Against the Grain

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Cases of Note--Copyright v. Right-to-Publicity

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LEGAL ISSUES

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Cases of Note — Copyright v. Right-to-Publicity

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JOHN DRYER, ELVIN BETHEA, EDWARD WHITE V. THE NATIONAL FOOTBALL LEAGUE. UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT. 814 F.3d 938; 122016 U.S. App. LEXIS 3435.

We've come a long way from the days when pro baseball players gave up their image for $125 a season and the Leagues made millions off trading cards.

And yes, I had to look it up. The 8th Circuit is Arkansas, Iowa, Missouri, Nebraska, North and South Dakota.

NFL Films does films of significant games, seasons and players in the **NFL** history. Our **players** were in the **NFL** in the 1960s, 70s, and 80s. They are in the game footage and gave interviews after retirement.

They sued under the right-of-publicity of a variety of states and for unjust enrichment. There were more than just the three named in the suit. The others settled after the **NFL** created a fund for the benefit of all players.

Our named three did not settle, and on appeal the issue was their individual right-of-publicity and ***Lanham Act*** claims for use of their images.

NFL won summary judgment in the district court on the right-of-publicity claim. The ***Copyright Act*** preempted the claim because **NFL** had a copyright in the film. The court also held the film to be expressive, non-commercial speech protected by the 1st Amendment. Plus, under the state laws, the films were newsworthy and protected by the public interest.

NFL won summary judgment on the *Lanham Act* claim as it applies only to commercial speech. There was no possibility of confusion for consumers.

The Appeal

To determine ***Copyright Law*** preemption, the court asks (1) is the work subject to copyright, and (2) is the state law created right-to-publicity equivalent to any of the exclusive rights under Copyright. *Nat'l Car Rental Sys., Inc. v. Comput. Assocs. Int'l, Inc.,* 991 F.2d 426, 428 (8th Cir. 1993).

Somewhat fatuously, **players** tried to argue the issue (1) saying a film was not an "original work of authorship fixed in any tangible medium …" 17 U.S.C. § 102(a).

True, the initial game is an "athletic event" outside copyright subject matter. ***Nat'l Basketball ass'n v. Motorola, Inc.,*** 105 F.3d 841, 846 (2d Cir. 1997). But a recording of the game is squarely within the ***Act***. Indeed the 1976 amendment was made specifically to insure recorded transmissions of games would meet the fixed in tangible medium requirement. *Id.* At 847.

I didn't know that.

As to (2), the purpose of Copyright is to "supply the economic incentive to create and disseminate ideas." ***Harper & Row Publishers, Inc. v. Nation Enters,*** 471 U.S. 539, 558 (1985). The right-of-publicity rationale is "the desire to provide incentives to encourage a person's productive activities and to protect consumers from misleading advertising." ***C.B.C. Distribution & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.,*** 505 F.3d 818, 824 (8th Cir. 2008).

You have to read those several times.

Players are seeking to limit — through their right-of-publicity — the use of material in an expressive work. This puts the issue over into Copyright.

Players argued that the films are advertisements for "**NFL**-branded football," a product promoted for **NFL's** economic benefit. Three factors determine whether speech is commercial rather than expressive: "(i) whether the communication is an advertisement, (ii) whether it refers to a specific product or service, and (iii) whether the speaker has an economic motivation for the speech." ***Porous Media Corp. v. Pall Corp.,*** 173 F.3d 1109, 1120 (8th Cir. 1999).

The films fail to propose a commercial transaction and thus are not advertisements. Nowhere do they encourage consumers to buy a product or service. They tell the history of past contests. Consumer demand for the films proves they exist as "products" in their own right. People consume the films by buying them or subscribing to ESPN.

The economic motivation (iii) of the **NFL** does not convert the other two elements into commercial speech. ***Cf. Joseph Burstyn, Inc. v. Wilson,*** 343 U.S. 495, 501 (1952).

Lanham Act

The ***Lanham Act*** "prohibits false representations concerning the origin, association, or endorsement of goods or services through the wrongful use of another's distinctive mark, name, trade dress, or other device." ***Am. Ass'n of Orthodontists v. Yellow Book USA, Inc.,*** 434 F.3d 1100, 1103 (8th Cir. 2006).

Players claimed there was an issue of material fact as to the films falsely representing that they endorsed or currently associated themselves with the **NFL**. And yet they had nary an example of the films saying that.

The films show them playing. The **NFL** is shown in a positive light, but nothing shows **Players** agreeing. Indeed they were interviewed in the films and asked to express their opinions. They agreed to the interviews.