

VIRTUAL CLONING: TRANSFORMATION OR IMITATION?

Reforming the Saderup Court's Transformative Use Test for Rights of Publicity

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INTRODUCTION

Tupac Shakur, dead nearly sixteen years, rose up slowly from beneath the stage at the 2012 Coachella Valley Music & Arts Festival in Indio, California to rouse the crowd and perform his songs *2 of Amerikaz Most Wanted* and *Hail Mary* alongside rap artists Snoop Dogg and Dr. Dre.¹ Celine Dion and Elvis Presley belted *If I Can Dream* together in a duet on the hit performance show *American Idol* in 2007,² thirty years after Presley's

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¹ Claire Suddath, *How Tupac Became a Hologram (Is Elvis Next?)*, BUSINESSWEEK (Apr. 16, 2012), <http://www.businessweek.com/articles/2012-04-16/how-tupac-became-a-hologram-plus-is-elvis-next>; *Tupac Hologram Snoop Dogg and Dr. Dre Perform Coachella Live 2012*, YOUTUBE (Apr. 17, 2012), <http://www.youtube.com/watch?v=TGbrFmPBV0Y> [hereinafter *Tupac Live Hologram*].

² *American Idol Elvis & Celine Dion "If I Can Dream,"* YOUTUBE (Jan. 8, 2010), <http://www.youtube.com/watch?v=plHtPG6eMio>.

death.³ In 2011, Mariah Carey performed live across five European countries — Germany, Croatia, Macedonia, Montenegro, and Poland — simultaneously.⁴ Pop artist Beyoncé performed at the Billboard Music awards in 2011; in fact several of her did: Beyoncé performed, at one point, with over forty replicas of herself.⁵ Hologram technology made all of these, and many similar performances, possible and has since transformed the entertainment industry.

The excitement of this new technology has not come without concern, however, and the legal issues it raises are many: right of publicity infringement, copyright infringement, and trademark infringement, to name a few.⁶ Not all celebrities, or their families, are thrilled with the technology. Some estates, like Marilyn Monroe's, have sought to stop digital re-creators from creating holograms of their deceased celebrities under these different legal theories.⁷ Tupac Shakur's mother consented to the use of her son's likeness in the Coachella concert, but even when a license is granted, re-creators may exceed the scope of that license, raising right-of-publicity issues.⁸

One main concern this hologram, or virtual cloning, technology presents is right-of-publicity infringement. Rights of publicity, as creatures of state law, provide a cause of action to celebrities (and sometimes their

³ Molly Ivins, *Elvis Presley Dies; Rock Singer Was 42*, N.Y. TIMES, Aug. 16, 1977, at A1, available at <https://www.nytimes.com/learning/general/onthisday/big/0816.html>.

⁴ *Mariah Carey Hologram Performs Simultaneously in Five Cities for Deutsche Telekom Campaign*, THE DRUM (Nov. 18, 2011, 12:14 PM), <http://www.thedrum.com/news/2011/11/18/mariah-carey-hologram-performs-simultaneously-five-cities-deutsche-telekom-campaign> [hereinafter *Mariah Carey Hologram*].

⁵ *Tupac's Coachella Performance and More Hologram Wins and Fails (VIDEO)*, THE DAILY BEAST (Apr. 8, 2012), <http://www.thedailybeast.com/articles/2012/04/18/tupac-s-coachella-performance-and-more-hologram-wins-fails-video.html>.

⁶ See generally Joseph J. Beard, *Clones, Bones and Twilight Zones: Protecting the Digital Persona of the Quick, the Dead and the Imaginary*, 16 BERKELEY TECH. L.J. 1165 (2001) (describing virtual cloning techniques and dangers).

⁷ Eriq Gardner, *Marilyn Monroe Estate Threatens Legal Action over Hologram (Exclusive)*, HOLLYWOOD REP. (June 11, 2012, 12:40 PM), <http://www.hollywoodreporter.com/thr-esq/marilyn-monroe-estate-hologram-legal-334817> (displaying a cease-and-desist letter from Monroe's estate to Digicon requesting Digicon stop a concert featuring Monroe's hologram).

⁸ See *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 411 (Cal. Ct. App. 2011) (providing an example of a right-of-publicity claim for exceeding the scope of a license to use a likeness).

estates)⁹ when the celebrities' likenesses are used without permission.¹⁰ Where the celebrity is alive and able to consent to the performance, as with Mariah Carey's concert, these issues can easily be resolved through licensing.¹¹ Where a celebrity has not consented and is either alive or was domiciled at death in a state that recognizes postmortem rights of publicity, the celebrity or estate may bring a right-of-publicity infringement claim. A First Amendment defense may still defeat that claim, however, depending on the facts of the case and the jurisdiction.

States have an amalgam of different protections for rights of publicity, and as such, several different First Amendment defense tests have developed across jurisdictions to protect legitimate uses of a celebrity's likeness.¹² California, the hotbed of celebrities and celebrity right-of-publicity claims, has adopted the transformative use test to determine whether the use of a likeness is protected by the First Amendment or whether a celebrity's rights of publicity will prevail. This new virtual cloning technology and its recent right-of-publicity challenges will pose new questions when balancing First Amendment interests under the transformative use test, particularly because California and others who have adopted the test have provided several different iterations of what may constitute a transformative use, and those iterations may lead to conflicting results. As such, courts should abandon these several iterations and instead adopt a single iteration of the transformative use test to better direct courts and parties alike.

This article focuses on the transformative use test applied by California and other United States courts when analyzing the First Amendment defense to right-of-publicity infringement claims in the context of newly developing virtual-cloning technology.¹³ Part I examines this virtual-cloning

⁹ See J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 9:18 (2013) (stating that twenty states have recognized postmortem rights of publicity, six by common law and fourteen by statute).

¹⁰ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (2012).

¹¹ See *Mariah Carey Hologram*, *supra* note 4.

¹² See generally Andreas N. Andrews, Note, *Stop Copying Me: Rethinking Rights of Publicity Verses the First Amendment*, 32 *TEMP. J. SCI. TECH. & ENVTL. L.* 127 (2013).

¹³ This work is intended to extend the discussion from my previous work, which considered the implications of virtual cloning and postmortem right-of-publicity choice-of-law complications that arise under current state right-of-publicity laws. See Shannon Flynn Smith, *If It Looks like Tupac, Walks like Tupac, and Raps like Tupac, It's*

technology and the Tupac Shakur concert. Part II sets out the current state of First Amendment defenses by examining the Supreme Court precedent on the issue and the cases where courts have applied the transformative use test. Part III then applies the transformative use test to the Tupac Shakur virtual clone concert to demonstrate that the different iterations of the transformative use test can lead to conflicting results using the same set of facts. Part IV concludes, based on this analysis using the Tupac virtual clone, that because the current iterations of the transformative use test are unclear and lead to contradictory results, courts should adopt the Mere Celebrity Likeness Test as the single iteration of the transformative use test.

I. VIRTUAL CLONING TECHNOLOGY & THE TUPAC SHAKUR VIRTUAL CLONE CONCERT

The Tupac Shakur virtual clone that performed at the Coachella music festival and other virtual clones like it present a unique question in applying First Amendment defenses to this new technology. At the concert, the Tupac Shakur virtual clone performed the song *Hail Mary* for a live audience, but Tupac had never actually performed this song live during his life; re-creators enabled the virtual clone to sing this song in front of an audience for the very first time.¹⁴ The re-creators' performance enabled the Tupac virtual clone to dance and rap alongside two other rappers, Dr. Dre and Snoop Dogg.¹⁵ The re-creators also added language never before spoken by the living Tupac Shakur: "What the fuck is up, Coachella!"¹⁶ The Coachella music festival in fact did not even exist until three years after Tupac's death.¹⁷ Finally, the re-creators took out the first lines of the

Probably Tupac: Virtual Cloning and Postmortem Right-of-Publicity Implications, 2013 MICH. ST. L. REV. 1719.

¹⁴ Ewan Palmer, *Tupac Shakur Hologram 'Performs' at Coachella 2012 [Video]*, INTERNATIONAL BUSINESS TIMES (Apr. 16, 2012, 11:32 AM), <http://www.ibtimes.co.uk/tupac-shakur-2pac-performs-coachella-hologram-dr-328517>.

¹⁵ *Id.*

¹⁶ Jason Lipshutz, *Opinion: The Problem with the Tupac Hologram*, BILLBOARD (Apr. 16, 2012, 7:25 PM), <http://www.billboard.com/articles/columns/the-juice/494288/opinion-the-problem-with-the-tupac-hologram>.

¹⁷ Suddath, *supra* note 1.

recorded *Hail Mary* song, “Killuminati all through your body, the blow’s like a twelve gauge shotty.”¹⁸

Other than these small changes, the virtual clone was so nearly identical to the deceased Tupac that some fans did not realize that the virtual clone was not the real Tupac. One fan at the concert was quoted as saying, “Wow, it was a hologram? . . . It was ridiculously realistic. Unbelievable.”¹⁹ After all, the clone danced like Tupac; rapped like Tupac; dressed like Tupac, wearing no shirt, baggy pants sagging below the waist, Timberland boots, and even Tupac’s characteristic gold-chain necklace; and donned the same “Thug Life” tattoo across its chest as the deceased Tupac sported.²⁰ As such, the re-creators added their own touches by creating a completely new visual performance — *Hail Mary* — but the idea of the performance was to make the clone resemble the true Tupac to the fullest extent possible.²¹

The Tupac virtual clone, while appearing to be a three-dimensional replica of the artist, was actually a flat optical illusion created by reflecting the image off of an angled piece of glass outside of the view of the audience;²² this distinction, however, would not likely change any First Amendment

¹⁸ Compare *Tupac Live Hologram*, *supra* note 1, with TUPAC SHAKUR, *Hail Mary*, on THE DON KILLUMINATI: THE 7 DAY THEORY (Koch Records 1996).

¹⁹ Jacob E. Osterhout, *It’s Tupac, Live 3-D Hologram Resurrects Rapper for Performance at Festival*, N.Y. DAILY NEWS, Apr. 17, 2012, at 38. Another fan later said, “The hologram was so real that I kept looking over at Snoop to catch his reaction at having his buddy back on stage with him after all of this time . . . He seemed happy.” *Id.*

²⁰ Cyrus Farivar, *Tupac “Hologram” Merely Pretty Cool Optical Illusion*, ARSTECHNICA (Apr. 16, 2012, 9:45 PM), <http://arstechnica.com/science/2012/04/tupac-hologram-merely-pretty-cool-optical-illusion/>; Osterhout, *supra* note 19, at 38.

²¹ Anthony McCartney, *Holograms Present Celebs with New Afterlife Issues*, MPRNEWS (Aug. 21, 2012), <http://minnesota.publicradio.org/display/web/2012/08/21/arts/holograms-present-celebs-with-new-afterlife-issues/> (quoting a Tupac re-creator as saying, “I also hope that the people who do follow us do it with the same care and the same sense of dedication because I would hate to see a bad version of Marilyn Monroe, a bad version of Elvis up there”).

²² Hayley Tsukayama, *How the Tupac ‘Hologram’ Works*, WASH. POST (Apr. 18, 2012), http://www.washingtonpost.com/business/technology/how-the-tupac-hologram-works/2012/04/18/gIQA1ZVyQT_story.html. For a diagram of the technology used to project this hologram, see Reggie Ugwu, *Everything You Ever Wanted to Know About the Tupac Hologram*, COMPLEX (Apr. 18, 2012, 5:53 PM), <http://www.complex.com/tech/2012/04/everything-you-ever-wanted-to-know-about-the-tupac-hologram>.

defense's success.²³ Whether the digital re-creation is used on-screen in a movie or off-screen in a virtual clone concert like Tupac's, two approaches are typically used to create virtual clones: the direct approach and the indirect approach.²⁴ Under one version of the direct approach, called motion capture, the re-creator uses an actor or the artist himself by attaching sensors to the artist and then recording the light refractions in front of a blue or green screen.²⁵ The re-creator can then manipulate this "human blueprint" in a computer program to do anything the re-creator would like.²⁶

Under the indirect approach, the artist is not present. In the indirect-approach method, re-creators use film, photos, and other media of the artist taken during the artist's life and then incorporate the person's image, voice, and even mannerisms from this material to create a completely new digital version of the artist.²⁷ The re-creators of the Tupac virtual clone would not reveal their exact strategy for creating the clone, but as Tupac was not available, some version of the indirect approach was used.²⁸ One method re-creators use in the indirect approach, called photogrammetry, is to feed images of the artist into computer software that establishes a three-dimensional coordinate point of the artist's face in a given photo and then repeats this process to establish all of the points of the face to create the clone.²⁹

Re-creators also use voice techniques to add new language to a performance. Digital voice compilation software allows a re-creator to input the voice of an artist from soundtracks, movies, and other audio recordings

²³ Cf. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 811 (Cal. 2001) (stating that regardless of the skill employed to create the depiction of an artist, the work may still lack transformative elements).

²⁴ Beard, *supra* note 8, at 1172.

²⁵ *Id.* at 1172–73.

²⁶ Joel Anderson, Comment, *What's Wrong with This Picture? Dead or Alive: Protecting Actors in the Age of Virtual Reanimation*, 25 LOY. L.A. ENT. L. REV. 155, 171 (2005) (quoting Kenneth Turan, *A Bumpy, Noisy Ride: Robert Zemeckis' Visually Striking 'Polar Express' Pumps up a Classic Children's Book*, L.A. TIMES, Nov. 10, 2004, at E1).

²⁷ Beard, *supra* note 6, at 1188–89. This method is called photogrammetry. *Id.* at 1188. Other possible indirect-approach methods include creating a bust from a life mask, creating a bust by referencing photos, or scanning a look-alike. *Id.* at 1186.

²⁸ See Suddath, *supra* note 1.

²⁹ Joseph J. Beard, *Casting Call at Forest Lawn: The Digital Resurrection of Deceased Entertainers — A 21st Century Challenge for Intellectual Property Law*, 8 HIGH TECH. L.J. 101, 111–12 (1993).

that can then be broken down into its base components and reconstructed.³⁰ This will then allow the re-creator to make a virtual clone speak new words never spoken in life. Re-creators may also simply use impersonators as an alternative where this voice technology is not available or is too expensive.³¹ This nearly exact replication of a dead individual raises the question of whether the estate would have to consent to this re-creation or whether by creating a completely new product using the indirect approach — the virtual clone — the re-creators would have a successful First Amendment defense to any possible right-of-publicity infringement claim.

II. RIGHTS OF PUBLICITY & THE FIRST AMENDMENT

Rights of privacy predated, and ultimately led to the establishment of, rights of publicity but were not a consideration for the courts until nearly 1900.³² It was not until the 1960s that rights of privacy began to develop as a concept of torts. In a law review article, Dean William Prosser identified four specific causes of action encompassing the rights of privacy: (1) intrusion,³³ (2) disclosure,³⁴ (3) false light,³⁵ and (4) appropriation.³⁶ The fourth tort, invasion of privacy by appropriation, then led to the courts' recognizing a commercial property right in one's likeness — rights of publicity.³⁷ Since this development of rights of publicity, individual states have

³⁰ Beard, *supra* note 6, at 1192.

³¹ Anderson, *supra* note 26, at 172–73.

³² Justice Louis Brandeis and Samuel Warren were two of the earliest scholars and jurists to consider rights of privacy, and they voiced their concerns in an 1890 Harvard Law Review article, *The Right to Privacy*. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 195–96 (1890), available at http://www.californialawreview.org/assets/pdfs/misc/prosser_privacy.pdf.

³³ William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960) (“[i]ntrusion upon plaintiff’s seclusion or seclusion or solitude, or into his private affairs”).

³⁴ *Id.* (“[p]ublic disclosure of embarrassing private facts about the plaintiff”).

³⁵ *Id.* (“[p]ublicity which places the plaintiff in a false light in the public eye”).

³⁶ *Id.* (“[a]ppropriation, for the defendant’s advantage, of the plaintiff’s name or likeness”).

³⁷ See *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (coining the phrase “right of publicity” to describe these property-like rights in one’s own likeness).

addressed this tort in very different ways. Most states, however, require the following prima facie elements for a right-of-publicity infringement action: “(1) defendant, *without permission*, has used some *aspect of identity or persona* in such a way that plaintiff is *identifiable* from the defendant’s use; and (2) defendant’s use is likely to *cause damage to the commercial value* of that persona.”³⁸

Other than these prima facie elements, however, states’ right-of-publicity protections vary greatly. For example, Indiana, the state known for providing the most protection for rights of publicity,³⁹ protects an artist’s “name, voice, signature, photograph, image, likeness, distinctive appearance, gestures, [and] mannerisms” but makes exemptions for literary works, television programs, works of art, and anything that has “political or newsworthy value.”⁴⁰ It further protects these rights for one hundred years after the death of the artist.⁴¹ New York, on the other hand, does not recognize postmortem rights of publicity at all,⁴² and its protection extends only to “the name, portrait or picture of any living person.”⁴³ Therefore, the celebrity may only bring a cause of action for right-of-publicity infringement for the unconsented use of these narrow aspects of a persona, and an estate has no claim after the celebrity’s death.

California, the state examined in this article to determine the legitimacy of a First Amendment defense in the Tupac virtual clone concert,⁴⁴

³⁸ Thomas Phillip Boggess V, *Cause of Action for an Infringement of the Right of Publicity*, in 31 CAUSES OF ACTION § 5 (Clark Kimball & Mark Pickering eds., 2d ed. 2013) (emphasis added) (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (2012)).

³⁹ See 1 MCCARTHY, *supra* note 9, § 6:59.

⁴⁰ IND. CODE § 32-36-1-1 (2013).

⁴¹ *Id.* § 32-36-1-8.

⁴² Without postmortem rights protection, the likeness of the celebrity becomes a part of the public domain upon the celebrity’s death, and anyone may use it. See ‘Rights of Publicity’ Extended Beyond the Grave, NPR (Sept. 4, 2012, 1:00 PM), <http://www.npr.org/2012/09/04/160551338/rights-of-publicity-extended-beyond-the-grave>.

⁴³ N.Y. CIV. RIGHTS LAW §§ 50–51 (McKinney 2013).

⁴⁴ California law would be applicable to this use of Tupac’s likeness had Tupac’s mother not consented to the performance or had the use of the likeness exceeded the scope of the license. See Jana M. Moser, *Tupac Lives! What Hologram Authors Should Know About Intellectual Property Law*, BUS. L. TODAY, Sept. 2012, at 3, available at <http://apps.americanbar.org/buslaw/blt/content/2012/09/all.pdf> (stating that Tupac’s mother, who holds Tupac’s postmortem rights of publicity, granted permission to Dr. Dre to use

provides right-of-publicity protection both statutorily and by common law.⁴⁵ California provides statutory protection for a deceased celebrity's "name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services"⁴⁶ for seventy years following the artist's death.⁴⁷ That same statute also delineates that the following will not be considered a product, article of merchandise, good, or service for application of the statute: "a play, book, magazine, newspaper, musical composition, audiovisual work, radio or television program, single and original work of art, work of political or newsworthy value, or an advertisement . . . for any of these works . . . if it is fictional or nonfictional entertainment, or a dramatic, literary, or musical work."⁴⁸ This legislative remedy is meant to "complement, not supplant"

the likeness in the clone); see, e.g., *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 411 (Cal. Ct. App. 2011) (providing an example of a right-of-publicity claim for exceeding the scope of a license to use a likeness). Under the domicile-at-death rule, the law of the artist's domicile at death governs questions of the availability of postmortem right-of-publicity protections. 2 McCARTHY, *supra* note 9, § 11:15. Therefore, California law, including the transformative use test adopted in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001), would be applicable to any case brought regarding this hologram concert because California was Tupac's domicile at death, Jon Pareles, *Tupac Shakur, 25, Rap Performer Who Personified Violence, Dies*, N.Y. TIMES, Sept. 14, 1996, at 1.

⁴⁵ *Kirby v. Sega of Am., Inc.*, 60 Cal. Rptr. 3d 607, 612 (Cal. Ct. App. 2006).

⁴⁶ CAL. CIV. CODE § 3344.1(a)(1) (West 2013). It is arguable that the Coachella concert used Tupac Shakur's likeness in a service, as the concert was not a tangible good. Further, any copies of the concert that the re-creators sold would arguably fall within this statute as goods using Tupac's likeness. Beard, *supra* note 29, at 159 (asserting that the showing of a film or theatrical exhibition may not fall within the goods category but that the sale of the film on a videocassette would be considered the sale of a good). If the concert did fall within the statute on the first instance, a court would still need to consider whether it falls within a statutory exception.

⁴⁷ § 3344.1(g).

⁴⁸ *Id.* § 3344.1(a)(2). This statutory exception, meant to protect works where an artist's life is depicted, such as books or movies about the artist, may also apply to the Tupac virtual clone. See Beard, *supra* note 29, at 161. A re-creator of the Tupac virtual clone may assert that this concert falls within the "audiovisual work . . . if it is fictional or nonfictional entertainment" category of protection and as such is a statutory exception to any right-of-publicity claim Tupac's rights-holder could bring. *Id.* at 164. This statutory defense is outside the scope of this article, however.

common law rights of publicity, in which the plaintiff must prove that there was unauthorized use of the plaintiff's likeness that results in injury, regardless of whether the purpose is commercial.⁴⁹

A. SUPREME COURT PRECEDENT: *ZACCHINI V. SCRIPPS-HOWARD BROADCASTING CO.*

Due in part to the distinct nature of these state laws,⁵⁰ the United States Supreme Court has only addressed state rights of publicity once.⁵¹ In *Zacchini v. Scripps-Howard Broadcasting Co.*, the Supreme Court heard a case arising from the Ohio statutory right of publicity.⁵² In *Zacchini*, plaintiff Hugo Zacchini brought suit after a local news station rebroadcast Zacchini's fifteen-second human cannonball routine in its entirety.⁵³ Zacchini asserted that this violated his Ohio rights of publicity because the television station rebroadcast the entire act and did not compensate him.⁵⁴ The television station asserted a First Amendment defense, and the Ohio Supreme Court found for the television station in holding that the station was protected by the First Amendment and could broadcast matters of public interest.⁵⁵ The U.S. Supreme Court granted certiorari and considered the issue of whether the First and Fourteenth Amendments could shield the television station from damages arising from a state right-of-publicity infringement claim when the performance had been rebroadcast in its entirety.⁵⁶

In balancing the state interests in compensating publicity rights holders and providing public access to information, the Court found that

⁴⁹ *Kirby*, 60 Cal. Rptr. 3d at 612.

⁵⁰ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 566 (1977) (stating that if the judgment rested on independent state grounds, certiorari should be denied).

⁵¹ MCCARTHY, *supra* note 9, §1:33.

⁵² 433 U.S. at 565.

⁵³ *Id.* at 563–64.

⁵⁴ *Id.* at 564.

⁵⁵ The Ohio Supreme Court, in its syllabus wrote:

“A TV station has a privilege to report in its newscasts matters of legitimate public interest which would otherwise be protected by an individual's right of publicity, unless the actual intent of the TV station was to appropriate the benefit of the publicity for some non-privileged private use, or unless the actual intent was to injure the individual.”

Id. at 566 (quoting 47 Ohio St. 2d 224 (1976)).

⁵⁶ *Id.* at 565.

“[w]herever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer’s entire act without his consent.”⁵⁷ The Court reasoned that broadcasting the act in its entirety threatened the economic value of Zacchini’s performance, which lay in his right to control the publicity of the act.⁵⁸

The Court stated that “unlike the unauthorized use of another’s name for purposes of trade or the incidental use of a name or picture by the press, [this] goes to the heart of petitioner’s ability to earn a living as an entertainer.”⁵⁹ Recognizing that this may be the strongest case for a right-of-publicity claim, the Court decided that this was “not the appropriation of an entertainer’s reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.”⁶⁰ The Court found important that Zacchini was seeking compensation rather than an injunction, and it held that the First Amendment did not require that the press have the right to rebroadcast Zacchini’s performance where Ohio chose to enact right of publicity legislation.⁶¹

B. THE TRANSFORMATIVE USE TEST

Without more guidance on the appropriate balance between rights of publicity and the First Amendment, states have struggled to hone First Amendment tests to determine when there is “a privilege to report matters of legitimate public interest even though such reports might intrude” on other rights, such as rights of publicity.⁶² For example, to weigh these interests, courts have created several different tests. Courts have used a “Predominant Purpose Test” and asked whether the predominant purpose of the use or portrayal is to serve a social function valued by free speech or

⁵⁷ *Id.* at 574–75.

⁵⁸ *Id.* at 575.

⁵⁹ *Id.* at 576.

⁶⁰ *Id.*

⁶¹ *Id.* at 578.

⁶² *Id.* at 567 (internal quotation marks omitted).

to commercially exploit the likeness in the same way the celebrity would.⁶³ The Second Circuit established the *Rogers Test*, which asks whether the challenged work is wholly unrelated to the underlying work and whether the plaintiff's name is used for its advertisement and commercial value.⁶⁴ California has also used a "Public Interest Test" of sorts to ask whether the events are ones of public interest that the public has a right to know and the press has a right to tell.⁶⁵ The California Supreme Court considered these tests and others in *Comedy III Productions, Inc. v. Gary Saderup, Inc.* and instead adopted the transformative use test.⁶⁶

1. *The Origin of the Transformative Use Test: Copyright & Fair Use Analyses*

Taking from established copyright fair use analyses, the California Supreme Court was the first to import the copyright transformative use concept to weigh the First Amendment in right-of-publicity cases in.⁶⁷ Under copyright law, traditional fair use factors include: "(1) the purpose and

⁶³ Andrews, *supra* note 12, at 133; see *Presley's Estate v. Russen*, 513 F. Supp. 1339, 1356 (D.N.J. 1981). The court in this case held that THE BIG EL SHOW could not sustain its First Amendment defense against right-of-publicity infringement claims by the Elvis Presley estate because the predominant purpose behind the imitation show was for the defendant's own economic interest, and it did not have significant social value as a mere imitation without more. *Id.* at 1359.

⁶⁴ See *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989). In this case, the Second Circuit found for the defendant, MGM, who had produced the film "Fred and Ginger," which imitated Fred Astaire and Ginger Rogers's cabaret performances. *Id.* at 1004–05. The court found that the film's title both related to the product, the movie, and was not an advertisement in disguise. *Id.*

⁶⁵ Andrews, *supra* note 12, at 134; see *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790, 793 (1995). In this case, the California Court of Appeal for the Sixth District held that a news story relating to past Superbowls and NFL player Joe Montana was a matter of public interest and protected by the First Amendment. *Id.* at 797.

⁶⁶ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 806–09 (Cal. 2001).

⁶⁷ Matthew D. Bunker, *Free Speech Meets the Publicity Tort: Transformative Use Analysis in Right of Publicity Law*, 13 COMM. L. & POL'Y 301, 305 (2008). A second defense recognized in California is the public interest defense. *Arenas v. Shed Media U.S. Inc.*, 881 F. Supp. 2d 1181, 1190 (C.D. Cal. 2011). Under the public interest defense, "no cause of action will lie for the publication of matters in the public interest, which rests on the right of the public to know and the freedom of the press to tell it." *Id.* at 1191. This defense is beyond the scope of this article, however, because the concert was created by re-creators and would not otherwise be newsworthy, as it would not exist.

character of the use . . . ; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for the copyrighted work.”⁶⁸

In 1994, in *Campbell v. Acuff-Rose Music, Inc.*, the United States Supreme Court endorsed the idea of asking whether a use was transformative in considering the purpose and character of the use prong of the fair use test.⁶⁹ In *Campbell*, the Court considered whether the rap group 2 Live Crew’s song “Pretty Woman” could survive a copyright infringement claim brought by Ray Orbison, who wrote the original song “Oh, Pretty Woman,” by asserting a fair use defense.⁷⁰ To determine whether 2 Live Crew’s song constituted a fair use of Orbison’s song, the United States Supreme Court adopted the transformative use test, stating that it is a proper inquiry in a copyright fair use analysis to ask “whether the new work merely ‘supersede[s] the objects’ of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is ‘transformative.’”⁷¹

The Court further stated that finding transformation was sufficient but not necessary to determine whether a new work could be considered a fair use.⁷² The Court reasoned that the goals of copyright — to “promote the Progress of Science and useful Arts”⁷³ — are furthered when transformative works are created; as such, the transformative use inquiry was appropriate to protect those original works that deserved protection when the second work in question did not add its own expression.⁷⁴ Further

⁶⁸ 17 U.S.C. § 107 (2006).

⁶⁹ 510 U.S. 569, 578 (1994) (“The central purpose of this investigation is to see, in Justice Story’s words, whether the new work merely ‘supersede[s] the objects’ of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is ‘transformative.’” (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841) (internal citations omitted))).

⁷⁰ *Id.* at 571–72.

⁷¹ *Id.* at 579 (internal citations omitted).

⁷² *Id.*

⁷³ U.S. CONST. art I, § 8, cl. 8.

⁷⁴ *Campbell*, 510 U.S. at 579.

justifying the transformative use test, the Court reasoned that the more transformative a secondary work was, “the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.”⁷⁵ The Court stated that 2 Live Crew’s song was a parody and “has an obvious claim to transformative value”⁷⁶ deserving of fair use protection under the four-prong fair use test.⁷⁷

2. *Applying the Transformative Use Test to Rights of Publicity*

In drawing upon this Supreme Court precedent in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, the California Supreme Court also adopted the transformative use test as the applicable First Amendment defense test to be applied in right-of-publicity claims.⁷⁸ In *Saderup*, plaintiff Comedy III Productions owned the rights to the images of the Three Stooges.⁷⁹ The defendant, Gary Saderup, made charcoal-type drawings that he then silkscreened onto various products and sold.⁸⁰ Saderup made a charcoal drawing of the Three Stooges and then sold this likeness on shirts without obtaining permission from Comedy III Productions.⁸¹ Saderup made approximately \$75,000 in profits from these shirts.⁸² When Comedy III Productions brought suit against Saderup for violating California’s postmortem-right-of-publicity statute, the district court enjoined Saderup from violating the statute by using the likeness of the Three Stooges.⁸³ On appeal, Saderup claimed that his conduct was protected by the First Amendment, and the California appellate court struck the injunction but affirmed the judgment of damages and attorneys’ fees.⁸⁴

The California Supreme Court, hearing the case on appeal, adopted the transformative use test to determine the essential balance between

⁷⁵ *Id.* at 578.

⁷⁶ *Id.*

⁷⁷ *Id.* at 594.

⁷⁸ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001) (quoting *Campbell*, 510 U.S. at 579).

⁷⁹ *Id.* at 800.

⁸⁰ *Id.*

⁸¹ *Id.* at 800–01.

⁸² *Id.* at 801.

⁸³ *Id.*

⁸⁴ *Id.*

publicity rights and the First Amendment.⁸⁵ The Court recognized that rights of publicity and the First Amendment are in tension and that rights of publicity have the potential to frustrate the purposes of the First Amendment.⁸⁶ As such, the Court concluded that the “inquiry into whether a work is ‘transformative’ appears to us to be necessarily at the heart of any judicial attempt to square the right of publicity with the First Amendment.”⁸⁷ The Court recognized that the two also shared common goals: both rights of publicity and the First Amendment seek to encourage “free expression and creativity.”⁸⁸ Where a likeness is used without significant transformative elements, the Court stated that “protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.”⁸⁹ Similar to the transformative use justification in *Campbell*, the *Saderup* Court also suggested that where a work contains significant transformative elements, it is more deserving of First Amendment protection and is also not as likely to interfere with the original artist’s economic interest in his or her likeness.⁹⁰ As such, when a secondary work is transformative, First Amendment interests should prevail.⁹¹

In adopting the transformative use test though, the Court explicitly rejected applying the entire copyright fair use test to right-of-publicity claims.⁹² The Court was willing to adopt the first prong of the copyright fair use test — the purpose and character of the work — but was unwilling to apply the entire test because at least two prongs — the nature of the copyrighted work and the amount and substantiality of the portion used — were particularly designed to apply to “the partial copying of works of authorship ‘fixed in [a] tangible medium of expression.’”⁹³

⁸⁵ *Id.* at 808.

⁸⁶ *Id.* at 803.

⁸⁷ *Id.* at 808.

⁸⁸ *Id.* (“Both the First Amendment and copyright law have a common goal of encouragement of free expression and creativity, the former by protecting such expression from government interference, the latter by protecting the creative fruits of intellectual and artistic labor.”).

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *Id.* at 809.

⁹² *Id.* at 807–08.

⁹³ *Id.* (quoting 17 U.S.C. § 102) (“[I]t is difficult to understand why these factors would be especially useful for determining whether the depiction of a celebrity likeness

Then looking to *Saderup*'s work, the Court recognized that the portraits were expressive works, for the purpose of entertaining, and done for financial gain, but this did not void the constitutional protection they should receive.⁹⁴ The Court found that the appropriate inquiry was whether the work in question "adds something new, with a further purpose or different character, altering the first new expression, meaning, or message," quoting the U.S. Supreme Court in *Campbell*.⁹⁵ The Court did not stop at this New Meaning Test,⁹⁶ however, and instead provided several other iterations of what else may constitute a transformative use. The Court expressed that where a work is transformative and "adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation" (the Mere Celebrity Likeness Test), it should be protected under the First Amendment.⁹⁷

The Court continued on, also iterating the Raw Materials Test: "Another way of stating the inquiry is whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question."⁹⁸ The Court also phrased the test in a fourth way to ask "[w]hether a product containing a celebrity likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness," with expression meaning something other than the celebrity's likeness — the Defendant's Own Expression Test.⁹⁹ Addressing what may constitute a transformative use, the Court listed parody, factual reporting, "heavy-handed lampooning," and social criticism.¹⁰⁰ The Court further

is protected by the First Amendment.").

⁹⁴ *Id.* at 802, 804.

⁹⁵ *Id.* at 808 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994)).

⁹⁶ The names for these three tests were not used by the Court but have been added by the author to demonstrate the different questions truly involved in the *Saderup* transformative use test.

⁹⁷ *Saderup*, 21 P.3d at 799. The court reasons that this type of depiction is also not likely to interfere with the economic interests that the artist has in his or her own likeness, as it will have its own value and not act as a good substitute for the original likeness itself. *Id.* at 808.

⁹⁸ *Id.* at 809.

⁹⁹ *Id.*

¹⁰⁰ *Id.*

reasoned that literal depictions may be protected in some circumstances,¹⁰¹ but where a work is simply a literal depiction of the celebrity (lacking other expressive elements), the interests of rights of publicity prevail over First Amendment interests.¹⁰²

In answering all of these questions (or tests), the Court found that Saderup's portraits had no such transformative elements.¹⁰³ Even if it took great skill to draw the portraits, the Court stated, the use of a likeness is still subject to challenge if the imitative elements of the portraits predominated and the economic value of the portraits derived mainly from the fame of the celebrity.¹⁰⁴ In this case, despite the fact that Rush used his artistic talents to create the charcoal drawings, the Court found no significant transformation and found that Saderup's skill was subordinated to his purpose to capitalize on the Three Stooges' fame through literal depictions.¹⁰⁵ Saderup's portraits using the Three Stooges' likenesses could not sustain a First Amendment defense claim.¹⁰⁶

3. *The Development of the Right-of-Publicity Transformative Use Test*

Since the adoption of the transformative use test by the California Supreme Court in *Saderup*, California courts and federal circuit courts alike have asked whether the likeness of a celebrity was transformed to balance celebrities' and artists' interests.

a. *ETW Corp. v. Jireh Publishing, Inc.*

The Sixth Circuit in *ETW Corp. v. Jireh Publishing, Inc.*, in one of the highest profile right-of-publicity cases to use the transformative use test,¹⁰⁷

¹⁰¹ See *id.* at 811. The Court discusses Andy Warhol's reproduction of celebrity portraits and demonstrates that by manipulating the likeness, Warhol conveys 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" and which may be deserving of First Amendment protection. *Id.*

¹⁰² *Id.* at 808.

¹⁰³ *Id.* at 811.

¹⁰⁴ *Id.* at 810. The Court held that even though these were reproductions of the likeness, this does not remove the significant creative elements that entitled the portraits to protection under the First Amendment as expressive works of art. *Id.*

¹⁰⁵ *Id.* at 811.

¹⁰⁶ *Id.*

¹⁰⁷ Bunker, *supra* note 67, at 315.

settled the issue of whether a painter's use of Tiger Woods's likeness was protected under the First Amendment.¹⁰⁸ In *ETW*, painter Rick Rush created a work of art depicting Tiger Woods famously winning the 1997 Masters Tournament in Augusta, Georgia.¹⁰⁹ Rush created the painting, *The Masters of Augusta*, depicting Woods completing a swing and lining up to observe a putt with one of his caddies on either side of him.¹¹⁰ In a blue sky-like background, Rush painted the Augusta National Clubhouse; the Masters leaderboard; and past famous golfers Arnold Palmer, Sam Snead, Ben Hogan, Walter Hagen, Bobby Jones, and Jack Nicklaus.¹¹¹

ETW, the exclusive holder of Woods's rights of publicity, brought suit claiming, among other claims, an infringement on Woods's rights of publicity under Ohio common law.¹¹² Ultimately, in a short transformative use analysis, the court set out tests similar to those of *Saderup*, asking whether Rush had added a significant creative component.¹¹³ The court also focused on the economic impact that the work would have on Woods's own economic interests in his likeness.¹¹⁴ Ultimately, the court concluded that Rush's work was a transformative use that consisted of more than the mere use of Woods's likeness.¹¹⁵ The court found the added elements of the clubhouse, leaderboard, caddies, and legendary golfers significant and creative, stating that they "in themselves are sufficient to bring Rush's work within the protection of the First Amendment" by adding the message that Woods would one day become one of these golf greats.¹¹⁶ The court also

¹⁰⁸ 332 F.3d 915, 919 (6th Cir. 2003).

¹⁰⁹ *Id.* at 918.

¹¹⁰ *Id.*

¹¹¹ *Id.*

¹¹² *Id.* at 918–19.

¹¹³ *Id.* at 938.

¹¹⁴ *Id.*

¹¹⁵ *Id.* at 936.

¹¹⁶ *Id.* The court in its analysis considered other right-of-publicity cases decided on First Amendment grounds: *White v. Samsung Electronics America, Inc.*, where the Ninth Circuit found that a robot wearing a gown and wig intended to look like Vanna White did not qualify under a parody defense against White's right-of-publicity claims, *id.* at 932 (citing 989 F.2d 1512 (9th Cir. 1993)); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, where the Tenth Circuit found that trading cards with humorous commentary about baseball players constituted a parody and added a creative component to make an entirely new product, *id.* at 932–33 (citing 95 F.3d 959 (10th Cir. 1996));

found persuasive that the painting included a collage of images to describe a historic sporting event.¹¹⁷ Finally the court found that Rush's painting was not capitalizing solely on Wood's literal depiction and would not interfere with Woods's ability to profit from the use of his likeness.¹¹⁸ Therefore, Rush's First Amendment interests outweighed any right-of-publicity interest that Woods maintained.

b. *Winter v. DC Comics*

Another instance where the California Supreme Court found a clear transformative use was the case of *Winter v. DC Comics*. In *Winter*, the defendant created a series of comics that featured singers Edgar and Johnny Winter as half-worm, half-human characters.¹¹⁹ The Winter brothers' likenesses appeared in a volume titled *Autumns of our Discontent*, and the half-worm characters were aptly named Edgar and Johnny Autumn.¹²⁰ In determining whether DC Comics' use of the Winters's likeness infringed the Winters's rights of publicity, the Court used the transformative use test to balance DC Comics' First Amendment rights.¹²¹ In setting out the test, the Court reaffirmed the use of *Saderup*'s Raw Materials Test and Defendant's Own Expression Test.¹²² The California Supreme Court went further than in *Saderup* though, expressing that even if the market and economic value of a work derive from the celebrity's fame, the secondary work may still be transformative.¹²³ The Court then iterated that a "work is protected by the First Amendment inasmuch as it contains significant transformative elements or that the value of the work does not derive primarily from the celebrity's fame."¹²⁴

The Court also stated that rights of publicity may not be used to censor portrayals of the celebrity that the celebrity dislikes, but rather are intended

Hoffmann v. Capital Cities/ABC, Inc., where the Ninth Circuit found that an altered image of Dustin Hoffman wearing a spring 1997 line of women's clothing was not commercial speech and was entitled to full First Amendment protection, *id.* at 933–34 (citing 255 F.3d 1180 (9th Cir. 2001)); and *Saderup, id.* at 934–36 (citing 21 P.3d 797 (Cal. 2001)).

¹¹⁷ *ETW*, F.3d at 938.

¹¹⁸ *Id.*

¹¹⁹ *Winter v. DC Comics*, 69 P.3d 473, 476 (Cal. 2003).

¹²⁰ *Id.*

¹²¹ *Id.* at 477.

¹²² *Id.* at 477–78.

¹²³ *Id.* at 478.

¹²⁴ *Id.* at 478–79.

to prevent the misappropriation of a likeness for economic value.¹²⁵ As such, the Court found that “this case is not difficult” and that the comic books did not contain literal depictions of the Winters brothers, but rather they added significant expressive content.¹²⁶ The Court concluded that the plaintiffs were “merely part of the raw materials from which the comic books were synthesized.”¹²⁷ As such, the Court found the incorporation of these likenesses into the comic books to be one of the clearest examples of a transformative use and protected the use of the likenesses under the First Amendment.

c. The Use of Athletes’ Likenesses in Video Games

Another common area where right-of-publicity infringement claims have arisen has been the use of celebrity likenesses in video games, in which sports video game creators’ First Amendment defenses have largely been unsuccessful.¹²⁸ Recently, in *Hart v. Electronic Arts, Inc.*, the Third Circuit found for Rutgers University football quarterback Ryan Hart where the video game creator, Electronic Arts, Inc., incorporated Hart’s likeness into its *NCAA Football 2004, 2005, and 2006* games.¹²⁹ The video game incorporated aspects of Hart’s identity to make up the Rutgers quarterback in its game.¹³⁰ The quarterbacks both played for Rutgers; wore number thirteen; were 6’2” tall and 197 pounds; came from the same hometown, team, and class year; and looked alike.¹³¹ Any game user could alter the digital avatar resembling Hart to change statistics like height, weight, and throwing distance, but could not change the hometown and class year.¹³²

In applying the transformative use test to determine the validity of Electronic Arts’ First Amendment defense, the Third Circuit listed both

¹²⁵ *Id.* at 478.

¹²⁶ *Id.* at 479.

¹²⁷ *Id.*

¹²⁸ In *In re NCAA Student-Athlete Name & Likeness Litigation*, 724 F.3d 1268 (9th Cir. 2013), the Ninth Circuit heard a class-action claim by student athletes against video game developer Electronic Arts. The court found that the First Amendment did not protect the use of college athletes’ likenesses in football video games against the athletes’ right-of-publicity infringement claims because the use was not transformative where the athletes’ likenesses were used to play football in the game as they did in life. *Id.*

¹²⁹ 717 F.3d 141,170 (3d Cir. 2013).

¹³⁰ *Id.* at 146.

¹³¹ *Id.*

¹³² *Id.*

the Raw Materials Test and the Defendant's Own Expression Test as the appropriate inquiries.¹³³ The Court then found that the digital avatar closely resembled Hart and that the context of the video game was not transformative: "The digital Ryan Hart does what the actual Ryan Hart did while at Rutgers: he plays college football . . ." ¹³⁴ The Court further found that the video game player's ability to change the avatar was not sufficient to constitute a transformative use and rather fell into the "'mere trivial' variation"¹³⁵ category, in which rights of publicity surmount First Amendment protections.¹³⁶ Other creative elements of the game that did not affect Hart's digital avatar were not applicable to the question of whether Hart's likeness had been transformed,¹³⁷ and the Court found this use violated Hart's rights of publicity.¹³⁸

d. The Use of Musicians' Likenesses in Video Games

College athletes have not been the only ones seeking to recover from the video game industry for the use of their likenesses to sell video games. Musicians have also brought right-of-publicity infringement claims against video game creators for including their likenesses and music in video games.

i. Kirby v. Sega of America

In *Kirby v. Sega of America*, for example, '90s singer Keirin Kirby brought suit against video game distributor Sega for allegedly incorporating her likeness into the video game *Space Channel 5*.¹³⁹ Kirby alleged that the main character of *Space Channel 5*, Ulala, was a depiction of Kirby.¹⁴⁰ Kirby claimed that she had a specific "funky diva-like" character and that she typically wore "platform shoes, knee-socks, brightly colored form-fitting clothes and unitards, short pleated or cheerleader-type skirts, bare

¹³³ *Id.* at 160.

¹³⁴ *Id.* at 166.

¹³⁵ *Id.* at 168 (quoting *Winter v. DC Comics*, 69 P.3d 473, 478 (Cal. 2003)).

¹³⁶ *Id.* at 167.

¹³⁷ *Id.* at 169 ("Decisions applying the Transformative Use Test invariably look to how the *celebrity's identity* is used in or is altered by other aspects of a work.")

¹³⁸ *Id.* at 170.

¹³⁹ 60 Cal. Rptr. 3d 607, 609 (Cal. Ct. App. 2006).

¹⁴⁰ *Id.*

midriff, . . . a blue backpack, and red/pink hair.”¹⁴¹ She also claimed that her signature lyrical expression was “ooh la la,” phonetically similar to the name of the Ulala character.¹⁴² Sega released *Space Channel 5* in 1999, and the game featured Ulala as a news reporter working in outer space in the twenty-fifth century.¹⁴³ In the game, Ulala primarily wore an orange outfit with a bare midriff, a miniskirt, elbow-length gloves, platform boots, hot pink hair, and a blue jetpack.¹⁴⁴ Considering the similarities and differences between Ulala and Kirby, the California Court of Appeals for the Second District found that there was a factual issue as to whether Sega infringed, but the court ultimately concluded that any use of Kirby’s likeness was protected by the First Amendment.¹⁴⁵

The court applied the transformative use test to the game and listed the Raw Materials Test, the Defendant’s Own Expression Test, and the New Meaning Test as applicable inquiries.¹⁴⁶ The court reasoned that Ulala was more than a literal depiction in part because of differences in physical appearance but also because of the context in which Ulala appeared, as a futuristic space reporter, not a 1990s singer.¹⁴⁷ The fact that Ulala and Kirby also did not have similar dance moves demonstrated that Ulala was transformative and as such protected under the First Amendment. Finally, the court rejected Kirby’s argument that Ulala and the game must have some type of social commentary or meaning, stating, “Whether the Ulala character conveys any expressive meaning is irrelevant to a First Amendment defense. All that is necessary is that respondents’ work add ‘something new . . . altering the first with new expression, meaning, or message.’”¹⁴⁸ The court found that Ulala was not simply “an imitative character contrived of ‘minor digital enhancements or manipulations,’” and as such was protected by the First Amendment against Kirby’s claims.¹⁴⁹

¹⁴¹ *Id.*

¹⁴² *Id.*

¹⁴³ *Id.* at 610.

¹⁴⁴ *Id.*

¹⁴⁵ *Id.* at 616.

¹⁴⁶ *Id.* at 615.

¹⁴⁷ *Id.* at 616.

¹⁴⁸ *Id.* at 617 (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001)).

¹⁴⁹ *Id.* at 616.

ii. *No Doubt v. Activision Publishing, Inc.*

In another case involving musicians' likenesses appearing in a video game, however, the California Court of Appeal for the Second District applied the transformative use test and found that the First Amendment did not supersede the band No Doubt's rights of publicity.¹⁵⁰ In *No Doubt v. Activision Publishing, Inc.*, the band No Doubt had contracted with Activision to appear in Activision's game *Band Hero*, which allowed players to perform various popular songs in a rock band with other digital members of the band.¹⁵¹ Players would choose an avatar character and then play with either digital versions of real-life rock stars or other fictional avatars.¹⁵² No Doubt agreed to appear in the video game and granted Activision a nonexclusive license to use their likenesses in the game, subject to the band's prior approval.¹⁵³

To facilitate the game creation, No Doubt participated in a motion-capture photography¹⁵⁴ session to make the digital representations closely look like the real band members.¹⁵⁵ No Doubt later became aware that an unlocking feature of the game (when the player reached a certain level) would allow the player to choose No Doubt avatars to perform other songs in the game that "No Doubt maintains it never would have performed."¹⁵⁶ Players could also manipulate the No Doubt band member Gwen Stefani to sing in a male voice and male band members to sing in female voices or manipulate band members to perform solo without the rest of the band.¹⁵⁷ No Doubt demanded that Activision stop these additional functions, but Activision refused.¹⁵⁸ No Doubt then brought suit alleging that Activision had violated the band's rights of publicity by exceeding the scope of its

¹⁵⁰ *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 411 (Cal. Ct. App. 2011).

¹⁵¹ *Id.* at 401.

¹⁵² *Id.*

¹⁵³ *Id.* at 401–02.

¹⁵⁴ See *supra* note 25 and accompanying text.

¹⁵⁵ *No Doubt*, 122 Cal. Rptr. 3d at 402.

¹⁵⁶ *Id.*

¹⁵⁷ *Id.*

¹⁵⁸ *Id.* Activision admitted that because No Doubt had not performed these new songs during its motion capture photography session, Activision had simply used impersonators to create the likenesses that would perform songs other than those licensed by No Doubt.

license, which indicated that the likenesses would only appear performing No Doubt songs.¹⁵⁹ Activision asserted that even if it did exceed the scope of its license, the First Amendment provided a complete defense to the complaint.¹⁶⁰

In applying the transformative use test, the court listed all four of the *Saderup* test iterations: the New Meaning, Defendant's Own Expression, Mere Celebrity Likeness, and Raw Materials tests.¹⁶¹ The court then considered that the digital representations were nearly an exact replication because of the motion-capture photography.¹⁶² It then looked to the context of the likenesses within the game.¹⁶³ The court found compelling that "no matter what else occurs in the game during the depiction of the No Doubt avatars, the avatars perform rock songs, the same activity by which the band achieved and maintains its fame. Moreover, the avatars perform those songs as literal recreations of the band members."¹⁶⁴ The court recognized that the band members could be manipulated to play in different venues, including outer space, but found that these other creative elements did not transform the avatars into doing anything other than what the band members would normally do — play songs.¹⁶⁵ The fact that Activision used the depictions to increase interest in its game by enticing the band's fan base to purchase the game also ultimately led the court to conclude that the use of the band's likenesses was not transformative.¹⁶⁶

III. THE TRANSFORMATIVE USE TEST & THE TUPAC VIRTUAL CLONE: TRANSFORMATION OR INFRINGEMENT?

To determine whether the Tupac virtual clone could be protected under the First Amendment, the virtual clone must first be protected speech. The United States Supreme Court has stated that video games can constitute

¹⁵⁹ *Id.*

¹⁶⁰ *Id.* at 406.

¹⁶¹ *Id.* at 407.

¹⁶² *Id.* at 409.

¹⁶³ *Id.* at 410.

¹⁶⁴ *Id.* at 410–11.

¹⁶⁵ *Id.* at 411.

¹⁶⁶ *Id.*

protected speech,¹⁶⁷ a proposition that lower courts have followed when weighing right-of-publicity interests against First Amendment interests.¹⁶⁸ The video game *Band Hero*, which the court found was protected speech,¹⁶⁹ closely resembles the Tupac concert. For example, *Band Hero* used motion-capture technology to incorporate the likeness of the band No Doubt into a video game to perform its own songs.¹⁷⁰ To achieve the Tupac performance, re-creators used an indirect approach to virtual cloning that allowed a two-dimensional Tupac to appear rapping in a live concert.¹⁷¹ Because similar virtual cloning technology was used to create both the band and Tupac, and both were created to perform their own music for an audience, this virtual performance is likely also protected speech. Because of this, the re-creators may attempt to claim a First Amendment defense to any common law right-of-publicity claim.¹⁷²

A. ARGUMENTS AGAINST TUPAC'S VIRTUAL CLONE AS A TRANSFORMATIVE USE UNDER *SADERUP*'S TEST ITERATIONS

It is not the case that the First Amendment “automatically trumps” rights of publicity,¹⁷³ and to balance these interests, the *Saderup* transformative use test requires that the work in question (1) “adds something new, with a further purpose or different character, altering the first with *new expression, meaning, or message*”;¹⁷⁴ (2) “adds significant creative elements so as

¹⁶⁷ See *Brown v. Entm't Merch. Ass'n*, 131 S. Ct. 2729, 2738 (2011) (analyzing a restriction on video games under a strict scrutiny standard because it “impose[d] a restriction on the content of protected speech”).

¹⁶⁸ See *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 618 (Cal. Ct. App. 2006) (“Because Kirby’s claims are subject to a First Amendment defense, and the video game is protected speech, Kirby’s state common law and statutory claims fail.”).

¹⁶⁹ See *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 405 (Cal. Ct. App. 2011).

¹⁷⁰ *Id.* at 402.

¹⁷¹ See *supra* notes 22–31 and accompany text (describing the possible creation technique that re-creators used to create the concert performance).

¹⁷² To sustain a common law right of publicity, the plaintiff must prove that there was unauthorized use of the plaintiff’s likeness that results in injury, regardless of whether the purpose is commercial. *Kirby*, 50 Cal. Rptr. 3d at 612.

¹⁷³ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 806 (Cal. 2001).

¹⁷⁴ *Id.* at 808 (emphasis added).

to be transformed into something more than a *mere celebrity likeness* or imitation”;¹⁷⁵ (3) “is so transformed that it has become primarily the *defendant’s own expression* rather than the celebrity’s likeness,” with expression meaning something other than the celebrity’s likeness;¹⁷⁶ or (4) uses the celebrity likeness as one of the ‘*raw materials*’ from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.”¹⁷⁷ In considering whether a likeness has been transformed, the court first considers the likeness itself and then the context in which the likeness appears¹⁷⁸ to determine whether the new work is transformative.

1. Likeness Similarities

The Tupac virtual clone, like the No Doubt motion-capture use, was intended to resemble the deceased Tupac as closely as possible. Using either a direct or an indirect approach to virtual cloning in and of itself demonstrates that the re-creators are attempting to replicate the likeness. The Tupac virtual clone donned Tupac’s tattoos, gold-chain necklace, Timberland boots, and even sagging baggy pants exactly the way the true Tupac had in life.¹⁷⁹ Arguably, under the Mere Celebrity Likeness Test, by making the virtual clone physically identical to the true Tupac, the re-creators did not add “significant creative elements” to transform the Tupac virtual clone “into something more than a mere celebrity . . . imitation.”¹⁸⁰ Rather, replicating the likeness down to the tattoos on Tupac’s chest was “painstakingly designed to mimic [his] likeness,” exactly like the No Doubt video game avatars that did not meet the court’s requirements for transformative use.¹⁸¹

¹⁷⁵ *Id.* at 799 (emphasis added).

¹⁷⁶ *Id.* at 809 (emphasis added).

¹⁷⁷ *Id.* (emphasis added).

¹⁷⁸ See *No Doubt v. Activision Publ’g, Inc.*, 122 Cal. Rptr. 3d 397, 409–10 (Cal. Ct. App. 2011).

¹⁷⁹ *Coachella’s ‘Astonishing’ Tupac Shakur Hologram: How They Did It*, THE WEEK (Apr. 17, 2012), <http://theweek.com/article/index/226859/coachellas-astonishing-tupac-shakur-hologram-how-they-did-it> (“No detail was glossed over, with the late rapper’s signature tattoos, jewelry, and body movements all incorporated into the hologram.”).

¹⁸⁰ *Saderup*, 21 P.3d at 799.

¹⁸¹ *No Doubt*, 122 Cal. Rptr. 3d at 409.

The fact that the likeness was a literal depiction of the former Tupac Shakur weighs against a finding of transformative use where the virtual clone is more or less a “fungible” image of Tupac Shakur, which he and his estate have the right to monopolize.¹⁸² Further, the songs performed also incorporated Tupac Shakur’s voice exactly as he had sung those songs when he was alive.¹⁸³ As such, it was not just Tupac’s physical identity that the re-creators took, but rather it was his physical identity, paired with his own voice, making the virtual clone simply a full-blown substitute for, or imitation of, the former Tupac Shakur. Rather than using Tupac’s likeness as a raw material to create a new work, the new work itself was just a carbon copy of which the imitation of Tupac is “the very sum and substance.”¹⁸⁴ Therefore, this exact replication would weigh against transformation under both the Raw Materials and Mere Celebrity Likeness tests.

The virtual clone likely took much skill and significant resources to create.¹⁸⁵ Using the indirect approach, the re-creators needed to incorporate many different performances, photos, etc. to be able to create the virtual clone with sufficient detail. The software is also likely very complex and not operable by a lay user, as evidenced by the fact that Dr. Dre teamed up with two different audio-visual companies to create the virtual clone.¹⁸⁶ The complexity and skill required, however, do not transform the virtual clone performance itself into something new or something other than a mere imitation of Tupac’s likeness. The Court in *Saderup* recognized that while Saderup’s charcoal drawings took the skill of an artist to create, this alone did not make the depiction of the Three Stooges transformative because the “marketability and economic value . . . derived primarily from the fame of the celebrity depicted” rather than the “creativity, skill, and reputation” of the re-creator — thus failing the Defendant’s Own Expression Test.¹⁸⁷

¹⁸² *Id.* at 407.

¹⁸³ *Compare Tupac Live Hologram, supra* note 1, with *2-Pac-Hail Mary (Official Music Video)* (1996), YouTube (Nov. 8, 2010), <https://www.youtube.com/watch?v=3SQVBsJG9Rs>.

¹⁸⁴ *Winter v. DC Comics*, 69 P.3d 473, 477 (Cal. 2003).

¹⁸⁵ The re-creators stated that the Tupac hologram cost between \$100,000 and \$400,000. Gil Kaufman, *Exclusive: Tupac Coachella Hologram Source Explains How Rapper Resurrected*, MTV.com (Apr. 16, 2012, 12:49 PM), <http://www.mtv.com/news/articles/1683173/tupac-hologram-coachella.jhtml>.

¹⁸⁶ *Id.*

¹⁸⁷ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001).

The media aftermath of the concert demonstrates that the focus of the audience was on seeing Tupac perform again, not on the mastery of AV Concepts and Digital Domain. The fans and media were ecstatic to see Tupac resurrected and performing next to his friends again, not to see the AV Concept's *version* of Tupac.¹⁸⁸ This was not a case of Andy Warhol recreating Marilyn Monroe's face to make it Andy Warhol's version of Marilyn Monroe; rather it was simply AV Concepts creating a replica of Tupac to be Tupac.¹⁸⁹ As such, there are strong arguments that the virtual clone would not pass the Defendant's Own Expression Test, further weighing against a finding of transformative use.

2. Likeness Differences Insignificant

The re-creators did change elements of the performance, namely creating a live performance for the song *Hail Mary*, which Tupac had never actually performed for a live audience; adding new language into Tupac's vernacular, "Coachella"; and opening and closing the performance with awe-inspiring visual effects, raising Tupac from beneath the ground and then vanishing him into a cloud of gold specks.¹⁹⁰ Transformative use precedent is not clear, however, on whether these minor changes constitute transformative use where the overall effect is still to physically replicate the virtual clone Tupac to perform as Tupac performed in life. The ability to change quarterback Ryan Hart's avatar to reflect different bodily physique and skill was insufficient to make Hart's likeness in the football video game transformative.¹⁹¹ Arguably, this precedent could apply to any minor changes (intended or unintended) made to Tupac's physical appearance and would weigh toward a finding that the virtual clone is not a transformative use under the Mere Celebrity Likeness Test.

In *No Doubt*, the court also considered the fact that the game player could manipulate the band's voices and make men sound like women and

¹⁸⁸ See Osterhout, *supra* note 19, at 38 (quoting a concert-goer as saying, "The hologram was so real that I kept looking over at Snoop to catch his reaction at having his buddy back on stage with him after all of this time . . . [h]e seemed happy").

¹⁸⁹ See *Saderup*, 21 P.3d at 811 (describing a celebrity depiction that would be deserving of First Amendment defense protection under the transformative use test).

¹⁹⁰ Suddath, *supra* note 1.

¹⁹¹ *Hart v. Electronic Arts, Inc.*, 717 F.3d 141, 168 (3d Cir. 2013).

vice versa.¹⁹² The court's finding that this element did not transform the likeness into something new is also telling for the Tupac performance where only one truly new word was added to Tupac's vernacular. As such, this minor addition may be rather insignificant when considering whether the virtual clone as a whole deserves First Amendment protections over Tupac's rights of publicity. In *No Doubt*, the avatars could perform with or without the band, and the avatars sang new songs by other artists that the band had not sung before.¹⁹³ Tupac similarly performed with other rappers during the concert, Dr. Dre and Snoop Dogg. The fact that the *No Doubt* court put little weight behind the argument that the separation of the band was transformative could also indicate that simply including new rappers into the virtual clone performance will not constitute a transformative use, particularly where the artist had in fact performed with those rappers in life.¹⁹⁴

Finally, the fact that the Tupac virtual clone performed a song that Tupac had not performed in life is arguably also not transformative. The *No Doubt* avatars were forced to sing the songs of other artists in *Band Hero*, and the court found that this made the video game no more transformative.¹⁹⁵ As such, forcing Tupac's virtual clone to sing a Tupac song, albeit not one performed in life, is arguably directly in line with this *No Doubt* precedent and will not transform this use of Tupac's likeness under the Defendant's Own Expression or Raw Materials tests also employed in *No Doubt*.¹⁹⁶ Therefore, these minor changes to the Tupac virtual clone are similar to that which Activision undertook in *No Doubt* and which the court found unconvincing and un-transformative.¹⁹⁷ Considering the similarity of the likeness alone however cannot dictate whether a use is transformative.¹⁹⁸

¹⁹² *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 402, 406 (Cal. Ct. App. 2011).

¹⁹³ *Id.*

¹⁹⁴ See *2Pac-2 of Amerikaz Most Wanted*, YouTube (Feb. 12, 2006), <https://www.youtube.com/watch?v=Qb4V4jfHOO8&feature=kp> (showing a music video of Tupac performing with rapper Snoop Dogg); *2Pac-California Love*, YouTube (Feb. 12, 2006), <https://www.youtube.com/watch?v=FWOsbGP5Ox4&feature=kp> (showing a music video of Tupac performing with rapper Dr. Dre).

¹⁹⁵ *No Doubt*, 122 Cal. Rptr. 3d at 407.

¹⁹⁶ *Id.* at 410.

¹⁹⁷ *Id.* at 411.

¹⁹⁸ *Id.* at 415; *Hart v. Electronic Arts, Inc.*, 717 F.3d 141, 166 (3d Cir. 2013).

3. Context

Courts have also looked to the context in which the celebrity's likeness appears to determine whether the re-creator added significant creative elements, thus making it transformative and worthy of protection.¹⁹⁹ The Tupac virtual clone performed two Tupac songs alongside Dr. Dre and Snoop Dogg, two performers that he had performed with during life.²⁰⁰ Because the only songs the trio sang were songs that Tupac had written and sung during his life, arguably the message of both songs in the context of a new concert was the same message conveyed when Tupac was alive, rather than any new message that the re-creators were attempting to impart. The estate could then assert that the performance should fail the New Meaning Test for transformativeness.

Further, courts have been reluctant to provide protection to re-creations that depict the celebrity doing exactly "the same activity by which the [celebrity] achieved and maintains [his or her] fame."²⁰¹ Rapping made Tupac famous and continued to make him famous throughout both his life and his death.²⁰² In the virtual clone concert, re-creators capitalized on what made Tupac famous — his rap lyrics and style. The Tupac virtual clone even performed Tupac's own songs, which contributed to his fame. This use of Tupac's likeness to perform the same activity that made him famous is much like the use of Zacchini's entire cannonball act, which was also how Zacchini achieved his reputation.²⁰³ It may similarly be what the United States Supreme Court termed one of the "strongest case[s] for a 'right of publicity' involving, not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place."²⁰⁴ Ryan Hart played college football for Rutgers. Ryan Hart's avatar played college football for Rutgers. No Doubt

¹⁹⁹ See *No Doubt*, 122 Cal. Rptr. 3d at 409–10.

²⁰⁰ See *supra* note 194.

²⁰¹ *No Doubt*, 122 Cal. Rptr. 3d at 411.

²⁰² Derek Iwamoto, *Tupac Shakur: Understanding the Identity Formation of Hyper-Masculinity of a Popular Hip-Hop Artist*, THE BLACK SCHOLAR, Summer 2003, at 44, available at <http://www.jstor.org/stable/41069025?seq=2>. ("In the mid-1990s [Tupac] was one of the most popular rap stars. Even today he is considered a legend in the hip-hop world, and has sold over 22 million records, posthumously.")

²⁰³ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

²⁰⁴ *Id.*

performed songs. No Doubt's avatars in the *Band Hero* video game performed songs. No matter what else changed on the football field or in the concert arena in these video games, the celebrities were depicted doing the exact activities that made them famous.²⁰⁵ And as such, these depictions were arguably not transformative under any of the *Saderup* tests.²⁰⁶

The added creative elements of the concert, such as Tupac's entrance and exit and the fact that Tupac performed as one part of an entire music festival, are also arguably insufficient to make the use transformative. The court in *Hart* rejected an argument that the other elements of the video game (not affecting Hart's likeness) elevated the entire game as a transformative use.²⁰⁷ Instead, the court stated that the transformative use test looks only at the way in which the celebrity's identity is used or changed, not other extraneous creative parts of the game (or concert in this case).²⁰⁸ Therefore, other elements of the concert outside of the Tupac performance do not bear on the transformative use inquiry.²⁰⁹ These other elements may be relevant though when considering whether the performance interferes with the Tupac estate's economic interest in his likeness.

4. Possible Interference with Economic Interest

In considering whether a use is transformative, courts have also taken into account the extent to which the new use of the artist's likeness will affect the economic interest of the artist, asserting that the more transformative the work, the less it will interfere with the celebrity's economic interest.²¹⁰ The Coachella concert organizers sold tickets to the show, as any concert

²⁰⁵ *Hart v. Electronic Arts, Inc.*, 717 F.3d 141, 166 (3d Cir. 2013); *No Doubt*, 122 Cal. Rptr. 3d at 411 ("Moreover, Activision's use of life-like depictions of No Doubt performing songs is motivated by the commercial interest in using the band's fame to market *Band Hero*, because it encourages the band's sizeable fan base to purchase the game so as to perform as, or alongside, the members of No Doubt.").

²⁰⁶ *Hart*, 717 F.3d at 166; *No Doubt*, 122 Cal. Rptr. 3d at 411.

²⁰⁷ *Hart*, 717 F.3d at 166.

²⁰⁸ *Id.* 169.

²⁰⁹ *Id.*

²¹⁰ See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575 (1977); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001) ("On the other hand, when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity.").

presenter would. These ticket sales alone are not likely detracting from any economic interest Tupac's estate has unless the estate itself would like to capitalize on a Tupac virtual clone performance of its own. If this were the case, the Coachella concert would be in direct competition with the estate's economic interest in the use of the likeness.

Following the concert though, Tupac Shakur's *Greatest Hits* album returned to the Billboard top 200 for the first time since 2000, falling into spot 129, with 4,000 copies sold.²¹¹ The concert thus boosted record sales more than a 570% increase from the previous week.²¹² This alone would not likely interfere with the estate's economic interest but would rather do the opposite and enhance the estate's economic interest in Tupac's music. However, if the fans turned to purchasing recorded versions of the concert to view the performance rather than buying "The Don Killuminati: The 7 Day Theory" album that simply contains the song *Hail Mary*, this could interfere with the estate's interest in Tupac's likeness. This is still a very narrow substitute, however, and the likelihood is greater that the estate's economic interest would be enhanced following the concert rather than impeded based on the post-concert record sales.

These elements, the identical depiction of Tupac doing exactly what Tupac did to obtain and maintain his fame, tend to weigh against a finding that Dr. Dre and his audio-visual counterparts added "significant creative elements so as to . . . transform[] [the Tupac virtual clone] into something more than a mere celebrity likeness or imitation."²¹³ Rather this concert, meant to astonish fans by resurrecting an iconic deceased rapper using an indirect virtual cloning approach, is likely more akin to "when an artist's skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame" that then subordinates a re-creator's First Amendment defenses to the celebrity's rights of publicity under the Mere Celebrity Likeness Test.²¹⁴ Where there is arguably no or little economic interference, however, critics

²¹¹ Keith Caulfield, *Tupac's Virtual Coachella Appearance Spurs Huge Sales Bump*, BILLBOARD (Apr. 26, 2012, 9:30 PM), <http://www.billboard.com/news/tupac-s-virtual-coachella-appearance-spurs-1006896752.story>.

²¹² *Id.*

²¹³ *Saderup*, 21 P.3d at 799.

²¹⁴ *Id.* at 810.

of rights of publicity are not without hope, as this lack of interference would tend to show transformation. Several other elements of the concert also weigh toward a finding of transformative use.

B. ARGUMENTS FOR TRANSFORMATIVE USE OF TUPAC'S LIKENESS USING *SADERUP*'S TEST ITERATIONS

Tupac's re-creators would undoubtedly assert that they created something of their own that contributes more to Tupac's performance and his legacy than any "trivial variation" could.²¹⁵ The re-creators added aspects both to the likeness and to the context of the performance that arguably add a new message, that of the re-creator rather than Tupac himself, thus passing the New Meaning, Defendant's Own Expression, and Raw Materials tests.

1. Likeness & Context Additions Under the Defendant's Own Expression & Raw Materials Tests

While the virtual clone is a literal depiction meant to look like the deceased Tupac Shakur, courts applying the transformative use test have not damned artistic expressions merely for being a literal reproduction. The courts in *No Doubt* and *Saderup* both recognized that the First Amendment can protect literal reproductions where there are added elements making the depiction recognizable as the work of the artist rather than the celebrity.²¹⁶ While not as distinct as Andy Warhol's famous additions to Marilyn Monroe's likeness, the re-creators reproduced Tupac but did so by creating an entirely new performance to accompany the song *Hail Mary*. The re-creators had to either find old dance moves in past performances or create the new dance moves digitally themselves because Tupac had not ever actually shown the world how he would dance to and perform this song live. The re-creators thus added their own creative elements to the performance. Even the music video for the song *Hail Mary* does not show Tupac dancing, so the virtual clone's moves, while undoubtedly Tupac-esque, are something that the re-creators memorialized and constructed to fit the lyrics and rhythm of the

²¹⁵ *Id.*

²¹⁶ *Id.* at 811; *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 402, 408 (Cal. Ct. App. 2011).

song themselves.²¹⁷ In adding words that Tupac had never spoken and deleting the beginning portion of the recorded song *Hail Mary* from the live performance, the re-creators arguably also made artistic changes to the performance to make the performance as a whole more coherent and forceful, thus likely passing the Defendant's Own Expression Test.

These changes to a literal reproduction to represent real-life events with artistic additions are similar to the changes that transformed Tiger Woods's likeness in *ETW*. In *ETW*, Rick Rush created a painting of Tiger Woods, intended to look like Tiger Woods, and depicting Woods as he appeared in real life — winning the Masters Tournament.²¹⁸ These facts made Rush's work no less transformative or deserving of First Amendment protection. Rush added elements to a historical event by including Woods's caddies, the Master's Leader Board, and famous golf greats in the background looking down on Woods.²¹⁹ The Tupac re-creators added rap greats Dr. Dre and Snoop Dogg to the concert and included both a mesmerizing resurrection from below the ground to open the performance and a shocking burst of light to represent Tupac's exit from the stage — but not the music industry. Under this theory, taking the exact replication of Tupac's likeness was just one of the raw materials used to create this larger performance that then added significant creative elements, thus passing the Raw Materials Test.

While this performance was not a historic event, like the youngest golfer ever to win the Masters,²²⁰ these added elements are arguably deserving of First Amendment protection where the re-creators transformed Tupac's live performances into a new performance all their own. AV Concepts also created other virtual clone performances for artists like Madonna, the Gorillaz, Celine Dion, and the Black Eyed Peas,²²¹ so AV could assert that, like Rush, it is creating literal reproductions with added elements that make the performances "recognizably [AV's] own" expression.²²²

²¹⁷ See *2-Pac-Hail Mary (Official Music Video) (1996)*, *supra* note 183.

²¹⁸ *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 918 (6th Cir. 2003).

²¹⁹ *Id.* at 936.

²²⁰ *Id.* at 918.

²²¹ Tom Eames, *Tupac Shakur Hologram Took Several Months, Says Creator*, DIGITAL SPY (Apr. 16, 2012, 5:02PM), <http://www.digitalspy.com/music/news/a376774/tupac-shakur-hologram-took-several-months-says-creator.html#~oAGyIsmhbhVPuz>.

²²² *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001).

2. *The Re-Creators' Added Message: The New Meaning Test*

The re-creators, in re-creating and resurrecting a performer who died too young and whom the public has idolized to the extent of questioning his death,²²³ arguably “added something new, with a further purpose or different character, altering the first [Tupac] with new expression, meaning, or message.”²²⁴ This concert may well have added new meaning to the Tupac performances than existed before. In life, his performances carried the message that thug life was difficult and that racial oppression was occurring right in front of society’s face, but nothing was changing.²²⁵ In death, however, the re-creators created the virtual clone from the memories and vision of Dr. Dre²²⁶ with the purpose of adding new meaning to the *posthumous* Tupac’s performance — the world has not forgotten you. This concert arguably elevated Tupac to an iconic status as a rapper that, even in death, the world will not let die.²²⁷ The concert could have been making a comment that unlike Tupac himself, Tupac’s music will live on forever.

However, while this new message is persuasive to a finding that the use was transformative, whether or not the concert actually made this comment about Tupac is not required under the transformative use test.²²⁸ All that the re-creators needed to do is add new meaning that the likeness did not otherwise provide,²²⁹ which the resurrection, new performance,

²²³ Chris Whitworth, *Tupac Shakur: Top 5 Conspiracy Theories*, 3 NEWS (June 17, 2011, 3:00 PM), <http://www.3news.co.nz/Tupac-Shakur-Top-5-conspiracy-theories/tabid/418/articleID/215479/Default.aspx> (listing Tupac’s posthumous albums and lyrics pointing to his death as reasons supporting conspiracy theories that Tupac Shakur is still alive).

²²⁴ *Saderup*, 21 P.3d at 808.

²²⁵ Iwamoto, *supra* note 202, at 44.

²²⁶ “[Q]uite honestly, it was Dre and Snoop who had to guide us. He is their friend and they know him,” said the chief creator at Digital Domain. Suddath, *supra* note 1; see also Nadeska Alexis, *Dr. Dre Hopes Jimi Hendrix, Marvin Gaye Follow ‘Pac as Holograms*, MTV.COM (Apr. 19, 2012, 12:36 PM), <http://www.mtv.com/news/articles/1683463/tupac-hologram-dr-dre.jhtml> (stating that the creation of the hologram was Dr. Dre’s idea, and his vision was what was used to bring Tupac back).

²²⁷ Re-creator Dylan Brown, a filmmaker who worked on the Tupac virtual clone, stated, “even if you die we’ll bring you back.” McCartney, *supra* note 21.

²²⁸ See *Kirby v. Sega of Am., Inc.*, 60 Cal. Rptr. 3d 607, 617 (Cal. Ct. App. 2006) (“The law does not require Ulala to ‘say something — whether factual or critical or comedic’ about Kirby the public figure in order to receive First Amendment protection. This argument has been soundly rejected by the Supreme Court.”).

²²⁹ *Id.*

and vanishing may indeed all do. The slow resurrection from beneath the stage adds meaning to the likeness — Tupac’s music and messages cannot be killed. Singing the song *Hail Mary*, of all the songs in Tupac’s discography,²³⁰ also added meaning to the concert because the song includes lyrics like “[w]hen they turn out the lights, I’ll be down in the dark [t]huggin eternal through my heart,” and “[d]ealing with fate, hoping God don’t close the gate.”²³¹ This song and its title — the name of a Catholic prayer calling for the intercession of the Virgin Mary²³² — further exemplify the “eternal” nature of Tupac’s music, and the virtual clone’s performance to this song that had never been performed further conveys the message that, to the audience and friends, Tupac will never truly die. This new message, that of an eternal Tupac Shakur, is new meaning that Tupac’s likeness did not maintain during Tupac’s life, and as such, the use of the likeness passes the transformative use test under the New Meaning and Raw Materials subtests and is deserving of First Amendment protection.

IV. THE MANY TESTS OF *SADERUP*

Because the *Saderup* test iterations seemingly lead to contrary results in situations like the Tupac virtual clone concert, one may question whether the transformative use test is really the most appropriate inquiry when balancing right-of-publicity and First Amendment interests. The California Supreme Court in *Saderup*, however, took the approach most directly imparted by the United States Supreme Court in adopting the transformative use test, rather than the tests adopted by other circuits and jurisdictions.²³³ The U.S. Supreme Court in *Zacchini* stated that Ohio’s goals in providing right-of-publicity protection were “closely analogous” to the goals of both copyright and patent protection by “focusing on the right

²³⁰ See *2Pac Discography*, MTV, <http://www.mtv.com/artists/2pac/discography/> (last visited Mar. 26, 2014) (listing fourteen Tupac albums released).

²³¹ *Hail Mary*, AZ LYRICS, <http://www.azlyrics.com/lyrics/2pac/hailmary.html> (last visited Mar. 26, 2014).

²³² *Hail Mary*, MERRIAM WEBSTER, <http://www.merriam-webster.com/dictionary/hail%20mary> (last visited Mar. 26, 2014).

²³³ See *supra* notes 62–66 and accompanying text (outlining the First Amendment tests applied in right-of-publicity infringement cases).

of the individual to reap the reward for his endeavors”²³⁴ and providing an economic incentive to create.²³⁵ The Court again compared rights of publicity and copyrights in declaring that the Constitution would no more prevent a state from requiring the news station to compensate Zacchini than it would allow a defendant to broadcast a copyrighted dramatic work without compensating the copyright holder.²³⁶

Because the U.S. Supreme Court had already recognized the connection between copyrights and rights of publicity in a case balancing First Amendment protections against rights of publicity, the California Supreme Court’s decision to take a similar approach — using an aspect of the established copyright fair use test based on these common goals — is warranted under *stare decisis* principles.²³⁷ Further, because *Zacchini* is the only U.S. Supreme Court case to address rights of publicity generally, much less rights of publicity as weighed against the First Amendment, adopting a similar copyright transformative use test would be most consistent with the only binding precedent of all of the possible right-of-publicity tests employed.

In adopting the transformative use test over other possible First Amendment defense tests, the Third Circuit in *Hart* rejected the *Rogers* test²³⁸ because it did not maintain a single focus on whether the work in question sufficiently transformed the celebrity’s likeness in simply requiring that the new work be unrelated and not use the celebrity’s name for its commercial value.²³⁹ The court said that this inquiry overlooked the possibility that misappropriation can occur in the celebrity’s market as well.²⁴⁰

²³⁴ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

²³⁵ *Id.* at 576.

²³⁶ *Id.* at 575.

²³⁷ See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001) (“The right of publicity, at least theoretically, shares this goal with copyright law. . . . When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist.”).

²³⁸ The *Rogers Test* asks whether the challenged work is wholly unrelated to the underlying work and whether the plaintiff’s name is used for its advertisement and commercial value. See *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989).

²³⁹ *Hart v. Electronic Arts, Inc.*, 717 F.3d 141, 163 (3d Cir. 2013).

²⁴⁰ *Id.*

The court also rejected the Predominant Purpose Test,²⁴¹ stating that the court's inquiry should not start and stop with commercial purpose or value but that it must look at whether the work is the creator's own expression.²⁴² This analysis, coupled with the U.S. Supreme Court dicta in *Zacchini*, further demonstrates that the transformative use test is the most appropriate test for balancing rights of publicity against the First Amendment.

The *Saderup* Court in presenting several different iterations of the transformative use test, however, derailed the analysis slightly by not adopting a single iteration of the test to narrow the scope of the inquiry to strictly consider the use of the celebrity's likeness. The California Supreme Court should address these four iterations of the transformative use test that it laid out in *Saderup* and instead adopt just one, the Mere Celebrity Likeness Test. This more narrow iteration of the test can provide predictability without losing the spirit of the larger goals found in both copyright and rights of publicity.

As the Tupac virtual clone shows, the transformative use test itself now has subparts, each of which can weigh toward contrary results using the same set of facts. The Tupac re-creators, even though creating a literal reproduction, added new elements to the performance — new language, dance moves, and interactions — and may well have added new meaning to the performance in addition to any meaning that the *Hail Mary* and 2 of *Amerikaz Most Wanted* songs or performances held before. The re-creators made artistic changes and inserted the message that “Tupac's music will live forever” into the minds of fans and the media. This additional meaning or message would weigh in favor of the defendant re-creators under the *Saderup* transformative use New Meaning Test. The fact that the re-creators had similarly created other concert performances using virtual cloning technology, in addition to the added message in the Tupac concert, also tends to show that the virtual clone was really the re-creators' own expression. This would again weigh in favor of the re-creators' First Amendment interests under the *Saderup* Defendant's Own Expression Test.

²⁴¹ The Predominant Purpose Test asks whether the predominant purpose of the use or portrayal is to serve a social function valued by free speech or to commercially exploit the likeness in the same way the celebrity would. See *Presley's Estate v. Russen*, 513 F. Supp. 1339, 1356 (D.N.J. 1981).

²⁴² *Hart*, 717 F.3d 163 & n.29.

On the other hand, the re-creators made an exact replica of Tupac Shakur and profited from the activity that made and kept him famous, rapping, which courts have weighed heavily against a finding of transformative use.²⁴³ Therefore, this would also weigh heavily against a finding that the re-creators' use of both Tupac's likeness and his voice would be a transformative use under the *Saderup* Mere Celebrity Likeness and Raw Materials tests. It is also unclear how the Court should weigh the possible interference with the artist's economic interest under the transformative use test and its current subtests adopted in *Saderup*,²⁴⁴ reaffirmed in *Winter*,²⁴⁵ and subsequently used by the Third, Sixth, and Ninth Circuits.²⁴⁶ Under the current set of tests, cases similar to this one involving virtual-cloning technology will present new issues for the Court, which will have a difficult time parsing the convoluted test-setting precedent and the strong case law on each side of the debate.

To avoid this outcome, first the California Supreme Court should clarify the New Meaning Test in terms of right-of-publicity issues and reject the blanket New Meaning Test used in *Campbell* — a copyright test.²⁴⁷ Merely taking the test in its entirety confuses the issue in right-of-publicity claims; that is, whether the likeness has been transformed into something more. The depictions themselves must “contain[] significant expressive content beyond the [celebrity's] likeness.”²⁴⁸ Simply asking whether “a work . . . adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message” misses the mark and is too broad.²⁴⁹ While copyright and rights of publicity have similar goals in respect to applying the First Amendment,²⁵⁰ they are still two different areas of law comparing two different things.

²⁴³ See *supra* notes 204–205 and accompanying text.

²⁴⁴ See *supra* notes 95–99 and accompanying text.

²⁴⁵ See *Winter v. DC Comics*, 69 P.3d 473, 477–78 (Cal. 2003).

²⁴⁶ See *Hart*, 717 F.3d at 160; *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 938 (6th Cir. 2003); *In re NCAA Student-Athlete Name & Likeness Litigation*, 724 F.3d 1268, 1275–76 (9th Cir. 2013).

²⁴⁷ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

²⁴⁸ *Kirby v. Sega of Am.*, 60 Cal. Rptr. 3d 607, 615 (Cal. Ct. App. 2006).

²⁴⁹ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001).

²⁵⁰ See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573, 575–76 (1977).

In copyright infringement claims, the United States Supreme Court has said that a transformative use is sufficient but not necessary to find a fair use.²⁵¹ In right-of-publicity analyses using the transformative use test, however, a finding of transformativeness is imperative to the decision of whether the use of the likeness is legitimate because it is the only question at issue. Therefore, employing the exact same iteration of the New Meaning Test to rights of publicity and copyright infringement is inappropriate because of these distinct legal standards. Copyright transformative use compares two works to determine whether the second is deserving of First Amendment protection because it is itself a new creation with added creative elements.²⁵² Right-of-publicity First Amendment analyses, however, compare a secondary work not with an original work, but with an actual likeness (a property right the celebrity has a right to compensation for).²⁵³ While both are similar negative rights, comparing a human being and a work is a different analysis than comparing a work against another work. As such, even when employing a similar test derived from copyright law — the New Meaning Test — the question when dealing with rights of publicity must be posed in terms of the likeness that triggers the cause of action — did the new likeness add expressive content *to the old likeness*?²⁵⁴

The *Saderup* Court rejected importing the entire copyright fair use analysis because in its entirety it would be inapplicable to right-of-publicity questions.²⁵⁵ However, in continuing to use the copyright New Meaning Test as an iteration of what constitutes a right-of-publicity transformative use, the Court is implicitly introducing the broad copyright transformative use test rather than focusing on whether the work has been transformed to do something more than just exploit the likeness for its monetary gain. As such, this broad definition of the test should be abandoned for a more focused inquiry.

²⁵¹ *Campbell*, 510 U.S. at 579.

²⁵² *Id.*

²⁵³ *Winter v. DC Comics*, 69 P.3d 473, 478 (Cal. 2003) (“What the right of publicity holder possesses is not a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity’s fame . . .”).

²⁵⁴ *Hart v. Electronic Arts, Inc.*, 717 F.3d 141,169 (3d Cir. 2013) (“Decisions applying the Transformative Use Test invariably look to how the *celebrity’s identity* is used in or is altered by other aspects of a work. Wholly unrelated elements do not bear on this inquiry.”).

²⁵⁵ *Saderup*, 21 P.3d at 807–08.

Because of this breadth of the transformative use test and the possibility of confusing the real issue — appropriation of one’s likeness — the Court should clarify and narrow the transformative use by adopting the Mere Celebrity Likeness Test as the single iteration for the transformative use test in right-of-publicity cases. The Court should instead simply ask “whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.”²⁵⁶ This maintains the spirit of both the *Campbell* and *Saderup* rules, including the New Meaning, Defendant’s Own Expression, and Raw Materials tests, but narrows the scope of the inquiry to focus specifically on whether the celebrity or the defendant should profit from the use of the likeness.

The Mere Celebrity Likeness Test language is also clearer and arguably more predictable than the very similar Raw Materials Test that similarly asks “whether the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question.”²⁵⁷ By asking whether significant creative elements have been added, the Court is similarly asking whether there is a larger work encompassing that likeness. By also asking whether the work has been made into something more than an imitation of the likeness, the Court is similarly determining whether the likeness is actually serving as the “sum and substance” of the new work. If the work is imitative and does not have significant creative elements, the Court can conclude, as it would under the Raw Materials Test, that the likeness is not a raw material synthesized into a larger work but rather that the imitation serves as the sum and substance of the new work. This single iteration would not change the conclusion under the Raw Materials test but would offer clarity to future courts in providing only one test iteration for the court to follow rather than unnecessarily employing several similar tests.

Further, if the defendant has transformed the likeness so that the work has become the defendant’s own expression (of something other than the celebrity’s likeness), the Mere Celebrity Likeness Test acknowledges this contribution as well but without requiring that the Court point to exactly what that expression is. So long as the work adds creative elements to be

²⁵⁶ *Id.* at 799.

²⁵⁷ *Id.* at 809.

something more than a mere celebrity likeness or imitation, the Court need not find anything else, and the First Amendment interests prevail. By maintaining this one consistent iteration of the transformative use test, rather than four, the Court can give better direction both to re-creators who want to fairly use a likeness and to the courts that will hear the cases, which now have strong precedent on both sides of the issue.

CONCLUSION

Virtual-cloning technology has advanced to the point where live concerts featuring both the living and the dead are possible. Rights of publicity, meant to protect an artist's economic interest in his or her likeness, conflict with First Amendment free expression principles, and courts have struggled to balance the two. The transformative use test has emerged as one of the predominant tests to determine whether the use of a celebrity's likeness is legitimate, but courts have come to different conclusions depending on the facts of each case due to the four different *Saderup* iterations of the right-of-publicity transformative use test. The Tupac virtual clone concert, which incorporated Tupac's exact physical appearance and voice, also depicted Tupac doing what made him famous in life: rapping. While the Tupac re-creators also added new elements to this performance — a stunning entrance, exit, and entirely new live performance never before done by Tupac — this may be insufficient to transform the performance into anything more than a mere imitation of the artist to profit from the likeness itself.

Precedent on transformative use is available and currently strengthens both sides of the debate based on the four different subtests created in *Saderup*. Because these four different test iterations can lead to contrary results based on the same set of facts, the California Supreme Court, as the pioneer of the right-of-publicity transformative use test, and other courts using the transformative use test should adopt the Mere Celebrity Likeness Test as the sole iteration of the transformative use test in right-of-publicity First Amendment defense claims. This will maintain the spirit of the original iterations but also provide for more consistency and predictability for cases, including virtual-cloning cases, still to come.