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Kym Carrier

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Right of Publicity: *Cardtoons, L.C. v. Major League Baseball Players Association*

I. Introduction

*In sum, it is unlikely that little leaguers will stop dreaming of the big leagues or major leaguers will start 'dogging it' to first base if MLBPA is denied the right to control the use of its members' identities in parody.*¹

The right of publicity is a legal theory which permits each individual to control and profit from the value of his or her name, likeness, image, or other aspects of identity.² Approximately one-half of the states recognize this right either by statute or common law.³ Oklahoma has one of the most expansive bodies of publicity law in the nation, with two separate statutory enactments, and explicit recognition of the common law right of publicity.⁴ But, it was in Oklahoma that a small start-up company called Cardtoons dared to challenge the Major League Baseball Players Association (MLBPA) by printing parodies of active major league players. The Tenth Circuit held that although Cardtoons violated the MLBPA's right of publicity under one of the Oklahoma statutes, the First Amendment protected Cardtoons' trading card parodies.⁵

First, this note briefly relates the history of the right of publicity, the right as it exists in Oklahoma, and discusses cases and developments which preceded the Cardtoons decision. The second section of this note examines two district court *Cardtoons* opinions and analyzes the Tenth Circuit's decision. Finally, this note interprets the effect the Tenth Circuit opinion will have on the right of publicity and its treatment in future court decisions.

II. Roots of the Right of Publicity

A. Early Years

The right of publicity is rooted in the more limited right of privacy, the right "to be let alone."⁶ The right of privacy can be traced to a law review article⁷ written in 1890 by two young Boston law partners, Samuel D. Warren and Louis D. Brandeis.⁸

1. *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 974 (10th Cir. 1996).

2. See Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 215-17 (1954).

3. See J. Thomas McCarthy, *The Human Persona as Commercial Property: The Right of Publicity*, 19 COLUM.-VLA J.L. & ARTS 129, 132 (1995).

4. See Lucian W. Beavers, *Oklahoma's Right of Publicity Laws*, 57 OKLA. B.J. 2612, 2612 (1986).

5. See *Cardtoons*, 95 F.3d at 976.

6. McCarthy, *supra* note 3, at 134.

7. See Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

8. Almost 40 years later, Justice Louis D. Brandeis wrote that the framers of the Constitution

Generally, the right of publicity differs from the right of privacy by protecting a commercial rather than a personal interest.⁹ Actions for infringement of the right of publicity may involve the use of some aspect of the celebrity identity in advertisements¹⁰ or the use of the celebrity's¹¹ name, likeness, or identity on products or merchandise.¹²

In 1953, a federal judge coined the term "right of publicity" in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*¹³ *Haelan*, appropriately enough, involved two chewing gum manufacturers in a dispute over the exclusive rights to use the image of a major league baseball player to promote their respective products. Rejecting an argument that the player only had a privacy right, a "personal and non-assignable right not to have his feelings hurt by such a publication,"¹⁴ the court found that "a man has a right in the publicity value of his photograph."¹⁵ The court explained:

This right might be called a "right of publicity." For it is common knowledge that many prominent persons (especially actors and ball-players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.¹⁶

Recognition of the right of publicity has spread to many American jurisdictions since 1953.¹⁷ The widespread acceptance of the right is largely attributable to an

"sought to protect Americans in their beliefs, their thoughts, their emotions and their sensations. They conferred, as against the Government, the right to be let alone - the most comprehensive of rights and the right most valued by civilized men." *Olmstead v. United States*, 277 U.S. 438, 478 (1928).

9. See *McCarthy*, *supra* note 3, at 134.

10. See, e.g., *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (imitation of distinctive voice); *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (replica of well-known race car driver's car).

11. Any person can assert a right of publicity claim. However, most actions involve celebrities because "there is little pecuniary gain in appropriating the name and likeness of an unknown individual." Fred M. Weiler, Note, *The Right of Publicity Gone Wrong: A Case for Privileged Appropriation of Identity*, 13 *CARDOZA ARTS & ENT. L.J.* 223, 224 n.8 (1994).

12. See, e.g., *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (portable toilets); *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981) (pendants); *Martin Luther King, Jr., Ctr. For Soc. Change, Inc. v. American Heritage Prods., Inc.*, 296 S.E.2d 697 (Ga. 1982) (plastic busts).

13. 202 F.2d 866, 868 (2d Cir. 1953).

14. *Id.*

15. *Id.*

16. *Id.*

17. See *McCarthy*, *supra* note 3, at 132.

article¹⁸ written by Melville Nimmer shortly after *Haelan*. Some form of the right of publicity is now viable in twenty-five states.¹⁹

The United States Supreme Court first acknowledged the existence of the right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*²⁰ Zacchini brought an action against a television station which aired his fifteen-second "human cannonball" act in its entirety. The station had taped his act at a local fair without Zacchini's permission. Zacchini claimed the station had appropriated his "professional property."²¹ An Ohio state court found that although Zacchini had a "right to the publicity value of his performance,"²² the First Amendment protected the station's broadcast.²³ The United States Supreme Court reversed the Ohio court's decision, holding that the First Amendment does not allow the media to appropriate a performer's entire act, thereby threatening the economic value of the performance.²⁴

B. The Right of Publicity in Oklahoma

Oklahoma has one of the most expansive bodies of publicity law in the nation.²⁵ Oklahoma recognizes three separate causes of action for the wrongful appropriation of an individual's identity: two statutory enactments²⁶ and a common law right of publicity.²⁷ Oklahoma's privacy statute, enacted in 1965, prohibits the unconsented use of a person's name or picture in advertising.²⁸ In 1986, Oklahoma enacted a much broader publicity statute,²⁹ which does not limit the control of an individual's publicity right to advertising purposes.

C. The Climate Prior to *Cardtoons*

The right of publicity has expanded over the past forty years. Commentators have argued that the decision in *White v. Samsung Electronics America, Inc.*³⁰ took "the right of publicity to its farthest reach yet"³¹ and protest that the right has expanded to the point of conflicting with the First Amendment.³²

18. See Nimmer, *supra* note 2.

19. See McCarthy, *supra* note 3, at 132.

20. 433 U.S. 562 (1977).

21. *Id.* at 564.

22. *Id.* at 565-66.

23. See *id.*

24. See *id.* at 575.

25. See Beavers, *supra* note 4, at 2612.

26. See 21 OKLA. STAT. §§ 839.1-839.3 (1991); 12 OKLA. STAT. §§ 1448-1449 (1991).

27. See McCormack v. Oklahoma Publ'g Co., 613 P.2d 737, 740 (Okla. 1980).

28. See 21 OKLA. STAT. § 839.1 (1991).

29. See 12 OKLA. STAT. § 1449 (1991).

30. 971 F.2d 1395 (9th Cir. 1992).

31. Stephen R. Barnett, *First Amendment Limits on the Right of Publicity*, 30 TORT & INS. L.J. 635, 638 (1995).

32. See *id.* at 637; Gretchen A. Pemberton, *The Parodist's Claim to Fame: A Parody Exception to the Right of Publicity*, 27 U.C. DAVIS L. REV. 97, 100 (1993); Douglas J. Ellis, Comment, *The Right of Publicity and the First Amendment: A Comment on Why Celebrity Parodies are Fair Game for Fair Use*, 64 U. CIN. L. REV. 575, 579 (1996); Linda J. Stack, Note, *White v. Samsung Electronics, Inc.'s Expansion of the Right of Publicity: Enriching Celebrities at the Expense of Free Speech*, 89 NW. U. L.

In 1992, Vanna White, the hostess of the game show "Wheel of Fortune," brought a right of publicity action against Samsung, alleging that Samsung had used her identity in a humorous magazine advertisement for video cassette recorders. The advertisement featured a robot, dressed to resemble White, turning letters on a game board. The caption read "Longest-running game show, 2012 A.D." The joke was that Samsung recorders would still be around even after White had been replaced by a robot. The Ninth Circuit found that White did not have a claim under California's publicity statute because the statute only proscribed the commercial use of one's "name, voice, signature, photograph, or likeness,"³³ and the robot was not White's likeness.³⁴ The court did find, however, that Samsung's use was sufficient to "evoke" White's identity, thus infringing on White's common-law right of publicity.³⁵ White subsequently recovered \$403,000.³⁶

When the Ninth Circuit denied a rehearing, Judge Kozinski, in his dissent, unleashed unabashed criticism of the court's cursory dismissal of Samsung's First Amendment claim: "[T]he last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them."³⁷ Many commentators agreed with Judge Kozinski, fearing that *White* foreclosed any future commercial use of parody.³⁸

Then in 1994, the United State Supreme Court upheld the commercial use of parody in *Campbell v. Acuff-Rose Music, Inc.*³⁹ In *Campbell*, a rap music group parodied a 1960s rock ballad. The Court held that 2 Live Crew's "Pretty Woman" could be found a fair use of Roy Orbison's "Oh, Pretty Woman."⁴⁰ Although *Campbell* is a copyright infringement case, commentators eagerly awaited its application to the next right of publicity action involving a parody.⁴¹ In pursuit of consistency, commentators long had promoted the use of copyright's fair use doctrine⁴² in right of publicity

REV. 1189, 1209 (1995).

33. *White*, 971 F.2d at 1397 (citing CAL. CIV. CODE § 3344(a)).

34. *See id.*

35. *See id.* at 1399.

36. *See Vanna White Wins Suit Over Ad With Look-Alike Robot*, S.F. CHRON., Jan. 21, 1994, at C13.

37. *White v. Samsung Electronics America, Inc.*, 989 F.2d 1512, 1519 (9th Cir. 1993) (Kozinski, J., dissenting).

38. *See supra* notes 31-32 and accompanying text.

39. 510 U.S. 569 (1994).

40. *See id.* at 594.

41. *See, e.g.*, Ellis, *supra* note 32. At least one commentator, presuming the Tenth Circuit would utilize fair use analysis, encouraged the court to refuse to distinguish between advertising and commercial products in the court's analysis of the first prong. *See* Michael E. Hartmann & Daniel R. Kelly, *Parody (of Celebrities, in Advertising), Parity (Between Advertising and Other Types of Commercial Speech), and (the Property Right of) Publicity*, 17 HASTINGS COMM. & ENT. L.J. 633, 687 (1995).

42. The fair use doctrine sets forth four factors to be considered in determining whether a use of copyrighted material qualifies as a "fair use," thus making the use permissible. This exception strives to accommodate the First Amendment. *See* 17 U.S.C. § 107 (1994); *see also infra* note 71 (setting out the four factors).

analysis.⁴³ Undoubtedly, many assumed that the Tenth Circuit would apply the Supreme Court's fair use analysis to *Cardtoons*.⁴⁴

Over the years, numerous factors emerged which indicated that copyright's fair use analysis would be the appropriate analytical vehicle for right of publicity cases. For example, in *Zacchini*, the Supreme Court found that the state's interest in a right of publicity action was analogous to its interest in a copyright or patent action.⁴⁵ In addition, the Court found that the goals of the right of publicity were analogous to those of the laws of copyright.⁴⁶ The advantages of employing fair use analysis are numerous. According to one proponent of its use:

By utilizing the copyright analogy in right of publicity decisions, courts can inject uniformity and predictability into an area of law marred by inconsistent and often conflicting determinations among sister states. Because copyright is of constitutional origin, judges can draw upon an extremely well-developed body of copyright case law to assist their resolution of publicity right issues. Moreover, because the policies underlying both the right of publicity and copyright are similar, the copyright analogy is especially apt.⁴⁷

Although not all commentators agreed that fair use analysis was appropriate for right of publicity cases,⁴⁸ most endorsed some version of such analysis.⁴⁹ The highly criticized *White* opinion, combined with the Supreme Court's application of the fair use doctrine to a parody, seemed to set the stage for a court to embrace copyright's fair use doctrine in a right of publicity case.

III. *Cardtoons, L.C. v. Major League Baseball Players Association*

A. Facts

Cardtoons, L.C., a Tulsa-based company formed in late 1992, designed a series of baseball trading cards that parodied active major league baseball players and teams. The cards used recognizable caricatures, team colors, and names, so that anyone familiar with the game would have little difficulty identifying the targeted players. The

43. See, e.g., Randall T.E. Coyne, *Toward a Modified Fair Use Defense in Right of Publicity Cases*, 29 WM. & MARY L. REV. 781, 782 (1988); H. Lee Hetherington, *Direct Commercial Exploitation of Identity: A New Age for the Right of Publicity*, 17 COLUM.-VLA J.L. & ARTS 1, 28-30 (1992).

44. Chief Judge Ellison applied the fair use doctrine and found that *Cardtoons'* trading cards were indeed a fair use. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 868 F. Supp. 1266, 1271-75 (N.D. Okla. 1994). His 1994 decision was affirmed by the Tenth Circuit. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 974 (10th Cir. 1996).

45. See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977).

46. See *id.*

47. Coyne, *supra* note 43, at 814.

48. See, e.g., Roberta Rosenthal Kwall, *The Right of Publicity vs. The First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 58 (1994) (arguing that the automatic invocation of the copyright fair use analysis in cases presenting a conflict between First Amendment and right of publicity is inappropriate).

49. See *supra* note 43 and accompanying text.

cards poked fun at a variety of aspects of baseball, including the players' large salaries,⁵⁰ the players' large egos,⁵¹ and the slow pace of the game.⁵² The MLBPA serves as the exclusive collective bargaining agent for all active major league baseball players.⁵³ The MLBPA threatened Cardtoons with legal action if it marketed the trading cards. Cardtoons responded by seeking a declaratory judgment in federal district court to determine whether the parody baseball cards would infringe upon the publicity rights of players represented by the MLBPA.⁵⁴

B. The Magistrate's Report: Cardtoons I

In 1993, a federal magistrate held that Cardtoons had improperly infringed upon the publicity rights of the baseball players parodied in their cards.⁵⁵ The magistrate first found that Cardtoons' use of the players' identity was for a "purely commercial purpose"⁵⁶ and in violation of Oklahoma's publicity statute,⁵⁷ thus leading to the question: "Is there a First Amendment 'parody' defense for a commercial product under a balancing approach?"⁵⁸ Finding no case in which a First Amendment parody defense was successful to a right of publicity claim,⁵⁹ the magistrate examined First Amendment defenses under both trademark⁶⁰ and copyright law.⁶¹ The magistrate found that First Amendment parody defenses are generally denied to commercial uses.⁶² Finally, the magistrate balanced Cardtoons' *use* (commercial) and *type of medium* (product) against the MLBPA's property rights and the ramifications of a decision allowing Cardtoons' defense in this case.⁶³ The magistrate concluded that

50. One card featured San Francisco Giant Barry Bonds, who had just signed a six-year, \$43.75 million contract at the end of the 1992 season. The card called him "Treasury Bonds" of the "Gents." See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 962-63 (10th Cir. 1996).

51. A card featured "Egotisticky Henderson" (Ricky Henderson) of the "Pathetics" (Oakland Athletics) accepting the "Me-Me Award," saying: "I would just like to thank myself for all I have done. (Pause for cheers.)" *Id.* at 963.

52. Another card featured "Cal Ripkenwinkle" (Baltimore Orioles' Cal Ripken). The card said "he once fell asleep in the first inning and, when he awoke 20 years later, the game was still going. So he proposed several rules to speed up play. Among them: Players may scratch themselves only between innings." Robert Facht, *Baseball Doesn't See What's So Funny*, WASH. POST, July 9, 1993, at C2.

53. The cards included the following disclaimer: "Cardtoons Baseball is a parody and is NOT licensed by Major League Baseball Properties or Major League Baseball Players Association." *Cardtoons*, 95 F.3d at 962. Since 1966, the MLBPA has operated a group licensing program in which it acts as the assignee of individual publicity rights for all active major league baseball players. It has entered numerous licensing agreements for a variety of products, the most lucrative being baseball trading cards which account for 70% of its licensing revenue. See *id.* at 963.

54. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 838 F. Supp. 1501 (N.D. Okla. 1993).

55. See *id.* at 1521.

56. *Id.* at 1515.

57. See *id.* at 1512.

58. *Id.* at 1515.

59. See *id.*

60. See *id.* at 1516-18.

61. See *id.* at 1518-19.

62. See *id.* at 1519.

63. See *id.* at 1519-21.

Cardtoons has a First Amendment right to parody baseball cards or players, but only in a "non-commercial venue."⁶⁴ The district court adopted the magistrate's report and entered a declaratory judgment for the MLBPA.⁶⁵

C. *Cardtoons II*

Almost a year later, the district court set aside the above-described judgment, finding for Cardtoons.⁶⁶ The district court decided to reconsider its earlier ruling so that it could determine the effect of the Supreme Court's interim decision in *Campbell v. Acuff-Rose Music, Inc.*⁶⁷

The district court first employed the magistrate's three-part test to determine whether Cardtoons had violated the Oklahoma statute.⁶⁸ The district court found that the MLBPA had proved that Cardtoons: "(1) 'knowingly' used MLBPA's 'name' or 'likeness;' (2) on 'products, merchandise or goods;' (3) without MLBPA's prior consent."⁶⁹ Once the MLBPA had proved each of the elements required by Oklahoma's statute, held the district court, the burden shifted to Cardtoons to raise a valid defense.⁷⁰ The district court then applied fair use analysis⁷¹ and found that the trading cards constituted a "fair use."⁷² Furthermore, the district court found that a parody exception to Oklahoma's right of publicity statute was necessary to accommodate the First Amendment.⁷³

D. *Cardtoons III*

In August 1996, the Tenth Circuit affirmed the district court's judgment for Cardtoons, but rejected the district court's fair use analysis.⁷⁴ The Tenth Circuit identified three steps necessary to the analysis of *Cardtoons*.⁷⁵ First, the court would need to determine whether the trading cards infringed upon the MLBPA's property rights as established by Oklahoma's right of publicity statute.⁷⁶ Second, if a violation

64. *Id.* at 1521.

65. *See id.* at 1503.

66. *See Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 868 F. Supp. 1266, 1275 (N.D. Okla. 1994).

67. 510 U.S. 569 (1994) (upholding parody First Amendment defense to a copyright infringement claim).

68. *See Cardtoons*, 868 F. Supp. at 1269 (applying 12 OKLA. STAT. § 1449 (1985)).

69. *Id.* (quoting *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 838 F. Supp. 1501, 1511 (N.D. Okla. 1993)).

70. *See id.*

71. The four fair use factors to be considered are: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work. *See Cardtoons*, 868 F. Supp. at 1271 (citing 17 U.S.C. § 107).

72. *See id.* at 1274.

73. *See id.* at 1275.

74. *See Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 971 (10th Cir. 1996).

75. *See id.* at 966.

76. *See id.* (citing 12 OKLA. STAT. § 1449(A) (Supp. 1985)). The Tenth Circuit also determined whether the trading cards violated the MLBPA's rights under section 43(a)(1) of the Lanham Act, 15

was found, the court would need to determine whether the First Amendment protected the cards.⁷⁷ Finally, if both *Cardtoons* and the MLBPA were determined to have rights at stake, the court would need to balance the parties' respective rights.⁷⁸

1. Step One: Infringement of the Publicity Statute

The Tenth Circuit found that *Cardtoons* had violated the three elements of the Oklahoma publicity statute.⁷⁹ Furthermore, the Tenth Circuit found that the two exceptions provided for in the statute offered "no haven for *Cardtoons*";⁸⁰ the cards could not be characterized as either a "news" exception⁸¹ or an "incidental use" exception.⁸² Thus, finding that *Cardtoons* had infringed on the MLBPA's publicity rights under the Oklahoma statute, the Tenth Circuit addressed the second step of its analysis: Whether *Cardtoons*' parody baseball cards are protected by the First Amendment.⁸³

2. Step Two: Ascertaining the level of First Amendment Protection for the Trading Cards

Resolving the second step of its analysis was not so easy for the court. The necessity of determining the level of First Amendment protection of parody baseball cards delivered the Tenth Circuit into a hazy stretch of law marked by few clear landmarks or road signs. First, as a preliminary matter, the Tenth Circuit found that the application of Oklahoma's statute was sufficient to satisfy the requirement that the alleged encroachment on speech protected by the First Amendment has been made by a government actor.⁸⁴ The Tenth Circuit was next faced with the task of characterizing the type of speech to which the cards belonged, thus entering the murky waters of "commercial speech" identification. Commercial speech is generally defined as advertising or speech that does no more than propose a commercial transaction.⁸⁵ However, identifying commercial uses, or products sold for profit, can sometimes be confusing. For example, the magistrate judge in the first *Cardtoons* opinion found that the trading cards were not entitled to First Amendment protection because commercial speech receives limited constitutional protection, and commercial speech that is a product is entitled to even less protection.⁸⁶

U.S.C. § 1125(a)(1) (1994). See *Cardtoons*, 95 F.3d at 966-67. The possibility of a claim under the Lanham Act provided the basis for the court's jurisdiction. See *id.* at 966. The court disposed of the Lanham Act claim rather quickly, finding that the cards did not infringe on MLBPA's rights under the Act because the cards did not create a likelihood of confusion. See *id.* at 967.

77. See *id.* at 966.

78. See *id.*

79. See *id.* at 968.

80. *Id.*

81. See *id.* at 968 (citing 12 OKLA. STAT. § 1449(D) (Supp. 1985)).

82. See *id.* (citing 12 OKLA. STAT. § 1449(F) (Supp. 1985)).

83. See *id.*

84. See *id.* at 968-69 (citing *New York Times Co. v. Sullivan*, 376 U.S. 254, 265 (1964)).

85. See *Virginia State Bd. Of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) (citing *Pittsburgh Press Co. v. Human Relations Comm'n*, 413 U.S. 376, 385 (1972)).

86. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 838 F. Supp. 1501, 1520 (N.D.

The Tenth Circuit, however, found that *Cardtoons'* parody trading cards were entitled to full First Amendment protection because they were not commercial speech.⁸⁷ The Tenth Circuit held that the cards do not advertise another product,⁸⁸ and the fact that the trading cards are sold for profit does not transform them into commercial speech.⁸⁹ The Tenth Circuit found that the cards provide "social commentary on public figures . . . who are involved in a significant commercial enterprise."⁹⁰ Furthermore, the Tenth Circuit found that the humorous aspect of the cards makes them no less protected than if they had provided serious commentary.⁹¹ Specifically, the Tenth Circuit acknowledged that parody has long been recognized as a literary device which provides valuable social commentary.⁹² Furthermore, "cartoons and caricatures, such as those in the trading cards, have played a prominent role in public and political debate throughout our nation's history."⁹³

The MLBPA had argued that *Cardtoons* should receive less First Amendment protection because it "fail[ed] to use a traditional medium of expression."⁹⁴ The Tenth Circuit, however, rejected this argument, finding that even untraditional media are entitled to First Amendment protection.⁹⁵ Several "untraditional forms of expression"⁹⁶ have been recognized by the Supreme Court as deserving of First Amendment protection, noted the Tenth Circuit, including "flag burning,"⁹⁷ "nude dancing,"⁹⁸ and "wearing a jacket bearing the words 'Fuck the Draft.'"⁹⁹

The Tenth Circuit found that "even if less common mediums of expression were to receive less First Amendment protection (perhaps out of concern for whether they contain any expression at all), trading cards do not fall into that category."¹⁰⁰ The Tenth Circuit found that baseball trading cards have traditionally informed the public about baseball players,¹⁰¹ providing an "education in baseball."¹⁰² Therefore, the Tenth Circuit found that *Cardtoons'* trading cards are entitled to First Amendment protection because they are an important form of expression.¹⁰³

Okla. 1993) (citing *Central Hudson v. Public Serv. Comm'n*, 447 U.S. 557, 563 (1980)).

87. *See Cardtoons*, 95 F.3d at 970.

88. *See id.*

89. *See id.* (citing *Virginia State Bd. of Pharmacy*, 425 U.S. at 761).

90. *Id.* at 969.

91. *See id.*

92. *See id.* (citing *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 28 (1st Cir. 1987)).

93. *Id.* (citing *Hustler Magazine v. Falwell*, 485 U.S. 46, 53-55 (1988)).

94. *Id.*

95. *See id.*

96. *Id.*

97. *See id.* (citing *Texas v. Johnson*, 491 U.S. 397 (1989)).

98. *See id.* (citing *Schad v. Mount Ephraim*, 452 U.S. 61 (1981)).

99. *See id.* (citing *Cohen v. California*, 403 U.S. 15 (1971)).

100. *Id.*

101. *See id.*

102. *Id.* (citing *Fleer Corp. v. Topps Chewing Gum, Inc.*, 501 F. Supp. 485, 495-96 (E.D. Pa. 1980)).

103. *See id.*

3. Step Three: Balancing the MLBPA's Property Right Against Cartoons' First Amendment Right to Free Expression

Finally, the Tenth Circuit approached the task of balancing Cartoons' free speech rights with the MLBPA's property rights. The Tenth Circuit acknowledged that copyright's fair use doctrine provided a First Amendment safeguard for copyright cases.¹⁰⁴ The Tenth Circuit even cited *Campbell* as a recent Supreme Court decision that applied the fair use doctrine to parody.¹⁰⁵ But then, without explanation, the Tenth Circuit rejected the district court's application of the fair use doctrine to *Cartoons*, finding that "Oklahoma's right of publicity statute . . . does not provide a similar accommodation for parody, and we must therefore confront the First Amendment issue directly."¹⁰⁶

The Tenth Circuit examined the value of parody to society, finding that in order to effectively criticize, parodists must use images and symbols that are familiar to society.¹⁰⁷ Furthermore, the Tenth Circuit found that without First Amendment protection, Oklahoma's statute would require Cartoons to obtain permission to publish its criticism.¹⁰⁸ The Tenth Circuit found that this would "allow MLBPA to censor criticism of its members"¹⁰⁹ and also would "have a chilling effect upon future celebrity parodies."¹¹⁰ Therefore, the Tenth Circuit found that Cartoons' right to free speech "implicates some of the core concerns of the First Amendment."¹¹¹

Next, the Tenth Circuit identified the consequences of infringing upon the MLBPA's right of publicity. The Tenth Circuit identified both economic and noneconomic justifications for the right of publicity.¹¹² The economic arguments for the right of publicity include the incentive it provides for "creativity and achievement,"¹¹³ its promotion of the "efficient allocation of resources,"¹¹⁴ and the protection the right of publicity provides "against consumer deception."¹¹⁵ The noneconomic justifications for the right of publicity are that it "stem[s] from some notion of natural rights,"¹¹⁶ it allows "celebrities to enjoy the fruits of their labors,"¹¹⁷ it prevents "unjust enrichment,"¹¹⁸ and it "prevents emotional injuries."¹¹⁹ The Tenth Circuit then balanced

104. *See id.* at 970-71.

105. *See id.* at 971.

106. *Id.*

107. *See id.* at 972.

108. *See id.*

109. *Id.* at 973.

110. *Id.*

111. *Id.* at 972.

112. *See id.* at 973.

113. *Id.*

114. *Id.* at 974.

115. *Id.* at 975.

116. *Id.*

117. *Id.*

118. *Id.* at 976.

119. *Id.*

Cardtoons' First Amendment right of free speech against these justifications for the right of publicity.¹²⁰

The Tenth Circuit recognized that the economic arguments that support the right of publicity are somewhat similar to the underlying policies of copyright and patent law.¹²¹ The Tenth Circuit found, however, that the economic incentive argument has little application to celebrity parodies.¹²² The Tenth Circuit recognized that people attain celebrity through diverse means including practice, natural talent, and luck.¹²³ The Tenth Circuit found that celebrities are usually well compensated and that unpaid publicity, particularly parodic uses, would not discourage people to attain celebrity status.¹²⁴

Finally, the Tenth Circuit found that the noneconomic justifications did not stand up against Cardtoons' right of free expression.¹²⁵ The Tenth Circuit found that these noneconomic arguments were particularly tenuous in the context of celebrity parody because the right of publicity would then be "reduced to the power to suppress criticism."¹²⁶

The Tenth Circuit concluded that the application of Oklahoma's publicity statute to Cardtoons' trading cards was a classic case of overprotection.¹²⁷ The court found little benefit in allowing the MLBPA control of the use of baseball players' identities in parody trading cards.¹²⁸ In addition, the court found that the cards are an "important form of entertainment and social commentary that deserve First Amendment protection."¹²⁹

IV. The Legacy of Cardtoons

The Tenth Circuit's affirmation of the district court's decision is not surprising. The only truly surprising aspect of its decision is the route the court took to get there. For a decade, commentators have endorsed copyright fair use analysis in right of publicity cases.¹³⁰ The district court wholeheartedly adopted such analysis in its *Cardtoons* decision.¹³¹ But the Tenth Circuit, with little explanation, rejected copyright fair use analysis and chose instead to confront the First Amendment issues head-on.¹³²

The effect of the Tenth Circuit's decision on at least one segment of the trading card market is clear: *Cardtoons* creates an exception in the right of publicity for trading

120. *See id.*

121. *See id.* at 973.

122. *See id.* at 976.

123. *See id.* at 975-76.

124. *See id.* at 974.

125. *See id.* at 976.

126. *Id.*

127. *See id.*

128. *See id.*

129. *Id.*

130. *See supra* note 43 and accompanying text.

131. *See Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 868 F. Supp. 1266, 1271 (N.D. Okla. 1994).

132. *See Cardtoons*, 95 F.3d at 970-71.

card parodists. One company began selling trading card parodies of National Basketball Association (NBA) players in 1994.¹³³ The NBA did not file an action against that company, choosing to await the outcome of *Cardtoons*.¹³⁴ Other sports cards' parodists will surely join the market.

Another consequence, perhaps not considered by the Tenth Circuit, is much more intriguing. The court may very well have opened the door for unlicensed manufacture of all trading cards - even those of a more traditional ilk. In its attempt to avoid the "commercial use" problem, the court made sweeping proclamations regarding all baseball trading cards, not just parodic cards. With its proclamation that trading cards are "an education in baseball"¹³⁵ and entitled to the level of First Amendment protection granted to other traditional media, the court may have elevated baseball cards to the same level of protection as is given books, magazines, and television broadcasts. Prior to *Cardtoons* it was well established that traditional media could publish stories about professional athletes, which include photographs and statistics.¹³⁶ If trading cards demand the same level of First Amendment protection as traditional media - if they are in fact "education[s] in baseball"¹³⁷ - then licenses may no longer be required for any trading card publisher, even baseball card companies like Fleer, Topps, and Upper Deck.¹³⁸

The commentators who hoped that the Tenth Circuit would carve out a parody First Amendment defense to right of publicity cases for advertisers should be disappointed.¹³⁹ The court explicitly found that the analysis would be different for commercial speech.¹⁴⁰ The court treated *Cardtoons*' trading cards as analytically distinct from advertising or commercial speech.¹⁴¹ The court found that *Cardtoons*'

133. In October 1994, First Amendment Publishing, Inc. of New York (owned by Joseph Mauro) began selling its trading cards, "Skinsies," which parody NBA players. See Joseph Mauro, *Impact of 'Cardtoons' on Intellectual Property Law*, N.Y.L.J., Feb. 10, 1995, at 7.

134. The Tenth Circuit granted First Amendment Publishing, Inc.'s motion for leave to file an amicus curiae brief. See *Cardtoons*, 95 F.3d at 976.

135. *Id.* at 969 (citing *Fleer Corp. v. Topps Chewing Gum, Inc.*, 501 F. Supp. 485, 495-96 (E.D. Pa. 1980)).

136. In the first *Cardtoons*, the magistrate judge suggests that "Cardtoons could parody the sport (and its players) in a traditional forum such as a book or magazine," without infringing upon the MLBPA's publicity rights. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 838 F. Supp. 1501, 1521 (N.D. Okla. 1993).

137. *Cardtoons*, 95 F.3d at 969 (citing *Fleer Corp. v. Topps Chewing Gum, Inc.*, 501 F. Supp. 485, 495-96 (E.D. Pa. 1980)).

138. In 1993, the MLBPA authorized six companies to manufacture and sell trading cards depicting its members: Topps, Fleer, Score, Upperdeck, Leaf/Donruss, and Pacific. The MLBPA also granted two limited licenses that year. See *Cardtoons*, 838 F. Supp. at 1525. The baseball trading card business generates an estimated \$1.4 billion in annual sales. The six card companies pay royalties to the MLBPA, which in turn distributes proportionate shares to its player members. See *Spoofing Baseball Cards Parodists Striking Out with Players*, ARIZ. REPUBLIC (Phoenix), Sept. 4, 1995, at B6, available in 1995 WL 2825746.

139. See, e.g., Hartmann & Kelly, *supra* note 41, at 687.

140. "This efficiency argument is most persuasive in the context of advertising, where repeated use of a celebrity's likeness to sell products may eventually diminish its commercial value." *Cardtoons*, 95 F.3d at 975.

141. See *id.* at 970.

parody trading cards, unlike advertising or commercial speech, were entitled to full First Amendment protection.¹⁴²

The Tenth Circuit dealt the largest disappointment to those commentators who viewed *Cardtoons* as a ripe opportunity for a federal court to embrace fair use analysis and thereby inject a greater consistency into right of publicity jurisprudence.¹⁴³ The Tenth Circuit analyzed both economic and noneconomic justifications for the right of publicity.¹⁴⁴ These justifications, however, were gleaned from several different sources, with only two of the justifications coming from Supreme Court right of publicity jurisprudence: the incentive for creativity and achievement, and the avoidance of unjust enrichment.¹⁴⁵ Therefore, the Supreme Court could offer little guidance in the Tenth Circuit's analysis of the case because many of the factors considered came from a variety of sources¹⁴⁶ outside the Court.

The Supreme Court's recent application of fair use analysis to a parody¹⁴⁷ could have provided the Tenth Circuit with on-point guidance if the Tenth Circuit had adopted fair use analysis in *Cardtoons*. The fair use doctrine employs the weighing of four factors to determine if a use falls within the fair use exception.¹⁴⁸ The factors include:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.¹⁴⁹

These factors are not to be rigidly applied, and no single factor should be dispositive of the issue.¹⁵⁰

The district court had applied fair use analysis to *Cardtoons*, relying heavily upon the Supreme Court's decision in *Campbell*.¹⁵¹ The district court found that *Cardtoons'* trading cards were a commercial use under the first guideline,¹⁵² the "purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes."¹⁵³ The court noted that in *Campbell*, the Supreme Court found that a parody sold for profit is entitled to more First Amendment

142. See *id.*

143. See *supra* note 43 and accompanying text.

144. See *supra* text accompanying notes 112-26.

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

146. See, e.g., *McCarthy*, *supra* note 3.

147. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 572 (1994).

148. See 17 U.S.C. § 107 (1994).

149. *Id.*

150. See *Campbell*, 510 U.S. at 577-78.

151. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 868 F. Supp. 1266, 1272 (N.D. Okla. 1994).

152. See *id.* at 1272-73.

153. *Id.* at 1272 (citing 17 U.S.C. § 107(1) (1994)).

protection than a parodic advertisement.¹⁵⁴ Thus, the court found that *Cardtoons'* parodies were a fair use under this guideline.¹⁵⁵

The district court found that the second guideline, "the nature of the copyrighted work," was inapplicable to this analysis because the nature of a likeness is factual, not creative.¹⁵⁶ The court noted that this factor is intended to provide greater protection to creative works and less protection to works that are more informational or functional.¹⁵⁷ Because the court may use its discretion in the use of these guidelines or the consideration of any additional factors, the district court discounted this guideline from its analysis.¹⁵⁸

The third guideline is "the amount and substantiality of the portion used in relation to the copyrighted work as a whole."¹⁵⁹ In a parody context, this guideline's goal is to ascertain whether more of the original was taken than necessary to achieve a successful parody. *Cardtoons* used caricatures rather than photographs of the players. The district court found that *Cardtoons* could have accomplished its purpose with a more extensive use of the "original" by using photographs, but could not have succeeded with anything less.¹⁶⁰ Therefore, the court found that the third factor weighed in favor of fair use.¹⁶¹

Finally, the fourth guideline is "the effect of the use upon the potential market for or value of the copyrighted work."¹⁶² This factor is the most important consideration of fair use analysis.¹⁶³ The district court identified the principal query as whether the sale of *Cardtoons'* parodic trading cards would usurp the market for traditional cards. The court found this unlikely primarily because of the differences between the two types of cards.¹⁶⁴ Traditional cards use photographs and statistical data; *Cardtoons'* cards use cartoons and irrelevant commentary.¹⁶⁵ The court found that the parody cards are not a "substitute product" for traditional cards even though some people may indeed buy both types of cards.¹⁶⁶ Therefore, the court concluded that this guideline also weighed in favor of fair use.¹⁶⁷

The district court thus found that three of the fair use guidelines weighed in favor of finding that *Cardtoons'* trading cards were a fair use of the players' likenesses, and one guideline was inapplicable to the right of publicity.¹⁶⁸ The Tenth Circuit refused,

154. *See id.* at 1273.

155. *See id.* at 1272-73.

156. *See id.* at 1273 (citing 17 U.S.C. § 107(2) (1994))

157. *See id.*

158. *See id.*

159. 17 U.S.C. § 107(3) (1994).

160. *See Cardtoons*, 868 F. Supp. at 1273-74.

161. *See id.* at 1274.

162. 17 U.S.C. § 107(4) (1994).

163. *See Cardtoons*, 868 F. Supp. at 1274 (citing *Fisher v. Dees*, 794 F.2d 432, 437 (9th Cir. 1986) (quoting *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 566 (1985))).

164. *See id.*

165. *See id.*

166. *See id.*

167. *See id.*

168. *See id.*

however, to utilize the district court's fair use analysis despite the seemingly perfect timing and the widespread support of its application to the right of publicity.

It seemed that without question, *Cardtoons* was the perfect publicity case for the application of fair use analysis for three reasons. First, it followed so closely behind the Supreme Court's decision in *Campbell*. Second, the claimed infringement in both cases was a commercial product. In *Campbell*, the product was a popular song; in *Cardtoons*, the product was trading cards. Finally, and particularly significant, was the fact that both products were parodies of the originals.

Certainly the district court had recognized the applicability of the *Campbell* analysis to *Cardtoons*. The court had cited the *Campbell* decision as its primary reason for rejecting the earlier magistrate's decision. The district court effectively applied the Supreme Court's fair use analysis to *Cardtoons*. The Tenth Circuit affirmed the district court's decision, but rejected the district court's fair use analysis. In doing so, the Tenth Circuit left publicity jurisprudence in the same confused state in which the court found it.

V. Conclusion

The Tenth Circuit carved out a First Amendment exception to Oklahoma's right of publicity statute. This exception will clearly protect parodies used in non-commercial speech. Non-parodic speech, and even advertising parodies, will have to fight their own battle to claim First Amendment protection in right of publicity actions. Courts that decide future right of publicity cases will have to choose the type of analysis that seems appropriate in each case. Courts may follow the Tenth Circuit and identify the underlying justification for one party's right of publicity and balance that against the cost of infringing upon the opposing party's First Amendment rights of free expression. Or, perhaps, some court in the future will apply the well-developed fair use doctrine to right of publicity cases.

It is possible that a trading card company may interpret the Tenth Circuit's opinion as a green light to publish unlicensed trading cards, regardless of whether the cards are parodic in nature. The Tenth Circuit's proclamation that trading cards are "an education in baseball" and, therefore, entitled to the same First Amendment protection as traditional media, may have raised trading cards to the protection level enjoyed by books, magazines, and television broadcasts. The district court had avoided this construction in its fair use analysis. Although this construction was surely not intended by the Tenth Circuit, it could provide support to a trading card publisher looking to increase its bottom line by avoiding the expense of licensing.

Finally, no one is trying to promote a bright line test for right of publicity cases. Like in copyright, the respective interests of the parties must be balanced. But balancing tests can sometimes deteriorate into juggling acts, and a clear description of the preliminary factors to be weighed would provide the desired consistency necessary for courts to avoid calamity.

Kym Carrier

