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## Missouri's Interfacing of the First Amendment and Right of Publicity: Is the Predominant Purpose Test Really That Desirable

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# Missouri's Interfacing of the First Amendment and the Right of Publicity: Is the "Predominant Purpose" Test Really That Desirable?

*Doe v. TCI Cablevision*<sup>1</sup>

## I. INTRODUCTION

Many jurisdictions have struggled with the difficult question of how they should interface the interest of a celebrity in his or her right of publicity and the interest society holds in the freedom of artistic expression. The United States Supreme Court has not definitively addressed this issue, and, as a result, the approach to dealing with these types of First Amendment claims varies from jurisdiction to jurisdiction.

This Note examines how the Missouri Supreme Court recently confronted this issue. To appreciate the court's analysis, it is important to understand the interests that the right of publicity seeks to protect and how courts in other jurisdictions have dealt with this First Amendment issue. This Note examines the interests protected by, and the elements of, a right of publicity action and the various approaches articulated for dealing with the First Amendment issue. This Note also examines the potential practical implications of the test the Missouri Supreme Court chose to adopt for dealing with First Amendment questions in a right of publicity context.

## II. FACTS AND HOLDING

In 1992, Todd McFarlane ("McFarlane") created the comic book entitled *Spawn*.<sup>2</sup> McFarlane, "an avowed hockey fan," admitted that he sometimes named his comic book characters after professional hockey players.<sup>3</sup> One such character was Anthony "Tony Twist" Twistelli, a fictional villain named after former N.H.L. "enforcer" Tony Twist ("Twist").<sup>4</sup>

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1. 110 S.W.3d 363 (Mo. 2003) (en banc).

2. *Id.* at 366. The *Spawn* comic book is about a CIA assassin who, after being killed by the Mafia and descending to hell, made a deal with the devil and returned to earth as a new creature, Spawn, where he was "to commit various violent and sexual acts on the devil's behalf." *Id.*

3. *Id.* at 366-67.

4. *Id.* The fictional Tony Twist character is a murderous Mafia don who has also been known to abduct children and have sex with prostitutes. *Id.* at 366. While this fictional character bore no resemblance to Tony Twist, the hockey player, aside from the fact they were both known as "enforcers," McFarlane stated in a 1994 issue

In 1997, Twist first became aware that a character bearing his name existed in the *Spawn* comic book.<sup>5</sup> In October of that year, Twist brought, *inter alia*, a misappropriation of name action against McFarlane and various companies connected to the comic book.<sup>6</sup> Twist argued that McFarlane had benefited through the use of his name and, by associating Twist's name with a villainous character, diminished its endorsement value.<sup>7</sup> As a result, Twist sought damages in the amount that the defendants should have paid him for using his name and for the loss in endorsement value attached to his name.<sup>8</sup>

After the suit was filed, McFarlane and the other defendants filed motions for summary judgment on First Amendment grounds, but these motions were denied.<sup>9</sup> The case proceeded to trial where McFarlane argued that the Tony Twist character was not a misappropriation of Twist's identity.<sup>10</sup> McFarlane also denied that he or the other defendants gained any advantage through the use of Twist's name.<sup>11</sup> Twist countered by presenting evidence that McFarlane directly targeted hockey fans with hockey products bearing the *Spawn* logo and the sponsorship of a "Spawn Night" at a minor league hockey game.<sup>12</sup> The jury ultimately agreed with Twist and returned a \$24.5 million verdict in Twist's favor.<sup>13</sup>

Following the verdict, the circuit court entered a judgment notwithstanding the verdict because Twist had failed to make a submissible case on his misappropriation of name claim.<sup>14</sup> The circuit court said Twist failed to establish the commercial advantage element of his cause of action because no evidence showed that the defendants "intended (1) 'to injure Twist's marketability,' (2) 'to capitalize on the market recognition of the name,' or (3) 'derived any pecuniary benefit whatsoever from the use of that name.'"<sup>15</sup> After

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of *Spawn* and in a 1996 trade magazine article that the fictional character was named after the professional hockey player. *Id.* at 366-67.

5. *Id.* at 367.

6. *Id.*

7. *Id.* A former sports nutrition executive testified that his company revoked a \$100,000 endorsement offer to Twist after they learned he was associated with an evil character in the comic book. *Id.*

8. *Id.* at 368.

9. *Id.* at 367.

10. *Doe v. TCI Cablevision*, No. ED78785, 2002 Mo. App. LEXIS 1577, at \*10 (Mo. Ct. App. July 23, 2002) *aff'd in part & rev'd in part*, 110 S.W.3d 363 (Mo. 2003) (en banc).

11. *Doe*, 110 S.W.3d at 367.

12. *Id.*

13. *Id.* at 367-68.

14. *Id.* at 368.

15. *Id.* at 370.

the Court of Appeals for the Eastern District of Missouri affirmed the circuit court's decision,<sup>16</sup> the Missouri Supreme Court granted transfer.<sup>17</sup>

The high court held that Twist's complaint stated a "right of publicity" action as opposed to a name misappropriation suit.<sup>18</sup> As a result, the court granted Twist a new trial, holding that he made a submissible case on a right of publicity action because there was sufficient evidence to show "(1) [t]hat defendant used plaintiff's name as a symbol of his identity (2) without consent (3) and with the intent to obtain a commercial advantage."<sup>19</sup> The court further held that Twist's claim was not barred by the First Amendment even if McFarlane's work contained some expressive elements because the predominant purpose behind the use of Twist's name and identity was to gain a commercial advantage.<sup>20</sup>

### III. LEGAL BACKGROUND

The "right of publicity" action has its historical underpinnings in the cause of action for misappropriation of name. The general definitions of the two torts are similar in that they both require a misappropriation of another's identity for the purpose of gaining an advantage without obtaining that party's consent.<sup>21</sup> Some jurisdictions have yet to formally distinguish the two.<sup>22</sup>

For those jurisdictions that have drawn a distinction, the difference lies in the type of harm the plaintiff can claim she has suffered.<sup>23</sup> In name misappropriation actions, the harm suffered can be both pecuniary and emotional.<sup>24</sup> In right of publicity actions, the harm suffered must be a commercial loss.<sup>25</sup>

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16. *Doe v. TCI Cablevision*, No. ED78785, 2002 Mo. App. LEXIS 1577, at \*1 (Mo. Ct. App. July 23, 2002) *aff'd in part & rev'd in part*, 110 S.W.3d 363 (Mo. 2003) (en banc).

17. *Doe*, 110 S.W.3d at 365.

18. *Id.* at 368.

19. *Id.* at 369-72.

20. *Id.* at 374.

21. *Compare* RESTATEMENT (SECOND) OF TORTS § 652C (1977) ("One who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of his privacy.") *with* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995) ("One who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability for the relief appropriate under the rules stated in §§ 48 and 49.").

22. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. b.

23. *Id.*

24. *Bear Foot, Inc. v. Chandler*, 965 S.W.2d 386, 389 (Mo. Ct. App. 1998); *Haith v. Model Cities Health Corp. of Kansas City*, 704 S.W.2d 684, 688 (Mo. Ct. App. 1986); *Munden v. Harris*, 134 S.W. 1076, 1079 (Mo. Ct. App. 1911).

25. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. a (stating the rule is "limited to the redress of *commercial injuries*") (emphasis added).

The reason for this distinction can be found in the relationship between the two torts and the different interests they protect.

### *A. Relationship Between Misappropriation of Name and Right of Publicity*

Name misappropriation actions are claims for an invasion of one's privacy.<sup>26</sup> Early formulations of the tort recognized misappropriation of one's identity as an invasion of privacy because:

a man has the right to pass through this world, if he wills, without having his picture published, his business enterprises discussed, his successful experiments written up for the benefit of others, or his eccentricities commented upon either in handbills, circulars, catalogues, periodicals, or newspapers; and, necessarily, that the things which may not be written and published of him must not be spoken of him by his neighbors, whether the comment be favorable or otherwise.<sup>27</sup>

Given this foundation in protecting a privacy interest, it was said that a victim not only suffered loss through another's commercial misappropriation of her identity, but also suffered loss in the form of "enjoyment of life and the exercise of liberty."<sup>28</sup> Thus, courts treated emotional distress as part of the damage suffered by a victim of this name misappropriation.<sup>29</sup>

One might argue, however, that those already in the limelight would not be as quick as others to suffer emotional distress over things such as having their picture published. In line with this premise, the Fifth Circuit, in *O'Brien v. Pabst Sales Co.*,<sup>30</sup> held that a famous football player could not claim he suffered an invasion of his privacy when one of his publicity photos was used in a beer advertisement without his consent because "[he] was an outstanding national football figure and had completely publicized his name and his pictures."<sup>31</sup> The majority carefully pointed out that they were only dealing with a case involving a claim for personal injury associated with a loss of privacy, and not a claim to recover the commercial value for the use of the plaintiff's

26. *Sullivan v. Pulitzer Broad. Co.*, 709 S.W.2d 475, 477 (Mo. 1986) (en banc).

27. *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442, 443 (N.Y. 1902), *superseded by*, N.Y. CIV. RIGHTS LAW § 50 (Consol. 1909).

28. *Munden*, 134 S.W. at 1079.

29. *Bear Foot*, 965 S.W.2d at 389; *Haith*, 704 S.W.2d at 688; *Munden*, 134 S.W. at 1079. See also, RESTATEMENT (SECOND) OF TORTS § 652C cmt. a (1977) ("[P]rotection of his personal feelings against mental distress is an important factor leading to a recognition of the rule . . .").

30. 124 F.2d 167 (5th Cir. 1941).

31. *Id.* at 169-70.

name in the advertisement.<sup>32</sup> However, the dissent remained concerned that the majority's holding would leave all those who have achieved a certain degree of popularity and seek publicity without remedy when advertisers "seize upon such popularity to increase their sales of any lawful article without compensation of any kind for such commercial use of one's name and fame."<sup>33</sup>

The Second Circuit shared the concerns of the *O'Brien* dissenters when it had to deal with a similar situation in *Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>34</sup> It recognized that while celebrities may not suffer a high level of emotional harm when their identities are misappropriated, celebrities nevertheless need some type of protection from such activities. Therefore, the court drew a distinction between those misappropriation actions where a plaintiff sought protection of her privacy interest and those misappropriation actions where a plaintiff sought only to protect her commercial interest in the exclusive use of her identity.<sup>35</sup> That court was the first to formally recognize a distinction between the two actions,<sup>36</sup> deeming the latter claim a "right of publicity."<sup>37</sup> This distinction has since been recognized by courts in other jurisdictions<sup>38</sup> as well as by the Restatement (Third) of Unfair Competition.<sup>39</sup>

Because these two torts are similar, analysis of the name misappropriation tort remains important in establishing the elements of its progeny—the right of publicity.<sup>40</sup> Name misappropriation occurs when the defendant: (i) uses of the plaintiff's identity, (ii) without consent, (iii) to gain some advantage.<sup>41</sup> Therefore, after applying the previously mentioned distinction to the advantage element,<sup>42</sup> a right of publicity action arises when the defendant: (i) uses the plaintiff's identity, (ii) without consent, (iii) to gain a *commercial* advantage.<sup>43</sup>

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32. *Id.* at 170.

33. *Id.* at 171 (Holmes, J., dissenting).

34. 202 F.2d 866 (2d Cir. 1953).

35. *Id.* at 868.

36. Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 478 (2003).

37. *Id.*

38. *Bear Foot, Inc. v. Chandler*, 965 S.W.2d 386, 389 (Mo. Ct. App. 1998).

39. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. b (1995).

40. *See id.*

41. *Nemani v. St. Louis Univ.*, 33 S.W.3d 184, 185 (Mo. 2000) (en banc).

42. *Haelen Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

43. *See e.g., Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 837 (6th Cir. 1983); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 133-34 (Wis. 1979).

## B. Analysis of the Right of Publicity Elements

In applying the three elements of a right of publicity action, courts have taken special care to articulate what "plaintiff's identity" consists of<sup>44</sup> and what constitutes "gaining a commercial advantage."<sup>45</sup>

### 1. Identity

Misappropriation of another's identity has not been limited to cases where the defendant used the plaintiff's actual name or literal image.<sup>46</sup> Rather, courts have held that a person's identity can be appropriated in any number of ways, "such as the use of a name, nickname, voice, picture, performing style, distinctive characteristics or other indicia closely associated with the person."<sup>47</sup> Relevant evidence of the identity element has been said to include things such as "the nature and extent of the identifying characteristics used by the defendant, the defendant's intent, the fame of the plaintiff, evidence of actual identification made by third persons, and surveys or other evidence indicating the perceptions of the audience."<sup>48</sup>

Several cases illustrate the breadth of actions that constitute misappropriating another's identity. The Ninth Circuit held that Vanna White stated a claim in her complaint over an advertisement that depicted a robot standing next to a Wheel of Fortune type gameboard while wearing clothing and jewelry similar to that worn by Vanna on the show.<sup>49</sup> The Ninth Circuit also sustained Bette Midler's claim that Ford appropriated her identity by having a voice similar to hers singing in the background of a television advertisement.<sup>50</sup> The Sixth Circuit held that Johnny Carson stated a claim for misappropriation when a company incorporated his show's catch phrase by naming itself "Here's Johnny Portable Toilets."<sup>51</sup> Football player Elroy "Crazylegs" Hirsch's complaint that S.C. Johnson & Son appropriated his identity by naming one of its products "Crazylegs" was sustained by the Wisconsin Supreme Court.<sup>52</sup>

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44. See e.g., *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398-99 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988); *Carson*, 698 F.2d at 835.

45. See e.g., *Benavidez v. Anheuser Busch, Inc.*, 873 F.2d 102, 104 (5th Cir. 1989); *Henley v. Dillard Dep't Stores*, 46 F. Supp. 2d 587, 594 (N.D. Tex. 1999).

46. See *Carson*, 698 F.2d at 835 ("Carson's identity may be exploited even if his name, John W. Carson, or his picture is not used.").

47. *Henley*, 46 F. Supp. 2d at 591 (quoting *Elvis Presley Enters., Inc. v. Capece*, 950 F. Supp. 783, 801 (S.D. Tex. 1996), *rev'd*, 141 F.3d 188 (5th Cir. 1998)).

48. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. d (1995).

49. *White*, 971 F.2d at 1399.

50. *Midler v. Ford Motor Co.*, 849 F.2d 460, 463-64 (9th Cir. 1988).

51. *Carson*, 698 F.2d at 836.

52. *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 140 (Wis. 1979).

## 2. Commercial Advantage

In addition to establishing that his identity was appropriated, to state a right of publicity cause of action the plaintiff must also show that the misappropriation was done to gain a *commercial advantage*.<sup>53</sup> To satisfy the commercial advantage element, the facts must establish that the misappropriation was done with the actual intent of gaining a commercial advantage.<sup>54</sup> That the defendant may have received incidental benefits as a result of his actions is not enough.<sup>55</sup>

For example, in *Benavidez v. Anheuser Busch, Inc.*,<sup>56</sup> the plaintiff's identity was appropriated without his consent to the defendant's commercial advantage, but the plaintiff was nonetheless denied a cause of action. In *Benavidez*, Anheuser-Busch ("ABI") produced a historical documentary on Hispanic Congressional Medal of Honor recipients.<sup>57</sup> Without first obtaining his consent, ABI included a segment depicting the heroic actions of the plaintiff.<sup>58</sup> The film was made available "to schools, government agencies, veterans organizations, and Hispanic organizations."<sup>59</sup> The film was also shown at ABI hospitality centers where people could sit and watch the film while enjoying free ABI products.<sup>60</sup> The plaintiff argued that he stated a claim because ABI's film was "much more than a mere documentary" insofar as it was shown at hospitality centers along side company logos and free beer.<sup>61</sup> He argued that ABI was attempting to capitalize on his good name and reputation.<sup>62</sup>

The Fifth Circuit disagreed. It reasoned that ABI might have enjoyed increased goodwill in the Hispanic community resulting from the production and showing of the film, but the film was not produced with the intent of boosting sales.<sup>63</sup> Any commercial benefit gained was purely incidental, and, therefore, the plaintiff did not state a claim.<sup>64</sup>

However, aside from this limitation, the showing required to establish intent remains relatively insubstantial. First, it is irrelevant whether the defendant actually realized a commercial advantage through the use of the

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53. See e.g., *Carson*, 698 F.2d at 835; *Hirsch*, 280 N.W.2d at 134.

54. *Wendt v. Host Int'l Inc.*, 125 F.3d 806, 811-12 (9th Cir. 1997).

55. *Benavidez v. Anheuser Busch, Inc.*, 873 F.2d 102, 104 (5th Cir. 1989).

56. 873 F.2d 102 (5th Cir. 1989).

57. *Id.* at 103.

58. *Id.*

59. *Id.*

60. *Id.*

61. *Id.* at 104.

62. *Id.*

63. *Id.*

64. *Id.*



plaintiff's name or likeness.<sup>65</sup> Second, courts have held that to establish intent, the defendant must only have intended to catch the consumer's eye.<sup>66</sup>

One illustrative case, *Abdul-Jabbar v. General Motors Corp.*,<sup>67</sup> involved a claim brought by former basketball star Kareem Abdul-Jabbar ("Abdul-Jabbar") over the use of his former name, Lew Alcindor, in a GMC commercial airing during the 1993 NCAA basketball tournament.<sup>68</sup> The ad did not make it appear that Abdul-Jabbar endorsed any GMC product. Instead, it simply used his name as the answer to a trivia question.<sup>69</sup> The commercial asked the audience, "'Who holds the record for being voted the most outstanding player of this tournament?'"<sup>70</sup> Abdul-Jabbar's former name was then printed on the screen as the correct answer.<sup>71</sup> The answer was followed by a second question, "'Has any car made the "Consumer Digest's Best Buy" list more than once?'"<sup>72</sup> The response to the second question was that a GMC product had.<sup>73</sup> Based on these facts, the Ninth Circuit held that Abdul-Jabbar stated a claim because "[t]o the extent GMC's use of the plaintiff's birth name attracted television viewers' attention, GMC gained a commercial advantage."<sup>74</sup>

Another such case, *Henley v. Dillard Department Stores*,<sup>75</sup> involved an action brought by rock star Don Henley over the use of his name in a Dillard's clothing advertisement for a shirt known as a "henley."<sup>76</sup> In the ad, Dillard's placed a picture of a man wearing the shirt with an arrow pointing to his head and another arrow pointing to the shirt.<sup>77</sup> Beside the arrow pointing to his head were the words "'This is Don.'"<sup>78</sup> Beside the arrow pointing to the shirt were the words "'This is Don's henley.'"<sup>79</sup> Based on this advertisement, the court found the commercial advantage element had been met because the "[d]efendant's sophisticated and experienced ad creators described the benefit

65. *Henley v. Dillard Dep't Stores*, 46 F. Supp. 2d 587, 597 (N.D. Tex. 1999) ("The plaintiff in a right to publicity action is not required to show that the defendant made money off the commercial use of the name or likeness, as Defendant suggests.").

66. *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 415 (9th Cir. 1996); *Henley*, 46 F. Supp. 2d at 597.

67. 85 F.3d 407 (9th Cir. 1996).

68. *Id.* at 409.

69. *Id.*

70. *Id.*

71. *Id.*

72. *Id.*

73. *Id.*

74. *Id.* at 415.

75. 46 F. Supp. 2d 587 (N.D. Tex. 1999).

76. *Id.* at 589.

77. *Id.*

78. *Id.*

79. *Id.*

they received as being able to catch the eye of the consumer and make the ad more interesting.”<sup>80</sup>

### C. First Amendment Protections

Even if the plaintiff is able to establish all of the elements of a right of publicity action, her claim will be barred if the defendant's actions are protected by the First Amendment. Because the United States Supreme Court has not yet adopted a definitive approach,<sup>81</sup> the issue of whether the use of another's identity is protected speech remains in flux. To deal with this problem, courts and legal commentators have articulated several approaches.

#### 1. The Restatement's "Related Use" Test

The Restatement (Third) of Unfair Competition offers a test examining whether the use of another's name or likeness is somehow related to that person.<sup>82</sup> If the use is sufficiently related to that person, the speech is protected.<sup>83</sup> If the use is solely to attract attention to a work not related to or about that person, the speech is unprotected.<sup>84</sup> However, “[t]he fact that the publisher or other user seeks or is successful in obtaining a commercial advantage from an otherwise permitted use of another's identity does not render the appropriation actionable.”<sup>85</sup> Examples of this type of speech are the use of a person's name or identity in a news broadcast, book, movie, or play about that person.<sup>86</sup> The Restatement offers the following illustration of a situation where a plaintiff's right of publicity action would be defeated by the First Amendment because the use is related to or about the complaining party:

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80. *Id.* at 597.

81. The only U.S. Supreme Court case to deal with this was *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977), but the Court limited its holding to the facts of that case. *Id.* at 578-79.

82. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (1995).

83. *Id.*

84. *Id.*

85. *Id.* An excellent illustration of the underlying reasoning for this principle can be seen in *Falwell v. Penthouse International, Ltd.*, 521 F. Supp. 1204 (W.D. Va. 1981). Reverend Falwell felt he was entitled to damages because Penthouse published an interview of him against his wishes purely for the purposes of increasing magazine sales. *Id.* at 1206. The court said the mere fact that the interview was published to increase sales does not defeat First Amendment protection. *Id.* at 1209. The court reasoned that “[o]bviously, everything that appears in a magazine is placed with the intention of increasing sales.” *Id.* at 1210. If that alone were sufficient to defeat First Amendment protections, there would be an intrusion “on important constitutional freedoms, which guarantee the uninhibited dissemination of ideas.” *Id.*

86. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c.

A is the subject of an unauthorized biography published by B. The biography is entitled "A" and contains a photograph of A on the dust jacket. The biography contains numerous false statements concerning facts and incidents in A's life. B has not infringed A's right to publicity. Whether B is subject to liability to A for the false statements contained in the biography is determined under the rules governing liability for defamation or invasion of privacy by placing another in a false light.<sup>87</sup>

In contrast, the following situation offers an illustration of a plaintiff who would have a right of publicity cause action because the use of that person's identity is not related to or about her:

A is an actress. B, a pharmaceutical company, publishes without consent an advertisement containing a photograph showing A as she appeared in one of her motion pictures, with simulated dialogue discussing one of B's products. B is subject to liability to A for infringement of A's right of publicity . . . .<sup>88</sup>

## 2. The California "Transformative Use" Test

California courts have used a different test, looking to see whether the use of the complaining party's identity was transformative in that it contained a significant expressive element.<sup>89</sup> When the use contains a significant expressive element, the work receives First Amendment protection.<sup>90</sup>

An application of this test can be seen in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*,<sup>91</sup> a dispute over an unauthorized charcoal drawing of the Three Stooges which had been reproduced in lithographs and on silk screen T-shirts.<sup>92</sup> In dealing with the First Amendment issue raised by the defendant, the California Supreme Court stated that the critical inquiry was "whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness."<sup>93</sup> In other words, in cases where the "celebrity likeness is one of the 'raw materials' from which an original work is synthesized," the

87. *Id.* § 47 cmt. c, illus. 6.

88. *Id.* § 47 cmt. a, illus. 1.

89. *Comedy III Prods., Inc v. Gary Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001).

90. *Id.*

91. 21 P.3d 797 (Cal. 2001).

92. *Id.* at 800-01.

93. *Id.* at 809.

use of the celebrity likeness is protected under the First Amendment.<sup>94</sup> However, when “the depiction or imitation of the celebrity is the very sum and substance of the work in question,” such as a drawing that is nothing more than a literal reproduction of a celebrity’s image, the use would not be protected and a right of publicity action would lie.<sup>95</sup> In close cases, a subsidiary, but non-determinative, inquiry is whether “the marketability and economic value of the challenged work derive[d] primarily from the fame of the celebrity depicted.”<sup>96</sup> The court said that celebrity images such as those created by Andy Warhol may be sufficiently transformative because they “convey[ed] a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself.”<sup>97</sup> However, the court found that the drawings at issue in *Comedy III* were not sufficiently transformative because they were simply “literal, conventional depictions of the Three Stooges so as to exploit their fame.”<sup>98</sup>

*Winter v. DC Comics*<sup>99</sup> illustrates a situation in which the California Supreme Court did find a work to be sufficiently transformative.<sup>100</sup> The plaintiffs, two well-known musicians named Johnny and Edgar Winter, complained that DC Comics had appropriated their names and likenesses by creating two comic book characters named Johnny and Edgar Autumn.<sup>101</sup> Their allegations were:

that the defendants selected the names Johnny and Edgar Autumn to signal readers the Winter brothers were being portrayed; that the Autumn brothers were drawn with long white hair and albino features similar to plaintiffs’; that the Johnny Autumn character was depicted as wearing a tall black top hat similar to the one Johnny Winter often wore; and that the title of volume 4, *Autumns of Our Discontent*, refers to the famous Shakespearian phrase, “the winter of our discontent.”<sup>102</sup>

The court nevertheless held the work to be protected by the First Amendment because there was sufficient expressive content.<sup>103</sup> The court reasoned that “[a]lthough the fictional characters . . . are less-than-subtle evo-

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94. *Id.*

95. *Id.*

96. *Id.* at 810.

97. *Id.* at 811.

98. *Id.* A copy of the picture in question is included in the appendix to the case. *Id.* app. at 811.

99. 69 P.3d 473 (Cal. 2003).

100. *Id.* at 473.

101. *Id.* at 476.

102. *Id.*

103. *Id.* at 479.

cations of Johnny and Edgar Winter . . . [the] plaintiffs [were] merely part of the raw materials from which the comic books [were] synthesized.”<sup>104</sup> Any depictions of the plaintiffs were more along the lines of parody or caricature, and the Autumn brothers were only characters in a larger, quite expressive overall story.<sup>105</sup> That the defendants may have used the plaintiffs’ likenesses and reputations to generate interest and increase comic book sales was irrelevant because the work was sufficiently transformative.<sup>106</sup>

A meaningful distinction can be drawn between these two cases. Because the work of art in *Comedy III* was a literal depiction of the Three Stooges, the artist was essentially just selling Three Stooges pictures to devoted fans.<sup>107</sup> In *Winter*, the fans were not just buying pictures of the Winter brothers.<sup>108</sup> Instead they were buying comic books that “depict[ed] fanciful, creative characters.”<sup>109</sup>

### 3. The “Predominant Purpose” Test

Intellectual property litigator Mark Lee (“Lee”) has recently suggested a different approach to dealing with the First Amendment issue. Lee expresses concern about the premise that products being sold to predominantly exploit the commercial value of another’s identity may be considered by some as protected speech due to the presence of expressive content.<sup>110</sup> Lee argues that the fairest approach to this issue is a balancing test that looks at the predominant purpose behind the use of another’s identity.<sup>111</sup> Under his test, if the *predominant purpose* was to exploit the commercial value of another’s identity, the use should not be protected even though some expressive content exists.<sup>112</sup> If the *predominant purpose* behind the work was expressive commentary, the expressive values under the balancing test should receive greater weight and, in turn, there would be a better argument for First Amendment protection.<sup>113</sup>

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104. *Id.*

105. *Id.* The Court likened the comic books to “the trading cards caricaturing and parodying prominent baseball players that have received First Amendment protection.” *Id.* (citations omitted).

106. *Id.* (“The question is whether the work is transformative, not how it is marketed.”).

107. *Id.*

108. *Id.*

109. *Id.* at 480.

110. Lee, *supra* note 36, at 498-500.

111. *Id.* at 500.

112. *Id.*

113. *Id.*

#### IV. THE INSTANT DECISION

In this action, the Missouri Supreme Court reviewed the circuit court's grant of a judgment notwithstanding the verdict ("JNOV") following a jury trial for a misappropriation of name suit.<sup>114</sup> While the jury found for the plaintiff at the trial level,<sup>115</sup> the court granted the defendants' JNOV motion on the grounds that the plaintiff failed to make a submissible claim on the commercial advantage element of the tort.<sup>116</sup> More specifically, the court held that there was a lack of evidence to establish that the defendants "intended (1) 'to injure Twist's marketability,' (2) 'to capitalize on the market recognition of the name,' or (3) 'derived any pecuniary benefit whatsoever from the use of that name.'"<sup>117</sup>

Twist was not seeking to recover damages for any emotional distress caused by the use of his name in the *Spawn* comic book;<sup>118</sup> the damages he sought were strictly commercial.<sup>119</sup> Therefore, the court held that Twist's action was more appropriately labeled a right of publicity claim, a point both parties conceded in their briefs.<sup>120</sup>

The court quickly pointed out that the elements of a name misappropriation action and a right of publicity action are basically the same.<sup>121</sup> The court found that the only real difference between the two was that in a right of publicity action the plaintiff must prove the misappropriation was made to achieve a *commercial* advantage.<sup>122</sup> Because the elements of the two claims are so similar, the court looked at Missouri name misappropriation cases to articulate what the critical elements in a Missouri right of publicity action should be.<sup>123</sup> In view of these cases and the tort's definition in the Restatement (Third) of Unfair Competition, the court identified three things that a plaintiff must show to state a claim for right of publicity: "(1) [t]hat defendant used plaintiff's name as a symbol of his identity (2) without consent (3) and with the intent to obtain a commercial advantage."<sup>124</sup>

In analyzing the first element, the court disagreed with the defendants' assertion that the mere use of the common name did not constitute a misappropriation of Twist's identity.<sup>125</sup> The court stated that the fact both characters shared the same unusual name and "tough guy [personas] create[d] an

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114. Doe v. TCI Cablevision, 110 S.W.3d 363, 365 (Mo. 2003) (en banc).

115. *Id.*

116. *Id.* at 369.

117. *Id.* at 370.

118. *Id.* at 368.

119. *Id.*

120. *Id.*

121. *Id.*

122. *Id.* at 369.

123. *Id.*

124. *Id.*

125. *Id.* at 370.

unmistakable correlation between Twist the hockey player and Twist the Mafia don that . . . conclusively establishe[d] that [defendants] used his name and identity.”<sup>126</sup> Therefore, the court held that Twist presented sufficient evidence to show “his name [had been] used as a symbol of his identity.”<sup>127</sup>

On the commercial advantage element, the element upon which JNOV was granted,<sup>128</sup> the court found that the trial court had taken into account irrelevant factors in reaching its conclusion.<sup>129</sup> The trial court looked at whether the defendants intended to actually injure Twist and whether the defendants actually gained a commercial advantage by using his name.<sup>130</sup> The supreme court held that a showing of those factors was not required.<sup>131</sup> There was no need to show intent to injure the plaintiff personally, nor was there a need to show that the defendants were actually successful in their venture to gain a commercial advantage.<sup>132</sup> All that was required was a showing by Twist that the defendants intended to obtain a commercial advantage by using his name.<sup>133</sup> This showing could be satisfied by establishing that the defendants’ use of Twist’s name was an attempt to attract consumer attention to their products.<sup>134</sup> The court found that evidence of the defendants’ statements and actions in producing and marketing the comic book reflected at least some intent to convey the idea that Twist was somehow associated with the comic book.<sup>135</sup> Therefore, Twist had established the commercial advantage element of the tort.<sup>136</sup>

Having determined that Twist established a submissible right of publicity claim, the court turned its attention to the First Amendment defense raised by the defendants.<sup>137</sup> The court identified three distinct ways this issue could be analyzed: 1) by examining the relationship between the use of the person’s identity and the person herself (“related use” test), 2) by examining whether the use of the person’s identity was transformative to the point of being expressive (“transformative use” test), or 3) by examining whether the predominant purpose behind the misappropriation was to gain a commercial advantage (“predominant purpose” test).<sup>138</sup> Identifying the strengths and weakness of each method, the court found that the first two afforded too little protection to the interests of the celebrity because they “operate to preclude a

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126. *Id.*

127. *Id.*

128. *Id.* at 369.

129. *Id.* at 371.

130. *Id.* at 370.

131. *Id.* at 371.

132. *Id.*

133. *Id.*

134. *Id.*

135. *Id.*

136. *Id.* at 372.

137. *Id.*

138. *Id.* at 373-74.

cause of action whenever the use of the name and identity is in any way expressive, regardless of its commercial exploitation.”<sup>139</sup> For this reason, the court chose to adopt the “predominant purpose” test, stating that mere presence of expressive content does not automatically entitle a defendant to First Amendment protection.<sup>140</sup> Instead, First Amendment protection should only be available when the predominant purpose of a misappropriation was to make an expressive comment.<sup>141</sup>

Applying the “predominant purpose test” to the present case, the court held that use of Twist’s name in the comic book was not protected speech.<sup>142</sup> The court stated that the use of Twist’s name was “predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity.”<sup>143</sup>

## V. COMMENT

The commercial use of celebrities is a big business, and it seems to be getting even bigger.<sup>144</sup> In 1984, basketball player Michael Jordan signed an endorsement contract with Nike worth \$2.5 million.<sup>145</sup> As substantial as this amount seems, it is relatively modest when compared to the \$90 million endorsement contract eighteen-year-old basketball player LeBron James recently received from the same company.<sup>146</sup> Not all celebrities have the fame necessary to command such a sum, but these figures show that allowing others to use their identities commercially can be a significant source of income. The Missouri Supreme Court recognized that celebrities need legal protection for this valuable interest and granted it in the form of right of publicity suits.

From a fairness standpoint, right of publicity suits, on their face, appear desirable. Smart celebrities work hard to maintain a marketable image,<sup>147</sup> and it would be unjust to allow another person to capitalize on that value without first compensating the party responsible for creating it. Also, because the state of one’s reputation can be such a determinative factor regarding a celeb-

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139. *Id.* at 374.

140. *Id.*

141. *Id.*

142. *Id.*

143. *Id.*

144. See *The Cash Register: Putting a Finger on the Pulse of the Money That Really Matters*, ENT. WKLY., June 6, 2003, at 19.

145. *Id.*

146. *Id.*

147. Dru Sefton, *Best Bet for Celebs: Get Advice Before PR Crisis*, SAN DIEGO UNION-TRIB., Aug. 24, 2003, at E5. See also *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992) (“Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit.”).



rity's potential earning ability,<sup>148</sup> he should not be left to stand idly by while his reputation is being tarnished through an unwitting association with an undesirable product. The potential harm from a damaged reputation may be limited to losing one or two small endorsements, but it could also affect one's entire career. For example, imagine what would happen if a highly controversial organization, such as a racial hate group, were allowed to portray, without consent or recourse, movie-star "A" as an organization spokesperson. Following the certain public backlash, "A" would probably lose many endorsements and probably have trouble getting cast in any future movie roles. It is true that "A" could use his celebrity status to take elaborate steps outside of the legal arena to make it known that he does not hold such beliefs; however, the allegations alone may have done irreparable damage.<sup>149</sup>

In applying the elements of a right of publicity action, there should be some leeway in the standards for determining what constitutes a misappropriation of another's *identity* to gain a *commercial advantage*. In addition to their names or images, many celebrities have other tell-tale signs that make any reference to them easily identifiable. Advertisers can use such tell-tale signs to draw reference to these celebrities without ever using their names or literal images. The following example is illustrative:

Consider a hypothetical advertisement which depicts a mechanical robot with male features, an African-American complexion, and a bald head. The robot is wearing black high top Air Jordan basketball sneakers, and a red basketball uniform with black trim, baggy shorts, and the number 23 (though not revealing "Bulls" or "Jordan" lettering). The ad depicts the robot dunking a basketball one-handed, stiff-armed, legs extended like open scissors, and tongue hanging out. Now envision that this ad is run on television during professional basketball games. Considered individually, the robot's physical attributes, its dress, and its stance tell us little. Taken together, they lead to the only conclusion that any sports viewer who has registered a discernable pulse in the past five years would reach: the ad is about Michael Jordan.<sup>150</sup>

If such actions were not considered a breach of the right of publicity, the tort would offer essentially no protection at all.

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148. See Sefton, *supra* note 147.

149. Take, for instance, the situation O.J. Simpson has faced since he stood trial for murder. Although he was found not guilty, the criminal trial still damaged his reputation to the point that one reputation management professional referred to him as "the walking dead" because of his inability to make money. *Id.*

150. *White*, 971 F.2d at 1399.

However, sitting opposite of the celebrity's valid interest in protecting the commercial value of his identity is society's interest in promoting freedom of artistic expression. The easy cases are those where the use of another's identity is strictly commercial.<sup>151</sup> More difficult are those cases where there is both a commercial and artistic purpose behind the use.<sup>152</sup> Where to draw the line has proven to be a difficult task for the various courts dealing with this issue. The "related use" and "transformative use" tests appear to protect artistic expression more. But the Missouri Supreme Court, through its adoption of the "predominant purpose" test, appears to favor protecting the celebrity.

Through use of the "predominant purpose" test, the court is attempting to achieve what it considers a more appropriate balance by truly getting to the heart of the matter.<sup>153</sup> This attempt is amicable because one can easily imagine the situations where the rationale for a right of publicity action suggests there should be a cause of action, but due to borderline expressive elements the claim is defeated. Twist's claim may have been doomed to fall in this category had the court applied a test other than the "predominant purpose" test. Given the strong factual consistency between Twist's claim and the claim of the Winter brothers in *Winter v. DC Comics*,<sup>154</sup> a California court would likely have barred Twist's complaint. Such a result would seem inequitable in light of the fact that McFarlane apparently only used Twist's name to attract attention to and increase sales of his comic book.<sup>155</sup>

One must wonder, though, whether the test, as articulated by the Missouri Supreme Court, will be so desirable in situations outside the context of this case. Many professional artists create truly expressive works of movie stars, athletes, or political heroes. However, one can also imagine that for many of these artists, the predominant purpose in creating such a work is commercial. They make their living by selling their art, and therefore, the underlying goal is to create a marketable product.

A real-life example of such a situation can be seen in *ETW Corp. v. Jireh Publishing, Inc.*<sup>156</sup> Artist Matt Rush ("Rush") created a painting entitled *The Masters of Augusta* commemorating Tiger Woods' 1997 Masters victory, making Woods the youngest player ever to achieve this feat.<sup>157</sup> The painting depicted Woods in various poses, such as swinging a golf club or lining up a putt.<sup>158</sup> In the background, paintings of other famous golfers of

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151. See, e.g., *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001).

152. See, e.g., *Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003).

153. *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (en banc).

154. 69 P.3d 473 (Cal. 2003)

155. *Doe*, 110 S.W.3d at 374.

156. 332 F.3d 915 (6th Cir. 2003).

157. *Id.* at 918.

158. *Id.*

the past were depicted looking down on Woods from above.<sup>159</sup> Rush made copies of the painting for the purpose of selling limited edition prints.<sup>160</sup>

Rush's work was an expressive comment on a historic event in professional sports.<sup>161</sup> If the predominant purpose behind his work was to profit by selling the limited edition prints, would the Missouri Supreme Court nevertheless view this painting as unprotected speech? The Sixth Circuit, in *ETW Corp.*, realized that a holding to that effect would be unjust. The court reasoned that "[p]ermitting Woods's right of publicity to trump Rush's right of freedom of expression would extinguish Rush's right to profit from his creative enterprise."<sup>162</sup> The Restatement (Third) of Unfair Competition also recognizes this concern,<sup>163</sup> as do the courts of California.<sup>164</sup>

However, the Missouri Supreme Court's test seems to suggest that the painting is not protected speech if Rush created the work with the ultimate goal of realizing a profit. If this is truly how the test operates in situations involving paintings like Rush's *The Masters of Augusta*, one can imagine the test will likely have the effect of chilling a great deal of artistic expression.

## VI. CONCLUSION

One can assume that the goal of the Missouri Supreme Court in adopting the "predominant purpose" test was to promote future acts of artistic expression. Therefore, potential application problems with this test are very foreseeable, especially in cases where professional artists exercise legitimate expression through the use of celebrity images. Mark Lee, the author of the "predominant use" test, even recognized that it would be difficult to apply in many circumstances.<sup>165</sup> How the court will go about accommodating such expressive and artistic speech remains to be seen.

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159. *Id.*

160. *Id.*

161. *Id.* at 938.

162. *Id.*

163. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c (1995).

164. See *Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003).

165. Lee, *supra* note 36, at 501.