

Sports Litigation Alert

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Fair Use or Foul Play by EA in Video Game Dispute?

By Jeffrey S. Kravitz, Esquire

The headache continues for Electronic Arts, Inc. (“EA”) as it faces yet another lawsuit involving its Madden NFL video game series. Tony Davis, a retired NFL running back, has filed a class action suit on behalf of approximately 6,000 former NFL players against EA in the U.S. District Court for the Central District of California over using their likenesses in its Madden NFL 09 video game. (Case No. 3:2010cv03328, filed on July 29, 2010.) Davis alleges that, although EA removed the players’ names from the video game characters’ jerseys and scrambled their jersey numbers, it included other aspects of their likenesses, such as height, weight, positions, and statistics, and therefore violated their right of publicity. However, even if EA used their likenesses, it may nevertheless have a defense grounded in the First Amendment right to freedom of expression. Which right will win: the players’ right of publicity or EA’s First Amendment right to freedom of expression?

Just last year, former NFL running back Jim Brown asserted similar claims in a suit against EA for using his likeness in the Madden NFL video games, but specifically that such use constituted false endorsement of the games under Lanham Act Section 43(a).

Citing *Video Software Dealers Ass’n v. Schwarzenegger*, 556 F.3d 950, 958 (9th Cir. 2009), the late Judge Florence-Marie Cooper of the U.S. District Court for the Central District of California dismissed his claims, holding that even if EA’s Madden NFL video games “do use Brown’s likeness, that use is protected by the First Amendment” because video games are a form of creative expression protected by the First Amendment. (Case No. 2:09-cv-01598-FMC-RZx, Order 5:17-19, 9:10-11, Sept. 23, 2009.) The case is on appeal. Also, former UCLA all-American basketball player Ed O’Bannon has sued the NCAA for similar violations in the gaming world.

However, Davis is suing under common law and statutory right of publicity claims rather than false endorsement. Should First Amendment protection nevertheless be similarly afforded to EA in Davis’ case?

To specifically address the balance between the right of publicity and the First Amendment, the California Supreme Court has suggested a “transformative elements” test, borrowed from part of copyright law’s fair use defense. In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 405 (2001), the California Supreme Court held that if a work contains significant transformative elements rather than a “literal depiction or imitation of a celebrity,” First Amendment protection outweighs whatever interest the state may have in enforcing the right of publicity. *Id.* at 405. Under this test, does EA’s use of the likenesses of Davis and other former NFL players involve significant transformative elements? Perhaps *Keller v. Electronic Arts, Inc.*, 2010 WL 530108 (N.D. Cal. 2010), in which the court applied this test, may provide some guidance.

Though *Keller* involved EA’s NCAA Football video game series (involving likenesses of amateurs rather than professionals), the Court’s discussion of the



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right of publicity and First Amendment could still be instructive on the application of the “transformative elements” test to video games. The likenesses allegedly used in the NCAA Football series are similar to those used in the Madden NFL series. In denying EA’s motion to dismiss, the Court held that EA’s use of the likeness of Sam Keller, a former Arizona State University quarterback, does not involve significant transformative elements, and thus EA is not protected under the First Amendment, because the virtual character that allegedly resembles Keller wears the same jersey number, is the same height and weight, and comes from the same home state. *Id.* at 5. Thus, the Court stated that “EA does not depict Keller in a different form; he is represented as what he was: the starting quarterback for Arizona State University.” *Id.*

However, is this the only way to define “transformative”? In *Perfect 10 v. Amazon.com, Inc.*, 508 F.3d 1146, 1165 (9th Cir. 2009), the Ninth Circuit held that Google’s display of thumbnail images of a copyright owner’s photographs was significantly transformative because the “search engine transform[ed] the original into a pointer directing an Internet user to a particular source of information.” Thus, it involved significant transformative elements by using the original in an entirely new context to serve a new purpose. *Id.* Can the same be said about EA’s use of Keller’s and Davis’ likenesses? Perhaps. It does not seem too far-fetched to argue that EA transforms the players’ likenesses into

video game characters (giving them an entirely new context) to be used and manipulated by video game players (serving a new purpose or function).

Ultimately, it does not seem like a slam dunk (or rather, touchdown) case for either side. Although Brown’s failed lawsuit involved false endorsement claims, perhaps Judge Cooper’s First Amendment reasoning in dismissing his suit may still provide some guidance. On the other hand, the “transformative elements” may need to be applied, as in *Keller*. However, even if Davis’ case is held up to that test, the result appears uncertain.

Perhaps EA should take every step to assure that none of its characters look like former NFL players whatsoever by, say, creating a 5’0”, 150-pound NFL offensive tackle in the video game. EA would not have to worry about infringing on anyone’s right of publicity if it did that, but its credibility could be sacrificed. Such a game would give new meaning the term “fantasy football.”

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