

PAUSE THE GAME: ARE VIDEO GAME PRODUCERS PUNTING AWAY THE PUBLICITY RIGHTS OF RETIRED ATHLETES?

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I. INTRODUCTION

In the video game world, few games are as much anticipated as Electronic Arts Sports' ("EA Sports") Madden NFL¹ franchise ("Madden"). Madden has become the bestselling video game franchise of all time.² Last year's release, Madden 09, grossed \$133.5 million in sales in the first month it was sold, out-selling many of the movies then playing at the box office.³ Madden 09 has sold over four and a half million copies.⁴ It prides itself on having the "most authentic gameplay ever," and the game even adapts to the game player's individual skill level.⁵

Recently, Jim Brown, the former Cleveland Browns's star running back, filed suit against EA Sports for its unauthorized use of his likeness in EA Sports' Madden games.⁶ In his complaint, Brown alleged, among other things,

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¹ National Football League ("NFL").

² Press Release, Elec. Arts, Inc., EA's Madden NFL 09 Tackles Top Movie Releases in Aug. (Sept. 9, 2008), *available at* http://files.shareholder.com/downloads/ERTS/569990348x0x230622/aefed470-6711-4638-a388-baf8e84335fd/ERTS_News_2008_9_9_General.pdf.

³ *Id.* Madden 09 generated more revenue in August 2008 than box office attractions Tropic Thunder (\$83.9 million), Mamma Mia! (\$56.4 million), and Pineapple Express (\$79.9 million). *Id.*

⁴ Press Release, Elec. Arts, Inc., EA Reports Second Quarter Fiscal Year 2009 Results (Oct. 30, 2008), *available at* http://files.shareholder.com/downloads/ERTS/468810291x0x245319/f0a58760-2c38-408f-8779-2782cf681255/Q209%20ER_10.30_10am.pdf.

⁵ EA Sports, Madden 09, <http://maddennfl.easports.com/features.action?platform=xbox&version=09> (last visited April 8, 2010).

⁶ *See* Complaint, Brown v. Sony USA, Inc., No. 08110412 (N.Y. Sup. Ct. 2008) [hereinafter Sony Complaint]; Complaint, Brown v. Elec. Arts, Inc., No. 2:09-cv-01598-MMM-RZ (C.D. Cal. 2009) [hereinafter EA Complaint]. Brown originally filed a complaint in a New York state court on July 30, 2008. Sony Complaint, *supra*, at 1. The defendants removed the case to federal court. Notice of Removal, Brown v. Sony USA, Inc., No. 08-CV-8217(PKC)(MHD) (S.D.N.Y. 2008). However, Brown voluntarily dismissed the case, and re-filed in federal court in California. Notice of Dismissal Pursuant to FRCP 41(a)(A)(f), Brown v. Sony USA, Inc., No. 08-CV-8217(PKC)(MHD) (S.D.N.Y. 2008); EA Complaint, *supra*. The core claims are essentially the same, with the only major difference being Brown

violation of the Lanham Act and infringement of statutory and common law publicity rights.⁷ The complaint reads that starting in 2001:

EA Sports engaged in the manufacture, distribution, and sale of goods which featured “REAL OLD SCHOOL TEAMS AND PLAYERS-50 of the NFL’s greatest players.” . . . Further, the greatest teams feature included among other things an “All Brown’s [sic] Team,” wherein the running back was a muscular African American player wearing the number 32, in direct violation of plaintiff JIM BROWN’s rights in said trademark and likeness.⁸

Brown claims that he did not sign away any licensing rights to EA Sports and that the NFL had a league-wide policy while he was playing that players should not use lawyers or agents when negotiating compensation.⁹ This presents the issue of whether video game producers, such as EA Sports, can use the likenesses of retired athletes in video games without first obtaining the retired athletes’ likeness rights.

This Note argues that widely recognized retired athletes, such as Jim Brown, whose likenesses have been used in video games, will be able to recover damages under likeness laws if video game producers do not take more action to protect themselves from such lawsuits. Part II of this Note will discuss the history of likeness rights and how they have developed in our legal system. Part III will discuss how licensing agreements operate in sports through collective bargaining agreements between the current athletes and the player unions. This Note will then argue, using *Brown v. Sony* as an example, that courts can hold video game producers liable when they use recognizable retired athletes’ likenesses in their games without the consent of the players. Finally, Part V of this Note will make suggestions on how video game producers can protect themselves from similar lawsuits in the future.

II. THE RIGHT OF PUBLICITY

A. Common Law Right of Publicity

One commentator has stated that the right of publicity is “the inherent right of every human being to control the commercial use of his or her identity.”¹⁰ The right of publicity originated within the law of privacy.¹¹ Histori-

included a trademark infringement claim in his first complaint. See Sony Complaint, *supra*; EA Complaint, *supra*.

⁷ EA Complaint, *supra* note 6, at 7-9.

⁸ Sony Complaint, *supra* note 6, at 6. On the Madden 2001 official website, it confirms the ability to unlock NFL’s fifty greatest players. EA Sports, Madden NFL 2001, <http://web.archive.org/web/20010205010100/http://madden2001.ea.com/ps2features.html>.

⁹ EA Complaint, *supra* note 6, at 5.

¹⁰ 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1:3 (2d ed. 2010). The Tenth Circuit has stated several economic and noneconomic reasons why the right of publicity is justified. *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 973-76 (10th Cir. 1996). The court justified the right of publicity economically because: (1) “it provides an incentive for creativity and achievement”; (2) “it promotes the efficient allocation of resources”; and (3) it protects consumers against deception. *Id.* at 973-75. The noneconomic justifications for the right of privacy include: (1) publicity rights stem from natural rights; (2) “publicity rights allow celebrities to enjoy the fruits of their labors”; (3) publicity rights prevent unjust enrichment; and (4) publicity rights prevent emotional injuries. *Id.* at 975-76.

cally, the right was defined as the “right to be let alone.”¹² BY NATURE, THE RIGHT OF PRIVACY IS CONSIDERED A PROPERTY RIGHT.¹³ The Second Circuit first recognized the right to protect the commercial value of one’s identity in 1953.¹⁴ The court recognized that a baseball player had a right of publicity and that he had the exclusive rights to publish his photograph under New York common law.¹⁵

The famed commentator William Prosser organized the right of privacy into four categories, including the appropriation of another’s name or likeness.¹⁶ Georgia was the first state to adopt a right of privacy in *Pavesich v. New England Life Insurance Co.*¹⁷ The Restatement (Second) of Torts states that the “right of privacy is invaded by . . . appropriation of the other’s name or likeness.”¹⁸ This occurs when one “APPROPRIATES TO HIS OWN USE OR BENEFIT THE NAME OR LIKENESS OF ANOTHER.”¹⁹

Eighteen states have since enacted the tort of privacy in statute,²⁰ and thirty-five states have a common law right of privacy.²¹ For example, Nevada law states that: “There is a right of publicity in the name, voice, signature, photograph or likeness of every person.”²² Washington state law pronounces that: “Every individual or personality has a property right in the use of his or her name, voice, signature, photograph, or likeness.”²³ Florida law states that: “No person shall publish, print, display or otherwise publicly use for purposes of trade or for any commercial or advertising purpose the name, portrait, photograph, or other likeness of any natural person . . .”²⁴ The underlying claim of the common law or statutory right of publicity is that “it is improper to make unauthorized use of another’s name or likeness for one’s own use or benefit.”²⁵

¹¹ MCCARTHY, *supra* note 10, § 1:7.

¹² RESTATEMENT (SECOND) OF TORTS § 652A cmt. a (1977).

¹³ *Id.* § 652C cmt. a.

¹⁴ *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953).

¹⁵ *Id.* at 868-69.

¹⁶ 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 28:5 (4th ed. 2009). The other three categories include: (1) “intrusion upon the plaintiff’s physical solitude”; (2) “public disclosure of embarrassing private facts”; and (3) “placing the plaintiff in a false light in the public eye.” *Id.*

¹⁷ *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905); *see* RESTATEMENT (SECOND) OF TORTS § 652A cmt. a (1977).

¹⁸ RESTATEMENT (SECOND) OF TORTS § 652A(2) (1977).

¹⁹ *Id.* § 652C.

²⁰ These states are: California, Florida, Illinois, Indiana, Kentucky, Massachusetts, Nebraska, Nevada, New York, Ohio, Oklahoma, Rhode Island, Tennessee, Texas, Utah, Virginia, Washington, and Wisconsin.

²¹ Barbara A. Solomon, *Can the Lanham Act Protect Tiger Woods? An Analysis of Whether the Lanham Act is a Proper Substitute for a Federal Right of Publicity*, 94 TRADEMARK REP. 1202, 1205 (2004).

²² NEV. REV. STAT. § 597.790(1) (2007).

²³ WASH. REV. CODE § 63.60.010 (2008).

²⁴ FLA. STAT. § 540.08(1) (2008).

²⁵ Solomon, *supra* note 21, at 1205. Stated another way, the policy behind the right of publicity is “to prevent a third party from taking some aspect of a person that has market value and for which the third party would normally have to pay.” *Id.*; *see also* *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

California common law and statutory publicity rights provide the broadest protections among the states.²⁶ In relevant part, the California Civil Code, section 3344 provides that:

(a) 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.²⁷

California's common law is even more expansive than the statute.²⁸ The main difference between the common law and statutory law is that the statute provides that the plaintiff must show that the defendant knowingly appropriated the plaintiff's likeness, while the common law has no such requirement.²⁹

Courts have also held that publicity rights survive the death of their owner.³⁰ In *Martin Luther King, Jr., Center for Social Change, Inc. v. American Heritage Products*, the defendant company created small plastic busts of Martin Luther King, Jr., without the permission of his estate.³¹ The defendant argued that King's right of publicity had ended at his death.³² However, the Georgia Supreme Court ruled that King's publicity rights survived his death and that they were inheritable and devisable.³³ The court reasoned that if publicity rights died with the celebrity, the celebrity's economic value during life might be diminished because a celebrity's untimely death or impairment would destroy the continued commercial use of the right.³⁴

Many states have codified the common law right to allow people's publicity rights to extend after their death.³⁵ California, for example, allows the likeness rights of a person to extend up to seventy years after the death of the person.³⁶ However, some states, such as New York, do not allow for post-mortem publicity rights in their statutes.³⁷

Under the common law, to prove misappropriation of one's likeness, the plaintiff would have to prove the following elements:

²⁶ Pamela Edwards, *What's the Score?: Does the Right of Publicity Protect Professional Sports Leagues?*, 62 ALB. L. REV. 579, 591 (1998).

²⁷ CAL. CIV. CODE. § 3344 (West 2007).

²⁸ See *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 414 (9th Cir. 1996) ("We have construed the statute's protection of name, voice, signature, photograph, or likeness more narrowly than the common law's protection of identity.") (internal quotations omitted); *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639, 640 (Cal. Ct. App. 1995) ("The statutory cause of action complements rather than codifies [the] common law . . .").

²⁹ See CAL. CIV. CODE. § 3344 (West 2007); *Abdul-Jabbar*, 85 F.3d at 413-14.

³⁰ See *Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. Am. Heritage Prods. Inc.*, 296 S.E.2d 697, 705 (Ga. 1982).

³¹ *Id.* at 698.

³² *Id.* at 699.

³³ *Id.* at 705.

³⁴ *Id.*

³⁵ See, e.g., CAL. CIV. CODE § 3344.1 (West Supp. 2010); IND. CODE § 32-36-1-8 (2008); OKLA. STAT. tit. 12, § 1448(G) (2008).

³⁶ CAL. CIV. CODE § 3344.1(g) (West Supp. 2010).

³⁷ See N.Y. CIV. RIGHTS LAW § 50 (McKinney 2009); see also MASS. GEN. LAWS ch. 214, § 3A (2009); UTAH CODE ANN. § 45-3-4 (2008).

(1) [T]he defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to the defendant's advantage, commercially or otherwise; (3) the lack of consent; and (4) the resulting injury.³⁸

Identifiability has been determined to be the key factor in likeness cases.³⁹ In *Newcombe v. Adolf Coors Co.*, Donald Newcombe, a former Major League Baseball pitcher, sued Coors Brewing Co. over an advertisement depicting Newcombe's likeness that it placed in *Sports Illustrated*.⁴⁰ The advertisement showed a drawing of a pitcher in the windup position, which Newcombe, along with his family and former teammates, immediately recognized as him.⁴¹ Subsequently, Newcombe filed suit in California alleging that Coors misappropriated his likeness in violation of California common and statutory law.⁴²

In defining how identifiable the depiction must be, the court held that for Newcombe's likeness to have been misappropriated, the pitcher in the advertisement must "be readily identifiable" as Newcombe.⁴³ Comparing a newspaper photograph of Newcombe to the advertisement, the court noted that both depictions contained Newcombe's unique pitching stance, and that the advertisement contained almost the exact same uniform styling.⁴⁴ Consequently, the court held that this created a triable issue of material fact notwithstanding some differences between the two depictions of Newcombe.⁴⁵ The court found that it would not be unreasonable for a jury to find that "a direct connection [existed] between [him,] as the central feature of the advertisement, and the commercial sponsorship of [Coors's product]."⁴⁶

In another common law likeness case, the plaintiff claimed that a video game producer used his likeness without his permission in a video game.⁴⁷ The defendant video game producer used the plaintiff, a martial artist, to pose as a

³⁸ *Eastwood v. Superior Court of Los Angeles*, 198 Cal. Rptr. 342, 347 (Cal. Ct. App. 1983); *see also* *Joe Dickerson & Assocs., LLC v. Dittmar*, 34 P.3d 995, 1002 (Colo. 2001). Some states have slightly different elements, but they all have the same general meaning. *See, e.g.,* *Parks v. LaFace Records*, 329 F.3d 437, 460 (6th Cir. 2003) ("All that a plaintiff must prove in a right of publicity action is that she has a pecuniary interest in her identity, and that her identity has been commercially exploited by a defendant."); *Brown v. Ames*, 201 F.3d 654, 657-58 (5th Cir. 2000) ("[A] plaintiff must prove that (1) the defendant misappropriated the plaintiff's name or likeness for the value associated with it and not in an incidental manner or for a newsworthy purpose; (2) the plaintiff can be identified from the publication; and (3) the defendant derived some advantage or benefit."); *Blair v. Nev. Landing P'ship*, 859 N.E.2d 1188, 1192 (Ill. App. Ct. 2006) (omits the "resulting injury" requirement).

³⁹ *Newcombe v. Adolf Coors Co.*, 157 F.3d 686, 692 (9th Cir. 1998) (citing *Eastwood*, 198 Cal. Rptr. at 346).

⁴⁰ *Id.* at 689.

⁴¹ *Id.*

⁴² *Id.*

⁴³ *Id.* at 692.

⁴⁴ *Id.*

⁴⁵ *Id.* at 692-93.

⁴⁶ *Id.* at 694. Coors admitted the drawing was made to resemble a photograph of Newcombe pitching in the 1949 World Series. *Id.* at 690. The drawing and the photograph were virtually the same, with the number of the player and the color of the hat being the only real differences. *Id.*

⁴⁷ *Pesina v. Midway Mfg. Co.*, 948 F. Supp. 40, 41-42 (N.D. Ill. 1996).

model for the characters in the game.⁴⁸ However, the court found that there was no evidence that suggested the plaintiff's likeness was recognizable because the video game producers had extensively altered the plaintiff's appearance.⁴⁹

The right of publicity is not limited to the appropriation of one's name or likeness, but also includes the plaintiff's identity.⁵⁰ As the Ninth Circuit stated:

Advertisers use celebrities to promote their products. The more popular the celebrity, the greater the number of people who recognize her, and the greater the visibility for the product. The identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice.⁵¹

In one case, the Sixth Circuit Court of Appeals found that the defendant had appropriated Johnny Carson's identity by using the phrase, "Here's Johnny," even though Carson's name or likeness was not used in marketing the defendant's product.⁵² The court explained that:

[t]he right of publicity has developed to protect the commercial interest of celebrities in their identities. The theory of the right is that a celebrity's identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity. . . .

. . . If the celebrity's identity is commercially exploited, there has been an invasion of his right whether or not his "name or likeness" is used.⁵³

To prove injury, plaintiffs must show that their likenesses have commercial value.⁵⁴ Where the likeness has commercial value, the injuries are usually of an economic nature.⁵⁵ The Ninth Circuit has noted that the greater the fame of the person, the greater the extent of the economic injuries.⁵⁶ Notably, the Tenth Circuit explained in *Cardtoons, L.C. v. Major League Baseball Players Association*⁵⁷ that athletes have a greater claim to publicity rights than celebrities because whereas celebrities' fame is largely created by the media and their audiences,⁵⁸ athletes' success results more from their natural talent and dedication.⁵⁹ Because professional athletes "sell the use of their name, likeness, or persona to companies for a financial gain," athletes are economically injured when their characteristics are used without their permission.⁶⁰

⁴⁸ *Id.* at 41.

⁴⁹ *Id.* at 42. Evidence showed that only six percent of 306 Mortal Combat game users could identify the plaintiff as the model. *Id.*

⁵⁰ *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992).

⁵¹ *Id.* at 1399.

⁵² *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 836-37 (6th Cir. 1983).

⁵³ *Id.* at 835.

⁵⁴ *See Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 824 (9th Cir. 1974).

⁵⁵ *Id.*

⁵⁶ *Id.* at 824 n.11.

⁵⁷ *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996).

⁵⁸ *Id.* at 975.

⁵⁹ *Id.* However, the argument can be made that some celebrities are just as talented and dedicated as many professional athletes.

⁶⁰ Stephen Reginald Fowler, *Taking a Bite out of Michael Vick's Publicity Rights: An Analysis of How the Right of Publicity Should Be Treated After a Celebrity Is Convicted of a Crime*, 16 J. INTELL. PROP. L. 109, 124 (2008).

B. The Lanham Act

Although federal law does not have a right of publicity statute,⁶¹ the Lanham Act is often used as a substitute.⁶² The Lanham Act reads in § 1125(a):

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . .

. . . .

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.⁶³

Although the right of publicity protects an individual's likeness, the Lanham Act "was enacted primarily to protect consumers from misrepresentations or deceptions and to protect trademark owners from the misperception that they are associated with or endorse a product."⁶⁴ The legislative history behind the Act provides that it serves as a "[p]rotection to goodwill, to prevent diversion of trade through misrepresentation, and the protection of the public against deception"⁶⁵ The scope of the Lanham Act has been expanded over the years to include unfair competition and false advertising, but the essential element of the Act requires a consumer's misconception that the plaintiff sponsors, endorses, or is associated with the defendant's product or service.⁶⁶

Under the Lanham Act, there are two different ways to bring a likeness claim: (1) false endorsement; and (2) infringement of an unregistered trademark.⁶⁷ The false endorsement claim is based on the unauthorized use of a person's identity "which is likely to confuse consumers as to the plaintiff's sponsorship or approval of the product."⁶⁸ Under a trademark infringement claim, athletes and celebrities have standing to sue because "they possess an economic interest in their identities akin to that of a traditional trademark holder."⁶⁹

⁶¹ However, the United States Code gives protection to live musical performers to some degree. See 17 U.S.C. § 1101 (2006).

⁶² Solomon, *supra* note 21, at 1206.

⁶³ 15 U.S.C. § 1125(a) (2006).

⁶⁴ Solomon, *supra* note 21, at 1206.

⁶⁵ S. REP. NO. 79-1333, at 6 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1277.

⁶⁶ Solomon, *supra* note 21, at 1206.

⁶⁷ *Id.* at 1212. The false endorsement claim has been more widely used by celebrities due to the difficulty of prevailing under a trademark infringement claim. *Id.* at 1213-15. Under a trademark infringement claim, plaintiffs have to show that they own a valid trademark that has a meaning independent of the person, which few persons have. *Id.* at 1215. As an example of a mark with independent meaning, the author states that the likeness of Paul Newman identifies a well-known celebrity, but his likeness also serves as a trademark to identify his line of food products. *Id.*

⁶⁸ *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992), *cert. denied*, 506 U.S. 1080 (1993).

⁶⁹ *Parks v. LaFace Records*, 329 F.3d 437, 445 (6th Cir. 2003), *cert. denied*, 540 U.S. 1074 (2003).

When evaluating a claim for false endorsement, courts use a “likelihood of confusion” test.⁷⁰ This test requires that courts apply eight factors to determine whether consumers are likely to be confused and believe that the plaintiff has endorsed the product.⁷¹ The eight-factor test includes: “(1) the strength of the plaintiff’s mark; (2) relatedness of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; (7) defendant’s intent in selecting the mark; [and] (8) likelihood of expansion of the product lines.”⁷² An exact likeness is not required to create liability under the Act.⁷³

To assert infringement of an unauthorized mark, plaintiffs must show that they own a valid, legally protectable trademark and that the defendant’s subsequent use of a similar mark is likely to cause confusion as to the origin of the goods.⁷⁴ A mark can be a word, name, or symbol “used in the sale or advertising of services to identify the service of the entity and distinguish them from the services of others.”⁷⁵ Furthermore, a trademark “has no independent significance apart from the goodwill it symbolizes.”⁷⁶

Due to the lack of an explicit federal right of publicity, several commentators have argued that Congress should enact a federal right of publicity.⁷⁷ The

⁷⁰ See, e.g., *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 926 (6th Cir. 2003); *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626-27 (6th Cir. 2000); *Wendt v. Host Int’l, Inc.*, 125 F.3d 806, 812 (9th Cir. 1997); *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 626-27 (S.D.N.Y. 1985). The Third Circuit also uses a false advertising test to show that the celebrity’s likeness sends a false message to the consumer. *Seale v. Gramercy Pictures*, 964 F. Supp. 918, 930 (E.D. Pa. 1997), *aff’d*, 156 F.3d 1225 (3d Cir. 1998). The false advertising test requires the plaintiff to show that: “(1) the context of the use contains a message of the plaintiff’s endorsement, approval or affiliation; and (2) that [the] message is false or misleading.” *Id.* If the message does not contain a clear endorsement of the product, the plaintiff may produce evidence showing what message the product conveys to the consumer. *Id.*

⁷¹ See, e.g., *Wendt*, 125 F.3d at 812.

⁷² *Id.*; *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1019-20 (3d Cir. 2008); *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626-27 (6th Cir. 2000).

⁷³ *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400-01 (9th Cir. 1992).

⁷⁴ *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 581-82 (2d Cir. 1990). In one of the few cases where a celebrity prevailed on a trademark infringement claim of a likeness, the court found that the celebrity’s likeness could not be a valid mark, but a particular image of the celebrity could be a valid mark if it retained a “single and continuing commercial impression.” *Estate of Presley v. Russen*, 513 F.Supp 1339, 1363-64 (D.N.J. 1981).

⁷⁵ *Caesars World, Inc. v. Caesar’s Palace*, 490 F. Supp. 818, 822 (D.N.J. 1980). The United States Supreme Court has recognized a cause of action under § 43 of the Lanham Act for infringement of an unregistered trademark. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (“[I]t is common ground that § 43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).”).

⁷⁶ *Marshak v. Green*, 746 F.2d 927, 929 (2d Cir. 1984).

⁷⁷ See Eric J. Goodman, *A National Identity Crisis: The Need for a Federal Right of Publicity Statute*, 9 J. DEPAUL-LCA J. ART & ENT. L. & POL’Y 227, 228 (1999) (“Without a standardized federal law on the subject, challenges in licensing the national use of one’s likeness requires careful and time consuming analyses of the various laws of the over twenty-five states that offer such protection. Inconsistencies in the various state laws make it both difficult and risky for lawyers and their celebrity clients.”); Alice Haemmerli, *Whose Who? The Case For a Kantian Right Of Publicity*, 49 DUKE L.J. 383, 410-11 (1999) (declaring that a federal statute would greatly reduce transaction costs and other market inefficien-

International Trademark Association proposed in 1998 to amend the Lanham Act to include a right of publicity.⁷⁸ The proposed legislation would preempt all state common and statutory law to harmonize differing state laws.⁷⁹ Additionally, the legislation also provides for fair use and First Amendment defenses.⁸⁰ The International Trademark Association believes that preempting state law would create much needed uniformity for publicity rights and make negotiating rights more predictable for rights holders.⁸¹

More recently in 2002, the Intellectual Property Section of the American Bar Association also suggested legislation to amend the Lanham Act explicitly to include a federal right of publicity.⁸² The proposed legislation recognizes a right of publicity by stating, "The right to control and to choose whether and how to use an individual's identity for commercial purposes is recognized as each individual's right of publicity."⁸³ The amendment states that a person's commercial identity may not be used unless a third party has received permission by the person whose likeness is being appropriated or that person's authorized representative.⁸⁴ Furthermore, the proposed amendment also allows for the transferability of publicity rights and the descendability of publicity rights after the death of the owner.⁸⁵ However, this proposed legislation has not been adopted.

C. *Defenses to Likeness Suits*

There are two general defenses against right of publicity claims: (1) consent and (2) the First Amendment.⁸⁶ As the name of the first defense suggests, the consent defense occurs when a person releases the rights to his or her likeness for commercial use.⁸⁷ The ability to assert the First Amendment defense

cies); Richard S. Robinson, *Preemption, the Right of Publicity, and a New Federal Statute*, 16 CARDOZO ARTS & ENT. L.J. 183, 201-02 (1998) ("A federal right of public identity statute would benefit the public, the judiciary, and those who invest time, effort, and money in their personal identities."); J. Eugene Salomon, Jr., Note, *The Right Of Publicity Run Riot: The Case for a Federal Statute*, 60 S. CAL. L. REV. 1179, 1186 (1987) ("The end result of [a preemption analysis] is always that one party's rights will be enforced at the expense of another's. A federal statute could provide a solution to this all or nothing situation.").

⁷⁸ International Trademark Association, *Federal Right of Publicity: Request for Action* by the INTA Board of Directors (Mar. 3, 1998), available at http://www.inta.org/index.php?option=com_content&task=view&id=285&Itemid=153&getcontent=5.

⁷⁹ *Id.*

⁸⁰ *Id.*; see *infra* Part II(C) for more information on these defenses.

⁸¹ *Id.*

⁸² *Proposed Federal Right of Publicity Act*, 2001-2002 Annual Report, ABA Section of Intellectual Property Law, Committee on Federal Trademark Legislation, available at <http://www.abanet.org/intelprop/annualreport06/content/01-02/COMMITTEE%20NO%20201.pdf>.

⁸³ *Id.* § 3.

⁸⁴ *Id.* § 5(a).

⁸⁵ *Id.* § 4.

⁸⁶ Laura Lee Stapleton & Matt McMurphy, *The Professional Athlete's Right of Publicity*, 10 MARQ. SPORTS L.J. 23, 42 (1999). A third defense of parody has also been used, which stems from the First Amendment defense. *Id.* One court stated that "[s]peech that entertains, like speech that informs, is protected by the First Amendment . . ." *Cartoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 969 (10th Cir. 1996).

⁸⁷ *Sharman v. C. Schmidt & Sons, Inc.*, 216 F. Supp. 401, 407 (E.D. Pa. 1963) ("A sports figure can complain when his name or likeness is used to advertise a product but he can

depends on whether the speech is categorized as either communicative or commercial.⁸⁸ The famed commentator, Thomas McCarthy, explained the difference between communicative and commercial speech:

A “communicative” use is one in which the policy of free speech predominates over the right of a person to his identity, and no infringement of the right of publicity takes place. A “commercial” use is one in which the right of publicity is infringed because, while there are overtones of ideas being communicated, the use is primarily commercial.

. . . The medium used will often determine the result. For example, the unpermitted use of a person’s identity on a product such as a coffee mug or a T-shirt will be “commercial” and require a license. However, the unpermitted use of a person’s identity and picture to illustrate a story in a newspaper, magazine or television news program will be “communicative” and immune.⁸⁹

McCarthy further explains that the First Amendment will preempt publicity rights when the likeness is being used in the context of news reporting, commentary, entertainment or works of fiction and nonfiction.⁹⁰

The case of *Abdul-Jabbar v. General Motors Corp.*⁹¹ helps to illustrate the difference between commercial and communicative speech. General Motors ran a television ad that presented the question of who holds the record for being voted the most valuable player of the NCAA tournament the most times.⁹² The advertisement then showed the printed words, “Lew Alcinder.”⁹³ The advertisement then depicted one of its cars and asked which car had been a consumer best buy multiple times.⁹⁴ The court held that, although presenting Alcinder’s records was newsworthy, General Motors used Alcinder’s record in the context of an advertisement, not for a news or sports account; therefore, General Motors could not assert the First Amendment defense because it was commercial speech.⁹⁵

In addition to the consent and First Amendment defenses, defendants have additional defenses available under the Lanham Act. For example, the Lanham Act provides for a fair-use defense, which includes both a statutory⁹⁶ and a judicially created fair-use.⁹⁷ Statutory fair use will be found where the defendant makes “a use, otherwise than as a mark . . . of a term or device which is

recover damages only if he has not consented to such use or the advertising exceeds the consent granted.”).

⁸⁸ MCCARTHY, *supra* note 16, § 28:41.

⁸⁹ *Id.*

⁹⁰ *Id.* §§ 28:40-41.

⁹¹ *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407 (9th Cir. 1996).

⁹² *Id.* at 409.

⁹³ *Id.* Lew Alcinder is more commonly known as Kareem Abdul-Jabbar. NBA Encyclopedia, Kareem Abdul-Jabbar, http://www.nba.com/history/players/abduljabbar_summary.html (last visited March 8, 2010).

⁹⁴ *Abdul-Jabbar*, 85 F.3d at 409.

⁹⁵ *Id.* at 416.

⁹⁶ 15 U.S.C. § 1115(b)(4) (2006).

⁹⁷ This is recognized in the Ninth Circuit. *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992) (“If the defendant’s use of the plaintiff’s trademark refers to something other than the plaintiff’s product, the traditional fair use inquiry will continue to govern. But, where the defendant uses a trademark to describe the plaintiff’s product, rather than its own, we hold that a commercial user is entitled to a nominative fair use defense”).

descriptive of and used fairly and in good faith only to describe the goods or services of such party”⁹⁸ Judicially created fair use, or nominative fair use, will be found where the defendant shows that: (1) the product in question is not readily identifiable without use of the trademark; (2) the mark is only used as is reasonably necessary to identify the product; and (3) the user of the mark does nothing that would suggest sponsorship by the trademark holder.⁹⁹

D. Remedies

Generally there are two types of remedies available under state and federal laws to plaintiffs who prevail on likeness rights cases: (1) injunctive relief and (2) damages.¹⁰⁰ Injunctive relief is appropriate for two reasons. First, measuring past and future monetary damages is difficult because of the uniqueness of a person’s likeness.¹⁰¹ Second, it prevents further misuse of the plaintiff’s likeness.¹⁰² Damages can include both compensatory damages (if there has been a commercial loss) and punitive damages.¹⁰³ Usually, punitive damages are assessed against the defendant only where there is a willful disregard of the plaintiff’s publicity rights.¹⁰⁴ Most publicity statutes provide for actual damages, including profits resulting from the unauthorized use of the plaintiff’s likeness.¹⁰⁵

Compensatory damages are defined as the fair market value of the plaintiff’s likeness, the damage to one’s professional standing and publicity value, and any unjust enrichment by the defendant.¹⁰⁶ The fair market value of the plaintiff’s likeness can be determined through an expert witness who can testify as to the kinds of fees that similar people get for similar uses of someone’s likeness.¹⁰⁷ Regarding one’s professional standing and publicity value, an award of damages is appropriate when, “The timing or context of defendant’s use may damage plaintiff’s professional standing and reasonable expectation of income, as well as the future publicity value of the plaintiff’s identity.”¹⁰⁸ These damages are usually in addition to fair market value damages.¹⁰⁹ Damages for unjust enrichment are common in trademark and copyright infringement cases, and allow the plaintiff to recover any profits made by the

⁹⁸ 15 U.S.C. § 1115(b)(4).

⁹⁹ *New Kids on the Block*, 971 F.2d at 308.

¹⁰⁰ Alexander Margolies, *Sports Figures’ Right of Publicity*, 1 SPORTS LAW. J. 359, 367 (1994).

¹⁰¹ *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1283 (D. Minn. 1970).

¹⁰² Stapleton & McMurphy, *supra* note 86, at 53.

¹⁰³ 2 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY, §§ 11.28-36 (2d ed. 2010). While the Lanham Act does not allow punitive damages, it does allow for enhanced damages of the plaintiff’s monetary damages. 15 U.S.C. § 1117(a) (2006); *Playboy Enters., Inc. v. Baccarat Clothing Co., Inc.*, 692 F.2d 1272, 1276 (9th Cir. 1982).

¹⁰⁴ *Id.* § 11:36.

¹⁰⁵ See, e.g., CAL. CIV. CODE § 3344.1 (West Supp. 2010); FLA. STAT. § 540.08(2)-(3) (2009); IND. CODE § 32-36-1-10 (2007).

¹⁰⁶ Stapleton & McMurphy, *supra* note 86, at 56.

¹⁰⁷ See Margolies, *supra* note 100, at 367-68.

¹⁰⁸ MCCARTHY, *supra* note 103, § 11.33.

¹⁰⁹ Stapleton & McMurphy, *supra* note 86, at 59.

defendant's use of the plaintiff's likeness.¹¹⁰ The Lanham Act provides that the plaintiff is entitled to recover the defendant's profits as well as any damages sustained by the plaintiff.¹¹¹

III. LICENSING AGREEMENTS

Most professional sports leagues have player unions that represent the professional athletes.¹¹² Player unions help protect the rights and interests of the athletes against the sports leagues, usually through a collective bargaining agreement.¹¹³

¹¹⁰ *Id.* at 60. An argument has been made that damages from unjust enrichment should also apply to right of publicity cases. *Id.*

¹¹¹ 15 U.S.C. § 1117(a) (2006).

¹¹² Each of the four main United States professional sports leagues' (Major League Baseball, the National Basketball Association, the National Football League, and the National Hockey League) players' associations have provisions regarding the ownership of athletes' likeness rights. These provisions are located in each respective league's collective bargaining agreement. Major League Baseball ("MLB") through its players' association, the MLBPA, states in its collective bargaining agreement that it has exclusive rights to the likenesses of MLB players. Major League Baseball Players Association, Frequently Asked Questions, <http://mlbplayers.mlb.com/pa/info/faq.jsp> (last visited Mar. 19, 2010). Specifically, the MLBPA website states that:

Any company seeking to use the names or likenesses of more than two Major League Baseball players in connection with a commercial product, product line or promotion must sign a licensing agreement with the MLBPA. The license grants the use of the players' names and/or likenesses only and not the use of any MLB team logos or marks.

Id. The website includes video games as an example of products licensed by the MLBPA. *Id.*

The National Basketball Association ("NBA") through its players' association, the National Basketball Players Association ("NBAPA"), states in its collective bargaining agreement that the NBA has the exclusive rights to use the attributes of every NBA player. NATIONAL BASKETBALL PLAYERS ASSOCIATION, COLLECTIVE BARGAINING AGREEMENT Art. XXXVII § 1 (2005), available at <http://www.nbpa.org/sites/default/files/ARTICLE%20XXXVII.pdf> (last visited Mar. 19, 2010). The National Hockey League ("NHL") through its players' association, the National Hockey League Players' Association ("NHLPA"), owns the likeness rights of players whenever three or more players are in a product or advertisement. NATIONAL HOCKEY LEAGUE PLAYERS' ASSOCIATION, COLLECTIVE BARGAINING AGREEMENT Art. 25.5(b) (2005), available at <http://www.nhlpa.com/About-Us/CBA/> (follow "Download a copy of the CBA" hyperlink) (last visited Mar. 19, 2010).

In contrast to professional sports leagues, the National Collegiate Athletic Association ("NCAA") Bylaws allow commercial entities to use players' exact identities without acquiring a license from the NCAA as long as the products do not use the players' names. Matthew G. Matzkin, *Gettin' Played: How the Video Game Industry Violates College Athletes' Rights of Publicity by Not Paying for Their Likenesses*, 21 LOY. L.A. ENT. L. REV. 227, 238-44 (2001). If NCAA athletes were to sell their likeness rights on their own, they would lose their amateur status and would not be allowed to compete in collegiate athletics. NATIONAL COLLEGIATE ATHLETIC ASSOCIATION, NCAA BYLAWS §§ 12.5.2.1, 12.5.2.2, available at http://grfx.cstv.com/photos/schools/samf/genrel/auto_pdf/Media_Internet_Sites.pdf (last visited Mar. 19, 2010).

¹¹³ See, e.g., National Basketball Players Association, About the NBAPA, <http://www.nbpa.org/about-us> (last visited Mar. 19, 2010); National Hockey League Players' Association, About the NHLPA, <http://www.nhlpa.com/About-Us/> (last visited March 19, 2010); Major League Baseball Players Association, Frequently Asked Questions, <http://mlbplayers.mlb.com/pa/info/faq.jsp#group> (last visited March 14, 2009). A collective bargaining agreement

A. *Legal Right to Licensing Agreements*

The courts first recognized that professional athletes' likeness rights could be assigned to player associations in *Topps Chewing Gum, Inc. v. Major League Baseball Players Ass'n*.¹¹⁴ In that case, Topps filed an antitrust lawsuit against the Major League Baseball Players Association ("MLBPA") claiming that the MLBPA monopolized the market for publicity rights by acquiring the likeness rights from all the players.¹¹⁵ Although the court did not specifically address the assignability of players' publicity rights, the court appears to have acquiesced to the assignment because the court did not discuss the agreements, but instead opted to move on to another issue.¹¹⁶

B. *The NFL and Licensing Agreements*

The NFL has a player union, the National Football League Players Association ("NFLPA").¹¹⁷ The NFLPA started in 1956 when players of the Cleveland Browns football team contacted Creighton Miller, the first general manager of the Browns, to represent them.¹¹⁸ Miller then began contacting players from other teams to join the association.¹¹⁹ Early on, the NFLPA mainly assisted the players in providing salary protection.¹²⁰ Currently, however, the NFLPA:

Represents all players in matters concerning wages, hours and working conditions and protects their rights as professional football players[;] Assures that the terms of the Collective Bargaining Agreement are met[;] Negotiates and monitors retirement and insurance benefits[;] Provides other member services and activities[;] Provides assistance to charitable and community organizations[;] [and] Enhances and defends the image of players and their profession on and off the field.¹²¹

is a contract between the sports league and the players association that regulates "employment conditions, wages, benefits, and grievances." BLACK'S LAW DICTIONARY 280 (8th ed. 2004).

¹¹⁴ *Topps Chewing Gum, Inc. v. Major League Baseball Players Ass'n*, 641 F. Supp. 1179 (S.D.N.Y. 1986).

¹¹⁵ *Id.* at 1181.

¹¹⁶ *Id.* at 1181-92; Erika T. Olander, Comment, *Stop the Presses! First Amendment Limitations of Professional Athletes' Publicity Rights*, 12 MARQ. SPORTS. L.J. 885, 892 (2002) ("Though in this particular decision the court did not specifically address the assignability of the players' publicity rights, the court apparently acquiesced to such assignability by means of the MLBPA's execution of its [sic] Commercial Authorization Agreements, because the court did not discuss the agreements or their validity and moved directly to the antitrust analysis. Therefore, professional athletes can assign their publicity rights to licensees for a specified use.").

¹¹⁷ National Football League Players Association, About Us, <http://www.nflplayers.com/about-us/> (last visited March 19, 2010).

¹¹⁸ National Football League Players Association, History, <http://www.nflplayers.com/about-us/History/> (last visited March 19, 2010).

¹¹⁹ *Id.*

¹²⁰ *Id.*

¹²¹ National Football League Players Association, About Us, <http://www.nflplayers.com/about-us/> (last visited Mar. 19, 2010).

Additionally, the NFLPA has created a group licensing agreement through its collective bargaining agreement.¹²² The group license is “defined as the use of a total of six or more NFL players’ names, signatures[,] facsimiles, voices, pictures, photographs, likenesses and/or biographical information on or in conjunction with products”¹²³ In 2004, Electronic Arts signed a deal with the NFLPA for the exclusive rights of NFL players estimated to be worth around \$300 million.¹²⁴ The NFLPA distributes the revenues from the licensing rights among the players.¹²⁵ Recently, the NFLPA and Electronic Arts extended their agreement through 2012 for an undisclosed amount.¹²⁶

However, the current collective bargaining agreement only applies to current NFL players or those seeking employment with the NFL, therefore excluding retired football players.¹²⁷ In many respects, the situation faced by retired players is much the same as that faced by college athletes. In EA Sports’ popular NCAA Football video game series, the video game producers assign the players in the game fake names, or simply call them by their numbers because of NCAA bylaws prohibiting commercial entities from using the real names of players and profiting from it.¹²⁸ Although the video game producers do not use the athletes’ real names to identify the players in the game, the players are readily identifiable as their living counterparts by their numbers, physical attributes, and the schools they represent.¹²⁹ Retired players often face the same dilemma as college athletes because although video game producers omit the retired athletes’ names from games, they create fictional characters that wear the same number, play for the same team, and have many of the same physical attributes as the retired players.

The claim made by retired players, however, is perhaps stronger than that of college athletes because of the economic value of the professional athlete. Athletes earn substantial sums of money through endorsements. For example, in 2008 athletes such as Tiger Woods, LeBron James, and Phil Mickelson each made over twenty million dollars a year in endorsements.¹³⁰ By contrast, the popularity of a college athlete will generally translate into higher ticket and sports paraphernalia sales that go directly to the institution, but none of that

¹²² National Football League Players Association, NFL-Hopeful-FAQS, <http://www.nflplayers.com/About-Us/FAQs/NFL-Hopeful-FAQs/> (last visited April 8, 2010).

¹²³ NATIONAL FOOTBALL LEAGUE PLAYERS ASSOCIATION, COLLECTIVE BARGAINING AGREEMENT Art. 5 § 4 (2006), available at <http://www.nflplayers.com/About-us/CBA-Download/> (follow “CBA 2006-2012” hyperlink) (last visited Mar. 19, 2010). This includes “trading cards, clothing, videogames, computer games, collectibles, internet sites, fantasy games, etc.” *Id.*

¹²⁴ Matt Richtel, *Electronic Arts Gets an Exclusive N.F.L. Deal*, N.Y. TIMES, Dec. 14 2004, at C2.

¹²⁵ See NATIONAL FOOTBALL LEAGUE PLAYERS ASSOCIATION, *supra* note 123, at Art. 5 § 4.

¹²⁶ Press Release, Elec. Arts, Inc., EA Extends Interactive Videogame Agreements With NFL and NFL Players (Feb. 12, 2008), available at http://files.shareholder.com/downloads/ERTS/569990348x0x203469/0ecfad7b-0078-419b-b5dd-c6d722e3fab9/ERTS_News_2008_2_12_General.pdf (last visited Mar. 19, 2010).

¹²⁷ NATIONAL FOOTBALL LEAGUE PLAYERS ASSOCIATION, *supra* note 123, at Preamble.

¹²⁸ See Matzkin, *supra* note 112, at 239-40.

¹²⁹ See *id.* at 239-44.

¹³⁰ Jonah Freedman, *Ranking the 50 Highest-earning Athletes in the U.S.*, SI.com, <http://sportsillustrated.cnn.com/more/specials/fortunate50/> (last visited Mar. 19, 2010).

money goes directly to the student. Although popular professional athletes can also generate higher ticket and paraphernalia sales that benefit the teams and leagues that those players represent, professional athletes have the ability to sign very lucrative endorsement and contract deals that college athletes cannot. Moreover, retired players can still have a high economic value after their playing careers are over because of the success they had while still playing professionally. Popular retired athletes, such as Michael Jordan, still receive millions of dollars in endorsement deals because of the fame and notoriety they obtained while playing.¹³¹

Recently, a group of retired NFL players filed a class action lawsuit against the NFLPA in a United States District Court based on an NFLPA licensing program that sought to take advantage of the economic value of retired NFL athletes.¹³² The retired players alleged that the NFLPA promoted a “Retired Players Group Licensing Program” through which the NFLPA “solicit[ed] retired players to grant the NFLPA a group license” of their likeness rights, much in the same way it does with current athletes.¹³³ The license included the “right to market the . . . player’s name, number, likeness, voice, facsimile[,] signature, photograph, picture, and/or biographical information”¹³⁴ The licensing agreements stated that the NFLPA would divide the revenues created by the group licensing agreement between the players.¹³⁵ However, the retired players alleged that the NFLPA breached its contractual obligations by not sharing the generated revenues with those retired players that participated in the Retired Players Group Licensing Program.¹³⁶

On November 10, 2008, a federal jury, after deciding that the NFLPA had withheld fees for the use of their images, unanimously voted in favor of the retired players.¹³⁷ The jury awarded the players \$28.1 million in damages, roughly amounting to a \$13,000 payout for each of the 2062 retired NFL players that participated in the program.¹³⁸ Perhaps the most damaging evidence against the NFLPA that the former players recovered was a letter from a union executive to EA Sports that directed EA Sports to scramble the images of the retired players to avoid royalty payments from the sales of Madden games.¹³⁹ Herb Adderley, a named member of the class action and former Green Bay Packers cornerback and member of the NFL Hall of Fame, said that “[i]f you

¹³¹ The Celebrity 100: #18 Michael Jordan, http://www.forbes.com/lists/2008/53/celebrities08_Michael-Jordan_UGGU.html (last visited Mar. 19, 2010).

¹³² Complaint, *Parrish v. Nat. Football League Players Ass’n*, 3:07-cv-00943-WHA (N.D. Cal. 2007) 2007 WL 5157108.

¹³³ *Id.* at 5.

¹³⁴ *Id.*

¹³⁵ *Id.* at 7.

¹³⁶ *Id.* at 10.

¹³⁷ Greg Johnson, *NFL Union Takes Hit in Court*, L.A. TIMES, Nov. 11, 2008, at D1. The NFLPA later filed an appeal contesting whether there was enough evidence to support the jury’s decision. See *Parrish v. Nat. Football League Players Ass’n*, No. 3:07-cv-00943-WHA at 2 (N.D. Cal. 2009) (order denying all post-trial motions). The District Court judge denied the NFLPA’s appeal and ruled that the verdict and the monetary damages were appropriate. *Id.* at 5-6. The Judge thought that the large punitive damages award “was not disproportionate to the wrong done or to the compensatory award.” *Id.*

¹³⁸ Johnson, *supra* note 137, at D1.

¹³⁹ *Id.*

look at the 1976 Green Bay Packers in that game, you'll know that the only left cornerback that year had to be Herb Adderley, but they scrambled my face and took the number off of my jersey . . . Yet, they had my correct height, weight and years of experience."¹⁴⁰

IV. BROWN V. SONY

Brown v. Sony is a good example of the type of lawsuit that video game producers that use the likenesses of retired athletes without permission can expect.¹⁴¹ Although this Note focuses its analysis on Jim Brown's likelihood of success, a similar analysis can be used for other retired professional athletes who have achieved the same level of success and notoriety as Brown.

A. Parties' Background Information

Jim Brown is often heralded as the greatest football player of all time.¹⁴² Brown played college football at Syracuse University from 1954 to 1956, and was later inducted into the College Football Hall of Fame for his standout play.¹⁴³ He not only excelled on the football field, but was also considered one of the greatest lacrosse players at that time.¹⁴⁴ The Cleveland Browns of the NFL selected Brown as its first pick in the 1957 NFL draft.¹⁴⁵ Subsequently, Brown played nine seasons in the NFL for the Cleveland Browns from 1957-1965.¹⁴⁶ He was the NFL Rookie of the Year in 1957 and played in nine straight NFL Pro-Bowl games.¹⁴⁷ Brown also won the NFL's Most Valuable Player award twice: in 1958 and 1965.¹⁴⁸ He retired from the NFL holding 20 records¹⁴⁹ and still holds records today in such categories as most season rushing titles, highest average gain per rush for running backs, and most seasons leading the league in touchdowns scored.¹⁵⁰ Brown holds virtually every

¹⁴⁰ *Id.*

¹⁴¹ Former college athletes have filed similar suits against EA Sports. See William C. Rhoden, *A Lasting Image: Standing up to the N.C.A.A.*, N.Y. TIMES, July, 22, 2009, at B12.

¹⁴² The Sporting News, Football's 100 Greatest Players, <http://archive.sportingnews.com/nfl/100/> (follow "The complete list" hyperlink) (last visited Mar. 14, 2010).

¹⁴³ College Football Hall of Fame, Jim Brown, <http://www.collegefootball.org/famer-search.php?id=50092> (last visited March 14, 2009).

¹⁴⁴ National Lacrosse Hall of Fame, http://apps.uslacrosse.org/museum/halloffame/list_alpha.php?letter=B (last visited Mar. 19, 2010). Jim Brown was later inducted into the National Lacrosse Hall of Fame. *Id.*

¹⁴⁵ Cleveland Browns, Players: Jim Brown, http://www.clevelandbrowns.com/team/history/honor/jim_brown.php (last visited Mar. 19, 2010).

¹⁴⁶ National Football League, Jim Brown, <http://www.nfl.com/players/jimbrown/profile?id=BRO483276> (last visited Mar. 19, 2010).

¹⁴⁷ Cleveland Browns, *supra* note 145.

¹⁴⁸ *Id.*

¹⁴⁹ The Sporting News Football's 100 Greatest Players, <http://archive.sportingnews.com/nfl/100/> (follow "The complete list" hyperlink; then follow "Jim Brown" hyperlink) (last visited March 14, 2009).

¹⁵⁰ National Football League, Record and Fact Book, <http://www.nfl.com/history/randf/records/indiv/rushing> (last visited Mar. 19, 2010).

meaningful Cleveland Browns record for running backs including most rushing yards, carries, combined yards, and touchdowns.¹⁵¹

In 1971, at age thirty-five, Brown became the second-youngest player to be inducted into the NFL Hall of Fame.¹⁵² Following his football career, Brown became an actor, starring in several movies and making guest appearances on television shows.¹⁵³ Currently, Brown runs a non-profit organization that provides life-management skills to youth in high-crime and low-income neighborhoods.¹⁵⁴

EA Sports is a label owned by Electronic Arts.¹⁵⁵ Electronic Arts was founded in 1982 and is headquartered in Redwood City, California.¹⁵⁶ Electronic Arts claims to be one of the leading interactive entertainment software companies in the world.¹⁵⁷ Electronic Arts has created popular game titles such as *The Sims*, *Rock Band*, and many popular sports game franchises.¹⁵⁸ For the 2008 fiscal year, it posted \$3.67 billion in revenues and had twenty-seven game titles that sold over one million copies, with fifteen of those titles selling over two million copies.¹⁵⁹ Electronic Arts is the number one video game publisher in North America with a nineteen percent market share, and in Europe, with a twenty percent market share.¹⁶⁰

B. Likeness Suit

Brown's claim originates over a likeness issue between Brown and EA Sports' Madden NFL series.¹⁶¹ However, a federal district court recently granted EA Sports' Motion to Dismiss Brown's false endorsement Lanham Act claim.¹⁶² Even though the court dismissed Brown's false endorsement Lanham Act claim, an analysis of Brown's claims for violations of common law and statutory right of publicity laws and the Lanham Act provide a framework for

¹⁵¹ Cleveland Browns, *supra* note 145.

¹⁵² Cleveland Browns, Players: Jim Brown, http://www.clevelandbrowns.com/team/history/honor/jim_brown.php (last visited Mar. 19, 2010).

¹⁵³ See EA Complaint, *supra* note 6, at 4; International Movie Database, Jim Brown, <http://www.imdb.com/name/nm0000987/> (last visited March 14, 2009).

¹⁵⁴ See The Amer-I-Can Program, Foundation Home, http://www.amer-i-can.org/AMIC_Program_Overview.pdf (last visited Mar. 21, 2010).

¹⁵⁵ Electronic Arts, Inc., Company Labels, <http://aboutus.ea.com/companylabels.action> (last visited Mar. 19, 2010).

¹⁵⁶ Electronic Arts, Inc., About Us, <http://aboutus.ea.com/home.action> (last visited Mar. 19, 2010).

¹⁵⁷ *Id.*

¹⁵⁸ See Electronic Arts, Inc., Products, <http://press.ea.com/schedule.asp?order=&s=0> (last visited Mar. 19, 2010).

¹⁵⁹ Press Release, Elec. Arts, Inc., EA Reports Fourth Quarter and Fiscal Year 2008 Results (May 13, 2008), available at <http://files.shareholder.com/downloads/ERTS/468810291x0x205801/b5229035-2624-4a11-bcee-6dc5645f5ffe/Earnings%20Release.pdf>.

¹⁶⁰ *Id.*

¹⁶¹ EA Complaint, *supra* note 6, at 5-6.

¹⁶² Brown v. Elec. Arts, Inc., No. 2:09-cv-01598-FMC-RZ at 10 (C.D. Cal. Sept. 23, 2009) (order granting in part defendant's motion to dismiss and order dismissing defendant's motion to strike as moot). The court did not rule on the state and common law claims. *Id.* at 9.

how similar retired professional athletes might fare in likeness rights cases.¹⁶³ Because these suits are likely to be very costly for individual retired players, a class-action suit would probably be more effective.

1. Common Law Right of Publicity

In order for Brown to recover damages from EA Sports' misappropriation of his likeness, Brown would have to show: (1) EA Sports used Brown's identity in the Madden game; (2) that EA Sports did so without Brown's consent; (3) that EA Sports' appropriation of Brown's name or likeness was to its advantage, commercially or otherwise; and (4) that EA Sports injured Brown.¹⁶⁴ First, there is little doubt of Brown being identified as the player in EA Sports' Madden NFL franchise. Although the player in the game might not look exactly like Brown, the player in the game shares the same identity as Brown. Anyone familiar with football would readily identify Brown as the player on the Cleveland Browns's all-time team for the following reasons: Brown played for the Cleveland Browns for his entire career and was the best running back that the franchise ever had;¹⁶⁵ the player in the video game wears number thirty-two, the same number that Brown wore as a player for the Browns;¹⁶⁶ and both the player in the game and Brown are African-American.¹⁶⁷ Furthermore, Brown has been mentioned as the greatest NFL player of all-time,¹⁶⁸ so there is little doubt that he would be placed on a game that advertised itself as featuring fifty of the greatest NFL players of all-time.

In *White v. Samsung Electronics America, Inc.*,¹⁶⁹ the Ninth Circuit used a perfect analogy to Brown's case to describe identifiability.¹⁷⁰ In *White*, the court compared a computerized image of Vanna White from the popular *Wheel of Fortune* television show to a hypothetical computerized version of the famous basketball player, Michael Jordan.¹⁷¹ The court said:

¹⁶³ The court dismissed Brown's false endorsement Lanham Act claim because the court held that even if EA Sports used Brown's likeness in the game, it would be protected by the First Amendment. *Id.* at 9. The court held the use of Brown's likeness to be expressive speech, "akin to an expressive painting that depicts celebrity athletes . . ." *Id.* at 7. After determining that such use constituted expressive speech, the court then applied a two-prong test to preclude the false endorsement claim. *Id.* at 5-6. The first prong, "require[d] that the defendant's use of plaintiff's trademark be relevant to the underlying work . . ." *Id.* at 6. The second prong then required that the "use of [the plaintiff's] likeness explicitly mislead[] consumers as to the source or content of the work." *Id.* at 8. An analysis of Brown's false endorsement and trademark infringement Lanham Act claims are included because the court only analyzed the First Amendment defense without going through an analysis of the likelihood of confusion factors. *See id.* at 4-5.

¹⁶⁴ *See Eastwood v. Superior Court of Los Angeles*, 198 Cal. Rptr. 342, 347 (Cal. Ct. App. 1983).

¹⁶⁵ *See Cleveland Browns, Players: Jim Brown*, http://www.clevelandbrowns.com/team/history/honor/jim_brown.php (last visited March 14, 2009).

¹⁶⁶ *Id.*

¹⁶⁷ Sony Complaint, *supra* note 6, at 6.

¹⁶⁸ The Sporting News, *Football's 100 Greatest Players*, <http://tsn.sportingnews.com/nfl/100/> (last visited March 14, 2009).

¹⁶⁹ *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1385 (9th Cir. 1992).

¹⁷⁰ *Id.* at 1399.

¹⁷¹ *Id.*

Consider a hypothetical advertisement which depicts a mechanical robot with male features, an African-American complexion, and a bald head. The robot is wearing black hightop Air Jordan basketball sneakers, and a red basketball uniform with black trim, baggy shorts, and the number 23 (though not revealing “Bulls” or “Jordan” lettering). The ad depicts the robot dunking a basketball one-handed, stiff-armed, legs extended like open scissors, and tongue hanging out. Now envision that this ad is run on television during professional basketball games. Considered individually, the robot’s physical attributes, its dress, and its stance tell us little. Taken together, they lead to the only conclusion that any sports viewer who has registered a discernible pulse in the past five years would reach: the ad is about Michael Jordan.¹⁷²

Almost the exact same hypothetical could be posed using Brown and the player found in the Madden games.

Second, there is likely to be little, if any evidence to suggest that EA Sports obtained Brown’s consent to use his likeness, therefore preventing EA Sports from asserting the consent defense.¹⁷³ In his complaint, Brown states that he “never authorized the use of his name or likeness to be used in connection” with EA Sports’ video game.¹⁷⁴ Furthermore, information from the *Parish* case helps to illustrate that EA Sports did not have Brown’s consent. EA Sports knew that the NFLPA had created a Retired Players Group Licensing Agreement,¹⁷⁵ and from this, EA Sports would have known that it needed the licensing rights of retired players to use them in its games. EA Sports knew which players had signed the group licensing agreement because the NFLPA told EA Sports to scramble the retired players’ images to avoid royalty payments.¹⁷⁶ Jim Brown was not part of the Retired Players Group Licensing Program;¹⁷⁷ therefore, EA Sports would have known that it needed to get Brown’s consent in order to use his likeness in the game.

Third, Brown would have to prove that EA Sports used Brown’s likeness to its advantage. EA Sports advertised that its Madden game included former players as an incentive to get consumers to purchase the game, therefore profit-

¹⁷² *Id.*

¹⁷³ In another case, a former Western Michigan University player sued Electronic Arts, Inc. under a common law misappropriation claim. *Neal v. Elec. Arts, Inc.*, 374 F. Supp. 2d 574, 576 (W.D. Mich. 2005). The plaintiff alleged that EA used his likeness in Madden NFL 05 and Madden NFL 06. *Id.* The plaintiff, an African-American named Steve Neal, shared the same name with a then current Caucasian NFL player. *Id.* In the biographical portion of the Madden game, the game mistakenly pictures the plaintiff instead of the current NFL player, but correctly shows the NFL player’s statistics and properly displays the current NFL player in the action part of the game. *Id.* The plaintiff had tried-out to play for an NFL team and had signed an agreement releasing his likeness rights to the NFLPA. *Id.* at 577. Because the plaintiff had assigned his rights to the NFLPA, the court held that EA Sports successfully raised a consent defense and the court held it not liable under the misappropriation claim. *Id.* at 578-79. In this case, Brown’s contract with the NFLPA would have ended when his career did, as the NFLPA Collective Bargaining Agreement does not include retired players. NATIONAL FOOTBALL LEAGUE PLAYERS ASSOCIATION, *supra* note 123, at Preamble.

¹⁷⁴ EA Complaint, *supra* note 6, at 5.

¹⁷⁵ See Johnson, *supra* note 137, at D1 (EA Sports knew of the licensing agreement because the NFLPA sent them a letter telling them to scramble the identities of the retired players so that the NFLPA would not have to pay licensing fees).

¹⁷⁶ *Id.*

¹⁷⁷ There is no mention of Brown as a party to the *Parish* case.

ing off of Brown and other former NFL players. Regardless of the advertising aspect, EA Sports would have been able to increase its own profits by not purchasing the licensing rights to Brown's likeness.

Last, Brown should have little difficulty proving that he was injured by EA Sports' use of his likeness. The most obvious injury to Brown stems from the royalty payments that Brown would have earned if EA Sports had purchased his likeness rights. EA Sports pays hundreds of millions of dollars to the NFL and the NFLPA to be able to use NFL logos, teams, and the players' likeness rights.¹⁷⁸ Had EA Sports obtained a license from Brown, Brown would have been able to collect part of the payments. Brown may also have been economically injured due to potential lost opportunities on other licensing agreements with other video game producers. If other video game producers thought that EA Sports had an exclusive licensing agreement with Brown, other video game producers would not have approached Brown to use his likeness in their games; therefore, Brown would have lost additional profits.¹⁷⁹

EA Sports will not be able to assert any effective defenses against Brown. As already discussed, Brown did not consent to EA Sports' use of his likeness. That leaves only the First Amendment defense.¹⁸⁰ EA Sports will have an extremely difficult time trying to prove that the speech is communicative. The video game is not trying to communicate any type of news or to illustrate a story. The depiction of Brown in the video games is a purely commercial use from which EA Sports is trying to profit.

2. Statutory Right of Publicity

Brown should be able to recover damages under the California right of publicity statute that Brown claimed EA Sports violated. Brown need only prove that EA Sports knowingly used his likeness in the game.¹⁸¹ In this case, EA Sports must have knowingly used Brown's likeness for its game because EA Sports modeled the player in the game after Brown. The player in the game wears Brown's number, is African-American, plays the same position as Brown, and plays for Brown's former team.¹⁸² EA Sports also represents that the player in the game is one of the fifty greatest NFL players. Furthermore, the player is on the Cleveland Browns's all-time great team, somewhere anyone familiar with the game would expect Brown to be because of his prominence while playing in the NFL.¹⁸³

¹⁷⁸ Richtel, *supra* note 124, at C2.

¹⁷⁹ See *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 416 (9th Cir. 1996).

¹⁸⁰ The court dismissing Brown's claim applied the First Amendment defense in the context of a Lanham Act claim, not a common law claim. See *Brown v. Elec. Arts, Inc.*, No. 2:09-cv-01598-FMC-RZ at 5 (C.D. Cal. Sept. 23, 2009) (order granting in part defendant's motion to dismiss and order dismissing defendant's motion to strike as moot).

¹⁸¹ See CAL. CIV. CODE § 3344.1 (West Supp. 2010).

¹⁸² Sony Complaint, *supra* note 6, at 6.

¹⁸³ See *supra* Part IV(A).

3. *Lanham Act*

The Lanham Act allows Brown and similarly situated athletes to bring claims for both false endorsement and trademark infringement.¹⁸⁴ Many of the factors in this analysis require the plaintiff to show the consumer's reaction to the depiction of the plaintiff's likeness.

a. *False Endorsement*

To establish a claim for false endorsement, the plaintiff must prove that there is a likelihood of confusion among consumers that the plaintiff endorsed the defendant's product.¹⁸⁵ Under the eight factor test, plaintiffs would have to show: "(1) the strength of the plaintiff's mark; (2) relatedness of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; (7) defendant's intent in selecting the mark; [and] (8) likelihood of expansion of the product lines."¹⁸⁶ A plaintiff need not prove each of the factors in order to prevail, but the court would consider each factor to help make the ultimate determination.¹⁸⁷

First, Brown has a strong mark. The plaintiff's mark can be associated with the plaintiff's name or likeness and the strength of the mark "refers to the level of recognition the celebrity enjoys among members of society."¹⁸⁸ In the arena in which EA Sports markets the game, Brown is likely well known to almost anyone who is a football fan and is familiar with its history and players. Second, Brown's fame is almost entirely based on his football career, so his "goods" would be closely related to a game based on NFL players and licensed by the NFL and the NFLPA.¹⁸⁹ Third, as already discussed in the right of publicity section,¹⁹⁰ the similarities between Brown and the player depicted in the video game are striking.

Fourth, Brown would have to present evidence that some people actually thought that EA Sports was using Brown's likeness in the game.¹⁹¹ Although expensive, this would likely be relatively easy to establish because of all the similarities between Brown and the athlete depicted in the game. However, Brown would also have to show that consumers actually thought that Brown endorsed the game beyond just having his virtual self represented in the game.

¹⁸⁴ See *supra* Part II(B).

¹⁸⁵ See *supra* Part II(B). Brown could also bring a claim under the false advertising test, but it is highly unlikely that Brown would prevail under this test. There is no real clear endorsement of the product by Brown. Brown does not appear on any type of advertisement for the game, and his name is not mentioned anywhere on the product. Because there is no clear endorsement of the product, Brown would have to prove what message consumers received from seeing his likeness in the game. This would have to be done by using expensive market research and/or using consumer surveys. See *Seale v. Gramercy Pictures*, 964 F. Supp. 918, 930 (E.D. Pa. 1997). Brown and other retired players would be better off not asserting a claim for false advertising because of the low probability of success and because of the greater likelihood of success applying the likelihood of confusion test.

¹⁸⁶ *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 812 (9th Cir. 1997).

¹⁸⁷ *Eclipse Assocs. Ltd. v. Data Gen. Corp.*, 894 F.2d 1114, 1118 (9th Cir. 1990).

¹⁸⁸ *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992).

¹⁸⁹ *Id.* ("[T]he plaintiff's 'goods' concern the reasons for or source of the plaintiff's fame.").

¹⁹⁰ *Supra* Part IV(B)(1).

¹⁹¹ See *Wendt*, 125 F.3d at 813.

Brown would have to present evidence that he somehow promoted the game or EA Sports used Brown's name or likeness in its advertising. The balancing of the fifth element could be favorable to either party. Brown would need to show that EA Sports used Brown's likeness or identity in similar marketing channels that Brown would market himself.¹⁹² Brown would naturally market himself to a football audience because those are the people that recognize him. However, Brown would have to prove that his fan base is also comprised of video game players and that Brown would market himself through video games.

The sixth element for degree of purchaser care could also work favorably to either party depending on how the parties characterize the issue. Most purchasers of the popular Madden series of games are probably very aware of who endorses the game. Each cover of the game depicts one of the NFL's current stars.¹⁹³ There is even a widely known "Madden Curse" that is associated with the athletes who appear on the covers of the Madden games.¹⁹⁴ The game has become so much a part of the popular culture that there is even a television show that depicts some of the country's best Madden video game players competing in a tournament, with each contestant represented by a current NFL player.¹⁹⁵ Therefore, there are some individuals that might purchase the game because of those players who are in the game, although there are others who purchase the game just because they like football video games.

The seventh factor would require Brown to prove that EA Sports "'intended to profit by confusing consumers' concerning the endorsement" of the Madden games.¹⁹⁶ Brown could again establish this by using the fact that the fictional character in the game closely resembles Brown and that EA Sports advertised the game as having fifty of the NFL's greatest players, a list on which any football fan would expect to find Brown. The eighth factor is usually not relevant in a celebrity endorsement case,¹⁹⁷ but Brown could show that he intended to expand his product line into other football video games. Brown would have to present evidence that other video game producers would have approached him to enter into licensing agreements with them regarding their video games had it not been for the apparent "contract" with EA Sports in the Madden games.

From this short analysis, it would seem that many of the factors weigh in Brown's favor, as they could with other similarly situated athletes. However, as the recent dismissal of Brown's false endorsement claim shows, it might not even matter if plaintiffs can prove that the factors weigh in their favor because video game producers will be able to assert the First Amendment defense. Nevertheless, because there is no circuit court authority on this exact issue, a different court could find differently based on a case presented by a similarly situated retired athlete.

¹⁹² See *id.*; *White*, 971 F.2d at 1400.

¹⁹³ See Mike Penner, *Madden Curse Eyes Young*, L.A. TIMES, April 18, 2007, at D2.

¹⁹⁴ *Id.* (Several of the athletes on the cover of the game have suffered injuries or had poor seasons following their appearance on the cover.).

¹⁹⁵ Press Release, Elec. Arts, Inc., ESPN2's Madden Nation to Begin Fourth Season (Sept. 15, 2008), available at <http://press.ea.com/release.asp?i=984>.

¹⁹⁶ See *White*, 971 F.2d at 1400 (internal citations omitted).

¹⁹⁷ *Id.* at 1401.

*b. Trademark Infringement*¹⁹⁸

Brown would have a very difficult time establishing trademark infringement to his likeness or name. Not only would this be a difficult claim for Brown to prove, but EA Sports would be able to assert the defense, *inter alia*, that Brown lacks protectable rights to his trademark and that the use of the trademark is protected by fair use. For Brown to prove trademark infringement of his likeness, Brown would have to show that his likeness was a symbol of an independent product line.¹⁹⁹ For example, one court held that Elvis Presley had a valid trademark to his likeness of only one particular pose that was used in conjunction with promoting and advertising products.²⁰⁰ However, Elvis could not assert a trademark to his general likeness because that would be too broad.²⁰¹ In this case, Brown would be asserting a general claim to his likeness, which is likely to fail. Brown does not have any one pose that would qualify him to a trademark of his image, and even if he did, it would not associate him with the Madden games.

Next, Brown could argue that he owns a trademark to his name. In Brown's complaint, he alleged that he owned an arbitrary trademark in a name as the "All-Time Great Cleveland Brown [sic] Running Back" that has acquired a secondary meaning.²⁰² An arbitrary trademark uses common words in an uncommon way.²⁰³ However, it seems that Brown's claim of having an arbitrary trademark would be misplaced. Brown's claim of owning a trademark over "All-Time Great Cleveland Browns Running Back" would more appropriately implicate a possible descriptive trademark. A descriptive trademark identifies or describes "some aspect, characteristic, or quality of the [product] [service] to which they are affixed in a straightforward way that requires no exercise of imagination to be understood."²⁰⁴ A descriptive mark receives trademark protection if it has acquired distinctiveness through a secondary meaning.²⁰⁵ A mark acquires secondary meaning when "the name and the business have become synonymous in the mind of the public."²⁰⁶ In other words,

¹⁹⁸ A claim for trademark infringement was only part of the original complaint, not the second complaint, so this claim was never reached by the court that dismissed Brown's claims. Sony Complaint, *supra* note 6, at 7. Furthermore, as discussed *infra*, it is unlikely that Brown would be able to prove such a claim in the first place.

¹⁹⁹ See *Marshak v. Green*, 746 F.2d 927, 929 (2d Cir. 1984) (noting that there are "no rights in a trademark apart from the business with which the mark has been associated[.]").

²⁰⁰ *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1363-64 (D. N.J. 1981).

²⁰¹ *Id.* The court found that a particular pose of Elvis Presley could serve as a mark because it had been used in promoting and advertising, which created a "continuing commercial impression." *Id.* In another case involving Tiger Woods, the court held that a person's likeness of image cannot function as a trademark because that would classify Woods as a walking, talking trademark. *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 922 (6th Cir. 2003).

²⁰² Sony Complaint, *supra* note 6, at 7.

²⁰³ Philip A. Jones et al., *Trademark Infringement Primer*, 904 PRAC. LAW INST. 207, 395 (2007). The computer company Apple would be an arbitrary trademark because apple does not describe computers, but rather designates where the computers come from. *Id.*

²⁰⁴ *Id.* at 396.

²⁰⁵ *Abraham Zion Corp. v. Lebow*, 761 F.2d 93, 104 (2d Cir.1985).

²⁰⁶ *Id.*

secondary meaning occurs where “the primary significance of a [mark] is to identify the source of the product rather than the product itself.”²⁰⁷

Although the public might understand the primary meaning of “All-Time Great Cleveland Browns Running Back” to represent Brown, the mark has not acquired secondary meaning such as through advertising or promotion of a product.²⁰⁸ The Madden game only uses the description “All-time Great Cleveland Browns Running Back” in the primary sense—to identify the great running back Jim Brown. It would then not constitute an infringement of his trademark, but would be protected through fair use.²⁰⁹

However, even if retired athletes situated similarly to Brown could prove all of the elements of a false endorsement or trademark infringement claim and overcome any potential defenses, a retired athlete’s case might be distinguishable from other celebrities that have prevailed under Lanham Act claims. In many of the suits where celebrities prevailed on their Lanham Act claims, the defendant used the celebrity’s likeness in the context of an advertisement.²¹⁰ Furthermore, in other cases, the celebrity’s mark was much more distinct and more widely known than that of many athletes.²¹¹ Still, in other cases, even the most widely known sports figures and celebrities have not prevailed on their Lanham Act claims for likeness right violations.²¹² In cases like that of Brown’s, it is likely that the athletes have not appeared in any advertisements for the Madden games that would show their endorsement of it, nor is their fame as great as that of some of the other celebrities that have prevailed on their likeness claims, or even some that have failed, for that matter. This area of the law will still remain relatively unsettled until there is some clear circuit authority on how these types of cases will unfold.

²⁰⁷ *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982).

²⁰⁸ *See Estate of Presley v. Russen*, 513 F. Supp. 1339, 1365 (D. N.J. 1981).

²⁰⁹ *See Pirone v. MacMillan, Inc.*, 894 F.2d 579, 584 (2d Cir. 1990) (the use of Babe Ruth’s name and picture in a calendar did not infringe on Ruth’s trademark because his name and picture were only used in the primary sense to refer to the great baseball player). If a mark is used in the primary or descriptive use, it will be protected by the fair-use doctrine, and there will be no infringement. *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 920 (6th Cir. 2003).

²¹⁰ *See, e.g., Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 413 (9th Cir. 1996) (holding that a reasonable jury could conclude that the famous basketball player Kareem Abdul-Jabbar could prevail on a false endorsement claim in an advertisement); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1111 (9th Cir. 1992) (holding there was sufficient evidence to support the jury’s finding that “consumers were likely to be misled by the commercial into believing that Waits [a famous singer] endorsed SalsaRio Doritos”); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1401 (9th Cir. 1992) (holding a genuine issue of material fact remained whether Samsung violated Vanna White’s likeness in a series of advertisements).

²¹¹ *See, e.g., Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204-05 (2d Cir. 1979) (the court found a likelihood of confusion that the Dallas Cowboys Cheerleaders endorsed a movie that contained women wearing outfits very similar to Dallas Cowboys Cheerleaders outfits); *Estate of Presley*, 513 F. Supp. at 1363-64 (holding that Elvis Presley had a trademark for only one particular pose).

²¹² *See, e.g., ETW Corp.*, 332 F.3d at 937-38 (holding that Tiger Woods did not establish the elements to prevail on a false endorsement or trademark infringement case); *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1155 (9th Cir. 2002) (holding that the heirs of Princess Diana could not prevail on a Lanham Act claim); *Pirone*, 894 F.2d at 585 (holding that Babe Ruth did not have protectable trademarks to his likeness).

4. Remedies

Despite Brown's claim for false endorsement being dismissed, Brown could still obtain an injunction and/or compensatory damages under his other claims. Brown would first seek injunctive relief in order to prevent any further use of his likeness by video game producers. Brown would then seek compensatory damages. To determine the amount of compensatory damages, Brown would need to hire an expert to testify how much other video game producers paid retired athletes for the use of their likeness rights. Brown could also determine the value of his likeness by determining how much the NFLPA paid players for their likeness rights in connection with the NFLPA's collective bargaining agreement. Brown might also try to argue that he lost other opportunities to sell his licensing rights to other video game producers. If other video game producers thought that EA Sports had the exclusive rights to Brown's likeness rights to appear in the Madden games, they would not have approached Brown to be in their football video games, thus preventing Brown from obtaining other video game deals.

Brown could also try to recover punitive damages for EA Sports' willful disregard of his publicity rights. Brown would need to find, in discovery, information to prove that EA Sports knew that it was using Brown's likeness in the game, but purposefully did not include his name so that it could avoid paying Brown royalty payments for the use of his likeness.²¹³ In the *Parish* case, the court likely found the punitive damages award to be reasonable because of the evidence recovered by the retired players that instructed EA Sports to scramble the images of retired players so that the NFLPA would not have to pay royalty payments to the members of the Retired Players Group.²¹⁴

V. PROTECTIONS FOR VIDEO GAME PRODUCERS

Video game producers have two simple precautions that they can take in order to avoid liability: (1) video game producers can obtain the consent of the retired athletes through licensing agreements; or (2) video game producers can stop using "all-time great" players who are modeled after retired players. A recent article in the *New York Bar Journal* suggests that a potential defendant should always secure the individual consent of the player.²¹⁵ Furthermore, the article suggests that the licensing agreement "should transfer, in whole or in part, specific rights setting forth, at a minimum, the scope, term, representations, warranties, fees, choice of law and a morals clause."²¹⁶ As one commentator has suggested, "The most efficient allocation of resources is obtained in a free market by which producers of products and services compete for the right to use [athletes'] identities, and the [athletes] and producers are incentivized to negotiate licensing fees based upon what the market will bear for such use."²¹⁷

²¹³ See McCARTHY, *supra* note 103, § 11:36.

²¹⁴ See Johnson, *supra* note 137, at D1.

²¹⁵ James A. Johnson, *Personal Images: The Professional Athlete's Right of Publicity*, 80 N.Y. ST. B.J. 11, 16 (2008).

²¹⁶ *Id.*

²¹⁷ Richard T. Karcher, *The Use of Players' Identities in Fantasy Sports Leagues: Developing Workable Standards for Right of Publicity Claims*, 111 PENN S. L. REV. 557, 585 (2007).

However, the problem with this option is that obtaining the licensing rights of former players will likely be extremely costly to video game producers.

One video game producer, 2K Sports, has already taken precautions to avoid liability by getting the consent of former NFL players that it uses in its games. Because of EA Sports' exclusive agreement with the NFLPA to use the likeness rights of current NFL players, 2K Sports created "All-Pro Football 2K8," which features only retired football players.²¹⁸ 2K Sports obtained licensing agreements from each of the 240 retired players it features in its game.²¹⁹ By doing this, 2K Sports avoids the problem that many other video game producers could face by obtaining the likeness rights of former players. Because of its actions to secure licensing agreements, 2K Sports does not have to worry about lawsuits from retired players over "fictional" players in its games that closely resemble retired athletes.

The other option for video game producers is to stop using "all-time great" players or "all-time great" teams that include former players. The video games would then just be limited to current players whose likeness rights the video game producers already possess. This would eliminate the chances of facing future likeness rights lawsuits. If the video game producer is adamant in having "all-time great" features in the game without obtaining licenses from the players, then the producers should completely invent new players without using past players as models. Simply changing the number of the player or the color scheme on the uniform is insufficient to prevent lawsuits.

VI. CONCLUSION

In cases such as *Brown v. Sony*, it is likely that courts will find video game producers liable under right of publicity laws when they use the likenesses of retired athletes without first obtaining the athletes' likeness rights. Video game producers pay player unions millions of dollars for the exclusive rights to use the likeness rights of professional athletes in their games. However, in the case of the NFL and its players association, the NFLPA, the collective bargaining agreement does not include retired players. This opens the doors for lawsuits when video game producers, such as EA Sports, create "fictional" retired players for their "all-time great teams" that share almost identical identities with retired athletes. When this occurs, retired athletes can allege likeness right misappropriations against the video game producers under both common and statutory right of publicity laws and under federal law using the Lanham Act. In the case of *Brown v. Sony*, the fictional player used in EA Sports' video game is nearly identical to Brown. The fictional player in the game used Brown's former number, had the same ethnicity as Brown, and both Brown and the fictional player played on Brown's former team, the Cleveland Browns.

Where courts find video game producers liable for their misappropriation of a retired athlete's likeness, the video game producers are likely to be held liable for extensive damages, at least under common law and statutory right of publicity claims. Because courts have only had few occasions to address Lan-

²¹⁸ Jane L. Levere, *Wary of Infringing Rival Games, Take-Two Calls up Football's Golden Oldies*, N.Y. TIMES, July 23, 2007, at C5.

²¹⁹ *Id.*

ham Act violations in the context of video games, it is difficult to determine how courts will decide these types of cases without clear precedent. However, popular retired players such as Jim Brown can present a strong case that when video game producers use retired athletes' likenesses in their games because there is a high likelihood of consumer confusion regarding the athlete's endorsement of the game. The only drawback to such actions is the high cost of prosecuting them. Claims might be more economical if retired athletes bring class-action lawsuits with other similar retired athletes.

After the recent decision in *Parish* and the filing of the *Brown* case, video game producers will need to do more in the future to protect themselves from future lawsuits by retired players. Some precautions can be as simple as including only current players in their games or by creating fictional characters that do not resemble former players in any manner. Video game producers can take other more expensive measures, such as obtaining the licensing rights of the retired players just as the video game producer 2K Sports did. Regardless of the specific avenues that video game producers pursue in this regard, they must take some form of action to prevent an imposition of liability and an infringement on the rights of the former professional athlete.