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By Anne F. Downey

Of Athletes and Video Games

Can a video game company use an athlete's likeness in a game without his or her permission? The answer is maybe.

The Ninth Circuit recently rejected Jim Brown's Lanham Act Section 43 claim against Electronic Arts, Inc. (EA) for using his likeness in the *Madden NFL* video game series without permission. *Brown v. Electronic Arts, Inc.*, 724 F. 3d 1235 (9th Cir. July 31, 2013). Brown, a Hall of Fame inductee, played for the Cleveland Browns from 1957 to 1965. In the *Madden* series, EA included a player with the likeness of Brown, clearly recognizable as the Hall of Famer although Brown's name was not used and his jersey number was changed. While EA enters into licensing agreements with the NFL and the NFL Players Association for the use of names and likenesses of current players, former players are not covered by those agreements.

Brown sued in the U.S. District Court for the Central District of California alleging violation of Section 43 of the Lanham Act, which has been held to allow a civil cause of action against persons who use a public figure's persona, likeness or other uniquely distinguishing characteristics so as to cause confusion over affiliation or endorsement. Brown also asserted California state law claims for invasion of privacy and unfair and unlawful business practices. The district court granted EA's motion to dismiss the Section 43 claim and declined to exercise supplemental jurisdiction over the state law claims.

Brown appealed to the Ninth Circuit, which affirmed. Essentially, the court ruled that the public interest in the video games' "artistic expression" trumped the public interest in avoiding consumer confusion.

The Ninth Circuit followed the test enunciated by the Second Circuit in the case of *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). In that case, Ginger Rogers sued the producers and distributors of the *Ginger and Fred* movie, a fictional story about two Italian cabaret players who imitated Ginger Rogers and Fred Astaire. Rogers alleged violation of Section 43 on ground that the movie title misled viewers into believing she sponsored or endorsed the film or was otherwise involved in it. The U.S. District Court for the Southern District of New York granted summary judgment for defendants, and the Second Circuit affirmed. The Second Circuit held that Section 43 should not be applied to "expressive works" unless a two-prong test is met. The use of the trademark or other identifying material must have no artistic relevance whatsoever to the underlying work or, if it has some artistic relevance, the trademark or identifying material must explicitly mislead as to the source or content of the work. The Second Circuit found that the names "Ginger and Fred" had artistic relevance to the underlying story and that the names did not explicitly mislead the public or denote sponsorship or endorsement by Ginger Rogers.

In the *Brown* case, the Ninth Circuit applied the *Rogers* test and found that the use of Brown's likeness was artistically relevant to the *Madden* series and did not explicitly mislead the public about his endorsement or involvement.

In the wake of the *Brown* and *Rogers* cases, public figures may want to pursue state law claims instead of Lanham Act Section 43 claims. In *Hart v. Electronic Arts, Inc.*, No. 11-3750 (3d Cir. May 21, 2013), a former athlete prevailed against EA based on a claim that a videogame violated his state right of publicity. In its

NCAA Football series of videogames, EA used without permission the likeness and biographical information of Ryan Hart, a Rutgers quarterback. Hall sued in the U.S. District Court for the District of New Jersey, claiming violation of his right of publicity under New Jersey law. EA defended on First Amendment grounds, and the District Court agreed and granted summary judgment for EA.

The Third Circuit reversed the grant of summary judgment and remanded the case. Although the Third Circuit agreed that videogames constitute artistic expression protected by the First Amendment, the right of free expression must be balanced against other protected rights, such as the right of publicity. The court rejected the *Rogers* test in favor of a Transformative Use Test. Under the Transformative Use Test, the issue is whether the artistic work contains significant transformative elements, thereby altering the meaning behind the celebrity's likeness. Applying the Transformative Use Test to Hall's case, the court found a lack of transformative elements in EA's depiction of Hall. Accordingly, the District Court erred in granting summary judgment in favor of EA.

A similar holding was reached by the Ninth Circuit in *Keller v. Electronic Arts, Inc.*, 724 F. 3d 1268 (9th Cir. July 31, 2013). Samuel Keller, a former college football player, sued EA for violating his right of publicity under California law. The Ninth Circuit rejected the *Rogers* test for right of publicity claims and instead used the Transformative Use Test. Like the Third Circuit, the Ninth Circuit found no transformative use in the *NCAA Football* series. The court noted that only the Sixth Circuit has used the *Rogers* test in right of publicity case, and it has done so inconsistently.

Subsequently, EA petitioned for writ of certiorari to the U.S. Supreme Court, and the Ninth Circuit stayed its ruling until final disposition of the case. The NCAA moved to intervene in the case, but the motion was denied on January 15, 2014. In separate litigation, former players have sued EA and the NCAA for conspiring to restrain the commercial use of their name, likeness and images.

In September 2013, EA settled with the players for \$40 million and announced that it would end the *NCAA College Football* series. The antitrust case against NCAA continues. [B]