

## First Amendment Defeats Right of Publicity Claims Against Electronic Arts' NCAA Football Video Games

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On Sept. 9, 2011, Judge Freda Wolfson of the United States District Court for the district of New Jersey issued a 67 page opinion that is not only the latest in a series of decisions involving Electronic Arts' (EA) sports video games but is also a significant contribution to the law on the interplay between the First Amendment and the right of publicity. In *Hart v. Electronic Arts, Inc.*, Civil Action 09-cv-5990, Judge Wolfson granted summary judgment for EA on the claims of a putative class of NCAA football players that EA had misappropriated their likeness and identity for a commercial purpose in violation of New Jersey law. The Court found that defendant's First Amendment right to free expression outweighed plaintiff's right of publicity.

Plaintiff Ryan Hart, a former quarterback for Rutgers University, had brought suit in Superior Court, New Jersey on behalf of himself and others similarly situated alleging, *inter alia*, that EA had violated his right of publicity by misappropriating his likeness as a virtual player in four editions of EA's *NCAA Football* video game. After EA removed to Federal Court, it moved to dismiss. Judge Wolfson granted the motion, but gave Hart leave to file an amended complaint to allege additional facts in support of his right of publicity claim.

The amended complaint alleged that EA misappropriated Hart's likeness by including in several editions of the game a virtual Rutgers player from his home state, bearing his jersey number, incorporating his physical attributes (such as height, weight, hair color and style) and preferences (wrist band, helmet visor), as well as his skills (such as his speed and agility rating and passing accuracy, all derived from his published season statistics). Hart argued that the games' commercial value derived from the wholesale appropriation of the individual players' identity and the resulting "realism" of the games. He further argued that the use of a photograph of Hart in a photomontage in the game constituted an unauthorized promotional use of his image.

Solely for purposes of its summary judgment motion, EA conceded that it used Hart's likeness within certain versions of *NCAA Football*. It argued, however, that as expressive speech, the games should be afforded full First Amendment protection, which here outweighed the plaintiff's publicity interests.

The Court agreed. In an especially thorough and scholarly opinion, the Court began by walking through the distinction between commercial and expressive speech and, relying on the recent Supreme Court decision in *Brown v. Entertainment Merchants Ass'n*<sup>1</sup>, concluded that the games, like other forms of entertainment, were expressive. The photograph did not constitute promotion or advertising "because this photograph is part of the video game itself, the commercial transaction has already taken place." To

determine whether the First Amendment trumped Hart's New Jersey common law right of publicity, the Court examined the origin and development of the right of publicity, New Jersey's adoption of the Restatement (Second) of Torts, the shift from a right-of-privacy-based tort to a property-based one, and the history of the application of the First Amendment to the right of publicity, leading to the various tests that courts have employed across the country to balance those competing interests. The primary tests, and those examined at length by Judge Wolfson, are the transformative test, urged in his papers by Hart, and the *Rogers* test, advocated by EA, and it is here that the decision makes its greatest contribution to this area of the law. Although expressing a preference for the transformative test because "it best encapsulates the type of nuanced analysis required to properly balance the competing . . . interest[s]," the Court found that EA prevailed under either test.

The Court explained that the transformative test, which has its origins in the fair use analysis of copyright law and has been applied in a number of jurisdictions, looks to the extent that the likeness has been transformed by expressive changes or additions in the new work, or, in the words of the California Supreme Court, whether "the celebrity likeness is one of the 'raw materials' from which an original work is synthesized, or whether the depiction of the celebrity is the very sum and substance of the work in question."<sup>2</sup> Reviewing recent cases applying the transformative test, including to videogames, the Court concluded that EA's use of plaintiff's likeness was transformative.<sup>3</sup> Although the game structure begins with an avatar that incorporates many elements of Hart's likeness and that of other college players, EA designers added many interactive expressive features that create a new work out of that likeness, including virtual stadiums, coaches, fans, sound effects, music and commentary. Key to the Court's decision was that the game permits users to alter many of the players' physical characteristics and skills, change the composition of teams, and determine the outcome of individual games and the entire season in a multitude of different ways. This interactive element is what distinguishes *NCAA Football* from the works at issue in other cases that have failed the transformative test.

The Court went out of its way to address the contrary holding in *Keller v. Electronic Arts, Inc.*<sup>4</sup> a putative class action involving the same series of video games. There, denying EA's motion to dismiss under California's anti-SLAPP statute, the district court for the Northern District of California held that *NCAA Football* was not sufficiently transformative. Noting that the present motion for summary judgment embraced a broader factual record, Judge Wolfson criticized the *Keller* court's failure to take into account the expressive nature of the interactive features of the game and its overly narrow focus on the alleged likeness alone instead of the game as a whole. "[I]n my view, it is logically inconsistent to consider the setting in which the character sits, which *Keller* does in its analysis, yet ignore the remainder of the game."

The *Rogers* test, developed by the Second Circuit in *Rogers v. Grimaldi*, was derived from protections against false endorsement under the Lanham Act, and has been applied to a number of right of publicity claims in that and other circuits. In essence, the test asks whether the challenged work is wholly unrelated to the underlying work or

whether the use of the plaintiff's name or likeness is a disguised commercial advertisement. Although Judge Wolfson praised the clarity of its application, she questioned whether a test derived from trademark law was properly applicable to a right of publicity claim and whether it struck the right balance between the competing interests. Nonetheless, applying the test to the facts at issue, Hart's image was clearly not wholly unrelated to *NCAA Football*, nor was its incorporation into the game a "disguised commercial advertisement" indicating his endorsement or creative input. Summary judgment was therefore appropriate under this test as well.

This decision appears while the appeal of the *Keller* decision is still pending before the Ninth Circuit. It remains to be seen whether Judge Wolfson's thorough analysis of the issues will be reflected in the Ninth Circuit's decision.

EA was represented in this case by Elizabeth McNamara, Christopher Robinson and Sam Bayard of Davis Wright Tremaine's New York office, with assistance from Bruce Rosen at McCusker, Anselmi, Rosen & Carvelli, P.C as local counsel.

## FOOTNOTES

- <sup>1</sup> *Brown v. Entertainment Merchants Ass'n*, 131 S.Ct. 2729 (2011).
- <sup>2</sup> *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 406 (2001).
- <sup>3</sup> E.g., *Winter v. DC Comics*, 30 Cal. 4th 881 (2003) (comics); *Hilton v. Hallmark Cards*, 580 F.3d 874 (9th Cir. 2009) (greetings card); *Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47 (Cal. App. 2006) (video game); *No Doubt v. Activision, Inc.*, 192 Cal. App. 4th 1018 (Cal. App. 2011) (video game).
- <sup>4</sup> No. C 09-1967, 2010 WL 530108 (N.D.Cal. Feb. 6, 2010), appeal pending (No. 10-15387). Kelli Sager and Al Wickers of Davis Wright Tremaine's Los Angeles office, Jake Schatz at EA and Jamie Slaughter at Keker Van Nest are lead counsel representing EA in its appeal to the Ninth Circuit.

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