

No. B285629

IN THE COURT OF APPEAL FOR THE STATE OF CALIFORNIA
SECOND APPELLATE DISTRICT, DIVISION 3

FX NETWORKS, LLC AND PACIFIC 2.1 ENTERTAINMENT GROUP, INC.,

Defendants - Appellants,

v.

OLIVIA DE HAVILLAND, DBE,

Plaintiff - Respondent.

On Appeal from the Los Angeles Superior Court,

Case No. BC667011

The Honorable Holly E. Kendig, Dept. 42

**BRIEF OF AMICI CURIAE ELECTRONIC FRONTIER
FOUNDATION, ORGANIZATION FOR TRANSFORMATIVE
WORKS, AND WIKIMEDIA FOUNDATION IN SUPPORT OF
DEFENDANTS - APPELLANTS**

DANIEL K. NAZER (SBN 257380)

daniel@eff.org

ELECTRONIC FRONTIER
FOUNDATION

815 Eddy Street

San Francisco, CA 94109

Telephone: (415) 436-9333

Facsimile: (415) 436-9993

Counsel for Amici Curiae

Received by Second District Court of Appeal

TABLE OF CONTENTS

I. INTRODUCTION.....	8
II. ARGUMENT	9
A. If Allowed to Stand, the Superior Court’s Ruling Would Chill Accurate Speech About Celebrities.....	9
B. The Transformative Use Test Should Not Be Applied So Inflexibly That It Punishes All Realistic Expression	13
C. To the Extent the Transformative Use Test Punishes Creators for Accuracy, It Should Be Abandoned.	17
1. A Single Strand of Fair Use Law Cannot Stand-In for the Entire First Amendment in the Right of Publicity Context.	17
2. The Transformative Use Test Wrongly Penalizes Realistic Accounts of Public Events.....	21
3. The Rogers/Restatement Test is More Appropriate for Accommodating the Competing Free Speech Values in Publicity Claims.....	22
D. Expert Testimony Regarding Purported Industry Practices Cannot Trump the First Amendment.	23
III. CONCLUSION	26
CERTIFICATE OF WORD COUNT.....	27
CERTIFICATE OF SERVICE.....	28

TABLE OF AUTHORITIES

Cases

<i>Baggett v. Bullitt</i> (1964) 377 U.S. 360	13
<i>Bleistein v. Donaldson Lithographing Co.</i> (1903) 188 U.S. 239	19
<i>Cambridge Univ. Press v. Patton</i> (11th Cir. 2014) 769 F.3d 1232.....	18
<i>Campbell v. Acuff-Rose Music, Inc.</i> (1994) 510 U.S. 569	19
<i>Cardtoons, L.C. v. Major League Baseball Players Ass’n</i> (10th Cir. 1996) 95 F.3d 959.....	13
<i>Caterpillar, Inc. v. Walt Disney Co.</i> (C.D.Ill. 2003) 287 F. Supp.2d 913	24
<i>Comedy III Prods., Inc. v. Gary Saderup, Inc.</i> (2001) 25 Cal.4th 387	<i>passim</i>
<i>Davis v. Costa-Gavras</i> (S.D.N.Y. 1987) 654 F.Supp. 653	11
<i>Doe v. TCI Cablevision</i> (Mo. 2003) 110 S.W.3d 363	21
<i>Eldred v. Ashcroft</i> (2003) 537 U.S. 186	18
<i>ETW Corp. v. Jireh Publ’g, Inc.</i> (6th Cir. 2003) 332 F.3d 915.....	13, 14
<i>Gionfriddo v. Major League Baseball</i> (2001) 94 Cal.App.4th 400	13
<i>Golan v. Holder</i> (2012) 565 U.S. 302	18

<i>Guglielmi v. Spelling-Goldberg Prods.</i> (1979) 25 Cal.3d 860	13, 16, 17, 24
<i>Harper & Row Publishers, Inc. v. Nation Enters.</i> (1985) 471 U.S. 539	19
<i>Harris v. Quinn</i> (2014) 134 S. Ct. 2618	23
<i>Hart v. Electronic Arts, Inc.</i> (3d Cir. 2013) 717 F.3d 141	20
<i>Hicks v. Casablanca Records</i> (S.D.N.Y. 1978) 464 F.Supp. 426.....	20
<i>In re NCAA Student-Athlete Name & Likeness Licensing Litig.</i> (9th Cir. 2013) 724 F.3d 1268.....	20, 21
<i>Joseph Burstyn, Inc. v. Wilson</i> (1952) 343 U.S. 495	25
<i>Mattel v. MCA Records</i> (9th Cir. 2002) 296 F.3d 894.....	24
<i>Noriega v. Activision/Blizzard, Inc.</i> (Cal.Super.Ct., Oct. 27, 2014, No. BC551747) [2014 WL 5930149]	15
<i>NXIVM Corp. v. Ross Inst.</i> (2d Cir. 2004) 364 F.3d 471	18
<i>Parks v. LaFace Records</i> (6th Cir. 2003) 329 F.3d 437	22
<i>Rogers v. Grimaldi</i> (2d Cir. 1989) 875 F.2d 994.....	22
<i>Rosa & Raymond Parks Inst. for Self Dev. v. Target Corp.</i> (11th Cir. 2016) 812 F.3d 824.....	20
<i>Sarver v. Chartier</i> (9th Cir. 2016) 813 F.3d 891.....	17, 20

<i>Seale v. Gramercy Pictures</i> (E.D.Pa. 1996) 949 F.Supp. 331	13, 20
<i>Stevens v. Nat'l Broad. Co.</i> (1969) 270 Cal.App.2d 886	24
<i>Taylor v. NBC</i> (Cal.Super.Ct., Sept. 12, 1994, No. BC110922) [1994 WL 780690]	20
<i>United States v. Alvarez</i> (2012) 567 U.S. 709	21, 22
<i>Winter v. DC Comics</i> (2003) 30 Cal.4th 881	10, 21

Other Authorities

Alexandra Gil, <i>Great Expectations: Content Regulation in Film, Radio, and Television</i> (2009) 2009 Den.U.Sports&Ent.L.J. 31	24
Barbara Basbanes Richter, Fine Books Magazine (Dec. 1, 2017) <i>Kickstarter-Funded Biography of W.A. Dwiggin's Heading to the Presses</i> , at https://www.finebooksmagazine.com/fine_books_blog/2017/12/kickstarter-funded-biography-of-wa-dwiggin's-heading-to-the-presses.phtml	12
David A. Kaplan, Fortune, <i>The Social Network Mystery: Where Are The Lawsuits?</i> (Sept. 27, 2010) at http://archive.fortune.com/2010/09/27/technology/Suing_The_Facebook_Effect.fortune/index.htm . .9	
David Batty & Chris Johnston, The Guardian, <i>Social Network 'made up stuff that was hurtful', says Mark Zuckerberg</i> (Nov. 8, 2014), at https://www.theguardian.com/technology/2014/nov/08/mark-zuckerberg-social-network-made-stuff-up-hurtful	10, 23
Eugene Volokh, <i>Freedom of Speech and the Right of Publicity</i> (2003) 40 Hous.L.Rev. 903	20

Heidi MacDonald, <i>The Beat</i> (March 14, 2006) <i>Kickstarter is increasingly crucial to indie comics publishing</i> , at http://www.comicsbeat.com/kickstarter-is-increasingly-crucial-to-indie-comics-publishing/)	13
Ian Burrell, <i>The Independent</i> , <i>How 127 Hours was brought to the big screen</i> (Feb. 27, 2011) at http://www.independent.co.uk/arts-entertainment/films/features/how-127-hours-was-brought-to-the-big-screen-2225892.html	9
James Gibson, <i>Risk Aversion and Rights Accretion in Intellectual Property Law</i> (2007) 116 Yale L.J. 882.....	25
Jennifer E. Rothman, <i>The Questionable Use of Custom in Intellectual Property</i> (2007) 93 Va.L.Rev. 1899,	24, 25
Josh Duboff, <i>Vanity Fair</i> , <i>Kim Kardashian Was Not Thrilled About Her Portrayal on The People v. O.J. Simpson</i> (June 16, 2016) at https://www.vanityfair.com/style/2016/06/kim-kardashian-people-v-oj-simpson-portrayal	10
Michael A. Carrier, <i>Cabining Intellectual Property Through a Property Paradigm</i> (2004) 54 Duke L.J. 1	19
Michael D. Shearjan, <i>New York Times</i> (Jan. 13, 2013) <i>White House Denounces Web Video by N.R.A.</i> at http://www.nytimes.com/2013/01/17/us/politics/nra-attacks-obama-in-video.html	12
Pierre N. Leval, <i>Toward a Fair Use Standard</i> (1990) 103 Harv.L.Rev. 1105	19
Rebecca Kheel, <i>The Hill</i> (Nov. 9, 2016) <i>ACLU to Trump: 'See you in court'</i> at http://thehill.com/policy/defense/305216-aclu-pledges-to-use-full-firepower-if-trump-pursues-deportations-muslim-ban	12
Restatement (Third) of Unfair Competition	22
Stacey L. Dogan & Mark A. Lemley, <i>What the Right of Publicity Can Learn from Trademark Law</i> (2006) 58 Stan.L.Rev. 1161	18, 20

William McGeeveran, *Trademarks, Movies, and the Clearance Culture*,
Info/Law, July 2, 2009 at [http://blogs.law.harvard.edu/infolaw/](http://blogs.law.harvard.edu/infolaw/2009/07/02/tm-movie-clearance/)
2009 /07/02/tm-movie-clearance/24

BRIEF OF AMICI CURIAE

I. INTRODUCTION

The trial court applied a simple, but radical, rule: producers of drama that strives for realism must secure permission from any real person portrayed in their work. This approach to the right of publicity would have a devastating impact on freedom of speech. At a minimum, by requiring approval from all real world subjects, it would condemn the docudrama genre to tepid hagiography. In addition, by turning realism into a potential source of liability, it will likely chill a vast range of creative expression that portrays real people and events. If the trial court's decision is allowed to stand, it would threaten speech spanning from Hollywood blockbusters like *The Social Network*, to independent documentaries and fan websites.

The trial court made two critical errors. *First*, the court failed to properly apply First Amendment limits to the right of publicity, embracing instead an excessively rigid interpretation of the transformative use test of *Comedy III Productions, Inc. v. Gary Saderup, Inc.* (2001) 25 Cal.4th 387. As a result, the trial court found that *Feud* was not protected by the First Amendment simply because the producers wanted to make the appearance of the Olivia de Havilland character as real as possible. This ignores, and devalues, many ways in which the work is creatively transformative such as the acting, set design, and direction. Indeed, if the transformative use test is so rigid that it truly mandates the radical holding below, then California courts must reject the test as contrary to the First Amendment.

Second, the trial court improperly allowed expert testimony concerning purported industry standards and practices to trump the First Amendment. Plaintiff submitted two expert reports claiming

that it is customary practice for producers of docudramas to clear portrayals with any living subjects of their work. Even if this were true, it has no bearing on whether FX's work is protected expression. The cautious conduct of some producers cannot justify stripping others of their right to freedom of speech.

II. ARGUMENT

A. If Allowed to Stand, the Superior Court's Ruling Would Chill Accurate Speech About Celebrities.

Dramas inspired by real events, and portraying real people, are a significant part of contemporary culture and the preservation of the historical record. These includes movies, television shows, and plays such as *The Queen*, *The Audience*, *Frost/Nixon*, *I Tonya*, *This House*, *The History of Everything*, *127 Hours*, *The Big Short*, *The Insider*, *Snowden*, *The Social Network*, *Too Big To Fail*, *All The President's Men*, and *The Post*. Some of these works were produced with the approval and input of their real-life subjects.¹ Others were not.² If Plaintiff prevails, however, only dramas that gain the approval of their subjects will survive. Just as it is common for public figures to be upset with the press, it is common for subjects of drama inspired by

¹ (See, e.g., Ian Burrell, *The Independent*, *How 127 Hours was brought to the big screen* (Feb. 27, 2011) at <http://www.independent.co.uk/arts-entertainment/films/features/how-127-hours-was-brought-to-the-big-screen-2225892.html>).

² (See, e.g., David A. Kaplan, *Fortune*, *The Social Network Mystery: Where Are The Lawsuits?* (Sept. 27, 2010) [noting that HBO, producer of *Too Big To Fail*, "typically does not pay for the rights to anyone's 'life story.'"] at http://archive.fortune.com/2010/09/27/technology/Suing_The_Facebook_Effect.fortune/index.htm.)

real events to be displeased by aspects of their portrayal, and to seek to suppress them.³

The trial court's order is shockingly broad. The court held that the First Amendment does not protect realistic portrayals. (See JA 1093.) And the court compounded that error by holding that it also does not protect a work if the creator merely *intended* a realistic portrayal. (*Ibid.*) Indeed, it found the work unprotected because FX "attempted to make the program 'consistent with the historical record.'" (*Ibid.*, emphasis added [citing declaration of executive producer Ryan Murphy].) The Plaintiff's Brief in Opposition confirms that she is seeking an extremely broad ruling that would strip First Amendment protection from all realistic works, including any works that merely allude to real people and events. (See Plaintiff Brief in Opp'n at p. 43 fn. 18 [arguing that "where the identity of the celebrity is a literal imitation, the First Amendment does not protect it"] [citing *Winter v. DC Comics* (2003) 30 Cal.4th 881].)

When combined with the trial court's ruling on Plaintiff's false light claim,⁴ the decision below creates an impossible dilemma for

³ (See, e.g., David Batty & Chris Johnston, *The Guardian*, *Social Network 'made up stuff that was hurtful', says Mark Zuckerberg* (Nov. 8, 2014), at <https://www.theguardian.com/technology/2014/nov/08/mark-zuckerberg-social-network-made-stuff-up-hurtful>; Josh Duboff, *Vanity Fair*, *Kim Kardashian Was Not Thrilled About Her Portrayal on The People v. O.J. Simpson* (June 16, 2016) at <https://www.vanityfair.com/style/2016/06/kim-kardashian-people-v-oj-simpson-portrayal>.)

⁴ This brief does not address the substance of Plaintiff's false light claim. *Amici* agree with Defendants-Appellants that the trial court improperly treated minor fictionalization as evidence of actual malice and that the false light count should be dismissed. (See

producers of reality-based drama: fictionalization will support a false light claim, while accuracy will support a right of publicity claim.

And it's even worse for docudramas that include fictional elements – as most, if not all, do. They can bear *both* false light and right of publicity liability. The trial court treated the mere *intention* to create realistic drama as enough to cancel out First Amendment protections. This effectively makes the entire genre dependent on the express and advance permission of all subjects, rendering it impossible to make searching and critical works like *The Social Network* or *The People v. O.J. Simpson*.

The trial court's ruling, if upheld, will also threaten speech well beyond the docudrama genre. An enormous range of expression concerns real people, brings some economic benefit to the speaker, and is made without the permission of the subject. This includes documentaries, websites, biographies, songs, and countless other works. Documentaries frequently involve depicting real people and generally strive for realism. Fan websites featuring real people are as diverse as fandom itself, whether they be Facebook groups for devotees of actor Benedict Cumberbatch⁵ or Justice Ruth Bader Ginsberg⁶, or a blog publishing critical theory about Lady Gaga.⁷ Non-profit organizations often feature real people – such as President Trump or Obama – in their advertising and fundraising

Opening Br. at p. 38-49; see also *Davis v. Costa-Gavras* (S.D.N.Y. 1987) 654 F.Supp. 653, 658.)

⁵ At <https://www.facebook.com/cumbercollectiveunite/>.

⁶ At <https://www.facebook.com/notoriousRBG/>.

⁷ At <http://gagajournal.blogspot.com/>.

appeals.⁸ If the trial court's ruling is upheld, all of this speech could be stripped of First Amendment protection merely because it sought to portray a celebrity accurately.

Even worse, the mere threat of a right of publicity suit could be enough to deter many creators from finishing a project. While a television network like FX might be able to afford to fight back in court, not all speakers have such resources. Indeed, thanks to new models of funding and distribution, it is more common than ever for artists to publish without the backing of a major corporation. For example, dozens of documentaries are crowd-funded through Kickstarter every year.⁹ Crowdfunding has also become an important source of funding for biographies¹⁰ and independent comic books.¹¹ As with docudramas, some of these works will

⁸ (See Rebecca Kheel, *The Hill* (Nov. 9, 2016) *ACLU to Trump: 'See you in court'* at <http://thehill.com/policy/defense/305216-aclu-pledges-to-use-full-firepower-if-trump-pursues-deportations-muslim-ban>; Michael D. Shearjan, *New York Times* (Jan. 13, 2013) *White House Denounces Web Video by N.R.A.* at <http://www.nytimes.com/2013/01/17/us/politics/nra-attacks-obama-in-video.html>.)

⁹ A search for “most-funded” documentaries on the Kickstarter platform reveals hundreds of results. (See https://www.kickstarter.com/discover/advanced?category_id=30&woe_id=23424977&sort=most_funded&seed=2527756&page=1.)

¹⁰ (See Barbara Basbanes Richter, *Fine Books Magazine* (Dec. 1, 2017) *Kickstarter-Funded Biography of W.A. Dwiggins Heading to the Presses*, at https://www.finebooksmagazine.com/fine_books_blog/2017/12/kickstarter-funded-biography-of-wa-dwiggins-heading-to-the-presses.phtml)

¹¹ (See Heidi MacDonald, *The Beat* (March 14, 2006) *Kickstarter is increasingly crucial to indie comics publishing*,

portray real-world subjects positively, others will be highly critical. Without First Amendment breathing room, these low-budget works could easily be chilled. (See *Baggett v. Bullitt* (1964) 377 U.S. 360, 372 [noting that unclear standards can force speakers to “steer far wider of the unlawful zone”]). The trial court’s ruling does not provide this essential breathing room for speech.

B. The Transformative Use Test Should Not Be Applied So Inflexibly That It Punishes All Realistic Expression

It is well settled that the First Amendment limits the scope of publicity rights. (See *Comedy III*, 25 Cal.4th at p. 396 [noting the “tension between the right of publicity and the First Amendment”].) Courts in California and around the country have dismissed right of publicity claims that would burden free speech. (See, e.g., *Guglielmi v. Spelling-Goldberg Prods.* (1979) 25 Cal.3d 860, 865-66; *Gionfriddo v. Major League Baseball* (2001) 94 Cal.App.4th 400, 409-10; *ETW Corp. v. Jireh Publ’g, Inc.* (6th Cir. 2003) 332 F.3d 915, 936; *Cardtoons, L.C. v. Major League Baseball Players Ass’n* (10th Cir. 1996) 95 F.3d 959, 976; *Seale v. Gramercy Pictures* (E.D.Pa. 1996) 949 F.Supp. 331, 337.)

It is easy to identify the trial court’s error that led to its radical departure deviation from this precedent. The trial court misapplied *Comedy III*’s transformative use test, using a far narrower definition of “transformative use” than has been used by other courts.

at <http://www.comicsbeat.com/kickstarter-is-increasingly-crucial-to-indie-comics-publishing/>)

Under *Comedy III*, a work is protected by the First Amendment if it “adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.” (25 Cal.4th at p. 391.) But this rule does not mean that a work is unprotected simply because it is, or is intended to be, “realistic.” Rather, a court must look to the work as a whole to determine if it is transformative.

The Sixth Circuit’s application of *Comedy III* in *ETW Corp.*, explaining how even a realistic work can be transformative, is instructive. In that case, the court considered a painting of Tiger Woods. The painting realistically depicted Woods in various poses before a background of the Augusta National golf course and other golfers. (See 332 F.3d at p. 919.) The court wrote:

[A]pplying the transformative effects test adopted by the Supreme Court of California in *Comedy III*, we find that Rush’s work does contain significant transformative elements which make it especially worthy of First Amendment protection Unlike the unadorned, nearly photographic reproduction of the faces of The Three Stooges in *Comedy III*, Rush’s work does not capitalize solely on a literal depiction of Woods. Rather, Rush’s work consists of a collage of images in addition to Woods’s image which are combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods’s achievement in that event.

(332 F.3d at p. 938.)

Importantly, the Sixth Circuit considered the work as a whole, looking at all of the elements of the new work, including the parts of the image that did not depict Woods himself.



[A reproduction of the print involved in *ETW Corp. v. Jireh*.]

More recently, Judge William Fahey of Los Angeles Superior Court applied *Comedy III* and found that a computer game featuring former Panamanian Dictator Manuel Noriega was protected expression. (See *Noriega v. Activision/Blizzard, Inc.* (Cal.Super.Ct., Oct. 27, 2014, No. BC551747) [2014 WL 5930149].) The authors had developed a realistic portrayal of Noriega using photographs. (See *ibid.* at *4.) Like in *ETW*, however, the mere fact of a realistic depiction of the plaintiff did not end the analysis. In evaluating transformative use, Judge Fahey also looked at the work as a whole, citing numerous elements beyond the portrayal of Noriega. These included the fact that the game featured many other characters and missions, and was the product of large team of designers and engineers. (See *ibid.* at *3.) By considering the work as a whole, and not just the realistic physical depiction of Noriega, the court found it

transformative and protected.



[A still from *Feud* featuring Catherine Zeta Jones as Olivia de Havilland and Susan Sarandon as Bette Davis]

The reasoning of these cases applies directly to FX's miniseries. *Feud*, like the painting of Woods or Activision's computer game, includes many other figures and creative elements. Indeed, a multi-episode series includes far more creative elements than the painting considered by the Sixth Circuit.

The requirement that works be considered as a whole also squares *Comedy III* with the concurring opinion of Chief Justice Rose Bird in *Guglielmi v. Spelling-Goldberg Productions* (1979) 25 Cal.3d 860. That opinion strongly supports the view that a realistic docudrama is protected by the First Amendment. (See *ibid.* at pp. 865-70.) Indeed, Chief Justice Bird concluded that if the right of publicity could apply to works based on real events, then an "important avenue of self-expression would be blocked and the marketplace of ideas would be

diminished.” (*Ibid.* at p. 872.) The *Comedy III* court cited Chief Justice Bird’s opinion approvingly. (See 25 Cal.4th at p. 396 fn. 7.) The *Comedy III* court also noted that a majority of the justices had approved the concurring opinion’s reasoning. (See *ibid.*) The trial court erred in applying *Comedy III* in a way that contradicts the venerable *Guglielmi* concurrence. (See also *Sarver v. Chartier* (9th Cir. 2016) 813 F.3d 891, 905 fn. 9.)

Ultimately, the only sensible approach to applying *Comedy III* is to analyze works as a whole, weighing all of their expressive and creative elements. The mere fact that a figure is portrayed realistically (or is intended to be portrayed realistically) cannot mean that the court should ignore all of the other aspects of a work.

C. To the Extent the Transformative Use Test Punishes Creators for Accuracy, It Should Be Abandoned.

Although *Comedy III*, properly applied, supports a sensible result in this case, *amici* respectfully suggest that the merits of the transformative use test should be reconsidered. This is for two important reasons. First, differences between copyright and the right of publicity suggest that the test may not make sense for the right of publicity context. Second, the transformative use test improperly disfavors accurate expression.

1. A Single Strand of Fair Use Law Cannot Stand-In for the Entire First Amendment in the Right of Publicity Context.

The *Comedy III* court adapted the first statutory fair use factor from copyright law. This factor considers “the purpose and character of the use.” (25 Cal.4th at p. 404.) More specifically, the court applied an aspect of this factor which asks whether a work is “transformative.” (*Ibid.*) But there are a number of reasons to believe

this is not the best First Amendment test for the right of publicity.

First, the right of publicity lacks copyright's constitutional pedigree. In considering free speech limits to copyright, the Supreme Court has repeatedly emphasized that the First Amendment and the Copyright Clause were adopted "close in time." (*Golan v. Holder* (2012) 565 U.S. 302, 328 [quoting *Eldred v. Ashcroft* (2003) 537 U.S. 186, 219].) In contrast, the right of publicity is a relatively recent offshoot of state privacy torts. (See generally Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law* (2006) 58 Stan.L.Rev. 1161, 1168-750.) While courts have treated copyright as broadly "compatible with free speech principles," *Eldred*, 537 U.S. at p. 219, courts should not assume such compatibility with a much more recent restriction on speech.

Second, copyright's fair use test does not rely on any one factor but in every case involves a consideration of all four factors. (See *NXIVM Corp. v. Ross Inst.* (2d Cir. 2004) 364 F.3d 471, 482 [noting that "no one factor should dominate" fair use analysis].) Uses can be fair even if the use is no transformation. (See, e.g., *Cambridge Univ. Press v. Patton* (11th Cir. 2014) 769 F.3d 1232, 1263 [noting that some educational uses are fair even if non-transformative].) In contrast, *Comedy III* makes transformative use the beginning and the end of the analysis. This makes the test far less flexible than fair use.

For example, the second fair use factor reflects, among other values, the view that purely factual work is less expressive. (See *Cambridge Univ. Press*, 769 F.3d at p. 1270 fn. 28 [noting the close relationship between factor two and the idea-expression dichotomy].) When this factor is not present to weigh in favor of a non-transformative use, the scale is heavily skewed against realistic depictions.

Third, unlike the right of publicity, copyright's multi-factored fair use doctrine balances competing free speech interests, with the goal of optimizing the flow of creative works to the public. (See *Campbell v. Acuff-Rose Music, Inc.* (1994) 510 U.S. 569, 575-76 [the need to protect authors while allowing others to build on their work is an "inherent tension" as old as copyright itself].) As the Supreme Court has explained, copyright provides an incentive to create speech. (See *Harper & Row Publishers, Inc. v. Nation Enters.* (1985) 471 U.S. 539, 558 [describing copyright as an "engine of free expression"].) At the same time, without appropriate limitations, exclusive rights can impede the creation and dissemination of new works. (See Pierre N. Leval, *Toward a Fair Use Standard* (1990) 103 Harv.L.Rev. 1105, 1108-09.)

In contrast, publicity rights do not reward the creation of new speech and expression; any incentive for speech, or even an incentive to become a celebrity is weak and attenuated. (See Michael A. Carrier, *Cabining Intellectual Property Through a Property Paradigm* (2004) 54 Duke L.J. 1, 43-44.) Applying a test that is designed to help balance competing speech interests to a situation where one side has no speech interest makes very little sense.

Fourth, an emphasis on "transformative" use makes little sense in the right of publicity context where there is no original work to be "transformed." Not surprisingly, as-applied, the test tends to turn on the court's evaluation of artistic or social merit – precisely the kind of artistic judgment that the Supreme Court has counseled against in the copyright context. (See, e.g., *Campbell*, 510 U.S. at pp. 582-83; *Bleistein v. Donaldson Lithographing Co.* (1903) 188 U.S. 239, 251-52.)

This problem is illustrated by the *Comedy III* decision itself. There, the Court attempted to distinguish *Saderup*'s charcoal

drawing of The Three Stooges from Andy Warhol's famous silkscreens of Marilyn Monroe. (See 25 Cal.4th at pp. 408-09.) The Court suggested that Warhol's work was transformative because "through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond . . . commercial exploitation." (*Ibid.*) But, as many commentators have noted, there is "little difference between Warhol's depictions and Saderup's, except that Warhol is already a recognized artist." (See Dogan & Lemley, *supra*, 58 Stan.L.Rev. at p. 11178 fn. 77; see also Eugene Volokh, *Freedom of Speech and the Right of Publicity* (2003) 40 Hous.L.Rev. 903, 913-25.) Since "transformative use" cannot distinguish Warhol from Saderup, the Court's own artistic judgment does all the work.

The transformative use test has compounded a problem in right of publicity jurisprudence whereby favored media, like books and movies, are found to be protected while disfavored media, like computer games or comic books, are unprotected. Despite the trial court's ruling in this case, courts usually find that the First Amendment preempts right of publicity claims against books, motion pictures, and television shows. (See, e.g., *Sarver*, 813 F.3d at p. 905 fn. 9 [movie]; *Rosa & Raymond Parks Inst. for Self Dev. v. Target Corp.* (11th Cir. 2016) 812 F.3d 824, 826 [book]; *Seale v. Gramercy Pictures* (E.D.Pa. 1996) 949 F.Supp. 331 [book and film biography], *affd.* without opinion (3d Cir. 1998) 156 F.3d 1225; *Hicks v. Casablanca Records* (S.D.N.Y. 1978) 464 F.Supp. 426, 433 [docudrama and novel]; *Taylor v. NBC* (Cal.Super.Ct., Sept. 12, 1994, No. BC110922) [1994 WL 780690, at *2] [television show].) In contrast, computer games and comic books are commonly found to be non-transformative uses. (See *In re NCAA Student-Athlete Name & Likeness Licensing Litig.* (9th Cir. 2013) 724 F.3d 1268 [computer game]; *Hart v. Electronic Arts, Inc.* (3d Cir. 2013) 717 F.3d 141 [computer game]; *Doe v. TCI Cablevision*

(Mo. 2003) 110 S.W.3d 363 [comic book].) But it is difficult to see how the transformative use test, if applied consistently, protects docudramas but not computer games and comic books. (See *NCAA Student-Athlete Name & Likeness Licensing Litig.* 724 F.3d at p. 1290 (dis. opn. of Thomas, J.) [noting that, if applied literally, the majority's reasoning on transformative use would "jeopardize[] the creative use of historic figures in motion pictures, books, and sound recordings"].)

2. *The Transformative Use Test Wrongly Penalizes Realistic Accounts of Public Events.*

The transformative use test wrongly penalizes accurate and realistic expression and thus threatens not only docudramas, but documentaries, biographies and other many other works.

An enormous range of expression derives its value from realism. Should a biography be less protected because it is accurate? Should a biopic be less protected because the actors and makeup artists do an uncannily good job of imitating the movie's real-life inspiration? Suppose FX, inspired by *Winter v. DC Comics* (2003) 30 Cal.4th 881, had chosen to portray de Havilland as a half-human/half-worm creature. By the logic of the trial court, that would mean *Feud* would be protected by the First Amendment. But if qualifying for free speech protection requires an artist to turn any real world subject into a half-human/half-worm creature to warrant First Amendment protection, then the underlying doctrine has gone seriously wrong.

The transformative use test, in penalizing realistic portrayals, upends the Supreme Court's free speech jurisprudence. In most contexts our courts provide *less* protection for inaccurate speech. (See generally *United States v. Alvarez* (2012) 567 U.S. 709, 732-35

(conc. opn. of Breyer, J.).) And even then, the Supreme Court has made it clear that falsehoods can be regulated only in narrow circumstances – such as perjury, fraud, and defamation. (See *ibid.* [noting that laws prohibiting false statements impose strict *mens rea* requirements and require proof of harm].)

3. *The Rogers/Restatement Test is More Appropriate for Accommodating the Competing Free Speech Values in Publicity Claims.*

California courts should instead adopt the so-called “*Rogers* test” which is more consistent with core First Amendment law. This standard asks whether the defendant’s use is “wholly unrelated” to the content of the accused work or was “simply a disguised commercial advertisement for the sale of goods or services.” (See *Parks v. LaFace Records* (6th Cir. 2003) 329 F.3d 437, 461 [citing *Rogers v. Grimaldi* (2d Cir. 1989) 875 F.2d 994, 1004].) The Restatement (Third) Of Unfair Competition essentially applies the *Rogers* test, limiting the application of publicity rights to only those uses made for “purposes of trade” – that is, uses that appear “in advertising the user’s goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user.” (Rest.3d, Unfair Competition, § 47.) The Restatement further explains that commercial use does not include “news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.” (*Ibid.*) Under this test, the right of publicity outweighs a speaker’s First Amendment right, for example, when the speaker falsely represents that a celebrity has endorsed a product or service. (See Rest. § 47; see also *Facenda v. N.F.L. Films, Inc.* (3d Cir. 2008) 542 F.3d 1007, 1032 [the right of publicity “is meant to protect is a citizen’s prerogative not to have

his or her name, likeness, voice, or identity used in a commercial advertisement”].)

The *Rogers*/Restatement test strikes a far better balance between free speech rights and publicity rights. This approach draws a clean line based on the well-established distinction between commercial speech and noncommercial speech. (See *Harris v. Quinn* (2014) 134 S. Ct. 2618, 2639 [“Our precedents define commercial speech as ‘speech that does no more than propose a commercial transaction.’”].) It protects celebrities and consumers from unauthorized commercial speech. At the same time, the test shields creative expression that happens to be about a celebrity (including books, movies, and news reporting).

Ultimately, *amici* hope that the trial court’s error in this case can lead to a more sensible approach to the right of publicity in California.

D. Expert Testimony Regarding Purported Industry Practices Cannot Trump the First Amendment.

In reaching its decision, the trial court relied on the testimony of two of Plaintiffs’ experts regarding industry practices. (See JA 1115, 1118.) For example, the trial court cited a declaration from Cort Casady claiming that it is “standard practice” in the entertainment industry to obtain consent whenever a production includes the image of a celebrity. (JA 1115.) But even if this testimony were accurate,¹² it is not relevant to the First Amendment analysis.

¹² While some companies may follow this procedure, *amici* question whether Plaintiff’s expert testimony accurately describes a universal industry practice. (See note 3 *supra*.)

Consider an analogy to trademark law. It is common in the entertainment industry to seek clearance for trademarks that appear in motion pictures. (See Jennifer E. Rothman, *The Questionable Use of Custom in Intellectual Property* (2007) 93 Va.L.Rev. 1899, 1912 fn. 34; William McGeeveran, *Trademarks, Movies, and the Clearance Culture*, Info/Law, July 2, 2009.)¹³ But courts do not actually require that producers obtain consent for all trademarks that appear in creative works. (See *Caterpillar, Inc. v. Walt Disney Co.* (C.D.Ill. 2003) 287 F. Supp.2d 913 [holding that Disney did not need permission to depict Caterpillar bulldozers in the film *George of the Jungle 2*].) Trademarked products are an integral part of modern life and art would be impoverished if we were not allowed to tell stories that included them. As Chief Justice Bird wrote 30 years ago, no “author should be forced into creating mythological worlds or characters wholly divorced from reality.” (*Guglielmi*, 25 Cal.3d at p. 869 (conc. opn. of Bird, C.J.).) Indeed, the Ninth Circuit has held that creators have a First Amendment right to depict trademarked goods in their art. (See *Mattel v. MCA Records* (9th Cir. 2002) 296 F.3d 894.) Industry practices cannot overcome this right.

History provides another helpful analogy. From 1934 until approximately 1968, the American film industry operated under the restrictive “Hays Code” which prohibited profanity, nudity, ridicule of the clergy, and many other topics. (See Alexandra Gil, *Great Expectations: Content Regulation in Film, Radio, and Television* (2009) 2009 Den.U.Sports&Ent.L.J. 31; see also *Stevens v. Nat'l Broad. Co.* (1969) 270 Cal.App.2d 886, 890 [considering a 1946 employment contract that required the Hays Code be followed].) This, like the

¹³ Available at: <http://blogs.law.harvard.edu/infolaw/2009/07/02/tm-movie-clearance/>.

clearance culture described by Plaintiff's experts, was an industry practice. Suppose this practice still existed. Would it establish that the First Amendment does not protect, say, a film that ridiculed the clergy? Of course not. It is the role of the courts, and not business habit, to determine the scope of constitutional rights. (See *Joseph Burstyn, Inc. v. Wilson* (1952) 343 U.S. 495, 501 [the "importance of motion pictures as an organ of public opinion is not lessened by the fact that they are designed to entertain as well as to inform"].)

Similar logic applies in this case. It may be that some in the entertainment industry demand that publicity rights always be cleared. But the mere existence of this practice doesn't establish that it is legally mandated. (See Rothman, *supra*, 93 Va.L.Rev. at pp. 1911-12 [the "clearance culture is primarily motivated by efforts to avoid litigation and operates without regard to what [the] law requires or what, as a normative matter, should be protected"].) In fact, allowing these practices to determine the scope of First Amendment protection would create a feedback-loop where producers hoping to minimize risk unwittingly reduced legal protections for creators. (See James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law* (2007) 116 Yale L.J. 882, 921).

It is the task of this Court, and not Plaintiff's experts, to determine whether the First Amendment protects FX's series. The Court should hold that the First Amendment allows creators to produce realistic works.

III. CONCLUSION

For the foregoing reasons, *amici* urge this Court to reverse the trial court and dismiss Plaintiff's right of publicity claim.

Dated: January 25, 2018

Respectfully submitted,

/s/ Daniel K. Nazer
DANIEL K. NAZER
ELECTRONIC FRONTIER
FOUNDATION

Counsel for Amici Curiae

CERTIFICATE OF WORD COUNT

I certify pursuant to California Rules of Court 8.204 and 8.504(d) that this Brief of *Amici Curiae* Electronic Frontier Foundation, Organization for Transformative Works, and Wikimedia Foundation is proportionally spaced, has a typeface of 13 points or more, contains 4,616 words, excluding the cover, the tables, the signature block, verification, and this certificate, which is less than the total number of words permitted by the Rules of Court. Counsel relies on the word count of the Microsoft Word word-processing program used to prepare this brief.

Dated: January 25, 2018

/s/ Daniel K. Nazer
DANIEL K. NAZER
ELECTRONIC FRONTIER
FOUNDATION

Counsel for Amici Curiae

CERTIFICATE OF SERVICE

STATE OF CALIFORNIA, COUNTY OF SAN FRANCISCO

I am over the age of 18 years and not a party to the within action. My business address is 815 Eddy Street, San Francisco, California 94109.

On January 25, 2018, I served the foregoing document entitled:

BRIEF OF *AMICI CURIAE* ELECTRONIC FRONTIER FOUNDATION, ORGANIZATION FOR TRANSFORMATIVE WORKS, AND WIKIMEDIA FOUNDATION IN SUPPORT OF DEFENDANTS - APPELLANTS

on the parties in this action on the attached Service List:

☒ BY ELECTRONIC TRANSMISSION VIA TRUEFILING: I caused a copy of the foregoing documents to be sent via TrueFiling to the persons at the e-mail addresses listed in the Service List. The following parties and/or counsel of record are designated for electronic service in this matter on the TrueFiling website. I did not receive, within a reasonable time after the transmission, any electronic message or other indication that the transmission was unsuccessful.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Executed on January 25, 2018 at San Francisco, California.



Madeleine Mulkern

SERVICE LIST

Suzelle M. Smith
Don Howarth
Zoe E. Tremayne
Howarth & Smith
523 West Sixth Street
Suite 728
Los Angeles, CA 90014
ssmith@howarth-smith.com
dhowarth@howarth-smith.com
ztremayne@howarth-smith.com

*Attorneys for Olivia De Havilland:
Plaintiff and Respondent*

Glenn D. Pomerantz
Kelly M. Klause
Fred A. Rowley, Jr.
Mark R Yohalem
Munger, Tolles & Olson LLP
350 South Grand Avenue
50th Floor
Los Angeles, CA 90071-1560
Glenn.Pomerantz@mto.com
Kelly.Klaus@mto.com
Fred.Rowley@mto.com
Mark.Yohalem@mto.com

*Attorneys for FX Networks, LLC
and Pacific 2.1 Entertainment
Group, Inc.: Defendant and
Appellant*

Los Angeles County Superior
Court
Stanley Mosk Courthouse
111 North Hill Street
Los Angeles, CA 90012

Supreme Court of California
350 McAllister Street
San Francisco, Ca 94102-4797