



IDENTITY CRISIS

BY J. ALEXANDER JOHNSON

The NCAA has used the names and likenesses of some players during and after their collegiate athletic careers without compensating them. In 2009, former UCLA basketball star Ed O'Bannon sued—and others have followed suit. Do they have a case?

MANY EVENINGS, THE BREAKING NEWS ON ESPN, XFINITY, OR SOME OTHER SPORTS CHANNEL IS OFTEN ABOUT AN INCREASE IN THE NUMBER OF LAWSUITS INVOLVING ATHLETES, UNIVERSITIES, AND ATHLETIC ORGANIZATIONS.

One case in particular questions the National Collegiate Athletic Association's bylaws and procedures regarding payment of student-athletes. The pivotal question rests on the NCAA's use of the athlete's name, image, or likeness during and after his or her collegiate athletic career.

In 2009, former UCLA basketball star Ed O'Bannon sued the NCAA and the Collegiate Licensing Company. The basis of the lawsuit was the NCAA's failure to compensate O'Bannon *during and after his collegiate athletic career* for the use of his name, image, and likeness on trading cards, DVDs, video games, and other materials.¹ Subsequently, the O'Bannon lawsuit was consolidated with a lawsuit brought by former University of Nebraska quarterback Sam Keller to form what is now styled *In Re: NCAA Student-Athlete Name and Likeness Litigation*.² On July 5, 2013, U.S. District Judge Claudia Wilken, sitting in the Northern District of California, ruled that the plaintiffs' attorneys would be allowed to amend their complaint to include current college athletes. On July 18, 2013, the plaintiffs added Vanderbilt linebacker Chase Graham, Clemson cornerback Darius Robinson, University of Arizona linebacker Jake Fischer and kicker Jake Smith, as well as University of Minnesota tight end Moses Alipate and wide receiver Victor Keise. They joined 16 former NCAA athletes already listed as plaintiffs.

In the consolidated lawsuit, commonly referred to as *O'Bannon*, the plaintiffs allege that the NCAA and its business partners made agreements that unreasonably restrain trade in violation of the Sherman Act, and that the NCAA deprives former student-athletes of their right of publicity.³ Keller and O'Bannon contend that, through these agreements, the NCAA prevents student-athletes from entering the licensing market and negotiating a price in exchange for their right of publicity. In addition, the plaintiffs argue that the NCAA's profits from these agreements constitute unjust enrichment. To prevail on their Section I Antitrust claim, Keller and O'Bannon must show that (1) an agreement was made; (2) the agreement unreasonably restrains trade under a rule of reason analysis; and (3) the restraint affects interstate commerce.⁴ The court has determined that a relevant and sufficient market exists to support a Sherman Act claim. But, see *Agnew v. National Collegiate Athletics Association*, where the 7th U.S. Circuit Court of Appeals affirmed a decision by a district court to dismiss a claim for failure to identify a relevant market in which the NCAA allegedly committed violations of the Sherman Act.⁵

The NCAA dominates regulation of intercollegiate sports, making it virtually impossible for colleges and universities to engage in competition without complying with the myriad requirements it promulgates. The NCAA offers two principal reasons for the restrictions on payments to student-athletes: (1) maintaining amateurism and (2) preserving competitive balance.

At the core of the plaintiffs' unjust enrichment claim is form 08-3a, which is required to be signed at the beginning of each year by each student-athlete. This form authorizes the NCAA to use the athlete's name or picture to promote NCAA championships and other NCAA events and programs. A student-athlete cannot participate in intercollegiate athletics until he or she has signed this form. O'Bannon and Keller claim this agreement restricts and precludes the student-athlete's ability to use his or her name, image, or likeness for commercial purposes, *particularly after graduation*. Moreover, the plaintiffs dispute that the signing of form 08-3a by each student-athlete gives the NCAA a right of publicity for commercial purposes.

If the plaintiffs prevail in their lawsuit, any right of publicity agreements between the NCAA and current student-athletes would be null and void. College sports are big business and have become a billion-dollar industry. In fact, the NCAA recently signed a \$10.8 billion, 14-year TV contract with CBS and Turner Broadcasting.

DISTINCTION OF RIGHTS

The right of publicity is a protectable property interest in one's name, identity, or persona. Every person—celebrity or non-celebrity—has a right of publicity that is the right to own, protect, and commercially exploit one's identity. The genesis of the legal right of publicity is rooted in the right of privacy.⁶ Privacy and publicity rights become entwined when an appropriation of another's name or likeness for one's own benefit occurs without permission.⁷ Notwithstanding, the right of privacy is distinguishable because it is a personal right, non-assignable, and terminates at death.

To further illustrate the difference and similarity between privacy and publicity rights, a photograph in an advertisement that causes injury to the plaintiff's feelings and dignity, resulting in mental or physical damages, implicates the right of privacy. Failing the elements of mental or physical injury invokes the right of publicity. It is the legal right to exploit for commercial purposes one's own name, character traits, likeness,⁸ or other indicia of identity. Depending on state law, a caricature,⁹ popular phrase ("Here's Johnny"),¹⁰ sound-alike voice,¹¹ name in a car commercial,¹² animatronic likeness,¹³ and statistics of professional baseball players¹⁴—all used without consent—have been held to come within the ambit of publicity rights and constitute infringement.

PROPRIETARY INTEREST

An individual has the right to control, direct, and commercially use his or her name, voice, signature, likeness, or photograph. Publicity rights may include the right to assign, transfer, license, devise, and enforce the same against third parties. Today, 19 states have regional publicity statutes,¹⁵ which differ widely, and at least a half dozen more, by common law. Thirteen states do not recognize the right of publicity.¹⁶ It is the commercial value, together with the commercial exploitation, without prior consent, that triggers a cause of action. The unauthorized use in a commercial context engenders money damages or equitable relief by way of an injunction or both.

PENDENT JURISDICTION

Unlike other fields of intellectual property law, there is no federal statute or federal common law governing rights of publicity. Nevertheless, federal claims of unfair competition and false advertisement or false endorsement under the Lanham Act,¹⁷ together with a state claim of publicity, can be asserted in federal court under pendent jurisdiction. A prevailing party, in appropriate circumstances, can collect treble damages, costs, and attorneys' fees on Lanham Act claims in establishing unfair competition, dilution, or the likelihood of public confusion.¹⁸ Where the defendant's activities are also a willful disregard of the plaintiff's rights, punitive damages are warranted.¹⁹

CONSTITUTIONAL PROTECTION

Reporting newsworthy events or newsworthiness, with nonconsensual use of a name or photo in a magazine, is afforded First Amendment guarantees of freedom of speech and the press.²⁰ There is no violation of publicity rights. It is this newsworthy dimension or article of public interest that provides constitutional protection, even for a newspaper selling promotional posters of NFL Quarterback Joe Montana's four Super Bowl Championships.²¹ In this example, the posters were reproductions of actual pages of the newspaper. The California Court of Appeals opined that the posters depicted newsworthy events and the newspaper had a right to promote itself with them.

Similarly, a publisher of an artist's work depicting Tiger Woods's likeness entitled "The Masters of Augusta," is afforded First Amendment protection based on "fine art,"²² despite the fact that 5,250 copies of the print had been sold. The court found that the art print was not a mere poster or item of sports merchandise but rather an artistic creation seeking to express a message. Further, the right of publicity does not extend to prohibit depictions of a person's life story in a television miniseries,²³ book,²⁴ or film.²⁵ How is it that celebrities may prevent the use of their visual and audio images yet cannot stop authors from writing about them? The courts do not draw a clear path between commercial exploitation and protected

expression. In this morass, questions abound and answers elude.

Not only do the publicity statutes in 19 states vary widely, but their post-mortem protections do also. For example, Kentucky's remain for 50 years; Ohio's last 60 years; and Tennessee sticks to 10 years with a potential perpetual right, so long as there is no nonuse for two consecutive years. New York does not recognize a post-mortem right of publicity. In 2007, California amended its statute to include deceased personalities. It provides a cause of action for the unauthorized use of a deceased personality's name, voice, signature, photograph, or likeness for commercial purposes within 70 years of the personality's death.²⁶ Is it now time for a uniform federal statute governing the rights of publicity?

In *Cobb v. Time, Inc.*,²⁷ Randall "Tex" Cobb, a former professional boxer, sued *Sports Illustrated* for an article describing his alleged participation in drug use and a fixed boxing match. The 6th U.S. Circuit Court of Appeals affirmed summary judgment of the district court based on the actual malice standard because Cobb was a public figure.

CONCLUSION

O'Bannon's antitrust lawsuit against the NCAA challenges the right of the NCAA, the Collegiate Licensing Company, and EA Sports to use student-athletes' likenesses without paying them. It is interesting to note that the plaintiffs include National Basketball Association Hall of Fame legends Bill Russell and Oscar Robertson. In August, it was reported that University of Michigan Heisman legend Desmond Howard was considering joining the O'Bannon suit.

Also, in September 2013, former University of Tennessee football players Chris Walker and Ben Martin and former North Carolina State University player Dan Ahern filed a class-action lawsuit against the NCAA in federal court in Chattanooga, Tennessee. They allege that the NCAA failed to educate football players about the long-term, life-altering risks of head impacts and did not establish known protocols to prevent, mitigate, monitor, diagnose, or treat brain injuries. The plaintiffs are seeking a NCAA-funded, medical-monitoring program for the lifelong risks of brain injury.

The First Amendment requires that the right to be protected from unauthorized publicity be balanced with the public interest in the dissemination of news and information. This is congruent with democratic processes under the constitutional guarantees of freedom of speech and the press. Not all commercial unauthorized uses of identity violate the right of publicity. Violations depend on how the identities are used in a commercial context. Is the use solely to promote, sell, or endorse products and services, or is it a fair use? In particular, is it fair that student-athletes be required to sign form 08-3a in order to participate in collegiate athletics? The ultimate answer will be based

on the facts and circumstances of each case.

On Sept. 27, 2013, Electronic Arts and Collegiate Licensing Company, the other defendants in the O'Bannon case, tentatively settled the plaintiffs' claims against them for \$40 million, which is subject to court approval and a plan of acceptable distribution to the players. This leaves the NCAA as the lone defendant.

On Oct. 25, 2013, Judge Wilken denied a motion by the NCAA to dismiss the O'Bannon lawsuit. In her 24-page opinion, she indicated that the case should not be bound by the NCAA's contention to preserve amateurism and that the allegations in the complaint are sufficient to state a Section I Sherman Act antitrust claim. Moreover, Judge Wilken stated that neither the First Amendment nor the California Civil Code requires dismissal of the plaintiffs' antitrust claims. In light of this, the NCAA filed documents asking the U.S. Supreme Court to review a federal appeals court ruling against the video game maker Electronic Arts, which involves the use of college athletes' names and likenesses. The NCAA was not a party to that settlement but has an interest in the case because of its involvement at the district court level. It can be gleaned that the issues here are critical to its position in the O'Bannon lawsuit.

In early November 2013, Judge Wilken partially certified class-action status in *O'Bannon v. NCAA* involving current and future college athletes but not former ones.

And in the latest development, on Nov. 20, 2013, the NCAA filed a lawsuit against Electronic Arts and the Collegiate Licensing Company.

Fame is valued. The right of publicity protects the athlete's proprietary interest in the commercial value of his or her identity from exploitation by others.²⁸ Therein lies the question that the court has to determine in the O'Bannon case. The crux of the right of publicity is the commercial value of human identity.

It is possible that the NCAA's guiding principle of preserving amateurism will engender a call from the striped-shirt people on the basketball floor and the football field: *FOUL!* If that happens, there will be significant changes in the NCAA landscape. The days of competition "for the love of the game" at the collegiate level could become a joy of the past. **TBJ**

This article is dedicated to L. Giles Rusk of Tyler, Texas—mentor, friend, and co-counsel who taught me by example fundamentals, ethics, and professional acumen.

NOTES

1. *O'Bannon v. Nat'l Collegiate Athletics Ass'n*, No. C 09-3329 CW, 2009 WL 4899217 (N.D. Cal. Dec. 11, 2009).
2. *In Re: Student-Athlete Name & Likeness Licensing Litig.*, No. CW, 2010 WL 5644656 (N.D. Cal. Dec. 17, 2010).
3. *Id.*
4. 15 U.S.C. Ch.1 § 1 et seq.
5. *Agnew v. Nat'l Collegiate Athletics Ass'n*, 683 F.3d (7th Cir. 2012).
6. *Robertson v. Rochester Folding Box Co.*, 171 N.Y. 538, 64 N.E. 442 (1902). —rejected the common law right of publicity, which led to the enactment of the

New York privacy law, codified in the New York Civil Rights Law, 1903, N.Y. Civ. Rights, §§50-51; *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905). —first state to recognize a personal privacy right against unauthorized commercial exploitation; *Pallas v. Crowley Milner and Co.*, 322 Mich 411, 33 N.W. 2d 911(1948). —Supreme Court of Michigan recognizes a right of publicity where invasion of privacy was pleaded in preventing the nonconsensual use of a model's photograph in a local department store advertisement. The plaintiff was not a nationally known celebrity. Michigan recognizes publicity rights through a derivative privacy right at common law. —*Janda v. Riley-Meggs Industries, Inc.*, 764 F. Supp 1223 (E. D. Mich 1991)., *Haelan Laboratories v. Topps Chewing Gum* is the seminal case that coined the term "right of publicity." 202 F.2d 866 (2d Cir. 1953)., cert. denied, 346 U.S. 816 (1953).

7. *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031 (1986). —demonstrates the labyrinth of intellectual property rights in publicity issues such as copyright infringement and trademark dilution.
8. *Newcombe v. Coors*, 157 F.3d 686 (9th Cir. 1998). —Don Newcombe's stance and windup of the Brooklyn Dodgers, displayed in a drawing in *Sports Illustrated* created a triable issue of fact whether Newcombe is readily identifiable as the pitcher in the beer advertisement. It is interesting to note that Don Newcombe (Cy Young Award, MVP, and Rookie of the Year) is the only player in major league history to have won all three awards.
9. *Titan Sports, Inc. v. Comics World Corp.*, 870 F.2d 85 (2d Cir. 1989).
10. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983).
11. *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1986), *Waits v. Frito Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992).
12. *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407 (9th Cir. 1996).
13. *Wendt v. Host International Inc.*, 125 F.3d 806 (9th Cir. 1997), *White v. Samsung Electronics America Inc.*, 971 F.2d 395 (9th Cir. 1992); 989 F.2d 1512 (9th Cir. 1993).
14. *Uhlaender v. Hendricksen*, 316 F. Supp. 1277 (Minn. 1970).
15. California: Cal. Civ. Code §3344; Florida: Fla. Stat. Ann. §540.08; Illinois: 765 Ill. Comp. Stat. §1075/30; Indiana: Ind. Code 32-36-1-1; Kentucky: Ky. Rev. Stat. Ann. §391.170; Massachusetts: Mass. Gen. L. Ann., ch 214, §3; Nebraska: Neb Stat. §§20-201-20-211 and 25-840.01; Nevada: Nev. Stat. §§597.77-597.810; New York: N.Y. Civ. Rights L. §§50-51 N. Y. Gen. Bus. L. §397; Ohio: Ohio Rev. Code Ann. §2741.04; Oklahoma: 21 Okla. Stat. §§839.1-839.3; 12 Okla. §§ 1448-1449; Rhode Island: R.I. Gen Laws §9-1-28; Tennessee: Tenn. Code Ann. §§47-25-1101-47-25-1108; Utah: Utah Code Ann. §§45-3-1; Virginia: Va. Code Ann. §§8.01-40, 18.2-216; Washington: Wash. Rev. Code §§63.60.030-63.60.037; Wisconsin: Wis. Stat. Ann. §§ 895.50; in Texas the tort of misappropriation protects a person's persona and the unauthorized use of one's name, image, or likeness. *Brown v. Ames*, 201 F.3d 654 (5th Cir. 2000), post-mortem right of publicity: Tex. Prop.Code §§ 26.001-26.015.
16. Alaska, Arizona, Connecticut, Idaho, Louisiana, Mississippi, New Hampshire, New Mexico, North Dakota, Oregon, South Carolina, Vermont, and Wyoming.
17. Lanham Act § 43(a), 15 U.S.C. § 1125(a).
18. 35(a), 15 U.S.C. §1117(a).
19. *Frazier v. South Florida Cruises, Inc.*, 19 U.S.P.Q. 2d (BNA) 1470 (E.D. Pa. 1991). —defendant placed a full-page unauthorized advertisement in *Ring Magazine* inviting the public to cruise with former world heavyweight champion, Smokin' Joe Frazier; Cecil Fielder, three-time MLB All-Star in 2003 won more than \$400,000 against a design firm for using his name without permission in commercial ads.
20. *Neff v. Time, Inc.*, 406 F. Supp. 858 (W.D. Pa. 1976); See, *Joe Dickerson & Assoc. v. Ditmar*, 34 P. 3d 995 (Colo. 2001). —Colorado Sup. Ct. recognizes the tort of invasion of privacy by appropriation of name or likeness subject to First Amendment privilege where the use involves publication of matters that are newsworthy or of legitimate public concern.
21. *Montana v. San Jose Mercury News Inc.*, 34 Cal. App. 4th 790 (1995)., See e.g., *Hogan v. Hearst*, 945 S.W.2d 246 (Tex. App. 1997). —exemplifying the breadth of the newsworthy exception in negating a claim of invasion of privacy based on disclosure of highly embarrassing facts, obtained from a public record; *Peckham v. Boston Herald, Inc.*, 719 N.E. 2d 888 (Mass. App. Ct. 1999). —defense summary judgment on basis of newsworthiness to a statutory private facts claim.
22. *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915 (6th Cir. 2003); See, *Comedy III Productions, Inc. v. Saderup, Inc.*, P. 3d 797 (Cal. 2001). —a T-shirt artist's realistic drawing of the Three Stooges was not sufficiently transformative to defeat a claim of California's publicity rights statute.
23. *Ruffin-Steinbeck v. dePasse*, 82 F. Supp. 2d 723 (E.D. Mich. 2000).
24. *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996). —applying Pennsylvania law.
25. *Matthews v. Wozencraft*, 15 F.3d 432 (5th Cir. 1994). —applying Texas law.
26. Cal. Civ. Code § 3344.1.
27. 278 F.3d 629 (6th Cir. 2002).
28. *O'Brien v. Pabst Sales, Co.*, 124 F.2d 167, 170 (5th Cir. 1941). —famed Heisman quarterback and Philadelphia Eagle opened the door to the professional athlete's right of publicity.

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