements from one area of the law to another is not uncommon.²²⁴ Thus, it is not surprising that trademark jurisprudence may assist copyright law.

220. See *Standard Oil Co. v. Standard Oil Co.*, 252 F.2d 65, 74 (10th Cir. 1958) (articulating that a trademark can confuse a consumer not only through visual similarity but also when "it conveys the same idea, or stimulates the same mental reaction, or has the same meaning").

221. See, e.g., *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) (explaining that the foundation of Bette Midler's claim lay in the fact that a listener would associate the defendant's song with the persona of Midler, even though it was not her voice).

222. J. Thomas McCarthy notes that:

Similarity is not limited to the eye or ear. The mental impact of a similarity in meaning may be so pervasive as to outweigh any visual or phonetic differences. That is, the 'psychological imagery evoked by the respective marks' may overpower the respective similarities or differences in appearance and sound.

4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 23:26, at 23-139 (4th ed. 2009) (quoting *Vornado, Inc. v. Breuer Elec. Mfg. Co.*, 390 F.2d 724, 156 (C.C.P.A. 1968) (Smith, J., dissenting)). The Ninth Circuit listed the following factors for trademark infringement guidance:

the similarity of the conflicting designations; relatedness or proximity of the two . . . products or services; strength of [plaintiff's] mark; the marketing channels used; degree of care likely to be exercised by purchasers in selecting goods; [defendant's] intent in selecting its mark; evidence of actual confusion; and likelihood of expansion in product lines.

Brookfield Commc'ns, Inc. v. West Coast Entmn't Corp., 174 F.3d 1036, 1053 (9th Cir. 1999).

223. Cf. *Kellogg v. Nat'l Biscuit Co.*, 305 U.S. 111, 114 (1938) (holding that two shredded wheat cartons were not inappropriately similar because the competitor's carton contained three more biscuits than the plaintiff's, the competitor's cartons did not resemble the plaintiff's cartons in "size, form, or color," the labels were strikingly different, and the competitor's biscuit was about "two-thirds the size of the plaintiff's" biscuit).

224. See, e.g., 1 MCCARTHY, *supra* note 222, § 6:14, at 6-33 (clarifying that copyright and trademark law "may overlap to give protection to different aspects of a single item. For example, a picture of a person or character is copyrightable as a pictorial work and may also be used as a mark to identify the source of goods or services."); Note, *Computer Programs and Proposed Revisions of the Patent and Copyright Law*, 81 HARV. L. REV. 1541, 1552-54 (1968) (explaining that a computer program that is copyrightable may also be patentable, thus, both forms of law can be applied to the

To decide if the copyright holder acted within the reasonable expectations of the celebrity, courts should look to six factors—adapted from the trademark test for confusion—to make an overall determination of similarity, as follows: (1) the prominence of the celebrity in the original and derivative work, (2) the purpose of each work, (3) the sight, sound, and plot of the two works, (4) whether the two works were distributed through the same consumer marketing channels, (5) the degree of care that the copyright holder used in respecting the rights of the celebrity, and (6) the expanding use of the derivative work for purely commercial purposes.²²⁵ As in trademark law, not all of the factors will be relevant in every case, and the presence of one factor can make up for the lack of another.²²⁶

This trademark test can help solve the copyright-preemption dispute because it adds elements that focus on a consumer's reaction to the works rather than relying solely on subjective judicial interpretation. In trademark disputes, courts compare the similarity of two marks to determine whether the relevant consumer of a good is likely to confuse two goods because the branding, packaging, or symbols used to market the goods are too similar.²²⁷ The test's focus on the similarity of the product and the mind of the relevant consumer²²⁸ is useful to the preemption debate in copyright law because it will allow courts to determine if an individual viewer is likely to find that the derivative work serves a similar purpose to the

dispute). *But see* Dastar Corp. v. Twentieth Century Fox Film Corp. 539 U.S. 23, 34 (2003) (cautioning against “over-extension” of trademark law into the realm of copyright protection (quoting *Trafix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001))).

225. *See Brookfield Commc'ns, Inc.*, 174 F.3d at 1053 (listing the eight factors of the trademark test for confusion in order to assess the similarity of two goods). Each of the factors for the proposed test nearly mirrors the factors as put forth in *Brookfield*, such as tangible similarity of the works and the market for distribution of the two works. *See id.* However, the terms “product” and “good” are replaced with this test for copyrighted work.

226. *See* *Triumph Hosiery Mills, Inc. v. Triumph Int'l Corp.*, 308 F.2d 196, 198 (2d Cir. 1962) (explaining that the list for likelihood of confusion factors is not exhaustive and that “the court may have to take still other variables into account”).

227. *See Brookfield*, 174 F.3d at 1053 (“The core element of trademark infringement is the likelihood of confusion, i.e., whether the similarity of the marks is likely to confuse customers about the source of the products.” (quoting *Official Airlines Guides, Inc. v. Goss*, 6 F.3d 1385, 1391 (9th Cir. 1993))).

228. *See, e.g.,* *Beacon Mut. Ins. Co. v. OneBeacon Ins. Group*, 376 F.3d 8, 10 (1st Cir. 2004) (explaining that a likelihood of confusion claim in trademark law will only be actionable if the confusion “exist[s] in the mind of a relevant person” (quoting *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1207 (1st Cir. 1983))).

original copyrighted work.²²⁹ Including the perspective of the relevant viewer is critical in this preemption issue because the celebrity should not be able to make a claim of commercial exploitation if the public viewer does not associate the celebrity with any commercial advertisement after exposure to the work.²³⁰

B. The Recommended Framework Promotes the Interests of the Copyright Owners and Celebrities

The proposed multi-factor test is more useful than Nimmer's preemption test because it promotes the three primary goals related to copyright law. First, it protects the unified copyright system because copyright owners will feel comfortable knowing that their derivative work will receive federal protection, so long as it is relatively similar to the original copyrighted work.²³¹ Unlike Nimmer's test, the recommended test does not involve choosing between terms of a contract and federal copyright protection.²³² Copyright owners would have specific factors to predetermine the reasonableness of the derivative work,²³³ allowing them to produce

229. See Rothman, *supra* note 15, at 253 (employing a similar focus on the consumer's mind in her proposal for a preemption test when she suggests that "[i]f an image not only 'reminds' people of the right of publicity holder, but also 'looks like' the right of publicity holder, then the defendant has taken the expression of the person's identity, not merely the idea of that person").

230. Cf. *Laws v. Sony Music Entm't Inc.*, 448 F.3d 1134, 1143–46 (9th Cir. 2006) (opining that Sony used Laws's song as a sample in another song, and this use was unlikely to be seen as an advertisement for any product); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184–86 (9th Cir. 2001) (holding that a picture of Hoffman appearing in the magazine about the film *Tootsie* was akin to an expressive editorial, and Hoffman's picture was not used for commercial advertisement or exploitation).

231. See 17 U.S.C. § 106 (2006) (providing an exclusive right to control the use of derivative works); see also Kreiss, *supra* note 36, at 14 (explaining that copyright is about making money, and copyright owners must be assured that their derivative works will receive federal copyright protection). The proposed test directly compares the tangible similarities between the original and the derivative works, an assessment that any author or copyright owner could make prior to using a celebrity's identity in a derivative work, rather than relying on a judicial interpretation of the commercial/entertainment use of a work. See *supra* text accompanying note 225 (proposing a six factor test for determining similarity between two copyrighted works).

232. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][II], at 1-88.2(12) (arguing that if the artist's contract did not explicitly agree to a commercial advertisement, the copyright owner should not be able to exercise the exclusive right to produce a derivative work that might have an additional advertising purpose).

233. See *supra* Part III.A (listing the proposed factors for assessing the similarity between two copyrighted works based on the "likelihood of confusion" test in trademark law).

additional works without fear of subjective interpretations of copyright conflict preemption.²³⁴

Second, the proposed test does not leave courts or copyright owners with the impossible task of distinguishing between commercial and entertainment expression.²³⁵ This test does not punish works merely because they are commercial; rather, it provides proper protection for commercial works, as required by the First Amendment.²³⁶ The test also provides copyright owners with a clear standard to evaluate whether their works will receive protection based on objective comparisons of the original and derivative works, not on subjective guesses between protected expression and commercial exploitation.²³⁷

Finally, the recommended test promotes the interests of the state and federal legislatures by not precluding a celebrity from succeeding in a right of publicity claim.²³⁸ It allows a celebrity to overcome a competing copyright claim where the derivative work or the use of the work was unreasonably dissimilar to the original copyrighted work.²³⁹ This scenario promotes the interests behind the right of publicity laws, including the prevention of unjust enrichment and

234. Compare Rothman, *supra* note 15, at 235 (explaining that when dealing with copyright preemption issues some courts look to the deleted language of section 301 for guidance in preemption, while others turn to different areas of copyright law for assistance), with 1 WILLIAM E. LEVIN, TRADE DRESS PROTECTION § 7:2 (2d ed. 2009) (explaining that even though slight variances exist across courts when applying the likelihood of confusion factors to individual cases, the majority of courts still rely on the same list of factors, and multiple circuit courts have explicitly discussed the importance of applying the likelihood of confusion test in a consistent manner).

235. See, e.g., Goldman, *supra* note 68, at 616–17 (explaining that drawing the line between commercial and non-commercial expression “is not that simple” and may lead to under-protection of free speech).

236. See, e.g., Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180, 1184 (9th Cir. 2001) (emphasizing that commercial speech receives “a measure of First Amendment protection”); see also Brookfield Commc’ns, Inc. v. West Coast Entmn’t Corp., 174 F.3d 1036, 1053 (9th Cir. 1999) (comparing the marketing channels in the likelihood of confusion test). Looking to an evaluation of marketing channels in both the trademark test and the modified test for copyright law reveals that the proposed test would not preclude a copyright claim merely because the work might be used to market goods or services to consumers.

237. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(12) (admitting that it is not always easy to draw a line between commercial and entertainment uses of a work).

238. See Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 576 (1977) (noting the importance of the right of publicity claim because the failure to protect such a claim may result in unjust enrichment).

239. Compare *supra* Part III.B (asserting that the right of publicity should not be preempted if the derivative work seeks to promote an entirely different product or access an entirely unrelated market), with 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.2(12) (agreeing that an artist should not be associated with a commercial advertisement that was not in his original contract).

commercial exploitation of celebrities.²⁴⁰ However, this test also recognizes the deference that a preemption solution should pay to a competing federal copyright claim, based upon the Supremacy Clause of the Constitution and the inclusion of the Copyright Act's preemption clause.²⁴¹ If the author did not create the derivative work in bad faith and the work is reasonably similar to the original work, the recommended test favors the copyright claim.²⁴² Ultimately, the federal interest in a uniform system to incentivize new creative works would dominate; however, a celebrity's right of publicity claim can triumph in a case of clear commercial exploitation.²⁴³

While there are several advantages to the recommended test, there remains some potential for conflicting outcomes in preemption disputes. The multiple factors in the test provide courts with detailed guidance in deciding the case; however, various jurisdictions might choose to emphasize different factors, which may lead to inconsistent application of the test.²⁴⁴ Moreover, any multi-factor test runs the risk of becoming overly complex and tedious during litigation.²⁴⁵ Finally, one could argue that, while Nimmer's test gives courts the authority to decide subjectively between a commercial and entertainment work, the proposed test still allows a court to speculate how a consumer would respond to the works.²⁴⁶ Despite these potential drawbacks, the proposed test provides substantially more direction for courts and

240. See *Zacchini*, 433 U.S. at 565 (noting that the purpose of the right of publicity is to prevent unjust enrichment by using a celebrity's work in a way that denies the celebrity the ability to reap commercial benefit).

241. See *supra* Part I.A.2–3 (discussing the role of the Supremacy Clause in copyright jurisprudence, and the inclusion of section 301 to ensure that a state law does not conflict with federal copyright law).

242. See *supra* III.A (arguing that the degree of care the copyright holder uses in respecting the rights of the celebrity is an important factor in assessing similarity).

243. Cf. *Zacchini*, 433 U.S. at 565 (providing an example of clear commercial exploitation).

244. See Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1587, 1622–47 (2006) (arguing that there continues to be a strong disparity across jurisdictions concerning how to apply the multi-factor trademark test and explaining the discrepancy in interpretations of each factor in the likelihood of confusion test).

245. See William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 66–69 (2008) (arguing that the problem with the likelihood of confusion test is that the test itself is vague, and its application is time-consuming due to the “fact-intensive nature” of the test).

246. See *id.* at 73–74 (arguing that the likelihood of confusion test is inappropriate because it allows courts to arbitrarily give weight to multiple factors, none of which gives appropriate consideration for expressive speech protected by the First Amendment).

more adequately promotes the incentive system in copyright law than Nimmer's framework.

C. Application of Recommended Test to Copyright-Preemption Disputes

Facenda provides an apt example of how the recommended test could have helped the NFL determine the reasonableness of its derivative use of Facenda's voice. First, Facenda's voice was very prominent in the original work, and thus Facenda had a strong interest in the future use of such copyrighted films.²⁴⁷ Second, the original film and the derivative videogame film did not have a similar purpose, as the former focused only on NFL football games, while the latter related to a consumer product.²⁴⁸ Third, the sound and visual appearance of the two works were distinct: the original focused on NFL players and coaches, while the derivative work featured long segments with the game's creators.²⁴⁹ Fourth, the marketing channels were similar because both works targeted football fans.²⁵⁰ The fifth and sixth factors relating to bad faith are not clear in this case.²⁵¹ Finally, the expansion of the NFL's sound recordings from pure entertainment to a commercial purpose was evident because the derivative use of the segments related to a consumer product.²⁵² With five out of seven factors showing a stark difference between the two works, it is not surprising that the Third Circuit upheld Facenda's right of publicity claim.²⁵³

In contrast to *Facenda*, the proposed test would not allow a right of publicity claim to preempt a copyright claim where both works take on a similar form and target viewers in a similar manner.²⁵⁴ Nimmer analyzes *Laws v. Sony Music Entertainment, Inc.*,²⁵⁵ where Sony used a

247. See *Facenda v. NFL Films*, 542 F.3d 1007, 1011 (3d Cir. 2008) (discussing how the NFL described Facenda's voice in the original films as "distinctive, recognizable [and] legendary" (internal quotations omitted)).

248. *Id.* at 1012.

249. See *id.* (noting that the program described the realism of the video game).

250. *Id.*

251. See *id.* (mentioning that the NFL might have originally referred to the film as the "Madden Promo" during production, but then denied that the film was a promotion in their testimonies).

252. See *id.* (explaining that in 2005 the NFL decided to create the "Making of Madden NFL 06" film, while Facenda's original films related solely to NFL documentaries and not promotional videos).

253. *Id.* at 1033 (noting that the Pennsylvania right of publicity statute does not conflict with federal copyright by protecting Facenda's voice).

254. See *supra* Part III.A (noting the importance of the consumer's perspective in determining if a work is unreasonably commercially exploitive).

255. 448 F.3d 1134 (9th Cir. 2006).

sample from Debra Laws's sound recording in the background of a Jennifer Lopez song.²⁵⁶ Both of Lopez's and Laws's works were voice recordings released on albums, and Sony owned valid copyrights in both works.²⁵⁷ Nimmer argues that Laws's claim should be preempted because the Lopez song is not commercial.²⁵⁸ Under the proposed test, the copyright claim also preempts Laws's claim; however, it is not necessary for a court to consider if the song has a commercial purpose. It is enough that both the derivative work and the original were songs released on albums to the general music consumer.²⁵⁹ Laws agreed to sing for a song, and Sony simply exerted its right to use that voice recording in a song.²⁶⁰

Finally, in *Wendt v. Host International, Inc.*,²⁶¹ Nimmer explains that a celebrity's right of publicity claim should not be preempted where an animatronic figure of a *Cheers* television character, Norm, was used for the commercial purpose of luring customers into an airport restaurant.²⁶² In contrast to Nimmer's conclusion, under the proposed test the right of publicity would be preempted because the copyright owner was merely exercising the right to create derivative works based upon the copyrighted *Cheers* character. The animatronic figure was visually similar to the original copyrighted character, and was marketed at fans of the copyrighted show *Cheers*. The allure of the figurine depended upon its association with the copyrighted character Norm, not with the exploitation of the personality of the actor, Wendt. As such, the animatronic derivative work was reasonably similar to the copyrighted work, and the actor should reasonably expect that the copyright might give rise to such derivative works.

256. *Id.* at 1136.

257. *Id.*

258. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][II], at 1-88.2(16)–(20) (explaining that, because the use of the copyrighted sound recording in Lopez's song constituted an expressive use, the copyright claim would not be preempted by Laws's right of publicity).

259. See *supra* Part III.A (explaining that the proposed test focuses on the similarity of the product and the mind of the relevant consumer rather than the commercial use of the work).

260. 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][II], at 1-88.2(16)–(20).

261. 125 F.3d 806 (9th Cir. 1997).

262. See 1 NIMMER & NIMMER, *supra* note 4, § 1.01[B][3][b][iv][I], at 1-88.1, 1-88.2(9)–(15) (explaining that the use of the *Cheers* animatronic figures, which resembled the image of Wendt, were used solely for "commercial exploitation" in order to attract customers into a restaurant).

The recommended test provides a clearer standard to determine whether a copyrighted work will preempt a state right of publicity. Where Nimmer's test fails to promote the general goals relating to creative copyrighted works, this test protects original expression, so long as the derivative use is similar to the original use of the celebrity's persona.²⁶³ The recommended test methodically²⁶⁴ allows copyright owners to determine if a court is likely to recognize the derivative creation as part of the exclusive right to prepare derivative works in the Copyright Act.²⁶⁵ Thus, the test promotes the production of creative works, while recognizing celebrities' right to limit the unfair exploitation of their identities.

CONCLUSION

Although Nimmer's preemption framework might be alluring to courts struggling to find clarity in the copyright-preemption debate, courts should resist the temptation to adopt his framework. Nimmer's call for courts to decide when a copyright should preempt a competing right of publicity—based on a subjective judicial determination of what constitutes a commercial use and an expressive use—undermines the goals of the Copyright Act, the First Amendment, and the Constitution.

Instead, courts should determine preemption cases based on the reasonable expectations of copyright owners and celebrities. This determination requires considering the similarity between the original and derivative use and incorporating a consumer's reaction to the works. The recommended test, adopted from trademark law, provides a clearer standard to determine whether a copyrighted work will trump a state right of publicity. The test provides a six-prong approach that protects artistic expression, so long as it is not exploitative. It also reduces the need for subjective judicial interpretations of works and offers tangible factors that copyright owners might consider before investing the time and money to produce a derivative work. While the increased presence of Bollinger champagne and Aston Martin cars in James Bond films might increase our inclination for expensive goods, the recommended test

263. See *supra* Part III.B (proposing a new test to balance the rights of celebrities against the right to create original works).

264. See *id.* (listing six factors that copyright owners and courts can evaluate to determine if the original work is sufficiently similar to the derivative work).

265. See 17 U.S.C. § 106 (2006) (providing copyright owners the exclusive right to create and control the use of derivative works).

ensures that it will not suppress our access to future Bond-related films and products.