

***U-La-La*, What's Happened to Our California Right of Publicity?**

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INTRODUCTION

In 1971, the California Legislature first enacted California Civil Code section 3344 to protect the economic interest of celebrities by banning the use of the name, likeness, voice and image of celebrities without authorization.¹ While the statute originally gave broad protection to the rights of celebrities (as well as non-celebrities) to protect the economic interest their fame generates, the courts have had to balance the broad rights of the statute against the interests of the First Amendment.²

As the rights granted under section 3344 cross the powerful protections of the First Amendment, California's courts have limited the power of celebrities to control their own image and likeness as sometimes violative of the First Amendment's protections of free speech.³

Because so many celebrities call California home, it has always been a leading proponent of the right of publicity.⁴ California codified the right of publicity through California Civil Code section 3344, as well as the post-mortem right of publicity in California Civil Code section 3344.1⁵. Although California's statutes are not the most liberal in their protections of celebrity rights, they are considered strong protectors of celebrity rights.⁶

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1 CAL. CIV. CODE § 3344 (West 1997).

2 *See, e.g.*, *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 799 (Cal. 2001); *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 608 (Ct. App. 2006).

3 *See, e.g.*, *Comedy III*, 21 P.3d at 804.

4 *See id.* at 799–800 (discussing the protections regarding the right of publicity granted by the California Legislature and common law).

5 CAL. CIV. CODE § 3344.1 (West 1997).

6 California is one of only a handful of states that recognize the right of publicity through statute (at last count, sixteen states have right of publicity statutes). All states recognize the common law right of publicity. George P. Smith II, *The Extent of Protection of the Individual's Personality Against*

Cases interpreting the statute have consistently struggled to define the limits of protection.⁷ Even with the strong protections granted by the statute, celebrities have had a difficult time overcoming the boundaries of the First Amendment in controlling and protecting their persona.⁸

This article discusses the development of the history of the California right of publicity statutes through the analysis of three recent California cases. These cases—*Comedy III*,⁹ *Winter*,¹⁰ and *Kirby*¹¹—begin to define California courts' willingness to expand First Amendment protection against California's statutory right of publicity. This article also discusses the theory of transformative elements and the role of the courts as the "trier of fact" when deciding what is "art" in these three landmark decisions.¹²

I. A BRIEF HISTORY OF THE STATUTE

Section 3344 stems from the common law right of privacy, which protects a plaintiff against appropriation of his or her name or likeness for the defendant's advantage.¹³ Often the protection is considered to extend to one's "persona."¹⁴ This not only protects a person's name and likeness, but also the public character or "persona" they create.¹⁵ California continues to recognize the common law right of publicity, which section 3344 codifies and complements.¹⁶ The early language of the statute prescribed "recovery of damages by any living person whose name, photograph, or likeness has been used for commercial purposes without his or her consent."¹⁷

It was not until 1979, in *Lugosi v. Universal Pictures*, that the Califor-

Commercial Use: Toward A New Property Right, 54 S.C. L. REV. 1, 29 (2002). Although California has an inherent interest because of the numbers of celebrities that reside there, other states, such as Indiana and Tennessee, have stronger statutes to protect the rights of celebrities. Alain J. Lapter, *How the Other Half Lives (Revisited): Twenty Years Since Midler v. Ford—A Global Perspective on the Right of Publicity*, 15 TEX. INTEL. PROP. L.J. 239, 264–66 (2007). Indiana's interest springs from the presence of CMG Worldwide, which represents the rights to the Estates of Marilyn Monroe, James Dean, Babe Ruth and Princess Diana, while Tennessee is home to the Estate of Elvis Presley. CMG Worldwide, Clients, <http://www.cmgww.com/clients.html>.

⁷ See, e.g., *Comedy III*, 21 P.3d at 807 ("It is admittedly not a simple matter to develop a test that will unerringly distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity.")

⁸ See, e.g., *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607 (Ct. App. 2006).

⁹ *Comedy III*, 21 P.3d 797.

¹⁰ *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003).

¹¹ *Kirby*, 50 Cal. Rptr. 3d 607.

¹² The title of this article is in reference to the *Kirby* case, the most recent of the above-mentioned cases. As I will explain below, Kieran Kirby, the former lead singer of the band Deee-Lite, used the phrase, "ooh-la-la" over and over in their most famous song, "Groove is in the Heart." *Id.* at 609. The main character of Sega's game, *Space Channel 5*, was named, "Ulala." *Id.* at 609–10.

¹³ Compare CAL. CIV. CODE § 3344 (West 2008) with *Eastwood v. Sup. Ct.*, 198 Cal. Rptr. 342, 346 (Ct. App. 1983). See also William Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960).

¹⁴ See *Kirby*, 50 Cal. Rptr. 3d at 614.

¹⁵ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 803 (Cal. 2001).

¹⁶ *Id.* at 799.

¹⁷ *Id.* (emphasis added). "The statutory right originated in Civil Code section 3344, enacted in 1971, authorizing recovery of damages by any living person whose name, photograph, or likeness has been used for commercial purposes without his or her consent." *Id.*

nia Supreme Court recognized a common law right of publicity.¹⁸ However, even then it was not recognized as a descendible right.¹⁹ In 1984, because neither the common law right of publicity nor section 3344 allowed for protection of deceased celebrities' rights of publicity, the legislature enacted California Civil Code section 990 (later changed to section 3344.1), which protected the descendible rights of celebrities.²⁰

In 1984, the legislature made a significant change to 3344 and inserted the words, "on or in products, merchandise, or goods."²¹ The legislature intended to expand the statute's protection for celebrities, but instead created an opportunity for the courts to more fully explore the statute's struggle against the First Amendment.²² The base language of the statute now reads:

Any person who knowingly uses another'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, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof.²³

The shift away from strictly advertising purposes enhances the statute's entanglement with the First Amendment, as commercial speech receives inherently less protection than purely political speech, artistic expression or speech that is newsworthy.²⁴ The legislature's change, which was intended to further protect celebrities from any use,²⁵ increased the likelihood that a court would magnify the First Amendment concerns when reviewing the statute.

Under the original statute, "for commercial purposes" established a line to which courts and practitioners could separate proper from improper appropriation of a celebrity's likeness. Courts have always given their highest protections under the First Amendment to the press and newsworthy events, and less protection to commercial speech.²⁶ For example, it was clear that the image of a celebrity could be used in a newspaper for educational use, or even to promote a newspaper.²⁷ However, using a celebrity's image as a commercial endorsement or print ad without their authorization

¹⁸ 603 P.2d 425, 428 n.6 (Cal. 1979).

¹⁹ *Id.* at 429.

²⁰ CAL. CIV. CODE § 3344.1 (West 2008); *Comedy III*, 21 P.3d at 799-800.

²¹ *See Comedy III*, 21 P.3d at 801 (emphasis added).

²² *See id.*

²³ CAL. CIV. CODE § 3344 (West 2008) (emphasis added).

²⁴ *See Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 614 (Ct. App. 2006) (finding that "[First Amendment] protections may extend to all forms of expression, including written and spoken words (fact or fiction), music, films, painting, and entertainment, whether or not sold for a profit.").

²⁵ *See Comedy III*, 21 P.3d at 801.

²⁶ *Cent. Hudson Gas & Elec. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 562-63 (1980). *See also Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 416 (9th Cir. 1996) (distinguishing between the use of athletic statistics in news and advertising contexts).

²⁷ *See Namath v. Sports Illustrated*, 363 N.Y.S.2d 276 (N.Y. Sup. Ct. 1975).

was most certainly a violative use.²⁸

The early right of publicity cases reviewed the basic threshold issues for protection under the statute. The court did not find in favor of Joe Montana in his case against the San Jose Mercury News for using a photograph of Montana in a poster to promote the newspaper.²⁹ Even though the use by the San Jose Mercury News was actually a promotional tool to increase circulation, the event depicted was newsworthy in and of itself.³⁰ It stands as a clear example of the overriding concern the court has for the freedom of the press and the heightened level of protection granted to the press. While the Ninth Circuit dismissed the statutory claims of Vanna White when Samsung used a blond-headed robot to turn letters during a commercial promoting one of its products, the Ninth Circuit upheld the common law right of publicity because there was a triable issue of fact.³¹ In contrast to the pure commercial nature of promoting a product through television commercials, the *Montana* and *White* cases are good examples that the First Amendment affords protection for use of a celebrity's likeness to promote a newspaper's archival records (newsworthy protection).

Since the initial round of cases, such as the *Montana* and *White* cases, the courts have had to struggle with the intersection of celebrity rights and the First Amendment in situations that are more difficult to define.



II. *SADERUP, WINTER, AND KIRBY*

The first case in which the Supreme Court of California developed the theory of “transformative elements” to establish the First Amendment boundaries for the right of publicity was *Comedy III Productions v. Gary Saderup, Inc.*³² In *Comedy III*, charcoal sketch artist Gary Saderup created his artistic rendering of The Three Stooges, which he then sold to the public as lithographic T-shirts.³³ Comedy III Productions, the owner of the rights of publicity of Moe, Jerome “Curly” Howard, and Larry Fine—collectively known as The Three Stooges—sued to enjoin the sale of the lithographs and T-shirts as well as to collect damages and attorney’s fees.³⁴ Saderup defended the case to the United States Supreme Court, which denied review.³⁵ Saderup advanced two separate defenses: (1) that his conduct did not violate the terms of section 3341.1; and (2) that his actions were protected by the First

²⁸ See *Cher v. Forum Int’l, Ltd.*, 692 F.2d 634, 639 (9th Cir. 1982).

²⁹ *Montana v. San Jose Mercury News*, 40 Cal. Rptr. 2d 639 (Ct. App. 1995).

³⁰ *Id.* at 640–41.

³¹ *White v. Samsung Elecs. Am.*, 971 F.2d 1395, 1399 (9th Cir. 1992).

³² 21 P.3d 797, 808 (Cal. 2001).

³³ *Id.* at 800.

³⁴ *Id.* at 800–01.

³⁵ *Id.*, cert. denied, 534 U.S. 1078 (2002).

Amendment.³⁶ The court found neither argument persuasive.³⁷

The court first addressed Saderup's argument that the use of the image in the lithographs and on T-shirts was not within the statute.³⁸ He contended that the statute applied only to the use of a deceased personality's name, voice, photograph or image for the purpose of advertising, selling, or soliciting the purchase of products or services.³⁹ The court focused on the language, "in any manner" in ruling that his argument was simply "unpersuasive."⁴⁰ The court found that the lithographs and T-shirts themselves were tangible personal property, which satisfied the requirements of the statute.⁴¹ The court clarified that, while the original sketch itself was protected by the First Amendment, the lithograph copies and T-shirts were violative.⁴²

The second argument moved the court away from simple interpretation of the statute toward a balancing of the boundaries of the right of publicity against the protections of the First Amendment.⁴³ Political speech, use by the press, or artistic expression require pure or enhanced protection by the First Amendment.⁴⁴ The entanglement of the First Amendment and celebrity rights emerges when there is a product involved.⁴⁵ Although commercial speech is not entitled to the same level of protection as pure non-commercial speech, it is still entitled to the protection of the First Amendment.⁴⁶ The introduction of a product, such as the lithographs and T-shirts in *Comedy III*, introduces the question of whether or not Saderup's motives were purely for commercial gain or actually for artistic motives.⁴⁷ There is no question that Saderup created a piece of artwork in the original sketched image and, as stated earlier, the original drawing is not a violation of the statute. The question with which the *Comedy III* court was faced was whether the transfer of the sketch to the lithographs and T-shirts and their subsequent sales violated the statute.

Section 3344.1 gives protection to original works of art.⁴⁸ But what happens when the original work is reproduced for sale without permission of the celebrity subject for sale to the general public? To decide this, the court developed the *transformative elements test*.⁴⁹ The *Comedy III* court stated that, in order to evoke the protection of the First Amendment, the

³⁶ *Id.* at 801.

³⁷ *Id.*

³⁸ *Id.* at 801-02.

³⁹ *Id.* at 801.

⁴⁰ *Id.*

⁴¹ *Id.* at 802.

⁴² *Id.* at 801.

⁴³ *Id.* at 802-11.

⁴⁴ *Id.* at 809.

⁴⁵ *Id.* at 802.

⁴⁶ *Id.*

⁴⁷ *Id.* at 810.

⁴⁸ CAL. CIV. CODE § 3344.1(a)(2) (West 2008).

⁴⁹ *Comedy III*, 21 P.3d at 809.

court must look to the actual creation to determine what extent the work is “transformative.”⁵⁰ But what exactly is, “transformative?” In its most explainable form, a work is *transformative* when it has elements the artist has added that give “significant expression” beyond the original work.⁵¹ In these cases, the “original work” is really that of the image or “likeness of the celebrity.”⁵² The *Comedy III* court refused First Amendment protection.⁵³

Saderup failed to create a work that was uniquely his. His *reproductions* were nothing more than a literal rendering of the Three Stooges in charcoal.⁵⁴ The California Supreme Court said that the literal rendering failed to have any transformative elements from the original image of the celebrity and, without that, the First Amendment defense simply does not apply.⁵⁵ Saderup simply did not do enough to add his own artistic vision to the drawing of the Three Stooges.

Many artists, especially those out of the sixties’ pop art movement, used celebrities as the subject of their art. Andy Warhol’s portraits of Marilyn Monroe, Chairman Mao, and James Dean are examples of popular culture lending itself to art.⁵⁶ Certainly, Warhol (or his estate) can sell recreations of “Marilyn” without having to pay royalties or even get permission from Marilyn Monroe’s estate. The age of Marilyn has enough transformative qualities to it that it is known as an important work by Warhol and famous as a Warhol work, rather than simply as an image of Marilyn Monroe.⁵⁷ Although there is little doubt that Warhol’s intent was not only to create art but to earn money, it does not appear that his immediate goal was to put the paintings on T-shirts for sale.



Although Warhol is an excellent example of a famous artist, a less famous artist is not left out of the analysis under *Comedy III*, requiring only transformative elements to relieve an artist from the grasp of the celebrity’s rights.⁵⁸ However, a jury of twelve could have ruled differently. The California Supreme Court, by reviewing the case without remand, acted as the curator of the museum to decide whether or not there was a significant enough transformation to give Saderup’s work First Amendment protection

⁵⁰ *Id.*

⁵¹ *Id.* at 808.

⁵² *Id.* at 809.

⁵³ *Id.* at 810.

⁵⁴ *Id.* at 801.

⁵⁵ *Id.* at 811.

⁵⁶ Zeke Quezada, Press Release, About.com, Andy Warhol: The Celebrity Portraits, <http://govegas.about.com/cs/familyfun/a/warhol.htm> (last visited Apr. 21, 2008) [hereinafter *Celebrity Portraits*].

⁵⁷ *Id.*

⁵⁸ *Comedy III*, 21 P.3d at 808.

as a serious work of art. It is this author's opinion that, although the "art" that Saderup created was woefully short of transformative elements, his clear intention to simply sell T-shirts should have played a more pivotal role in the court's analysis. If Saderup had created a one of a kind drawing, which then hung on a museum wall for a number of years and achieved its own fame as a work of art, it is extremely unlikely that the court would have reached the same conclusion.

Although the right of publicity won the battle against the First Amendment in *Comedy III*, the California Supreme Court's transformative elements test set the stage for a First Amendment takeover. The case of *Winter v. DC Comics* was the first to truly interpret the rule developed by the *Comedy III* court.⁵⁹ In *Winter*, the Winter brothers, Johnny and Edgar,



a long-time singing duo with distinct long white hair and extremely fair skin, sued DC Comics for the publication of *Jonah Hex*.⁶⁰ *Jonah Hex* was a five volume comic series featuring the Autumn Brothers, a pair of half snake, half human killers named Johnny and Edgar.⁶¹ Both carried weapons—one a pistol, the other a rifle—and were evil characters.⁶²

Fig. 1 The Autumn Brothers of Jonah Hex



Fig. 2 Johnny Winter



Fig. 3 Edgar Winter

⁵⁹ 69 P.3d 473, 476 (Cal. 2003).

⁶⁰ *Id.* at 476.

⁶¹ *Id.*

⁶² *Id.*

The Winter brothers sued DC Comics for misappropriation of their right of publicity for basing the Autumn Brothers characters on them.⁶³ DC Comics defended on First Amendment grounds and won summary judgment in the trial court.⁶⁴ The court of appeal originally affirmed the trial court's grant of summary judgment for DC Comics, but, on instruction from the California Supreme Court, reversed its decision and remanded, stating that there were triable issues of fact which existed with regard to California Civil Code section 3344.⁶⁵ Interestingly, *Winter*'s first visit to the supreme court was delayed because of the *Comedy III* decision, which the court decided first.⁶⁶

In the second round, the court of appeal affirmed summary judgment on all counts except misappropriation under California Civil Code section 3344 and remanded the case to the trial court.⁶⁷ DC Comics petitioned the California Supreme Court to review the matter again for determination that the use, as a matter of law, was not a misappropriation of the Winters' likenesses.⁶⁸

The supreme court, in its first right of publicity decision since *Comedy III*, granted review.⁶⁹ The court specifically addressed the economic issue inherent in section 3344, stating that the rights conveyed by the statute are economic.⁷⁰ Addressing the issue much like claims under the Lanham Act,⁷¹ the court looked at the monopolization of the celebrity's likeness by the owner.⁷² The celebrity can still "monopolize the production of conventional, more or less fungible, images of the celebrity" with regards to memorabilia.⁷³ However, when the creation contains "significant transformative elements" that remove it from the general economic crossover that may be found in celebrity memorabilia, the defendant is entitled to First Amendment protection because it is less likely to interfere with the economic interests that the statute is designed to protect.⁷⁴ The court posed the question of whether or not the DC Comics creation of *Jonah Hex* was something with which the Winter brothers should be economically concerned.⁷⁵

The obvious challenge that courts must face is to define, "significant transformative elements." In doing so, *Winter* looked to the language of

⁶³ *Id.* The Winter Brothers also filed suit for defamation, which is not discussed here. *Id.*

⁶⁴ *Id.*

⁶⁵ *Id.*

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Id.*

⁶⁹ *Id.*

⁷⁰ *Id.* at 477-78.

⁷¹ 15 U.S.C. §§ 1051-1141n (2000).

⁷² *Winter*, 69 P.3d at 477-78.

⁷³ *Id.* at 477.

⁷⁴ *Id.*

⁷⁵ *Id.* at 478.

Comedy III: “[E]xpression of something other than the likeness of the celebrity”⁷⁶ and “[a]n artist depicting a celebrity must contribute something more than a ‘merely trivial’ variation, but must create something recognizably ‘his own’ in order to qualify for legal protection.”⁷⁷ The court continued: “[W]hen 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, then the artist’s right of free expression is outweighed by the right of publicity.”⁷⁸ The court continued to explore the transformative elements added by the artist, whether or not the work was worthy of First Amendment protections due to the artist’s contribution to the celebrity’s likeness, and to what extent the new work’s economic interest is furthered by the involvement of the celebrity.⁷⁹

The supreme court held in favor of DC Comics, determining that the economic interests of the Winter Brothers were not infringed when weighed against the interests of the First Amendment.⁸⁰ The court suggested that the use by DC Comics was not one with which the Winter brothers should be concerned, because the brothers were a singing duo who likely would not have an economic interest in a comic book and whose particular fans do not really care about them in cartoon form.⁸¹

However, as further discussed below, the court should not simply be looking at whether or not the fans should care, as the publicity right is, and should be, based on the origination of the likeness. The Winter brothers should be allowed to control their likeness and decide where, when, and how it can be used. Where it came from, how it was imagined and who should control that use is a key pillar of the right of publicity that the courts are now retreating from in the face of the First Amendment.

The court addressed this case using the First Amendment argument based on the transformative nature of the work.⁸² And, in this instance, the court, stepping in as the trier of fact, concluded that the work was entitled to First Amendment protection.⁸³ The court could have put before the jury the questions: (1) whether the work was a transformative use of the Winters’ images; and (2) whether the intent of DC Comics was to merely capitalize on the fame and persona of the Winter brothers as a vehicle to draw prospective readers. Looking to commercial intent, in addition to the transformative elements, creates a more complete analysis to decide the question of whether or not there is an economic misappropriation. The issue of whether or not this infringed on the economic interests could have been put

⁷⁶ *Id.* (quoting *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001)).

⁷⁷ *Id.* (quoting *Comedy III*, 21 P.3d 797).

⁷⁸ *Id.* (quoting *Comedy III*, 21 P.3d 797).

⁷⁹ *Id.*

⁸⁰ *Id.* at 480.

⁸¹ *Id.* at 479.

⁸² *Id.*

⁸³ *Id.*

to a jury. In this author's opinion, the court was not incorrect in its finding because of the significant level of transformative elements; however, in cases that are less certain, the court's ruling as a matter of law causes strain on the transformative elements test.

In *Kirby v. Sega of America, Inc.*, a California appellate court was called on to review another case involving *transformative elements*.⁸⁴ Kierin Kirby was the lead singer of the early 1990's band, Deee-Lite.⁸⁵ She performed as lead of the band with great devotion as a character she developed, "Lady Miss Kier."⁸⁶ Kirby's celebrity and public persona was based more on her fame from Deee-Lite and as Lady Miss Kier than anything else.⁸⁷ Lady Miss Kier had a distinctive style that Kirby is still known for



today, combining retro and futuristic looks with signature platform shoes, knee-socks, unitards, short pleated skirts (generally plaid), and sporting a bare midriff and backpack.⁸⁸ Kirby also claims the lyrical expression "ooh-la-la", which she sings in Deee-Lite's most popular song, "Groove is in the Heart."⁸⁹ Although Kirby had not put out an album, with or without Deee-Lite, in many years, she maintained a distinct following for Lady Miss Kier.⁹⁰

Enter Sega.⁹¹ Sometime between 1997 and 1999 an employee from Sega Japan created *Space Channel 5*, a video game targeted to teenage girls.⁹² *Space Channel 5*'s main character was Ulala, a female reporter who is dispatched to investigate aliens who are invading Earth by causing uncontrollable dancing.⁹³ Ulala was outfitted with several different costumes throughout the game, but was primarily seen in a miniskirt, elbow-length gloves, stiletto-heeled knee-high platform boots and hot pink

⁸⁴ 50 Cal. Rptr. 3d 607 (Ct. App. 2006)

⁸⁵ *Id.* at 609.

⁸⁶ *Id.*

⁸⁷ *See id.*

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ Sega was not the only defendant in the case. *Id.* at 611. THQ and AGETEC were also defendant parties. *Id.* THQ as a licensee for the handheld version of the game for Nintendo and AGETEC for their license to distribute for the Playstation platform. *Id.* at 610.

⁹² *Id.* at 609.

⁹³ *Id.* at 610.

hair tied in two dramatic ponytails.⁹⁴

After Sega had released the game in several formats, Sega contemplated using the Deee-Lite song, "Groove is in the Heart" to promote the game. They even contacted Kirby to see if she, as Lady Miss Kier, would promote the game.⁹⁵ She refused and, in 2003, sued Sega for infringement of the common law right of publicity, violation of California Civil Code section 3344, violation of the Lanham Act, unfair competition and interference with prospective economic advantage.⁹⁶

Sega moved the court for summary judgment on two grounds. First, Sega argued that Kirby failed to meet all of the elements required for her claims.⁹⁷ Additionally, Sega asserted that the First Amendment was a complete defense to the action.⁹⁸ Under the appellate court's analysis, it is apparent that the first part of Sega's defense was simply not necessary. The trial court had found that material factual issues existed as to whether Sega had misappropriated Kirby's likeness by their creation of the Ulala character, and the appellate court agreed.⁹⁹ There were material issues of fact whether Ulala was based on Kirby under both common law and statute.¹⁰⁰ However, the court stated that it was unnecessary to carry the analysis that far, as the First Amendment was a complete defense to Kirby's claims.¹⁰¹

The court, immediately citing *Comedy III* and *Winter*, looked to the transformative elements and inquired whether "the defendant's work 'adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.'"¹⁰² The court further stated that the transformative nature of the work would make it "less likely to interfere with the economic interests protected by the right of publicity."¹⁰³ The court, in reaching its decision, did not give any weight to the fact that Sega approached Kirby to endorse the game prior to its release.¹⁰⁴ As such, the court completely ignored Sega's commercial intent when creating the Ulala character.

Kirby insisted that the Ulala character was, indeed, her, simply with "digital enhancements and manipulations."¹⁰⁵ The court did not agree with this argument and felt that Kirby and the Ulala character, although they shared similarities, had sufficiently different hairstyles, clothing, look, and

⁹⁴ *Id.*

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ *Id.* at 613.

¹⁰⁰ *Id.* at 614.

¹⁰¹ *Id.*

¹⁰² *Id.* at 615 (citations omitted).

¹⁰³ *Id.*

¹⁰⁴ *See id.* at 615–18.

¹⁰⁵ *Id.*

even dance moves.¹⁰⁶ The court, despite Kirby's insistence, refused to reject the *transformative elements* test and reaffirmed *Comedy III's* analysis.¹⁰⁷ Although it certainly could be argued that Kirby based her own character, Lady Miss Kier on Japanese *anime* style and is, therefore, not entitled to any protection because it was not developed by her, the character that she developed is clearly entitled to protection under both the common law and statutory right of publicity, at least to some extent. The court did address the similarities between Lady Miss Kier and Ulala and dismissed them by simply stating that, although there were some similarities, Sega's actions were protected by the First Amendment due to the transformative elements that were present.¹⁰⁸

Should jurists really be determining what is "art"? None of the three cases discussed here, although stating that the transformative elements test is a factual question, actually allowed a jury—or even a trial court judge—to make the determination, as each was decided by a panel.¹⁰⁹ The Kirby court's application of the transformative elements test, which left out the actual balance in the economic interest as enunciated in *Comedy III*, may have led to an inconsistent result. It is unknown whether a jury would have decided the fate of Lady Miss Kier the same as the appellate court panel.¹¹⁰

CONCLUSION

The rulings from the above three cases are interesting from more than simply a legal perspective. The rulings affect our popular culture and the money derived from our popular culture. The rights protected by section 3344 are, as defined by the courts, economic rights and the right to control the economic aspects of a celebrity's persona and the economic interest the celebrity built in to that persona.¹¹¹ According to the courts, a bit of tweaking here and there to the image or likeness or the name may allow an "unauthorized" artist to capitalize on that persona.¹¹² Without something more, *the transformative elements* test is incomplete. The court must also look to the commercial intent of the defendant. If we look at the facts of the three cases on a use scale that combines the transformative elements, as well as the commercial nature or intent of the defendant, the court could give better direction as to what is violative of the First Amendment. *Comedy III* was essentially a direct copy of a basic image of the Three Stooges and con-

¹⁰⁶ *Id.* at 615–17.

¹⁰⁷ *Id.* at 616–18.

¹⁰⁸ *Id.* at 615.

¹⁰⁹ *Id.* at 608; *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 799 (Cal. 2001).

¹¹⁰ One can judge for oneself. A montage of Lady Miss Kier and Ulala has been assembled on YouTube. Who Came First—Ulala or Lady Kier?, <http://www.youtube.com/watch?v=IpyI75Wd8ug> (last visited Mar. 28, 2008).

¹¹¹ See CAL. CIV. CODE § 3344 (West 2008).

¹¹² *Kirby*, 50 Cal. Rptr. 3d at 615.

verted into a charcoal drawing for the specific intent of selling T-shirts.¹¹³ This is a clear violation of the economic interest of the celebrity. There is little question that this level of use should be stopped. On the other end of the scale is the *Winter* case, where the use has little intent and is highly transformative. The characters developed by DC Comics had little, if anything, to do with the Winter brothers, other than some basic level of inspiration as to their overall look of the caricature.¹¹⁴ There was little to do with the public persona that Winter brothers had established. Further, the creation of a comic book, which many consider art in a form similar to movies or television, would be entitled to a higher level of protection. Combining the two analyses would give a more defined result.

Carefully viewing the commercial intent could lead to a different conclusion in *Kirby*. Keiran Kirby (or, as she was better known to the public, Lady Miss Kier) was clearly more than simple inspiration for the Ulala character in the Sega video game. Her hair, clothes, backpack, and overall style were almost identical to the video game character. Further, Sega went so far as to contact her to promote the game.¹¹⁵ Sega's intent could be looked at as attempting to further connect the two characters. Despite these obvious connections, the obvious inspiration, and the clear recognition of the character to Lady Miss Kier to the Sega character, the court blocked her attempt at the misappropriation claim by simply stating that the elements to the character were transformed enough to be protected by the First Amendment—without having a jury make that decision.¹¹⁶ Sega's commercial intent is slightly less clear. We know that Sega attempted to have Kirby and her band's song to promote the game.¹¹⁷ The persona that Sega used could be argued to be for the purpose of selling more video games. A jury balancing these elements together could clearly render a different result.

Paying attention to the commercial nature in addition to the “transformative use” certainly assists the trier of fact in its determination. What is the actual difference between *White* and *Kirby*? In *White*, White's persona was transformed into a robot that turned letters on a board, an action that was very similar to her day job.¹¹⁸ The robot was specifically used to sell through a television commercial.¹¹⁹ In *Kirby*, the use was a video game. Ulala was arguably based on Kirby to attract the specific demographic to which Kirby appealed. Therefore, Sega used the persona to capitalize on the demographic and fan base that Kirby built, thus heightening the commercial nature of their use. Leaving out the commercial nature of

¹¹³ *Comedy III*, 21 P.3d 797.

¹¹⁴ *Winter*, 69 P.3d 473.

¹¹⁵ *Kirby*, 50 Cal. Rptr. 3d at 610.

¹¹⁶ *Id.* at 616.

¹¹⁷ *Id.* at 613.

¹¹⁸ *White v. Samsung*, 971 F.2d 1395, 1396 (9th Cir. 1992)

¹¹⁹ *Id.*

the analysis can severely damage the rights the statutes are designed to protect. The *Winter* court did address the economic right but quickly dismissed the Winter brothers' claim that DC Comics had impaired such right by stating that transformative works, especially those that are worthy of First Amendment protection, are less likely to interfere with the economic interest protected by the right of publicity.¹²⁰ Further, the court asserted that the statute's purpose is to protect the celebrity's economic right, i.e., the right to distribute its own memorabilia.¹²¹ This approach leaves out what celebrity has truly become to our pop culture.

America has been dominating the market on celebrity culture since before the first frame of film was shot in Hollywoodland in the late 1800's. Through the 1800's, showman wrestlers, circus performers, and boxers were known wherever there were newspapers—not just in America, but worldwide. Certainly, P.T. Barnham was one of the first to control the economic right and capitalize on the fame of a celebrity.

Just as the world focuses our collective attention on the celebrity, the celebrity focuses its attention on trying to exploit and monetize it—as is its right. The right of the celebrity to control its economic rights is bounded only by the tenets of the First Amendment.¹²² As the *Kirby* case shows us, Sega, with a far greater ability to reach millions of people than Lady Miss Keir ever could, has stumbled onto a new outlet for exploiting the fame of a celebrity apart from the celebrity's own rights. Just as Sega developed a game—arguably based on the persona of Lady Miss Kier—one can imagine a game based on two debutante sisters, both tall, thin and attractive, who have to save the world by attending parties and driving in convertible Bentleys. One could also imagine a game based on an Austrian bodybuilder who must build an empire on his way to becoming a top politician. In recognition of the recent decisions and the light standard that the court has now set to earn First Amendment protection, creators and artists could create characters truly based on celebrities without their permission or authorization as long as it is *transformed* enough from the literal image of the celebrity.

Allowing First Amendment protection based solely on considerations of transformative elements, without recognition of commercial intent, circumvents too much of the statute's protections. As discussed above, Andy Warhol often used celebrities as the subject of his work.¹²³ However, Warhol's dominant motive was not simply to sell T-shirts or lithographs or video games bearing his creation. His dominant motive was to actually create

¹²⁰ *Winter v. DC Comics*, 69 P.3d 473, 477 (Cal. 2003) (citing *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001)).

¹²¹ *Id.*

¹²² *Id.* (“We noted that the right of publicity threatens two purposes of the First Amendment: (1) preserving an uninhibited marketplace of ideas; and (2) furthering the individual right of self-expression.”).

¹²³ See *Celebrity Portraits*, *supra* note 56.

a work of art. Warhol uses celebrities as the focus of his work to show us just how celebrity-driven our culture is. However, regardless of the motive, his works became known more as the work of Warhol than the celebrities they depicted. They were not literal depictions and certainly had “transformative elements,” but in many cases there was little difference between the work he created and a literal image of the celebrity. The Marilyn Monroe painting is a good example of this. There is no question that the painted image is simply Marilyn in a distorted color pattern. However, the painting became known as an artistic work by Warhol, rather than simply an image of Marilyn.

Even if the painting was by a different artist, as long as the artist’s rendition becomes known for its own merit apart from the celebrity it no longer infringes on the celebrity’s economic interests. A Warhol effect, so to speak. If Saderup’s sketch of the Three Stooges had become famous on its own, it would be difficult for the court to stop Saderup’s commercialization of the sketch.

The *Winter* court discussed the Winter brothers’ lack of exploitation in the comic book market.¹²⁴ However, as our culture has an ever-growing fascination with “celebrity,” and with the amazing avenues a celebrity and its team of advisors can use to exploit its fame, celebrities *should* have the right to pursue any and all avenues. The right of publicity should protect all avenues for the celebrity, whether a particular judge believes they can be exploited or not. Clothing lines, bottled waters, luggage lines, sunglasses, sunscreens . . . how about a line of Nicole Ritchie baby care books . . . or Brett Favre hand warmers . . . are all commercial and are more obvious economic interests. It is not hard to imagine a comic book series starring Jessica Simpson and her boyfriend-of-the-moment. Should she not have the right to exploit that economic interest?

The courts’ failure to look beyond the sketch, the image, or the digitized version is likely to further the misuse of celebrity name and likeness. Courts should instead look to the dominant motive and the strength of the artwork itself, and the notoriety it has gained on its own.

It is unlikely that we will see legions of unauthorized Arnold Schwarzenegger copies in digitized form for a video game without his name or voice, which would be protected under the statute. If the theory of transformative elements is followed, however, without consideration of the commercial intent, commercialization of celebrities’ images, without authorization for a myriad of uses, will continue to be viable. A court must also take into consideration the intent of the defendant along with the transformative elements to form a more complete test to protect both the right of publicity and First Amendment guarantees.

¹²⁴ *Winter*, 69 P.3d 473.

