

**Intellectual Property and Virtual Reality Environments
Reunion Weekend 2015
CLE Materials
Prof. Barton Beebe**

- *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008)
- *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013)
- *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268 (9th Cir. 2013)

though § 1015(a) and § 1001(a) were not enacted as part of the “same Act” within the meaning of *Russello*, they are both located within Chapter 47 of Title 18 of the United States Code, which deals with “Fraud and False Statements.” Section 1001(a) explicitly requires a false statement to be material. Congress could have written a materiality requirement into § 1015(a) as it did in § 1001(a), but chose not to do so.

Under the *Russello* rationale, § 1015(a) should be interpreted as Congress enacted it, without a materiality requirement. Therefore, we do not interpret § 1015 to include a materiality requirement.

IV. CONCLUSION

We affirm the district court’s judgment.

AFFIRMED.



**E.S.S. ENTERTAINMENT 2000, INC.,
d/b/a Playpen, Plaintiff-
Appellant,**

v.

**ROCK STAR VIDEOS, INC., e/s/a MMM
Rockstar Games, Inc.; Take-Two In-
teractive Software, Inc., Defendants-
Appellees.**

No. 06-56237.

United States Court of Appeals,
Ninth Circuit.

Argued and Submitted March 5, 2008.

Filed Nov. 5, 2008.

Background: Owner of strip club with name “Play Pen Gentlemen’s Club” brought suit against creator of video games, claiming that depiction of club having name “Pig Pen” in one video game violated club owner’s trademark and trade dress protection under Lanham Act. The

United States District Court for the Central District of California, Margaret M. Morrow, J., 444 F.Supp.2d 1012, granted video game creator’s motion for summary judgment. Strip club owner appealed.

Holdings: The Court of Appeals, O’Scannlain, Circuit Judge, held that:

- (1) nominative fair use defense did not apply to video game creator’s use of “Pig Pen,” but
- (2) video game creator’s use of “Pig Pen” was protected by the First Amendment.

Affirmed.

1. Trademarks ⇄1062

Trade dress involves the total image of a product and may include features such as size, shape, color or color combination, texture, graphics, or even particular sales technique.

2. Trademarks ⇄1523(3)

Nominative fair use defense did not apply to video game creator’s use of “Pig Pen,” as a virtual, cartoon-style strip club in its video game, in trademark infringement action brought by owner of strip club operating under the name “Play Pen Gentlemen’s Club;” video game creator’s use of “Pig Pen” was not identical to owner’s “Play Pen” mark, and video game creator’s lead map artist testified that goal in designing the virtual strip club was not to comment on the owner’s strip club per se.

3. Trademarks ⇄1523(3)

Unlike a traditional fair use scenario, nominative fair use occurs when the defendant uses the trademarked term to describe not its own product, but the plaintiff’s; the nominative fair use doctrine protects those who deliberately use another’s trademark or trade dress for the purposes of comparison, criticism, or point of reference.

4. Constitutional Law ¶1604**Trademarks** ¶1524(1)

Video game creator's use of "Pig Pen," as a virtual, cartoon-style strip club in its video game, was protected by the First Amendment from trademark and trade dress infringement claims brought by owner of strip club operating under the name "Play Pen Gentlemen's Club," including a strip club in the video game that was similar in look and feel to the owner's strip club had at least some artistic relevance as it helped create a cartoon-style parody of East Los Angeles, and video game's use of "Pig Pen" did not explicitly mislead consumers as to the source or content of the work, as there was no evidence that the buying public would reasonably have believed that the strip club owner produced the video game or that the video game creator operated a strip club. U.S.C.A. Const.Amend. 1; Lanham Trade-Mark Act, § 1 et seq., 15 U.S.C.A. § 1051 et seq.

5. Trademarks ¶1524(1)

An artistic work's use of a trademark that otherwise would violate the Lanham Act is not actionable unless the use of the mark has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless it explicitly misleads as to the source or the content of the work. U.S.C.A. Const.Amend. 1; Lanham Trade-Mark Act, § 1 et seq., 15 U.S.C.A. § 1051 et seq.

Trademarks ¶1800

Pig Pen.

Trademarks ¶1800

Play Pen.

* The Honorable John R. Gibson, Senior United States Circuit Judge for the Eighth Circuit,

Robert F. Helfing, Sedgwick, Detert, Moran & Arnold LLP, Los Angeles, CA, for the plaintiff-appellant; David A. Schinder, Sedgwick, Detert, Moran & Arnold LLP, Los Angeles, CA, and Ernest J. Franceschi, Attorney, Los Angeles, CA, were on the briefs.

Russell Frackman, Mitchell Silberberg & Knupp LLP, Los Angeles, CA, for the defendants-appellees; Karin G. Pagnanelli and Eric J. German were on the brief.

Appeal from the United States District Court for the Central District of California; Margaret M. Morrow, District Judge, Presiding. D.C. No. CV-05-02966-MMM.

Before: JOHN R. GIBSON,* Senior Circuit Judge, DIARMUID F. O'SCANNLAIN and SUSAN P. GRABER, Circuit Judges.

O'SCANNLAIN, Circuit Judge:

We must decide whether a producer of a video game in the "Grand Theft Auto" series has a defense under the First Amendment against a claim of trademark infringement.

I

A

Rockstar Games, Inc. ("Rockstar"), a wholly owned subsidiary of Take-Two Interactive Software, Inc., manufactures and distributes the Grand Theft Auto series of video games (the "Series"), including Grand Theft Auto: San Andreas ("San Andreas" or the "Game"). The Series is known for an irreverent and sometimes crass brand of humor, gratuitous violence and sex, and overall seediness.

sitting by designation.

Each game in the Series takes place in one or more dystopic, cartoonish cities modeled after actual American urban areas. The games always include a disclaimer stating that the locations depicted are fictional. Players control the game's protagonist, trying to complete various "missions" on a video screen. The plot advances with each mission accomplished until the player, having passed through thousands of cartoon-style places along the way, wins the game.

Consistent with the tone of the Series, San Andreas allows a player to experience a version of West Coast "gangster" culture. The Game takes place in the virtual cities of "Los Santos," "San Fierro," and "Las Venturas," based on Los Angeles, San Francisco, and Las Vegas, respectively.

Los Santos, of course, mimics the look and feel of actual Los Angeles neighborhoods. Instead of "Hollywood," "Santa Monica," "Venice Beach," and "Compton," Los Santos contains "Vinewood," "Santa Maria," "Verona Beach," and "Ganton." Rockstar has populated these areas with virtual liquor stores, ammunition dealers, casinos, pawn shops, tattoo parlors, bars, and strip clubs. The brand names, business names, and other aspects of the locations have been changed to fit the irreverent "Los Santos" tone. Not especially saintly, Los Santos is complete with gangs who roam streets inhabited by prostitutes and drug pushers while random gunfire punctuates the soundtrack.

To generate their vision for Los Santos, some of the artists who drew it visited Los Angeles to take reference photographs. The artists took pictures of businesses, streets, and other places in Los Angeles that they thought evoked the San Andreas theme. They then returned home (to Scotland) to draw Los Santos, changing the images from the photographs as necessary to fit into the fictional world of Los

Santos and San Andreas. According to Nikolas Taylor ("Taylor"), the Lead Map Artist for Los Santos, he and other artists did not seek to "re-creat[e] a realistic depiction of Los Angeles; rather, [they] were creating 'Los Santos,' a fictional city that lampooned the seedy underbelly of Los Angeles and the people, business and places [that] comprise it." One neighborhood in the fictional city is "East Los Santos," the Game's version of East Los Angeles. East Los Santos contains variations on the businesses and architecture of the real thing, including a virtual, cartoon-style strip club known as the "Pig Pen."

B

ESS Entertainment 2000, Inc. ("ESS"), operates a strip club, which features females dancing nude, on the eastern edge of downtown Los Angeles under the name Play Pen Gentlemen's Club ("Play Pen"). ESS claims that Rockstar's depiction of an East Los Santos strip club called the Pig Pen infringes its trademark and trade dress associated with the Play Pen.

The Play Pen's "logo" consists of the words "the Play Pen" (and the lower-and upper-case letters forming those words) and the phrase "Totally Nude" displayed in a publicly available font, with a silhouette of a nude female dancer inside the stem of the first "P." Apparently, ESS has no physical master or precise template for its logo. Different artists draw the nude silhouette in Play Pen's logo anew for each representation, although any final drawing must be acceptable to Play Pen's owners. There are several different versions of the silhouette, and some advertisements and signs for the Play Pen do not contain the nude silhouettes.

Although the artists took some inspiration from their photographs of the Play Pen, it seems they used photographs of other East Los Angeles locations to design

other aspects of 15148 the Pig Pen. The Pig Pen building in Los Santos, for instance, lacks certain characteristics of the Play Pen building such as a stone facade, a valet stand, large plants and gold columns around the entrance, and a six-foot black iron fence around the parking lot. The Play Pen also has a red, white, and blue pole sign near the premises, which includes a trio of nude silhouettes above the logo and a separate “Totally Nude” sign below. The Pig Pen does not.

C

[1] On April 22, 2005, ESS filed the underlying trademark violation action in district court against Rockstar. ESS asserted four claims: (1) trade dress infringement and unfair competition under section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a);¹ (2) trademark infringement under California Business and Professions Code § 14320;² (3) unfair competition under California Business and Professions Code §§ 17200 et seq.; and (4) unfair competition under California common law. The heart of ESS’s complaint is that Rockstar has used Play Pen’s distinctive logo and trade dress without its authorization and has created a likelihood of confusion among consumers as to whether ESS has endorsed, or is associated with, the video depiction.

In response, Rockstar moved for summary judgment on all of ESS’s claims, arguing that the affirmative defenses of

1. “Trade dress involves the total image of a product and may include features such as size, shape, color or color combination, texture, graphics, or even particular sales technique.” *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 808 n. 13 (9th Cir.2003) (internal quotation marks and citations omitted). Because the only relevant similarities at issue in this case involve the use of the “Pig Pen” mark versus the “Play Pen” mark, disposition of the trade dress infringement claim follows resolution of the trademark infringement claim. See *Kendall-Jackson Winery,*

nominative fair use and the First Amendment protected it against liability. It also argued that its use of ESS’s intellectual property did not infringe ESS’s trademark by creating a “likelihood of confusion.”

Although the district court rejected Rockstar’s nominative fair use defense, it granted summary judgment based on the First Amendment defense. The district court did not address the merits of the trademark claim because its finding that Rockstar had a defense against liability made such analysis unnecessary.

II

Rockstar argues that, regardless of whether it infringed ESS’s trademark under the Lanham Act or related California law, it is entitled to two defenses: one under the nominative fair use doctrine and one under the First Amendment.

A

[2, 3] “Unlike a traditional fair use scenario, [nominative fair use occurs when] the defendant . . . us[es] the trademarked term to describe not its own product, but the plaintiff’s.” *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 801 (9th Cir.2002). The doctrine protects those who deliberately use another’s trademark or trade dress “for the ‘purposes of comparison, criticism[,] or point of reference.’” *Walking Mountain*, 353 F.3d at 809 (alteration

Ltd. v. E. & J. Gallo Winery, 150 F.3d 1042, 1046 (9th Cir.1998) (“Section 43(a) now protects both trademarks and trade dress from infringement . . . [and] there is no persuasive reason to apply different analysis[sic] to the two.” (internal quotation marks, alteration and citation omitted)).

2. This section has recently been repealed. Cal. Stats. ch. 711 § 1. Since we hold that Rockstar has a defense to all of ESS’s claims, the repeal is irrelevant to our decision.

omitted) (quoting *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir.1992)). In this case, however, Rockstar's use of "Pig Pen" is not "identical to the plaintiff's [Play Pen] mark." Furthermore, the district court observed that Rockstar's Lead Map Artist "testified the goal in designing the Pig Pen was . . . not to comment on Play Pen *per se*." Since Rockstar did not use the trademarked logo to describe ESS's strip club, the district court correctly held that the nominative fair use defense does not apply in this case. See *Welles*, 279 F.3d at 801.

B

[4, 5] Rockstar's second defense asks us to consider the intersection of trademark law and the First Amendment. The road is well traveled. We have adopted the Second Circuit's approach from *Rogers v. Grimaldi*, which "requires courts to construe the Lanham Act 'to apply to artistic works *only* where the public interest in avoiding consumer confusion *outweighs* the public interest in free expression.'" *Walking Mountain*, 353 F.3d at 807 (emphasis in original) (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir.1989)). The specific test contains two prongs. An artistic work's use of a trademark that otherwise would violate the Lanham Act is not actionable "unless the [use of the mark] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless [it] explicitly misleads as to the source or the content of the work.'" *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir.2002) (quoting *Rogers*, 875 F.2d at 999). Although this test traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why it ought not also apply to the use of a trademark in the body of the work. See *Walking Mountain*, 353 F.3d at 809 n. 17 (implying that it would be acceptable to apply the *Rogers* test to non-titular trade dress claim). The

parties do not dispute such an extension of the doctrine.

1

We first adopted the *Rogers* test in *MCA Records*, a case which is instructive for that reason. *MCA Records*, 296 F.3d at 902 ("We agree with the Second Circuit's analysis and adopt the *Rogers* standard as our own."). In *MCA Records*, the maker of the iconic "Barbie" dolls sued MCA for trademark infringement in the title of a song the record company had released, called "Barbie Girl." *Id.* at 899–900. The song was a commentary "about Barbie and the values . . . she [supposedly] represents." *Id.* at 902. Applying *Rogers*, the court held that the First Amendment protected the record company. The first prong was straightforward. Because the song was about Barbie, "the use of Barbie in the song title clearly is relevant to the underlying work." *Id.*; see also *Walking Mountain*, 353 F.3d at 807 (holding that use of Barbie doll in photographic parody was relevant to the underlying work).

Moving to the second prong, we made an important point. "The *only* indication," we observed, "that Mattel might be associated with the song is the use of Barbie in the title; if this were enough to satisfy this prong of the *Rogers* test, it would render *Rogers* a nullity." *MCA Records*, 296 F.3d at 902 (emphasis in original). This makes good sense. After all, a trademark infringement claim presupposes a use of the mark. If that necessary element in every trademark case vitiated a First Amendment defense, the First Amendment would provide no defense at all.

2

Keeping *MCA Records* and related cases in mind, we now turn to the matter before us. ESS concedes that the Game is artistic and that therefore the *Rogers* test

applies. However, ESS argues both that the incorporation of the Pig Pen into the Game has no artistic relevance and that it is explicitly misleading. It rests its argument on two observations: (1) the Game is not “about” ESS’s Play Pen club the way that “Barbie Girl” was “about” the Barbie doll in *MCA Records*; and (2) also unlike the Barbie case, where the trademark and trade dress at issue was a cultural icon (Barbie), the Play Pen is not a cultural icon.

ESS’s objections, though factually accurate, miss the point. Under *MCA Records* and the cases that followed it, only the use of a trademark with “no artistic relevance to the underlying work *whatsoever*” does not merit First Amendment protection. *Id.* (emphasis added) (quoting *Rogers*, 875 F.2d at 999). In other words, the level of relevance merely must be above zero. It is true that the Game is not “about” the Play Pen the way that Barbie Girl was about Barbie. But, given the low threshold the Game must surmount, that fact is hardly dispositive. It is also true that Play Pen has little cultural significance, but the same could be said about most of the individual establishments in East Los Angeles. Like most urban neighborhoods, its distinctiveness lies in its “look and feel,” not in particular destinations as in a downtown or tourist district. And that neighborhood, with all that characterizes it, *is* relevant to Rockstar’s artistic goal, which is to develop a cartoon-style parody of East Los Angeles. Possibly the only way, and certainly a reasonable way, to do that is to recreate a critical mass of the businesses and buildings that constitute it. In this context, we conclude that to include a strip club that is similar in look and feel to the Play Pen does indeed have at least “some artistic relevance.” *See id.*

3

ESS also argues that Rockstar’s use of the Pig Pen “explicitly misleads as to the

source or the content of the work.’” *Id.* (quoting *Rogers*, 875 F.2d at 999). This prong of the test points directly at the purpose of trademark law, namely to “avoid confusion in the marketplace by allowing a trademark owner to prevent others from duping consumers into buying a product they mistakenly believe is sponsored by the trademark owner.” *Walking Mountain*, 353 F.3d at 806 (internal quotation marks and alteration omitted). The relevant question, therefore, is whether the Game would confuse its players into thinking that the Play Pen is somehow behind the Pig Pen or that it sponsors Rockstar’s product. In answering that question, we keep in mind our observation in *MCA Records* that the mere use of a trademark alone cannot suffice to make such use explicitly misleading. *See MCA Records*, 296 F.3d at 902.

Both San Andreas and the Play Pen offer a form of low-brow entertainment; besides this general similarity, they have nothing in common. The San Andreas Game is not complementary to the Play Pen; video games and strip clubs do not go together like a horse and carriage or, perish the thought, love and marriage. Nothing indicates that the buying public would reasonably have believed that ESS produced the video game or, for that matter, that Rockstar operated a strip club. A player can enter the virtual strip club in Los Santos, but ESS has provided no evidence that the setting is anything but generic. It also seems far-fetched that someone playing San Andreas would think ESS had provided whatever expertise, support, or unique strip-club knowledge it possesses to the production of the game. After all, the Game does not revolve around running or patronizing a strip club. Whatever one can do at the Pig Pen seems quite incidental to the overall story of the Game. A reasonable consumer would not think a company that owns one strip club in East Los Angeles, which is not well

known to the public at large, also produces a technologically sophisticated video game like San Andreas.

Undeterred, ESS also argues that, because players are free to ignore the storyline and spend as much time as they want at the Pig Pen, the Pig Pen can be considered a significant part of the Game, leading to confusion. But fans can spend all nine innings of a baseball game at the hot dog stand; that hardly makes Dodger Stadium a butcher's shop. In other words, the chance to attend a virtual strip club is unambiguously *not* the main selling point of the Game.

III

Considering all of the foregoing, we conclude that Rockstar's modification of ESS's trademark is not explicitly misleading and is thus protected by the First Amendment. Since the First Amendment defense applies equally to ESS's state law claims as to its Lanham Act claim, the district court properly dismissed the entire case on Rockstar's motion for summary judgment.

AFFIRMED.



Priscilla VASQUEZ, Plaintiff-Appellant,

v.

Michael J. ASTRUE, Commissioner of Social Security, Defendant-Appellee.

No. 06-16817.

United States Court of Appeals,
Ninth Circuit.

Argued and Submitted May 15, 2008.

Filed Nov. 5, 2008.

Background: Social Security disability benefits and Supplemental Security In-

come (SSI) claimant suffering from lower-back impairment and purported cognitive impairment sought judicial review of Commissioner's finding of no disability. The United States District Court for the Northern District of California, James Ware, J., granted summary judgment for Commissioner, and claimant appealed.

Holdings: The Court of Appeals, James V. Selna, District Judge sitting by designation, held that:

- (1) ALJ had provided inadequately specific basis for lack-of-credibility finding as to claimant's reports of pain severity;
- (2) application of credit-as-true rule was appropriate even though there were outstanding issues prior to final disability determination;
- (3) ALJ should have been afforded opportunity to consider additional cognitive-impairment evidence generated after ALJ's denial of claim; and
- (4) denial of claimant's previous disability benefits claim could not be given res judicata effect.

Vacated and remanded.

Michael Daly Hawkins, Circuit Judge, filed concurring opinion.

O'Scannlain, Circuit Judge, filed dissenting opinion.

1. Social Security and Public Welfare
⇌149.5

Court of Appeals reviews de novo district court's order affirming denial of Social Security disability benefits. Social Security Act, § 223, 42 U.S.C.A. § 423.

2. Social Security and Public Welfare
⇌148.15

Federal court may set aside Social Security Commissioner's denial of disability benefits when ALJ's findings are based

James “Jim” BROWN, Plaintiff–
Appellant,

v.

ELECTRONIC ARTS, INC.,
a Delaware corporation,
Defendant–Appellee.

No. 09–56675.

United States Court of Appeals,
Ninth Circuit.

Argued and Submitted Feb. 15, 2011.

Submission Vacated Feb. 18, 2011.

Argued and Resubmitted July 13, 2012.

Filed July 31, 2013.

Background: Former professional football player sued video game manufacturer, alleging, inter alia, that manufacturer violated Lanham Act by using his likeness in series of football video games. The United States District Court for the Central District of California, Florence–Marie Cooper, J., 2009 WL 8763151, granted manufacturer’s motion to dismiss Lanham Act claim. Former player appealed.

Holdings: The Court of Appeals, Bybee, Circuit Judge, held that:

- (1) *Rogers* test governed former player’s false endorsement claim under Lanham Act;
- (2) use of former player’s likeness was artistically relevant to football video games under *Rogers* test;
- (3) use of former player’s likeness, coupled with consumer survey, did not show explicit misleading conduct required under *Rogers* test to establish false endorsement claim under Lanham Act;
- (4) manufacturer’s changes to versions of its games that could make consumers less confident that former player was player being depicted did not mislead consumers into believing that former

player was involved with or endorsed manufacturer’s games; and

- (5) district court could decide, on motion to dismiss, that former player did not satisfy *Rogers* test, as required for him to pursue false endorsement claim under Lanham Act.

Affirmed.

1. Antitrust and Trade Regulation ⇨30
Constitutional Law ⇨1604

Provision of Lanham Act addressing false designations of origin protects the public’s interest in being free from consumer confusion about affiliations and endorsements, but this protection is limited by the First Amendment, particularly if the product involved is an expressive work. U.S.C.A. Const.Amend. 1; Lanham Act, § 43(a)(1), 15 U.S.C.A. § 1125(a)(1).

2. Antitrust and Trade Regulation ⇨29
Constitutional Law ⇨1604
Trademarks ⇨1524(1)

Under *Rogers* test, provision of Lanham Act addressing false designations of origin will not be applied to expressive works protected by First Amendment unless the use of the trademark or other identifying material has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the use of trademark or other identifying material explicitly misleads as to the source or the content of the work. U.S.C.A. Const.Amend. 1; Lanham Act, § 43(a)(1), 15 U.S.C.A. § 1125(a)(1).

3. Antitrust and Trade Regulation ⇨30
Constitutional Law ⇨1899

Football video games, which featured characters, dialogue, plot, and music, as well as prevalent interaction between games’ virtual worlds and individuals playing games, were expressive works entitled to First Amendment protection, and there-

fore *Rogers* test governed former football player's false endorsement claim against games' manufacturer under provision of Lanham Act addressing false designations of origin. U.S.C.A. Const.Amend. 1; Lanham Act, § 43(a)(1), 15 U.S.C.A. § 1125(a)(1).

4. Antitrust and Trade Regulation ⇌39

Constitutional Law ⇌1604

Trademarks ⇌1524(1)

Level of artistic relevance of trademark or other identifying material to the work merely must be above zero for trademark or other identifying material to be deemed artistically relevant under *Rogers* test used to determine applicability of Lanham Act provision addressing false designations of origin to expressive works protected by First Amendment. U.S.C.A. Const.Amend. 1; Lanham Act, § 43(a)(1), 15 U.S.C.A. § 1125(a)(1).

5. Antitrust and Trade Regulation ⇌30

Constitutional Law ⇌1899

Use of likeness of former professional football player was artistically relevant to football video games under *Rogers* test used to determine applicability of Lanham Act provision addressing false designations of origin to expressive works protected by First Amendment; video game manufacturer prided itself on extreme realism of games, and former player's likeness was important to recreating realistically one of teams in games. U.S.C.A. Const.Amend. 1; Lanham Act, § 43(a)(1), 15 U.S.C.A. § 1125(a)(1).

6. Constitutional Law ⇌1604

Trademarks ⇌1524(1)

Use of a mark alone is not enough to satisfy prong of *Rogers* test used to determine applicability of Lanham Act provision addressing false designations of origin to expressive works protected by First Amendment which requires that creator of

expressive work use mark explicitly to mislead consumers as to source or content of the work. U.S.C.A. Const.Amend. 1; Lanham Act, § 43(a)(1), 15 U.S.C.A. § 1125(a)(1).

7. Constitutional Law ⇌1604

Trademarks ⇌1524(1)

Under prong of *Rogers* test used to determine applicability of Lanham Act provision addressing false designations of origin to expressive works protected by First Amendment that requires creator of expressive work to use mark explicitly to mislead consumers as to source or content of the work, evidence, to be relevant, must relate to the nature of the behavior of the identifying material's user, not the impact of the use. U.S.C.A. Const.Amend. 1; Lanham Act, § 43(a)(1), 15 U.S.C.A. § 1125(a)(1).

8. Constitutional Law ⇌1899

Trademarks ⇌1524(1)

Use of likeness of former professional football player in football video games did not, when coupled with consumer survey demonstrating that majority of the public believed that identifying marks could not be included in products without permission, did not demonstrate that game manufacturer explicitly misled consumers into believing that former player endorsed or sponsored its games, as required, under *Rogers* test, for former player to establish false endorsement claim against manufacturer under Lanham Act despite games' protected expressive content; survey did not concern nature of manufacturer's behavior in using former player's likeness, but instead related to effect of that use. U.S.C.A. Const.Amend. 1; Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

9. Antitrust and Trade Regulation ⇌30

Constitutional Law ⇌1899

Statements included in written materials that accompanied versions of football

video games which contained likeness of former professional football player did not show that games' manufacturer attempted to mislead consumers about former player's endorsement or involvement in games, as required, under *Rogers* test, for former player to establish false endorsement claim against manufacturer under Lanham Act despite games' protected expressive content; statements which indicated that games included depictions of 50 of professional football league's greatest players and one commentator's all-star teams were true and did not suggest that depicted football players endorsed video games. U.S.C.A. Const.Amend. 1; Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

10. Antitrust and Trade Regulation

⌘30

Constitutional Law ⌘1899

Changes made by manufacturer of football video games to versions of its games that could make consumers less confident that certain player depicted was famous former professional football player could not have misled consumers into believing that former player was involved with or endorsed manufacturer's games, as required, under *Rogers* test, for former player to establish false endorsement claim against manufacturer under Lanham Act despite games' protected expressive content. U.S.C.A. Const.Amend. 1; Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

11. Antitrust and Trade Regulation

⌘30

Constitutional Law ⌘1899

Comments made by officials for manufacturer of football video games in letters and at academic conference regarding games' use of likenesses of current and former professional football players, which

were not made to consumers, could not realistically be expected to confuse consumers about former player's involvement with game, as required, under *Rogers* test, for former player to establish false endorsement claim against manufacturer under Lanham Act despite games' protected expressive content. U.S.C.A. Const. Amend. 1; Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

12. Federal Courts ⌘712

Court of Appeals would not consider arguments not raised in appellant's opening brief on appeal in action under Lanham Act. Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a).

13. Federal Civil Procedure ⌘1829, 1835

On a motion to dismiss, court presumes that the facts alleged by plaintiff are true, and will also draw all reasonable inferences from the complaint in plaintiff's favor. Fed.Rules Civ.Proc.Rule 12(b)(6), 28 U.S.C.A.

14. Federal Civil Procedure ⌘1835

Court deciding motion to dismiss is not required to accept any unreasonable inferences or assume the truth of legal conclusions cast in the form of factual allegations. Fed.Rules Civ.Proc.Rule 12(b)(6), 28 U.S.C.A.

15. Constitutional Law ⌘976

Facts pleaded by former professional football player in support of his assertions that his likeness had no artistic relevance to manufacturer's football video games and that manufacturer attempted to mislead consumers about former player's involvement with those games did not actually justify those asserted conclusions, and therefore, on manufacturer's motion to dismiss for failure to state claim, district

court could decide that former player did not satisfy *Rogers* test, as required for him to pursue false endorsement claim under Lanham Act despite games' protected expressive content. U.S.C.A. Const.Amend. 1; Lanham Act, § 43(a), 15 U.S.C.A. § 1125(a); Fed.Rules Civ.Proc.Rule 12(b)(6), 28 U.S.C.A.

16. Federal Civil Procedure ⇌1832

In deciding motion to dismiss former professional football player's false endorsement claim under Lanham Act against manufacturer of football video games, district court could consider versions of game submitted to it as part of complaint itself through incorporation by reference doctrine.

West Codenotes

Limited on Constitutional Grounds

15 U.S.C.A. § 1125(a)(1)

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* The motion of these organizations to file their amicus brief is **GRANTED**.

Nathan Siegel and Lee Levine, Levine Sullivan Koch & Schulz, L.L.P., Washington, D.C., for amici curiae Advance Publications, A & E Television Networks, Allied Daily Newspapers of Washington, Association of American Publishers, Activision, California Newspaper Publishers Association, Capcom USA, Comic Book Legal Defense Fund, E! Entertainment Television, ESPN, First Amendment Coalition, First Amendment Project, Freedom Communications, The Gannett Company, Gawker Media, Hybrid Films, ITV Studios, Konami Digital Entertainment, The Los Angeles Times, The McClatchy Company, Namco Bandai Games America, Original Productions, The PressEnterprise Company, Radio Television Digital News Association, Sirens Media, Take Two Interactive Software, Thq, Viacom, The Washington Newspaper Publishers Association, and Wenner Media.*

Appeal from the United States District Court for the Central District of California, Florence-Marie Cooper, District Judge, Presiding. D.C. No. 2:09-cv-01598-FMC-RZ.

Before: SIDNEY R. THOMAS and JAY S. BYBEE, Circuit Judges, and GORDON J. QUIST, Senior District Judge.**

OPINION

BYBEE, Circuit Judge:

Plaintiff—Appellant James “Jim” Brown alleges that Defendant—Appellee Electronic Arts, Inc. (“EA”) has violated § 43(a) of the Lanham Act, 15 U.S.C.

** The Honorable Gordon J. Quist, Senior District Judge for the U.S. District Court for Western Michigan, sitting by designation.

§ 1125(a), through the use of Brown’s likeness in EA’s *Madden NFL* series of football video games. In relevant part, § 43(a) provides for a civil cause of action against:

[a]ny 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 . . . 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[.]

15 U.S.C. § 1125(a)(1). Although claims under § 43(a) generally relate to the use of trademarks or trade dress to cause consumer confusion over affiliation or endorsement, we have held that claims can also be brought under § 43(a) relating to the use of a public figure’s persona, likeness, or other uniquely distinguishing characteristic to cause such confusion.¹

[1,2] Section 43(a) protects the public’s interest in being free from consumer confusion about affiliations and endorsements, but this protection is limited by the First Amendment, particularly if the product involved is an expressive work. Recognizing the need to balance the public’s First Amendment interest in free ex-

pression against the public’s interest in being free from consumer confusion about affiliation and endorsement, the Second Circuit created the “*Rogers* test” in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir.1989). Under the *Rogers* test, § 43(a) will not be applied to expressive works “unless the [use of the trademark or other identifying material] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the [use of trademark or other identifying material] explicitly misleads as to the source or the content of the work.” *Id.* at 999. We adopted the *Rogers* test in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir.2002).

Applying the *Rogers* test, the district court in this case granted EA’s motion to dismiss Brown’s Lanham Act claim, finding that Brown had not alleged facts that satisfied either condition that allow a § 43(a) claim to succeed under the *Rogers* test. *Brown v. Elec. Arts, Inc.*, No. 2:09-cv-01598, 2009 WL 8763151, at *3–5, 2009 U.S. Dist. LEXIS 131387, at *8–15 (C.D.Cal. Sept. 23, 2009). Brown appealed, challenging the applicability of the *Rogers* test, the district court’s analysis under the *Rogers* test, and the suitability of his case for resolution without additional factfinding. We affirm the district court’s decision.

I

Jim Brown is widely regarded as one of the best professional football players of all

1. See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir.1992) (“A false endorsement claim based on the unauthorized use of a celebrity’s identity is a type of false association claim, for it alleges the misuse of a trademark, *i.e.*, a symbol or device such as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic, which is likely

to confuse consumers as to the plaintiff’s sponsorship or approval of the product.”); see also *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399–1400 (9th Cir.1992) (“In cases involving confusion over endorsement by a celebrity plaintiff, ‘mark’ means the celebrity’s persona.”).

time. He starred for the Cleveland Browns from 1957 to 1965 and was inducted into the National Football League (“NFL”) Hall of Fame after his retirement. After his NFL career, Brown also achieved success as an entertainer and public servant. There is no question that he is a public figure whose persona can be deployed for economic benefit.

EA is a manufacturer, distributor and seller of video games and has produced the *Madden NFL* series of football video games since 1989. The *Madden NFL* series allows users of the games to control avatars representing professional football players as those avatars participate in simulated NFL games. In addition to these simulated games, *Madden NFL* also enables users to participate in other aspects of a simulated NFL by, for example, creating and managing a franchise. Each version of *Madden NFL* includes the current year’s NFL teams with the teams’ current rosters. Each avatar on a current team is designed to mirror a real current NFL player, including the player’s name, jersey number, physical attributes, and physical skills. Some versions of the game also include historical and all-time teams. Unlike for players on the current NFL teams, no names are used for the players on the historical and all-time teams, but these players are recognizable due to the accuracy of their team affiliations, playing positions, ages, heights, weights, ability levels, and other attributes. Although EA enters into licensing agreements with the NFL

and NFL Players Association (“NFLPA”) for its use of the names and likenesses of current NFL players, Brown, as a former player, is not covered by those agreements and has never entered into any other agreement allowing EA to use his likeness in *Madden NFL*. Brown asserts that EA has used his likeness in several versions of the game dating back at least to 2001 but that he has never been compensated.

Brown brought suit in the United States District Court for the Central District of California, claiming that EA’s use of his likeness in the *Madden NFL* games violated § 43(a) of the Lanham Act. Brown also brought claims under California law for invasion of privacy and unfair and unlawful business practices. EA filed a motion to dismiss pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, and the district court applied the *Rogers* test and dismissed Brown’s Lanham Act claim. *Brown*, 2009 WL 8763151, at *3–5, 2009 U.S. Dist. LEXIS 131387, at *9–15. The district court declined to exercise supplemental jurisdiction over the state-law claims. *Id.* at *5–6, 2009 U.S. Dist. LEXIS 131387, at *15–16. Brown filed a timely appeal of the dismissal of his Lanham Act claim.² We have jurisdiction pursuant to 28 U.S.C. § 1291. We review the district court’s dismissal de novo. *Kahle v. Gonzales*, 487 F.3d 697, 699 (9th Cir.2007).

II

The legal issues raised by this case are not novel, but their lack of novelty should

2. We emphasize that this appeal relates only to Brown’s Lanham Act claim. Were the state causes of action before us, our analysis may be different and a different outcome may obtain. See, e.g. *Keller v. Elec. Arts, Inc.*, 724 F.3d 1268, 1271, No. 10–15387, 2013 WL 3928293, *1 (9th Cir. July 31, 2013) (affirming a district court’s ruling that EA had no

First Amendment defense against the state-law right-of-publicity claims of former college football player Samuel Keller and other former college football and basketball players related to the use of their likenesses in EA’s college football and college basketball video games).

not be mistaken for lack of difficulty. Significant judicial resources, including the resources of this court, have been expended trying to find the appropriate balance between trademark and similar rights, on the one hand, and First Amendment rights, on the other. Brown suggests that the case law has produced a lack of clarity as to the appropriate legal framework to apply in this case and urges us to consider the “likelihood of confusion” test and the “alternative means” test in addition to the *Rogers* test. We are convinced that the *Rogers* test remains the appropriate framework.

A decade ago, in *Mattel, Inc. v. MCA Records, Inc.*, we adopted the *Rogers* test as our method for balancing the trademark and similar rights protected by § 43(a) of the Lanham Act against First Amendment rights in cases involving expressive works. *MCA*, 296 F.3d at 902. Although *MCA* concerned the use of a trademark in the title of an expressive work, and the language of the *MCA* opinion did not make it clear that we were adopting the *Rogers* test for cases where the trademark or other identifying material in question was used in the body of a work rather than in the title, we clarified in *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.* that application of the *Rogers* test was not dependent on the identifying material appearing in the title but “also appl[ies] to the use of a trademark in the body of the work.” 547 F.3d 1095, 1099 (9th Cir.2008). We have consistently employed the *Rogers* test in § 43(a) cases involving expressive works since *MCA*, including where the trademark or other identifying material in question was used in the body of a work rather than in the title. *See, e.g., id.; Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir.2003).

[3] The *Rogers* test is reserved for expressive works. Even if *Madden NFL* is not the expressive equal of *Anna Karenina* or *Citizen Kane*, the Supreme Court has answered with an emphatic “yes” when faced with the question of whether video games deserve the same protection as more traditional forms of expression. In *Brown v. Entertainment Merchants Ass’n*, the Court said that “[l]ike the protected books, plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player’s interaction with the virtual world)” and that these similarities to other expressive mediums “suffice[] to confer First Amendment protection.” — U.S. —, 131 S.Ct. 2729, 2733, 180 L.Ed.2d 708 (2011). Although there may be some work referred to as a “video game” (or referred to as a “book,” “play,” or “movie” for that matter) that does not contain enough of the elements contemplated by the Supreme Court to warrant First Amendment protection as an expressive work, no version of *Madden NFL* is such a work. Every version of the game features characters (players), dialogue (between announcers), plot (both within a particular simulated game and more broadly), and music. Interaction between the virtual world of the game and individuals playing the game is prevalent. Even if there is a line to be drawn between expressive video games and non-expressive video games, and even if courts should at some point be drawing that line, we have no need to draw that line here.³ Each version of *Madden NFL* is an expressive work, and our precedents dictate that we apply the *Rogers* test in § 43(a) cases in-

3. Brown points to several examples of courts

suggesting that certain video games may not

volving expressive works. Brown acknowledges that *Rogers* may apply here, but he argues that the “likelihood of confusion” test, exemplified by *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir.1997), or the “alternative means” test, exemplified by *International Olympic Committee v. San Francisco Arts & Athletics*, 781 F.2d 733 (9th Cir.1986), *reh’g en banc denied*, 789 F.2d 1319 (9th Cir.1986), *aff’d on other grounds, S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 107 S.Ct. 2971, 97 L.Ed.2d 427 (1987), are also relevant. We disagree. We have previously rejected the “likelihood of confusion” test as “fail[ing] to account for the full weight of the public’s interest in free expression” when expressive works are involved. *MCA*, 296 F.3d at 900. The “alternative means” test was rejected for the same reason in *Rogers* itself, 875 F.2d at 999, a position we approved by adopting the *Rogers* test in *MCA*. The only relevant legal framework for balancing the public’s right to be free from consumer confusion about Brown’s affiliation with *Madden NFL* and EA’s First Amendment rights in the context of Brown’s § 43(a) claim is the *Rogers* test.

III

Rogers involved a suit brought by the famous performer Ginger Rogers against

warrant First Amendment protection as expressive works, but all of the cases cited were decided years before the Supreme Court issued its opinion in *Brown v. Entertainment Merchants Ass’n*, — U.S. —, 131 S.Ct. 2729, 180 L.Ed.2d 708 (2011). See *Am. Amusement Mach. Ass’n v. Kendrick*, 244 F.3d 572, 579–80 (7th Cir.2001); *Wilson v. Midway Games, Inc.*, 198 F.Supp.2d 167, 180–81 (D.Conn.2002); *Am.’s Best Family Showplace Corp. v. City of New York*, 536 F.Supp. 170, 173–74 (E.D.N.Y.1982). Brown argues that EA’s insistence that the *Rogers* test governs is an attempt to portray First Amendment law

the producers and distributors of *Ginger and Fred*, a movie about two fictional Italian cabaret performers who imitated Rogers and her frequent performing partner Fred Astaire. *Rogers*, 875 F.2d at 996–97. Among Rogers’ claims was that the use of her name in the title of the movie violated § 43(a) by creating the false impression that she was involved with the film. *Id.* at 997. Recognizing that enforcing § 43(a) in this context might constrain free expression in violation of the First Amendment, the Second Circuit asserted that the Lanham Act should be “appl[ie]d to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999. The *Rogers* court introduced a two-pronged test, under which the Lanham Act should not be applied to expressive works “unless the [use of the trademark or other identifying material] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the [trademark or other identifying material] explicitly misleads as to the source or the content of the work.” *Id.*

A

[4] As we explained in *E.S.S.*, a case with similar facts to Brown’s case in which we applied the *Rogers* test to a § 43(a)

as settled with regard to video games when it is in fact evolving, but *Brown v. Entertainment Merchants Ass’n* demonstrates that any evolution favors greater protection, a fact Brown ignores by emphasizing these earlier cases. This evolution in recent years toward greater First Amendment protection for non-traditional media has not been limited to video games. See, e.g., *Anderson v. City of Hermosa Beach*, 621 F.3d 1051, 1055 (9th Cir.2010) (holding that “tattooing is a purely expressive activity fully protected by the First Amendment”).

claim related to the use of the likeness of a Los Angeles strip club in the video game *Grand Theft Auto: San Andreas*, “the level of [artistic] relevance [of the trademark or other identifying material to the work] merely must be above zero” for the trademark or other identifying material to be deemed artistically relevant. 547 F.3d at 1100. This black-and-white rule has the benefit of limiting our need to engage in artistic analysis in this context.⁴

[5] We agree with the district court that the use of Brown’s likeness is artistically relevant to the *Madden NFL* games. As Brown points out in trying to undermine the status of the games as expressive works, EA prides itself on the extreme realism of the games. As Brown emphasizes in arguing that it is in fact his likeness in the games: “[I]t is axiomatic the ’65 Cleveland Browns simply, by definition, cannot be the ’65 Cleveland Browns without the players who played for the ’65 Cleveland Browns. This fundamental truth applies especially to that team’s most famous player, Jim Brown.” Given the acknowledged centrality of realism to EA’s expressive goal, and the importance of including Brown’s likeness to realistically recreate one of the teams in the game, it is obvious that Brown’s likeness has at least some artistic relevance to EA’s work. The fact that any given version of *Madden NFL* includes likenesses of thousands of different current and former NFL players does not impact this analysis. In *E.S.S.*, the virtual strip club in question was just one of many virtual structures included by the designers of *Grand Theft Auto: San Andreas* in an attempt to simulate the feel

of East Los Angeles, but we nonetheless concluded that the strip club was artistically relevant to the work. 547 F.3d at 1100. There is no significant distinction to be made here.

Brown questions the artistic relevance of his likeness to *Madden NFL* in part by pointing us to the Sixth Circuit’s decision in *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir.2003). In *Parks*, civil rights hero Rosa Parks sued the musical duo Outkast under § 43(a) after Outkast released a song called *Rosa Parks*. *Id.* at 441. Partially due to the fact that one of the members of Outkast had said that the song was not “intended . . . to be about Rosa Parks or the civil rights movement,” the Sixth Circuit concluded that the district court should have at least considered additional evidence before deciding that the use of Ms. Parks’ name was artistically relevant to the song. *Id.* at 452–53. Brown alleges that EA has made similar denials of Jim Brown’s relevance to *Madden NFL*, and thus argues that Brown’s likeness is not artistically relevant to the *Madden NFL* games. The court in *Parks*, however, did not rely solely on the band’s denial that the song was about Ms. Parks or the civil rights movement in concluding that there was a factual dispute about artistic relevance. “The composers did *not* intend [the song] to be about Rosa Parks, and the lyrics are *not* about Rosa Parks,” the court stated, emphasizing both Outkast’s denials and the court’s own determination that the song’s lyrics were unrelated to Ms. Parks or the civil rights movement. *Id.* at 452. Here, even if EA’s denials regarding Brown are equivalent to Outkast’s denial regarding Parks, the content of the *Mad-*

4. Cf. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251, 23 S.Ct. 298, 47 L.Ed. 460 (1903) (Holmes, J.) (“It would be a dangerous undertaking for persons trained only to the

law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”).

den NFL games—the simulation of NFL football—is clearly related to Jim Brown, one of the NFL’s all-time greatest players. Moreover, EA’s denials are not equivalent to Outkast’s denial. EA has denied using the aspects of Brown’s likeness that may be protected by the Lanham Act and certain state laws, but such denials are a far cry from Outkast’s outright denial of relevance. In letters to Brown’s attorneys, EA officials have claimed that “Brown has not appeared in any *Madden NFL* game since 1998,” and that “Brown’s name and likeness does not appear in *Madden NFL 08* or any packaging or marketing materials associated with the product.” EA has not denied that Brown’s likeness is relevant to *Madden NFL*; rather, it has denied that Brown has appeared in the *Madden NFL* games released since 1998. If the denials are true—that is, if Brown’s likeness does not in fact appear in the games—Brown has no claim at all under the Lanham Act. We do not understand this to be Brown’s position. Outkast’s denial did not similarly undermine Ms. Parks’ Lanham Act claim because Outkast was not denying the use of Parks’ name. In order to have a valid § 43(a) claim based on artistic irrelevance, Brown needs to show both that his likeness was used and that his likeness was artistically irrelevant to the *Madden NFL* games. If artistic irrelevance can only be proven by accepting the truth of EA’s denial of the use of Brown’s likeness, Brown cannot possibly

satisfy both of these burdens. Moreover, in the context of a motion to dismiss, we accept Brown’s factual allegations as true, and Brown alleges that his likeness was used. We must thus assume that EA’s denials are false, meaning they provide no support for artistic irrelevance.⁵

One of the Sixth Circuit’s animating concerns in *Parks* was that a celebrity’s name could be “appropriated solely because of the vastly increased marketing power of a product bearing the name of [the celebrity].” 329 F.3d at 454. This is a legitimate concern, but the facts in *Parks*—specifically, the court’s determination that the lyrics of Outkast’s song may very well have nothing to do with Rosa Parks or the civil rights movement—made that concern much more realistic in that case than in this one. EA did not produce a game called *Jim Brown Presents Pinball* with no relation to Jim Brown or football beyond the title; it produced a football game featuring likenesses of thousands of current and former NFL players, including Brown. Comparing this case to *Parks* does not further Brown’s cause.

Brown also asserts that our interpretation of the *Rogers* test in *E.S.S.* to require artistic relevance to “merely . . . be above zero,” 547 F.3d at 1100, has rendered the *Rogers* test—described in the *Rogers* opinion itself as seeking to strike a “balance” between “the public’s interest in free expression” and “protect[ing] the public

5. In addition to pointing us to *Parks*, Brown also analogizes his case to *American Dairy Queen Corp. v. New Line Productions, Inc.*, 35 F.Supp.2d 727 (D.Minn.1998), in which the defendant admitted in its briefing that it did not intend its “Dairy Queens” title to refer to plaintiff American Dairy Queen Corporation. Based on this admission, the district court found that the defendant could express its ideas in other ways, and thus that on balance

the risk of consumer confusion and trademark dilution outweighed the public interest in free expression. *Id.* at 734–35. As explained in our discussion of *Parks*, this analogy is inapt because there is no similar explicit denial of relevance in this case, and because we presume the truth of Brown’s allegations that EA has used his likeness. *American Dairy Queen* also was not a case involving application of the *Rogers* test.

against flagrant deception,” 875 F.2d at 999—an inflexible and mechanical rule that more or less automatically protects expressive works regardless of the deception involved. But a balance need not be designed to find each of the sides weightier with equal frequency. The language in *Rogers* is clear. “[T]hat balance will normally not support application of the [Lanham] Act unless the [use of the trademark or other identifying material] has *no artistic relevance to the underlying work whatsoever*” 875 F.2d at 999 (emphasis added). The *Rogers* test is applicable when First Amendment rights are at their height—when expressive works are involved—so it is no surprise that the test puts such emphasis on even the slightest artistic relevance. “Intellectual property rights aren’t free: They’re imposed at the expense of future creators and of the public at large,” *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1516 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc), and the *Rogers* test applies when this expense is most significant. Our interpretation of the “artistic relevance” prong of the *Rogers* test in *E.S.S.* is correct, and Brown fails to allege facts that satisfy that prong in this case.

B

Even if the use of a trademark or other identifying material is artistically relevant to the expressive work, the creator of the expressive work can be subject to a Lanham Act claim if the creator uses the mark or material to “explicitly mislead[] [consumers] as to the source or the content of the work.” *Rogers*, 875 F.2d at 999. It is key here that the creator must *explicitly* mislead consumers. “[T]he slight risk that . . . use of a celebrity’s name might implicitly suggest endorsement or sponsorship to

some people is outweighed by the danger of restricting artistic expression, and [in cases where there is no explicit misleading] the Lanham Act is not applicable.” *Id.* at 999–1000. This second prong of the *Rogers* test “points directly at the purpose of trademark law, namely to avoid confusion in the marketplace by allowing a trademark owner to prevent others from duping consumers into buying a product they mistakenly believe is sponsored by the trademark owner.” *E.S.S.*, 547 F.3d at 1100 (internal quotation marks and citation omitted). We must ask “whether the [use of Brown’s likeness] would confuse [*Madden NFL*] players into thinking that [Brown] is somehow behind [the games] or that [he] sponsors [EA’s] product,” *id.*, and whether there was an “explicit indication,” “overt claim,” or “explicit misstatement” that caused such consumer confusion, *Rogers*, 875 F.2d at 1001. Brown puts forth several arguments attempting to show that this second prong of the *Rogers* test is satisfied, but each of his arguments is unsuccessful.

[6–8] First, Brown argues that the use of his likeness in the game coupled with a consumer survey demonstrating that a majority of the public believes that identifying marks cannot be included in products without permission at least raises a triable issue of fact as to the second prong of the *Rogers* test. It is well established that the use of a mark alone is not enough to satisfy this prong of the *Rogers* test. In *MCA*, we noted that if the use of a mark alone were sufficient “it would render *Rogers* a nullity.” 296 F.3d at 902. We reiterated this point in *E.S.S.*, asserting that “the mere use of a trademark alone cannot suffice to make such use explicitly misleading.” 547 F.3d at 1100. Adding survey evidence changes nothing. The test re-

quires that the use be *explicitly* misleading to consumers. To be relevant, evidence must relate to the nature of the behavior of the identifying material's user, not the impact of the use. Even if Brown could offer a survey demonstrating that consumers of the *Madden NFL* series believed that Brown endorsed the game, that would not support the claim that the use was explicitly misleading to consumers. The Sixth Circuit's decision in *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915 (6th Cir.2003), demonstrates this point. In that case, Tiger Woods' licensing agent, ETW Corporation, brought a Lanham Act claim against the publisher of artwork commemorating Woods' 1997 victory at The Masters. *Id.* at 918. A survey was produced in which participants were shown the artwork and asked if they thought Tiger Woods was affiliated or connected with the work or had approved or sponsored it. *Id.* at 937 & n. 19. Over sixty percent of the participants answered affirmatively, but the Sixth Circuit asserted: "[P]laintiff's survey evidence, even if its validity is assumed, indicates at most that some members of the public would draw the incorrect inference that Woods had some connection with [the work]. The risk of misunderstanding, not engendered by any explicit indication on the face of the [work], is so outweighed by the interest in artistic expression as to preclude application of the [Lanham] Act." *Id.* at 937 (footnote omitted). In *Rogers* itself, the Second Circuit rejected similar survey data for the same reasons. 875 F.2d at 1001. The use of Brown's likeness together with the cited survey do not provide a valid argument to allow Brown's case to go forward based on this prong of the *Rogers* test.

[9] Second, Brown argues that certain written materials that accompanied ver-

sions of the game demonstrate EA's attempts to explicitly mislead consumers about his endorsement or involvement with the game's production. Unlike mere use of the mark or a consumer survey, statements made in materials accompanying the game are at least the right kind of evidence to show that EA tried to explicitly mislead consumers about its relationship with Brown. Here, however, the statements highlighted by Brown do not show any attempt to mislead consumers. Brown points to materials that say that one of the game's features was the inclusion of "[f]ifty of the NFL's greatest players and every All-Madden team." Since Brown is one of the fifty greatest NFL players of all time and has been named to the "All Madden, All Millennium" team, Brown argues that the statement "explicitly represents that Brown was in EA's game." But Brown needs to prove that EA explicitly misled consumers about Brown's endorsement of the game, not that EA used Brown's likeness in the game; nothing in EA's promotion suggests that the fifty NFL players who are members of the All Madden, All Millennium team endorse EA's game. EA's statement is true and not misleading.

[10, 11] Third, Brown argues that the changes made to Brown's likeness for use in certain versions of the game satisfy the second prong of the *Rogers* test. EA made changes to certain versions of the game that might make a consumer of the game less confident that the player in question was intended to be Brown. Most notably, EA changed the jersey number on the Brown avatar from 32 (the number Brown wore in the NFL) to 37. If these changes had any impact on whether consumers believed that Brown endorsed the game, however, surely they made consum-

ers less likely to believe that Brown was involved. Brown offers various theories about EA's legal motives in "scrambling" his likeness for use in the game. It may be true that EA was trying to protect itself from being sued for using Brown's likeness, under the Lanham Act or otherwise, but an action that could only make consumers less likely to believe that Brown endorsed *Madden NFL* cannot possibly satisfy the second prong of the *Rogers* test.

[12] Fourth, Brown cites various comments made by EA officials as evidence that the second prong of the *Rogers* test is satisfied. As previously discussed, EA attorneys sent letters to Brown's attorneys stating that "Brown has not appeared in any *Madden NFL* game since 1998" and that "Brown's name and likeness does not appear in *Madden NFL 08* or any packaging or marketing materials associated with the product." Brown claims that EA officials contradicted these statements when they allegedly said at a conference held at USC Law School that EA was able to use the images and likenesses of players because it obtained written authorization from both the NFL players and the NFL. The statements made in letters to Brown's attorneys are irrelevant to this prong of the *Rogers* analysis. They were not made to consumers, and they do not say anything about Brown's endorsement of the game. The statement allegedly made at

the conference is perhaps the closest Brown comes to offering evidence that EA acted in an explicitly misleading manner as to Brown's endorsement of the game, but again, the statement was made to a limited audience, not to consumers. If a similar statement appeared on the back cover of a version of *Madden NFL*, that might satisfy the "explicitly misleading" prong, or at least raise a triable issue of fact, but a statement made at an academic conference about all of the likenesses used in the game could not realistically be expected to confuse consumers as to Brown's involvement.⁶

IV

Brown also argues that the district court improperly engaged in factfinding in granting EA's motion to dismiss. The district court, in Brown's view, could not possibly have granted the motion to dismiss if it accepted all of the allegations in Brown's complaint as true, as Brown alleges in his complaint that his likeness is not artistically relevant to *Madden NFL* and that EA attempted to mislead consumers about his involvement with *Madden NFL*.

[13–15] Brown is of course correct that "[o]n a motion to dismiss, the court presumes that the facts alleged by the plaintiff are true." *Halet v. Wend Inv. Co.*, 672 F.2d 1305, 1309 (9th Cir.1982). We will also "draw[] all reasonable inferences

6. Brown argues that a similar statement appearing on the packaging of the 2007 and 2009 versions of *Madden NFL* could explicitly mislead consumers as to Brown's endorsement. The packaging has the logo for the NFL Players Association and says "Officially Licensed Product of NFL PLAYERS." NFL PLAYERS is the licensing arm of the NFLPA and manages licensing rights for both current players and retired players, so Brown contends that the statement on the packaging

could be understood by consumers to mean that retired players, including Brown, endorse the game. We decline to address this argument because Brown did not raise it in his opening brief. See *Friends of Yosemite Valley v. Kempthorne*, 520 F.3d 1024, 1033 (9th Cir.2008). For the same reason, we decline to address Brown's contention that EA explicitly misled consumers by using Brown's likeness on the back covers of the same two versions of the game.

from the complaint in [Brown's] favor." *Mohamed v. Jeppesen Dataplan, Inc.*, 614 F.3d 1070, 1073 (9th Cir.2010) (en banc) (internal quotation marks omitted). We are not, however, required to "accept any unreasonable inferences or assume the truth of legal conclusions cast in the form of factual allegations." *Iieto v. Glock Inc.*, 349 F.3d 1191, 1200 (9th Cir.2003). Brown asserts that there is no artistic relevance and that EA attempted to mislead consumers about Brown's involvement with *Madden NFL*, but none of the facts asserted in support of these legal conclusions actually justify the conclusions.

[16] With regard to artistic relevance, even presuming that EA officials have denied the inclusion of Brown's likeness in the game, the district court could conclude, having reviewed the versions of *Madden NFL* provided to the court,⁷ that the likeness of a great NFL player is artistically relevant to a video game that aims to recreate NFL games.

With regard to Brown's allegation that EA explicitly misled consumers as to his involvement with the game, the factual support Brown offers is simply of the wrong type. Brown would need to demonstrate that EA *explicitly* misled consumers as to his *involvement*. Instead, his allegations, if taken as true, only demonstrate that (1) the public can generally be misled about sponsorship when marks are included in products; (2) EA explicitly stated that Brown's likeness appears in *Madden NFL*; (3) EA tried to disguise its use of Brown's likeness, if anything making consumers less likely to believe that he was involved; (4) EA was dishonest with Brown's attorney about the inclusion of his

likeness in the game; and (5) EA suggested to a group of individuals at an academic conference that the players whose likenesses were used in *Madden NFL* had signed licensing agreements with EA. There is simply no allegation that EA explicitly misled consumers as to Brown's involvement, and thus no problem with the district court deciding this issue in response to a motion to dismiss.

V

As expressive works, the *Madden NFL* video games are entitled to the same First Amendment protection as great literature, plays, or books. Brown's Lanham Act claim is thus subject to the *Rogers* test, and we agree with the district court that Brown has failed to allege sufficient facts to make out a plausible claim that survives that test. Brown's likeness is artistically relevant to the games and there are no alleged facts to support the claim that EA explicitly misled consumers as to Brown's involvement with the games. The *Rogers* test tells us that, in this case, the public interest in free expression outweighs the public interest in avoiding consumer confusion. The district court's judgment is thus **AFFIRMED**.



7. The district court properly considered the versions of *Madden NFL* submitted to the court as part of the complaint itself through

the "incorporation by reference" doctrine. See *Knievel v. ESPN*, 393 F.3d 1068, 1076 (9th Cir.2005). We do the same.

552 F.2d at 1225.² The Seventh Circuit's reasoning is directly on point here, and to be consistent with our sister circuit, we should apply the California parole statutes at face value and hold that Thornton's challenges to the GPS requirement and residency restriction are likewise cognizable only in habeas.

II

In sum, Thornton's challenges to his parole conditions would necessarily imply the partial invalidity of his sentence because parole is a required part of a determinate sentence in California. Therefore, his challenge cannot be brought under § 1983. I respectfully dissent from the majority's conclusion to the contrary, which conflicts with Supreme Court precedent and sister circuit authority.



In re NCAA STUDENT-ATHLETE NAME & LIKENESS LICENSING LITIGATION,

2. The majority asserts that *Drollinger* is distinguishable because the conditions in that case were imposed “as part of a court judgment,” maj. op. at 1262. But the Supreme Court has not indicated that it would make any differ-

Samuel Michael Keller; Edward C. O’bannon, Jr.; Byron Bishop; Michael Anderson; Danny Wimprine; Ishmael Thrower; Craig Newsome; Damien Rhodes; Samuel Jacobson, Plaintiffs–Appellees,

v.

Electronic Arts Inc., Defendant–Appellant,

and

National Collegiate Athletic Association; Collegiate Licensing Company, Defendants.

No. 10–15387.

United States Court of Appeals,
Ninth Circuit.

Argued and Submitted Feb. 15, 2011.

Submission Vacated Feb. 18, 2011.

Argued and Resubmitted July 13, 2012.

Filed July 31, 2013.

Background: Former college football player filed putative class-action against developer of video games, which allowed users to control avatars representing college football and basketball players as those avatars participated in simulated games, alleging violations of class members’ rights of publicity. Developer moved to strike the complaint as a strategic lawsuit against public participation (SLAPP) under California’s anti-SLAPP statute. The United States District Court for the Northern District of California, Claudia A. Wilken, J., 2010 WL 530108, denied the motion, and developer appealed.

ence under *Heck* whether an agency, rather than a court, establishes the parole conditions that are imposed as part of a sentence under state law, and the majority does not explain why this is significant.

Holding: The Court of Appeals, Bybee, Circuit Judge, held that video game developer's use of the likenesses of college athletes in its video games was not protected by the First Amendment, and therefore former college football player's right-of-publicity claims against developer were not barred by California's anti-SLAPP statute.

Affirmed.

Thomas, Circuit Judge, filed dissenting opinion.

1. Pleading ⇌358

California's anti-SLAPP (strategic lawsuit against public participation) statute is designed to discourage suits that masquerade as ordinary lawsuits but are brought to deter common citizens from exercising their political or legal rights or to punish them for doing so. West's Ann. Cal.C.C.P. § 425.16(b)(1).

2. Pleading ⇌358, 360

In evaluating an anti-SLAPP (strategic lawsuit against public participation) motion under California law, court requires that defendant make a prima facie showing that the plaintiff's suit arises from an act by the defendant made in connection with a public issue in furtherance of the defendant's right to free speech under the United States or California Constitution, and then determine whether the plaintiff has established a reasonable probability that the plaintiff will prevail on his or her claim. U.S.C.A. Const.Amend. 1; West's Ann.Cal.C.C.P. § 425.16(b)(1).

3. Torts ⇌385

Elements of a right-of-publicity claim under California common law are: (1) the defendant's use of the plaintiff's identity, (2) the appropriation of plaintiff's name or

likeness to defendant's advantage, commercially or otherwise, (3) lack of consent, and (4) resulting injury; same claim under California Civil Code requires a plaintiff to prove all the elements of the common law cause of action plus a knowing use by the defendant as well as a direct connection between the alleged use and the commercial purpose. West's Ann.Cal.Civ.Code § 3344.

4. Constitutional Law ⇌1899

Pleading ⇌358

Torts ⇌391

Under California's transformative use defense, video game developer's use of the likenesses of college athletes in its video games was not protected by the First Amendment, and therefore former college football player's right-of-publicity claims against developer were not barred by California's anti-SLAPP (strategic lawsuit against public participation) statute; video game realistically portrayed college football players in the context of college football games, and thus developer's use of player's likeness did not add significant creative elements so as to be transformed into something entitled to First Amendment protection. U.S.C.A. Const.Amend. 1; West's Ann.Cal.C.C.P. § 425.16(b)(1); West's Ann.Cal.Civ.Code § 3344.

5. Federal Courts ⇌383, 390, 391

Where there is no binding precedent from the state's highest court, federal court must predict how the highest state court would decide issue of state law using intermediate appellate court decisions, decisions from other jurisdictions, statutes, treatises, and restatements as guidance.

6. Torts ⇌384

Under California law, right of publicity protects the celebrity, not the consumer. West's Ann.Cal.Civ.Code § 3344.

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* The NCAA's motion to file its amicus brief is GRANTED.

** The Honorable Gordon J. Quist, Senior District Judge for the U.S. District Court for the

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Gregory L. Cutner and Robert J. Wierenga, Schiff Harden, LLP, Ann Arbor, MI; Rocky N. Unruh, Schiff Hardin, LLP, San Francisco, CA, for Amicus Curiae National Collegiate Athletic Association.*

Appeal from the United States District Court for the Northern District of California, Claudia A. Wilken, District Judge, Presiding. D.C. No. 4:09-cv-01967-CW.

Before: SIDNEY R. THOMAS and JAY S. BYBEE, Circuit Judges, and GORDON J. QUIST, Senior District Judge.**

OPINION

BYBEE, Circuit Judge:

Video games are entitled to the full protections of the First Amendment, because

Western District of Michigan, sitting by designation.

“[l]ike the protected books, plays, and movies that preceded them, video games communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player’s interaction with the virtual world).” *Brown v. Entm’t Merchs. Ass’n*, — U.S. —, 131 S.Ct. 2729, 2733, 180 L.Ed.2d 708 (2011).¹ Such rights are not absolute, and states may recognize the right of publicity to a degree consistent with the First Amendment. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 574–75, 97 S.Ct. 2849, 53 L.Ed.2d 965 (1977). In this case, we must balance the right of publicity of a former college football player against the asserted First Amendment right of a video game developer to use his likeness in its expressive works.

The district court concluded that the game developer, Electronic Arts (“EA”), had no First Amendment defense against the right-of-publicity claims of the football player, Samuel Keller. We affirm. Under the “transformative use” test developed by the California Supreme Court, EA’s use does not qualify for First Amendment protection as a matter of law because it literally recreates Keller in the very setting in which he has achieved renown. The other First Amendment defenses asserted by EA do not defeat Keller’s claims either.

I

Samuel Keller was the starting quarterback for Arizona State University in 2005

1. In *Brown v. Electronic Arts, Inc.*, No. 09–56675, 724 F.3d 1235, 1241–42, 2013 WL 3927736, at *3 (9th Cir. July 31, 2013), we noted that “there may be some work referred to as a ‘video game’ (or referred to as a ‘book,’ ‘play,’ or ‘movie’ for that matter) that does not contain enough of the elements contemplated by the Supreme Court [in *Brown v. Entertainment Merchants Association*] to war-

before he transferred to the University of Nebraska, where he played during the 2007 season. EA is the producer of the *NCAA Football* series of video games, which allow users to control avatars representing college football players as those avatars participate in simulated games. In *NCAA Football*, EA seeks to replicate each school’s entire team as accurately as possible. Every real football player on each team included in the game has a corresponding avatar in the game with the player’s actual jersey number and virtually identical height, weight, build, skin tone, hair color, and home state. EA attempts to match any unique, highly identifiable playing behaviors by sending detailed questionnaires to team equipment managers. Additionally, EA creates realistic virtual versions of actual stadiums; populates them with the virtual athletes, coaches, cheerleaders, and fans realistically rendered by EA’s graphic artists; and incorporates realistic sounds such as the crunch of the players’ pads and the roar of the crowd.

EA’s game differs from reality in that EA omits the players’ names on their jerseys and assigns each player a home town that is different from the actual player’s home town. However, users of the video game may upload rosters of names obtained from third parties so that the names do appear on the jerseys. In such cases, EA allows images from the game containing athletes’ real names to be posted on its website by users. Users can further alter

rant First Amendment protection as an expressive work,” but asserted that “[e]ven if there is a line to be drawn between expressive video games and non-expressive video games, and even if courts should at some point be drawing that line, we have no need to draw that line here.” The same holds true in this case.

reality by entering “Dynasty” mode, where the user assumes a head coach’s responsibilities for a college program for up to thirty seasons, including recruiting players from a randomly generated pool of high school athletes, or “Campus Legend” mode, where the user controls a virtual player from high school through college, making choices relating to practices, academics, and social life.

In the 2005 edition of the game, the virtual starting quarterback for Arizona State wears number 9, as did Keller, and has the same height, weight, skin tone, hair color, hair style, handedness, home state, play style (pocket passer), visor preference, facial features, and school year as Keller. In the 2008 edition, the virtual quarterback for Nebraska has these same characteristics, though the jersey number does not match, presumably because Keller changed his number right before the season started.

Objecting to this use of his likeness, Keller filed a putative class-action complaint in the Northern District of California asserting, as relevant on appeal, that EA violated his right of publicity under California Civil Code § 3344 and California common law.² EA moved to strike the complaint as a strategic lawsuit against public participation (“SLAPP”) under California’s anti-SLAPP statute, Cal.Civ.Proc. Code § 425.16, and the district court denied the motion. We have jurisdiction

2. There are actually nine named plaintiffs, all former National Collegiate Athletic Association (“NCAA”) football or basketball players: Keller, Edward O’Bannon, Jr. (UCLA), Byron Bishop (University of North Carolina), Michael Anderson (University of Memphis), Danny Wimprine (University of Memphis), Ishmael Thrower (Arizona State University), Craig Newsome (Arizona State University), Damien Rhodes (Syracuse University), and Samuel Jacobson (University of Minnesota). EA’s

over EA’s appeal pursuant to 28 U.S.C. § 1291. See *Batzel v. Smith*, 333 F.3d 1018, 1024–26 (9th Cir.2003).³

II

[1] California’s anti-SLAPP statute is designed to discourage suits that “masquerade as ordinary lawsuits but are brought to deter common citizens from exercising their political or legal rights or to punish them for doing so.” *Batzel*, 333 F.3d at 1024 (internal quotation marks omitted). The statute provides:

A cause of action against a person arising from any act of that person in furtherance of the person’s right of petition or free speech under the United States Constitution or the California Constitution in connection with a public issue shall be subject to a special motion to strike, unless the court determines that the plaintiff has established that there is a probability that the plaintiff will prevail on the claim.

Cal.Civ.Proc.Code § 425.16(b)(1). We have determined that the anti-SLAPP statute is available in federal court. *Thomas v. Fry’s Elecs., Inc.*, 400 F.3d 1206 (9th Cir.2005) (per curiam).

[2] We evaluate an anti-SLAPP motion in two steps. First, the defendant must “make a prima facie showing that the plaintiff’s suit arises from an act by the defendant made in connection with a public

NCAA basketball games are also implicated in this appeal. Because the issues are the same for each plaintiff, all of the claims are addressed through our discussion of Keller and *NCAA Football*.

3. We review *de novo* the district court’s denial of a motion to strike under California’s anti-SLAPP statute. *Mindys Cosmetics, Inc. v. Dalkar*, 611 F.3d 590, 595 (9th Cir.2010).

issue in furtherance of the defendant's right to free speech under the United States or California Constitution." *Batzel*, 333 F.3d at 1024. Keller does not contest that EA has made this threshold showing. Indeed, there is no question that "video games qualify for First Amendment protection," *Entm't Merchs. Ass'n*, 131 S.Ct. at 2733, or that Keller's suit arises from EA's production and distribution of *NCAA Football* in furtherance of EA's protected right to express itself through video games.

[3] Second, we must evaluate whether the plaintiff has "establish[ed] a reasonable probability that the plaintiff will prevail on his or her . . . claim." *Batzel*, 333 F.3d at 1024. "The plaintiff must demonstrate that the complaint is legally sufficient and supported by a prima facie showing of facts to sustain a favorable judgment if the evidence submitted by plaintiff is credited." *Metabolife Int'l, Inc. v. Wornick*, 264 F.3d 832, 840 (9th Cir.2001) (internal quotation marks omitted). The statute "subjects to potential dismissal only those actions in which the plaintiff cannot state and substantiate a legally sufficient claim." *Nawellier v. Sletten*, 29 Cal.4th 82, 124 Cal. Rptr.2d 530, 52 P.3d 703, 711 (2002) (internal quotation marks omitted). EA did not contest before the district court and does not contest here that Keller has stated a right-of-publicity claim under California common and statutory law.⁴ Instead, EA

raises four affirmative defenses derived from the First Amendment: the "transformative use" test, the *Rogers* test, the "public interest" test, and the "public affairs" exemption. EA argues that, in light of these defenses, it is not reasonably probable that Keller will prevail on his right-of-publicity claim. This appeal therefore centers on the applicability of these defenses. We take each one in turn.⁵

A

The California Supreme Court formulated the transformative use defense in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal.4th 387, 106 Cal.Rptr.2d 126, 21 P.3d 797 (2001). The defense is "a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation." *Id.* 106 Cal.Rptr.2d 126, 21 P.3d at 799. The California Supreme Court explained that "when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity." *Id.* 106 Cal.Rptr.2d 126, 21 P.3d at 808. The court rejected the wholesale importation of the copyright "fair use" defense into right-of-publicity claims, but recognized that some aspects of

4. The elements of a right-of-publicity claim under California common law are: "(1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury." *Stewart v. Rolling Stone LLC*, 181 Cal.App.4th 664, 105 Cal.Rptr.3d 98, 111 (internal quotation marks omitted). The same claim under California Civil Code § 3344 requires a plaintiff to prove "all the

elements of the common law cause of action" plus "a knowing use by the defendant as well as a direct connection between the alleged use and the commercial purpose." *Id.*

5. Just as we did in *Hilton v. Hallmark Cards*, we reserve the question of whether the First Amendment furnishes a defense other than those the parties raise. 599 F.3d 894, 909 n. 11 (9th Cir.2010).

that defense are “particularly pertinent.” *Id.*; see 17 U.S.C. § 107; see also *SOFA Entm’t, Inc. v. Dodger Prods., Inc.*, 709 F.3d 1273, 1277–78 (9th Cir.2013) (discussing the “fair use” defense codified in 17 U.S.C. § 107).

Comedy III gives us at least five factors to consider in determining whether a work is sufficiently transformative to obtain First Amendment protection. See J. Thomas McCarthy, *The Rights of Publicity and Privacy* § 8:72 (2d ed.2012). First, if “the celebrity likeness is one of the ‘raw materials’ from which an original work is synthesized,” it is more likely to be transformative than if “the depiction or imitation of the celebrity is the very sum and substance of the work in question.” *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 809. Second, the work is protected if it is “primarily the defendant’s own expression”—as long as that expression is “something other than the likeness of the celebrity.” *Id.* This factor requires an examination of whether a likely purchaser’s primary motivation is to buy a reproduction of the celebrity, or to buy the expressive work of that artist. McCarthy, *supra*, § 8:72. Third, to avoid making judgments concerning “the quality of the artistic contribution,” a court should conduct an inquiry “more quantitative than qualitative” and ask “whether the literal and imitative or the creative elements predominate in the work.” *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 809. Fourth, the California Supreme Court indicated that “a subsidiary inquiry” would be useful in close cases: whether “the marketability and economic value of the challenged work derive primarily from the fame of the celebrity depicted.” *Id.* 106 Cal.Rptr.2d 126, 21 P.3d at 810. Lastly, the court indicated that “when an artist’s skill and talent is manifestly sub-

ordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame,” the work is not transformative. *Id.*

We have explained that “[o]nly if [a defendant] is entitled to the [transformative] defense as a matter of law can it prevail on its motion to strike,” because the California Supreme Court “envisioned the application of the defense as a question of fact.” *Hilton*, 599 F.3d at 910. As a result, EA “is only entitled to the defense as a matter of law if no trier of fact could reasonably conclude that the [game] [i]s not transformative.” *Id.*

California courts have applied the transformative use test in relevant situations in four cases. First, in *Comedy III* itself, the California Supreme Court applied the test to T-shirts and lithographs bearing a likeness of The Three Stooges and concluded that it could “discern no significant transformative or creative contribution.” *Id.* 106 Cal.Rptr.2d 126, 21 P.3d at 811. The court reasoned that the artist’s “undeniable skill is manifestly subordinated to the overall goal of creating literal, conventional depictions of The Three Stooges so as to exploit their fame.” *Id.* “[W]ere we to decide that [the artist’s] depictions were protected by the First Amendment,” the court continued, “we cannot perceive how the right of publicity would remain a viable right other than in cases of falsified celebrity endorsements.” *Id.*

Second, in *Winter v. DC Comics*, the California Supreme Court applied the test to comic books containing characters Johnny and Edgar Autumn, “depicted as villainous half-worm, half-human offspring” but evoking two famous brothers, rockers Johnny and Edgar Winter. 30 Cal.4th 881, 134 Cal.Rptr.2d 634, 69 P.3d 473, 476 (2003). The court held that “the comic

books are transformative and entitled to First Amendment protection.” *Id.* 134 Cal.Rptr.2d 634, 69 P.3d at 480. It reasoned that the comic books “are not just conventional depictions of plaintiffs but contain significant expressive content other than plaintiffs’ mere likenesses.” *Id.* 134 Cal.Rptr.2d 634, 69 P.3d at 479. “To the extent the drawings of the Autumn brothers resemble plaintiffs at all, they are distorted for purposes of lampoon, parody, or caricature.” *Id.* Importantly, the court relied on the fact that the brothers “are but cartoon characters . . . in a larger story, which is itself quite expressive.” *Id.*

Third, in *Kirby v. Sega of America, Inc.*, the California Court of Appeal applied the transformative use test to a video game in which the user controls the dancing of “Ulala,” a reporter from outer space allegedly based on singer Kierin Kirby, whose “‘signature’ lyrical expression . . . is ‘ooh la la.’” 144 Cal.App.4th 47, 50 Cal.Rptr.3d 607, 609–10 (2006). The court held that “Ulala is more than a mere likeness or literal depiction of Kirby,” pointing to Ulala’s “extremely tall, slender computer-generated physique,” her “hairstyle and primary costume,” her dance moves, and her role as “a space-age reporter in the 25th century,” all of which were “unlike any public depiction of Kirby.” *Id.* at 616. “As in *Winter*, Ulala is a ‘fanciful, creative character’ who exists in the context of a unique and expressive video game.” *Id.* at 618.

Finally, in *No Doubt v. Activision Publishing, Inc.*, the California Court of Appeal addressed Activision’s *Band Hero* video game. 192 Cal.App.4th 1018, 122 Cal.Rptr.3d 397, 400 (2011), *petition for review denied*, 2011 Cal. LEXIS 6100 (Cal. June 8, 2011) (No. B223996). In *Band Hero*, users simulate performing in a rock band

in time with popular songs. *Id.* at 401. Users choose from a number of avatars, some of which represent actual rock stars, including the members of the rock band No Doubt. *Id.* at 401. Activision licensed No Doubt’s likeness, but allegedly exceeded the scope of the license by permitting users to manipulate the No Doubt avatars to play any song in the game, solo or with members of other bands, and even to alter the avatars’ voices. *Id.* at 402. The court held that No Doubt’s right of publicity prevailed despite Activision’s First Amendment defense because the game was not “transformative” under the *Comedy III* test. It reasoned that the video game characters were “literal recreations of the band members,” doing “the same activity by which the band achieved and maintains its fame.” *Id.* at 411. According to the court, the fact “that the avatars appear in the context of a videogame that contains many other creative elements[] does not transform the avatars into anything other than exact depictions of No Doubt’s members doing exactly what they do as celebrities.” *Id.* The court concluded that “the expressive elements of the game remain manifestly subordinated to the overall goal of creating a conventional portrait of No Doubt so as to commercially exploit its fame.” *Id.* (internal quotation marks omitted).

We have also had occasion to apply the transformative use test. In *Hilton v. Hallmark Cards*, we applied the test to a birthday card depicting Paris Hilton in a manner reminiscent of an episode of Hilton’s reality show *The Simple Life*. 599 F.3d at 899. We observed some differences between the episode and the card, but noted that “the basic setting is the same: we see Paris Hilton, born to privilege, working as a waitress.” *Id.* at 911. We reasoned that “[w]hen we compare

Hallmark's card to the video game in *Kirby*, which transported a 1990s singer (catchphrases and all) into the 25th century and transmogrified her into a space-age reporter, . . . the card falls far short of the level of new expression added in the video game." *Id.* As a result, we concluded that "there is enough doubt as to whether Hallmark's card is transformative under our case law that we cannot say Hallmark is entitled to the defense as a matter of law." *Id.*⁶

[4] With these cases in mind as guidance, we conclude that EA's use of Keller's likeness does not contain significant transformative elements such that EA is entitled to the defense as a matter of law. The facts of *No Doubt* are very similar to those here. EA is alleged to have replicated Keller's physical characteristics in *NCAA Football*, just as the members of No Doubt are realistically portrayed in *Band Hero*. Here, as in *Band Hero*, users manipulate the characters in the performance of the same activity for which they are known in real life—playing football in this case, and performing in a rock band in *Band Hero*. The context in which the activ-

ity occurs is also similarly realistic—real venues in *Band Hero* and realistic depictions of actual football stadiums in *NCAA Football*. As the district court found, Keller is represented as "what he was: the starting quarterback for Arizona State" and Nebraska, and "the game's setting is identical to where the public found [Keller] during his collegiate career: on the football field." *Keller v. Elec. Arts, Inc.*, No. C 09-1967 CW, 2010 WL 530108, at *5 (N.D.Cal. Feb. 8, 2010).

EA argues that the district court erred in focusing primarily on Keller's likeness and ignoring the transformative elements of the game as a whole. Judge Thomas, our dissenting colleague, suggests the same. *See* Dissent at 1285. We are unable to say that there was any error, particularly in light of *No Doubt*, which reasoned much the same as the district court in this case: "that the avatars appear in the context of a videogame that contains many other creative elements[] does not transform the avatars into anything other than exact depictions of No Doubt's members doing exactly what they do as celebrities." *No Doubt*, 122 Cal.Rptr.3d at 411.⁷

6. We also briefly addressed the transformative use test in a footnote in *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001). We indicated that if we had considered the test, we would have concluded that an image of Dustin Hoffman from "Tootsie" that had been altered to make it appear like he was wearing fashions from a decade later "contained 'significant transformative elements.'" *Id.* at 1184 n. 2; 1182-83. "Hoffman's body was eliminated and a new, differently clothed body was substituted in its place. In fact, the entire theory of Hoffman's case rests on his allegation that the photograph is not a 'true' or 'literal' depiction of him, but a false portrayal." *Id.* at 1184 n. 2.

7. Judge Thomas argues that the "sheer number of virtual actors," the absence of "any evidence as to the personal marketing power

of Sam Keller," and the relative anonymity of each individual player in *NCAA Football* as compared to the public figures in other California right-of-publicity cases all mitigate in favor of finding that the EA's First Amendment rights outweigh Keller's right of publicity. *See* Dissent at 1286-88. These facts are not irrelevant to the analysis—they all can be considered in the framework of the five considerations from *Comedy III* laid out above—but the fact is that EA elected to use avatars that mimic real college football players for a reason. If EA did not think there was value in having an avatar designed to mimic each individual player, it would not go to the lengths it does to achieve realism in this regard. Having chosen to use the players' likenesses, EA cannot now hide behind the numerosity of its potential offenses

EA suggests that the fact that *NCAA Football* users can alter the characteristics of the avatars in the game is significant. Again, our dissenting colleague agrees. *See* Dissent at 1286–87. In *No Doubt*, the California Court of Appeal noted that *Band Hero* “[d]id not permit players to alter the No Doubt avatars in any respect.” *Id.* at 410. The court went on to say that the No Doubt avatars “remain at all times immutable images of the real celebrity musicians, in stark contrast to the ‘fanciful, creative characters’ in *Winter* and *Kirby*.” *Id.* The court explained further:

[I]t is the differences between *Kirby* and the instant case . . . which are determinative. In *Kirby*, the pop singer was portrayed as an entirely new character—the space-age news reporter Ulala. In *Band Hero*, by contrast, no matter what else occurs in the game during the depiction of the No Doubt avatars, the avatars perform rock songs, the same activity by which the band achieved and maintains its fame. Moreover, the avatars perform those songs as literal recreations of the band members. That the avatars can be manipulated to per-

or the alleged unimportance of any one individual player.

8. EA further argues that *No Doubt* is distinguishable because the video game company in that case entered into a license agreement which it allegedly breached. However, the California Court of Appeal did not rely on breach of contract in its analysis of whether the game was transformative. 122 Cal. Rptr.3d at 412 n. 7. Keller asserts here that EA contracted away its First Amendment rights in a licensing agreement with the NCAA that purportedly prohibited the use of athlete likenesses. However, in light of our conclusion that EA is not entitled to a First Amendment defense as a matter of law, we need not reach this issue and leave it for the district court to address in the first instance

form at fanciful venues including outer space or to sing songs the real band would object to singing, or that the avatars appear in the context of a video-game that contains many other creative elements, does not transform the avatars into anything other than exact depictions of No Doubt’s members doing exactly what they do as celebrities.

Id. at 410–11. Judge Thomas says that “[t]he Court of Appeal cited character immutability as a chief factor distinguishing [*No Doubt*] from *Winter* and *Kirby*.” Dissent at 1287. Though No Doubt certainly mentioned the immutability of the avatars, we do not read the California Court of Appeal’s decision as turning on the inability of users to alter the avatars. The key contrast with *Winter* and *Kirby* was that in those games the public figures were transformed into “fanciful, creative characters” or “portrayed as . . . entirely new character[s].” *No Doubt*, 122 Cal. Rptr.3d at 410. On this front, our case is clearly aligned with *No Doubt*, not with *Winter* and *Kirby*. We believe No Doubt offers a persuasive precedent that cannot be materially distinguished from Keller’s case.^{8,9}

on remand should the finder of fact determine in post-SLAPP proceedings that EA’s use is transformative.

9. In dissent, Judge Thomas suggests that this case is distinguishable from other right-to-publicity cases because “an individual college athlete’s right of publicity is extraordinarily circumscribed and, in practical reality, non-existent” because “NCAA rules prohibit athletes from benefitting economically from any success on the field.” Dissent at 1289. Judge Thomas commendably addresses the fairness of this structure, *see* Dissent at 1289 n. 5, but setting fairness aside, the fact is that college athletes are not indefinitely bound by NCAA rules. Once an athlete graduates from college, for instance, the athlete can capitalize on his success on the field during college in

The Third Circuit came to the same conclusion in *Hart v. Electronic Arts, Inc.*, 717 F.3d 141 (3d Cir.2013). In *Hart*, EA faced a materially identical challenge under New Jersey right-of-publicity law, brought by former Rutgers quarterback Ryan Hart. *See id.* at 163 n. 28 (“*Keller* is simply [*Hart*] incarnated in California.”). Though the Third Circuit was tasked with interpreting New Jersey law, the court looked to the transformative use test developed in California. *See id.* at 158 n. 23 (noting that the right-of-publicity laws are “strikingly similar . . . and protect similar interests” in New Jersey and California, and that “consequently [there is] no issue in applying balancing tests developed in California to New Jersey”); *see also id.* at 165 (holding that “the Transformative Use Test is the proper analytical framework to apply to cases such as the one at bar”). Applying the test, the court held that “the *NCAA Football* . . . games at issue . . . do not sufficiently transform [Hart]’s identity to escape the right of publicity claim,” reversing the district court’s grant of summary judgment to EA. *Id.* at 170.

As we have, the Third Circuit considered the potentially transformative nature of the game as a whole, *id.* at 166, 169, and the user’s ability to alter avatar characteristics, *id.* at 166–68. Asserting that “the lack of transformative context is even more pronounced here than in *No Doubt*,” *id.* at 166, and that “the ability to modify the avatar counts for little where the appeal of the game lies in users’ ability to play as, or alongside[,] their preferred players or team,” *id.* at 168 (internal quotation marks omitted), the Third Circuit agreed with us that these changes do not render the *NCAA Football* games suffi-

ciently transformative to defeat a right-of-publicity claim.

[5] Judge Ambro dissented in *Hart*, concluding that “the creative components of *NCAA Football* contain sufficient expressive transformation to merit First Amendment protection.” *Id.* at 175 (Ambro, J., dissenting). But in critiquing the majority opinion, Judge Ambro disregarded *No Doubt* and *Kirby* because “they were not decided by the architect of the Transformative Use Test, the Supreme Court of California.” *Id.* at 172 n. 4. He thus “[d]id not attempt to explain or distinguish the[se cases]’ holdings except to note that [he] believe[s] *No Doubt*, which focused on individual depictions rather than the work in its entirety, was wrongly decided in light of the prior precedent in *Comedy III* and *Winter*.” *Id.* We recognize that we are bound only by the decisions of a state’s highest court and not by decisions of the state’s intermediate appellate court when considering statelaw issues sitting in diversity jurisdiction. *See In re Kirkland*, 915 F.2d 1236, 1238–39 (9th Cir. 1990). Nonetheless, where there is no binding precedent from the state’s highest court, we “must predict how the highest state court would decide the issue using *intermediate appellate court decisions*, decisions from other jurisdictions, statutes, treatises, and restatements as guidance.” *Id.* at 1239 (emphasis added). As stated above, we believe *No Doubt* in particular provides persuasive guidance. We do not believe *No Doubt* to be inconsistent with the California Supreme Court’s relevant decisions, and we will not disregard a well-reasoned decision from a state’s intermediate appellate court in this context. Like the majority in *Hart*, we rely substantially

any number of ways. EA’s use of a college athlete’s likeness interferes with the athlete’s

right to capitalize on his athletic success once he is beyond the dominion of NCAA rule.

on *No Doubt*, and believe we are correct to do so.

Given that *NCAA Football* realistically portrays college football players in the context of college football games, the district court was correct in concluding that EA cannot prevail as a matter of law based on the transformative use defense at the anti-SLAPP stage. *Cf. Hilton*, 599 F.3d at 910–11.¹⁰

B

EA urges us to adopt for right-of-publicity claims the broader First Amendment defense that we have previously adopted in the context of false endorsement claims under the Lanham Act: the *Rogers* test.¹¹ *See Brown v. Elec. Arts*, 724 F.3d at 1239–41, 2013 WL 3927736, at *1–2 (applying the *Rogers* test to a Lanham Act claim brought by former NFL player Jim Brown relating to the use of his likeness in EA’s *Madden NFL* video games).

Rogers v. Grimaldi is a landmark Second Circuit case balancing First Amendment rights against claims under the Lanham Act. 875 F.2d 994 (2d Cir.1989). The case involved a suit brought by the famous performer Ginger Rogers against the pro-

ducers and distributors of *Ginger and Fred*, a movie about two fictional Italian cabaret performers who imitated Rogers and her frequent performing partner Fred Astaire. *Id.* at 996–97. Rogers alleged both a violation of the Lanham Act for creating the false impression that she endorsed the film and infringement of her common law right of publicity. *Id.* at 997.

The *Rogers* court recognized that “[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection,” but that “[t]he purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product.” *Id.* “Consumers of artistic works thus have a dual interest: They have an interest in not being misled and they also have an interest in enjoying the results of the author’s freedom of expression.” *Id.* at 998. The *Rogers* court determined that titles of artistic or literary works were less likely to be misleading than “the names of ordinary commercial products,” and thus that Lanham Act protections applied with less rigor when considering titles of artistic or literary works than when considering ordinary products. *Id.* at 999–1000. The court concluded that “in general the Act should be construed to apply to artistic works only

10. Judge Thomas asserts that “[t]he logical consequence of the majority view is that all realistic depictions of actual persons, no matter how incidental, are protected by a state law right of publicity regardless of the creative context,” “jeopardiz[ing] the creative use of historic figures in motion pictures, books, and sound recordings.” Dissent at 1290. We reject the notion that our holding has such broad consequences. As discussed above, one of the factors identified in *Comedy III* “requires an examination of whether a likely purchaser’s primary motivation is to buy a reproduction of the celebrity, or to buy the expressive work of that artist.” *McCarthy*, *supra*, § 8:72; *see Comedy III*, 106 Cal.

Rptr.2d 126, 21 P.3d at 809. Certainly this leaves room for distinguishing between this case—where we have emphasized EA’s primary emphasis on reproducing reality—and cases involving other kinds of expressive works.

11. Keller argues that EA never asked the district court to apply *Rogers* and has therefore waived the issue on appeal. Although it could have been more explicit, EA’s anti-SLAPP motion did cite *Rogers* and argue that Keller had not alleged that his likeness was “wholly unrelated” to the content of the video game or a “disguised commercial advertisement,” the two prongs of the *Rogers* test.

where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999. The court therefore held:

In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the [Lanham] Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.

Id.

We first endorsed the *Rogers* test for Lanham Act claims involving artistic or expressive works in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002). We agreed that, in the context of artistic and literary titles, “[c]onsumers expect a title to communicate a message about the book or movie, but they do not expect it to identify the publisher or producer,” and “adopt[ed] the *Rogers* standard as our own.” *Id.* Then, in *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, we considered a claim by a strip club owner that video game maker Rock Star incorporated its club logo into the game’s virtual depiction of East Los Angeles, violating the club’s trademark right to that logo. 547 F.3d 1095, 1096–98 (9th Cir.2008). We held that Rock Star’s use of the logo and trade dress was protected by the First Amendment and that it therefore could not be held liable under the Lanham Act. *Id.* at 1099–1101. In so doing, we extended the *Rogers* test slightly, noting that “[a]lthough this test traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why it ought not also apply to the use of a trademark in the body of the work.” *Id.* at 1099.

In this case, EA argues that we should extend this test, created to evaluate Lanham Act claims, to apply to right-of-publicity claims because it is “less prone to misinterpretation” and “more protective of free expression” than the transformative use defense. Although we acknowledge that there is some overlap between the transformative use test formulated by the California Supreme Court and the *Rogers* test, we disagree that the *Rogers* test should be imported wholesale for right-of-publicity claims. Our conclusion on this point is consistent with the Third Circuit’s rejection of EA’s identical argument in *Hart*. See *Hart*, 717 F.3d at 154–58. As the history and development of the *Rogers* test makes clear, it was designed to protect consumers from the risk of consumer confusion—the hallmark element of a Lanham Act claim. See *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1149 (9th Cir. 2002). The right of publicity, on the other hand, does not primarily seek to prevent consumer confusion. See *Hart*, 717 F.3d at 158 (“[T]he right of publicity does not implicate the potential for consumer confusion . . .”). Rather, it primarily “protects a form of intellectual property [in one’s person] that society deems to have some social utility.” *Comedy III*, 106 Cal. Rptr.2d 126, 21 P.3d at 804. As the California Supreme Court has explained:

Often considerable money, time and energy are needed to develop one’s prominence in a particular field. Years of labor may be required before one’s skill, reputation, notoriety or virtues are sufficiently developed to permit an economic return through some medium of commercial promotion. For some, the investment may eventually create considerable commercial value in one’s identity.

Id. 106 Cal.Rptr.2d 126, 21 P.3d at 804–05 (internal quotation marks and citations omitted).

[6] The right of publicity protects the *celebrity*, not the *consumer*. Keller’s publicity claim is not founded on an allegation that consumers are being illegally misled into believing that he is endorsing EA or its products. Indeed, he would be hard-pressed to support such an allegation absent evidence that EA explicitly misled consumers into holding such a belief. See *Brown v. Elec. Arts*, 724 F.3d at 1242–43, 2013 WL 3927736, at *4 (holding under the *Rogers* test that, since “Brown’s likeness is artistically relevant to the [*Madden NFL*] games and there are no alleged facts to support the claim that EA explicitly misled consumers as to Brown’s involvement with the games,” “the public interest in free expression outweighs the public interest in avoiding consumer confusion”). Instead, Keller’s claim is that EA has appropriated, without permission and without providing compensation, his talent and years of hard work on the football field. The reasoning of the *Rogers* and *Mattel* courts—that artistic and literary works should be protected unless they explicitly mislead consumers—is simply not responsive to Keller’s asserted interests here. Cf. *Hart*, 717 F.3d at 157 (“Effectively, [EA] argues that [Hart] should be unable to assert a claim for appropriating his likeness as a football player precisely because his likeness was used for a game about football. Adopting this line of reasoning threatens to turn the right of publicity on its head.”).

We recognize that *Rogers* also dealt with a right-of-publicity claim—one under Oregon law—and applied a modified version of its Lanham Act test in order to adapt to that particular context:

In light of the Oregon Court’s concern for the protection of free expression, . . . the right of publicity [would not] bar the use of a celebrity’s name in a movie title

unless the title was “wholly unrelated” to the movie or was “simply a disguised commercial advertisement for the sale of goods or services.”

875 F.2d at 1004. However, the *Rogers* court was faced with a situation in which the “Oregon Courts . . . [had] not determined the scope of the common law right of publicity in that state.” *Id.* at 1002. In the absence of clear state-law precedent, the *Rogers* court was “obliged to engage in the uncertain task of predicting what the New York courts would predict the Oregon courts would rule as to the contours of a right of publicity under Oregon law.” *Id.* In light of *Comedy III* and its progeny, we are faced with no such uncertain task.

Lastly, we note that the only circuit court to import the *Rogers* test into the publicity arena, the Sixth Circuit, has done so inconsistently. In *Parks v. LaFace Records*, the Sixth Circuit indicated that the *Rogers* test was appropriate for right-of-publicity claims, noting that the Restatement (Third) of Unfair Competition had endorsed use of the test in that context. 329 F.3d 437, 461 (6th Cir.2003) (citing *Restatement (Third) of Unfair Competition* § 47 cmt. c). Subsequently, in *ETW Corp. v. Jireh Publishing, Inc.*, the court acknowledged the *Parks* decision but did not apply the *Rogers* test to the Ohio right-of-publicity claim in question. 332 F.3d at 915, 936 & n. 17 (6th Cir.2003). Instead, the court applied a balancing test from comment d in the *Restatement* (analyzing “the substantiality and market effect of the use of the celebrity’s image . . . in light of the informational and creative content”), as well as the transformative use test from *Comedy III*. *Id.* at 937–38; see *Hart*, 717 F.3d at 157 (“We find *Parks* to be less than persuasive [as to the applicability of the *Rogers* test to right-of-pub-

licity cases] given that just over a month later another panel of the Sixth Circuit decided [*ETW*], a right of publicity case where the Circuit applied the Transformative Use Test.”). Similarly, the Tenth Circuit in *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959 (10th Cir.1996), and the Eighth Circuit in *C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818 (8th Cir.2007), rejected the *Rogers* test in favor of a flexible case-by-case approach that takes into account the celebrity’s interest in retaining his or her publicity and the public’s interest in free expression. Therefore, we decline EA’s invitation to extend the *Rogers* test to right-of-publicity claims.

C

California has developed two additional defenses aimed at protecting the reporting of factual information under state law. One of these defenses only applies to common law right-of-publicity claims while the other only applies to statutory right-of-publicity claims. *Montana v. San Jose Mercury News, Inc.*, 34 Cal.App.4th 790, 40 Cal.Rptr.2d 639, 640 (1995). Liability will not lie for common law right-of-publicity claims for the “publication of matters in the public interest.” *Id.* at 640–41. Similarly, liability will not lie for statutory right-of-publicity claims for the “use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign.” Cal. Civ.Code § 3344(d). Although these defenses are based on First Amendment concerns, *Gill v. Hearst Publ’g Co.*, 40 Cal.2d 224, 253 P.2d 441, 443–44 (1953), they are not coextensive with the Federal Constitution, *New Kids on the Block v. News Am. Publ’g,*

Inc., 971 F.2d 302, 310 n. 10 (9th Cir.1992), and their application is thus a matter of state law.

EA argues that these defenses give it the right to “incorporate athletes’ names, statistics, and other biographical information” into its expressive works, as the defenses were “designed to create ‘extra breathing space’ for the use of a person’s name in connection with matters of public interest.” Keller responds that the right of publicity yields to free use of a public figure’s likeness only to the extent reasonably required to report information to the public or publish factual data, and that the defenses apply only to broadcasts or accounts of public affairs, not to EA’s *NCAA Football* games, which do not contain or constitute such reporting about Keller.

California courts have generally analyzed the common law defense and the statutory defense separately, but it is clear that both defenses protect only the act of publishing or reporting. By its terms, § 3344(d) is limited to a “broadcast or account,” and we have confirmed that the common law defense is about a publication or reporting of newsworthy items. *Hilton*, 599 F.3d at 912. However, most of the discussion by California courts pertains to whether the subject matter of the communication is of “public interest” or related to “news” or “public affairs,” leaving little guidance as to when the communication constitutes a publication or reporting.

For instance, in *Dora v. Frontline Video, Inc.*, a wellknown surfer sued the producer of a documentary on surfing entitled “The Legends of Malibu,” claiming misappropriation of his name and likeness. 15 Cal.App.4th 536, 18 Cal.Rptr.2d 790, 791 (1993). The court held that the documentary was protected because it was “a fair comment on real life events which have

caught the popular imagination.” *Id.* at 792 (internal quotation marks omitted). The court explained that surfing “has created a lifestyle that influences speech, behavior, dress, and entertainment,” has had “an economic impact,” and “has also had a significant influence on the popular culture,” such that “[i]t would be difficult to conclude that a surfing documentary does not fall within the category of public affairs.” *Id.* at 794–95. Similarly, in *Gionfriddo v. Major League Baseball*, retired professional baseball players alleged that Major League Baseball violated their right of publicity by displaying “factual data concerning the players, their performance statistics, and verbal descriptions and video depictions of their play” in game programs and on its website. 94 Cal.App.4th 400, 114 Cal.Rptr.2d 307, 314 (2001). The court reasoned that “[t]he recitation and discussion of factual data concerning the athletic performance of these plaintiffs command a substantial public interest, and, therefore, is a form of expression due substantial constitutional protection.” *Id.* at 315. And in *Montana v. San Jose Mercury News, Inc.*, former NFL quarterback Joe Montana brought a right-of-publicity action against a newspaper for selling posters containing previously published

pages from the newspaper depicting the many Super Bowl victories by Montana and the San Francisco 49ers. *Montana*, 40 Cal.Rptr.2d at 639–40. The court found that “[p]osters portraying the 49’ers’ [sic] victories are . . . a form of public interest presentation to which protection must be extended.” *Id.* at 641 (internal quotation marks omitted).

We think that, unlike in *Gionfriddo*, *Montana*, and *Dora*, EA is not publishing or reporting factual data. EA’s video game is a means by which users can play their own virtual football games, not a means for obtaining information about real-world football games. Although EA has incorporated certain actual player information into the game (height, weight, etc.), its case is considerably weakened by its decision not to include the athletes’ names along with their likenesses and statistical data. EA can hardly be considered to be “reporting” on Keller’s career at Arizona State and Nebraska when it is not even using Keller’s name in connection with his avatar in the game. Put simply, EA’s interactive game is not a publication of facts about college football; it is a game, not a reference source. These state law defenses, therefore, do not apply.¹²

12. We similarly reject Judge Thomas’s argument that Keller’s right-of-publicity claim should give way to the First Amendment in light of the fact that “the essence of *NCAA Football* is founded on publicly available data.” Dissent at 1288. Judge Thomas compares *NCAA Football* to the fantasy baseball products that the Eighth Circuit deemed protected by the First Amendment in the face of a right-of-publicity claim in *C.B.C. Distribution and Marketing*, 505 F.3d at 823–24. Dissent at 1288. But there is a big difference between a video game like *NCAA Football* and fantasy baseball products like those at issue in *C.B.C.* Those products merely “incorporate[d] the names along with performance and biographical data of actual major league baseball players.” *Id.* at 820. *NCAA Football*, on the

other hand, uses virtual likenesses of actual college football players. It is seemingly true that each likeness is generated largely from publicly available data—though, as Judge Thomas acknowledges, EA solicits certain information directly from schools—but finding this fact dispositive would neuter the right of publicity in our digital world. Computer programmers with the appropriate expertise can create a realistic likeness of any celebrity using only publicly available data. If EA creates a virtual likeness of Tom Brady using only publicly available data—public images and videos of Brady—does EA have free reign to use that likeness in commercials without violating Brady’s right of publicity? We think not, and thus must reject Judge Thomas’s

III

Under California's transformative use defense, EA's use of the likenesses of college athletes like Samuel Keller in its video games is not, as a matter of law, protected by the First Amendment. We reject EA's suggestion to import the *Rogers* test into the right-of-publicity arena, and conclude that statelaw defenses for the reporting of information do not protect EA's use.

AFFIRMED.

THOMAS, Circuit Judge, dissenting:

Because the creative and transformative elements of Electronic Arts' *NCAA Football* video game series predominate over the commercial use of the athletes' likenesses, the First Amendment protects EA from liability. Therefore, I respectfully dissent.

I

As expressive works, video games are entitled to First Amendment protection. *Brown v. Entm't Merchs. Ass'n*, — U.S. —, 131 S.Ct. 2729, 2733, 180 L.Ed.2d 708 (2011). The First Amendment affords additional protection to *NCAA Football* because it involves a subject of substantial public interest: collegiate football. *Moore v. Univ. of Notre Dame*, 968 F.Supp. 1330, 1337 (N.D.Ind.1997). Because football is a

point about the public availability of much of the data used given that EA produced and used actual likenesses of the athletes involved.

1. I agree with the majority that the test articulated in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir.1989), should not be employed in this context. The *Rogers* test is appropriately applied in Lanham Act cases, where the primary concern is with the danger of consumer confusion when a work is depicted as something

matter of public interest, the use of the images of athletes is entitled to constitutional protection, even if profits are involved. *Montana v. San Jose Mercury News, Inc.*, 34 Cal.App.4th 790, 40 Cal. Rptr.2d 639, 643 n. 2 (1995); *see also* Cal. Civ.Code § 3344(d) (exempting from liability the "use of a name . . . or likeness in connection with any . . . public affairs, or sports broadcast or account").

Where it is recognized, the tort of appropriation is a creature of common law or statute, depending on the jurisdiction. However, the right to compensation for the misappropriation for commercial use of one's image or celebrity is far from absolute. In every jurisdiction, any right of publicity must be balanced against the constitutional protection afforded by the First Amendment. Courts have employed a variety of methods in balancing the rights. *See, e.g., Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo.2003) (en banc). The California Supreme Court applies a "transformative use" test it formulated in *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal.4th 387, 106 Cal.Rptr.2d 126, 21 P.3d 797 (2001).¹

As the majority properly notes, the transformative use defense is "a balancing test between the First Amendment and the right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity like-

it is not. 15 U.S.C. § 1125(a)(1). However, the right of publicity is an economic right to use the value of one own's celebrity. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576-77, 97 S.Ct. 2849, 53 L.Ed.2d 965 (1977). Therefore, a more nuanced balancing is required. In our context, I believe the transformative use test—if correctly applied to the work as a whole—provides the proper analytical framework.

ness or imitation.” *Comedy III*, 106 Cal. Rptr.2d 126, 21 P.3d at 799. The rationale for the test, as the majority notes, is that “when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity.” *Id.* 106 Cal.Rptr.2d 126, 21 P.3d at 808.

The five considerations articulated in *Comedy III*, and cited by the majority, are whether: (1) the celebrity likeness is one of the raw materials from which an original work is synthesized; (2) the work is primarily the defendant’s own expression if the expression is something other than the likeness of the celebrity; (3) the literal and imitative or creative elements predominate in the work; (4) the marketability and economic value of the challenged work derives primarily from the fame of the celebrity depicted; and (5) an artist’s skill and talent has been manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit the celebrity’s fame. *Id.* 106 Cal.Rptr.2d 126, 21 P.3d at 809–10.

Although these considerations are often distilled as analytical factors, Justice Mosk was careful in *Comedy III* not to label them as such. Indeed, the focus of *Comedy III* is a more holistic examination of whether the transformative and creative elements of a particular work predominate over commercially based literal or imitative depictions. The distinction is critical, because excessive deconstruction of *Comedy III* can lead to misapplication of the test. And it is at this juncture that I must respectfully part ways with my colleagues in the majority.

2. I agree fully with Judge Ambro’s excellent dissent in *Hart*, which describes the analytic

The majority confines its inquiry to how a single athlete’s likeness is represented in the video game, rather than examining the transformative and creative elements in the video game as a whole. In my view, this approach contradicts the holistic analysis required by the transformative use test. See *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 170–76 (3d Cir.2013) (Ambro, J., dissenting).² The salient question is whether the entire work is transformative, and whether the transformative elements predominate, rather than whether an individual persona or image has been altered.

When EA’s *NCAA Football* video game series is examined carefully, and put in proper context, I conclude that the creative and transformative elements of the games predominate over the commercial use of the likenesses of the athletes within the games.

A

The first step in conducting a balancing is to examine the creative work at issue. At its essence, EA’s *NCAA Football* is a work of interactive historical fiction. Although the game changes from year to year, its most popular features predominately involve role-playing by the gamer. For example, a player can create a virtual image of himself as a potential college football player. The virtual player decides which position he would like to play, then participates in a series of “tryouts” or competes in an entire high school season to gauge his skill. Based on his performance, the virtual player is ranked and available to play at select colleges. The player chooses among the colleges, then assumes the role of a college football player. He

flaws of applying a transformative use test outside the context of the work as a whole.

also selects a major, the amount of time he wishes to spend on social activities, and practice—all of which may affect the virtual player's performance. He then plays his position on the college team. In some versions of the game, in another mode, the virtual player can engage in a competition for the Heisman Trophy. In another popular mode, the gamer becomes a virtual coach. The coach scouts, recruits, and develops entirely fictional players for his team. The coach can then promote the team's evolution over decades of seasons.

The college teams that are supplied in the game do replicate the actual college teams for that season, including virtual athletes who bear the statistical and physical dimensions of the actual college athletes. But, unlike their professional football counterparts in the *Madden NFL* series, the NCAA football players in these games are not identified.

The gamers can also change their abilities, appearances, and physical characteristics at will. Keller's impressive physical likeness can be morphed by the gamer into an overweight and slow virtual athlete, with anemic passing ability. And the gamer can create new virtual players out of whole cloth. Players can change teams. The gamer could pit Sam Keller against himself, or a stronger or weaker version of himself, on a different team. Or the gamer could play the game endlessly without ever encountering Keller's avatar. In the simulated games, the gamer controls not only the conduct of the game, but the weather, crowd noise, mascots, and other environmental factors. Of course, one may play the game leaving the players unaltered, pitting team against team. But, in this context as well, the work is one of historic fiction. The gamer controls the teams, players, and games.

Applying the *Comedy III* considerations to *NCAA Football* in proper holistic context, the considerations favor First Amendment protection. The athletic likenesses are but one of the raw materials from which the broader game is constructed. The work, considered as a whole, is primarily one of EA's own expression. The creative and transformative elements predominate over the commercial use of likenesses. The marketability and economic value of the game comes from the creative elements within, not from the pure commercial exploitation of a celebrity image. The game is not a conventional portrait of a celebrity, but a work consisting of many creative and transformative elements.

The video game at issue is much akin to the creations the California Supreme Court found protected in *Winter v. DC Comics*, 30 Cal.4th 881, 134 Cal.Rptr.2d 634, 69 P.3d 473, 476 (2003), where the two fabled guitarists Johnny and Edgar Winter were easily identifiable, but depicted as chimeras. It is also consistent with the California Court of Appeal's decision in *Kirby v. Sega of America, Inc.*, 144 Cal. App.4th 47, 50 Cal.Rptr.3d 607, 609–10 (2006), where a character easily identified as singer Kierin Kirby, more popularly known as Lady Miss Kier, was transformed into a “fanciful, creative character” who exists in the context of a unique and expressive video game.” *Id.* at 618. So, too, are the virtual players who populate the world of the *NCAA Football* series.

No Doubt v. Activision Publishing, Inc., 192 Cal.App.4th 1018, 122 Cal.Rptr.3d 397 (2011), is not to the contrary. The literal representations in *No Doubt* were not, and could not be, transformed in any way. Indeed, in *No Doubt*, the bandmembers

posed for motion-capture photography to allow reproduction of their likenesses, *id.* at 402, and the Court of Appeal underscored the fact that the video game did not “permit players to alter the No Doubt avatars in any respect” and the avatars remained “at all times immutable images of the real celebrity musicians,” *id.* at 410. The Court of Appeal cited character immutability as a chief factor distinguishing that case from *Winter* and *Kirby*. *Id.* Unlike the avatars in *No Doubt*, the virtual players in *NCAA Football* are completely mutable and changeable at the whim of the gamer. The majority places great reliance on *No Doubt* as support for its proposition that the initial placement of realistic avatars in the game overcomes the First Amendment’s protection, but the Court of Appeal in *No Doubt* rejected such a cramped construction, noting that “even literal reproductions of celebrities may be ‘transformed’ into expressive works based on the context into which the celebrity image is placed.” *Id.* at 410 (citing *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 797).³

Unlike the majority, I would not punish EA for the realism of its games and for the skill of the artists who created realistic settings for the football games. Majority op. at 1279 n. 10. That the lifelike roar of the crowd and the crunch of pads contribute to the gamer’s experience demonstrates how little of *NCAA Football* is driven by the particular likeness of Sam Keller, or any of the other plaintiffs, rather than by the game’s artistic elements.

In short, considering the creative elements alone in this case satisfies the transformative use test in favor of First Amendment protection.

3. Of course, to the extent that the Court of Appeal’s opinion in *No Doubt* may be read to be in tension with the transformative use test

B

Although one could leave the analysis with an examination of the transformative and creative aspects of the game, a true balancing requires an inquiry as to the other side of the scales: the publicity right at stake. Here, as well, the *NCAA Football* video game series can be distinguished from the traditional right of publicity cases, both from a quantitative and a qualitative perspective.

As a quantitative matter, *NCAA Football* is different from other right of publicity cases in the sheer number of virtual actors involved. Most right of publicity cases involve either one celebrity, or a finite and defined group of celebrities. *Comedy III* involved literal likenesses of the Three Stooges. *Hilton v. Hallmark Cards*, 599 F.3d 894, 909–12 (9th Cir.2009), involved the literal likeness of Paris Hilton. *Winter* involved the images of the rock star brother duo. *Kirby* involved the likeness of one singer. *No Doubt* focused on the likenesses of the members of a specific legendary band.

In contrast, *NCAA Football* includes not just Sam Keller, but thousands of virtual actors. This consideration is of particular significance when we examine, as instructed by *Comedy III*, whether the source of the product marketability comes from creative elements or from pure exploitation of a celebrity image. 106 Cal.Rptr.2d 126, 21 P.3d at 810. There is not, at this stage of the litigation, any evidence as to the personal marketing power of Sam Keller, as distinguished from the appeal of the creative aspects of the product. Regardless, the sheer number of athletes involved

as articulated by the California Supreme Court in *Comedy III* and *Winter*, it must yield.

inevitably diminish the significance of the publicity right at issue. *Comedy III* involved literal depictions of the Three Stooges on lithographs and T-shirts. *Winter* involved characters depicted in a comic strip. *Kirby* and *No Doubt* involved pivotal characters in a video game. The commercial image of the celebrities in each case was central to the production, and its contact with the consumer was immediate and unavoidable. In contrast, one could play *NCAA Football* thousands of times without ever encountering a particular avatar. In context of the collective, an individual's publicity right is relatively insignificant. Put another way, if an anonymous virtual player is tackled in an imaginary video game and no one notices, is there any right of publicity infringed at all?

The sheer quantity of the virtual players in the game underscores the inappropriateness of analyzing the right of publicity through the lens of one likeness only. Only when the creative work is considered in complete context can a proper analysis be conducted.

As a qualitative matter, the essence of *NCAA Football* is founded on publicly available data, which is not protected by any individual publicity rights. It is true that EA solicits and receives information directly from colleges and universities. But the information is hardly proprietary. Personal vital statistics for players are found in college programs and media guides. Likewise, playing statistics are easily available. In this respect, the information used by EA is indistinguishable

from the information used in fantasy athletic leagues, for which the First Amendment provides protection, *C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 823–24 (8th Cir.2007), or much beloved statistical board games, such as *Strat-O-Matic*. An athlete's right of publicity simply does not encompass publicly available statistical data. *See, e.g., IMS Health Inc. v. Sorrell*, 630 F.3d 263, 271–72 (2d Cir.2010) (“The First Amendment protects ‘[e]ven dry information, devoid of advocacy, political relevance, or artistic expression.’” (quoting *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 446 (2d Cir.2001)) (alteration in original)).⁴

Further, the structure of the game is not founded on exploitation of an individual's publicity rights. The players are unidentified and anonymous. It is true that third-party software is available to quickly identify the players, but that is not part of the EA package. And the fact that the players can be identified by the knowledgeable user by their position, team, and statistics is somewhat beside the point. The issue is whether the marketability of the product is driven by an individual celebrity, or by the game itself. *Comedy III*, 106 Cal.Rptr.2d 126, 21 P.3d at 810. Player anonymity, while certainly not a complete defense, bears on the question of how we balance the right of publicity against the First Amendment. This feature of the game places it in stark contrast with *No Doubt*, where the whole point of the enterprise was the successful commercial exploitation of the specifically identified, world-famous musicians.

4. Contrary to the majority's suggestion, I do not claim that any use of a likeness founded on publicly available information is transformative. Majority op. 1283–84 n. 12. The majority's analogy to a commercial featuring

Tom Brady is inapposite for at least two reasons: (1) a commercial is not interactive in the same way that *NCAA Football* is, and (2) Brady's marketing power is well established, while that of the plaintiffs is not.

Finally, as a qualitative matter, the publicity rights of college athletes are remarkably restricted. This consideration is critical because the “right to exploit commercially one’s celebrity is primarily an economic right.” *Gionfriddo v. Major League Baseball*, 94 Cal.App.4th 400, 114 Cal.Rptr.2d 307, 318 (2001). NCAA rules prohibit athletes from benefitting economically from any success on the field. NCAA Bylaw 12.5 specifically prohibits commercial licensing of an NCAA athlete’s name or picture. NCAA, *2012–13 NCAA Division I Manual* § 12.5.2.1 (2012). Before being allowed to compete each year, all Division I NCAA athletes must sign a contract stating that they understand the prohibition on licensing and affirming that they have not violated any amateurism rules. In short, even if an athlete wished to license his image to EA, the athlete could not do so without destroying amateur status. Thus, an individual college athlete’s right of publicity is

extraordinarily circumscribed and, in practical reality, nonexistent.⁵

In sum, even apart from consideration of transformative elements, examination of the right of publicity in question also resolves the balance in favor of the First Amendment. The quantity of players involved dilutes the commercial impact of any particular player and the scope of the publicity right is significantly reduced by the fact that: (1) a player cannot own the individual, publicly available statistics on which the game is based; (2) the players are not identified in the game; and (3) NCAA college athletes do not have the right to license their names and likenesses, even if they chose to do so.⁶

II

Given the proper application of the transformative use test, Keller is unlikely to prevail. The balance of interests falls squarely on the side of the First Amend-

5. The issue of whether this structure is fair to the student athlete is beyond the scope of this appeal, but forms a significant backdrop to the discussion. The NCAA received revenues of \$871.6 million in fiscal year 2011–12, with 81% of the money coming from television and marketing fees. However, few college athletes will ever receive any professional compensation. The NCAA reports that in 2011, there were 67,887 college football players. Of those, 15,086 were senior players, and only 255 athletes were drafted for a professional team. Thus, only 1.7% of seniors received any subsequent professional economic compensation for their athletic endeavors. NCAA, *Estimated Probability of Competing in Athletics Beyond the High School Interscholastic Level* (2011), available at <http://www.ncaa.org/wps/wcm/connect/public/ncaa/pdfs/2011/2011+probability+of+going+pro>.

And participation in college football can come at a terrible cost. The NCAA reports that, during a recent five-year period, college football players suffered 41,000 injuries, including 23 non-fatal catastrophic injuries and

11 fatalities from indirect catastrophic injuries. NCAA, *Football Injuries: Data From the 2004/05 to 2008/09 Seasons*, available at <http://www.ncaa.org/wps/wcm/connect/public/ncaa/health+and+safety/sports+injuries/resources/football+injuries>.

6. While acknowledging that these considerations are relevant to the *Comedy III* analysis, the majority says EA’s use of realistic likenesses demonstrates that it sees “value in having an avatar designed to mimic each individual player.” Majority op. at 1276 n. 7. But the same is true of any right of publicity case. The defendants in *Winter* saw value in using comic book characters that resembled the Winter brothers. Andy Warhol—whose portraits were discussed in *Comedy III*—saw value in using images of celebrities such as Marilyn Monroe. In those cases, the products’ marketability derives primarily from the creative elements, not from a pure commercial exploitation of a celebrity image. The same is true of *NCAA Football*.

ment. The stakes are not small. The logical consequence of the majority view is that all realistic depictions of actual persons, no matter how incidental, are protected by a state law right of publicity regardless of the creative context. This logic jeopardizes the creative use of historic figures in motion pictures, books, and sound recordings. Absent the use of actual footage, the motion picture *Forrest Gump* might as well be just a box of chocolates. Without its historical characters, *Midnight in Paris* would be reduced to a pedestrian domestic squabble. The majority's holding that creative use of realistic images and personas does not satisfy the transformative use test cannot be reconciled with the many cases affording such works First Amendment protection.⁷ I respectfully disagree with this potentially dangerous and out-of-context interpretation of the transformative use test.

For these reasons, I respectfully dissent.



UNITED STATES of America,
Plaintiff–Appellee,

v.

Victor Manuel VALENZUELA–ARISQUETA, aka Victor Valenzuela–Arisqueta, Defendant–Appellant.

No. 12–10596.

United States Court of Appeals,
Ninth Circuit.

Argued and Submitted June 12, 2013.

Filed Aug. 1, 2013.

Background: Defendant appealed from order of the United States District Court

for the District of Arizona, Jennifer G. Zippis, J., which rejected his guilty plea to illegal reentry into the United States.

Holding: The Court of Appeals, Callahan, Circuit Judge, held that defendant was not subjected to double jeopardy.

Affirmed.

1. Criminal Law ⇌1023(3)

A pretrial order rejecting a claim of double jeopardy may be immediately appealable under the collateral order doctrine, as long as the double jeopardy claim is colorable. U.S.C.A. Const.Amend. 5.

2. Sentencing and Punishment ⇌794

For a court to impose an enhancement for illegal reentry into the United States based on a prior conviction, the felony conviction must precede the defendant's removal from the country. Immigration and Nationality Act, §§ 276(b), 8 U.S.C.A. § 1326(b).

3. Double Jeopardy ⇌57

District court did not subject defendant to double jeopardy by rejecting his guilty plea to illegal reentry into the United States and offering him the choice of again pleading guilty or proceeding to trial; plea colloquy was defective, in that defendant was not advised of maximum penalty for the offense for which he was charged, and even if jeopardy had attached when magistrate judge accepted defendant's guilty plea without an adequate colloquy, it did not terminate with rejection of his plea, since he retained options of proceeding to trial, pleading guilty, or seeking

7. See, e.g., *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir.2003) (affording First Amendment protection to an artist's use of photographs of Tiger Woods); J. Thomas

McCarthy, *The Rights of Publicity and Privacy* § 8.65 (2013 ed.) (collecting cases); *Hart*, 717 F.3d at 173 (Ambro, J., dissenting) (describing cases). Football.