

WHERE INTELLECTUAL PROPERTY AND FREE SPEECH COLLIDE

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The idea for this symposium came about several summers ago when Joe Liu, Fred Yen, and I met for coffee to talk about the right of publicity, and more specifically, about a pending case involving the unlicensed use of baseball players' names and statistics in a "fantasy baseball" league.¹ All three of us teach the right of publicity in our classes—Joe and Fred in their intellectual property courses, and I in my media law class—but we approach the common law tort from very different perspectives.

I am a First Amendment scholar, and the right of publicity often seems in conflict with everything I know about the freedom of expression. Except for those cases involving fraudulent commercial endorsement, the right of publicity seems largely unsupportable. After all, the Supreme Court's First Amendment jurisprudence is full of cases that privilege the expressive interests of third parties over plaintiffs' interests in reputation² or privacy,³ and parody gets absolute protection as long as no reasonable person would regard it as presenting actual facts about the plaintiff.⁴ The U.S. Supreme Court has specifically addressed the intersection of the right of publicity and the First Amendment in

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¹ See generally *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 443 F. Supp. 2d 1077 (E.D. Mo. 2006), *aff'd*, 505 F.3d 818 (8th Cir. 2007).

² *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964) (holding that public officials' reputational interests had to give way to the First Amendment even in cases involving the publication of false information, unless the publication was made with actual malice).

³ See, e.g., *Bartnicki v. Vopper*, 532 U.S. 514, 529–35 (2001) (concluding that the application of the federal wiretapping statute to the disclosure of illegally intercepted conversation on issue of public concern violated First Amendment); *Fla. Star v. B.J.F.*, 491 U.S. 524, 530–41 (1989) (rejecting privacy claim based on publication of rape victim's name); *Smith v. Daily Mail Publ'g Co.*, 443 U.S. 97, 837–46 (1979) (striking down statute barring the publication of the identities of juvenile offenders); *Landmark Commc'ns, Inc. v. Virginia*, 435 U.S. 829, 837–46 (1978) (rejecting as unconstitutional a statute that penalized publications that reported on confidential judicial misconduct proceedings).

⁴ See *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 57 (1988) (holding that a public official cannot recover for intentional infliction of emotional distress based on parody advertisement that was not reasonably believable); *Time, Inc. v. Hill*, 385 U.S. 374, 387–88 (1967) (holding that false light invasion of privacy claims must satisfy "actual malice" standard).

only one case, *Zacchini v. Scripps-Howard Broadcasting Co.*,⁵ but there the Court took pains to limit its holding to the unique facts of the case, where the plaintiff's "entire act" was broadcast, arguably damaging his livelihood by reducing the chance that people would pay money to come see his performance live.⁶

I sought out Joe and Fred's guidance to help me figure out what I was missing in my understanding of the right of publicity. When we met, both Fred and Joe indicated that they too were skeptical about some of the right of publicity cases that have been decided through the years—like the famous Vanna White case⁷—but my impression was that the very existence of the right did not seem quite as odd to them. I suppose that given their background in intellectual property law, it simply did not strike them as bizarre that the law would grant priority to someone's alleged economic interests over the expressive interests of third parties.

In the fantasy baseball league case that brought us together, the league sought a declaratory judgment that its use of players' names and statistics would not violate Major League Baseball's right of publicity. The U.S. District Court for the Eastern District of Missouri ruled in the league's favor, holding that the players' right of publicity was not implicated because the use of the players' names and playing records somehow did not constitute use of their persona and identity.⁸ Although I agreed with the outcome, I found the court's reasoning unsatisfying and, frankly, incoherent. Clearly the league was using the players' identities, but under my view of the First Amendment, it makes no sense that a player could recover for the use of true facts that were readily available in the public domain. A year or so later, the U.S. Court of Appeals for the Eighth Circuit affirmed the district court's judgment on First

⁵ 433 U.S. 562, 578 (1977).

⁶ See Roberta Rosenthal Kwall, *A Perspective on Human Dignity, the First Amendment, and the Right of Publicity*, 50 B.C. L. REV. 1345, 1356 (2009) (noting that it is easy to read *Zacchini*'s holding as limited to its facts); Diane Leenheer Zimmerman, *Money as a Thumb on the Constitutional Scale: Weighing Speech Against Publicity Rights*, 50 B.C. L. REV. 1503, 1519–20 (2009). I remain unconvinced that the right of publicity should trump First Amendment interests even in such limited circumstances, and in any event, as Diane Zimmerman notes in her Article, most right of publicity cases bear little resemblance to the facts of *Zacchini*. *Id.*

⁷ *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399, 1401 (9th Cir. 1992) (reversing summary judgment dismissal of Vanna White's common law right of publicity and Lanham Act claims against Samsung, which used a robot with a blond wig on a Wheel of Fortune set in a number of advertisements).

⁸ *C.B.C. Distrib. & Mktg., Inc.*, 443 F. Supp. 2d at 1089. The court bizarrely suggested that only use of the players' pictures would meet that standard. *Id.* at 1087.

Amendment grounds,⁹ but the decision was in tension with Missouri law the federal court was bound to apply.¹⁰ In addition, the decision did nothing to eliminate the great debate about how much of a role the First Amendment should play in limiting the right of publicity.¹¹

Since that summer of the fantasy baseball case, Joe, Fred, and I—as well as David Olson, who joined the Boston College faculty in 2007—have continued to have informal discussions about the interaction of the right of publicity and intellectual property law and the First Amendment. As these conversations continued, it was blatantly clear that we all had a lot more to learn about each other's field (or at least I had a lot to learn from all of them). We thought it would be fascinating to have a conference that would encourage a more formal and more rigorous discussion of whether, and how, to weigh First Amendment interests in cases involving the right of publicity, privacy law, and intellectual property law. We pitched our idea to the *Boston College Law Review* editors, and we were pleased when they agreed that it would be a great topic for a symposium.

In April 2009, a remarkable group of scholars gathered at Boston College Law School for a symposium titled *Publicity, Privacy, and Intellectual Property Meet the First Amendment*. The participants focused on First Amendment rights not only in right of publicity cases, but also in defamation, privacy, trademark, and copyright cases. Rather than have a multitude of speakers on each topic—defamation and privacy law, trademark law, the right of publicity, and copyright law—we decided to invite just two speakers on each topic so that we could devote a substantial amount of time to the presentation and discussion of each paper. The end result was a full day of fascinating dialogue that led to the series of thought-provoking Articles appearing in this special symposium issue.

This issue begins with two articles addressing current problems with speech on the Internet. Larissa Lidsky offers an overview of the evolution of libel lawsuits against anonymous “John Does,” where courts have struggled to balance the First Amendment right to anonymous speech against a plaintiff's right to recover for damage to reputation. Lidsky notes that these lawsuits pose a dramatic chilling effect not

⁹ The appellate court concluded that the fantasy baseball league clearly did use the players' identities for commercial gain, but the players' right of publicity claims were outweighed by First Amendment considerations. See *C.B.C. Distribution & Mktg., Inc.*, 505 F.3d at 822–24 (8th Cir. 2007).

¹⁰ See Zimmerman, *supra* note 6, at 1513.

¹¹ For a fuller discussion of the various theories courts and commentators have developed, see Kwall, *supra* note 6, at 1357–64.

merely on libelous speakers, but also on those expressing “uncomfortable truths and constitutionally protected opinions.”¹² Lidsky reports that in the last few years, courts have generally come to recognize the importance of putting some procedural obstacles in place before allowing the “unmasking” of anonymous speakers. Although the standard a plaintiff must meet varies from court to court, most courts require, at minimum, that a John Doe be given notice of the lawsuit and an opportunity to file a motion to quash in order to protect his anonymity. In addition, courts require plaintiffs to make some showing that their libel actions are viable.

Although these evolving standards offer greater protection for the First Amendment rights of “John Doe” defendants, Lidsky points out an even more heartening trend: the growing judicial understanding of the Internet as a communication medium and, as a result, more nuanced evaluations of plaintiffs’ defamation claims. As judges become more familiar with how people engage in expression on the Internet, they are more likely to take into account the context of the challenged expression when determining whether it is protected opinion, non-factual hyperbole, or actionable defamation. Lidsky expresses concern, however, that certain cases like *Doe I v. Individuals*, the so-called *AutoAdmit* case which involved “cybersmears,” tend to highlight the “dark side” of anonymous speech and will cause courts to retreat from granting strong protection to John Does.¹³ In addition, courts may grow frustrated with the limits of libel law, which do not offer the remedy wronged plaintiffs want most of all: the removal of the offensive material from the Internet. In other words, Lidsky is concerned that courts are moving away from striking the balance in favor of the First Amendment and instead are granting greater protection to reputation.

Like Larissa Lidsky, Lauren Gelman is concerned about the Internet and free speech interests. Gelman argues Web 2.0 technologies encourage people to share personal information with a social network of their friends and family while leaving it available for the entire world to see. She suggests that people are not natural exhibitionists; rather, they prefer to choose settings that make their information available to the world because they cannot define the boundaries of their social networks *a priori*. Gelman contends that social networking sites generally fail to provide adequate and appealing privacy protections, and as a

¹² Lyrrisa Barnett Lidsky, *Anonymity in Cyberspace: What Can We Learn from John Doe?*, 50 B.C. L. REV.1373, 1388 (2009).

¹³ 561 F. Supp. 2d 249 (D. Conn. 2008).

result, personal information is obtained by individuals outside of users' "blurry edged" social networks. This is problematic because people are generally deemed to have no right of privacy in information they have willingly exposed to public view. Unlike copyright law, which provides robust protection to copyright owners whose works are used without their consent, "owners" of private information have limited recourse under the law when their information is disseminated without their consent. Gelman cleverly proposes a technological fix for this legal problem that would permit social network users to notify third parties how they want their content used, and when those directions are not followed, allow aggrieved users to ask publishers to take down that content. Realizing that her "take down" proposal would be unenforceable under the current understanding of privacy torts and First Amendment doctrine, Gelman nevertheless argues that it would be useful because it would lead to new social norms against unwanted disclosure of private information.

Given that it was the right of publicity that provided the original impetus for the symposium, we were thrilled to have two of the nation's leading right of publicity scholars participate. In this issue, Diane Zimmerman and Roberta Rosenthal Kwall present radically different views on the value of the right of publicity. Zimmerman's Article focuses on the issue that has always concerned me in right of publicity cases: how to reconcile a robust right of publicity in non-advertising cases with the long line of Supreme Court cases giving much greater weight to First Amendment values than reputational harm, privacy interests, or emotional distress. She notes that although the right of publicity originated out of concern for "dignitary interests," plaintiffs have generally presented their right of publicity claims as ones where the defendants have unjustly obtained a financial benefit by trading on their personas.¹⁴ Zimmerman concludes that "property rights can take priority over speech rights if and when it can be shown that without speech restrictions, total market failure will result."¹⁵ In almost all right of publicity cases, she argues, there is no market failure. People will continue to create public personas even if the right of publicity is limited to those instances when the use of a celebrity's identity is unjust. Zimmerman concludes that the right of publicity can survive the First Amendment only when the alleged harms are "significant, highly particularized, and

¹⁴ Zimmerman, *supra* note 6, at 1505–06.

¹⁵ *Id.* at 1520.

non-speculative.”¹⁶ After all, she notes, the free speech rights of third parties are constitutional, while the vague economic and property rights that right of publicity claimants assert are not.

Unlike Zimmerman, Kwall does not limit her discussion of the right of publicity to the non-commercial context. Instead, she emphasizes the dignity interests at stake in many publicity actions involving the commercial appropriations of a celebrity’s identity that are not merely unauthorized but also objectionable, distasteful, and degrading. The dignitary harm is especially problematic when the use of a publicity plaintiff’s persona essentially amounts to compelled speech. By this Kwall means that the use of the plaintiff’s identity “forces” the plaintiff to say something that she does not believe, especially when the public would assume that the plaintiff has authorized the message. Kwall argues that it would make little sense to use the First Amendment to negate claims where this element is present given that one of the First Amendment’s purposes is to promote self-fulfillment and autonomy. Kwall’s contribution to this symposium is invaluable because it helps us think more deeply about what interest the right of publicity is designed to protect, a determination that is a necessary prerequisite to conducting any sort of First Amendment balancing.

In *Trade Secret Litigation and Free Speech: Is it Time to Restrain the Plaintiffs?*, Elizabeth Rowe asks whether trade secret litigation results in a chilling effect that so offends free-speech values as to justify placing special restrictions such litigation. Just as Lyrissa Lidsky argues that cases like the *AutoAdmit* case threaten to derail robust protections for anonymous speech on the Internet, Rowe concedes that trade secret cases like those by the Church of Scientology, which has invoked trade secret protection in order to stifle public discussion concerning its religious practices, have led to calls for substantive reform of trade secret law and a greater emphasis on First Amendment interests. Despite these “bad” cases, however, Rowe concludes that any chilling effect trade secret litigation might have on vigorous public debate is not unique to this area of the law but is instead the result of the broader problem of litigation abuse. Rowe argues that existing litigation safeguards can be used to minimize the risk to First Amendment interests.

In her article, Rebecca Tushnet also takes on the issue whether certain speech restrictions—in her case, the commercial speech doctrine—inappropriately skews public debate. Although trade secret doctrine inhibits the ability of outsiders to criticize a trade secret holder,

¹⁶ *Id.* at 1524.

the commercial speech doctrine restricts the ability of commercial entities to defend themselves in public debate. Tushnet considers the argument Nike made before the U.S. Supreme Court¹⁷ that a company should not be held, in essence, strictly liable for false factual statements it makes about itself. Otherwise, Nike claimed, its opponents would have an unfair advantage because they would be held to the lesser defamation standards of *New York Times Co. v. Sullivan*.

Tushnet insightfully points out that being on opposite sides of an argument does not, by itself, establish that the parties are equal, and that upon closer examination, the commercial speech doctrine does not in fact promote inequality. Tushnet notes that there are only three distinct groups that want to engage in speech about commercial entities or constrain the ability of those entities to make factual claims: consumers, other competitors, and the government. She concludes that the commercial speech doctrine does not place commercial actors at an unfair advantage vis-à-vis other competitors because both parties are held to the same standard. With respect to consumers, the doctrine actually helps level the playing field because consumers and commercial actors are not similarly situated. Commercial entities naturally have greater knowledge about their own activities, and they also generally have greater ability to access the media to respond to charges against them. Tushnet adds that abolishing the commercial speech doctrine would undermine false advertising and trademark laws.

Fred Yen and David Olson anchor the symposium with Articles on copyright law and the First Amendment. I must confess that this area of the law has always been a bit of mystery to me because it is fundamentally based on a concept foreign to First Amendment jurisprudence: that in the aggregate, a speech-restrictive law (here, copyright law) serves to encourage more speech than it discourages. In his symposium contribution, David Olson points out quite persuasively that, even in the copyright context, this assumption no longer necessarily holds true. Expanding the copyright term to the life of the author plus seventy years does not provide any greater, more meaningful incentive to create, and it dramatically limits the public domain of material that can be freely used. Although the idea/expression dichotomy and the fair use defense limit copyright protection somewhat, Olson argues more must be done to accommodate First Amendment interests.

Like David, Fred Yen agrees that current copyright doctrine—particularly the law governing third-party copyright liability—fails to take

¹⁷ Nike, Inc. v. Kasky, 539 U.S. 654, 656 (2003).

First Amendment interests adequately into account. By definition, the various doctrines of third-party copyright liability involve situations where the benefits of speaking are separated from the burdens of liability. As a result, intermediaries are more likely to chill otherwise protected speech in order to steer clear of the unlawful zone. Yen notes that in *Sullivan*, the Court concluded that erroneously restricting protected speech is worse than erroneously permitting libelous speech, and that this same sort of presumption should be adopted in copyright law. In order to be consistent with the First Amendment, Yen argues that third-party copyright laws should be applied less stringently so that more speech is tolerated, even if it means tolerating more copyright violations.

The Articles in this symposium issue are not the first to put the right of publicity, trade secret law, and copyright law under a First Amendment lens, but they provide an important contribution to this discussion. Perhaps even more valuably, this symposium brought together scholars in diverse fields to engage in a critical dialogue on these important issues. I hope that this symposium will serve as an impetus for more conversations between First Amendment and intellectual property scholars.

In closing, I would like to extend a special thanks to all those who supported and contributed to this symposium. In particular, the symposium's authors and commentators deserve special thanks for their insightful, engaging, and thoughtful comments throughout the symposium. I would also like to thank the *Boston College Law Review* for hosting this symposium and for carefully and thoughtfully editing the articles that appear in this issue. Finally, I must thank Fred Yen, Joe Liu, and David Olson for not only providing the inspiration for this symposium but also for investing their seemingly endless time and energy in developing its contours and inviting speakers. I am so grateful to have them as my colleagues.