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**COMMENT: RAY V. ESPN, INC. AND THE NEED
FOR FURTHER DEVELOPMENTS IN COPYRIGHT
PREEMPTION ANALYSIS OF THE RIGHT OF
PUBLICITY IN PROFESSIONAL SPORTS**

*Thomas Hwang**

The Eighth Circuit's recent decision in *Ray v. ESPN, Inc.*, while reaching the correct outcome of preemption, marks a missed opportunity to develop the complicated and confusing discourse at the intersection of federal copyright protection and right of publicity claims arising from state laws. This Comment traces the development of the right of publicity from its historical roots in the right of privacy to its modern manifestation of providing protection against the unauthorized commercial use of a person's likeness or identity by another. This Comment also explores the Congressional intent behind the Copyright Act of 1976 and its attempts to unify the then separate federal and state copyright law landscape under a single federal copyright protection system where federal law preempts state law when they conflict. Noting the complicated and inconsistent application by courts of the preemption doctrine of the Copyright Act over state law right of publicity claims, this Comment proposes a solution utilizing a modified version of Professor Nimmer's two-prong preemption test that would allow for more consistent predictions of how courts will determine preemption cases.

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I. INTRODUCTION

Remembering and reliving classic moments in sports history is part of the beloved tradition of being a sports fan. The proliferation of sports-history programming and documentaries commemorating influential or significant moments in athletics evidences the culture of sports fandom's dedication to reliving those moments.¹ However, before those athletic matches and moments could carve their iconic place in sports history, they had to be relayed and broadcasted to the masses beyond those spectators who were physically present. Predictably, given the commercial nature of sports broadcasts, conflict arose between the athletes and participants who asserted their individual and collective rights and the infrastructure that facilitated those broadcasts.²

The right of publicity has long been an embedded issue in the world of professional sports.³ Federal copyright law has often conflicted with state law right of publicity issues, further complicating how courts approach the already complicated right of publicity claims.⁴ This history has divided courts and has resulted in inconsistency in analyzing right of publicity claims and copyright issues.⁵

1. See *What is 30 for 30?*, ESPN, <http://www.espn.com/30for30> [<http://perma.cc/N287-NQF7>] (“With each documentary, the filmmakers brought their passion and personal approach to the screen, detailing the issues, trends, athletes, teams, rivalries, games and moments that have transformed the sports landscape from 1979 to 2009.”). See generally *ESPN 25: ESPN Counts Down the 100 Most Memorable Moments of the Past 25 Years*, ESPN, <http://sports.espn.go.com/espn/espn25/moments> [<http://perma.cc/YC55-4RMA>].

2. *Balt. Orioles, Inc. v. MLB Players Ass’n*, 805 F.2d 663, 666 (7th Cir. 1986) (involving a right of publicity claim by numerous Major League Baseball players regarding the use of their likeness in television broadcasts of games in which they participated); see also *Dryer v. NFL*, 55 F. Supp. 3d 1181, 1186 (D. Minn. 2014) (involving a right of publicity claim by former professional football players and the production of historical films by the NFL).

3. Justin B. Bryant, Article, *Applying the Lessons from Dryer v. NFL: Forming a Workable Framework for Analyzing the Right of Publicity in Professional Sports*, 22 *SPORTS LAW. J.* 1, 2 (2015).

4. See Kristen E. Riccard, Comment, *Product Placement or Pure Entertainment? Critiquing a Copyright-Preemption Proposal*, 59 *AM. U. L. REV.* 427, 429 (2009) (“Neither Congress nor the Supreme Court has a clear standard to determine when a federal copyright claim should trump a state right of publicity claim.”).

5. Bryant, *supra* note 3, at 2 (“That long history . . . has only served to complicate the evaluation of right-of-publicity claims, rather than help provide a consistent doctrinal framework for courts . . .”). See generally Robert J. Bernstein & Robert W. Clarida, *Copyright Law; Does Copyright Preempt the Right of Publicity?*, N.Y. L.J. (ONLINE), Mar. 18, 2005, LEXIS.

The Eighth Circuit of the United States Court of Appeals failed to make progress in addressing and resolving the inconsistency in how courts analyze conflicts between right of publicity claims and federal copyright law in its April 2015 opinion, *Ray v. ESPN, Inc.*⁶ There, former professional wrestler Steve “Wild Thing” Ray brought suit alleging state law claims against ESPN, Inc. and its subsidiaries (ESPN) for re-broadcasting old wrestling matches in which he participated.⁷ Despite arriving at the correct result in the federal copyright preemption issue of Ray’s state law claims,⁸ the Eighth Circuit missed an opportunity to make any meaningful additions to the current, yet insufficient, framework of state law right of publicity and federal copyright law preemption analysis.

This Comment will explore the complicated relationship of state right of publicity laws and the federal copyright preemption doctrine under the Copyright Act of 1976.⁹ It will also critique the Eighth Circuit’s shallow analysis of the preemption issue in *Ray v. ESPN, Inc.* and argue for a modified version of Professor David Nimmer’s preemption framework¹⁰ in an effort to address the inconsistency among the courts in resolving copyright preemption disputes.¹¹

Part II of this Comment will first document the background and development of the right of publicity from its origins in the right to privacy to its current framework, which incentivizes the development of performances that appeal to the public by protecting the economic interests

6. See *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1144–45 (8th Cir. 2015).

7. *Id.* at 1141.

8. Rebecca Tushnet, *8th Circuit Dismisses Right of Publicity Claim as Copyright Preempted*, REBECCA TUSHNET’S 43(B)LOG (Apr. 23, 2015, 3:45 PM), <http://tushnet.blogspot.com/2015/04/8th-circuit-dismisses-right-of.html> [<http://perma.cc/6DXF-EEXR>].

9. Riccard, *supra* note 4, at 430 (identifying the need for clarity in the copyright-preemption debate).

10. See MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT VOLUME 1* § 1.01(B)(3)(b)(iv)(I)–(II) (2013); see also Bryant, *supra* note 3, at 18 (“Professor Nimmer proposes a two-part test for analyzing cases where copyright, the right of publicity, and contract law intersect.”).

11. See Riccard, *supra* note 4, at 442 (identifying opposing outcomes of cases within both the Fifth Circuit and the Ninth Circuit).

of individuals in their own identities.¹² Part III will examine the current challenges facing courts in interpreting, analyzing, and applying the jurisdictional differences of state right of publicity laws as they vary from region to region. Part IV of this Comment will describe the development of current federal copyright law after the establishment of the Copyright Act of 1976. Part V will examine the history and interaction of federal copyright law with state right of publicity laws in federal courts. Lastly, Part VI will describe Professor Nimmer's current copyright preemption framework along with its shortcomings and Part VII will propose a modified version of this framework as a solution to the Eighth Circuit's shortcomings in *Ray v. ESPN, Inc.* Ultimately, this Comment will propose the use of a modified version of Nimmer's framework and test to help resolve copyright preemption disputes.

II. THE DEVELOPMENT OF THE RIGHT OF PUBLICITY

The right of publicity traces its origins to the right of privacy.¹³ The right of privacy was first postulated in the United States in Samuel D. Warren and future United States Supreme Court Justice Louis D. Brandeis's 1890 Harvard Law Review article, *The Right to Privacy*, as the "right to be let alone."¹⁴ This right sought to protect the private affairs of individuals from becoming open and public.¹⁵ It additionally sought to protect all persons from unwarranted public disclosure of matters they would prefer to keep private.¹⁶ However, Warren and Brandeis noted that there were certain persons, namely political figures, who may have in varying degrees renounced their right to live "screened from public observation."¹⁷

12. *Balt. Orioles, Inc. v. MLB Players Ass'n*, 805 F.2d 663, 678–79 (7th Cir. 1986) (citing generally *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977)).

13. Alex J. Berger, Note, *Righting the Wrong of Publicity: A Novel Proposal for a Uniform Federal Right of Publicity Statute*, 66 HASTINGS L.J. 845, 849 (2015); see also Justin B. Bryant, Article, *Applying the Lessons from Dryer v. NFL: Forming a Workable Framework for Analyzing the Right of Publicity in Professional Sports*, 22 SPORTS LAW. J. 1, 3 (2015).

14. See Samuel D. Warren & Louis D. Brandeis, *The Right of Privacy*, 4 HARV. L. REV. 193, 197 (1890); see also Berger, *supra* note 13; Bryant, *supra* note 13.

15. Warren & Brandeis, *supra* note 14, at 214–15.

16. *Id.*; Berger, *supra* note 13.

17. Warren & Brandeis, *supra* note 14, at 215.

In 1960, William Prosser laid the framework for what would become the modern right of publicity in his article, *Privacy*.¹⁸ Prosser observed that the law of privacy was comprised of four different types of tort invasions that each fundamentally interfered with a person's right "to be let alone."¹⁹ These four tort invasions of privacy were: intrusion upon a person's privacy, public disclosure of "embarrassing private facts," placing a person in a false light in the public eye, and misappropriation of a person's name or likeness for the advantage of another.²⁰ The modern right of publicity derives from the fourth tort of misappropriation of a person's name or likeness for the advantage of another.²¹ In discussing the tort of misappropriation of name or likeness, Prosser noted that at that point in time, there were a large number of cases in many states where plaintiffs were able to recover when other persons used their names or likenesses without their consent for advertisements and other business purposes and had benefitted from such use.²² However, certain states limited the scope of their misappropriation statutes to unauthorized uses for advertising or "purposes of trade" and were therefore narrower in scope than their common law counterparts in other states.²³ Notably, Prosser distinguished the misappropriation of a person's name or likeness for the advantage of another from the other three tort invasions of privacy because the interest protected was not a mental one, but an economic interest in the exclusive use of a person's name or likeness as an aspect of that person's identity.²⁴

Case law developed simultaneously, thereby laying the foundation for modern judicial scrutiny and analysis of the right of publicity.²⁵ In *O'Brien*

18. William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960); *see also* Berger, *supra* note 13; Bryant, *supra* note 13, at 3–4.

19. Prosser, *supra* note 18; *see also* Bryant, *supra* note 13.

20. Prosser, *supra* note 18; *see also* Bryant, *supra* note 13.

21. Bryant, *supra* note 13, at 4; *see also* Berger, *supra* note 13.

22. Prosser, *supra* note 18, at 401–02.

23. *Id.* at 402–03 (discussing the statute in New York and similar statutes modeled after it).

24. *Id.* at 406; *see also* Bryant, *supra* note 13, at 4.

25. *See O'Brien v. Pabst Sales Co.*, 124 F.2d 167, 167 (5th Cir. 1941); *see* Bryant, *supra* note 13, at 4–5 ("Also helping to pave the way for a judicially recognized right of publicity was the case of *O'Brien v. Pabst Sales Co.*").

v. Pabst Sales Co., the former collegiate and professional football player, Davey O'Brien, claimed that the defendant's use of a picture of him in his football uniform in a calendar was an invasion of his privacy rights.²⁶ The Fifth Circuit held in favor of the defendant, determining that the plaintiff was a public figure, had posed for the original photo specifically intending to receive publicity, and that the photo's subsequent use in the calendar with the permission of the photo's owner did not create the impression that the plaintiff endorsed or recommended the defendant's beer.²⁷

The United States Court of Appeals for the Second Circuit would later coin the term "right of publicity" for the first time in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*²⁸ There, plaintiff Haelan Laboratories contracted with a baseball player for the exclusive right to use his photograph for the purposes of selling gum for a stated term.²⁹ The contract stipulated that the baseball player could not grant a similar right to any other gum manufacturer during that term, and also provided Haelan Laboratories the option to extend the exclusive use term for a designated period.³⁰ Aware of this contract, Topps Chewing Gum then induced the same baseball player to enter into a similar contract.³¹ The Second Circuit held in favor of the plaintiff, recognizing a right of publicity that was separate and independent from the right of privacy.³² This separate right of publicity was a pecuniary right based on the principle that a person could

26. *O'Brien*, 124 F.2d at 168; see Bryant, *supra* note 13, at 4–5 (discussing the facts and holding of *O'Brien v. Pabst Sales, Co.*).

27. *O'Brien*, 124 F.2d at 170; see also Bryant, *supra* note 13, at 4–5 (discussing the facts and holding of *O'Brien v. Pabst Sales, Co.*).

28. See *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) ("This right might be called a 'right of publicity.'"); Berger, *supra* note 13 ("The actual term 'right of publicity' first appeared in the case of *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* in 1953."); see also Bryant, *supra* note 13, at 5 ("*Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* was the first federal case to recognize a stand-alone right of publicity.").

29. *Haelan Labs., Inc.*, 202 F.2d at 867.

30. *Id.*

31. *Id.*

32. *Id.* at 868.

detach and convey his or her likeness to another, similar to a property right.³³

It was not until 1977 in *Zacchini v. Scripps-Howard Broadcasting Co.* that the United States Supreme Court weighed in on the issue of the right of publicity.³⁴ There, a television reporter attended a fair and recorded the entire performance of a fair entertainer against the entertainer's wishes and despite the entertainer's instruction to the reporter not to do so.³⁵ That recording was later broadcasted on the television station's evening program.³⁶ Holding that the Constitution did not conflict with state right of publicity laws,³⁷ the Supreme Court noted that the purpose of the state right of publicity was to protect the pecuniary and discretionary interests of performers in their acts and analogized the right to the purposes of patent and copyright law.³⁸ Further focusing on the commercial aspect of the right of publicity, the Supreme Court noted that much of the economic value of a performance lay in the performer's "right of exclusive control over the publicity given to his performance."³⁹ The Supreme Court's rationale for protecting the state right of publicity also lay in preventing the unauthorized use of a performer's performance for the unjust enrichment of another.⁴⁰ Moreover, the Supreme Court noted that protecting performers'

33. *Id.* ("[A] man has . . . the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made . . . without any accompanying transfer of a business or of anything else."); Bryant, *supra* note 13, at 5 ("The [Second Circuit] concluded that individuals have a property right in their identities that is capable of being legally separated from them.").

34. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 562 (1977); *see* Berger, *supra* note 13, at 850 ("The Supreme Court first considered the right of publicity in 1977, in *Zacchini v. Scripps-Howard Broadcasting Company.*"); Bryant, *supra* note 13, at 5 ("The only United States Supreme Court case to address the right of publicity was *Zacchini v. Scripps-Howard Broadcasting Co.*").

35. *Zacchini*, 433 U.S. at 563–64.

36. *Id.* at 564.

37. *Id.* at 577–79 ("The Constitution does not prevent Ohio from . . . deciding to protect the entertainer's incentive in order to encourage the production of this type of work.").

38. *Id.* at 573.

39. *Id.* at 575 ("The rationale for protecting the right of publicity is the straight forward one of preventing unjust enrichment by the theft of good will.").

40. *Zacchini*, 433 U.S. at 576; Kristen E. Riccard, Comment, *Product Placement or Pure Entertainment? Critiquing a Copyright-Preemption Proposal*, 59 AM. U. L. REV. 427, 437 (2009)

state rights of publicity served the additional goal of providing economic incentives for performers to continue to “make the investment required to produce a performance of interest to the public” and likened the right to the considerations behind federal patent and copyright laws.⁴¹ While recognizing the validity of state right of publicity claims,⁴² the Supreme Court in *Zacchini* ultimately failed to put forth any definitive standard or test for courts to follow in conducting a right of publicity analysis.⁴³ Instead, and perhaps tellingly, the Supreme Court reached its conclusion simply by likening the underlying goal and policy of the state right of publicity to federal patent and copyright law.⁴⁴

III. THE RIGHT OF PUBLICITY TODAY

Today, the right of publicity has become widely recognized and accepted, manifesting in over half of all states through enacted state legislation, common law, or both.⁴⁵ Functionally, the right of publicity allows an individual the means to protect against the unauthorized commercial use of his or her likeness or identity by another.⁴⁶ Because the

(observing that the goal of the Supreme Court in protecting the right of publicity was to prevent a person from benefiting from the unauthorized use of another’s identity).

41. *Zacchini*, 433 U.S. at 576; *see also* Berger, *supra* note 13, at 850 (“The Court held that ‘the protection provides an economic incentive for [the performer] to make the investment required to produce a performance of interest to the public.’”); Riccard, *supra* note 40, at 437–38 (“[T]he Court also noted other justifications for this state right, including the need to encourage celebrities to invest time and money to make their performances interesting to the public.”).

42. *Zacchini*, 433 U.S. at 577–79 (finding that neither the First nor the Fourteenth Amendments barred states from protecting rights of publicity).

43. Bryant, *supra* note 13, at 5.

44. *Id.* at 5–6; *see Zacchini*, 433 U.S. at 576 (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’”).

45. *See* Alex J. Berger, Note, *Righting the Wrong of Publicity: A Novel Proposal for a Uniform Federal Right of Publicity Statute*, 66 HASTINGS L.J. 845, 851 (2015) (“[T]he right of publicity has rapidly spread throughout the country, taking on various forms in state statutes and case law. As of 2010, thirty-one states recognize the right of publicity—eleven exclusively through statute, twelve through the common law, and eight through a combination of the two.”).

46. Justin B. Bryant, Article, *Applying the Lessons from Dryer v. NFL: Forming a Workable Framework for Analyzing the Right of Publicity in Professional Sports*, 22 SPORTS

right of publicity concerns an individual's exclusive right to control the use of his or her own likeness or identity for economic benefit, it is a separate and distinct right from the right of privacy.⁴⁷ It is perhaps most often utilized by prominent public figures and celebrities in claims attempting to prevent the use of their likeness or image for the purpose of advertisements.⁴⁸

However, the right of publicity's origins independent development in state common law, and the lack of a codified federal right of publicity statute has resulted in right of publicity laws with elements that vary from jurisdiction to jurisdiction.⁴⁹ Additional disagreement and inconsistency between jurisdictions arises from conflicting statutory and common law right of publicity laws, even within the same states.⁵⁰ The differing right of publicity laws creates unnecessary and burdensome issues in litigation for both the courts and the litigating parties involved.⁵¹ This variance from state to state leaves federal courts with the odious task of interpreting the different jurisdictional right of publicity laws, "often in relation to a single party in a single action."⁵²

The problems that arise from inconsistencies in the laws is demonstrated in comparing courts' application of right of publicity laws. The Ninth Circuit has applied the common law right of publicity with a wide brush to include works that merely "evoke" a celebrity's persona without the misuse of any tangible aspects of his or her identity.⁵³ In contrast, the Second Circuit's analysis is based on the trademark regulating

LAW. J. 1, 3 (2015); Kristen E. Riccard, Comment, *Product Placement or Pure Entertainment? Critiquing a Copyright-Preemption Proposal*, 59 AM. U. L. REV. 427, 436 (2009).

47. Riccard, *supra* note 46.

48. *Id.* at 437.

49. Bryant, *supra* note 46, at 6.

50. Berger, *supra* note 45, at 859–60.

51. *Id.* at 859 ("Because the right of publicity differs from state to state, federal courts are commonly burdened with interpreting different state laws, often in relation to a single party in a single action.").

52. *Id.* (discussing the current state of the right of publicity).

53. *Id.* at 846–47 (referencing *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992)).

Lanham Act,⁵⁴ requiring the specific use of another's likeness for the endorsement of products to sustain a right of publicity claim.⁵⁵

Still, state right of publicity claims are becoming more common in courts.⁵⁶ Right of publicity claims in professional and broadcast sports are of specific relevance to this article.⁵⁷ This is an especially problematic issue given the seemingly unavoidable conflict between most state right of publicity laws and federal copyright laws.⁵⁸ The most common situation for this conflict to occur is when a celebrity or athlete whose likeness or image is attached to a copyrighted work wishes to prevent the copyright owner from using the work in some unapproved manner.⁵⁹ Thus, while state right of publicity laws play an important role in enabling individuals to protect their commercial and discretionary interests in their own likeness and image, they often directly conflict with the federally-backed right of copyright owners to exercise their exclusive rights to control their copyrighted works.⁶⁰

IV. FEDERAL COPYRIGHT LAW

The basis for copyright protection is stated in Article I, Section 8 of the United States Constitution: “[t]o promote the progress of science and useful arts, by securing, for limited times to authors and inventors, the

54. *Id.* at 847 (referring to New York state courts and *Groden v. Random House, Inc.*, 61 F.3d 1045, 1049 (2d Cir. 1995)). *See generally* 15 U.S.C. § 1125 (2012).

55. Berger, *supra* note 45, at 847 (“[C]ommonly reject claims in which the defendant has not used the celebrity’s likeness to endorse a specific product and sustain claims where the defendant used the likeness for ‘blatant selfish commercial exploitation.’”).

56. *See Riccard, supra* note 46, at 438 (“Courts’ willingness to uphold a right of publicity claim is on the rise.”).

57. *E.g.*, *Ray v. ESPN, Inc.*, 783 F.3d 1140 (8th Cir. 2015); *Dryer v. NFL*, 55 F. Supp. 3d 1181 (D. Minn. 2014); *Balt. Orioles, Inc. v. MLB Players Ass’n*, 805 F.2d 663 (7th Cir. 1986); *see also Bryant, supra* note 46, at 6 (discussing the right of publicity challenges that have arisen in the arena of fantasy sports and professional baseball).

58. Berger, *supra* note 45, at 847 (“This uncertainty is further complicated because most statutory and common law right of publicity laws conflict with existing copyright law.”).

59. Riccard, *supra* note 46, at 439.

60. *Id.* at 439–40.

exclusive right to their respective writings and discoveries.”⁶¹ This Section of the Constitution, known as the Copyright and Patent Clause, reflects the drafters’ understanding of the need to incentivize the investment of time and effort in creating “science and useful arts.”⁶² However, this policy of incentives was not the main reason for establishing copyright protection.⁶³ The underlying rationale was that by incentivizing people to create new works of art and science, they would directly advance and improve public welfare through their innovative contributions to society.⁶⁴ This underlying rationale remains the driving logic in modern federal statutory copyright law by way of continuing the policy of economically incentivizing creations and copyright ownership.⁶⁵

The Federal Copyright Act of 1976 (“Copyright Act”) is codified in 17 U.S.C. §§ 101–1331.⁶⁶ At the fundamental level, the Copyright Act protects the property interests of copyright holders in retaining ownership

61. U.S. CONST. art. I, § 8, cl. 8; *see also* Joseph P. Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976*, 10 VAND. J. ENT. & TECH. L. 1, 11 (2007).

62. *See* Bauer, *supra* note 61 (“[A]ccording certain exclusive rights to authors . . . is a necessary and appropriate incentive to, and reward for, the creation of literary and artistic works.”); *see also* Kristen E. Riccard, Comment, *Product Placement or Pure Entertainment? Critiquing a Copyright-Preemption Proposal*, 59 AM. U. L. REV. 427, 432 (2009) (“However, Congress recognized the need to provide some reward to creators, authors, and producers in exchange for their investment in order to encourage individuals to spend time and money producing original works for public access.”).

63. *See* Feist Pubs., Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 349 (1991) (“The primary objective of copyright is not to reward the labor of authors, but ‘[t]o promote the Progress of Science and useful Arts.’”).

64. *See* Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 576 (1977) (“The economic philosophy behind the clause empowering Congress to grant patents and copyright is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’ Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.”) (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)); *see also* Bauer, *supra* note 61 (“However, it is important to bear in mind that the real beneficiary of copyright protection is the public, because the quality and quantity of society’s cultural resources are increased.”).

65. *See* Zacchini, 433 U.S. at 576 (“This same consideration underlies the patent and copyright laws long enforced by this Court.”).

66. *See generally* Copyrights, 17 U.S.C. §§ 101–1332 (2012).

of qualifying works.⁶⁷ The origins of this protected interest trace back to Article I, Section 8 of the Constitution, as it is based on the same kind of incentives first put forth in the Copyright and Patent Clause.⁶⁸ The Copyright Act establishes the parameters of what the subject matter of copyright encompasses⁶⁹ and outlines the exclusive rights that copyright owners have in their property.⁷⁰ The incentives inherent in the protection of these rights allow copyright owners the freedom to capitalize on their ownership interests, thereby giving economic value to their rights as copyright holders.⁷¹ This is consistent with the framework put forth by the founders in Article I, Section 8 of the Constitution.⁷² However, these underlying copyright principles, as the Supreme Court noted in *Zacchini v. Scripps-Howard Broadcasting Co.*, are similar to and often overlap with the underlying principles of the right of publicity.⁷³

When Congress enacted the Copyright Act, it replaced the dual state and federal copyright system under the Copyright Act of 1909 with a single unified federal copyright law framework.⁷⁴ Under the prior Copyright Act of 1909, both state and federal copyright protection existed simultaneously.⁷⁵ However, the protection was layered with federal copyright law, requiring works to be published before qualifying for federal copyright protection.⁷⁶ Without publication, a work could only be

67. See Bauer, *supra* note 61, at 11–12 (characterizing the qualifying works as “intellectual property”).

68. U.S. CONST. art. I, § 8, cl. 8; see also Bauer, *supra* note 61.

69. See generally 17 U.S.C. §§ 102–103 (outlining the eight categories of original works of authorship, as well as compilations and derivative works).

70. See generally 17 U.S.C. § 106 (granting copyright owners exclusive rights).

71. See Riccard, *supra* note 62, at 433 (“This control creates a system of economic rewards for copyright owners because they can charge others for access to, and use of, the work.”).

72. U.S. CONST. art. I, § 8, cl. 8; see also Bauer, *supra* note 61.

73. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977).

74. See generally Bauer, *supra* note 61.

75. *Id.* at 6.

76. *Id.*

protected under state copyright common law.⁷⁷ Furthering the inconsistencies, once a work achieved publication and obtained federal copyright protection, that federal protection required renewal after a term of years with an eventual expiration date, thereby returning the work to the public domain.⁷⁸ By contrast, common law copyright protection of unpublished works had no such expiration date, meaning an author or creator could, in effect, achieve eternal copyright protection by simply not publishing his or her work.⁷⁹

With the enactment of the Copyright Act of 1976, which included the preemption doctrine provided by section 301,⁸⁰ the dual state and federal system of copyright protection was replaced and copyright law was unified under the new federal statute.⁸¹ To achieve this uniformity, the drafters included section 301, which expressly preempted all prior existing state copyright laws, consequently establishing the Copyright Act as the sole controlling law.⁸² However, the language of section 301 extends not just to the preemption of prior state copyright laws, but all state law rights that are found to be equivalent to any of the rights codified under the new Copyright Act.⁸³ This express preemption of other incompatible state law rights beyond common law copyright was the result of the drafters' attempt to construct a copyright law framework that provided for the protection of

77. *See id.*

78. *Id.* at 7 (Following the initial 28 year term, works could be renewed for an additional 28 years after which federal copyright protection expired.).

79. Bauer, *supra* note 61, at 7.

80. *Id.* at 7–8.

81. *Id.* at 23–27 (discussing the alternative state and federal copyright system under the Copyright Act of 1909 and the benefits of a single federal regime).

82. *Id.* at 7–8; *see generally* 17 U.S.C. § 301 (2012) (“On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.”).

83. Bauer, *supra* note 61, at 7–8 (discussing that the extension of the preemption provision reaches even additional state rights).

certain works.⁸⁴ This reflected the drafters' concerted effort to move forward in favor of a unified, single federal system.⁸⁵

The drafters offered four main arguments for favoring a single federal system: (1) the importance of national uniformity and avoiding the "practical difficulties" of having to navigate under differing laws and "in the separate courts of the various States"; (2) the increasing obsolescence of publications in the developing digital world; (3) the implementation of the "limited times" provision of the Constitution; and (4) the "[a]doption of a uniform national [standard] would greatly improve international dealings in copyrighted materials."⁸⁶ While the enactment of the Copyright Act may have achieved the drafters' broader goal of discarding state common law copyright law and establishing a uniform federal copyright law system, section 301 has failed to achieve that goal in the context of preemption and state law right of publicity claims.⁸⁷

V. STATE RIGHT OF PUBLICITY CLAIMS AND THE DEVELOPMENT OF FEDERAL COPYRIGHT ACT PREEMPTION ANALYSIS

According to its drafters, the goal of section 301 of the Copyright Act was to achieve uniformity by federalizing copyright law and affording consistent interpretation of the preemption provisions.⁸⁸ The drafters' assertions that section 301 would achieve uniformity and consistency has proven to be incorrect.⁸⁹ Since its enactment, scholars have noted that the volume of cases in which both federal and state courts have had to interpret the statutory provision, coupled with the high number of appellate decisions that have overruled lower courts, is a clear indication that neither

84. *Id.* at 8.

85. *Id.*

86. *Id.* at 8–9 (citing H.R. REP. NO. 94-1476, at 129–30 (1976)).

87. See Riccard, *supra* note 62, at 429–30; see also Bauer, *supra* note 61, at 3–4 ("The uncertainty about the scope of preemption is highlighted . . . by the fact that, in particular, the appellate decisions have not infrequently overruled the trial court's conclusion on preemption, and/or have contained concurring and dissenting opinions on this supposedly 'clear' issue.").

88. Joseph P. Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976*, 10 VAND. J. ENT. & TECH. L. 1, 7–9 (2007) (discussing the legislative history of section 301 of 1979).

89. *Id.* at 3 (discussing the legislative history of section 301).

uniformity nor consistent interpretation has been achieved.⁹⁰ This Comment, however, will narrow the focus of its analysis to copyright preemption and state law right of publicity claims as they are relevant to the Eighth Circuit's decision in *Ray v. ESPN, Inc.*

Administratively, the current state of confusion and inconsistency in court analysis of state law right of publicity claims⁹¹ reflects the difficulties that the drafters of section 301 hoped to remove by creating a uniform federalized system.⁹² Indeed, the first of the four offered arguments put forth by the drafters for the development of section 301 was “promot[ing] national uniformity and . . . avoid[ing] the difficulties of determining and enforcing an author's rights under the differing laws and in the separate courts of the various States.”⁹³ The inconsistency between common law and statutory right of publicity laws presents a major obstacle for courts and parties trying to interpret different jurisdictional laws independent of the additional issue of copyright preemption under section 301(a) of the Copyright Act.⁹⁴

Statutory preemption analysis begins with section 301(a) of the Copyright Act, which contains the two requirements that must be met for preemption of a state law claim.⁹⁵ The first prong of section 301(a) requires that the work at issue be “fixed in a tangible medium of expression” and fall within the subject matter or scope of copyright

90. *Id.* at 3–4.

91. Alex J. Berger, Note, *Righting the Wrong of Publicity: A Novel Proposal for a Uniform Federal Right of Publicity Statute*, 66 HASTINGS L.J. 845, 859–60 (2015) (discussing the litany of issues facing both courts and would-be litigants, and the confusion and inconsistency stemming from conflicting statutory and common law rights of publicity).

92. *See* Bauer, *supra* note 88, at 8–9 (citing H.R. REP. NO. 94-1476, at 130 (1976)).

93. *Id.* at 8 (citing H.R. REP. NO. 94-1476, at 130 (1976)).

94. *See* Berger, *supra* note 91, at 860.

95. *See* 17 U.S.C. § 301(a) (2012) (“On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.”).

protection.⁹⁶ The second prong of section 301(a) requires that the state law right barred be “equivalent to any of the exclusive rights within the general scope of copyright as specified in § 106 [of the Copyright Act].”⁹⁷ Section 301 then lists limitations to its own reach and identifies the types of claims outside of its preemptive powers.⁹⁸ Prior to the enactment of the current provision, an earlier draft of section 301 explicitly listed various state laws and rights that would not be preempted by the Copyright Act.⁹⁹ The unfortunate removal of this list prior to enactment has been a source of additional confusion in the preemption and right of publicity discourse as courts have tried to glean Congress’s intentions for removing it as guidance, inevitably resulting in inconsistent applications.¹⁰⁰

A. Federal Copyright Equivalency and Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n

Congress has failed to issue any clear guidance on when federal copyright preemption of state claims should or should not occur and the Supreme Court has remained silent on the matter, effectively guaranteeing inconsistent treatment and analysis.¹⁰¹ As a result, the intersection of federal copyright preemption and state law right of publicity claims has

96. *Id.*; see also *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1142 (8th Cir. 2015) (“(1) [T]he work at issue is within the subject matter of copyright as defined in §§ 102 and 103 of the Copyright Act . . .”) (citing *Nat’l Car Rental Sys., Inc. v. Comput. Assocs. Int’l, Inc.*, 991 F.2d 426, 428 (8th Cir. 1993)); Bauer, *supra* note 88, at 16 (deconstructing the prong into two separate elements).

97. See *Ray*, 783 F.3d at 1143 (“(2) [T]he state law created right is equivalent to any of the exclusive rights within the general scope of copyright as specified in § 106.”) (citing *Nat’l Car Rental Sys., Inc. v. Comput. Assocs. Int’l, Inc.*, 991 F.2d 426, 428 (8th Cir. 1993)); Bauer, *supra* note 88, at 16 (further deconstructing the prong into two separate elements).

98. 17 U.S.C. § 301.

99. Kristen E. Riccard, Comment, *Product Placement or Pure Entertainment? Critiquing a Copyright-Preemption Proposal*, 59 AM. U. L. REV. 427, 441 (2009) (referencing H.R. REP. NO. 94-1476, at 24 (1976)).

100. *Id.* at 441–42 (referencing Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 234–35 (2002)).

101. See Bauer, *supra* note 88, at 5 (“These considerations, coupled with the significant divergence of results that one would expect from courts in fifty different jurisdictions and the lamentable fact that the Supreme Court has never heard a case under § 301, either from a state or a federal court, only contribute to the problem.”); Riccard, *supra* note 99, at 442–43.

been a particularly challenging issue for courts.¹⁰² The Seventh Circuit's opinion in *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n* has emerged as an important and controversial decision over the years.¹⁰³ There, three professional baseball players filed suit against the Baltimore Orioles, asserting that television broadcasts of games violated their rights of publicity.¹⁰⁴ This action followed a long-standing disagreement between the Major League Baseball Players Association and the Major League Baseball Clubs regarding the ownership of broadcast rights of the baseball players' performances during games.¹⁰⁵ In its opinion, the Seventh Circuit determined that section 301(a) of the Copyright Act preempted the state law right of publicity claims raised by the players.¹⁰⁶ The court concluded that because the players' performances were recorded during the telecasts, their performances were fixed in a tangible form of a copyrightable work, thereby satisfying the first prong of the preemption test.¹⁰⁷ As to the second prong, the court found that the players' asserted rights of publicity were equivalent to the right to "perform" an audiovisual work, which falls within the scope of copyright.¹⁰⁸ The court went on to determine that the underlying purposes of both federal copyright protection and the right of publicity were the same—to promote works that benefit the public by providing incentives.¹⁰⁹ Scholars have noted the Seventh Circuit's problematic interpretation of finding preemption equivalence from the similar purposes of both federal and state laws rather than establishing that

102. See Bauer, *supra* note 88, at 71 ("Courts have had substantial difficulty wrestling with the proper scope of the preemption of a state right of publicity claim.").

103. *Id.*; see Robert J. Bernstein & Robert W. Clarida, *Copyright Law; Does Copyright Preempt the Right of Publicity?*, N.Y. L.J. (ONLINE), Mar. 18, 2005, LEXIS; Schuyler Moore, *Keeping Copyright Preemption on Track*, L.J. NEWSLETTERS (Entm't Law & Fin. Newsletter), Aug. 1, 2012, at 5.

104. *Balt. Orioles, Inc. v. MLB Players Ass'n*, 805 F.2d 663, 666 (7th Cir. 1986).

105. *Id.* at 665.

106. *Id.* at 674.

107. *Id.* at 674–75.

108. *Id.* at 677.

109. *Balt. Orioles, Inc.*, 805 F.2d at 679 (dismissing the players' argument that the right of publicity is not equivalent to the rights in section 106 because the right of publicity and copyrights serve different interests); see also Bauer, *supra* note 88, at 72.

the underlying goals of the laws are not required elements necessary to establish equivalence under section 301.¹¹⁰ Despite this confusing application, *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n* has served as an important yet controversial precedent in determining that many right of publicity claims should be preempted under section 301 because they are sufficiently equivalent to one of the rights of copyright holders as listed in section 106.¹¹¹

B. Influence of Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n on Ray v. ESPN, Inc.

The Eighth Circuit's opinion in *Ray v. ESPN, Inc.* alluded to the holding in *Baltimore Orioles, Inc.*¹¹² In *Ray*, the plaintiff cited to the Fifth Circuit case of *Brown v. Ames* in support of his argument that the true "focal point" of his claim was not the re-broadcast of the video recordings, but rather ESPN's alleged use of his "likeness;" therefore his claim was not within the subject matter reach of the Copyright Act,¹¹³ a requirement for preemption under the first prong of section 301.¹¹⁴ The Eighth Circuit rejected the plaintiff's comparison to *Brown* on the grounds that the *Brown* defendants were distinguishable because they used plaintiffs' likenesses and names of the plaintiffs to sell CD's, cassettes, and other music paraphernalia, despite not having received permission from the plaintiffs or possessed valid copyrights.¹¹⁵ The Eighth Circuit further commented:

Notably, the court in *Brown* specifically distinguished *Baltimore Orioles*—and in so doing, distinguished this case as well—on the grounds that 'the right of publicity claimed' by the plaintiffs in *Baltimore Orioles*

110. Bauer, *supra* note 88, at 71–72.

111. *Id.* at 72; *see Balt. Orioles, Inc.*, 805 F.2d at 677; *see also* Bernstein & Clarida, *supra* note 103; Moore, *supra* note 103.

112. *See Ray v. ESPN, Inc.*, 783 F.3d 1140, 1143 (8th Cir. 2015) (opining that the Fifth Circuit in *Brown v. Ames*, 201 F.3d 654 (5th Cir. 2000) distinguished *Brown* from *Baltimore Orioles, Inc.* and therefore *Ray* as well).

113. *Id.*

114. *See* 17 U.S.C. § 301(a) (2012).

115. *Ray*, 783 F.3d at 1143; *see Brown*, 201 F.3d at 656–57.

‘was essentially a right to prevent rebroadcast of games whose broadcast rights were already owned by’ other parties.¹¹⁶

In finding the *Brown* case factually distinguishable, the Eighth Circuit properly drew parallels between the facts in *Baltimore Orioles* and the facts in *Ray v. ESPN, Inc.* and effectively adopted the Seventh Circuit’s reasoning from *Baltimore Orioles*.¹¹⁷ Like *Baltimore Orioles*, *Ray* involved a professional athlete that contracted with a governing sports institution to perform in filmed and televised sports matches for pecuniary gain.¹¹⁸ However, the Eighth Circuit in *Ray* failed to address the *Brown* court’s concern about the precedent set in *Baltimore Orioles*: “*Baltimore Orioles* . . . has been heavily criticized for holding that a baseball game is a protectable work of authorship simply because the performance was recorded on videotape that was itself copyrightable.”¹¹⁹

The Fifth Circuit in *Brown* ultimately declined to find an individual’s likeness copyrightable “simply because it was embodied in a copyrighted work.”¹²⁰ By contrast, the Eighth Circuit in *Ray* concluded that the use of an individual’s likeness is indeed copyrightable if used with that individual’s permission for economic or commercial purpose or if that likeness is not detachable from the copyrighted performance contained in a work.¹²¹ Mirroring the reasoning in *Baltimore Orioles*, the Eighth Circuit found that individual performances are copyrightable so long as they are fixed in tangible form.¹²² However, despite the correct outcome, the

116. *Ray*, 783 F.3d at 1143.

117. *See id.*

118. *Id.* at 1141; *see also* *Ray v. ESPN, Inc.*, No. 13-1179-CV-W-SOW, 2014 WL 2766187, at *1–2 (W.D. Mo. Apr. 8, 2014).

119. *Brown*, 201 F.3d at 659.

120. *Id.*; *see also* *Bernstein & Clarida*, *supra* note 103 (“We decline appellants’ invitation to find name or likeness copyrightable simply because they are placed on CD’s and tapes or in catalogs that have copyrightable subject matter recorded on them.”).

121. *See Ray*, 783 F.3d at 1144 (“ESPN did not use Ray’s likeness or name in an advertisement without his permission to promote its commercial products, and, as the district court correctly noted, Ray’s ‘likeness could not be detached from the copyrighted performances that were contained in the film.’”).

122. *Id.* (accepting the District Court’s analysis); *see* *Balt. Orioles, Inc. v. MLB Ass’n*, 805 F.2d 663, 674–75 (concluding that once a performance is recorded, it becomes fixed in tangible form and thus is subject to federal copyright preemption).

problem in the Eighth Circuit's reasoning lies in the distinction between the use of the work for commercial versus non-commercial purposes.¹²³ This distinction is problematic because, as the Supreme Court noted, the economic incentives from which both copyright law and the right of publicity derive are similar.¹²⁴ As will later be explored, the inclusion of this "commercial purpose" element is flawed because its addition does not necessitate removing equivalency from the state right in question and rights protected by the Copyright Act.¹²⁵ If those rights are still equivalent, then statutory preemption of the state right under federal copyright law must occur.¹²⁶

Additionally, the Eighth Circuit overlooked an important fact in *Ray* and subsequently missed an opportunity to explore and develop a question that was left open by *Baltimore Orioles*: signed express waivers of athletes' rights of publicity.¹²⁷ The Eighth Circuit and the district court both noted that when the plaintiff in *Ray* contracted to perform recorded and televised wrestling matches, he did so with the express knowledge and understanding that the matches would be filmed and sold for future use to "generate revenue."¹²⁸ The Eighth Circuit mentioned the issue of permission, but

123. See *Ray*, 783 F.3d at 1144 ("ESPN did not use Ray's likeness or name in an advertisement without his permission to promote its commercial products, and, as the district court correctly noted, Ray's 'likeness could not be detached from the copyrighted performances that were contained in the film.'").

124. See generally *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) (opining that the protection of performers' rights of publicity provides economic incentive for performers to continue to make the investments required to produce performances of interest to the public, the same consideration that underlies patent and copyright laws).

125. See *Bauer*, supra note 88, at 74–75 (reasoning that in a right of publicity action, the added element of commercial purpose does not necessarily "give rise to a claim that is not 'equivalent' to the rights conferred on the copyright owner[s] by § 106.").

126. See 17 U.S.C. § 301(a) (2012).

127. See *Balt. Orioles, Inc.*, 805 F.2d at 674 ("[T]he Players claim that broadcasts of these games made without their *express consent* violate their rights to publicity in their performances.") (emphasis added); see also Robert E. Freeman & Erica H. Esposito, *An Update on Athlete Publicity Rights in Sports Broadcasts*, LAW360 (July 27, 2015, 2:11 PM), <http://www.law360.com/articles/678990/an-update-on-athlete-publicity-rights-in-sports-broadcasts> [<http://perma.cc/VN2T-H6BH>] ("As similar cases unfold it will be interesting to see what effect, if any, signed releases of the athlete's right of publicity have on the courts' decisions and their copyright preemption analyses.").

128. *Ray*, 783 F.3d at 1141 ("Ray specifically agreed with a representative of the UWF that the films would be 'sold and used.'"); see *Ray v. ESPN, Inc.*, No. 13-1179-CV-W-SOW,

only as it relates to the additional commercial element.¹²⁹ Additionally, the court cited to the leading copyright treatise, *Nimmer on Copyright*, to discuss the implied waiver framework.¹³⁰ However, by not further exploring the significance and impact of an expressly signed waiver of the right of publicity, the Eighth Circuit missed an opportunity to further refine the analytical framework of how courts approach a state right of publicity law and federal copyright preemption issue, particularly in the arena of professional sports where such express signed waivers are common.¹³¹

C. Meaningful Additional Elements and Downing v. Abercrombie & Fitch

Courts have found some small measure of agreement in their findings that federal copyright should not preempt state law right of publicity claims in cases involving the use of an individual's likeness without permission in advertisements for commercial gain.¹³² *Downing v. Abercrombie & Fitch* illustrates this situation.¹³³ There, the work in question was a photograph containing an image of the plaintiffs at a surf competition in 1965.¹³⁴ Abercrombie purchased the photograph directly from the photographer and then published the photograph in its catalog as part of a broad, surf-themed

2014 WL 2766187, at *1 (W.D. Mo. Apr. 8, 2014) (“[Ray] entered into a series of contracts . . . and each match was filmed for future use in order to generate revenue.”).

129. *Ray*, 783 F.3d at 1144.

130. *Id.* (explaining in a parenthetical that when a performer collaborates in creating a copyrighted work, he or she may not then try to use the right of publicity to prevent the use of the copyrighted work for its intended purpose).

131. *See id.*

132. *See Bauer, supra* note 88, at 72 (“A comparably straightforward situation for finding that a right of publicity claim was *not* preempted is presented by a case like *Downing v. Abercrombie & Fitch*.”). *See generally* *Toney v. L’Oreal USA, Inc.*, 406 F.3d 905 (7th Cir. 2005) (involving the continued use of a model’s photograph and likeness to sell hair care products after the initial license expired); *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001) (involving the use of a copyrighted photograph containing the plaintiffs without their consent in a broad advertising campaign); *Brown v. Ames*, 201 F.3d 654 (5th Cir. 2000) (involving the use of the plaintiffs’ names and likenesses to sell music records and paraphernalia).

133. *See Bauer, supra* note 88, at 72 (“A comparably straightforward situation for finding that a right of publicity claim was *not* preempted is presented by a case like *Downing v. Abercrombie & Fitch*.”).

134. *Downing*, 265 F.3d at 999–1000.

advertising campaign without obtaining plaintiffs' permission.¹³⁵ Along with publishing the photo and identifying the plaintiffs by name, Abercrombie also offered the same tee shirts worn by the plaintiffs in the photo for sale in its catalog.¹³⁶ The Ninth Circuit correctly determined that although the photograph itself qualified as a work protected under section 103 of the Copyright Act, the fundamental issue and the basis of the plaintiffs' claims was the unauthorized "use of the [plaintiffs'] likenesses and their names pictured in the published photograph."¹³⁷ Reversing in favor of the plaintiffs, the Ninth Circuit held that "[a] person's name or likeness is not a work of authorship within the meaning of 17 U.S.C. § 102" and therefore, section 301 of the Copyright Act did not preempt the plaintiffs' claims based on the state right of publicity.¹³⁸

The Ninth Circuit's opinion addressed in its preemption analysis additional meaningful elements derived from the plaintiffs' state common law and state statutory law claims.¹³⁹ These additional elements require that the defendant's actions from which the plaintiffs' claims arose be "for commercial purposes and without the plaintiffs' permission."¹⁴⁰ However, the important distinction is the meaningful additional nature of these elements and not their commercial purpose use per se.¹⁴¹ Known as the "extra element" test, plaintiffs' claims are removed from the general scope of copyright and thus preemption if the meaningful additional elements "change[] the nature of [state] claims so that it is qualitatively different from copyright infringement claims."¹⁴² In *Downing*, the Ninth Circuit

135. *Id.* at 1000.

136. *Id.*

137. *Id.* at 1003; *see also* Bauer, *supra* note 88, at 72–73 ("[A]lthough the plaintiffs' *personas* were embodied in the copyrightable photographs, the *subject matter* of their claims was the unauthorized use of their names and likenesses.").

138. *Downing*, 265 F.3d at 1004–05, 1010.

139. Bauer, *supra* note 88, at 73 ("Furthermore, the action for the defendant's use of [plaintiffs'] *personas*, which required evidence that the defendant's actions were undertaken for commercial purposes and without the plaintiffs' permission, alleged meaningful additional elements."); *see Downing*, 265 F.3d at 1001 (describing the California common law and statutory causes of action for commercial misappropriation).

140. Bauer, *supra* note 88, at 73.

141. *Id.* at 38–39 (describing the "extra element" test many courts have utilized).

142. *See id.* (describing the "extra element" test many courts have utilized).

correctly identified that these meaningful additional elements removed the plaintiffs' claims from the subject matter of copyright because the subject matter of the plaintiffs' claims was the use of the plaintiffs' names and likenesses, which are not copyrightable.¹⁴³

D. Downing v. Abercrombie & Fitch and Ray v. ESPN, Inc.

The Eighth Circuit also distinguished *Ray* from *Downing* by emphasizing the additional element alluded to by the Ninth Circuit requiring evidence of the commercial purpose of a defendant's actions.¹⁴⁴ However, by simply stating whether or not the commercial purpose element was met, the Eighth Circuit essentially asserted the inconsistent conclusion that use of a copyrighted work in an advertisement for commercially economic purposes constitutes use of a likeness whereas the use of the exact same work in a mere rebroadcast, as in *Baltimore Orioles*, does not.¹⁴⁵ Regardless, the end result of preemption that the court reached was the correct outcome,¹⁴⁶ as the Eighth Circuit determined that Ray's likeness could not be detached from the copyrighted performances contained in the video recordings.¹⁴⁷ Additionally, in concluding that ESPN did not use Ray's likeness without his permission to serve that commercial economic purpose, the Eighth Circuit properly determined that Ray's right of publicity claim was preempted.¹⁴⁸ Despite reaching the correct result, the Eighth Circuit's hasty opinion again brushed past an

143. See *Downing*, 265 F.3d at 1005 (“[T]he subject matter of the [plaintiffs’] statutory and common law right of publicity claims is their names and likenesses, which are not copyrightable.”).

144. See *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1144 (8th Cir. 2015) (“ESPN did not use Ray’s likeness or name in an advertisement without his permission to promote its commercial products . . .”).

145. Rebecca Tushnet, *8th Circuit Dismisses Right of Publicity Claim as Copyright Preempted*, REBECCA TUSHNET’S 43(B)LOG (Apr. 23, 2015, 3:45 PM), <http://tushnet.blogspot.com/2015/04/8th-circuit-dismisses-right-of.html> [http://perma.cc/6DXF-EEXR].

146. *Id.*

147. *Ray*, 783 F.3d at 1144 (quoting the District Court’s finding that once performances are captured on film with the consent of the performer, they are a part of the copyrighted material and the performer’s likeness can no longer be detached from the copyrighted performances contained in the recording).

148. *Id.* at 1144–45 (quoting the District Court).

analysis of express waiver of the right of publicity and instead simply relied on *Nimmer on Copyright* and its argument of an implied waiver of an individual's right to publicity by that individual's collaboration in creating the copyrighted work.¹⁴⁹

E. Proof of Additional Elements and Wendt v. Host International, Inc.

The inclusion in preemption analysis of additional elements like those alluded to by the Ninth Circuit in *Downing* has not been without controversy.¹⁵⁰ *Wendt v. Host International, Inc.*, another Ninth Circuit decision, has been the subject of much scrutiny and criticism by courts and scholars alike.¹⁵¹ There, the plaintiffs were two actors from the television show "Cheers."¹⁵² The defendant sought to open several "Cheers" themed airport bars and, after acquiring the licenses from the owners of the copyright in the show, created and placed in the bars animatronic figures based on the characters played by the plaintiffs.¹⁵³ The Ninth Circuit erroneously held that the plaintiffs' right of publicity claims were not preempted by federal copyright law because those claims required satisfaction of additional elements different from those required of a copyright claim.¹⁵⁴ In so doing, the Ninth Circuit determined that if a right

149. *Id.* at 1144 (explaining in a parenthetical that *Nimmer's* argument that performers that collaborate in creating copyrighted works are barred from making right of publicity claims to prevent the use of that copyrighted work for its intended purpose).

150. Bauer, *supra* note 88, at 73 ("Far more problematic in its treatment of the preemption of the right of publicity is another Ninth Circuit decision, *Wendt v. Host International, Inc.*, which is among the most frequently-discussed and heavily-criticized decisions dealing with this question.").

151. *Id.* ("*Wendt v. Host International, Inc.* . . . is among the most frequently-discussed and heavily-criticized decisions dealing with [preemption of the right of publicity].").

152. *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 809 (9th Cir. 1997).

153. Bauer, *supra* note 88, at 73 (providing the factual background of the case).

154. *See Wendt*, 125 F.3d at 810 (explaining its previous holding in *Wendt* that plaintiffs' state law claims "are not preempted by the federal copyright statute so long as they 'contain elements, such as the invasion of personal rights . . . that are different in kind from copyright infringement.'"); *see also* Bauer, *supra* note 88, at 74 ("[Plaintiffs'] claims were not preempted because they required proof of additional elements beyond those needed to make out a copyright claim—specifically, 'proof that the defendant's use of the plaintiff's 'likeness' or 'identity' was commercial . . . whereas copyright infringement occurs with any unauthorized copying of the protected material.'").

of publicity claim contains any of these additional elements, it does not fall under the section 301 preemption provision of the Copyright Act.¹⁵⁵ This rationale is problematic because the addition of an extra element by itself does not necessarily dictate that the claim then ceases to be equivalent to one of the rights protected under section 106 of the Copyright Act.¹⁵⁶

Indeed, as the Seventh Circuit mistakenly asserted in *Baltimore Orioles*, if equivalency between the right of publicity and rights protected under federal copyright law is established because of their analogous underlying interests in promoting works for the benefit of the public,¹⁵⁷ then the mere addition of a commercial use requirement would not destroy this equivalency.¹⁵⁸ The Eighth Circuit in *Ray v. ESPN, Inc.* mirrored this flawed reasoning by restricting the focus of its analysis simply to whether ESPN used Ray's likeness for a commercial purpose without his permission rather than explore whether this commercial purpose gave rise to a state right of publicity claim fundamentally different from a copyright infringement claim.¹⁵⁹

VI. SHORTFALLS OF NIMMER'S PREEMPTION FRAMEWORK

In the leading copyright treatise *Nimmer on Copyright*, Professor David Nimmer sets forth a framework that utilizes a two-part test for courts to use in analyzing the intersection of federal copyright law, state law right of publicity, and contract law.¹⁶⁰ Nimmer proposed the test after surveying relevant case law and comparing the differing decisions reached by courts

155. See *Wendt*, 125 F.3d at 810.

156. See Bauer, *supra* note 88, at 75 (“[T]hat added ‘fact’ or ‘element’ in a right of publicity action does not, by itself, properly give rise to a claim that is not ‘equivalent to’ the rights conferred on the copyright owner by § 106.”).

157. *Balt. Orioles, Inc. v. MLB Players Ass’n*, 805 F.2d 663, 678–79 (7th Cir. 1986).

158. See Bauer, *supra* note 88, at 75 (“[T]hat added ‘fact’ or ‘element’ in a right of publicity action does not, by itself, properly give rise to a claim that is not ‘equivalent to’ the rights conferred on the copyright owner by § 106.”).

159. See *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1144 (8th Cir. 2015).

160. See MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT VOLUME 1* § 1.01(B)(3)(b)(iv)(I)–(II) (2013); see also Justin B. Bryant, Article, *Applying the Lessons from Dryer v. NFL: Forming a Workable Framework for Analyzing the Right of Publicity in Professional Sports*, 22 *SPORTS LAW. J.* 1, 18 (2015) (“Professor Nimmer proposes a two-part test for analyzing cases where copyright, the right of publicity, and contract law intersect.”).

in analyzing federal copyright preemption of state law right of publicity cases.¹⁶¹ This two-step process was developed from the patterns that emerged, highlighting the divergence of court decisions based on the determining factor of whether the works in question were used for commercial advertisement purposes or for entertainment purposes.¹⁶²

Under Nimmer's test, courts would first determine how the copyrighted work in question is being used—specifically, whether for commercial advertisement purposes or for entertainment purposes.¹⁶³ Nimmer warns courts against categorizing the works by type or medium, as no single type of work always falls into the same category of commercial advertisement or entertainment.¹⁶⁴ Nimmer found that when copyrighted works are used “‘for the purposes of trade,’ such as in an advertisement, plaintiffs’ right-of-publicity claims have not been held to be preempted.”¹⁶⁵ Rather, expressive uses of copyrighted works are likely to preempt state right of publicity claims.¹⁶⁶ The Third Circuit in *Facenda v. NFL Films, Inc.* opined that this is because the regulation of trade practices falls under the authority of state law while limiting the use of expressive works crosses into the subject matter of federal copyright law.¹⁶⁷

If the court finds that a copyrighted work was used for commercial advertisement purposes, it should then proceed to Nimmer's second prong of the test and examine the terms of the contract to determine the “purpose of the use” of the work to which the plaintiff consented when they initially signed the contract.¹⁶⁸ Nimmer emphasizes that courts should focus on whether the plaintiff “collaborated in the creation of a copyrighted

161. Kristen E. Riccard, Comment, *Product Placement or Pure Entertainment? Critiquing a Copyright-Preemption Proposal*, 59 AM. U. L. REV. 427, 444–45 (2009); see *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1029 (3d Cir. 2008). See generally NIMMER & NIMMER, *supra* note 160.

162. Riccard, *supra* note 161, at 444–45; see NIMMER & NIMMER, *supra* note 160.

163. Riccard, *supra* note 161, at 444; see NIMMER & NIMMER, *supra* note 160.

164. Riccard, *supra* note 161, at 445; see NIMMER & NIMMER, *supra* note 160.

165. *Facenda*, 542 F.3d at 1029.

166. Riccard, *supra* note 161, at 445; see NIMMER & NIMMER, *supra* note 160.

167. *Facenda*, 542 F.3d at 1029.

168. Riccard, *supra* note 161, at 446; see NIMMER & NIMMER, *supra* note 160.

advertising product.”¹⁶⁹ If the original work that the plaintiff consented to was a commercial advertisement, courts have found that the plaintiff gave his or her implied permission to the copyright owner to create derivative works for commercial purposes.¹⁷⁰

Within this framework, Nimmer properly advocates for the establishment of a waiver analysis in the second prong of his test by proposing that courts examine whether the plaintiff in a preemption case essentially waived his or her rights of publicity by collaborating to create a copyrighted advertising work or by implicitly giving their consent to the copyright owner by agreeing to participate in a copyrighted work that he or she knows will be used for commercial advertisement purposes.¹⁷¹ However, the problem lies with Nimmer’s first prong and its focus on the commercially economic or expressive use of the copyrighted work.¹⁷² As noted earlier, the use of a copyrighted work for commercially economic purposes does not in itself assert a right that is not equivalent to a right protected under federal copyright statute.¹⁷³ Therefore, while Nimmer’s framework is successful in harmonizing how various courts have reached their outcomes in federal copyright preemption of state right of publicity issues in the past,¹⁷⁴ it is not helpful in analyzing potential future preemption cases.

VII. RAY V. ESPN, INC. AND A MODIFIED SOLUTION

A proper framework for federal copyright preemption of state right of publicity issues should facilitate predictions of how a court will determine a

169. Bryant, *supra* note 160; *see* NIMMER & NIMMER, *supra* note 160.

170. Riccard, *supra* note 161, at 446; *see* NIMMER & NIMMER, *supra* note 160.

171. *See* Ray v. ESPN, Inc., No. 13-1179-CV-W-SOW, 2014 WL 2766187, at *5 (W.D. Mo. Apr. 8, 2014) (“When a performer gives permission or collaborates in creating a copyrightable work, the performer is barred from ‘using the right of publicity’ to squelch exploitation of that copyrighted work for its intended purpose”) (citing NIMMER & NIMMER, *supra* note 160, at § 1.01(B)(3)(b)(iv)(II)).

172. *See* Bryant, *supra* note 160; *see* NIMMER & NIMMER, *supra* note 160.

173. Joseph P. Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976*, 10 VAND. J. ENT. & TECH. L. 1, 75 (2007).

174. Riccard, *supra* note 161, at 446–47.

preemption case.¹⁷⁵ This is in fact necessary to further the underlying principles of both federal copyright protection and the states' right of publicity laws: incentivizing the creation of works for the public benefit.¹⁷⁶ A modification of Nimmer's two-prong preemption test will help achieve this goal.

Rather than restrict the focus of its first prong to whether or not the use of a copyrighted work is commercially economic or expressive,¹⁷⁷ the "extra element" test used by some courts should be utilized to determine whether the elements of the state right of publicity claim constitute meaningful additional elements that give rise to a claim fundamentally and qualitatively different from an infringement claim under federal copyright law.¹⁷⁸ This would allow courts to avoid the flawed outcome of the Ninth Circuit's reasoning in *Wendt v. Host International, Inc.*¹⁷⁹ If there are no meaningful additional elements or the additional elements do not adequately change the nature of the claim, the plaintiff's state claim should be found preempted, as the right is equivalent to one of the rights protected by federal copyright law and thus is properly subject to preemption under Section 301.¹⁸⁰

If additional meaningful elements are present, then courts should proceed to Nimmer's waiver analysis under the second prong of his test.¹⁸¹ However, this waiver analysis should be expanded to include situations where individuals expressly sign waivers and contracts forfeiting their

175. Kristen E. Riccard, Comment, *Product Placement or Pure Entertainment? Critiquing a Copyright-Preemption Proposal*, 59 AM. U. L. REV. 427, 457–58 (2009).

176. *Id.* at 458–59 (noting that the continuing creation of creative works will only continue if parties can determine that their investments will be protected).

177. Justin B. Bryant, Article, *Applying the Lessons from Dryer v. NFL: Forming a Workable Framework for Analyzing the Right of Publicity in Professional Sports*, 22 SPORTS LAW. J. 1, 18 (2015); see MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT VOLUME 1 § 1.01(B)(3)(b)(iv)(I)–(II) (2013).

178. See Joseph P. Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976*, 10 VAND. J. ENT. & TECH. L. 1, 38–39 (2007).

179. *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 810 (9th Cir. 1997) (explaining the previous holding that plaintiffs' state law claims were not preempted by federal copyright statute if they require additional elements different from the elements of copyright infringement).

180. 17 U.S.C. § 301(a) (2012).

181. See NIMMER & NIMMER, *supra* note 177.

rights of publicity as performers and collaborators in the creation of copyrighted works. If the individual waived his or her right to publicity claim either through an expressly signed contract or implicitly through collaboration with the express knowledge of how the copyrighted work will be used,¹⁸² then that individual's state right of publicity claim should be preempted.

Applying this modified framework to *Ray v. ESPN, Inc.* allows for a more coherent and deliberate arrival to the same end result of preemption achieved by the Eighth Circuit.¹⁸³ While ultimately unavailing, Ray's assertion that the basis of his claim is not within the subject matter of federal copyright because it stems from the unauthorized use of his likeness and persona¹⁸⁴ would satisfy the "extra element" test of the modified first prong, paralleling the Ninth Circuit determination in *Downing v. Abercrombie & Fitch*.¹⁸⁵ However, under the second prong, Ray's claim would fail since he would be found to have both expressly waived his right to publicity¹⁸⁶ and implicitly waived it by collaborating in the creation of the copyrighted work.¹⁸⁷ As his individual performance in the recordings was copyrightable, his likeness could therefore not be detached from those performances.¹⁸⁸

182. *Id.*; see also *Ray v. ESPN, Inc.*, No. 13-1179-CV-W-SOW, 2014 WL 2766187, at *5 (W.D. Mo. Apr. 8, 2014) ("When a performer gives permission or collaborates in creating a copyrightable work, the performer is barred from 'using the right of publicity' to squelch exploitation of that copyrighted work for its intended purpose . . .") (citing *NIMMER & NIMMER*, *supra* note 177, at § 1.01(B)(3)(b)(iv)(II)).

183. See *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1144–45 (8th Cir. 2015) (concluding that Ray's state-law claims were preempted under the Copyright Act).

184. *Id.* at 1143.

185. *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003 (9th Cir. 2001); see also Bauer, *supra* note 178, at 72–73 ("[A]lthough the plaintiffs' *personas* were embodied in the copyrightable photographs, the *subject matter* of their claims was the unauthorized use of their names and likenesses.").

186. *Ray*, 783 F.3d at 1141 ("Ray specifically agreed with a representative of the UWF that the films would be 'sold and used.'"); *Ray*, 2014 WL 2766187, at *1 ("[Ray] entered into a series of contracts . . . and each match was filmed for future use in order to generate revenue.").

187. *Ray*, 2014 WL 2766187, at *5.

188. *Ray*, 783 F.3d at 1144.

VIII. CONCLUSION

Despite reaching the correct result, the Eighth Circuit's analysis in *Ray v. ESPN, Inc.* failed to make a mark in the development of a solid and consistent framework for analyzing federal copyright preemption of state law right of publicity claims. While Professor Nimmer's framework is useful in unifying how different courts have reached their outcomes in federal copyright preemption of state law right of publicity issues in the past,¹⁸⁹ it is less useful in analyzing future preemption cases. Therefore, with Professor Nimmer's two-prong preemption test¹⁹⁰ as a foundation, courts should use the proposed modified version that, instead of restricting the focus of Nimmer's first prong to whether or not the use of a copyrighted work is commercially economic or expressive,¹⁹¹ utilizes the "extra element" test to determine whether the elements of the state law right of publicity claim constitute meaningful additional elements that give rise to a claim fundamentally and qualitatively different from an infringement claim under federal copyright law.¹⁹²

189. Kristen E. Riccard, Comment, *Product Placement or Pure Entertainment? Critiquing a Copyright-Preemption Proposal*, 59 AM. U. L. REV. 427, 447–48 (2009).

190. MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT VOLUME 1 § 1.01(B)(3)(b)(iv)(I)–(II) (2013); see also Justin B. Bryant, Article, *Applying the Lessons from Dryer v. NFL: Forming a Workable Framework for Analyzing the Right of Publicity in Professional Sports*, 22 SPORTS LAW. J. 1, 18 (2015) ("Professor Nimmer proposes a two-part test for analyzing cases where copyright, the right of publicity, and contract law intersect.").

191. Bryant, *supra* note 190; see NIMMER & NIMMER, *supra* note 190.

192. See Joseph P. Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976*, 10 VAND. J. ENT. & TECH. L. 1, 38–39 (2007).