

PEOPLE FOR THE ETHICAL TREATMENT OF OBAMA

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I. INTRODUCTION

In January 2010, People for the Ethical Treatment of Animals (“PETA”) began an advertising campaign in Washington, D.C. to promote its efforts to make the city fur-free.¹ The advertisement included a picture that digitally remixed preexisting photographs of Michelle Obama, Carrie Underwood, Oprah Winfrey and Tyra Banks to make them appear as if they were posing together in glamorous attire for an important public event.² The ad was captioned with the title, FUR-FREE and Fabulous!, and included two prominent references to PETA – its logo and the statement “Read all about it at peta.org.”

The website indicated that Oprah Winfrey had worked actively to educate viewers about animal rights and was PETA’s person of the year in 2008.³ It also stated that Tyra Banks publicly renounced fur by modeling a hat with one of PETA’s “no fur” buttons. In addition, the site reported that PETA had voted Underwood its Sexiest Vegetarian alive and provided quotes from several other celebrities who directly criticized the use of fur for fashion. However, the only information about Michelle Obama was a statement from her deputy press secretary that “Mrs. Obama does not wear fur.”⁴

The White House immediately objected to the use of Obama’s image, and asked the organization to take down the ads. Although PETA swiftly complied with the request, the organization refused to admit that it had violated Obama’s legally protected rights.⁵ In this regard, PETA stated that it was on firm legal ground because the advertisement used Obama’s image simply to provide PETA’s opinion about a reported factual matter.⁶ Nonetheless, PETA decided to remove the advertisements to “show good faith”, undoubtedly recognizing that it would be strategically counter-productive to alienate the first lady when she might otherwise be predisposed to support animal rights.⁷

If PETA had not voluntarily removed the ads, the dispute would have raised fascinating and difficult issues regarding the limits of intellectual property rights in the face of the First Amendment. For instance, Obama might have claimed that the ad would have led people to believe that she had some affiliation with PETA or endorsed its

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¹ The advertisement appeared as a poster at a couple Metro stations and was also displayed on a PETA van.

² PETA incorporated the image of Michelle Obama from her official White House portrait photograph.

³ <http://www.peta.org> (last visited on June 16, 2010).

⁴ The site told viewers to learn more information about its work to make D.C. fur free in the spring issue of *Animal Times* and to watch a video on animal cruelty called *Fashion Victims*.

⁵ As of June 16, 2010, a reproduction of the advertisement can still be viewed on the website in the archives.

⁶ See e.g., Robin Givhan, *The Obamas, Unwilling Product Pitchmen*, WASH. POST, Jan. 8, 2010, at C1. (Ingrid Newkirk, president of PETA, stated, “This is reporting a statement of fact: She doesn’t wear fur. And our opinion: We think that’s fabulous”).

⁷ *PETA Pulls Ads Featuring Michelle Obama*, USA TODAY, Jan. 12, 2010.

positions, thus implicating trademark-like rights. In addition, the appearance of the ads could have reduced Obama's opportunities to someday cash in on her celebrity, thereby infringing her right of publicity. Any enforcement of Obama's claims, though, would have interfered with PETA's First Amendment right to freely use words and images to express its opinion about a public figure. Thus, as is true in so many cases involving intellectual property, resolution of the dispute would have required a court to delicately balance the competing interests to best serve social welfare.

This article uses PETA's advertisement to address some of the important variables that drive court decisions when trademark and publicity rights clash with the First Amendment. As we shall see, courts use several approaches to guide their thinking, such as the degree of transformation, the necessity of the use and the relevance of the subject to the issues involved. While considering the application of these tests to PETA's ad, it becomes clear that courts strive to distinguish uses of names or images that are central to the matters involved from those that are merely opportunistic ways to gain attention to tangential concerns. Framing the debate in these terms may prove to be extremely useful. For instance, along with the other tests, it helps to substantiate the potentially controversial conclusion that PETA's inclusion of Obama's image was probably unlawful, notwithstanding the veracity of its content and the public importance of the debate. It also may give the legal community a more coherent approach to evaluate other digital imaging debates that are sure to arise in the future.

II. THE FIRST AMENDMENT AND ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

PETA's advertising campaign combined statements and photographs in a clever way to celebrate the fact that several famous women, including Michelle Obama, do not wear fur. On first blush, this appears to be just the kind of speech the reaches to the core of the First Amendment, which supports "a profound national commitment to the principle that debate on public issues should be uninhibited, robust, and wide-open."⁸ In these instances, the courts have consistently prevented enforcement of laws that deter the speech because the policies are not supported by sufficiently compelling governmental interests.⁹ Nor did PETA's decision to express its view by incorporating Obama's image in an artistic collage depreciate the value of its opinion, or extent of protection, under the First Amendment.¹⁰ Thus, one's instinct may be that PETA's position was a slam dunk in its favor. Nevertheless, the First Amendment does not protect all speech with equal force, thus opening the door to various permissible restrictions, including many imposed through intellectual property laws. Often, this requires courts to establish controversial methods to weigh competing interests in intellectual property cases.

⁸ *N.Y. Times v. Sullivan*, 376 U.S. 254, 270 (1964).

⁹ *See, e.g., Austin v. Michigan State Chamber of Commerce*, 494 U.S. 652, 657 (1990).

¹⁰ *See Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 804 (Cal. 2001).

For example, a court once had to address the constitutionality of the Digital Millennium Copyright Act, which among other things, prevents individuals from posting computer code that is designed to disable copyright protection systems.¹¹ Since computer programs involve documentation that can be read by programmers, those challenging the law claimed that the DMCA's restrictions infringed on their free speech rights to share research.¹² The court disagreed, though, because computer programs not only express words and ideas, but also control the operations of a machine.¹³ In effect, they speak and act at the same time, which the court compared to expressive conduct.¹⁴ The Supreme Court has long held that the government has leeway to regulate this kind of speech as long as it has sufficiently important reasons to deter the conduct.¹⁵ Based on this analogy, the court approved of the DMCA because the statute satisfied the legitimate goal of protecting copyrights without unduly burdening the programmers' speech interests.¹⁶

Beyond the DMCA, copyrights raise numerous other First Amendment debates because authors, musicians and artists so often incorporate preexisting copyrighted material into their works for socially valued objectives, such as critical inquiry. The Copyright Act accounts for their free speech rights through the fair use exception, which establishes a flexible balancing approach based on four principles, including the purpose of the use and the resultant market effect.¹⁷ In this regard, the Supreme Court has put a premium on new works that are transformative by, for instance, having a different purpose or character than the original.¹⁸ The Court also requires that no more of the preexisting work be taken than is necessary to achieve the transformative result.¹⁹

¹¹ Universal City Studios, Inc. v. Corley, 273 F.3d 429 (2d Cir. 2001).

¹² *Id.* at 445-49.

¹³ *Id.* at 451.

¹⁴ *Id.* at 450-53.

¹⁵ *See, e.g.*, United States v. O'Brien, 391 U.S. 367, 376-77 (1968).

¹⁶ *Corley*, 273 F.3d at 454-55.

¹⁷ *See, e.g.*, Consumers Union of United Scientists v. General Signal Corp., 724 F.2d 1044, 1048 (2d Cir. 1983) ("The fair use doctrine balances the public interest in the free flow of ideas with the copyright holder's interest in the exclusive use of his work."). The fair use exception to copyright infringement is provided in section 107 of the Copyright Act, 17 U.S.C. §107 (1976). The statute provides that a fair use of materials for criticism, comment, news reporting, teaching, scholarship or research does not constitute infringement. The section further clarifies the relevant factors that must be weighed in a fair use analysis:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes,
- (2) the nature of the copyrighted work,
- (3) the amount and substantiality of the portion used; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

Id.

The Supreme Court has made it clear that fair uses are not confined to the "productive" uses listed in the preamble, but can extend to other kinds of uses, such as entertainment. *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 455 n.40 (1984).

¹⁸ *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578-79 (1994).

¹⁹ *Id.* at 588.

Another area touching on intellectual property is defamation, which typically may be banned because no public purpose would be served by protecting false and harmful statements of this nature.²⁰ However, even here, the Supreme Court has recognized that a balancing of interests may sometimes be necessary when the topics involve public figures, since those commenting on public matters may make mistakes when they air their views.²¹ If those engaged in speech about public events feared that they could be sued for every utterance they make, they undoubtedly would err on the side of safety and overly restrict their comments.²² For this reason, the Court has determined that the First Amendment protects those making false statements about public figures from liability for defamation unless the statements are made with reckless disregard for the truth.²³ Digital remixing, of course, is often used to create false realities, which can be defamatory if reasonable viewers do not recognize the manipulations. As we shall see, when the subjects are public figures, such as Michelle Obama, several competing rights and considerations must be weighed.

The Supreme Court has also ruled that commercial speech deserves a lower level of First Amendment protection than noncommercial speech and so the government has greater leeway to regulate it, even when it is truthful.²⁴ Furthermore, the government has the authority to ban commercial communications that are more likely to deceive the public than inform it.²⁵ This exclusion accounts for the basic constitutionality of trademark laws because they are intended to prevent confusion and false sponsorship.²⁶ However, as this article will demonstrate, laws protecting trademark right raise troubling First Amendment issues when protected images and symbols are used for other purposes besides causing deception, even if some confusion results in the process.²⁷ For instance, those viewing PETA's ad may have

²⁰ See *N.Y. Times v. Sullivan*, 376 U.S. 254, 268 (1964).

²¹ *Id.* at 271 (stating that “erroneous statement is inevitable in free debate”).

²² *Id.* at 279 (recognizing that “would-be critics . . . may be deterred from voicing their criticism, even though it is believed to be true and even though it is in fact true, because of doubt whether it can be proved in court or fear of the expense of having to do so.”).

²³ *Id.* at 279-80.

²⁴ *Central Hudson Gas & Elec. Corp. v. Public Service Commission of N.Y.*, 447 U.S. 557, 562-63 (1980).

²⁵ *Id.* at 563.

²⁶ See Rebecca Tushnet, *Trademark Law as Commercial Speech Regulation*, 58 S. C. L. REV. 737, 738 (2007) (stating that courts deny First Amendment protections to advertisers in trademark and false advertising cases, reasoning the trademark and false advertising laws pose no constitutional problems because they regulate only false and deceptive commercial speech). The same notion provides one rationale underpinning right of publicity laws because they often are invoked when the appropriation of a likeness creates a false and misleading impression. See *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 802 (Cal. 2001). The right of publicity is also considered a property right which must be balanced against First Amendment rights even when there is no evidence of confusion. See *Rosa Parks v. LaFace Records*, 329 F.3d 437, 460-61 (6th Cir. 2003).

²⁷ As one example not addressed in this article, the coverage of the federal trademark law (the Lanham Act) has been expanded to specifically protect trademarks from dilution, which does not require proof of confusion or deception. 15 U.S.C. §1125(c) (1946) (amended 2006). For this reason, the statute is careful to exempt the application of dilution principles from uses that have a high level of First Amendment protection, such as news reporting, noncommercial uses, and certain types of commentaries. 15 U.S.C. §1125(c)(3).

benefited from learning about Obama's beliefs while also being confused about her connection, if any, to PETA. Thus, courts have had to develop frameworks to balance the competing interests and they have not always been consistent in their approaches.

Courts and commentators also have struggled with the meaning of commercial speech, which is subject to greater regulation than noncommercial speech. When the Supreme Court used the term, it meant "speech proposing a commercial transaction," as opposed to works that are offered for sale or in commerce.²⁸ For instance, courts typically perceive that artistic works embody noncommercial speech although the pieces are available for sale in commercial markets.²⁹ This does not mean that the government does not have any power to control the speech-related attributes in the works; rather, the government just bears a tougher burden with demonstrating that the protected legal interests outweigh the First Amendment rights.³⁰

The article now proceeds to appraise the legality of PETA's advertisement in light of relevant court decisions that have balanced trademark and publicity rights with free speech interests. Although the article addresses the topics separately, the approaches used in one context almost always apply with equal force in the other.³¹ Thus, the overriding goal is to recognize general principles that help guide decisions of these kinds, no matter which legal theory is raised. This is important because not all states explicitly protect the right of publicity, and those that do provide varying coverage.³² Thus, in these jurisdictions, the only basis for making a claim may be via the trademark laws. Likewise, there may be occasions when plaintiffs will prefer to rely on publicity rights, such as when they have difficulty demonstrating a likelihood of confusion.³³

²⁸ *Central Hudson*, 447 U.S. at 562.

²⁹ See, e.g., *ETW Corp. v. Jireh Publishing Inc.*, 332 F.3d 915, 924 (6th Cir. 2003); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184-86 (9th Cir. 2001).

³⁰ Although PETA is a nonprofit organization supporting animal rights, its ad is nonetheless connected to commerce because the organization solicits money from contributors on its website and through other channels. Indeed, PETA actually sells products on the website for the purpose of raising money. Thus there is little question that the campaign is subject to trademark laws, which depend on uses in commerce, and publicity rights, which apply to advertising and soliciting. The more difficult question is whether the advertisement should be treated as commercial speech. See Bruce E. H. Johnson, *First Amendment Commercial Speech Protections: A Practitioner's Guide*, 41 LOY. L. A. L. REV. 297, 305-12 (2007) (noting inconsistencies in distinguishing a use in commerce with commercial speech). On the one hand, the campaign may be viewed as primarily informational, without the specific intent to propose a commercial transaction. On the other, the advertisement asks viewers to visit the website, where money is raised for its services. If nothing else, the hybrid nature of the campaign adds greater complexity to the constitutional evaluation. Cf. *Village of Schaumburg v. Citizens for a Better Environment*, 444 U.S. 620, 632 (1980) ("[B]ecause charitable solicitation does more than inform private economic decisions and is not primarily concerned with providing information about the characteristics and costs of goods and services, it has not been dealt with in our cases as a variety of purely commercial speech.").

³¹ See *ETW Corp.*, 332 F.3d at 924 (stating that the "elements of a Lanham Act false endorsement claim are similar to the elements of a right of publicity claim. . . . Therefore, cases which address both these types of claims should be instructive. . .").

³² For example, the right of publicity in some states, such as New York, only protects living persons, N.Y. CLS CivR §§50-51 (2000), while in others, such as California, it also covers people who are deceased, Cal. Civ. Code §3344 (1971) and §3344.1 (1984, renumbered 1999).

³³ See *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989) ("Because the right of publicity, unlike the Lanham Act, has no likelihood of confusion requirement, it is potentially more expansive than the Lanham Act.").

III. TRADEMARK RIGHTS

Trademarks are essentially words, symbols or devices that are used to distinguish the sources of goods or services.³⁴ Trademarks are often words that are distinctive in the industry, such as Michelin for tires. However, other kinds of attributes may serve as trademarks, including product shapes and packaging.³⁵

There is no question that a distinctive name of a famous individual may be protected as a trademark.³⁶ However, there is some controversy whether a person's image also may serve as a trademark. For instance, in a case involving a stage impersonation show, a court ruled that Elvis Presley did not have trademark rights in his likeness and image.³⁷ In the same vein, another court ruled that Tiger Woods's likeness could not serve as a trademark.³⁸ The justification underlying these rulings is that trademarks typically are static symbols that provide source identification through consistent use on separate products or services.³⁹ A person's image, on the other hand, not only changes routinely based on moods and hairstyles, but it also is an essential attribute of who the individual is.⁴⁰ Accordingly, a personal image does not represent the person, but rather is an integral part of the person.

These cases are hard to square with the reality that product shapes may be protected, for if a product's external appearance can represent the qualities of the product, why can't a person's external appearance represent the personal qualities of that individual?⁴¹ Fortunately, the debate has been rendered academic, because even those courts that refuse to extend trademark status to personal images still are willing to protect them under a provision of the federal trademark statute (the "Lanham Act") that covers unregistered identification attributes.⁴² Specifically, Section 43(a) of the Lanham Act provides:

³⁴ The Lanham Act provides that a trademark "includes any word, name, symbol or device, or any combination thereof." 15 U.S.C. §1127.

³⁵ See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

³⁶ As one example, the Tiger Woods has received a federal registration for his name. See, *ETW Corp.*, 332 F.3d at 920.

³⁷ *Estate of Presley v. Russen*, 513 F. Supp.1339 (D.N.J. 1981).

³⁸ *ETW Corp.*, 332 F.3d at 922-23. See also *Pirone v. MacMillan, Inc.*, 894 F. 2d 579 (2d Cir. 1990) (expressing doubt that Babe Ruth's image might serve as a trademark).

³⁹ 332 F.3d at 923.

⁴⁰ See *id.* at 922 ("ETW asks us, in effect, to constitute Woods himself as a walking, talking trademark."). See also Lee Burgunder, *Commercial Photographs of Famous Buildings: The Sixth Circuit Fails to Make the Hall of Fame*, 89 TRADEMARK REP. 791, 812-15 (1999) (questioning the analogy of building designs with individual likenesses because building designs may be conceptually separated from included services while likenesses may be part of who the individual is).

⁴¹ See *ETW Corp.*, 332 F.3d at 941 ("[C]ontrary to the majority's contention, the jurisprudence clearly indicates that a person's image or likeness can function as a trademark ... as long as there is evidence of consumer confusion as to the source of the merchandise upon which the image appears.") (Clay, J., dissenting).

⁴² See, e.g., *id.* at 925-26. (applying section 43(a) to an image of Tiger Woods despite holding his likeness could not serve as a trademark.); *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1007-09 (9th Cir. 2001) (applying the Lanham Act to the use of personal images in a catalog); *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1149 (9th Cir. 2002) (applying section 43(a) to the likeness of Princess Diana).

Any person who, on or in connection with any goods or services ... uses in commerce any word, term, name, symbol or device ... or any false designation of origin ... which ... is likely to cause confusion ... as to the origin, sponsorship, or approval of his or her goods, services or commercial activities by another person ... shall be liable⁴³

Based on the terms of this provision, courts appraise whether a person who uses an image without permission engages in unfair competition through what is called “false endorsement.”⁴⁴ As with traditional trademarks, likelihood of confusion is the determinative issue with false endorsement claims.⁴⁵ Thus, the bottom line is that personal likenesses are protected under the Lanham Act using the same principles as those applied to more traditional trademarks. For this reason, others who want to legally use them for public comment or criticism might have to appeal to the First Amendment.

Unfortunately, the application of the First Amendment in the context of trademarks is a controversial and difficult affair that has never been amenable to predictable rules. Often, courts address free speech contentions through traditional tests for likelihood of confusion.⁴⁶ In other words, courts have concluded that a First Amendment defense should succeed only if the public would not be confused regarding the sponsorship of the use in light of all relevant factors and circumstances.⁴⁷ Accordingly, defendants who use trademarks in parodies face little challenge because consumers recognize the joke and understand that the trademark owner would not demean itself in that way. This explains why a dog-toy company could call itself Chewy Vuitton, since Louis Vuitton obviously would not depreciate its high-brow reputation with such silliness.⁴⁸ On the other hand, those who make use of trademarks that are merely clever or funny, without directly poking fun at the trademarks, have to be more cautious. For instance, attaching the title, *Dairy Queens*, to a movie that satirizes Minnesota beauty pageants is certainly funny, but it ran afoul of trademark laws because viewers may have believed that Dairy Queen gave permission to use its mark.⁴⁹

This analysis raises some doubts that PETA could have successfully relied on the First Amendment to defend the use of Obama’s image in its advertisement. Although the ad may have been clever, it did not strive to make fun of Obama or her beliefs. Therefore, viewers may have legitimately believed that Obama gave PETA permission to include her image and that she consequently endorsed PETA’s campaign against animal cruelty. Because she never authorized the use, the ad may have potentially deceived the public.

A couple of cases involving titles to a song and a movie demonstrate how courts balance trademark interests and the First Amendment in circumstances that are

⁴³ 15 U.S.C. §1125(a)(1)(A).

⁴⁴ See, e.g., *ETW Corp.*, 332 F.3d at 924; *Cairns*, 292 F.3d at 1149-50.

⁴⁵ *Cairns*, 292 F.3d at 1149; *Downing*, 265 F.3d at 1007.

⁴⁶ See, e.g. *Parks*, 329 F.3d at 447-48 (citing numerous cases therein).

⁴⁷ Trademark confusion is typically evaluated in terms of eight separate factors, including the strength of the mark and the defendant’s intent in selecting the mark. See, e.g., *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979).

⁴⁸ *Louis Vuitton Malletier, S.A. v. Haute Diggity Dog LLC*, 507 F.3d 252 (4th Cir. 2007).

⁴⁹ *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 732 (D. Minn. 1998).

comparable to PETA's advertisement. In *Rogers v. Grimaldi*,⁵⁰ Ginger Rogers argued that the movie title, *Ginger and Fred*, violated trademark rights that she and Fred Astaire owned. The court, though, disagreed because the title had artistic relevance to the content of the film. The court explained that a film title can simultaneously be a means for an artist to communicate expression while serving commercial objectives through promotional advantages.⁵¹ Thus the court had to balance the public's interest in not being misled with its interest in enjoying the author's freedom of expression.⁵² The court recognized that the title might deceive some people about the content or sponsorship of the film. Nevertheless, it ruled that the balance tipped toward free expression because the title reflected the core dichotomy of the film, with Ginger and Fred representing an elegance and class that is contrasted with the gaudiness and banality of contemporary television.⁵³ Thus, according to the court, the title was an *integral part* of the film.⁵⁴

*Rosa Parks v. LaFace Records*⁵⁵ demonstrates how application of the artistic relevance test may lead to the opposite conclusion. In this litigation, the civil rights icon, Rosa Parks, claimed that the use of her name as the title to a song by OutKast infringed on her personal trademark. The song lyrics had some connection to Rosa Parks because they repeated the line "everybody move to the back of the bus" ten times in the refrain. However, the song was not about Rosa Parks or the civil rights movement, but rather was meant to inform competitive hip hop bands of their inferiority to OutKast. The court determined that Rosa Parks would have a viable cause of action "if consumers falsely believed that Rosa Parks had sponsored or approved the song, or was somehow affiliated with the song or the album."⁵⁶

To address the situation, the court noted that other jurisdictions had relied on three different approaches in previous cases to balance the risk of false sponsorship with First Amendment concerns: (1) rely solely on the traditional likelihood of confusion factors⁵⁷; (2) evaluate whether there are sufficient alternative means for an artist to convey the idea⁵⁸; or (3) evaluate the artistic relevance, as done in *Rogers*.⁵⁹ The court decided to use the artistic relevance test, and determined that unlike in *Rogers*, a reasonable juror in this instance might find that the title had little artistic relevance to the content of the song. In reaching this judgment, the court also distinguished *Mattel Inc. v. MCA Records, Inc.*,⁶⁰

⁵⁰ 875 F.2d 994 (2d Cir. 1989).

⁵¹ *Id.* at 998.

⁵² *Id.*

⁵³ *Id.* at 1001.

⁵⁴ *Id.*

⁵⁵ 329 F.3d 437 (6th Cir. 2003).

⁵⁶ *Id.* at 447.

⁵⁷ *See, e.g.,* *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1007-10 (9th Cir. 2001) (applying the likelihood of confusion factors to the use of surfers images in a catalog).

⁵⁸ *See, e.g.,* *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 734 (D. Minn. 1998) (finding no First Amendment protection for the movie title, *Dairy Queens*, because the producers could have used other titles, such as *Milk Maids*).

⁵⁹ *Parks*, 329 F.3d at 447-48.

⁶⁰ 296 F. 3d 894 (9th Cir. 2002).

which involved a song titled “Barbie Girl.”⁶¹ The court in that instance concluded that the title did not infringe Mattel’s trademark rights in Barbie because the song’s lyrics focused on Barbie and the values the band claimed she represents.⁶²

A case involving Tiger Woods demonstrates how courts will apply these same principles when personal images are used without permission. In *ETW Corp. v. Jireh Publishing, Inc.*,⁶³ a publisher distributed limited edition prints of a painting entitled, *The Masters of Augusta*, which commemorated Woods’s record-breaking victory at the Masters Tournament in 1997. The painting contained several views of Woods in different poses, along with images of his caddy, other famous golfers, the clubhouse and the leader board. The licensing agent for Woods sued, claiming, among other things, that the use of Woods’s images violated the Lanham Act by causing false endorsement.

The court recognized that the *Rogers* test is not limited to literary titles, but is generally applicable to works of artistic expression, including the use of images.⁶⁴ It then concluded that Woods’s images were artistically relevant to the underlying work, given that *The Masters* is probably the world’s most famous golf tournament, and Woods’s victory was a historic achievement.⁶⁵ In this regard, the court thought it would be ironic if a painting that celebrates the cultural value of a historic sporting event could not depict the athlete who was central to the occasion.⁶⁶ For this reason, the court ruled that the artist’s First Amendment rights trumped the false endorsement claim.⁶⁷

PETA’s advertisement stands in stark contrast to the situations with Fred and Ginger, Barbie Girl and *The Masters of Augusta* because PETA used Obama’s image primarily to draw attention to its campaign to defeat animal cruelty. Although the reported “fact” that Obama did not wear fur was relevant to the content on its website, it had only minimal significance. The website primarily discussed and quoted celebrities who had taken active positions against animal cruelty and the act of killing animals for fur fashions. Indeed, the website included several separate stories about each of the other three women depicted in the advertisement. However, the only reference to Obama was the press secretary’s statement that she did not wear fur. Certainly the use of Obama’s image was not necessary for PETA to make its point. In fact, including her image appears to have been simply a clever means to draw attention to the ad and PETA’s campaign.⁶⁸ This is remarkably similar to the claim Rosa Parks made successfully against OutKast for the use of her name in the song.

⁶¹ *Parks*, 329 F.3d at 456.

⁶² *Mattel*, 296 F.3d at 902.

⁶³ 332 F.3d 915 (6th Cir. 2003).

⁶⁴ *Id.* at 927.

⁶⁵ *Id.* at 936.

⁶⁶ *Id.*

⁶⁷ The court determined that the prints also did not violate Woods’s right of publicity for similar reasons. *Id.* at 938 (ruling that the work was protected by the First Amendment because it depicted the significance of Woods’ achievement at a historic event in sports history).

⁶⁸ *Cf. Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (stating that the First Amendment does not protect the use of a person’s name in a title, even if it has some relevance to the content, if the title explicitly misleads as to the source or content of the work).

Just to drive home the point, suppose a national vegetarian organization confirmed with a friend of Michelle Obama that Obama eats string beans. The group then distributes posters with a digitally remixed image of a smiling Obama holding a fork-full of string beans that exclaims, "Eats String Beans and Fabulous." However, the only discussion of Obama on the website is the statement that she eats string beans. There is no discussion that Obama is a vegetarian, that she supports the goals of vegetarians or has made public statements about the importance of vegetables. Although the image and statement on the poster are true and are related to some content on the website, the connection is obviously so minimal that the organization's purpose is clear: it simply is incorporating Obama's image and the statement that she eats string beans as a pretext to use her tremendous drawing power to attract visitors to the website.⁶⁹ The same arguments certainly could have been raised about PETA and its decision to include Obama's image on its advertisement.

As a final trademark-related tactic, PETA might have argued that it was making a permissible fair use of Obama's image. The Lanham Act specifically allows a third party to use a trademark fairly to describe the characteristics of its own goods or services.⁷⁰ For example, a soup company might be able to use the slogan, "The healthy choice in soups" even though the phrase "Healthy Choice" is a registered trademark. The courts, though, have established that under certain circumstances, a third party also can make a fair use of a trademark to describe the trademark owner's goods or services. This is known as making a nominative fair use.⁷¹

The issue that courts try to address with a nominative fair use arises when service providers need a short-hand way to refer to products (or services) offered by other companies. For instance, a Volkswagen repair shop should be able to use the phrase "Modern Volkswagen Service" to fairly inform the public about its specialization with fixing that particular brand of automobiles. To allow for this, the courts have developed the following three-part test for a nominative fair use:

1. the product or service in question must be one not readily identifiable without use of the trademark;
2. only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and
3. the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark owner.

⁶⁹ Cf. *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407, 413 (9th Cir. 1996) (Adding a trivia question about Lew Alcindor in an automobile advertisement may have violated Kareem Abdul-Jabbar's rights, even though the statement was true); *Rogers*, 875 F.2d at 1005 (stating that the right of publicity bars use of a celebrity's name in a movie title if the title is "simply a disguised commercial advertisement for the sale of goods or services").

⁷⁰ 15 U.S.C. §1115(b).

⁷¹ See, e.g., *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150 (9th Cir. 2002); *Abdul-Jabbar* 85 F.3d at 412-13.

Note that although the word “Volkswagen” is being used to describe the products sold by Volkswagen, the advertising ultimately uses the term to describe the services provided by the repair shop. Thus, the two fair use doctrines may differ in their focus, but they both are intended to allow companies to fairly explain what they do.

Based on nominative fair use principles, PETA might have argued that it simply used the image of Michelle Obama as a short-hand way to inform viewers that she was one of several fashionable women who was fur-free and fabulous. In support of its position, PETA might have pointed to a seller of collectible plates bearing the image of Princess Diana, which successfully defended the use of her likeness as a nominative fair use.⁷² After all, if a manufacturer can apply the likeness of Princess Diana simply to sell plates to people who adore her, certainly PETA should have been able to use Obama’s image to illustrate her position on a public issue. Despite the initial appeal of this argument, it nonetheless would probably have failed. In *Cairns*, the court determined that there could be no substitute for using the image of Princess Diana on a Diana-related collectible plate.⁷³ PETA, on the other hand, did not have to use Michelle Obama’s image to inform people that Obama did not wear fur. Rather, the organization could have simply used her name for that function. Therefore, in the final analysis, Obama may have been able to win trademark-related false endorsement claims, despite PETA’s free speech and fair use defenses.

IV. THE RIGHT OF PUBLICITY

The right of publicity developed under the common law umbrella of privacy, and protects the unauthorized “appropriation, for defendant’s advantage, of the plaintiff’s name or likeness.”⁷⁴ Many states have supplemented the common law with statutory provisions that further define and protect the right of publicity. For instance, California has passed a statute that provides:

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 purchase of, product, merchandise, goods or services, with such person’s prior consent ... shall be liable for any damages sustained by the person or persons injured as a result thereof.⁷⁵

According to the U.S. Supreme Court, “the rationale for protecting the right of publicity is the straight-forward one of preventing unjust enrichment by the theft of

⁷² *Cairns*, 292 F.3d at 1152-55. The dispute also involved other collectible items, including jewelry and dolls, along with their advertising.

⁷³ *Id.* at 1153. The court also determined that under the circumstances, prospective purchasers would not believe the plates were endorsed by Diana’s estate, although it thought this was a close call. *Id.* at 1155.

⁷⁴ See, e.g., *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 819 (Sup. Ct. 1979). For a good discussion of the historical development of the right of publicity, see Anastasios Kaburakis, et al., *NCAA Student-Athletes’ Rights of Publicity, EA Sports, and the Video Game Industry*, 27 ENT. & SPORTS LAW. 1, 6-9 (2009).

⁷⁵ Cal. Civ. Code 3344(a).

goodwill. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.”⁷⁶

As already noted, the public often needs to refer to the names and images of famous people to make the kinds of comments about public affairs that the First Amendment is designed to protect. As one California court stated:

Because celebrities take on public meaning, the appropriation of their likenesses may have important uses in uninhibited debate on public issues, particularly debates about culture and values. And because celebrities take on personal meaning to many individuals in society, the creative appropriation of celebrity images can be an important avenue of individual expression.⁷⁷

To strike the appropriate balance, the common law provides that “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.”⁷⁸ The California statute similarly accommodates the free speech concerns in the following terms: “[A] use of a name, voice, signature, photograph or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required.”⁷⁹

Although Michelle Obama clearly is a well-recognized politically-related figure, she nonetheless has the right to someday profit from her valuable image, even if it would not be appropriate for her to do so at this moment.⁸⁰ Senator Bob Dole, for instance, was featured in promotional advertisements for Viagra after he ended his political career.⁸¹ One can only imagine what might have happened to Dole’s ability to contract with Pfizer if an organization promoting the virtues of increased sexual promiscuity had included Dole’s image, while he was still in public office, to truthfully indicate on a poster that he used an erectile dysfunction medication.⁸² Similarly, Obama may someday want to license her image to a company or cause

⁷⁶ *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576 (1977).

⁷⁷ *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 803 (Cal. 2001). See Michael Madow, *Private Ownership of Public Images: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125 (1993).

⁷⁸ *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1001 (9th Cir. 2001); *Montana v. San Jose Mercury News*, 40 Cal. Rptr. 2d 639 (Cal. Ct. App. 1995).

⁷⁹ Cal. Civ. Code 3344(d).

⁸⁰ See Sean Masson, *The Presidential Right of Publicity*, 2010 B.C. INTELL. PROP. & TECH. FORUM 12001, at ¶¶ 7-10 (2010) (noting circumstances in which politicians, such as Spiro Agnew, Jesse Ventura and Arnold Schwarzenegger have sued companies for violating their rights of publicity by selling products bearing their images, with these cases settled or resolved after cease and desist letters).

⁸¹ The ads first appeared in 1999, after Senator Dole revealed on the Larry King Show that he was a participant in clinical trials for Viagra to address erectile dysfunction from prostate surgery. James Barada, *Dole’s Courage Helps Spread the Word*, TIMES UNION, Mar. 30, 1999, at A9. Senator Dole also served as a spokesperson for Visa and Pepsi.

⁸² This is merely hypothetical because Senator Dole did not publicly disclose that he had taken Viagra until after he had left office. His participation in the clinical trials also may have started after his Senate term ended.

involved with animal rights or fashion. However, PETA's previous appropriation of her image for the organization's purposes may negatively affect the compensation that other businesses or entities would be willing to offer for her sponsorship.

Of course, not all circumstances involving the right of publicity are difficult to resolve. For instance, when an image of a politician or celebrity is used solely for commercial purposes without any corresponding public interest, then the First Amendment does not stand in the way of protecting intellectual property rights through the right of publicity. Indeed, the Obama family has dealt with several circumstances that fall in this category, including a prominent advertisement for Weatherproof jackets that displayed the president wearing the brand, and a Ty doll of two girls called Marvelous Malia and Sweet Sasha.⁸³

The situation with PETA and Michelle Obama, on first blush, is somewhat different because PETA could have argued that its advertisements satisfied the public's interest in knowing whether Obama wears fur. Although this is probably true, one must be cautious before summarily concluding that the First Amendment would therefore have been more relevant to PETA's campaign. After all, Weatherproof might equally have argued that it was simply reporting the fact that President Obama had worn a Weatherproof jacket, and it merely wanted to comment on that by stating that he is a "Leader in Style." Notwithstanding this argument and the potential line-drawing problems it raises, it seems pretty clear that Weatherproof's ads fell on the side of pure commercial speech while PETA's campaign included more pervasive noncommercial attributes.⁸⁴

Although no previous case is directly on point, several are relevant and provide insights into whether PETA's use of Obama's image might have been upheld under principles of free speech. Several of the cases sanction use of an image on First Amendment grounds, but they do not necessarily support PETA's position. In fact, as we shall see, they point out why PETA's use of Obama's image might have been treated differently.

The first relevant case is *Montana v. San Jose Mercury News*,⁸⁵ which involved posters sold by the San Jose Mercury News that reproduced front page stories that the newspaper had previously published about the San Francisco 49ers Super Bowl victories. These pages included notable photographs of Joe Montana celebrating the respective accomplishments. Montana sued the newspaper

⁸³ Wil Longbottom, *Brand Obama: Clothes Company Weatherproof Uses Picture of President on Giant Times Square Billboard*, MAIL ONLINE, Jan. 7, 2010, available at <http://www.dailymail.co.uk> (last visited June 16, 2010). The Obamas also complained when a poster displayed at a D.C. metro stop referenced their children by stating, "President Obama's daughters get healthy school lunches. Why don't I?" Givhan, *supra* note 6.

⁸⁴ Another circumstance involving a political figure arose in 2004 when a company made a bobblehead doll depicting Arnold Schwarzenegger brandishing an assault rifle. The company defended its right to distribute a political message in this way, but agreed to license Schwarzenegger's image for a reconfigured doll after Schwarzenegger sued the company for violating his right of publicity. For a good article discussing the bobblehead case, see Charles J. Harder & Henry L. Self III, *Schwarzenegger vs. Bobbleheads: The Case for Schwarzenegger*, 45 SANTA CLARA L. REV. 557 (2005).

⁸⁵ 40 Cal. Rptr. 2d. 639 (Cal. Ct. App. 1995).

for violating his right of publicity by misappropriating his name and likeness in the posters for commercial gain.

The court determined that the posters were protected by the First Amendment. The court easily concluded that the newspaper accounts of the Super Bowl victories were matters of public interest, and so the newspaper was not subject to liability for publishing photographs of Montana therein.⁸⁶ Regarding the posters, the court stated that “Montana’s name and likeness appeared in the posters for precisely the same reason they appeared in the original newspaper front pages: because Montana was a major player in contemporaneous newsworthy sports events.”⁸⁷ For this reason, the court ruled that Montana’s claim must fail.⁸⁸

PETA’s use of Obama’s image differed markedly from the facts in *Montana*. The poster of Montana was constitutionally protected because Montana was a central figure who actively participated in the newsworthy event.⁸⁹ Obama, though, was hardly a primary participant in the anti-fur campaign. The website content resorted to a statement from the press secretary, perhaps because the first lady had not publicly denounced the use of fur herself. Indeed, she may have chosen to avoid fur for reasons other than animal cruelty, such as comfort or political expediency. Also, the article was not about Obama, but simply mentioned her name among others who clearly were more involved with the topic.

Other cases lead to the same analyses and conclusions. In *Dora v. Frontline Video*,⁹⁰ the defendant produced a video documentary titled, “The Legends of Malibu,” which chronicled the surfing history of Malibu and included footage of famous surfing personalities, including Mickey Dora. Dora sued for violating his right of publicity, but lost because he was a “legendary figure in surfing” and his exploits at Malibu were “the folklore of the sport.”⁹¹ As with *Montana*, Dora’s central role in the topic of the discussion distinguishes the situation from that involving Obama.

In fact, another case involving surfing drives home the point. In *Downing v. Abercrombie & Fitch*,⁹² several surfers sued the retailer for including a photograph of them in a surf theme catalog, which not only featured merchandise, but also had several articles about surfing, although none specifically about the plaintiffs. The court ruled that Abercrombie had violated the surfers’ right of publicity because, unlike in *Dora*, there was “a tenuous relationship” between the photograph and the

⁸⁶ *Id.* at 640-41.

⁸⁷ *Id.* at 641. The court also recognized that when a person’s photograph is originally published in one issue of a periodical as a newsworthy subject, it may be republished subsequently in another medium as an advertisement for the periodical itself. *Id.* at 642.

⁸⁸ *Id.* at 641.

⁸⁹ See *ETW Corp. v. Jireh Publishing Inc.*, 332 F.3d 915, 938 (6th Cir. 2003) (determining that artistic prints titled, *The Masters of Augusta*, which included the likeness of Tiger Woods did not violate the right of publicity because the prints conveyed a message about the significance of Woods’ achievement in a historic event).

⁹⁰ 18 Cal. Rptr. 2d 790 (Cal. Ct. App. 1993).

⁹¹ *Id.* at 791.

⁹² 265 F.3d. 994 (9th Cir. 2001).

catalog's theme.⁹³ In the court's view, Abercrombie used the photograph "essentially as window-dressing to advance the catalog's surf-theme."⁹⁴ In the same vein, PETA's use of Obama's image might be seen as window-dressing to advance its animal rights position.

*Paulsen v Personality Posters, Inc.*⁹⁵ demonstrates that the subject's active involvement with the featured public issue is also relevant. In this case, the defendant made a poster from a photograph, perhaps without authority, that was sent to it by Pat Paulsen's agent.⁹⁶ The only addition that the defendant made to the photograph was to include the words "For President" at the bottom in large letters. Paulsen did not successfully convince the court that the poster violated his right of publicity because the poster was considered newsworthy and of public interest. The court explained that the poster was "directly related to the interest engendered by the plaintiff's current comedy routine which is based upon his entry into the presidential race as the 'Put-On Candidate of 1968' under the banner of the Stag Party."⁹⁷ Thus, the poster was protected because Paulsen was the central figure and architect of his own presidential candidacy. In other words, he thrust himself into the limelight on exactly the issue depicted in the poster. Clearly, this is a far cry from Obama's involvement with animal rights and fur.⁹⁸

*Comedy III Productions, Inc. v. Gary Saderup, Inc.*⁹⁹ offers a different approach for addressing publicity rights in light of the First Amendment. In this case, an artist was sued for selling silk-screened t-shirts, which displayed a lithograph of The Three Stooges that he created. The court first noted that not all uses that claim to have noncommercial public interest aspects will avoid liability. It stated:

But having recognized the high degree of First Amendment protection for noncommercial speech about celebrities, we need not conclude that all expression that trenches on the right of publicity receives such protection. The right of publicity, like copyright, protects a form of intellectual property that society deems to have some social utility.¹⁰⁰

The court determined that it had to create a workable test to "distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity."¹⁰¹ It considered importing the fair use factors from copyright to resolve the conflicts, as many commentators had suggested, but

⁹³ *Id.* at 1002.

⁹⁴ *Id.*

⁹⁵ 299 N.Y.S.2d 501 (N.Y. App. Div. 1968).

⁹⁶ The parties disagreed about the purposes and terms of the submission, and whether there were any limitations on the defendant's use of the photograph in publicity posters. *Id.* at 503-05.

⁹⁷ *Id.* at 504.

⁹⁸ An organization might have a stronger case to use Michelle Obama's image on a poster regarding childhood obesity because Obama has spearheaded an initiative to combat the problem. *See, e.g.,* Robin Givhan, *Obesity Her Big Issue*, PITTSBURGH POST-GAZETTE, Feb. 28, 2010, at A7.

⁹⁹ 21 P.3d 797 (Cal. 2001).

¹⁰⁰ *Id.* at 804.

¹⁰¹ *Id.* at 807.

concluded that a wholesale importation of the fair use doctrine would not be appropriate.¹⁰² Nevertheless, it believed that the first fair use factor – the purpose and character of the use – seemed particularly pertinent to the task of reconciling the rights of free expression and publicity. And in this regard, it ruled 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.”¹⁰³ It justified this approach because transformative works not only include elements of independent creative value, but also are less likely to interfere with the economic interests protected by the right of publicity.¹⁰⁴

The court recognized that parody traditionally has the highest claim in such an analysis, but that creative contributions do not have to be confined to parody, and can take many forms, from factual reporting to subtle social criticism.¹⁰⁵ In terms of applying the test for transformation, the court indicated that the inquiry is “whether a product containing a celebrity’s likeness is so transformed that it has become primarily the defendant’s own expression rather than the celebrity’s likeness.”¹⁰⁶ The court also noted that in close cases, it is appropriate to ask whether the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted as opposed to the creativity and skill of the artist.¹⁰⁷ When the court applied the principles to the t-shirts, it easily concluded that they violated The Three Stooges’ right of publicity.¹⁰⁸

Ever since *Comedy III*, the transformation test has become the leading test for the right of publicity in California. Although the test proved useful with The Three Stooges, that was only because the artist added almost nothing of creative or social value.¹⁰⁹ The test does not address whether the image has to be altered to some meaningful extent in the new work, or if it is enough to just add other elements with it.¹¹⁰ It also does not address whether including simple social commentary with the image

¹⁰² *Id.* (citing several law review articles.).

¹⁰³ *Id.* at 808.

¹⁰⁴ *Id.* See *ETW Corp. v. Jireh Publishing Inc.*, 332 F.3d 915, 938 (6th Cir. 2003) (“It is not at all clear that the appearance of Woods’s likeness in artwork prints which display one of his major achievements will reduce the commercial value of his likeness.”).

¹⁰⁵ *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001).

¹⁰⁶ *Id.* See *ETW Corp.* 332 F.3d at 938 (finding that The Masters of Augusta print was transformative because the artist “added a significant creative component of is own to Woods’s identity”).

¹⁰⁷ *Comedy III*, 21 P.3d at 810.

¹⁰⁸ *Id.* at 811.

¹⁰⁹ See *ETW Corp.*, 332 F.3d at 938 (finding no violation of the right of publicity because “[u]nlike the unadorned, nearly photographic reproduction of the faces of The Three Stooges in *Comedy III*, [the artist’s] work does not capitalize solely on a literal depiction of Woods.”).

¹¹⁰ A recent case, *Keller v. Electronic Arts, Inc.*, 2010 U.S. Dist. LEXIS 10719 (N.D. Cal 2010), provides that the image has to be altered to satisfy the transformation test. In ruling that the use of a football player’s images in a video game might not be transformative, the court stated that the focus has to be on the depiction of the plaintiff and not whether the game, taken as a whole, contains transformative elements. *Id.* at 18. On the other hand, the court in the Tiger Woods case determined that a collage including images of Tiger Woods along with other important players and features at The Masters was transformative because they were “combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods’s achievement in that event.” *ETW Corp.*, 332 F.3d at 938.

suffices to make it transformative. PETA's advertisement was not a parody, and so did not sit on the firmest ground, but the *Comedy III* court recognized that this is not dispositive. Adding the statement "Fur-Free and Fabulous" should not, by itself, have been sufficient to transform the image, for if this were enough, then the right of publicity could be totally eviscerated by the simple inclusion of any accurate fact, even one that is unrelated to the image used.¹¹¹ Although PETA used digital techniques to include Obama's image with other subjects, the image itself was essentially unchanged and continued to be little else but her own likeness.¹¹² Thus, perhaps one needs to resort to the court's subsidiary test for close situations, and in this instance it appears that the appeal of the poster derived primarily from the fame of the celebrities that were depicted, including Obama. In fact, the transformation test in copyright asks a similar question – whether the image is used simply to draw attention to the work.¹¹³ Under the circumstances, including the White House portrait of the first lady appears to have had little other purpose. Thus, on balance, the use of Obama's image would seem to have unduly interfered with the economic interests protected by the right of publicity.

A particularly instructive case that applies the transformation test is *Hilton v. Hallmark Cards*.¹¹⁴ In this case, Hallmark sold a birthday card that contained an oversized photograph of Paris Hilton's head super-imposed on a cartoon-drawn waitress body. The card included statements about the food, with the punch line, "That's hot." Hilton sued for violating her right of publicity and Hallmark argued that the suit should be dismissed by California's anti-SLAPP statute.¹¹⁵ To evaluate the defense, the court had to address whether Hilton's right of publicity claim could possibly be legally sufficient in light of the First Amendment. In this regard, the court had to consider whether the card was necessarily transformative, because if it were, then Hilton's claim would have to fail.¹¹⁶

Hilton claimed that the card was patterned on a particular episode of the show, *Simple Life*, in which she worked as a waitress for a fast-food restaurant. In the episode, Hilton occasionally remarked that a person, thing or event was "hot."

¹¹¹ Had PETA made a comment about Obama's appearance in the White House portrait, then the social commentary would have related to the image used, and so might have been more justifiable under the First Amendment.

¹¹² The court in *Comedy III* noted the importance of image distortion as follows: "[W]orks of parody or other distortions of the celebrity figure are not, from the celebrity fan's viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect." *Comedy III*, 21 P.3d at 808.

¹¹³ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 (1994). The Supreme Court stated:

If, on the contrary, the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another's work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality, loom larger.

Id.

¹¹⁴ 580 F.3d 874 (9th Cir. 2009).

¹¹⁵ Hilton also sued for violating her trademark rights. The lower court dismissed the trademark claims, and Hilton did not appeal on those grounds. *Id.* at 879-80.

¹¹⁶ *Id.* at 890.

The cartoon drawings on the card contained significant differences in details than were used in the episode, such as with the uniforms, the types of restaurants, and the food served.¹¹⁷ However, the fact that both the card and the television episode showed Paris Hilton as one who is born of privilege and working as a waitress was enough for the court to conclude that the card might not be transformative.¹¹⁸ It indicated that the facts here were much different than a previous case involving a comic book that transformed the musicians, Johnny and Edgar Winter, into characters that were half-human and half-worm because that story was a parody and the subjects were grotesque recreations of the real-life subjects.¹¹⁹ Thus despite the large number of physical changes that Hallmark made to, and included with, Hilton's image, the court ruled that the card might still be insufficiently transformative to avoid liability for infringing Hilton's right of publicity.¹²⁰ Similarly, PETA's use of Obama's photograph in its advertisement may be too authentic to pass muster under the transformation test.

One final case worth reviewing is *Hoffman v. Capital Cities/ABC, Inc.*¹²¹ because it considered a situation specifically involving use of digital imaging techniques, just as PETA used with its advertisement. Los Angeles Magazine ("LAM") published a "Fabulous Hollywood Issue" and within it was an article entitled "Grand Illusions" that used computer technology to alter famous film still photographs so that the actors appeared to be wearing recent fashions. One of the shots used a well-known photograph of Dustin Hoffman in *Tootsie* and replaced Hoffman's body and clothes with the body of a male model in the same pose, but wearing a spaghetti-strapped evening dress and high-heeled sandals.¹²² Hoffman sued for violating his right of publicity, claiming that the photograph falsely gave the impression that he posed for it.¹²³

The court ruled for LAM. It determined that the article was a complement to the issue's theme, and that any commercial aspects of the photographs were inextricably entwined with the expressive elements of the entire production.¹²⁴ Because the whole point of the article was to provide visual and verbal editorial comments about classic films, the Hoffman photograph was clearly an integral component of that effort. Also, the court determined that in light of the entire issue, the average reader would recognize that the altered photograph did not use Hoffman's body.¹²⁵ This was

¹¹⁷ *Id.* at 891.

¹¹⁸ *Id.* For a similar analysis, see *Keller v. Electronic Arts, Inc.*, 2010 U.S. Dist. LEXIS 10719, at *16 (N.D. Cal 2010) (concluding that the use of plaintiff's image in a video game may not have been transformative because the game "does not depict plaintiff in a different form; he is represented as what he was, the starting quarterback for Arizona State University").

¹¹⁹ *Id.* (referencing *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003)). The *Winter* court also determined that fans of the musicians would find the comic book drawings to be unsatisfactory substitutes for conventional pictures of their idols. 69 P.3d at 479.

¹²⁰ *Hilton*, 580 F.3d at 891-92.

¹²¹ 255 F.3d 1180 (9th Cir. 2001).

¹²² *Id.* at 1183.

¹²³ *Id.* at 1187. The First Amendment does not protect speech about public figures that is knowingly false or made with reckless disregard for the truth. *Id.* at 1186. See *supra* notes 20-23 and accompanying text.

¹²⁴ *Id.* at 1185.

¹²⁵ *Id.* at 1187-88.

especially true because the magazine noted in several places that the photographs were manipulated with digital technologies. Therefore, the court ruled that LAM did not intend to falsely suggest to an ordinary reader that Hoffman posed for the altered shot.

PETA's recast photograph, in contrast, might have potentially created the false impression that Obama posed with the other women and that she did so specifically to support PETA's organization. There was nothing in the advertisement that might have served to dispel this misconception either in the photographic credits or by other explanatory statements. In fact, by putting its logo on the advertisement and telling viewers to read all about it at its website, PETA probably increased the odds that viewers would get the wrong impression. Thus, Obama might have been able to successfully argue that PETA intended to mislead ordinary viewers about her role in creating the advertisement.

V. CONCLUSION

PETA's use of Obama's image without permission raises important issues about trademark rights and the right of publicity. Digital technologies have now become so commonplace that even grade school children can effectively use them to manipulate preexisting images and sounds to suit their creative needs. One can expect, therefore, that individuals, organizations and companies will find it increasingly natural to embed images and voices of celebrities in new works so that they can inform, comment, and entertain while also making money. This article provides several insights on how courts may evaluate some of the debates that are certain to emerge. Although PETA quickly removed its advertisement in this particular situation, other organizations that use similar approaches in the future may not be so accommodating.