

Court of Appeals
of the
State of New York

New York County Clerk's Index No. 151633/14

KAREN GRAVANO,

Plaintiff-Appellant,

– against –

TAKE-TWO INTERACTIVE SOFTWARE, INC. and ROCKSTAR GAMES,

Defendants-Respondents.

New York County Clerk's Index No. 156443/14

LINDSAY LOHAN,

Plaintiff-Appellant,

– against –

TAKE-TWO INTERACTIVE SOFTWARE, INC., ROCKSTAR GAMES,
ROCKSTAR GAMES, INC. and ROCKSTAR NORTH,

Defendants-Respondents.

**BRIEF ON BEHALF OF LAW PROFESSORS AS *AMICI*
CURIAE IN SUPPORT OF DEFENDANTS-RESPONDENTS**

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* Counsel would like to thank Alexandra Gianelli and Tracy Yao, UCLA School of Law students who worked on this Brief.

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Interest of *Amici Curiae*

Amici are law professors who are knowledgeable about both First Amendment law and intellectual property law:

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David Welkowitz	Whittier Law School

They believe that, (1) to adequately protect free speech, courts must properly and narrowly define the scope of exclusive rights in names and likenesses, and (2) the decision in this case will prove influential in many cases far beyond those involving these particular parties. They hope that, because of their expertise and broader perspective, this brief will be of assistance to this Court.

No party to this case drafted any part of this brief, or contributed any money to the preparation of this brief; indeed, no-one other than the

UCLA School of Law has contributed any money intended for the preparation of the brief.

Summary of Argument

Using characters based on real people in works of fiction is a longstanding practice protected by the First Amendment. Creators often try to make their works true to life, and a large component of that life is celebrities. That has been done in a vast range of works, such as *Brave New World*, *Forrest Gump*, *Midnight in Paris*, and *Seinfeld*. The creators of video games, which are as protected by the First Amendment as are books and films, must have the same right.

When the state legislature enacted § 51 of the New York Civil Rights Law, it did not intend to restrict this commonly used artistic technique. Section 51 of the New York Civil Rights Law provides a limited right of privacy that prohibits the nonconsensual use of a person's voice, picture, name, or portrait for "advertising" or "trade" purposes. And New York courts have generally narrowly construed the statute as applying only to commercial advertising, to avoid conflicts with the First Amendment.

Because videogames are constitutionally protected creative works, like books and movies, the right of privacy statute does not apply to them,

or to advertisements for them. Thus, Gravano's and Lohan's claims that Take-Two impermissibly used their likeness in *Grand Theft Auto V*, or in material promoting *Grand Theft Auto V*, must fail. (We accept for purposes of our argument the plaintiffs' assertion that the characters were indeed deliberately based on Lohan and Gravano—though they appeared under other names—and that viewers would recognize them as such. Of course, if that assertion is incorrect, that is even more reason to reject liability in this case.)

And this historical limitation on the right of privacy has helped New York avoid the problems faced by other jurisdictions, which have interpreted the right of privacy more broadly—and, as a result, inconsistently, unpredictably, and with unacceptable subjectivity. Different courts applying rival tests have reached widely varying results on virtually identical facts. And both the predominate purpose test (urged by Gravano) and the transformative use test (urged by Lohan) have proved vague, too speech-restrictive, and open to discrimination in favor of what judges view as “high art” and against what they view as “low art.” This court should continue reading the right of privacy as limited to commercial advertising, and thus affirm the judgment below.

Argument

I. Authors Have Long Based Characters on Real People, and Have a Constitutional Right to Do So

Creators have long worked real famous people into their fictional stories, and they have a First Amendment right to do so. “Fiction writers may be able to more persuasively, more accurately express themselves by weaving into the tale persons or events familiar to their readers. . . . No author should be forced into creating mythological worlds or characters wholly divorced from reality. . . . Surely, the range of free expression would be meaningfully reduced if prominent persons in the present and recent past were forbidden topics for the imaginations of authors of fiction.” (*Guglielmi v Spelling-Goldberg Productions*, 25 Cal 3d 860, 869, 603 P2d 454, 460 [1979] (Bird, C.J., concurring) (concurrence endorsed by four of seven Justices).)

Thus, for instance, the creators of *Seinfeld* often introduced storylines where the main characters interacted with New York cultural icons to make the show’s New York setting more realistic. The character “George

Steinbrenner” repeatedly appears as George’s boss;¹ in one episode, Steinbrenner asks George to go to Cuba to recruit some of the country’s best baseball players.² In other episodes, “John F. Kennedy, Jr.” meets Elaine at a fitness club and almost goes on a date with her,³ and “Calvin Klein” asks Kramer to model underwear for him.⁴ Similarly, the Tony-Award-winning musical *Avenue Q* includes Gary Coleman, the 1980s child actor, as a character.⁵ (All these characters were played by actors, not by themselves.)

Likewise, Aldous Huxley used Henry Ford’s name as a deity-like reference in his 1931 novel *Brave New World*. The fictional society in that book reveres Ford as its creator: They celebrate Ford’s Day and use his

¹ See *Seinfeld: The Opposite* [NBC May 19, 1994]; *Seinfeld: The Secretary* [NBC Dec. 8, 1994]; *Seinfeld: The Jimmy* [NBC Mar. 16, 1995]; *Seinfeld: The Wink* [NBC Oct. 12, 1995]; *Seinfeld: The Hot Tub* [NBC Oct. 19, 1995]; *Seinfeld: The Caddy* [NBC Jan. 25, 1996]; *Seinfeld: The Calzone* [NBC Apr. 25, 1996]; *Seinfeld: The Bottle Deposit* [NBC May 2, 1996]; *Seinfeld: The Nap* [NBC Apr. 10, 1997]; *Seinfeld: The Millennium* [NBC May 1, 1997]; *Seinfeld: The Muffin Tops* [NBC May 8, 1997]; *Seinfeld: The Finale* [NBC May 14, 1998].

² *Seinfeld: The Race* [NBC Dec. 15, 1994].

³ *Seinfeld: The Contest* [NBC Nov. 18, 1992].

⁴ *Seinfeld: The Pick* [NBC Dec. 16, 1992].

⁵ Robert Lopez & Jeff Marx, *Avenue Q* [2002].

name in swearing (e.g., “Oh, for Ford’s sake!”).⁶ When the book was published, Ford was a celebrity famous for revolutionizing mass production; in the late 1920s, he even tried to build his own utopian city, Fordlândia.⁷ By invoking Ford’s name, Huxley instantly conveyed to his readers the principles underlying his fictional world—efficiency, mass production, and consumerism.

Similarly, in one scene in *Forrest Gump* (Paramount Pictures 1994), Elvis Presley watches as Forrest begins dancing unusually because of his leg braces, and this ends up being the inspiration for Presley’s signature gyrating dance moves. In other scenes, Forrest gets the Medal of Honor from Lyndon B. Johnson, and meets Richard Nixon and uncovers the Watergate scandal.⁸

⁶ Aldous Huxley, *Brave New World* 53, 60 [1931].

⁷ Simon Romero, *Deep in Brazil’s Amazon, Exploring the Ruins of Ford’s Fantasyland*, *NY Times* [Feb. 27, 2017].

⁸ Though New York does not recognize a post-mortem right of privacy, many other states do. *See e.g.* Cal Civ Code § 3344.1 (right lasts for 70 years after death); Fla Stat Ann § 540.08 (right lasts for 40 years after death); 42 Pa Cons Stat Ann § 8316 (right lasts for 30 years after death). In 2015, the New York state legislature considered amending the privacy statute to recognize a posthumous right lasting for 70 years after death (*see* 2015 NY Assembly Bill A07904). The *Forrest Gump* characters mentioned in the text would have been covered by life plus 70 years.

In *Midnight in Paris* (Sony Pictures Classics 2011), the hero is an aspiring novelist who is transported to 1920s Paris, where he meets Zelda Fitzgerald, Ernest Hemingway, Pablo Picasso, and Salvador Dalí. These characters make the setting more realistic, and also advance the plot as they offer the hero advice and help him finish his novel.⁹

The creators of the HBO show *Silicon Valley* similarly based a quirky character on Silicon Valley mogul Peter Thiel, co-founder of Paypal. Both the character and Thiel started fellowships to support young geniuses to leave school and start businesses; both built islands; and both are said to have similar speech patterns and personalities.¹⁰ The show also often mentions Mark Zuckerberg and other tech industry leaders to bring the culture of the modern computer business to life.¹¹

It is possible that the creators of some of these works could have gotten licenses from the people to whom they were referring—or, what could be more difficult, from those people's scattered heirs. But they should not

⁹ These characters would have been covered by a life-plus-70 years right of publicity.

¹⁰ Andrew Marantz, *How Silicon Valley Nails Silicon Valley*, *New Yorker*, June 9, 2016.

¹¹ Sarah Hughes, *Silicon Valley: The Whip-Smart Satire That's Mark Zuckerberg's Favourite Show*, *Guardian (UK)*, Apr. 29, 2016.

have to, and do not have to, get such permission (which in any event may be unavailable if the portrayal is not entirely flattering, or if the work is likely to prove controversial). Unauthorized biographies are as constitutionally protected as the authorized ones; likewise for unauthorized references to celebrities within broader works.

This case appears to involve the same literary trope as in the works discussed above: A video game set in contemporary Los Angeles may include characters based on actual celebrities—Karen Gravano, a mob boss’s daughter turned reality television star, and Lindsay Lohan, a child actress whom many grew up with—to realistically evoke Los Angeles celebrity culture. These artistic choices shape the message that creators are trying to convey, and broadly construing the right of privacy would unduly limit First Amendment expression.

As courts have repeatedly recognized, the First Amendment must protect the right of creators to incorporate celebrity images in their creative works—and thus must protect Take-Two’s right to create a vivid, realistic portrayal of Los Angeles celebrity culture:

- “Because celebrities are an important part of our public vocabulary,” “[r]estricting the use of celebrity identities restricts the communication of ideas” (*Cardtoons, L.C. v Major League Baseball Players Assn*, 95 F3d 959, 972 [10th Cir 1996] (upholding the right to use celebrity baseball player images in parody trading cards)).
- Celebrities “are widely used—far more than are institutionally anchored elites—to symbolize individual aspirations, group identities, and cultural values. Their images are thus important expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our cultural business and everyday conversation.” (*ETW Corp. v Jireh Pub., Inc.*, 332 F3d 915, 935 [6th Cir 2003] (upholding the right to use Tiger Woods’ image in prints).¹²)
- “Because celebrities take on public meaning, the appropriation of their likenesses may have important uses in uninhibited debate on public issues, particularly debates about culture and values. And

¹² Here, the court was indirectly quoting Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 Cal L Rev 125, 128 [1993] (italics, quotation marks, and footnotes omitted).

because celebrities take on personal meanings to many individuals in the society, the creative appropriation of celebrity images can be an important avenue of individual expression.” (*Comedy III Productions, Inc. v Gary Saderup, Inc.*, 25 Cal 4th 387, 397, 21 P3d 797, 803 [2001].)

The right of publicity thus “has the potential of censoring significant expression by suppressing alternative versions of celebrity images that are iconoclastic, irreverent, or otherwise attempt to redefine the celebrity’s meaning” (*id.*). And this Court should avoid this consequence by narrowly construing the right of privacy statute in a way that leaves creators free to build characters based on celebrities.

II. Video Games Are as Protected by the First Amendment as Are Other Expressive Works

Video games are fully protected by the First Amendment the same way that other expressive forms are. (*Brown v Entertainment Merchants Assn*, 564 US 786, 790 [2011].) Video games convey messages, including moral and political messages. *See e.g.* We Are Chicago, <http://wearechicago.com/> (a game about growing up amid gang violence in the South side of Chicago); Abigail Tucker, *The Art of Video Games*, Smithsonian, March 2012, <http://www.smithsonianmag.com/arts-culture/the-art-of->

video-games-101131359/ (discussing how video games can inspire players “to feel guilt or joy or moral ambiguity”). And, like creators of other art forms, video game creators build worlds for their viewers that often imitate real life and include real characters. For example, *Call of Duty: Black Ops II*, a popular first-person shooting video game, features Manuel Noriega, a former military dictator of Panama, as an avatar to heighten the realism of the game’s war on drugs setting (*Noriega v Activision/Blizzard, Inc.*, 42 Med L Rptr 2740, 2014 BL 309779 [Cal Super Ct Oct. 27, 2014, No. 551747] [Bloomberg Law] (holding that such a use was constitutionally protected against a right of publicity claim)).

Like the zombie and medieval video games mentioned in *American Amusement Machine Assn v Kendrick* (244 F3d 572, 577-78 [7th Cir 2001]), *Grand Theft Auto V* is a series of stories involving “age-old themes of literature,” including “self-defense, protection of others,” and crime. And, like *Forrest Gump*, *Seinfeld*, and *Midnight in Paris*, Take-Two wants to make those stories vivid and realistic by incorporating real characters that exemplify the society in which it is set.

As Gravano acknowledges, “Defendants represent that the essence of [Grand Theft Auto V] is to place players in a virtual world as close to

reality as possible The use of [her] portrait and likeness furthers Defendants['] creation of a virtual reality intended to ‘model Los Angeles, California.’” (Brief for Plaintiff-Appellant Gravano at 16-17 (citation omitted).) Gravano also seems to accept Take-Two’s view that “the game embodies popular culture” (*id.* at 17).

Celebrities like Gravano and Lohan are significant parts of that “popular culture,” and Take-Two must be free to use even their literal names and likenesses (as was done in *Forrest Gump*, for example) to capture the essence of that culture; and it is even clearer that Take-Two must be free to use characters that some may view as based on those celebrities. Thus, for instance, in the optional Grand Theft Auto V mission involving “Lacey Jonas”—the character allegedly based on Lohan—players of the game are tasked with helping Jonas escape the paparazzi and return home (Record for Plaintiff-Appellant Lohan at 22). As a famous actress, Lohan likely has to regularly evade the paparazzi, so this story line helps create a more vivid and realistic story. That would be constitutionally protected for a film set in Los Angeles; it should be equally so for a video game set in Los Angeles.

III. The Right of Privacy in New York Is Generally Limited to Commercial Advertising

The right of privacy in New York has always been limited, and the Legislature has long understood the need to keep it so, in part to avoid First Amendment problems. Section 51 applies only to “advertising” or “trade,” limitations “drafted with the First Amendment in mind” (*Foster v Svenson*, 128 AD3d 150, 156 [1st Dept 2015]). Because “[t]he protection of the right of free expression is so important” (*Frosch v Grosset & Dunlap, Inc.*, 75 AD2d 768, 769 [1st Dept 1980]), New York courts have underscored that § 51 “is to be narrowly construed” (*Messenger ex rel. Messenger v Gruner + Jahr Print. & Pub.*, 94 NY2d 436, 441 [2000]).

Before § 51 of the New York Civil Rights Law was enacted, no right of privacy existed in New York (*see Freihofer v Hearst Corp.*, 65 NY2d 135, 140 [1985]). This Court declined to recognize a common law right of privacy in *Roberson v Rochester Folding Box Co.* (171 NY 538, 555 [1902]), a case in which the defendant flour company printed 25,000 copies of the plaintiff’s photograph and used them in flour advertisements without the plaintiff’s consent. The Court reasoned that, because a right to privacy would potentially be so broad, adjudicating these cases would require courts to draw “arbitrary distinctions which no court should promulgate

as a part of general jurisprudence” (*id.* at 555). It also noted that a law providing “that no one should be permitted for his own selfish purpose to use the picture or the name of another for *advertising purposes* without his consent” would be permissible (*id.* at 545) (emphasis added).

After *Roberson*, the Legislature passed §§ 50 and 51, which “were drafted narrowly to encompass only the commercial use of an individual’s name or likeness and no more” (*Arrington v New York Times Co.*, 55 NY2d 433, 439 [1982]). “[T]he Legislature confined its measured departure from existing case law to circumstances akin to those presented in *Roberson*” (*id.*). The defendants’ use of the plaintiff’s likeness for flour advertisements in *Roberson* is a classic example of commercial advertising. “In no other respect did [the Legislature] undertake to roll back the court-pronounced refusal to countenance an action for invasion of privacy” (*id.*). “Since the right of privacy in this State is statutory it is more restricted than that right in states where it is recognized without legislation” (*Wojtowicz v Delacorte Press*, 58 AD2d 45, 47 [1st Dept 1977], *affd* 43 NY2d 858 [1978]).¹³

¹³ Furthermore, “plaintiff[s] cannot claim an independent common-law right of publicity,” because the right of publicity “is encompassed under the Civil Rights Law as an aspect of the right of privacy, which . . . is

In particular, New York courts have interpreted the statute as generally applying to commercial advertising, and not extending to creative works that are fully protected by the First Amendment, such as books and movies. “[W]orks of fiction and satire do not fall within the narrow scope of the statutory phrases ‘advertising’ and ‘trade’” (*Hampton v Guare*, 195 AD2d 366, 366 [1st Dept 1993]; see also *Costanza v Seinfeld*, 279 AD2d 255, 255 [1st Dept 2001]).

For example, in *Hicks v Casablanca Records* (464 F Supp 426, 428 [SDNY 1986]), the plaintiffs sought to enjoin the distribution of a movie and book that featured Agatha Christie as the main character. “Agatha,” the title of both works, offered a fictionalized account of an incident from Christie’s life (*id.* at 429). Without Agatha Christie, the defendants would not have had a book to write or a movie to produce. Nonetheless, the district court granted the defendants’ motions to dismiss, thus allowing the defendants to profit off of Christie’s name and life story (*id.* at 433).¹⁴

exclusively statutory in this State” (*Stephano v News Group Pubs.*, 64 NY2d 174, 183 [1984]).

¹⁴ To be sure, items that present “deliberate falsifications of events represented to be true” are covered under the statute (*Hicks*, 464 F Supp at 431), but there is no such misrepresentation here. Players know that the world of Grand Theft Auto V is fiction.

As *Hicks* demonstrates, having characters based on real people and using their actual names and likeness in a creative work is not prohibited by the statute, even when those people are much more central to the work than they are in this case. The Appellate Division thus rightly held that Grand Theft Auto V, a video game, “does not fall under the statutory definitions of ‘advertising’ or ‘trade’” (*Gravano v Take-Two Interactive Software, Inc.*, 142 AD3d 776, 777 [1st Dept 2016]).

Gravano concedes that Grand Theft Auto V fits the description of an expressive work: “All games contain artistic elements. It goes without saying that there is art in the graphics, design, functions, and ability of a player to engage in the virtual world.” (Brief for Plaintiff-Appellant Gravano at 16.) Nonetheless, Gravano claims that “a video game that is primarily a commercial product [is] not afforded absolute protection as a creative work” (*id.* at 18).

But “the degree of First Amendment protection” to which speech is entitled “is not diminished merely because the . . . speech is sold rather than given away” (*City of Lakewood v Plain Dealer Publ’g Co.*, 486 US 750, 756 n 5 [1988]). “That books, newspapers, and magazines are pub-

lished and sold for profit does not prevent them from being a form of expression whose liberty is safeguarded by the First Amendment” (*Time, Inc. v Hill*, 385 US 374, 397 [1967] (internal quotation marks and citation omitted)).

And this is as true in § 51 cases as in others. “[T]hat the defendant may have included [a photo] in its column solely or primarily to increase the circulation of its magazine and therefore its profits . . . does not mean that the defendant has used the plaintiff’s picture for trade purposes within the meaning of the statute” (*Stephano*, 64 NY2d at 184-85). “Part of the protection of free speech under the United States and New York State Constitutions is the right to disseminate the ‘speech,’ and that includes selling it” (*Simeonov v Tiegs*, 159 Misc 2d 54, 59 [NY City Civ Ct 1993] (holding that plaintiff artist could create ten bronze busts of a well-known model, without her consent, to sell for \$20,000 each)). Section 51 covers commercial advertising, and protected creative works—even with a profit motive—are not commercial advertising.

Finally, though § 51 generally does not extend beyond advertising, one form of advertising is not covered by § 51: advertising for a protected First

Amendment use, such as books, movies, and video games (*Hoepker v Kruger*, 200 F Supp 2d 340, 350 [SDNY 2002]; *see also Altbach v Kulon*, 302 AD2d 655, 658 [3rd Dept 2003] (use of plaintiff’s photograph on a flyer to advertise an artist’s gallery was “ancillary to . . . protected . . . expression because it . . . illustrates the content of [a] painting exhibited at the gallery” (citations and internal quotation marks omitted)). The billboards and video game packaging depicting an image of a woman in a bikini, allegedly based on Lohan, are permitted by the statute, because the “use of the character in advertising was . . . ancillary to the permitted use” in the video game (*Costanza*, 279 AD2d at 255 [1st Dept 2001]; *Velez v VV Publishing Corp.*, 135 AD2d 47, 49 [1st Dept 1988] (a “publisher’s incidental use of . . . portions of past editions of its own publications in promotional materials or advertisements is a necessary and logical extension of the clearly protected editorial use of the content of the publication”); *Koussevitzky v Allen, Towne & Heath, Inc.*, 188 Misc 479, 68 NYS2d 779 [1947] (advertising of a publication “has been held to be incidental to the publication itself” under §§ 50 and 51), *aff’d*, 272 AD 759, 69 NYS2d 432 [1st Dept 1947]).

IV. Only Explicit Use of a Person’s Name or Likeness Is Covered by the Privacy Statute

There is an independent reason why Take-Two should win this case: “Merely suggesting certain characteristics of the plaintiff, without literally using his or her name, portrait, or picture, is not actionable under the [New York privacy] statute” (*Allen v National Video, Inc.*, 610 F Supp 612, 621 [SDNY 1985], citing *Wojtowicz v Delacorte Press*, 43 NY2d 858 [1978])).

“[Section 51] was not intended to give a living person a cause of action . . . based on the mere portrayal of acts and events concerning a person designated fictitiously in a novel or play merely because the actual experiences of the living person had been similar to the acts and events so narrated. To so construe the statute would broaden its scope far beyond anything warranted by the meaning that would ordinarily be ascribed to the words ‘name, portrait or picture,’ especially when they are considered in the light of the history of the statute.” (*Toscani v Hersey*, 271 AD 445, 448 [1st Dept 1946].)

“New York courts have consistently dismissed § 51 claims based on the use of a fictitious name, even if the depiction at issue evokes some characteristics of the person or the person is identifiable by reference to external sources” (*Greene v Paramount Pictures Corp.*, 138 F Supp 3d 226, 233 [EDNY 2015]).

Lohan and Gravano claim that the characters “Lacey Jonas” and “Antonia Bottino,” respectively, are based on them (Record for Plaintiff-Appellant Gravano at 17; Record for Plaintiff-Appellant Lohan at 12), but Take-Two has not “literally” used either of their names, portraits, pictures, or voices. “[T]his fact renders any possible claim for invasion of privacy under § 51 fatally defective. It is the plaintiffs who have identified themselves to the public, not the defendants.” (*Wojtowicz*, 58 AD2d at 48 (internal quotation marks and citation omitted).) This limit on the right of publicity further implements First Amendment values by avoiding the chilling effect that could stem from unlimited protection for “identity.”

V. This Court Should Continue to Narrowly Construe the Right of Privacy Statute to Avoid First Amendment Problems

The narrow New York approach to the right of publicity has proven to be wise. Jurisdictions that have interpreted the right of publicity more broadly have developed subjective and unpredictable tests, often resulting in inconsistent, unsound, and likely unconstitutional conclusions, and leading to improper favoritism for what judges view as “high art” and discrimination against “low art.” “[W]here an otherwise acceptable construction of a statute would raise serious constitutional problems, [a]

[c]ourt will construe the statute to avoid such problems unless such construction is plainly contrary to the intent of [the legislature]” (*Edward J. DeBartolo Corp. v Florida Gulf Coast Bldg. & Const. Trades Council*, 485 US 568, 575 [1988]). This Court should continue to narrowly construe the privacy statute to avoid these problems.

A. Courts That Have Not Limited the Right of Publicity to Commercial Advertising Have Reached Widely Varying Results on Virtually Identical Facts

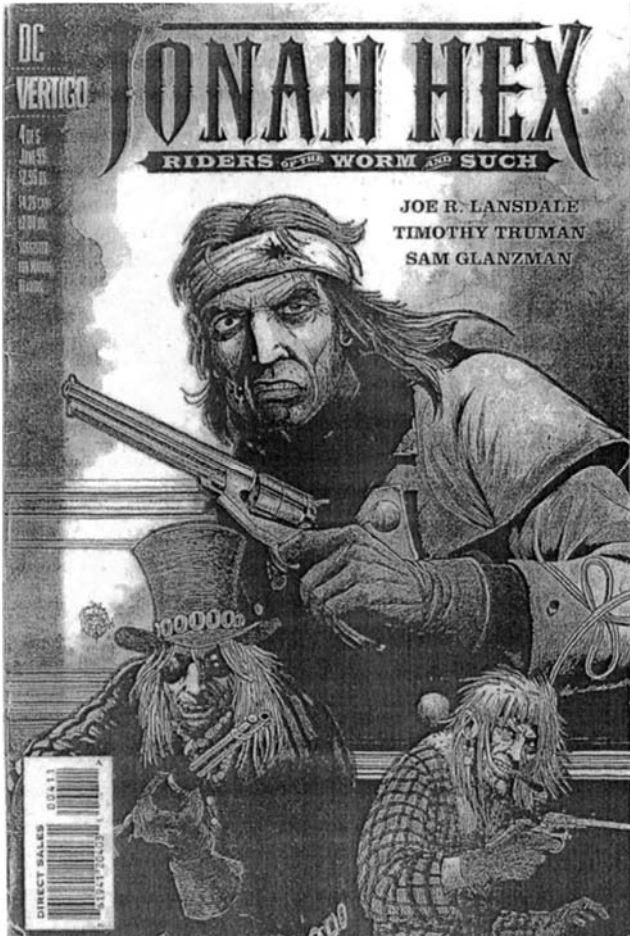
Courts that have not limited the right of publicity to commercial advertising have adopted different tests that yield opposite conclusions on nearly identical facts, and thus leave authors and lower courts uncertain about what may be freely created.

For example, are comic book writers free to create fictional characters based on real people? Yes, said the California Supreme Court (*Winter v DC Comics*, 30 Cal 4th 881, 886, 69 P3d 473, 476 [2003]). No, said the Missouri Supreme Court, resulting in a \$15 million verdict against the author, which drove him into bankruptcy (*Doe v TCI Cablevision, Inc.*, 110 SW3d 363, 374 [Mo 2003]; *Doe v McFarlane*, 207 SW3d 52, 56 [Mo Ct App 2006]; AP, *Jury Award Pushes Comic Book Company into Bankruptcy*, USA Today, Dec. 18, 2004).

In *Winter*, musicians Johnny and Edgar Winter alleged that DC Comics appropriated their names and distinctive albino features in creating the half-worm, half-human characters “Johnny and Edgar Autumn” (*Winter*, 30 Cal 4th at 886, 69 P3d at 476). Because the comic “depict[ed] fanciful, creative characters,” the California Supreme Court unanimously held that the comic was protected by the First Amendment from a right of publicity claim (*id.* at 892, 69 P3d at 480.).

Cover of comic book in *Winter* (30 Cal 4th at 892, 69 P3d at 480)

Johnny & Edgar Winter, <https://jubal666.tumblr.com/image/102798889249> (accessed Dec. 18, 2017)



But when a comic book writer named a character Tony Twist—after a prominent hockey player—the Missouri Supreme Court held that the comic book was not protected from a right of publicity claim (*TCI Cablevision, Inc.*, 110 SW3d at 374). The character Tony Twist was a Mafia don who shared no traits with the real hockey player Tony Twist besides his “tough-guy persona” (*id.* at 366). But the Missouri court concluded that

“the metaphorical reference to Twist, though a literary device, has very little literary value compared to its commercial value,” and therefore held that “free speech must give way to the right of publicity” (*id.* at 374).

Tony Twist the comic book character, https://static.comicvine.com/uploads/original/6/67602/2213923-tony_twist.jpg (accessed Dec. 18, 2017)



Tony Twist the hockey player, <http://www.hockeydb.com/ihdb/stats/pdisplay.php?pid=5509> (accessed Dec. 18, 2017)



Likewise, are sports-based computer games free to use real player information? Yes, said the Eighth Circuit, as to the use of players’ names and statistics in an online fantasy sports game, because the information was “readily available in the public domain” (*C.B.C. Distribution &*

Mktg., Inc. v Major League Baseball Advanced Media, L.P., 505 F3d 818, 823 [8th Cir 2007]). No, said the Third and Ninth Circuits as to the use of players' numbers and general body types, without using names or literal likeness, in a football video game (*Hart v Electronic Arts, Inc.*, 717 F3d 141, 170 [3d Cir 2013]; *In re NCAA Student-Athlete Name & Likeness Licensing Litigation* [*Keller v Electronic Arts, Inc.*], 724 F3d 1268, 1284 [9th Cir 2013]; *Davis v Electronic Arts, Inc.*, 775 F3d 1172, 1178 [9th Cir 2015]).

Are people free to distribute pictures that include celebrities? No, said the Ninth Circuit, as to this Hallmark greeting card depicting Paris Hilton, with a play on her well-known catchphrase, "That's hot":



(*Hilton v Hallmark Cards*, 599 F3d 894, 899, 911 [9th Cir 2010]; *Paris Hilton Sues Over Hallmark Card*, The Smoking Gun, <http://www.thesmokinggun.com/file/paris-hilton-sues-over-hallmark-card> (accessed Dec. 18, 2017).) Yet the Sixth Circuit held (in a 2-1 decision) that a painting depicting Tiger Woods, along with background pictures of other golfers, was protected against Woods' right of publicity claim (*ETW Corp. v Jireh Publishing, Inc.*, 332 F3d 915, 938 [6th Cir 2003]):



(*Tiger Woods Master of Augusta*, Ripley Auctions, <http://www.antique-helper.com/auctionimages/38085t.jpg> (accessed Dec. 18, 2017).) And this was so even though Woods was depicted doing exactly what he did as a celebrity—a factor that the Third and Ninth Circuits concluded cut in favor of liability in the video game cases. *Hart*, 717 F3d at 166; *Keller*, 724 F3d at 1276.

As these inconsistent results show, once courts extend the right of publicity beyond commercial advertising, reconciling the right of publicity with the First Amendment becomes a difficult and unpredictable process. Because of that, speakers become unable to tell whether their references

to real people will be legal or will drive them into bankruptcy—a result that risks a serious chilling effect on speech.

New York law, on the other hand, easily resolves these issues, by simply concluding that “the use of an individual’s name—even without his consent—is not prohibited by the New York Civil Rights Law if that use is part of a work of art,” *Lohan v Perez*, 924 F Supp 2d 447, 454 [EDNY 2013], with “work of art” defined broadly to include “expression and communication” that “is protected under the First Amendment” (in that case, music) (*id.* (citation and internal quotation marks omitted)). If a musician, in that case noted rapper Pitbull, wants to sing “So, I’m tip-toein’, to keep flowin’/ I got it locked up like Lindsay Lohan” (*id.* at 451), he is free to do so. Likewise, Paul Simon and Art Garfunkel can sing, “Where have you gone, Joe DiMaggio / Our nation turns its lonely eyes to you,”¹⁵ and the rest of us have the same right. This case offers this Court the opportunity to avoid the uncertainty created in other jurisdictions, and to instead continue this better New York tradition, which limits the right of privacy statute to commercial advertising.

¹⁵ Paul Simon, *Mrs. Robinson* [Universal Music Pub. Group 1967].

B. The Predominate Purpose Test, Urged by Gravano, Is Unsound

Not only are the right of publicity tests adopted by other courts inconsistent with each other—each is also independently wrong.

Gravano asks this Court to adopt the Missouri Supreme Court’s “predominant purpose” test, under which the right of publicity applies when an author’s motivation is more “commercial” than “expressive” (*TCI Cablevision, Inc.*, 110 SW3d 363, 372-74 [2003]; Brief for Plaintiff-Appellant Gravano at 16-18). But this test is especially unsound.

First, the predominant purpose test requires disentangling motives that often coincide. Many creators aim both to express themselves and make money. Indeed, the premise of the free market system—as well as of copyright law—is that creators often seek to create expression in order to make money (*see e.g. Harper & Row, Pubs., Inc. v Nation Enterps.*, 471 US 539, 558 [1985]). Conversely, creators often seek to make money in order to have the resources to create expression. “How is the finder of fact supposed to distinguish a ‘predominant purpose’ of making an expressive comment from that of making a buck, when the two go hand in hand?”¹⁶

¹⁶ Schuyler M. Moore, *Sex, Lies and Videotape: The First Amendment vs. the Right of Publicity for Expressive Works*, Ent L Rep 4, 6 [Nov. 2003].

Second, because the predominant purpose test requires judges to decide how “expressive” a work is, it leads them to distinguish between “high” art (which presumably is highly expressive) and “low” art. Had *TCI* involved a book or a film instead of a “low art” comic book, it is hard to imagine that the court would have held that naming a character after a real person violated the right of publicity. And the predominant purpose test also requires courts to decide—as *TCI* did—which “literary device[s]” have “very little literary value” (and thus do not count as highly expressive) and which have greater literary value (*TCI Cablevision, Inc.*, 110 SW3d at 374).

Any such distinctions, however, ask judges to improperly act as “discerning art critics” (*Hart*, 717 F3d at 154), and call on them to deny First Amendment protection to works based simply on the judges’ subjective artistic judgments. Yet “[w]hat seems to one to be trash may have for others fleeting or even enduring values” (*Hanegan v Esquire, Inc.*, 327 US 146, 158 [1946]). As New York courts have recognized, “[w]hether [works of fiction] are creations of merit, whether they have value only as entertainment and no value whatever as opinion, information or education, pose questions which would require us to stake out those elusive

lines that we have been warned not to attempt” (*Univ. of Notre Dame Du Lac v Twentieth Century-Fox Film Corp.*, 22 AD2d 452, 458 [1st Dept 1965]).

The “predominant purpose” test thus involves the very sort of “arbitrary distinctions” that this Court warned against when it declined to adopt a common law right of privacy in *Roberson* (171 NY at 555). As the Third Circuit noted, the “predominant purpose” test is “subjective at best, arbitrary at worst” (*Hart*, 717 F3d at 154). And the test, which requires judges “to analyze select elements of a work to determine how much they contribute to the entire work’s expressiveness,” would “suppose that there exists a broad range of seemingly expressive speech that has no First Amendment value”—a “concept . . . almost wholly foreign to free expression” (*id.* at 154 & n 15).

Indeed, Gravano actually invites courts to judge the ideological message of an expressive work: Grand Theft Auto V, she argues, does not deserve First Amendment protection because “[t]he public does not benefit from the information presented through this video game, if anything, it is allowing the public to do immoral things in a virtual landscape” (Brief for Plaintiff-Appellant Gravano at 18). But speech cannot lose its

First Amendment protection because the government views it as promoting “immoral” activity. *Kingsley Int’l Pictures Corp. v Regents of Univ. of State of N.Y.*, 360 US 684, 688-89 [1959] (holding that the law may not restrict speech on the grounds that it “attractively portrays” behavior—in that case, adultery—“which is contrary to the moral standards, the religious precepts, and the legal code of its citizenry”).

C. The Transformative Use Test, Urged by Lohan, Is Unsound

Lohan appears to propose (Brief for Plaintiff-Appellant Lohan at 18, 34) that this Court adopt the “transformative use” test that is used by California courts and the Third and Ninth Circuits. Yet that test is also unsound.

Under the transformative use test, a work is protected from a right of publicity claim if it “transform[s]” the utilized aspect of the person’s identity, for instance by parodying it (*see Davis*, 775 F3d at 1177-78 & n 3; *Keller*, 724 F3d at 1273-79; *Hart*, 717 F3d at 165). Works that merely realistically depict a plaintiff’s identity are actionable.

Thus, in *Keller*, NCAA Football video games were found to violate a football player’s right of publicity (*Keller*, 724 F3d at 1271-72), because they copied the player’s “jersey number” and “height, weight, build, skin

tone, hair color, and home state” (*id.* at 1271). The games consisted of much more than just players’ identities: The creators developed sophisticated strategic options that users could invoke, such as a “Dynasty” mode, where the player acts as the head coach and recruits players from among high school athletes, and a “Campus Legend” mode, where the player controls an avatar from high school through college, making athletic, social, and academic decisions (*id.* at 1272). Yet despite these creative additions, the Ninth Circuit held the game was not transformative, because “users manipulate the characters in the performance of the same activity for which they are known in real life” and the “context in which the activity occurs is similarly realistic” (*id.* at 1276; see also *Davis*, 775 F3d at 1178).

On the other hand, in *Sarver v Chartier*, 813 F3d 891, 905-06 [9th Cir 2016], the Ninth Circuit did not follow its *Keller* analysis. Jeffrey Sarver, an Army bomb disposal expert, sued the creators of *The Hurt Locker* for allegedly basing the main character of the film on him (*id.* at 896). The situation could easily be described the same way the Ninth Circuit described the game in *Keller*: The lead character in *The Hurt Locker* was

depicted as performing the same activity that Sarver performed in real life, and the context in which the activity occurred was similarly realistic.

Yet, faced with a situation where a movie depicted a true story without distorting major details or “transform[ing]” the plaintiff’s identity, the Ninth Circuit balked: *Keller*, the court held, did not apply because Sarver did not “make the investment required to produce a performance of interest to the public . . . or invest time and money to build up economic value in a marketable performance or identity” (*id.* at 905 (citation and internal quotation marks omitted)). But this rationale is inconsistent with the *Keller* test, which focuses on the defendants’ uses being transformative, not on the plaintiffs’ investing in their identities. *Sarver* reached the right result, but only by setting *Keller* aside.

And the transformative use test, like the predominant purpose test, seems to involve either impermissible discrimination in favor of “high” art and against “low,” or subtle artistic criticism of a sort that courts are unlikely to soundly perform. This is visible in the very case that announced the test, *Comedy III*, in which the California Supreme Court held that artist Gary Saderup’s prints and T-shirts containing charcoal

drawings of the Three Stooges were not sufficiently “transformative” (25 Cal 4th at 408, 21 P3d at 810).

Under the court’s logic, other much more famous works—such as Andy Warhol’s prints of Marilyn Monroe, Elizabeth Taylor, and Elvis Presley—might be endangered as well. But the court avoided that, by stating that those particular well-known works were “transformative” and protected by the First Amendment, because they were “a form of ironic social comment on the dehumanization of celebrity itself” (25 Cal 4th at 409, 21 P3d at 811).

Yet unless courts are just to focus on the artist’s prominence (Warhol wins, Saderup loses), how are they to reliably and objectively determine which images are sufficiently ironic or sly so as to be transformative, and which are not? The transformative use test “forces judges to become art critics and evaluate whose message matters”¹⁷—a task that judges should not be performing. The traditional New York approach, which simply focuses on whether a use is advertising or not, is more suitable to the judicial role.

¹⁷ Rebecca Tushnet, *A Mask That Eats into the Face: Images and the Right of Publicity*, 38 Colum JL & Arts 157, 170 [2015].

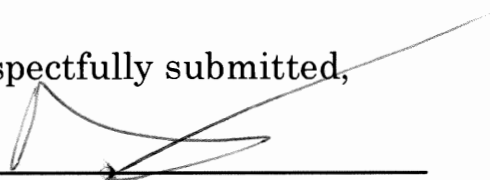
Conclusion

New York has dodged a bullet: By generally concluding that only commercial advertising can infringe the right of publicity, it has avoided First Amendment violations; it has provided clarity to creators and trial judges; and it has avoided putting judges in the role of art critics, or disfavoring “low art” and favoring “high art.” This Court should continue following in this path, and should therefore affirm the decision below.

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