

AROUND THE DIAMOND AND OUTFIELD: NINE BASEBALL CASES DEFINING AND LIMITING THE RIGHT OF PUBLICITY THAT ESTABLISH A JUDICIAL PARADIGM

*Matthew J. Mitten**

Courts initially refused to characterize celebrity names and likenesses as protectable property rights. In *Hanna Manufacturing. Co. v. Hillerich & Bradsby Co.*, the United States Court of Appeals for the Fifth Circuit reversed the district court's holding that "[b]aseball players, like any other individuals, have a property right to their names."¹ The court reasoned, "[f]ame is not merchandise. It would help neither sportsmanship nor business to uphold the sale of a famous name to the highest bidder as property."² The court ruled that a baseball player has a valid claim for the unauthorized commercial use of his name on a bat only if such usage falsely suggests that he uses or endorses the product, thereby constituting unfair competition.³

Subsequently, at least nine other baseball cases have shaped or significantly influenced the evolution of state law protection of publicity rights, as well as federal statutory and constitutional limits thereon. By recognizing and broadly defining the scope of an individual's publicity rights, these cases have provided the playing field for a multi-billion dollar market for athlete and celebrity product and service endorsements, in which some athletes earn more money than they do for playing or participating in their respective sports.⁴ These judicial precedents advance consumer

*Professor of Law and Director, National Sports Law Institute and LL.M. in Sports Law for Foreign Lawyers, Marquette University Law School; President, Sports Lawyers Association.

¹ *Hanna Mfg. Co. v. Hillerich & Bradsby Co.*, 78 F.2d 763, 766 (5th Cir. 1935).

² *Id.*

³ *Id.* at 765-66.

⁴ Corey Nachman, 7 "Athletes" who Made More Money Endorsing Products than Playing Sports in the Past Year, BUSINESS INSIDER (July 7, 2011, 5:27 PM), <http://www.businessinsider.com/athlete-endorsements-2011-2011-7>.

welfare by facilitating the development of numerous collateral products such as parody trading cards, fantasy games, and daily fantasy games such as Fan Duel and Draft Kings, which incorporate without authorization various aspects of baseball players' identities and/or athletic accomplishments deemed to be part of the public domain.

In *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, the United States Court of Appeals for the Second Circuit recognized, for the first time, the existence of an individual's common law right of publicity under New York law in a case involving the unauthorized use of Major League Baseball players' names and photographs on baseball cards.⁵ The court stated:

[A] man has a right in the publicity value of his photograph . . . and that such a grant may validly be made "in gross," i.e., without an accompanying transfer of a business or of anything else. Whether it be labelled a "property" right is immaterial; for here, as often elsewhere, the tag "property" simply symbolizes the fact that courts enforce a claim which has pecuniary worth.⁶

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.⁷

Thereafter, other courts broadly expanded the right of publicity beyond a baseball player's name and likeness to encompass unique individual attributes or characteristics such as

⁵ *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868-69 (2d Cir. 1953).

⁶ *Id.* at 868.

⁷ *Id.*

a pitcher's stance⁸ and player statistical information and accomplishments.⁹ Judicial (as well as statutory) recognition and enforcement of a broad exclusive property right protected by state law provided all athletes and celebrities with the ability to command substantial royalties for the licensed use of their names, likenesses, and other aspects of their persona, as well as to prevent unauthorized usage and to recover resulting damages. For example, a New York court found that the sale of clothing with a group portrait of the 1969 World Series Champion New York Mets without the permission of the individual players constituted infringement.¹⁰

On the other (gloved) hand, courts have kept the right of publicity within the ballpark in order to facilitate sports memorabilia commercial transactions, thereby reducing their costs to consumers. Applying the "first-sale doctrine" to enable the sale of authorized sport trading cards, the United States Court of Appeals for the Eleventh Circuit stated:

A holding that the first-sale doctrine does limit the right of publicity, on the other hand, would not eliminate completely a celebrity's control over the use of her name or image; the right of publicity protects against unauthorized use of an image, and a celebrity would continue to enjoy the right to license the use of her image *in the first instance*—and thus enjoy the power to determine when, or if, her image will be distributed. Appellants in this case, for example, have received sizable royalties from the use of their images on the trading cards at issue, images that could not have been used in the first place without permission. [The] application of the first-sale doctrine to limit the right of publicity under Alabama law will maintain the appropriate balance between the rights of celebrities in their identities and the rights of the public to enjoy those identities¹¹

⁸ *Newcombe v. Adolf Coors Co.*, 157 F.3d 686, 692-93 (9th Cir. 1998).

⁹ *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1278-79 (D. Minn. 1970).

¹⁰ *Shamsky v. Garan, Inc.*, 632 N.Y.S.2d 930 (N.Y. Sup. Ct. 1995).

¹¹ *Allison v. Vintage Sports Plaques*, 136 F.3d 1443, 1449 (11th Cir. 1998) (footnote omitted). *See also* *Upper Deck Authenticated, Ltd. v. CPG Direct*, 971 F. Supp. 1337, 1341 (S.D. Cal. 1997); *Major League Baseball Players Ass'n v. Dad's Kid Corp.*, 806 F. Supp. 458, 460 (S.D.N.Y. 1992).

Other courts have ruled that federal copyright law and/or the First Amendment preempts state right of publicity laws, thereby enabling the production of collateral products and providing consumers with a broad range of products and services that otherwise might not be available or would cost more. In *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, the Court of Appeals for the Seventh Circuit found that players' performance in games is within the scope of their employment and ruled that federal copyright law preempts their ability to enforce state law publicity rights in televised game performances.¹² Courts have held that the First Amendment strikes out right of publicity claims asserting exclusive rights that would preclude the unauthorized production of products and services incorporating baseball players' names, likenesses, and achievements in collateral products that do not cause a likelihood of consumer confusion regarding their approval, endorsement, or sponsorship by a player or group of players.

In *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, the Court of Appeals for the Tenth Circuit held that parody trading cards featuring caricatures of Major League Baseball players do not infringe player publicity rights:

One of the primary goals of intellectual property law is to maximize creative expression. The law attempts to achieve this goal by striking a proper balance between the right of a creator to the fruits of his labor and the right of future creators to free expression. Underprotection of intellectual property reduces the incentive to create; overprotection creates a monopoly over the raw material of creative expression. The application of the Oklahoma publicity rights statute to Cardtoons' trading cards presents a classic case of overprotection. Little is to be gained, and much lost, by protecting MLBPA's right to control the use of its members' identities in parody trading cards. The justifications for the right of publicity are not nearly as compelling as those offered for other forms of intellectual property, and are particularly unpersuasive in the case of celebrity parodies. The cards, on the other hand, are an important form of entertainment and

¹² *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 669-70 (7th Cir. 1986).

social commentary that deserve First Amendment protection.¹³

Similarly, in *Gionfriddo v. Major League Baseball*, a California appellate court ruled that Major League Baseball (MLB)'s use of retired players' names, voices, signatures, photographs, and likenesses on websites, documentaries, and game day programs is noncommercial speech accorded full First Amendment protection:

The right to exploit commercially one's celebrity is primarily an economic right. The challenged uses involve statements of historical fact, descriptions of these facts or video depictions of them. Plaintiffs never suggest how Baseball's actions impair their economic interests. It appears equally likely that plaintiffs' marketability is enhanced by Baseball's conduct challenged here. Balancing plaintiffs' negligible economic interests against the public's enduring fascination with baseball's past, we conclude that the public interest favoring the free dissemination of information regarding baseball's history far outweighs any proprietary interests at stake.¹⁴

In *C.B.C. Distribution & Marketing, Inc. v. Major League Baseball Advanced Media, L.P.*, the Court of Appeals for the Eighth Circuit extended *Cardtoons* and *Gionfriddo* as well as overruled *Uhlaender* by holding that the producer of a fantasy baseball game has the First Amendment right to use the names of MLB players and their statistics without a license and the payment of royalties:

[T]he information used in CBC's fantasy baseball games is all readily available in the public domain, and it would be strange law that a person would not have a first amendment right to use information that is available to everyone. It is true that CBC's use of the information is meant to provide entertainment, but "[s]peech that entertains, like speech that informs, is protected by the First Amendment because '[t]he

¹³ *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996).

¹⁴ *Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307, 317-18 (Cal. Ct. App. 2001) (internal citation omitted).

line between the informing and the entertaining is too elusive for the protection of that basic right.”¹⁵

In summary, courts have correctly called balls and strikes in baseball-related cases by appropriately balancing the scope of an individual’s exclusive publicity rights under state laws with the rights of others and the public under federal copyright law and the First Amendment. This baseball right of publicity jurisprudence has established a paradigm that other cases seem to be following. Consistent with *Baltimore Orioles*, courts have ruled that a broadcast of a team or individual performer sports event is a collateral product that does not infringe participating athletes’ publicity rights¹⁶ unless the broadcasters use the event to advertise, identify, or promote a separate unrelated product or service.¹⁷ Courts have held that video games, with avatars

¹⁵ C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P., 505 F.3d 818, 820, 823 (8th Cir. 2007) (quoting *Cardtoons*, 95 F.3d at 969).

¹⁶ See, e.g., Ray v. ESPN, Inc., 783 F.3d 1140, 1143-44 (8th Cir. 2015) (rejecting professional wrestler’s claim that rebroadcast of his performance violated his right of publicity, finding it is preempted by copyright law); *Marshall v. ESPN Inc.*, No. 3:14-01945, 2015 WL 3606645 at *11 (M.D. Tenn. June 8, 2015) (under Tenn. law, intercollegiate athletes do not have a right of publicity when participating in televised sports events that are produced by others); *Dryer v. NFL*, 55 F. Supp. 3d 1181, 1186, 1193, 1201-02 (D. Minn. 2014) (NFL’s use of former players’ names and images in “compilations of clips of game footage into theme-based programs describing a football game or series of games and the players on the field” is protected by the First Amendment as non-commercial, expressive works; productions incorporated copyrighted game footage, therefore federal copyright law preempted plaintiff’s right of publicity claims because they were not used to advertise a separate, unrelated product); *Somerson v. McMahon*, 956 F. Supp. 2d 1345 (N.D. Ga. 2012). But see *In re NCAA Student–Athlete Name & Likeness Licensing Litig.*, 990 F. Supp. 2d 996 (N.D. Cal. 2013) (college football and basketball players’ right of publicity claims arising out of alleged unauthorized usage of their images in televised game footage are not automatically preempted by the First Amendment or Copyright Act). Following *C.B.C.*, in *CBS Interactive Inc. v. Nat’l Football League Players Ass’n, Inc.*, 259 F.R.D. 398, 417 (D. Minn. 2009), the court ruled that the unauthorized use of NFL players’ names and statistics in a fantasy football game does not infringe players’ publicity rights because this “package of player information . . . is no different.”

¹⁷ In one case, the defendant made a videotape of a professional golfer’s hole-in-one and used his name to promote its hole-in-one fundraising competitions. *Pooley v. Nat’l Hole-in-One Ass’n*, 89 F. Supp. 2d 1108, 1110 (D. Ariz. 2000). Denying the defendant’s motion to dismiss the plaintiff’s right of publicity claim, the court held:

. . . while Plaintiff’s hole-in-one at the Bay Hill Classic was open to national observation and public videotaping, its *subsequent* unauthorized reproduction was not automatically privileged simply because the hole-in-one continued to be a “newsworthy” event. Defendant did not create the videotape in connection with a news

incorporating college athletes' real-life physical characteristics and wearing their respective university team jerseys with the same numbers, do not constitute transformative works protected by the First Amendment and do not infringe on players' publicity rights.¹⁸ In doing so, courts have implicitly analogized videogames to baseball cards with photographs of players in their team uniforms, thereby effectively adopting *Haelan Laboratories's* holding that "a man has a right in the publicity value of his photograph"¹⁹ and distinguishing *Cardtoons* by determining that college athletes' right to "the fruits of [their] labor" outweigh "the right of [videogame manufacturers] to free expression."²⁰

account. Defendant did not include Plaintiff's name and videotape footage simply to communicate an idea. It capitalized on Plaintiff's name, reputation, and prestige in the context of an advertisement. The promotional videotape went one step further and implied a false connection between the Plaintiff and its business. The Court finds that the use of Plaintiff's identity was strictly commercial and not protected by the First Amendment."

Id. at 1114.

¹⁸ *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1271-72 (9th Cir. 2013); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 170 (3d Cir. 2013).

¹⁹ *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

²⁰ *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996).